IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

COMMERCIAL MISCELLANEOUS PETITION NO. 23 OF 2026
WITH
INTERIM APPLICATION NO. 2089 OF 2026
IN
COMMERCIAL MISCELLANEOUS PETITION NO. 23 OF 2026

Black Diamond Motors Pvt. Ltd. ...Petitioner

Versus

1. Registrar of Trade Marks, Mumbai

2. Black Diamond Track Parts Pvt. Ltd. ...Respondents

Mr. Hiren Kamod, *a/w Thomas George & Neeti Nihal, Tanvi Sinha, Navankur Pathak, Bargavi Bharadwaj, i/b Saikrishna & Associates, for Petitioner/Applicant.*

Mr. Atul Singh *a/w Arzoo Gupta & Mitika Agarwal, i/b Nidhi Bangera, for Respondent No.2.*

CORAM: SOMASEKHAR SUNDARESAN, J.

DATE: JUNE 17, 2026

JUDGEMENT:

Context and Factual Background:

1. The captioned Commercial Miscellaneous Petition is essentially a statutory appeal filed by the Petitioner, Black Diamond Motors Pvt. Ltd. ("***Registrant***"), under Section 91 of the Trade Marks Act, 1999 (***"TM Act***").

2. The Appeal is directed against an order dated August 26, 2025 ("***Impugned Order***") passed by Respondent No. 1, the Registrar of Trade Marks, Mumbai ("***Registrar***"), allowing an Interlocutory Application dated March 16, 2024 ("***Interlocutory Application***") filed by the Respondent No. 2, Black Diamond Track Parts Pvt. Ltd ("***Rectification Applicant***").

3. In a nutshell, in the course of conducting Rectification Proceedings, the Registrar has permitted an affidavit of evidence ("***Evidence Affidavit***") sought to be filed by the Rectification Applicant under Rule 45 of the Trade Marks Rules, 2017 ("***2017 Rules***") despite a delay of over three years, invoking powers under Section 131 of the TM Act.

4. The core issue that falls for consideration is whether the deadline stipulated in Rule 45 of the 2017 Rules for filing an Evidence Affidavit is mandatory or directory.

5. I have heard at length, Mr. Hiren Kamod, Learned Advocate on behalf of the Registrant and Mr. Atul Singh, Learned Advocate on behalf of the Rectification Applicant. With their assistance, I have reviewed the material on record.

6. Both Learned Advocates would submit that there is no decision of this High Court interpreting Rule 45 of the 2017 Rules from the prism of whether the deadline contained in it is directory or mandatory. The corresponding provision under the Trade Marks Rules, 2002 ("***2002 Rules***") and its

predecessor, the Trade Marks Rules, 1959 ("***1959 Rules***"), have been emphatically declared by multiple Courts to be directory and not mandatory. However, the bone of contention is whether the 2017 Rules have fundamentally changed the character of such deadline to a mandatory deadline.

7. Mr. Kamod would submit that judgements by a Learned Single Judge in ***Sun Pharma***[1] and a Learned Division Bench in ***Mahesh Gupta***[2], both by the Delhi High Court, have held the deadline to be mandatory, declaring that there is a conscious departure in the legislative policy. This view of the Delhi High Court appears to have been endorsed by two different Learned Single Judges of the Madras High Court.

8. In contrast, Mr. Singh would submit that the deadline is evidently and inherently directory and not mandatory. Judgements by the Gujarat High Court in ***Wyeth***[3] and the erstwhile Intellectual Property Appellate Board ("***IPAB***") in ***Sahil Kohli***[4] support this view. Mr. Singh would rely on the march of the law declared in multiple judgements, interpreting the corresponding provisions of the 1959 Rules and the 2002 Rules to point out that the same principle would apply to the 2017 Rules as well.

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1 *Sun Pharma Laboratories Ltd. v. Dabur India Ltd.* – ***2024 SCC OnLine Del 813***
2 *Mahesh Gupta v. Registrar of Trademarks* – ***2024 SCC OnLine Del 1750***
3 *Wyeth Holdings Corpn. v. Controller General of Patents, Designs & Trade Marks* – ***2006 SCC OnLine Guj 620***
4 *Sahil Kohli v. Registrar of Trade Mark* – ***2018 SCC OnLine IPAB 55***

9. Both the Learned Advocates have pointed out that this Petition presents a pure question of law and did not dwell much on the facts involved except for the dates relating to the deadline under Rule 45 of the 2017 Rules, the date of filing of the Interlocutory Application, and the extension granted in the Impugned Order. Purely for context, suffice it to say that the dispute is over the right to use "Black Diamond Motors" in pursuit of their respective businesses. The family business comprises multiple businesses that have used the "Black Diamond" name. The Registrant and the Rectification Applicant are factions of the same family which split pursuant to a family settlement with effect from March 31, 2014.

10. The Registrant, who was incorporated on September 21, 2005, has obtained Registration No. 1842386 in Class 12 on July 22, 2009 for "Black Diamond Motors Pvt. Ltd." ("***Registered Trade Mark***") and enjoys the statutory benefits flowing from the registration. The Registrant is in the business of "tippers, tip-trailers, flatbed trailers, ash-handling bulkers and tailor-made carriers". On August 1, 2019, the Rectification Applicant filed an application for rectification of the Registered Trade Mark, invoking Section 57 of the TM Act ("***Rectification Application***"). The Rectification Applicant has also applied for registration on March 31, 2018.

11. According to the Registrant, the Rectification Applicant was only into mining machinery and spare parts but, since April 2018, has sought to

compete with the Registrant's business using "Black Diamond Motors" in breach of the family settlement. There is also a chequered litigation history to the matter. The Registrant filed a trademark infringement suit before the District Court, Bilaspur, Chhattisgarh, in June 2018. By an order dated August 6, 2019, interim injunctive reliefs were denied. An appeal in the Chhattisgarh High Court was repelled by an order dated October 24, 2019.

12. On ***November 11, 2019***, the Registrant filed its counter statement to the Rectification Application. This counter statement was served on the Rectification Applicant on ***November 14, 2019***. For purposes of Rule 45 of the 2017 Rules, this date is important since the deadline to file the Evidence Affidavit under Rule 45 is two months from the service of the counter statement, which fell on ***January 14, 2020***.

13. On January 4, 2020, the trademark infringement Suit was withdrawn by the Registrant from the District Court, Bilaspur, with liberty to file it afresh on the premise that significant amendments were necessary. On March 4, 2020, the Registrant filed its own Notice of Opposition to the Rectification Applicant's application for registration.

14. A new suit was instituted, but in the District Court, Saket, New Delhi, which by an order dated July 20, 2020, granted *ad interim* protection, which was made also absolute by an order dated September 25, 2020. A Learned Division Bench of the Delhi High Court, in a detailed judgement dated May

28, 2021, allowed an appeal against the injunction granted by the District Court, Saket, finding forum shopping and an approach with unclean hands and also made an interlocutory arrangement to avoid confusion in the market. On July 12, 2021, the Supreme Court refused to grant special leave to appeal against this judgement.

15. On ***December 5, 2020*** i.e. just short of eleven months since the date of service of the counter statement by the Registrant, the Rectification Applicant submitted documents as its evidence in support of its Rectification Application, but without an affidavit explaining the documents. On ***March 16, 2024***, the Rectification Applicant filed the Interlocutory Application along with an Evidence Affidavit requesting an extension of time and to bring it on record. By this time, nearly four years had passed since the filing of the counter statement by the Registrant, and a little over three years had passed since the filing of documents without an affidavit.

16. On April 17, 2025, the District Court, Saket stayed the suit until disposal of the Rectification Proceedings. On August 26, 2025, the Impugned Order allowed the Interlocutory Application, bringing on record the Evidence Affidavit under Rule 45 of the 2017 Rules that accompanied the Interlocutory Application. On October 24, 2025, the Registrant filed its Evidence Affidavit under Rule 46, while on November 20, 2025, the Rectification Applicant filed its Evidence Affidavit in reply under Rule 47 of the 2017 Rules.

17. While an earlier order had given one more opportunity to the Registrar to present its say, none appeared. In my view, in appellate proceedings such as these, the Impugned Order must speak for itself and I do not think it necessary to have the adjudicating authority explain its order through pleadings. Therefore, by consent of parties, the captioned Petition was taken up for final hearing. Besides, the Petition calls for a pure question of law to be answered, and the Registrar is not the author of the subordinate legislation under consideration.

Analysis and Findings:

18. At the core of the controversy is the admitted fact that the Interlocutory Application, which enclosed the Evidence Affidavit, was filed on March 16, 2024 and the Impugned Order has allowed it to be brought on record.

19. At the threshold, two strands of proceedings under the TM Act must be noticed – Opposition Proceedings under Section 21 of the TM Act, and Rectification Proceedings under Section 57 of the TM Act. Under Section 21, any person may, within four months from the date of the advertisement of an application for registration, issue a Notice of Opposition, objecting to the registration. On the other hand, under Section 57 of the TM Act, any person aggrieved by the grant of registration under the TM Act, may apply for cancellation or variation of the registration granted.

20. The 2017 Rules stipulate the procedural framework for administration and operation of these two streams of substantial statutory rights. Opposition Proceedings as well as Rectification Proceedings have to be initiated in the manner "prescribed", which essentially means prescription by rules made under Section 157 of the TM Act. For all purposes of this Petition, it is only the 2017 Rules that are relevant.

21. Rules governing Opposition Proceedings are located in Chapter II of the 2017 Rules, which essentially deals with the procedure for registration of a trademark. Rules 43 to 51 of the 2017 Rules regulate the conduct of Opposition Proceedings. On the other hand, Rules governing Rectification Proceedings are set out in Chapter VII of the 2017 Rules. Rules 97 to 100 deal with the conduct of Rectification Proceedings.

22. Rule 97 of the 2017 Rules, which sets out the manner in which a Rectification Application must be made, requires an application to be made in Form TM-O. It is noteworthy that even for Opposition Proceedings under Section 21 of the TM Act, Rule 42 of the 2017 Rules prescribes the same Form TM-O for filing a Notice of Opposition. Under Rule 97 of the 2017 Rules, the Registrar is required to "ordinarily transmit" the Rectification Application and supporting statement within a period of one month to the Registrant and to any other person whose interest in the trade mark appears in the register. Verification of the Rectification Application has to be in conformity with Rule

43, which stipulates the requirements to be met for a valid filing of a Notice of Opposition under Section 21.

Relevant Provisions of 2017 Rules:

23. Under Rule 98 of the 2017 Rules, within two months from the receipt of the Rectification Application, or within such further period not exceeding one month in the aggregate, the Registrant has a right to file a counter statement of the grounds on which he contests the Rectification Application. This too is in Form TM-O – it enables a like-to-like comparison of the contentions of both sides. It would be appropriate to first extract Rule 98 of the 2017 Rules, which stipulates the "further procedure":

> *"**98. Further procedure.–***
>
> ***Within two months from the receipt by a registered proprietor of the copy of the application mentioned in rule 97*** *or within* ***such further period not exceeding one month in the aggregate****, he* ***shall send to the Registrar on Form TM-O a counterstatement of the grounds on which the application is contested*** *and if he does so, the Registrar shall serve a copy of the counterstatement on the person making the application within one month of the receipt of the same.* ***In case no counter-statement has been filed within the period of three months from the date of receipt of the application mentioned in rule 97, the applicant for rectification shall file evidence in support of his application for rectification under the provisions of rule 45(1)****. The* ***provision under rules 46 to 51 shall thereafter apply mutatis mutandis to the further proceedings on the application****."*
>
> ***[Emphasis Supplied]***

24. A plain reading of the foregoing would make it clear that the Registrant is entitled to make his case against the Rectification Application by filing a counter statement. If such a counter statement is filed, it is to be served on the Rectification Applicant within a month. *If such a counter statement is not filed*, the Rectification Applicant is entitled to file his evidence in support of the Rectification Application under the provisions of Rule 45(1). Thereafter, Rules 46 to 51 would, as far as applicable (*mutatis mutandis*) apply to the Rectification Proceedings.

25. As seen above, Rule 98 leads to Rule 45(1) and thereafter the same procedure as that governing Opposition Proceedings. However, since Rule 45 is linked to Rule 44, it would be appropriate to consider all the provisions of the 2017 Rules governing Opposition Proceedings, starting with Rule 44, in order to answer the question of whether the deadline in Rule 45 is mandatory or directory. The provisions are extracted below:

> *"**44. Counterstatement.** –*
>
> *(1) **The counterstatement required by sub-section (2) of section 21 shall be sent on Form TM-O within two months from the receipt by the applicant of the copy of the notice of opposition** from the Registrar and shall set out what facts, if any, alleged in the notice of opposition, are admitted by the applicant. **A copy of the counterstatement shall be ordinarily served by the Registrar to the opponent within two months from the date of receipt of the same**.*
> *(2) **The counterstatement shall be verified in the manner as provided in sub-rules (2), (3) and (4) of rule 43.**"*

[Emphasis Supplied]

26. A plain reading of Rule 44 would indicate that it permits the applicant for registration to counter the Notice of Opposition within two months in much the same manner that Rule 98 permits the Registrant to counter the Rectification Application within two months. Rule 45, which is referred to in Rule 98, and lies at the heart of the controversy, is extracted below:

> *"**45. Evidence in support of opposition.**–*
>
> *(1) **Within two months from service of a copy of the counterstatement, the opponent shall** either leave with the Registrar, **such evidence by way of affidavit as he may desire to adduce in support of his opposition or shall intimate to the Registrar and to the applicant in writing that he does not desire to adduce evidence in support of his opposition but intends to rely on the facts stated in the notice of opposition**. He shall deliver to the applicant copies of any evidence including exhibits, if any, that he leaves with the Registrar under this sub-rule and intimate the Registrar in writing of such delivery.*
>
> *(2) **If an opponent takes no action under sub-rule (1) within the time mentioned therein, he shall be deemed to have abandoned his opposition**."*
>
> ***[Emphasis Supplied]***

27. Rule 45 provides for a two-month deadline computed from the date of service of the counter-statement, for the Opponent to file the Evidence Affidavit. Arguably, this two-month deadline would start from the date of receipt of the counter-statement. However, it is equally arguable that if a strict

mandatory reading of Rule 45 is to be adopted, the path to Rule 45(1) in Rule 98 must also be strictly read. In other words, the deadline in Rule 45 would be attracted only "*in case no counter-statement has been filed*" under Rule 97, as provided in Rule 98. This is the first factor for considering whether Rule 45 is directory or mandatory, pointing firmly in the direction of reading down Rule 45 and Rule 98 purposively to achieve common sense.

28. In my view, regardless of whether such reading of Rule 98 is narrow, pedantic and technical in the context of a strict and narrow reading of Rule 45 being canvassed, it is imperative to examine the entire scheme of the procedural provisions that follow. In particular, Rule 46 to Rule 48 of the 2017 Rules, present a wholesome answer on the issue of whether the deadline in Rule 45 is directory or mandatory.

29. In the two-month period referred to in Rule 45, the Opponent either would file the Evidence Affidavit or confirm that he would simply rely on the facts already pleaded in the Notice of Opposition and not lead any more evidence. Rule 45(2) provides that if neither option is exercised within the time mentioned in Rule 45(1), the opposition is deemed to have been abandoned. This may beg the question as to whether on a *mutatis mutandis* application, the Rectification Application would stand abandoned, but then Rule 98 attracts only Rule 45(1) and not Rule 45(2), and specifically provides for the *mutatis mutandis* application to start from Rule 46.

30. Mr. Kamod would submit that the deadline of two months in Rule 45(1) is a hard-coded deadline that has been rightly held in ***Sun Pharma*** and ***Mahesh Gupta*** to be mandatory in character, and incapable of being extended. Rules 46 to 48 of the 2017 Rules, which, among other factors, answer as to whether the two-month deadline in Rule 45 is mandatory or directory, are extracted below:

> *"**46. Evidence in support of application. —***
>
> *(1) **Within two months on the receipt by the applicant of the copies of affidavits in support of opposition or of the intimation that the opponent does not desire to adduce any evidence in support of his opposition, the applicant shall leave with the Registrar such evidence by way of affidavit as he desires to adduce in support of his application** and shall deliver to the opponent copies thereof **or shall intimate to the Registrar and the opponent that he does not desire to adduce any evidence but intends to rely on the facts stated in the counterstatement and or on the evidence already left by him in connection with the application in question**. In case the applicant adduces any evidence or relies on any evidence already left by him in connection with the application, he shall deliver to the opponent copies of the same, including exhibits, if any, and shall intimate the Registrar in writing of such delivery.*
> *(2) **If an applicant takes no action under sub-rule (1) within the time mentioned therein, he shall be deemed to have abandoned his application.***
>
> ***47. Evidence in reply by opponent.—***
>
> ***Within one month from the receipt by the opponent of the copies of the applicant's affidavit the opponent may leave with the Registrar evidence by affidavit in reply** and shall deliver to the applicant copies of the same including exhibits, if any, and*

shall intimate the Registrar in writing of such delivery.

48. Further evidence.—

No further evidence shall be left on either side, but *in any proceedings before* ***the Registrar, he may at any time, if he thinks fit, give leave to either the applicant or the opponent to leave any evidence upon such terms as to costs or otherwise*** *as he may think fit."*

[Emphasis Supplied]

31. It is well settled that when considering if a provision is mandatory or directory, Courts must have regard to the scheme of the law and the legislative policy discernible from it. In particular, the Court must examine the stated consequences of non-compliance (*whether penalties are stipulated for non-compliance*); the statutory language used (*for instance, usage of "shall", "must" or "may"*); the purpose and context of the law (*whether the requirement is procedural and regulates orderly conduct and administration, or gives rise to substantive rights*); the resultant injustice or inconvenience (*whether it gives rise to severe and disproportionate consequences or sheer inconvenience leading to absurdity*); and the nature of the provision itself (*whether it is procedural regulation of conduct of proceedings, or whether it cuts to the root of the matter such as a provision governing limitation*). No single factor may alone be dispositive of the issue, and one would need to take a holistic view of all these facets to answer the

question. The following extract from Justice G. P. Singh's *Principles of Statutory Interpretation* (*15th Edition, 2021, Page 304 onwards*) are noteworthy:

> *"The study of numerous cases on this topic does not lead to formulation of any universal rule except this that* ***language alone most often is not decisive, and regard must be had to the context, subject-matter and object of the statutory provision in question, in determining whether the same is mandatory or directory.*** *In an oft-quoted passage Lord Campbell said:*
>
> > *'No universal rule can be laid down as to whether mandatory enactments shall be considered directory only or obligatory with an implied nullification for disobedience.* ***It is the duty of courts of justice to try to get at the real intention of the legislature by carefully attending to the whole scope of the statute to be considered****.'*
>
> *As approved by the Supreme Court:*
>
> > *The* ***question as to whether a statute is mandatory or directory*** *depends upon* ***the intent of the Legislature and not upon the language in which the intent is clothed****. The meaning and intention of the Legislature must govern, and* ***these are to be ascertained not only from the phraseology of the provision, but also by considering its nature, its design, and the consequences which would follow from construing it the one way or the other.***
>
> ***For ascertaining the real intention of the legislature', points out Subbarao, J. that:***
>
> > ***'the court may consider inter alia, the nature and design of the statute, and the consequences which would follow from construing it the one way or the other; the impact of other provisions whereby the necessity of complying with the provisions in question is avoided; the circumstances, namely, that the statute provides for a contingency of the non-compliance with the provisions; the fact that the non-compliance with the provisions is or is not visited by some***

penalty; the serious or the trivial consequences, that flow therefrom; and above all, whether the object of the legislation will be defeated or furthered.'"

[Emphasis Supplied]

32. In this light, the scheme of the law in which Rule 45 of the 2017 Rules is located has to be examined along with the language in Rule 45 itself, to consider if the two-month deadline is mandatory and whether the failure to meet it would kill the prospect of any Evidence Affidavit ever being brought on record. In my judgement, a reading of such a consequence is absurd and leads to completely avoidable inconvenience, simply because to hold that missing the deadline in Rule 45 kills any prospect of filing any Evidence Affidavit, one would have to ignore the wider scheme flowing from Rules 46 to 48. In terms of Rule 46, within two months of the receipt of the Evidence Affidavit from the Rectification Applicant or intimation that he has chosen not to file one, the Registrant has two months to file his Evidence Affidavit or confirm that he has chosen not to file one. Thereafter, under Rule 47, the Rectification Applicant again has one month to file a further Evidence Affidavit in Reply. That apart, Rule 48 confers on the Registrar discretion to grant leave to both, the Registrant and the Rectification Applicant to lead any further evidence upon such terms as to costs or otherwise.

33. Neither ***Sun Pharma*** nor ***Mahesh Gupta*** deals with the implications of Rule 48 of the 2017 Rules. Past judgements on the 2002 Rules never had to

consider the provision corresponding to Rule 48 because Rule 50 of the 2002 Rules and Rule 53 of the 1959 Rules had inherent language to indicate discretion of the Registrar, which led to those provisions being held to be directory.

34. Not only is Rule 45 a procedural provision, it has been consciously located amidst the wider procedural scheme regulating the filing of evidence in the conduct of Opposition Proceedings, which is also made applicable to Rectification Proceedings. If the deadline in Rule 45 were to be a mandatory stipulation akin to a provision of limitation for filing an Evidence Affidavit, it would be illogical for Rule 47 to enable the Rectification Applicant to file more evidence and for Rule 48 to grant discretion to the Registrar to permit even more evidence being led. On the contrary, the unmistakable inference from the scheme of these provisions is that the deadline in Rule 45 is not a mandatory provision. Assuming this deadline is missed, the Registrar is still entitled to permit filing of an Evidence Affidavit under Rule 48 to enable adjudication of the Rectification Application properly and to assess the facts in issue, on such conditions, including imposition of costs.

35. Whether any element of evidence led under Rule 47 or Rule 48 is admissible and the normative value of such evidence are matters of adjudication. The issue to consider is whether the deadline under Rule 45 is mandatory in nature, and if missed, whether the Rectification Applicant has

no right whatsoever to lead evidence that he submits is relevant to the adjudication. The answer to that question is unmistakably in the negative, simply because under Rule 48, the Registrar could still allow what was missed at the Rule 45 stage if such evidence is vital and relevant for the adjudication of the Rectification Application.

36. Mr. Kamod would counter this proposition by suggesting that the evidence to be led under Rule 47 by the Rectification Applicant is only meant to be evidence in "reply" to the Evidence Affidavit filed by the Registrant under Rule 46. However, to my mind, from the perspective of whether Rule 45 is a mandatory provision, this facet does not turn the needle. There is no bar in Rule 48 to disentitle the Registrar from admitting evidence under Rule 48 should the deadline in Rule 45 have been missed. A Rectification Applicant could even file an Evidence Affidavit under Rule 47, seeking to rebut what is filed by the Registrant under Rule 46 and set out in that Evidence Affidavit contents that could have been filed under Rule 45.

37. Likewise, he would still be entitled to seek liberty of the Registrar to file an Evidence Affidavit under Rule 48, which the Registrar is entitled to allow, with imposition of costs. The Registrar may, on merits, come to a view that such request should be disallowed. However, the scheme of the law is that the Registrar has discretion to allow the filing of the evidence, which would point to the conclusion that Rule 45 is directory and not mandatory in nature. If it is

found that the evidence shut out at the stage of Rule 45 is necessary for the adjudication and can be permitted under Rule 48, the Registrant too may again need to file evidence, and also invoke Rule 48, which too is within the Registrar's powers.

38. One must remember that the scheme of Rules 44 to 51 of the 2017 Rules are procedural provisions to aid in adjudicating the merits of Opposition Proceedings and Rectification Proceedings. The Registrar has been given a free play in the joints with discretion to allow evidence necessary for the adjudication. What is perceived as being simply impermissible under Rule 45, when practically permissible under Rule 47 and Rule 48, makes it only reasonable to conclude that the deadline in Rule 45 is directory and not mandatory. In my view, the contrary stance, if accepted, one would need to hold that these provisions stipulate limitation and not procedure.

39. The power to impose costs under Rule 48 to permit an Evidence Affidavit is also a pointer. The very concept of imposition of costs is to adjust and provide for conduct of a party that has led to any other party having incurred costs and inconvenience. For the inconvenience and expense arising out of missing the deadline and belatedly seeking to bring in evidence to meet the ends of justice, the Registrar may impose costs. Therefore, far from penal consequences being visited for missing the deadline for filing evidence under Rule 45, if the Registrar is satisfied that evidence necessary for a fair and just

adjudication has been missed out, such evidence with imposition of costs can be allowed to be brought on record. The substance of the consequence is remedial and not penal. Therefore, this deadline in Rule 45 is not in the nature of a provision of limitation, but in the nature of a provision that regulates procedure and effective administration of the procedure.

40. Therefore, in my view, applying multiple parameters, including the consequences of non-compliance with the deadline under Rule 45, the purpose and context of the scheme of the law, the absurd inconvenience of multiple rounds of further evidence coming in under Rule 48 after elevating Rule 45 to a mandatory standard, and an overall holistic reading of Rule 45 in the wider context of the scheme of the 2017 Rules, in my opinion, Rule 45 stipulates a directory deadline and not a mandatory deadline.

41. At this stage it would be appropriate to deal with the implications of "*deemed*" abandonment of the very opposition and the very application for registration, as respectively set out in Rule 45(2) and Rule 46(2) of the 2017 Rules, if no Evidence Affidavit is filed and no confirmation of not being desirous of filing an Evidence Affidavit is issued. This facet has often been considered by other High Courts in the course of considering if the deadlines are mandatory or directory.

42. It is well settled that the reach of deeming fictions must be restricted to the purposes for which they are created. Rule 45(1) and Rule 46(1) stipulate a

procedural deadline for filing the respective Evidence Affidavits. This being the objective, namely, to enable a desirable strict deadline, one must consider how to interpret a subsidiary provision that creates a deeming fiction. If the desirable deadline is not met, to hold that the very Notice of Opposition or the application for registration would stand abandoned, would be truly absurd and in direct conflict with the substantive rights created under Section 21 and Section 57 of the TM Act. It would mean that regardless of the merits of the Rectification Application or the Notice of Opposition, the facts for which would already have been pleaded in Form TM-O, merely because the Evidence Affidavit is not filed, despite evidence being capable of being introduced later under Rule 48, the very proceedings would come to an end.

43. To my mind, the deeming fiction can never travel beyond the main provision in Rule 45(1) and Rule 46(1). The only requirement under Rule 45(1) and Rule 46(1) is to either file the Evidence Affidavit or confirm that it is not being filed. The failure to do so can only lead to a default position that the Evidence Affidavit deadline has been missed, and it cannot, through a deeming fiction wipe out the very underlying proceedings.

44. When applied on a *mutatis mutandis* basis to Rectification Proceedings, Rule 46 would imply that the Notice of Opposition would stand allowed, which would then mean the Registrant would be displaced – a truly absurd consequence. This is why the scheme of the deemed abandonment can only be

read in aid of the deadline for filing the Evidence Affidavit. In any case, Rule 48 still enables a full discretion to the Registrar to permit evidence necessary for the adjudication.

45. The objective of these Rules is well defined and discernible. Therefore, to avoid extrapolations beyond the purpose of the Rules leading to the absurdity described above, the other alternative reading of the deemed abandonment under Rule 45(2) and Rule 46(2) would only mean that the deeming fiction must be restricted as explained above. In this context, it would be appropriate to cite the following extracts from ***Kailash v. Nankhu***[5], which are self-explanatory:

> *"**29.** In **State of Punjab v. Shamlal Murari** [(1976) 1 SCC 719 : 1976 SCC (L&S) 118] the Court approved in no unmistakable terms the approach of moderating into wholesome directions what is regarded as mandatory on the principle that: (SCC p. 720)*
>
> > ***"Processual law is not to be a tyrant but a servant, not an obstruction but an aid to justice. Procedural prescriptions are the handmaid and not the mistress, a lubricant, not a resistant in the administration of justice."***
>
> *In **Ghanshyam Dass v. Dominion of India** [(1984) 3 SCC 46] the Court reiterated the **need for interpreting a part of the adjective law dealing with procedure alone in such a manner as to subserve and advance the cause of justice rather than to defeat it as all the laws of procedure are based on this principle**.*
>
> ***

5 *Kailash v. Nanhku* – **(2005) 4 SCC 480**

> ***35.*** ***Two decisions, having a direct bearing on the issue arising for decision before us, have been brought to our notice, one each by the learned counsel for either party. The learned Senior Counsel for the appellant submitted that in Topline Shoes Ltd. v. Corpn. Bank [(2002) 6 SCC 33] a pari materia provision contained in Section 13 of the Consumer Protection Act, 1986 came up for the consideration of the Court. The provision requires the opposite party to a complaint to give his version of the case within a period of 30 days or such extended period not exceeding 15 days as may be granted by the District Forum.*** *The Court took into consideration the Statement of Objects and Reasons and the legislative intent behind providing a time-frame to file reply and* ***held: (i) that the provision as framed was not mandatory in nature as no penal consequences are prescribed if the extended time exceeds 15 days, and; (ii) that the provision was directory in nature and could not be interpreted to mean that in no event whatsoever the reply of the respondent could be taken on record beyond the period of 45 days****.*
>
> ***36.*** *The Court further held that* ***the provision is more by way of procedure to achieve the object of speedy disposal of such disputes. The strong terms in which the provision is couched are an expression of "desirability" but do not create any kind of substantive right in favour of the complainant by reason of delay so as to debar the respondent from placing his version in defence in any circumstances whatsoever****."*
>
> ***[Emphasis Supplied]***

Section 131 and Rule 109:

46. There are *three* facets of Section 131 the TM Act to consider – *first*, whether the deadlines stipulated under the Rules would constitute deadlines provided for in the TM Act and therefore be outside the Registrar's powers to grant extension; *second*, whether the Interlocutory Application under Section

131 ought to have been filed before expiry of the stipulated deadline; and *third*, whether the effect of granting an extension can lead to a maximum extension period of one month stipulated under Rule 109 of the 2017 Rules being breached. Each is dealt with below.

I. Deadlines under the Rules being Deadlines under the Act:

47. To begin with, it would be necessary to extract Section 131 and also Rule 109, which is referable to the administration of Section 131 of the TM Act:

> *"**131. Extension of time.**—*
>
> *(1) **If the Registrar is satisfied**, on **application made to him in the prescribed manner** and **accompanied by the prescribed fee**, that **there is sufficient cause for extending the time** for doing any act (**not being a time expressly provided in this Act**), **whether the time so specified has expired or not**, he may, **subject to such conditions as he may think fit to impose, extend the time** and inform the parties accordingly.*
>
> *(2) **Nothing in sub-section (1) shall be deemed to require the Registrar to hear the parties** before disposing of an application for extension of time, and **no appeal shall lie from any order of the Registrar under this section**.*
>
> *"**109. Extension of time.**—*
>
> *(1) An **application for extension of time under Section 131 (not being a time expressly provided in the Act or prescribed by Rule 85 or by sub-rule (3) of Rule 86 or a time for the extension of which provision is made in the rules**) shall be made in Form TM-M.*
>
> *(2) Upon an application made under sub-rule (1) **the Registrar, if satisfied that the circumstances are such as to justify the extension of the time applied for, may,***

> ***subject to the provisions of the rules where a maximum time limit is prescribed and subject to such conditions as he may think fit to impose, extend the time not exceeding one month*** *and communicate the parties accordingly and* ***the extension may be granted though the time for doing the act or taking the proceeding for which it is applied for has already expired****."*
>
> ***[Emphasis Supplied]***

48. Section 131 of the TM Act is explicit in its terms. It confers an important discretionary power to extend time. What falls outside the scope of the Section 131 jurisdiction is any time "*expressly provided in this Act*". Every other deadline can be extended by the Registrar. This is logical because when Parliament has fixed deadlines in the TM Act, Parliament has equally chosen not to allow such deadlines to be diluted by administrative action by the Registrar.

49. There can be no quarrel about the proposition that any stipulation made under subordinate legislation such as the TM Rules, flows from authority conferred for making such legislation under the parent statute. The legal force and effect of such stipulation in subordinate legislation would be firmly binding as law. It is one thing to say that a deadline stipulation under Rule 45 (or for that matter, Rule 46) has the force of law as if it were made under the TM Act. However, it is quite another to hold that any deadline stipulation in the subordinate legislation is "*expressly provided*" under the TM Act.

50. To begin with, the words in brackets, namely "*not being a time expressly provided in this Act*", which create an exclusion from the jurisdiction for grant of time extension, constitute an exception to the rule that the Registrar may extend time specified for doing any act. The words have been consciously chosen by Parliament to restrict the scope of the jurisdiction of the Registrar to extend time. Consciously, Parliament has chosen to exclude timelines "*expressly provided*" in the TM Act within the parentheses. By "express provision" is meant any provision of time that is spelt out specifically in words in the TM Act. This phrase does not stipulate time stipulations expressly provided in the TM Rules. The particular choice of words "expressly provided" necessarily means that the TM Act should have explicitly stipulated a time for doing any act, which would then fall outside the scope of jurisdiction of Section 131 of the TM Act. This is not to say that the subordinate legislation cannot create legally binding time stipulations. All it means is that the Registrar's jurisdiction to extend time would cover all time specifications other than those explicitly in express words that are set out in the TM Act.

51. Indeed, the parenthesis is not structured as a "*proviso*" to Section 131 of the Act, but it is evidently, an exception to the provision. Exceptions, like provisos and exemptions, and that too when it provides for an ouster of jurisdiction, must be strictly construed, but always in the context of the intent

and object of the provision in question. This well-known principle is explained in ***Tribhovandas Haribhai***[6] by the Supreme Court in the following words:

> *"**6.** It is a cardinal rule of interpretation that a **proviso to a particular provision of a statute only embraces the field, which is covered by the main provision, it carves out an exception to the main provision to which it has been enacted by the proviso and to no other**. The proper **function of a proviso is to except and deal with a case which would otherwise fall within the general language of the main enactment, and its effect is to confine to that case. Where the language of the main enactment is explicit and unambiguous, the proviso can have no repercussion on the interpretation of the main enactment, so as to exclude from it, by implication what clearly falls within its express terms.** The scope of the proviso, therefore, is to carve out an exception to the main enactment and **it excludes something which otherwise would have been within the rule. It has to operate in the same field and if the language of the main enactment is clear, the proviso cannot be torn apart from the main enactment nor can it be used to nullify by implication what the enactment clearly says nor set at naught the real object of the main enactment**, unless the words of the proviso are such that it is its necessary effect."*
>
> **[Emphasis Supplied]**

52. Necessarily, the object and purpose of Section 131 is to give the Registrar the ability to smoothly administer the proceedings conducted under the TM Act and towards this end, empower the Registrar to extend time for carrying out any specified act, and such extension can be granted even after the expiry of the time specified. This objective being clear, the exception has to be strictly construed. It should necessarily follow that if Parliament had

6 *Tribhovandas Haribhai Tamboli v. Gujarat Revenue Tribunal* – **(1991) 3 SCC 442)**

intended to cover deadlines stipulated under the 2017 Rules within the exclusion from the scope of jurisdiction to grant extension, it would have stated so explicitly. Instead, the parenthesis specifically states that deadlines *expressly provided* in the TM Act would be out of the scope of the Registrar's power to extend.

53. Another indicator for interpreting Section 131 of the TM Act is that wherever Parliament intended to bring anything covered by the TM Rules within the scope of a specific provision under the TM Act, it has consciously used the phrase "*under this Act or rules made thereunder*". There are clear intrinsic pointers to such usage within the TM Act, namely Section 91(1) (*Appeals to High Court*) and Section 128 (*Exercise of discretionary power by Registrar*).

54. Section 91(1) of the TM Act reads thus:

> *"**91. Appeals to High Court**.—*
>
> *(1) Any person aggrieved by an order or decision of the Registrar **under this Act, or the rules made thereunder** may prefer an appeal to the High Court within three months from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal."*
>
> ***[Emphasis Supplied]***

55. There is a conscious choice of using the phrase "*under this Act, or the rules made thereunder*" to enable a statutory right to appeal in respect of any

order or decision taken by the Registrar, irrespective of whether the order or decision is taken under the TM Act or under the 2017 Rules. Parliament did not leave the right to appeal decisions under the 2017 Rules to necessary implication on the principle that decisions taken under the 2017 Rules are but decisions validly taken under the TM Act.

56. Section 128 is extracted below:

> *"**128. Exercise of discretionary power by Registrar**.—*
>
> *Subject to the provisions of section 131, the Registrar shall not exercise any discretionary or other power vested to him **by this Act or the rules made thereunder** adversely to a person applying for the exercise of that power without (if so required by that person within the prescribed time) giving to the person an opportunity of being heard."*
>
> ***[Emphasis Supplied]***

57. Here again, the intent is to ensure that the right of being heard is statutorily conferred on an applicant seeking exercise of power by the Registrar, by providing that no adverse decision shall be taken on an application without the applicant being heard. The exercise of such powers could be those conferred on the Registrar "*by this Act or the rules made thereunder*". Parliament did not leave this provision to the principle that any exercise of power under the 2017 Rules would necessarily be an exercise of

power under the TM Act. A conscious choice of the aforesaid phrase to include the subordinate legislation was made.

58. There are 44 iterations of the phrase "under this Act" in the TM Act and two specific iterations of "this Act or rules made thereunder" for specific situations. Therefore, one must read Section 131 with specific regard to the context in which it has been formulated. It is logical and reasonable to hold that the Registrar cannot nullify the deadlines expressly provided in the TM Act (without such a power being granted expressly) and instead the Registrar has been empowered to extend time specified in all other cases. It is nobody's case that time specified for doing any act under the 2017 Rules carries the force of the law contained in the TM Act, but that is not even a point in issue. The question is whether the power to grant extension will not cover any time stipulation in the 2017 Rules merely because it is legally valid, flowing as it does, from the legal force and effect of the TM Act.

59. Another element to note in Section 131 of the TM Act is that the only reliance it places on subordinate legislation is the prescription of the manner of application (Form TM-O) and of the fees for such an application. Those apart, the benefits of Section 131 are statutory benefits that cannot be taken away by subordinate legislation. The very power to extend time must entail that there has to be a time stipulation. Such stipulation, if in the TM Act, cannot be disturbed by the Registrar, but such stipulation, if in subordinate

legislation, can indeed be adjusted by the Registrar. If this were not to be the reading, the scope of power of the Registrar under Section 131 would become really very narrow – it would only cover such time stipulation as the Registrar himself makes, and even those, arguably, being done under the TM Act, cannot be extended by the contrary reading of this provision.

60. It is noteworthy that Rule 109(1) of the 2017 Rules, which administers Section 131 of the TM Act, purports to expand the parenthesis in Section 131 by adding references to Rule 85 (*registration of assignment to a company under Section 46*) and Rule 86(3) (*application for registration as registered user*) to the scope of exclusions from the Registrar's jurisdiction under Section 131. It is not within the remit of this judgement to pronounce upon the validity of such expansion when that is not a point in issue. However, it is quite clear that the deadline under Rule 85 is simply an import of the deadline stipulated in Section 46 and therefore would in any case fall within the exception in Section 131. The deadline under Rule 86(3) is a deadline provision introduced only in the subordinate legislation – an application to register a user of a registered trade mark has to be filed within six months from the agreement licensing such use. What does stand out is that if the authors of the subordinate legislation were of the view that every timeline for carrying out any specified act in the 2017 Rules is subsumed as a timeline stipulated in the TM Act, there was no need to only include two specific

timelines set out in the 2017 Rules within the scope of the exception under Rule 109(1) of the 2017 Rules. By necessary implication, all the time specifications in the 2017 Rules other than those in Rule 85 and Rule 86(3) would fall within the scope of extension of time, even under the 2017 Rules. The deadline under Rule 45 is not a part of this expanded exception.

61. Therefore, with the greatest respect, on the *first* facet, namely, that no time stipulated under the 2017 Rules could ever be extended under Section 131 of the TM Act, I am unable to be persuaded by the reasoning in this regard contained in ***Mahesh Gupta*** and the judgements it has followed. It is not accurate to equate the removal of the power to extend a time deadline from the scope of jurisdiction, with the power to make rules to legitimately stipulate time deadlines.

II. Filing of Interlocutory Application after Expiry of Deadline:

62. The *second* issue is whether the Interlocutory Application ought to have been filed before the expiry of the time period for which extension was sought i.e. before the expiry of the two-month period under Rule 45 of the 2017 Rules. The answer to this issue is found within Section 131 itself.

63. A core ingredient of Section 131 of the TM Act is that the extension of time specified for doing any act can be granted even after the time so specified has already expired. There is no positive stipulation that the application

seeking extension of time for doing any act has to be filed before the expiry of such specified time. Considering that the power to extend time is permitted to be exercised even after the expiry of the timeline sought to be extended, without any requirement to the effect that "*provided such application is filed within the time specified*", it would only follow that the application can be made even after the time has expired and such application can be adjudicated after the time has expired.

64. The TM Act vests the Registrar with this power to enable a fair and reasonable adjudication of matters. This cannot be wished away by imputing and importing a non-existent period of limitation for the filing of an application under Section 131.

65. A similar issue arose under the Arbitration and Conciliation Act, 1996 ("***Arbitration Act***") in interpreting a similar provision under Section 29A(4) of the Act, which provides for expiry of mandate of an Arbitral Tribunal unless the mandate is extended by the Court before or after the expiry of the mandate. The relevant provision reads quite similar to Section 131 and is extracted below:

> *"**Section 29-A(4) of the Arbitration Act:***
>
> *(4) **If the award is not made within the period specified** in sub-section (1) or the extended period specified under sub-section (3), **the mandate of the arbitrator(s) shall terminate** **unless the court has, either prior to or after the expiry of the period so specified, extended the period**:"*

[Emphasis Supplied]

66. The Calcutta High Court took the view that if the application seeking extension of mandate had not been filed before the expiry of the mandate, the Court ought not to entertain an application for extension since it would enable rogue applicants to delay arbitration proceedings. This was repelled by the Supreme Court in ***Rohan Builders***[7] - the following extracts are noteworthy:

> *"**15. An interpretive process must recognise the goal or purpose of the legal text.** [Shailesh Dhairyawan v. Mohan Balkrishna Lulla, (2016) 3 SCC 619 : (2016) 2 SCC (Civ) 426] **Section 29-A intends to ensure the timely completion of arbitral proceedings while allowing courts the flexibility to grant extensions when warranted. Prescribing a limitation period, unless clearly stated in words or necessary, should not be accepted. Bar by limitation has penal and fatal consequences.** This Court in North Eastern Chemicals Industries (P) Ltd. v. Ashok Paper Mill (Assam) Ltd. [North Eastern Chemicals Industries (P) Ltd. v. Ashok Paper Mill (Assam) Ltd., (2023) 19 SCC 798] observed: (SCC p. 812, para 37)*
>
> > *'37. ... **When no limitation stands prescribed it would be inappropriate for a Court to supplant the legislature's wisdom by its own and provide a limitation, more so in accordance with what it believes to be the appropriate period.**'*
>
> ***16. Courts should be wary of prescribing a specific period of limitation in cases where the legislature has refrained from doing so**. [Ajaib Singh v. Sirhind Coop. Mktg.-cum-Processing Service Society Ltd., (1999) 6 SCC 82 : 1999 SCC (L&S) 1054] **If we give a narrow and restrictive meaning to Section 29-A(4), we would be indulging in judicial legislation by incorporating a negative stipulation of a bar of limitation, which has a severe annulling effect.** Such an interpretation will add*

7 *Rohan Builders (India) (P) Ltd. v. Berger Paints (India) Ltd.,* ***(2025) 10 SCC 802***

words to widen the scope of legislation and amount to modification or rewriting of the statute. ***If the legislature intended such an outcome, it could have stated in the statute that — "the Court may extend the period only if the application is filed before the expiry of the mandate of the arbitrator, not after". Indeed, there would have been no need to use the phrase "after the expiry of the period" in the statute.*** *In other words, a rigid interpretation would amount to legislating and prescribing a limitation period for filing an application under Section 29-A, when the section does not conspicuously so state.* ***Rather, the expression and intent of the provision are to the contrary.****"*

[Emphasis Supplied]

67. The analysis of the law in a near-identically phrased provision (Section 29-A of the Arbitration Act) would squarely apply to interpretation of Section 131 of the TM Act. In both legislations, the legislature has not stipulated any period of limitation for filing of an application seeking extension of time. In both, the provision has given a significant play in the joints to the specified competent authority to extend time "for sufficient cause".

68. Even if one were to treat the provision that specifies the time to do any act as a limitation provision, the discretion to grant extension for sufficient cause in Section 131 of the TM Act would be akin to Section 5 of the Limitation Act, 1963, which has clearly been held to be an instrument to ensure that technicalities do not undermine substantive justice.

69. Moreover, where the TM Act has consciously chosen to impose a limitation with reference to an expired period, it has stated so, as can be seen in Section 91 of the TM Act, extracted below:

> *"**91. Appeals to High Court**.—*
>
> *(1) **Any person aggrieved by an order or decision of the Registrar** under this Act, or the rules made thereunder **may prefer an appeal to the High Court within three months** from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal.*
> *(2) **No appeal shall be admitted** if it is **preferred after the expiry of the period specified under sub-section (1)**:*
> *Provided that an **appeal may be admitted after the expiry of the period specified therefor, if the appellant satisfies the High Court that he had sufficient cause for not preferring the appeal within the specified period**.*
> *(3) ******
>
> ***[Emphasis Supplied]***

70. Therefore, the judgement in ***Rohan Builders*** and the scheme of the TM Act itself would indicate that where a limitation period is intended, it is positively provided for. Rule 45 is not a limitation provision but an administrative procedural provision. I have already recorded above, the other reasons for which the time specified in Rule 45 of the 2017 Rules is not a mandatory limitation period but a directory administrative timeline. Therefore, the standard not being one of excusing a period of limitation for sufficient cause, it is only appropriate that Section 131 enables extension of

time specified under Rule 45 at the discretion of the Registrar. In fact, Section 131, which confers discretion embedded in the main statute to extend time, is an intrinsic pointer to the timeline under Rule 45 being directory and not mandatory.

71. For the aforesaid reasons, in my opinion, there is no basis to accept the contention of the Registrant that the Interlocutory Application ought to have been filed before the scheduled expiry of the deadline under Rule 45 of the 2017 Rules.

III. The One-Month Limit for Extension:

72. The *third* issue is the effect of the maximum extension period of one month specified in Rule 109(2) of the 2017 Rules. Rule 109(2) uses the phrase "*subject to the provisions of the rules where a maximum time limit is prescribed*" extension of "*time not exceeding one month*" may be granted by the Registrar. This would necessarily mean that any provision in the 2017 Rules that caps the time for grant of extension would have to be borne in mind when granting extension. Likewise, the time extended by the Registrar cannot exceed one month.

73. In a nutshell, Mr. Kamod's submission is that without anything being done within the two-month period – no Evidence Affidavit; no confirmation of giving it a go-by with reliance only being placed on the Rectification

Application; the Interlocutory Application being filed nearly four years later; and that being allowed, effectively, the maximum extension of one month permitted in Rule 109(2) has been completely violated by the Impugned Order.

74. To begin with, Rule 45 does not contain any language providing a unique *maximum* time limit – it simply stipulates a time period for filing an Evidence Affidavit. For the reasons already spelt out, in my view Rule 45(1) contains a directory deadline, due to which it cannot stipulate a maximum time limit, namely, a time limit incapable of being extended under Section 131 of the TM Act. I have also explained above as to why in my view, Section 131 of the TM Act permitting grant of extension even after expiry of the deadline, does not stipulate a limitation period for filing an application seeking extension.

75. As regards, Mr. Kamod's submission that the Impugned Order, in effect, grants an extension of nearly four years, here again, the answer lies within the language of Section 131 of the TM Act.

76. The very ingredient of this provision, namely, that an application for extension can be granted even after expiry of the time within which a specified action has to be taken, is vital to note. Rule 109(2) too provides that such extension can be granted after the expiry of the time. Therefore, the phrase "*extend the time not exceeding one month and communicate the parties*

accordingly" can only mean that the additional time granted by the Registrar when disposing of an application for extension of time, cannot be for a period more than a month from the date of disposal of the application.

77. In other words, if the Registrar thinks it fit to grant an extension, the extension of time that he would grant when allowing the application would be for a maximum period of *another* month. In the instant case, the Interlocutory Application enclosed with it the Evidence Affidavit. It was allowed and therefore, on the same day, the Evidence Affidavit came on record. Therefore, the extended time for filing the Evidence Affidavit did not even need another month, which is the maximum further time that could be granted.

78. Therefore, in my opinion, the Impugned Order cannot be faulted. The extension granted was in disposal of the Interlocutory Application that can legitimately be filed after the expiry of the time stipulated under Rule 45. That Interlocutory Application was allowed and the time that could have been granted in allowing it was a maximum of one month from that date. In the facts of this case, upon the Interlocutory Application being allowed, compliance with the extended time was achieved and there was no need to use another month.

79. To hold otherwise, would mean that applications under Section 131 would have to be filed before the expiry of the deadline sought to be extended,

and such applications would necessarily have to be considered and disposed of by the Registrar before the scheduled expiry of the deadline and if allowed, the extension can only be for one more month. I have already explained why Courts cannot impute an un-legislated period of limitation and how the discretion given to the Registrar enables grant of extension even after the expiry of the scheduled deadline. If Mr. Kamod's submission is accepted, any disposal of an application under Section 131 allowing time extension, if granted after one month beyond the scheduled deadline has expired, would lead to the one-month cap being violated.

80. The temporal element in the operation of Section 131 read with Rule 109 is quite logical and reasonable. To assail any exercise of such power squarely granted in law by reference to an effective violation of an additional one month would inflict violence to the letter and scheme of these provisions. Therefore, on this *third* facet too, I do not find merit in the objections raised on behalf of the Registrant.

Ministerial Action and Appealability:

81. I must mention that the merits of the factual grounds on which the Impugned Order allowed the Interlocutory Application have not been seriously dwelt upon by the Learned Advocates. The primary line of attack

was that the Impugned Order is wholly without jurisdiction and contrary to law.

82. Both Learned Advocates have made submissions primarily on the law. Mr. Kamod indeed pointed to the Impugned Order being terse and cryptic about the reasons for which time extension was being granted. In this light, Mr. Singh's contention that an appeal is not even maintainable has to be considered. He would contend that the extension of time is a ministerial act and has been widely held to be so, and this is consistent with the legislative intent under Section 131(2) of the TM Act, which specifically disallows any appeal against a decision taken under Section 131 of the TM Act.

83. Section 131(2) treats the seeking and grant of extension of time as a matter between the Registrar and the applicant, by providing that the Registrar need not hear the parties before disposing of an application for extension of time. This is purely, therefore, a ministerial act, as has been declared in multiple judgements including ***Jagatjit Industries***[8]. Specifically, it is provided that no appeal would lie from an order of the Registrar under Section 131.

84. Mr. Singh is right when he contends that Section 131(2) indeed provides that "*no appeal shall lie from any order of the Registrar under this section*". However, an order refusing the grant of extension of time, although passed

8 *Jagatjit Industries Ltd. v. Intellectual Property Appellate Board* – ***(2016) 4 SCC 381***

under Section 131, could still have repercussions that make it an order referable to other sections from which, orders are appealable under Section 91 of the TM Act. For example, a declaration that a deemed abandonment under Rule 45(2) or Rule 46(2) of the 2017 Rules could constitute a rejection of the Notice of Opposition or a rejection of the application for registration. Therefore, such orders, being referable to the powers under not just Section 131, may become appealable. As another example, the Registrar may disallow extension of time specified under Rule 45(1) but hold that the deadline having been missed, only future Evidence Affidavits, if felt necessary under Rule 48, would be considered. Such a decision may not be referable to any other provision that leads to appealable orders.

85. However, an order simply allowing time extension would be squarely covered by the bar on appeals under Section 131(2) of the TM Act, which has been left untouched. This provision squarely stipulates that even a hearing is not necessary to decide an application for extension of time. Indeed, an extraordinary arbitrary exercise of this discretion is not without checks and balances and would be amenable to challenge under the extraordinary writ jurisdiction under the Constitution of India. However, appeals being a creature of statute, the explicit bar on appeal under Section 131(2) would entail a bar on an appeal against a decision to grant extension of time.

86. Therefore, to conclude, a logical and reasonable reading of Section 131(2) would be that a decision to allow an extension of time that is not referable to any other provision would not be an appealable decision, while a decision not to allow an extension of time, depending on other provisions to which it would be referable, may become appealable under Section 91 of the TM Act.

87. On facts, I have carefully examined the findings of the Learned Division Bench of the Delhi High Court in its judgement dated May 28, 2021, a challenge to which was repelled by the Supreme Court by its order dated July 12, 2021. It is only appropriate that since neither side has agitated any facet of facts, I should refrain from making any remarks on facts lest they influence the conduct of the proceedings pending before the Registrar.

Case Law Cited:

88. This brings me to the judgements cited in favour of holding that Rule 45 contains a mandatory deadline. Both ***Sun Pharma*** and ***Mahesh Gupta*** have extensively commented on the 2017 Rules and stated that the deadline under Rule 45 is mandatory as contradistinguished from the earlier directory regime under the 2002 Rules. Put differently, they have sought to comment on what the 2017 Rules are, in order to indicate what the 2002 Rules are not.

89. At this juncture, I must state that the dynamics that govern Opposition Proceedings and Rectification Proceedings stand in two different mutually

exclusive domains of policy concerns. I have to state this only because ***Sun Pharma*** relies significantly on the delay in grant of registration that would be occasioned if Opposition Proceedings are not conducted in a timebound fashion. It is only the procedure and form of presentation that are conveniently merged between Opposition Proceedings and Rectification Proceedings. In concept, an opposition before registration of a trade mark and a prayer for cancellation or rectification after registration of a trade mark would both assail the registration. However, the vital difference is that Opposition Proceedings are conducted before the statutory protections from registration can start flowing while Rectification Proceedings are conducted after the statutory benefits are already secured by the registration. Therefore, the approach to time sensitivity varies between the two types of proceedings.

90. The statutory protections and benefits that flow as a consequence of registration in Chapter IV of the TM Act are still aspired to by an applicant for registration while such entitlements and protections are already statutorily vested in the Registrant who faces Rectification Proceedings. In the former, a delay in enabling statutory protection presents the policy concern. In the latter, the delay in conduct of the Rectification Proceedings, giving the incumbent Registrant continued statutory protection which is a different policy concern.

91. It is also noteworthy that every judgement cited by each side has been rendered in the context of Opposition Proceedings initiated pending registration and not in the context of Rectification Proceedings conducted under Rules 46 to 51 on a *mutatis mutandis* basis. The policy concerns articulated in these judgements are all expressed in the context of a delay in grant of registration and not in the context of a Registrant who has already secured the statutory benefits, which are sought to be dislodged by the Rectification Proceedings.

92. I have carefully examined both ***Sun Pharma*** and ***Mahesh Gupta*** which were essentially ruling upon and interpreting the 2002 Rules. They compare the language in *Rule 45 of the 2017 Rules* with *Rule 50 of the 2002 Rules* and *Rule 53 of the 1959 Rules*. As stated in ***Ravi Ranjan***[9], it is well settled that a judgement is a precedent for the issue of law that is raised and decided and must be construed in the backdrop of the facts and circumstances in which the judgement has been rendered. A judgement is not to be read and interpreted as if it were a statute.

93. In any case, with the deepest respect, I must point out that the comments on the 2017 Rules did not entail an examination of the wider scheme of the 2017 Rules. I have articulated above why in my view the scheme of the 2017 Rules makes the deadline in Rule 45 a directory deadline and not a

9 *Ravi Ranjan Developers (P) Ltd. v. Aditya Kumar Chatterjee* – ***2022 SCC OnLine SC 568***

mandatory deadline. I am unable to be persuaded by the reliance upon ***Sun Pharma*** and ***Mahesh Gupta***, and for that very reason, I am also not persuaded by the decisions of the Madras High Court which rely upon or endorse ***Sun Pharma*** and ***Mahesh Gupta***.

94. To avoid prolixity, I do not think it necessary to compare the 1959 Rules, the 2002 Rules and the 2017 Rules. I have independently set out my reading of the 2017 Rules and its scheme. The reasons that weighed with different courts in holding the 1959 Rules and the 2002 Rules to stipulate directory deadlines are based on the language of those provisions and in the context of the factual matrix in which they were declared. I would only state that in Rule 53 of the 1959 Rules, the Registrar's discretion was set out in Rule 53(2) by usage of the term "unless the Registrar otherwise directs". Likewise, the discretion of providing extension by one month was inherently set out in Rule 50 of the 2002 Rules. The statutory entitlement of the Rectification Applicant to lead more evidence in Rule 47 of the 2017 Rules read with the discretionary power to permit more evidence under Rule 48 of the 2017 Rules all inexorably point to the deadline in Rule 45 of the 2017 Rules being directory and not mandatory.

95. How to structure and place the element of discretion to extend time is purely a matter of drafting and structuring of the legislation. A simple comparison of just corresponding provisions of specific rules and elevating

deadlines provided in the subordinate legislation to deadlines provided in the TM Act, does not appeal to me as a reasonable reading of the 2017 Rules.

96. Instead, the reasoning articulated by the IPAB in ***Sahil Kohli***, which is commended for endorsement by Mr. Singh, resonates with me. To begin with, this is a case where the factual matrix is entirely covered by the 2017 Rules alone, although here too, it is in the context of Opposition Proceedings where the Notice of Opposition was declared as deemed abandoned. It has been rightly held by the IPAB that the operation of Section 131 is adequate to address the deletion from Rule 45 of the 2017 Rules, of language that had provided for discretion in Rule 50 of the 2002 Rules. The IPAB held that the deadline in Rule 45 of 2017 Rules is still directory in nature. I am in complete agreement with the following extract from ***Sahil Kohli***, which differently summarises the analysis set out in the earlier part of this judgement:

> *"55.* ***But the altogether removal of the wordings relating to the extension of time from the Rule 45 will yield different results wherein one has to again revert to section 131 which is the parent provision which gives the room to the registrar to extend the time period****. Therefore, by removal of the wordings from rule 45,* ***the power of the registrar to grant extension of time in the matters of filing the evidence beyond two month time period cannot be taken away as the same would be contrary to section 131. The said section thus will continue to operate and the registrar will continue to have power to grant extension of time upon making of an application in a prescribed manner and prescribed fees upon furnishing of the sufficient cause.***
>
> *59.* ***The restrictive interpretation on the assumption that the Registrar has no discretion left for condoning the time period for filing the evidence in support of the***

opposition and the only consequence left is the operation of Rule 45(2) in the form of abandonment of opposition is clearly making the provisions of Section 131 as otiose and redundant*, therefore, it is* ***necessary to adopt the interpretation, wherein the discretion is left with the Registrar to condone the time period for filing the evidence in support of the opposition so as to make the provisions of Section 131 of Trade Marks Act, 1999 workable and continue to apply with respect to those acts for which the time limitation is not provided by the Act for doing any act****."*

[Emphasis Supplied]

Conclusions:

97. To summarise:

A] The deadline in Rule 45(1) of the 2017 Rules is not mandatory; it is directory;

B] The effect of the deemed abandonment of the Notice of Opposition or the application for registration under Rule 45(2) and Rule 46(2) respectively is restricted to the entitlement to file an Evidence Affidavit within the deadline stipulated in Rule 45(1) and Rule 46(1) respectively;

C] The missed deadline under Rule 45 (and for that matter Rule 46) is capable of being extended under Section 131 of the TM Act, the application for which can be filed and be granted even after the expired deadline;

D] Section 131 of the TM Act read with Rule 109 of the 2017 Rules permits an extension of time subject to the Registrar being satisfied, and the period by which the extension can be granted cannot exceed one month from the time when the order granting extension is made;

E] Rule 109(1) of the 2017 Rules marginally expands the scope of the fetter on the Registrar's jurisdiction under Section 131 of the TM Act, but only in relation to the deadline of six months imposed for the registration of an agreement to use a registered trade mark. This judgement makes no comment on the validity of such expansion of exclusion i.e. curtailment of the scope of the parent statute, since that issue need not be ruled upon in this case. In any case, the expanded fetter on jurisdiction under Section 131 of the TM Act does not bring within its reach the deadline under Rule 45 of the 2017 Rules;

F] The observations made in ***Sun Pharma*** and ***Mahesh Gupta*** in relation to Rule 45 of the 2017 Rules do not constitute the ratio to interpret this provision, since the factual matrix adjudicated therein entailed the interpretation of the 2002 Rules. Even if those observations were treated to be a ratio, I am not persuaded by those views. I respectfully disagree with the interpretation of the nature of Rule 45 of the TM Rules and the scope of Section 131 of the TM Act in those judgements. Instead, the law declared by the IPAB in ***Sahil***

Kohli lends itself to acceptance. Procedural provisions and that too in subordinate legislation must serve as a servant of justice delivery flowing from the parent statute and cannot be a "tyrant" ruling and curtailing the substantive rights created in the parent statute;

G] This case necessitated examining whether Rule 45 of the 2017 Rules is mandatory or directory. On finding that the deadline contained in it is directory, the necessary consequence is that the allowing of an extension of time under Rule 45 is only a ministerial act not appealable by operation of Section 131(2) of the TM Act. It is not a decision taken without jurisdiction; and

H] The Impugned Order does not call for any interference and rightly holds that the interests of justice necessitated allowing the Interlocutory Application, particularly considering the complex factual family history of the parties, and the contentions of the parties in the chequered litigation they have already indulged in.

98. Therefore, the Commercial Miscellaneous Petition is ***dismissed*** and the Impugned Order is upheld. Considering the nature of the legal issues that arose and had to be considered, I am persuaded that this is not a case where costs have to follow the event.

99. All actions required to be taken pursuant to this order shall be taken upon receipt of a downloaded copy as available on this Court's website.

[SOMASEKHAR SUNDARESAN, J.]