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## IN THE HIGH COURT OF JUDICATURE AT BOMBAY

## ORDINARY ORIGINAL CIVIL JURISDICTION

## WRIT PETITION NO.1669 OF 2012

CIPLA Limited	)
A company registered under the	)
Indian Companies Act, 1913, Having	)
its registered office at Mumbai Central	)
Mumbai-400 008	)....Petitioner
V/s.	
1 Registrar of Trade Marks	)
Boudhik Sampada Bhawan,	)
S.M.Road, Antop Hill,	)
Mumbai-400 037	)
2 Union of India	)
Through Ministry of Commerce	)
Department of Industrial Policy	)
& Promotion, Udyog Bhawan,	)
New Delhi-110011	)....Respondents

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Mr.Abhijeet Desai along with Mr.Manish Saurastri, Mr.Rahul Dhote and Dr.Rachana Bharadwaj i/by Krishna Saurastri & Associates for the petitioner.

Mr.Vinod Joshi i/by Mr.Kaushik Sharma for the respondent nos.1 & 2.

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**CORAM : S.J.VAZIFDAR &  
K.R.SHRIRAM,JJ**

**RESERVED ON : 16.9.2013**

**PRONOUNCED ON : 23<sup>rd</sup> September 2013.**

**Judgment :- ( Per : K.R.Shriram,J)**

1 Rule. By consent of parties, rule made returnable forthwith.

2 The petitioner has sought a writ of certiorari to quash and set aside the order of respondent no.1 removing from the register the petitioner's trade mark CIPLA and a writ of mandamus directing him to restore to the register the petitioner's said trade mark.

3 The mark was registered with effect from 6.11.1945 as evidenced by a certificate of registration dated 10.02.1949. The registration was renewed from time to time and was last renewed for a period of 7 years on 6.11.1995 till 6.11.2002. Thereafter due to inadvertence the registration was not renewed.

4 Sometime in the first quarter of 2012, the petitioner came to know that its mark had been removed from the register due to non-renewal. The petitioner however, had not received any notice as per Section 25(3) of the Trade Marks Act, 1999 (hereinafter referred to as the Act) from respondent no.1 notifying it of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained. The petitioner

therefore, caused an RTI application to be submitted on 24.04.2012 seeking information as to whether any notice in Form-O3 was issued and if so, to whom it was issued, the date of dispatch thereof, the address to which it was dispatched and proof of delivery of the notice. The petitioner received a reply dated 14<sup>th</sup> May 2012 from the Assistant Registrar of Trade Mark (Central Public Information Officer) stating: "As per Renewal Diary O-3 record is not available for the year 2002".

5 Mr.Desai, the learned Counsel for the petitioner, submitted that the impugned order is contrary to section 25 of the Act and in particular sub-section (3) thereof and Rule 64(1) of the Trade Marks Rules, 2002.

(A) Section 25 reads as under :-

**25.Duration, renewal, removal and restoration of**

**registration-**(1) The registration of a trade mark, after the commencement of this Act, shall be for a period of ten years, but may be renewed from time to time in accordance with the provisions of this section.

(2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period and subject to payment of the prescribed fee, renew the registration of the trade mark for a period of ten years from the date of expiration of the original registration or of the last

renewal of registration, as the case may be (which date is in this section referred to as the expiration of the last registration).

(3) At the prescribed time before the expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with the Registrar may remove the trade mark from the register.

Provided that the Registrar shall not remove the trade mark from the register if an application is made in the prescribed form and the prescribed fee and surcharge is paid within six months from the expiration of the last registration of the trade mark and shall renew the registration of the trade mark for a period of ten years under sub-section (2).

Where a trade mark has been removed from the register for non-payment of the prescribed fee, the Registrar shall, after six months and within one year from the expiration of the last registration of the trade mark, on receipt of an application in the prescribed form and on payment of the prescribed fee, if satisfied that it is just so to do, restore the trade mark to the register and renew the registration of the trade mark either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of ten years from the expiration of the last registration.”

Section 25 is in so far as it is relevant to this matter, is *pari materia* with section 25 of the Trade & Merchandise Act of 1958.

(B) Rule 64 (1) of the Trade Marks Rules, 2002, which is similar to Rule 67 of the Trade and Merchandise Marks Rules 1959, reads as under :-

**64. Notice before removal of trade mark from register-** (1) At a date not less than one month and not more than three months before the expiration of the last registration of a trade mark, if no application in Form TM-12 for renewal of the registration together with the prescribed fee has been received, the Registrar shall notify the registered proprietor or in the case of a jointly registered trade mark each of the joint registered proprietors and each registered user, if any, in writing in Form O-3 of the approaching expiration at the address of their respective principal places of business in India as entered in the register or where such registered proprietor or registered user has no principal place of business in India at his address for service in India entered in the register.”

Mr.Desai submitted that it was mandatory for the respondent no.1 to have issued the notice in form O-3 prior to

removing the petitioner's trade mark from the register. The first respondent's failure to do so renders the removal of the mark from the register illegal. He further submitted that the removal of a trade mark from the register entails civil consequences for the registered proprietor thereof. In the scheme of things, the removal of the registered trade mark cannot be done without prior notice to the registered proprietor of the trade mark.

6 Mr.Desai's submissions are well founded. They are supported by the judgment of a learned single Judge of the Delhi High Court in the matter of Malhotra Book Depot V/s. Union of India & Ors reported in 2012 (49) PTC 354 (Del.). The facts there were similar to the present petition. The Delhi High Court while allowing the petition and issuing a mandamus to the respondent to grant restoration and renewal of the trade mark analyzed the scheme of the 1958 Act and the Rules made thereunder, observed as under:-

14. ....

Analysis of Section 25 of the aforesaid Act shows that a trade mark registered under the said Act may be renewed from time to time for periods of seven years each on making of an application and payment of the requisite fee. The application for renewal of the trade mark may be made, not earlier than six months before the expiration of the last registration of the trade mark. If such an application is made, the registration of the trade mark would be renewed, provided the conditions

laid down under the Act and the Rules are satisfied. However, if no application is made for renewal of the registration of the trade mark and only two months are left before its expiration, then the Registrar is obliged to give a notice within one month to the registered proprietor or if there are more than one, to each of the registered proprietors, in writing in form O-3, of the approaching expiration of the registered trade mark. Upon receipt of said notice, the application for renewal of the registration may be made, in which case, the same would be renewed. If, however, after the expiration of the last registration of a trade mark, the renewal fee has not been paid despite issuance of a notice by the Registrar in form O-3, the Registrar may remove the trade mark from the register and advertise the fact forthwith in the journal.

16. The scheme of the Act and the Rules, therefore, is that before the removal of the mark from the register, the Registrar must give prior notice in form O-3 to the registered proprietor or to each of the joint registered proprietors in writing, putting them to notice of the impending expiry of registration of the mark. The removal of the registered mark from the register entails civil consequences for the registered proprietor of the mark. The said removal of the registered trade mark, in the scheme of things, therefore, cannot be done without prior notice to the registered proprietor/joint proprietors in the prescribed form. The mere expiration of the registration by lapse of time, and the failure of the registered proprietor of the trade mark to get the

same renewed, by itself, does not lead to the conclusion that the same can be removed from the register by the Registrar of Trade marks without complying with the mandatory procedure prescribed in Section 25(3) of the aforesaid Act or read with Rule 67 of the aforesaid Rules. Removal of the registered mark from the register without complying with the mandatory requirements of Section 25(3) of the aforesaid Act read with Rule 67 of the aforesaid Rules would itself be laconic and illegal.

7           The judgment was affirmed in appeal 2013(54) PTC 165(Del). The Division Bench confirmed that removal of the trade mark from the register without following the mandatory procedure under Section 25(3) is bad. Paragraph-16 of the judgment reads as under :-

“16. The scheme of the Rules regarding renewal of registration and restoration also suggests so. Rule 66 permits an application for renewal of registration to be made any time within six months before the expiration of the last registration. However the removal for non-renewal has not been made automatic. If the registered proprietor does not make an application for renewal till two months prior to the expiration of the last registration, the Registrar is required to notify the registered proprietor of the approaching expiration (under Rule 67) and is to remove the trademark from the register only thereafter, as is evident from Rule 68 having been



placed after Rule 67. If removal pursuant to non-renewal was to be de hors the notice for removal, Rule 68 would have followed Rule 66 and not Rule 67. Though Rule 68 permits removal upon expiration of last registration and non-payment of renewal fee and does not make the same dependent upon compliance of Rule 67 but to read Rule 68 as permitting removal de hors compliance of Rule 67 would be contrary to Section 25(3) which as aforesaid permits removal only if at the expiration of the time prescribed in the notice required to be sent thereunder, the registered proprietor has not applied for renewal. It is a settled principle of law that rules framed under a statute cannot override the statute. In *Ispat Industries Ltd. v. Commissioner of Customs* (2006) 12 SCC 583 it is held that the Rules are subservient to the Act and cannot deviate from the provisions of the parent Act. It was further held that the Rules are created to serve the object of the legislation and if there are two possible interpretations of a Rule, one which sub-serves the object of the provision in the parent statute ought to be adopted, as an interpretation to the contrary will make the Rule ultra vires the Act.”

8           We are in respectful agreement with the judgment of the Delhi High Court learned single Judge and of the Division Bench. Although that case was under the 1958 Act and the Rules thereunder the relevant provisions thereof viz. section 25(3) and Rule 67 are

similar in all material respects to the corresponding provisions of the 1999 Act and the 2002 Rules made thereunder viz. section 25(3) and Rule 64. The impugned order having been passed without following the provisions of Section 25(3) is void.

9           Mr.Joshi, the learned Counsel appearing on behalf of the respondents submitted that public notice had been issued by the Controller-General of Patents, designs and trade marks, who is the Registrar of Trade marks calling upon the parties who had not paid the renewal fee and who had not received the Form O-3 notice to pay and have the trade mark renewed and that only the trade marks of those who had not complied with the said requisition had been removed from the register.

10           The public notice does not constitute compliance with the provisions of Section 25(3). Section 25(3) requires the Registrar to send the notice "to the registered proprietor". A general public is not contemplated under the section.

11           Mr.Joshi further contended that in the present case, the office must have issued O-3 notice. However, the concerned record pertaining to the year 2002 is not readily available.

12           There is nothing on record to either establish or indicate that the requisite notice was sent to the petitioner. There are no circumstances that warrant an inference to that effect. Considering the consequences of the impugned order we are not inclined to speculate in this regard in the respondents' favour.

13           Mr.Joshi also contended that the petitioner ought to be relegated to the alternate remedy of filing an appeal under Section 91 of the Act.

14           Mr.Desai however, submitted that section 91 is inapplicable as no order or decision of the registrar has been communicated to the petitioner.

15           It is not necessary for us to decide this issue. In any event the failure to comply with the mandatory provisions of Section 25(3) is a jurisdictional issue which raises a pure question of law. We are therefore, inclined to entertain this petition in exercise of our extra ordinary jurisdiction under Article 226 of the Constitution of India.

16           The question in our view should not be approached from any penal point of view. If restoration is just, it is bound to be made. That is the effect of the scheme of the Act and the Rules. It is true

there has been an inordinate delay. If that delay has led to registration of the trade mark in favour of someone else, it may be a different matter depending upon the facts of the case. No one else has applied for or claimed any right of registration in the said trade mark in the meantime.

17 Therefore, in the facts and circumstances of the case, the respondents are directed to grant restoration and renewal of the trade mark registration CIPLA no.114794 dated 6<sup>th</sup> November 1945, within two weeks of the petitioner paying the requisite charges and complying with the requisite formalities.

The petition stands disposed of accordingly. There shall be no order as to costs.

**(K.R.SHRIRAM, J)**

**(S.J.VAZIFDAR, J)**