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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
Date of decision: 6th March, 2020

+ **W.P.(C) 2325/2010**

KISHORE KUMAR

..... Petitioner

Through: Mr. Neeraj Grover and Mr. Rohan
Yadav, Advocates.

versus

UNION OF INDIA

..... Respondent

Through: Mr. Gaurang Kanth, CGSC with Mrs.
Biji Rajesh and Ms. Eshita,
Advocates. (M:9999285585)

WITH

+ **W.P.(C) 10040/2019 & CM APPLS. 41542/2019, 52388/2019**

M/S B.E.C. INDUSTRIES

..... Petitioner

Through: Mr. Neeraj Grover, Ms. Avani
Kapoor, Mr. Rudratti and Mr. Rohan
Yadav, Advocates.

versus

UNION OF INDIA

..... Respondent

Through: Mr. Akshay Makhija, CGSC with Ms.
Nidhi Mohan Parashar, Govt. Pleader,
Ms. Roshni, Mr. Shiram, Advocate.
(M:9953899908) along with Mr.
Pawan Kumar Pandey,

WITH

+ **W.P.(C) 11284/2019 & CM APPL. 46493/2019**

ASIANET STAR COMMUNICATIONS PVT LTD..... Petitioner

Through: Mr. Sumant Narang, Advocate.
(M:9810621272)

versus

THE REGISTRAR OF TRADEMARKS & ANR. Respondent

Through: Mr. Gaurang Kanth, CGSC with Mrs. Biji Rajesh and Ms. Eshita, Advocates.

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

W. P. (C) 2325/2010

1. The Petitioner was the proprietor of the registered trade mark “HOMELITE” in Class 9 bearing No. 771268. The application for registration of the trade mark was filed on 6th October, 1997 and the registration certificate was issued to the Petitioner on 23rd March, 2006. Sometime in August, 2009, the Petitioner applied for renewal of the trade mark under TM-12 and TM-13. However, a letter was issued by the Registrar of Trade Marks to the effect that the renewal fee had not been paid within the prescribed time and hence, the mark is likely to be removed. The same was replied to by the Petitioner’s counsel vide letter dated 21st December, 2009, wherein it was informed that no form O-3 notice had been received by the Petitioner and hence, the mark could not be removed. The Petitioner was also willing to file form TM-56 for renewal/restoration along with any penalty. The status on the Trade Marks Registry’s (*hereinafter*, “TMR”) website showed the trade mark as ‘abandoned’. Hence, the writ petition.

W. P. (C) 10040/2019

2. The order dated 17th September, 2019 records the factual background to this petition as follows:

“2. The Petitioner is the owner and registered proprietor of trademark bearing No. 278366 in class

9 for the mark “B.E.C. (logo)”. The said mark was applied for in the year 1972 and was registered in 1978. The same was last renewed for a period of 10 years from 16th February, 2007. The next renewal had to be done prior to 16th February, 2017. The Petitioner’s case is that it did not receive any notice for renewal and accordingly, it could also not apply for renewal as the counsel dealing with the matter had passed away and there was some miscommunication.

3. Sometime in August, 2019, the Petitioner, while sending its registration to a proposed joint venture partner realised that the same was not renewed. It therefore approached a trademark attorney and tried to deposit the renewal fee, however, it noticed an online notice uploaded as O-3 notice on the trademark registry’s website. A screenshot of the same has been placed on page 34 of the petition. Ld. counsel submits that when the said O-3 notice was opened for viewing, the same was shown as form RG-3, purportedly dated 2nd November, 2016.

4. The submission of Mr. Neeraj Grover, ld. counsel is that form RG-3 was, in fact, a new form which was introduced only with the notification of the trademarks rules in 2017, with effect from 6th March, 2017. Thus, he submits that it is surprising that the notice dated 2nd November, 2016 is called form RG-3. According to him, it is clear that the form O-3 notice was never dispatched and accordingly, the Petitioner ought to be permitted to renew his trademark.

5. Ld. Counsel appearing on behalf of the Respondent submits that she has been served with an advance copy and seeks time for taking instructions.

6. A perusal of the website screenshots shows that the O-3 notice is purportedly dated 2nd November, 2016. There can be no dispute that the form RG-3 notice only came into effect from 6th March, 2017. The O-3 notice, therefore, could not have been an RG-3 notice

if the notice was actually issued on 2nd November, 2016. The fact that the form is wrongly uploaded with the date of 2nd November, 2016 is also evident from the fee being charged i.e., Rs.10,000/-, which is the newly notified annual fee, unlike the annual fee in form O-3 which was Rs.5,000/-. These facts clearly indicate that there is something amiss in the uploading of these forms and the same is prima facie not as per procedure and the Rules.”

3. Thereafter, ld. counsel for the Registrar of Trade Marks has taken instructions in the matter.

W. P. (C) 11284/2019

4. The facts of this petition are recorded in order dated 22nd October, 2019 as follows:

*“2. This writ petition has been filed by the Petitioner bringing to the notice of the Court that the trademark of the Petitioner was deemed to have been abandoned for non-filing of renewal fee and seeking permission to renew the same. The stand of the Petitioner is that the O-3 notice for renewal was not issued by the Registrar of Trade Marks. As per the orders of the Division Bench of this Court, as also the Bombay High Court in **Malhotra Book Depot v. Union of India & Ors., 2012 (49) PTC 354 (Del.)** and **Cipla Limited v. Registrar of Trade Marks & Anr. [W.P. No.1669 of 2012, decided on 23rd September, 2013]** respectively, if O-3 notices are not issued, the marks cannot be treated to be abandoned. The stand of the Petitioner is that when it checked the website of the Trademark Registry around 20th June, 2019, no O-3 notice in respect of the Petitioner’s trademark No.586576 was uploaded on the website. Thereafter, the Petitioner applied for renewal, along with the past fee/penalty. Surprisingly, on 30th July, 2019, the Petitioner found the O-3 notice, which was uploaded*

with the date of 5th September, 2016. The contention of ld. counsel for the Petitioner is that the fact that this O-3 notice is backdated is evident from the notice which is titled as "Form RG-3". This form came into effect only on 6th March 2017, when the new Trade Mark Rules were notified. Thus, "Form RG-3" did not exist as of 2016. Thus, according to the Petitioner, the O-3 notice was never issued and the mark ought not to be treated as abandoned.

3. According to the Registrar of Trade Marks, O-3 notices were sent on 12th September, 2016 to the Petitioner i.e., Asianet Star Communications Pvt. Ltd. at C-20, Qutab Institutional Area, New Delhi - 110016. The bar code issued by the post office is relied upon by the Registrar of Trade Marks, which has been handed across to the Court."

W. P. (C) 2325/2010

W. P. (C) 10040/2019 & CM APPLs. 41542/2019 (stay), 52388/2019 (exemption)

W. P. (C) 11284/2019 & CM APPL. 46493/2019 (interim direction)

5. All the above three petitions raised issues in respect of the renewal of the respective registered trademarks and the fact that renewal notices (Form – O3) were not received by the registered proprietors. During the hearing in these petitions, it was noticed that there was a need for streamlining the process of registration of trade-marks as O-3 notices were not being sent to the parties, leading to the abandonment of the marks. Moreover, in one of the cases, form RG-3 notice, which was introduced in 2017 under the Trade Mark Rules, 2017, was uploaded in place of the alleged O-3 notice which was indeed mysterious as the date of the notice was 2nd November, 2016 and the Trade Mark Rules, 2017 came into effect only on 6th March, 2017. Under the regime which was prevalent prior to the Trade Mark Rules, 2017,

only an O-3 notice could have been uploaded and thus the uploading of a RG-3 notice dated 2nd November, 2016 showed that there was something amiss.

6. In the background of all these writ petitions, the various problems in the processing of Trade Mark applications were considered and on 17th September, 2019, the following order was passed in W.P.(C) 110040/2019:

*“7. Trademark rights are extremely valuable rights. Without issuing form O-3 notices, the said marks cannot be treated as abandoned and renewal fee would have to be permitted to be paid by the Petitioner. As per the Division Bench Judgment of the Bombay High Court in **Cipla Limited v. Registrar of Trade Marks & Anr.** [W.P. No. 1669 of 2012, decided on 23rd September, 2013] and the Delhi High Court in **Malhotra Book Depot v. Union of India & Ors, 2012 (49) PTC 354 (Del.)**, the dispatch of a form O-3 notice is compulsory and mandatory prior to abandoning a trademark for non-renewal. Accordingly, the Petitioner ought to be permitted to pay the renewal fee which it is not being able to do as is evident from page 33 of the writ petition.*

8. Under these circumstances, the following interim directions are passed:

- i. The Petitioner is permitted to approach the Id. Registrar of Trade Marks, Delhi and deposit the renewal fee physically if not through the online method.*
- ii. The registration of the Petitioner's trademark shall not be treated as abandoned till the next date and the Petitioner shall continue to enjoy all rights as the registered proprietor of the mark.*
- iii. The Examiner of Trade Marks - Ms. Shikha Dewan, who has signed the form RG-3 notice*

which is purportedly dated 2nd November, 2016, shall file a personal affidavit as to when this particular form was uploaded and as to in what manner it was communicated to the Applicant. She shall also file relevant documents to support the said uploading. Ms. Shikha Dewan is directed to be present in Court on the next date.

9. The ld. Registrar of Trade Marks, Delhi shall file an affidavit as to the manner in which Renewal notices are being uploaded and communicated to clients. Further, the affidavit will deal with the contentions raised in the writ petition. The Controller General shall conduct an enquiry into the manner in which an O-3 notice was purportedly uploaded on 2nd November, 2016 whereas the actual form which is uploaded came into effect only from 6th November, 2017. The enquiry shall be conducted by a senior official from the office of the Controller of Patents, Designs and Trade Marks. The Enquiry Report shall be placed on record before the next date of hearing.”

7. The Examiner of Trade Marks appeared and explained that though the Petitioner had filed a TM Form 34 for change of his address on 24th April, 2007, since the same was allowed only on 28th September, 2017, the O-3 notice dated 5th September, 2016 was dispatched to the earlier address available with the Respondent in 2016. Insofar as the form O-3 notice appearing as a form RG-3 notice is concerned, the Examiner submitted that while she did not have any personal knowledge as to why the O-3 notice is being reflected as an RG-3 notice, discussions with the IT development team of NIC has revealed that due to technical errors, some of the O-3 notices issued by the office even before 6th March, 2017 were shown in the form of an RG-3 notice as per the new Trade Marks Rules, 2017. It was, however,

clarified that the physical copies sent to the concerned proprietor's registered offices remained in the proper format.

8. In view of the technical issues which were highlighted by parties, a need was felt that there ought to be further streamlining of the process of trade mark applications, and accordingly, this Court had further passed order dated 31st October, 2019 in WP(C) 11284/2019, as under: -

6. In order to obviate the recurrence of such situations in the future, which have clearly become endemic in the Trade Mark Registry, a proper procedure is required to be established for the processing of trade mark applications and registrations. Accordingly, the Registrar of Trade Marks shall place on record an affidavit of Mr. Hoshier Singh, the Head of the Trade Marks Registry Office, Delhi, detailing the following aspects:

i) the current procedure for processing of trade mark applications, including the various steps starting from filing, acceptance of fee, allocation of application number, examination and generation of examination report, acceptance of responses, hearings held, if any, orders passed on the said files, grant of trade mark registration certificates, change of address, change of name, processing of licences and assignments, renewal notices, etc. and whether they are dealt with by one officer or by different departments, even if they relate to same application. The same may be explained by means of a flow chart;

ii) the manner and procedure for uploading of documents which is currently being followed at each and every stage by the Trade Marks Registry;

iii) whether it is considered efficient to allocate a particular trade mark application to a specific officer who would then process the various forms

filed in respect of that application so that the familiarity of the officer with the file would enable efficient processing of the same;

iv) insofar as post-registration formalities, such as renewals, assignments, etc. are concerned, whether the same should be dealt with by a separate department and if so whether post registration formalities of specific registered trade marks ought to be handled by a single officer.

7. The above be placed in the form of an affidavit so that this Court may consider passing appropriate directions for streamlining of the processing of trade mark applications on the next date of hearing.”

9. Subsequently, this Court has also passed various directions on 5th December, 2019 and 13th January, 2020.

10. The entire purpose of passing directions in these petitions has been to ensure that the processing of Trade Mark applications is properly streamlined and multiple officers do not handle the same Trade Mark application leading to lack of a coordinated approach. The TMR had also deputed Mr. Pawan Kumar Pandey, Deputy Registrar, who has regularly appeared before the Court. Various stakeholders were also consulted after the issuance of public notices.

11. In respect of the directions issued on 31st October, 2019, the TMR has filed affidavits explaining the process and capturing the various steps taken for implementing a more streamlined process.

12. Vide affidavit dated 13th January, 2020, the TMR reported that the pendency in the processing of trademarks has reduced considerably. In the said affidavit, it was stated as under:

“28. I further say that in view of the huge pendency of applications at different stages,

the processing of applications was re-engineered and additional posts were sanctioned by the government which reduced pendency remarkably. Some key developments are as under:

(a). Pendency in examination is reduced to one month from more than a year during 2015-16,

(b). Percentage of acceptance of applications at the examination stage has increased to 48% from around 5-6 % during 2015-16,

(c). Pendency in consideration of reply against the office objection has reduced to around 1-2 months from more than a year in 2015-16,

(d). Pendency in show-cause hearings has been reduced to less than two years from six years in 2015-16.

(e). Pendency in processing of request related to post registration amendment is reduced from 87,000/- in April 2017 to around 11,000/- at present.

*29. I say that in terms of the order dated 5.12.2019 passed by this Hon'ble Court, stakeholder meetings have been organised at Delhi on 11.12.2019, at Mumbai on 17.12.2019 and at Chennai on 23.12.2019. A copy of the summary of the suggestions made by the stake-holders and office response in reference to the same has been annexed herewith and marked as **ANNEXURE R-3**.*

*30. I say that a public notice dated 12.12.2019 has also been issued inviting suggestions from stake-holders by 10.01.2020. Copy of public notice dated 12.12.2019 has been annexed herewith and marked as **ANNEXURE R-4**. It is further submitted that*

all the suggestions received will be compiled and due action will be taken by the Trade Marks Registry as per law. The compiled report will also be uploaded at the official website along with the office response.

31. In view of the above it is submitted that Trade Marks Registry is continuously endeavouring to improve and speed up the process of trademark applications. During last three years, number of meetings with stakeholders have been held and changes in the system effected to streamline processes and reduce difficulties of stakeholders. The office will make continuous efforts in this regard.”

13. A further affidavit dated November, 2019 deposited by Mr. Hoshier Singh, Head of Office of the TMR, stated that the function of the Registrar of Trade Marks is performed through computerised software, the central server of which is located at the Intellectual Property Office at Delhi. Comprehensive e-filing services have been introduced and attempts have been made to coordinate as many functions as possible by the same officer, including renewal and other post-registration requests.

14. The TMR has also issued public notices seeking the views of various stakeholders on the improvements that can be effected in the system. The suggestions given by the stakeholders, as also the comments of the Registrar, TMR, has been placed on record in the form of a tabulated chart.

15. After perusing the affidavits dated November, 2019, 13th January, 2020 and 6th March, 2020, as well as the public notice dated 20th February, 2020, the tabulated chart placed on record by the TMR is set-out below, along with directions in respect of each of the suggestions and steps to be taken for further streamlining the process of registration: -

Sr. No.	Suggestion Received	Office Responses	Directions
1	It is suggested that a nodal officers for solving the issued in time bound manner be nominated at each branches of TM registry. It is further suggested that any commendation send to nodal officers be confirmed by receipt of the same.	Suggestions accepted and an office order dated 03/01/2020 issued in this regard.	Accepted.
2	An issued relating to streamline of disposal of TM-M is also rose.	It has been informed to the stakeholders that processing of TM-M is already streamlined and that TM-M is taken up for disposal by the same officer who is dealing with the application at particular stage. The system has been designed as such that form filed in the application is moved with the application and the officer dealing with application shall require to dispose the pending form also to proceed further in the application. However, again a direction to show-cause hearing officers has also been issued to take up the amendment request for disposal at the time of	In view of the response of the Trade Marks Registry, it is directed that all forms filed till the stage of registration are processed by one officer. At the time of show-cause hearing, any pending TM-M shall also be disposed of before the mark proceeds for advertisement.

		hearing vide office order dated 03/01/2020.	
3	An issue raised in regard to hearing u/r 45(2) where service of the counterstatement has not been served properly.	It has been informed to the applicant that notices have been issued in only those matters where the office is having dispatch details of counter-statement. However if any issue exists in particular matter, same may raised to the concerned hearing officer in the matter.	No directions required.
4	A request is made to provide additional opportunity to upload document at hearing stage which is limited one time at present.	It is informed to the stake-holders that opportunity to upload reply to the applicant has been provided stage-wise. There is space constraint exists as present, however, due care will be given at the time of implementation of the new eTMR system.	Let provision for additional uploading be made in accordance with the Rules in the new e-TMR system.
5	A suggestion is made to put application related to similar trademark before same officers.	It is informed that presently office is clubbing the matter related to same agent for particular period for scheduling of hearing. Fixation of similar trademark related to same application before same office required further discussion in regard to limitation and challenges.	There is no requirement for clubbing applications of similar trade-marks as issues as to which marks are similar will also arise. That would put enormous burden on the Trade Marks Registry

6	Applicant/opponent email id should be visible to each other.	Request Accepted. Necessary change will be effected soon.	Change be effected on or before 30 th April 2020 so that the email addresses of the opposing parties is available to all concerned.
7	A suggestion is made to provide opportunity to update email ID in application filed before 6 th march, 2017.	A Public Notice dated 03/12/2019 was issued to provide said opportunities.	Opportunity to update new e-mail ID be provided on or before 30 th April 2020.
9	A suggestion made to upload opposition / show-cause cause list in time. It is also requested to send hearing notices in at least 30 days advance.	Request accepted. Necessary effort will be made to upload cause list at least a month before w.e.f from 01/04/2020. As far as dispatch of notices in concerned, it is issued 30 days in advance only. However, if any delay exists in this regard in some matter, necessary steps will be taken.	Cause list be uploaded one month prior to the hearing and notices be dispatched 30 days in advance. The cause list shall contain pre- and post- lunch slots for hearing. Email service of notice would be adequate service.
10	Additional space may be provided for uploading documents	Currently there is space contract in present TM System. However, this request will be considered after the implementation of new eTMR.	Let allocation of additional space be considered with the implementation of the new e-TMR system.
11	Multi-class application should be advertised in respective classes against the present practice of class 99.	Suggestions accepted and will be done by making changes in the system.	In the case of multi-class applications, the trade mark be advertised in each of the classes so that those persons who wish to oppose the mark in a particular

			class do not miss out on filing of oppositions and burden is not increased on all trade mark owners to search the TMJ for multi-class category to identify identical/similar applications.
12	Daily order sheet be arranged to uploaded in the application details of e-register	It was informed that this is already under consideration. Presently not possible due to limitation of present TM system. However will be done after the implementation of eTMR.	Uploading of orders be implemented on or before 15 th April 2020. If the uploading is not possible due to server space constraints or any other reason, until the implementation of the e-TMR system, the order shall be dispatched to the respective parties by e-mail within a week after it is passed.
13	Display board of hearing matters, Scheduling of hearing be done slot-wise to avoid the long waiting for hearing	Accepted, and will be implemented w.e.f. 01/04/2019.	-- Same as 9 above--
14	Multi class search facility be provided.	The present system is having its limitation and this sort of changes may not be possible in the same. However, it is further informed that this requirement will be available in new eTMR.	Let the same be implemented in the new e-TMR system.

15	Display of Hearing Board related to show cause hearing in Advance.	Show-Cause hearing scheduled in bulk and the same is divided among the present authorised hearing officer for the purpose. In case hearing officer take leave then with a view to avoid inconvenience to the parties, hearing officer wise board decided by system on the same day. However, Slotting of the matter in to two parts i.e. pre-lunch and post lunch is under consolidation.	--Same as 9 above--
16	Processing of Registered user request on TM-U, Partial Assignment.	At present there is no such module exist for processing of such request, however same will be come in existence with implementation of eTMR.	Let the same be implemented in the new e-TMR system.
17	FAQ be updated	The office is in process to update the same and updated version will uploaded at official website shortly.	No directions required.
18	Request for dispatch of Physical copy of Registration certificate.	In view of the making office environment friendly, we started reducing the use of papers. A policy decision is taken to shift on issuance of digital registration certificate. Applicant can always print a physical copy.	Let the digital registration certificates be uploaded within three months from the date when the period for filing the notice of opposition expires, if no opposition is filed.

19	Some suggestion received in regard to processing of TM-P and branch by single officer.	It may be noted that processing of post registration amendment required is done as such, all request related to single application processed by the same officer. The office is committed to dilute the pendency in this area and dispose such request within three month from the date of filing. It is further clarified that hearing, if required, is provided at the branch under which jurisdiction the original application filed. However normal processing is done by which officers or at which location should not be area of concern to the applicant.	W.e.f. 30th April 2020, all forms filed post-registration i.e., TM-P's ought to be processed by the same officer. O-3 and RG-3 notices ought not to be issued till the pending TM-P's are disposed of, as stated in the affidavit of the Deputy Registrar dated 6th March, 2020, the relevant portion of which reads as under: - <i>"I state that to avoid discrepancy in issuance of O-3/ RG-3 notices during the pendency of TM-P's, the Registry will implement a system wherein O-3/RG-3 notices will not be issued unless the pending TM-P's are disposed of by the officer concerned. The same will be implemented in the new e-TMR system which is expected to be implemented by the end of this year."</i>
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20	Early publication of the Annual report.	It is inform to the stakeholders that Annual Report is published after the approval of the competent authority and placement in the parliament only. However, possible measure may be taken to reduce delay in future.	No directions required.
21	GI should not be registered as TM.	There is Statutory provision for restriction of registration of TM of registered GI. However, if some discrepancy noted specifically, may be brought is the knowledge of the office.	No directions required.
22	Request made to avoid discrepancy in regard to filing of letter / correspondence.	It was inform to the stakeholder that specific nomenclature is given for speedy allotment or processing of application such as reply to examination report, reply to formality check fail, etc. Everyone should take proper care to file the document properly. However, in some specific cases, office may be consulted, if required.	No directions required.

“Note 1:

Some suggestion received relating to structural changes in the system, such as visibility of classes of opposition in case of multiclass application, display of email ID in opposition BAR, image search, multiclass search, display of daily order sheet, etc. will be considered at the time of implementation of new eTMR system as the office is in process to finalize and implement new eTMR system for electronic processing in near future.

Due consultation/testing will also be done with representative of associations before implementation of the same.

Note 2:

Some general queries rose without any suggestion in this regard. It is to inform that FAQ document will be updated shortly covering all such queries.”

16. A perusal of these affidavits and the tabulation above, shows that several suggestions made by the stakeholders have already been agreed to by the Registrar of Trade Marks. Further, insofar as the processing of Trade Mark applications by the same officer is concerned, form TM-Ms are to be processed by the same officer. The table above consists broadly of two categories of directions which are to be implemented. Some are to be implemented w.e.f. 30th April 2020. Steps shall also be taken by TMR to ensure implementation as directed. It has been further submitted on behalf of the Registrar of Trade Marks that a new e-TMR system is likely to be established and put into motion by December, 2020. Let the needful be accordingly done for implementing the e-TMR system as contemplated and the various suggestions and directions in respect thereof as contained in the table above be implemented in the said system.

17. As per Mr. Pawan Kumar Pandey, pendency in the Trade Mark application process has reduced. All the measures taken by the Registrar of Trade Marks are taken on record and the TMR is directed to adhere to the statements made in the affidavits filed before this Court.

18. Since the processing and setting up of more efficient measures, as part of the e-TMR system, is an on-going process, till the same is fully implemented, the Petitioners/any other stakeholders are permitted to submit any further suggestions to the Registrar of Trade Marks within a period of

six weeks from today for being considered for implementation in the e-TMR system, in accordance with the Trade Marks Act, 1999 and the Trade Marks Rules, 2017.

19. Ld. counsel submit that the Trade Marks insofar as the present writ petitions are concerned, in W.P.(C) 10040/2019 and W.P.(C) 11284/2019 the same have been renewed. If renewal of the Trade Mark in W.P.(C) 2325/2010 is pending, let the same be processed within a period of eight weeks and the renewal certificate be granted. No further orders are called for in these writ petitions.

20. With these observations, the petitions and all pending applications are disposed of.

PRATHIBA M. SINGH
JUDGE

MARCH 06, 2020
dj/MR/T

(Corrected and released on 19th March, 2020)