



OP (PT) No. 2 of 2024

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 11.07.2024

Pronounced on: 02.08.2024

CORAM:

THE HON'BLE MR.JUSTICE P.B.BALAJI

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&

(PT) A. No.2 of 2024

1.Mr.R.Arun

2.Mr.M.Dinesh

3.M/s.ESPOIRS SOLUTIONS,
A Partnership Firm,
Rep. by its Partner
Mrs.G.Lakshmi Prabha.

.. Petitioners

..Vs.

1.M/S.INTEGRAY HEALTH CARE PRIVATE LIMITED,
No.B2, Plot No.130, Thiruvengada Nagar,
Ambattur, South End Road, Chennai – 600 053,
Tamil Nadu, India.

2.Mr.Vijayakumar Irusappan

3.Mr.Sabrinathan Irusappan.

4.The Deputy Controller of Patents & Designs,
The Patent Office Intellectual Property Building,
GST Road, Guindy, Chennai – 600 032,
Tamil Nadu, India.

.. Respondents



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Prayer: Original Petition has been filed for Design Cancellation from the Register under Section 19 read with Section 4 of the Designs Act, 2000, to cancel the Registration of the first respondent, which was granted by the 4th respondent on February 9th 2024, being the Design No.400027-001.

For Petitioners : Mr.Ramesh Ganapathy

For Respondents : Mr.K.Subburanga Bharathi,
Central Government Standing
Counsel for R4

ORDER

The Original Petition has been filed to cancel the Registration of the first respondent, which was granted by the 4th respondent on February 9th 2024, being the Design No.400027-001.

2. Since the maintainability of this Original Petition would have to be decided first, notice was issued to the official respondent/R4 on 17.04.2024 by this Court.

3. I have heard Mr.Ramesh Ganapathy, learned counsel for the petitioners and Mr.K.Subburanga Bharathi, learned Central Government

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Standing Counsel for the fourth respondent.

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4. The learned counsel for the petitioner, Mr. Ramesh Ganapathy would submit that the above Original Petition is maintainable before this Court. He would fortify his submission in this regard by stating that the Designs Act, 2000 (in short 'Act') is not a complete code by itself and it refers to the Patents Act, 1970. Further, he would submit that there is no express ouster of jurisdiction of the Court in the Designs Act, 2000. He would also draw a comparison with the Trademarks Act, 1999, Copy Right Act, 1957, Patents Act, 1970 and Geographical Indication (Registration and Protection) Act, 1999 in this regard. Lastly, he would submit that originally the Design Office was only in Kolkata but subsequently, the Design Office is also opened in Chennai and when both the petitioner and the respondent are in Chennai, it would be improper and unfair to direct the petitioner to go to Kolkata for seeking cancellation of the Design in the subject case.

5. Per contra, Mr. Subbu Ranga Bharathi, learned Central Government Standing Counsel would submit that this Court is the Appellate Forum as



against the order passed by the Controller under Section 19 of the Designs Act, 2000, in an action Cancellation of Registration and therefore, this Court cannot act as a Controller and decide a petition for cancellation of registration of the Design. He would therefore pray for dismissal of the Original Petition as not being Maintainable.

6. I have considered the rival submissions advanced by the learned counsel on either side.

7. According to the learned counsel for the petitioner, the Designs Act does not oust the jurisdiction of this Court explicitly. He would refer to Section 2(e) of the Act, which defines “High Court” to have the same meaning as assigned in Section 2(i) of the Patents Act, 1970. Similarly, 2(h) of the Act, adopts the very same definition of the “Patent Office” as referred in Section 74 of the Patents Act, 1970. Section 23 of the Act makes certain provisions of the Patents Act, 1970, applicable to Designs Act. No doubt, prior to the enactment of the present Designs Act, 2000 and the promulgation of the Design Rules, 2000, the Indian Patent and Designs



Act, 1911 was in force. Section 51(A) of the said Act runs as follows:-

“51A.Cancellation of registration.

(1) Any person interested may present a petition for the cancellation of the registration of a design-

*(a) at any time after the registration of the design, to the **High Court** on any of the following grounds, namely:-*

(i) that the design has been previously registered in 2 [India]; or

(ii) that it has been published in 2 [India] prior to the date of registration ; or

(iii) that the design is not a new or original design ; or

(b) within one year from the date of the registration, to the Controller on either of the grounds specified in sub- clauses (i) and (ii) of clause (a).

(2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.”

8. Under the said Act, it was open to any interested person to seek cancellation of Registration of Design, any time after the Registration of the Design by approaching this Court on the available grounds in Section 51A(1) (a)(i, ii & iii), Section 51A(2) which have been extracted above and enables an Appeal to be filed before this Court from any order of the Controller and it was also open to the Controller to refer any Petition to the High Court for decision. However, this position changed after the Designs Act, 2000 came into force. Section 19 of the present Designs Act reads



thus:-

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“19. Cancellation of registration.—

(1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:—

(a) that the design has been previously registered in India; or

(b) that it has been published in India or in any other country prior to the date of registration; or

(c) that the design is not a new or original design; or

(d) that the design is not registrable under this Act; or

(e) that it is not a design as defined under clause (d) of section 2.

(2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.”

9. Therefore, on a reading of the above, it is clear that there is a departure from the earlier provision viz., Section 51A of the Act, 1911 which enabled an interested person seeking cancellation to approach the High Court at any time after the registration of the Design. However Section 19 of the Act, 2000, now expressly mandates such person seeking cancellation of Registration of a Designs to approach **“the Controller”** alone and Section 19 (2) provides an Appeal to this Court from any order of the Controller including any matter to be referred to the Controller for



decision of this Court.

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10. In the light of the specific provision available in Section 19, directing a petition for cancellation of Registration of Design to be made before the Controller, I am unable to countenance the argument of the learned counsel for the petitioner that there being no express ouster of jurisdiction of the High Court, a Petition for cancellation before this Court would also be maintainable.

11. In view of the above, I am unable to draw any analogy to other intellectual property enactments like the Trademarks Act, 1999, Section 47 where the Section itself provides for an Application to be made for removal from the register on the ground that non use either to the Registrar or to the High Court. Similarly under Section 64 of the Patents Act, 1970 also there is a clear provision enabling an Application to be made for revoking the Patent before this Court. Similarly, in the Copy Rights Act, 1957 also Section 50, enables Rectification of the Register by Application to the High Court. Even in the Geographical Indication of Goods (Registration and Protection), 1999 as well, under Section 27, power to cancel the



Registration and to rectify the Register is by way an Application either to the High Court or to the Registrar.

12. Thus in all these enactments, the provisions themselves permit an Application to be filed before the High Court. However, insofar as the Designs Act, even though the earlier Designs Act, 1911 enabled such Application to be filed before the Court, it has been taken away by the Designs Act, 2000 and by incorporation of Section 19, an Application for cancellation of Registration can be made only to the Controller and an Appeal against the the order of the Controller is also made available by approaching this Court. When an appeal is also made available to the aggrieved party by approaching this Court, it cannot be said that this Court can exercise concurrent jurisdiction alongwith the Controller. Therefore, I do not find any merit in the arguments advanced by the learned counsel for the petitioner that the ouster has to be express and in the absence of an express ouster, it has to be implied that the jurisdiction of this Court is available to be exercised by this Court, including entertaining an Application under Section 19 for Cancellation of the Designs.



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13. Though the learned counsel also made references to the Letters Patent of this Court and jurisdiction available under Clause 11, especially with regard to ouster of jurisdiction which cannot be readily inferred in the absence of an express provision in any enacted law taking away such jurisdiction, I find that the phraseology employed in Section 19 of the Designs Act is clearly taking away the jurisdiction of this Court insofar dealing with an Application for cancellation of Registration of the Design.

14. In view of the above reasons, I hold that the Original Petition filed before this Court is not maintainable and the petitioner has to necessarily approach the Controller having jurisdiction and canvass all its objections there.

15. In fine, the Original Petition is dismissed. However, liberty is granted to the Petitioner to move the jurisdictional Controller and if the said Application is made within a period of 60 days from the date of receipt of the copy of this order, the Controller shall not hold delay or limitation



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against the petitioner and shall take up the Application on merits and decide the same in accordance with law after hearing all the parties concerned.

Consequently, connected Application is also dismissed. No costs.

02.08.2024

Index : Yes/No
Speaking/Non-speaking order
rkp
To

The Deputy Controller of Patents & Designs,
The Patent Office Intellectual Property Building,
GST Road, Guindy, Chennai – 600 032,
Tamil Nadu, India.



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P.B.BALAJI, J.

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