



* IN THE HIGH COURT OF DELHI AT NEW DELHI

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Reserved on: April 29, 2025
Pronounced on: May 27, 2025

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W.P.(C)-IPD 40/2024 & CM 141/2024

RAKESH KUMAR MITTAL

....Petitioner

Through: Mr. Siddharth Yadav, Mr. Ayush Dey and Mr. Nageshwar Kumhar, Advocates.

Versus

THE REGISTRAR OF TRADE MARKS

....Respondent

Through: Ms. Nidhi Raman, CGSC.

CORAM:

HON'BLE MR. JUSTICE SAURABH BANERJEE

J U D G M E N T

Preface:

1. By way of the present writ petition, the petitioner seeks issuance of a writ of mandamus or any other appropriate writ, order or direction directing the Registrar of Trade Marks¹ to restore and reinstate the



registration of the petitioner's trademark MILTON/ in Class 9 of the Trade Marks Act, 1999²; for quashing of any internal decision, action or omission that resulted in the removal of the said trademark from the Register of Trade Marks³; and directions to the respondent to permit him to file renewal applications for the periods 2004-2014, 2014-2024,

¹Hereinafter referred as "*respondent*"

²Hereinafter referred as "*TM Act*"

³Hereinafter referred as "*Register*"



and 2024-2034; and upon such filing, to issue the corresponding renewal certificates.

Brief Facts and Contention:

2. The petitioner is engaged in the business of Amplifiers Microphones, Horns for Loud Speakers, Loud Speakers and Transformers and Horn Units and Parts. The petitioner filed application no.627446 on



06.05.1994 for registration of the trademark MILTON/ in Class 9 of the TM Act, claiming usage since 24.09.1982. Subsequently, the Registration Certificate was issued on 30.05.2003 and the trademark was due for renewal on 06.05.2004.

3. However, due to non-renewal within the prescribed time, the registration of the aforesaid trademark lapsed and was consequently removed from the Register, as notified in Trade Marks Journal No.1442 dated 16.10.2010.

4. The petitioner then filed an RTI application to ascertain whether the respondent had served him with a Form O-3 Notice in terms of Section 25(3) of the TM Act. The relevant part of the response thereto is as under:-

“As per record subject application was applied dated 06/05/1994 vide certificate no 263429 Dated : 30/05/2003 for 10 year from 06/05/1994 to 06/05/1994. If the application is registered after 10 years from the date of Application, the provision of sec 25(3) does not applicable. The Registered Proprietor will get six months from the date of issuance of Registration Certificate.”

5. As per petitioner, *admittedly*, though the Registration Certificate was issued on 30.05.2003 and the trademark was due for renewal on



06.05.2004, the respondent had to send the mandatory Form O-3 Notice specifying the date of expiration of the registration and the conditions for its renewal in compliance of *Section 25(3)* of the TM Act. However, Form O-3 Notice was never served on the petitioner.

6. In view of the aforesaid non-compliance by the respondent of the mandatory procedure prescribed under *Section 25(3)*⁴ of the TM Act, the renewal application was not filed by the petitioner within the prescribed time. Therefore, since the removal was without any fault of the petitioner, as such the same was illegal and unsustainable.

7. Based on the aforesaid facts and circumstances, learned counsel for the petitioner has primarily submitted that there is a sheer non-compliance of the mandatory provisions of the TM Act as also the Trade Marks Rules, 2002⁵ and thus the registration of the trademark in issue ought to be restored.

8. Learned CGSC, supporting the order of the respondent of removal of the trademark of the petitioner from the Register submitted that there is no fault in the order and the trademark of the petitioner has rightly been removed from the Register of the trademarks.

Analysis and Reasoning:

⁴25. *Duration, renewal, removal and restoration of registration.*—

(3) *At the prescribed time before the expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with the Registrar may remove the trade mark from the register: Provided that the Registrar shall not remove the trade mark from the register if an application is made in the prescribed form and the prescribed fee and surcharge is paid within six months from the expiration of the last registration of the trade mark and shall renew the registration of the trade mark for a period of ten years under sub-section (2).*

⁵Hereinafter referred as “*TM Rules*”



9. This Court has heard learned counsel for the parties as also perused the pleadings along with the relevant documents filed in support thereof.

10. The prescribed time and manner for issuance of Form O-3 Notice are set out in *Rule 64(1)* of the TM Rules, wherein it is mandated that where no renewal application along with the prescribed fee has been received, the Registrar shall issue a written Form O-3 Notice to the registered proprietor(s) of the trademark, at least one month and not more than three months before the date of expiration of the registration.

11. In fact, the issuance of notice under *Section 25(3)* of the TM Act read with *Rule 64(1)* of the TM Rules is a mandatory precondition before removal of a trademark from the Register, as held in a consistent line of judicial precedents of this Court as well as by various other Hon'ble High Courts. In this regard, the Hon'ble Division Bench of this Court in ***Union of India v. Malhotra Book Depot***⁶, while dealing/ interpreting *Section 25* of the earlier Trade and Merchandise Marks Act, 1958, which is akin to *Section 25* of the TM Act, held as under:

“13. Even otherwise, on a plain reading of Section 25, the inescapable conclusion is that though the period of registration was prescribed as seven years, renewable from time to time on application in the prescribed manner within the prescribed time [under Sub-Sections (1) & (2)] but the removal of the mark from the register has been made subject to sending of a notice in the prescribed manner calling upon the registered proprietor to renew the mark and permitted only upon the failure of the registered proprietor to do so [under Sub-Section (3)] and not merely on the failure of the registered proprietor to apply for renewal within the prescribed time.

*14. The Supreme Court, though in the context of a Rent Legislation, in *E. Palanisamy v. Palanisamy*(2003) 1 SCC 123 reiterated in *Sarla Goel v. Kishan Chand*(2009) 7 SCC 658, emphasized the importance of following the statutory procedure step by step and held an earlier*

⁶2013 SCC OnLine Del 828



step to be a precondition for the next step and it being impermissible to straightaway jump to the last step. It was further held that the last step can come only after the earlier step has been taken. The Trade Marks Act is an Act for the benefit of the proprietors of trademarks (refer Thukral Mechanical Works v. P.M. Diesels Pvt. Ltd. (2009) 2 SCC 768). When the Act itself has prescribed the procedure for removal, we do not find any justification for holding the said procedure to be not mandatory or not binding on the Registrar or to uphold the removal even if such procedure is not followed. We are here concerned with the legislative interpretation and cannot be guided by the consequences as argued by the counsel for the appellants, which may follow as a result of the said interpretation. Where the statute is clear, the Court has to give effect to the right created and should not restrict that right merely in order to minimize litigation. It has been held in Coal India Ltd. v. Saroj Kumar Mishra (2007) 9 SCC 625 that legislative interpretation cannot be rejected merely for the reason of opening the floodgates of applications or litigations.

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16. Section 25(3) providing for sending of a notice prescribes removal of the trademark only if at the expiration of the time prescribed in the notice, the conditions required therein to be fulfilled have not been complied. The Supreme Court recently in Head Master, Lawrence School Lovedale v. Jayanthi Raghu AIR 2012 SC 1571 held that the use of the word if is meant to indicate a condition. Thus, Section 25(3) cannot be interpreted as permitting removal without the condition of sending of notice being complied with. Earlier also, a Full Bench of the Punjab & Haryana High Court in Harbans Singh v. State of Punjab AIR 1987 P & H 19 held that the word if is always expressive of a condition... ..”

[Emphasis supplied]

12. The Hon’ble Division Bench of Bombay High Court in ***Cipla Ltd. v. Registrar of Trade Marks and another***⁷ and ***Kleenage Products (India) Private Limited v. Registrar of Trade Marks and Others***⁸ as also co-ordinate benches of this Court in ***Promoshirt SM. (P) Ltd. v. Registrar of***

⁷2013 SCC OnLine Bom 1270

⁸2018 SCC OnLine Bom 46



*Trade Marks*⁹, *Malhotra Book Depot v. Union of India*¹⁰, *Gopal Ji Gupta v. Union of India*¹¹, *Ashok Bhutani v. The Registrar of Trade Marks & anr.*¹² have consistently reiterated the settled legal position that the mere expiration of a trademark registration by lapse of time and/ or failure of registered proprietor(s) to get it renewed does not *ispo facto* justify its removal from the Register. Such removal must be preceded by strict compliance with the mandatory requirement of sending of Form O-3 Notice by the Registrar, notifying the registered proprietor(s) of the impending expiration of the registration and conditions for its renewal.

13. In the present facts, it is an admitted case that the petitioner filed



application no.627446 for the registration of trademark MILTON/ under *Class 9* of the TM Act on 06.05.1994. It is also an admitted position that since the Registration Certificate was subsequently issued on 30.05.2003, which was valid until 06.05.2004. However, as evident from the reply of the respondent to the petitioner's RTI application, the respondent did not issue the mandatory Form O-3 Notice in terms of *Section 25(3)* of the TM Act read with *Rule 64(1)* of the TM Rules. Thus, since the petitioner was not informed about the impending expiration of the registration and the conditions for its renewal, the aforesaid trademark was wrongly removed from the Register. Since the respondent did not comply with the mandatory procedural requirement/ precondition, the

⁹ 2024 SCC OnLine Del 7722

¹⁰ 2011 SCC OnLine Del 5086

¹¹ 2019 SCC OnLine Del 7670

¹² W.P.(C)-IPD 22/2024




removal of the trademark MILTON/  from the Register is *ex facie* illegal.

Conclusions:

14. Accordingly, in view of the afore-noted reasoning and analysis, the present writ petition is allowed. The respondent is directed to:

- i. Restore and reinstate the registration of the petitioner's



trademark MILTON/ , bearing application no.627446 in *Class 9* of the TM Act; and

- ii. Upon the petitioner filing appropriate application(s) and fulfilling the prescribed formalities, grant renewal of the aforesaid trademark for the periods 2004-2014, 2014-2024, and 2024-2034, and accordingly issue the certificates of renewal.

15. As such, the present writ petition is disposed of, leaving the parties to bear their own costs.

SAURABH BANERJEE, J.

MAY 27, 2025/R