

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
WRIT PETITION NO.850 OF 2015

Kleenage Products (India) Private Limited)
a company registered under the Companies Act,))
1956, having its registered office at Gat No.227,))
228 & 230, Alandi Markal Road, Village Markal,))
Tal: Khed, Dist. Pune 412105, Maharashtra.) ... Petitioner

Vs.

1. The Registrar of Trade Marks)
Boudhik Sampada Bhawan,)
S. M. Road, Antop Hill, Mumbai - 37.)

2. Union of India)
Through Ministry of Commerce)
Dept. of Industrial Policy & Promotion)
Udyog Bhawan, New Delhi - 110011.)
And also at-)
Ministry of Law & Justice, Aaykar Bhavan)
Annexe, 2nd Floor, New Marine Line,)
Mumbai - 400 020.) ... Respondents

Mr. Hiren Kamod a/w. Ms Rinku Gajria and Ms Raina Gajria i/b. Gajria
& Co. for Petitioner.

Mr. Advait M. Sethna i/b. Mr. Parag Vyas for Respondents No.1 and 2.

**CORAM : R. M. BORDE &
R. G. KETKAR, JJ.
DATE : JANUARY 17, 2018**

ORAL JUDGMENT (PER R. M. BORDE, J.) :

Heard.

2. Rule. With the consent of the parties, Petition is taken up for
final hearing.

3. The petitioner is praying for issuance of Writ of Prohibition or any other Writ or direction in the nature of prohibition prohibiting the respondent No.1 or his subordinate officers from removing the trademark 'KLITOLIN' under No.379894 from the records of the register of trademarks maintained by respondent No.1. The petitioner is also praying for quashment of the directions issued by the respondent No.1 whereby the petitioner's trademark, more specifically referred to above, has been removed from the register or is not being permitted to be restored or renewed. The petitioner is also praying for issuance of directions to the respondent No.1 to restore and renew the petitioner's trademark for further period of 10 years with effect from 21.08.2009.

4. The petitioner is a private limited company duly incorporated under the Companies Act, 1956 in India and is engaged in the business of manufacture and sale of washing and cleaning preparations. The petitioner is the owner of various trademarks including 'SWAN BRAND' and 'KLITOLIN' under which its various products are sold. An application was tendered by the petitioner praying for registration of the trademark 'KLITOLIN', which was accepted by the respondent No.1 and the trademark was duly registered. The trademark was thereafter renewed from time to time from 21.08.1988 to 21.08.2009. The trademark was due for renewal on 21.08.2009. However, inadvertently, petitioner did not tender application for renewal. It is the contention of the petitioner that the respondent No.1 also failed to issue the requisite mandatory notice in Form O-3 to the registered proprietor under Section 25(3) of the Trade Marks Act, 1999. It was thereafter revealed that the said trademark is likely to be removed from the register. According to the petitioner, since the respondent No.1 has failed to issue O-3 notice, which was mandatorily required to be issued under Section 25(3) of the Trade Marks Act, 1999, the respondent No.1 ought to allow restoration

and renewal of the said trademark. Respondents have presented affidavit in reply and controverted the contentions raised by the petitioner. According to the respondents, the petitioner has renewed the trademark from time to time upto 21.08.2009. However, thereafter, it was not renewed. The respondents have further contended that the communication of the next renewal i.e. O-3 notice under Section 25(3) of the Trade Marks Act, 1999 in respect of the registered trademark gained by the petitioner does not appear on record. The petitioner, placing reliance on the judgment in the matter of ***Cipla Limited Vs. Registrar of Trade Marks and another, Writ Petition No.1669 of 2012*** decided by the Division Bench of this Court on 23.09.2013, contends that respondent No.1 is mandatorily required to issue a notice in Form O-3 and in the absence of issuance of such notice or production of record indicating issuance of such notice, the trademark in question cannot be removed from the register. In the judgment delivered by the Division Bench of this Court in ***Cipla's matter***, reference is made to the judgment of the Delhi High Court reported in **2012 (49) PTC 354 (Del.)**. It is observed in paragraph 16 of the said judgment, as quoted below:

“16. The scheme of the Act and the Rules, therefore, is that before the removal of the mark from the register, the Registrar must give prior notice in form O-3 to the registered proprietor or to each of the joint registered proprietors in writing, putting them to notice of the impending expiry of registration of the mark. The removal of the registered mark from the register entails civil consequences for the registered proprietor of the mark. The said removal of the registered trade mark, in the scheme of things, therefore, cannot be done without prior notice to the registered proprietor/joint proprietors in the prescribed form. The mere expiration of the registration by lapse of time, and the failure of the registered proprietor of the trade mark to get the same renewed, by itself, does not lead to the conclusion that the same can be removed from the register by the Registrar of Trade marks without complying with the

mandatory procedure prescribed in Section 25(3) of the aforesaid Act or read with Rule 67 of the aforesaid Rules. Removal of the registered mark from the register without complying with the mandatory requirements of Section 25(3) of the aforesaid Act read with Rule 67 of the aforesaid Rules would itself be laconic and illegal.”

5. If the registered proprietor does not make an application for renewal till two months prior to the expiration of the last registration, the Registrar is required to notify the registered proprietor of the approaching expiration (under Rule 67) and is to remove the trademark from the register only thereafter, as is evident from Rule 68 having been placed after Rule 67. If removal pursuant to non-renewal was to be de hors the notice for removal, Rule 68 would have followed Rule 66 and not Rule 67. Though Rule 68 permits removal upon expiration of last registration and non-payment of renewal fees and does not make the same dependent upon compliance of Rule 67 but to read Rule 68 permitting removal de hors compliance of Rule 67 would be contrary to Section 25(3) which as aforesaid permits removal only if at the expiration of the time prescribed in the notice required to be sent thereunder, the registered proprietor has not applied for renewal. It is a settled principle of law that rules framed under the Statute cannot override the Statute [paragraph 16 - **2013 (54) PTC 165 (Del)**]. The judgment in the matter of **Cipla Limited** has been followed in various judgments delivered by this Court in identical circumstances. In the instant matter, it is the contention of the respondent that the record in respect of issuance of O-3 notice is not traceable. An identical issue had arisen for consideration in the matter of **Court Receiver, High Court, Mumbai Vs. Registrar of Trademarks and another, Writ Petition No.1259 of 2015** decided by the Division Bench of this Court on **04.10.2016**. The Division Bench of this Court turned down the arguments advanced on behalf of the respondent and has observed that

in the absence of any reliable evidence in support of the stand taken by the respondent that O-3 notices were sent, it was difficult to accept the contention that the O-3 notices were duly sent. In the absence of documentary evidence in respect of the contentions raised by the respondent, it cannot be concluded that such notices were sent and the petitioner is in receipt of the same.

6. In view of the judgment in the matter of **Cipla Limited** as well as the judgment delivered by the Division Bench, referred to above, the contentions raised by the petitioner in the instant Petition deserve to be allowed. For the reasons recorded above, Writ Petition is allowed. Rule is made absolute in terms of prayer clauses (a) and (b). The respondents are directed to consider the application tendered by the petitioner for renewal of the trademark subject to payment of requisite fees.

(R. G. KETKAR, J.)

(R. M. BORDE, J.)

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