



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 17.10.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/6/2023  
(OA/21/2011/TM/CHN)

Marico Limited,  
Rang Sharda, K.C.Marg,  
Bandra Reclamation,  
Bandra (W),  
Mumbai - 400 050.

... Appellant

-VS-

1.Mathewsons Exports & Imports Pvt. Ltd.,  
No.1, Mathewsons Building,  
Kaloor, Cochin - 682 017.

2.S.Sivasubramaniam,  
No.2, M/s.Divine Pharmaceuticals,  
Keerthibhavan,  
Polaythodu, Kollam - 691 001.

3.The Deputy Registrar of Trade Marks,  
No.3, Office of the Trade Marks Registry,  
IP Building, GST Road,  
Guindy, Chennai 600 032.

... Respondents



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**PRAYER:** Transfer Miscellaneous Appeal (Trade Marks) is filed under Section 91 of the Trade Marks Act, 1999, praying that the order dated November 2, 2010 passed by the Respondent vide official letter no.PR/150 266 be set aside and the request for recordal of assignment be taken on record and the appellant be made the subsequent proprietor of the registered assigned trade marks.

For Appellant : Ms.Elizabeth Seshadri  
for M/s.Iyer & Thomas

For Respondent 1 : Mr.A.Swaminathan

For Respondent 2 : Mr.John Mathew  
for M/s.John Mathew and Associates

For Respondent 3 : Mr.C.Samivel, SPC

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### **JUDGMENT**

The appellant is the assignee of trade marks under Deed of Assignment dated 03.01.2005. Pursuant thereto, the appellant applied for registration of such assignment by filing Form TM-24 on 08.01.2008. The request for registration of the assignment was rejected by order dated 02.11.2010 which is impugned herein.



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2. As against the assignor, the first and second respondents herein had filed rectification petitions. Therefore, they were joined as parties to proceedings before the Registrar of Trade Marks and in this appeal. Both counsel for the first and second respondents, on instructions, stated that they are not contesting this appeal.

3. Learned counsel for the appellant invited my attention to the Deed of Assignment dated 03.01.2005 and to the impugned order. With reference thereto, learned counsel submitted that two reasons were cited for refusal. The first being the pending rectification petitions and the second being that the trade mark "MANJAL" is a generic name and cannot be registered under Section 9 of the Trade Marks Act, 1999 (the Trade Marks Act). Learned counsel submitted that the pending rectification petitions do not qualify as a justifiable cause to reject the application for registration of assignment. With regard to the scope of such proceedings, learned counsel relied upon



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the judgment of the Delhi High Court in *Sun Pharmaceuticals Industries Limited v. Cipla Limited*, 2009(39) PTC 347 (Delhi), particularly paragraphs 11 and 13 thereof. Learned counsel also referred to the reply dated 28.07.2010 of the appellant to the Registrar of Trade Marks in response to the hearing notice.

4. In response to the submissions, Mr.C.Samivel, learned SPC, submitted that the request for registration of assignment was refused largely on account of the pending rectification petitions.

5. On examining the impugned order, it is evident that two reasons were mentioned for refusing the request for registration of assignment. The first of these reasons is the pending rectification petitions in respect of the original registrations. At the relevant time, Section 45 of the Trade Marks Act, which deals with registration of assignment was as under:

***"45. Registration of assignments and transmissions - (1) Where a person becomes***



*entitled by assignment or transmission to a registered trade mark, he shall apply in the prescribed manner to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register:*

*Provided that where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until the rights of the parties have been determined by a competent court."*

6. On examining the above provision, it is clear that the Registrar is required to consider whether the assignee has provided proof of title to the satisfaction of the Registrar. The proviso thereto deals with a situation where the validity of assignment is challenged.



In this case, neither the assignor nor a person claiming through the assignor has challenged the validity of assignment. Therefore, the proviso is not applicable on the facts of this case.

7. In order to prove title, the appellant / assignee has placed on record the Deed of Assignment dated 03.01.2005. The said document sets out the registered and unregistered trade marks which were assigned thereunder. The scope of enquiry by the Registrar of Trade Marks should have been confined to whether the appellant / assignee provided proof of title to the satisfaction of the Registrar. Instead of taking the relevant factors into consideration, the Registrar has rejected the application on account of the pending rectification petitions. The said conclusion is completely untenable.

8. The other reason mentioned in the impugned order is that the mark "MANJAL" is generic and, therefore, cannot be registered under Section 9 of the Trade Marks Act. This conclusion is also



wholly inappropriate in an application for registration of an assignment. Put differently, upon application by the assignor, the relevant marks were registered and entered on the Register of Trade Marks. While deciding an application for registration of assignment, Sections 9 and 11 of the Trade Marks Act have no role to play. Therefore, neither reason cited by the Registrar of Trade Marks is tenable.

9. Consequently, the impugned order is set aside and (T)CMA(TM)/6/2023 is allowed without any order as to costs by directing the Registrar of Trade Marks to take necessary action to register the assignment in favour of the appellant. This process shall be completed within a maximum period of *four weeks* from the date of receipt of a copy of this order.

**17.10.2023**

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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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