



2025:DHC:2991



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

% *Date of decision: 22<sup>nd</sup> April, 2025*

+ W.P.(C)-IPD 57/2021

M/S ZINE DAVIDOFF S.A.

.....Petitioner

Through: Mr. Ranjan Narula, Mr. Shakti Priyan  
Nair and Mr. Parth Bajaj, Advocates.

versus

UNION OF INDIA AND ANR

.....Respondent

Through: Mr. L.B. Rai, Mr. Ayush Pandita and  
Mr. Satvik Rai, Advocates for R-2.

**CORAM:**

**HON'BLE MR. JUSTICE AMIT BANSAL**

**AMIT BANSAL, J. (Oral)**

1. The present petition has been filed challenging the order dated 9<sup>th</sup> March, 2012 (hereinafter 'impugned order') passed by the erstwhile Intellectual Property Appellate Board (hereinafter 'IPAB').
2. By way of the impugned order, the IPAB allowed the rectification petition no. ORA/265/2010/TM/DEL/1994 filed by the respondent no.2 and removed the petitioner's mark '*DAVIDOFF*' bearing no.454875 from the Register. It was held that the impugned mark was wrongly renewed long after the statutory deadline for seeking renewal had expired. Thus, the mark was treated to have lapsed.
3. Mr. Ranjan Narula, counsel for the Petitioner, submits that the application for registration of the aforesaid mark in class 25 was filed on 30<sup>th</sup>



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May, 1986 and would have been valid till 30<sup>th</sup> May, 1993. However, the registration certificate for the said mark was only issued on 31<sup>st</sup> December, 1997.

4. Upon receiving the said certificate, the petitioner applied for renewal of the mark on 29<sup>th</sup> June, 1998 for a period of seven years from 30<sup>th</sup> May, 1993 to 30<sup>th</sup> May, 2000 which was within the statutory period of six months as evident from the letter dated 10<sup>th</sup> April, 2001 (Annexure P-14).

5. Thereafter, the petitioner further filed another application for renewal of the mark on 16<sup>th</sup> April, 2001 for a period of seven years from 30<sup>th</sup> May, 2000 to 30<sup>th</sup> May, 2007. Thus, the petitioner had sought renewal of the mark in a timely manner and the petitioner's mark had not expired at any point of time.

6. He further submits that the mandatory provisions of Section 25 of the Trade Marks Act, 1958 and Rule 64 of the Trade Marks Rules, 1959 were not complied with by the Trade Mark Registry, as no notice was issued to the petitioner under the Form O3 prior to the removal of the mark. Reliance in this regard is placed on the judgment of a division bench of this Court in ***Union of India v. Malhotra Book Depot***, 2013 (54) PTC 165 (Del) DB.

7. The predecessor Bench *vide* order dated 1<sup>st</sup> March, 2024, directed the Trade Mark registry to verify the issuance of Form O3 notice to the petitioner by way of an affidavit.

8. In the order dated 13<sup>th</sup> August, 2024 it was noted that the record pertaining to the Form O-3 notice of the Trade Mark Registry, Dwarka, New Delhi is not available.

9. The aforesaid position was also confirmed in the affidavit dated 26<sup>th</sup> September, 2024 filed on behalf of the Trade Marks Registry.



10. In *Epsilon Publishing House Pvt. Ltd. v. Union of India & Ors.*, 2017 (72) PTC 480 [Del], this Court took the view that the proprietor of a registered mark must not be penalized for the lapse of the Registry in failing to follow the procedure prescribed under the Act and the allied Rules. The relevant extracts of the judgment are as follows:

*“26. There may be merit in the contention that the Registrar has to follow the procedure as prescribed; however, the essential question is not whether the Registrar has any discretion in the matter, but, what are the consequences of the Registrar not following the established procedure? Plainly, in the facts of the present case, it is apparent that the Trademark Registry has not adhered to the timelines as required. Surely, respondent No. 3 cannot be penalised for the same and would be entitled to pursue its application for renewal of its trademark.”*

11. It is settled position of law that issuance of O-3 notice is a mandatory requirement which must be complied by the Trademark Registry. Reference in this regard may be made to *CIPLA Limited v. Registrar of Trade Marks & Ors.*, 2013 (56) PTC 217 [Bom] [DB]; *Union of India and Ors. v. Malhotra Book Depot*, (supra) and *Gopal Ji Gupta v. Union of India*, 2019 SCC OnLine Del 7670.

12. The aforesaid Judgments were relied upon by me in *Promoshirt SM. S.A. v. The Registrar of Trade Marks*, W.P.(C)-IPD 28/2024 decided on 24<sup>th</sup> October, 2024 and *Ashok Bhutani v. Registrar of Trademarks*, W.P.(C)-IPD 22/2024 decided on 27<sup>th</sup> September, 2024, wherein I had issued directions for issuance of certificates of renewal in similar circumstances.

13. Counsel for the petitioner submits that since all the aforesaid judgments, which changed the legal position with regard to renewal of a mark, came after the impugned order was passed by the IPAB, this aspect did not come up for consideration before the IPAB.



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14. In my considered view, in light of the legal position obtaining now on the basis of the aforesaid judgments, the petitioner would be entitled to the benefit of the same.

15. In the affidavit, the Trade Marks Registry has clearly admitted that it does not have any records to show that a form O3 notice was issued to the petitioner.

16. Accordingly, the present petition is disposed of with the following directions:

- a. The petitioner's mark 'DAVIDOFF' bearing trademark registration no. 454875 is restored to its original number in the Register.
- b. Respondent no.1 shall make necessary corrections in their database with respect to the renewal status and renewal date of the trademark application bearing no. 454875.

17. The Registry is directed to supply a copy of the present judgment to the office of the Controller General of Patents, Designs & Trade Marks of India on the e-mail- *llc-ipo@gov.in* for compliance.

**AMIT BANSAL, J**

**APRIL 22, 2025**

*Vivek/-*