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

% **Date of Decision: 16th October, 2019**

\+ W.P.(C) 3851/2019 & CM Appls. 17546/2019, 29362/2019

INTELLECTUAL PROPERTY ATTORNEYS ASSOCIATION ..... Petitioner

Through: Mr.C.M. Lall, Senior Advocate with Ms.Nancy Roy and Mr.Rahul Vidhani, Advocates
Mr.Amarjit Singh with Ms.Shubhi Sharma, Advocates for Interveners.

versus

THE CONTROLLER GENERAL OF PATENTS, DESIGNS & TRADE MARKS & ANR ..... Respondents

Through: Mr.Ravi Prakash, CGSC with Mr.Farman Ali, Advocate

CORAM:
HON'BLE MR. JUSTICE J.R. MIDHA

J U D G M E N T (ORAL)

1. The petitioner is aggrieved by the non-speaking orders passed by the Registrar of Trade Marks while refusing applications for registration of Trade Marks in violation of Section 18(5) of the Trade Marks Act.

2. Section 18(5) of the Trade Marks Act mandates the Registrar to record in writing the grounds for refusal or conditional acceptance of the application for registration of Trade Marks. Section 18 of the Trade Marks Act is reproduced hereunder:-

"***Section 18—Application for registration***

(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark.

(2) A single application may be made for registration of a trade mark for different classes of goods and services and fee payable therefor shall be in respect of each such class of goods or services.

(3) Every application under sub-section (1) shall be filed in the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the applicant or in the case of joint applicants the principal place of business in India of the applicant whose name is first mentioned in the application as having a place of business in India, is situate: Provided that where the applicant or any of the joint applicants does not carry on business in India, the application shall be filed in the office of the Trade Marks Registry within whose territorial limits the place mentioned in the address for service in India as disclosed in the application, is situate.

(4) Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit.

(5) In the case of a refusal or conditional acceptance of an application, the Registrar shall record in writing the grounds for such refusal or conditional acceptance and the materials used by him in arriving at his decision."

(Emphasis Supplied)

3. Learned senior counsel for the petitioner urged at the time of the hearing that Section 18(5) of the Trade Marks Act, 1999 mandates the Registrar to record in writing the ground for refusal/conditional acceptance and the material used by him in arriving at his decision and the same has to be communicated to the applicant forthwith. It is submitted that Rule 36 of the Trade Marks Rules, 2017 is violative of Section 18(5) insofar as it provides for sending the copy of the order to the applicant without the grounds for refusal/conditional acceptance. It is submitted that Rule 36 is inconsistent with the mandatory provision of Section 18(5) of the Trade Marks Act and the Registrar of Trade Marks be directed to send the copy of the order containing the grounds of refusal/conditional acceptance to the applicant.

4. Learned Standing Counsel fairly submits that the Registrar of Trade Marks has to comply with Section 18(5) of the Trade Marks Act, 1999. Learned counsel however submits that Rule 36 of Trade Marks Rules provides that the Registrar shall communicate the decision in writing to the applicant and if the applicant intends to appeal from such decision, he may apply within 30 days in Form TM-M to the Registrar whereupon the grounds of refusal/conditional acceptance shall be furnished.

5. This Court is of the view that the Registrar of Trade Marks is duty bound to send the 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 his decision to the applicant. Rule 36 of the Trade Marks Rules is arbitrary, unreasonable and inconsistent with the mandatory provision of the statute insofar as it empowers the Registry to communicate the decision without the grounds for refusal/conditional

acceptance. In that view of the matter, Section 18(5) of the Trade Marks Act shall prevail over Rule 36 of the Trade Marks Rules.

6. The writ petition is allowed and the Registrar of Trade Marks is directed to strictly implement Section 18(5) of the Trade Marks Act by recording in writing grounds for refusal/conditional acceptance and the order containing the grounds of refusal/conditional acceptance be sent to the applicant within two weeks of the passing of the order.

7. This Court appreciates the assistance rendered by learned counsel for all the parties in this matter.

8. The pending applications are disposed of.

9. Copy of this judgment be given *dasti* to counsel for the parties under the signature of the Court Master.

J.R. MIDHA, J.

OCTOBER 16, 2019
ak/dk