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

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Date of decision: 24th October, 2024+ **W.P.(C)-IPD 29/2024****PROMOSHIRT SM. PVT. LTD.**

.....Petitioner

Through: Ms. Swathi Sukumar, Mr. Essenese Obhan, Ms. Urvashi Singh, Ms. Akansha Sikri, Mr. Ritik Raghuvanshi and Mr. Rishubh Agarwal, Advocates.

versus

THE REGISTRAR OF TRADE MARKS

.....Respondent

Through: Ms. Nidhi Raman, CGSC with Mr. Zubin Singh and Ms. Rashi Kapoor, Advocates for R-1

CORAM:**HON'BLE MR. JUSTICE AMIT BANSAL****AMIT BANSAL, J. (Oral)**

1. The present writ petition has been filed seeking a direction for allowing the renewal of the Indian Trademark Application no.1150198.
2. It is the case of the petitioner that an application bearing No.1150198



for the trademark **SWISS BELLS** was filed on 12th November, 2002 on a 'proposed to be used' basis in Class 25 in respect of "textile items". The trade mark was published in the trademark journal no.1330-1 on 15th May, 2006.



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3. An opposition was filed in respect of the aforesaid application by Swiss Army Brand Ltd., however, pursuant to a settlement, the opposition was withdrawn *vide* letter dated 26th October, 2010. *Via* an order dated 2nd August, 2012 passed by the Trademark Registry, the opposition was treated as withdrawn and the application was allowed to proceed for registration.
4. It is submitted on behalf of the petitioner that despite the aforesaid order being passed by the Trademark Registry on 2nd August, 2012, a registration certificate was not issued in favour of the petitioner until 24th May, 2016, despite the petitioner sending various communications/reminders to the Trademark Registry.
5. Ultimately, the registration certificate was issued on 25th May, 2016, i.e., four years after the expiration of the validity of the trademark.
6. The grievance raised by the petitioner in the present petition is that since the registration certificate was issued four years after the expiration of validity of the trademark, the petitioner was unable to renew the registration granted in respect of the aforesaid trademark.
7. It is also stated that that upon a perusal of the Trade Marks Registry's record available online by the petitioner, a defective/void Notice of Renewal of Trade Mark (O-3 Notice) dated 27th May, 2016 was issued for the renewal of the Application. However, there was no recipient address on this notice and the same was never served upon the Applicant or its erstwhile attorneys.
8. An interlocutory petition bearing no.1150198 was filed with Registrar of Trade Marks on behalf of the petitioner on 8th July, 2019 seeking renewal of the aforementioned trademark.
9. It is stated that till date no hearing has been scheduled in the said



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interlocutory petition despite the same having been filed in July 2019. The petitioner has neither received the registration certificate within the prescribed statutory time period under Section 23(1) of the Trade Marks Act, 1999, nor the mandatory O-3 Notice, as prescribed under Section 25(3) of the Trade Marks Act, 1999 was issued to the petitioner due to which the petitioner could not renew its subject trademark registration.

10. Presently, the status page of the Application on Trade Marks Registry's website shows "*Trade mark is likely to be removed due to non-filing of Renewal request within prescribed time limit*".

11. Hence, the petitioner has filed the present writ petition.

12. The main ground taken in the writ petition is that the respondent issued the Trademark Registration certificate belatedly, even after the expiry of the validity of the Trade Mark Registration and timeline for renewal, thus rendering the petitioner without any remedies with respect to their trademark application no.1150198.

13. The second ground taken in the writ petition is that the respondent is required to serve a O-3 notice, in accordance with the provisions of Section 25(3) of the Trade Marks Act, 1999, which the respondent has clearly failed to do.

14. The predecessor Bench, *vide* order dated 23rd September, 2024, asked the counsel appearing on behalf of the respondents to take instructions.

15. Ms. Nidhi Raman, Central Government Standing Counsel, appearing on behalf of the respondents submits that the records of the renewal notice sent in Form O-3 are not traceable.

16. In *Epsilon Publishing House Pvt. Ltd. v. Union of India & Ors.* 2017 (72) PTC 480 [Del], this Court took the view that the proprietor of a



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registered mark must not be penalized for the lapse of the Registry in failing to follow the procedure prescribed under the Act and the allied Rules. The relevant extracts of the judgment are as follows:

“26. There may be merit in the contention that the Registrar has to follow the procedure as prescribed; however, the essential question is not whether the Registrar has any discretion in the matter, but, what are the consequences of the Registrar not following the established procedure? Plainly, in the facts of the present case, it is apparent that the Trademark Registry has not adhered to the timelines as required. Surely, respondent No. 3 cannot be penalised for the same and would be entitled to pursue its application for renewal of its trademark.”

17. It is settled position of law that issuance of O-3 notice is a mandatory requirement which must be complied by the Trademark Registry. In **CIPLA Limited v. Registrar of Trade Marks & Ors.**, 2013 (56) PTC 217 [Bom] [DB], it has been held as under:-

“10. The public notice does not constitute compliance with the provisions of section 25(3). Section 25(3) requires the Registrar to send the notice "to the registered proprietor". A general public is not contemplated under the section.”

18. In another writ petition **“Ashok Bhutani v. Registrar of Trademarks”** bearing W.P.(C)-IPD 22/2024 decided on 27th September, 2024, I had issued directions for issuance of certificates of renewal in similar circumstances.

19. Accordingly, the following directions are issued in the petition:

- a. Respondents are directed to issue the certificate of renewal of trademark from the year 12th November, 2012 to 12th November, 2022 to the petitioner in respect of the trademark application bearing no.1150198 and restore the same.
- b. The petitioner is permitted to file fresh renewal application and



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upon fulfilling the prescribed formalities, respondents shall restore and renew the trademark bearing no. 1150198 for further period of ten years with effect from 12th November, 2022.

- c. Respondents shall make necessary corrections in their database with respect to the renewal status and renewal date of trademark application bearing no.1150198.

20. The writ petition stands disposed of.

AMIT BANSAL, J

OCTOBER 24, 2024