

### Trademark | Case Law Update

## What amounts to receipt when notice of opposition is served by the Trade Marks Registry through email?

**By Pankaj Dwivedi**

The question that arose for consideration before the Madras High Court in the recent case of *Ramya S. Moorthy vs Registrar of Trade Marks and Anr.*, in August, was what amounted to receipt of notice of opposition when served by email for the purposes of calculating the time limit for filing a counter statement.

To give context, Section 21 of the Trade Marks Act, 1999 (TM Act) stipulates that once the Registrar of Trademarks (Registrar) serves a copy of the notice of opposition on the applicant for registration, within two months from the receipt of such copy, the applicant must send their counterstatement. Failure to do so would result in a deemed abandonment of the application. Additionally, Rule 18(2) of the Trade Marks Rules, 2017 (Rules) stipulates among others that any such communication by email shall be deemed to have been served at the time of sending the e-mail.

The petitioner, Ramya S. Moorthy (Moorthy), had filed two trademark applications, both of which were opposed on January 12, 2023. As per the Registrar, the oppositions were served on Moorthy via e-mail on January 19, 2023, thereby setting the clock for her to file the counter statements by March 19, 2023. Since she did not file counter statements within that time, orders were issued by the Registrar under Section 21(2) of the TM Act treating the applications as deemed to be abandoned.

Moorthy challenged the abandonment orders passed by the Registrar through constitutional writs before the Madras High Court. In the writs, she denied receipt of the notices of opposition and argued that under Section 21(2) of the TM Act, the clock starts ticking only upon receipt of a copy of the notice of opposition by the applicant; and that since she never received the notices, the conclusion that she abandoned the applications was untenable. On the other hand, the Registrar relied on Rule 18(2) of the TM Rules and argued that the service of notice by e-mail is deemed to be proper service upon mere dispatch of the e-mail.

The Court considered the arguments and noted that the words “at the time of sending the e-mail” in Rule 18(2) if construed literally, would mean that to establish receipt, all that is needed is proof of transmission of the e-mail. The Court further noted that this is not in consonance with Section 21(2) of the TM Act which does not have a provision for deemed receipt. The section provides that the time limit for filing the counter statement would run from the date of receipt by the applicant of the notice of opposition.

Accordingly, the Court held that the prescribed time limit for filing counterstatement would only run from the date of receipt of the e-mail, and the document relied on by the Registrar does not qualify as evidence of receipt by Moorthy.