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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 12.10.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

CMA(TM) No.6 of 2023

Ashok Kumar Sethi,
Proprietor,
M/s.Abhinav Export Corporation
Residing at C-2, Nos.1 & 3,
Swarup Heritage, II Street,
Kasthuri Estate,
Poes Garden,
Chennai – 600 086. ... Appellant

Vs.

The Registrar of Trade Marks,
Office of the Trade Marks Registry,
Intellectual Property Rights Building,
Industrial Estate, SIDCO RMD,
Godown Area, G.S.T. Road, Guindy,
Chennai – 600 032. ... Respondent

Prayer: Civil Miscellaneous Appeal (Trade Marks) filed under Section 91 of the Trade Marks Act, 1999, praying to allow the Appeal against the order of the respondent dated 24.03.2021 and set aside the same and direct the respondent to accept the renewal

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request filed by the appellant in respect of Trade Mark Application No.728906 dated 02.09.1996 in Class 03.

For Appellant : Mrs.Gladys Daniel
for M/s. Daniel & Gladys

For Respondent : Mr.C. Samivel
Senior Panel Counsel

JUDGMENT

This appeal is directed against an order dated 24.03.2021 by which the request for renewal of Trade Mark No.728906 in Class 3 of the Register of Trade Marks was refused by citing the delay in the submission thereof.

2. The appellant applied for registration of the Trade Mark 'BLACK GOLD' in Class 3 on 02.09.1996, claiming user since 06.07.1993. The application was opposed by Mr.Ved Prakash Malhotra trading as M/s.S.P.Products (India) and such opposition was registered as Opposition No.720480. Upon hearing the

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applicant and the opponent, by order dated 31.01.2013, the opposition was rejected. Thereafter, the registration certificate was issued on 31.05.2017. Since such registration dated back to 02.09.1996 (date of application), the appellant filed renewal application in Form TM-R on 18.04.2018. A sum of Rs.18,000/- was remitted as renewal fees. Pursuant thereto, a renewal certificate dated 22.04.2018 was issued for renewal of registration for a period of 10 years from 02.09.2006. The record reflects that a notice under Section 25(3) of the Trade Marks Act, 1999 (the Trade Marks Act) was issued by the Registrar of Trade Marks on 02.07.2018 informing the appellant that the registration would expire on 02.09.2016. Thereafter, the appellant, by communication dated 23.08.2018, called upon the Registrar of Trade Marks to renew the registration for the next block of 10 years from 02.09.2016 to 02.09.2026. This request was rejected by the impugned order.

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3. Learned counsel for the appellant invited my attention to the order dated 31.01.2013 by which the opposition was rejected. She then pointed out that registration certificate dated 31.05.2017 appears to have been uploaded about 4 years later without communicating the same to the appellant. Once the appellant came to know of the registration certificate, the appellant endeavoured to renew the registration for 2 blocks of 10 years each by filing Form TM-R on 18.04.2018. According to learned counsel, the registration fee for online renewal is Rs.9,000/- per renewal and, therefore, the aggregate renewal fee of Rs.18,000/- was paid for renewal for 2 blocks of 10 years extending up to September 2026. Learned counsel submitted that the registration was renewed for the first block of 10 years from 02.09.2006 to 02.09.2016. As regards the second block of 10 years, she submitted that the request for renewal was not processed. Turning to the communication dated 02.07.2018, learned counsel submitted that such communication was not received by the appellant and was

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merely uploaded on the website. Upon coming to know of this communication, the appellant endeavoured to renew the registration from 02.09.2016 to 02.09.2026, but such request was refused under the impugned order. In these facts and circumstances, learned counsel contended that the impugned order is liable to be set aside.

4. In response to these submissions, Mr.C.Samivel, learned SPC, submitted that the application for renewal was submitted more than 2 years and 11 months after the lapse of the period prescribed for such renewal. Therefore, he submitted that the rejection of the request for renewal was in accordance with the Trade Marks Act and the Trade Marks Rules, 2017 (the Trade Mark Rules). In response to the question as to whether the Trade Mark Certificate dated 31.05.2017 was communicated to the appellant, learned counsel submitted that the records do not contain evidence of the communication thereof to the appellant.

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Likewise, as regards the RG-3 notice dated 02.07.2018, learned counsel states that the records of the Trade Marks Registry do not contain evidence of the communication thereof to the appellant.

5. The facts of this case exemplify the trials and tribulations of applicants for registration of trade marks when registration is made after considerable delay. In this case, the application for registration was filed on 02.09.1996 and the opposition proceedings were decided on 31.01.2013. Thereafter, the registration certificate was issued on 31.05.2017, which is more than 4 years after the opposition was rejected. The issuance of such registration certificate does not appear to have been communicated to the appellant. Since the registration is with effect from the date of application and such registration is valid for a term of 10 years subject to renewal, by the time the above registration certificate was issued, the first two terms of 10 years each had expired. Nonetheless, until the entry is made on the

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Register of Trade Marks, an application for renewal cannot be filed. Whether the Trade Marks Act and the rules framed thereunder provide for such piquant situation is examined next.

6. Rules 57 & 58 of the Trade Marks Rules deal with renewal of registration. The said rules are set out below:-

> *"**57. Renewal of registration.** — (1) An application for the renewal of the registration of a Trade Mark shall be made in Form TM-R along with the fee as prescribed in the First Schedule and may be made at any time not more than one year before the expiration of the last registration of the Trade Mark.*
>
> *(2) A request for renewal of registration of the Trade Mark filed within prescribed time shall be allowed unless the Trade Mark has been removed or cancelled or is otherwise not renewable under any of the provisions of the Act and rules or by any order of the competent Court or the Registrar.*
>
> ***58. Notice before removal of Trade Mark from register.** — (1) In case no application for renewal of the*

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registration in the prescribed form together with the specified fee has been received, ***the Registrar shall send, not more than six months before the expiration of registration of the Trade Mark, a notice in Form RG-3 at the address of service informing the registered proprietor of the approaching date of expiration*** *and the conditions, if any, subject to which the renewal of the registration may be obtained. (emphasis added)*

(2) Where, in the case of a Trade Mark the registration of which (by reference to the date of application for registration) becomes due for renewal, the Trade Mark is registered at any time within six months before the date on which renewal is due, the registration may be renewed by the payment of the renewal fee within six months after the actual date of registration and where the renewal fee is not paid within that period, the Registrar shall subject to rule 60, remove the Trade Mark from the register.

(3) Where, in the case of a Trade Mark the registration of which (by reference to the date of application for registration) becomes due for renewal, ***the Trade Mark is registered after the date of renewal, the registration may be renewed by the payment of***

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> ***the renewal fee within six months of the actual date of registration*** *and where the renewal fee is not paid within that period the Registrar shall, subject to rule 60, remove the Trade Mark from the register.(emphasis added)*
>
> *(4) The renewal of registration of a collective Trade Mark or a certification Trade Mark shall be in Form TM-R along with the prescribed fee as specified in the First Schedule."*

7. As per sub-rule 1 of Rule 57, an application for renewal of registration of a Trade Mark is required to be made at any time not more than one year before the expiration of the last registration of the Trade Mark. The Trade Marks Rules envisage a situation where the Trade Mark is registered after the expiry of the date of renewal. The said situation is dealt with in sub-rule 3 of Rule 58. Sub-rule 3 provides that the registration may be renewed by the payment of renewal fee within 6 months of the actual date of registration if the Trade Mark is registered after the date of renewal. If the appellant had been informed of the renewal or if

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the registration certificate dated 31.05.2017 had been communicated to the appellant, sub-rule 3 of Rule 58 would have been attracted and the appellant would have been required to seek renewal within 6 months from 31.05.2017. As discussed earlier, learned counsel for the Trade Marks Registry submits that the records of the Registry do not contain evidence that the certificate was communicated to the appellant. In these circumstances, the appellant was justified in applying for renewal on 18.04.2018.

8. Learned counsel for the appellant asserted that the said application was enclosed with fees for renewal for 2 blocks of 10 years each. The receipt indicates that a sum of Rs.18,000/- was remitted and this represents the renewal fee for 2 blocks of 10 years each. The Registrar of Trade Marks, however, renewed the registration for only one block of 10 years from 02.09.2006 to 02.09.2016 under certificate of renewal dated 22.04.2018. If the registration had been renewed for two terms at that juncture, the

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present imbroglio would have been averted. A few months later, a notice in Form RG-3 dated 02.07.2018 appears to have been uploaded. As per sub-rule 1 of Rule 58, such notice was required to be sent not more than 6 months before the expiration of the registration of the Trade Mark, whereas the notice was issued on 02.07.2018 (i.e. about 22 months after the expiry of the term of last registration) indicating the date of expiry as 02.09.2016. Undoubtedly, this notice was not in accordance with sub-rule 1 of Rule 58. Even otherwise, it flies in the face of reason and common sense to expect a party to renew a registration which expired on 02.09.2016 pursuant to notice issued on 02.07.2018.

9. For all these reasons, the impugned order is unsustainable and is hereby set aside. As a corollary, the Registrar of Trade Marks is directed to receive the requisite renewal fees, if previously refunded to the appellant, and renew the registration of Trade Mark No.728906 for a period of 10 years from 02.09.2016 to

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02.09.2026. Such renewal of registration shall, however, be subject to the outcome of (T)CMA(TM) No.30 of 2023 (OA/36/2013/TM/CH).

10. CMA(TM) No.6 of 2023 is allowed on the above terms without any order as to costs.

12.10.2023

Index: Yes/No

Speaking Order/Non-speaking Order

Internet: Yes/No

Neutral Citation: Yes/No

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To

The Registrar of Trade Marks,
Office of the Trade Marks Registry,
Intellectual Property Rights Building,
Industrial Estate, SIDCO RMD,
Godown Area, G.S.T. Road, Guindy,
Chennai – 600 032.

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SENTHILKUMAR RAMAMOORTHY,J.

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