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IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON : 08.09.2026

PRONOUNCED ON : 30.09.2026

CORAM

THE HON'BLE DR.JUSTICE A.D.MARIA CLETE

WP(IPD) No. 26 of 2026

H.Rajagoplan
S/o.Late V.G.Harihara Iyer,
No.60, Kumbeswarar Sannadhi,
Kumbakonam,
Thanjavur District- 612 001.

..Petitioner(s)

Vs

1. The Registrar Of Trade Marks
   Trade Marks Registry,
   Intellectual Property Building,
   G.S.T.Road, Guindy, Chennai-032.

2. K.Hariharan
   S/o.Kailasam,
   No.25/9, Solai Appan Street,
   Kumbakonam,
   Thanjavur District- 612 001.

..Respondent(s)

PRAYER: Writ Petition is filed under Article 226 of the Constitution of India for a Writ of Mandamus seeking for a direction to the 1st Respondent to transfer the pending Rectification petition of the Rectification No. 268705 filed by the Petitioner against the 2nd Petitioner's trade mark Application No.4081447 in class 43 to the files of the Intellectual Property Division of this Court.

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For Petitioner(s): Mr. G. Ramesh Ganapathy

For R1: Mr.B.Sudhir Kumar,
Senior Panel Counsel

For R2: Mr.S.Diwakar
for M/s. Factum Law

O R D E R

This Writ Petition has been filed seeking issuance of a Writ of Mandamus directing the first respondent to transfer Rectification No.268705, filed by the petitioner in respect of Trade Mark Application/Registration No.4081447 in Class 43 standing in the name of the second respondent, from the Trade Marks Registry to the Intellectual Property Division of this Court.

2. The petitioner states that his family has been carrying on a hotel business at Kumbakonam since 1914 under the name and style “Sri Mangalambika Vilas Coffee Hotel”. According to him, his father, late V.G. Harihara Iyer, originally commenced the business, and the petitioner thereafter continued it.

3. The petitioner is the registered proprietor of a trade mark containing the words “Sri Mangalambika Vilas”, bearing Application No.4898811 in Class 43, applied for on 10.03.2021 claiming user from 01.01.1914.

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4. According to the petitioner, the second respondent was entrusted with looking after the hotel during the petitioner's absence from India. The petitioner alleges that during such period the second respondent commenced a separate hotel under the name “Mangalambiga Coffee and Tiffin Centre” and obtained registration of a device mark bearing Application No.4081447 in Class 43, applied for on 08.02.2019 on a proposed-to-be-used basis.

5. Aggrieved by the registration obtained by the second respondent, the petitioner filed an application for rectification before the Trade Marks Registry on 29.06.2020, which was numbered as Rectification No.268705.

6. Thereafter, the petitioner instituted O.S.No.160 of 2022 before the Principal District Court, Thanjavur, seeking a permanent injunction and other reliefs against the second respondent for infringement and passing off. By judgment dated 13.02.2025, the suit was dismissed.

7. Challenging the said judgment, the petitioner preferred Appeal (CAD) (MD) No.7 of 2025 before the Madurai Bench of this Court. By judgment dated 05.06.2026, the Division Bench set aside the judgment and decree of the Principal District Court, Thanjavur and remitted the suit for fresh consideration.

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8. While remitting the matter, the Division Bench directed the Trial Court to keep the suit proceedings in abeyance until a final decision is taken in the rectification application. The Division Bench further directed the petitioner/plaintiff to take immediate steps to get the rectification application pending before the Trade Marks Authority transferred to the High Court, being the competent authority to deal with the rectification application.

9. Pursuant to the said direction, the petitioner has instituted the present Writ Petition seeking transfer of Rectification No.268705 from the first respondent to this Court.

10. The second respondent has filed a counter affidavit questioning the very maintainability of the writ petition. According to him, the petitioner does not challenge any order, decision or refusal of the first respondent. The only relief sought is transfer of Rectification No.268705 from the Trade Marks Registry to the Intellectual Property Division of this Court. It is therefore contended that the relief is essentially one of transfer of a pending statutory proceeding and cannot be converted into a writ of mandamus by invoking Article 226 of the Constitution.

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11. The second respondent further states that though the Division Bench, by judgment dated 05.06.2026 in Appeal CAD (MD) No.7 of 2025, directed the petitioner to take immediate steps to get the rectification application transferred to the High Court, the Division Bench did not itself order such transfer or direct the Registrar to transmit the records. According to the second respondent, the petitioner was therefore required to adopt the appropriate procedure in law for obtaining such transfer.

12. It is also contended that the relief sought pertains to the original civil and statutory jurisdiction of the Intellectual Property Division and not to public law judicial review. The IPD Rules separately recognise original proceedings, appeals and writ petitions, and proceedings under Section 57 of the Trade Marks Act are treated as original proceedings. Since no order of the Registrar is challenged and there is no refusal requiring judicial review, the second respondent contends that the essential basis for invoking writ jurisdiction is absent.

13. The second respondent further relies on Rules 14 and 15 of the IPD Rules to contend that transfer and consolidation are matters of civil procedural jurisdiction. Even though Rule 14(2) does not expressly provide for transfer of a

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rectification proceeding from the Trade Marks Registry, Rule 15 permits recourse to the Code of Civil Procedure, the Original Side Rules and other applicable procedural rules. Hence, according to the second respondent, Article 226 does not become the default remedy merely because a specific form of transfer application is not prescribed.

14. It is also specifically pleaded that the petitioner has not established the basic requirement for issuance of a writ of mandamus, namely, a prior demand to the statutory authority followed by failure or refusal to act. The second respondent points out that no such prior request for transfer was made to the Registrar before filing the present writ petition.

15. On facts, the second respondent admits that the petitioner has filed Rectification No.268705 challenging Registration No.4081447 in Class 43 and that the rectification proceeding is pending. However, he denies the petitioner's claims regarding prior use, proprietorship and deceptive similarity and asserts that the registration continues to subsist unless varied or cancelled in accordance with law.

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16. The second respondent therefore contends that, though the Division Bench's direction is binding, it must be complied with by following the appropriate statutory and procedural course, not by invoking the extraordinary writ jurisdiction. On that basis, dismissal of the writ petition is sought.

17. Learned counsel for the petitioner submitted that the rectification application was instituted on 29.06.2020, well before the institution of O.S.No.160 of 2022. Therefore, the case is governed by Section 125(2) of the Trade Marks Act, 1999, which expressly empowers the Registrar to refer an application for rectification pending before him to the High Court.

18. Learned counsel further submitted that under Section 124(4) of the Trade Marks Act, the final order passed in the rectification proceeding would be binding upon the parties in the pending civil suit and the Civil Court has to dispose of the suit in conformity with such order insofar as the question of validity of registration is concerned.

19. It was contended that the Division Bench, by judgment dated 05.06.2026, has specifically directed the petitioner to take immediate steps to have the

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rectification proceeding transferred to the High Court. The Trial Court has simultaneously been directed to keep O.S.No.160 of 2022 in abeyance until disposal of the rectification proceeding. Therefore, an expeditious transfer of the rectification proceeding is necessary for further progress of the suit.

20. Learned counsel placed reliance upon the decision of this Court in **Asia Match Company Pvt. Ltd. v. Deputy Registrar of Trade Marks & GI and another, 2023 SCC OnLine Mad 8549**, wherein, in similar circumstances, a writ petition seeking transfer of a rectification application pending before the Registrar to the High Court was entertained and allowed.

21. Learned counsel submitted that in **Asia Match Company**, the rectification proceeding had also been instituted before the Registrar before the institution of the civil suit. This Court, after considering Sections 124 and 125 of the Trade Marks Act, directed transfer of the rectification proceeding to this Court.

22. As to the objection under Section 24 CPC, learned counsel submitted that the present case does not involve the transfer of a proceeding from one Civil Court to another. The rectification application is pending before the statutory

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authority, namely, the Registrar of Trade Marks, and Section 125(2) of the Trade Marks Act specifically provides for the power of reference. Rule 14(2) of the Madras High Court Intellectual Property Rights Division Rules, 2022, which deals with transfer of proceedings pending before a Commercial Court for consolidation, therefore has no application.

23. Per contra, learned counsel appearing for the second respondent raised a preliminary objection as to the maintainability of the Writ Petition.

24. Learned counsel submitted that the petitioner does not challenge any order, decision or refusal on the part of the first respondent. What is sought in substance is transfer of a pending rectification proceeding from one forum to another. Such a transfer, according to the second respondent, is essentially civil and procedural in character and cannot be converted into a proceeding under Article 226 of the Constitution merely by describing the relief as one of mandamus.

25. It was further submitted that a rectification proceeding under Section 57 of the Trade Marks Act is an original proceeding. Any order passed by the Registrar thereon is appealable to this Court under Section 91 of the Act.

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Reference was also made to the Madras High Court Intellectual Property Rights Division Rules, 2022, to contend that rectification proceedings are treated as original proceedings and, upon transfer, would have to be numbered as a Transferred Original Petition.

26. Learned counsel submitted that Rule 15 of the IPD Rules makes the provisions of the Code of Civil Procedure applicable where no specific procedure is prescribed. Therefore, according to the second respondent, the petitioner ought to have invoked the procedure under Section 24 CPC instead of filing a writ petition.

27. Reliance was placed upon **Thansingh Nathmal v. Superintendent of Taxes, AIR 1964 SC 1419**, for the proposition that the extraordinary jurisdiction under Article 226 should ordinarily not be exercised where an effective alternative statutory remedy or procedure is available.

28. Learned counsel sought to distinguish **Asia Match Company** on the ground that no objection regarding maintainability of the writ petition was raised in that case and, therefore, the said judgment cannot be treated as laying

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down a general proposition that every transfer of a rectification proceeding from the Registrar to the High Court can be sought through Article 226.

29. It was further submitted that the Division Bench, in its judgment dated 05.06.2026, did not order the transfer of Rectification No.268705, nor did it direct the petitioner to file a writ petition. The petitioner was merely directed to take appropriate steps to have the rectification proceeding transferred. According to the second respondent, the petitioner must comply with such direction by following the appropriate procedure available in law.

30. Finally, learned counsel for the second respondent submitted that the petitioner has not pleaded the customary foundation for issuance of a writ of mandamus, namely, a prior demand made to the authority charged with the alleged duty and a failure or refusal on the part of such authority to act. It was therefore contended that, in the absence of any such prior demand and consequent failure or refusal by the first respondent, the present writ petition seeking a mandamus is not maintainable.

31. The principal question that arises for consideration is:

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Whether Rectification No.268705, instituted before the Registrar of Trade Marks in O.S.No.160 of 2022, is liable to be transferred to the Intellectual Property Division of this Court under Section 125(2) of the Trade Marks Act, 1999?

32. The dates relevant for deciding the present proceeding are not in serious dispute. The petitioner filed Rectification No.268705 before the Registrar of Trade Marks on 29.06.2020 challenging the second respondent's Trade Mark Application/Registration No.4081447 in Class 43. The civil suit in O.S.No.160 of 2022 was instituted thereafter. Thus, the rectification proceeding admittedly preceded the civil suit.

33. Section 125 of the Trade Marks Act, 1999 reads as follows:

> *"125. Application for rectification of register to be made to High Court in certain cases.— (1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined*

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only on an application for the rectification of the register and, notwithstanding anything contained in section 47 or section 57, such application shall be made to the Appellate Board and not the Registrar.

(2) Subject to the provisions of sub-section (1), where an application for rectification of the register is made to the Registrar under Section 47 or Section 57, the Registrar may, if he thinks fit, refer the application at any stage of the proceedings to the Appellate Board."

34. Section 125 of the Trade Marks Act deals with two different situations. Where the question of validity of a registered trade mark arises in an infringement suit, and rectification is sought thereafter, Section 125(1) requires the rectification to be made before the High Court. On the other hand, where the rectification application had already been filed before the Registrar under Section 47 or Section 57 before institution of the suit, Section 125(2) permits the Registrar, if he thinks fit, to refer the application to the High Court at any stage of the proceedings.

35. In the present case, Rectification No.268705 was filed before the Registrar on 29.06.2020, whereas O.S.No.160 of 2022 was instituted subsequently. Therefore, the rectification proceeding was validly instituted before the Registrar and Section 125(1) has no application. The case falls under

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Section 125(2), under which the Registrar has the power to refer the pending rectification proceeding to the High Court.

36. The position where the rectification application precedes the suit has been explained by the Supreme Court in **Jagatjit Industries Limited v. Intellectual Property Appellate Board, (2016) 4 SCC 381**. Considering the scheme of Sections 124 and 125 together, the Supreme Court observed in paragraph 24 of the judgment:

> *"24. The scheme under Section 124 is of great importance in understanding the scope of Section 125. It is clear that where proceedings for rectification of the register are pending before the filing of the suit for infringement in which the defendant pleads that the registration of the plaintiff's trade mark is invalid, such proceedings may be made either before the Registrar or before the Appellate Board, in view of Sections 57(1) and (2) of the Act. But, if rectification proceedings are to be instituted after the filing of such suit for infringement in which the defendant takes the plea that registration of the plaintiff's trade mark is invalid, then rectification proceedings can only be taken before the Appellate Board and not before the Registrar."*

37. The decision of this Court in **Asia Match Company Pvt. Ltd. v. Deputy Registrar of Trade Marks & GI, 2023 SCC OnLine Mad 8549**, is also

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relevant. In that case, the rectification proceeding was filed before the Registrar before the civil suit, and this Court held that Section 125(2) empowers the Registrar to transfer the proceeding to the High Court. However, in that case, the petitioner had already made a written request to the Registrar seeking transfer, which remained unanswered, and the Registrar had also expressed no objection to the transfer. Those features are absent in the present case.

38. It is also significant that the Division Bench, by judgment dated 05.06.2026 in Appeal (CAD)(MD) No.7 of 2025, has directed the Trial Court to keep O.S.No.160 of 2022 in abeyance until disposal of the rectification proceeding and has further directed the petitioner to take immediate steps to have the rectification application transferred to the High Court. Thus, the progress of the civil suit now depends upon the decision in Rectification No.268705.

39. The second respondent's contention that the petitioner ought to have invoked Section 24 CPC cannot be accepted. Section 24 CPC deals with transfer of proceedings pending before Courts, whereas Rectification No.268705 is a statutory proceeding pending before the Registrar. The Trade Marks Act itself contains a specific provision under Section 125(2) for such reference. Rule 14(2) of the IPD Rules also deals with transfer of proceedings

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pending before a Commercial Court and therefore does not directly govern the present situation.

40. The more substantial objection is that the petitioner had not, before filing the writ petition, requested the Registrar to exercise his power under Section 125(2). Ordinarily, a writ of mandamus is preceded by a demand upon the authority and a failure or refusal to act. The objection is factually correct, and in this respect the present case differs from **Asia Match Company.**

41. However, the requirement of prior demand is a rule of practice intended to allow the authority to consider the request. In the present case, the first respondent has been impleaded, served with the writ petition, represented through counsel and has had sufficient opportunity to obtain instructions and place his stand before this Court. Therefore, the very purpose behind the rule requiring a prior demand has substantially been served.

42. Further, Section 125(2) confers a discretionary power upon the Registrar which may be exercised at any stage of the proceedings. The circumstances warranting exercise of that power are present here, particularly because the Division Bench has already directed the petitioner to take immediate steps for transfer and has kept the civil suit in abeyance awaiting the result of the

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rectification proceeding. Requiring the petitioner now first to make a separate representation to the Registrar and thereafter again approach this Court would only result in further delay in a matter pending since 2020.

43. At the same time, it is made clear that ordinarily a party seeking reference under Section 125(2) should first approach the Registrar and Article 226 cannot be invoked as a matter of course without doing so. The present case stands on its own facts, namely, the Division Bench's specific direction, the pendency of the remanded suit awaiting the rectification decision, and the first respondent's participation in the present proceedings.

44. In these circumstances, keeping Rectification No.268705 pending before the Registrar would only prolong the dispute. The transfer of the rectification proceeding to this Court would therefore be consistent with Section 125(2), the judgment of the Division Bench dated 05.06.2026 and the decision in **Asia Match Company.**

45. Accordingly, W.P.(IPD) No.26 of 2026 is allowed, with the following directions:

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(i) The first respondent, Registrar of Trade Marks, is directed to transfer Rectification No.268705, relating to Trade Mark Application/Registration No.4081447 in Class 43 standing in the name of the second respondent, together with the entire records pertaining thereto, to the Intellectual Property Division of this Court.

(ii) The transfer shall be effected within a period of four weeks from the date of receipt of a copy of this order.

(iii) Upon receipt of the records from the Trade Marks Registry, the Registry of this Court shall renumber the rectification proceeding appropriately in accordance with the Madras High Court Intellectual Property Rights Division Rules, 2022 and place the same before the appropriate Bench, if otherwise in order.

(iv) The rectification proceeding shall thereafter be considered and disposed of independently on its own merits, uninfluenced by any observation contained in this order.

46. There shall be no order as to costs.

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Index: Yes/No

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To

The Registrar Of Trade Marks
Trade Marks Registry,
Intellectual Property Building,
G.S.T.Road, Guindy, Chennai-032.

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DR.A.D.MARIA CLETE, J.

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