

(2020) 10 DEL CK 0103

In the Delhi High Court

Case No : Civil Writ Petition No. 1295 Of 2020, Civil Miscellaneous Application
No. 4498 Of 2020, 21470 Of 2020

H S Sahni

APPELLANT

Vs

Union Of India And Ors

RESPONDENT

Date of Decision : 15-10-2020

Acts Referred:

Trade Marks Act, 1999 — Section 45(1)

Citation : (2020) 10 DEL CK 0103

Hon'ble Judges : Prathiba M. Singh, J

Bench : Single Bench

Advocate : S.K. Bansal, Ajay Amitabh Suman, Biji Rajesh, Gaurang Kanth, Saif Khan, Akshay Agarwal, Achuthan Sreekumar, Junaid Alam

Final Decision : Disposed Of

Judgement

Prathiba M. Singh, J

1. This hearing has been done by video conferencing.
2. The present petition has been filed by Mr. H.S. Sahni trading as M/s M.K. Auto Sales Corporation challenging the copyright registration bearing no. A-106276/2013, granted in favour of Respondent No.4 - M/s M.G. Cables (India) - a partnership firm.
3. The grievance of the Petitioner is that the label is an artistic work which also has a trademark and hence required a No Objection Certificate from the Trademark Registry under Section 45(1) of the Trade Marks Act, 1999. Mr. Bansal, Id. counsel appearing for the Petitioner submits that there are two search reports issued by the Trademark Registry, one in 2012 and one in 2016. According to him, owing to the fact that there are two search reports issued, the certificate of registration issued in 2013, which is based on the first search report, is completely invalid and the copyright registration is liable to be quashed. He further submits that it is quite strange that the Trademark Registry

has issued two search reports dated 6th December, 2012 and 30th September, 2016 and if the latter search report is deemed to be correct then the copyright certificate is not tenable in law as the registration could not have been granted prior to the search report being issued.

4. In view of these contentions the Court had summoned the original copyright registration file and called for an affidavit from the Registrar of Trademarks in this regard.

5. The original record has been received today by the Court and the same has been perused. A perusal of the original record shows that the file has only two main documents, apart from the copies of the applications and related forms etc.,. The covering letter to the original Search certificate that is on record is dated 6th December, 2012 with the despatch no. TMR-D/CC/16274 dated 6th December, 2012. The search certificate is also dated 6th December, 2012. The label in respect of which the search certificate has been issued is attached to the certificate and also has a seal. A perusal of the original records also reveals that the red seal is torn from the edges, however, the manner in which it is torn, shows that the label was part of the said search certificate. In fact, the tear marks on the label are also visible to the Court. Thus, insofar as the search certificate dated 6th December, 2012 is concerned, the same appears to have been the basis of the grant of copyright registration no. A-106276/2013 dated 5th October, 2013.

6. Insofar as the 2016 search certificate, a copy of which has been placed on record is concerned, no such search certificate exists on the original record. According to Mr. Bansal, Id. counsel, an RTI application was filed with the Trademarks Registry to confirm as to which is the correct search certificate. The reply to the RTI dated 16th January, 2020 simply transmits the information in the Form TM-60 dated 8th September, 2012, an M.G. Cables label, a letter by M/s Lalji Advocates dated 15th October, 2012- the trademark agent and the search report dated 13th October, 2012 as also the search certificate dated 30th September, 2016. The search certificate dated 6th December, 2012 is not transmitted and hence the Petitioner suspects that it is the 2016 search certificate which is valid and not the 2012 search certificate.

7. In order to assuage these concerns and to confirm the actual facts, the original record is perused. As far as the original record is concerned, the search certificate dated 6th December, 2012 exists on the record and the same appears to have been the basis of the copyright registration certificate.

8. Insofar as the 2016 certificate is concerned, the same is not produced as a part of the original record. This Court does not wish to arrive at any conclusion as to whether the 2016 search certificate in fact exists or not. Ms. Biji Rajesh, Id. counsel appearing for Mr. Gaurang Kanth, Id. CGSC who represents the Trademarks Registry, submits that in 2016, a second search certificate was issued under the presumption that the original request was still pending. There is

also an infringement proceeding which is pending between the parties. The purport and effect of the 2016 search certificate need not be gone into inasmuch as such a certificate does not exist on the record produced before this Court. The Court is satisfied that the original file which has been produced shows that the 2013 copyright certificate is based on the 2012 search certificate.

9. The question whether the search certificate has been rightly issued or not in view of any conflicting claims of either party, is also not an issue which this Court is going into and the same would depend on various other factors including prior registration and prior use etc., All issues on merits are left open. The Petitioner's remedies, if any, in respect of the copyright registration certificate dated 5th October, 2013 are also left open.

10. With these observations, the writ petition is disposed of. All pending applications are also disposed of.

11. The scanned copy of the original file be retained on record and the original file be returned to the Id. counsel for the UOI/TMR.