

Ashwini V

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
WRIT PETITION NO. 4061 OF 2022**

Nalli Chinnasami Chetty & Ors

...Petitioners

Versus

Department For Promotion & Ors

...Respondents

**Mr Ravindra Kadam, Senior Counsel, a/w Ms NS Nappinai i/b
Navin P Sachanandani for the Petitioners.**

**Mr DP Singh i/b Dhvani Jain i/b Ashish Mehta, for Respondent Nos.1
& 2.**

**Mr Murlidhar Khadilkar with Akash Joshi i/b Murlidhar Khadilkar,
for Respondent No.3.**

**CORAM G.S. Patel &
 Dr Neela Gokhale, JJ.**

DATED: 31st January 2023

PC:-

1. Rule. Affidavits have been filed. Rule is made returnable forthwith.

2. The petition lies in a narrow compass. The principal reliefs sought are in prayer clause (a)(i) to (a)(v) at pages 39 to 41. We are considering only prayer clauses (a)(i), (ii), (iii) and (iv). The dispute about the trade mark *Nalli*, famous in relation to sarees, is between the Petitioners and Respondent No.3. This trademark has been in

existence since 1935. The parties are also no strangers to litigation, including before this Court.

3. The 3rd Respondent has a competing business. It is Mumbai based. He filed an application for registration of a trademark for the label mark Nalli Silk Saree Center in class 24. The Petitioners filed an opposition to that application once it came to be advertised in the Trade Mark journal. By an order dated 2nd July 2008, the 2nd Respondent, the Registrar of Trade Marks dismissed the Petitioner's opposition and allowed the 3rd Respondent to use the label mark.

4. Petitioner No.1 filed an original appeal before the Intellectual Property Appellate Board ("**IPAB**") as it then stood. That Board has since been dissolved following the Tribunals Reforms (Rationalisation and Conditions of Service) Ordinance, 2021 and the subsequent enactment of the Tribunals Reforms Act 2021. All pending IPAB appeals are now transferred to the respective High Courts. In this High Court, they are before a Learned Single Judge to whom intellectual property matters are assigned by the roster. In the IPAB appeal, the 1st Petitioner filed a miscellaneous petition for interim reliefs seeking a stay on the 2nd July 2008 impugned order of the Assistant Registrar. One of the directions that the 1st Petitioner sought was to restrain the Assistant Registrar of Trade Marks from issuing the trade mark registration certificate pending the outcome of the appeal. The 3rd Respondent was served and appeared at various hearings before the IPAB. On 31st March 2009, the IPAB stayed the impugned order of 2nd July 2008. But it also

directed the Registrar not to issue the certificate of registration to the 3rd Respondent.

5. This is also where the real controversy is because it appears that by this time, i.e., 31st March 2009 the 2nd Respondent had *already* issued the certificate of registration. Respondent No.3 had in fact received the registration certificate even before IPAB passed its order on 31st March 2009. For reasons that are presently unclear — and we will not speculate— nobody seems to have told the IPAB that the registration certificate had already been issued, and, therefore, a direction to the Assistant Registrar not to issue the certificate was inappropriate and that relief would have had to be moulded.

6. This is all that the Petitioners seek today. The 3rd Respondent's affidavit accepts in paragraph 4(b) at page 124 says that prior to the order of the IPAB, the Registry had on 6th August 2008, already issued a trade mark certificate to the 3rd Respondent which was received on September 2008. The 3rd Respondent submitted that the 1st Petitioner's Miscellaneous Petition for stay before the IPAB was infructuous, but surely that begs the question. If the 3rd Respondent had the trade mark registration certificate, then it was duty bound to point this out to the IPAB and then to seek whatever order and to make whatever submissions it then thought appropriate in that regard. The Registrar is before us and also confirms the issuance of the certificate before the IPAB order.

7. There is no question that the 3rd Respondent was in fact represented before the IPAB. This is clear from the IPAB order itself. The actual direction of the IPAB includes an endorsement that the order of the IPAB should be uploaded so that the registration certificate “may not be issued as per orders of IPAB”.

8. We are told that while all this was going on the registration certificate came up for renewal and Registrar has in fact granted that renewal. The Registrar now accepts that this renewal was incorrect in view of the IPAB order and since the appeal before IPAB is still pending (now before a Learned Single Judge of this Court).

9. Hence, there is no question that Rule will have to be made absolute to the extent of the renewal of registration certificate. The petition succeeds to this extent and Rule is made absolute in the following terms:

- (a) The renewal certificate issued on 10th September 2013 is quashed and set aside.
- (b) There will also be an order in terms of prayer clause a(iv) set out about the pending of the final disposal of the IPAB.

10. We clarify that we have not expressed any opinion on the merits of the IPAB appeal. All contentions in that regard are expressly kept open.

(Dr Neela Gokhale, J)

(G. S. Patel, J)