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(1976) 10 DEL CK 0004

In the Delhi High Court

Case No : First Appeal Nos 89 of 1970

Lachhman Das Bihari Lal — APPELLANT

Vs

Bhagwan Dass etc — RESPONDENT

Date of Decision : 14-10-1976

Acts Referred:

Citation : AIR 1977 Delhi 200 : (1977) ILR Delhi 327

Hon'ble Judges : B.C. Misra, J

Bench : Single Bench

Advocate : Anoop Singh and N.K. Anand, for the Appellant;

Judgement

B.C. Misra, J.

(1) This first appeal has been filed under sec- corporation 109(6) of the Trade & Merchandize Marks Act, 43 of 1958 (hereinafter referred to as the Act). It is directed against the order of the Assistant Registrar, dated 25th April, 1970, by which he has refused the application of the appellants to remove the mark of the contesting respondents I to 3 (hereinafter referred to as the respondents), from the register of trade marks.

(2)

"The facts of the case are that the appellants filed an application u/s 56 of the Act to rectify the register by removal of the entry No. 183344 of the impugned trade mark of the respondents. The allegations made by the appellants were that they were the registered proprietors of trade mark No. 141860 having the leading feature of the device of a train and the words "ROYAL Frontier Mail SNUFF"

in class 34 and that the respondents had contravened the conditions of the registration of their own mark, which they had altered by adding a device of a train and had thereby committed infringement of the appellants'' registered trade mark. It was further alleged that the respondents had obtained their registration

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by fraud and they had no bona fide intention to use the mark as registered in relation to their goods and had not used the same up to the month before the date of the application. Notice of this application was issued to the respondents, who contested the same and statements and counter-statements were filed. However, at the hearing the respondents did not appear and the Assistant Registrar closed their case. He, however, came to the conclusion that in an application for rectification the onus lay on the applicants to establish a case for removal of the mark from the register as is clear from section 31(1) of the Act which provides that registration of a trade mark is prima facie evidence of the validity thereof and that u/s 56(2) of the Act the Tribunal has a discretion either to remove or not to remove a mark from the Register. He further held that the appellants before me were aggrieved persons, since they were from the same trade and from the same place. On the merits of the case, the Assistant Registrar came to the conclusion that the appellants had failed to prove that the respondents had not been using the registered mark or had obtained the registration by fraud. He repelled the contentions of the appellants that the respondents had no intention to use the mark and that its use did in the opinion of the Assistant Registrar, not amount to infringement of the appellants trade mark. As a result, he dismissed the application with costs.

(3) Feeling aggrieved, the appellants have assailed the said order in this appeal and their counsel, Mr. Anoop Singh, has contended: The Assistant Registrar below has erred in not relying on the affidavit of Jaswant Siagh; (2) He has erred in correctly appreciating and applying the rule of law laid down in Toofan Mail''s case; (3) The respondents were not using the trade mark as registered, but the one which had been substantially altered and its use was contrary to B the imposed conditions; and (4) The impugned trade mark had not been registered with the bona fide intention to use and was, Therefore, liable to removal. I have heard Mr. Anoop Singh in support of the appeal and Mr. N.K. Anand for the respondents at some length.

(4) In my opinion, the Assistant Registrar was correct in his finding that the appellants are really the aggrieved persons and that onus in an application for rectification rests on the applicants to establish the grounds on which the rectification must be ordered.

(5) The Assistant Registrar has, however, fallen into an error in not accepting the affidavit of Jaswant Singh. The reason he has advanced is that after having filed the affidavit, he, at a later stage, withdrew the previous affidavit and so the Assistant Registrar has rejected the affidavit. In my opinion, once evidence has been produced on the file, it is not open to any party to withdraw the same without leave of the court granted on adequate grounds. The original affidavit had been filed by the party as evidence of truth. So far as the subsequent letter withdrawing the same is concerned, neither the party nor the deponent took the responsibility for the same and mere receipt of communication in the office of the Registrar purporting to be from the deponent, though attested by a Notary

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Public, withdrawing the affidavit cannot be acted upon. In such a case, the Assistant Registrar must insist upon the parties to show cause for withdrawal of the affidavit and if the parties do not take the responsibility, then the deponent must appear before the Registrar and satisfy him with sufficient grounds for withdrawal of the previous affidavit, e.g. if the previous affidavit had not been sworn by him or had been obtained by fraud or coercion or any other sufficient ground, then the Registrar may decide as to whether he would accept the withdrawal or would refuse leave for its withdrawal and would act on the first affidavit. The only effect of a subsequent affidavit of withdrawal, if genuine would be that there may be two conflicting affidavits on the file and this will have an important bearing on the reliability of the affidavit, but withdrawal of an affidavit simplicities by subsequent affidavit much less by a letter is not a procedure known to judicial or quasi-judicial proceedings. Should this withdrawal be permitted, the matter may become endless as the Registrar may be faced with a number of conflicting affidavits or withdrawals or withdrawal of withdrawals, as the parties may succeed in procuring and filing. It is, Therefore, clear that once an affidavit has been filed, it can ordinarily not be withdrawn unless and until the Registrar is satisfied that the previous one had been filed under circumstances that would make its filing invalid. The reason advanced by the Assistant Registrar for rejecting the affidavit of Jaswant Singh is legally not correct. But no opinion is expressed on the merits of the case and it would be open to the Assistant Registrar to deal with the said affidavit in such manner according to law as he thinks fit.

(6) Toofan Mail''s case was the subject matter of Civil Original 16-D of 1959 (Lachman Dass, etc. by Behar- Lal, etc.), decided by Falshaw, J. on 11th December, 1959. (1) A Letters Patent Appeal against the same was L.P.A. 69-D of 1959. and was decided by Bishan Nairain and 1. D. Dua, JJ. by order dated 13th September, 1960. The appellants before me were the petitioners in the original petition in the High Court and they applied under section.. 45 and 37 of the Trade Marks Act, 5 of 1940 (the predecessor of the present Act.) for cancellation of the trade mark of Chanan Ram Behari Lal. The facts were that the appellants, who were proprietors of the trade marks Royal Frontier Mail Snuft", registered under No. 141860 on 4th January, 1950, felt aggrieved by the registered trade mark of the opposite party in that case. The impugned trade mark consisted of a blank rectangle about 3'""X2" surrounded by a sort of frame. It was contended that the respondents did not get the trade mark registered with the bona fide intention of using it and had not in fact ever used their registered trade mark, though they had been fraudulently using the word ''Registered'' on the trade mark they had been using which included the picture of the train. The use of the device of the train in the mark was contrary to the registered mark. It was consequently contended that the use of the trade mark with the device of a train and calling it registered trade mark showed that the party had never a bona fide intention to use their trade mark as registered with a blank panel without any device. The learned single Judge held that the party had not used the

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registered trade mark for more than five years and so ordered its removal from the register. An important feature of the case, as noticed in the judgment of the single Judge, is this: In the course of the brief cross-examination of the respondent he virtually gave his whole case away. He was shown a certified copy of his registered trade mark and he said : ''One of our registered trade mark is Ex. P2. When I registered the trade mark it was not my intention to have the central place blank but to put in the picture of a train. We have never used the trade mark as it is in Ex. P2 with the space blank''. On this admission the court came to the conclusion that the trade mark was liable to cancellation on both the grounds (a) and (b) of sub-section (1) of section 37 since the trade mark was registered without any bona fide intention of using it in that form and in fact it had not been used for more than five years before the application was filed. 16HCD/76 6.

(7) The decision of Falshaw J. was subject matter of a. Letters Patent Appeal. The Division Bench on appeal found that the addition of the train with a down signal substantially affected its identity and the distinguishing feature of the mark as used was the train and not the writing around it and so the addition in tile registered trade mark was held to substantially affect its identity. The court observed that in this view of the matter, admittedly the trade mark as registered had never been used by the appellant-firm; the trade mark was registered in June, 1949 and the appellant-firm had not been using it for ten years; and it was clear from the written statement of the appellant-firm that it has neither used nor intended to use the trade mark as registered and that it has been using before and after its registration with a, railway train and the "down signal". Consequently, they had never intended to use the trade mark as registered. With these observations, the appeal was dismissed.

(8) In my opinion, this authority turns on its own facts. Whether or not a party had a bona fide intention never to use the trade mark as registered must be esta,blished as a fact on the material placed on the record. It is not possible to infer it as a matter or law merely E from the use of the registered trade mark by the party with an alteration in breach of the conditions of registration. If a condition of the registration is broken, it may be open to the Assistant Registrar to remove the mark for this or any other reason, but not en the ground that the party never had the intention to use the registered trade mark. The Assistant Registrar in the impugned order noticed the above authority to decide the case in hand on its own facts and has not committed any error of law in appreciating the Toofan Mail''s case. But, since this case is not reported. I have extracted its substance and stated its ratio by perusal of the original records of the court.

(9) This takes us to the consideration of the remaining contention of Mr. Anoop Singh. Section 56 of the Act reads as follows :

"(1)On application made in the prescribed manner to a High Court or to the Registrar by any person aggrieved, the tribunal may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground

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of any contravention, or failure to observe a condition entered on the register in relation thereto. 2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to a High Court or the Registrar, and the tribunal may make such order for making, expunging or varying the entry as it may think fit. (3)The Tribunal may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register. (4)The Tribunal, of its own motion may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2). (5)Any order of the High Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly. (6)The power to rectify the register conferred by this section shall include the power to remove a trade mark registered in Part A of the register to Part B of the register."

Section 46(1) reads as follows :

"Subject to the provisions of section 47. a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application made in the prescribed manner to a High Court or to the Registrar by an person aggrieved on the ground either (a)that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him or, in a case to which the provisions of section 45 apply, by the company concerned, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to a date one month before the date of the application; or (b)that up to a date one month before the date of the application, a continuous period of five years or longer had elapsed during which the trademark was registered and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being: Provided that, except where the applicant has been permitted under sub-section (3) of section 12 to register an identical or nearly resembling trade mark in respect of the goods in question or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark the tribunal may refuse an application under clause (a) or clause (b) in relation to any goods, if it is shown that there has been. before the relevant date or during the relevant period, as the case may, be. bona fide use of the trade mark by any proprietor l hereof for the time being in relation to goods of the same description, being goods in respect of which the trade murk is registered."

The arguments addressed at the bar seek to make out a point that in order to attract the removal of the Trade Mark u/s 56(1), the applicant must satisfy the grounds mentioned in clauses (a) and b) of section 46(1) of the Act and the

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appellants before me have attempted to bring their case within clauses (a) and (b) of section 46(1). In my opinion, there is a fallacy in the submission. Section 46 is (subject to S. 47) an independent provision which furnishes the grounds for removal of the trade mark from the register. In an application filed u/s 56 of the Act, it is not always necessary to establish the ingredients of either clause (a) and (b) of section 46, although some of the grounds may partly overlap. Section 56(1) of the Act is clear and self-combined and lays down that the High Court or the Registrar is entitled to order the cancellation or variation of the registration of the trade mark on the ground of any contravention or failure to observe a condition entered on the register in relation thereto.

(10) In Nokes v. Doncaster Amalgamated Collieries Limited, (1940) AC 1014, it was held that the principles of construction which apply in interpreting a section were well established ; the golden rule is that the words of statute must prima facie be given their ordinary meaning..... and Judges were not called upon to apply their opinions of sound policy so as to modify the plain meaning of statutory words. Similarly, the Supreme Court in Sales Tax Officer, Banaras and Others Vs. Kanhaiya Lal Mukundlal Saraf, , observed in paragraph 16 that if the terms were plain and unambiguous, resort could not be had to the position in law as it obtained in England or in other countries and it was the clear duty of the courts to construe the plain terms of the statute and give them their legal effect. It was further observed in paragraph 21 that to ascertain the true meaning and intent of the provisions we have got to turn to the very terms of the statute itself, divorced from all considerations as to what was the state of the previous law or the law in England or elsewhere at the time when the statute was enacted. To do otherwise would be to make the law, not to interpret it.

(11) Consequently, I am of the view that the plain words of our statute must be construed and given their full legal effect and it is not necessary for me to dwell on the state of law prevailing in the U.K. and the decisions available there. On a plain construction of section 56 of the Act, it. Therefore, follows that if a proprietor of a registered trade mark substantially contravenes or fails to observe any condition of the registration imposed upon him, then the Tribunal is authorised to order the cancellation or variation in its discretion on this ground simpliciter, whether or not the grounds mentioned in section 46 are established and for that matter whether or not the impugned trade mark infringes section Ii of the Act. That may or may not be a ground for action for removal, but the power to remove u/s 56(1) is independent of sections 11 and 46 of the Act. It inheres in the language of section 56 and merely because the party has contravened the conditions either by any act or omission, the Tribunal has been enabled to cancel the registration. There is a valid reason for the same. Whenever registration is granted subject to some conditions, it is expected that the party will faithfully observe the conditions. If it fails to do so, the Registrar is enabled to enforce the condition by ordering cancellation of the registration; whether or not the contravention of the condition imposed by the Registrar at the time of registration infringes the rights of some other party or not. This is also

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evident from the provisions of section 56(4), which entitles the Tribunal to act suo motu.

(12) However, I do not wish to suggest that the Registrar or the High Court for that matter, is bound to order cancellation or variation for every contravention of the conditions, but the matter rests in the discretion of the Tribunal to be exercised according to well established principles of law, as is manifest from the expression ''such order as it may think fit''. In my opinion, the parties have, Therefore, misdirected themselves with regard to the scope of section 56. Even at the risk of repetition, it may be emphasised that where the contravention of a condition also involves infringement of clauses (a) and (b) of section 46(1) or section Ii or any other provision of law, that may afford a substantially good ground for the Registrar to cancel the registration. But to order cancellation or variation, the Registrar has ample power u/s 56(1) and the exercise of this power is not dependent upon the finding of infraction of any other provision of law, like section 46 or section 11 of the Act or the rights of any other party. Again section 46 of the Act itself contains self-sufficient provisions for removal from the register or for various on the grounds of nonuser, and the High Court and the Registrar are empowered by the language of the section to order taking of the registered trade mark from the register on an application made in the prescribed manner. There is nothing in the language of section 56 of the Act to attract the construction that the exercise of power u/s 56 is dependent on the establishment of ingredients of section 46.

(13) In view of the rule of law laid down above, it will be for the Registrar to determine as to whether the respondents have committed any substantial breach of the conditions of registration of their trade mark and if so what orders should be passed by him u/s 56 of the Act. The counsel for the appellants also requests me to leave the question open as to whether the act of the respondents renders liable to removal of the trade mark u/s 46 of the Act. I agree that the request is reasonable. In this view of the matter, I do not propose to discuss the various authorities cited by the counsel for the parties to show whether or not the act of the respondents rendered them liable to removal u/s 46 of the Act. No opinion is expressed on the merits of the case either, as to whether the respondents have or have not used the impugned mark in breach of the conditions.

(14) As a result, the appeal is allowed. The impugned order of the Assistant Registrar is set aside and the case is remanded to him for fresh decision according to law, after affording both the parties another opportunity to produce such evidence as they may produce in accordance with law. The costs of this appeal will -abide by the result of the application.

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