

(1998) 04 MAD CK 0156

In the Madras High Court

Case No : O.P. No. 474 of 1995 Application No. 3670 of 1997

Priya Enterprises

APPELLANT

Vs

Prestige Housewares (India) Ltd.

RESPONDENT

Date of Decision : 03-04-1998

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 107, 108, 111, 3, 3(e)

Citation : (1998) 04 MAD CK 0156

Hon'ble Judges : B. Akbar Basha Khadiri, J

Bench : Single Bench

Advocate : Mohan Associates, for the Appellant; N.A.K. Sarma, Litta Srinivasan and N. Nithianandam, for the Respondent

Final Decision : Allowed

Judgement

B. Akbar Basha Khadiri, J.—This application has arisen in this way:- The sole proprietrix of Priya Enterprises Saidapet has filed O.P.No.474 of 1995 against the Prestige Housewares (India) Ltd.. Bangalore for rectification of the register of trade and for removal of the trade mark from the register for non-user of the trade mark. According to the petitioner, the registered trade mark No. 141602 being the word mark, namely, prestige, was originally registered in class 21 in the name of plaster and Stampers Limited, Colne Road, Burnley, Lancashire, England during 1949. The name of the registered proprietor was subsequently altered to the Prestige Group Limited. Prestige House. Holborn, London E.C.I., England on 12.01.1957. Then, on 13.10.1989 the trade mark was registered in the name of the Prestige Housewares (India) Limited, Bangalore with effect from 04.10.1985. But the respondent, the Prestige Housewares (India) limited has not been using the trade mark for more than past five years and one month.

The petitioner is the manufacturer of rubber gasket which are fixed to the pressure cooker lids. He is manufacturing gaskets suitable for the pressure cookers sold with the brand names Prestige, Killicks, Videocon, Usha, etc. for the purpose of identifying that this product is meant to be used as a gasket for the

particular type of pressure cooker, in the back of his rubber gasket, the petitioner is using the brand name.

2. The respondent issued a cease and desist notice to the petitioner calling upon him to the cease and desist from the word "Prestige" Because of the existence of the registration of the impugned trade mark in favour of the respondent. the petitioner apprehends that it may not be possible to do his business lawfully. Therefore, the petitioner has come forward with the main petition for removal of the trade mark of the respondent from the register.

3. The respondent in the main petition has filed the instant application namely. Application No. 3670 of 1997, contending that the respondent trade mark was registered with the Registrar of Trade Mark at Calcutta and if any rectification proceeding is sought to be instituted that should be done only at Calcutta and this Court has no Jurisdiction and therefore, the main O.P. should be dismissed.

4. The petitioner / respondent herein had not filed counter, but contested the matter.

5. The point for consideration is whether this Court has jurisdiction to entertain the main petition?

6. The learned Counsel for the respondent submitted that rectification proceedings can her instituted only in the High Court, within whose jurisdiction the trade is registered and the registry is situate. The learned counsel for the Petitioner submitted that the present registered office of the respondent is in Bangalore and the territory of Bangalore comes within the jurisdiction Registrar of Trade mark at Madras and therefore, this Court has jurisdiction. According to the counsel for the petitioner, the respondent is a foreign company who had to place of business is India at the time when the trade mark was registered or even at the time when the Trade Mark Act. 1949 and the Trade Mark Act 1958 came into force and therefore, provisions of 3(e)of the Trade and Merchandise Marks Act. 1958 would apply.

7. The trade mark was registered at Calcutta Office of the registrar of the Trade Mark as No. 141602 in class 21. I have carefully gone through the provisions of sections 3, 5, 46, 56, 107, 108and 111of the Trade and Merchandise Marks Act. Prior to 1959. there was only one Trade Mark Registrar's Office at Calcutta for the whole of India. But, by notification dated 25.11.1959. the whole India has been divided into four regions, namely. Bombay. Calcutta, Delhi, and Madras, and the Registrar of Trade Mark at Madras has jurisdiction over the State of Andhra Pradesh. Kerala, Mysore and Tamilnadu. Mysore has now become Karnataka State. The jurisdiction of the High Court is determined by the section 3of the act. An application for rectification of the register can be entertained only by the Court depending upon where the trade mark in question was registered. Section 3of the Trade and Merchandise Marks Act reads as under;

"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;

(b).....

(c).....

(d).....

(e) where the registered proprietor or the applicant for the registration as aforesaid has no place of business in India or where some of the joint applicants as aforesaid has any place of business in India, the office of the Trade Marks Registry within whose territorial limits.

(i) In relation to a trade mark on the Register of Trade Mark at the commencement of this Act. the place mentioned in the address for service in India as entered in the register at such commencement;

(ii) In relation to a trade mark for which an application for registration is pending at or is made on or after such commencement, the place mentioned in the address for service in India as specified in the application; is situate"

According to the petitioner, the respondent was originally an English Company who had no place of business in India at the time of registration of the trade mark, at the time when earlier Trade Mark Act, 1940 came into force and also at the the time when the new Trade and Merchandise Marks Act, 1958 came into force and therefore. the provisions of section 3(e) would apply according to which the place where the respondent is residing, i.e.. Bangalore, which comes within the jurisdiction of the Trade Marks Registry of Madras and therefore, this Court has jurisdiction. According to the respondent, though the respondent has no principal place of business in India, in the Registry of Trade Marks, the address of service in India has been mentioned as C/O. Remfry & Son. Stephen House, Dalhousie Square. Calcutta. Therefore. a applying the provisions of section 3(e) (i) of the Act, only the High Court at Calcutta has jurisdiction to entertain the application.

8. The learned Counsel cited three authorities in support of his arguments. In *Chunulal Seetaram Vs. G.S. Muthiah and Brothers and Others*, . it has been held that the office of the Registrar of Trade Marks is situated in Bombay, that the Register of Trade Mark is kept at Bombay, and the rectification is made in that register, that it must, therefore, be held that the High Court having jurisdiction in the matter is the High Court at Bombay and not High Court at Madras. Though the decision cited supra is given u/s 76 (1) of the Act, it squarely applies to the facts of the instant case. In *Vikas Manufacturing Co. v. Bharaj Manufacturing Co.* (Reqd.) (1980 (1) P.L.R. 16). the application was filed in Punjab and Haryana

High Court for rectification of the register, and the respondent took a preliminary objection that that Court had no jurisdiction. The Punjab and Haryana High Court held that section 3 read section 5 of the Trade and Merchandise Marks Act would show that court had no jurisdiction to entertain the application for rectification. In a recent case, decided by my learned brother Rengaswamy. J. in O.P. No. 803 of 1994 and Appln. No. 2495 in C.S. No. 5 of 1994. it has been held that the application u/s 56 of the Act can be entertained only in the High Court referred to section 3 of the Act. The trade mark having been registered at Bombay, only Bombay High Court will have jurisdiction. On a careful consideration of the matters placed before me. I am satisfied that the main petition for rectification ought to have been instituted in Calcutta High Court. In that view of the matter, this application. A. No. 3670 of 1997 is allowed. Return O.P. No. 474 of 1995 for presentation before the proper court.