
(2025) 05 DEL CK 0861

In the Delhi High Court

Case No : C.A.(COMM.IPD-TM) No. 1 Of 2023 with I.A.No. 1530, 1532, 26186 Of 2023

Romil Gupta Trading As Sohan Lal Gupta

APPELLANT

Vs

Registrar Of Trade Marks & Anr

RESPONDENT

Date of Decision : 14-05-2025

Acts Referred:

Trade Marks Act, 1999 — Section 11, 57(4), 91
Trade Marks Rules, 2017 — Rule 37, 100, 100(1)

Citation : (2025) 05 DEL CK 0861

Hon'ble Judges : Amit Bansal, J

Bench : Single Bench

Advocate : Sanjeev Sindhwani, Rajat Bhardwaj, Sandeep Khatri, Gaurav Sindhwani, Shivani Negi, Ujjwal Bhardwaj, Nidhi Raman, Debasish Mishra, R. Venkat Prabhat, Kamna Behrani, Ansh Kalra, Divyanshu Sinha, J. Sai Deepak, Vipin Wason, Stuti Wason, Avinash Sharma, Sanjay Pandita

Final Decision : Allowed

Judgement

Amit Bansal, J.

1. The present appeal has been preferred by the appellant under Section 91 of the Trade Marks Act, 1999 (hereinafter 'Act') assailing the order dated 15th December 2022 passed by the respondent no.1 (hereinafter 'impugned order') vide which the registration of the trade mark (hereinafter 'subject mark') bearing no. 3986970 in class 6 in the name of the appellant has been cancelled.

BRIEF FACTS

2. Brief undisputed facts relevant to the present appeal are as follows:

2.1. The appellant, engaged in the business of manufacturing and trading of self-tapping metal screws and self-drilling screw, is the bona fide user of the subject mark since 2013.

2.2. The appellant filed a trade mark application bearing no. 3986970 in class 6 on 30th October 2018 with a user claim since 27th February 2013 (hereinafter 'subject application').

2.3. The respondent no.1 issued the examination report dated 26th November 2018 raising objections under Section 11 of the Act. The appellant filed a reply to the examination report on 13th December 2018 wherein the appellant made references to use of the subject mark since 2013. 2.4. The appellant claims that inadvertently, instead of the subject mark, the mark (hereinafter 'applied mark') was applied for in the subject application. The appellant, upon realizing this clerical error in the subject application, filed an application on 13th December 2018 for correction of the clerical error and amendment of the applied mark to the subject mark.

2.5. The subject application proceeded towards registration on 23rd June 2019 and the registration certificate was issued to the appellant in respect of the subject mark.

2.6. The respondent no.2, on 24th July 2019, filed a rectification application against the registration of the subject mark in favour of the appellant. The appellant filed his counter statement dated 30th September 2019 to the rectification application.

2.7. Meanwhile, the respondent no.2 also filed a suit for permanent injunction against the appellant wherein, vide order dated 7th September 2019, an ex-parte ad interim injunction was granted in favour of the respondent no.2. The aforesaid ex-parte ad interim injunction order was vacated on 3rd October 2019.

2.8. The respondent no.2, on 29th July 2020, filed a complaint before the respondent no.1, with the subject 'regarding irregularities in registration of the Trademark No. 3986970 in the name of Shri Romil Gupta trading as M/s Sohan Lal Gupta', raising an objection for the first time that the amendment sought in the applied mark was substantial in nature and not permissible under Rule 37 of the Trade Marks Rules, 2017 (hereinafter 'Rules'). Another objection taken was that a fresh user affidavit was not filed along with the aforesaid amendment application.

2.9. The respondent no.1 issued a notice dated 31st October 2022 under Section 57(4) of the Act to the appellant in respect of the aforesaid complaint filed by the respondent no.2 giving three weeks' time to the appellant to file written submissions.

2.10. A hearing was held on 17th November 2022 before the respondent no.1 and the same was attended by the appellant and the respondent no.2. Subsequently, the impugned order was passed on 15th December 2022.

3. On 25th January 2023, notices to the respondents were issued in the present appeal and the impugned order was stayed.

SUBMISSIONS ON BEHALF OF THE PARTIES

4. Submissions made on behalf of the appellant are as follows:

4.1. The notice dated 31st October 2022 was communicated to the appellant vide email dated 1st November 2022 and the hearing was scheduled for 17th November 2022. The respondent no.1 failed to give one month's notice to the appellant, which is mandated under Section 57(4) of the Act and Rule 100 of the Rules. Therefore, the impugned order has been passed contrary to the provisions of the Act and the Rules.

4.2. Section 57(4) has wrongly been invoked by the respondent no.1 as the hearing held on 17th November 2022 was not on account of its own motion but only pursuant to the complaint filed by the respondent no.1.

4.3. In the aforesaid notice, the ground taken for cancellation was 'substantial alteration' of the applied mark. However, the impugned order goes beyond the aforesaid ground while directing the cancellation of registration the subject mark.

4.4. No explanation or finding has been provided in the impugned order as to how the amendment sought by the appellant results in a 'substantial alteration' in the applied mark.

4.5. The size and font of the letters 'SD' had not been changed and the amendment was sought to the limited extent of inverting the letters 'SD' in the applied mark. Therefore, there was no substantial change/ alteration in the subject mark as compared to the applied mark in terms of Rule 37 of the Rules.

4.6. The amendment sought by the appellant was necessitated on account of a clerical error that the letters 'SD' in the applied mark had been written horizontally instead of vertically. Therefore, no fresh user affidavit was required to be filed along with the amendment application.

5. Submissions made on behalf of the respondent no.2 are as follows:

5.1. The appellant did not raise any objection before the respondent no.1 that the aforesaid notice did not give time of at least one month from the date of the said notice and is now raising this objection at a belated stage.

5.2. By attending the hearing and making submissions before the respondent no.1 without raising the aforesaid objection, the appellant has waived his right to object to the notice period given by the respondent no.1.

5.3. By virtue of the amendment, the appellant sought 'substantial alteration' in the visual representation of the applied mark which is impermissible under Rule 37 of the Rules. Therefore, the amendment application filed by the appellant was erroneously allowed by the respondent no.1.

5.4. It can be inferred from a comparison of the applied mark with the subject mark that size of the letters 'SD' has also been enlarged in the subject mark. Therefore, there was no clerical error in the subject application but the

amendment sought by the appellant was a 'substantial alteration' of the applied mark.

5.5. The appellant failed to file any documents with the subject application or during the rectification proceeding to establish his use of the subject mark since 2013. Further, the documents filed by the appellant with the present appeal to show use of the subject mark are forged.

5.6. The appellant also failed to file a fresh user affidavit along with the amendment application despite making a substantial change in the applied mark.

5.7. There is no provision under the Act and the Rules barring any person who has initiated rectification proceedings and/ or a civil suit for injunction from bringing to the attention of the respondent no.1 any procedural lapse leading to improper registration of a mark.

5.8. There is no bar on the Registrar of Trade Marks to invoke its suo moto powers even during the pendency of any other proceedings. Likewise, any proceeding under Section 57(4) of the Act is a remedy independent of any other proceedings occurring parallelly before the respondent no.1. Therefore, any pending suit/ rectification proceeding before any forum does not have any bearing on the validity/ legality of the proceedings under Section 57(4) of the Act.

ANALYSIS AND FINDINGS

6. At the outset, it needs to be highlighted that the impugned order was passed by the respondent no.1 invoking its suo moto powers under Section 57(4) of the Act. The impugned order was preceded by the notice dated 31st October 2022 calling upon the appellant to show cause as to why the registration granted in his favour should not be cancelled. The aforesaid notice gave an opportunity to the appellant to file response/ submissions within 21 days and called upon him to be present for hearing on 17th November 2022.

7. The relevant extract of the notice dated 31st October 2022 is set out below:

"This is to inform that a complaint dated 23.07.2020 received in this office regarding improper registration of the trademark No. 3986970.

Prima facie, it appears that the trademark was applied as with user claim since 27/02/20213, however, substantial alteration of the trademark and subsequent registration thereof with the same user claim was allowed contrary to the provisions of the Trade Marks Act, 1999 and Rules framed thereunder.

Therefore, a notice under section 57 (4) of the Trade Marks Act, 1999 is hereby issued as to why the registration of the aforesaid trademark should not be cancelled being contrary to the provisions of the law.

Hereby, an opportunity is given to you to make submissions, if any, within 21 days hereof as also to be present for hearing on 17.11.2022 before the Registrar of Trade Marks at Trade Marks Registry, IPO Building, Plot No. 32, Sector 14,

Dwarka, Delhi failing which appropriate orders shall be passed in the matter.”

[emphasis supplied]

8. The aforesaid notice was in clear violation of the mandate of Rule 100 of the Rules which provides that the Registrar of Trade Marks is required to give at least one month’s notice under Section 57(4) of the Act.

9. For the ease of convenience, Rule 100(1) of the Rules is set out below:

“100. Rectification of the register by the Registrar of his own motion – (1) The Notice, which the Registrar is required to issue under sub-section (4) of section 57, shall be sent in writing to the registered proprietor, to each registered user, if any, and to any other person who appears from the register to have any interest in the trademark, and shall state the grounds on which the Registrar proposes to rectify the register and shall also specify the time, not being less than one month from the date of such notice, within which an application for a hearing shall be made.”

[emphasis supplied]

10. Clearly, the aforesaid notice was not only in violation of the provisions of the Act, but was also against the principles of natural justice. By virtue of the said notice, the respondent no.1 was seeking to cancel the registration granted in favour of the appellant more than three years back. Therefore, it was only fair that the respondent no.1 gave to the appellant the bare minimum time prescribed under the statute to put forward his case. Surprisingly, the respondent no.1 did not even stick to the three weeks’ time given for filing response and fixed the date of hearing within 17 days from the date of the aforesaid notice.

11. Counsel for the respondent no.2 submits that the appellant never took this objection in the hearing before the respondent no.1. In my considered view, the requirements and timelines prescribed under Rule 100 of the Rules are mandatory. There cannot be any question of waiver of such requirements and timelines by the appellant. Therefore, I do not find any merit in the aforesaid ground taken by the respondent no.2.

12. From a perusal of the notice, it is evident that the notice was issued only on account of a complaint filed by the respondent no.2, who had already filed a rectification petition seeking cancellation of the registration of the subject mark in favour of the appellant on 24th July 2018, and had also initiated a civil suit against the appellant.

13. The notice was premised on the ground that there was ‘substantial alteration’ of the applied mark in the subject mark. However, a reading of the impugned order would show that there is no finding on the ‘substantial alteration’ carried out by the appellant despite recording the appellant’s submission that there has been no substantial change in the subject mark consequent to the amendment.

14. The impugned order proceeds on the basis that the subject mark,

subsequent to the amendment, was advertised without seeking any clarification or asking any explanation from the appellant about the amendment sought by him and also without seeking a fresh affidavit and documents in respect of the appellant's alleged user claim for the subject mark. To be noted, requirement of a fresh user affidavit to establish the user claim in respect of the subject mark since 27th February 2013 was not mentioned in the notice issued by the respondent no.1 as a ground for cancellation of the registration. If the respondent no.1 was of the view that the appellant had not filed a fresh user affidavit along with documents in support of his user claim in respect of the subject mark since 27th February 2013, it should have called upon the appellant to furnish such affidavit and/ or documents. The notice issued by the respondent no.1 never called upon the appellant to file a fresh user affidavit or documents to evidence his use of the subject mark since 27th February 2013.

15. The moot issue to be considered by the respondent no.1 was whether there was any 'substantial alteration' in the subject mark by the appellant, which the respondent no.1 failed to consider.

16. The amendment carried out by the appellant in the present case was that the two letters 'S' and 'D' were originally placed horizontally in the applied mark, which were subsequently placed vertically by way of the amendment. The subject mark continued to have the same four letters 'S', 'D', 'H' and 'P' wherein the letters 'S' and 'D' continued to be in smaller font as compared to the letters 'H' and 'P'. By no stretch of imagination can this be termed as 'substantial alteration'.

17. It is also to be noted that the appellant filed the amendment application along with the reply to the examination report issued by the respondent no.1, i.e., immediately after filing the subject application. Therefore, there was no inordinate delay on the part of the appellant in filing the amendment application. The amendment sought by the appellant was in accordance of the provisions of the Act and the same was duly allowed by the respondent no.1 in terms of Rule 37 of the Rules.

18. The impugned order, in effect, seeks to set aside the amendment that was allowed in favour of the appellant. However, the same could not have been done by the respondent no.1 without following the prescribed timelines provided in the statute. Further, the respondent no.1 also erred in passing the impugned order on the basis of grounds which were not even mentioned in the notice issued to the appellant.

19. In view of the discussion above, the impugned order passed by the respondent no.1 is unsustainable, and the same is set aside. Consequently, the present appeal stands allowed.

20. Needless to state, the observations made herein would have no bearing on the rectification petition filed by the respondent no.2 seeking cancellation of registration of the subject mark in the name of the appellant.

21. All pending applications stand disposed of.

22. The Registry of this Court is directed to supply a copy of the present order to the Office of the Controller General of Patents, Designs and Trade Marks on e-mail ID - llc-ipo@gov.in, for compliance.