



W.A.Nos.1458, 1455 & 1454 of 2023

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 10.07.2023

CORAM

THE HON'BLE MR.SANJAY V.GANGAPURWALA, CHIEF JUSTICE
AND
THE HON'BLE MR.JUSTICE P.D.AUDIKEVALU

W.A.Nos.1458, 1454 & 1455 of 2023

Umaid Mohonot
Bijay Singh Mohonot .. Appellants in
WA No.1458/23

Umaid Mohonot
Nikky Mohonot
Rep. By Power of Attorney
Bijay Singh Mohonot .. Appellants in
WA No.1454/23

Umaid Mohonot
Rep. By Constituted Attorney
Bijay Singh Mohonot .. Appellant in
WA No.1455/23

Vs.

1. Union of India
Through Secretary
Ministry of Industries
Udyog Bhavan
New Delhi.
2. Assistant Registrar of Trade Marks & GI
Trade Marks Registry
IP Building, GST Road, Guindy
Chennai 600 032.



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3. The Controller General of Patents
Designs & Trade Marks
Intellectual Property Bhavan
Near Antop Hill Head Post Office
S.M.Road, Antop Hill
Mumbai 400 037.

Respondents in
.. all W.As.

Prayer: Appeals filed under Clause 15 of the Letters Patent against the orders dated 10.03.2023 made in W.P.No.17349 of 2009, W.P.No.17351 of 2009 and W.P.No.17350 of 2009 respectively.

For the Appellants : Mr.Arun C.Mohan

For the Respondents : Mr.Rajesh Vivekanandan
Deputy Solicitor General of
India

JUDGMENT

(Delivered by the Hon'ble Chief Justice)

Heard Mr.Arun C.Mohan, learned counsel for the appellants and Mr.Rajesh Vivekanandan, Deputy Solicitor General of India for the respondents.

2. The appellants assail the order passed by the learned Single Judge thereby dismissing the writ petitions. The appellants had assailed the show cause notice issued to them by the Registrar



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3. The appellants have adopted the trade mark "Arrow" in the year 1994 for the manufacture and sale of Plastic Tag Pins and Plastic Tag Guns extensively. The same "Arrow" trade mark was further extended to manufacture and sale of "Textile Cleaning Spray Guns" in the year 1997. The trade mark of the appellants is registered under the provisions of the Trade Marks Act, 1999. The appellants are issued with a show cause notice stating that the registration of trade marks or device is preferable under the Central Government directions being the property of the Government of India. The learned Single Judge did not entertain the writ petitions on the ground that the appellants have been issued with a show cause notice and that the High Court would not adjudicate the disputed questions of fact under Article 226 of the Constitution.

4. Learned counsel for the appellant strenuously contends that the show cause notice can be assailed before this Court in exercise of its extraordinary jurisdiction under Article 226 of the

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Constitution, more particularly when the same has been issued without authority and or jurisdiction.

5. Learned counsel, relying upon the judgment of the Apex Court in the case of *Whirlpool Corporation v. Registrar of Trade Marks [(1998) 8 SCC 1]*, submits that if a particular proceeding is pending before the Registrar, any other proceeding, which may, in any way relate to the pending proceedings, 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.

6. Learned counsel for the appellants submits that at the



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relevant time, the matter was pending before the Delhi High Court in C.S.No.523 of 2009. It was filed by the appellants herein against Praveen Rai and others and the Chinese Company with regard to the same trade mark "Arrow". The matter was sub judice before the High Court of Delhi and the Delhi High Court, being the appellate authority, the Registrar ought to have not issued the show cause notice.

7. It is further submitted by learned counsel for the appellants that the matter was also pending before the Intellectual Property Appellate Board. The same was filed by the Chinese Company against the appellants under Sections 47, 57 and 125 of the Trade Marks Act relating to the same trade mark. In view of the judgment of the Apex Court in *Whirlpool* (supra), the Registrar could not have issued the impugned show cause notice.

8. Learned counsel also submits that the trade mark "Arrow" is not a prohibited trade mark under the list of trade marks as per the list detailed under the Trade Marks Act. The appellants could not



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have produced a negative evidence when the trade mark "Arrow" is not a prohibited trade mark and the dispute with regard to the said trade mark is already sub judice before this Court and the Appellate Authority, the Registrar ought not to have issued the show cause notice and this Court ought not to have exercised its extraordinary jurisdiction under Article 226 of the Constitution.

9. We have considered the submissions canvassed by learned counsel for the appellants, so also perused the order passed by the learned Single Judge.

10. The appellants are issued with the show cause notice on 27.07.2009 on the ground that the registration of trade mark or device is preferable under the Central Government directions being the property of Government of India. Therefore, the Entry relating to the aforesaid registered Trade mark has been made wrongly and remains with the registration of trade mark without sufficient cause. In view of that, show cause notice was issued referring to Section 57(4) of the Trade Marks Act, 1999.

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11. The jurisdiction of this Court to entertain a writ petition challenging the show cause notice is in a narrow compass. This Court would exercise its powers of judicial review under Article 226 of the Constitution in challenge to the show cause notice only if it is shown that the show cause notice has been issued by an authority without jurisdiction. Inter alia, by a person or authority coram non judice. It is not disputed that the Registrar who issued notice had necessary jurisdiction. The bone of contention is that as the dispute was already pending before the the Delhi High Court and the Intellectual Property Appellate Board, the Registrar could not have exercised its jurisdiction.

12. It needs to be considered that the civil suit before the Delhi High Court was filed by the appellants against the private parties seeking injunction restraining the defendants therein from dealing with their products in whatsoever manner under the trade mark "Arrow". So also, damages were claimed from the private parties. The dispute before the Intellectual Property Appellate Board was also between the private parties, that is the Chinese company

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13. Much reliance has been placed by learned counsel for the appellants on the judgment of the Apex Court in the case of *Whirlpool* (supra). Paragraph 62 of the said judgment reads thus:

“62. 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 the “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



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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 decisions on the same question by the Registrar and the High Court besides generating a multiplicity of proceedings.”

14. The Apex Court has held 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.

15. In the present case, the premise on which the show cause notice was issued is completely distinct from the inter se dispute between the appellants and the private parties. The contour of the contentions to be considered by the Registrar would be completely



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different. The show cause notice is based on facts alone. The dispute between the appellants and the private parties is pending before the Delhi High Court in civil suit and also pending before the Intellectual Property Appellate Board. The contents of the show cause notice and the dispute pending before the Intellectual Property Appellate Board and Delhi High Court would, in no manner, be considered the same or similar so as to divest the Registrar of his powers under Section 57(4) of the Trade Marks Act, 1999.

16. So far as the contention of learned counsel for the appellants that the trade mark "Arrow" is not shown in the prohibited list of the trade marks under the Act is concerned, it is a matter to be considered, on merits, by the Registrar. The appellants would always have liberty to put forth their stand before the Registrar, which stand, certainly the Registrar would consider on merits. It appears that the appellants have already submitted their stand to the show cause notice long back to the Registrar. We permit the appellants to submit additional stand if they choose, within 15 days, which shall also be considered by the Registrar on

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17. The appeals stand disposed of. There will be no order as to costs. Consequently, C.M.P.Nos.14100, 14079 and 14084 of 2023 are closed.

(S.V.G., CJ.) (P.D.A., J.)
10.07.2023

Index : Yes/No
Neutral Citation : Yes/No

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To

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