

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 24.06.2016

CORAM

THE HON'BLE MR.JUSTICE M.JAICHANDREN

W.P.No.32851 of 2015

M/s.Soudal,  
Joint Stock Company registered  
under the laws of Belgium  
Everdongelaan 20  
Turnhout, Belgium  
having local address at :  
De Penning & De Penning  
120, Velachery Main Road,  
Guindy, Chennai-600 032  
represented by its Authorized Signatory. ...Petitioner

Vs.

The Registrar,  
Trade Marks Registry,  
Government of India,  
IP Buildings, GST Road,  
Guindy,  
Chennai-600 032. ...Respondent

The writ petition is filed under Article 226 of the Constitution of India praying for the issue of a writ of certiorarified mandamus calling for the impugned order, i.e., the return endorsement dated 30.11.2012 returning the petitioner's representation dated 31.10.2012 (including interlocutory petition and affidavit of renewal) and to quash the same and consequently, direct the respondent to take on file and process the petitioner's representation dated 31.10.2012 (including interlocutory petition and affidavit of renewal).

For Petitioner : Mr.Dwarakesh Prabhakaran  
For Respondent : Mr.P.Saravanan, ACGSC

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ORDER

Heard the learned counsel appearing on behalf of the petitioner, as well as the learned counsel appearing on behalf of the respondent.

2 This writ petition has been filed, praying that this Court may be pleased to issue a Writ of Certiorarified Mandamus, to call for the records relating to the endorsement made by the respondent, on 30.11.2012, on the application of the petitioner, for the renewal of the Certificate of Registration, bearing No.297539, dated 15.3.2004, and to direct the respondent to remove the said endorsement and to return the application made by the petitioner, for the renewal of the registration, for being re-presented by it.

3 The petitioner has stated that it is a Company registered under the laws of Belgium. The petitioner had filed an application before the respondent, dated 23.11.1994, for the registration of its trade mark (label mark in series) "SOUDAL" in Class 2 (paint, varnishes, lacquers; preservatives against rust and against deterioration of wood; coats and filling products comprised in this class; plasters, colourants; mordants; raw natural resins for all use; mastics (natural resin); water proof products comprised in this class). The mark was limited to colours : Red, Black and White. After the necessary amendments had been made by the petitioner, the application of the petitioner had been accepted by the respondent and the respondent had published the proposed trade mark, in the Trade Mark Journal, dated 25.8.2003.

4 It had been found, from the online records of the Trade Mark Registry, that the trade mark applied for by the petitioner had been registered. The online records had shown that the Certificate of Registration, bearing No.297539, dated 15.3.2004, had been issued. However, the petitioner had not received the said certificate. As such, the respondent had violated the requirement of Section 23(2) of the Trade Marks Act, 1999, herein-after referred to as "the Act".

5 It has been further stated that Section 25(3) of the Act, read with Rule 64 of the Trade Marks Rules, 2002, specifically mandates that the respondent shall, not more than 3 months before the expiration of the registration and if no renewal application had been received, send a notice to the registered Proprietor of the trade mark, relating to the expiry of the trade mark and its renewal. The respondent had not issued such a notice to the petitioner. However, the petitioner company was surprised to know, while conducting a routine check of the status of the trade mark of the petitioner, during the month of October, 2012, that the registration of the trade mark of the petitioner had been removed from the Trade Mark register. It had also been learnt that the period for filing I.P. for restoration was 31.3.2011. In such circumstances, the application filed by the petitioner, for renewal of the registration of the trade mark, had been returned by the respondent, with an endorsement, dated 30.11.2012, stating that the status of the application

shows that the registration of the trade mark of the petitioner had been removed and that the period for filing the I.P. for restoration was 31.3.2011 and that there is no order for extension.

6 At this stage of the hearing of the writ petition, the learned counsel appearing on behalf of the petitioner had submitted that the respondent had failed to issue to the petitioner the Certificate of Registration of the Trade Mark of the petitioner, bearing No.297539, dated 15.3.2004. Further, the fixing of the cut off date for the renewal of the expired registration, as 31.3.2011, is arbitrary, illegal and void. The petitioner had no knowledge of the expiry of the Registration of the Trade Mark of the petitioner, as no notice had been issued to the petitioner in this regard, as per Section 25(3) of the Act, read with Rule 64 of the Trade Mark Rules, 2002. As such, the respondent is not justified in returning the application of the petitioner, dated 31.10.2012, for the renewal of the Certificate of Registration, with an endorsement that it was out of time.

7 The learned counsel appearing on behalf of the petitioner had relied on the decision of the High Court of Delhi, made in Union of India and others Vs. Malhotra Book Depot [2013 (134) DRJ 504 (DB)] and the decision of the High Court of Bombay, made in CIPLA Ltd. Vs. Registrar of Trade Marks and another [2014 (2) Mh. L.J. 315], wherein it has been held that the impugned order, which has been passed without following the relevant provisions of Section 25(3) of the Act, and the Trade Mark Rules, 2002, cannot be held to be valid in the eye of law. It had further been held that a public notice issued by the Trade Mark Registry would not constitute compliance with the provisions of Section 25(3) of the Act, which requires the Registrar to send the notice to the registered Proprietor of the trade mark. A general public notice is not contemplated under the said section.

8 In such circumstances, the learned counsel appearing on behalf of the petitioner had submitted that this Court may be pleased to permit the petitioner to re-submit the application for renewal of the Certificate of Registration, bearing No.297539, dated 15.3.2004 and to direct the respondent to consider the same and pass appropriate orders thereon, for renewal of the registration of the trade mark of the petitioner, within the time limit as fixed by this Court.

9 The learned counsel appearing on behalf of the respondent has no serious objection for this Court passing such an order.

10 In such circumstances, the petitioner is permitted to re-submit the application for renewal of the Certificate of Registration, bearing No.297539, dated 15.3.2004, within a period of fifteen days from the date of receipt of a copy of this order. On receipt of the application, re-submitted by the petitioner, the respondent shall consider the same and pass appropriate orders, with regard to the renewal of the registration of the trade mark of the petitioner, as prayed for by the petitioner, in the present writ petition, within a period of eight weeks thereafter, after giving an opportunity of hearing to the authorized representative of the petitioner and without raising the question of delay in preferring the application, if the petitioner is otherwise eligible and entitled for such renewal.

11 The writ petition is disposed of with the above direction. No costs.

vvk

Sd/-  
Asst.Registrar

/true copy/

Sub Asst. Registrar

To

The Registrar,  
Trade Marks Registry,  
Government of India,  
IP Buildings, GST Road,  
Guindy, Chennai-600 032.

+ 1 cc to Mr.P.Saravanan, Advocate Sr 35184

+ 1 cc to Mr.Dwarakesh Prabhakaran, Advocate Sr 35206

KR/12/7/16

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