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W.P.No.15872 of 2021

IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED : 04.07.2024

DELIVERED: 12.07.2024

CORAM:

THE HON'BLE MR. JUSTICE P.B.BALAJI

W.P.No.15872 of 2021
WMP No.16767 of 2021

Mahendra Perfumery Works,
a Partnership Firm,
Mahendra Mahal, Ramaiyengar Road,
V.V.Puram, Bengaluru 560 004

... Petitioner

Versus

1. Office of the Controller General of Patents, Designs & Trade Marks,
Office of the Trademarks Registry,
Intellectual Property Building,
Bhouthik Sampada Bhavan,
Shaikh Misree Marg,
Dosti Acres, Antop Hill,
Mumbai-400 037.

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

... Respondents



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Petition filed under Article 226 of the Constitution of India praying to issue Writ of Certiorarified Mandamus to call for the records of the 2nd respondent relating to the order of removal of the trademark PALKI in Trademark Journal No.1434 dated 16.02.2010 and the order dated 13.08.2013 and quash the same as illegal and violative of principles of natural justice and consequently direct the 2nd respondent to entertain Form TM 12 application dated 07.11.2006 for restoration/renewal of trademark PALKI under Class 3 to the Trademark Register.

For Petitioner : Mr.R.Sathish Kumar

For Respondents : Mr.J.Madana Gopal Rao
SPC

ORDER

The writ petition has been filed seeking to quash the impugned order dated 13.08.2013 and to consequently direct the second respondent to entertain Form TM 12 application dated 07.11.2006 for restoration/renewal of the petitioner's Trade Mark PALKI under Class 3.



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2. I have heard Mr.R.Sathish Kumar, learned counsel for the petitioner and Mr.J.Madana Gopal Rao, learned Senior Panel Counsel for the respondents. With the consent of all the parties, the main writ petition itself is taken up for final disposal.

3. Learned counsel for the writ petitioner would submit that the writ petitioner was the registered proprietor of the Trade Mark, “PALKI”, right from the year 1973. When the registration was granted under the then Trade Marks Act, 1958 under the scheme of the old Act, the registration is liable to be renewed every 7 years. According to the learned counsel for the petitioner, the petitioner's Trade Mark has been renewed every 7 years, right from 1978 onwards, periodically, upto 1997. The next renewal was due only in 2006 and in the interregnum period, the Trade Marks Act, 1999 was brought into force on 15.09.2003, according to which, renewals are valid for a period of ten (10) years. However, the learned counsel for the petitioner would submit that the renewals which were due under the 1958 Act were to be renewed only under the 1958 Act and not under 1999 Act. Therefore, the



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writ petitioner's renewal was due on 20.12.2006 and renewal application was made along with the Demand Draft for the requisite amount for renewal on 26.08.2006.

4. It is the further case of the writ petitioner that on 06.09.2009, the writ petitioner was informed that the first respondent has responded to the renewal application stating that renewal can be sought only six months before the due date and the writ petitioner was directed to file a fresh form TM 12 along with the prescribed fee.

5. Accepting the said position, the writ petitioner once again filed a renewal application on 07.11.2006, which is well within six months, as required under the statute. In view of the necessary amount already been remitted by Demand Draft dated 06.03.2006 and the said amount also being encashed by the first respondent, the petitioner was under the fond hope that it's registration would be renewed for a period of ten years from 2006 to 2016, under the scheme of 1999 Act.



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6. However, the writ petitioner's Trade Mark, "PALKI" was removed by publishing the same in the Trade marks Journal No.1434 dated 16.02.2010. On coming to know about the same, the petitioner wrote a letter to the respondents on 03.05.2012 seeking for the renewal to be reflected in the Trade Marks Register. Since there is no response to the same, the petitioner sent a communication again on 30.08.2012 and followed it up with another letter dated 12.07.2013 addressed to the second respondent. On 13.08.2013, the second respondent sent a communication stating that Form TM 12 filed by the petitioner on 09.06.2006 was refused as it was filed before six months period contemplated under Rule 63 of the Trade Mark Rules, 2002. On receipt of the said communication, the petitioner has addressed two communications to the second respondent on 17.08.2013 and 19.11.2013, for which, there has been no response from the side of the respondents. Having no other option to redress its grievances, the present writ petition has been filed.

7. Mr.J.Madana Gopal Rao, learned Senior Panel Counsel would submit that as per the records, the respondents have rightly refused the



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registration, since the application was six months prior in point of time.

However, learned Senior Panel Counsel was unable to satisfy this Court as to how the petitioner's subsequent application, though within time, has been totally brushed aside.

8. Having heard the learned counsel on either side, I am inclined to allow the writ petition for the simple reason that even though at the first instance, the petitioner's application for renewal was rightly rejected citing Rule 63 of then Trade Mark Rules, 2002, requiring an application for renewal of registration to be made in Form TM-12 any time not more than six months before the expiration of the last registration of the Trade Mark, when the writ petitioner has admittedly realised its folly and filed a fresh renewal application on 07.11.2006 in Application No.277020 in class 3, which satisfies the mandate of Rule 63 of the Trade Mark Rules, 2002, there was no reason for the respondents to reject the same, especially after having encashed the prescribed fee for renewal, paid even when the first application for renewal was made, though prematurely.



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9. Therefore, the impugned order clearly suffers from violation of principles of natural justice and also *per se* illegal in the light of the subsequent application for renewal being made in time.

10. For all the aforesaid reasons, the impugned order passed by the second respondent dated 13.08.2013 is set aside and the writ petition is allowed. The second respondent is directed to entertain Form TM 12 application dated 07.11.2006, filed by the writ petitioner, and process the same for renewal of trademark, “PALKI” under Class 3, in accordance with law and pass final orders within a period of six weeks from the date of receipt of a copy of this order.

No costs. Consequently, connected miscellaneous petition is closed.

12.07.2024

sr

Index: Yes/No

Speaking Order/Non-Speaking Order



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To

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P.B.BALAJI., J.

SR

Pre-Delivery Order in W.P.No.15872 of 2021

12.07.2024