

\$~29

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

Date of decision: 11th February, 2020

+ **W.P.(C) 13158/2019 & CM APPL. 53565/2019**

S K COSMETICS

..... Petitioner

Through: Mr. M.K. Miglani, Mr. Prithvi Gulati
and Mr. Anubhav Chhabra,
Advocates. (M:7838093715)

versus

**THE CONTROLLER GENERAL OF PATENTS, DESIGNS AND
TRADE MARKS AND ORS.**

..... Respondents

Through: Mr. Kirtiman Singh, CGSC WITH
Mr. Waize Ali Noor, Advocate for R-
1 & 2 with Mr. Vikram Singh,
(Examiner, Trade Marks).
(M:9811700872)
Mr. Mahir Malhotra, Mr. Satish
Kumar and Ms. Mansi Gulati,
Advocates for R-3. (M:9810023821)

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. M/s S. K. Cosmetics had two partners - Mr. Shyam Sunder Nagpal and Mr. Naresh Kumar Nagpal, who is Respondent No.3. There were various trade marks which the firm owned/used.
2. The trade marks were also registered with the Trade Marks Registry ("TMR"). The present petition has been filed by M/s S. K. Cosmetics challenging the various online status changes made by the Trademark Registry in respect of various registered trademarks of M/s S K Cosmetics. The case of the Petitioner is that Forms TM-33 and 34 were filed for

changing of description and for changing the address of the proprietor. When these forms were filed, the TMR in fact effected a change in the name of the proprietor itself, thereby resulting in the ownership of the trademark changing to Mr. Naresh Kumar Nagpal instead of the original proprietor - M/s S. K. Cosmetics or Shyam Sunder Nagpal. The relief sought in this petition reads:

- “i. A Writ, Order of Direction in the nature of Mandamus directing the Respondent no. 1 to revoke its orders passed on request of Respondent no. 3 on form TM-33 and TM-34 dated 30/01/2017 & 16/08/2016 respectively in connection with trademarks nos. 440395, 491569, 789148, 789148, 1027514, 1168312, 1198243, 1327898, 1843825, 1469941 and 1843824*
- ii. and rectify its records/Register of Trade Marks enter names of proprietors and principal place of business as were existing prior to filing of form TM-33 and TM-34 and to pass orders on said requests on Form TM-33 and TM-34 after notice to the petitioner and after hearing the petitioner.*
- iii. A Writ, Order of Direction in the nature of Mandamus directing the Respondent no. 1 to pass orders on all other pending requests of the parties after notice and upon hearing the parties.*
- iv. Such other writ, order or direction in favour of the Petitioner as may be deemed just and proper in the facts and circumstances of the case.”*

3. The case of the Petitioner is that under the garb of form TM-33 and 34 the ownership of the marks cannot be changed in this manner. By way of illustration, the ownership of the mark `TONI' which was in the name of Mr. Shyam Sunder Nagpal and Mr. Naresh Kumar trading as S.K. Cosmetics was changed to Mr. Naresh Kumar Nagpal. Thus, disputes have arisen between the parties in respect of the ownership of the marks which

has been confounded by the changes reflected in the Online status on the website of the TMR. It is the case of Respondent No.3 that upon his retirement from the firm in 1997, the mark TONI had to exclusively vest in the Respondent No.3. This position is disputed by the Petitioners.

4. The challenge in this petition is very limited i.e., whether when Form - TM 33 or 34 is filed, the ownership of the registered mark can be changed or not. The answer is clearly in the negative. Forms TM 33 and 34 are not meant to change the ownership or the proprietary nature of the mark, but only to carry out any change in the description or in the address etc. If there is any assignment or change in ownership that is pleaded by either party, the same would have to be made in the form of a request on an appropriate Form i.e., Form TM-P (earlier Form TM-23 or TM-24), to which any interested party would be entitled to object. The objections on the assignment would then have to be adjudicated by the Registrar, usually, after giving a hearing to the parties, and only then can a change in ownership be effected. Recordal of assignments or transmission of registered trade marks is a serious matter, especially if there are disputes pending in respect of ownership of the marks. The owner of a registered trade mark cannot therefore be changed in a mechanical or a perfunctory manner, simply upon filing of any Form. The same has to be after fulfilment of various formalities, explanation on affidavit of the reasons for the assignment/transmission sought supported by documents, inviting of objections, if any, and affording of a hearing, if required. Where there are no disputes in respect of the mark, then the assignment can be recorded without a hearing – say in the case of a mark being assigned from one group company to another. In the case of assignment of marks to a third party, the

Registrar has to record satisfaction and only then pass orders recording the assignment. If a civil court is seized of the dispute as to ownership, usually, the decision of the court ought to be awaited before allowing the recordal of the assignment.

5. Ld. counsel appearing for the TMR submits that vide order dated 26th November, 2019, the TM-33 has been disposed of by holding that the same was only for change of name of the registered proprietor without changing ownership. The said order reads:

“Subject: Request on Form No: TM-33 in respect of Registered TradeMark No: 491566 in Class: 3 dated: 30/01/2017 in the name of M/s. S.K. COSMETICS.

Sir,

With reference to the above your attention is invited to the following paragraphs:

- 1. It is pertinent to mention that TM-33 under Trade Marks Rule 2002 was only for change of name of Registered Proprietor without change in ownership. Request for including the name of another person as registered proprietor amounts to change in ownership of the mark. Hence TM-333 dated 30/01/2017 has been disposed off.*
- 2. As such this request should have been filed on form TM-P (SUBSEQUENT PROPRIETOR BY WAY OF ASSIGNMENT OR TRANSFER OF MARK) with proper fees under Trade Marks Rule 2017 and not on TM-33.”*

It is submitted by Ld. counsel for TMR that the change in ownership would not be effected and the same would be considered only in Form TM-P. Mr. M.K. Miglani, ld. counsel for the Petitioner submits that in view of the order dated 26th November, 2019, the Trademark Registry has now affected the change in the online records as well, and he relies upon various printouts in

respect of trademarks no. 491566, 440395, 491569, 789148, 1027514, 1168312, 1198243, 1327898, 1469941, 1843825, 2215318 and 1843824 which show that the *status quo ante* has been restored.

6. In view of the above, the present petition no longer survives. It is made clear that if any party makes a request under form TM-P (earlier TM-23 and 24) the same shall be proceeded with in accordance with law after objections, if any, being heard and appropriate orders being passed by the Trademark Registry. The pending Forms TM-P shall be heard and disposed of not later than 31st July, 2020.

7. With these observations the petition and all pending applications are disposed of.

PRATHIBA M. SINGH
JUDGE

FEBRUARY 11, 2020

dj

corrected & released on 19th February, 2020