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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 22.04.2022

CORAM :

THE HONOURABLE MR.JUSTICE M.GOVINDARAJ

W.P.Nos.3768 & 3769 of 2011

&

M.P.Nos.1 & 2 of 3769 & 3768 of 2011

Marico Limited.,
5th Floor, Rang Sharda,
Bandra Reclamation,
K.C.Marg,
Bandra West,
Mumbai.
rep. by its Authorized Signatory,
Mr.Vijayalakshmy Malkani

...Petitioner in both WPs.

vs.

1. The Deputy Registrar of Trademarks,
Trademark Registry, IP Building,
GST Road, Guindy,
Chennai-600 032
2. The Registrar of Trademarks,
Bhoudhik Sampada Bhavan, near Antop Hill,
Head Post Office, Antop Hill,
Mumbai-400 037 ...Respondents 1 & 2 in both WPs.
3. S.Siva Subramaniyan, Proprietor,
Divine Pharmaceuticals,
Polaythodu, Mundakkal, Kollam,
State of Kerala-691 001.
...3rd respondent in WP.No.3768 of 2011
- 4.Mathewsons Exports & Imports (P) Ltd.,
Mathewsons Building, Kaloor, Cochin,
State of Kerala. ...3rd respondent in WP. No.3769 of 2011

Writ Petitions filed under Article 226 of the Constitution of India, praying for issuance of a Writ of Certiorari,

(i)to call for the records connected with the impugned order dated January 21, 2011, made in Rectification no.259345 in Class 3 to the Registered Trademark Application no.1109980 in Class 3 passed by the 1st respondent and quash the same as being without



jurisdiction(prayer in in WP. No.3768 of 2011).

(ii)to call for the records connected with the impugned order dated February 10, 2011, made in Rectification no.259225 in Class 3 to the Registered Trademark Application no.1109980 in Class 3 passed by the 1st respondent and quash the same as being without jurisdiction(prayer in in WP. No.3769 of 2011).

For Petitioner (in both WPs): M/s.Elizabeth Seshadri for
Mr.Iyer & Thomas

For Respondents(in both WPs) : Mr.N.Ramesh, Senior counsel
for RR1 & 2

: Mr.John Mathew for R3

COMMON ORDER

These writ petitions have been filed under Article 226 of the Constitution of India, seeking for issuance of a Certiorari, to call for the records connected with the impugned order dated January 21, 2011, made in Rectification no.259345 and impugned order dated February 10, 2011, made in Rectification no.259225 respectively in Class 3 to the Registered Trademark Application no.1109980 in Class 3 passed by the 1st respondent and quash the same as being without jurisdiction.

2.The petitioner Company incorporated under the Companies Act is a leading manufacturer and merchant of various consumer products and a leading provider of skin care services and global ayurvedic business. The petitioner is inter alia the proprietor of the Trademark ''MANJAL'' in respect of toilet/bath soap, which is registered in India under registration no.1109980 in Class 3 of the Trade Marks Act, 1999 since June 07, 2002 in respect of Ayurvedic bath soap.The said Trademark was registered in the name of M/s.Oriental Extractions Private Limited, an Indian Company and was subsequently assigned to the petitioner vide a Deed of Assignment dated 03.01.2006 together with good will of the business. An application for recording the petitioner as the subsequent Proprietor has been filed with the first respondent vide TM-24 on 14.01.2008. However, the first respondent by his order dated 28.07.2010 refused to record the assignment in view of the pendency of rectification petition filed by the third respondent. During April 2007, the petitioner came to know that the third respondent was selling both soaps under the trademark ''MANJAL'' along with the word AYUR, which was residually similar registered trademark of the petitioner. Hence, the petitioner issued notice on 05.04.2007 to the third respondent to cease from using trademark ''MANJAL'' on 23.04.2007. However, the third respondent is denying the



petitioner's right to use the trademark. Hence, he filed a suit in O.S.No.550 of 2008 on the file of the Delhi High Court for permanent injunction. Injunction was granted in favour of the petitioner against the third respondent. But the third respondent in his Written Statement filed before the Delhi High Court on 08.05.2008, challenging the validity of the registered trademark and filed a rectification application dated 17.07.2008 before the first respondent, for rectifying the trademark. The petitioner has filed Interlocutory Application dated 10.10.2008 to return the rectification application by invoking Section 125 of the Trademarks Act 1955 and also questioning the jurisdiction of the first respondent to deal with rectification application. However, the first respondent without acceding to the request of the petitioner, hastily decided the rectification application and removed the registered trademark of the petitioner, which is under challenge in these Writ Petitions.

3.The learned counsel for the first and second respondents would contend that there is an avenue of Appeal available to the petitioner and without exhausting this Appeal remedy, the petitioner has rushed to this Court and hence, these Writ Petitions are not maintainable.

4.Heard both sides.

5.The learned counsel for the third respondent though appeared, has not made his submissions.

6.The entire issue revolves around the jurisdiction of the first respondent in passing the order in rectification application filed by the third respondent. Admittedly, the petitioner had filed a suit in O.S.No.550 of 2008 for permanent injunction on the file of the Delhi High Court and obtained interim injunction. It is relevant to extract Section 125 of the Trademarks Act, which reads as under:

"125. Application for rectification of register to be made to Appellate Board in certain cases.-

(1)Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the



register and, notwithstanding anything contained in section 47 or section 57, such application shall be made to the Appellate Board and not to the Registrar.

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(2) Subject to the provisions of sub-section (1), where an application for rectification of the register is made to the Registrar under section 47 or section 57, the Registrar may, if he thinks fit, refer the application at any stage of the proceedings to the Appellate Board."

7. The substance of the above statutory provision is that when a suit for infringement of a registered trade mark is pending before the Competent Court, where the validity of the registration is challenged by the defendant, if at all he filed an application for rectification, it shall be made before the Appellate Board and not to the Registrar. Even, in case, where an application for rectification of the register is made to the Registrar under Sections 47 or 57, the Registrar may, refer the application at any stage of the proceedings to the Appellate Board. In effect, the power of determination of the rectification application during the pendency of the suit for infringement of a registered trade mark, shall be placed before the Appellate Board for specific performance. In other words, the Registrar has no jurisdiction to deal with such rectification application during the pendency of the suit for infringement.

8. It is also relevant to refer to Section 45 of the Trademarks Act, with regard to the registration of assignments and transmissions, where a person becomes entitled by assignment or transmission to a registered trade mark, he/she shall apply in a prescribed manner to the Registrar to register his/her title before him. On such application being filed, the Registrar may request the applicant to furnish evidence or proof or to clarify the doubts as to the veracity of the statement made or the documents furnished and in case he does not accept or not satisfied, he may refuse to register the assignment and refer the parties to sue. In case, there is any dispute between the parties, he can refuse to register the assignment and can refer the parties to resolve the dispute before the Competent Court. But in all other cases, where there is no dispute, he shall pass appropriate orders. In the instant case, the first respondent had rejected the application for assignment on the ground of pendency of rectification application, which is not a ground contemplated under Section 45 of the Act. Further, in spite of objection taken out by the petitioner with respect to entertaining the rectification application, in view of Section 125 of Trademarks Act, and the pendency of suit for injunction



before the Competent Court, the impugned orders have been passed.

9. It is also relevant to note that the first respondent while refusing to register the assignment in the name of the petitioner, proceeded with the rectification application under the pretext that the owner of the trademark was a different person namely, M/s. Oriental Extractions Private Limited., and the quietus of the rectification is sustainable and there is no embargo ultimately while deciding the issue. Ultimately, in the order passed by the first respondent, it is not that the trade mark made by the M/s. Oriental Extractions Private Limited is removed, on the other hand, the trademark owned by the petitioner is said to have been removed. On one hand, the first respondent proceeded with the rectification on the ground that the petitioner has nothing to do with that and the suit filed by the petitioner will not be a bar under Section 125 of the Trademarks Act. On the other hand, without acceding to the request of the petitioner, hastily decided the rectification application and removed the registered trademark of the petitioner, which in the opinion of this Court, is colourable exercise of power. The first respondent exercised his power with an ulterior motive to pass adverse order against the petitioner.

10. From perusal of the impugned order placed before this Court, it is noted that the order came to be passed mechanically without application of mind, printing the same name as applicant whereas, in rectification application no.259225, this application has been filed by M/s.Mathewsons Exports & Imports (P) Ltd, it is defined as S.Siva subramaniyan, who is an applicant in other rectification petition. Besides this, the rectification application filed by the said Siva Subramanian was decided against the petitioner on 21.01.2011. As rightly concluded by the first respondent, the matter stood abated in the case of rectification petition filed by M/s.Mathewsons Exports & Imports (P) Ltd. Subsequently, the order passed by M/s.Mathewsons Exports & Imports (P) Ltd dated 10.02.2011 is also shows non-application of mind to the statutory provisions which appears that the first respondent decided the application without the jurisdiction.

11. Therefore, this Court is of the view that the order passed by the first respondent is without jurisdiction in view of Section 125 of the Trademarks Act as well as it suffers from non-application of mind.

12. Accordingly, these Writ Petitions are allowed and the impugned order dated January 21, 2011, made in Rectification no.259345 and impugned order dated February 10, 2011, made in Rectification no.259225 respectively in Class 3 to the Registered Trademark Application no.1109980 in Class 3 passed by



the 1st respondent are hereby set aside.No costs. Consequently, connected miscellaneous petitions are closed.

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Sd/-
Assistant Registrar(CS-IX)

//True Copy//

Sub Assistant Registrar

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To

1. The Deputy Registrar of Trademarks,
Trademark Registry, IP Building,
GST Road, Guindy, Chennai-600 032
2. The Registrar of Trademarks,
Bhouthik Sampada Bhavan, near Antop Hill,
Head Post Office, Antop Hill,
Mumbai-400 037.

+1cc to M/s.Elizabeth Seshadri, Advocate, S.R.No.28287

W.P.No.3768 & 3769 of 2011

AD(CO)
RGA(25/05/2022)