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OP (TM) Nos.51 & 52 of 2



IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 31.07.2024

Pronounced on:02.08.2024

CORAM:

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

OP (TM) Nos.51 & 52 of 2024

VARAMM Healthcare Private Limited,
Having its registered office at:
No.69, 4th Main Road, T Block,
3rd Aenue Anna Nagar, Chennai - 600 040.

.. Petitioner in both OPs

..Vs.

1.MGM Healthcare Private Limited,
Having its registered office at:
New No.72, Lalah Towers,
Nelson Manickam Road, Aminjikarai,
Chennai - 600 029.

2.The Registrar of Trademarks,
Office of the Trademarks Registry,
IPR Building, Industrial Estate, SIDCORMD,
GST Road, Guindy, Chennai - 600 032.

.. Respondents in both OPs

Common Prayer: These Original Petitions for rectification of the Trademarks Register or remvoal of the Trademark from the Register under Sections.57 & 125 of the Trademarks Act, 1999, praying this Court to remove/expunge/rectify the entry relating to registration Nos.5028086 & 5028084 in Class 44 and award costs in favour of the petitioner.



For Petitioner : Mr.R.Sathishkumar for
Mr.Vijayan Subramanian
in both OPs

For Respondents : Mr.Abishek Jenasenan for R1
in both OPs
Mr.M.Karthikeyan,
Central Government Standing Counsel
for R2 in both OPs

COMMON ORDER

The above Original Petitions have been filed for rectification of the Trademarks Register for the Registration Nos.5028086 & 5028084 in Class 44.

2. At the time of admission, Mr.Abishek Jenasenan, learned counsel for the first respondent would take preliminary contentions that the above Original Petitions are not maintainable in view of the orders passed by this Court in C.S. (Comm.Div) No.2 of 2023. Hence, I directed the learned counsel for the first respondent to file a counter affidavit limited to the Maintainability issue alone.



3. Today, I have heard Mr.R.Sathishkumar, learned counsel for Mr.Vijayan Subramanian, learned counsel for the petitioner and Mr.Abishek Jenasenan, learned counsel for the first respondent and Mr.M.Karthikeyan, learned Central Government Standing Counsel for the second respondent on the issue of maintainability of the above Original Petitions.

4. The learned counsel for the petitioner in the Original Petitions would submit that no doubt in C.S. (Comm.Div.) No. 2 of 2023, Applications were filed in A.Nos.2028 & 2029 of 2023 under Section 124 of the Trademarks Act, 1999 seeking a prayer to frame a preliminary issue regarding validity of the first respondent's Trademark registration. This Court was pleased to allow the said Applications on 19.02.2024, adjourning the suit for a period of three months to enable the defendant to apply to the IP Division of this Court and seek rectification of the plaintiff's registered Trademark 'VARAM' under Nos.5028086 and 4748384 and directed the suit to be listed after a period of three months.

5. It is the specific contention of the learned counsel for the petitioner, Mr.R.Sathishkumar, that by inadvertence, the rectification



petitions were not filed within a period of three months from the date of order i.e., 19.02.2024 and they were filed within a period of three months from the date of receipt of the copy of the order on 08.07.2024. He would therefore submit when there is a provision for extension of time provided under Section 124 of the Trademarks Act, 1999 the Original Petitions cannot be held to be not maintainable. He would therefore pray for the rectification petitions to be admitted and heard in accordance with law.

6. Per contra, Mr.Abishek Jenasenan, learned counsel for the first respondent would submit that the order dated 19.02.2024 in Application Nos.2028 and 2029 of 2023, had clearly given a period of three months from the date of order and not from the date of the receipt of the order copy and the Applications ought to have been filed on or before 03.06.2024. When the rectification petitions were filed only on 08.07.2024, that too without the leave of the Commercial Court, the petitions were clearly not maintainable.

7. He would place reliance on the decision of the Hon'ble Supreme Court in the case of *Patel Field Marshal Agencies and another Vs.*



P.M.Diesels Limited and others, reported in (2018) 2 SCC 112, where the Hon'ble Supreme Court held that the plea with regard to the rectification would no longer survives.

8. I have carefully considered the submissions advanced by the learned counsel on either side. Section 124 of the Trademarks Act, 1999 is usefully extracted as hereunder:-

'124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc.

(1) Where in any suit for infringement of a trade mark--

(a) the defendant pleads that registration of the plaintiff's trade mark is invalid; or

(b) the defendant raises a defence under clause(e) of sub-section(2) of section 30 and the plaintiff pleads the invalidity of registration of the defendant's trade mark, the court trying the suit (hereinafter referred to as the court), shall,--

(i) if any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar or the [High Court], stay the suit pending the final disposal of such proceedings;

(ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is prima facie tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the [High Court] for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause(b)(ii) of sub-section(1) within the time specified therein or within such extended time as the court may for sufficient cause allow, the trial of the suit shall stand stayed until the final disposal of the rectification proceedings.



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(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section(1) or sub-section(2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction, directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.”

9. No doubt, as rightly contended by Mr.R.Sathishkumar, learned counsel for the petitioner, there is a provision to seek extension of time to file the rectification petition beyond the date of three months, here admittedly, without getting the time extended from this Court, the present Original Petitions have been filed. Only after the objections with regard to the maintainability have been taken by the first respondent, it is seen that the petitioner appears to have moved the Commercial Division seeking extension of time. Admittedly, as on date, there is no order extending the time in terms of Section 124(3) of the Trademarks Act, 1999. Therefore, on the face of it, the Original Petitions filed on 08.07.2024 are not maintainable in the eye of law, since the Statute is clear that the issue regarding validity



of the registration of the Trademark concerned shall be deemed to have been abandoned. However, at the same time, it is needless to state that if and when the petitioner gets the time extended in terms of Section 124 (3) of the Trademarks Act, 1999, then there would be no bar or impediment for the petitioner to move rectification petitions afresh. However, as on date, I am unable to hold that the Original Petitions are maintainable.

10. Accordingly, the above Original Petitions are dismissed as not maintainable. No costs.

02.08.2024

Index : Yes/No
Speaking/Non-speaking order
rkp

To
The Registrar of Trademarks,
Office of the Trademarks Registry,
IPR Building, Industrial Estate, SIDCORMD,
GST Road, Guindy, Chennai - 600 032.



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P.B.BALAJI,J.

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**Pre-delivery Order in
OP (TM) Nos.51 & 52 of 2024**

02.08.2024