

Whirlpool Corporation vs Registrar Of Trade Marks, Mumbai & Ors on 26 October, 1998

Equivalent citations: AIR 1999 SUPREME COURT 22, 1998 AIR SCW 3345, 1999 (1) SRJ 182, (1998) 7 JT 243 (SC), 1998 (33) ARBI LR 553, 1998 (5) SCALE 655, 1998 (8) SCC 1, 1998 (8) ADSC 37, (1998) 3 SCJ 656, (1999) 1 MAHLR 686, (1998) 31 CORLA 195, (1998) 33 ARBILR 553, (1998) 8 SUPREME 176, (1999) 1 RECCIVR 220, (1998) 5 SCALE 655, (1999) 2 MAD LW 200, (1999) 2 BOM CR 70, 1999 (1) BOM LR 448, 1999 BOM LR 1 448

Author: S.Saghir Ahmad

Bench: S.Saghir Ahmad, K.T.Thomas

PETITIONER:
WHIRLPOOL CORPORATION

Vs.

RESPONDENT:
REGISTRAR OF TRADE MARKS, MUMBAI & ORS.

DATE OF JUDGMENT: 26/10/1998

BENCH:
S.SAGHIR AHMAD, K.T.THOMAS,

ACT:

HEADNOTE:

JUDGMENT:

JUDGMENT S.Saghir Ahmad. J.

Leave granted.

WHIRLPOOL, true to their name have created a WHIRLPOOL of litigation in this country. Based, as they are, the United States of America, they started the gyrating movement by applying for

registration of their Trade Mark "WHIRLPOOL" to the Registrar of the Trade Marks under the Trade Marks Act, 1940, which has since been replaced by the Trade and Merchandise Marks Act, 1958 and which for the sake of brevity, shall hereinafter be referred to as the "Act". The Trade Mark was duly registered and a Certificate of Registration was issued on 31st of July, 1957 which was renewed twice, in 1962 for a period of seven years and again for seven years with effect from 22.2.70. Since further renewal was not obtained after 1977, it was removed from the Register but the appellants continued to publicise their Trade Mark "WHIRLPOOL" as also the company name through publications which had wide circulation in this country and thus managed to maintain their reputation among the business circle including prospective customers and buyers. On 6th of Aug. 1986, Mrs. Sumitra Charat Ram and Mr. N.R.Dongre, as Trustees of Chinara Trust applied for registration of the Trade Mark "Whirlpool" in class under Application No. 458134, which was duly advertised by the Registrar in Trade Marks Journal No. 945 on Page 845 pursuant to which the appellant filed their Opposition on 6th January, 1989, but their objections were dismissed by the Assistant Registrar by his order dated 12.8.1992. An appeal against this order which was filed in the Delhi High Court on 7.11.1992 has since been admitted on 1.2.1993 and registered as C.M.(Main) No. 414 of 1992. In the meantime, "Whirlpool" was registered as the Trade Mark of the Chinara Trust on 30.11.1992 and a Certificate of Registration No. 458134 was granted to them. A petition for Rectification and for removal of this entry from the Register has already been filed by the appellant before the Registrar on 4.8.1993 under Sections 45 & 46 of the Act. It is still pending.

Since Chinara Trust had also started using the Trade Mark "Whirlpool" in relation to certain washing-machines, allegedly manufactured by them, the appellant, as owner of the Trade Mark "Whirlpool", filed a Suit (Suit No. 1705 of 1994) for passing off in the Delhi High Court with a application for temporary injunction under Order 39 Rules 1 & 2 of the Code of Civil Procedure for restraining the defendants, namely, Chinara Trust, etc., from using the Trade Mark Whirlpool in relation to their products. A Single Judge of the Delhi High Court granted temporary injunction to the appellant on 31.10.1994 which was upheld by the Division Bench on 21.4.1995. Special Leave Petition filed against this order by the Chinara Trust has already been dismissed by this Court on 30.8.1996.

On 28.2.1997, the appellant filed an application in Form TM-12 for renewal of the Trade Mark "Whirlpool" in Class 7 and the Registrar, by his order dated 29th July, 1997, allowed the renewal for three successive periods, namely, 22.2.1977, 22.2.1984 and finally 22.2.1991. Thereafter, on 8th Aug., 1997 appellant made an application under Order 6 Rule 17 C.P.C. for amendment of the plaint in Suit No. 1705 of 1994, referred to above, so as to include the ground of infringement of the Trade Mark also in the suit but the application is still pending in the Delhi High Court which has already granted time twice to the defendants, namely, Chinara Trust to file a reply. In the meantime, Chinara Trust, through its attorneys, wrote on 10th Sept. 1997 to the registrar to take suo motu action under Section 56(4) for cancellation of the Certificate of Renewal granted to the appellant on 29th July, 1997 and the registrar, acting on that request, issued a notice to the appellant on 26th Sept., 1997 requiring it to show cause why the Certificate of Registration be not cancelled. Against this notice, the appellant filed a writ petition in the Bombay High Court which was dismissed on 8.12.1997. It is against this judgment that the present appeal has been filed.

Mr. Iqbal Chagla, senior counsel appearing for the appellant, has contended that a notice under Section 56(4) can be issued only by the 'TRIBUNAL' which has been defined in Section 2 (1)(x), which means the Registrar or the High Court before which the 'proceeding concerned' is pending. Mr. Chagla has contended that it is either the Registrar or the High Court, which can issue a notice under Section 56(4), but out of the two, only that authority can issue the notice before which the 'proceeding concerned' is pending. It is further contended that since a passing-off suit was already pending in the Delhi High Court, where the appellant has also moved an application for amendment of the plaint so as to include the relief of infringement of its Trade Mark. notice under Section 56(4) could have been issued only by the Delhi High Court and not by the Registrar. Mr. R.N.Trivedi, ASG appearing for the Registrar, has on the contrary, contended that the Registrar continued to retain his jurisdiction under Section 56 of the Act, notwithstanding the pendency of the passing off suit filed by the appellant in the High Court as the said suit could not be treated to constitute, in any manner, "proceedings" under the Act. Moreover, the application for amendment, by which the relief relating to infringement of Trade Mark was sought to be added in the plaint was still pending and unless that application was allowed and the additional paragraphs, including the above relief, were added in the plaint, the nature of proceedings would not change and they will continue to be treated as proceedings in a suit and not "proceeding" under the Act.

This is also the contention of Mr. Sudhir Chandra, senior counsel appearing for the Chinara Trust. He has also contended that the High Court was fully justified in dismissing that petition at the threshold particularly as the Writ Petition was directed only against a notice issued under Section 56(4) of the Act requiring the appellant to show cause why the Registration Certificate be not cancelled. The appellant, it is contended, should have submitted a reply to that notice and allowed the Registrar to dispose of the whole matter on merits particularly as the Registrar had initiated the action principally on the ground that the appellant had obtained the renewal of the Trade Mark by misrepresentation and concealment of relevant facts. Mr.Chagla, in reply, has submitted that where the action initiated by a statutory authority is wholly without jurisdiction, it can be challenged under Article 226 of the Constitution and the Writ Petition cannot be dismissed summarily. In the instant case, the Registrar, it is contended, could not have legally acted as the Tribunal as the "Proceedings concerned" was pending before the High Court and, therefore, the High Court alone could have acted as a "TRIBUNAL" and initiated action under Section 56(4) of the Act.

Learned counsel appearing on behalf of the parties have thus tried to create a whirlpool of arguments around the word "TRIBUNAL" as defined in Section 2(1)(x) of the Act and, therefore in order to save ourselves from becoming the victim of "Vertigo" of this whirlpool at the Bar, we have, for the time being, dispassionately assumed the role of a grammarian, to consider the science of English language from the point of view of inflexion, punctuation and of course, whole syntax, as the argument of the respondent's counsel is based, almost wholly, on the importance of "comma" and the pronouns, "which" or "whom" occurring in that definition keeping at the same time in our mind the principle Grammatical false non vitiatur chartam (false grammar does not vitiate a deed) and the question whether this would also apply to statutory interpretation. But before we do it, we will first dispose of the preliminary objection relating to maintainability of the Writ Petition as filed in the High Court, allegedly, being premature and having been brought without first exhausting the alternative remedies under the Act.

Learned counsel for the appellant has contended that since suo motu action under Section 56(4) could be taken only by the High Court and not by the Registrar, contingencies, namely, where the Writ Petition has been filed for the enforcement of any of the Fundamental rights or where there has been a violation of the principle of natural justice or where the order or proceedings are wholly without jurisdiction or the vires of an Act is challenged. There is a plethora of case law on this point but to cut down this circle of fornicies whirlpool we would rely on some old decisions of the evolutionary era of the constitutional law as they still hold the field.

Rashid Ahmad vs. Municipal Board, Kairana, AIR 1960 SC 163, laid down that existence of an adequate legal remedy was a factor to be taken into consideration in the matter of granting Writs. This was followed by another Rashid case, namely, K.S. Rashid & Son Vs. The Income Tax Investigation Commissioner AIR 1954 SC 207 which reiterated the above proposition and held that where alternative remedy existed, it would be a sound exercise of discretion to refuse to interfere in a petition under Article 226. This proposition was, however, qualified by the significant words, "unless there are good grounds therefor", which indicated that alternative remedy would not operate as an absolute bar and that Writ Petition under Article 226 could still be entertained in exceptional circumstances. Specific and clear rule was laid down in State of U.P. vs. Mohd. Nooh 1958 SCR 595 = AIR 1958 SC 86, as under

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"But this rule requiring the exhaustion of statutory remedies before the Writ will be granted is a rule of policy convenience and discretion rather than a rule of law and instances are numerous where a writ of certiorari has been issued in spite of the fact that the aggrieved party had other adequate legal remedies."

This proposition was considered by a Constitution Bench of this Court in A.V. Venkateswaran, Collector of Customs. Bombay vs Ramchand Sobhraj Wadhvani & Anr. AIR 1961 SC 1506 and was affirmed and followed in the following words "The passages in the judgments of this Court we have extracted would indicate (1) that the two exceptions which the learned solicitor General formulated to the normal rule as to the effect of the existence of an adequate alternative remedy were by no means exhaustive and (2) that even beyond them a discretion vested in the High Court to have entertained the petition and granted the petitioner relief notwithstanding the existence of an alternative remedy. We need only add that the broad lines of the general principles on which the Court should act having been clearly laid down, their application to the facts of each particular case must necessarily be dependent on a variety of individual facts which must govern the proper exercise of the discretion of the Court, and that in a matter which is thus pre-eminently one of discretion, it is not possible or even if it were, it would not be desirable to lay down inflexible rules which should be applied with rigidity in every case which comes up before the Court".

Another Constitution Bench decision in Calcutta Discount Co. Ltd. vs Income Tax Officer Companies Distt. I AIR 1961 SC 372 laid down :

"Though the writ of prohibition or certiorari will not issue against an executive authority, the High Courts have power to issue in a fit case an order prohibiting an executive authority from acting without jurisdiction. Where such action of an executive authority acting without jurisdiction subjects or is likely to subject a person to lengthy proceedings and unnecessary harassment, the High Court will issue appropriate orders or directions to prevent such consequences. Writ of certiorari and prohibition can issue against Income Tax Officer acting without jurisdiction under 8.34 I.T.Act".

Much water has since flown beneath the bridge, but there has been no corrosive effect on these decisions which though old, continue to hold the field with the result that law as to the jurisdiction of the High Court in entertaining a Writ Petition under Article 226 of the Constitution, in spite of the alternative statutory remedies, is not affected, specially in a case where the authority against whom the Writ is filed is shown to have had no jurisdiction or had purported to usurp jurisdiction without any legal foundation.

That being so, the High Court was not justified in dismissing the Writ Petition at the initial stage without examining the contention that the show cause notice issued to the appellant was wholly without jurisdiction and that the Registrar, in the circumstances of the case, was not justified in acting as the "TRIBUNAL".

We proceed to the next question now.

Section 56, under which the notice to show cause has been issued to the appellant, provides as under :

56. Power to cancel or vary registration and to rectify the register -

1. On application made in the prescribed manner to a High Court or to the registrar by any person aggrieved, the tribunal may make such order as it may think fit for the 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 may be necessary or expedient to decide in connection with the rectification of the register.

4. The tribunal, 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.

6. The power to rectify the register conferred by this section shall include the power to remove a trade mark registered in Part A of the register to Part B of the register.

Section 56(1) provides that on an application made to the High Court or the Registrar by the person aggrieved, the Tribunal may cancel or vary the registration of the Trade Mark. Under Sub-section 4 of Section 56, this power can be exercised by the "Tribunal" suo motu. TRIBUNAL has been defined under Section 2(1) (x) as under :

"Tribunal" means the Registrar, or as the case may be the High Court before which the proceeding concerned is pending."

This definition treats "High Court" and "Registrar" both as "TRIBUNAL" for purposes of this Act.

High Court has been defined in Section 2(h) as the "High Court" having jurisdiction under Section 3" which, in its turn, provides that it shall be that High Court within the limits of whose appellate jurisdiction the office of the Trade Marks Registry referred to in each of the sub-clauses

(a) to (e) is situate.

We have to consider the meaning of these definitions in the context of other relative provisions of the Act so as to find an answer to the question relating to the extent of jurisdiction of the Registrar and the High Court functioning as "Tribunal".

Now the principle is that all statutory definitions have to be read subject to the qualification variously expressed in the definition clauses which created them and it may be that even where the definition is exhaustive inasmuch as the word defined is said to mean a certain thing, it is possible for the word to have a somewhat different meaning in different sections of the Act depending upon the subject or context. That is why all definitions in statutes generally begin with the qualifying words, similar to the words used in the present case, namely 'unless there is anything repugnant in the subject or context'. Thus there may be sections in the Act where the meaning may have to be departed from on account of the subject or context in which the word had been used and that will be giving effect to the opening sentence in the definition section, namely 'unless there is anything repugnant in the subject or context'. In view of this qualification, the Court has not only to look at the words but also to look at the context, the collocation and the object of such words relating to such matter and interpret the meaning intended to be conveyed by the use of the words under those circumstance". (See : Vanguard Fire and General Insurance Co. Ltd. Madras vs Fraser & Ross, AIR

1960 SC 971).

Before considering the contextual aspect of the definition of "Tribunal", we may first consider its ordinary and simple meaning. A bare look at the definition indicates that High Court and the Registrar, on their own, are not "Tribunal". They become "Tribunal" if "the proceeding concerned" comes to be pending before either of them. In other words, if "the proceeding concerned" is pending before the High Court, it will be treated as "Tribunal". If on the contrary, "the proceeding concerned" is pending before the Registrar, the latter will be treated as "Tribunal". Since "Tribunal" is defined in Section 2 which, in its opening part, uses the phrase "Unless the context otherwise requires", the definition, obviously, cannot be read in isolation. The phrase "Unless the context otherwise requires" is meant to prevent a person from falling into the whirlpool of "definitions" and not to look to other provisions of the Act which, necessarily, has to be done as the meaning ascribed to a "definition" can be adopted only if the context does not otherwise require. The history of legislation is more than a century old. The first legislation brought on the Statute Book was the India Merchandise Marks Act, 1889 (Act No. 4 of 1889). This was followed by the Trade Marks Act, 1940 (Act No. 5 of 1940). Both these acts were repealed by the Trade & Merchandise Marks Act, 1958. This Act follows the pattern of Trade Marks Act, 1938 of the United Kingdom. Prior to the enactment of Trade Marks Act, 1940, the disputes or problems, specially those relating to infringement of trade-marks or passing-off were decided in the light of Section 54 of the Specific Relief Act, 1877, while the registration problem was tackled by obtaining a declaration as to ownership of a trade-mark under the Indian Registration Act, 1908. The present Act which, as pointed out above, has repealed the Indian Merchandise Marks Act, 1889 and Trade Marks Act, 1940, also provides in Section 129 that any document declaring or purporting to declare the ownership or title of a person to a trade-mark other than a registered trade mark, shall not be registered under the Indian Registration Act, 1908.

We may now have a quick look at other relevant provisions of the Act.

Section 4 provides that Central Govt. shall appoint a person as Controller-General of Patents, Designs & Trade Marks who shall be the Registrar of Trade Marks under the Act. The functions of the Registrar, as are authorised by him, can also be performed by such other persons as the Central Government may appoint. Thus, there is an element of plurality in the sense that the functions of the Registrar can be performed by more than one person.

Section 5 provides for the establishment of a Registry known as Trade Marks Registry, with a Head Office and Branch Offices at such places as the Govt. may think fit.

Under Section 6 read with Section 7 of the Act, a Register of Trade Marks, in two parts, namely, Part A and Part B, is to be maintained with the original Register kept at the Head Office of the Trade Marks Registered Trade Marks with the names, addresses and descriptions of the proprietors, and all notifications of assignments are to be entered in that Register. Section 9 indicates the requisites for registration of a Trade Mark in Part A or Part B. Sub-section (5) of Section 9 gives guidelines to the Tribunal to follow in determining one of the relevant criteria for that purpose.

There is a prohibition contained in Section 12 on the registration of a Trade Mark which is identical or deceptively similar to an already registered Mark except as provided in Sub-section (3) thereof which authorises the Registrar to permit the registration by more than one proprietor of Trade Marks which are identical or nearly resemble each other (whether any such Trade Mark is already registered or not) in respect of the same goods or description of goods subject to such conditions and limitations as he may think fit to impose. Section 10(1) provides that a trade mark may be limited wholly or in part to one or more specified colors, and any such lamination shall be taken into consideration by the "Tribunal" while deciding the distinctive character of the trade mark.

Section 17 contains the provision for "Registration of Trade Mark subject to disclaimer" and provides that the Tribunal, in deciding whether the Trade Mark shall be entered or shall remain on the register, may require as a condition of its being on the register, that the proprietor shall either disclaim any right to the exclusive use of such part or of all or any portion of such matter, as the case may be, to the exclusive use of which the Tribunal holds him not to be entitled, or make such other disclaimer as the Tribunal may consider necessary for the purpose of defining the rights of the proprietor under the registration. Chapter III of the Act deals with the procedure for and duration of Registration. Section 18 deals with the making of an application for Registration of a Trade Mark either in Part A or Part B of the Register. The application has to be made to the Registrar though filed in the office of the Trade Mark Registry within whose territorial limits the principal place of business of the applicant, or in the case of joint applicants, whose name is first mentioned, is situate. The Registrar may either accept or refuse the application or accept it with conditions. Section 19 empowers the Registrar to withdraw his acceptance if it was given in the circumstances enumerated in clauses (a) and (b) the Section.

Where an application has been accepted either absolutely or subject to certain conditions and limitations, it has to be advertised (Sec : Section 20), though the Registrar may advertise it even before its acceptance in certain situations contemplated by that Section. Under Section 21, Notice of Opposition may be given to the Registrar by any person opposing registration and the applicant may, in reply thereto, file a counter-statement. Thereafter the Registrar is required, after giving an opportunity of hearing to the applicant and his opponent, to decide whether registration is to be permitted absolutely or subject to such conditions or limitations as he may deem fit to specify. Then comes the stage of registration of the Trade Mark under Section 23 which provides that if the application is not opposed and the period of filing "opposition" has expired or the "opposition" has been decided in favour of the applicant, the Registrar shall register the Trade Mark either in Part A or part B of the Register and issue a Certificate of Registration. Registration of a Trade Mark is done initially for a period of 7 years which can be renewed from time to time in accordance with the provisions of Section 25. The renewal can be obtained by making an application to the Registrar in the prescribed manner within the prescribed period and on payment of the prescribed fee. The renewal will be for another period of 7 years. Sub-section (3) of Section 25 provides that the Registrar, at the prescribed time before the expiration of the last registration of the Trade Mark, shall send a notice to the registered proprietor of the date of expiration and the conditions as to payment of fees upon which a renewal of registration may be obtained. If, at the expiration of the time prescribed in that behalf, those conditions have not been duly complied with, the Registrar may remove the Trade Mark from the Register. But the Trade Mark can be restored and it can be

renewed provided an application is made within one year from the expiration of the last registration and provided the Registrar is satisfied that it would be just so to do. Once a Trade Mark has been removed from the Register for failure to pay the fee for renewal, it would, nevertheless, be deemed to be a Trade Mark already on the Register for a period of one year for purposes of any application for registration of another Trade Mark, unless the "Tribunal" is satisfied either :

(a) that there has been no bona fide trade use of the trade mark which has been removed during the years immediately preceding its removal; or

(b) that no deception or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

Chapter IV of the Act deals with the effect of the registration. This Chapter deals with the rights conferred by registration, infringement of Trade Marks and also defines the acts which do not constitute infringement. Chapter V deals with assignment and transmission, while Chapter VI deals with the use of Trade Marks and registered Users.

Chapter VII deals with Rectification and Correction of the Register, which begins with Section 56, around which the bulk of arguments made by both the sides, any three, as Registrar has also addressed us has revolved. This Section also speaks of the "Tribunal", "Registrar" and the "High Court".

Chapter VIII deals with Certificate of Trade Marks, Chapter IX contains "Special Provisions For Textile Goods", while chapter X deals with offences, penalties and procedure therefor. Chapter XI contains the miscellaneous provisions which, inter alia, provides that suits for infringement etc. of the Trade Marks or relating to any right in a registered Trade Mark or for passing off arising out of the use by the defendant of a Trade Mark, which is identical with or deceptively similar to the plaintiff's Trade Mark, whether registered or unregistered, shall not be instituted in any court inferior to a district Court. (See : Section 105). Section 106 specifies the reliefs which may be granted in suits for infringement or for passing off. Under Section 107 of the Act, any application for rectification of Register has to be made, in the circumstances specified therein, only to the High Court and not to the Registrar. The provisions of this section are quoted below :-

"107. Application for rectification of register to be made to High Court in certain cases. (1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under Clause (d) of sub-section (1) of section 30 and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register, and notwithstanding anything contained in section 46, sub-section (4) of section 47 or section 56, such application shall be made to the High Court and not to the Registrar.

(2)Subject to the provisions of sub-section (1), where an application for rectification of the register is made to the Registrar under Section 46 or sub-section (4) of section 47 or section 56, the Registrar may , if he thinks fit, refer the application at any stage of the proceeding to the High Court."

Since a reference in this Section has been made to Sections 46 of the Act, they are reproduced below:-

"46. Removal from register and imposition of limitations on ground of non-use. - (1) Subject to the provisions of section 47, 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 made in the prescribed manner to a High Court or to the Registrar 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 by him or, in a case to which the provisions of section 45 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 had 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 :

proprietor thereof for time Provided that, except where the applicant has been permitted under sub-section (3) of section 12 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 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.

(2)Where in relation to any goods in respect of which a trade mark is registered

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(a)the circumstances referred to in clause (b) of sub-section (1) are shown to exist so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise trade in, in a particular place in India (otherwise than for export from India), or in

relation to goods to be exported to a particular market outside India; and

(b) a person has been permitted under sub-section (3) of section 12 to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be so sold, or otherwise trade in or in relation to goods to be so exported, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark;

on application by that person in the prescribed manner to a High Court or to the Registrar, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as it thinks proper for securing that registration shall cease to extend to such use. (3) An applicant shall not be entitled to rely for the purpose of clause (b) of sub-section (1) or for the purposes of sub-section (2) on any non-use of a trade mark which is shown to have been due to special circumstances in the trade and not to any intention to abandon or not to use the trade mark in relation to the goods to which the application relates."

"47. Defensive registration of well known trade marks : (1) Where a trade mark consisting of any invented words has become so well known as respects any goods in relation to which it is registered and has been used, that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then notwithstanding that the proprietor registered in respect of the first mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section 46, the trade mark may, on application in the prescribed manner by such proprietor, be registered in his name in respect of those other goods as a defensive trade mark, and while so registered, shall not be liable to be taken off the register in respect of those goods under the said section.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be and shall be registered as associated trade mark.

(4) On application made in the prescribed manner to a High Court or to the Registrar, by any person aggrieved, the registration of a trade mark as a defensive trade mark

may be cancelled on the ground that the requirements of sub-section (1) are no longer satisfied in respect of any goods in relation to which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in relation to which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in sub-section (1).

(5)The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark. (6)Except as otherwise expressly provided in this section, the provisions of this act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other case."

Section 108 lays down the procedure and the manner in which the application for rectification shall be dealt with by the High Court. It provides as under :-

"108.Procedure for application for rectification before a High Court (1) An application for rectification of the register made to a High Court under section 46, sub-section (4) of section 47 or section 56 shall be in such form and shall contain such particulars as may be prescribed.

(2)Every such application shall be heard by a single Judge of the High Court :

Provided that any such Judge may, if he thinks fit, refer the application at any stage of the proceedings for decision to a Bench of that High Court.

(3)Where any such application is heard by a single Judge of the High Court an appeal shall lie from the order made by him on application to a Bench of the High Court.

(4)Subject to the provisions of this Act and the rules made thereunder, the provisions of the Code of Civil Procedure, 1908 (5 of 1908), shall apply to applications to a High Court under this section.

(5)A certified copy of every order of judgment of the High Court or of the Supreme Court, as the case may be relating to a registered trade mark under this section shall be communicated to the Registrar by that Court and the Registrar shall give effect to the order of Court and shall, when so directed, amend the entries in, or rectify, the register in accordance with such order."

Section 109 makes provision for an appeal to the High Court against any order or decision of the registrar under this Act or the rules made thereunder. The appeal is to be heard by a Single Judge with a further appeal before the Division Bench of the High Court. Sub-section (6) of Section 109

provides that in disposing of the appeal, the High Court shall have power to make any order which the Registrar could make under the Act.

Section 111 provides for the circumstances in which proceedings in a suit are to be stayed. It is quoted below :-

"111.Stay of proceedings where the validity of registration of the trade mark is questioned, etc.- (1) Where in any suit for the infringement of a trade mark -

(a)the defendant pleads that the registration of the plaintiff's trade mark is invalid; or

(b)the defendant raises a defence under clause (d) of sub-section (1) of section 30 and the plaintiff pleads the invalidity of the registration of the defendant's trade mark;

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

(i)if any proceeding for rectification of the register in relation to the plaintiff's or defendant' 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 and 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 (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 making any interlocutory order (including any order granting an injunction directing accounts to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit."

It is in the background of the above provisions that the question relating to the jurisdiction of the "Registrar" and the "High Court", which individually and separately constitute "Tribunal" within the meaning of Section 2(1)(x), has to be considered.

The functions and extent of jurisdiction of the registrar and that of the High Court which, incidentally, has also been constituted as the appellate authority of the Registrar, have been distinctly set out in different provisions of the Act. There are, however, certain matters for which jurisdiction has been given to the "Tribunal" which, by its definition, includes the "High Court" and the "Registrar" and therefore, the question is "can both be said to have "concurrent" jurisdiction over matters as are set out for example, in Sections 9, 10, 26, 45, 46, 47 and 56". If the proceeding is cognisable both by the Registrar and the High Court, which of the two will have jurisdiction to entertain such proceeding to the exclusion of the other or the jurisdiction being concurrent, can the proceeding go on simultaneously before the High Court and the Registrar, resulting, may be, in conflicting decisions at the end, is a question which seems to be answered by the words "before which the proceeding concerned is pending"

occurring in the definition of "Tribunal" in Section 2(1)(x) of the Act. Let us test whether the answer is correct. Section 56 contemplates proceedings of varying nature. The proceedings contemplated by Sub-section (1) relate to the cancellation of Trade Mark or varying the registration of Trade Mark, on the ground that the condition on which the registration was granted, was either violated or there was failure in observing the condition of registration. These proceedings may be entertained either by the High Court or the Registrar on the application, and, at the instance, of the "person aggrieved".

The proceedings contemplated by Sub-section (2) of Section 56 relate to the absence or omission of an entry in the Register or an entry having been made without sufficient cause or an entry wrongly remaining on the Register or there being any error or defect in an entry in the Register. Such proceedings may also be entertained either by the Registrar or the High Court on an application made in the prescribed manner by a "person aggrieved". The High Court or the registrar may, in these proceedings, pass an order either for making an entry, or expunging or varying the entry. In these proceedings which may be pending either before the High court or the Registrar, it would be open to either of them to decide any further question which may be necessary or expedient to decide in connection with the rectification of the Register. Obviously, this gives very wide jurisdiction to the High Court or the Registrar working as a Tribunal as the jurisdiction is not limited to the proceedings pending under Sub-section (1) or Sub-section (2) but extends also to decide, in the same proceedings, any other question which may legitimately arise in connection with the rectification proceedings.

The jurisdiction conferred on the High Court or the Registrar under Sub-section (1) or Sub-section (2) can also be exercised suo motu subject to the condition that a notice is issued to the parties concerned and an opportunity of hearing is given to them before passing any order contemplated by Sub-section (1) or Sub-section (2). The Registrar and the High Court have also been given the jurisdiction under this Section to order that a Trade Mark registered in Part A shall be shifted to

Part B of the Register.

An order of rectification, if passed by the High Court, is implemented by the Registrar by rectifying the Register in conformity with the order passed by the High Court.

The extent of jurisdiction conferred by Section 56 on the Registrar to rectify the Register, is, however curtail by Section 107 which provides that an application for rectification shall, in certain situations, be made only to the High Court. These situations are mentioned in Sub-section (1) of Section 107, namely, where in a suit for infringement of the registered Trade Mark, the validity of the registration is questioned by the defendant or the defendant, in that suit, raises the defence contemplated by Section 30(1)(d) in which the acts which do not constitute an infringement, have been specified, and the plaintiff in reply to this defence questions the validity of the defendant's Trade Mark. In these situations, the validity of the registration of the Trade Mark can be determined only by the High Court and not by the Registrar. Section 107 thus impels the proceedings to be instituted only in the High Court. The jurisdiction of the Registrar in those cases which are covered by Section 107 is totally excluded. Significantly, Section 107(2) provides that if an application for rectification is made to the registrar under Section 46 or Section 47(4) or Section 56, the Registrar may, if he thinks fit, refer that application, at any stage of the proceeding, to the High Court. Similarly, under Section 111 of the Act, in a pending suit relating to infringement of a Trade Mark, if it is brought to the notice of the Court that any rectification proceedings relating to plaintiff's or defendant's trade Mark are pending either before the Registrar or the High Court, the proceedings in the suit shall be stayed pending final decision of the High Court or the Registrar. Even if such proceedings are not pending either before the Registrar or the High Court, the trial court, if prima facie satisfied that the plea regarding invalidity of plaintiff's or defendant's Trade Mark is tenable, may frame an issue and adjourn the case for three months to enable the party concerned to apply to the High Court for rectification of the Register. If within three months, the party concerned does not approach the High Court, the plea regarding invalidity of Trade Mark would be treated as abandoned but if such an application has been given hearing, the suit would be stayed awaiting final decision of the High Court. The finding of the High Court would bind the parties and the issue relating to the invalidity of Trade Mark would be decided in terms of those findings.

In this background, the phrase "before which the proceeding concerned is pending" stands out prominently to convey the idea that if the proceeding is pending before the "Registrar", it becomes the "Tribunal". Similarly, if the proceeding is pending before the "High Court", then the High Court has to be treated as "Tribunal". Thus, the jurisdiction of the Registrar and the High Court, though apparently concurrent in certain matters, is mutually exclusive. That is to say, if a particular proceeding is pending before the registrar, any other proceeding, which may, in any way, relate to the pending proceeding, will have to be initiated before and taken up by the Registrar and the High Court will act as the Appellate Authority of the Registrar under Section 109. It is obvious that if the proceedings are pending before the High Court, the registrar will keep his hands off and not touch those or any other proceedings which may, in any way, relate to those proceedings, as the High Court, which has to be the High Court having jurisdiction as set out in Section 3, besides being the Appellate Authority of the Registrar has primacy over the Registrar in all matters under the Act. Any other interpretation of the definition of "Tribunal" would not be in consonance with the scheme of

the Act or the contextual background set out therein and may lead to conflicting decision on the same question by the Registrar and the High Court besides generating multiplicity of proceedings. Learned counsel for the respondent - Chinara Trust, at this stage, invoked the Rule of Punctuation in English Grammar and contended that the definition of "Tribunal" is amply clear and requires no interpretative exercise as there is a distinction between the "Registrar" and the "High Court" inasmuch as the Registrar will have jurisdiction irrespective of the pendency of any proceeding, the High Court will have jurisdiction only when "proceeding concerned is pending before it. This he tried to show by pointing out that the words "as the case may be" are placed between two commas, one at the beginning immediately after the word "Registrar" and the other at the end, with the result that the words "Tribunal means the Registrar" stand out distinctly, while the words "High Court before which the proceeding concerned is pending" stand out separately as an independent phrase. It is contended that the words "before which the proceeding concerned is pending" will not be applicable to the Registrar and, therefore, the Registrar can exercise the jurisdiction under Section 56 irrespective of pendency of any "proceeding".

The argument is fallacious.

Learned counsel for the Chinara Trust is trying to give a measure of importance to the punctuation mark "comma", more than it deserves. If "comma" were that important, there, incidentally, is another "comma" obviously separates the phrase "before which the proceeding concerned is pending" from the word "High Court" with the result that this phrase becomes applicable both to "High Court" and the "Registrar". The word "concerned" in this phrase is also of significance inasmuch as the word Tribunal has been used in different sections in relation to different proceedings. At some places in the Act, all the three words, namely, Registrar, High Court and Tribunal have been used which indicate that if the proceeding under that particular provision is pending before the Registrar then on account of that proceeding, the Registrar becomes the Tribunal. So also, if the proceeding is pending before the High Court then that proceeding makes the High Court a Tribunal. It is in that sense that the word proceeding concerned has to be understood.

Pronoun means for-a-noun. It is defined as a word used instead of a noun. The Pronoun with which we are concerned in this case is the relative pronoun namely the pronoun WHICH which incidentally can be used in many other forms, namely as an interrogative pronoun, an interrogative adjective, or as a relative adjective. Its use is not limited to inanimate objects or animals but it can also be used for people as explained in A Practical English Grammar (A.J.Thomson and A.V. Martinet - Fourth Edition). The two Nouns, namely, the registrar and the High Court used in the definition of Tribunal are followed by the relative pronoun which and therefore the phrase before which the proceeding concerned is pending would relate to both the Nouns, namely, the Registrar and the High Court. This rule of Grammar which was sought to be pressed into aid by the learned counsel for the respondent is therefore of no use to him. Not content with the rejection of the above contention, learned counsel for the respondent invoked another rule of English grammar relating to the use of pronouns which and whom and contended that if the phrase before which the proceeding concerned is pending were meant to apply to the Registrar, the Legislature would have used the pronoun whom instead of which and the phrase would have read before whom the proceeding concerned is pending." The High Court, it is contended, is an inanimate object and, therefore, the

pronoun which has been used.

"Pronoun" means "for-a-noun". It is defined as a word lused "instead of a noun". The Pronoun with which we are concerned in this case is the relative pronoun. namely, the pronoun WHICH, which, incidentally, can be used in many other forms, namely, as an interrogative pronoun, an interrogative adjective. Its use is not limited to inanimate objects or animals but it can also be used for "people" as explained in A Practical English Grammar (A.J. Thomson and A.V.Martinet - Fourth edition). The two Nouns, namely, the Registrar and the High Court, used in the definition of Tribunal are followed by the relative pronoun which and therefore, the phrase before which the proceeding concerned is pending would relate to both the Nouns, namely, the Registrar and the High Court. This rule of Grammar which was sounght to be pressed into aid by the learned counsel for the respondent is therefore, of no use to him. Moreover, in a situation of this nature, mere rule of Grammar would not lead to correct interpretation of the definition which has to be analysed, as we have already done, in the background of those provisions in which the word Tribunal has been used together with the propose for which it has been used deeping in mind the overall scheme of the Act.

Learned counsel for the respondent than cited before us a decision of the Calcutta High Cort in Standard Pharmaceuticals vs. Dy. Registrar of Trade Marks [Appeal No. 213 of 1970 decided on 18.2.1975 by Sabyasachi Mukherjee, J. (as His Lordship then was)], in which it was inter alia, observed as under :-

.... "The definition clause under section 2(1)(x) provides as follows; "Tribunal means the Registrar or as the case may be, the High Court before whom the proceeding concerned is pending. Therefore, in order to be a tribunal the Registrar must be one before whom a proceeding is pending Counsel for the appellant contended that in section 56(1) of the Act, a proceeding could only be pending before the Registrar where there were two parties or in other words, where there was a proceeding initiated at the behest of a third party. It was contended that in this case no proceeding was pending. In my opinion, this contention also cannot be accepted. It is true that under the Act, the registrar (being the person designated) performs some function as the Registrar and the Registrar as well as the High Court perform in certain other cases certain functions of the tribunal. But both the High Court perform in certain other cases certain functions of the tribunal. But both the High Court and the Registrar perform the function of the tribunal, only in cases where proceedings are pending Proceedings in the case of statutory bodies, like this, need not be a dispute between two contending private parties. It could be a dispute between the adjudicating party and the party against whom the proceedings are taken. In this connection, reliance may be placed on the observations of the Supreme Court in the case of Associated Cement Companies Ltd. V. P.N. Sharma and another, A.I.R. 1965 S.C. 1965 at page 1999 where the Supreme Court observed "If a statutory body has power to do any act which will prejudicially affect the subject then although there are

not two parties apart from the authority and the contest is between the authority proposing to do the act and the subject opposing it, the final determination of the authority will yet be a quasi judicial act provided that the authority is required by the statute to act judicially. In such case the statutory body which adjudicates such a dispute would, in my opinion be a tribunal in terms of Section 2(1)(x) of the Trade and Merchandise Marks act, 1958. In this case, after the proceeding which was pending by the initiation of the notice dated the 9th May, 1968, the Registrar in deciding this controversy in my opinion, was acting as a tribunal and therefore, was competent to take action as a tribunal contemplated under section 56(4) of the Act."

As against the above decision, there is a decision of a Division Bench of the same High Court in Registrar of Trade Marks and Anr. Vs Kumar Ranjan Sen & Ors. AIR 1966 Calcutta 311, in which it was laid down as under :-

"It will be noticed that the word "Tribunal" as defined in clause (x) As against the above decision, there is a decision of a Division Bench of the same High Court in Registrar of Trade Marks and Anr. Vs. Kumar Ranjan Sen & Ors., AIR 1966 Calcutta 311, in which it was laid down as under :-

"It will be noticed that the word "Tribunal" as defined in clause (x) of Sub-section (1) of S. 2 does not simply mean the Registrar or the High Court but the Registrar or the High Court, only when proceedings are pending before them. It is a convenient way of describing either the Registrar of the High Court before whom proceedings were pending. Coming now to S. 56, we find that sub-section (1) refers to an application made in the Prescribed manner to a High Court or to a Registrar, but it is the Tribunal which can make an order under it of cancellation or varying the registration as the case may be. It is a mistake to think that the word "Tribunal"

Stands in contra-distinction to the word "High Court" or the "Registrar". The word "Tribunal" has been used as meaning the "High Court" or the "Registrar" before whom proceedings are pending. It is in this sense that the word "tribunal" has been used in sub-section (4). It is intended to convey that the "Tribunal", that is to say, the High Court or the Registrar before whom proceedings are pending may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make an order a referred to in sub-section (1) or sub-section (2). As will appear from sub-section (5) the High Court has itself power to order a rectification of the register. In fact, the Court below, having come to the conclusion that the registration had been improperly done in violation of the provisions of the said Act, was not powerless in the matter, but could of its own motion have rectified the register, even if its conclusion as to the powers of the Deputy Registrar was right. It is clear to us that the use of the word "Tribunal" in sub-section (4) of S. 56 does not exclude the provisions of sub-section (2) of S.4. The only thing to note is that in order to attract the provisions of sub-section (4) of Section

56. proceedings must be pending before the Registrar or the persons authorised by him to exercise a particular function under sub-section (2) or S. 4.

This decision has been considered by the learned Single Judge in Standard Pharmaceutical's case (supra). In our opinion, both the decisions are in line with the view that we have taken in the instant case on the interpretation of the definition of Tribunal. But the point before us is a little different as we are concerned essentially with the extent of jurisdiction of the "Registrar" and the High Court vis-a-vis other provisions of the Act.

In the instant case, it has already been indicated above that when the Assistant Registrar of Trade Marks dismissed appellant's opposition to the registration of respondent's Trade Mark by its order dated 12.8.1992, it filed an appeal in the Delhi High Court, which was admitted on 1.2.1993 and has since been registered as C.M.(Main) 414 of 1992. Thereafter, on 4.8.1993, the appellant filed a rectification petition under Sections 45 and 46 of the Act for removing the entry relating to the Trade Mark for which Registration Certificate was granted to the respondents on 30.11.1992. The appellant has also filed a suit for passing-off (Suit No. 1705 of 1994) in the Delhi High Court against the respondents in which an order of temporary injunction has been granted in favour of the appellant which has been upheld by the Division Bench of the High Court as also by this Court. In that suit, an amendment application has also been filed so as to include the ground of infringement of the appellant's Trade Mark but that application has not yet been disposed of. It is, however, obvious that if the application is allowed, the amendments will relate back to the date of the application, if not to the date of plaint.

In view of the pendency of these proceedings in the High Court and specially in view of Section 107 of the Act, the Registrar could not legally issue any suo motu notice to the appellant under Section 56(4) of the Act for cancellation of the Certificate of Registration/Renewal already granted. The appeal is consequently allowed and the show-cause notice issued by the Deputy Registrar (respondent No.2) on 26th of Sept. 1997 under Section 56(4) of the Act is hereby quashed. The appellants shall be entitled to their costs.