

(2012) 06 CAL CK 0053
In the Calcutta High Court
Case No : Writ Petition No. 8015 (W) of 2007

M/s. Stadmed Private Limited and Another	APPELLANT
Vs	
The Intellectual Property Appellate Board and Another	RESPONDENT

Date of Decision : 06-06-2012

Acts Referred:

Constitution of India, 1950 — Article 226, 226(2)
Intellectual Property Appellate Board (Procedure) Rules, 2003 — Rule 16, 20, 21, 23
Trade Marks Act, 1999 — Section 83

Citation : (2012) 06 CAL CK 0053

Hon'ble Judges : Jayanta Kumar Biswas, J

Bench : Single Bench

Advocate : Sudipto Sarkar and Mr. S.N. Mitra, s, with Ms. Mousumi Bhattacharjee, Mr. Rupak Ghosh and Mr. Susanta Kumar Dutta, for the Appellant; Ranjan Bachwat, R. Bhattacharjee, Paritosh Sinha, Amitava Mitra and Ms. Dolon Dasgupta, Advocates, for the 2nd Respondent, for the Respondent

Final Decision : Dismissed

Judgement

Hon"ble Mr Justice Jayanta Kumar Biswas

1. The petitioners in this WP under art.226 dated November 4, 2006 are questioning an order of the Intellectual Property Appellate Board established under s.83 of the Trade Marks Act, 1999. The order is at p.35 of the WP. It is dated August 4, 2006 and was passed in Mumbai by a Circuit Bench of the Appellate Board sitting in Mumbai. With a covering letter dated August 23, 2006 (at p.34) the office of the Appellate Board sent a certified copy of the order to Stadmed (the first petitioner) at its recorded address: 33A Jawaharlal Nehru Road, 11th Floor, Kolkata-700 071, a place within the territories in relation to which this Court exercises jurisdiction under art.226.

2. Stadmed filed an application for Rectification No. BOM-1034 dated January 16, 1995 before the Registrar of Trade Marks, Trade Marks Registry, Central Building, M.K. Road, Bombay-400 020. It wanted removal of a trade mark whose

registered proprietor was one Sun Pharmaceutical Industries Ltd., F.P. 145, Ram Mandir Road, Vile Parle (East), Bombay 400 057.

3. By an order dated March 24, 2003 the Deputy Registrar of Trade Marks allowed the Rectification Application and directed removal of the trade mark in question from the register. Feeling aggrieved, Sun Pharmaceutical (the second respondent) lodged an appeal with the Appellate Board. By the impugned order dated August 4, 2006 the Appellate Board allowed the appeal and set aside the order of the Deputy Registrar of Trade Marks, Mumbai dated March 24, 2003.

4. Mr Bachwat appearing for Sun Pharmaceutical has raised the question of jurisdiction of this Court to entertain the WP. He has said that no part of the cause of action on which the WP was filed had arisen within the territories in relation to which this Court exercises jurisdiction under art.226.

5. He has relied on the decisions in Collector of Central Excise, Madras Vs. M.M. Rubber and Co., Tamil Nadu, Municipal Corporation of Delhi Vs. Qimat Rai Gupta and Others, ; Samir Kumar Shill v. Union of India & Ors., 2007 (60) AIC 519 (Cal.,HC); W.P. No. 7030 (W) of 2007 (Heiza Boilers (I) Pvt. Ltd. & Anr. v. Union of India & Ors.) dated July 16 & 20, 2009, Single Bench of this Court; Chemithon Engineers Pvt. Ltd. v. Secy., Dept. of Atomic Energy & Ors., 2011(45) PTC 406 (Cal)(DB); and W.P. No. 22106 (W) of 2010 (SRRAK-REIPL JV. & Ors. v. Union of India & Ors.) dated January 19, 2011, Single Bench of this Court.

6. Mr Sarkar appearing for the petitioners has submitted that the petitioners rightly invoked the art.226 power of this Court, because the impugned order sent by the Appellate Board in compliance with the provisions of r.21 of the Intellectual Property Appellate Board (Procedure) Rules, 2003 had affected the petitioners in West Bengal where they had received it. His submission is that the cause of action on which the WP was filed - if not the whole, a substantial part thereof - had arisen within the territories in relation to which this Court exercises jurisdiction under art.226.

7. He has said that the facts constituting the cause of action and showing that this Court had jurisdiction are contained in para.36 of the WP. Paragraph 36 is quoted below:

36.The impugned order dated 4th August 2006 passed by the respondent no.1 was addressed to and received at the office of the petitioner within the ordinary original jurisdiction of this Hon''ble Court. The effect and consequence of the said order is felt at the office of the petitioner within the ordinary original jurisdiction of this Hon''ble Court. The records relating to the instant matter are further lying in the office of the petitioner within the ordinary original jurisdiction of this Hon''ble Court.

8. Elaborating his argument Mr Sarkar has said as follows. Rule 21 of the rules has created a mandatory statutory obligation of the Appellate Board to serve its order. Hence until an order, though pronounced by it under r.20, is served, the

appeal concerned remains pending and the order cannot be said to be passed and binding on the parties. The pronouncement, without notice, for notice is given only under r.16 and it is only for hearing, does not give rise to a cause of action; it arises only when the pronounced order is served. When law requires service of an order providing a cause of action, receipt thereof is a part of the cause of action. Besides, the petitioners were affected by the order in West Bengal where it was served.

9. Mr Sarkar has relied on the decisions in *The State of Punjab Vs. Sodhi Sukhdev Singh*, ; *Bachhittar Singh Vs. The State of Punjab*, ; *State of Punjab Vs. Amar Singh Harika*, ; *Serajuddin and Co. Vs. The State of Orissa and Others*, ; *Umasankar Chatterjee v. Union of India & Ors.*, 1982 (1) CHN 100; *Union of India (UOI) and Others Vs. Hindustan Aluminium Corporation Limited and Another*, ; and *Bikash Bhushan Ghosh and Others Vs. Novartis India Limited and Another*, .

10. The questions are whether the cause of action on which the WP was filed had arisen only when a copy of the order of the Appellate Board dated August 4, 2006 sent by its office was received by the petitioners; and if not, then whether the fact of receipt of the order by the petitioners was a part of the cause of action on which this WP was filed.

Rule 16 of the rules is quoted below:

16.Date of hearing to be notified.-The appellate Board shall notify the parties the date and place of hearing of the application or appeal in such manner as the Chairman may by general or special order direct.

Rules 20 and 21 of the rules are quoted below:

20.Order to be signed and dated.-(1) Every order of the Appellate Board shall be signed and dated by the Members of the Bench.

(2)The order shall be pronounced in the sitting of the Bench.

21.Communication of orders-A certified copy of every order passed by the Bench shall be communicated to the parties to the proceedings.

Rule 23 of the rules is quoted below:

23.Review petitions.-(1) A petition in triplicate for review of an order of the Appellate Board may be made to the Registry in the prescribed Form 6 under these rules within two months from the date on which the order is communicated accompanied by a statement setting forth the grounds on which the review is sought. Where the order in question concerns more than one respondent, sufficient extra copies of such petition and statement shall be filed.

(2) The Registry shall forward the petition and statement to the respondents to the review petition.

(3)The respondents may file counter-statement in Form 1 under these rules

within two months from the date of receipt of the review petition and shall forward a copy of the counte-statement to the petitioner directly under intimation to the Registry.

(4)The review petition shall be posted for hearing before a Bench by the Chairman.

11. The service requirement under r.21 of the rules has nothing to do with the passing of an order by the Appellate Board. The order is passed the moment it is signed, dated and pronounced pursuant to r.20. It is wrong to say that until the pronounced order is served, the appeal remains pending and it neither binds anyone, nor gives rise to a cause of action to question it. Once the order is pronounced, one aggrieved thereby gets a cause of action therein; it is that only for the purpose of one's review remedy under r.23 the limitation starts running not from the date of pronouncement, but from the date of service of the order.

12. The proposition stated, reiterated and explained in the cited decisions that an order, though signed and dated, is not said to be passed and binding until it is served has no application to the case of an order of the Appellate Board. Unlike judicial and quasijudicial orders, administrative orders are not pronounced. Judicial and quasi-judicial orders signed and dated, but not pronounced, and administrative orders signed and dated, but not dispatched for service, remain in the control of their authors who can change them; and this is why they are not said to be passed until they go out control of their authors. Once pronounced or dispatched, their authors lose the control.

13. In this case the order questioning which the WP was filed had been signed, dated and pronounced by the Appellate Board, pursuant to r.20 of the rules, on August 4, 2006. The appeal in question stood disposed of, for the Appellate Board was not required to do anything more with it. It was for the office of the Appellate Board to send a copy of the order to the parties. Therefore, the step taken by the office of the Appellate Board for service of the pronounced order pursuant to r.21 of the rules was not a part of the pronounced order in which the petitioners' whole cause of action was.

14. Since the cause of action on which the WP was filed had arisen on August 4, 2006 when the Appellate Board signed, dated and pronounced the order pursuant to r.20 of the rules and thus disposed of the appeal in question, it is to be examined whether the fact of receipt of the order by the petitioners was a part of the cause of action.

15. In SRRAK-REIPL also I examined the part of cause of action concept; and there I said:

I hope I will not be considered unappreciative of the very impressive arguments of counsel for the parties and disrespectful to the formidable authorities cited by them, if I say that in view of my decision in Heiza Boilers that I gave after considering the Supreme Court decisions in State of Rajasthan and Others Vs.

Swaika Properties and Another, , Oil and Natural Gas Commission Vs. Utpal Kumar Basu and Others, , Kusum Ingots and Alloys Ltd. Vs. Union of India (UOI) and Another, and Om Prakash Srivastava Vs. Union of India (UOI) and Another, for brevity's sake, instead of dealing with the cited decisions separately, I can reiterate the principles summarized in Heiza Boilers."

16. The principles summarized by me in Heiza Boilers were as follows:

Facts which have no bearing on the lis or the dispute involved in the case do not give rise to a cause of action so as to confer territorial jurisdiction on a court. What is to be seen is whether a particular fact is of substance and can be said to be material, integral or essential part of the lis between the parties. If it is, it forms a part of the cause of action. If it is not, it does not form a part of the cause of action. In determining the question the substance of the matter, and not the form thereof, is to be considered. The answer to the question whether the service of a notice is an integral part of the cause of action within the meaning of art. 226(2) must depend upon the nature of the impugned order or action giving rise to the cause of action, and the test to ascertain this is whether for questioning the order or action it is necessary to plead the fact of service of the notice in the writ petition and prove it. Only those facts without the proof of which the action must fail are material and essential facts in the bundle of facts constituting the cause of action. Hence a fact without the proof of which a writ petition will not fail is not an integral part of the cause of action, and, accordingly, it cannot be said that a part of the cause of action has arisen at the place where the event concerning the fact has happened.

17. I think in this case also it will not be inappropriate to say the same thing that I said in SRRAK-REIPL with respect to the decisions cited before me in support of the proposition that in certain cases a part of a cause of action arises at the place where an order of the respondent is served and received. Suffice it to say that none of the cited decisions can be said to be a binding precedent for the proposition. The test is whether the relied on facts are integral parts of the bundle of facts constituting the cause of action.

18. A fact is an integral part of the bundle of facts constituting a cause of action only when for succeeding in the case it is to be pleaded and proved. There is no reason to say that if the petitioners failed to plead and prove the fact concerning the step taken by the office of the Appellate Board for service of the pronounced order pursuant to r.21 of the rules, then their WP questioning the order would have failed. Hence service and receipt of the order at a place within the territories in relation to which this Court exercises jurisdiction under art.226 had nothing to do with the cause of action on which this WP was filed

19. It is not correct to say that since the petitioners were affected by the order in West Bengal, - the case stated in the WP taken at face value,- a part of the cause of action on which the WP was filed had arisen within the territories in relation to which this Court exercises jurisdiction under art.226. The order was to

affect the petitioners wherever they were. A part of the cause of action was not to arise at all their business places. It is not that the order had been affecting them at the place it was served due to any enforcement step taken by the Appellate Board. This is the test. For these reasons, I hold that this Court had no jurisdiction to entertain the WP. It is, accordingly, dismissed. No Costs. Certified xerox.