

(2011) 02 DEL CK 0425

In the Delhi High Court

Case No : Writ Petition (C) 3599 of 2002

Jaininder Jain and Another

APPELLANT

Vs

Central Govt. and Others

RESPONDENT

Date of Decision : 02-02-2011

Acts Referred:

Copyright Act, 1957 — Section 45(1), 72

Trade and Merchandise Marks Act, 1958 — Section 4, 56, 98

Trade and Merchandise Marks Rules, 1959 — Rule 24(1), 24(3)

Citation : (2011) 46 PTC 57

Hon'ble Judges : Dr. S. Muralidhar, J

Bench : Single Bench

Advocate : Shailen Bhatia, APS Jadaun and Priyanka, for the Appellant; Amarjit Singh, Dhruva Bhagat and Navneet Moni, for the Respondent

Judgement

S. Muralidhar, J.—The challenge in this petition is to a certificate dated 1st October 1999 granted by the Registrar of Trademarks ("Registrar") herein to M/s Kangaro Industries, Respondent No. 2 herein, u/s 45(1) of the Copyright Act, 1959 CA").

2. The case of the Petitioner is that the Petitioner No. 2 Mr. Janki Dass Jain established a proprietary concern M/s Kangaro Industries and simultaneously adopted the trademark "Kangaro". Later this was constituted into a partnership firm with his son Arihant Jain and daughter-in-law Kiran Jain as partners. The trademark "Kangaro" was registered in the name of the firm M/s Kangaro Industries. The registrations were in Classes 7, 8 and 16 of the Trade and Merchandise Marks Act, 1958 ("TM Act 1958"). It is stated that the Petitioner also floated other concerns such as M/s Jain Manufacturing Company and M/s Kanin (India) Pvt. Ltd.

3. It is stated that on 26th March 1992 it was agreed that there would be a division of various items by the firms in the following manner:

(a) Kangaro Industries - to manufacture paper punches and board clips.

(b) Jain Manufacturing Company - to manufacture index file clips and base plates for files.

(c) Kanin (India) - to manufacture staplers, staple pins and staple pin removers.

4. In December 1994 the family took a decision to form two separate groups; i.e., one consisting of Petitioner No. 1 herein and his father Janki Dass Jain Petitioner No. 2 and the other group consisting of two other sons Arihant Jain and Vishwa Jain. It was decided that the trademark "Kangaro" would go to Petitioner No. 1 along with the trade name "Kanin" while the trademark "Kanin" and trade name "Kangaro" would go to Arihant Jain. It is stated that this was formalized by Deed of Agreement/Family Settlement dated 10th/14th April 1995 in the presence of the arbitrators. The said Settlement provided for the joint working till 30th April 1995 and exclusive use of respective trademarks with effect from 1st April 1996.

5. It is stated that there have been several rounds of litigation between the parties in connection with the trademarks. The Registrar, at the instance of Respondent No. 2, removed the name of Smt. Janki Dass Jain and Smt. Kiran Jain from the registered trademarks, i.e., 376224, 384556, 463530 and 486516, by an order dated 30th October 1996. The Petitioners assail this order as being contrary to provisions of Section 98 of the TM Act 1958. It is stated that Shri Janki Dass Jain and Smt. Kiran Jain have filed a rectification petition u/s 56 of the TM Act 1958.

6. Respondent No. 2 filed a request on Form TM-60 under the provisions of the Trade and Merchandise Marks Rules, 1959 (TM Rules 1959) in respect of the artistic work "Kangaro". The requirement of obtaining a certificate from the Registrar of Trademarks before filing an application for registration of a copyright stems from an amendment made to Section 45(1) of the CA which came into force with effect from 9th August 1984. The said provision reads as under:

45. Entries in register of Copyrights. -- (1) The author or publisher of, or the owner of or other person interested in the copyright in, any work may make an application in the prescribed form accompanied by the prescribed fee to the Registrar of Copyrights for entering particulars of the work in the Register of Copyrights:

Provided that in respect of an artistic work which is used or is capable of being used in relation to any goods, the application shall include a statement to that effect and shall be accompanied by a certificate from the Registrar of Trade Marks referred to in Section 4 of the Trade and Merchandise Marks Act, 1958 (43 of 1958), to the effect that no trade mark identical with or deceptively similar to such artistic work has been registered under that Act in the name of, or that no application has been made under that Act for such registration by, any person other than the applicant.

7. Correspondingly Rule 24(1) and 24(3) of the TM Rules 1959 prescribe the

procedure to be followed for causing a search to be made for issuance of a certificate u/s 45(1). Rules 24(1) and 24(3) of TM Rules 1959 read as under:

24. Request to Registrar for search. -- (1) Any person may request the Registrar, on Form TM-54, to cause a search to be made in respect of specified goods classified in any one class in the Fourth Schedule to ascertain whether any mark is on record which resembles a trade mark of which three representations accompany the form. The Registrar shall cause such search to be made and the result thereof communicated to the person making the request.

...

(3) Any person may request the Registrar, on Form TM-60 to cause a search to be made and for issue of certificate under Sub-section (1) of Section 45 of Copyright Act, 1957 (14 of 1957) to the effect that no trade mark identical with or deceptively similar to such artistic work, as sought to be registered as copyright under the Copyright Act, 1957 (14 of 1957) has been registered as a trade mark under the Trade and Merchandise Marks Act, 1958 (43 of 1958) in the name of, or that no application has been made under that Act for such re-registration by any person other than the applicant.

8. In response to the above application filed by Respondent No. 2 on Form TM-60, the Registrar issued the following certificate:

It is certified that a search has been made among the collection of pending marks as well as in the Register of Trade Marks for the artistic work as a whole and that no Trade Mark identical with or deceptively similar to the said artistic work (a copy of which is annexed hereto) has been registered under the Trade and Merchandise Marks Act, 1958 or that no application has been made under the said Act for registration by any person other than the applicant who has applied for registration of the artistic work under No. 774582 in class 16.

9. The Petitioners have in the present petition challenged the above certificate on the ground that the Registrar has overlooked the fact that there were more than 100 registered/pending applications in respect of the mark "Kangaro". Accordingly, the Petitioners wrote to the Registrar as well as the Controller of Patents on 28th February 2002 asking that the certificate dated 1st October 1999 issued in favour of Respondent No. 2 be cancelled.

10. The Petitioner states that since the Registrar did not respond to the request they were compelled to file a separate request on Form TM-54 [relateable to Rule 24 (1) of the TM Rules 1959] in all the 34 classes. The Petitioner received search reports which showed that there were 98 trademarks which were identical/deceptively similar to the trademark "Kangaro".

11. On the strength of the certificate dated 1st October 1999 issued by the Registrar of Trademarks, Respondent No. 2 applied for registration of copyright in the artistic work "Kangaro". Objections to the said application were filed by the Petitioners herein. The objections were rejected by an order dated 28th February

2002 by the Registrar of Copyrights. Admittedly the point urged before the Registrar of Copyright was that since the objectors were the owners of the trademark "Kangaro" the artistic work "Kangaro" could not be registered under the CA. However, acting on the certificate issued on 1st October 1999 by the Registrar, the Registrar of Copyright granted the registration on 13th March 2002 in respect of the artistic work titled "Kangaro".

12. Aggrieved by the above order, the Petitioners on 26th March 2002 filed an appeal before the Copyright Board ("Board") u/s 72 of the CA. Although a reference was made in the grounds of appeal to Section 45(1) of the CA and Rule 24 (3) of the TM Rules 1959, it was not specifically urged that the certificate issued on 1st October 1999 by the Registrar of Trademarks was bad in law and ought not to have been acted upon by the Registrar of Copyright.

13. By an order dated 12th April 2005 the Board dismissed the Petitioner's appeal. Thereafter an application seeking review of the order dated 12th April 2005 was filed before the Board.

14. In the meanwhile, after the order of the Registrar of Copyright dated 28th February 2002 and after the filing of the appeal against the said order on 26th March 2002, the Petitioners applied in TM-54 for a search report in terms of Rule 24(1) of the TM Rules, 1959 and thereafter filed the present writ petition on 26th May 2002.

15. This Court has heard the submissions of Mr. Shailen Bhatia, learned Counsel appearing for the Petitioners and Mr. Amarjit Singh learned Counsel appearing for Respondent No. 2. None has appeared for Respondent No. 1.

16. Although there were several arguments made concerning Section 45(1) CA and Rules 24(1) and 24(3) of the TM Rules 1959 and the effect of the certificates obtained respectively by Respondent No. 2 and the Petitioners herein from the Registrar of Trademarks, this Court is of the view that it is not necessary to examine the merits of those contentions in this writ petition. The reason is that in the review petition filed before the Board in ground (I) the Petitioners have urged as under:

(I) The Hon'ble Board has observed that the "Appellant has failed in pointing out any formal or substantive infirmity in the Order of the Registrar". The Hon'ble Board has failed to consider the averments made in the Appeal/submissions of the Appellant/Petitioner. The impugned Order merits to be set aside on this ground alone.

17. Counsel for the Petitioner and Respondent No. 2 agree that the question whether the subsequent search reports provided by the Registrar to the Petitioners pursuant to an application made by them under TM-54 negates the earlier certificate dated 1st October 1999 issued by the Registrar to Respondent No. 2 pursuant to the searches made on its application under Form TM-60, can be permitted to be urged by the Petitioners before the Board in the review

petition pending before it and the Board will decide such question on merits. This Court is of the view that the above question will have a bearing on the validity of the order of the Registrar of Copyright granting copyright registration for the artistic work in question in favour of Respondent No. 2. Therefore, the Board should examine such question on merits. The Petitioners are permitted to place on record in the pending review petition before the Board, the documents in the form of search reports obtained by them as well as the print-outs from the internet in that regard. The Board will, within a period of six months from today, consider on merits the above question as well as the documents to be placed by the Petitioners before it and pass appropriate orders.

18. The writ petition is disposed of with the above directions.

19. Order dasti.