

(2009) 07 DEL CK 0309

In the Delhi High Court

Case No : Writ Petition (C) 18925 of 2006

Naresh Kumar Jain

APPELLANT

Vs

Union of India (UOI) and Others

RESPONDENT

Date of Decision : 14-07-2009

Acts Referred:

Constitution of India, 1950 — Article 226
Trade Marks Act, 1999 — Section 100

Citation : (2009) 41 PTC 228

Hon'ble Judges : Sanjiv Khanna, J

Bench : Single Bench

Advocate : Shailen Bhatia and Vandna Nathan, for the Appellant; Sandeep Sethi Gurvinder Singh and Gurpreet Singh for R-2, for the Respondent

Final Decision : Allowed

Judgement

Sanjiv Khanna, J.—The petitioner, Mr. Naresh Kumar Jain, has impugned the order dated 30th November, 2006 passed by the Intellectual Property Appellate Board dismissing his application dated 31st May, 2006 for placing on record additional documents in the rectification application.

2. The aforesaid rectification application was filed by the M/s. Shiva Tobacco Company, respondent No. 2 herein in 1997 in Delhi High Court and was registered as C.O. No. 11/1997. In the said rectification application, issues were framed on 29th July, 2002 and the parties were given time to file list of witnesses and additional documents, if any, within 4 weeks thereafter. The rectification application was being tried as a civil suit.

3. Additional documents were not filed by both the parties i.e. the petitioner and respondent No. 2 herein, as recorded in the order dated 9th September, 2002 of the Joint Registrar. While the case was pending, the respondent No. 2 herein filed an application for transfer of the civil suit pending between the parties before the District Judge. Notice of the said application was issued on 27th November, 2002 and vide order dated 29th July, 2003, the suit pending before the District Court

along with the counter claim was ordered to be transferred to this Court and directed to be listed along with the rectification application for directions on 14th October, 2003.

4. On 15th September, 2003, the Trade Marks Act, 1999 was partly enforced and the jurisdiction to decide rectification application was transferred to the Intellectual Property Appellate Board. On 19th December, 2003, learned single Judge of this Court passed a detailed order dealing with the contentions of the parties and directed that the rectification application should be transferred to the Intellectual Property Appellate Board and the civil suit and counter claim should be transferred back to the District Court.

5. The Intellectual Property Appellate Board after receiving the papers from this Court issued notice to the parties for appearance on 14th February, 2005. By another notice the hearing fixed on 14th February, 2005 was adjourned and reposted on 15th February, 2006. Subsequently by notice, the hearing fixed was reposted on 3rd May, 2006. As already stated above on 31st May, 2006, the petitioner had filed an application for filing of additional documents before the Intellectual Property Appellate Board.

6. Non-filing of documents does result in delay of proceedings and has to be viewed seriously as observed by the Intellectual Property Appellate Board in the impugned order. This Court had granted time to the parties to file additional documents vide order dated 29th July, 2002. However, additional documents were not filed by both the parties within four weeks. Normally in such circumstances, the petitioner and other parties should not be permitted to file additional documents. However, there are several other factors and reasons which counter balance and warrant setting aside of the impugned order passed by the Appellate Board and to permit the petitioner to file additional documents.

(i) The respondent No. 2 herein had moved an application for transfer of the civil suit along with the counter claim to the High Court in November, 2002. By order dated 29th July, 2003, the civil suit along with the counter claim were directed to be transferred to High Court and the matter was placed for direction on 14th October, 2003. It is accepted by the parties that at least some of the documents enclosed with the application dated 31st May, 2006 are part of the documents filed in the said civil suit/counter claim.

(ii) Subsequently, vide order dated 19th December, 2003, the rectification petition was directed to be transferred to the Appellate Board and the civil suit and counter claim retransferred to the District Court. Thereafter, no substantial proceedings had taken place before the Appellate Board as is clear from the notices issued by them. First hearing of the case was fixed on 14th February, 2005 but then adjourned by notice to 15th February, 2006 and again to 3rd May, 2006. Before any substantial proceedings had taken place, the petitioner had filed the application on 31st May, 2006 for placing on record additional documents.

(iii) It is accepted by the parties that respondent No. 2 in the rectification application filed before this Court had filed photocopy of documents. As per the provisions of the Code of Civil Procedure, 1908 and Evidence Act, primary evidence, i.e. original documents are required to be filed by the parties. With part notification of the Trade Marks Act, 1999, the rectification application was transferred from the High Court to the Appellate Board. But for the transfer, respondent No. 2 was required to seek liberty or move an application for placing on record original documents. Thus the respondent No. 2 was equally guilty and in the same identical position as the petitioner.

(iv) Section 100 of the Trade Marks Act, 1999 reads as under:

100. Transfer of pending proceedings to Appellate Board.-All cases of appeals against any order or decision of the Registrar and all cases pertaining to rectification of register, pending before any High Court, shall be transferred to the Appellate Board from the date as notified by the Central Government in the Official Gazette and the Appellate Board may proceed with the matter either de novo or from the stage it was so transferred.

The Appellate Board has liberty and discretion to try and decide whether de novo proceeding or proceeding from the stage the matter was transferred should be held. No specific order has been passed in this regard by the Board.

(V) Documents at Sr. No. 2 to 10 are copies of pleadings, advertisements or copy of applications which have been filed/issued by the respondent No. 2.

7. In these circumstances, I feel that the petitioner should be permitted to place on record/ produce original documents enclosed with the application. The petitioner however will pay cost of Rs. 20,000/- to the respondent No. 2 for the delay.

8. Normally, this Court would not have interfered with the order passed by the Appellate Board in exercise of jurisdiction under Article 226 of the Constitution of India. However, in the impugned order dated 30th June, 2006 several aspects/facts which are relevant and material for the decision of the application have not been taken into consideration. The errors pointed out are relevant and relate to the decision making process by which the final conclusion has been arrived at.

9. The writ petition is allowed to the extent indicated above. It is clarified that this Court has not expressed any opinion on merits of the claims of the parties inter se and also upon genuineness and veracity of documents. The cost will be paid to the respondent No. 2 within 10 days.