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

% *Judgement Delivered on: 31.01.2026*

\+ **C.A.(COMM.IPD-TM) 76/2024, I.A. 45128/2024&I.A. 45132/2024**

INNOCENTI SA .....Appellant

versus

EXAMINER OF TRADEMARKS & ANR. .....Respondents

Advocates who appeared in this case

For the Appellant : Mr. Chander M. Lall, Senior Advocate with Dr. Sheetal Vohra, Mr. Rahul Dwivedi, Mr. Sridharan Rajan Ramkumar, Ms. Annanya Mehan, Mr. Ashutosh & Ms. Sakshi Rathore, Advocates.

For the Respondents : Ms. Nidhi Raman, CGSC along with Mr. Mayank Sansanwal & Mr. Om Ram, Advocates for Respondent No.1.
Mr. Jayant Mehta, Senior Advocate along with Mr. Kapil Wadhwa, Ms. Apoorva Maheshwari, Ms. Bhavya Gupta & Ms. Priyanshi Bhageria, Advocates for Respondent No.4.

\+ **W.P.(C)-IPD 54/2025, CM 223/2025 & CM 224/2025**

AUGUST VENTURES PRIVATE LIMITED .....Petitioner

versus

REGISTRAR OF TRADE MARKS .....Respondent

Advocates who appeared in this case

For the Petitioner : Mr. Jayant Mehta, Senior Advocate along with Mr. Kapil Wadhwa, Ms. Apoorva Maheshwari, Ms. Bhavya Gupta & Ms. Priyanshi Bhageria, Advocates.

For the Respondent : Ms. Nidhi Raman, CGSC along with Mr. Mayank Sansanwal & Mr. Om Ram, Advocates.
Mr. Chander M. Lall, Senior Advocate with Dr. Sheetal Vohra Mr. Rahul Dwivedi, Mr. Sridharan Rajan Ramkumar, Ms. Annanya Mehan, Mr. Ashutosh & Ms. Sakshi Rathore, Advocates for Innocenti SA.

\+ **W.P.(C)-IPD 56/2025, CM 232/2025 & CM 233/2025**

AUGUST VENTURES PRIVATE LIMITED .....Petitioner

versus

REGISTRAR OF TRADE MARKS & ANR. .....Respondents

Advocates who appeared in this case

For the Petitioner : Mr. Jayant Mehta, Senior Advocate along with Mr. Kapil Wadhwa, Ms. Apoorva Maheshwari, Ms. Bhavya Gupta & Ms. Priyanshi Bhageria, Advocates.

For the Respondents : Ms. Nidhi Raman, CGSC along with Mr. Mayank Sansanwal & Mr. Om Ram, Advocates for Respondent No.1.

Mr. Chander M. Lall, Senior Advocate with Dr. Sheetal Vohra Mr. Rahul Dwivedi, Mr. Sridharan Rajan Ramkumar, Ms. Annanya Mehan, Mr. Ashutosh & Ms. Sakshi Rathore, Advocates for R-2.

CORAM:
HON'BLE MR. JUSTICE TEJAS KARIA

JUDGEMENT

TEJAS KARIA, J

1. By way of this common Judgement, C.A.(COMM.IPD-TM) 76/2024 ("**Appeal**"), W.P.(C)-IPD 54/2025 ("**WP 54**") and W.P.(C)-IPD 56/2025 ("**WP 56**") are decided in terms of the agreement between the Parties as recorded in order dated 16.10.2025.

2. The Appeal has been filed by *Innocenti SA* ("**Innocenti**") against the order dated 28.05.2024 ("**Impugned Order**") passed by the Registrar of Trade Marks refusing the registration of the Trade Mark, '' under Application No. 5628005 in Class 12.

3. WP 54 has been filed by *August Ventures Private Limited* ("**August Ventures**") seeking writ of *mandamus* against the Registrar of Trade Marks to consider and decide the Applications filed by August Ventures under Section 19 of the Trade Marks Act, 1999 ("**Act**") in Trade Mark Application Nos. 5628002 and 5628003 filed by Innocenti.

4. WP 56 has been filed by August Ventures seeking writ of *certiorari* quashing the Acceptance Orders dated 30.05.2025 and 23.06.2025 ("**Acceptance Orders**") and consequent advertisements dated 09.06.2025

for Application No. 5628002 and dated 07.07.2025 for Application No. 5628003 filed by Innocenti in the Trade Marks Journal. It is also prayed to direct the Registrar of Trade Marks ("**Registrar**") to bear in mind and consider the registrations and applications of August Ventures while conducting examination under Rule 33 and 34 of the Trade Marks Rules, 2017 ("**Rules**") and before granting acceptance and directing advertisement under Section 20 of the Act, whenever any applications consisting of the word, 'LAMBRETTA' are filed or come up for examination.

FACTUAL BACKGROUND:

5. In the year 1932, Innocenti Societa Generale per 1'Industria Metallurgica e Meccanica SPA ("**Innocenti SG**") was incorporated in Italy, and engaged in the business of designing, making, and selling motor scooters and parts thereof under the Name Mark, 'LAMBRETTA' and, thereafter, on 18.11.1948, Innocenti SG obtained Italian Trade Mark Registration No. 83425 for the word, 'LAMBRETTA' for vehicles in Class 12, which was renewed periodically. On 02.06.1949, Innocenti SG obtained Indian Trade Mark registration of the Mark, 'LAMBRETTA' for motor vehicles in Class 12.

6. On 16.06.1972, by a tripartite agreement amongst (i) Government of India acting through the President of India; (ii) Automobile Products of India Limited ("**API**") and (iii) Innocenti SG (which had become Gepar SPA in 1972) together with Innocenti Lambretta S.P.A. (which merged with Gepar SPA on 29.12.1972), Government of India purchased machinery, know-how, and rights in the Trade Mark, 'LAMBRETTA'.

7. The President of India assigned the aforesaid assets and rights to Scooters India Limited ("**SIL**") in 1972, which became the proprietor of the Trade Mark, 'LAMBRETTA'.

8. During the years 1992 to 2000, SIL was declared sick by the Board of Industrial and Financial Reconstruction ("**BIFR**") in terms of the provisions of Section 3(1)(0) of the Sick Industrial Companies (Special Provisions) Act, 1985. Subsequently, SIL was declared no longer sick in the year 2000.

9. In 2007, Brandconcern B.V. ("**Brandconcern**") filed Trade Marks Applications attempting to illegally usurp the brand, 'LAMBRETTA'.

10. During the years 2010 to 2015, SIL, was again declared sick and put under BIFR until the year 2015 and the use of the Trade Mark, 'LAMBRETT' continued worldwide through the licensees, and such use by the licensees belonged to SIL.

11. In the year 2015, Heritage Licensing SA changed its name to Innocenti SA.

12. On 05.09.2022, August Ventures participated in SIL's e-auction, and acquired worldwide rights, title, and interest in the Trade Marks, 'LAMBRETTA' and 'LAMBRO' and all associated Trade Marks and paid consideration for an amount of ₹6,86,14,131/-.

13. On 28.09.2022, Innocenti filed Trade Mark Application Nos. 5628002 and 5628003 for 'LAMBRETTA' on a proposed to be used basis under Classes 12 and 25 respectively.

14. On 24.11.2022, under a valid Assignment Deed, August Ventures acquired all the worldwide rights interest and title in respect of the Trade Marks, 'LAMBRETTA' and 'LAMBRO' and all other associated Trade Marks, along with the goodwill and all common law rights from SIL.

15. On 12.07.2023, the Examination Reports in Trade Mark Application Nos. 5625002 and 5628003, cited August Venture's prior applications / registrations.

16. On 25.07.2023 and 26.07.2023, Innocenti in the reply to the Examination Report in Trade Marks Application Nos. 5628002 and 5628003 admitted that the Mark, 'LAMBRETTA' was coined and adopted by Innocenti SG, which was later assigned to SIL and subsequently, to the August Ventures.

17. On 19.04.2024 and 16.05.2025, Innocenti relied upon international registrations obtained by Innocenti during the hearing in Trade Mark Application No. 5628002. On 09.06.2025 and 07.07.2025, the Trade Mark Application Nos. 5628002 and 5628003 were advertised in Trade Marks Journal Nos. 2212-0 and 2216-0, respectively.

18. August Ventures filed Applications under Section 19 of the Act on 20.06.2025 seeking withdrawal of acceptance and subsequent refusal of Trade Mark Application Nos. 5628002 and 5628003.

19. In September 2025, August Ventures filed the WP 54 seeking a writ in the nature of *mandamus* to consider and decide the Applications under Section 19 of the Act and WP 56 seeking a writ in the nature of *certiorari* quashing of the Acceptance Orders and consequent advertisements in the Trade Marks Journal.

SUBMISSIONS ON BEHALF OF AUGUST VENTURES:

20. The learned Senior Counsel for August Ventures submitted as under:

20.1. Innocenti is incorporated in Switzerland in 2008 as Heritage Licensing SA and changed its name to Innocenti SA in 2015 to create a false impression of being associated with original

Innocenti SG. Innocenti and its associated companies are habitual infringers and usurp the trademarks owned by third parties.

20.2. In 2008, the Court of the Hague *vide* order dated 24.09.2008 banned Brandconcern from filing Applications for the Mark 'Pink Ribbon' or combination of the words 'Pink' or 'Ribbon', which are owned by the Pink Ribbon Foundation, which is a charitable institution aimed to improve breast cancer awareness.

20.3. The first set of applications for registration of the Mark, 'LAMBRETTA' were filed in 2007 through Brandconcern and the second set of applications for the Mark, 'LAMBRETTA' have been filed by the Innocenti in 2022. Both these attempts are made to illegally obtained the registration of the Mark, 'LAMBRETTA' by claiming themselves to be the owners of the Mark, 'LAMBRETTA'.

20.4. Innocenti is a pirator and not the originator of the Mark, 'LAMBRETTA'. Accordingly, no rights vest in Innocenti to obtain registration of Mark, 'LAMBRETTA' in name of Innocenti. Therefore, the acceptance of Application Nos. 5628002 and 5628003 for registration of the Mark, 'LAMBRETTA' in Class 12 and 25 under Section 18(5) of the Act is squarely hit by Section 11 of the Act despite the Mark, 'LAMBRETTA' belonging to August Ventures having been cited.

20.5. The Acceptance Orders are contrary to the order dated 28.05.2024 refusing the Application No. 5628005 file by Innocenti for registration of the Mark, 'LAMBRETTA', against which Innocenti has filed the Appeal. Once the Respondent had taken a view that

the registration of the Mark, ‘LAMBRETTA’ was not permissible in Application No. 5628005, the Acceptance Orders passed under Section 18(5) of the Act were contrary to law.

20.6. The Respondent has erred in bypassing the provisions of Section 11 of the Act by ignoring the identical Mark, ‘LAMBRETTA’ belonging to August Ventures cited in the examination report. Any Application for an identical mark applied for in the same class of goods and services must be nipped in the bud. An application for registration of a Trade Mark cannot be accepted, if there is an identical mark, which is phonetically and visually similar, is cited in the examination report for the said application.

20.7. The right of a registered proprietor to protect its Trade Mark is precious and unlike a copyright or a design registration, the Trade Mark registration goes through an open challenge and the proprietor is granted registration after multiple levels of scrutiny at every stage. Section 11 of the Act is a mandate that the Registrar has to follow at every stage of the prosecution of a trade mark starting from acceptance to examination to opposition to registration to rectification. The duty to apply Section 11 of the Act encompasses the principles that govern a Trade Mark application at every stage. The acceptance or advertisement of a Mark is not merely a ministerial act and requires proper application of mind. The duty under Section 11 of the Act permeates across different stages of the Act and every stage is equally important. Therefore, availability of remedy of opposition or rectification cannot absolve

the Registrar from exercising its duty under Sections 9 and 11 of the Act.

20.8. Accordingly, Section 19 of the Act is a valuable right granted to the rightful owner of the Mark as well as to the Registrar. The purpose of Section 19 of the Act is to save the burden on the rightful owner of the trade mark to prosecute opposition under Section 21 of the Act or rectification under Sections 47 and 57 of the Act. Section 19 of the Act empowers the Registrar to rectify an 'error' or an oversight, which may have been committed under Section 18 of the Act. The availability of the remedy of opposition / rectification cannot be a tradeoff for exercising rights under Section 19 of the Act to rectify an 'error'.

20.9. The power under Section 19 of the Act is given to the Registrar to withdraw an erroneous acceptance of an application for a registration of the Trade Mark. To restrict exercise of such power only '*suo moto*' or at 'discretion' of the Registrar makes the power completely arbitrary.

20.10. There is no prohibition under Section 19 of the Act for a rightful proprietor of a trade mark to make a representation before the Registrar for exercising the right available under Section 19 of the Act. The purpose of Section 19 of the Act is to empower the Registrar to withdraw the acceptance of a trade mark application before its registration, if it is discovered that the acceptance was made in error. Section 19 shields the proprietors of the mark and also protects the public against the fraudulent marks as the power of Registrar to withdraw the acceptance exists to safeguard the

public interest and to prevent the grant of statutory right in respect of marks, which are not registerable under the Act.

20.11. Section 19 of the Act is a special provision, which empowers the Registrar to revisit the trade mark examination and nullify the acceptance independent of the opposition stage. The jurisdiction under Section 19 of the Act can be invoked by the Registrar either *suo moto* or at the instance of the third party as there is no prohibition any third-party representation being made to the Registrar. A purposive interpretation of broadly worded Section 19 of the Act would prevent the registration of fraudulent marks as contemplated under the Act. If there is an error apparent in acceptance of a mark, the Registrar cannot refuse to exercise its jurisdiction under Section 19 of the Act. If a fact of *prima facie* illegal / erroneous acceptance has been brought to the notice of the Registrar, the Registrar cannot refrain from applying the mind in terms of Section 19 of the Act.

20.12. The power of the Registrar under Section 19 of the Act is discretionary to decide the question of whether a trade mark has been accepted in error or it should not be registered. However, if a third party makes an application requesting the Registrar to exercise the power under Section 19 of the Act, it is obligatory on the Registrar to examine such a request and the examination of the same cannot be refused on the ground of discretion. The discretion is limited in the context of withdrawing the acceptance of the mark and not with respect to considering the application for exercising the power under Section 19 of the Act. Once an application is

made requesting the Registrar to exercise the power under Section 19 of the Act, it is obligatory on part of the Registrar to examine such a request.

20.13. In a number of cases, the Registrar has entertained the applications filed by the third parties under Section 19 of the Act. Therefore, the Registrar is duty bound to maintain parity and act with fairness. The Registrar has no discretion to entertain a few requests made under Section 19 of the Act and not consider the other. In ***Tikkam Chand & Anr. v. Dy. Registrar of Trade Marks & Anr.***, 1998 SCC OnLine Del 478, the Registrar had issued a show cause notice to the applicant on a Section 19 application filed by third party which was challenged before this Court. While dismissing the challenge, it was held that the Registrar should hear both the applicant and the objector. It shows that the Registrar has been entertaining the application under Section 19 of the Act filed by third parties and is estopped from acting contrary to such practice.

20.14. After the mark is accepted under Section 18(4) of the Act, it automatically proceeds towards advertisement. There is no intervening step where a review of the accepted mark is conducted by the Registrar while the mark is being advertised in the Trade Marks Journal. Therefore, if a third party points out an error in acceptance of the mark, it is imperative for the Registrar to exercise the power of withdrawal of acceptance under Section 19 of the Act as otherwise such a power would be rendered completely nugatory. Once an error in acceptance is discovered by the Registrar or brought to the notice by a third party, the Registrar

is bound to take steps as envisaged under Section 19 of the Act and Rule 38 of the Rules. The Registrar cannot ignore the error by citing discretion. If the Registrar fails to consider the application filed under Section 19 of the Act, once the error is brought to the notice of the Registrar, the same will amount to an arbitrary exercise of power. In most cases, the error may not be discoverable to the Registrar on its own unless the same is brought to the notice of the Registrar. A restrictive interpretation that prevents third parties from bringing the error to the Registrar's knowledge, would frustrate the very objective of Section 19 of the Act.

20.15. In ***M/s Kamdhenu Limited v. Union of India & Ors.***, W.P.(C)-IPD 29-33 of 2025, wherein the challenge was made to the examination report and acceptance order passed by the Registrar before filing any opposition proceedings, the applications were remanded for *de novo* adjudication in view of an apparent gross abuse of the jurisdiction by the Registrar.

20.16. The above decision underscores that where an error is brought to the notice of the Registrar, the corrective steps are bound to be taken to maintain the purity of the Register. The Act aims to prevent use of fraudulent marks and Section 19 of the Act is one of the ways to achieve the said goal.

20.17. The remedies of filing opposition post acceptance and pre-registration of the mark under Section 21 of the Act or filing rectification of the mark under Sections 47 and 57 of the Act after the registration of the mark are stage specific and not alternative remedies. Merely because the remedies under Sections 21, 47 or

57 of the Act are available at a later stage, it does not act as a bar to invocation of Section 19 of the Act. Section 19 of the Act operates in its own independent limited scope of error in acceptance. The existence of the other remedies such as opposition and rectification cannot negate a remedy available at the preliminary stage. The remedy under Section 19 of the Act is independent and not an alternate to Section 21 of the Act. Once the mark is accepted under Section 18(4) of the Act and advertised under Section 20 of the Act, the remedy to file an opposition under Section 21 of the Act is limited to the extent that the Registrar shall decide whether to grant a registration under Section 23 of the Act or not. The grant of registration under Section 23 of the Act is made subject to the provisions of Section 19 of the Act. Therefore, the remedies under Sections 19 and 21 of the Act are both independent as the powers conferred upon the Registrar under Section 19 of the Act and under Section 21 of the Act are entirely different.

20.18. The power under Section 19 of the Act is the only recourse to challenge the acceptance under Section 18(4) of the Act. Once an acceptance is granted, the only statutory mechanism for withdrawing the acceptance is provided under Section 19 of the Act. Whereas proceedings under Section 21 of the Act are directed towards opposing the registration of the mark after valid acceptance and advertisement. Accordingly, proceedings under Section 21 of the Act do not result in withdrawal of the acceptance granted under Section 18(4) of the Act.

20.19. The proceedings under Section 21 of the Act does not affect the acceptance under Section 18(4) of the Act. Section 19 of the Act results in withdrawal of the acceptance rendering the acceptance a nullity. Therefore, the remedies under Section 19 of the Act and Section 21 of the Act are not interchangeable and operate in different spheres.

20.20. If the Registrar makes an error while accepting the application for registration of a mark under Section 18(4) of the Act, such an error cannot be ignored at the first stage itself merely because there is a remedy available for filing an opposition under Section 21 of the Act. The opposition proceedings on an average take around three to five years and even if successful, it will not withdraw the acceptance under Section 18(4) of the Act. If an erroneous acceptance remains on record, the same will be used as a precedent for obtaining acceptance orders for other Trade Marks. Therefore, Sections 21, 47 or 57 of the Act are not alternative remedies to Section 19 of the Act. If remedy available under Section 21 of the Act is considered to be an alternative to Section 19 of the Act, the existence of a separate provision of Section 19 of the Act would be nugatory. Accordingly, the Registrar can decide an application under Section 19 of the Act despite the remedy of Section 21 of the Act still being available.

20.21. The provision of Section 19 of the Act can be read to be akin to the provision of Order VII Rule 11 of the Code of Civil Procedure, 1908, which is to nip the application in the bud if it is found to be without any valid cause of action or barred by law. Similarly,

Section 19 of the Act empowers the Registrar to withdraw the very acceptance of the mark, independent of opposition proceedings, if the application is found to be accepted in error.

20.22. If the Registrar fails to perform the duty under Section 19 of the Act, this Court has power to issue mandamus directing the Registrar to perform its statutory duty of consideration of Section 19 application. In ***S.C. Advocates-On-Record Association v. Union of India***, (1993) 4 SCC 441, it is held that a Court can issue a writ of *mandamus* directing the public authority to exercise its discretion within a reasonable time. The ground of practical difficulty and opening of flood gates if the remedy under Section 19 of the Act is held to be in addition to the remedy under Section 21 of the Act, cannot be the reason for circumventing the statutory duty under Section 19 of the Act. The practical difficulty cannot render the statutory provision otiose or in applicable.

20.23. In ***Jai Bhagwan Gupta v. Registrar of Trade Marks***, 2020:DHC:1532, this Court has held that the Registrar has to apply mind prior to the mark being advertised. The principles of ***Jai Bhagwan*** (supra) have been reaffirmed in ***Kaira District Cooperative Milk Producers Union Ltd. v. Registrar of Trademarks***, WP(C)-IPD 14/2021. Accordingly, the inaction of the Registrar to effectively its mind under Section 19 of the Act is amenable to the writ jurisdiction of this Court.

20.24. The Registrar has accepted the Application No. 5628002 stating that the cited marks are '*different as a whole*', which is an error under Section 11 of the Act and clear non-application of mind. It is

a settled law that application of mind must be proper, genuine, reasoned and not mechanical. The Registrar has relied upon the written submissions dated 16.05.2025 filed by Innocenti to state that cited marks are different as a whole, however, neither the Reply to Examination Report nor the Written Submissions filed by Innocenti make any such argument. The Registrar also failed to appreciate that Brandconcern's Rectification Petition against August Ventures in Trade Mark Application No. 139031 has been dismissed.

20.25. While accepting Application No. 5628003 filed by Innocenti for the Mark, 'LAMBRETTA' in Class 25 on proposed to be used basis, the Registrar made an error by bypassing the mandate of Section 11 of the Act despite the identical mark of August Ventures having phonetic, visual, conceptual and structural similarity.

20.26. WP 56 challenging the Acceptance Orders is maintainable as the said issue has been decided by the Division Bench of this Court in ***Ashiana Ispat Limited v. Kamdhenu Limited & Ors.***, LPA 407/2025, which held that the actions of the Registrar of not having been undertaken in accordance with the Act is challengeable. Accordingly, the question of maintainability of the writ petition challenging the Acceptance Orders is no longer *res integra*.

20.27. As regards the entertainability of the writ petition challenging the Acceptance Orders, where the error committed is gross and the Registrar has failed to effectively perform its duty under Sections 9, 11, 18 and 20 of the Act, this Court ought to intervene and quash

the Acceptance Orders and consequent advertisements. The availability of opposition proceedings being independent and separate, cannot be used to refuse entertaining the writ petition challenging and evidently illegal acceptance in gross violation of Section 11 of the Act. In any event, the opposition under Section 21 of the Act proceeds on the basis of validity of acceptance. WP 56 challenges the very acceptance under Section 18(4) of the Act by the Registrar, while failing to perform its bounden duty and completely bypassing Section 11 of the Act.

20.28. Accordingly, the Acceptance Orders passed by the Registrar ignoring the provisions of Section 11 of the Act are liable to be quashed. Further, the Registrar is liable to be directed to consider the application filed by August Ventures under Section 19 of the Act.

20.29. The Appeal filed by Innocenti against order dated 28.05.2024 refusing the Application No. 5628005 is liable to be dismissed as the Registrar has rightly rejected the said Application. The scope of inquiry at the stage of Section 18 of the Act is limited to Section 9 and Section 11 of the Act. At that stage, the Registrar is not required to venture into extraneous irrelevant issues. On a comparison of the Mark, ‘’ with the cited Mark, ‘’, it is evident that both the Marks are phonetically, visually, conceptually identical and are bound to cause confusion and deception.

20.30. Accordingly, the Registrar has rightly rejected the Application No. 5628005 in view of Section 11 of the Act. Accordingly, the Appeal deserves to be dismissed.

SUBMISSIONS ON BEHALF OF THE INNOCENTI:

21. The learned Counsel for Innocenti submitted as under:

21.1. The Innocenti was incorporated under the laws of Switzerland and has attained immense reputation in the international market over the years and operates in more than sixty countries through subsidiaries, numerous distributors and direct production facilities located in Thailand, Vietnam, and China.

21.2. Innocenti is in the business of distributing and selling of goods, namely, motor vehicles, motor scooters, electrically operated scooters, automobiles, motorized bicycles etc. Innocenti along with its affiliates and group company is the registered holder of various Trade Marks including 'LAMBRETTA', '', 'LAMBRO' and 'INNOCENTI' in various jurisdictions including North and South America, Asia, Oceania, Europe, Middle East, and Africa.

21.3. The Mark, 'LAMBRETTA' was initially used by an Italian company Innocenti SG based in a town near Milan, Italy for its range of scooters. The name, 'LAMBRETTA' is derived from the word, 'Lambrate', the suburb of Milan named after the river 'LAMBRO'. 'LAMBRETTA' was the name of mythical water-sprite associated with the river. Innocenti SG sold its models to India under the Mark, 'LAMBRETTA' *via* API until 1972. Innocenti SG became defunct in 1972 and sold its two-wheeler

division (Plant and Equipment) to the Government of India, who passed it forward to SIL. SIL used the brands like Ravalli, Digvijay, Vijai Falcon, Vijai Kesri and Allwyn Pushpak, but did not use the Mark, 'LAMBRETTA' in India.

21.4. Innocenti's group company, Brandconcern had intent to revive and adopt the Mark, 'LAMBRETTA' for its various products. Since 2007, Innocenti's group company had secured Trade Mark registrations globally, whereas a few existing registrations in the name of SIL were either removed for non-use or expired due to non-removal. Through its effort, Innocenti has claimed huge goodwill for the international Mark, 'LAMBRETTA'.

21.5. Innocenti has already commercially used the Mark, 'LAMBRETTA' globally. Innocenti operates international websites, www.lambretta.com and www.lambrettascooters.com. Innocenti is also the registered owner of domains, www.lambretta.in and www.lambretta.co.in.

21.6. The Impugned Order challenged in the Appeal is totally arbitrary, pedantic, cryptic and has been passed in a sweeping manner without any application of mind. The Impugned Order simply states that 'LAMBRETTA' is found phonetically and visually similar to the cited conflicting Mark, 'LAMBRETTA' *vide* Application No. 350817 for the similar goods. As the Mark, 'LAMBRETTA' was applied subsequently on proposed to be used basis by Innocenti, the Impugned Order states that there is likelihood of confusion. Further, the Impugned Order held that no

explanation is provided by Innocenti for adopting the Mark, 'LAMBRETTA', when a similar mark is already on record.

21.7. The Impugned Order does not record the grounds for refusal and the material used for arriving at the decision by the Registrar. The Examination Report Application No. 5628005 in Class 12 cited three Trade Marks. As regards Mark bearing No. 350817, '', Innocenti has already filed the cancellation as early as 28.10.2011. The second Mark belongs to the sister concern of Innocenti itself and the rectification of the third Mark bearing No. 2890657 has been filed by Innocenti. The Impugned Order does not consider these aspects and, accordingly, the Impugned Order is liable to be set aside.

21.8. Further, the Registrar also failed to consider reply filed by Innocenti to the Examination Report, wherein it is stated that the Mark, 'LAMBRETTA' is registered in multiple foreign jurisdictions being Brazil, Cambodia, Switzerland, CTM, Benelux, Mexico, France, Great Britain, Malaysia, Italy, Spain, WIPO, US and Canada.

21.9. The reply also mentioned that Innocenti has registration of the Mark, 'LAMBRETTA' in Class 18 under No. 1551216 and for the Mark, 'LAMBRO' in Class 12 under No. 1551219. The Registrar has also failed to consider the cancellation of SIL Trade Marks in United States, Great Britain, Europe, Canada filed by the sister concern of Innocenti. The Registrar has also failed to examine and written a finding on a rectification / cancellation of two cited Marks being SIL / August Ventures bearing No. 350817

‘’ and ‘LAMBRETTA’ bearing No. 2890657, in which it is clearly stated that the cited Marks have not been used since 1997. In fact, there is no ‘LAMBRETA’ scooter of SIL / August Ventures available in India. The Registrar failed to consider the document filed by Innocenti from the website of the proprietor cited mark being SIL stating that “*Company is under closure*”.

21.10. The Registrar has failed to consider the NOC given by sister concern of Innocenti, Brandconcern that it has no objection if Trade Mark No. 5628005 is registered in name of Innocenti. Therefore, this is the fit case for acceptance and advertisement of the Mark applied *vide* Application No. 5628005 in Class 12 so that August Ventures has a remedy to oppose the same.

21.11. The scheme of the Act and Rules do not provide for any third party to make an application under Section 19 of the Act. A bare reading of the Section 19 of the Act and Rule 38 of the Rules make it clear that the Registrar at pre-advertisement stage only needs to hear the applicant of the application and cannot hear any third party, like August Ventures, if the Registrar is of the view that the application has been accepted in error as it is the only applicant of the application whose rights are affected if acceptance is withdrawn.

21.12. Therefore, the Registrar has rightly not looked into the application filed by August Ventures under Section 19 of the Act for withdrawal of acceptance of Application Nos. 5628002 and 5628003.

21.13. Rule 38(1) of the Rules make it abundantly clear that at pre-advertisement stage, the Registrar only communicates with the applicant. Rules 38(2) and 38(3) of the Rules provide that only an applicant is afforded an opportunity to amend the application or right to be heard. Rule 38(4) of the Rules provide that the Registrar may, after hearing the applicant, on considering the submissions, if any, pass such orders as he may deem fit. Accordingly, there is no provision for third parties to file any application or be given the hearing prior to the advertisement of the trade mark.

21.14. In ***Rajkumar Sabu v. Sabu Trade Private Ltd and Anr.***, W.P. (IPD) No. 34/2025 and W.M.P (IPD) No. 23/2025, the High Court of Madras has held that it does not follow from Section 19 of the Act that a person other than the applicant has the right to be heard in relation to the withdrawal of the acceptance by the Registrar. A bare reading of Section 18(4) of the Act with Rule 33(2) of the Rules makes it apparent that if the Registrar is accepting an application, he communicates his acceptance in writing to the applicant and does not give grounds to the acceptance.

21.15. Section 18(5) of the Act provides that when the Registrar is refusing a trade mark or accepting a trade mark with conditions, the Registrar shall record in writing the grounds for such refusal or conditional acceptance and the materials used by the Registrar in arriving at such decision. Hence, there is no infirmity with the Acceptance Orders.

21.16. Further, Rule 38 of the Rules makes it clear that at the stage of Section 19 of the Act, there can be only two parties to the

proceedings, i.e., the Registrar and the applicant. Rule 38 of the Rules specifically lays down that only Registrar can have objection to the acceptance of the application and no third party can raise such an objection. The only party who can be heard at the stage of Section 19 of the Act is the applicant and no one else.

21.17. The decision in ***Jai Bhagwan*** (supra) is not applicable in the present case, as none of the applications being Application Nos. 5628002 and 5628003 have been advertised before acceptance. Rule 41 of the Rules allow any third party to file request in Form TM-M for particulars of advertisement of a trade mark through the Registrar, who shall provide the number and date of the journal in which the advertisement was published. Hence, the only remedy available with August Ventures is to file opposition under Section 21 of the Act, which allows 'any person' to file an opposition. Section 19 of the Act does not provide or indicate any third party to circumvent the opposition route and file an application before the Registrar for invocation of powers under Section 19 of the Act. Such powers are discretion of the Registrar, and a third party cannot interfere with the same.

21.18. WP 54 and WP 56 are filed by August Ventures for the same cause of action as the subject matter of both the Petitions are Application Nos. 5628002 and 5628003. Hence, two writ petitions for the same cause of action are not maintainable on the ground of constructive *res judicata* and amounts to abuse of the process of this Court.

21.19. In any event, August Ventures has not filed a single document to show how SIL got the Mark, 'LAMBRETTA', especially when

August Ventures has never used the Mark, 'LAMBRETTA' in India or anywhere in the world. Therefore, even on merits, August Ventures will not be able to establish the rights over the Mark, 'LAMBRETTA'.

21.20. Accordingly, the Appeal be allowed while dismissing WP 54 and WP 56.

SUBMISSIONS ON BEHALF OF THE REGISTRAR OF TRADE MARKS:

22. The learned CGSC for the Registrar of Trade Marks submitted as under:

22.1. August Ventures has incorrectly invoked the extra ordinary writ jurisdiction of this Court by bypassing the specific and statutory remedy available under Section 21 of the Act to oppose the Trade Mark applications filed by Innocenti. Accordingly, August Ventures has an effective and efficacious, alternative, statutory remedy available and, therefore, WP 54 seeking directions against the Registrar to consider the application under Section 19 of the Act is not maintainable.

22.2. Section 19 of the Act grants the Registrar a *suo moto* and discretionary power to withdraw the acceptance of trade mark application. The wording '*the Registrar is satisfied*' makes it clear that the process is triggered by the Registrar's own judgment and not by an application from a third party.

22.3. Rule 38 of the Rules explicitly outlines a two party process, i.e., involving the Registrar and the applicant. There is no provision for

a third party to file an application under Section 19 of the Act or be heard or participate at the stage of Section 19 of the Act.

22.4. The legislative intent behind creating separate process under Sections 19 and 21 of the Act is to provide different remedies to the Registrar and third parties. Section 21 of the Act allows 'any person' to file an opposition, whereas Section 19 of the Act gives the discretion only to the Registrar. In ***Rajkumar Sabu*** (supra) it is clearly held that Section 19 of the Act does not give a person other than the applicant the right to be heard.

22.5. The Registrar passed the Acceptance Orders based on a detailed response to the Examination Report from Innocenti. Based on the examination of the response, it was *prima facie* established that the application could be accepted and advertised based on the global ownership with registration in over forty countries and the contention that the owner of the cited Marks had no intention to use the cited Marks and informing about on-going proceedings to have those Marks rectified. Further, Innocenti also provided a no-objection certificate from the associated entity for registration of the Marks.

22.6. If August Ventures is not satisfied with the Acceptance Orders, it has a statutory remedy of filing opposition under Section 21 of the Act. By filing WP 54 and WP 56, August Ventures is attempting to bypass the required procedure to get invalidation of the Acceptance Orders. The writ jurisdiction is not meant to be a shortcut to avoid the statutory remedies in the correct legal forum. The grievance of August Ventures is not with the lack of the

process but with the outcome of the process. The contention of August Ventures that the opposition proceedings are burdensome is not tenable as August Ventures has availed the same remedy against the registration of Mark, 'LAMBRO' bearing Application No. 5639358 in Class 12 filed by Innocenti.

22.7. The opposition proceedings under Section 21 of the Act ensures due process by allowing both sides to present evidence and arguments before the Registrar to decide the dispute conclusively. The contention of August Ventures that the Acceptance Orders are untenable is the precise issue that can be decided by the Registrar in the opposition proceedings under Section 21 of the Act and the same cannot be a justification to bypass the process itself.

22.8. It is settled legal principle that the right holders must be vigilant in protecting their rights and monitoring the Journal is a standard and expected aspect of the diligence for every proprietor of Trade Mark. The Journal serves the critical public notice function, ensuring transparency and due process. While the Trade Mark registration confers rights, it does not exempt the owner from the diligence required to enforce them by actively monitoring the Journal for exercising the right to oppose.

22.9. The prohibition under Section 11 of the Act applies only to the final act of registration, but not the preliminary steps like acceptance and advertisement. By advertising the mark, the Registrar initiates the process that allows third parties to oppose and prevent the final registration. August Ventures has incorrectly filed the Writ Petitions seeking a final decision at the preliminary

stage without following the statutory scheme of opposition under Section 21 of the Act. Allowing the Writ Petitions, setting aside the Acceptance Orders or directing to exercise powers under Section 19 of the Act will set a wrong precedent, encouraging the third parties to bypass the statutory process of opposition under Section 21 of the Act. This would open floodgates for similar petitions, enabling competitors to strategically stall the registration of any mark. If the challenge to the orders passed under Section 18 of the Act is allowed by way of a writ petition, it would paralyze the entire trade mark registration system, undermining the structured, time bound procedure established by law.

22.10. The successive Writ Petitions filed by August Ventures on the very same cause of action of acceptance and advertisement of Trade Mark Application Nos. 5628002 and 5628003 are not maintainable. August Ventures was fully aware of the Acceptance Orders when it filed WP 54 as the Acceptance Orders formed the very basis for filing WP 54. Since the underlying cause is identical, August Ventures was obligated to include all related claims in WP 54 itself. The relief of quashing the Acceptance Orders sought in WP 56 was available to August Ventures when it filed WP 54. However, August Ventures chose only to seek writ of *mandamus* against the Registrar and did not seek writ of *certiorari* to quash the Acceptance Orders. It is a settled position of law that a party must bring the entire claim and seek all available remedies related to a single cause of action in one proceeding. Filing successive petitions based on the identical cause of action is improper.

22.11. It is also a settled position of law that a writ of *certiorari* can be issued only in cases of grave error of jurisdiction, violation of principles of natural justice and where the order is vitiated by an error apparent on the face of the record. In the present case, the Acceptance Orders are procedural in nature passed in due exercise of the statutory function under the Act after considering the Examination Report and the Reply filed by Innocenti before arriving at a subjective satisfaction to accept the Applications. A mere disagreement with the conclusion arrived at by the Registrar under Section 18 of the Act, does not constitute an error apparent on the face of the record warranting the exercise of writ jurisdiction by this Court. The correctness of the Acceptance Orders is a matter of merit to be adjudicated in the opposition proceedings or in appeal and not by way of a writ petition.

22.12. The allegation that the Acceptance Orders were passed without application of mind is baseless as the records clearly show that it was the Registrar, who initially raised objection under Section 11 of the Act citing the earlier Marks in the Examination Reports for both the Applications. After considering the Reply filed by the Innocenti to the Examination Reports and other materials place on record, Acceptance Orders were passed.

22.13. As regards the Appeal filed by Innocenti, the Impugned Order is well-reasoned and based on a correct appreciation of the facts and does not suffer from any infirmity that would warrant interference by this Court. The primary basis for passing the Impugned Order is the grounds stipulated under Section 11(1) of the Act. The Mark,

'' bears a striking and impermissible similarity to the cited Mark, '', giving rise to a likelihood of confusion upon the public as there exists a high degree of phonetic and visual similarity. Further, the goods in Class 12 are identical / similar to the goods covered by earlier cited Marks. Both the sets of the goods are targeted at the same consumer base and are sold through identical trade channels. The Mark, '' is applied on proposed to be used basis, which shows that Innocenti had no prior use or established goodwill in India.

22.14. Innocenti has failed to provide any cogent explanation or justification for the adoption of the Mark, which is so close and resembles to the ones already in the Register, which suggests a lack of due diligence and an attempt to trade on the goodwill and reputation of the earlier cited Marks.

22.15. Accordingly, the objection raised in the Impugned Order is fully justified and cannot be waived. To uphold the integrity and to maintain the purity of the Register of the Trade Marks as well as to protect the interests of the consumer and the rights of the registered proprietors of the earlier cited Marks the refusal of the registration in the Impugned Order was justified. Further, the proprietor of the earlier Marks is contesting the rectification petitions filed by Innocenti, which are currently pending before the Trade Marks Registry. Further, Innocenti has not impleaded the registered proprietor of the earlier Trade Marks in the Appeal.

22.16. Innocenti has also concealed material documents showing that the registered proprietor of earlier cited Marks has a tenable claim of prior use of the Mark, 'LAMBRETTA' in India being the predecessor-in-interest of Innocenti assigned all the rights in Mark, 'LAMBRETTA' to the President of India on 16.06.1972, which were further assigned to SIL *vide* Assignment Deed dated 26.07.1974. Therefore, the stand of registered proprietor of the earlier cited Marks cannot be ignored.

22.17. Accordingly, the Appeal as well as WP 54 and WP 56 deserve to be dismissed.

ANALYSIS AND FINDINGS:

23. The Appeal as well as WP 54 and WP 56 raise important questions of law regarding the interplay between various Sections of the Act read with the Rules and exercise of the writ jurisdiction, when the alternative statutory remedy is available under the Act.

24. At the first hearing of WP 54 on 11.09.2025 seeking writ of *mandamus* against the Registrar for exercising the powers under Section 19 of the Act, before issuing the Notice, following Issues were framed for consideration:

i. Whether the power under Section 19 of the Act, which provides as under:

> *"19. Withdrawal of acceptance. — Where, after the acceptance of an application for registration of a Trade Mark but before its registration, the Registrar is satisfied— (a) that the application has been accepted in error; or (b) that in the circumstances of the case the Trade Mark should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which*

> *the application has been accepted, the Registrar may, after hearing the applicant if he so desires, withdraw the acceptance and proceed as if the application had not been accepted."*

be exercised when the above Section states that the Respondent 'may' withdraw the acceptance, especially when there is no provision for filing the Applications before the Respondent by the Petitioner under Section 19 of the Act?

ii. Whether the Respondent is obligated to consider and decide the Applications filed by the Petitioner alleging that the Trade Mark Applications have been accepted in error?

iii. Whether the Respondent can be directed to consider and decide the Applications filed by the Petitioner under Section 19 of the Act, after giving opportunity of hearing to the Petitioner, when the Petitioner has also an alternative remedy under Section 20 of the Act?

25. Subsequently, August Ventures filed WP 56 seeking quashing and setting aside of Acceptance Orders passed under Section 18 of the Act, wherein Innocenti was also joined as Respondent No. 2. *Vide* order dated 26.09.2025, Notice was issued in WP 56 and both WP 54 and WP 56 were tagged together since they were in relation to the Acceptance Orders passed in the Trade Mark Application Nos. 5628002 and 5628003 filed by Innocenti. As it was pointed out that the Appeal filed by Innocenti was also pending consideration, the said Appeal was also heard along with WP 54 and WP 56 with consent of all the Parties.

Scope of Section 19 of the Act

26. As per Section 19 of the Act, the Registrar has the power to withdraw the acceptance of the application for registration of Trade Mark made under

Section 18 of the Act if the Registrar is satisfied that the application was accepted in error or the Trade Mark applied should not be registered or should be registered with certain conditions. August Ventures has invoked Section 19 of the Act calling upon the Registrar to exercise the power under Section 19 of the Act pursuant to the Acceptance Orders passed by the Registrar under Section 18 of the Act.

27. Since the Registrar has not acted upon the application filed by August Ventures under Section 19 of the Act, WP 54 has been filed seeking direction to the Registrar for exercising the right under Section 19 of the Act. August Ventures has interpreted Section 19 of the Act to provide discretionary power to the Registrar, which can be invoked by rightful owner / proprietor of the earlier Trade Marks, in absence of any prohibition for the same under Section 19 of the Act.

28. The plain language of Section 19 of the Act indicates that the power to withdraw the acceptance is based on subjective satisfaction of the Registrar that the acceptance of the application under Section 18 of the Act was in error or that circumstances of the case required that the Trade Mark should not be registered or should be registered subject to conditions or limitations. The trigger for invoking such power is a satisfaction of the Registrar about existence of the conditions mentioned in Section 19 of the Act. Section 19 of the Act is silent with regard to the basis on which the Registrar can arrive at such satisfaction.

29. August Ventures has sought to contend that the power given to the Registrar is also coupled with the duty to examine the existence of any of the conditions specified in Section 19 of the Act, if the same is brought to the notice of the Registrar by any third party by way of filing an application.

Section 19 of the Act does not specifically provide for any such application to be entertained by the Registrar. Rule 38 of the Rules, which deal with the withdrawal of acceptance by the Registrar under Section 19 of the Act reads as under:

> *"**Expedited examination, objection to acceptance, hearing**.- (1) After the receipt of the official number of an application under sub-rule (1) of rule 37, an applicant may request for expedited examination of an application for registration of a trade mark in Form TM-63 together with a declaration stating the reason for the request, on payment of five times the application fee.*
> *(2) If the Registrar is satisfied on the basis of declaration filed under sub-rule(1) that an expedited examination of the application is warranted, he shall cause the expedited examination of such application in the order in which the requests are filed and may ordinarily issue the examination report within three months of the date of such request.*
> *(3) Where the Registrar declines the request under sub-rule (1), the applicant shall be entitled to have the fee refunded: Provided that before declining any such request, the Registrar shall provide the applicant an opportunity of being heard.*
> *(4) If on consideration of an application for registration of a trade mark or on an application for an expedited examination of an application referred to in sub-rule (1) 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 right to impose under sub-section (4) of section 18, the Registrar shall communicate such objection or proposal in writing to the applicant.*
> *(5) If within one month from the date of communication mentioned in sub-rule (4), the applicant fails to amend his application according to the proposal or fails to submit his observations to the Registrar or apply for a hearing or fails to attend the hearing, the application shall be deemed to have been abandoned."*

30. As per Rule 38 of the Rules, the power to withdraw the acceptance can be exercised if the Registrar has any objection to the acceptance. In such

a case, the Registrar has to communicate such objection in writing to the applicant. If the applicant does not respond within thirty days of such communication, the acceptance of the application shall be deemed to be withdrawn, however, if the applicant requests for a hearing, the Registrar shall give an opportunity of hearing and pass an order as the Registrar may deem fit.

31. A conjoint reading of Section 19 of the Act and Rule 38 of the Rules makes it clear that the powers under Section 19 of the Act can only be invoked by the Registrar upon arriving at a satisfaction of the existence of the conditions mentioned in Section 19 of the Act. Therefore, it is not obligatory upon the Registrar to consider any application by the third party requesting the Registrar to exercise the power under Section 19 of the Act.

32. At the stage of Section 19 of the Act, there is no provision for a third party to make an application as there are only two parties contemplated under Section 19 of the Act and Rule 38 of the Rules, i.e., the Registrar and the applicant. Therefore, there is no scope for interpretation of Section 19 of the Act to permit any third party to make an application for invocation of power under Section 19 of the Act.

33. August Ventures has argued that the Court can issue a writ of *mandamus* directing a public authority to exercise its discretion within a reasonable time. In support, August Ventures has relied upon ***S.C. Advocates-on-record Association*** (supra), which is relied upon in ***Dr. S Gurushankar v. Govt. of Tamil Nadu and Ors.***, 2014 SCC OnLine Mad 9372, wherein it is held that where the public authority is guilty of non-performance of its public duty and it is shown that it has failed to perform its constitutional or statutory duty, a writ of *mandamus* can be issued. However,

for a writ of *mandamus* to compel performance of a duty, it must clearly appear from the language of the statute that a duty is imposed and the performance or non-performance of which is not a matter of mere discretion, but in cases where the duty is discretionary, as distinct from a statutory obligation, a limited *mandamus* could be issued directing the public authority to exercise its discretion within a reasonable time on sound reasoned principles and not merely on whim.

34. In view of the above, it is clear that for issuing writ of *mandamus*, the pre-condition is existence of a statutory duty. However, Section 19 of the Act does not impose any duty on the Registrar to withdraw the acceptance and only gives a discretion to exercise the power in appropriate cases. Therefore, it cannot be said that there was any duty on the Registrar to examine the conditions under Section 19 of the Act upon an application being filed by a third party. The power under Section 19 of the Act is purely discretionary and not coupled with a duty. The underlying rationale behind giving such a power to the Registrar is to correct any error which has crept in while accepting the application for registration. However, it does not impose any duty upon the Registrar to examine the application of any third-party seeking exercise of such power.

35. If any person is aggrieved by the acceptance of application and advertisement of the mark pursuant thereto, Section 21 of the Act provides an adequate remedy. Section 21 of the Act reads as under:

> *"21. Opposition to registration*
> *(1) Any person may, within four months from the date of the advertisement or re-advertisement of an application for registration, give notice in writing in the prescribed manner and on payment of such fee as may be prescribed, to the Registrar, of opposition to the registration.*

(2) The Registrar shall serve a copy of the notice on the applicant for registration and, within two months from the receipt by the applicant of such copy of the notice of opposition, the applicant shall send to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application, and if he does not do so he shall be deemed to have abandoned his application.

(3) If the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.

(4) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed manner and within the prescribed time to the Registrar, and the Registrar shall give an opportunity to them to be heard, if they so desire.

(5) The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not.

(6) Where a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice neither resides nor carries on business in India, the Registrar may require him to give security for the costs of proceedings before him, and in default of such security being duly given, may treat the opposition or application, as the case may be, as abandoned.

(7) The Registrar may, on request, permit correction of any error in, or any amendment of, a notice of opposition or a counter-statement on such terms as he thinks just."

36. In view of the efficacious alternative statutory remedy available in form of Section 21 of the Act, it cannot be said that August Ventures was remediless against the Acceptance Orders. The argument of August Ventures that the Acceptance Orders were passed in contradiction to the previous stand taken by the Registrar and, therefore, there was an error apparent on the face of the record cannot be a ground to invoke writ jurisdiction of this Court and bypassing the statutory remedy under Section 21 of the Act.

37. The argument of August Ventures that the Registrar has been entertaining the applications under Section 19 of the Act previously also

cannot entitle August Ventures to seek a writ of *mandamus* against the Registrar to consider the Application filed under Section 19 of the Act by August Ventures. The reliance upon ***Tikkam Chand*** (supra) by August Ventures to argue that a show cause notice was issued under Section 19 of the Act at the behest of some person is not helpful to interpret Section 19 of the Act in a manner that would permit an additional avenue to the aggrieved person to apply under Section 19 of the Act in addition to filing objection under Section 21 of the Act. The decision in ***Tikkam Chand*** (supra) does not consider the nature of right under Section 19 of the Act and only records the submission of the petitioner while directing the hearing by the Registrar under Section 19 of the Act. The said decision is not an authority on the scope of Section 19 of the Act with regard to the obligation on the Registrar to consider any application filed by third party for exercising the right under Section 19 of the Act.

38. In ***Rajkumar Sabu*** (supra), it is correctly held that Section 19 of the Act does not give a person other than the applicant the right to be heard.

39. The argument of August Ventures is that the remedies under Section 19 of the Act of withdrawal of the acceptance and under Section 21 of the Act for opposing to the registration are entirely distinct and separate from each other. Such averment cannot be accepted, as Section 19 of the Act does not permit any third party to make an application before the Registrar. The only option available to any person, who wishes to challenge the acceptance of the application, is to file an opposition under Section 21 of the Act. Therefore, there cannot be any comparison between the remedies under Sections 19 and 21 of the Act.

40. Section 21 of the Act provides an adequate process for any person to oppose the registration of the Mark even though the same is accepted under Section 18 of the Act in error or the Mark is not capable of registration under Sections 9 and 11 of the Act. The power under Section 19 of the Act is exclusively available to the Registrar independent of the power to determine the opposition under Section 21 of the Act. If the opponent to the application is given additional right to file an application under Section 19 of the Act in addition to the opposition under Section 21 of the Act, the statutory scheme of the Act will be unworkable. There are strict timelines provided under Section 21 of the Act, whereas there are no timelines under Section 19 of the Act and the power under Section 19 of the Act can be exercised by the Registrar at any stage from the date of acceptance till the mark is registered irrespective of any opposition under Section 21 of the Act. The opposition under Section 21 of the Act serves the same purpose of non-registration of the mark, if the objections are accepted by the Registrar. In case an application is allowed to be filed for withdrawal of the acceptance under Section 19 of the Act, Section 21 of the Act would be rendered redundant. The artificial distinction between ‘acceptance’ and ‘registration’ of the mark as sought to be created by August Ventures is misconceived as acceptance is only a step in the entire process of registration and does not confer any right on the applicant unless the mark is eventually accepted for registration after the completion of stage of Section 21 of the Act.

41. In any case, Rule 38 of the Rules do not contemplate any hearing to be given to third party at the time of considering the objection raised by the Registrar under Section 19 of the Act.

42. In view of the above, no relief can be granted in WP 54 for directing the Registrar to consider the Application filed by August Ventures under Section 19 of the Act.

Maintainability of WP 56

43. August Ventures has challenged the Acceptance Orders on the ground that the Registrar has committed error in accepting the Application Nos. 5628002 and 5628003, therefore, August Ventures has sought quashing and setting aside of the Acceptance Orders.

44. August Ventures has relied upon ***Jai Bhagwan*** (supra) and ***Kaira District*** (supra) to argue that the Registrar has to apply mind prior to the Mark being advertised. Accordingly, the inaction of the Registrar to effectively apply its mind would entitle August Ventures to file the Writ Petition seeking setting aside of the Acceptance Orders.

45. August Ventures has filed successive Petitions on the same cause of action that arises from the passing of the Acceptance Orders. In WP 54, August Ventures has sought writ of *mandamus* against the Registrar for seeking direction against the Registrar for exercising the jurisdiction under Section 19 of the Act pursuant to the Acceptance Orders and in WP 56, August Ventures has sought writ of *certiorari* for setting aside the Acceptance Orders. Although the reliefs sough in both these Petitions are worded differently, it aims to achieve the same purpose of seeking withdrawal of the acceptance by the Registry.

46. The attempt of August Ventures to invoke the writ jurisdiction of this Court by filing two separate Petitions on the same issue amounts to forum shopping, especially when August Ventures has efficacious alternative remedy in form of filing objection under Section 21 of the Act. The

decisions in ***Jai Bhagwan*** (supra) and ***Kaira District*** (supra) are not applicable to the facts of the present case. In ***Jai Bhagwan*** (supra), the issue pertained to automatic advertisement of the application prior to acceptance under Section 18 of the Act. Whereas in the present case, the Applications of Innocenti have been accepted by following the process under Section 18 of the Act. In fact, in ***Kaira District*** (supra), this Court refused to exercise the extra ordinary jurisdiction vested by Article 226 of the Constitution of India, 1950 in face of efficacious alternative avenues available in the Act and directed to exhaust the remedy under Section 21 of the Act.

47. It is trite law that writ of *certiorari* can only be issued in case of grave jurisdictional errors, violations of natural justice or obvious mistakes apparent on the face of the record. In the facts of the present case, the Acceptance Orders cannot be termed as grave jurisdictional error as the Registrar has passed the Acceptance Orders as per the power conferred under Section 18 of the Act. Every wrong decision while exercising the of power under Section 18 of the Act cannot entitle invocation of writ jurisdiction, when there is a statutory remedy available to file an opposition under Section 21 of the Act for the very same purpose of opposing the registration if the acceptance is found to be wrong by the Registrar.

48. The contention of August Ventures that in cases where the Registry has committed gross abuse of the jurisdiction, the writ jurisdiction ought to be exercised as in case of ***Kamdhenu Limited*** (supra), cannot be accepted as this is not such a case where the Registrar can be said to have committed gross abuse of jurisdiction. From the facts of the present case, it is apparent that all the objections that are taken by August Ventures in WP 56 can be taken at the time of filing the objections under Section 21 of the Act and the

Registrar will be empowered to consider and decide the same after giving opportunity to August Ventures and Innocenti.

49. August Ventures' argument that filing opposition under Section 21 is burdensome when the Acceptance Orders are *ex facie* illegal and contradictory to the previous stand taken by the Registrar, is not sufficient to exercise the writ jurisdiction to set aside the Acceptance Orders as the very same grounds can be taken by August Ventures in opposition under Section 21 of the Act.

50. During the course of the hearing, it was revealed that August Ventures has already availed the remedy under Section 21 of the Act, without prejudice to the pendency of WP 54 and WP 56, in order to save limitation under Section 21 of the Act. This clearly shows that August Ventures has sought the same remedy under Section 21 of the Act, albeit without prejudice to the reliefs sought in WP 54 and WP 56.

51. Accordingly, WP 56 is not maintainable, and no relief can be granted as sought therein.

Appeal filed by Innocenti

52. Innocenti has challenged the Impugned Order rejecting the registration of the Mark, '' under Application No. 5628005 in Class 12.

53. Interestingly, the Registrar has taken completely contradictory stands in Acceptance Orders and the Impugned Order for the same Marks and between the same Parties. The submissions made on behalf of the Registrar opposing WP 54 and WP 56 as well as the Appeal are self-contradictory and mutually destructive.

54. This clearly shows that the Registrar has taken inconsistent stands in relation to the same Marks in the different Applications filed by Innocenti. In Acceptance Orders, the Registrar has accepted the justification given by Innocenti for accepting the Marks for advertisement, whereas the Registrar has rejected the acceptance of the same Marks in the Impugned Order.

55. The Impugned Order and the Acceptance Orders both cannot coexist. Accordingly, the Impugned Order is set aside on this ground alone as the reasoning given in the Acceptance Orders is completely opposite to the Impugned Order.

CONCLUSION:

56. In view of the above analysis, W.P.(C)-IPD 54/2025 and W.P.(C)-IPD 56/2025 are dismissed and the Appeal being C.A.(COMM.IPD-TM) 76/2024 is hereby allowed with direction to the Registrar of Trade Marks decide and pass a consolidated order after giving opportunity of hearing to both *August Ventures Private Limited* and *Innocenti SA* and after considering all the material and documents placed on record in accordance with the provisions of Sections 18, 21, 47 and 57 of the Act, as may be applicable, in the following pending Applications and Rectification Petitions:

i. Application No. 5628005 filed by *Innocenti SA* for the registration of Mark, '' in Class 12.

ii. Opposition by *August Ventures Private Limited* to Application No. 5628002 filed by *Innocenti SA* for the registration of Mark, 'LAMBRETTA' in Class 12.

iii. Opposition by *August Ventures Private Limited* to Application No. 5628003 filed by *Innocenti SA* for the registration of Mark, 'LAMBRETTA' in Class 25.

iv. Rectification Petition filed by *Innocenti SA* for rectification of the Mark ‘’(Device) bearing Application No. 350817.

v. Rectification Petition filed by *Innocenti SA* for rectification of the Mark, ‘LAMBRETTA’ (Word) bearing Application No. 2890657.

57. It is clarified that this Court has not expressed any opinion on the merits and the Registrar of Trade Marks shall decide all the above proceedings on their own merits without being influenced by any observations made in this Judgment. All the rights and contentions of the Parties on merits are kept open, and all the objections shall be considered by the Registrar of Trade Marks, while passing a consolidated reasoned order in the above proceedings as expeditiously as possible, and in any event within a period of three months from the receipt of the copy of this Judgment.

58. A copy of this Judgment shall be sent to the Registrar of Trade Marks at e-mail address: llc-ipo@gov.in, for necessary compliance.

TEJAS KARIA, J

JANAURY 31, 2026
‘A’/ ‘ap’