2024:MHC:3109

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 13.08.2024

CORAM:

THE HONOURABLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

W.P.(IPD) Nos.4 to 14 of 2024 (11 WPs)

In all WPs

Jaisuryas Retail Ventures Pvt. Ltd.
309/3 & 4, Veerappampalayam Pirivu
Perundarai Road
Erode-638 012
rep. By its Director
Mr.Rajendra Kamath ...Petitioner

Vs.

The Registrar of Trade Marks
The office of the Trade Marks Registry
Intellectual Property Office Building
G.S.T.Road, Guindy, Chennai-600 032 ... Respondent

Prayer in W.P.(IPD) No.4 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2355816 in class 35 and renew the same in accordance with due process of law.

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Prayer in W.P.(IPD) No.5 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2388120 in class 30 and renew the same in accordance with due process of law.

Prayer in W.P.(IPD) No.6 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2388121 in class 29 and renew the same in accordance with due process of law.

Prayer in W.P.(IPD) No.7 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2388122 in class 43 and renew the same in accordance with due process of law.

Prayer in W.P.(IPD) No.8 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2388118 in class 32 and renew the same in accordance with due process of law.

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Prayer in W.P.(IPD) No.9 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2355818 in class 32 and renew the same in accordance with due process of law.

Prayer in W.P.(IPD) No.10 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2388119 in class 31 and renew the same in accordance with due process of law.

Prayer in W.P.(IPD) No.11 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2355819 in class 31 and renew the same in accordance with due process of law.

Prayer in W.P.(IPD) No.12 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2388817 in class 43 and renew the same in accordance with due process of law.

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Prayer in W.P.(IPD) No.13 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2355820 in class 29 and renew the same in accordance with due process of law.

Prayer in W.P.(IPD) No.14 of 2024: Writ Petition filed under Article 226 of the Constitution of India to issue a Writ of Mandamus directing the Respondents to permit the Petitioner to file renewal application for renewing the trade mark registered under number 2388117 in class 35 and renew the same in accordance with due process of law.

In all WPs

For Petitioner : M/s.Arun C. Mohan, Brinda Mohan, S.Karthik, K.Venkatesan, Keerthikiran Murali, Swabhhi Tyagi, Shruthi Srinivasan, Vandana Jain, Advaidh M. Nelakanttan

For Respondent : Mrs.R.Durga Rani, CGSC

COMMON ORDER

In each writ petition, the petitioner seeks a direction to the respondent to permit the filing of a renewal application in respect of the registered trade mark forming the subject of the respective

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petition.

2. Mr.N.Shivaji Siddarth is the registered proprietor of each trade mark dealt with in these writ petitions. By an assignment deed dated 22.10.2021, he assigned these trade marks to the petitioner. As on date, details relating to the assignment have not been entered on the register in terms of the applicable provisions of the Trade Marks Act, 1999 (the Trade Marks Act) and the rules framed thereunder. After endeavoring to apply for renewal and being unsuccessful on account of lack of access to the website, the present writ petitions were filed.

3. Learned counsel for the petitioner submits that an obligation is imposed on the Registrar of Trade Marks to issue notice prior to the expiry of the last registration of the trade mark to the registered proprietor. He contends that the registered proprietor did not receive such notice from the Registrar of Trade Marks. He further submits that the respondent did not take any steps to remove the relevant trade marks from the register of trade

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marks and, consequently, these trade marks remain on the register as on date. By relying on the judgment dated 16.02.2024 of a Division Bench of the Bombay High Court in *Motwane Private Limited v. Registrar of Trade Marks and another, Writ Petition (L) No.30537 of 2023(Motwane),* he contends that the Bombay High Court concluded that the effect of the lapse on the part of the Registrar of Trade Marks to issue notice under sub-section (3) of Section 25 of the Trade Marks Act is that the registered proprietor would be entitled to make an application for renewal as long as the mark remains on the register of trade marks. He also relies upon an order of this Court in *M/s. V.A.Mishra & Sons v. The Registrar of Trade Marks, W.P.(IPD) No.16 of 2024, order dated 01.07.2024,* wherein this Court permitted the petitioner therein to apply for renewal in view of the failure of the Registrar of Trade Marks to issue notice under sub-section (3) of Section 25.

4. In response to these contentions, learned counsel for the respondent submits that the petitioner is not the registered

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proprietor of the trade marks and that the petitioner did not file an application in relation to the assignment. She further submits that notice under sub-section (3) of Section 25 read with sub-rule (1) of Rule 58 of the Trade Marks Rules, 2017 (the TM Rules) was issued to the registered proprietor. In order to substantiate this contention, she refers to the correspondence register and points out that the notice was dispatched on 25.03.2022 to Jus Pro Legal Services, which is the agent of the registered proprietor. Consequently, she contends that the statutory mandate was complied with by the respondent. She also submits that Section 25 read with Rule 57 of the TM Rules makes it clear that an application for renewal may be made only up to one year from the date of expiration of the last registration of the trade mark, and not thereafter. In support of these contentions, reliance is placed upon the judgment of the Delhi High Court in *Irvinder Kaur Chadha Supreme Agencies v. Garnish Electronic Pvt. Ltd. and another(Irvinder Kaur Chadha), 2024 SCC Online Del 5253*.

5. Upon taking note of the rival contentions, by way of

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preamble, it is pertinent to point out that a trade mark may be renewed for blocks of ten years at a time in perpetuity. Unlike other forms of intellectual property, such as patents, designs and even copyrights, which are granted for a specified maximum length of time; subject to renewal, a trade mark registration may be renewed without any limitations as to time. The current dispute should be examined by bearing in mind this overarching characteristic of this form of intellectual property.

6. Sub-section (1) of Section 25 prescribes the validity period of ten years for the registration of a trade mark subject to renewal thereof. Sub-section (2) specifies the procedure for renewal; sub-section (3) imposes an obligation on the Registrar to issue notice regarding the date of expiry of registration; and sub-section (4) enables restoration of a removed trade mark within the time limit specified therein. Since Section 25 is critical for the determination of this dispute, it is set out below:

> *"25.* ***Duration, renewal, removal and restoration of registration***

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(1) ***The registration of a trade mark, after the commencement of this Act, shall be for a period of ten years****, but may be* ***renewed from time to time in accordance with the provisions of this section****.*

(2) The ***Registrar shall, on application made by the registered proprietor of a trade mark*** *in the prescribed manner and* ***within the prescribed period*** *and subject to payment of the prescribed fee, renew the registration of the trade mark for a period of ten years from the date of expiration of the original registration or of the last renewal of registration, as the case may be (which date is in this section referred to as the date of expiration of the last registration).*

*(3)****At the prescribed time before the expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration*** *and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time*

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prescribed in that behalf those conditions have not been duly complied with the Registrar may remove the trade mark from the register:

Provided that the Registrar shall not remove the trade mark from the register if an application is made in the prescribed form and the prescribed fee and surcharge is paid within six months from the expiration of the last registration of the trade mark and shall renew the registration of the trade mark for a period of ten years under sub-section (2).

(4) ***Where a trade mark has been removed from the register for non-payment of the prescribed fee, the Registrar shall, after six months and within one year from the expiration of the last registration of the trade mark****, on receipt of an application in the prescribed form and on payment of the prescribed fee, if satisfied that it is just to do so,* ***restore the trade mark to the register and renew the registration of the trade mark*** *either generally or subject to such conditions and limitations as he thinks fit to impose, for a period of ten years from the*

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expiration of the last registration."
(emphasis added)

While sub-section (2) confers on the registered proprietor the right to apply for renewal of registration in the prescribed manner and within the prescribed time, sub-section (3) imposes an obligation on the Registrar to send notice to the registered proprietor in the prescribed manner and at the prescribed time prior to the expiry of the last registration of the trade mark. If the registered proprietor fails to apply for renewal in spite of receipt of such notice, sub-section (3) further enables the Registrar to remove the trade mark from the register of trade marks. The proviso to sub-section (3) qualifies the right of removal by prescribing that the Registrar shall not remove the trade mark from the register if an application is made within six months from the expiry of the last registration seeking renewal subject to payment of fees and surcharge. Sub-section (4) is also relevant and enables the registered proprietor to seek restoration of the trade mark within one year from the expiration of the last registration.

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7. These provisions should be read with Rules 57 to 61 of the TM Rules, which, in relevant part, are set out below:

> *"57. Renewal of registration-(1)* ***An application for the renewal of the registration of a Trade Mark*** *shall be made in Form TM-R along with the fee prescribed in the First Schedule and* ***may be made at any time not more than one year before the expiration of the last registration of the Trade Mark****.*
>
> *(2)* ***A request for renewal of registration of the Trade Mark filed within prescribed time shall be allowed unless the Trade Mark has been removed or cancelled or is otherwise not renewable*** *under any of the provisions of the Act and rules or by any order of the competent Court or the Registrar.*
>
> *58. Notice before removal of Trade Mark from register -(1)* ***In case no application for renewal of the registration*** *in the prescribed form together with the specified fee* ***has been received, the Registrar shall send, not more***

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than six months before the expiration of registration of the Trade Mark*, a notice in Form RG-3 at the address of service* ***informing the registered proprietor of the approaching date of expiration*** *and the conditions, if any, subject to which the renewal of registration may be obtained.*

....

59. Advertisement of removal of Trade Mark from the register- If at the expiration of registration of a Trade Mark, the renewal fees has not been paid, the Registrar may remove the Trade Mark from the register and advertise the same forthwith in the Journal:

Provided that the Registrar shall not remove the Trade Mark from the register if an application for payment of surcharge is made under proviso to sub-section (3) of section 25 in Form TM-R within six months from the expiration of the registration of the Trade Mark.

60. Restoration and renewal of registration – An application for the restoration of a Trade Mark to the register and renewal of its

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registration under sub-section (4) of section 25, shall be made in Form TM-R within one year from the expiration of the registration of the Trade Mark accompanied by the prescribed fee. The registrar shall, while considering the request for such restoration and renewal have regard to the interest of other affected persons.

61. Notice and advertisement of renewal and registration – Upon the renewal or restoration and renewal of registration, a notice to that effect shall be sent to the registered proprietor and every registered user and the renewal or restoration and renewal shall be advertised in the Journal."

(emphasis added)

8. Sub-section (2) of section 25 of the Trade Marks Act prescribes that the Registrar shall renew the registration of a trade mark for a further period of ten years if an application is received from the registered proprietor in the prescribed form and within the prescribed time. Rule 57 stipulates that the application for renewal shall be made in Form TM-R (prescribed form). Curiously, as regards prescribed time, Rule 57 enables the filing of

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such application "at any time not more than one year before the expiration of the last registration of the Trade Mark". In effect, the earliest date for filing such application is prescribed, but not the last date. By way of illustration, if a registration had been granted for a ten year period running from 01.01.2014 to 31.12.2023, the application for renewal may be filed at any time after 31.12.2022. Sub-section (3) of section 25 mandates that a notice be issued by the Registrar at the prescribed time before the expiration of the last registration to the registered proprietor so as to put such person on notice regarding the approaching date of expiry of registration. Rule 58 requires that this notice be sent in Form RG-3 "not more than six months before the expiration of registration of the Trade Mark". Reverting to the earlier illustration, this notice may be given only after 30.06.2023 if the last registration was expiring on 31.12.2023.

9. Subject to issuing notice in Form RG-3, the Registrar is empowered to remove the trade mark from the register in accordance with sub-section (3) of section 25 read with the proviso

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to Rule 59. Effectively, even after issuing notice, the Registrar cannot remove the trade mark from the register until at least six months have lapsed after the expiry of the last registration because the proviso to sub-section (3) precludes removal if an application is made with the prescribed fee and surcharge within the above-mentioned six month period. Upon expiry of this six month period, the trade mark may be removed subject to such removal being advertised forthwith by the Registrar as per Rule 59. Even thereafter, the registered proprietor has a further window of six months to seek restoration as per sub-section (4) of section 25 read with Rule 60.

10. From the above discussion, the conclusions that follow are that there is a statutory obligation on the Registrar of Trade Marks to issue notice under sub-section (3) of Section 25 read with sub-rule (1) of Rule 58 in case an application for renewal is not received in terms of sub-section (2) of Section 25 read with sub-rule (1) of Rule 57. Given the right of a registered proprietor to renew the registration for blocks of 10 years at a time, the obvious

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object and purpose of the notice is to inform the registered proprietor that the time limit for expiry of the registration is approaching and to take necessary action to renew the registration, if so intended. Indeed, even after removal, sub-section (3) of Section 25 read with Rule 59 prescribes that the removal should be advertised in the Trade Mark Journal. Once again, the object and purpose is to put the registered proprietor and the public on notice about the removal of the trade mark so as to enable such registered proprietor to take action for restoration in terms of sub-section (4) of Section 25 read with Rule 60, as also to enable any person interested in or affected by the trade mark to take consequential action.

11. In this case, as adverted to earlier, the trade marks have not been removed from the Register of Trade Marks. While the respondent asserts that notice in Form RG-3 was sent to the registered proprietor under dispatch No.5567145, the respondent is unable to place on record acknowledgment of receipt of such notice. Without such acknowledgment, it cannot be concluded that the registered proprietor of the trade marks/assignor of the

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petitioner received such notice. The consequences of the above, including non-removal, warrant consideration next.

12. As stated at the outset of this discussion, a trade mark is a form of intellectual property which may be registered and renewed in perpetuity for blocks of ten years at a time. The earliest date for seeking renewal is prescribed in sub-rule (1) of Rule 57, but not the end date. Such end date is only prescribed for restoration in sub-section (4) of section 25 read with Rule 60. The sequitur is that an application for renewal may be made at any time after the start date prescribed in Rule 57(1) if the trade mark has not been removed from the register. The rationale for prescribing an end date for restoration is that the removal of a trade mark is advertised and third party rights, including by way of conflicting registrations, may be created thereafter. Up to the prescribed end date for restoration, the creation of adverse or conflicting third party rights is mitigated by the legal fiction in section 26 that the removed trade mark will be deemed to be on the register for one year after removal unless it falls within the exceptions specified therein.

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13. Hence, the failure of the respondent to put the registered proprietor on notice with regard to the impending expiry of registration and remove the trade marks from the register thereafter opens the door for such registered proprietor or his successor-in-interest to seek renewal. In this connection, the order of the Delhi High Court in *Irvinder Kaur Chadha* is distinguishable inasmuch as notice under sub-section (3) of section 25 was duly served in that case on the registered proprietor. For reasons set out above, I concur with the conclusion of the Division Bench of the Bombay High Court in *Motwane.*

14. The petitioner is, however, not the registered proprietor of these trade marks as on date. Instead, the petitioner asserts rights under a deed of assignment. Therefore, it is necessary for the petitioner to first apply for registration of such assignment in accordance with the relevant provisions. Once the assignment is registered, it will be open to the petitioner to apply for renewal of these trade marks.

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15. For reasons set out above, these writ petitions are disposed of on the following terms:

(i) the petitioner is permitted to apply for registration of assignment in accordance with the Trade Marks Act, 1999. Upon receipt of such application, the same shall be considered expeditiously.

(ii) Within one month from the date of registration of the assignment, the petitioner is permitted to apply for renewal of registration of these trade marks. Until such time, the respondent shall not take any steps for the removal of these trade marks.

(iii) In order to enable the petitioner to apply for registration of the assignment and for renewal of these trade marks, the respondent is directed to provide access to the portal or, in the alternative, permit the petitioner to file necessary documents in the physical form.

(iv) There shall be no order as to costs.

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Index : Yes / No

Internet : Yes / No

Neutral Citation : Yes / No

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SENTHILKUMAR RAMAMOORTHY,J.

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To

The Registrar of Trade Marks
The office of the Trade Marks Registry
Intellectual Property Office Building
G.S.T.Road, Guindy, Chennai-600 032.

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