

\$~1&2

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ C.R.P. No.146/2015 & CM No.21927/2015 (for stay)
REGISTRAR OF TRADE MARKS Petitioner
Through: Mr. Sanjeev Narula, CGSC and Ms.
Anumita Chandra, Adv.

versus

KAPOOR SAWS MANUFACTURING CO & ORS Respondents
Through: Mr. Amit Jain, Adv. for R-1.
Mr. S.K. Bansal, Mr. Ajay Amitabh
Suman, Mr. Saurabh Kapoor and Mr.
Kapil Kumar, Advs. for R-3&4.

AND

+ C.R.P. No.29/2017 & CM No.5066/2017 (for stay)
REGISTRAR OF TRADE MARKS
THR DEPUTY REGISTRAR OF TRADE MARKS Petitioner
Through: Mr. Sanjeev Narula, CGSC and Ms.
Anumita Chandra, Adv.

versus

SONIK INDUSTRIES & ORS Respondents
Through: Mr. S.K. Bansal, Mr. Ajay Amitabh
Suman, Mr. Saurabh Kapoor and Mr.
Kapil Kumar, Advs. for R-1.
Mr. S.M. Gupta, Adv. for R-2&3

CORAM:

HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

ORDER

%

31.07.2017

1. Civil Revision Petition No.146/2015 was instituted impugning the order, of the Additional District Judge in a suit *inter se* respondents therein, directing issuance of Proclamation under Order XVI Rule 10 of the Code of Civil Procedure, 1908 (CPC) to the Registrar of Trade Marks, Mumbai for the reason of the Registrar of Trade Marks, Mumbai having failed to respond

to the notice to show cause, earlier issued, for non-production of summoned record.

2. Civil Revision Petition No.146/2015 was entertained and vide *ex parte* order dated 1st October, 2015 which continues to be in force, further proceedings against the Registrar of Trade Marks before the Trial Court stayed.

3. It is however today informed that Proclamation to the Registrar of Trade Marks, in the suit qua which Civil Revision Petition No.146/2015 has been filed, was ordered to be issued for the reason of the petitioner Registrar of Trade Marks inspite of service of summons having not produced the records of the Office of the Registrar of Trade Marks summoned in the suit. It is also informed that the petitioner Registrar of Trade Marks has since then furnished to the respondent which had summoned the Registrar of Trade Marks, certified copies of the documents which were sought to be summoned and in default of producing which the Proclamation was issued.

4. The counsels were heard on 14th July, 2017. The counsel for the petitioner Registrar of Trade Marks drew attention to Sections 136, 137 and 138 of the Trade Marks Act, 1999 which provide as under:-

“136. Registered user to be impleaded in certain proceedings.—(1) In every proceeding under chapter VII or under section 91, every registered user of a trade mark using by way of permitted use, who is not himself an applicant in respect of any proceeding under that Chapter or section, shall be made a party to the proceeding.

(2) Notwithstanding anything contained in any other law, a registered user so made a party to the proceeding shall not be liable for any costs unless he enters an appearance and takes part in the proceeding.

137. Evidence of entries in register, etc., and things done by the Registrar.—(1) A copy of any entry in the register or of any document referred to in sub-section (1) of section 148 purporting to be 47 certified by the Registrar and sealed with the seal of the Trade Marks Registry shall be admitted in evidence in all courts and in all proceedings without further proof or production of the original.

(2) A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing that he is authorised by this Act or the rules to make or do shall be prima facie evidence of the entry having been made, and of the contents thereof, or of the matter or things having been done or not done.

138. Registrar and other officers not compellable to produce register, etc.—The Registrar or any officer of the Trade Marks Registry shall not, in any legal proceedings to which he is not a party, be compellable to produce the register or any other document in his custody, the contents of which can be proved by the production of a certified copy issued under this Act or to appear as a witness to prove the matters therein recorded unless by order of the court made for special cause.”

and contended that without making an effort to obtain certified copies of the record of the petitioner, Registrar of Trade Marks and producing the same to obviate the need to summon the petitioner Registrar of Trade Marks, straightway summons were being issued asking the petitioner Registrar of Trade Marks to produce the records. The counsel for the petitioner Registrar of Trade Marks further stated that the offices of the petitioner Registrar of Trade Marks at different locations are very small, with skeletal staff whose work is affected if the said staff is also required to appear as witness before different Courts. It was contended that once the petitioner Registrar of Trade

Marks furnishes certified copies of its records, certified copies can be obtained and tendered in evidence and which, under the provisions aforesaid, would be admitted in evidence in all proceedings, without further proof or production of the original. It was further contended that once it is provided in Section 138 supra that the petitioner Registrar of Trade Marks shall not in any legal proceedings to which it is not a party be compellable to produce the Register or any document in its custody, the contents of which can be proved by production of a certified copy issued under the said Act, the petitioner Registrar of Trade Marks cannot be summoned as a routine matter, as is generally being done.

5. Per contra, it was the contention of the counsel for the respondents No.3&4 in Civil Revision Petition No.146/2015 that such applications for certified copies made to the petitioner Registrar of Trade Marks remain pending for an indefinite time and hence the need accrues to summon the record.

6. On 14th July, 2017, the proposal, of this Court issuing directions to the petitioner Registrar of Trade Marks for time bound issuance of certified copies was mooted and the counsels requested to exchange the draft orders incorporating the said directions.

7. The counsels have been heard further today.

8. The counsel for the respondents no.3&4 in Civil Revision Petition No.146/2015 has contended, that notwithstanding the production of certified copies, need to summon the original record of the petitioner Registrar of Trade Marks may still arise in certain cases.

9. The counsel for the petitioner Registrar of Trade Marks states that Section 138 though prohibits production of records, contents of which can be proved by production of certified copy, but itself provides for the contingency where, notwithstanding production of certified copy, original may be required. It is however contended that the summoning of the petitioner Registrar of Trademark should not be in routine manner, without proper application of mind and it has to be by an order giving reasons.

10. Though in my view the Revision Petition under Section 115 of the CPC is not maintainable against the order impugned in Civil Revision Petition No.146/2015 but the petition having remained pending, it is deemed appropriate to proceed to issue directions of a general nature to all the offices throughout India of the petitioner Registrar of Trade Marks qua the issuance of certified copies.

11. The Registrars of Trade Marks are directed to:-

- (i) If not already in place, nominate one Nodal Officer of each branch to receive applications for certified copies and to issue certified copies.
- (ii) To, within two months of today, announce on the website of the Registrar of Trade Marks, the particulars i.e. name/designation, address, phone number/s and email address of the Nodal Officer responsible for accepting and entertaining applications for certified copy and to issue certified copies for each office of the Registrar of Trade Marks.
- (iii) To, within six months of today, make a provision, if not already in existence, for making online applications for certified copies.

- (iv) To, within six months of today, make a provision on the website of the Registrar of Trade Marks for disclosure of the status of the applications for certified copies including any deficiency or defect therein required to be remedied by the applicant and/or the date when it will be ready for collection.
- (v) To, till the aforesaid is functional, as an interim measure, make a provision for sending intimation, to the applicant/s for certified copies, of deficiencies / defects required to be rectified via e-mail, SMS and other modes of communication.
- (vi) To, endeavour to make provision for online payment of the fee and other charges if any for certified copies.
- (vii) To issue certified copies within one month of the receipt of a duly completed application.
- (viii) To indicate on the certified copy, whether it has been prepared from the original of the document or from a copy of the document.
- (ix) To explore the possibility of making an endorsement of 'original seen and returned' on the copies on the record, originals of which are returned.
- (x) To ensure, that the certified copies are legible and wherever the original / copy on the record of the Registrar of Trade Marks has any colour other than black and white, the certified copy reflects such colour.
- (xi) To, if the documents of which certified copies is sought have been lost or misplaced, intimate the same to the applicant

within one month as aforesaid of the application for certified copy having been made.

12. Once the Registrar of Trade Marks has implemented the aforesaid, it is expected that neither will any of the parties to the litigation nor any of the Courts, where such litigations are pending, would mechanically issue summons to the Registrar of Trade Marks as witness, requiring it to produce records unless reasons are recorded as to why the purpose of summoning cannot be served by obtaining certified copies and tendering the same in evidence.

13. The counsel for the petitioner Registrar of Trade Marks states that for issuing “expedited certified copies” within the meaning of the Proviso to Rule 122 of the Trade Marks Rules, 2017 also, the procedure above shall be followed.

14. I may mention that Mr. S.K. Bansal counsel for the respondents no.3&4 in Civil Revision Petition No.146/2015 has during the hearing sought several other directions but which are beyond the scope of this Roster and the counsel / his client is free to avail of the appropriate remedies in that regard.

15. The petitioner Registrar of Trade Marks shall be at liberty to put up this order on the website of the Registrar of Trade Marks for compliance by all litigants and Advocates.

16. The counsel for the petitioner Registrar of Trade Marks states that the position in Civil Revision Petition No.29/2017 is the same.

17. The counsel for the respondents no.2&3 in C.R.P. No.29/2017 however states that the Registrar of Trade Marks was summoned in that case

for, inspite of a direction to file an Action Taken Report qua the matter of allowing the trade mark to proceed for registration without opposition filed thereto being disposed of, having not been filed.

18. The counsel for the petitioner Registrar of Trade Marks states that if the Court has any reason to summon the Registrar of Trade Marks and has recorded the said reason in the order of summoning, the Registrar of Trade Marks would be bound to appear. The counsel however states that the Action Taken Report on an application for registration or on an opposition is also recorded and certified copy thereof can be issued; it is stated that the respondents no.2&3, without even obtaining the certified copy of the Action Taken Report, sought to summon the Registrar of Trade Marks.

19. The counsel for the respondents no.2&3 in C.R.P. No.29/2017 states that the action was not taken.

20. It will be open to the Civil Court where the suit, from which C.R.P. No.29/2017 arises, is pending, to decide whether any need to summon the Registrar of Trade Marks arises.

The petitions are disposed of.

No costs.

A copy of this order be forwarded to Hon'ble the Chief Justice to consider the need if any for circulating the same to all the Courts within the supervisory jurisdiction of this Court.

RAJIV SAHAI ENDLAW, J.

JULY 31, 2017

'pp'..