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W.P.(IPD) No.36 of 2024

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 13.02.2025

CORAM :

THE HON'BLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

W.P.(IPD) No.36 of 2024

P.Pandian

.. Petitioner

Vs.

The Registrar of Trade Marks
The Office of the Trade Marks Registry
Intellectual Property Office Building
G.S.T. Road, Guindy
Chennai 600 032.

.. Respondent

Prayer: Petition filed under Article 226 of the Constitution of India seeking a writ of Mandamus directing the respondent to permit the petitioner to file renewal application for renewing the Trade Mark WAHEED registered under number 573302 in Class 24 and renew the same in accordance with due process of law.

For Petitioner : Ms.Shruthi Srinivasan
For Mr.Arun C.Mohan

For Respondent : Mr.S.Janarthanam
Senior Panel Counsel



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ORDER

Petitioner seeks a direction to respondent to permit petitioner to file a renewal application for renewing the trademark WAHEED, which was registered under TM No.573302 in Class 24.

2. Petitioner applied for registration of the above mentioned trademark on 15.05.1992. After examination report was issued and hearing was conducted on 25.03.2004, petitioner was awaiting advertisement before acceptance. By communication dated 18.11.2019, petitioner asserted that publication in the trademark journal had not been effected and requested respondent to make such publication. After the advertisement was published on 03.02.2020, the registration certificate was issued on 12.09.2020. Meanwhile, petitioner noticed, on routine check, that the trademark registry reflected the status of the trademark as having expired on 15.05.2002. Since the online portal was inaccessible to petitioner for filing a renewal application, the present writ petition was filed.



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3. Learned counsel for petitioner submits that petitioner did not receive notice under Sub-rule (1) of Rule 58 of the Trade Marks Rules, 2017 informing petitioner of the approaching date of expiry of the trademark registration. After pointing out that the trademark has not been removed from the register as on date, learned counsel contends that petitioner is entitled to apply for renewal at this juncture. In support of these contentions, learned counsel relies upon several precedents, including the judgment of the Division Bench of the Bombay High Court in *Motwane Private Ltd. v. Registrar of Trade Marks and others* [Dated 16.02.2024 in W.P.(L) No.30537 of 2023]. She also relies upon the judgment of this Court in *Jaisuryas Retail Ventures Pvt. Ltd. v. The Registrar of Trade Marks* [Order dated 13.08.2024 in W.P.(IPD) Nos.4 to 14 of 2024].

4. In response to these submissions, Mr.Janarthanam submits that the registration certificate was issued on 12.09.2020. Consequently, he submits that the renewal fee should have been paid within six months from the date of actual registration as per Sub-rule (3) of Rule 58 of the Trade Marks Rules. In view of default in doing so,



he submits that petitioner is not entitled to seek renewal at this juncture. On instructions, he, however, confirms that the database of the trademark register does not reflect any notice being issued to petitioner with regard to non-renewal and impending expiry.

5. In *Jaisuryas Retail Ventures*, after citing *Motwane* with approval, I held as follows in paragraphs 8 and 13 of the said judgment:

“8. Sub-section (2) of section 25 of the Trade Marks Act prescribes that the Registrar shall renew the registration of a trade mark for a further period of ten years if an application is received from the registered proprietor in the prescribed form and within the prescribed time. Rule 57 stipulates that the application for renewal shall be made in Form TM-R (prescribed form). Curiously, as regards prescribed time, Rule 57 enables the filing of such application “at any time not more than one year before the expiration of the last registration of the Trade Mark”. In effect, the earliest date for filing such application is prescribed, but not the last date. By way of illustration, if a registration had been granted for a ten year period running from 01.01.2014 to 31.12.2023, the application for renewal may be filed at any time after 31.12.2022. Sub-section (3) of section 25 mandates that a notice be issued by the Registrar at the prescribed time before



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the expiration of the last registration to the registered proprietor so as to put such person on notice regarding the approaching date of expiry of registration. Rule 58 requires that this notice be sent in Form RG-3 “not more than six months before the expiration of registration of the Trade Mark”. Reverting to the earlier illustration, this notice may be given only after 30.06.2023 if the last registration was expiring on 31.12.2023.

...

13. Hence, the failure of the respondent to put the registered proprietor on notice with regard to the impending expiry of registration and remove the trade marks from the register thereafter opens the door for such registered proprietor or his successor-in-interest to seek renewal. In this connection, the order of the Delhi High Court in Irvinder Kaur Chadha is distinguishable inasmuch as notice under sub-section (3) of section 25 was duly served in that case on the registered proprietor. For reasons set out above, I concur with the conclusion of the Division Bench of the Bombay High Court in Motwane.”

6. The facts and circumstances of this case are substantially similar to those prevailing in ***Jaisuryas Retail Ventures***. Therefore,



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petitioner is entitled to apply for renewal. Respondent is directed to provide access to portal for such purpose or, in the alternative, permit petitioner to file necessary application and documents in physical form.

7. The writ petition is allowed on the above terms. There shall be no order as to costs.

13.02.2025

kpl

To

The Registrar of Trade Marks
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SENTHILKUMAR RAMAMOORTHY,J.

(kpl)

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