
(2007) 12 DEL CK 0229
In the Delhi High Court
Case No : WP (C) No. 20075 of 2005

R.K. Saraf

APPELLANT

Vs

The Assistant Registrar of Trade Marks and Another

RESPONDENT

Date of Decision : 03-12-2007

Acts Referred:

Constitution of India, 1950 — Article 226
Trade and Merchandise Marks Act, 1958 — Section 25, 25(3), 25(4), 26
Trade Marks Act, 1999 — Section 57(4), 83, 91
Trade Marks Rules, 2002 — Rule 69

Citation : (2008) 36 PTC 520

Hon'ble Judges : S. Ravindra Bhat, J

Bench : Single Bench

Advocate : S.K. Bansal and Pankaj Kumar, for the Appellant; Shailen Bhatia and Amita Kapur, for the Respondent

Final Decision : Dismissed

Judgement

S. Ravindra Bhat, J.—The Petitioner is aggrieved by an order of the Assistant Registrar Trade Marks, New Delhi dated 3.8.2005 whereby the Trade Mark "ROCHAK" being No. 447376 B was directed to be removed from the Register of Trade Marks with immediate effect.

2. The brief facts of the case are that the mark "ROCHAK" (hereafter referred to as the "Trade Mark") was registered in Clause 30, i.e. the Bread, Biscuits, Cakes, Pastry and Confectionery in respect of goods. It was in favor of Sh. K.C. Bajaj, B.K. Bajaj and Y.K. Bajaj, trading as M/s Bajaj Food Products, Najafgarh Industrial Area, New Delhi. The Trade Mark was originally registered on 26.12.1985. It was apparently renewed and became due for renewal on 26.12.1996. No renewal fee was paid. The Petitioner claims to have acquired through assignment the said trade mark on 5.3.2004. It is alleged that the examiner of trade-marks informed the Petitioner on 17.3.2004 that registration of the trade mark had been renewed for the period 26.12.1999 to 26.12.2006. Subsequently Form TM-23 was lodged by the Petitioner with the Registrar of

Trade Mark and necessary changes were made in the entries. The Petitioner was registered as a Proprietor of the Mark.

3. On 25.10.2004 the second Respondent objected to for renewal of the mark on the ground that no renewal fees for the period 26.12.1999 to 26.12.2006 had been paid. The first respondent i.e. the Assistant Registrar of Trade Marks issued a show cause notice u/s 57(4) was of the Trade Marks Act, 1999 asking the Petitioner to disclose why the entry with the Trade Mark should not be recalled/struck off of the Register. This notice was resisted and the first Respondent heard arguments on 15.7.2005. During the pendency of proceedings, on 16/18-7-2005, an application was made by the Petitioner requesting the first Respondent to verify whether notice Form O-3 was issued to the Registered Proprietor when the Trade Mark became due for renewal on 26.12.1999. By the impugned order the Assistant Registrar formed the opinion that since the Petitioner failed to produce the receipt for payment of renewal fee, (though it contended that no notice under Form O-3 had been received), nevertheless in the absence of the renewal fee there was no provision under the Trade Mark Act or Rules enabling the Proprietor of the Mark to get it renewed without payment of renewal fee.

4. Mr. S.K. Bansal, learned Counsel relied upon Section 25(3) of the Trade and Merchandise Act, 1958 (hereafter called the "Old Act") and submitted that the Registrar was under an obligation to issue and serve notice in the prescribed manner to the registered proprietor about the date of expiration. To enable renewal of registration of the trade mark without due compliance with such requirement, the use of power u/s 25(4) and submitted that even after removal the Registrar had the power to receive the application and if satisfy about the bonafides of the owner of trade mark, renew it in which event it would relate back to the point in time of its expiration. Counsel urged that the provisions of the new Trade Marks particularly Section 25 & 26 to say that the same intention has been manifested in the new Act.

5. Learned Counsel also relied upon the judgment of this Court Polson Ltd. v. Polson Dairy Ltd. 1996 (16) PTC 709. He contended that this Court had relied upon Section 25(4) of the old Act and Rule 69, to hold that the question whether a particular trade- mark had or had not been removed and whether it should be restored or removed would depend on the facts of each case, if the renewal is sought after expiry of the period. It was urged that the Court held that there is no restriction placed in the renewal of trade mark retrospectively and that the provisions of the Statute were not mandatory. Similarly, the judgment of Madras High Court reported as Abdul Karim Sahib & Sons. Etc., Tiruchirapalli v. Assistant Registrar of Trade Marks, Madras 1983 PTC 55 was relied upon to say that mere non-payment of the fee is an insufficient ground to hold that the mark did not exist. All the circumstances, including an enquiry into whether the mandatory notice u/s 25(3) had been issued would have to be gone into.

6. It was lastly urged that the strenuous and arduous nature of procedure for registering a trade mark should persuade this Court to take a liberal view of the

matter. Having regard to the position explained in Polson's case; the Court can lean in favor of preserving the trade mark and allowing its renewal even if the time prescribed in that regard is acceded. Counsel relied upon the view expressed in Kerly on Trade-marks that the marks removed from the register can be restored, beyond the prescribed period.

7. Learned Counsel for the second respondent which claims to have been using the Trade Mark "ROCHAK" since 1982 submitted that the use of the trade mark "ROCHAK" by the Petitioner was unauthorized. It is claimed that proceedings, both civil and criminal were instituted and are pending. Learned Counsel contended that the trade marks registry had issued renewal certificate after 1999 without payment of renewal fees. All that the impugned order did was to rectify the error.

8. Learned Counsel submitted that this Court should desist from exercising its jurisdiction for the reason several disputed questions have been raised; (i) there is no material to show that the Petitioner had validly been assigned the mark as alleged by it; (ii) the Petitioner has not disclosed whether the original owner of the mark had or had not been issued notice. The entire petition is premised on an assumption that no such notice was issued. It was also contended that under both the old and the new Act, the maximum time limit for renewal of expired trade-marks had been prescribed. Under the old enactment, renewal was possible, for good reasons shown to the Registrar, within one year of the expiration of the period. Under the new enactment a combined reading of the proviso to Section 25(3) and Section 25(4) disclose that the period was divided into two, each of six months. In this case the Petitioner had far exceeded such stipulation and, Therefore, the Registrar had no jurisdiction to restore or renew the trade mark.

9. The above discussion would show that there is no much dispute about the facts. The trade mark ought to have been, (but was not) renewed in 1999. Apparently the Petitioner, an alleged subsequent assignee of the mark in 2004, had it renewed. There is no dispute that for 5-6 years the renewal fee was not paid. The main argument of the Petitioner is since the Registrar did not fulfill his mandatory obligation u/s 25(3) and issue notice of renewal, the time never commenced and that the pre-condition for application of the outer limit would arise only if such notice had been issued.

10. Now the decisions relied upon by the Petitioner, particularly in Polson's case is undoubtedly suggestive of an understanding that trade-marks can be renewed despite lapse of the period. This understanding was based upon an appreciation of the law expounded in Kerly's Treatise on Trademarks. Yet however, time-limits have been prescribed. The decision in Polson was rendered in the context of an interlocutory proceeding, whereby injunction was sought. The view at best is a tentative one.

11. With the coming into force of the new Act, the orders of the Assistant

Registrar of the kind which has been impugned, are appealable to the Appellate Board., in terms of Section 91. The Appellate Board has been established u/s 83 of the Trade Marks Act, 1999.

12. I am of the opinion that at least two important aspects involve examination into facts i.e. the nature and surrounding circumstances of the assignment alleged by the Petitioner, in its favor, of the trade mark in 2004 and two whether notice u/s 25 was issued and if so to whom at the relevant time. These can be better considered and the Board, after appreciation of the facts and examining the legal position, would be able to render its findings. Although there is no thumb rule that alternative remedies statutory remedies should be exhausted before a writ can be issued by the Court under Article 226, yet the jurisdiction of this Court is discretionary and should be used circumspectly.

13. In view of the key factual elements which need examination it would be more appropriate if the appellate remedy is exhausted before the Petitioner or the aggrieved party approaches this Court under Article 226.

14. In view of the above findings I decline to exercise jurisdiction under Article 226. However, since these proceedings were pending ever since October 2005, ends of justice would be met with, if the Petitioner is reserved liberty to approach the Tribunal with an appeal. In case of its doing so within four weeks from today, the Appellate Board shall examine and dispose it off on the merits, unhindered by the question of limitation.

15. The Petition is accordingly dismissed with liberty as expressly made in the preceding paragraph in favor of the Petitioner. All rights and contentions of the parties are kept open. No costs.