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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
Date of decision: 3rd March, 2020
+ **W.P.(C) 11872/2005, CM APPLs. 8809/2005 & 8811/2005**
JAI BHAGWAN GUPTA Petitioner
Through: Mr. Sudershan K. Bansal, Mr. Ajay
Amitabh Suman and Mr. Vinay
Shukla, Advocates. (M:9990389539)

versus

REGISTRAR OF TRADE MARKS & ORS. Respondents
Through: Mr. Vishal Mittal, Senior Panel
Counsel for R-1, 2 & 3.
(M:9311177388)

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. The present writ petition has been filed by the Petitioner - Shri Jai Bhagwan Gupta, proprietor of M/s. Bhagwan Kirana Company, against the Registrar of Trademarks and Respondent Nos. 4 & 5. The Petitioner has used the trademark "*JEERA PUJARI*" in respect of *jeera* and *sauff* since 1980. The Petitioner also has registration for "*JEERA PUJARI*" word mark since 1987 bearing no.472153. The said mark has been duly renewed by the Petitioner. The Petitioner also has a second trademark bearing no.631107 for "*JAI PUJARI BRAND*" label.

2. The grievance of the Petitioner is that despite the Petitioner having registered the trademarks for "*JEERA PUJARI*" word mark and "*JAI PUJARI BRAND*" label mark, the Registrar of Trademarks is advertising various trademarks consisting of the word "PUJARI" in respect of identical goods falling in Class 30. It is, thus, submitted that though the Petitioner has filed oppositions in respect of these marks, the same has become a

burden upon the Petitioner who is saddled with costs for oppositions and for keeping a watch on the trademark journal. Under such circumstances, the Petitioner prays for the following reliefs:

“(i) issue a writ of certiorari quashing the impugned publication of the trademarks of respondent no. 4 and 5 published in the trade mark journals being ANNEXURES P - 4 & 5 as illegal and unconstitutional and proceedings taken towards its registration;

(ii) issue a writ of mandamus directing respondents no. 1 and 2 to perform the-official functions in consonance with provisions of law and principles of natural justice and further to desist from publishing trademarks identical with or deceptively similar to petitioner's trade marks in trade mark journals without following due procedures and provisions of law as envisaged under the Trade Marks Act and Rules there under;”

3. The submission of Mr. Bansal, Id. counsel appearing for the Petitioner is that the Trademark Registry ought to be examining trademark applications in a proper and efficient manner, so as to ensure that even marks which are identical to registered trademarks, are not cleared for advertisement, which in turn, increases the burden upon the applicants and their attorneys. It is his submission that the registered trademark of the Petitioner consists of the word mark “PUJARI” for spices in Class 30 and in the same Class, similar word marks are being permitted to be advertised for registration. He submits that the stand of the Registrar of the Trademarks is merely that the Petitioner ought to exercise the statutory remedy and nothing more. Reliance is placed upon Sections 9 and 11 of the Trademarks Act, 1999 (*hereinafter ‘the Act’*).

4. Mr. Vishal Mittal, Id. Senior Panel Counsel, appearing for the Registrar of Trademarks submits that there are two applications against

which the Petitioner has raised grievance i.e. trademark application bearing no.1188208 already stands abandoned and the second application bearing no.1285292 is pending for registration and the Petitioner has already opposed the said mark. The Petitioner, thus, having availed the statutory remedy, is not entitled to seek any relief by way of the present petition.

5. This Court has perused the record and heard ld. counsels for the parties. The obligation of the Registrar of Trademarks whenever a new trade mark application is filed, would be to examine the application in terms of Sections 9 & 11 of the Act, as well as the other relevant provisions in order to see if there are any grounds, which are attracted in respect of the said application. Section 9 of the Act consists of the absolute grounds for refusal of a trademark and Section 11 consists of the relative grounds for refusal of registration of a mark. The prohibitions are contained in Section 13 and further conditions are stipulated under Sections 14, 15 & 16 of the Act. The completion of formalities are also to be examined by the Registrar of Trademarks. The examiner has also to consider if the applicant is entitled to registration of the mark due to honest and concurrent usage under Section 12 of the Act. After examining the mark in detail, as per the provisions of the Act, the Registrar of Trademarks has two options i.e. firstly - to accept the mark and direct advertisement of the same in the trademark journal or secondly - without accepting the mark, advertise the mark before acceptance under the proviso of Section 20(1) of the Act. Section 20 is reproduced below for ready reference:

“20. Advertisement of application.- (1) When an application for registration of a trade mark has been accepted whether absolutely or subject to conditions or

limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted together with the conditions or limitations, if any, subject to which it has been accepted, to be advertised in the prescribed manner:

Provided that the Registrar may cause the application to be advertised before acceptance if it relates to a trade mark to which sub-section (1) of section 9 and sub-sections (1) and (2) of section 11 apply, or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do.

(2) Where—

(a) an application has been advertised before acceptance under sub-section (1); or

(b) after advertisement of an application,-

(i) an error in the application has been corrected; or

(ii) the application has been permitted to be amended under section 22,

the Registrar may in his discretion cause the application to be advertised again or in any case falling under clause (b) may, instead of causing the application to be advertised again, notify in the prescribed manner the correction or amendment made in the application.”

6. A perusal of the above provision shows that under Sec. 20(1), the mark can be advertised after acceptance or subject to conditions and limitations. Historically, the Registrar of Trademarks used to pass a specific order under Section 20(1) either accepting the mark or in some cases, direct advertisement of the mark before acceptance. Marks were advertised before acceptance only, in exceptional circumstances, when the examiner has a doubt as to whether the marks ought to be accepted for registration or not. This is because if a mark is advertised before acceptance and thereafter during opposition or further proceedings, the mark is either amended or corrected, it would require re-advertisement of the mark. This is in line with

the settled legal position as succinctly captured in Narayanan on Trade Marks and Passing Off, [Narayanan, P. (2004). *Law of Trade Marks and Passing Off* (6th ed.). Kolkata: Eastern Law House]. The Id. Author observes as under:

“5.24 Advertisement of application – s.20 and Rules 43-46

If the applicant satisfactorily meets all the objections raised by the office, the application will be advertised in the Trade Marks Journal, either as accepted or before acceptance (s.20), on the applicant furnishing a printing block, where necessary. An application may be advertised before acceptance if it relates to a trade mark to which s. 9(1) and s. 11(1) and (2) applies or in any other case where it appears that it is expedient by reason of any exceptional circumstances so to do. Where the application has been advertised before acceptance under the proviso to s. 20(1), the Registrar may in his discretion cause the application to be advertised again. Re-advertisement of the application may also be ordered where an error in the application has been corrected or where the application has been amended under s. 22 after its advertisement. In the alternative, the correction or the amendment made in the application may be notified in the Trade Marks Journal in the prescribed manner.”

7. A similar view is expressed in *Halsbury’s Laws of India*, Vol. 20(1), which opines as under:

“[185.834] Advertisement of application after acceptance

When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar will, as soon as may be after acceptance, cause the application as accepted together with the conditions or limitations, if any, subject to which it has been accepted, to be

advertised in the prescribed manner.”

8. Thus, it is not in every case that a trade mark is advertised before acceptance. The said course of action ought to be the exception and not the rule. If upon examination of a trade mark application, the Registrar is of the view that the mark cannot proceed for registration, then not every mark needs to be advertised. A mechanical advertisement of marks even when it is clear that the same ought not to proceed for registration, is contrary to the maintenance of the purity of the Register. Thus, upon examination of a trade mark, as per the various applicable provisions of the Act and the Rules, the Registrar of Trade Marks, *inter alia*, has the following options:

- i. Accept the mark unconditionally and direct advertisement in the Trade Marks Journal;
- ii. Accept the mark subject to a condition and direct advertisement in the Trade Marks Journal;
- iii. Accept the mark subject to a limitation and direct advertisement in the Trade Marks Journal;
- iv. Direct the advertisement of the mark in the Trade Marks Journal, before acceptance, if Section 9 or Section 11 is attracted or if exceptional circumstances exist or if it is considered expedient to do so;
- v. Reject the application at that stage itself if the Registrar is of the opinion that the same ought not to proceed for registration due to any of the absolute prohibitions etc.,

9. In recent times it is noticed, that almost all the trademarks are being advertised before acceptance under the Proviso to Section 20(1) of the Act.

Such a procedure would be contrary to the Act, inasmuch as there is application of mind which is required to be exercised by the Registrar of Trademarks, prior to the mark being advertised. Under Section 20(1), there has to be a reason why the Registrar of Trademarks is directing 'advertisement before acceptance' and the same cannot be a ministerial act or a mere formality. The application of mind, prior to acceptance or advertisement before acceptance, has to be deliberate and conscious and the provisions of the Act would have to be considered by the Registrar in a conscious manner. Marks that do not deserve advertisement ought not to be advertised before acceptance. The automatic or indiscriminate advertisement of trade mark applications tends to increase the burden upon the applicants to keep a watch on the Trade Marks Journal and also to oppose, leading to heavy costs to maintain trademark rights which are granted under the Act. Thus, it is not proper and is impermissible for the Registrar of Trademarks to direct advertisement of a majority of marks, before acceptance, under the proviso to Section 20(1) of the Act. A specific order would have to be passed as to the reason why the mark is being advertised after acceptance or the reason why the mark is being advertised before acceptance. The order need not be detailed but ought to exist on file, even if, very brief. The burden of the Registrar of Trademarks to examine marks as per the provisions of the Act and Rules, cannot be completely shifted upon the applicants/proprietors/owners of the trademarks. Such a procedure would result in completely ignoring the provisions of Act itself, which is impermissible. The Registrar has to maintain the purity of the Register.

10. It is, accordingly, directed that the Registrar of Trademarks shall ensure that whenever marks proceed for advertisement, a specific brief order

is passed under Section 20(1) after acceptance for advertisement or under exceptional circumstances - under the proviso to Section 20(1) for advertisement before acceptance. All marks ought not to be permitted to proceed for advertisement and thereafter for registration.

11. Under these circumstances, the writ petition is disposed of with the following directions:

- i. The opposition, which is pending in respect of trademark registration no. 1285292, shall now be decided expeditiously.
- ii. Whenever any applications are filed and consist of the word “PUJARI” especially in respect of Class 30, the Registrar of Trademarks shall bear in mind the registrations of the Petitioner and shall direct advertisement under Section 20 only after considering the said trademark registrations of the Petitioner under either Section 20(1) or under the Proviso to Section 20(1).
- iii. In case the mark is advertised, the Petitioner’s right to oppose the mark would still be available and such oppositions shall be decided in accordance with law.

12. With these observations, the writ petition and all pending applications are disposed of.

13. The present order be communicated to the Controller General of Patents, Designs and Trade Marks on the email address cgooffice-mh@nic.in

PRATHIBA M. SINGH
JUDGE

MARCH 03, 2020/dk/A.S.

(corrected and released on 19th March, 2020)