

\* IN THE HIGH COURT OF DELHI AT NEW DELHI

Pronounced on: 03<sup>rd</sup> July, 2023

+ C.A.(COMM.IPD-TM) 130/2021

SAP SE..... Petitioner

Through: Mr. Peeyoosh Kalra, Mr. CA Brijesh  
and Ms. Pragati Agrawal, Advocates.

versus

SWISS AUTO PRODUCTS AND ANR..... Respondents

Through: Mr. Sanjeev Singh, Advocate for R-1.  
Mr. Harish Vaidyanathan Shankar,  
CGSC with Mr. Srish Kumar Mishra,  
Mr. Sagar Mehlawat and  
Mr. Alexander Mathai Paikaday,  
Advocates for R-2.

**CORAM:**  
**HON'BLE MR. JUSTICE SANJEEV NARULA**

**JUDGMENT**

**SANJEEV NARULA, J.**

1. The crux of the present appeal revolves around Appellant's entitlement to furnish additional evidence, in a bid to bolster its claim for the registration of a proposed trademark. The situation calls for the resolution of a critical question of law, the nexus between the chronology of the application and the procedural rules in effect during different stages of its pendency, thereby setting the stage for the legal quandary.

**FACTS**

2. Originating in 1972, the Appellant – SAP SE, has emerged as a

significant player in the domain of providing synergistic business solutions for an array of industries and ranks amongst the world's leading business software entities. Despite its Germany-based headquarters, the Appellant's influence has spread globally, with an established presence in several countries. Marking its entry into India in 1992, the Appellant has been engaged in the distribution of products/services under the flagship trademark "SAP". The Appellant holds ownership over several intellectual properties, notably the trademark "SAP", a moniker adopted way back in 1972 and utilized extensively and uninterruptedly since then. The said trademark has become intrinsically intertwined with Appellant's business persona, exemplified in its trading style, corporate identity, and online presence. In an effort to secure its intellectual property rights, the Appellant has pursued and achieved registrations for the trademarks "SAP" and "SAP" formative marks in multiple classes.

3. To add to its bouquet of registrations, on 06<sup>th</sup> December, 1999, the Appellant filed an application for registration of trademark "SAP" in class 09 in respect of "*machine-readable data media of all types provided with programs; computer programs and software of all types; magnetic carriers, namely magnetic tapes, disks, wafers and cards*". The application was filed claiming priority from German trademark No. 399 46 355.0 dated 03<sup>rd</sup> August, 1999, and use since 01<sup>st</sup> November, 1995. The registration process was punctuated by a notice of opposition dated 02<sup>nd</sup> August, 2007 filed by Swiss Auto Products (Respondent No. 1), challenging the registration. This opposition notice was forwarded to the Appellant's attorney on 12<sup>th</sup> October, 2011 and received by them on 24<sup>th</sup> October, 2011, calling for a counter-

statement. The requested counter-statement was submitted by the Appellant on 21<sup>st</sup> December, 2011 and was subsequently forwarded to Respondent No. 1's attorney on 09<sup>th</sup> July, 2013 *via* letter No. TOP/3089, soliciting evidence to support their opposition.

4. During this period, both parties engaged in multifarious discussions in pursuit of a mutually agreeable settlement; however, these deliberations were to no avail. On 09<sup>th</sup> October, 2013, Respondent No. 1 reached out to the Registrar of Trademarks (Respondent No. 2), expressing a desire to rely on the facts detailed in the opposition notice as part evidence. Later, on 19<sup>th</sup> October, 2013, Respondent No. 1 submitted an affidavit of evidence in support of opposition, a copy of which was delivered to the Appellant's attorney on 23<sup>rd</sup> October, 2013.

5. According to the Appellant, the copy received by it lacked the enclosed annexures labelled A to C. A request for these omitted annexures was promptly made by the Appellant's attorney on 24<sup>th</sup> October, 2013. Respondent No. 1, in response, demanded compensation for the expenses incurred in the photocopying and dispatch of the missing annexures. Finally, on 12<sup>th</sup> November, 2013, the Appellant's attorney received the requested copies of the annexures mentioned in the affidavit. *Vide* letter dated 09<sup>th</sup> January, 2014 addressed to Respondent No. 2, the Appellant postulated that the deadline for submitting evidence to support their application should commence from 12<sup>th</sup> November, 2013, *i.e.*, the date on which the complete set of annexures was furnished. To this end, they also proceeded to file multiple TM-56 forms, each requesting a one-month extension of time. On

09<sup>th</sup> May, 2014, the Appellant filed an Interlocutory Petition (“IP”) accompanied by affidavits, constituting the evidence in support of their application. However, following a series of hearings conducted over the span of 2018-2019, Respondent No. 2, by virtue of the order dated 12<sup>th</sup> June, 2019 (hereinafter referred to as the “*Impugned Order*”), decided against the Appellant, thereby refusing to take the evidence on record.

### **COUNSEL’S SUBMISSIONS**

6. Mr. Peeyoosh Kalra, counsel for the Appellant, contended as follows:

6.1 Appellant never lacked diligence in prosecuting its application and the delay of mere three months in filing evidence in support of the application was due to unavoidable circumstances, which arose due to time consumed in collating voluminous documents. This short delay should not take away Appellant’s valuable right to protect and defend its intellectual property vesting in the trademark “SAP”.

6.2 The Registrar could have condoned the delay by exercising the discretion vested in him under Rule 53 of the Trademarks Rules, 2002 (hereinafter, “*2002 Rules*”). Respondent No. 2 has erred in holding that it is not permissible under Rule 51(1) of the 2002 Rules to grant an extension of more than one month. Rule 51 is not to be considered in isolation, but is to be read harmoniously with other provisions of the Trademarks Act, 1999 (hereinafter, “*the Act*”) and the rules framed thereunder. Reference is made to Section 131 of the Act to contend that a harmonious construction of the 2002 Rules and the Act leads to the conclusion that the time period

prescribed under Rule 51 is directory and not mandatory in nature,<sup>1</sup> and thus, it does not take away the Registrar's discretion to extend the timeframe beyond one month.

6.3 In passing the Impugned Order, Respondent No. 2 has failed to appreciate that Section 21(4) of the Act does not provide a specific time period for filing of evidence in support of application, which indicates the legislature's intention to not constrain the time for filing evidence. The intent is to allow the Registrar to take on record relevant evidence in deserving cases.

7. Mr. Sanjeev Singh, counsel for Respondent No. 1, on the other hand, argued that the Impugned Order does not call for any interference by making the following submissions:

7.1 Section 131(2) of the Act bars any appeal against the order passed by Registrar under Section 131(1). Hence, the present appeal is not maintainable as Respondent No. 2 has exercised the discretionary power, which exercise of jurisdiction is not appealable.

7.2 In the IP, the Appellant did not make any reference to Rule 53 of the 2002 Rules. Instead, they pled Rule 51 and implored the Registrar of Trademarks to exercise discretionary power in accordance with Section 131

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<sup>1</sup> Appellant placed relied upon the following judgements:

(a) **Bausch and Lomb Incorporated v. Union of India and Ors.**, in Special Civil Application No. 373/2016 dated 03<sup>rd</sup> October, 2016.

(b) **Wyeth Holding Corp and Anr. v. Controller General of Patent, Design and Trademarks and Ors.**, 2006 SCC OnLine Guj 620.

(c) **Torrent Pharmaceuticals Ltd. v. Union of India**, 1998 SCC OnLine Guj 145.

(d) **K.T. Jobanputra v. Registrar of Trademarks**, in Misc. Petition Nos. 926/ 1997 and 1511/1997, dated 27<sup>th</sup> March, 1980.

(e) **Asian Paints Limited v. Registrar of Trademarks**, in M.P. No. 119/2004 and O.A. No. 106/2004/TM/DEL, dated 10<sup>th</sup> February, 2005.

of the Act. This stance is clearly reflected across multiple paragraphs within the appeal. The contention based on Rule 53 only surfaced in the written notes submitted to the Court and as such, cannot be taken as a ground to contest the Impugned Order.

7.3 Without prejudice, Rule 53 is not applicable as it deals with leading additional evidence and does not deal with previously omitted evidence under Rule 51.

7.4 Provisions of 2002 Rules *qua* filing of evidence have been held to be mandatory by Coordinate Benches of this Court in *Sunrider Corporation, USA v. Hindustan Lever Ltd. and Anr.*<sup>2</sup> and *Aman Engineering Works v. Registrar of Trade Marks and Anr.*<sup>3</sup> Therefore, the judgments relied upon by the Appellant to contend that the said provisions are directory, are not applicable.

### **ANALYSIS**

8. The Court, upon careful consideration of the issues at hand, acknowledges that the central theme of the arguments put forth by both parties is the determination of the question – whether the stipulations of 2002 Rules regarding timelines for submission of evidence are of a mandatory or directory nature. However, prior to engaging with this debate, it becomes imperative to address a fundamental question – was it within the jurisdiction of Respondent No. 2 to employ the 2002 Rules in formulating the disputed conclusion encapsulated in the impugned decision?

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<sup>2</sup> 2007 SCC Online Del 1018.

<sup>3</sup> 2022 SCC Online Del 3666.



9. The Court considers this initial enquiry to be a crucial step that precedes the resolution of the issue at hand. The significance of this preliminary investigation arises from the fact that the relevant provisions pertaining to filing of evidence supporting the application have undergone considerable revisions with the enactment of the Trademarks Rules, 2017 (“2017 Rules” hereinafter). These modifications could materially impact the classification of the Rules as either mandatory or directory. It would thus be prudent to juxtapose the pertinent rules to elucidate the nature and implications of the amendments introduced over the years:

<b>Trade and Merchandise Marks Rules, 1959</b>	<b>The Trademarks Rules, 2002</b>	<b>The Trademarks Rules, 2017</b>
<p><b>54. Evidence in support of Application-</b></p> <p>Within two months from the receipt by the applicant of the copies of affidavits in support of the opposition or of the intimation that the opponent does not desire to adduce any evidence in support of its 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 counter statement and or on the evidence already left by him in connection with the application in question. In case the applicant relies on any evidence already left by him in connection with the application, he shall deliver to the opponent copies thereof.</p>	<p><b>51. Evidence in support of application-</b></p> <p>(1) Within two months or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow, 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 relies on any evidence already left by him in connection with the application,</p>	<p><b>46. Evidence in support of application-</b></p> <p>(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</p>

	he shall deliver to the opponent copies thereof. (2) <u>An application for the extension of the period of one month mentioned in sub-rule (1) shall be made in Form TM-56 accompanied by the prescribed fee before the expiry of the period of two months mentioned therein.</u>	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 <u>deemed to have abandoned his application.</u>
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[Emphasis Supplied]

10. As delineated in the afore-mentioned comparison, the Trade and Merchandise Marks Rules, 1959 (referred to as “1959 Rules” hereinafter) did not instate any rigid timelines under Rule 54 that would impinge upon the Registrar’s discretionary power to admit requests for evidence beyond the prescribed period. Rule 53 (evidence in support of opposition) of the 1959 Rules was classified as directory, rather than mandatory, by a Full Bench of this Court in *Hastimal Jain Trading as Oswal Industries v. Registrar of Trade Marks*.<sup>4</sup> This conclusion was premised on a thorough examination of the structure and provisions of the Trade and Merchandise Marks Act, 1958 (hereinafter, “1958 Act”) and the 1959 Rules, wherein it was discerned that the Registrar was accorded the discretion to extend timelines for filing evidence under various provisions of the 1958 Act and the 1959 Rules, as the 1958 Act did not itself lay down specific timelines for the said purpose.

11. Subsequent to the above decision, this Court, in the case of *Sunrider Corporation (Supra)*, differed from the views expressed in the afore-mentioned decision due to the disparities between the repealed provisions of

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<sup>4</sup> 2000 (20) PTC 24.



the 1959 Rules and the revised provisions under the 2002 Rules. The Court ruled that Rule 50(2) of the 2002 Rules is mandatory, rather than directory. Interestingly, under the 2017 Rules, the legal position has apparently reverted to the state that existed prior to the enactment of the 2002 Rules. The phrase “*within such period not exceeding one month in the aggregate thereafter as the Registrar may on request allow*” has been expunged. This particular phrase constituted the core rationale behind this Court’s ruling in *Sunrider Corporation (Supra)* that the 2002 Rules were mandatory, rather than directory. Hence, in light of the congruence of 2017 Rules with the 1959 ones, the judgement in *Hastimal Jain (Supra)* once again becomes germane to the question of whether the Registrar possesses the discretion to admit evidence even when submitted beyond the stipulated period of two months.

12. Now coming to the controversy at hand. The Impugned Order, dated 12<sup>th</sup> June, 2019, was passed at a time when the 2002 Rules had been superseded by the 2017 Rules, which had come into effect on 06<sup>th</sup> March, 2017. Given these circumstances, the Court considers it imperative to scrutinize the repeal and savings provision *i.e.*, Rule 158 of the 2017 Rules, which reads as follows:

*“158. Repeal – The Trade Marks Rules, 2002, are hereby repealed without prejudice to anything done under such rules before the coming into force of these rules.”*

13. The 2017 Rules have thus repealed 2002 Rules in its entirety, saving only the acts which had been done prior to the date on which the 2017 Rules

entered into effect (06<sup>th</sup> March, 2017). In the instant case, although the proceedings relating to the trademark application and opposition thereto were initiated while 2002 Rules were in force, nonetheless, there was no finality in the decision making of Respondent No. 2. According to the facts detailed above, the computation of the deadline for filing the evidence in support of the application commenced from 12<sup>th</sup> November, 2013. The Appellant had, *vide* letter dated 09<sup>th</sup> January, 2014 (within two months of the deadline), sought an extension of one month for filing the evidence in support of the application. Crucially, it had also submitted that in the event that this request is denied, the Appellant intended to rely on the facts stated in the counter-statement. By virtue of this action, the Appellant has avoided the application of the deemed abandonment provision present in Rule 46(2) of the 2017 Rules, which was notably absent in the 2002 Rules.

14. On the issue of retrospective application of law, the Supreme Court has pronounced its stance on the implications of procedural amendments in numerous judgements. The highest judicial authority has maintained that procedural amendments are presumed to hold retrospective efficacy, unless the amendment statute explicitly or implicitly suggests to the contrary. This presumption serves to ensure the smooth administration of justice by adapting to changes that enhance the efficiency and efficacy of legal proceedings.

15. In *Hitendra Vishnu Thakur v. State of Maharashtra*,<sup>5</sup> the law on

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<sup>5</sup> (1994) 4 SCC 602.

retrospective application of procedural amendment has been summarised as thus:

*“(i) A statute which affects substantive rights is presumed to be prospective in operation, unless made retrospective, either expressly or by necessary intendment, whereas a Statute which merely affects procedure, unless such a construction is texturally impossible, is presumed to be retrospective in its application, should not be given an extended meaning, and should be strictly confined to its clearly defined limits.*

*(ii) Law relating to forum and limitation is procedural in nature, whereas law relating to right of action and right of appeal, even though remedial, is substantive in nature.*

*(iii) Every litigant has a vested right in substantive law, but no such right exists in procedural law.*

*(iv) A procedural Statute should not generally speaking be applied retrospectively, where the result would be to create new disabilities or obligations, or to impose new duties in respect of transactions already accomplished.*

*(v) A Statute which not only changes the procedure but also creates a new rights and liabilities, shall be construed to be prospective in operation, unless otherwise provided, either expressly or by necessary implication.”*

[Emphasis Supplied]

16. This view has been reiterated in ***Securities and Exchange Board of India v. Classic Credit Ltd.***,<sup>6</sup> wherein Supreme Court observed that presumption against retrospective application of law does not apply to legislation that is concerned merely with matters of procedure or evidence.

17. The immediate question that comes to the mind is whether the amendment introduced by 2017 Rules to the limitation of timelines for filing of evidence under the 2002 Rules is a procedural or a substantive one. In ***Securities and Exchange Board of India (Supra)***, the Supreme Court has held that law relating to forum and limitation is procedural in nature, whereas law relating to right of action and right of appeal is substantive in

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<sup>6</sup> (2018) 13 SCC 1.

nature. In *Topline Shoes Ltd. v. Corporation Bank*,<sup>7</sup> the Supreme Court observed that the timelines prescribed for filing replies under the Consumer Protection Act, 1986 are procedural in nature, and such provisions are merely meant to expedite hearing of such matters and to avoid unnecessary adjournments during the proceedings.

18. In *Thirumalai Chemicals Ltd. v. Union of India*,<sup>8</sup> the Supreme Court explained that the procedural law establishes a mechanism for determining the rights and liabilities of the parties and machinery for enforcing them by holding that “(r)ight of appeal may be a substantive right but the procedure for filing the appeal including the period of limitation cannot be called a substantive right, and aggrieved person cannot claim any vested right claiming that he should be governed by the old provision pertaining to period of limitation.”

19. In *Anant Gopal Sheorey v. State of Bombay*,<sup>9</sup> the Supreme Court quoted Maxwell on Interpretation of Statutes and held as under:

*“No person has a vested right in any course of procedure. He has only the right of prosecution or defence in the manner prescribed for the time being by or for the Court in which the case is pending and if by an Act of Parliament the mode of procedure is altered he has no other right than to proceed according to the altered mode.”*

[Emphasis Supplied]

20. Therefore, since the nature of the provisions regarding timelines of filing evidence, as in the present case, are merely procedural in nature, no

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<sup>7</sup> 2002 (3) SCR 1167.

<sup>8</sup> 2011 6 SCC 739.

<sup>9</sup> [1959] 1 SCR 910.

party can have any vested rights in the same. The presumption against retrospective application would not apply to such provisions and pending actions would also be governed by the amended procedure.

21. It must also be noted that the preamble of the 2017 Rules states that the Central Government has made the Rules in supersession of the 2002 Rules, “*except as respect things done or omitted to be done before such supersession, namely:*”, but does not list any such acts done or omitted to be done, which seems to be a legislative oversight.

22. To examine the effect of the repeal on the 2002 Rules, the Court has also referred to the General Clauses Act, 1897 (hereinafter referred to as “GCA”), which consolidates the rules of interpretations for various enactments. Section 6(e) of the GCA provides that any investigation, legal proceedings or remedies in relation to rights and obligations provided for under a repealed enactment, shall not be affected by the amendment, unless specified. However, a Constitution Bench of the Supreme Court in ***Kolhapur Canesugar Works Ltd. v. Union of India***,<sup>10</sup> has clarified that the savings clause contained in Section 6 does not apply to repeal of a ‘rule’ within the meaning of Section 3(51) of the GCA. In this case, the Supreme Court adjudicated upon maintainability of proceedings conducted under repealed provisions of the Central Excise Rules, 1944. The Court held that the proceedings under the Central Excise Rules will not be protected by the application of Section 6 of the GCA as it only covers repeals by ‘central

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<sup>10</sup> (2000) 2 SCC 536.

acts' and 'regulations', and not rules. Rules do not come within the ambit of 'act' or 'regulation' as per the meaning given in the GCA. Section 3(50) defines 'regulation' as a regulation made by the President under Articles 240 and 243 of the Constitution of India, 1950 or a regulation made by the Central Government under the Government of India Acts of 1870, 1915 or 1935. The 2017 Rules and the 2002 Rules fall squarely within the definition of 'rule' under the GCA, which has been defined to mean "*rules made in exercise of a power conferred by any enactment...*",<sup>11</sup> and therefore, Section 6 would not protect the applicability of the 2017 Rules to the proceedings before the Registrar.

23. The upshot of the above discussion is that due to the procedural nature of 2017 Rules, the Examiner has erred by applying the 2002 Rules on the date when the same had been repealed. The 2017 Rules do not contain any clause that provides that the pending proceedings are unaffected and are to continue as per the 2002 Rules. In absence of any saving clause under the 2017 Rules, in the opinion of the Court, the Registrar ought to have decided the matter by taking into account the provisions of Rule 46 of the 2017 Rules and the provisions of Rules 51 of the 2002 Rules would not apply.

24. On this issue, the Court further takes note of the decision of a Coordinate Bench of this Court in ***Mahesh Gupta v. Registrar of Trademarks and Anr.***,<sup>12</sup> which was delivered after the present case was reserved for judgment. In the aforesaid decision, the Court has taken a view

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<sup>11</sup> Under Section 3(51) of the GCA.

<sup>12</sup> DHC Neutral Citation No.: 2023/DHC/001627.



that the proceedings which were initiated under 2002 Rules would have to be adjudicated under the said Rules. Analysing Rule 158 of 2017 Rules, it was held that the expression “*without prejudice to anything done under such rules before the coming into force of these rules*”, would include the filing of evidence in support of the opposition by the Appellant therein and would thus be governed by the 2002 Rules. The opinion expressed is as follows:

*“7. I may observe, at the very outset, that the learned Deputy Registrar has formally erred in law in passing the impugned order under the 2017 Rules. All proceedings before the learned Deputy Registrar, save and except for the passing of the impugned order, on 7<sup>th</sup> August 2019, took place when the 2002 Rules were in force. The application seeking registration, the opposition thereto, the counter statement filed by way of response to the opposition and the filing of the evidence in support of the opposition by the appellant along with the application seeking condonation of delay, were all prior to coming into force the 2017 Rules; in fact, much prior thereto.*

*8. Rule 158 of the 2017 Rules, even while repealing the 2002 Rules, clearly holds that such repeal would be “without prejudice to anything done under such rules before the coming into force of these rules”. In other words, the repeal of the 2002 Rules by the 2017 Rules would, inter alia, be without prejudice to all proceedings which took place in the present case, including the filing of the evidence in support of the opposition by the appellant which, admittedly, was under Rule 50(1) of the 2002 Rules. The repeal of the 2002 Rules by the 2017 Rules cannot, therefore, prejudice the applicability of the 2002 Rules, insofar as the issue of whether the evidence filed by the appellant under Rule 50(1) of the 2002 Rules could be taken on record, is concerned.*

*9. The dispute has, therefore, to be examined in the light of Rule 50(1) of the 2002 Rules. What has to be seen, therefore, is whether the opposition of the appellant could be treated as having deemed to have been abandoned by applying Rule 50(1) of the 2002 Rules.”*

25. The afore-noted decision does not take note of the judgments of the Supreme Court regarding the retrospective application of procedural amendments. Furthermore, Rule 158 categorically provides that the 2002 Rules are repealed. This means that 2002 Rules no longer have any legal force or effect from the time when 2017 Rules came into effect. The expression “*without prejudice to anything done under such rules before the*

*coming into force of these rules*”, means that any actions taken, decisions made or rights granted under the 2002 Rules, are still valid and will not be affected by the repeal. In other words, the repeal of 2002 Rules, does not erase or invalidate what has been done under them prior to the coming into force of 2017 Rules. Further, the expression “*before the coming into force of these rules*”, specifies the timeline that the clause applies to, which is to any time period before the 2017 Rules came into force. As discussed above, generally, procedural amendments are intended to apply retrospectively unless there is a clear indication to the contrary. The saving expression in the clause noted above is designed to ensure that actions taken, decisions made or rights granted under the repealed rules (2002 Rules) are preserved and remain unaffected by the repeal. The clause would apply to actions completed or rights accrued under the 2002 Rules. The phrase “*anything done under such rules*”, typically refers to completed actions or established rights. In the instant case, the significant action taken under the 2002 rules was filing of the trademark application or submitting the evidence. These actions remain valid and would not be invalidated by the coming into force of 2017 Rules. However, the decision declining Appellant’s evidence because of delay, taken in 2019, is a separate action, at which point of time 2017 Rules were subsisting and therefore, the decision should have been guided by the 2017 Rules. The saving clause protects what was done under the 2002 Rules, but does not dictate that the 2002 Rules continue to govern all aspects of the proceedings after the enforcement of 2017 Rules. Such an interpretation would effectively render the repeal of 2002 Rules meaningless, thereby defeating the intent of replacing the old rules with new ones.

26. Thus, with all due respect, this Court is unable to concur with the view expressed by the Coordinate Bench in *Mahesh Gupta (Supra)*. In the Court's opinion, there is a need for clarity on whether the procedural changes introduced by 2017 Rules apply retrospectively to the ongoing proceedings initiated under the 2002 Rules. Since, as noted above, the 2017 Rules relating to filing of evidence have undergone considerable changes, a determination on this crucial aspect is imperative which would have significant implications for the rights and obligations of parties engaged in similar disputes. Different interpretations would lead to different outcomes resulting in legal uncertainty. Therefore, a definite ruling by a Larger Bench would ensure consistency and predictability in the application of the Rules.

27. For the foregoing reasons, in view of the decision of the Supreme Court in *Central Board of Dawoodi Bohra Community and Anr. v. State of Maharashtra and Anr.*,<sup>13</sup> the present file be placed before the Hon'ble the Chief Justice with a request for constituting a Larger Bench to decide the following issues:

- i) Whether the rules dealing with procedural aspects, including those relating to the filing of evidence introduced by the Trademarks Rules, 2017, would apply retrospectively to proceedings initiated under the Trademarks Rules, 2002.
- ii) Whether failure to file evidence in support of the trademark application would tantamount to 'anything done under the Trademarks Rules, 2002', which is saved by Rule 158 of the Trademarks Rules, 2017

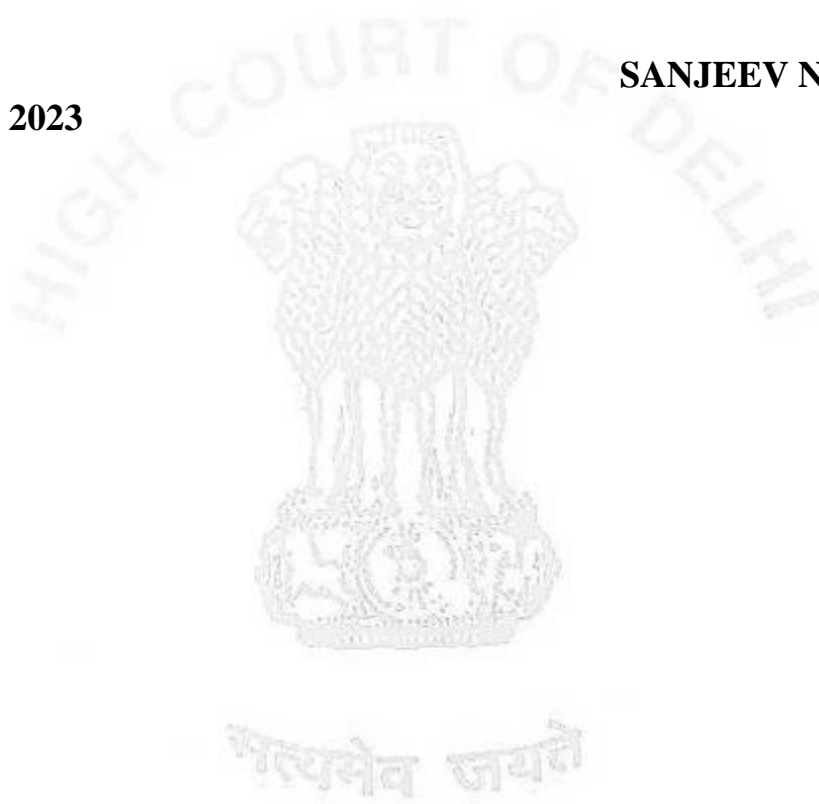
and would continue to be governed by the Trademarks Rules, 2002.

28. After obtaining the appropriate orders of Hon'ble the Chief Justice, list the matter before the Larger Bench for consideration of the afore-noted issues on 14<sup>th</sup> July, 2023.

**JULY 03, 2023**

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**SANJEEV NARULA, J**



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<sup>13</sup> (2005) 2 SCC 673.