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IN THE HIGH COURT OF JUDICATURE AT BOMBAY**ORDINARY ORIGINAL CIVIL JURISDICTION****WRIT PETITION NO.2793 OF 2013**

Ravin Cables Limited

..Petitioner

Versus

Union of India & Ors.

..Respondents

.....

Dr. V. V. Tulzapurkar, Ramesh Gajaria & Ms. Deepa Hate i/b. Gajaria & Co.
for the Petitioner.

Mr. A. M. Sethna a/w Dushyant Kumar for Respondent nos.1 and 2.

Mr. Subodh K. Pathak a/w Adil Aniz i/b. Amrita Saldhana for Respondent
no.3.

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**CORAM: M. S. SANKLECHA &
A. K. MENON, JJ.**

DATE : 21st JULY, 2016

PC.:

It was after the petition was argued for almost an hour and we were to commence dictating our order that an application was made on behalf of respondent nos.1 and 2 i.e. Union of India and Intellectual Property Appellate Board (Board) to keep the matter back on the ground that Mr. A. M. Sethna, the counsel is on his way. However as the Board is the statutory authority whose order is impugned before us and it speaks for itself, we saw no reason to keep the petition back. More particularly when the contesting parties i.e. the petitioner and respondent no.3 were heard at length and at their request the Petition is being disposed of finally at the

stage of admission.

2. This Petition challenges the order dated 7th August, 2013 passed by the Board (Circuit Bench sitting at Mumbai). By the impugned order the application of respondent no.3 for rectification of the Register of Trade-Marks made under Section 57 of the Trade Marks Act, 1999 (Act) was allowed. This resulted in removal of the following trade-marks registered in the petitioner's name from the Register:

“(a) Prime Cab Cables (label) under no.1250483

(b) Prime Cab Cables (label) under no.1250484

(c) Prime Cab Cables (label) under no.813036.” (said Marks)

3. The grievance of the petitioner is that the impugned order of the Board has taken up an issue suo moto which was not even urged by the respondent no.3 at the hearing and directed the removal of the said Marks. This according to the petitioner is evident from the following portion of the impugned order:-

“10. We are truly astonished how the registry 'manages' to keep a prior application of the same mark for the same goods pending, while entertaining, processing, advertising in the TM Journal and finally registering the impugned registration when the application under no.779092 filed

on 20th November, 1997 is under opposition by the respondent. Until the fate of that application is finally determined, it is unethical and illegal to register subsequent applications of identical marks for identical goods. The registry should indulge in horse trading with the winner past the post taking the jackpot.

11. We do not wish to go into the merits of the rectification petition. In our view, the law should be applied without fear or favour. The conduct of the registry in the instant case exhibits the perceived lawlessness and whimsical functioning. We have also come across case where prior applications are wrongly abandoned to favour subsequent applications. The impugned mark cannot remain on the register even for a single minute.”

(emphasis supplied)

4. The grievance of the respondent no.3 i.e. applicant before the Board was that it was a prior user of the said Mark and therefore respondent no.3 sought cancellation/removal of the said Marks registered in the name of the petitioner. However, the impugned order of the Board did not go into the basic grievance of the respondent no.3 i.e. of prior user yet allowed the application on account of its view on the functioning of the Registry. Further it imputed motives at the petitioner's application being allowed while the respondent no.3's application was still awaiting

disposal. It is submitted that in case the Board is of the view that the application be allowed on a fresh/new issue then the procedure as provided under Section 57(4) of the Act ought to have been followed.

5. Mr. Pathak, the learned counsel appearing for the respondent no.3 i.e. applicant before the Board contends that he is a prior user of the said mark. Therefore he is entitled to have the name of the petitioner as registered user/owner of trade-mark cancelled. In these circumstances, it is submitted that this Court should not interfere with the impugned order of the Board.

6. We have considered the rival submissions. We find that amongst the various grounds taken by the respondent no.3 in its application for rectification before the Board was also that although its application which is earlier in point of time was not disposed of, the subsequent application of the petitioner was disposed of. Thus this ground is not taken up suo-moto by the Board. In the above view there is no need for any specific notice under Section 57(4) of the Act to the petitioner.

7. However, even according to respondent no.3, its basic issue before the Board was its prior user. As pointed herein above, particularly para 10 and 11 of the impugned order which specifically records the fact that it is

not going into the merits of the rectification application. The application of respondent no.3 was thus, disposed of on the basis of the opinion of the Board that all is not well with the functioning of the Registrar of Trade-marks. The impugned order of the Board did not decide the basic lis before it and nor did it hear the trade-mark Registry before expressing its astonishment at the functioning of the Trade-mark Registry. We are informed that at the hearing of appeals/applications by the Board, the Registry is not represented. In a normal case, the representing by the Registry may not be necessary. However when the functioning of the Registry is being examined by the Board it must consider the say of the Registry before commenting upon it. Thus the importance of giving specific notice to the Registry and hearing it on the issues considering its functioning before passing an order which may have a wide ranging impact. This hearing need not necessarily be oral and a say of the Registry on the issues raised about its functioning would in the facts of a case meet the ends of justice. This is entirely for the Board to decide. However no order adversely commenting on the functioning of the Registry should be passed without an opportunity being given to the Registry.

8. In case the Registry was heard, the Board would have learnt it, why and how an earlier application was pending in the Registry. In case after hearing the Registry, it came to the conclusion that the Registration

granted of the said Trade-marks to the petitioner was in breach of the practice normally followed, then the consequences thereof could visit the petitioner. However, the consequence of removing the said Mark of the petitioner from the Register of Trade Marks cannot be done by an inadequate enquiry i.e. condemning the Registry in the manner in which it functions without it having an occasion to present its views. This is particularly so as there is nothing on record to indicate that the disposal of the petitioner's application was deliberate and/or malafide. It is not recorded in the impugned order that granting of this application by the Registry was extraordinary as otherwise it does follow the first in first out practice while disposing of the applications for Registration of Trade Marks before it.

9. In our view there is a flaw in the decision making process leading to the impugned order of the Board. We therefore set aside the order of the Board dated 7th August, 2013 and restore the respondent no.3's application before the Board for fresh consideration on merits of the rectification application in accordance with law. It is made clear that if the Board desires to make any observation on the functioning of the Trade-marks Registry then the same would be made by the Board in its order, only after the record of the Trade-marks Registry are called for and the Registry is heard not on the merits of the dispute but only on its

functioning.

10. Needless to state that in case the Board does come to the conclusion that the petitioner's application for registration was unfairly given priority in disposal pending the respondent no.3's application, then of course the rectification of the Register can be directed. Since the impugned order of the Board which has been set aside by us today is dated 7th August, 2013, we would request the Board to dispose of the Respondent's application for rectification as expeditiously as possible in accordance with its turn, without granting undue adjournments.

11. Petition is disposed of in above terms. No order as to costs.

(A. K. MENON, J.)

(M. S. SANKLECHA, J.)