

(2001) 10 DEL CK 0143
In the Delhi High Court
Case No : CO No. 19 of 1995

Lakha Ram Sharma

APPELLANT

Vs

Balar Marketing Pvt. Ltd. and Others

RESPONDENT

Date of Decision : 10-10-2001

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 107, 108, 2(1), 23(1), 3
Trade and Merchandise Marks Rules, 1959 — Rule 4, 5, 6

Citation : (2002) 97 DLT 342 : (2002) 3 RCR(Civil) 246

Hon'ble Judges : A.K. Sikri, J

Bench : Single Bench

Advocate : Manmohan Singh, Sadhna Sharma and Surinder Singh, for the Appellant; S.K. Bansal, for the Respondent

Judgement

A.K. Sikri, J.—An interesting question relating to territorial jurisdiction of this court has been posed in this case. The petitioner filed the application u/s 46 and 56 of the Trade and Merchandise Marks Act(for short "Act") for rectification of the registered trade mark No. 507445 as of 23th March, 1989 in class 9 of the IV Schedule of the Act. The trade mark KUNDAN/KUNDAN CAB is the subject matter of the aforesaid registration which is registered in the name of the respondent No. 1. It is in respect of electrical accessories and fittings including electrical switches, main switches, fuse units, wires and cables and electrical irons. The petitioner claims that it has also been using the trade mark KUNDAN/KUNDAN CAB/KUNDAN CABLES INDIA in respect of these very goods since 1980 and when the petitioner came to know that the respondent No. 1 was also using the same trade mark, the petitioner filed suit for permanent injunction in the court of District Judge, Delhi. In the said suit, the respondent No. 1 filed counter claims and it was disclosed that the trade mark KUNDAN/KUNDAN CAB is registered in favor of the respondent No. 1. It is because of this reason, the present petition is filed by the petitioner for rectification and prayer is made the trade mark No. 507445 in Class 9 of IV Schedule be cancelled/expunged from the Register of Trade Marks.

2. The question of territorial jurisdiction arises in the following circumstances:

3. The respondent No. 2 herein, which is a firm, with its office at Chennai had filed an application for registration of the aforesaid trade marks. When the application was still pending, the respondent No. 2 assigned the trade mark KUNDAN in favor of respondent No. 1. This assignment application was allowed by the Registrar and accordingly the registration certificate was issued to the respondent No. 1. Since the application was filed in the Trade Mark Registry at Chennai, the objection of the respondents 1 & 2 is that the application for rectification can be filed in the court at Chennai only.

4. In support of the aforesaid submissions, learned counsel for the respondents 1 & 2 submitted that Section 2(1)(h) of the Act defines High Court to mean the High Court having jurisdiction u/s 3. u/s 3(b) of the Act, the High Court having jurisdiction under this Act shall be the High Court within the limits of whose appellate jurisdiction the office of the Trade Mark Registry referred to in each of the following cases is situated present purposes Clause (b) is relevant and accordingly the application for registration of the said trade mark was made at the Trade Mark Registry at Chennai and it is in that office where the present trade mark is registered. Under Rule 4 of the Trade and Merchandise Mark Rules, 1959 (for short "Rules") the appropriate office of the Trade Mark Registry for the purposes of making the application for registration or for filing an application for rectification or for any proceedings under the Act and Rules for the purposes of the said trade mark registration and the instant rectification is the Trade Mark Registry at Chennai. Further, the jurisdiction of the appropriate office cannot be altered by change in principal place of business or address for service under Rule 5. Under Rules 6, the Registrar of Trade Marks has entered the appropriate office of the Trade Mark Registry at Chennai as the appropriate office wherein the said trade mark has been registered and wherein the said application for registration was made. The same is also borne out by the advertisement of the said trade mark in the Trade Mark Journal No. 1045 at page 990 and a perusal thereof shows that the principal place of business and the appropriate office thereof is at Chennai as also for registration was also made before the Registrar of Trade Marks at Chennai. u/s 5 of the Act, the Government of India has established Trade Mark Registries in five regions covering the whole of India having jurisdiction over their notified States and territories. The five regions having their respective Trade Mark Registries are at Bombay, Calcutta, Delhi, Ahmedabad and Chennai. The Registrar of Trade Marks at Chennai exercises jurisdiction over the States of Andhra Pradesh, Kerala, Tamil Nadu, Karnataka and the Union Territories of Pondicherry and Lakshadweep islands. The appropriate office of the trade mark registry where the said trade mark was registered and the said registry is situate is at Chennai and the appropriate High Court as per Section 3 of the Act is at Chennai.

5. In support of his submission learned counsel relied upon the following three judgments as well:

1. Priya Enterprises v. Prestige Housewares (India) Ltd. reported in 1998 (18) PTC 539.

2. Satyanarayana Khubchand Carva and Others Vs. Ramchander Laxmi Narayan Karva,

3. Vikas Manufacturing Company v. Maharaj Manufacturing Company reported in 1981 PTC 87.

6. The submission of the learned counsel for the petitioner, on that other hand, was that the application for registration was filed by the respondent No. 2 with the Chennai office on 23th March, 1989, it was published in the Journal on 16th December, 1992 and the application for assigning the trade mark by respondent No. 2 in favor of the respondent No. 1 was filed on 17th February, 1993 which was allowed on 14th April, 1993 itself. Thus the respondent No. 1 which is a party in Delhi, got itself substituted for respondent No. 2 and pursued with the application. The certificate of registration was granted on 15th November, 1994 in favor of the respondent No. 1 which has its office at Delhi. On the basis of these facts, learned counsel for the petitioner submitted that provisions of Section 3(a) would get attracted as per which this court has the territorial jurisdiction to try the instant petition.

7. It was his further submission that the application for rectification has to be decided as a suit in view of the position laid down in Section 107 of the Act. He also referred to the other provisions relating to rectification and correction of the register i.e. Section 56 and Section 108 of the Act.

8. I have given my thoughtful consideration to the issue involved.

9. Section 3 of the Act deals with the jurisdictional aspect and stipulates that as to which High Court shall have the jurisdiction to deal with the cases under different circumstances. Five different situations are mentioned in Clause (a) to (e) of Section 3. We are not concerned with Clause (c) to (e). Whereas the petitioner is relying upon Clause (a) of Section 3 the respondents 1 & 2 are taking shelter under Clause (b). In order to appreciate the rival's contention, it would be appropriate to reproduce the provisions of these two Clauses in the first instance:

3. High Court having jurisdiction:- The High Court having jurisdiction under this Act shall be the High Court within the limits of whose appellate jurisdiction the office of the Trade Marks Registry referred to in each of the following cases is situate, namely:-

(a) in relation to a trade mark on the Register of Trade Marks at the commencement of this Act, the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the proprietor of the trade mark as entered in the register at such commencement is situate;

(c) in relation to a trade mark for which an application for registration of pending

at or is made on or after the commencement of this Act, the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the applicant as disclosed in his application is situate.

10. Clause (a) shall have no application in the present case simply because it is applicable in those cases where the trade mark has already been registered at the time of commencement of the Act and in that case the office of the trade mark registry within whose territorial limit the principal place of business in India of the proprietor of the trade mark as entered in the register at such commencement is situate. This provision takes care of all those trade marks which were already registered at the time when this Act came into force and does not deal with applications for registration filed after the commencement of the Act. In the present case application for registration of trade mark was filed much after the Act came into force. The provisions of Clause (b) are clearly attracted in such case which, inter alia, deals with those situations also where the application for registration is made on or after the commencement of the Act. In that case the office of the Trade Mark Registry within whose territorial limits the principal place of business in India of the applicant as disclosed in his application is situate. Here the application was filed by the respondent No. 2 in the Trade Mark Registry at Chennai. The principal place of business as disclosed in his application was Chennai. Simply because during the pendency of the application, the assignment was made in favor of the respondent No. 1 would not alter the position in law. After all the application remained pending with the Trade Mark Registry at Chennai where it is ultimately registered and the register containing the registration of the respondent No. 1's trade mark is kept at Chennai.

11. Let us now examine the position from another angle. In those cases where the registration is done by the Trade Mark Registry of a particular region and subsequently there is an assignment by the trade mark owner in favor of another party which is outside the jurisdiction of that Trade Mark Registry, such subsequent assignment would not alter or affect the position in any manner. The appropriate office of the Trade Mark Registry would continue to remain the same and this conclusion is inevitable on the combined reading of Sections 2(1)(h), 3(b), and 5 of the Act as well as Rules 4, 5 & 6 of the Rules. This is also the ratio of the three judgments cited by learned counsel for the respondents 1 and 2. Therefore, emphasis is on the place where the application is made initially. After making the application assignment takes place during the pendency of the application or after the registration of the trade mark would not make any difference in law. Thus I find force in the arguments of learned counsel for the respondents 1 and 2. u/s 23(1)(b) of the Act, the trade mark when registered shall be registered as of the date of making of the said application and it is that date that shall be deemed to be the dt of registration. The date on which the application of registration was made in March, 23 1989 which is clear from the Trade Mark Journal. The purpose of confining the trade mark registration to one jurisdiction/office for the purposes of its rectification under the provisions of

Sections 2(1)(h), 3, 5 and Rules 4, 5 and 6 is, inter alia, to facilitate rectification proceedings so that an aggrieved party does not have to run around to various courts should the assignment be effected in various different jurisdiction. Likewise, even the registered proprietor gets confined to one jurisdiction wherein the validity/removal of his mark can be determined. The Legislature has chosen the situs of the trade mark as the place for conferring territorial jurisdiction which continuous to be at the trade mark registry at Chennai. Even in a civil action for injunction the suit can be filed at a place where the mark is registered even though the person infringing the registered mark does not carry out its impugned activities in that place. (Refer: 1. Amrutanjan Ltd. v. Ashwin Fine Chemicals and Pharmaceuticals reported in 1991(2) Arb.L.R. 384(MAD), 2. K.B. Venkatachala Mudaliar v. Vanaja Match Works reported in 1990 PTC 259 and 3. Ramu Hosieries rep. by M. Murugesan v. Ramu Hosieries, rep. by Pandela Ramu and Anr. reported in 1999 PTC 183.

12. Consequently this application which is filed by the petitioner is not maintainable in this court and ought to have been instituted in the High Court of Madras at Chennai.

13. The petition is accordingly returned for presentation before the appropriate court.