

Trademark Opposition Timelines: A Liberal Interpretation

In the case of *'Pioneer Electronic Corporation vs. M/S. Suse Electronics and Anr.'* (OA/52/2018/TM/DEL), the Intellectual Property Appellate Board ('IPAB') has had the opportunity to adjudicate a critical question of law connected with trademark opposition proceedings - whether or not Rule 51 of the Trade Mark Rules, 2002 ('Rules'), that permits a mere one month extension of time for filing evidence, is mandatory in nature.

Pioneer Electronic Corporation (represented by the Firm) had filed an application to register its well-known mark 'Pioneer' in Class 9, which was opposed by the respondent. At the time of filing 'evidence in support of its application', we also filed an Interlocutory Petition ('IP') to overcome the delay in filing the evidence basis Section 131 of the Trade Marks Act, 1999 ('Act'). Under the said provision, the Registrar of Trade Marks has discretionary power to extend any time period (which is not



expressly provided under the Act). The practice of filing an 'IP' has been in existence for several decades and, if cogent reasons to explain delay were provided, the Trade Marks Registry in earlier times allowed such petitions in the routine. In the extant matter, the appellant explained that the delay was on account of the fact that it was a multinational company and had to collate documents/exhibits from different sources and offices spread across the world.

Post a October 1, 2015 hearing, the Registrar of Trade Marks (*vide* order dated October 16, 2015) refused to take the appellant's evidence on record stating Rule 51 was mandatory in nature and that the Registrar lacked the discretionary power to allow more time beyond the prescribed one month extension under the said Rule.

The appellant filed an appeal before the IPAB, which remarked on the 10 year delay in opposition proceedings *vis-à-vis* the less than 4 week (well explained) delay on the part of the appellant in filing evidence. Turning to the statutory provisions under contention, it observed that Sections 21(1) and 21(2) of the Act clearly set out the time for filing a notice of opposition and counter statement. However, clause 4 of the said Section 21, which deals with filing of evidence, is silent on timelines. This implied that wherever the legislature wanted to prescribe a fixed timeline, it had specifically provided the same in the Act; for other provisions prescribing no specific timeline, the legislature had granted the Registrar of Trade Marks the discretionary power to extend timelines under Section 131 of the Act. Upon a harmonious reading of the Act and Rules, the IPAB ruled that the restriction pertaining to grant of extension for one month in

aggregate under Rule 51 is directory and not mandatory, and thus, the appellant could seek a further extension of time for filing evidence.

The Indian Trade Marks Registry has 5 offices across the country and until now, there was no uniform interpretation and application of law with regard to extension requests for filing evidence in opposition proceedings. This June 2020 judgment by the IPAB should go a long way in developing a synchronised approach.