IN THE HIGH COURT OF KERALA AT ERNAKULAM

PRESENT

THE HONOURABLE MR.JUSTICE MURALI PURUSHOTHAMAN

THURSDAY, THE 30TH DAY OF MARCH 2023 / 9TH CHAITHRA, 1945

WP(C) NO. 42552 OF 2018

PETITIONER/S:

ANZAR M.A., AGED 47 YEARS
TRADEMARK ATTORNEY (CODE 3699),
S/O. ABDUL KAREEM, LAW DESK INDIA,
GROUND FLOOR, LEAGUE HOUSE, MARKET ROAD,
NORTH, ERNAKULAM ,KERALA-682018.

BY ADVS.
R.MANOJ
SRI.P.SREEKUMAR
SHRI.S.GANESH

RESPONDENT/S:

1 THE REGISTRAR OF TRADE MARKS,
INTELLECTUAL PROPERTY BUILDING,
O.S.T. ROAD, GUINDY, CHENNAI-600032.

2 THE CONTROLLER GENERAL OF TRADE MARKS,
PATENT AND DESIGNS, OFFICE OF THE CONTROLLER GENERAL OF PATENTS, DESIGNS AND TRADE MARK,
BHOUDHIK SAMPATHA BHAVAN, ANTOP HILL,
S.M.ROAD, MUMBAI-400087.

BY ADVS.
SRI.SUVIN R.MENON, CGC
SMT.C.G.PREETHA, CGC

THIS WRIT PETITION (CIVIL) HAVING COME UP FOR ADMISSION ON 30.03.2023, THE COURT ON THE SAME DAY DELIVERED THE FOLLOWING:

JUDGMENT

The petitioner, a legal practitioner and a registered Trade Marks Attorney, had submitted 47 applications in respect of his clients for registration of Trade Marks. The petitioner states that in terms of Rule 33 of the Trade Marks Rules, 2017 (hereinafter referred to as 'the Rules' for short), the Registrar of Trade Marks shall cause the applications to be examined as per the provisions of the Trade Marks Act, 1999 (hereinafter referred to as 'the Act' for short) and if on consideration of the application, the Registrar has any objection to the acceptance of the application, the Registrar shall communicate such objection in writing to the applicant in the form of an examination report, and the applicant has to respond to the examination report within one month of its receipt. If the applicant fails to respond to the communication, the Registrar may treat the application as abandoned. According to the petitioner,

all the 47 applications submitted by him were treated as abandoned by the Registrar, the 1st respondent, as per Exts.P1 to P47 orders dated 30.11.2018 and 01.12.2018 and Ext.P1 order reads thus:

> **" ORDER**
>
> The abovementioned application was examined and the examination report mentioned therein the objections(s) to acceptance of the application for registration of the trademark was posted on the official website and was also sent on 23.04.2018 to the applicant/applicant's authorized agent. The response to the examination report was required to be submitted on behalf of the applicant within one month from the date of receipt of the examination report.
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> It was clearly mentioned in the examination report that if no reply is received or a request for a hearing is applied for within the above mentioned stipulated time, the said application shall be treated to have been abandoned for lack of prosecution under Section 132 of the Trade Marks Act, 1999 and thereafter the status of the application in the computer database shall reflect the factual position. However no response to the examination report has been received so far either mentioning the applicant's comments on office objections or requesting for hearing.
>
> The abovementioned application is therefore deemed to have been abandoned under Rule 33(4) of the Trade Marks Rules, 2017 and the status of the application is changed accordingly in the records of the Trade Marks Registry.

Dated: 30/11/2018 For Registrar of Trade Marks."

2. According to the petitioner, he has not received the examination reports in the above applications and the applications cannot be treated as abandoned. The petitioner states that all the 47 orders are similarly worded and are contrary to the provisions contained under Section 132 of the Act and in violation of the principles of natural justice. The petitioner states that the 1st respondent has not given any notice to remedy the default before treating the application as abandoned. On coming to know about the examination reports, he filed replies, but the applications were by the time abandoned by the 1st respondent. That apart, the petitioner points out that, though all the 47 applications were abandoned, the 1st respondent later issued Ext.P58 certificate of registration in respect of Ext.P45 rejection order. According to the petitioner, the same shows non-application of mind and pick and choose

policy on the part of the 1st respondent in considering the applications. The petitioner states that, since the examination reports are not duly communicated to him, the applications cannot be treated as abandoned and therefore, seeks to quash Exts.P1 to P47 abandonment orders and also to declare Rule 33(4) of the Rules as void being *ultra vires* Section 132 of the Act.

3. The respondents have filed a counter affidavit stating that examination reports containing objections were sent to the applicant/applicant counsel by e-mail. A true copy of the details of e-mail dispatch dates, reply received dates, and application abandonment dates has been produced as Ext. R1 (a) along with the counter affidavit. It is stated that, as per the provisions of Section 128 of the Act and Rule 33 of the Rules, before an adverse order is passed, opportunity of hearing should be given only in cases where reply to the examination report is filed or the applicant/petitioner has made a request for hearing within

the prescribed time and not in cases where no such request is made or reply not filed. It is also contended that the petitioner has an alternate remedy of review under section 127 (c) of the Act.

4. Heard Sri. P.Sreekumar, learned Counsel for the petitioner and Sri.Suvin R.Menon, learned CGC appearing for the respondents.

5. The applications have been treated as abandoned by the 1st respondent under Rule 33(4) of the Rules on the ground that the applicants failed to respond to the examination reports within the time stipulated. In Exts.P1 to P47 orders, it is stated that the examination reports were posted on the official website of the 1st respondent and were also sent to the applicant/ applicant's authorized agent. In the counter affidavit filed on behalf of the respondents, it is stated that the examination reports were sent to the applicant/applicant counsel by e-mail. A typed copy of the details of e-mail dispatch dates has been given

in the counter affidavit. No other details of communication of examination reports have been given in the counter affidavit. The specific case of the petitioner is that he has not received the examination reports by e-mail as claimed by the respondents. The petitioner contends that Exts.P1 to P47 orders, treating the applications as abandoned, are in total violation of Section 132 of the Act and Rule 33(4) of the Rules. Section 132 of the Act reads as under:

> **"132. Abandonment**
>
> Where, in the opinion of the Registrar, an applicant is in default in the prosecution of an application filed under this Act or any Act relating to trade marks in force prior to the commencement of this Act, the Registrar may, by notice require the applicant to remedy the default within a time specified and after giving him, if so, desired, an opportunity of being heard, treat the application as abandoned, unless the default is remedied within the time specified in the notice."

6. Rule 33 of the Rules reads as follows:

> "33. Examination, Objection to acceptance, hearing.-
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> (1) The Registrar shall cause the application to be examined as per provisions of the Act, wherein a search shall also be conducted among the earlier trademarks,

registered or applied for registration, for the purpose of ascertaining whether there are on record in respect of the same goods or services or similar goods or services any trademark identical with or deceptively similar to the trademark applied for. The Registrar may cause the re-examination of the application including re-search of earlier trademarks at any time before the acceptance of the application but shall not be bound to do so.

(2) If, on consideration of the application for registration of a trademark and any evidence of use or of distinctiveness or of any other matter which the applicant may or may be required to furnish, the Registrar has any objection to the acceptance of the application or proposes to accept it subject to such conditions, amendments, modifications or limitations as he may think fit to impose under subsection (4) of section 18, the Registrar shall communicate such objection or proposal in writing to the applicant in the form of an examination report.

(3) If on consideration of the application for registration of a trademark and any evidence of use or of distinctiveness or of any other matter which the applicant may or may be required to tarnish, the Registrar accepts the application for registration absolutely, he shall communicate such acceptance to the applicant and cause the application to be advertised as accepted under sub-section (1) of section 20.

(4) If within one month from the date of receipt of the examination report, the applicant fails to respond to the communication, the Registrar may treat the application as abandoned.

(5) In case the response to the examination report is received within the aforesaid time, the same shall be duly considered and if the Registrar accepts the application for registration, he shall communicate such acceptance to the

> applicant and cause the application to be advertised as accepted under sub-section (1) of section 20.
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> (6) If the response to the examination report is not satisfactory or where the applicant has requested for hearing, the registrar shall provide an opportunity of hearing to the applicant and the same shall be conducted as per rule 115.
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> (7) In case the applicant fails to appear at the scheduled date of hearing and no reply to the office objection has been submitted by the applicant, the Registrar may treat the application as abandoned.
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> (8) Where the applicant has submitted his reply to the examination report within the aforesaid period or has appeared in the hearing and made his submissions, the Registrar shall pass an appropriate order."
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> *(underlining supplied)*

7. Rule 33(2) of the Rules provides that on examination of the application for registering a trade mark, if the Registrar has any objection to the acceptance of the application, the Registrar shall communicate such objection in writing to the applicant in the form of an examination report. The Rules mandate that the objection or proposal shall be in writing and the same shall be communicated to the applicant. Rule 33(4) of the Rules provides that if, within one month from the date of receipt of the

examination report, the applicant fails to respond to the communication, the Registrar may treat the application as abandoned. The date of receipt of examination report by the applicant is significant as the application can be treated as abandoned only when the applicant fails to respond to the communication. In Exts.P1 to P47, it is stated that the examination reports were posted on the official website of the 1st respondent and were also sent to the applicants/applicants' authorized agent. Though it is stated that the examination reports were sent to the applicants/applicants' authorized agent, the mode of communication was not stated in the said orders. In the counter affidavit, it is stated that the examination reports were sent by e-mail. The petitioner contends that he has not received the examination reports by e-mail. Ext.R1(a) is only a typed copy of the details regarding the date of dispatch of examination reports and the same cannot be treated as conclusive proof of communication of

examination reports and there is no evidence of receipt of the communication by the petitioner. With regard to the posting of the examination reports on the official website of the 1st respondent, a Division Bench of the Bombay High Court in **Institute of Cost Accountants of India Kolkata** v. **Registrar of Trade Marks Mumbai and Another** [2013 KHC 2915 : AIR 2013 Bom. 107] while considering the scope of Rules 38 of the Trade Marks Rules, 2002, which corresponscopeds to Rule 33 of the Trade Marks Rules, 2017 held that, merely placing the examination report on website of the Registrar of Trade Marks does not constitute communication of objection or proposal in writing as required by the Rules. Paragraph 9 of the said decision reads as follows:

> "9.The respondent was bound to communicate any objection or proposal in writing to the applicant. The respondent admittedly did not do so. Placing the notice of the website does not constitute compliance with that R.38(4) of the said Rules. The respondents have not indicated anything that obliged the petitioner to inspect the

> website on a daily basis. Nor did they indicate any rule or practice by which the petitioner was bound legally to take notice of anything that is posted on the respondents' website. R.38(4) by itself does not require an applicant for registration to inspect the respondents' website. The petitioner therefore cannot be imputed with the knowledge of the said letter dated 19.09.2011. The mere posting of the letter on the website does not constitute communication of the objection or proposal in writing as required by R.38(4).”

8. I am in complete agreement with the view taken by the Division Bench of the Bombay High Court in Institute of Cost Accountants (supra). The act of abandonment of an application for registration of a trade mark is an extreme step and has to be taken in unavoidable circumstances after due communication of default to the applicant/agent. When there is no communication of the examination report, the respondents cannot contend that opportunity of being heard can be afforded only on request by the applicant. I find that there is no communication of examination reports to the petitioner and the applications cannot be treated as

abandoned. Exts.P1 to P47 orders are set aside. The 1st respondent is directed to restore the applications of the petitioner (other than application No.3681967) and to proceed in accordance with law. The same shall be done within a period of two months from the date of receipt of a copy of this judgment.

The writ petition is disposed of. There will be no order as to costs.

Sd/-
MURALI PURUSHOTHAMAN
JUDGE

SB

APPENDIX OF WP(C) 42552/2018

PETITIONER EXHIBITS

EXHIBIT P1	TRUE COPY OF ORDER BEARING NO.3642533 DATED 30.11.2018
EXHIBIT P2	TRUE COPY OF ORDER BEARING NO.3665231 DATED 30.11.2018
EXHIBIT P3	TRUE COPY OF ORDER BEARING NO.3662409 DATED 30.11.2018
EXHIBIT P4	TRUE COPY OF ORDER BEARING NO. 3661781 DATED 30.11.2018
EXHIBIT P5	TRUE COPY OF ORDER BEARING NO. 3782717 DATED 30.11.2018
EXHIBIT P6	TRUE COPY OF ORDER BEARING NO.3660780 DATED 30.11.2018
EXHIBIT P7	TRUE COPY OF ORDER BEARING NO.3660707 DATED 30.11.2018
EXHIBIT P8	TRUE COPY OF ORDER BEARING NO.3660706 DATED 30.11.2018
EXHIBIT P9	TRUE COPY OF ORDER BEARING NO.3825469 DATED 30.11.2018
EXHIBIT P10	TRUE COPY OF ORDER BEARING NO.3818269 DATED 30.11.2018
EXHIBIT P11	TRUE COPY OF ORDER BEARING NO.3650252 DATED 30.11.2018
EXHIBIT P12	TRUE COPY OF ORDER BEARING NO.3815823 DATED 30.11.2018
EXHIBIT P13	TRUE COPY OF ORDER BEARING NO.3810416 DATED 30.11.2018
EXHIBIT P14	TRUE COPY OF ORDER BEARING NO.3810403 DATED 30.11.2018
EXHIBIT P15	TRUE COPY OF ORDER BEARING NO. 3801453 DATED 30/11/2018
EXHIBIT P16	TRUE COPY OF ORDER BEARING NO. 3801444 DATED 30.11.2018
EXHIBIT P17	TRUE COPY OF ORDER BEARING NO. 2846923 DATED 30.11.2018
EXHIBIT P18	TRUE COPY OF ORDER BEARING NO.2833467 DATED 30.11.2018
EXHIBIT P19	TRUE COPY OF ORDER BEARING NO.2832208 DATED 30.11.2018
EXHIBIT P20	TRUE COPY OF ORDER BEARING NO.2831960 DATED

	30.11.2018
EXHIBIT P21	TRUE COPY OF ORDER BEARING NO.2831308 DATED 30.11.2018
EXHIBIT P22	TRUE COPY OF ORDER BEARING NO. 3799648 DATED 30.11.2018
EXHIBIT P23	TRUE COPY OF ORDER BEARING NO.3767324 DATED 30.11.2018
EXHIBIT P24	TRUE COPY OF ORDER BEARING NO. 3761522 DATED 30.11.2018
EXHIBIT P25	TRUE COPY OF ORDER BEARING NO. 3759115 DATED 30.11.2018
EXHIBIT P26	TRUE COPY OF ORDER BEARING NO.3754496 DATED 30.11.2018
EXHIBIT P27	TRUE COPY OF ORDER BEARING NO.3753110 DATED 30.11.2018
EXHIBIT P28	TRUE COPY OF ORDER BEARING NO.3750197 DATED 30.11.2018
EXHIBIT P29	TRUE COPY OF ORDER BEARING NO.3744164 DATED 30.11.2018
EXHIBIT P30	TRUE COPY OF ORDER BEARING NO. 3721087 DATED 01.12.2018
EXHIBIT P31	TRUE COPY OF ORDER BEARING NO.3719526 DATED 01.12.2018
EXHIBIT P32	TRUE COPY OF ORDER BEARING NO.3714371 DATED 01.12.2018
EXHIBIT P33	TRUE COPY OF ORDER BEARING NO.3713833 DATED 01.12.2018
EXHIBIT P34	TRUE COPY OF ORDER BEARING NO.3713029 DATED 01.12.2018
EXHIBIT P35	TRUE COPY OF ORDER BEARING NO.3706874 DATED 01.12.2018
EXHIBIT P36	TRUE COPY OF ORDER BEARING NO.3702651 DATED 01.12.2018
EXHIBIT P37	TRUE COPY OF ORDER BEARING NO.3702665 DATED 01.12.2018
EXHIBIT P38	TRUE COPY OF ORDER BEARING NO. 3702652 DATED 01.12.2018
EXHIBIT P39	TRUE COPY OF ORDER BEARING NO.3696512 DATED 01.12.2018
EXHIBIT P40	TRUE COPY OF ORDER BEARING NO.3694723 DATED 01.12.2018
EXHIBIT P41	TRUE COPY OF ORDER BEARING NO.3687955 DATED 01.12.2018

EXHIBIT P42	TRUE COPY OF ORDER BEARING NO.3687013 DATED 01.12.2018
EXHIBIT P43	TRUE COPY OF ORDER BEARING NO. 3686985 DATED 01.12.2018
EXHIBIT P44	TRUE COPY OF ORDER BEARING NO. 3683134 DATED 01.12.2018
EXHIBIT P45	TRUE COPY OF ORDER BEARING NO.3681967 DATED 01.12.2018
EXHIBIT P46	TRUE COPY OF ORDER BEARING NO.3679553 DATED 01.12.2018
EXHIBIT P47	TRUE COPY OF ORDER BEARING NO.3676371 DATED 01.12.2018
EXHIBIT P48	TRUE COPY OF THE DETAILS OF DISPOSALS FROM 30.11.2018 TO 1.12.2018
EXHIBIT P49	TRUE COPY OF THE PUBLIC NOTICE DATED 25.6.2018 IN RESPECT OF THOSE APPLICATIONS WERE EXAMINATIONS WERE COMPLETED BEFORE THE 31.12.2017
EXHIBIT P50	TRUE COPY OF THE JUDGMENT OF THE HON'BLE HIGH COURT OF DELHI IN WP(C) NOS. 7084, 7085 AND 7087 DATED 28.11.2013.
EXHIBIT P51	TRUE COPY OF THE JUDGMENT IN WRIT PETITION NO.2088/2012 ON THE FILES OF THE HIGH COURT OF BOMBAY DATED 1.3.2013.
EXHIBIT P52	TRUE COPY OF THE REPRESENTATION SUBMITTED BY THE PETITIONER TO THE 1ST RESPONDENT DATED 3.12.2018
EXHIBIT P53	TRUE COPY OF THE EXAMINATION REPORTS ISSUED BY THE TRADEMARK REGISTRY.
EXHIBIT P54	TRUE COPY OF STATUS GENERATED FROM THE WEBSITE OF THE RESPONDENTS.
EXHIBIT P55	TRUE COPIES OF THE REPRESENTATION OF THE PETITIONER DATED 02.04.2019 ALONG WITH DOCUMENTS.
EXHIBIT P56	TRUE COPY OF THE NOTICE ISSUED BY THE RESPONDENTS U/R 33(7) OF THE TRADEMARKS RULE.
Exhibit P57	A TRUE COPY OF THE COMMUNICATION DATED 25/06/2019 SHOWING THE ACCEPTANCE OF THE TRADEMARK APPLICATION 3681967 INTO THE JOURNAL.
Exhibit P58	A TRUE COPY OF THE CERTIFICATE OF REGISTRATION OF TRADEMARK 3681967.

RESPONDENTS EXHIBITS

EXHIBIT R1(A)	TRUE COPY OF THE DETAILS OF E-MAIL DISPATCH DATE, REPLY RECEIVED DATE AND APPLILCATION ABANDONED.