



W.P.No.16151 of 2017

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 17.10.2022

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THE HON'BLE **MR.JUSTICE C.SARAVANAN**

W.P.No.16151 of 2017

and

M.P.Nos.17450 & 17452 of 2017

M/s.India Gate
Rep by its Managing Partner
Mr.Francis Kaliath
Palace Road, Thrissur,
Kerala – 680 001.

... Petitioner

Vs.

1.The Controller General of Patents, Designs
and Trademarks,
Office of Controller General of Patents, Designs
and Trademarks,
Boudhik Sampada Bhavan,
Antop Hill, S.M.Road, Mumbai – 400 037.

2.The Assistant Registrar of Trademarks,
The office of Trademark Registry,
Boudhik Sampada Bhawan,
G.S.T.Road, Guindy, Chennai – 600 032.

3.KRBL Ltd,
Rep by its Director,
No.5190, Lahori Gate,
New Delhi – 110 006.

... Respondents



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Prayer: Writ Petition filed under Article 226 of Constitution of India, for issuance of a Writ of Certiorarified Mandamus, to call for the records relating to order dated 23.02.2017 passed by the 2nd respondent in the matter of opposition No.MAS-241715 relating to trademark application No.1252763 cancelling the Trademark Registration of the mark “India Gate Restaurant” registered in favour the petitioner and quash the same as ultravires and illegal and consequently direct the 2nd respondent to hear the Rectification No.MAS-241715 on merits after rectifying the defect in the entry in the Register relating service description of the mark applied under No.1252763.

For Petitioner : Mr.A.K.Rajaraman

For Respondent : No Appearance

ORDER

There is no representation on behalf of the respondents.

2.This case is listed under the caption “for dismissal”. On the previous occasion, i.e, on 11.10.2022 there was no representation on behalf of the petitioner and the respondents. Today, when the case was taken up for hearing the learned counsel for the petitioner is present. No counter has been filed on behalf of the respondents.



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3.This writ petition has been filed for a certiorarified mandamus, to call for the records relating to order dated 23.02.2017 passed by the 2nd respondent in the matter of opposition No.MAS-241715 relating to trademark application No.1252763 cancelling the Trademark Registration of the mark “India Gate Restaurant” registered in favour of the petitioner and quash the same and consequently direct the 2nd respondent to hear the Rectification No.MAS-241715 on merits after rectifying the defect in the entry in the Register relating service description of the mark applied under No.1252763.

4.The facts on record indicates that the petitioner had filed a trade mark application on 02.12.2003 for registration of the Trademark “India Gate Restaurant” vide application No.1252763 in Class 42 in respect of “Pure Vegetarian Restaurant”. The 2nd respondent also appears to have granted registration to the petitioner on 19.05.2005 vide Trademark No.1252763 in respect of “Pure Vegetarian Restaurant” in Class 42.

5.The 3rd respondent filed an application for rectification of the register for the removal of the registered trade mark of the petitioner in Form TM-26 (in Triplicane) on 22.09.2006 stating that the same mark has been in use



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since 1993 continuously by them and that a similar application was filed by the 3rd respondent in class 30 vide T.M.No.846009 and that the said application was pending and was likely to be registered on completion of remaining formalities.

6.That apart, it was also stated that the mark which was registered in favour of the petitioner was non distinctive and therefore the registration granted in favour of the petitioner was liable to be removed and therefore trademark register was to be rectified. The 2nd respondent vide impugned order dated 23.02.2017 was allowed the application filed by the 3rd respondent.

7.The impugned order of the 2nd respondent has been challenged by the petitioner on the ground that before rectifying the register, the 2nd respondent should have obtained proper approval from the 1st respondent.

8.It is further submitted that in terms of Section 57(4) of Trade Marks Act, 1999, though the 2nd respondent is given power, however, before cancelling a certificate of registration, the discretion should have been



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properly exercised by the 2nd respondent.

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9.It is the further case of the petitioner that petitioner should not be deprived for valuable right in the trade mark “India Gate Restaurant” after having allowed to be use the mark for more than a decade.

10.It is further averred that the 3rd respondent has not stated at the time of presenting the application for rectification, the 3rd respondent has issued a letter to invoke the power of the registration under Section 57(4) of the Act and the registration ought not to have allowed the plea of the 3rd respondent at the time when the impugned order was passed.

11.Heard the learned counsel for the petitioner and also perused the affidavit filed in support of the present writ petition.

12.The aforesaid registration in TM.No.1252763 in Class 42 was granted to the petitioner on 19.09.2005 was rectified at the behest of the 3rd respondent on the strength of prior requisition of trademark “India Gate” in terms of the 3rd respondent in class 30 vide Trade Mark Office vide Trade



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Mark No.846009.

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13.It is noticed that an office circular has been issued by the Controller General of Patents, Designs and Trade Marks & GI on 08.06.2012 bearing No.CG/F/Order/2012-13/91 in Officer Order No.16 of 2012-13. The relevant portion of the said circular reads as under:-

“8.If the erroneous registration certificate has been generated in consequence of erroneous advertisement of the application having errors as to the trademark, proprietorship, statement as to use of the trademark, class or specification of goods or services (except spelling mistakes) jurisdiction, condition or limitation for acceptance/advertisement of the mark, the Section Incharge shall put up a note to the supervising office for suo moto cancellation of registration of the trademark by issuing notice under Section 57(4). The supervising officer shall seek approval from the CGPDTM for this purpose. If approval of the CGPDTM for issuing notice under Section 57(4) is received in writing the same shall be digitized and uploaded in the system to be integrated with other records of the application. The Section Incharge shall send the case to the Tribunal Section concerned for further action.”

14.The petitioner had an alternate remedy before the Intellectual Property Appellate Board (IPAB), Guindy. During the pendency of the present writ petition, the Intellectual Property Appellate Board (IPAB) has also been abolished. Prior to creation of the aforesaid Board, Trademark



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Appeals were entertained as TMA before this Court. The status quo prior to creation and abolition of Intellectual Property Appellate Board has now been restored back.

15.The impugned order reads as under:-

“This order will dispose of the notice issued under Section 57(4). A hearing was fixed on 19.12.2016 to decide the matter.

In the said case, the impugned mark was applied under application No.1252763 in Class-42 in respect of 'Pure Vegetarian Restaurant' and it was advertised in the Trade Marks Journal as 'Pure Vegetarian' only and the registration certificate was erroneously issued as 'Pure Vegetarian' by omitting the word 'Restaurant'. Subsequently, rectification was filed by M/s KRBL Limited, New Delhi under No.241715 requesting that the impugned registered trade mark INDIA GATE (label) with device of India Gate under No.1252763 in Class-42 is liable to be rectified on sole ground that the services applied by the Registered Proprietor in application on Form TM-1 was in respect of 'Pure Vegetarian Restaurant', whereas the trade mark published in the Trade Marks Journal was in respect of services 'PURE VEGETARIAN', which is totally wrong.

I have also verified from the record that as rightly pointed out by the petitioner's counsel the entry relating to the aforesaid registered trade mark has been wrongly remains on the Register of



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trade mark without sufficient cause, and therefore, a hearing under Section 57(4) was fixed to submit the original registration certificate on 19.12.2016 and the applicant's counsel has present for the hearing and has not submitted the original certificate and therefore, the following orders have been passed.

In view of the above, it is hereby ordered that the registration certificate issued to the applicant is hereby cancelled and the application under No.1252763 in Class-42 is to be re-advertised as 'PURE VEGETARIAN RESTAURANT' included in Class-42 as applied in TM-1 and the Tribunal Section is directed to take steps to re-advertise the mark. Consequently, the rectification under No.241715 is abated with no order as to costs.”

16.In the impugned order, there is no discussion on merits. A registered trade mark can be removed and the trade mark register rectified only after a proper discussion in the order.

17.Under these circumstances, the impugned order is liable to be set aside and remitted back to the 2nd respondent to pass afresh order on merits after hearing the petitioner and the 3rd respondent.



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18.It is made clear that appropriate order shall be passed after following principle of natural justice. It is also made clear that the Registration shall not be restored pursuant to this order to the file, unless orders are passed on merits by the 2nd respondent.

19.Considering the fact that the impugned order was passed on 23.02.2017 and considering the fact that the petitioner had filed the application for registration of the Trade Mark as early as 02.12.2003 which was registered on 19.09.2005, the 2nd respondent shall endeavour to pass final orders on merits and in accordance with law with the provisions of the Trade Marks Act read with rules within a period of six months from the date of receipt of a copy of this order.

20.This writ petition stands disposed of with the above observations.
No costs. Consequently, connected miscellaneous petitions are closed.

17.10.2022

Index : Yes/No
Internet : Yes/No
Speaking/Non-speaking Order
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C.SARAVANAN, J.

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