

G.T.E. DIRECTORIES LANKA (PVT) LTD.
v.
MUKTHAR MARIKKAR AND ANOTHER

SUPREME COURT
AMERASINGHE, J.,
DHEERARATNE, J.
GUNAWARDANA, J.
S.C. APPEAL NO. 151/97
C.A. NO. 507/92 (F)
D.C. COLOMBO NO. 3210/SPL
JUNE 15, 1998

Appeal – Intellectual Property Act, No. 52 of 1979 – Time for appeal under S. 182 of the Act – Civil Procedure Code – Sections 5 and 6 – Prescription Ordinance – S. 10.

In terms of S. 182 of the Code of Intellectual Property Act, No. 52 of 1979, a person aggrieved by a decision of the Registrar of Patents has a right of appeal to the District Court. However, the Act does not provide a time limit within which an appeal should be lodged or the appellate procedure.

Held:

The appeal which was, quite rightly, lodged by the appellant by filing a plaint in the District Court constituted an action within the meaning of s. 6 of the Civil Procedure Code founded on a "cause of action" as defined in s. 5 of the Code. In terms of s. 10 of the Prescription Ordinance, the appeal could be filed within 3 years of the date of the decision of the Registrar.

Cases referred to:

1. *Stassen Exports Limited v. Brooke Bond (Ceylon) Limited and Another* (1990) 2 Sri LR 63.
2. *Western Bank Limited v. Schindler* (1977) ch 1 at 18.
3. *Lowe v. Fernando* (1913) 16 NLR 398 and 404.
4. *Jalaldeen v. The Colombo Municipal Council* (1908) 4 Appeal Court Reports 131.
5. *Dodwell v. John* (1918) 20 NLR 206.
6. *Fuard v. Weerasooriya* (1954) 56 NLR 12.

APPEAL from the judgment of the Court of Appeal.

K. Kanag-Iswaran P.C., with *N. R. Sivendran* for appellant.

S. Sivarasa P.C., with *Barhee Ahamed* and *M. Mawjith* for 1st respondent.

No appearance for 2nd respondent.

Cur. adv. vult.

August 17, 1998.

DHEERARATNE, J.

This appeal raises an interesting question of law relating to the Code of Intellectual Property Act. The 1st respondent filed application No. 44027 for registration of a trade mark while General Telephone Directories Company (M) SDN BHD of Malaysia (The Malaysian Company) filed its notice of opposition to the said application. After hearing the parties the 2nd respondent Registrar of Patents & Trade Marks, by his order dated 3rd January, 1990, refused the said opposition and allowed the propounded mark to be registered. The appellant, who by then had become the assignee of the interests of the Malaysian Company, being aggrieved by the order of the 2nd respondent, by plaint dated 10th December, 1990, appealed against that order to the District Court, in terms of section 182 of the Code of Intellectual Property Act, No. 52 of 1979. The 2nd respondent

informed the District Court that he had no stake in the appeal and that he would abide by whatever order made by court.

Section 182 of the 1979 Act does not provide a time limit within which an appeal should be lodged; while conferring appellate jurisdiction on the District Court, that section provides no specific appellate procedure. The legislative predecessor of the present Act, the Trade Marks Ordinance No. 15 of 1952 (the 1964 Act was not brought into operation), too did not provide for an appealable period but its subsection 12 (6) stated that an appeal "shall be made in the prescribed manner". Rule 98 made by the Minister under section 60 of that Ordinance and published in the *Gazette* No. 7559 dated 10.12.1926 (vide *Subsidiary Legislation 1956 vol.11*) provided for an appeal from a decision of the Registrar to be made within one month thereof. These rules published in the *Gazette* in 1926 were later rescinded by the order of the Minister published in the *Gazette* 60/20 dated 31.10.1979.

At the hearing before the District Court, it was contended on behalf of the 1st respondent that the appeal should be rejected as it has been filed out of time. The learned District Judge upheld the objection and dismissed the action of the appellant. He reasoned out that since section 182 did not provide for an appealable period, the court must entertain an appeal within a "reasonable time"; since the rescinded regulations made under the repealed Ordinance specified a period of one month, that period should be reckoned as the "reasonable time". The Court of Appeal affirmed the order of the learned District Judge and held that the previous law should be looked at, to provide for what was thought to be a *casus omissus*. Although the Court of Appeal thought it found support for the view it took, from the dicta of my brother Amerasinghe, J. at pages 92, 95 and 96 of his exhaustive judgment in *Stassen Exports Limited v. Brooke Bond (Ceylon) Limited and another*⁽¹⁾, I find nothing in the dicta as lending support to that view. My brother Amerasinghe, J. was clearly not dealing with cases of *casus omissus* in those passages quoted by the Court of Appeal.

Perhaps at this point, it is apposite to remind ourselves the words of Scarman, LJ. in the case of *Western Bank Limited v. Schindler*⁽²⁾ where he said :

"Judicial legislation is not an option open to an English Judge. Our courts are not required, as are, for instance, the Swiss courts (see the Swiss Civil Code, articles 1 and 2), to declare and insert into legislation rules which the judge would have put there, had

he been the legislator. But our courts do have the duty of giving effect to the intention of Parliament, if it be possible, even though the process requires a strained construction of the language used or the insertion of the words in order to do so . . . The line between judicial legislation, which our law does not permit, and judicial interpretation in a way best designed to give effect to the intention of Parliament is not an easy one to draw. Suffice it to say that before our courts can imply words into a statute the statutory intention must be plain and the insertion not too big, or too much at variance with the language used by the legislature. The courts will strain against leaving unfiled the *casus omissus*.

The Court of Appeal was of the view that failure to provide for an appealable period in section 182 is tantamount to the appellant holding an unenforceable right and therefore the rescinded regulation should be resorted to, in order to give effect to the intention of the legislature. This view appears to be erroneous. On the other hand, to contend that, since there is no period of prescription specified, an appeal could be lodged at any time even after the lapse of a number of years, is equally erroneous. In my view the solution to the problem could be found within the provisions of the Civil Procedure Code (CPC) and the Prescription Ordinance No. 22 of 1871.

In terms of section 8 of the CPC, unless specially provided for by the CPC or any other law that proceeding may be taken by way of summary procedure, every *action* shall commence by a course of regular procedure prescribed in the CPC. The appeal in this instance, quite rightly, was lodged by the appellant in the District Court by filing a plaint which conforms to the requisites of a plaint in a regular action as specified in section 40. The 1st respondent filed his answer, conforming with the requisites mentioned in section 75 of the CPC.

Section 6 of the CPC defines an *action* as –

"Every application to a court for relief or remedy obtainable through the exercise of the court's authority, or otherwise to invite its interference, constitutes an action".

The net of the language of the definition is cast so wide, as to include within it the appeal filed by the appellant. On the one hand appellant's plaint is an application for relief or remedy obtainable through the exercise of the court's authority; on the other hand it is

an application inviting the court's interference. The definition of a *cause of action* in section 5 is also given in similar sweeping terms.

"Cause of action is a wrong for the prevention or redress of which an action may be brought, and includes the denial of a right, the refusal to fulfil an obligation, the neglect to perform a duty, and the infliction of an affirmative injury".

The advantage gained by the registration of the 1st respondent's trade mark could amount to a wrong. It is a privation of the appellant's right. A wrong is a combination of a right and its violation. See *Lowe v. Fernando*⁽⁵⁾. Proceedings against an assessment made to the Court of Requests in terms of the Municipal Councils Ordinance were held to be an action within the meaning of section 5 of the CPC. See *Jalaldeen v. The Colombo Municipal Council*⁽⁴⁾.

The Prescription Ordinance No. 22 of 1871 governs the whole field of jurisdiction of the Civil Courts of the Island. See decisions of the Privy Council in *Dodwell v. John*⁽⁵⁾ and *Fuard v. Werasooriya*⁽⁶⁾. The cause of action of the plaintiff attracts section 10 of the Prescription Ordinance as it is not caught up by any other provision of the Ordinance. Section 10 reads :

"No. action shall be maintainable in respect of any cause of action not hereinbefore expressly exempted from the operation of this Ordinance, unless the same shall be commenced within three years from the time when such cause of action shall have accrued".

For the above reasons I hold that an appeal under section 182 of the Code of Intellectual Property Act could be filed within 3 years of the date of the decision of the Registrar. The appeal is allowed and the order of the District Court and the judgment of the Court of Appeal are set aside. In view of the special circumstances of this case, parties will bear their own costs of this court and of the court below. The Registrar of this court is directed to send the record of this case back to the District Court as expeditiously as possible.

AMERASINGHE, J. – I agree.

GUNAWARDANA, J. – I agree.

Appeal allowed.