

(1966) 04 MAD CK 0036
In the Madras High Court

A.P.K. Narayanaswami Chettiar Firm

APPELLANT

Vs

V.K. Perumal Chettiar and Sons

RESPONDENT

Date of Decision : 13-04-1966

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Section 24

Citation : (1968) ILR (Mad) 199 : (1966) 79 LW 463 : (1966) 2 MLJ 318

Hon'ble Judges : M. Natesan, J

Bench : Single Bench

Judgement

M. Natesan, J.—This revision has been preferred against the order of the learned District Judge of Salem, directing the transfer of a suit on his file to this Court, to be tried on the Original Side, purporting to act under Sections 26 and 29 of the Indian Patents and Designs Act, 1911. The suit was instituted by the plaintiff u/s 53 of the Act for piracy of a design. The cause of action for the suit was imitation of the plaintiff's registered design, the plaintiff claiming that his design has been registered by the Government of India under the provisions of the Act. The written statement, in meeting this claim, has set up the available defence to such an action. It is pointed out inter alia that there was no question of piracy of the design and that the defendant was taking suitable action for revocation of the registration. However though on the pleadings it can have no relevance, Section 26 of the Act was referred to. The material issues set out herein reflect the contest between the parties clearly and unambiguously. They run thus: (1) Whether the plaintiff's registered design is not a new design and is of the pre-existing common type known as "Kuppadam border"; (2) whether the plaintiff is entitled to a declaration of his title to the design noted in the plaint (3) whether the defendant has infringed the design of the plaintiff by fraudulent and colourable imitation amounting to piracy; (4) whether the two designs of the plaintiff and defendant are distinct and dissimilar as contended by the defendant. It is abundantly clear that the dispute between the parties relates to a design and not to a patent.

2. The Act under Part I deals with patents and Part II relates to designs. The issues were framed on 2nd January, 1964 and subsequently the application out of which this revision arises was filed for transfer of the suit to this Court. In the affidavit, the character and nature of the suit, that is as relating only to a design and covered by Part II of the Act, is completely overlooked and the averments proceed as if the suit relates to an infringement of a patent. It is then stated that the defendant was entitled to take grounds by way of defence u/s 26 of the Act and the suit must be transferred to the High Court under the proviso to Section 29(1) of the Act. By the proviso to Section 29(1), where there is a counter-claim for revocation of a patent by the defendant, the suit, along with the counter-claim, shall be transferred to the High Court for decision. Section 26 relates to an application for revocation of a patent. Section 29(1) provides for the institution by a patentee of a suit in the District Court on infringement of patents. When we come to designs under Part II, Section 51-A provides for cancellation or registration of a design. An application for relief has to be made to the High Court and in certain circumstances it could be made to the Controller. From the Controller an appeal is competent to the High Court. Section 53 provides for institution of a suit for piracy of registered design. There is no provision corresponding to the proviso to Section 29(1) in respect of designs. Nor by any provision under the Act are the provisions relating to transfer of suits on infringement of patent made applicable to legal proceedings in respect of designs. Section 54 of the Act is of limited application as it only provides that the provisions of the Act with regard to certificates of the validity of a patent and the remedy in case of groundless threats of legal proceedings by a patentee that is, Sections 32 and 36 under Part I relating to patents shall apply in the case of registered designs in like manner as they apply in the case of patents with the substitution of references to the copyright in a design for references to a patent, and of reference to the proprietor of a design for references to the patentee and of references to the design for references to the invention. The proviso to Section 29(1) under Part I is not made applicable to a suit instituted u/s 53 for piracy of a registered design.

3. No doubt Section 51-A provides for proceedings in the High Court for cancellation of registration of a design. But for that reason only the District Court by itself cannot direct the transfer of a suit pending before it, u/s 53 of the Act. In the absence of any provision in the Act the District Court will have no jurisdiction to transfer a suit to a superior Court. The general provisions for transfer are to be found u/s 24, Civil Procedure Code. The District Court cannot avail itself of this provision in this case. It may be that if a defendant applies in the High Court for cancellation of registration of a design and makes out a case he can have the suit withdrawn to the High Court for trial along with his application for cancellation of registration of a design made u/s 51-A of the Act. An order of transfer in such circumstances cannot be as of course. I am not now called upon to discuss the matter.

4. It is not contended before me that the present case has anything to do with

patents. On a perusal of the affidavit and counter in the matter and the order made it is obvious that somehow when the application was made, the fact that the dispute related to a design and not to a patent was lost sight of. The suit relating to a design, the order of transfer cannot be sustained. It is represented at the Bar for the defendant that the defendant has already filed an application for cancellation of registration of the design u/s 51-A of the Act. It will be open to the defendant to apply in this Court for withdrawal of the suit pending on the file of the District Court, Salem. It is needless to state that the plaintiff will be free to contest the petition. But by reason of the fact that there is a possibility of the defendant getting an order of transfer, this order of transfer without jurisdiction cannot be maintained. In the circumstances, the revision is allowed. It will be open to the defendant to move the District Court for stay of further proceedings pending any application for withdrawal he may make in this Court. There will be no order as to costs.