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

WRIT PETITION (L) NO. 30537 OF 2023

Motwane Private Ltd. … Petitioner

Versus

1. The Registrar of Trade Marks
2. Union of India …Respondents

Mr. Hiren Kamod i/b. Mr. Amit Kukreja and Ms. Haseena Khan for the petitioner.
Ms. Shruti Vyas, Spl. Counsel for UOI.

CORAM: G. S. KULKARNI &
FIRDOSH P. POONIWALLA, JJ.
DATED: 16 February, 2024

Oral Judgment : (Per G.S. Kulkarni, J.)

1. Rule. Returnable forthwith. Respondents waive service. By consent of the parties, heard finally.

2. This petition under Article 226 of the Constitution of India espouses a cause of action against the Registrar of Trade Marks-respondent no.1, in regard to non-renewal of three trademarks of the petitioner, which according to the petitioner inadvertently could not be renewed and which have continued to remain on the Register of Trade Marks.

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3. The relevant facts need to be noted: It is petitioner's case that it had registered the trade mark "MOTWANE" (for short "**the said mark**") under Nos. 312470, 312472 and 312473, which according to the petitioner was renewed by the petitioner upto 17 February, 1983. The said marks are stated to have been in continuous use by the petitioner in its business since 1976.

4. The petitioner contends that post 17 February 1983, the registration of these marks remained to be renewed. However, the marks continued to be reflected as the petitioner's registered marks in the trade mark register, as seen on the official website of the Registrar of Trade Marks.

5. It is contended that sometime in August 2023, the petitioner conducted a routine search of the status of its registered trade marks, including the trade mark in question, when the petitioner noticed that such trade marks were not renewed since the year 1983. It is contended that also a notice under sub-section (3) of Section 25 of the Trade Marks Act, 1999 read with Rule 58 of the Trade Mark Rules, 2017 was not received by the petitioner from respondent no. 1 in regard to the removal of these marks consequent to the non-renewal of the registration of the said marks. It is in these circumstances, the petitioner through its advocate filed separate applications under the Right to Information Act with the office of respondent no. 1 *inter alia* seeking details regarding the issuance of any removal notice by respondent no. 1. Such RTI

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applications were responded by the office of respondent no. 1 *inter alia* stating that no removal notice was issued, dispatched or delivered by respondent no. 1, in relation to any of the registrations of the subject marks. In these circumstances, the petitioner contends that as no notice under sub-section (3) of Section 25 of the Trade Marks Act was issued to the petitioner and the marks having continued to remain on the register of trade marks, it is an implicit recognition of the petitioner's legal right to seek renewal of the trade marks, by presenting appropriate renewal applications.

6. It is on such premise, the petitioner through its attorney made an attempt to apply for renewal of the registration of these three marks resorting to the online procedure, however, it was noticed that the online module available on the official website of the Trade Marks Registry, which is generally used for filing all the applications, did not provide any option for such renewal. This according to the petitioner was for the reason that the trade marks were not renewed in time. This stood confirmed by the impugned rejection generated by the system, with a remark which was to the effect that the petitioner's *"Application cannot be renewed (delay of more than one year)".* In these circumstances, the petitioner has approached this Court praying for the following reliefs:

> "a) this Hon'ble Court be pleased to issue a Writ of Prohibition or a Writ in the nature of Prohibition or any other Writ, order or direction, restraining respondent no. 1 from removing the petitioner's said mark

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> "MOTWANE" under the subject Registration Nos. 312470, 312472 and 312473 from the Register of Trade Marks on the ground of non-renewal of the registration.
>
> b) This Hon'ble Court be pleased to issue a Writ of Mandamus or a Writ in the nature of Mandamus or any other appropriate Writ, order or direction directing Respondent no. 1 to restore and renew the petitioner's said mark 'MOTWANE' under the subject registration nos. 312470, 312472 and 312473.
>
> c) that pending the hearing and disposal of the present petition, this Hon'ble Court be pleased to issue a direction/order restraining respondent no. 1 from removing the petitioner's said mark 'MOTWANE' under the subject Registration nos. 312470, 312472 and 312473 from the Registrar of Trade Marks."

7. Mr. Kamod, learned Counsel for the petitioner has supported the above prayers by contending that the petitioner has a legal right to seek renewal of the registraton of the marks in question, as the reasons/remarks as generated by the electronic system, would be untenable considering the clear provisions of Section 25 of the Trade Marks Act. It is submitted that a notice as per Section 25(3) of the Trade Marks Act was not received by the petitioner, which was an admitted position as communicated by respondent no. 1, in the reply to the petitioner's RTI applications. It is, hence, submitted that the petitioner's applications for renewal of the marks, as also such applications requiring consideration of respondent no. 1 would be the requirement of law. It is submitted that the petitioner therefore, cannot be left in a situation that the petitioner's applications for renewal are not maintainable.

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8. It is submitted by Mr. Kamod that the provisions of Section 25 of the Trade Marks Act in similar situation fell for consideration of the Courts. He submits that in a situation where the trade marks had continued to remain on the register of the Registrar of Trade Marks, the legal right of the proprietor of the marks to get the same renewed was recognised by the Courts. According to Mr. Kamod in such situation, it would be a clear mandate of the provision of Section 25 of the Trade Marks Act, that the renewal of the registration of the petitioner's marks ought not to be denied. In support of his submissions, Mr. Kamod has placed reliance on the decisions of Division Bench of this Court in **Cipla Ltd. vs. Registrar of Trade Marks Boudhik Sampada Bhawan & Ors.**[1]**;** in a batch of petitions in **Harbans Singh Khanduja & Anr. vs. The Registrar of Trade Marks & Anr.**[2] and on the decision in the case of **Ipca Laboratories Ltd. vs. The Registrar of Trade Marks & Anr.**[3]**.**

9. On the other hand, Ms. Vyas, learned Addl. Government Pleader has opposed this petition relying on the reply affidavit as filed on behalf of respondent no. 1. Her principal submission is that there is admittedly a delay and/or laches on the part of the petitioner in renewing the registration of the trade marks in question, hence it cannot be accepted that such default on the part of the petitioner, can in any manner amount to a fault of respondent no. 1.

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1 2014 (7) Bom. C.R. 863

2 Writ Petition No. 41 of 2016 and other petitions decided on 20 October, 2016

3 Writ Petition (L) No. 2015 of 2014 and 2016 of 2014 decided on 13 August, 2014.

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She would submit that such long delay would be fatal to the petitioner's case. She would, however, fairly submit that no notice under Section 25(3) of the Trade Marks Act and/or any procedure, as the law would mandate, for removal of the marks in question from the register of trade marks, was ever adopted by respondent No.1 in relation to the petitioner's trade marks in question. She would also fairly submit that if the petitioner intends to apply for renewal of the marks, the petitioner would be under an obligation to follow the procedure as prescribed under the rules and law, by filing appropriate applications and paying appropriate fees, so as to seek the renewal of their registration.

10. On such backdrop, we have heard learned Counsel for the parties. With their assistance we have perused the record.

11. Having heard learned counsel for the parties, we find much substance in the contentions as urged on behalf of the petitioner. There appears to be no dispute that the marks in question stood registered in the petitioner's name and as noted by us hereinabove. The petitioner however failed to renew the registraton of these marks. As respondent no. 1 did not adopt any procedure for removal of the marks from the register of trade marks, these marks, admittedly, have continued to remain in the register of marks as maintained by the Registrar of Trade Marks. It is not in dispute that there is a substantial delay on the part of the petitioner, that is the petitioner not taking steps to

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renew the registration of these marks. However, considering the clear position in law as Section 25 of the Trade Marks Act would bring about, namely no steps being taken by the trade mark registry, to remove the petitioner's marks from the register of trade marks, it appears that the right of the petitioner to seek renewal of the trade marks continued to subsist. Such is the clear mandate, which would flow from sub-section (3) of Section 25. We note the said provision, which reads thus:

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

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> of the prescribed fee, if satisfied that it is just so to do, restore the trade mark to the register and renew the registration of the trade mark either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of ten years from the expiration of the last registration.
>
> (emphasis supplied)

12. It is clear from the plain reading of Section 25 that sub-section (1) thereof would provide that the registration of a trade mark shall be for a period of ten years, but may be renewed from time to time in accordance with the said provisions. For such purpose, sub-section (2) provides that the Registrar shall, on application made by the registered proprietor of a trade mark within 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. However, what is significant is that sub-section (3), providing that 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 the payment of fees and otherwise, upon which renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf, those conditions being not duly complied, the Registrar may remove the trade mark from the register. The proviso below sub-section (3) ordains 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

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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). Although we are not concerned with sub-section (4), it is seen that sub-section (4) has made available an opportunity to the registered proprietor, in case, where a trade mark has been removed from the register for non-payment of the prescribed fee. In such case, the Registrar shall, after six months and within one year as the case may be, 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 is satisfied, that it is just so to do, restore the trade mark to the register and renew the registration of the trade mark, either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of ten years from the expiration of the last registration.

13. Having noted the scheme of Section 25 of the Trade Marks Act, we may observe that from a bare reading of sub-section (3) which is relevant in the present context, it is clear that before the expiration of the registration of a trade mark, it was mandatory for the Registrar to send notice, in the prescribed manner, to the proprietor of the mark, intimating the date of expiration of the registration, and the conditions as to payment of fees and otherwise, upon which, a renewal of registration could be obtained by the registered proprietor, and only on the expiration of the time prescribed in such notice, and if

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conditions as contemplated in the notice are not complied by the registered proprietor, the Registrar would be authorised to remove the trade mark from the register. Thus, in the facts of the present case, once such notice under sub-section (3) was not issued and the trade mark had continued to remain on the register of trade marks as maintained by the Registrar, it would be implicit, that in such situation, when there is a two-way lapse, that is, a lapse not only on the part of the registered proprietor in not making an application for renewal of registration, but also a lapse on the part of respondent no. 1, in not issuing notice of removal of the trade mark, the result would be, that the mark although not renewed would continue to remain on the register of respondent no.1, shown as the mark of the registered proprietor. In these circumstances, certainly an opportunity is available to the registered proprietor to make an application for renewal, for the reason that the mark is not removed from the register of trade marks, maintained by the Registrar.

14. In our opinion, sub-section (3) of Section 25 cannot be interpreted to mean that in the absence of a notice under sub-section (3) of Section 25 being issued to the registered proprietor, the right of renewal of the registration of the trade mark can be presumed to have extinguished or lost by the registered proprietor in any manner. Non-issuance of a notice under sub-section (3) would encompass a situation, that in the event such notice is issued, then certainly an opportunity is available to the registered proprietor to make an

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application for renewal. There cannot be any other reading of sub-section (3) of Section 25.

15. Thus, in a situation of a mutual lapse on the part of the petitioner in not renewing the registration of its marks within the prescribed time accompanied with an inaction on the part of respondent no. 1 in non-issuance of notice under Section 23(3) of the Trade Marks Act, would not in any manner work to the disadvantage of the petitioner/registered proprietor, so as to not recognize the petitioner's right to seek renewal of the registration of the trade mark. If this be the implication which is brought about by sub-section (3) of Section 25, then certainly, the petitioner is entitled to maintain its application for renewal of the registration of its trade marks, and in such event the electronic module should not have generated a remark that there is lapse of one year, so as to not recognise the petitioner's renewal applications. Thus, the impugned communication as received by the petitioner in not recognizing the petitioner's application for renewal would be in the teeth of provisions of sub-section (3) of Section 25.

16. In the above circumstnaces, Mr. Kamod would also be justified in relying on the decision of this Court in *Cipla Ltd.* (supra) where the Court considering the decision of the Delhi High Court in ***Malhotra Book Depot vs. Union of India & Ors.***[4] has recognized the right of the petitioner therein, to

4 2012 (49) PTC 354 (Del.)

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maintain its renewal application. In such decision, the Court considering the fact that there was nothing on record that a requisite notice was sent to the petitioner as mandated by sub-section (3) of Section 25, directed the respondents to grant restoration and renewal of trade mark registration of the petitioner.

17. The decision in ***Harbans Singh Khanduja***'s case (supra) was similar to the facts of the present case wherein the petitioners had not renewed the registration of their marks from 21 December, 1983 and such non-renewal was also notified and published in the Trade Mark Journal. In such case in or around August, 2015, when the petitioners were surfing the official website of the trade mark registry, it was revealed to them that the petitioners trade marks were removed from the official register, as the same were not renewed. The Court, considering the provisions of Section 25 of the Trade Marks Act read with Rule 64 of the Trade Mark Rules, as also referring to the decision in *Cipla Ltd.* (supra), observed that the Registrar of Trade Marks was under an obligation to take appropriate steps in accordance with law [section 25(3)], in the event the trade mark registry intended to remove the marks from the register and prior to effecting any removal, it was incumbent for the Registrar to act in terms of Section 25(3) of the Trade Marks Act. On such observations, the petitions were allowed.

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18. Similar view was taken in ***Ipca Laboratories Ltd.*** (supra) wherein the petitioners having not received from the Registrar of Trade Marks a notice as per Section 25(3) of the Trade Marks Act, notifying the petitioners, the date of expiration of the registration of the trade marks and the conditions as to payment of fees and otherwise upon which, a renewal of registration may be obtained, the Court directed the respondents to grant restoration and/or renewal of the marks.

19. Thus, the common thread which would run through these decisions is to the effect that in the absence of notice issued under sub-section (3) of Section 25 of the Trade Marks Act, any removal of the trademark from the register of the trademarks as maintained by respondent no. 1 cannot be recognized, as also, in such situation the right of the proprietor of the trade mark to renew the trademarks, by making an application and by submitting the prescribed fees would also stand recognized. Considering such legal position, with certitude, we may observe that the legal right of the petitioner to seek renewal of registration of the trade marks in question would subsist. Consequently, the petitioner's applications need to be considered and granted subject to all the other procedural compliances being met by the petitioner.

20. In view of the above discussion, the petition needs to succeed. We, accordingly, allow the petition by the following order:

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ORDER

(i) The impugned communication Exhibits 'F', 'F-1' and 'F-2' to the effect that the applications of the petitioner cannot be renewed, for the reason of delay of more than one year are quashed and set aside.

(ii) It is held that the petitioner is entitled to maintain applications in the prescribed form and on payment of prescribed fees for renewal of registration of its trademarks in question, which be granted by respondent No.1 in accordance with law on the petitioner satisfying other procedural requirements.

(iii) The petitioner is permitted to make the requisite applications either in the physical form or by the electronic module (if so made available) within a period of two weeks from the day a copy of the same is made available, which be considered and granted as per the above directions within a period of two weeks thereafter.

(iv) Rule is made absolute in the aforesaid terms. No costs.

(FIRDOSH P. POONIWALLA, J.) (G. S. KULKARNI , J.)

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