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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 28.10.2024

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THE HONOURABLE MR.JUSTICE K.KUMARESH BABU

W.P.No.15517 of 2021

BETCO ENTERPRISES
Raghavendra Colony, No.72/2, 5th Main Road,
Chamrajpet, Bengaluru 560018. ... Petitioner

-Vs-

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

2. The Registrar of Trademarks,
Office of the Trademarks Registry,
Intellectual Property Building,
GST Road, Guindy, Chennai 600 032. ...Respondents

For Petitioner : Mr.R.Sathish Kumar
For Respondents :Mr.R.Subramanian, ACGSS

ORDER

The present writ petition has been filed to direct the second respondent to receive the application for renewal of the trade mark under No.764009 in class and renew the same.

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2. Heard Mr.R.Sathish Kumar, learned counsel appearing for the petitioner and Mr.R.Subramanian, ACGSS, the learned counsel appearing on behalf of the respondents.

3. Mr.R.Sathish Kumar, learned counsel appearing for the petitioner would submit that he had filed an application for registration of trade marks as early as in the year 1997. However, the advertisement came to be issued in the year 2006, based upon which an objection had been received and the objection was dismissed by the Registrar of Trade Marks on 14.09.2018. The certificate of registration of trade marks was issued on 16.03.2019. When an application for renewal was sought to be made, the same could not be uploaded by the petitioner as the same was beyond the period of time limit for submitting the renewal application. He would submit that the petitioner cannot make an application for renewal as the certificate of registration had not been issued till the year 2019. He would rely upon Section 25 of the Trade Marks Act read with Rule 58 and would contend that if no application had been taken out, it is the duty of the Registrar to intimate the owner of the trade mark prior to six (6) months of the expiry of the trade mark calling upon the owner of trade mark to submit an application for renewal. In the present case, he would submit that there was no such notice issued by the Registrar as prescribed under Section 25 of the Trade Marks Act read with Rule 58. Hence, the petitioner cannot be found fault and therefore, he would pray this Court to direct the respondent to receive the application for renewal of the

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trade mark and subsequently renew the same.

4. Countering his arguments, Mr.R.Subramanian, the learned counsel appearing on behalf of the respondent would submit that the impugned trade mark got registered in the year 2019 and six (6) months was available to the petitioner from the said date for filing the application for renewal. However, the same had not been made by the petitioner and therefore, it could only be treated that he had abandoned his right for renewal. He would further submit that the application of the petitioner was registered after the date of renewal and hence, Section 25(3) of the Trade Marks Act cannot be made applicable for the Registrar to issue a notice. The petitioner was well aware that his certificate of registration was issued much after the application was filed in the year 1997 and that certificate of registration relates back to the date of application and therefore, it is the bounden duty of the petitioner to file an application immediately on the grant of registration. Therefore, he would submit that there is no merits in the Writ Petition and prays to dismiss the same.

5. I have considered the rival submissions made by the learned counsels appearing on either side and perused the materials available on record.

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6. It is an admitted case that the petitioner had made an application for the registration in the year 1997 and the same was granted only in the year

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2019. It is to be noted that the petitioner cannot be found fault for such belated registration, as the same was subject matter of opposition by a third party, which also stood rejected by the Registrar. The objection of the respondent that Section 25(3) could not be applicable to the present facts of the case, in my considered view is a fallacious objection. It is true that the petitioner was the registered owner of the trade mark in the year 2019. The statue stipulates that when the tenure of a trade mark is about to expire then the Registrar concerned will have to intimate to the owner as per Section 25(3) read with Rule 58 calling upon him to file an application for renewal if no such application has been made. If it is the case of the respondent that the petitioner ought to have filed an application for renewal when the certificate was granted to him, the Registrar should have intimated the petitioner even at the time of granting the certificate of registration that the petitioner should make an application for renewal forthwith as the certificate of registration dates back to the date of application i.e., 1997.

7. In such view of the matter, I am inclined to allow the Writ Petition by issuing following directions,

(i) the petitioner is directed to submit the application for renewal on or before 22.11.2024

(ii) On receipt of such application from the petitioner, the respondent shall consider the said application and renew the trademark under No.764009 within a period of six (6) weeks thereafter.

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28.10.2024

Index: Yes/ No
Speaking order: Yes/ No
Note: Issue Order Copy on 29.10.2024.

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K.KUMARESH BABU,J.

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