IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

WRIT PETITION NO. 41 OF 2016

1. Harbans Singh Khanduja & Anr. ... Petitioners
Vs
1. The Registrar of Trade marks & Anr. ... Respondents

WITH
WRIT PETITION NO. 42 OF 2016

1. Harbans Singh Khanduja & Anr. ... Petitioners
Vs
1. The Registrar of Trade marks & Anr. ... Respondents

WITH
WRIT PETITION NO. 46 OF 2016

1. Harbans Singh Khanduja & Anr. ... Petitioners
Vs
1. The Registrar of Trade marks & Anr. ... Respondents

WITH
WRIT PETITION NO. 49 OF 2016

1. Harbans Singh Khanduja & Anr. ... Petitioners
Vs
1. The Registrar of Trade marks & Anr. ... Respondents

Mr. Hemant Thadani with Mr. Hiren Kamod, Mr. Minesh Andharia, Ms. Janhvi Chadha i/b M/s. Krishna & Saurashtri Associates for the Petitioners in all Writ Petitions.

Mr. Pradeep S. Jetly with Mr. Parag Vyas for the Respondents in all the Writ Petitions.

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CORAM : S.C. DHARMADHIKARI &
B.P. COLABAWALLA, JJ.

THURSDAY, 20TH OCTOBER, 2016

P.C. :

1. By this writ petition under Article 226 of the Constitution of India, the petitioner challenges a publication at the instance of the respondents and appearing in the Trade Mark Journal, copy of which is Annexure-E page 35 of the paper-book informing the general public that the trademarks appearing in the list appended thereto at page 36 have been removed from the Register as the same have not been renewed on time in accordance with the Trade Marks Act, 1999.

2. The petitioners are contending that the respondents are the authorities under the Trade Marks Act, 1999. The petitioners have an old and established business of manufacture and/or sale of parts and fittings of motor land vehicles. They adopted and used the trademark 'AUTOMANN' in relation to hand tools. They have marketed and sold their parts and fittings under this trademark. On 21st December, 1976, the second petitioner-firm made an application for

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registration of this trademark consisting of the word 'AUTOMANN' (label) in respect of hand tools included in Class-8. The trademark application was dealt with in due course and eventually the registration certificate was issued. There was a publication in the Trade Mark Journal also. Reliance is placed on Annexures C and D to support this argument. Thereafter, the petitioners expanded the business and their products gained popularity. They renewed the registration from 21st December, 1983 and the renewal was also notified and published in the Trade Mark Journal. It is only when the petitioners were surfing through the official website in or around August, 2015, that they came across the impugned publication. That is how this writ petition is filed claiming the declaration that the publication and impugned in the writ petition does not remove the trademark from the Register and some act will have to be performed prior to the said removal.

3. The only contention raised before us is that the mandate of Section 25(3) of the Act read with Rule 64 of the Trade Mark Rules, 2002, has not been followed. The mandate is that it is incumbent upon the Registrar to serve a notice in Form O-3

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upon the petitioner, being the registered proprietor, and thereafter affect the removal in accordance with this provision. In paragraph 10 of the writ petition, this is what is stated :

> *"10. A conjoint reading of Section 25(3) of the Trade Marks Act, 1999 and Rule 64 of the Trade Marks Rules, 2002, makes it explicitly clear that it is mandatory for Respondent No.1 to serve a notice on Form O-3 upon the Petitioner being the registered proprietor of the said trade mark before removal thereof from the Register of Trade Marks. It is submitted that Section 25(3) of the Trade Marks Act, 1999, contemplates a notice being sent in the prescribed manner to the registered proprietor of trade mark upon which a renewal of the registration may be obtained and the Registrar may remove the trade mark from the Register if those conditions as stated in the notice have not been complied. No such notice was ever served by Respondent No.1 to the Petitioners with reference to the removal of trade mark. Further, Rule 64 of the Trade Marks Rules 2002, contemplates the sending of notice on Form O-3 to the proprietor of trade mark at the address entered in the Register for renewal of trade mark before causing the mark to be removed from the Register and the same was also not done."*

4. In support of the above submissions, the learned counsel pressed into service a Division Bench judgment of this Court in the case of *CIPLA Ltd. vs. Registrar of Trade Marks and Anr*. Writ Petition No.1669 of 2012 decided on 23rd September, 2013.

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5. Upon a private notice, Mr. Jetly appears for the respondents. We specifically enquired with Mr. Jetly as to whether before publication or informing the public by the impugned publication, was there any compliance made with the requirement in the Act and the Rules. Meaning thereby, any notice was served on the petitioners as contended prior to the removal. Mr. Jetly, on instructions, fairly states that there is no record available of any notice being issued and the Registrar complying with the requirement of the Act.

6. In these circumstances, on this short ground alone and going by the mandate of the Act and the Rules, the writ petitions succeed. It is declared that by the sheer publication and appearing at page 35/36 of the paper-book, there is no removal effected of the trademark registered by the petitioners on 21st December, 1976. The respondents would have to take appropriate steps and in accordance with law in the event they decide on removal of the mark from the Register. Prior to affecting removal they would have to act in terms of Section 25 and the Trade Mark Rules referred above.

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7. The writ petitions succeed in these terms. There shall be no order as to costs. The mark shall stand restored to the Register only upon the petitioners paying the requisite renewal fees and as applicable within a period of two weeks from the date of receipt of a copy of this order.

8. In the facts and circumstances, we do not deem it necessary to decide any larger question, particularly whether the publication as is impugned in the present petition can be construed or interpreted as an order of removal under the Act and, therefore, appealable. We leave that controversy open for being decided in an appropriate case.

B.P. COLABAWALLA, J. ***S.C. DHARMADHIKARI, J.***

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