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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

*Reserved on: 1 September 2023*  
*Pronounced on: 4 September 2023*

+ C.O. (COMM.IPD-TM) 8/2023

DR. REDDYS LABORATORIES LIMITED ..... Petitioner  
Through: Mr. Ranjan Narula, Mr. Shashi  
P. Ojha, Ms. Aishani Singh and Ms.  
Shivangi Kohli, Advs.

versus

FAST CURE PHARMA AND ANR. .... Respondents  
Through: Mr. Harish Vaidyanathan  
Shankar, CGSC with Mr. Srish Kumar  
Mishra, Mr. Alexander Mathai Paikaday and  
Mr. M. Sriram, Advs. for R-2

+ C.O. (COMM.IPD-TM) 97/2023 & I.A. 11985/2023

CENTRE CONSORTIUM, LLC ..... Petitioner  
Through: Mr. Urfee Roomi, Ms. Soumya  
Jain, Ms. Anuja Chaudhury and Mr.  
Anubhav Chhabra, Advs.

versus

KRUNAL HARJIBHAI SARDHARA & ANR.

..... Respondents  
Through: Mr. Haresh Raichura and Mr.  
Kalp Raichura, Advs. for R-1  
Mr. Harish Vaidyanathan Shankar, CGSC  
with Mr. Srish Kumar Mishra, Mr.  
Alexander Mathai Paikaday and Mr. M.  
Sriram, Advs. for R-2  
Ms. Ridhi Raman, CGSC with Mr. Zubin  
Singh, Adv. for Registrar of Trademarks



**CORAM:  
HON'BLE MR. JUSTICE C. HARI SHANKAR**

**JUDGMENT**

**04.09.2023**

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**C.O. (COMM.IPD-TM) 8/2023 & C.O. (COMM.IPD-TM) 97/2023**

[Legal provisions have been reproduced to the extent relevant.]

1. In both these matters, a common question of law has arisen, regarding the appropriate High Court before which an application under Section 47<sup>1</sup>, 57<sup>2</sup> or 124<sup>3</sup> of the Trade Marks Act, 1999, for

<sup>1</sup> 47. **Removal from register and imposition of limitations on ground of non-use. –**

(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the High Court by any person aggrieved on the ground either –

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of Section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

Provided that except where the applicant has been permitted under Section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the Registrar or the High Court, as the case may be, is of opinion that he might properly be permitted so to register such a trade mark, the Registrar or the High Court, as the case may be, may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to –

(i) goods or services of the same description; or

(ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.

<sup>2</sup> 57. **Power to cancel or vary registration and to rectify the register. –**

(1) On application made in the prescribed manner to the High Court or to the Registrar by any person aggrieved, the Registrar or the High Court, as the case may be, 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.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the High Court or to the Registrar, and the Registrar or the High Court, as the case may be, may make such order for making, expunging or varying the entry as it may think fit.



rectification of the Register of Trademarks by deleting, therefrom, the mark of the Respondent 1 in each of these cases, may be filed.

2. In each of these cases, the Trademark Registry, where the impugned mark was registered, is situated outside Delhi and, therefore, outside the territorial reach of this Court. This issue crops up before this Court in various cases. It is, therefore, of recurring importance.

## Bare Facts

(3) The Registrar or the High Court, as the case may be, may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(4) The Registrar or the High Court, as the case may be, of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).

(5) Any order of the High Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

<sup>3</sup> **124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc. –**

(1) Where in any suit for infringement of a trade mark –  
 (a) the defendant pleads that registration of the plaintiff's trade mark is invalid; or  
 (b) the defendant raises a defence under clause (e) of sub-section (2) of Section 30 and the plaintiff pleads the invalidity of registration of the defendant's trade mark,

the court trying the suit (hereinafter referred to as the court), shall, -

(i) if any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar or the High Court, stay the suit pending the final disposal of such proceedings;

(ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is *prima facie* tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the High Court for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b)(ii) of sub-section (1) within the time specified therein or within such extended time as the court may for sufficient cause allow, the trial of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction, directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.



C.O.(COMM.IPD-TM) 8/2023

3. The petitioner, Dr. Reddy's Laboratories has filed CS (COMM) 436/2021 against Respondent 1, Fast Cure Pharma ("FCP") alleging that FCP's mark RAZOFAST infringes the petitioner's mark RAZO. Both marks are used for the antacid pharmaceutical compound 'Rabeprazole'.

4. The suit stands decreed, *vide* judgment dated 16 August 2023, in favour of the petitioner.

5. During the pendency of the suit, the petitioner sought an adjournment, on 23 August 2022, to file a petition seeking cancellation of the defendant's RAZOFAST mark. Adjournment, as sought, was granted by this Court *vide* order dated 23 August 2022.

6. The petitioner, thereafter, proceeded to file the present petition before this Court on or around 15 November 2022, seeking rectification of the Register of Trade Marks by removal, therefrom, of the mark RAZOFAST of Respondent 1.

7. Nonetheless, Mr. Ranjan Narula was candid and fair in acknowledging, on the last date of hearing – 16 August 2023 – that this Court would have to take a view on whether the present rectification petition would lie before this Court, or before the High Court of Calcutta, which exercises territorial jurisdiction over the Kolkata office of the Trade Marks Registry, which granted registration, on 23 December 2018, to the RAZOFAST mark of



Respondent 1.

8. It is thus that the issue of territorial jurisdiction has arisen.

C.O.(COMM.IPD-TM)-97/2023

9. This application does not carry the baggage, behind it, of any pending suit. The petitioner seeks cancellation of the registration granted by the Ahmedabad office of the Trade Marks Registry to the **USDC** mark of Respondent 1, under Section 47<sup>1</sup>, on the ground of non-use for over five years since registration.

10. The registration having been granted by the Ahmedabad office of the Trade Marks Registry, the issue of whether the present petition lies before this Court arises in this case as well.

11. I may note, here, that Mr. Haresh Raichura, learned Counsel for Respondent 1 in C.O.(COMM.IPD-TM) 97/2023, acknowledged, in response to a query from the Court that, were Centre Consortium, the petitioner in C.O.(COMM.IPD-TM) 97/2023, to file an infringement suit against his client, that suit would lie before this Court. The present petition would not, however, according to him, for the reasons which would presently be noted.

### **Rival Contentions and Analysis**

12. I have heard Mr. Ranjan Narula, learned Counsel for the petitioner in C.O. (COMM.IPD-TM) 8/2023 and Mr. Urfee Roomi, learned Counsel for the petitioner in C.O. (COMM.IPD-TM) 97/2023.



Mr. Chander M. Lall, learned Senior Counsel and Mr. Dushyant Mahant, learned Counsel, who practice in this field of law, have also graciously assisted this Court. I have also heard Mr. Haresh Raichura, learned Counsel for Respondent 1 in C.O. (COMM.IPD-TM) 97/2023 and Mr. Harish Vaidyanathan, learned Counsel for Respondent 2 in both these petitions. Respondent 1 in (COMM.IPD-TM) 8/2023 has remained unrepresented.

**13.** The question that arises for consideration is whether a petition under Section 47<sup>1</sup> or 57<sup>2</sup> of the Trade Marks Act, for removal of a trademark from the Register of Trademarks and consequent rectification of the register would lie only before the High Court having territorial jurisdiction over the office of the Trademark Registry where the impugned mark was registered, or could be filed in another High Court; specifically in the present case, this Court.

**14.** The same issue arises in the context of Section 124<sup>3</sup>, albeit in a slightly different conspectus. The decision on whether to permit the plaintiff, in the pending suit, to file a rectification petition, or not, would obviously be taken by the Court where the suit is pending. Before doing so, Section 124(1)(ii) requires the Court, in seisin of the suit, to satisfy itself that the challenge to the validity of the mark is tenable. Once it is so satisfied, it adjourns the suit to enable the challenger to challenge the mark by way of a rectification petition. That has already happened in C.O.(COMM.IPD-TM) 8/2023. The petitioner Dr Reddy's Laboratories has, pursuant thereto, filed the present petition here. The question is – should it, instead, have been filed in the High Court of Calcutta?



**15.** Section 47 of the Trade Marks Act empowers the High Court to, on an application by an aggrieved person, take a registered mark off the Register of Trade Marks on the ground of non-use. Section 57 empowers the Registrar or the High Court to cancel or vary the registration of a trade mark on the ground of contravention or failure to observe a condition entered on the register in relation to the registered mark, or where the entry was made in the register without sufficient cause, or where the entry is wrongly remaining on the register or suffers from any error or defect. In all such cases, the cancellation or variation of the registration of the impugned mark would be on application by a person aggrieved. Section 57(4) empowers the Registrar or the High Court to pass orders varying or cancelling the registration of a registered mark on its own motion as well, after notice to the affected parties.

**16.** Section 124(1) deals with two exigencies, *vide* clauses (a) and (b) thereof. Both clauses apply where there is a pre-existing suit alleging infringement of trademark. Section 124(1)(a) applies where the defendant, in defence to the suit, pleads that the registration of the plaintiff's trademark, asserted in the suit, is invalid. Section 124(1)(b) applies where, in defence to the suit, the defendant pleads registration of its mark as a defence [under Section 30(2)(e)<sup>4</sup>] and the plaintiff alleges invalidity of the defendant's trademark. As such, Clause (a) applies where the defendant alleges invalidity of the plaintiff's

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<sup>4</sup> (2) A registered trade mark is not infringed where –  
(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.



trademark and Clause (b) applies where the plaintiff alleges invalidity of the defendant's trademark.

**17.** The sequitur, in either of these cases, is provided in Clauses (i) and (ii) of the second part of Section 124(1). Section 124(1)(i) refers to a situation where rectification proceedings were pending prior to the institution of the suit. In that case, the Court is required under Section 124(1)(i) to stay the suit, pending final disposal of the rectification proceedings. Section 124(1)(i) is not applicable to either of the petitions with which we are concerned. Section 124(1)(ii) applies where there is no rectification proceeding pending on the date when the suit is instituted, but the plaintiff, or the defendant, as already noted, raises a plea of invalidity of the trademark of the opposite party. In either of these cases, Section 124(1)(ii) requires the Court, in the first instance, to satisfy itself that the plea of invalidity, whether raised by the plaintiff or the defendant, is tenable. If the Court finds that the plea is tenable, the Court is required to raise an issue regarding the plea of invalidity and to adjourn the matter by three months *“in order to enable the party concerned to apply to the High Court for rectification of the register”*.

**18.** But which High Court? That is the question.

**19.** The expression “High Court” is not defined in the Trade Marks Act. Section 3(25) of the General Clauses Act, 1897, however, defines “High Court” to mean “the highest Civil Court of appeal (not including the Supreme Court) in the part of India in which the Act or Regulation containing the expression operates”.





**20.** Mr. Raichura, learned Counsel for Respondent 1 in C.O. (COMM.IPD-TM) 97/2023 and Mr. Vaidyanathan, learned Standing Counsel appearing for Respondent 2 in both these petitions, contend that these petitions would have to be filed before the High Court having jurisdiction over the office of the Trade Marks Registry which registered the impugned marks.

**21.** Mr. Raichura raises, principally, the following grounds to support his stand:

(i) Among the grounds on which the registration of a registered mark could be expunged or varied under Section 57(2) is the existence of any error or defect in the concerned entry. The reference to “error or defect”, submits Mr. Raichura, analogises the exercise to one of review. Review, he submits, has to be before the authority which has taken the initial decision. As such, the application for rectification would lie either before the office of the Trademark Registry which granted registration to the impugned trademark or before the High Court having territorial jurisdiction over such office.

(ii) Mr. Raichura also relies on the power conferred, by Section 57(4) on the Registrar or the High Court to, of its own motion, vary or expunge an entry relating to registration of a trademark. He submits that the words “of its own motion” clearly indicates that a High Court which does not have territorial jurisdiction over the office of the Registry which



granted registration to the mark cannot exercise jurisdiction under Section 57(4). Ergo, he submits, it cannot exercise jurisdiction under Section 57(1) or 57(2) either.

(iii) Mr. Raichura has also cited Section 58(1)(c)<sup>5</sup> of the Trade Marks Act, which empowers the Registrar to cancel the entry of a trademark in the register of Trademarks on an application made by the registered proprietor of the trademark. This again, he submits, is a power which can be exercised only by the Registrar in the office of the Trademarks Registry which granted registration to the mark in the first place.

(iv) Reliance on Section 124 of the Trade Marks Act, according to Mr. Raichura, would be misguided, as there is a fundamental difference between an infringement suit and a rectification application.

(v) The attention of Mr. Raichura was invited to a judgment of a Full Bench of this Court in *Girdhari Lal Gupta v. K. Gian Chand & Co.*<sup>6</sup>, which examined a similar issue in the context of the Designs Act, 1911 (the predecessor of the present Designs Act, 2000). The Full Bench of this Court was, in that case, concerned with the issue of the appropriate court before which

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<sup>5</sup> 58. **Correction of register.** –

(1) The Registrar may, on application made in the prescribed manner by the registered proprietor, -

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(c) cancel the entry of a trade mark on the register; and may make any consequential amendment or alteration in the certificate of registration, and for that purpose, may require the certificate of registration to be produced to him.

<sup>6</sup> AIR 1978 Del 146



an application for cancellation of a registered design could be made under Section 51(a) of the Designs Act, 1911. The Full Bench took the view that the application could be made either before the High Court having jurisdiction over the office of the Controller of Designs which granted registration to the design or any High Court within whose jurisdiction the “dynamic effect” of the registration could be felt. Mr. Raichura expressed his reservations regarding the correctness of this enunciation of the law. Needless to say, being a decision of a Full Bench of this Court, it is not possible for me to subscribe to any such submission.

**22.** Mr. Harish Vaidyanathan Shankar, learned Standing Counsel endorsed the stand of Mr. Raichura, albeit for the following reasons:

(i) Mr. Vaidyanathan invited my attention to certain provisions of the Ayyangar Committee Report<sup>7</sup>, which examined the provision of the erstwhile Trade Marks Act, 1940 and made certain recommendations, on the basis of which the Trade and Merchandise Marks Act, 1958 (“the TMMA 1958”) came to be enacted. Specifically, Mr. Vaidyanathan stressed the following paragraphs from the Ayyangar Committee Report:

“41. The first matter relates to applications for rectification under sections 37, 38, and 46 of the Act. The Trade Marks Act 1940, in line with the U.K. Act of 1938 vests in an applicant the option of applying either to the Registrar or

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<sup>7</sup> The Ayyangar Committee was a committee chaired by Hon’ble Mr Justice N. Rajagopala Ayyangar, a former Judge of the Supreme Court, which examined the provisions of the Trade Marks Act, 1940 and made various suggestions, on the basis of which the Trade & Merchandise Marks Act, 1958 – the precursor to the present Trade Marks Act – came to be enacted.



the High Court for the rectification of the register. While there is no difficulty in locating the first mentioned forum, the identity of the High Court to which resort must be had in order to file the application for rectification is not indicated with any certainty. Though the definition of a High Court in section 2(d) of the Act appears comprehensive enough to include every High Court in the country, it cannot be that without any territorial connection between the locus of the Register which is sought to be rectified and a particular High Court, that High Court could obtain jurisdiction to pass an order for rectification. Different views have been held as to what nexus is necessary to attract the jurisdiction of a High Court to any particular case. But without going into the correctness of the several views entertained by different Judges, it appears to me to be expedient to specify with certainty the High Court which will have jurisdiction in any particular case.

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51.(a) In regard to marks which have been registered on applications filed after the coming into force of the amending Act, the locality of the applicant, in the sense of his residence or place of business will determine the office in which he should file the application for registration and this should finally determine the locus of the office of the registry for the purpose of subsequent applications for rectification. In view of this, every application for rectification of such a mark would, if before the Registrar, be filed in the office where it is registered or deemed to be registered in accordance with the above provisions. If, instead of before the Registrar, the application is made before the High Court in the first instance, the competent Court will be that High Court within whose territorial jurisdiction that particular Branch of the Registry where the application for registration has been made is situated. It is unnecessary to add that on the above provisions there will be no difficulty in ascertaining the High Court having jurisdiction to deal with appeals from the Registrar's orders in such rectification proceedings.

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62. The question that next follows is how the exclusive jurisdiction vested in the particular High Courts to rectify the register should be correlated with proceedings in an infringement action which might be instituted before any District Court. I have considered the matter deeply and the



best solution I am able to offer is, that in cases where a defendant in an infringement action raises a defence as regards the invalidity of the registration of the plaintiff's mark, such defence will not be gone into by the District Court or other Court trying the action. The defendant will be required within a reasonable time granted to him (in the draft I have suggested three months as reasonable) to take out appropriate proceedings for rectification before the Competent Court for that purpose. If he does this, the trial of the infringement action will be stayed. The Court trying the infringement action will however retain jurisdiction to pass, notwithstanding the stay, interim orders necessary to protect the rights of parties pending the decision of the suit. When the rectification proceeding is completed and reaches a stage of finality, the result of those proceedings should be declared binding on the Court trying the infringement action. If, in the rectification proceedings; the registered trade mark is ordered to be taken off the register, the issue as to validity of registration will be decided against the plaintiff in the action; and the rest of the action, if anything remains, will be proceeded with. If on the other hand, the rectification proceeding fails and the mark is retained on the register, the other defences, if any, will be investigated and the action will proceed to trial on those other matters. Of course from the decision of the District Court, even without special provision in that regard in this Act, an appeal would lie to the higher courts right up to the Supreme Court in appropriate cases.”

(ii) Mr. Vaidyanathan also placed especial reliance on para 4 of the Statement of Objects and Reasons (“SOR”, hereinafter) preceding the Tribunals Reforms (Rationalization and Conditions of Service) Bill, 2021 (“the Tribunal Reforms Bill”), which reads as under:

“4. The tribunals that are proposed to be abolished in this phase are of the kind which handle cases in which public at large is not a litigant or those which neither take away any significant workload from High Courts *which otherwise would have adjudicated such cases* nor provide speedy disposal. Many cases do not achieve finality at the level of tribunals and are litigated further till High Courts and Supreme Court, especially those with significant implications. Therefore, these tribunals only add to another additional layer of litigation. Having separate tribunal



requires administrative action in terms of filling up of posts and such other matters, and any delay in such action further delays disposal of cases. Reducing the number of tribunals shall not only be beneficial for the public at large, reduce the burden on public exchequer, but also address the issue of shortage of supporting staff of tribunals and infrastructure.”

Mr. Vaidyanathan seeks to contend that the italicized words “which otherwise would have adjudicated such cases”, in para 4 of the SOR of the Tribunals Reforms Bill indicate that the High Court which replaced the Tribunals – in this case, the Intellectual Property Appellate Board (IPAB) – would be the High Court having jurisdiction over the bench of the IPAB which was abolished.

(iii) Next, Mr. Vaidyanathan cited Rule 4<sup>8</sup> of the Trade Marks

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<sup>8</sup> 4. **Appropriate office of the Trade Marks Registry.** – The appropriate office of the Trade Marks Registry for the purposes of making an application for registration of a trade mark under Section 18 or for giving notice of opposition under Section 21 or for making an application for removal of a trade mark under Section 47 or cancelling or varying the registration of a trade mark under Section 57 or for any other proceedings under the Act and the rules shall be –

A. in relation to a trade mark on the Register of Trade Marks at the notified date, the office of the Trade Marks Registry within whose territorial limits –

(i) the principal place of business in India of the registered proprietor of the trade mark as entered in the register at such date is situate;

(ii) where there is no entry in the register as to the principal place of business in India of the registered proprietor, the place mentioned in the address for service in India as entered in the register at such date is situate;

(iii) in the case of jointly registered proprietors, the principal place of business in India of the proprietor whose name is entered first in the register as having such place of business in India at such date is situate;

(iv) where none of the jointly registered proprietors is shown in the register as having a principal place of business in India, the place mentioned in the address for service in India of the joint proprietors as entered in the register at such date, is situate;

(v) if no principal place of business in India of the registered proprietor of the trade mark or in the case of joint registration, of any of the joint proprietors of the trade mark, is entered in the register, and the register does not contain any address for service in India, the place of the office of the Trade Marks Registry where the application for registration of the trade mark was made, is situate; and

B. in relation to a trade mark for which an application for registration is pending at the notified date or is made on or after the notified date, the office of the Trade Marks Registry within whose territorial limits –

(i) the principal place of business in India of the applicant as disclosed in the application or, in the case of joint applicants, the principal place of business in India of the applicant whose name is first mentioned in the application, as having such place of business is situate;



Rules, 2017 to contend that the Rule, which was intended to effectuate operation of Section 47<sup>1</sup> and 57<sup>2</sup> of the Trade Marks Act, specifically identified the situs of the Trade Mark Registry where an application for removal of a trade mark under Section 47<sup>1</sup>, or for cancellation of a trade mark under Section 57<sup>2</sup> could be made, as the office where the mark was registered in the first place. This principle, he submits would have to apply, *mutatis mutandis*, to the situs of the High Court which could be approached under Section 47<sup>1</sup> or 57<sup>2</sup>, as the Trade Marks Registry and High Court exercised co-equal and concurrent jurisdiction under both provisions.

(iv) I, thereupon, queried of Mr. Vaidyanathan as to why, if the Rule making authority had identified the office of the Registrar of Trade Marks which could exercise jurisdiction under Section 47<sup>1</sup> or 57<sup>2</sup>, no similar Rule, identifying the High Court which could exercise concurrent jurisdiction, was not framed. Mr. Vaidyanathan's response is that, in the case of the High Court which could exercise jurisdiction under Section 47<sup>1</sup> or 57<sup>2</sup>, the use of the definite article "the" before "High Court", in both provisions, amply clarified that the High Court would be that which had jurisdiction over the office of the Registrar.

## Analysis

**23.** Having heard learned Counsel and applied myself to the issue at

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(ii) where neither the applicant nor any of the joint applicants, as the case may be, has a principal place of business in India, the place mentioned in the address for service in India as specified in the application is situate.



hand, I am of the concerned opinion that this Court is competent to entertain the present applications/petitions.

**24.** At the outset, it must be noted that there is only *one* provision, in the Trade Marks Act, which provides for rectification of the Register of Trade Marks, by removing, therefrom, a registered mark, which is Section 57. The application for rectification of the register of Trade Marks, to which Section 124(ii) alludes, would also, therefore, have to be filed under Section 57 alone, and under no other provision. The only difference is that a rectification petition/application, if filed under Section 124(1)(ii), has to necessarily be filed in the High Court, whereas a rectification petition under Section 57 can be filed either before the Registrar or in the High Court. The High Court which would have to be approached directly under Section 57, therefore, is the same High Court which would have to be approached through the more circuitous route of Section 124(1)(ii).

**25.** *Expressio unius, the law tells us, est exclusio alterius*<sup>9</sup>. Had the Trade Marks Act expressly identified a particular High Court as the High Court to be approached under Section 47 or 57 (and, therefore, under Section 124(1)(ii) as well), the jurisdiction of all other High Courts would stand excluded. But the Trade Marks Act has *not* done so. Ergo, it has *not* expressly excluded any High Court from being competent to exercise jurisdiction either under Section 47 or 57. There is, therefore, no *express statutory proscription* against any High Court exercising jurisdiction either under Section 47 or 57.

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<sup>9</sup> “The expression of one thing is the exclusion of the other.” Refer **A.B.C. Laminart (P) Ltd v. A.P. Agencies, (1989) 2 SCC 163**





26. Can it, then, be said that, *by implication*, the petition under Section 47, or Section 57, would have to be filed before a particular High Court? If it can, the *expressio unius* principle would apply, and all other High Courts would be excluded from exercising such jurisdiction. The same legal position is more generally expressed in the trite principle, of *Taylor v. Taylor*<sup>10</sup> vintage and continuing through *Nazir Ahmed v. King Emperor*<sup>11</sup> and thereafter through a host of judgments of the Supreme Court, most notably *Singhara Singh v State of U.P.*<sup>12</sup>, that, if the law requires a thing to be done in a particular manner, it has to be done in that manner alone, or not done at all.

27. Mr. Raichura and Mr. Vaidyanathan would contend that the answer to this query has to be in the affirmative. It is only the High Court within whose jurisdiction the Trade Mark Office, which granted registration to the impugned trade mark is situate, which, according to them, would have to be approached, whether under Section 47 or Section 57/Section 124.

28. I am unable to agree, for a variety of reasons.

29. Effect of Section 28(1): Section 28(1)<sup>13</sup> of the Trade Marks Act confers, on the proprietor of a registered trade mark, a right to sue for

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<sup>10</sup> (1875) 1 Ch D 426

<sup>11</sup> AIR 1936 PC 253

<sup>12</sup> AIR 1964 SC 358

<sup>13</sup> 28. **Rights conferred by registration.** –

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.



infringement of the said trade mark, only if the registration is valid.<sup>14</sup> Validity of the registration is, therefore, an essential prerequisite for an infringement suit to be maintained. Validity of the registration of the asserted mark and infringement of the asserted mark are, therefore, inextricably intertwined. It is intrinsic to the ethos of the Trade Marks Act and to its very structure, therefore, that the question of validity and the question of infringement should be decided by one Court.

### 30. “Person aggrieved” – the judgment in *Girdhari Lal Gupta*<sup>6</sup>

**30.1** The petition for removal under Section 47, or the petition for rectification/cancellation under Section 57, has statutorily to be by a “person aggrieved”. In the context of Section 46 of the TMMA 1958, which is *in pari materia* with Section 47 of the Trade Marks Act, 1999, the Supreme Court, in *Kabushiki Kaisha Toshiba v. Toshiba Appliances Company*<sup>15</sup> adopted, with approval, the following definition of a “person aggrieved” as expostulated in *Trade Mark No. 70,078 of Wright, Crossley & Co.*<sup>16</sup>:

“I think, notwithstanding what was said in that case, and has been said in other cases dealing with trademarks, that an applicant in order to show that he is a person aggrieved, must show that *in some possible way he may be damaged or injured if the trade mark is allowed to stand*; and by ‘possible’ I mean possible in a practical sense, and not merely in a fantastic view.”

(Emphasis supplied)

Possible damage or injury to him, if the mark of the respondent is allowed to stand, if shown by the petitioner, would suffice to render him a “person aggrieved” for the purposes of Section 47 or Section 57. In both the matters before me, Respondent 1 is using a mark

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<sup>14</sup> Refer *K. Narayanan v. S. Murali*, (2008) 10 SCC 479

<sup>15</sup> (2008) 10 SCC 766

<sup>16</sup> (1898) 15 RPC 131 (Ch D)



which, according to the petitioner, is allegedly deceptively similar to the petitioner's mark. The "use", by Respondent 1 in each case takes place, or can take place, within the jurisdiction of this Court. Additionally, in CO (COMM) 97/2023, the petitioner's attempt to register its USDC mark stands stymied by the existing mark of Respondent 1 which, according to the petitioner, is liable to be removed from the Register for non-use. In either case, therefore, the petitioner is a "person aggrieved" within the meaning of Section 47 (in the case of the petitioner in CO (COMM. IPD TM) 97/2023) and Section 57 (in the case of the petitioner in CO (COMM. IPD TM) 8/2023).

**30.2** Once it is determined that the petitioner, in either case, is a "person aggrieved", the decision of the Full Bench of this Court in *Girdhari Lal Gupta*<sup>6</sup>, though rendered in the context of the Designs Act, 1911, would indicate that the cancellation/rectification petition could be filed *either* before the High Court having jurisdiction over the office of the Trade Marks Registry which granted registration to the impugned mark, and where, therefore, *the static effect* of the registration is felt, *or* before this Court, where the petitioner in each case is affected by the use of the impugned mark by Respondent 1 and where, therefore, *the dynamic effect* of the registration is felt.

**30.3** *Girdhari Lal Gupta*<sup>6</sup> dealt with the issue of the competence of the High Court before which an application for cancellation of a registered design could be made under Section 51-A<sup>17</sup> of the Patents

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<sup>17</sup> 51-A. Cancellation of registration. –



& Designs Act, 1911 (“the P & D Act”, hereinafter). K. Gian Chand Jain and Co. (“KG CJ”, hereinafter) filed applications under Section 51-A of the Designs Act before this Court, for cancellation of the registered design of Girdhari Lal Gupta (“GLG”, hereinafter). The design had been registered by the Registrar of Designs, Calcutta. GLG contended that the cancellation applications were not maintainable before this Court and had necessarily to be preferred before the High Court of Calcutta. “High Court” was, at that time, defined in Section 2(7) of the Designs Act 1911, to mean (a) in relation to a State, the High Court for that State and (b) in relation to Union Territories, the High Court which had been given jurisdiction over the Union Territories. As such the definition of “High Court”, though it existed, was of no real assistance in identifying the appropriate High Court(s) before which the cancellation petition could be filed.

**30.4** *The Full Bench, notes at the outset, in para 7, that the reason for the legislature for not confining, in the P & D Act, the jurisdiction to cancel the registration of a design only to the High Court having jurisdiction over the office of the Controller of Designs which granted registration, could only be that the legislature did not intend to confine jurisdiction to one High Court alone. At the same time, the Full Bench held that Section 51-A of the Designs Act could not be so*

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(1) Any person interested may present a petition for the cancellation of the registration of a design –

(a) at any time after the registration of the design, to the High Court on any of the following grounds, namely:—

(i) that the design has been previously registered in India; or  
(ii) that it has been published in India prior to the date of registration; or  
(iii) that the design is not a new or original design; or

(b) within one year from the date of the registration, to the Controller on either of the grounds specified in sub-clauses (i) and (ii) of clause (a).



interpreted as to permit the petitioner to file the cancellation petition before any High Court of his choice.

**30.5** The real question to be addressed, according to the Full Bench, was the identification of the situs of the High Court which had a real connection with the subject matter over which the jurisdiction was to be exercised. At the same time, it was held that the subject matter could not be treated as merely the registration and continuance of the registration of the design. That was only the “static effect” of the registration. Inasmuch as the registration of a design gave the registered proprietor the right to enjoy monopoly over the design over all territories of India to which the P & D Act applied, the impact of the registration, constituting its “dynamic effect”, travelled beyond the place of registration.

**30.6** The Full Court went on to hold, therefore, that the cancellation petition could be filed either before the Court having jurisdiction over the Controller who registered the design, or over any petitioner who suffered the dynamic effect of the registration of the design. Paras 14, 12 to 15, 16, 18, 19, 21 and 22 of the judgment of the Full Bench, to the extent they are relevant, may be extracted thus:

“12. The strength of this argument<sup>18</sup> depends on the correctness of its assumption that the subject matter consists only of the registration and the continuance of the registration of a design. *This takes into account only the static effect of the registration. But the registration gives the registered proprietor of the design a monopoly of the copyright in the design and this extends to all the territories of India to which the Act applies. The impact of the registration, therefore, travels beyond the place of registration. This is the dynamic aspect of the effect of registration.*

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<sup>18</sup> viz., that the cancellation petition would lie only before the High Court having jurisdiction over the office of the Registry which had granted registration to the design.



13. *An analysis of section 51-A yields two distinct elements. The first element is the registration of the design and the effects of the registration — static and dynamic. The second is the capacity to make the application being vested only in a person interested. It is only when both these elements co-exist that an application under section 51-A can be made for the cancellation of the registration on all or any of the grounds specified therein. Let us now further consider each of these two elements of section 51-A.*

#### Effects of Registration

14. *If the cause of action for an application for cancellation is only the static effect of the registration then it is confined to the place where the registration is made and is continued. Since the Register is kept presently at Calcutta, the High Court of Calcutta would have jurisdiction over the place at which the cause of action arises due to the static effect of the registration. What about the dynamic effects of the registration which prevents any person other than the registered proprietor of the design from using the said design in any of the territories to which the Act applies? This prevention may be of two kinds. Firstly, a person may intend to use the registered design but is prevented from carrying out his intention into practice because he would be thereby, infringing the copyright created by the registered design and would, therefore, be contravening the law. The cause of action in favour of such a person consists only of the existence of the registration. Since such a cause of action arises only at the place of the registration, it is only that High Court which has jurisdiction over the place of registration which can entertain an application under section 51-A for the cancellation of the design from such a person.*

*Secondly, there may be persons who are actually using the said registered design and the use of such design may be interfered with or stopped by the dynamic effect of the registration which prevents such traders all over the country wherever the Act applies from using the design. The legal injury to such traders is caused at the place at which their trade is carried on. This is to be contrasted with the legal injury complained by a person who merely intends in future to use the design. The injury to the latter person is not caused where the person resides. It is caused at the place where the registration exists.*

#### Person Interested

15. *Just as there are two kinds of legal Injury that may be caused by the static and dynamic effects of registration, former confined to the place of registration and the latter extending*



beyond it, similarly, a person interested may fall into either of two categories. Firstly, a person interested may be aggrieved by a legal injury to his own interest in property, business, reputation, etc. He is thus a person aggrieved and as such has locus standi to make the application. The place where the injury occurs is the place where his interest has been adversely affected. The cause of action, therefore, arises at the place where the legal injury to his existing private interest has occurred. As already stated above, if a person merely intends in future to use such a design then no present interest of such a person is injured and, therefore, the only injury of which he can complain is that his future activity is prevented by the existence of the registration. That cause of action will relate to the place of the registration. The expression “person interested” is quite common in legislative drafting. For instance, it is used in section 18 (1) of the Land Acquisition Act, 1894. Its purpose is to confine the competence to make an application to a person who has his own interest to be served by such application. It intends to exclude a mere busybody from making such an application, though none of his interests has been affected. In other words, a person interested is a person aggrieved by the existing situation or by the cause of action.

16. Of late, however, the concept of locus standi which gives competence to a person to make an application or file a suit or a petition has been broadened. It includes not only a legal injury to some private interest of the petitioner, but also a legal injury to some public interest in the redress of which the petitioner has some interest over and above the interest of a mere member of the public. For instance, a neighbour was held to have locus standi to file a writ petition that the resolution of the Municipal Corporation to make a children's park in front of the petitioner's house should be given effect to even though no individual interest of the petitioner was injured by the delay on the part of the Municipal Corporation in implementing the said resolution. For, the petitioner lived very near the site of the children's park and was more interested than an ordinary member of the public in seeing to it that the plot belonging to the Municipal Corporation should be developed as a children's park in accordance with the resolution passed by the Corporation (see **Radhey Sham v. Lt. Governor, Delhi**<sup>19</sup>. See also an article on Standing and Justiciability in 1971-13, Journal of the Indian Law Institute, pages 164 to 170). While, on the one hand, the location of a *pro bona publico* interested in vindicating a legal injury to the public interest would not be a part of the cause of action or the subject matter, on the other hand, the injury suffered to his private interest by a person aggrieved may become a part of the cause of action or the subject matter for an

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<sup>19</sup> ILR (1970) Delhi 260





application under s. 51-A. If, for instance, the Institute of Designs at Ahmedabad or some such person or Institution in public interest makes an application under s. 51-A, the location of such a person or institution would be no part of the cause of action or the subject matter. Under section 51-A. On the other hand, the respondents in the appeals before us are traders doing business at Delhi. *They allege that their trading is injured because of the wrongful protection and monopoly given to the designs registered in favour of the appellant. This injury to the interest of the respondents takes place at Delhi. In this case the appellant is also enforcing his right based on registration by suits filed against the respondents at Delhi. The significance of being "person interested" is, therefore, two-fold. Firstly, it gives them the locus standi to make the application under section 51-A. Secondly, it helps to fix the place at which the applications may be made by them the place being Delhi where the injury to their interest occurred. The injury to the private interest of the respondents is thus a part of the cause of action or the subject matter for the applications made under section 51-A.* The rest of the subject matter or the cause of action consists firstly in the registration and continuance of the design, and secondly in the wrongfulness of such registration and continuance because of the existence of the grounds or any of the grounds mentioned in clause (a) of sub-section (1) of section 51-A of the Act, namely, that the design has been previously registered in India or that it has been published in India prior to the date of registration or that the design is not new or original.

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18. The registration of the design and its continuance in the Register of Designs is only a part of the subject matter. *What the respondents complain is not merely of the registration. They rather complain of the impact or the effect of the registration which extends far beyond the place where the Register of Designs is kept. The effect of the registration of the design under the Act is to confer a copyright in the design on the appellant. This copyright prevents the respondents from using the same design so long as the registration subsists in favour of the appellant. The copyright effect of the registration is felt in Delhi and would be felt at any place where it prevents competitors of the appellant from using the registered design for their own purpose. Viewed in this way a part of the subject matter of the application under section 51-A would be seen to be at Delhi where the alleged legal injury and the damage in fact is said to have been suffered by the respondents though the rest of it may be at Calcutta where the entry in the Register of Designs rests. It is not only the static entry in the Register of Designs, but also the dynamic effect of the copyright all over the country, which causes injury to the competitors of the*





*appellant. These injured persons would have the right to make the application to the High Court having jurisdiction over the place in which this injury has occurred.* In *Workmen of Shri Rangavilas Motors (P) Ltd. v. Shri Rangavilas Motors (P) Ltd.*<sup>20</sup>, (supra), the order was passed at the Head Office of the company at Krishnagiri. It was that order which was the injury done to the workmen. It was, therefore, argued that the nexus of the subject matter to the appropriate Government was between Krishnagiri which was the State of Tamil Nadu, and the Government of Tamil Nadu at Madras which had the jurisdiction over Krishnagiri. *But, the Supreme Court repelled this argument with the statement that “but the order was to operate on a workman working in. Bangalore”.* *By that observation the Supreme Court held the subject matter to be at Bangalore and not at Krishnagiri.* The nexus, therefore, was with the appropriate Government, viz. the Government of Mysore.

#### Section 51-A compared and contrasted

19. *Section 53 (1) prohibits Piracy of registered design. Section 53 (2) enables the registered proprietor of a design to obtain damages for piracy of his design. The learned counsel for the appellant did not dispute that such a suit for damage would lie at a place at which damage has been caused to the registered proprietor of the concerned design. In our view, section 51-A is the reverse of section 53. While section 53 enables the registered proprietor to obtain damages from a person, who violates the copyright granted to him by the registration of the design, section 51-A enables a person to attack the very correctness of the registration and to get it cancelled. While the cause of action of the registered proprietor under section 53 is the damage caused to him by the piracy of the design, the cause of action of the plaintiff under section 51-A is the damage caused to him by the enjoyment of the copyright by the registered proprietor based on the registration of the design. If the situs of the damage under section 53 can be the place where the damage is actually caused, there is no reason why the situs of the damage under section 51-A should not be a relevant consideration to determine jurisdiction under section 51-A. If a suit is maintainable because of the nexus in a court having jurisdiction over such a place under section 53, on the same reasoning of the nexus it may be argued that an application should be maintainable in the High Court having Jurisdiction over such a place under section 51-A.*

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<sup>20</sup> (1967) 2 SCR 528



21. *It is in this context that the use of the definite article “the” to qualify the court or the High Court in these provisions assumes significance. It is not a High Court or any High Court, but only the High Court which would have jurisdiction meaning that it is the nexus of the subject matter or the cause of action with the territory of a High Court which fixes jurisdiction and vests it in that particular High Court.*

22. *For the above reasons, we find that the petition for cancellation of the design under section 51-A would lie to that High Court with the territory of which subject matter has the necessary nexus. The subject matter consists of a series of connected events beginning with the registration of the design in the register of designs by the order of the Controller and ending with the impact of the said design on the rights of the competitors on such places at which the trading of the competitors is injured or affected by the enjoyment of the copyright by the registered proprietor of the design basing his right on the registration of the design. An application may, therefore, be filed either in the High Court having jurisdiction over the place at which the design is registered or in the High Court having jurisdiction over the place at which the enjoyment of the copyright by the registered proprietor causes injury to the commercial interests of the applicant. Briefly, the application would be made in the High Court, the local jurisdiction of which has a nexus with the subject matter or the cause of action of the application. It follows, therefore, that the application cannot be made in any other High Court merely because the applicant chooses to do so. The applicant would have to show jurisdiction in the High Court to which the application is made and such jurisdiction can be shown only by establishing connection between the cause of action and/or subject matter of the application and the territory within the local jurisdiction of the High Court. While such an application can always be made to the High Court within the local limits of which the registration of the design is made, the jurisdiction is not confined to that High Court, but would extend to any other High Court within the local limits of which a part of the cause of action and/or subject matter of the application may arise. This view differs from the view of the learned, single Judge and the other decisions of this court relied in the order under appeal. We also differ from the view expressed by K.T. Desai J. of the High Court of Bombay in the **Kohinoor Mills Co.'s case**<sup>21</sup>.”*

(Italics and underscoring supplied)

**30.7** The “dynamic effect” principle has, I may note, been according

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<sup>21</sup> **Kohinoor Mills Co. Ltd v. Vijay Bharat Thread Mills (India), (1958) 60 Bom LR 397**



Apex imprimatur on more occasions than one. *Kusum Ingots & Alloys Ltd v. U.O.I.*<sup>22</sup> – which is considered a watershed decision in territorial jurisdiction jurisprudence in the context of writ petitions – examined the issue of whether a writ petition, challenging a legislative enactment which had been applied by a judicial or executive authority to the prejudice of the petitioner, could be filed at Delhi, even though the petitioner was not located within the jurisdiction of this Court and had felt no effect of the legislation within such jurisdiction, merely because the situs of the Union legislature, which enacted the legislation, was in Delhi. Answering the issue in the negative, the Supreme Court held that a writ petition would lie, not before the High Court having jurisdiction over the legislature which enacted the legislation, but over the location of the litigant who *felt* the effect of the legislation by the passing of the judicial or executive order *based on* the impugned legislation – which is what *Girdhari Lal Gupta*<sup>6</sup> terms “the dynamic effect”. The intrinsic relationship between the situs of a litigation, or an executive action under challenge, and its dynamic effect as felt by the litigant is, therefore, fossilized in the law.

**30.8** The “dynamic effect” principle thus enunciated by the Full Bench nearly half a century ago has now expanded to the point where an infringement suit can be instituted, in the case of a defendant which sells its goods, or provides its services online, before any Court which has jurisdiction over any place from where the goods could be purchased or the services accessed. Gone are the days when there had to be a physical use of the impugned mark within the territorial

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<sup>22</sup> (2004) 6 SCC 254



jurisdiction of the Court which the petitioner sought to petition. With the expansion of the internet, and the access, by persons anywhere in the country, to goods and services though they may originate from some distant site, a litigant is free to file an infringement, or passing off, suit, before any Court within whose jurisdiction “use” of the impugned mark takes place, even if merely by making the goods bearing the mark *available* for sale and purchase online, with or without proof of actual sale or purchase.<sup>23</sup> The “dynamic effect” of the registration is, therefore, felt within *every such jurisdiction*.

**30.9** Applying the principle enunciated in *Girdhari Lal Gupta*<sup>6</sup>, therefore, a rectification petition could be instituted before any Court within whose jurisdiction the dynamic effect of the registration of the defendant’s trademark is felt. That would, however, be conditional on the petitioner establishing that it is in fact suffering the dynamic effect of the registration within such jurisdiction, either by actually accessing the impugned mark within such jurisdiction, or intending to do so, or, as in the case of CO (COMM. IPD TM) 97/2023, the impugned registration acting as an obstruction to the petitioner securing registration of its own mark. In each of these cases, the dynamic effect of the registration of the impugned mark would be felt by the petitioner and, therefore, the petitioner could institute the cancellation petition within the jurisdiction of the High Court within which he feels such effect.

**30.10** When three eminent and learned Judges of this Court have thus

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<sup>23</sup> Refer *Tata Sons Pvt Ltd v. Hakunamatata Tata Founders* [2022 SCC OnLine Del 2968], *World Wrestling Entertainment v. Reshma Collection* [(2014) 16 PTC 452(Del -DB)],



spoken, I see no justification for this Court attempting to re-invent the wheel. I may note that the decision in *Girdhari Lal Gupta*<sup>6</sup> was per a majority of two learned Judges to one, with V.S. Deshpande, J. (as he then was) speaking for himself and S.S. Chadha, J., and H.L. Anand, J. penning a minority opinion. The minority opinion was, however, at one with the majority on the position that the cancellation petition could be filed either before the High Court having jurisdiction over the office of the Registry which granted registration to the impugned design, or before the High Court where the person seeking cancellation of the registration was situate. H.L. Anand, J. did not, however, subscribe to the note of caution, expressed in the majority verdict, that Section 51-A, or the definition of “High Court” in the Designs Act, could not be interpreted so widely as to enable a litigant to file a petition seeking cancellation of a registered design anywhere in the country. Anand, J., was, rather, of the view that, if the legislature so provided, it was not for the Court to restrict the scope and sweep of the provision. Ergo, in the opinion of Anand, J., the cancellation petition would lie before *every High Court* in the country.

**30.11** To reiterate the note of caution sounded in para 9 of *Girdhari Lal Gupta*<sup>6</sup>, however, that cannot justify a litigant petitioning a Court, for cancellation or removal of the respondent’s mark, before which he is neither feeling, nor is likely to feel any effect. That a provision of law cannot arm a litigant with a means of harassing his opponent is also trite; apart from *Girdhari Lal Gupta*<sup>6</sup>, one may refer, in this context, to *Ultra Home Construction Pvt Ltd v. Purushottam Kumar*



*Chaubey*<sup>24</sup>.

**30.12** Though Mr. Lall had his reservations with this proposition, and sought to contend that, if the law permitted recourse by a litigant to a multitude of fora, it was perfectly open to him to choose that forum which was most inconvenient to his opponent, and that the law could not proscribe such recourse, I do not agree. Litigation may be adversarial, but cannot be oppressive. It cannot be made a means of harassment. The aim of litigation is not to secure a victory come what may, but to secure the ends of justice. Justice is our sanctified preambular law; not even law, and law which does not aspire to justice is not worth its name. Use of the law in an unjust fashion, even if the strict letter of the law permits it, is not use, but misuse and, perhaps, in a given case, even abuse. Mr. Lall's contention that the petitioner can assail the respondent's registration even before a High Court within whose jurisdiction he is not feeling the dynamic impact of the respondent's registration is, to my mind, completely unacceptable.

**30.13** Mr. Lall, in fact, sought to canvass the view expressed by H.L. Anand, J., in his minority opinion, as the correct one, and also advanced certain arguments in that regard. I do not, however, intend to burden this judgment by alluding thereto, as it is obviously not open to me to hold that the minority view of Anand, J., is preferable to the majority view penned by Deshpande, J. Mr. Lall may, therefore, have to reserve his energies – which, needless to say, were as usual both

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<sup>24</sup> 227 (2016) DLT 320 (DB)



considerable and commendable – for another occasion, possibly before another forum. Nonetheless, as the point was taken, I have, in para 30.12 *supra*, stated what I believe to be the correct legal position.

**30.14** In the present case, however, the petitioner, in each of these petitions, *is* experiencing the dynamic effect of the registration of the impugned trade mark in favour of Respondent 1, within the jurisdiction of this Court. The petitions would, therefore, be maintainable before this Court even for that reason.

**30.15** The position of law enunciated in *Girdhari Lal Gupta*<sup>6</sup>, when applied to the Trade Marks Act, would, therefore, in my view, render these petitions maintainable before this Court.

### **31. The Ayyangar Committee Report and its relevance**

**31.1** The submissions of Mr. Vaidyanathan, predicated on the Ayyangar Committee Report, have already been noted. In examining the submissions, the evolution of the statute has to be borne in mind. When the two are juxtaposed, useful pointers to the solution of the issue at hand emerge.

**31.2** The Ayyangar Committee had, as its remit, the particular task of examining the Trade Marks Act, 1940 (“the TMA 1940”, hereinafter), and suggesting changes. Sections 37<sup>25</sup> and 46<sup>26</sup> of the TMA 1940

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<sup>25</sup> 37. **Removal from register and imposition of limitations on ground of non-use. –**

(1) Subject to the provisions of Section 38, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application in the





parallel Sections 47 and 57 of the present Trade Marks Act. “High Court” was, however, defined, in Section 2(d) of the TMA 1940, as meaning

- “(a) in relation to any State, the High Court for that State;
- (b) in relation to the Union territories of Delhi and Himachal Pradesh, the High Court of Punjab;
- (c) in relation to the Union territories of Manipur and Tripura, the High Court of Assam;
- (d) in relation to the Union territory of the Andaman and Nicobar Islands, the High Court at Calcutta; and

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prescribed manner by any person aggrieved to a High Court or to the Registrar, on the ground either

- (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him or, in a case to which the provisions of Section 36 apply, by the company concerned, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to a date one month before the date of the application; or
- (b) that up to a date one month before the date of the application, a continuous period of five years or longer elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being;

Provided that, except where the applicant has been permitted under sub-section (2) of Section 10 to register an identical or nearly resembling trade mark in respect of the goods in question or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark, the tribunal may refuse an application made under clause (a) or clause (b) in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

<sup>26</sup> **46. Power to cancel or vary registration and to rectify the register. –**

- (1) On application in the prescribed manner by any person aggrieved to a High Court or to the Registrar, the tribunal 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.
- (2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to a High Court or to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as it may think fit.
- (3) The tribunal may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.
- (4) A High Court or the Registrar, of its or his own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).
- (5) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.





(e) in relation to the Union territory of Laccadive, Minicoy and Amindivi Islands, the High Court of Kerala.”

Clearly, the definition provides no clues to the situs of the High Court which would have to be approached either under Section 37 (now 47) or 46 (now 57). The definition is merely geographical, not contextual, in nature.

**31.3** Para 41 of the Ayyangar Committee Report observed, significantly, that the definition of “High Court”, in Section 2(d) of the TMA 1940, was “comprehensive enough to include every High Court in the country”. It could not, observed the Report, however, “be that without any *territorial connection between the locus of the Register which is sought to be rectified and a particular High Court*, that High Court could obtain jurisdiction to pass an order for rectification”. Ergo, opined the Report, it was “expedient to specify with certainty the High Court which will have jurisdiction in any particular case”. Para 51(a) of the Report again reinforced the recommendation that the High Court, which was to be approached for rectification, ought to be the High Court having jurisdiction over the office of the Trade Mark Registry where the mark was registered.

**31.4** The Ayyangar Committee Report resulted in the enactment of the TMMA 1958, which specifically defined “High Court” for the purpose of rectification. Sections 46 and 56 of the TMMA 1958 were identical to Sections 37 and 47 of the TMA 1940. “High Court” was, however, defined in Section 2(h) of the TMMA 1958 as “(meaning) the High Court having jurisdiction under Section 3”. Section 3(a) specifically identified “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, and

(b) in relation to a trade mark for which an application for registration is 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”,

as “the High Court having jurisdiction under this Act”. There was, therefore, no ambiguity whatsoever in the 1958 Act, and the High Court, having jurisdiction over the office of the concerned Trade Marks Registry was the High Court which had to be approached for cancellation or rectification. The Ayyangar Committee recommendation, therefore, clearly had the approval of the legislature, while engrafting the 1958 TMMA.

**31.5** Come 1999, however, the TMMA 1958 was repealed and the present Trade Marks Act was enacted. By that time, the IPAB had come into existence, and the words “High Court” of the Trade Marks Act 1999 did not find place in Section 47 or Section 57; instead, jurisdiction, in the matter of cancellation under Section 47 or rectification under Section 57 – or Section 124(1)(ii), for that matter – vested either with the Registrar or with the IPAB. The issue of the



situs of the *High Court* which the applicant seeking cancellation, or removal, of a registered trade mark, from the Trade Marks register, would have to approach, therefore, ceased to be of relevance.

**31.6** Come 2021, however, the issue again assumed importance. The IPAB was abolished by the Tribunals Reforms Act, 2021 and the High Court took its place. The words “the Tribunal”, in Section 47 and Section 57 were, therefore, deleted, and the words “High Court” resuscitated, in their place.

**31.7** Of stellar significance, in this background, is the fact that *the legislature, while again clothing the “High Court” with powers of removal under Section 47, or rectification/cancellation/modification under Section 57 and Section 124(1)(ii), did not re-introduce the definition of “High Court” and “High Court having jurisdiction”, as found place in Section 2(d) and 3 of the 1958 TMMA. The legislature, while enacting the Tribunals Reforms Act, and reviving power with the High Court to adjudicate on removal applications under Section 47 and rectification/cancellation applications under Section 57, did not approve of the proposal of restricting the jurisdiction only with the High Court having jurisdiction over the office of the Trade Marks Registry which granted registration. The Ayyangar Committee report and its recommendations, seen in the backdrop of the Trade Marks Act, 1999 as amended in 2021, would, therefore, indicate that the jurisdiction under Section 47, 57 or 124 (1)(ii) is not vested only with the High Court having jurisdiction over the situs of the Trade Marks registry which granted registration to the impugned mark.*



**31.8** As Mr. Lall correctly contends, the submission of Mr. Vaidyanathan would essentially be seeking to achieve, by judicial fiat, what the legislature has consciously omitted to do. Where the legislature has consciously omitted, from the Trade Marks Act 1999, while amending it in 2021, the definition of “High Court”, and Section 3, as contained in the 1958 TMMA, Mr. Vaidyanathan’s submission would effectively result in this Court incorporating, by judicial fiat, both the said provisions into the Trade Marks Act, 1999, as it presently stands. The Court, needless to say, cannot do what the legislature has chosen to undo, just as it cannot undo what the legislature has done (short, of course, of declaring it *ultra vires*). The definition of “High Court” as contained in the 1958 TMMA, into the Trade Marks Act, 1999. This is obviously completely impermissible.

**32.** Impact of Section 124:

**32.1** Section 124(1) of the Trade Marks Act envisages two situations. Clause (a) envisages a plea by the defendant that the plaintiff’s trade mark is invalid, whereas Clause (b) envisages a challenge, by the plaintiff, to the validity of the defendant’s mark.

**32.2** Section 124(1)(ii) requires *the Court trying the infringement suit, to first satisfy itself that the challenge, whether by the plaintiff or the defendant to the registration of the mark of the other is tenable*. In the event that the challenge is found to be tenable, the Court is required to adjourn the proceedings by three months so as to enable the challenger to move the High Court for rectification.



**32.3** This provision also indicates that the High Court, which has the competence to decide the dispute in the suit, should have also competence to adjudicate on the rectification application. In case the suit is instituted before a District Court lower in the judicial hierarchy to the High Court, the High Court having supervisory/appellate jurisdiction over such District Court should also have the jurisdiction to adjudicate on the rectification petition.

**32.4** This is for two reasons.

**32.5** Firstly, if the rectification petition is competent only before another High Court, the situation that would result is that, in the first instance, the High Court, or District Court, before which the suit has been filed, would first adjudicate on the *tenability* of the challenge. In other words, it is perfectly permissible, of the Court before which the suit has been filed, to refuse to frame an issue regarding validity, or grant time to the challenger to file a rectification petition, *on the ground that the challenge to validity is not tenable*. There is no guidance, in the Trade Marks Act, on the considerations which would determine whether the challenge is, or is not, “tenable”. Apropos Section 87(1)(a)<sup>27</sup> of the TMMA 1958, which also envisages subjective satisfaction, by the magistrate, that a defence on the ground of invalidity of the asserted mark is “tenable”, however, P. Ramanatha Aiyar, in his classic Advanced Law Lexicon, defines “tenable” as

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<sup>27</sup> 87. **Procedure where invalidity of registration is pleaded by the accused. –**

(1) Where the offence charged under Section 78 or Section 79 is in relation to a registered trade mark and the accused pleads that the registration of the trade mark is invalid, the following procedure shall be followed :—

(a) If the magistrate is satisfied that such defence is prima facie tenable, he shall not proceed with the charge but shall adjourn the proceeding for three months from the date on which the plea of the accused is recorded to enable till the accused to file an application before the High Court under this Act, for the rectification of the register on the ground that the registration is invalid.



“capable of being retained, kept or defended”. There is no reason why the said definition should not apply, *mutatis mutandis*, to Section 124(1)(ii) of the Trade Marks Act, 1999.

**32.6** Section 124(1)(ii), therefore, requires the Court, before which the infringement suit is filed, to assess whether the challenge to the validity of the mark, whether of the plaintiff or the defendant, by the other party, is, or is not, tenable; i.e., whether it is, or is not, capable of being defended. In *Patel Field Marshal Agencies v. P.M. Diesels Ltd*<sup>28</sup>, the Supreme Court undertook a searching scrutiny of Section 111 of the TMMA 1958, which is *in pari materia* with Section 124 of the Trade Marks Act, 1999, except that the rectification petition was to be filed before the IPAB, and not before the High Court. The Tribunals Reforms Act, which abolished, among others, the IPAB, however, replaced the words “the Appellate Board”, in Section 124(1) with “the High Court”, thereby rendering Section 124(1) of the Trade Marks Act, 1999 not only *in pari materia* but also *in haec verba* to Section 111 of the TMMA 1958 [the sole difference being that Section 111 of the TMMA 1958 referred, in sub-section (1)(b), to Section 30(2)(b), being the predecessor provision to Section 30(1)(e) of the Trade Marks Act, 1999]. Paras 28 to 32 and 34 of *Patel Field Marshal Agencies*<sup>28</sup> read thus:

“28. In cases where in a suit for infringement of a registered trade mark the validity of the registration of the trade mark is questioned either by the plaintiff or by the defendant, Section 107 of the 1958 Act provides that an application for rectification shall be made to the High Court and not to the Registrar notwithstanding the provisions contained in Section 46 or Section 56 of the 1958 Act. This would seem to suggest that in such cases (where a suit

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<sup>28</sup> (2018) 2 SCC 112



for infringement is pending) the legislative scheme is somewhat different.

29. The above seems to become more clear from what is to be found in Section 111 of the 1958 Act which deals with “*stay of proceedings where the validity of registration of the trade mark is questioned*”. The aforesaid provision of the 1958 Act specifically provides that if a proceeding for rectification of the register in relation to the trade mark of either the plaintiff or the defendant is pending before the Registrar or the High Court, as may be, and a suit for infringement is filed wherein the aforesaid plea is raised either by the defendant or by the plaintiff, the suit shall remain stayed. Section 111 further provides that if no proceedings for rectification are pending on the date of filing of the suit and the issue of validity of the registration of the plaintiff's or the defendant's trade mark is raised/arises subsequently and the same is prima facie found to be tenable, an issue to the aforesaid effect shall be framed by the civil court and the suit will remain stayed for a period of three months from the date of framing of the issue so as to enable the party concerned to apply to the High Court for rectification of the register. Section 111(2) of the 1958 Act provides that in case an application for rectification is filed within the time allowed the trial of the suit shall remain stayed. Sub-section (3) of Section 111 provides that in the event no such application for rectification is filed despite the order passed by the civil court, the plea with regard to validity of the registration of the trade mark in question shall be deemed to have been abandoned and the suit shall proceed in respect of any other issue that may have been raised therein. Sub-section (4) of Section 111 provides that the final order as may be passed in the rectification proceeding shall bind the parties and the civil court will dispose of the suit in conformity with such order insofar as the issue with regard to validity of the registration of the trade mark is concerned.

30. Following well-accepted principles of interpretation of statutes, which would hardly require a reiteration, the heading of Section 111 of the 1958 Act i.e. “*Stay of proceedings where the validity of registration of the trade mark is questioned, etc.*”, cannot be understood to be determinative of the true purport, intent and effect of the provisions contained therein so as to understand the said section to be contemplating only stay of proceedings of the suit where validity of the registration of the trade mark is questioned. Naturally, the whole of the provisions of the section will have to be read and so read the same would clearly show lack of any legislative intent to limit/confine the operation of the section to what its title may convey.





31. Rather, from the résumé of the provisions of the 1958 Act made above, it becomes clear that all questions with regard to the validity of a trade mark is required to be decided by the Registrar or the High Court under the 1958 Act or by the Registrar or the IPAB under the 1999 Act and not by the civil court. The civil court, in fact, is not empowered by the Act to decide the said question. Furthermore, the Act mandates that the decisions rendered by the prescribed statutory authority [Registrar/High Court (now IPAB)] will bind the civil court. At the same time, the Act (both old and new) goes on to provide a different procedure to govern the exercise of the same jurisdiction in two different situations. *In a case where the issue of invalidity is raised or arises independent of a suit, the prescribed statutory authority will be the sole authority to deal with the matter. However, in a situation where a suit is pending (whether instituted before or after the filing of a rectification application) the exercise of jurisdiction by the prescribed statutory authority is contingent on a finding of the civil court as regards the prima facie tenability of the plea of invalidity.*

32. Conversely, *in a situation where the civil court does not find a triable issue on the plea of invalidity* the remedy of an aggrieved party would not be to move under Sections 46/56 of the 1958 Act but to challenge the order of the civil court in appeal. This would be necessary to avoid multiple proceedings on the same issue and resultant conflict of decisions.

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34. The intention of the legislature is clear. All issues relating to and connected with the validity of registration has to be dealt with by the Tribunal and not by the civil court. In cases where the parties have not approached the civil court, Sections 46 and 56 provide an independent statutory right to an aggrieved party to seek rectification of a trade mark. However, in the event the civil court is approached, inter alia, raising the issue of invalidity of the trade mark such plea will be decided not by the civil court but by the Tribunal under the 1958 Act. The Tribunal will however come into seisin of the matter *only if the civil court is satisfied that an issue with regard to invalidity ought to be framed in the suit.* Once an issue to the said effect is framed, the matter will have to go to the Tribunal and the decision of the Tribunal will thereafter bind the civil court. If despite the order of the civil court the parties do not approach the Tribunal for rectification, the plea with regard to rectification will no longer survive.”

(Italics and underscoring supplied)





The Supreme Court has, therefore, in *Patel Field Marshal Agencies*<sup>28</sup>, equated the concept of a “tenable challenge”, as envisaged by Section 124(1)(ii), to a “triable issue”. This would necessarily imply at least a rudimentary appreciation of the merits of the challenge. If the challenge to the validity of the mark is found to be tenable (or triable), the High Court/District Court before which the suit is filed would have to frame an issue to that effect and adjourn the suit to enable the petitioner to file a rectification petition, under Section 57. Consigning the adjudication of the objection to validity of the mark to another High Court, other than the High Court/District Court which ruled on the tenability of the objection to validity, would mean that the tenability of the objection would be decided by one High Court/District Court and the merits of the objection by another. Concededly, there is no inherent legal embargo to such an exercise. However, where neither Section 124, nor Section 57, *restricts* the rectification jurisdiction to another High Court, the benefits of permitting the rectification petition to be decided, on merits, by the same High Court which adjudicated on the tenability of the challenge, is obvious. *The interests of wholesome administration of justice, and a possible conflict of views also, therefore, justifies conferment, on the High Court which is in seisin of the suit, or which exercises supervisory jurisdiction over the District Court which is in seisin of the suit, of the jurisdiction to decide the rectification petition as well, especially as there is no statutory proscription thereto.*

**32.7** The High Court or the District Court, before which the suit is filed, would have, in the first instance, to satisfy itself that the challenge to the validity of the mark is tenable. Once the High Court



or the District Court satisfies itself that the challenge is tenable, it would adjourn the matter in order to enable the challenger to move the other High Court (assuming the respondent's stand were to be accepted) by way of a rectification petition. The said other High Court would then again examine whether the challenge to the validity of the mark has, or has not, any merit. This would result in an obvious possibility of conflicting views on the aspect of validity of the challenged mark.

**32.8** Though *this* discussion – apropos Section 124 – cannot be determinative of the situs of the High Court which could be approached under Section 47 or Section 57, nonetheless, in the absence of any contrary indication in the Trade Marks Act, and given the fact that, applying the law enunciated in *Girdhari Lal Gupta*<sup>6</sup>, the dynamic effect of the registration of the impugned marks *is* being felt by the petitioners in these cases within the jurisdiction of this Court, there is no justification, in my view, for this Court to decline to exercise jurisdiction in these petitioners on the ground of territorial incompetence.

**33.** Re. Rule 4 of the Trade Marks Rules:

**33.1** Mr. Vaidyanathan's reliance on Rule 4 of the Trade Marks Rules in fact defeats the case that he seeks to espouse. Plainly read, Rule 4 does not deal with the jurisdiction of the High Court at all. It deals with the issue of the office of the Trade Mark Registry which would be competent to remove a trade mark under Section 47 or cancel or vary the registration of the trade mark under Section 57 of



the Trade Marks Act. What is provided in Rule 4 is, in fact, but obvious. It is obvious that one office of the Registry of Trade Marks cannot possibly cancel, vary or modify a registration granted by another office. All that Rule 4 provides, is therefore, that the power to cancel, vary or modify the registration granted by a particular office of the Registrar of Trade Marks would vest only with that office and none other.

**33.2** This Rule cannot, therefore, be possibly have any impact on the situs of the High Court which, under Sections 57 or 124 of the Trade Marks Act would have the jurisdiction to examine a challenge to the validity of a registered trade mark. For the reasons aforesaid, that jurisdiction would vest not only with the High Court within whose jurisdiction the registering office of the Trade Mark Registry is located, but also with the High Court within whose jurisdiction a challenger experiences the dynamic effect of the registration.

**33.3** Indeed, if the legislature intended to make Rule 4 of the Trade Marks Rules also applicable to the High Court which would have jurisdiction to adjudicate on an application for rectification of the register and cancellation of a registered trade mark, there is no reason why it would not have expressly said so. When I posed this query to Mr. Vaidyanathan, his response was that the situs of the High Court which would have jurisdiction to adjudicate on the rectification petition under Section 57 is clear even from the provision, by use of the words “*the High Court*”.

**33.4** With great respect to Mr. Vaidyanathan’s considerable



articulative skills, I am unable to fathom the submission. To my understanding, the definitive article “the” ordinarily refers to something to which reference has been made earlier. If, therefore, earlier in Section 57 of the Trade Marks Act, there was reference to any particular High Court, then, by using the words “the High Court”, later in the said provision, the reference would relate back to the High Court to which the earlier part of the provision alluded. There is, however, no reference to any particular High Court before the use of the words “the High Court” in Section 57(1) of the Trade Marks Act. The use of the word “the” cannot, therefore, be accorded more importance than it commands, which is basically only a means of designating a High Court, for which no article other than “the” would have been sufficed or been apposite in the context. In any event, the use of the article “the” before “High Court” in Section 57(1) cannot legitimately lead to an inference that it is only the High Court which has jurisdiction over the office of the Registrar of Trade Marks, which granted registration of the impugned mark, which can adjudicate on its validity.

**33.5** In the absence of any provision analogous to Rule 4 of the Trade Marks Rules, designating any particular High Court as competent to exercise jurisdiction under Section 47 or Section 57 of the Trade Marks Act, there is no justification to create any such designation by judicial fiat. Apparently, the intent of the legislature was *not to limit the jurisdiction, under Section 47 or Section 57, to any particular High Court.*

**34.** Para 4 of the SOR of Tribunals Reforms Bill – Para 4 of the



SOR of the Tribunals Reforms Bill, extracted in para 22 *supra*, too, cannot support Mr. Vaidyanathan's stand. The para states that the Tribunals which were being abolished by the Tribunals Reforms Act were of the kind which neither took away "any significant workload from High Courts which otherwise would have adjudicated such cases nor (provided) speedy disposal". Mr. Vaidyanathan sought to contend that the words "which otherwise would have adjudicated such cases" indicated that the High Court would be that which had jurisdiction over the bench of the IPAB which was abolished. I see no justification, whatsoever, for any such assumption. The para certainly does not say so, either expressly or by necessary implication. All it says that the Tribunals which were being abolished had not succeeded in mitigating the workload of the High Courts which otherwise would have dealt with such cases. Which those High Courts would have been, is not indicated in the para. The para 4 does not, therefore, in any way militate against the competence of a High Court, within whose jurisdiction the dynamic effect of a registration of a trade mark is felt, from deciding a petition seeking removal or cancellation of the mark.

### **35. Section 33(3) of the Tribunals Reforms Act**

**35.1** Mr Vaidyanathan also handed over written submissions, which rely on Section 33(3)<sup>29</sup> of the Tribunals Reforms Act. It is sought to

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<sup>29</sup> 33. **Transitional provisions.** –

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(3) Any appeal, application or proceeding pending before the Tribunal, Appellate Tribunal or other Authorities specified in the Second Schedule, other than those pending before the Authority for Advance Rulings under the Income-tax Act, 1961 (43 of 1961), before the notified date, shall stand transferred to the court before which it would have been filed had this Act been in force on the date of filing of such appeal or application or initiation of the proceeding, and the court may



be contended that, in implementation of the Section, consequent on abolition of the IPAB, “as a matter of record, the High Courts at Delhi, Mumbai, Chennai, Kolkata and Ahmedabad have taken over matters pending at the IPAB, constituting Intellectual Property Divisions (IPD) to deal with the same.” What is, therefore, sought to be contended is that jurisdiction vests, consequent on the abolition of the IPAB, with the High Courts within whose territorial jurisdiction the Branch Offices of the Trade Marks Registry are situate, to deal with petitions under Section 47 or Section 57 of the Trade Marks Act, which were earlier being handled by the IPAB.

**35.2** The submission begs the issue.

**35.3** There can be no cavil, whatsoever, with the jurisdiction of the High Courts, within whose territory the Trade Marks Registry office which granted registration to the trade mark under challenge is situate, to deal with petitions under Section 47 or Section 57. As was held in *Girdhari Lal Gupta*<sup>6</sup>, the “static effect” of the registration would be felt within the jurisdiction of these High Courts.

**35.4** The question is – are these *the only High Courts which can exercise such jurisdiction?* Section 33(3) does not answer the question. Nor does the practice which evolved with respect to dealing with the petitions which were pending before the IPAB, do so. Section 33(3) is an enabling, not a disabling, provision. In fact, the provision *does not mandate that the Section 47 or Section 57*

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proceed to deal with such cases from the stage at which it stood before such transfer, or from any earlier stage, or *de novo*, as the court may deem fit.



*applications, then pending with the IPAB, be transferred only to the High Courts of Bombay, Madras, Delhi, Calcutta or Ahmedabad. These High Courts undoubtedly had the jurisdiction to deal with the applications; ergo, their transfer to these High Courts cannot be faulted. Equally, however, would the High Courts which exercised jurisdiction over the location where the challenger felt the dynamic effect of the impugned registration be competent to decide these applications. Section 33(3) does not – and cannot – indicate to the contrary.*

**36. Sections 57(2), 57(4) and 58(1)(c) of the Trade Marks Act**

**36.1** These provisions, which Mr Raichura sought to rely on, do not really assist in deciding the issue at hand. Section 57(2), to the extent it permits rectification of the register of Trade Marks on the ground of “any error or defect in any entry in the register” was sought to be analogized, by Mr Raichura, to a power of review. There is no *deemed* power of review, review being necessarily a creature of statute. Besides, the argument overlooks the fact that we are concerned, here, not with the issue of the situs of the office of the Registry which could be approached under Section 57, but the situs of the High Court which could be so approached.

**36.2** I may note, there, that there appears to be an unjustified conflation of these two issues, in the arguments advanced by learned Counsel for the respondents. An impression seems to be existing, in their mind, that the High Courts, within whose jurisdiction the office of the Registry of Trade Marks which could exercise jurisdiction,





whether under Section 47 or under Section 57, could *alone* exercise such jurisdiction. There is no legal basis for such a presumption. The power of removal (under Section 47), or of cancellation, variation or modification (under Section 57), of the impugned mark, is undoubtedly conferred, by the statute, both on the Registrar and on the High Court. That does not mean, however, that the geographical location of the Registrar and the High Court must be the same. Nor does it mean that the High Court, which could exercise jurisdiction, under these provisions, must necessarily be the High Court having territorial dominion over the Registrar. The prefixing of “High Court”, in Section 47(1) or 57(1) by the definite article “the” certainly does not lead to any such inference, at least as per any known principle of grammar or syntax.

**36.3** *Thus, though the Registrar, who could exercise jurisdiction under Section 47 or Section 57 would undoubtedly be the Registrar who granted registration to the impugned mark, the High Court which could exercise such jurisdiction would not only be the High Court having territorial dominion over such Registrar, but also any High Court within whose jurisdiction the petitioner experiences the dynamic effect of the registration.*

**36.4** Section 57(4) deals with exercise of *suo motu* jurisdiction, and Section 58(1)(c) deals with correctional powers of the Registrar. Neither of these provisions enlighten on the situs of the High Court which could exercise jurisdiction under Section 57.

**36.5** Indeed, even on a more empirical analysis, keeping principles



of equity in mind, restricting jurisdiction, under Section 47 or Section 57 of the Trade Marks Act only to High Courts within whose jurisdiction the impugned mark of the respondent was registered, would not stand scrutiny. Consider a case where the respondent has its mark registered in Chennai. The petitioner is situated in Delhi. The respondent infringes the petitioner's mark within the jurisdiction of the High Court of Delhi. The petitioner could, therefore, certainly sue the respondent at Delhi, in view of Section 134 of the Trade Marks Act, and would not have to travel to distant Chennai to do so. The validity of the respondent's mark would also have to be assailed in the process. Can it be that the petitioner can institute and prosecute the infringement suit before this Court, but would have to travel to Chennai to challenge the validity of the respondent's mark? *Had there been a statutory command to that effect, then, certainly, it would have to be respected. Had, therefore, "High Court" been defined, in the present Trade Marks Act, as it was defined in the TMMA 1958, then the petitioner would have had no option but to travel to Chennai to challenge the validity of the respondent's mark. There is, however, no such statutory mandate. The legislature has consciously omitted, from the present Trade Marks Act, even while amending it in 2021, any provision analogous to Section 2(d), or Section 3, of the TMMA 1958.* That being the statutory position, I see no reason why the petitioner, who can prefer and prosecute his infringement suit before this Court, should not be allowed to prefer and prosecute his removal/cancellation/rectification petition, likewise.

## **Conclusion**



**37.** I, therefore, hold that applications under Section 47 or Section 57 of the Trade Marks Act, 1999, as also under Section 124(1)(ii), would be maintainable not only before the High Courts within whose jurisdiction the offices of the Trade Mark Registry which granted the impugned registrations are situated, but also before the High Courts within whose jurisdiction the dynamic effect of the impugned registration is felt by the petitioner/applicant. The dynamic effect of the impugned registrations in these cases having been felt by the petitioners before this Court, these petitions are maintainable before it.

**38.** The Court acknowledges the contribution of Mr. Lall and Mr. Mahant in enabling it to negotiate this somewhat intricate legal labyrinth.

**39.** List these petitions for deciding on the further course of action to be followed on 12 October 2023.

**C.HARI SHANKAR, J**

**SEPTEMBER 4, 2023**

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