

*** IN THE HIGH COURT OF DELHI AT NEW DELHI**

%

Date of Decision: 27th April, 2015

+ W.P.(C) 8658/2011

MAHINDER NAGPAL

..... Petitioner

Through: Mr.Mohan Vidhani & Mr.Rahul
Vidhani, Advs.

versus

UOI AND ORS.

..... Respondents

Through: Mr.Vivek Goyal, Adv. for R-1
& 2.
Mr.Dipak Kumar Jena &
Mr.Jaladhar Das, Advs. for R-3.

CORAM:

HON'BLE MR. JUSTICE VED PRAKASH VAISH

VED PRAKASH VAISH, J. (ORAL)

1. By way of the present petition under Articles 226 and 227 of Constitution of India, the petitioner seeks direction to the respondent Nos.1 and 2 to issue certificate of registration of trade mark to the petitioner in respect of the trade mark application No.541927 in class 3 which was filed on 14.12.1990 and advertised in the trade mark journal No.1090 at page 1062.

2. The facts of the case as emerging from the petition are that the petitioner alongwith his erstwhile partner namely Mrs. Kamlesh Nagpal, trading as TONI INTERNATIONAL filed an application for the registration of the trade mark 'EVANI' under the application

No.541927 on 14.12.1990 in class 3 in respect of specification of goods to read as “cosmetics”. After completion of official formalities, the said application was published in the trade mark journal No.1090 dated 01.11.1994 at page 1062. On or about 24.01.1995 the said application was opposed by Mr. Bajrang Lal Agarwal and the said opposition proceedings were designated as opposition No.DEL-9279. The said opposition proceeding was dismissed vide order dated 17.04.1998 passed by the learned Registrar of Trade Mark, respondent No.2 with the directions that the application of the petitioner shall proceed to registration.

3. Again on or about 15.02.1995 the said application was opposed by M/s. Societe Anonyme Des Eaux Minerale D Evian, France and the opposition proceedings were designated as opposition No.DEL-9338. The opposition No.DEL-9338 was withdrawn by the opponent therein and the learned Registrar of Trade Mark vide order dated 30.04.2001 passed the order of withdrawal with directions that the application of the petitioner shall proceed to registration. Thereafter, the petitioner had been waiting for the receipt of the registration certificate from the respondent Nos.1 and 2 as apart from the afore stated two oppositions there was no other opposition pending. However, the petitioner did not receive the registration certificate. In the meantime, the other partner of the petitioner namely Mrs. Kamlesh Nagpal retired from the firm w.e.f. 31st March, 2004 and the petitioner became the sole proprietor of the business with all its assets and liabilities including the impugned trade mark.

4. Sometime in January, 2009 the petitioner saw the status of the application on the website of the respondent which showed that the mark was registered. However, since the petitioner had not received the registration certificate the petitioner wrote a letter to the respondents for the service of the registration certificate to the petitioner after he was informed that even the agent on record had not received the registration certificate. The petitioner had been continuously writing to the said respondents for the issuance of the registration certificate from time to time i.e. on 12.01.2009, 09.07.2009 and 17.04.2011. However, no response was given by the said respondents. Since, the petitioner did not receive the registration certificate the petitioner is not in a position to seek the renewal of the trade mark. Under such circumstances, the petitioner has approached this Court.

5. Learned counsel for the petitioner submits that the respondent is under an obligation to issue and serve the certificate of registration within the provisions of law as provided in Section 23(2) of the Trade Mark Act, 1999 (hereinafter referred to as the 'Act') and Rule 62(1) of the Trade Mark Rules, 2002 (hereinafter referred to as the 'Rules') and also to serve the notice in Form O-3 of the approaching renewal. However, the respondent has failed to perform its statutory duties. In the absence of the issuance of the registration certificate the petitioner is not to file the request for the renewal of the trade mark.

6. *Per contra*, learned counsel for respondent Nos.1 and 2 submits that the mark of the petitioner was registered and the registration certificate was issued on 09.04.2005. The application of the petitioner

was filed as per Trade and Merchandise Act Marks Act, 1958 but the registration was granted after the Act had come into force on 15.09.2003. The term of registration was for ten years i.e. upto 14.12.2000. Since the registration was granted after ten years of the date of application the renewal fees was required to be paid within six months from the date of issue of registration certificate as per Rule 64(3) of the Rules.

7. It was further submitted on behalf of the said respondents that there was no obligation of issuance of Form, O-3 notice. If the applicant claims that the certificate had not been received on the very same date of the issuance, the period of date of issuance and the date of dispatch can be added with the six months period for renewal. Accordingly, the renewal could have been accepted upto 09.10.2005 plus one months and 17 days gap in dispatch of the registration certificate and not beyond that. However, no such request was made by the petitioner.

8. Learned counsel for respondent No.3 submits that the mark under the alleged registration is a mere copy of the well-known trade mark 'EMAMI' of respondent No.3 and is not capable of distinguishing the goods of the registered proprietor from the goods of respondent No.3 and hence is devoid of any distinctive character as such the alleged mark was registered by respondent No.2 in contravention of the provisions of Section 9(1)(a) of the Act. Respondent No.3 had also filed a rectification petition against the registration of the trade mark of the petitioner which is pending before respondent No.2.

9. The short issue for consideration before this Court is whether respondent Nos.1 & 2 can be directed to serve the registration certificate on the petitioner at this stage. The implication of which would be that the petitioner would have a right to apply for renewal of the registration of trade mark which has expired.

10. The respondent Nos.1 and 2 in the counter affidavit have annexed the photocopy of a page which is stated to be from the dispatch register. The said page only indicates the number of the trade mark and does not provide any other details as to the mode of dispatch, the address on which the certificate was dispatched or even the name of the addressee. On 28.02.2012 the answering respondent Nos.1 and 2 were directed to file an additional affidavit giving the details including the proof of delivery of the registration certificate within four weeks. However, no such detail has come on record. On 14.08.2012 learned counsel for the said respondents, on instructions, stated that they did not possess any additional information and the information in their possession had already been placed on record. During arguments also, learned counsel for the said respondent states that the said respondents have no other document to show that registration certificate was ever dispatched to the petitioner.

11. In the absence of such records and relevant material, the claim of the said respondents that the registration certificate was dispatched to the petitioner at its correct address cannot be accepted and the grievance of the petitioner has to be considered on the assumption that the respondent had not dispatched and served the registration certificate on the petitioner.

12. At this juncture, it will be relevant to observe that this Court in '**Rakesh Kumar vs. Union of India and Anr.**', *W.P.(C) No.6093/2013 decided on 11.09.2014*, relying on the order of this Court in '**XEL Components Pvt. Ltd. vs. Union of India**', *W.P.(C) No.1245/2010 decided on 04.04.2011*, had directed the respondent to deliver the registration certificate to the petitioner therein within four weeks from the date of that order along with the directions that if an application for renewal is moved, the same would be considered as filed within time.

13. This Court is in agreement with the view taken by this Court in the aforesaid two judgments. Clearly the time limit specified under Rule 64(3) of the Rule would begin to run only after the receipt of the certificate of registration by the petitioner. Till the receipt of the registration certificate by the petitioner the time limit for the petitioner having to file the application for renewal would not begin to run, which I have already observed in the absence of the proof from respondent Nos.1 and 2 would be presumed as not sent on petitioner till date.

14. In the light of above discussion the respondents Nos.1 and 2 are directed to deliver the registration certificate in respect of trade mark No.541927 to the petitioner within four weeks from today. In the event the petitioner submits an application for renewal of the trade mark within a period of one month thereafter, the same would be considered as having filed within the time prescribed under the Rules and would be accordingly considered by the trade mark registry.

15. So far as the rectification application of respondent No.3 is concerned, it is directed that respondent No.2 shall decide the same on its own merits as expeditiously as possible.

16. The writ petition stands disposed of with the aforesaid directions.

(VED PRAKASH VAISH)
JUDGE

APRIL 27th, 2015
hs