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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated : 06.03.2024

CORAM: JUSTICE N.SESHASAYEE

W.P. (IPD) No.31 of 2023

Rexcin Pharmaceuticals Private Limited
Rep. by its Director
17-B, First Floor, Block A-1A
Janakpuri, New Delhi - 110 058 ... Petitioner

Vs.

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

COMMON PRAYER: Writ petition filed under Article 226 of the Constitution of India for a writ of mandamus directing the respondent to permit the petitioner to renew the registration of the mark GENTALENE under No.476162 in Class 5.

For Petitioner : Mr.S.Diwakar

For Respondents : Mr.K.Ramamoorthy,
Central Govt. Standing Counsel

https://www.mhc.tn.gov.in/judis

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O R D E R

This writ petition is laid to remedy a cause which the petitioner was forced to face in very unfortunate circumstances. The prayer in the writ petition is innocent looking, as it seeks a direction to the respondent herein to accept the petitioner's application for renewal of its mark, but there it stops, and the facts to be narrated will explain it.

- On 31.07.1987, some 37 years from now, a certain Croslands Research Laboratories Limited, had applied for registering its mark. The Trade Marks Registry slept over it for next seven years and finally found its auspicious moment on 01.04.1994 to advertise the mark in its journal and after about eight months, the applicant was informed about certain opposition made by a third party.
- During the pendency of this opposition, on 16.07.2002, the proprietor-cum-applicant of the mark assigned the same to M/s.Ranbaxy Limited. This was promptly intimated to the Trade Marks Registry through Form TM-16. The Trade Marks Registry did not find time to attend to that immediately.
- Some 14 months later, on 02.09.2003, even as the Trade Marks Registry was in hibernation mode, M/s.Ranbaxy Limited assigned the mark to

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M/s.Oscar Pharmaceuticals Pvt. Ltd. The assignee of the mark again notified about the assignment to the Trade Marks Registry and sought amendment of the application vide TM-16. Nothing will activate the Trade Marks Registry, as it assumed an attitude to challenge Kumbakarna. But life has to move on, and it indeed moved on when M/s.Oscar Pharmaceuticals chose to transfer the mark to the petitioner.

- Petitioner, on his part, would seek an amendment vide Form TM-16 dated 06.04.2004. Given the determination with which the Trade Marks Registry was pursuing its inaction, a mere Form 16 at the instance of the petitioner is too small an effort to wake up the Trade Marks Registry.
- Then arrived a day on 26.06.2009, and on that day a miracle happened. The Trade Marks Registry chose to wake up to consider a petition that was pending its consideration for 22 years. It dismissed the opposition, passed an order allowing the amendment to the first TM-16 filed by M/s.Ranbaxy Limited, and ignored the subsequent two amendment applications. The tale of agony does not end there. It may have to be noted that by this time, the 10 years period during which a trade mark would have been alive if only it was registered had expired. But then the Trade marks Registry is extremely duty conscious and therefore, on

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16.11.2019, it chose to issue a certificate of registration, after a cool 32 years, no matter that the validity of the registration, had expired by then.

2. By now, the petitioner had almost forgotten about TM-16 that he had filed. The petitioner avers in his affidavit that accidentally it came to know while searching for some information in the official website of the respondent about the issuance of certificate of Registration to M/s.Ranbaxy Limited. To add to the confusion, M/s.Ranbaxy Limited ceased to exist by now, as the company having been merged with some other company in 2015.

3. Now the certificate of registration issued on 16.11.2019, necessarily will date back to the date of original application, namely 31.07.1987, which implied that the very certificate itself was issued some 25 years after the expiry of the very trade mark, since the life of a registered trade mark under the Act 1958 was only seven years.

4. The petitioner would now approach the Trade Marks Registry for renewal of its mark, but the Trade Marks Registry comes with an answer that the one year period stipulated for seeking renewal had expired beyond the statutory period

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of six months prescribed for the same. It is in these circumstances, the petitioner had approached this court with this petition.

5. The learned counsel for the respondent submitted that he is hugely handicapped, since all the records of the Trade Marks Registry were destroyed in 2015 floods in Chennai, when the entire city was floating for few weeks.

6. This court carefully evaluated the facts before it. 2015 floods was in December 2015, the year when M/s.Ranbaxy Limited ceased to exist. If all the records were then destroyed, this court wonders from where the Trade Marks Registry would find some certificate of registration in favour of Ranbaxy Limited on 16.11.2019. The Trade Marks Registry has literally taken the applicant and all his assignees for a huge ride. Nothing disappoints this court than an attitude painted with the brush of irresponsibility of a statutory functionary. The Trade Marks Registry did not care to inform this petitioner or even M/s.Ranbaxy Limited, why it took 32 years for issuing a certificate of registration. No explanation is offered why it took 10 years to issue the same certificate when it had dismissed the opposition on 26.06.2009. This court wonders what exactly is happening in the Trade Marks Registry. Indeed, even

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today, in most cases where Trade Marks Registry is involved, this court hears serious complaints from the members of the Bar as to how the Trade Marks Registry adopts an attitude of unfriendliness vis-a-vis the application filed before it for registration. Every case leaves its sordid imprints.

7. What amazes this court is that despite it is a defaulter, the Trade Mark Registry exhibits immense confidence to raise an issue of limitation for seeking renewal of the mark despite it consuming an unexplained and inexplicable 32 years delay for registering the mark. Even that job was half done for it had ignored two subsequent TM-16 forms filed by the assignees of the mark, namely M/S.Oscar Pharmaceuticals, and the petitioner. He who is at fault can hardly claim *locus standi* within the statutory scheme to insist on limitation. It tells us: *"I am not bound by any rule of responsibility or limitation but still I want you to abide by limitation".* This is an atrocious state of affairs and this court cannot encourage it.

8. This court now directs the Trade Marks Registry to receive the application for renewal from the present petitioner. Since the assignor of the petitioner may not be available, this court merely requires the petitioner to make available such

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documents of assignment, which are with it along with appropriate Form C for renewal. The petitioner is directed to file its application within a period of four weeks from the date of receipt of a copy of this order and the date on which it files the application will be the date for determining the period of renewal. The fee for renewal will be paid only from the date on which he files his application for renewal for one term from the date on which it was initially registered.

9. The appeal is allowed with the above direction. No costs.

06.03.2024

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

To

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

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N.SESHASAYEE, J.,

Asr

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