



2024:DHC:8551



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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 31/2024
PROMOSHIRT SM. S.A.

.....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.1105799.
2. It is the case of the petitioner that an application bearing No. 1105799



SWISS

MOUNTAINS

for the trademark **MOUNTAINS** was filed on 20th May, 2002 in Class 16 in respect of “pen” with a prior user claim since 1st January, 1993. The trade mark was advertised in the trademark journal no.9999-4 on 25th October,



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2003.

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in respect of the aforesaid application by Swiss Army Brand Ltd., however, pursuant to a settlement, the opposition was withdrawn *vide* letter dated 26th October, 2010. *Via* an order dated 10th October, 2011 passed by the Trademark Registry, the opposition was treated as withdrawn and the application was allowed to proceed for registration.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 10th October, 2011, a registration certificate was not issued in favour of the petitioner until 3rd September, 2017, despite the petitioner sending various communications/reminders to the Trademark Registry.

5. Ultimately, the registration certificate was issued on 4th September, 2017, i.e., five 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 two 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. An interlocutory petition bearing no.1105799 was filed with Registrar of Trade Marks on behalf of the petitioner on 8th July, 2019 seeking renewal of the aforementioned trademark.

8. It is stated that till date no hearing has been scheduled in the said 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



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petitioner could not renew its subject trademark registration.

9. 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*".

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

11. 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.1105799.

12. 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.

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

14. 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.

15. 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 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



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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.”

16. It is settled position of law that issuance of O-3 notice is a mandatory requirement which must be complied by the Trademark Registry. Reference in this regard may be made to **CIPLA Limited v. Registrar of Trade Marks & Ors.**, 2013 (56) PTC 217 [Bom] [DB]; **Union of India and Ors. v. Malhotra Book Depot** 2013 (54) PTC 165 [Del] [DB] and **Gopal Ji Gupta v. Union of India**, 2019 SCC OnLine Del 7670]

17. 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.

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

- a. Respondents are directed to issue the certificate of renewal of trademark from the year 20th May, 2012 to 20th May, 2022 to the petitioner in respect of the trademark application bearing no.1105799 and restore the same.
- b. The petitioner is permitted to file fresh renewal application and upon fulfilling the prescribed formalities, respondents shall restore and renew the trademark bearing no. 1150799 for further period of ten years with effect from 20th May, 2022.
- c. Respondents shall make necessary corrections in their database with respect to the renewal status and renewal date of trademark application bearing no.1105799.



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19. The writ petition stands disposed of.

OCTOBER 24, 2024

AMIT BANSAL, J