

**STASSEN EXPORTS LTD.  
VS.  
REGISTRAR OF PATENTS AND TRADE MARKS AND OTHERS**

COURT OF APPEAL  
BALAPATABENDI, J AND  
IMAM, J  
CA 723/92(F)  
D.C. COLOMBO 3263/SPL  
NOVEMBER 15TH 2004

*Code of Intellectual Property Act, No. 52 of 1979, sections 172(2) and 182- Failure to file notice of opposition to the registration of eight trade marks - One action instituted - Seeking extension of time of tender notice of opposition rejected—Should there be one action or eight actions? -Civil Procedure Code, sections 8 and 36.*

The plaintiff-appellant failed to file notice of opposition within the prescribed time in the Registry of the Registrar of Trade Marks; consequently application for time to file opposition had been rejected and the applications of the 2nd defendant respondent to registrar eight trade marks were accepted and registered by the name "Rabea". The plaintiff appellant instituted action under section 172(2) of the Code of Intellectual Property Act to expunge the Trade Marks. The District Court dismissed the action on the basis that the plaintiff ought to have filed eight separate actions, but permitted the plaintiff to file eight actions if he so desires.

On appeal -

**HELD:**

- (i) Any person aggrieved by any decision or order made by the Registrar of Trade Marks could come to court under the provisions of section 172(2) or section 182 of the Code of Intellectual Property Act. The procedure followed by the plaintiff was under section 172(2).
- (ii) Both sections do not provide any specific procedure to be followed in an appeal to the District Court against the order.
- (iii) When there is no procedure laid down, section 8 of the Civil Procedure Code applies. In the absence of any reference to the summary procedure in the relevant section of the Act, the application could be filed under regular procedure.
- (iv) The procedure adopted was regular and the causes of action which were on the same Trade Mark "R bea" in respect of the eight applications registered was between the same parties and could be united in one action.

*Per* Balapatabendi, J

" In a situation of this kind the court should adopt a common sense approach not prohibited by law to prevent multiplicity of actions - District Judge could not have dismissed the action when he could have ordered separate trials, if any such causes of action cannot be conveniently tried or disposed together, in terms of section 36 of the Civil Procedure Code.

**APPEAL** from the judgment of the District Court of Colombo.

**Cases referred to :**

1. *GTE Directories Lanka (Pvt) Ltd. vs. Mukthar Marikkar and another* (1998) 3 Sri LR 180
2. *Malhotra International (Pvt.) Ltd. vs. Anglo Asia Distributors and others* (2003) 3 Sri LR 116

*Shibly Aziz, P.C. with Gomin Dayasiri* for plaintiff appellant  
*P.A.D. Samarasekera, P.C. with Hiran de Alwis* for 2nd defendant respondent  
*Eva Wanasundera, Deputy Solicitor General* for 1st defendant respondent

*cur. adv. vult.*

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**Editors Note :**

“ The Supreme Court on 30.05.2005 in S.C. Spl. LA 38/2005 dismissed the Special Leave to Appeal application.

January 30, 2005

**JAGATH BALAPATAPENDI, J.**

Since the Appellant - Petitioner - Plaintiff - Respondent - Respondent the Stassen Exports Ltd. (hereinafter referred to as plaintiff appellant) had failed to file notice of opposition within the prescribed time in the registry of the Registrar of Trade Marks consequently the application for time to file opposition had been rejected and the applications of the 2nd respondent - respondent- defendant (hereinafter referred to as 2nd Defendant-Respondent) to register eight Trade Marks by the name -

“ Rabea” were registered and gazetted by the Registrar of Trade Marks. Thereafter, the plaintiff-appellant had instituted an action in the District Court of Colombo in terms of the procedure laid down in the Code of Intellectual Property Act, No. 52 of 1979.

The Plaintiff - appellant in his plaint dated 1st March 1991, had alleged *inter alia* that he moved for extension of time to tender notice of opposition to the Registrar, but the Registrar (the first respondent - respondent - defendant failed to consider the applications for extension of time and neglected to reply the Plaintiff -appellant for the said applications made. Further, he had alleged that he is the registered proprietor of the Trade Mark No. 40849 Spring Brand (which in Arabic language is Rabea”) Thus, the purported registration and placement of eight applications in the name of the 2nd defendant - respondent in the Register of Trade Marks was wrongful, unlawful and was made without complying with the procedure laid down in the said Act, Also, he had alleged that there was travesty of justice as he was not given an opportunity to file notice of opposition and right of hearing to the said eight applications of the 2nd defendant - respondent. Hence he had prayed for the following :-

- (i) a declaration to expunge the said marks 47711, 47712, 47713, 47714, 47715, 47716, 47717 and 49305 from the Registrar of Trade Marks.
- (ii) a declaration that a fresh inquiry be held into application relating to the registration of the said marks 47711, 47712, 47713, 47714, 47715, 47716, 47717 and 49305.

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- (iii) a declaration that the Petitioner has the right to file objections and participate at the fresh inquiry.
  - (iv) to set aside the decision of the 1st Respondent to register the marks 47711, 47712, 47713, 47714, 47715, 47716, 47717 and 49305 in the name of 2nd respondent.
  - (v) for costs, and
  - (vi) for such other and further relief as Your Honours court shall seem fit.

At the trial in the District Court a preliminary objection had been raised by the 2nd Defendant-Respondent that " instead of filing eight applications/actions in Court, the plaintiff-appellant had instituted a single application/action for eight different registration of Trade Mark, hence the application/action should be dismissed as it is bad in law. The learned District Judge upheld the preliminary objection and dismissed the action of the plaintiff - appellant, and further held that " if the plaintiff -appellant so desires he could tender eight different applications/actions to court".

The appeal bearing No. 732/92 is preferred by the plaintiff-appellant against the order upholding the preliminary objection and dismissal of the action, the appel bearing No. 733/92 is preferred by the 2nd defendant-respondent against the order permitting the plaintiff- appellant to file eight different applications/actions.

At the hearing of the appeal counsel for the plaintiff-appellant contended that the action in the District Court was in relation to one Trade Mark by the name "Rabea" on which eight applications have been made to the Registrar of Trade Marks by the 2nd defendant-respondent, and were registered in eight different classifications, such as :- Services of education and entertainment, services of material treatment, services of transport and storage, services of communication, services of construction and repair, services of advertising and financial and under the classification of goods-Tea, therefore the registration carry different numbers. The question to be determined in the action before the District Court was between the same parties on the identical issue in respect of a Trade Mark carrying the name "Rabea". The said action filed was in terms of the Code of Intellectual Property Act under the provisions of the Section 172(2) praying for a

declaration to rectify the Register by expunging entries sanctioned by the Registrar under the said Act. He further contended that, there is no procedure laid down and no reference to causes of action within which a party has to bring a case under the Code of Intellectual Property Act unlike in the Civil Procedure Code. The only procedure to be followed is under the provisions of section 172(2) of the said Act.

He referred to the provisions of section 172(2), which states as follows :- Subject and without prejudice to other provisions of this Code a) “ the Court may on the application in the **prescribed manner** of any person aggrieved by the non-insertion in or omission from any register, of any entry, or by any entry made in any register without sufficient cause or by any entry wrongly remaining in any register, or by any error or defect in any entry in any register, make such order for making, expunging, or varying such entry, as it may think fit.”

His contention was that the “prescribed manner” referred to in the above section, has not been prescribed up to date, hence the action under section 172(2) is *sui-juris*. When there is an absence of laid down rules, regulations and procedure in the said Act, the procedure to be followed is the procedure laid down in the Civil Procedure Code. Thus, the eight different causes of action could be brought and determined in one action since the dispute is between the same parties and on the same Trade Mark “Rabea”. Also, there is no requirement that separate applications/actions must be filed in Court in respect of each application made to the Registrar of Trade Mark, and all eight applications could be consolidated and attended together in one action in the interest of justice, expediency and convenience. Therefore the order made by the learned District Judge was erroneous and without any rational justification.

The contention of the counsel for the Defendant-respondent was that the said eight applications were accepted, separately registered, separately advertised and published in Government Gazettes. Thus the action filed by the plaintiff-appellant in the District Court praying for a declaration to set aside the registration of the Trade Mark of eight different classes in one application/action was bad in law; hence the order of the learned District Judge was a correct order which could have made in Law.

The Deputy Solicitor General had informed Court that no submissions will be made on behalf of the 1st Defendant - respondent the Registrar of Trade Marks, and that she would abide by whatever order made by Court.

It is apparent that the question to be decided in this appeal is whether the procedure adopted by the plaintiff-appellant in the District Court under section 172(2) of the Code of Intellectual Property Act was valid in law.

Any person aggrieved by any decision or order made by the Registrar of Trade Marks could come to Court under the provisions of section 172 (2) or section 182 of the said Act.

Both sections do not provide any specific procedure to be followed in an appeal to the District Court against the order of the Registrar, the "Prescribed manner" referred to in section 172(2) had not been prescribed in the Act or in any Gazette notification. When there is no procedure laid down for such an application/action the section 8 of the Civil Procedure Code enacts that :- Save and except in actions in which it is by this Ordinance specially provided that proceedings may be taken by way of summary procedure, every action shall commence and proceed by a course of regular procedure, as hereinafter prescribed. " Thus, I am of the opinion that in the absence of any reference to the summary procedure in the relevant section of the said Act, the application/action could be filed under regular procedure. It is apparent that the plaintiff-appellant had instituted the action rightly by the plaint dated 1st March 1991 was correct under regular procedure. (*vide the decisions of G.T.E. Directories Lanka (Pvt) Ltd vs. Mukthar Marikkar and others* <sup>(1)</sup> and *Malhotra International (Pvt) Ltd. vs Anglo Asian Distributors and others*<sup>(2)</sup>)

It is to be noted that in the instant action the plaintiff-appellant had sought *inter alia* a declaration to expunge the Trade Mark - "Rabea" in respect of eight applications registered in the register of Trade Marks. I am of the view that as the procedure adopted by the plaintiff appellant was regular procedure and the causes of action which were on the same Trade Mark "Rabea" in respect of the eight applications registered was between the same parties could be united in one action.

Further, in a situation of the kind, the Court should adopt a common sense approach not prohibited by law, to prevent multiplicity of actions.

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However, having considered the facts and circumstances of the case the learned District Judge could not have dismissed the action of the Plaintiff - appellant, when he could have ordered separate trials if any such causes of action cannot be conveniently tried or disposed together, in terms of section 36 of the Civil Procedure Code.

For the reasons mentioned above, I set aside the Order of the learned District Judge dated 08.12.1992 on the preliminary objections raised with costs of Rs. 10,000.

In view of the above mentioned order, it is needless to make an order in the connected appeal bearing No. 733/92

**IMAM, J.** - I agree

*Appeal allowed.*

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