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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 11.12.2023

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

W.P(IPD)/30/2023

Asia Match Company Pvt. Ltd.,
Represented by its Director,
Boopathy Building, No.116(17/A),
Virudhunagar Road,
Sivakasi-626 123.

... Petitioner

-vs-

1.Deputy Registrar of Trade Marks & GI,
Trade Marks Registry,
Intellectual Property Office Building,
G.S.T.Road, Guindy,
Chennai-600 032.

2.P.Sundaram
Trading as Andal Match Works,
No.46, Bharathiyar Street,
Pichanoor Post, Gudiyattam-632 602.

... Respondents

PRAYER: Writ Petition (IPD) filed under Article 226 of the Constitution of India, pleased to issue a Writ of mandamus directing the first respondent to transfer the Rectification Petition No.269638



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pertaining to Trade Mark Application No.3958891 in Class 34 to this Court.

For Petitioner : Mr.K.Premchandrar
Mr.N.C.Vishal

For R1 : Mr.G.Baskaran, CGSC

For R2 : Mr.R.Pushkar
Ms.Priya

ORDER

By this writ petition, the petitioner seeks a direction to the 1st respondent to transfer Rectification Petition No.269638 pertaining to Trade Mark Application No.3958891 in Class 34 to this Court.

2. Learned counsel for the petitioner provided an overview of the dates and events relating to this case. He pointed out that Rectification Petition No.269638 was filed on 10.11.2020 by the writ petitioner before the Registrar of Trade Marks. Thereafter, a civil suit was filed before this Court in April 2021. The plaint was returned on the ground that this Court does not have territorial jurisdiction. Therefore, the civil suit was filed before the Principal District Court, Srivilliputhur in C.O.S.No.6 of 2022. He



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also pointed out that the 2nd respondent herein filed the written statement in the said suit. In such written statement, the defendant asserted that its trade mark is registered and that the plaintiff therein was not entitled to sue for infringement unless the registration is held to be invalid by the Registrar.

3. In the above facts and circumstances, learned counsel submits that Section 125(1) of the Trade Marks Act, 1999 (the Trade Marks Act) becomes applicable and that the rectification proceedings are liable to be transferred to this Court.

4. In response to these submissions, learned counsel for the 2nd respondent submits that sub-section (1) of Section 125 does not apply to a situation where the rectification petition was filed prior to the suit. In support of this contention, learned counsel refers to and relies upon the judgment of the Hon'ble Supreme Court in *Jagatjit Industries Limited v. Intellectual Property Appellate Board and others (Jagatjit Industries)*, (2016) 4 SCC 381. With specific reference to paragraphs 23 and 24 of the judgment, learned counsel submits that the Supreme Court made it clear that



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a rectification petition may be filed either before the Registrar or the High Court, if such petition is filed prior to the institution of the civil suit.

According to him, the said judgment applies squarely to this case and that, therefore, no case is made out to transfer the rectification petition to this Court. In this connection, he further submits that the pleadings are complete in the rectification petition and that all that remains is to proceed with arguments.

5. This case hinges on the interpretation of Section 125 of the Trade Marks Act. Section 125 is set out below:

“125. Application for rectification of register to be made to High Court in certain cases:

(1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register and,



notwithstanding anything contained in section 47 or section 57, such application shall be made to the High Court and not to the Registrar.

(2) Subject to the provisions of sub-section (1), where an application for rectification of the register is made to the Registrar under section 47 or section 57, the Registrar may, if he thinks fit, refer the application at any stage of the proceedings to the High Court.”

Sub Section (1) of Section 125 applies in two situations. The first of these is when the defendant in a suit for infringement questions the validity of registration of the plaintiff's trade mark. The second situation is where the defendant in a suit for infringement raises a defence on the basis of clause (e) of sub-section (2) of Section 30 by relying on the registration of such defendant. In both the above situations, if a rectification petition were to be filed subsequently, such rectification petition would only lie before the High Court and not before the Registrar. Therefore, learned counsel for the 2nd respondent is correct in submitting that sub-section (1) of Section 125 applies when the rectification petition is filed subsequent to the civil suit. The provision clearly prescribes that the rectification petition shall only be



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filed before the High Court in that situation.

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6. In the case at hand, the admitted factual position is that the rectification petition was filed prior to the filing of the civil suit. Undoubtedly, in such situation, both under Sections 47 and 57, the rectification petitioner has the option of filing the petition either before the Registrar or the High Court. It is this position which has been stated in paragraph 24 of *Jagatjit Industries*. The said paragraph 24 is set out below:

“24. The scheme under Section 124 is of great importance in understanding the scope of Section 125. It is clear that where proceedings for rectification of the register are pending before the filing of the suit for infringement in which the defendant pleads that the registration of the plaintiff's trade mark is invalid, such proceedings may be made either before the Registrar or before the Appellate Board, in view of Sections 57(1) and (2) of the Act. But, if rectification proceedings are to be instituted after the filing of such suit for infringement in which the defendant takes the plea that registration of the



plaintiff's trade mark is invalid, then rectification proceedings can only be taken before the Appellate Board and not before the Registrar."

7. Since the rectification petition was filed by the petitioner before the Registrar, the petitioner herein addressed the Registrar on 15.09.2023 and requested that Rectification Petition No.269638 be transferred. The petitioner did not receive a reply till date from the Registrar of Trade Marks in response to this request. Learned counsel for the Registrar of Trade Marks submits, on instructions, that the Registrar of Trade Marks is agreeable to transfer the rectification petition.

8. In a situation where the rectification petition was filed prior to the institution of the civil suit, sub-section (2) of Section 125 undoubtedly empowers the Registrar to transfer the application at any stage of the proceedings to the High Court. By referring to the pending civil suit, the petitioner made such request to the Registrar in September 2023. Especially in view of the fact that the final order made in the rectification proceeding is binding on the civil court in terms of sub-section (4) of Section 124 of the



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Trade Marks Act, in situations where a civil suit is pending, it is appropriate that the Registrar exercises discretionary power under sub-section (2) of Section 125 by acceding to a request for transfer. Therefore, this is a fit case to direct the Registrar to transfer the rectification petition.

9. For reasons set out above, WP(IPD)/30/2023 is allowed without any order as to costs by directing the Registrar of Trade Marks to transfer Rectification Petition No.269638 pertaining to Trade Mark Application No.3958891 in Class 34 to the file of this Court within a period of four weeks from the date of receipt of a copy of this order. Upon receipt of the rectification petition, the Registry is directed to renumber the same and list the petition for hearing, if in order.

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Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes / No

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SENTHILKUMAR RAMAMOORTHY,J

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