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

+ **W.P.(C)-IPD 8/2025 & CM 33/2025**

MANKIND PHARMA LIMITED

.....Petitioner

Through: Mr. Hemant Daswani, Ms. Saumya
Bajpai, Advs.

versus

REGISTRAR OF TRADE MARKS

.....Respondent

Through: Mr. Sumit Nagpal, SPC (through vc)
Mr. Ratan Prakash, GP

CORAM:

HON'BLE MS. JUSTICE MANMEET PRITAM SINGH ARORA

ORDER

% **24.11.2025**

1. The present writ petition has been filed under Articles 226 and 227 of the Constitution of India for the issuance of a writ of Certiorari to quash the letter dated 24.09.2024 under reference no. AD-3149 ['impugned letter'] issued by the Respondent and the issuance of Mandamus directing the Registrar of Trademarks to renew the Petitioners' registered Trademark under no. 1591512 in accordance with the law.

Factual Matrix

2. The Petitioner is the 4th largest pharmaceutical company of India, and was incorporated in 1991. It is engaged in the business of manufacturing and/or marketing medicinal, pharmaceutical and veterinary preparations.

3. On 17.08.2008, the Petitioner applied for the registration of the trademark V-STAR bearing TM application no.1591512 in class 5. The said application faced two [2] oppositions, namely Opposition Nos. 763378 and



763509.

4. Opposition No. 763378 was dismissed for want of prosecution vide order dated 08.12.2022, and Opposition No. 763509 was dismissed/withdrawn vide order dated 06.03.2023; thereafter which the trademark proceeded for registration. After sixteen [16] years of filing the trademark application, the Respondent issued the registration certificate on 06.03.2023; however, it was never sent to or received by the Petitioner. The Petitioner came to know about the issuance of the registration certificate only on 06.06.2024, upon routine verification.

5. Since the trademark was registered after the date of its renewal, in June 2024, when the Petitioner tried applying for the renewal application, the Respondent's online e-filing system prohibited the same, and an error message was displayed.

6. The Petitioner's representative visited the Respondent's Delhi office on multiple occasions in June/July 2024 to submit the renewal fees, but was repeatedly sent back. On 19.08.2024, the Petitioner sent a letter with Form TM-R and a demand draft of Rs. 10,000/- to the Respondent's Mumbai office, which was also sent back, stating the application should be filed at the Delhi office. Accordingly, the Petitioner filed the application again with the Delhi office on 18.09.2024 via speed post. However, on 24.09.2024 vide the impugned letter, the Respondent refused to accept renewal, stating that 'the Renewal Restoration is over' and the same is also time-barred under the Trademark Rules, 2017; hence, the petition.

Submissions by the Parties

7. Learned counsel for the Petitioner states that the Respondent failed to issue any O-3 notice [now known as RG-3 notice] after 06.03.2023,



informing the Petitioner about the approaching renewal date and the time left to renew the mark. No O-3/RG-3 notice was uploaded on its online portal under the 'Correspondences and Notices' section.

8. He states despite the statutory mandate, the Respondent failed to issue any RG-3 notice, in accordance with Section 25(3) of the Trademarks Act 1999 ['the Act'], read with Rule 58(1) of Trademarks Rules, 2017 ['the Rules']. In this regard, reliance is being placed upon the judgment of the Madras High Court in **Jaisuryas Retail Ventures Pvt. Ltd. v. The Registrar of Trademarks**¹ and the judgment of a coordinate bench of this Court in **Promoshirt SM. S.A. v. Registrar of Trademarks**².

9. He states that this has resulted in the Petitioner being completely unaware of:

- (a) The fact that the registration certificate had been issued on 06.03.2023;
- (b) The date of registration of 06.03.2023;
- (c) The date on which the renewal would become due.

10. He therefore prays that, keeping in view the aforementioned judgments, this Court may exercise its discretion and set aside the impugned letter dated 24.09.2024.

11. In reply, learned counsel for the Respondent fairly apprised the Court that the Petitioner's submission that the Respondent failed to communicate the issuance of the registration certificate dated 06.03.2023 is correct as per the record. However, he states that Rule 58(3) of the Rules should be invoked in the facts of this case and not Rule 58(1) of the Rules, which is

¹ W.P.(IPD) Nos.4 to 14 of 2024 (11 WPs)

² 2024 SCC OnLine Del 7724



applicable during the period of validity of the trademark registration.

12. He clarifies that in the intervening period, no other mark in the same Class has been registered, and therefore, the interest of no third party will be affected.

Court's Findings

13. This Court has considered the submissions of the parties and perused the record.

14. In the facts of this case, the Petitioner had applied for registration of the mark V-STAR on 17.08.2008, however, the trademark was registered sixteen [16] years later on 06.03.2023. The Petitioner was unable to apply for its renewal within six (6) months from the actual date of registration as contemplated under Rule 58(3) of the Rules and therefore the registration has expired.

Pertinently, it has come on record that the fact of registration and the issuance of the registration certificate was not communicated by the Trademark Registry to the Petitioner on 06.03.2023 or thereafter.

Form RG-3 Notice

15. The Petitioner has raised a ground that the Respondent failed to issue the mandatory notice in Form RG-3, in accordance with the provisions of Section 25(3) of the Act, read with Rule 58(1) of the Rules and therefore, the Petitioner, being unaware of the registration of the trademark, was unable to file an application for renewal or restoration within the statutory period.

16. Rule 58(1) of the Rules stipulates that when an application for renewal of registration has not been filed by the proprietor, and the trademark is about to expire; in such a case, the Registrar is required to



issue a notice to the registered proprietor in Form RG-3.

17. However, in the considered opinion of this Court, the aforementioned Section and Rule are not applicable when the trademark is registered after the date of renewal [which is the factual scenario in the present case].

18. Therefore, the reliance placed by the Petitioner on Section 25(3) of the Act read with Rule 58(1) of the Rules, and the judgment of **Jaisuryas Retail Ventures Pvt. Ltd. v. The Registrar of Trademarks** (supra) is inapplicable, as in the facts of that case, the issue of notice of renewal arose during the validity of the trademark registration. The Petitioner has also relied upon the judgment of the Co-ordinate Bench in **Promoshirt SM. S.A. v. Registrar of Trademarks** (supra); however, this Court finds no reference or deliberation in the said judgment on Rule 58(3) of the Rules, which is squarely applicable to the facts of this case and this Rule does not contemplate issuance of notice in Form RG-3 as discussed hereinafter.-

19. This Court is of the considered opinion that the reason why the legislature stipulated issuance of a notice in Form RG-3 contemplated under Rule 58(1) is that ordinarily it is presumed that registration would be granted to the applicant within 1-2 years of filing of the application, and the said registration is then valid for ten [10] years. The IP rights vested in the proprietor due to the registration are valuable. However, it is reasonable to presume that the proprietor may not always remember the expiry date when the period of ten [10] years is coming to a close; and the legislature with a view to remind the proprietor of its obligation to renew registration deemed it appropriate to provide for issuance of a notice in Form RG-3 by the Registrar so that the proprietor can take steps to keep the registration alive, as failure to renew would result in removal of mark from register and affect



the valuable rights of the proprietor.

20. However, the fact scenario when an anomalous situation arises inasmuch as the trademark itself is registered ten [10] years later, i.e., after the date of renewal, the applicable Rule governing the renewal is Rule 58(3) as well as Rule 60; and Rule 58(1) has no application to such facts. The facts of the present case are governed by Rule 58(3) as well as Rule 60 of the Rules, which read as under:

“Rule 58. Notice before removal of trademark from register. —

.....

(3) Where, in the case of a trademark the registration of which (by reference to the date of application for registration) becomes due for renewal, the trademark is registered after the date of renewal, the registration may be renewed by the payment of the renewal fee within six months of the actual date of registration and where the renewal fee is not paid within that period the Registrar shall, subject to rule 60, remove the trademark from the register.

.....

Rule 60. Restoration and renewal of registration. — An application for the restoration of a trademark to the register and renewal of its registration under sub-section (4) of section 25, shall be made in Form TM-R within one year from the expiration of the registration of the trademark accompanied by the prescribed fee. The Registrar shall, while considering the request for such restoration and renewal have regard to the interest of other affected persons.”

21. As is apparent, Rule 58(3) does not contemplate the issuance of any notice by the Registrar to the registered proprietor for taking steps for renewal, unlike Rule 58(1). The legislature, while stipulating issuance of notice as per Form RG-3 under Rule 58(1), has, however, consciously elected not to provide for the same mechanism under Rule 58(3). In the considered opinion of this Court, this is not a case of *casus omissus* but rather the intended scheme of the Rules. The reason for the same is not far to



seek. In cases contemplated under Rule 58(3), where the trademark is registered after the date of the renewal, the proprietor and its trademark agent on the date of issuance of the registration certificate itself are aware that the trademark registration has already expired on the said date and has to be renewed within six [6] months as per Rule 58(3) to ensure that it remains on the register. The registration certificate itself clearly states the period of validity of registration is ten [10] years from the date of application and that it may be renewed for a further term of ten [10] years. The registration certificate is issued as per Form RG-2, and the said form stipulates a Note with respect to the period of registration and the obligation of renewal specifically.

22. Thus, in the scenario envisaged under Rule 58(3) of the Rules, the registered proprietor on the date of receipt of the registration certificate has knowledge of the date of expiry of the registration and the legal obligation to renew the same so as to keep the registration alive. And, therefore, there is no requirement or occasion of issuing a reminder notice by the Registrar to the registered proprietor in the facts scenario contemplated under Rule 58(3), and the law expects the registered proprietor to be vigilant about its rights and obligations to renew the registration. Therefore, this Court finds no merit in the ground raised by the Petitioner as regards any alleged default by the Registrar in not issuing Form RG-3 notice, as, in the fact scenario envisaged under Rule 58(3) of the Rules, no such notice has to be issued.

Effect of non-communication of the registration certificate dated 06.03.2023 to the Petitioner

23. Since there is an obligation under Rule 58 (3) to renew the mark within six [6] months of the actual date of registration, which in the facts of



this case was 06.03.2023, the period of six [6] months would have expired on 06.09.2023. However, the Respondent has fairly conceded that the factum of the registration of the trademark had not been communicated to the proprietor, and the registration certificate was not communicated to the proprietor. Therefore, in the facts of this case, there is no evidence on record to attribute the knowledge of the date of registration to the Petitioner/proprietor.

24. The Petitioner has urged that it learnt about the registration on a routine verification in June 2024 and made diligent attempts to have the registration renewed between June 2024 and September 2024 with the Registrar; and ultimately filed the writ in January 2025. Consequently, this Court finds that the Petitioner has not been negligent and its failure to apply for renewal of registration within six [6] months as per Rule 58(3) was due to reasons beyond its control. It is evident that the Petitioner was unable to apply within the stipulated period due to the non-communication of the fact of registration.

25. The statute itself under Section 25(4) read with Rule 60 contemplates condoning lapse of a proprietor to apply for renewal beyond the specified period of six [6] months within one [1] year, subject to the interest of other affected persons. In this case, as noted above, the Respondent has clarified that there is no third person who will be affected if the renewal is granted in favour of the Petitioner herein.

26. Therefore, in the peculiar facts of this case, this Court is satisfied that the Court must exercise its extraordinary jurisdiction to permit the renewal of the TM no. 1591512 and its restoration. The facts of the case show that the Petitioner applied for the mark sixteen [16] years ago, and its valuable



rights secured by its registration ought not to be set at naught due to the lapse of communication of the date of registration.

27. Accordingly, the Respondent is directed to take on record the renewal filed by the Petitioner in the TM no. 1591512 for the mark V-STAR and renew the registration as per the Rules, expeditiously and preferably within four (4) weeks from the receipt of this order.

28. Learned counsel for the Respondent is also directed to communicate this order to the Registrar for information and compliance.

29. With the aforesaid direction, the petition stands disposed of.

30. Pending applications, if any, stand cancelled.

31. The digitally signed copy of this order, duly uploaded on the official website of the Delhi High Court, www.delhihighcourt.nic.in, shall be treated as a certified copy of the order for the purpose of ensuring compliance. No physical copy of order shall be insisted by any authority/entity or litigant.

MANMEET PRITAM SINGH ARORA, J

NOVEMBER 24, 2025/aa