



No. 02/2012

Trademarks – Registrar of Trade Marks not to Revise Deputy Registrar’s Decision Subsequent to Opposition Proceeding

A belated opposition was filed by a third party along with a request for extension of time against registration of the trade mark E4 (label). The Registrar of Trade Marks after having disallowed the request for extension and treating the opposition as in-fructuous ordered the applicant’s mark to proceed to registration but with disclaimer of “E4”.

Being aggrieved by the Registrar’s order, the Appellant (applicant) preferred an appeal in the High Court contending that after the Registrar’s dismissal of the opposition holding that notice of opposition had become in-fructuous being time barred, he could not modify the order of the Deputy Registrar of Trade Marks by imposing a fresh disclaimer. Allowing the appeal, the High Court held that the authorities were not justified in ordering the Appellant’s application to proceed to registration with a fresh disclaimer of E4, as no such disclaimer was ordered by the Deputy Registrar, while considering the application for registration. As such, the Registrar’s order was set aside to the extent of disclaimer of E4 and order of Deputy Registrar on the point was restored.

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Appeal in High Court

Appellant: PETROMARK (PRIVATE) LIMITED

Respondent: REGISTRAR OF TRADE MARKS and another

Decision: Appeal allowed

In this case the Appellant, Petromark (Pvt) Limited, had filed an application for registration of the trade mark E4 (label) which was duly examined and as per the hearing held before the Deputy Registrar of Trade Marks, the mark was advertised in the Trade Marks Journal. The mark was opposed by a third party by filing a belated request for extension of time on the prescribed form along with a notice of opposition. The Registrar of Trade Marks disallowing the request for extension of time treated the opposition proceeding as in-fructuous, ordered the applicant’s mark to proceed to registration but with disclaimer of “E4”.

The Appellant (applicant) being dissatisfied with the order of the Registrar preferred an appeal in the High Court. The Appellant submitted that since the entire opposition was dismissed by the Registrar as being time barred and he had deemed the notice opposition as in-fructuous, he could not modify the order of the Deputy Registrar and order the Appellant’s application to proceed to registration with disclaimer of E4. The Appellant further submitted that subsequent to the order of the Registrar in the opposition proceeding the Appellant had effected payment of registration fee under the direction of the Registrar and as such it has acquired vested right for registration of its trade mark as per order passed by the Deputy Registrar during the application proceeding i.e. without the disclaimer of E4.

After hearing the arguments, the court allowing the appeal held that the arguments advanced by the counsel of the Appellant carry a lot of force. It also held that the Registrar does not appear to be justified in ordering the Appellant’s application to proceed to registration with disclaimer of E4, as no such disclaimer was imposed by the Deputy Registrar at the time of considering the Appellant’s application for registration, against whose order the opponent had filed the opposition. Accordingly, the court ordered to set aside the order of the Registrar to the extent of disclaimer of E4 and the order of the Deputy Registrar on the point restored (*Reported in 2011 CLD 1082*).





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