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

Date of Decision: 22nd November, 2023

+ **W.P.(C)-IPD 18/2022**

LAXMI KOHLU GHAR THROUGH
ITS PARTNER SH ARUN KUMAR

..... Petitioner

Through: Mr. Himanshu Arora, Mr. Gaurav
Arora, Mr. Kamal Kishore Arora
and Ms. Smriti Arora Advs. (M.
9888540772)

versus

CONTROLLER GENERAL OF PATENTS
DESIGNS AND TRADE MARKS AND
REGISTRAR OF TRADE MARKS & ORS.

..... Respondents

Through: Mr. Asheesh Jain, CGSC with Mr.
Gaurav Kumar and Ms Prerna Dhall,
Advs. R- 1 to 3 (M. 9811125100).

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.
2. The present petition, filed by the Petitioner-Laxmi Kohlu Ghar, under Article 226, seeks various directions to Respondent No. 2-Trade Mark Registry, in relation to prosecution of trade mark applications and compliance of directions issued by the Court. The Petitioner's grievance is that the reasons for the orders passed by the Trade Mark Office, whether accepting or directing the advertisement of a mark, are not made publicly available.



3. Specifically, the Petitioner is aggrieved with the non-compliance of mandatory directions issued by this Court in '*Jai Bhagwan Gupta vs. Registrar of Trade Marks*' (2020: DHC:1532). Moreover, the Petitioner seeks directions on the following aspects:

- Arbitrary examination processes of new trade mark applications.
- Mechanical and reckless acceptance of false, frivolous, and undeserving trade mark applications without valid reasons.
- Opaque acceptance, refusal, or advertising of applications without disclosing reasons online.
- Neglecting the maintenance of purity of the Register of Trade Marks.

4. The Petitioner has been in business since 1953, dealing in various edible oils, oil cakes, animal foodstuff, and related goods and services. Since its inception in 1953, the Petitioner states that it has consistently used the mark 'LAXMI', derived from the name 'LAXMI NARAIN KUMAR', the founder-proprietor of the firm. They have also used the trade name 'LAXMI KOHLU GHAR' (also known as 'LAXMI OIL MILLS'). According to the Petitioner, it is the first and prior adopter of the 'LAXMI' mark.

5. The Petitioner claims to possess statutory rights over the mark 'LAXMI' under the Trade Marks Act, 1999. The Petitioner claims to have registered the mark 'LAXMI' under registration nos. 226891, 382518, 994330 and 2026782. In addition, the Petitioner also holds copyright for the artistic works underlying the mark 'LAXMI', bearing registration nos. *A-32338/81* and *A-128775/2019* registered under the Copyright Act, 1957.



6. Vide order dated 4th July, 2023, this Court directed Mr. Jain, Id. Counsel to seek instructions in the present petition. Further, this Court gave liberty to the Respondents to file their respective rebuttal documents.

7. An affidavit dated 6th December 2022 has been filed on behalf of the Respondent No. 1 *i.e.*, by Mr. Vikas Punia, Head of Office Trade Mark Registry, Delhi. According to the said affidavit, the stand of the Trade Mark Registry is that reasons for accepting or directing the advertisement of a mark under Section 20 of the Trade Marks Act, 1999 are recorded in an internal note sheet maintained by the Registry. The said note sheet may be given upon the filing of an RTI application by the Applicant or any other concerned party.

8. On the other hand, Id. Counsel for the Petitioner has brought to the notice of this Court the directions issued in *Jai Bhagwan Gupta (supra)*, which reads as under:-

“9. In recent times it is noticed, that almost all the trademarks are being advertised before acceptance under the Proviso to Section 20(1) of the Act. Such a procedure would be contrary to the Act, inasmuch as there is application of mind which is required to be exercised by the Registrar of Trademarks, prior to the mark being advertised. Under Section 20(1), there has to be a reason why the Registrar of Trademarks is directing advertisement before acceptance’ and the same cannot be a ministerial act or a mere formality. The application of mind, prior to acceptance or advertisement before acceptance, has to be deliberate and conscious and the provisions of the Act would have to be considered by the Registrar in a conscious manner. Marks that do not deserve advertisement ought not to be advertised before acceptance. The



automatic or indiscriminate advertisement of trade mark applications tends to increase the burden upon the applicants to keep a watch on the Trade Marks Journal and also to oppose, leading to heavy costs to maintain trademark rights which are granted under the Act. Thus, it is not proper and is impermissible for the Registrar of Trademarks to direct advertisement of a majority of marks, before acceptance, under the proviso to Section 20(1) of the Act. A specific order would have to be passed as to the reason why the mark is being advertised after acceptance or the reason why the mark is being advertised before acceptance. The order need not be detailed but ought to exist on file, even if, very brief. The burden of the Registrar of Trademarks to examine marks as per the provisions of the Act and Rules, cannot be completely shifted upon the applicants/proprietors/owners of the trademarks. Such a procedure would result in completely ignoring the provisions of Act itself, which is impermissible. The Registrar has to maintain the purity of the Register.

10. It is, accordingly, directed that the Registrar of Trademarks shall ensure that whenever marks proceed for advertisement, a specific brief order is passed under Section 20(1) after acceptance for advertisement or under exceptional circumstances - under the proviso to Section 20(1) for advertisement before acceptance. All marks ought not to be permitted to proceed for advertisement and thereafter for registration.”

9. The above directions have also been reiterated by the Id. Coordinate Bench of this Court in *Kaira District Cooperative Milk Producers Union Ltd and Another v. Registrar of Trademarks and Others (2023 SCC OnLine Del 1730)* which reads as under:-



“28. Mr. Abhishek Singh points out that a coordinate Bench of this Court, in its judgment in Jai Bhagwan Gupta v. Registrar of Trade Marks laid down certain guidelines to be followed by the officers in the Registry of Trade Marks while dealing with applications seeking registration. The said order continues to hold the field and, therefore, needless to say, these guidelines would be binding on the Registrar of Trade Marks and the officers functioning within the Registry of Trade Marks. The said order requires a "brief order" to be passed by the Registrar under Section 20(1) of the Trade Marks Act. The said direction would, therefore, supplement the present judgment.”

10. As per the above two judgments, a brief order should be passed at the time of acceptance or rejection of the mark. It is doubtful whether such an order can be called as an internal note sheet. Ordinarily, a brief order should be available on the online portal of the Trade Mark Registry for litigants’ reference. However, if the same is not uploaded for all applications, a copy of the brief order should still be made available upon request via email. The need for filing an application under the RTI Act, 2005 appears to be unnecessarily onerous.

11. On this issue, Mr. Asheesh Jain, Id. CGSC wishes to seek instructions. Insofar as the Petitioner’s prayer that in every trademark application consisting of the word mark ‘LAXMI’, the Petitioner’s mark ought to be cited, the procedure for citing of marks would be governed by Section 9 and 11 of the Trade Marks Act, 1999. Needless to add, whenever an examination takes place, if there are identical or similar marks to the Petitioner’s ‘LAXMI’ mark, as per section 11 of the Trade Marks Act, 1999, the requisite procedure, in accordance with law, would have to be followed.



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No specific direction can be issued in favour of any specific proprietor in the manner as is being sought by the Petitioner.

12. List for further submissions on 25th January, 2024.

PRATHIBA M. SINGH
JUDGE

NOVEMBER 22, 2023

mr/dn