
(1977) 04 AP CK 0006

In the Andhra Pradesh High Court

Case No : Appeal Against Order S.R. No. 80657 of 1977

Satyanarayana Khubchand Carva and Others

APPELLANT

Vs

Ramchander Laxmi Narayan Karva

RESPONDENT

Date of Decision : 06-04-1977

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 2, 3, 56

Citation : AIR 1977 AP 360

Hon'ble Judges : Sambasiva Rao, Acting C.J.;Amareswari, J

Bench : Division Bench

Advocate : V. Jogayya Sarma, for the Appellant; K.V. Rama Sarma, for the Respondent

Judgement

A. Sambasiva Rao, Ag. C.J.

1. The question we will have to answer in this reference made by the Office is; whether an appeal (Civil Miscellaneous Appeal) lies to this Court against an order of the Assistant Registrar of Trade Marks, Madras, dismissing an application u/s 56 of the Trade and Merchandise Marks Act, 1958, hereinafter called "the Act", filed for rectification of the register of trade marks ? When the appeal was presented to this Court (it) has no jurisdiction to entertain the appeal and it is only the Madras High Court that has jurisdiction over the matter.

2. The material facts are simple and are not in controversy. The proposed appellants filed an application u/s 56 of the Act to rectify the register of trade marks, before the Assistant Registrar of Trade Marks, Madras. It may be noted here that there are only four such Registries in the entire country, one at Madras, second at Bombay, third at Calcutta and fourth at Delhi. The Registry at Madras has jurisdiction over the States of Tamil Nadu, Andhra Pradesh, Kerala and some other Southern Regions. The dispute about the trade mark was raised in Hyderabad, because it related to a business in that City. However, the application was filed before the Assistant Registrar at Madras. He heard the matter at Hyderabad and rendered his decision at Madras and despatched his order to the

parties who were living at Madras. Contending that the matter relates to the business at Hyderabad, that the parties live and had their business at Hyderabad and that the case was heard counsel for the proposed appellants, has presented the appeal in this Court. The Office raised the objection that under the provisions of the Act, the appeal lies only to the High Court of Madras and not to this Court. When the learned counsel demurred to this statement of the law, the matter was placed before us for orders.

3. The problem can be resolved by making a reference to the material provisions of the Act. We will first notice the definition contained in Ss. 2(e) and 2(h). Section 2(e) defines "District Court" as having the same meaning assigned to it in the Civil Procedure Code, 1908, Section 2(h) states,

"High Court means the High Court having jurisdiction u/s 3."

Section 3 says this about "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 situated, namely :-"

It is not necessary to refer to the five clauses set out thereafter. It is common case of the parties before us that the present case comes under Clause (b) of Section 3. Sri Rama Sarma for the respondent and Sri Jogayya Sarma for the proposed appellants are one in saying that the matter comes u/s 3(b). Pausing here for a minute, it is necessary to notice the distinction kept up by the Act between "District Court" and "High Court", "District Court" as per the provisions of the Act, has the same meaning which has been assigned to it in the Civil Procedure Code, 1908. The expression "High Court" has a different connotation. As per Section 2(h), it is the High Court having jurisdiction u/s 3; and Section 3 makes it abundantly clear that a High Court having jurisdiction under the Act is the High Court within the limits of whose appellate jurisdiction the Office of the Trade Marks Registry is situate. So, if Section 2(h) is read with Section 3, there cannot be any doubt that the High Court which has jurisdiction under the Act is the High Court within whose limits of jurisdiction the Office of the Trade Marks Registry is situate. If that is the test, since the office of the Trade Marks Registry is in Madras, it is the High Court of Madras which is the High Court that has jurisdiction.

4. Further provisions of the Act re-inforce this conclusion. We will now go to Section 56 which deals with power to cancel or vary registration and to rectify the register. According to it, either the High Court or the Registrar may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto. That can be done by either authority on the application made in the prescribed manner. Section 57 confers power on the Registrar to correct the register in certain specified cases on an application made in this behalf by the Registered proprietor. It is thus seen that under

Sections 56 and 57, power is conferred either on the High Court or on the Registrar to cancel or vary registration or to rectify the register and on the Registrar to make a correction of the register in certain cases. If these two provisions are compared with Section 105, the distinction that is brought out would be very revealing. Section 105 refers to suits for infringement and according to it, no suit for infringement of a registered trade mark, or relating to any right in a registered trade mark, or for passing off arising out of the use by the defendant of any trade mark which is identical with or deceptively similar to the plaintiffs trade mark, whether registered or unregistered, shall be instituted in any Court inferior to the District Court having jurisdiction to try the suit. We have already noticed that as per Section 2(e) which defines District Court, District Court has the same meaning as has been given to it under the Civil Procedure Code. So, if there is any infringement of a registered trade mark, the Act provides through Section 105 that a suit shall be instituted in Courts which are not inferior to a District Court. Thus, the dichotomy between action for infringement and action for variation and rectification is kept up by the Act. For variation, rectification etc., an aggrieved party will have to go straightway to the High Court or to the Registrar; and for infringement of a registered trade mark and allied reliefs, he will have to go to the District Court or a Court Superior thereto. To get such a relief, he cannot go either to the High Court u/s 57. Then Section 107 provides for filing an application for rectification of register before High Court in certain cases. Once again, it has emphasised the dichotomy that has been maintained by the Act between rectification on the one side and suit for infringement on the other. Different remedies before different forms are provided for these two categories of relief by the Act.

5. Now we come to Section 109. What is material is Sub-section (2) of that Section. It reads:

"Save as otherwise expressly provided in Sub-section (1) or in any other provisions of this Act, an appeal shall lie to the High Court within the prescribed period from any order or decision of the Registrar under this Act or the rules made thereunder."

Sub-section (8) of the same Section says:

"Subject to the provisions of this Act and of the rules made thereunder, the provisions of the Civil Procedure Code, 1908 shall apply to appeals before a High Court under this Act."

Now Section 109(2) provides for appeals to the High Court only against an order or decision of the Registrar made under the Act or the rules made thereunder. It is significant to note that this Section does not provide for any appeal against a decision made by the Court u/s 105. In fact, there is no provision in the Act providing for an appeal against an order or decree passed by the Court in a suit filed u/s 105. Obviously and patently, an appeal against such orders and decree will lie as per the CPC and as per the provisions of the Civil Court Act before the

appellate authority. If it is the District Court, the appeal against the decree or order of the Court lies to the High Court having appellate jurisdiction over that District Court. Such, however, is not the case in regard to orders and decisions passed or made by the Registrar under this Act. As we have already adverted to, the matters relating to rectification of the register are within the realm of either the High Court or the Registrar. If it is the order or decision of the Registrar, in regard to rectification, the appeal shall lie to the High Court.

6. Then the only question that remains is, which is the High Court that is postulated by Section 109 ? There cannot be any two opinions as to how this word "High Court" occurring in Section 109(2) should be understood. It should be understood in the light of the definition contained in Section 2(h) read with Section 3. In clear and categorical terms, Section 3 declares that the High Court having jurisdiction under the Act shall be the High Court within the limits of whose appellate jurisdiction the Office of the Trade Marks Registrar is situate. Therefore, there cannot be any hesitation in answering the question that only the High Court within the limits of whose appellate jurisdiction the Office of the Trade Marks Registrar is situate which has the jurisdiction to entertain the appeal against the order or decision of the Registrar. There is no dispute and indeed there could be no dispute that the Trade Marks Registry which has rendered the decision in this case is situate in Madras, which is undoubtedly within the appellate jurisdiction of the High Court Madras. The fact that the business in respect of which the trade mark dispute has arisen was at Hyderabad, the further fact that the parties live in Hyderabad, and the still further fact that the matter has been heard in Hyderabad, do not make any difference with the legal position that emanates from the examination of all the above material provisions of the Act. Therefore, we have no hesitation in holding and in fact the provisions of the Act do not leave any scope for holding otherwise, that this Court has no jurisdiction because the Registry is not within its appellate jurisdiction and that the Madras High Court alone has jurisdiction because the Registry is within its appellate jurisdiction.

7. We would not have felt it necessary to refer to any case-law on the point because the statute itself is very clear. However, since they have been placed before us, we would like to refer to them very briefly.

8. Before we refer to the decisions, we must note that the Act of 1940 has been re-enacted in 1959. In *Chunulal Seetaram Vs. G.S. Muthiah and Brothers and Others*, , a Division Bench of the Madras High Court was considering the case under the old Act. This is what Rajamannar, C. J., speaking for the Division Bench, said on this particular aspect of the matter:

"As the Office of the Registrar of Trade Marks is situated in Bombay, the register of Trade Marks is kept at Bombay and the rectification is made in that register, it must be held that the High Court having jurisdiction in the matter is the High Court at Bombay and not the High Court at Madras."

Another Division Bench of the same High Court said this in *Sri Chamundeeswari Weaving and Trading Co. (Pie) Ltd. Vs. The Mysore Spinning and Manufacturing Co., Ltd., and Another, ,* which is also under the 1940 Act:

"An application for rectification of Trade Marks Register by deleting the registered trade marks can be filed only in the High Court within whose jurisdiction the Trade Marks Register is situate or in that High Court within whose jurisdiction the owner of the mark resides or carries on business. The High Court within whose jurisdiction the goods bearing the impugned trade mark are sold has no such jurisdiction."

Out won High Court has also spoken on this subject. In *Habeeb Ahmad Vs. Registrar of Trade Marks, Madras and Another, , Jaganmohan Reddy, J.,* (as he then was) sitting single, considered the question as to which High Court the party should apply for rectification. While repelling the argument that since the parties lived and did their business within the jurisdiction of this Court, the learned Judge held:

"Thus if a person wishes to apply for the registration of a mark he should go to the office which has jurisdiction over the area in which he has his principal place of business. Rectification proceedings can be taken only in the High Court having jurisdiction, that is to say, if a trader has registered his trade mark in Bombay, then rectification proceedings will take place in the Office at Bombay or in the High Court at Bombay as the case may be. Only four High Courts would have jurisdiction for rectification, namely, the High Courts at Bombay, Calcutta, Madras and Punjab. The Court having appellate jurisdiction is the Court which has jurisdiction for rectification etc. The High Court of the places where the Registry is situate are the Appellate Courts against the orders passed by that Registry, so that for the four Registry Offices, the four High Courts are the four Appellate Courts having appellate jurisdiction. In the circumstances, Andhra Pradesh High Court has no jurisdiction for registration of a mark or for its rectification."

While coming to this conclusion, the learned Judge relied on *Chunulal Seetaram Vs. G.S. Muthiah and Brothers and Others, .* Like view have been taken by the Allahabad and Gujarat High Courts in *Batti Kunwar v. Chunnilal Sukla*, AIR 1965 All 256 and *M/s. New Prabhat Tiles Works v. M/s. Prajapati Tiles Co.,* (1972) 13 Guj LR 645.

9. In the light of the above discussion only one answer is possible, and that is that this Court has no jurisdiction to entertain the appeal and it is the High Court of Madras that can entertain it. The question referred to us by the office is answered accordingly.

10. The Memorandum of Civil Miscellaneous Appeal shall be returned to the learned counsel for the appellants on or before 13th April, 1977 so that he can represent it to the proper Court.

11. Reference answered accordingly.