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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

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Date of Decision: 25th May, 2023

+ W.P.(C)-IPD 64/2021

TATA SIA AIRLINES LIMITED

..... Petitioner

Through: Mr. Pravin Anand, Ms. Kruttika Vijay, Mr. Aditya Gupta, Mr. Mukul Kochhar, Mr. Achuthan Sreekumar and Mr. Rohil Bansal, Advocates.

versus

UNION OF INDIA

..... Respondent

Through: Mr. Asheesh Jain, Central Government Standing Counsel with Mr. Keshav Mann and Mr. Gaurav Kumar, Advocates for Respondent/UOI.

Mr. Vaibhav Vutts, Advocate (*Amicus Curiae*) with Ms. Aamna Hasan, Advocate for INTA.

Mr. Hemant Singh, Advocate (*Amicus Curiae*) for AIPPL.

CORAM:

HON'BLE MS. JUSTICE JYOTI SINGH

JUDGEMENT

JYOTI SINGH, J.

C.M. APPL. 11/2022 (Exemption)

Allowed, subject to all just exceptions.

Application stands disposed of.

W.P.(C)-IPD 64/2021 & CM APPL. 47831/2019 and 10/2022

1. Present writ petition has been filed by the Petitioner seeking a writ of *mandamus* directing the Respondent to consider Petitioner's letter dated 23.08.2019 for inclusion of the trademark VISTARA® in the List of Well-Known Trademarks maintained by it, amongst other reliefs.

2. Factual expose to the extent relevant and captured in the writ petition is that the Petitioner is a joint venture between Tata Sons Private Limited and Singapore Airlines Limited, with Tata Sons holding majority stake of 51% in the Petitioner. It operates its full-service Airlines under the trademark VISTARA[®], both domestic and international and has a growing fleet of Aircrafts. On account of impeccable, excellent and efficient services provided, Petitioner's mark VISTARA[®] has become a widely recognized and trusted brand in travel and hospitality sectors in India. VISTARA[®] was adjudged as one of India's most promising brands in the year 2016. Several honours and awards have been earned by the Petitioner and its growing popularity and distinctiveness of the mark VISTARA[®] is evident from the sales turnover as well as substantial expenditure incurred on promotion and advertisements which illustratively, was to the tune of Rs. 33.73 crores for the Financial Year 2017-18.

3. On account of continuous and extensive use of the trademark VISTARA[®], the same has become synonymous with and is exclusively associated by the public with Petitioner's services. It was on 11.08.2014 that Petitioner announced its intention to use the trademark VISTARA[®] for its Airlines. Petitioner has obtained registrations for the trademark VISTARA[®] in multiple classes 12, 16, 18, 21, 25, 27, 28 and 39 and applications for registrations are pending in certain other classes. Petitioner has always been vigilant in protecting its statutory and common law rights in relation to its intellectual property and wherever required, injunction suits and oppositions have been filed against third-parties.

4. On 25.03.2019, Petitioner filed a suit titled ***TATA SIA Airlines Limited v. M/s. Pilot18 Aviation Book Store & Anr.,*** being CS(COMM) 156/2019 before this Court seeking injunction restraining

the Defendants therein from infringing the registered trademark



VISTARA® and device mark and passing off etc. Petitioner also sought declaration of the trademark VISTARA® as a well-known trademark as defined under Section 2(1)(zg) of the Trade Marks Act, 1999 (hereinafter referred to as the ‘Act’). On 05.08.2019, suit was decreed in favour of the Petitioner and trademark VISTARA® was declared as a well-known trademark, entitled to the highest degree of protection across all classes including against disparate products and services.

5. As the chronology of events goes, on 23.08.2019 Petitioner wrote to the Registrar of Trade Marks (hereinafter referred to as the “Registrar”), to consider the decree passed by this Court and consequently include the trademark VISTARA® in the List of Well-Known Trademarks, by virtue of the provisions of Section 11(8) of the Act. Petitioner was compelled to approach this Court on refusal of the Registrar to take the requisite action.

6. On 04.11.2019, notice was issued in the writ petition and after formulating the issue arising in the present petition as under, Respondent was directed to file an affidavit:-

“

The question is whether, once the Court has determined a trademark to be a well-known mark, the Petitioner is required to comply with Rule 124 of the Trademark Rules, and pay the requisite fee along with filing of form TM-M. The stand of the Petitioner is that once the Court has determined the mark to be well-known under Section 11(8), there ought to be no necessity to file form TM-M or to pay the fee for such determination and the declaration by the Registrar of Trademarks is merely a formality

....”

7. Vide the same order, the Court observed that it was appropriate to issue notices to the various Bodies representing the brand owners and IP Lawyers for filing *amicus* briefs and assist the Court as the issue concerned large number of trademark owners. Pursuant thereto, a few IP Associations filed their *amicus* briefs and arguments were heard by this Court on behalf of the Petitioner, learned *Amici curiae* representing INTA and AIPPI and counsel for the Registrar.

8. Arguing on behalf of the Petitioner, Mr. Pravin Anand, contended as follows:

- a. The intendment of Section 11(8) of the Act as well as the decree of declaration of the trademark as well-known trademark granted by this Court is rendered otiose by Registrar's refusal to accept the request of the Petitioner for inclusion of the trademark VISTARA® in the List of Well-Known Trademarks in the absence of an application filed in accordance with Rule 124(1) of the Trade Marks Rules, 2017 (hereinafter referred to as the '2017 Rules'). Scope and ambit of Rule 124(1) is plainly evident from the heading and language of the Rule that its applicability is restricted to a request by a proprietor for 'determination' of the trademark as a well-known trademark by the Registrar and relates to Section 11(6), (7) and (9) of the Act;
- b. Scheme of the Act unequivocally provides for two different and distinct authorities to recognize and/or determine a trademark to be a well-known trademark within the meaning of Section 2(1)(zg) of the Act i.e. the Court and the Registrar. Section 11(6), (7) and (9) of the Act enumerates the factors that the Registrar is required to consider while determining the status of the trademark. Two distinct words

‘determine’ and ‘consider’ have been used in Section 11(8) and each word must be interpreted as having distinct meaning to give effect to the apparent intention of the Legislature. ‘Determine’ has been judicially interpreted by the Supreme Court to mean, ‘expression of opinion which ends a controversy or a dispute by some Authority to whom it is submitted under valid law’, in contradistinction to ‘consider’ which is understood to mean ‘to regard as’ or ‘deem to be’. Section 11(6) and (7) enables the Registrar to determine the mark as a well-known trademark based on certain defined factors and parameters, while Section 11(8) by its clear and unambiguous language makes the Court’s determination of a mark being a well-known mark binding on the Registrar, who must consider it so and include the same in the List of Well-Known Trademarks, with no further questions or procedures;

- c. Respondent is *ad idem* with respect to the meaning of the term ‘determine’ as used in Section 11 of the Act and this is evident from a bare perusal of the List of Well-Known Trademarks maintained by the Respondent which under the header row specifies the ‘Determining Authority’ of a well-known mark and the List of Well-Known Trademarks itself includes decisions where the Court is the Determining Authority. The List would further show that prior to the coming into effect of 2017 Rules, in accordance with the Scheme of the Act, a total of 81 marks were included in the List, of which 66 marks were those which were determined to be well-known by the Indian Courts and 09 by the erstwhile IPAB (‘Intellectual Property Appellate Board’) and

each of these were included on written representations by the proprietors. The definition of well-known trademark within the meaning of Section 2(1)(zg) of the Act has also remained unchanged from 15.09.2003 when the Act was enacted. Therefore, the action of the Respondent in not including Petitioner's mark VISTARA® in the List of Well-Known Trademarks, determined to be so by this Court, is wholly arbitrary and against the provisions of the Act;

- d. Even after the notification of the 2017 Rules on 06.03.2017, Respondent has included 11 marks in the List of Well-Known Trademarks without any advertisement or publication such as MOTHER DAIRY etc. and for the reasons best known to the Registrar, only the trademark VISTARA® has been so far excluded from inclusion in the List;
- e. Plain reading of Rule 124(1) of 2017 Rules shows that the procedure envisaged therein will apply only to the determination of the trademark as well-known by the Registrar and in such a case request is to be filed under Form TM-M along with the prescribed fee as mentioned in the First and Second Schedules, accompanied by a statement of case along with all evidence and documents sought to be relied upon by the applicant, in support of the claim. This procedure will not apply to cases where the Registrar is required to 'consider' the trademark to be a well-known trademark based on a determination of a Court under Section 11(8), as in the case of the Petitioner. Rule 124 was introduced as part of 2017 Rules with an intention to fill-in the lacuna in the existing procedural framework i.e. to allow

a person to approach the Registrar for determination of its trademark in a non-adversarial proceeding. This Rule can neither take away the power of a Court to determine and declare the trademark as well-known nor can the Registrar sit as an Appellate Court to adjudicate/re-determine a decree or declaration by a Court;

- f. Stand of the Respondent taken before this Court that where the mark is already determined as a well-known trademark by a Court or Tribunal, the Registrar will only verify its correctness/authenticity and proceed to publish the same in Trade Marks Journal without inviting the objections as envisaged in Rule 124(4) of the 2017 Rules, but without dispensing the requirement of Form TM-M with prescribed fee of Rs.1,00,000/-, is completely fallacious and the Office Order No. 31 of 2018 dated 08.08.2018 is clearly contrary to the provisions of Section 11(8) of the Act. If this procedure is permitted then by necessary implication, Section 11(8) would be subject to Rule 124, which is against all rules of statutory interpretation;
- g. Failure of the Registrar to take on record the representation of the Petitioner dated 23.08.2019 annexing a copy of the judgment of this Court declaring the mark VISTARA® to be a well-known mark is causing insurmountable prejudice to the Petitioner. Inclusion of a mark in the List of Well-Known Trademarks is a constructive notice to any prospective Applicant about the width of the rights of the proprietor on such a mark and also aids the Registry in weeding out and rejecting application for identical/deceptively similar marks across disparate goods and

services. This is also depriving the Petitioner of the effective statutory protection of its trademark available under Section 11(2) and (10) of the Act. In fact with passage of the time, several deceptively similar marks have proceeded to the stage of advertisement in the Trade Marks Journal and Petitioner is unable to reap the fruits of the status of its mark;

- h. The First Schedule which enumerates the fee payable for inclusion in the List of Well-Known Trademarks specifically relates to the procedure set out under Rule 124. This is evident from the fact that the First Schedule was amended and Entry in relation to request for inclusion in the List was made in 2017, at the same time as the introduction of Rule 124. Language in Entry 18 in the First Schedule is 'Request to include the trademark in the List of Well-Known Marks' and likewise Second Schedule provides that Form TM-M can be *inter alia* used for 'Request for Inclusion of a Trademark in List of Well-Known Trademarks' and this language is not to be found in Section 11, demonstrating thereby that it has a direct co-relation to Rule 124(1). Further, Second Schedule only makes reference to Rule 124 and Entry 18 of the First Schedule but conspicuously omits to mention Section 11(8), which is a clear indication that Form TM-M relates to Rule 124 and not to inclusion after determination of the status of the mark by the Court;
- i. Section 11(8) is a mandatory provision as evident from the use of the word 'shall' and Registrar can exercise no discretion for inclusion of mark determined by the Court to be well-known and much less claim lack of any procedure or

form/fee to deny Petitioner's right for inclusion in the List of Well-Known Marks, his mark VISTARA.[®]

- j. Reliance was placed on the judgments in *CIT, Andhra Pradesh v. Taj Mahal Hotel, Secunderabad, (1971) 3 SCC 550* and *Radha Krishan v. Compensation Officer, Meja, Allahabad and others, 1953 SCC OnLine All 177*, for the proposition that Rules are meant for the purpose of carrying out provisions of an Act and they cannot take away what was conferred by the Act or whittle down its effect. Reliance was placed on the judgment in *International Society for Krishna Consciousness Bangalore (ISKCON) v. International Society for Krishna Consciousness (ISKCON) and Others, 2022 SCC OnLine Bom 1545*, to contend that the Registrar of Trade Marks is bound by the finding of a Court declaring a trademark to be a well-known trademark and cannot re-look into the matter as an Appellate Forum; and
- k. Reliance placed by the Respondent on the judgments in *Sreenivasa General Traders and Others v. State of Andhra Pradesh and Others, (1983) 4 SCC 353*, *Krishi Upaj Mandi Samiti and Others v. Orient Paper & Industries Ltd., (1995) 1 SCC 655* and *Dewan Chand Builders and Contractors v. Union of India and Others, (2012) 1 SCC 101*, is misplaced as the same are inapplicable. All these judgments are on the aspect of principle of proportionality of the Government fees charged in relation to the services rendered, which is not the issue raised here as the case of the Petitioner is that fee of Rs. 1,00,000/- is not payable since it

relates to requests filed under Rule 124 through the prescribed Form TM-M in the First and Second Schedules.

9. Mr. Hemant Singh and Mr. Vaibhav Vutts, learned *Amici curiae* made submissions as follows:

- a. Section 11(8) of the Act provides that where a trademark has been determined to be a well-known in at least one relevant section of the public in India by any Court 'or' Registrar, Registrar shall consider that trademark as a well-known trademark for registration under the Act. Even prior to the introduction of the 2017 Rules, Trade Marks Registry was competent to determine a mark to be a well-known trademark under Section 11 of the Act. The procedure for determination was introduced by a delegated legislation i.e. the Trade Marks (Applications and Appeals to the Intellectual Property Appellate Board) Rules, 2003, by way of Amendments made in 2017. The introduction was not to override or create a conflict with the scheme of determination provided under Section 11(8) of the Act. The factors required for declaring the trademark to be a well-known are the same whether it is by the Court or the Registrar and therefore once the Court adjudicates a trademark to be a well-known taking into account all the factors and parameters, it cannot be re-adjudicated by the Registrar in the garb of practice and procedure prescribed under Rule 124 of the 2017 Rules. At best, the Rule is only a supplemental procedure for recording of the mark as a well-known and including it in the List of Well-Known Trademarks as a purely administrative or ministerial act;

- b. Use of the word ‘shall’ in Section 11(8) of the Act leaves no room for further determination or deliberation by the Registrar as the provisions admit of no exception or discretion. If the stand of the Registrar that the procedure laid down in Rule 124 has to be mandatorily followed for inclusion of the mark in the List of Well-Known Trademarks despite a judicial determination of the mark, is accepted it would be contrary to the statutory scheme of the Act. The Act and the 2017 Rules provide for two distinct opportunities to determine a trademark to be well-known viz: by the Registrar or a Court and this would be covered under Section 11(8) ‘or’ by the Registrar on an application under Rule 124 in accordance with the procedure prescribed therein. The word ‘or’ means one of the two and not both and thus if either one has determined that the trademark as well-known, the other cannot re-start the process by insisting on a further procedure;
- c. Prior to the introduction of the 2017 Rules, proprietor of a mark had to wait for adversarial proceedings to conclude and secure a favourable declaration as to the well-known nature of his mark in such proceedings and then make a representation to the Trade Marks Registry armed with such a recordal requesting the mark to be included in the List of Well-Known Trademarks. In the lengthy procedure that followed a request was considered by a Committee set up for considering such requests, which would then process the request and if the representation and documents were in order, proceed to publish the same in the List. The aim and objective of introduction of the Rules was not to replace the

earlier regime but to reduce the dependency of the proprietor of the trademark on the institution of such adversarial proceedings and to give an opportunity to apply for recordal of the mark as well-known based on the documents and evidence supporting such claim. Therefore, Rule 124 is only supplementing Section 11(8) and providing an alternative path to a proprietor. This can be the only interpretation, if Section 11(8) of the Act and Rule 124 of the 2017 Rules are harmoniously construed. The very language of Rule 124(1) does not support the case of the Registrar as it provides that an application on Form TM-M and payment of fee under First Schedule is only required when request is made to the Registrar for 'determination' of a mark as a well-known trademark. As a corollary if a mark has already been declared as well-known by a Court, no determination is required to be made by the Registrar and hence there is no requirement of an application under Form TM-M and payment of fee. Registrar in his Affidavit dated 20.12.2019 filed in the present proceedings has admitted that when the proprietor of a mark has obtained a Court order, he cannot and shall not adjudicate upon the well-known nature of the mark but shall only process the mark for publishing in the Trade Marks Journal. Even in such a scenario, requiring the proprietor to follow the procedure as prescribed under Rule 124(1), particularly payment of fee prescribed, would defeat the whole purpose of the Court decree/declaration and render Section 11(8) of the Act redundant and otiose;

- d. Stand of the Registrar is also contrary to the Scheme of the Act, as no provision in the Act or the 2017 Rules provides

for payment of fee for the sole purpose of publishing the mark in the Trade Marks Journal. Rule 10(1) of the Rules provides that fees to be paid in respect of applications, oppositions, registration, renewal, expedited processing of application or any other matters in the Act and the Rules shall be that specified in the First Schedule. Additionally, Rule 11(2) of the Rules provides that any Form when filed at the Registry shall be accompanied by the prescribed fee. The First Schedule under the 2017 Rules mentions the fee to be paid for filing of various applications, requests, Forms etc., however, the payment of any fee for publication of a mark is conspicuously absent from the said Schedule. Therefore, it can be inferred that the intent of the Rule was to provide for payment of fee only while filing a Form, application or request but not for publication in the Trade Marks Journal. Therefore, the insistence of the Registrar on payment of fee for publication of a mark in the List of Well-Known Trademarks is totally misconceived and directly against the Scheme of the Act and the intent of the Rule;

- e. Reliance was placed on the judgment of the Supreme Court in *Salem Advocate Bar Association, T.N. v. Union of India, (2005) 6 SCC 344* to argue that the word 'shall' used in a statutory provision is itself not conclusive to determine whether the provision is mandatory or directory and this would be ascertained by the objective it serves and the design and context in which the provision is enacted. The word 'shall' is ordinarily indicative of mandatory nature of the provision but having regard to the context in which it is used or the intention of the legislation, the same can be

construed as directory. Rules of procedure are made to advance cause of justice and not defeat it and any strict interpretation in a given case could defeat justice;

- f. In order to emphasise on the point of hierarchy of statutory framework and aid the argument that the Registrar cannot have primacy over a Court's determination and/or Rule 124 will relate to Section 11(6), (7) and (9), but cannot override the powers of the Court to declare a trademark as a well-known mark, reliance was placed on the judgment in *Whirlpool Corporation v. Registrar of Trade Marks, Mumbai and Others, (1998) 8 SCC 1*, where the Supreme Court in the context of the Trade Marks Act, 1999 examined the powers of the Registrar and the Court and held that jurisdiction of both is mutually exclusive i.e. if a particular proceeding is pending before the Registrar, any other proceeding which in any way relates to the pending proceeding, will have to be initiated before the Registrar and the High Court will act as an Appellate Authority of the Registrar under Section 109 of the Act. Where proceedings are pending before the High Court, Registrar will keep his hands off and not touch those proceedings as the High Court, besides being the Appellate Authority of the Registrar, has primacy over the Registrar in all matters under the Act. Relying on *Indian Performing Rights Society Limited v. Sanjay Dalia and Another, (2015) 10 SCC 161*, it was urged that it is a settled proposition of law that provisions must be interpreted so as to prevent mischief and the points that must be kept in mind while interpreting a Statute are that the problem or mischief that the Statute was designed to

remedy should be first identified and the construction that suppresses the problem and advances the remedy should be adopted; and

- g. As an alternate, it is recommended that there should be two parallel processes for recordal of the mark as a well-known trademark: (a) on an application under Rule 124(1) requiring filling up of the Form TM-M with statement of case and affidavit along with reasonable fee; and (b) on a representation/letter of the proprietor who has a declaration of the mark as well-known by a Court.

10. Learned counsel appearing on behalf of the Registrar raised the following contentions:-

- a. Even in cases where determination has already been made by a Court declaring the mark of a proprietor to be a well-known trademark, requisite application under Form TM-M along with the prescribed fee of Rs.1,00,000/- has to be filed under Rule 124, enabling the Registrar to process the mark and publish it in the Trade Marks Journal for inclusion in the List of Well-Known Trademarks maintained by the Office of Registrar. However, the only difference in the procedure would be that when the application is moved and it is brought to the notice of the Registrar that a competent Court/Tribunal, on the basis of evidence led in the matter, has already determined the same as a well-known trademark, then the same would be directly published under Rule 124(5) of the 2017 Rules, without the necessity of going through the procedure prescribed under Rule 124(3) and (4). Rule 10(5) of the 2017 Rules clearly provides that any document filed without the prescribed fee shall be deemed not to have

been filed at all. Hence, despite declaration of the mark as well-known by this Court, Petitioner has to mandatorily file an application in the prescribed Form accompanied by the requisite fee to get the mark included in the List;

- b. By a Public Notice dated 22.05.2017, provisions of Rule 124 have been categorically explained along with the procedure to be followed in the circumstances such as in the present case and this position has been further amplified and reiterated in the Office Order No. 31 of 2018 dated 08.08.2018 filed before this Court on an affidavit. Intent of framers of the Rules is clear from reading of Clause (k) of Form TM-M and Entry 18 of the First Schedule, both of which refer to request for 'inclusion' and not 'determination' of the trademark alone;
- c. A plain reading of Rule 124(1) makes it clear that the Registrar is duty bound to follow the procedure and can include the trademark in the List of Well-Known Trademarks only when the requisite Form TM-M is filed and the requisite fee is paid. Use of the word 'shall' in sub-Rule (2) of Rule 124 makes it mandatory for the Registrar to take into account Section 11(6) to (9) of the Act while determining the trademark as well-known. Since the present case is covered by Section 11(8) of the Act, consequently, Registrar would straightaway include the trademark in the List of Well-Known Trademarks under Rule 124(5). Further, use of the words 'may' as opposed to 'shall' in sub-Rules (3) and (4) of Rule 124 is indicative of the intent behind the Rule that where determination has been made by a Court, the procedure prescribed in the sub-Rules may be dispensed

with. However, Registrar is duty bound to do some basic verifications, especially in view of the law laid down by this Court in *Verizon Trademark Services LLC & Ors. v. Mr. Parth Solanki & Anr.*, 2017 SCC OnLine Del 11623 and *Samsung Electronics Company Ltd. & Anr. v. M/s. D.R. Radio Corporation & Ors.*, 2017 SCC OnLine Del 11733;

- d. If the provisions of Section 11(8) read with Rule 124 were to be interpreted in a manner suggested by the Petitioner, Registrar would act on a mere letter or representation, without any verification including one relating to the authenticity of the certified copies supplied and this would reduce the office of the Registrar to a mere post-office, which could be detrimental to the interest of some proprietors in a given case. Even otherwise, there is no conflict between Rule 124 and the provisions of Section 11(6) to (9) of the Act as Rule 124 serves to provide a procedure to carry out and enforce the provisions of the Act. This position safely emerges from the provisions of Rule 124(2) which clarify that any determination by the Registrar has to be in accordance with Section 11(6) to (9) of the Act. Significantly, there is no challenge to the vires of Rule 124;
- e. Perusal of the Second Schedule to the Rule would show that the words used in Column 3 against Form TM-M are ‘Request for Inclusion of a Trademark in the List of Well-Known Marks’, as opposed to request for determination of the mark as a well-known mark. Perusal of entry (k) of Form TM-M would show that the words used are ‘request for inclusion of trademark in the List of well-known

marks Registration Certificate under Rule 124'. Therefore, irrespective of whether determination has been made by the Court or the Registrar is called upon to do so, any request for inclusion of the mark in the List has to be by filing the application in Form TM-M and paying the prescribed fee of Rs.1,00,000/-.

- f. The provision prescribing payment of requisite fee forms a part of the 2017 Rules, which are not challenged before this Court and secondly, it cannot be said that no services whatsoever are provided by the Trade Marks Office for inclusion of the mark in the List of Well-Known Trademarks where the determination has been made by a Court. Even after the determination of the mark as well-known mark by the Court, the Trade Marks Office is required to provide various other services such as publication in the Trade Marks Journal, inclusion in List of Well-Known Trademarks, maintaining records of such trademarks, providing inspection, dealing with objections, if any, received in future against such inclusion in the List, etc. All the services have a reasonable nexus with the purpose for which the fee has been prescribed in the First Schedule under Rule 124. Dealing with distinction between the concept of a Tax and a Fee, Courts have time and again rejected the contention that there must be actual and exact co-relation between the services rendered and the fee charged thereof. It is not possible to work out with a mathematical precision the amount of fee required for services rendered and/or collect the exact amount which could be stated to be sufficient for meeting the expenditure

incurred. Reliance was placed on the judgment in *Sreenivasa General Traders (supra)*, where the Supreme Court held that the traditional view that there must be actual ‘*quid pro quo*’ for a fee charged, has undergone a sea change. Power of a Legislature to levy fee is conditioned by the fact that there must by and large be a *quid pro quo* for the services rendered. However, relationship between levy of fee and services rendered is one of general character and cannot be determined with mathematical exactitude. All that is necessary is that there should be a reasonable connection between levy of fee and services rendered. This view has been reaffirmed in many decisions such as *Krishi Upaj Mandi Samiti (supra)* and *Dewan Chand Builders & Contractors (supra)*. Therefore, no infirmity can be found with the decision of the Registrar refusing to include trademark VISTARA® in the List of Well-Known Trademarks in the absence of a request being made on Form TM-M along with prescribed fee of Rs.1,00,000/-, under First Schedule to Rule 124(1).

11. I have heard learned counsels for the Petitioner and counsels for the Respondent as well as the *Amici Curiae* appointed by the Court.

12. It is an undisputed fact that Petitioner’s trademark VISTARA® has been declared as a well-known mark by this Court vide judgment dated 05.08.2019. The conundrum that is required to be resolved by this Court is whether once the Court has determined the trademark to be a well-known mark can the Petitioner be compelled to comply with Rule 124 and his request for inclusion of the mark in the List of Well-Known Trademarks can only be entertained when made on Form TM-M along with the prescribed fee and/or does Rule 124 come in

conflict with Section 11(8) of the Act, which is extracted hereunder for ready reference:

“11. Relative grounds for refusal of registration –

....

(8) Where a trade mark has been determined to be well known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.

.....”

13. A plain reading of Section 11(8) shows that the Legislature has consciously used two distinct words i.e. ‘determine’ and ‘consider’. Golden rule of interpretation is that the words of a Statute must be given their ordinary meaning. It is yet another rule of construction that when the words of the Statute are clear, plain and unambiguous, Courts are bound to give effect to that plain meaning, irrespective of the consequences. The use of the word ‘shall’ in Section 11(8) of the Act indubitably leaves not a speck of doubt that once the trademark has been determined to be a well-known mark at least in one relevant section of the public in India by any Court, there is no further scope for determination by the Registrar. Section 11(8) on a plain reading admits of no caveat or exception or any discretion with the Registrar, who is under a clear mandate to include the trademark determined by the Court as a well-known mark in the List of Well-Known Trademarks. Petitioner is right that in the scheme of hierarchy and in view of the unambiguous language of Section 11(8), Registrar cannot review or re-determine the status of a trademark declared to be well-known by a Court and is bound to proceed to publish in the List of Well-Known Trademarks.

14. Rule 124(1) introduced by way of 2017 Rules, provides that any person may request the Registrar for determination of a trademark as well-known and lays down the procedure to do so. A conjoint reading

of Section 11(8) of the Act and Rule 124(1) shows that the Scheme of the Act provides two different and distinct mechanisms for determination of a trademark to be a well-known mark viz. (a) by a Court or Registrar, which is covered by Section 11(8); and (b) by the Registrar on an application in accordance with the procedure prescribed under Rule 124 read with the relevant Schedules. This unambiguously connotes that either the Court or the Registrar can determine a trademark to be a well-known mark and it goes without saying that if either one of them has determined the trademark to be a well-known trademark, the other cannot and therefore no proprietor can be relegated to a second route. To this extent there is merit in the submissions of the Petitioner and *Amici Curiae*. Therefore, if the Court has declared a trademark to be a well-known trademark, then the Registrar is only required to include the said trademark in the List of Well-Known Trademarks and cannot enter into an exercise for re-determination and be it ingeminated that this position in law is not even disputed or contested by the Registrar. In fact, it is a conceded case of the Registrar, on an affidavit, that there shall not be a re-determination or re-examination of the trademark determined to be a well-known mark by a Court and the procedure will only include making a request in Form TM-M with the prescribed fee, which would be followed by requisite action under Rule 124(5), after verification of certified copy of the judgement of the Court and other administrative modalities, without resorting to the procedure prescribed under Rule 124(4).

15. Petitioner contends that Rule 124 is wholly inapplicable where a trademark declared to be well known by a Court is sought to be included in the List of Well-Known Trademarks, Registrar contends otherwise. Before embarking on deciding the issue emanating from

the present writ petition, it would be profitable to extract the relevant provisions of the Act and Rules for ready reference. ‘Well-known Trademark’ has been defined in Section 2(1)(zg) of the Act and is as follows:-

“2(1)(zg) “well-known trade mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.”

16. Section 11 of the Act provides relative grounds for refusal of registration. Sub-Sections (6), (7) and (9) enumerate the factors which are to be considered/not considered for determining whether a trademark is a well-known trademark. Sub-Section (8) provides that where a trademark has been determined to be well-known in at least one relevant section of the public in India by any Court or Registrar, the Registrar shall consider that trademark as a well-known trademark for registration under the Act. Sections 11(6) and (8) are extracted hereunder:-

“11. Relative grounds for refusal of registration –

(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

(i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;

(ii) the duration, extent and geographical area of any use of that trade mark;

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this

Act to the extent they reflect the use or recognition of the trade mark;

(v) the record of successful enforcement of the rights in that trade mark; in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

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(8) Where a trade mark has been determined to be well-known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.”

17. Rule 11(1) of 2017 Rules stipulates that the Forms set forth in the Second and Third Schedules shall be used in all cases to which they are applicable and may be modified as directed by the Registrar to meet other cases. Sub-Rule (2) prescribes that any Form when filed at the Trade Marks Registry shall be accompanied by prescribed fee. Rule 11(1) and (2) is as under:-

“11. Forms. — (1) The Forms set forth in the Second and the Third Schedules shall be used in all cases to which they are applicable and may be modified as directed by the Registrar to meet other cases.

(2) Any Form, when filed at the Trade Marks Registry, shall be accompanied by the prescribed fee.”

18. Rule 10(1) stipulates that the fees to be paid in respect of applications, oppositions, registrations, renewal, expedited processing of applications or any other matters under the Act and the Rules shall be those as specified in the First Schedule. Sub-Rule (2) provides that where in respect of any matter, fee is required to be paid under the Rules, the Forms/Applications/Request of the Applicant shall be accompanied by the prescribed fee and sub-Rule (5) further provides that where the document is filed without fee or with insufficient fee, such document shall be deemed not to have been filed for the purposes of any proceedings under these Rules. Rule 10(1), (2) and (5) is as follows:-

“10. Fees. — (1) *The fees to be paid in respect of applications, oppositions, registration, renewal, expedited processing of application or any other matters under the Act and the rules shall be those as specified in the First Schedule.*

(2) *Where in respect of any matter, a fee is required to be paid under the rules, the form or the application or the request of the petition thereof, it shall be accompanied by the prescribed fee.*

xxx xxx xxx

(5) *Where a fee is payable in respect of filing of a document and where the document is filed without fee or with insufficient fee, such document shall be deemed not to have been filed for the purposes of any proceedings under these rules.”*

19. Rule 124, which is really the bone of contention between the parties to the *lis*, is extracted hereunder for ready reference:-

“124. Determination of Well Known Trademark by Registrar.-

(1) *Any person may, on an application in Form TM-M and after payment of fee as mentioned in First schedule, request the Registrar for determination of a trademark as well-known. Such request shall be accompanied by a statement of case along with all the evidence and documents relied by the applicant in support of his claim.*

(2) *The Registrar shall, while determining the trademark as well-known take in to account the provisions of sub section (6) to (9) of section 11.*

(3) *For the purpose of determination, the Registrar may call such documents as he thinks fit.*

(4) *Before determining a trademark as well-known, the Registrar may invite objections from the general public to be filed within thirty days from the date of invitation of such objection.*

(5) *In case the trademark is determined as well-known, the same shall be published in the trademark Journal and included in the list of well-known trademarks maintained by the Registrar.*

(6) *The Registrar may, at any time, if it is found that a trademark has been erroneously or inadvertently included or is no longer justified to be in the list of well-known trademarks, remove the same from the list after providing due opportunity of hearing to the concerned party.”*

20. From a plain reading of the aforesaid provisions, it is luminously clear that a trademark can be determined as a well-known trademark either by a Court or by the Registrar. The factors/facts which the Registrar is obliged to consider while determining a

trademark to be a well-known trademark are enumerated and postulated in Section 11(6) and (7). Section 11(8) is in the nature of a mandatory provision, providing a deeming fiction that where a trademark has been determined to be a well-known in at least one relevant section of the public in India by any Court or Registrar, no further determination on this aspect would be done by the Registrar and the trademark shall be considered a well-known trademark and the Registrar must proceed for registration under the Act. Relevant it is note at this stage that the Section does not provide a mechanism/procedure to include the mark so declared in the List of Well-Known Trademarks and the dispute really transcends into the realm of Rule 124.

21. Broadly understood, Petitioner and the *Amici Curiae* contend that once a trademark is declared as a well-known trademark by the Court, the earlier procedure of a letter/representation must suffice as Rule 124 applies when an application is made for ‘determination’ of a trademark as a well-known trademark by the Registrar and for this strength was drawn from Section 11(8) and the ‘heading’ of Rule 124 which reads “Determination of Well Known Trademark by Registrar”.

22. It is trite that the heading of a Section or marginal note may be relied upon to clear any doubt or ambiguity on the interpretation of a statutory provision and to discern the legislative intent. However, when the Section is clear and unambiguous, there is no need to traverse beyond those words and the headings or marginal notes would not control the meaning of the body of the Section. [*Ref. Union of India and Another v. National Federation of the Blind and Others, (2013) 10 SCC 772*]. Earlier in *Raichurmatham Prabhakar*

and Another v. Rawatmal Dugar, (2004) 4 SCC 766, the Supreme Court had examined the said issue and held as follows:-

“14. The view is now settled that the headings or titles prefixed to sections or group of sections can be referred to in construing an Act of the legislature. But conflicting opinions have been expressed on the question as to what weight should be attached to the headings or titles. According to one view, the headings might be treated as preambles to the provisions following them so as to be regarded as giving the key to opening the mind of the draftsman of the clauses arranged thereunder. According to the other view, resort to heading can only be taken when the enacting words are ambiguous. They cannot control the meaning of plain words but they may explain ambiguities. (See Principles of Statutory Interpretation by Justice G.P. Singh, 9th Edn., 2004, pp. 152 and 155.) In our opinion, it is permissible to assign the heading or title of a section a limited role to play in the construction of statutes. They may be taken as very broad and general indicators of the nature of the subject-matter dealt with thereunder. The heading or title may also be taken as a condensed name assigned to indicate collectively the characteristics of the subject-matter dealt with by the enactment underneath; though the name would always be brief having its own limitations. In case of conflict between the plain language of the provision and the meaning of the heading or title, the heading or title would not control the meaning which is clearly and plainly discernible from the language of the provision thereunder.”

23. Rule 124 on a plain reading admits of no ambiguity and when holistically read, in my view, is not restricted to mere determination of a trademark as a well-known trademark and therefore the heading should not be taken as a guide to understand the import of the Rule. It is true that Rule 124(1) enables any person to make an application for determination of the trademark as well-known and while doing so, mandates the making of the application in Form TM-M and paying the fee prescribed in the First Schedule. Rule 124(2), however, requires the Registrar to take into account provisions of Section 11(6) to (9), which includes sub-Section (8). Therefore, an existing declaration of the trademark as well-known is bound to be taken into consideration. Further, sub-Rules (5) and (6) enable the Registrar to publish trademark in the Trade Marks Journal and include the same in the List

of Well-Known Trademarks or remove the same, if included erroneously. Contention of the Petitioner that Rule 124 is restricted in its scope and ambit only to determination of a trademark as well-known, is not well founded and deserves to be rejected. Provisions of the Rule include the procedure for examining if the mark is already declared as well-known and inclusion in the List of Well-Known Trademarks. Rule 124(5) does not differentiate between a trademark determined as well-known by the Court or by the Registrar and in both eventualities the procedures envisaged is the same and consciously the word 'Registrar' is omitted after the words 'in case the trademark is determined as well-known' and in the scheme of the Rule follows sub-Rule (2), where the examination may show that the mark has been determined as well-known by the Court. The purpose of Rule 124 was to streamline the procedure and bring uniformity and going by the language of the Rule, in my view, it cannot be restricted in its application to cases where request for 'inclusion' is made with respect to a trademark 'determined' as well-known by the Registrar under 124(1) and exclude inclusion where such a determination is by the Court.

24. The fear or apprehension that was repeatedly expressed was that the Registrar would re-determine the correctness of the well-known status of the trademark declared by the Court as an Appellate Authority in the garb of insisting on the procedure of filing the request for inclusion in Form TM-M with the fee, as also that with a declaratory decree of a Court, the proprietor cannot be burdened and compelled once again to undergo the long drawn procedure before the Registrar. The apprehensions are wholly unfounded and baseless. During the course of hearing, counsel for the Registrar had reiterated the position taken in the additional affidavit predicated on an Office

Order No. 31 of 2018 dated 08.08.2018, that if during the determination process it is found that the trademark has been determined as a well-known trademark by a competent Court or Registrar then following the mandate under Section 11(8), the mark shall proceed for publication in Trade Marks Journal directly under Rule 124(5). Relevant part of the Office Order is as follows:-

“CG/Office Order/TMR/2018/42

Data:08/08/2018

Office Order No. 31 of 2018

In view of streamlining the processing of application filed under rule 124 of TM Rules, 2017 for inclusion of a trademark in the list of well-Known trademark maintained by the Registrar of Trade Marks, it has been decided to establish a dedicated Section for processing of such applications at Trade Marks Registry, Mumbai.

These applications shall be processed as per procedure mentioned below:

.....

Provided that if it is found by the Tribunal that the mark is already determined as a well-known trademark by a competent Court or Tribunal, the same shall proceed for publication in TM Journal directly under rule 125 (5) of the rules.”

25. It is thus clear that there is no ambiguity or dichotomy on the procedure that the Registrar of a trademark shall follow for including the well-known trademark in the List of Well-Known Trademarks in a case where it stands determined and declared as a well-known trademark by any Court or Tribunal and in which case the trademark shall proceed towards publication in the Trade Marks Journal and inclusion in the List of Well-Known Trademarks under Rule 124(5) *albeit* it may be noted that on account of a typographical error, Rule 124(5) has been erroneously mentioned as Rule 125(5) in the Office Order No.31 of 2018. The Registrar will not and cannot review the judgement of the Court and this position is well understood and conveyed to the environment and stakeholders by issuing the aforementioned Office Order.

26. Relevant would it be to note that the procedure detailed in the Office Order is only clarificatory as this principle has its genesis in Rule 124(2), which emphasises the mandate of the Registrar stipulated under sub-Sections (8) of Section 11 that when an application is received from any person for determining the trademark as well-known, the Registrar will first examine if the trademark stands determined as well-known and if so, the procedure prescribed for calling documents, inviting objections from the general public, etc. in sub-Rule (4) will not be followed and instead the trademark shall be published in the Trade Marks Journal and included in the List of Well-Known Trademarks under Rule 124(5). Rule 124(2) by its plain reading admits of no other interpretation and there is no ambiguity on two aspects i.e. Rule 124 is not limited to determination alone and the Registrar will not re-determine the status of a trademark declared as well-known by a Court or Tribunal. The additional affidavit clearly brings out that verification would be limited to procedural aspects such as checking the authenticity of the certified copy of the judgement etc. and no more.

27. In light of the rival contentions the next question that begs an answer is if there is any conflict between Section 11(8) of the Act and Rule 124. Section 11(8) on a plain reading contains a deeming fiction that once a trademark is determined to be well-known by the Court, it will be considered so by the Registrar. Rule 124 provides the procedure for 'determination', where the trademark is not already declared as well-known as also for its inclusion in the List of Well-Known Trademarks, after determination. The Rule is 'procedural' in nature and by a plain reading admits of no ambiguity or conflict. In my view, Rule 124 applies at two distinct stages: (a) determination of the trademark as well-known by the Registrar; and (b) publication and

inclusion in the List of Well-Known Trademarks under Rule 124(5). At the cost of repetition, reading of Rule 124(2) with Rule 124(5) shows that the second stage is not limited to inclusion of a mark determined by the Registrar under sub-Rule (1) but also envisions and includes a trademark determined by the Court and thus the procedure prescribed therein including applying in Form TM-M and the fee cannot be excluded. Rule 124 must be read as a whole and full meaning must be given to all the words used therein. Section 11(8) or any other provision of the Act does not provide for the procedure/mechanism for publication and inclusion and the field is open. Therefore, the Rules can fill in the gap and in fact the very purpose of framing Rule 124 was to streamline the procedure for determination of a trademark as well-known by the Registrar as an alternate by a non-adversarial mechanism and also its publication and inclusion in the List. There is no conflict between Section 11(8) and Rule 124 and both operate in two different fields, one stipulating a deeming fiction and the other providing a procedure for enforcement of Section 11.

28. Golden Rule of Interpretation of a Statute is that it has to be given its literal and natural meaning and intention of the Legislature must be seen from the language employed in the Statute itself. The question is not what is supposed to have been intended but what is stated. [Ref. *Dayal Singh and Others v. Union of India and Others*, (2003) 2 SCC 593]. Two principles of construction i.e. *casus omissus* and reading the Statute as a whole, are fairly well-settled. In this context, I may refer to the judgment of the Supreme Court in *Union of India and Others v. Dharamendra Textile Processors and Others*, C.A. No. 005893-005893/2008, decided on 29.09.2008, where

principles have been summarised on almost all aspects relating to interpretation of Statutes and the relevant passages are as under:-

“13. It is a well-settled principle in law that the court cannot read anything into a statutory provision or a stipulated condition which is plain and unambiguous. A statute is an edict of the legislature. The language employed in a statute is the determinative factor of legislative intent. Similar is the position for conditions stipulated in advertisements.

14. Words and phrases are symbols that stimulate mental references to referents. The object of interpreting a statute is to ascertain the intention of the legislature enacting it. (See Institute of Chartered Accountants of India v. Price Waterhouse 1977 6 SCC 312). The intention of the legislature is primarily to be gathered from the language used, which means that attention should be paid to what has been said as also to what has not been said. As a consequence, a construction which requires for its support, addition or substitution of words or which results in rejection of words as meaningless has to be avoided. As observed in Crawford v. Spooner (1846) 6 MOO PC1, the courts cannot aid the legislature’s defective phrasing of an Act, they cannot add or mend, and by construction make up deficiencies which are left there. (See State of Gujarat v. Dilipbhai Nathjibhai Patel 1998 (3) SCC 234). It is contrary to all rules of construction to read words into an Act unless it is absolutely necessary to do so. [See Stock v. Frank Jones (Tipton) Ltd 1978 (1) ALL ER 948.] Rules of interpretation do not permit the courts to do so, unless the provision as it stands is meaningless or of doubtful meaning. The courts are not entitled to read words into an Act of Parliament unless clear reason for it is to be found within the four corners of the Act itself. (Per Lord Loreburn, L.C. in Vickers Sons”)

15. The question is not what may be supposed and has been intended but what has been said. “Statutes should be construed not as theorems of Euclid”, Judge Learned Hand said, “but words must be construed with some imagination of the purposes which lie behind them”. (See Lenigh Valley Coal Co. v. Yensavage 218 FR 547) The view was reiterated in Union of India v. Filip Tiago De Gama of Vedem Vasco De Gama (1990) 1 SCC 277 (SCC p. 284, para 16).

16. In D.R. Venkatachalam v. Dy. Transport Commr. (1977) 2 SCC 273, it was observed that the courts must avoid the danger of a priori determination of the meaning of a provision based on their own preconceived notions of ideological structure or scheme into which the provision to be interpreted is somewhat fitted. They are not entitled to usurp legislative function under the disguise of interpretation.

17. While interpreting a provision the court only interprets the law and cannot legislate it. If a provision of law is misused and subjected to the abuse of process of law, it is for the legislature to amend, modify or repeal it, if deemed necessary. (See CST v.

Popular Trading Co. (2000) 5 SCC 511) The legislative casus omissus cannot be supplied by judicial interpretative process.

18. Two principles of construction - one relating to casus omissus and the other in regard to reading the statute as a whole, appear to be well settled. Under the first principle a casus omissus cannot be supplied by the court except in the case of clear necessity and when reason for it is found in the four corners of the statute itself but at the same time a casus omissus should not be readily inferred and for that purpose all the parts of a statute or section must be construed together and every clause of a section should be construed with reference to the context and other clauses thereof so that the construction to be put on a particular provision makes a consistent enactment of the whole statute. This would be more so if literal construction of a particular clause leads to manifestly absurd or anomalous results which could not have been intended by the legislature. "An intention to produce an unreasonable result", said Danckwerts, L.J. in *Artemiou v. Procopiou* (1965) 3 ALL ER 539 (All ER p. 544 I) "is not to be imputed to a statute if there is some other construction available". Where to apply words literally would "defeat the obvious intention of the legislation and produce a wholly unreasonable result", we must "do some violence to the words" and so achieve that obvious intention and produce a rational construction. [Per Lord Reid in *Luke v. IRC* (1963) AC 557 where at AC p. 577 he also observed: (All ER p.664 I) "This is not a new problem, though our standard of drafting is such.

19. It is then true that:

"When the words of a law extend not to an inconvenience rarely happening, but due to those which often happen, it is good reason not to strain the words further than they reach, by saying it is casus omissus, and that the law intended quae frequentius accidunt."

"But", on the other hand,

"it is no reason, when the words of a law do enough extend to an inconvenience seldom happening, that they should not extend to it as well as if it happened more frequently, because it happens but seldom". (See Fenton v. Hampton (1858) 11 MOO PC 347).

20. A casus omissus ought not to be created by interpretation, save in some case of strong necessity. Where, however, a casus omissus does really occur, either through the inadvertence of the legislature, or on the principle quod enim semel aut bis existit praetereunt legislatores, the rule is that the particular case, thus left unprovided for, must be disposed of according to the law as it existed before such statute - casus omissus et oblivioni datus dispositioni communis juris relinquitur; "a casus omissus", observed Buller, J. in *Jones v. Smart* 1785 (1) TR 44:99 ER 963 (ER p. 967) "can in no case be supplied by a court of law, for that would be to make laws". The principles were examined in detail in *Maulavi*

Hussein Haji Abraham Umarji v. State of Gujarat (2004 (6) SCC 672).

21. *The golden rule for construing all written instruments has been thus stated:*

“The grammatical and ordinary sense of the words is to be adhered to unless that would lead to some absurdity or some repugnance or inconsistency with the rest of the instrument, in which case the grammatical and ordinary sense of the words may be modified, so as to avoid that absurdity and inconsistency, but no further.” (See Grey v. Pearson.)

22. *The latter part of this “golden rule” must, however, be applied with much caution. “If”, remarked Jervis, C.J.,*

“the precise words used are plain and unambiguous, in our judgment, we are bound to construe them in their ordinary sense, even though it do lead, in our view of the case, to an absurdity or manifest injustice. Words may be modified or varied, where their import is doubtful or obscure. But we assume the functions of legislators when we depart from the ordinary meaning of the precise words used, merely, because we see, or fancy we see, an absurdity or manifest injustice from an adherence to their literal meaning”. (See Abley v. Dale, ER p.525)

23. *The above position was highlighted in Sangeeta Singh v. Union of India and Ors. (2005 (7) SCC 484). ”*

29. Reference may also be made to the judgment of the Supreme Court in ***Illachi Devi (Dead) by LRs. And Others v. Jain Society, Protection of Orphans India and Others, (2003) 8 SCC 413***, relevant passages of which are as follows:-

“34. It is a well-known principle of construction of statutes that all words employed therein must be given their full meaning unless the same results in absurdity. In Gurudevdatto VKSSS Maryadit v. State of Maharashtra [(2001) 4 SCC 534] it has been held : (SCC pp. 552-53, para 26)

“26. Further we wish to clarify that it is a cardinal principle of interpretation of statute that the words of a statute must be understood in their natural, ordinary or popular sense and construed according to their grammatical meaning, unless such construction leads to some absurdity or unless there is something in the context or in the object of the statute to suggest to the contrary. The golden rule is that the words of a statute must prima facie be given their ordinary meaning. It is yet another rule of construction that when the words of the statute are clear, plain and unambiguous, then the courts are bound to give effect to that meaning, irrespective of the consequences. It

is said that the words themselves best declare the intention of the law-giver.”

35. *In Sutters v. Briggs [(1922) 1 AC 1 : 91 LJ KB 1 : 125 LT 737 (HL)] the Privy Council held:*

“There is indeed no reason for limiting the natural and ordinary meaning of the words used. The term ‘holders or indorsees’ means any holder and any indorsee, whether the holder be the original payee or a mere agent for him, and the rights of the drawer must be construed accordingly. The circumstance that the law apart from the section in question was repealed in 1845, without any repeal of the section itself, may lead to anomalies, but cannot have weight in construing the section.”

30. *In Nasiruddin and Others v. Sita Ram Agarwal, (2003) 2 SCC 577*, the Supreme Court held as under:-

“35. In a case where the statutory provision is plain and unambiguous, the court shall not interpret the same in a different manner, only because of harsh consequences arising therefrom.....

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37. The court's jurisdiction to interpret a statute can be invoked when the same is ambiguous. It is well known that in a given case the court can iron out the fabric but it cannot change the texture of the fabric. It cannot enlarge the scope of legislation or intention when the language of the provision is plain and unambiguous. It cannot add or subtract words to a statute or read something into it which is not there. It cannot rewrite or recast legislation. It is also necessary to determine that there exists a presumption that the legislature has not used any superfluous words. It is well settled that the real intention of the legislation must be gathered from the language used..... But the intention of the legislature must be found out from the scheme of the Act.....”

31. *In State of Jharkhand and Another v. Govind Singh, (2005) 10 SCC 437*, the Supreme Court held that Statute is an edict of Legislature and the elementary principles for interpreting or constructing a Statute is to gather the *mens or sententia legis* of the Legislature. Where there is no obscurity, ambiguity and the intention of the Legislature is clearly conveyed, there is no scope for the Court to innovate or take upon itself the task of amending or altering statutory provisions. The Courts must remember that there is a line, though thin, which separates adjudication from legislation and that

line should not be crossed or erased. This can be vouchsafed by “an alert recognition of the necessity not to cross it and instinctive, as well as train reluctance to do so”.

32. In *Visitor, AMU and Others v. K.S. Misra*, (2007) 8 SCC 593, the Supreme Court observed as under:-

“13. It is well-settled principle of interpretation of the statute that it is incumbent upon the court to avoid a construction, if reasonably permissible on the language, which will render a part of the statute devoid of any meaning or application. The courts always presume that the legislature inserted every part thereof for a purpose and the legislative intent is that every part of the statute should have effect. The legislature is deemed not to waste its words or to say anything in vain and a construction which attributes redundancy to the legislature will not be accepted except for compelling reasons. It is not a sound principle of construction to brush aside words in a statute as being inapposite surplusage, if they can have appropriate application in circumstances conceivably within the contemplation of the statute.”

33. It would be useful to refer to two passages from the judgment of *Mohd. Shahabuddin v. State of Bihar and Others*, (2010) 4 SCC 653, where the Supreme Court held that –

*“179. Even otherwise, it is a well-settled principle in law that the court cannot read anything into a statutory provision which is plain and unambiguous. The language employed in a statute is a determinative factor of the legislative intent. If the language of the enactment is clear and unambiguous, it would not be proper for the courts to add any words thereto and evolve some legislative intent, not found in the statute. Reference in this regard may be made to a recent decision of this Court in *Ansal Properties & Industries Ltd. v. State of Haryana* [(2009) 3 SCC 553].*

180. Further, it is a well-established principle of statutory interpretation that the legislature is specially precise and careful in its choice of language. Thus, if a statutory provision is enacted by the legislature, which prescribes a condition at one place but not at some other place in the same provision, the only reasonable interpretation which can be resorted to by the courts is that such was the intention of the legislature and that the provision was consciously enacted in that manner. In such cases, it will be wrong to presume that such omission was inadvertent or that by incorporating the condition at one place in the provision the legislature also intended the condition to be applied at some other place in that provision.”

34. On the question whether a Statute is mandatory or directory, **Crawford** on “Statutory Construction” (Ed. 1940, Art. 261, p. 516) stated as follows:-

“The question as to whether a statute is mandatory or directory depends upon the intent of the legislature and not upon the language in which the intent is clothed. The meaning and intention of the legislature must govern, and these are to be ascertained, not only from the phraseology of the provision, but also by considering its nature, its design, and the consequences which would follow from construing it the one way or the other.”

35. From a reading of the above judgments, it is clear that it is well-settled as a canon of construction that Statute must be read as a whole and in its context. Statute is an edict of Legislature and the Courts must not cross the thin line between interpretation and adjudication and legislation. It is also palpably clear that only because the implementation of a Statute results in harsh or inconvenient consequences, where the provision is plain and unambiguous, the Courts should not give a different interpretation.

36. Testing the arguments of the Petitioner in light of the principles enunciated for interpretation, this Court finds that there is no conflict between the provisions of Section 11(8) and Rule 124 is an enabling provision for enforcing and giving effect to Section 11(8) after the trademark has been declared to be well-known by a judicial order. Legislature while enacting Section 11(8) has proscribed the Registrar from re-determining a trademark already declared as well-known by a Court/Registrar and does not deal with the procedure or mechanism for determination or publication or inclusion of the trademark, which is separately provided for in Rule 124 read with the Schedules. It is thus held that even where a trademark is declared to be a well-known trademark by the Court, Rule 124 will apply with respect to the procedure for publication and inclusion, save and except, calling for

documents and inviting objections under sub-Rules (4) and (5) thereof. This interpretation based on plain reading of both provisions will further the object of 2017 Rules.

37. The interpretation is fortified by reading the entire scheme of the 2017 Rules along with the First and Second Schedules thereto. In Rule 11(1), the word used is “shall” and the mandate is that the Forms set forth in the Second and Third Schedules shall be used in all cases, to which they are applicable. Second Schedule relates to ‘Forms’ and against TM-M in Column-2 under the heading ‘Section and Rules of the Act & Rules’, Rule 124 is mentioned. Column-3 deals with ‘Title for which form may be used’ under which there is a clear reference to ‘Request to inclusion of a mark in List of well-known trademarks’. Therefore, when Column-3 is read with Rule 11, the inescapable conclusion is that even for a request to include a trademark in the List of Well-Known Trademarks, Form TM-M is mandatory. This is further fortified on a perusal of Form TM-M which is divided in three parts, i.e. A, B and C. Parts A and C are required to be filled compulsorily, which is annotated in the Form itself. Going to Part B, the same concerns ‘Purpose of request’ and entry ‘k’ reads as under:-

k	Request for inclusion of Trademark in the list of Well-Known Trademarks Registration Certificate under rule 124	Representation of the Mark (paste here)	Fee in Rs.
	Is requested mark is registered with Trademark Registry, India – If Yes (details there off)		

38. Rules have been framed by the Central Government in exercise of powers conferred by Section 157 of the Act and the Schedules thereto are a part of the Rules and have a binding force. Schedules do not recognise a segregation in Forms, one for determination and other

for inclusion and instead provide that for ‘inclusion’ of the well-known mark in the List of such marks, Form TM-M shall be filed. The legal position of Schedules vis-à-vis the position of the Statute is settled and reference can be profitably made to the judgment of the Andhra Pradesh High Court in ***Siva Krishna Wines, Cuddapah District v. Commissioner of Prohibition and Excise, Andhra Pradesh, Hyderabad and others, 2008 SCC OnLine AP 689***, wherein the Court places reliance on *G.P. Singh’s ‘Principles of Statutory Interpretation’ (Tenth Edition, 2006)*, which is as follows:-

“Schedules appended to statutes form part of the statute. They are added towards the end and their use is made to avoid encumbering the sections in the statute with matters of excessive detail. They often contain details and forms for working out the policy underlying the sections of the statute, and at times they contain transitory provisions which remain in force till the main provisions of the statute are brought into operation. Occasionally they contain such rules and forms which can be suitably amended according to local or changing conditions by process simpler than the normal one required for amending other parts of the statute. The division of a statute into sections and Schedules is a mere matter of convenience and a Schedule therefore may contain substantive enactment which may even go beyond the scope of a section to which the Schedule may appear to be connected by its heading. In such a case a clear positive provision in a Schedule may be held to prevail over the prima facie indication furnished by its heading and the purpose of the Schedule contained in the Act. However, if the language is not so clear, the provision in the Schedule may be construed as confined to the purpose indicated by its heading and the section in the statute to which it appears connected. In case of conflict between the body of the Act and the Schedule the former prevails.”

39. Coming now to the next and most contentious issue in the matter i.e. the prescribed fee of Rs.1,00,000/- required to be deposited along with Form TM-M. I have already held above that Rule 124 would apply for inclusion of a trademark declared as well-known by the Court with respect to the procedure, with the caveat penned earlier. In the regime of payment of fee, Rules 10 and 11 as well as First and Second Schedules to the 2017 Rules are relevant. Purposes for which

applications can be made under the Act are enumerated in Rule 10 such as oppositions, registration, renewal, expedited processing of application and or any other matters under the Act and the Rules are those specified in the First Schedule. The expression ‘any other matters under the Act’ will take its colour from the words preceding thereto and will include an application for inclusion of a mark in the List of Well-Known Trademarks. This interpretation is fortified by First Schedule to Rule 11 and entry 18 therein which reads as follows:-

Entry No.	On what payable	Amount in INR.	
		For Physical filing	For E-filing
18	Request to include a trademark in the list of well-known trademark <i>(Note: applicable fee is for one mark only.)</i>	Not allowed	1,00,000

40. The framers of the Rule have carefully used the words ‘Request for inclusion of a Trademark’ and not ‘determination’ of a trademark. When Entry 18 of First Schedule is read with Rule 10(1), (2), (5) and Rule 11(2), there can be no doubt that: (a) the fee of Rs.1,00,000/- is prescribed not just for determination of the trademark but for inclusion of the trademark in the List of Well-Known Trademarks; and (b) deposit of fee is mandatory and failure to deposit the fee prescribed or even where the deposit is of insufficient fee, consequence that the document shall be deemed not to have been filed for the purposes of any proceeding under 2017 Rules, will follow. This Court, therefore, cannot read or interpret the provisions of Rule 124 in the manner Petitioner reads it so to hold that fee is required to be deposited only when an application is made under Rule 124(1) for determination of a trademark as a well-known trademark by the Registrar.

41. An argument was also raised by the Petitioner and the *Amici Curiae* that once the trademark has been declared as well-known, then nothing remains for the Registrar to do in the process of inclusion of the trademark and in the absence of a complete *quid pro quo*, fee of Rs.1,00,000/- is wholly unjustified. I am afraid that this Court cannot enter into the exercise of testing the prescribed fee on the yardstick of quantum of work required to be done by the Registrar, more so in the absence of challenge to any Rule and in view of the fact that the Schedule provides fee for 'inclusion' without any further segregation. This would be an interpretation totally in the teeth of interpretation of a Rule or Schedule applying the analogy of interpretation of Statute. It is not in the domain of this Court in a writ jurisdiction to assess the volume of work that would be required for the purpose of publication and inclusion of the well-known trademark in the List or subsequently in maintaining the register or other related and incidental work and decide on a scale of 01 to 10, the proportionate or commensurate fee structure. Fee is already prescribed in the First Schedule and this Court finds no reason to interfere and hold that the Registrar shall entertain an application for inclusion of well-known trademark in the List maintained by it without following the procedure to apply in Form TM-M with the prescribed fee.

42. Learned Counsel for the Respondent was right in putting forth that dealing with the distinction between Tax and Fee, Courts have repeatedly rejected the contention that there must be actual and exact co-relation between the services rendered and the fee charged thereof. It is not possible to work out with a mathematical precision the amount of fee required for services to be rendered and collect only that amount which is sufficient for meeting the expenditure incurred in rendering the services. Reliance was correctly placed on the judgment

in *Sreenivasa General Traders (supra)*, where the Supreme Court held that the traditional view that there must be actual ‘*quid pro quo*’ for a fee charged has undergone a sea change. Power of any Legislature to levy a fee is conditioned by the fact that there must, by and large, be a *quid pro quo* for the services rendered, however, neither any general prescription can be made with respect to a link between a levy and services rendered nor a formula can be laid down with mathematical exactitude/precision. All that is necessary is that there should be a reasonable connection between levy of fee and services rendered. This view has been reaffirmed in many decisions such as *Krishi Upaj Mandi Samiti (supra)* and *Dewan Chand Builders & Contractors (supra)*. Therefore, no infirmity can be found with the decision of the Respondent in insisting on applying for inclusion of the trademark VISTARA® in the List of Well-Known Trademarks in the prescribed and requisite Form TM-M along with prescribed fee of Rs.1,00,000/- under First Schedule to Rule 124.

43. Learned counsel for the Petitioner had vehemently contended that the Registrar of the Trade Marks is acting arbitrarily and taking inconsistent stands inasmuch as while in the present case, there is insistence to apply in Form TM-M and pay the prescribed fee for inclusion of the trademark VISTARA® in the List of Well-Known Trademarks, on the other hand, Registry is permitting inclusion without following the said procedure, as in the case of the trademark MOTHER DAIRY. Respondent has responded to the said argument by stating that the 2017 Rules came into force w.e.f. 06.03.2017 and all representations pending/filed before the notification of the said Rules were considered by a Committee and out of the 11 representations, three marks SEMENS, LAVASA and MOTHER DAIRY were included in the list. However, all applications received

after the notification of the 2017 Rules are only being entertained by following the procedure of filling up the form TM-M along with the requisite fee. No fault can be found with this course of action adopted by the Registrar and therefore, the ground that MOTHER DAIRY has been included in the List of Well-Known Trademarks without following the prescribed procedure cannot come to the aid of the Petitioner. In any case, if an error has been committed in one odd case, two wrongs cannot make a right and this Court cannot be called upon to perpetuate the wrong.

44. This Court has perused the judgments relied upon by the Petitioner and is of the view that none of these judgments inure to the Petitioner's advantage. In *CIT, Andhra Pradesh (supra)* and *Radha Krishan (supra)*, the Supreme Court has held that Rules are meant to carry out the purpose of the provision of the Act and there can hardly be any dispute on this proposition of law. This Court has already held above that there is no conflict between Rule 124 and Section 11(8) as both operate differently and Rule 124 is for implementation and enforcement of the provisions of Section 11(8), enabling the Registrar to include the already declared well-known mark in the list after its publication in the Trade Marks Journal. In *International Society for Krishna Consciousness Bangalore (ISKCON) (supra)*, the Bombay High Court has declared the trademark ISKCON as a well-known trademark and there can be no two opinions that after the mark has been so declared, the Registrar will not enter into the exercise of re-determining it and would be bound by the declaration. In the present case, a categorical stand has been taken by the Registrar that once the mark is declared as well-known by the Court and an application is received for its inclusion in the List of Well-Known Trademarks, the procedure pertaining to inviting objections etc. will

not be necessary and straightaway the Registrar shall proceed to publish the trademark and include it in the list, subject however to verifications etc. relating to the authenticity of the certified copy of the judgment furnished and/or other administrative and procedural formalities and modalities, all of which will be cast into a cauldron to be determined by the Registrar.

45. For the myriad reasons, this Court finds no infirmity in the stand of the Respondent on any of the grounds which learned counsels for the Petitioner/*Amici Curiae* have proffered.

46. Writ petition is accordingly dismissed along with pending applications.

47. Before drawing the curtains, I may express my profound appreciation for the valuable assistance rendered in the matter by all the Counsels, especially Mr. Pravin Anand and Mr. Hemant Singh & Mr. Vaibhav Vutts, learned *Amici Curiae*.

MAY 25th, 2023/shivam

JYOTI SINGH, J