

Sharayu Khot.

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

COMMERCIAL MISCELLANEOUS PETITION NO. 86 OF 2022

Musicians Institute

...Petitioner

Versus

Registrar of Trade Marks & Anr.

...Respondents

Mr. Yatin Khochare i/by Krishna and Saurastri Associates LLP for the
Petitioner.

Mr. Yashodeep Deshmukh for the Respondent.

CORAM : R.I. CHAGLA J

DATE : 31 August 2023

ORDER :

1. Heard the learned Counsel for the parties. Although the Commercial Miscellaneous Petition No. 86 of 2022 has been listed on today's board. However, on the Courts record, the cause title of the Petition is bearing Appeal under Section 91 of the Trade Marks Act, 1999 being O.A. No. 3 of 2020 before the Intellectual Property Appellate Board. Requisite steps will be taken by the Applicant/Petitioner to reflect the change in the cause title of the

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papers and proceedings in the above matter. This shall be done forthwith. Registry shall accept the same.

2. By this Petition, the Petitioner is seeking setting aside of impugned orders dated 13th June 2018 and 9th April 2019.

3. The learned Counsel for the Petitioner has drawn this Court's attention to the impugned order dated 13th June 2018 refusing the registration of the applied for trade mark and impugned order dated 9th April 2019 which had dismissed the Review Application. He has submitted that the Senior Examiner of Trade Marks has passed the impugned orders which are cryptic in that no reasons have been furnished. In the impugned order dated 13th June 2018, there is a one line rejection which reads as "*The trade mark applied for is objectionable under Section 9/11 of the Act. The application is accordingly refused.*" Thereafter, reference is made to Rule 36(1) of Trade Marks Rules, 2017 and it is provided that the where the Application is refused a request may be made in form No. TM-M along with the prescribed fee to communicate in writing the grounds of decision and materials used by the Registrar in arriving at his decision to refuse the said Application. The said request on form

TM-M is to be tendered within 30 days of receipt of order of refusal.

4. The learned Counsel for the Petitioner has submitted that the practice of placing reliance upon to Rule 36(1) of the Trade Marks Rules, 2017 and calling upon the Applicant to make a request for communication of grounds of decision and materials used by the Senior Examiner of Trade Marks in arriving at his decision to refuse the Application is a practice which requires to be deprecated.

5. The learned Counsel for the Petitioner has referred to decision of the Delhi High Court in **Intellectual Property Attorneys Association Vs. The Controller General of Patents Designs and Trade Marks**¹ where the learned Single Judge has held that Rule 36 of Trade Marks Rules, 2017 is violative of Section 18(5) of the Trade Marks Act, 1999 insofar as it provides for sending the copy of the order to the Applicant without the grounds for refusal/conditional acceptance. The learned Single Judge has held that Rule 36 is inconsistent with the mandatory provision of Section 18(5) of the Trade Marks Act and that the Registrar of Trade Marks is directed to send copy of the order containing the grounds of refusal/conditional acceptance of the

1 WP (C) No. 3851/19 & CM Appeals No. 17546/19, 29362/19 Jt dtd 16.10.2019

Applicant.

6. The learned Single Judge of the Delhi High Court has held that the Registrar of Trade Mark is duty bound to send a copy of the order passed under Section 18(5) of the Trade Marks Act containing the grounds for refusal/conditional acceptance and material used by him in arriving at the decision in the Application. Rule 36 of the Trade Marks Rules, 2017 has accordingly been held to be arbitrary, unreasonable and inconsistent with the mandatory provisions of the statute. The Writ Petition was allowed by the learned Single Judge and the Registrar of Trade Marks was directed to strictly implement Section 18(5) of the Trade Marks Act by recording in writing ground for refusal/conditional acceptance.

7. The learned Counsel for the Petitioner has further submitted that the Division Bench of this Court in **The Institute Cost Accountants of India Vs. The Registrar of Trade Marks**² has referred to Rule 38(4) of the Trade Mark Rules, 2002 and held that placing notice on the website does not constitute compliance thereof. The Division Bench has held that the Registrar of Trade Marks is bound to

2 Writ Petition No. 2088/12 decision dated 1.03.2013

communicate any objection or proposal in writing to the Applicant. He has submitted that in the present case, the said decision is apposite.

8. The learned Counsel for the Respondent has on instructions stated that the impugned orders may be set aside and the matter remanded back to the Senior Examiner of Trade Marks to pass reasoned order and communicate the reasoned order in writing to the Petitioner. Statement is accepted.

9. Having considered the submissions, in my view, there is much merit in the submissions of the learned Counsel for the Petitioner. The Senior Examiner of Trade Marks is obligated to pass reasoned order after considering the submissions of the Petitioner which is required to be reflected in the order. It is not sufficient for the Senior Examiner of Trade Marks to merely make reference to Rule 36(1) of the Trade Marks Rules, 2017 and call upon the Applicant to make request for communication in writing of the grounds of decision and material used by the Registrar in arriving at the decision to refuse the Application. This is exactly what has happened in the present case as can be seen from the impugned order dated 13th

June 2018. Further, in the 2nd impugned order dated 9th April 2019, the Senior Examiner of Trade Marks has merely held that the Review Application by order dated 13th June 2018 is refused. There are no reasons given for the refusal and/or the grounds of challenge to the 1st impugned order dated 13th June 2018 considered. The orders of the Respondent is required to pass order in conformity with the principles of natural justice. Further the Respondent is required to follow the mandatory provisions of the Act, in particular, Section 18(5) of the Trade Marks Act, 1999, by recording in writing in the impugned order the grounds of refusal and materials used by him in arriving at the decision. Further, it is insufficient for the Respondent to place the order on the official website, but the same must be communicated to the Applicant.

10. Considering the aforementioned statement made on behalf of the Respondent which is accepted by this Court, the following order is passed.:-

- (i) Impugned orders dated 13th June 2018 and 9th June 2019 are quashed and set aside.

(ii) The matters is remanded back to the Senior Examiner of the Trade Marks.

(iii) The Respondent/Senior Examiner of Trade Marks shall after hearing the Petitioner, pass fresh order and communicate the same to the Petitioner within a period of six weeks from the date of this order.

(iv) The fresh order shall be in conformity with Section 18(5) of the Trade Marks Act, 1999.

(v) The Respondent/Senior Examiner of Trade Mark shall communicate the fresh order to the Petitioner/Applicant and not merely place the order on the website.

(vi) The Registry shall forthwith act on the Application of the Petitioner in correcting the cause title of the papers and proceedings in the above matter which shall reflect "*Commercial Miscellaneous Petition No. 86 of 2022*" filed in this Court and not "*O.A. No. 3 of*

2020” before Intellectual Property Appellate Board.

(vii) Commercial Miscellaneous Petition is accordingly,
disposed of.

[R.I. CHAGLA J.]