



W.P(IPD)Nos.30 & 32 of 2024

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 20.02.2025

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

W.P.(IPD)Nos.30 & 32 of 2024

M/s.Woltop India Pvt. Ltd.,
Rep. by its Director Mr.Suresh Talbot Ashish,
696/1b1, 697/2, 698, 699, Villangadupakkam Village,
New Madhavaram T.K., Thiruvallur,
Chennai, Tamil Nadu-600 060.

... Petitioner

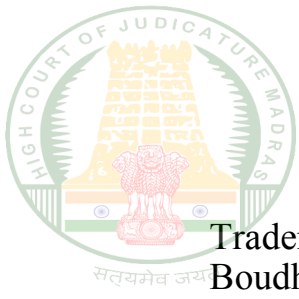
-VS-

1.Union of India
Through its Secretary,
Ministry of Commerce and Industry,
Department for Promotion of Industry
and Internal Trade Udyog Bhawan,
New Delhi-110 011.

2.Controller General of Patents, Designs
and Trademarks,
Office of the Controller General of Patents,
Designs & Trademarks, Registry,
Boudhik Sampada Bhawan,
S.M. Road, Antop Hill, Mumbai- 400 037.

3.The Registrar of Trademarks,
Trademarks Registry Mumbai,
Boudhik Sampada Bhawan,
S.M. Road, Antop Hill, Mumbai- 400 037.

4.The Registrar of Trademarks,



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Trademarks Registry, Ahmedabad,
Boudhik Sampada Bhawan,
Near Chanakyapuri Overbridge,
Besides AMC City Civic Centre,
Ghatlodia, Ahmedabad- 380061.

5.Mr.Sandeep Kagalwala
Sole Proprietor of M/s.Ace Assets,
K-201, 2nd Floor, 'K' Wing,
Western City Apartment, Nr.L.P. Savani School,
Pal-Adajan, Surat -395009, Gujarat.
Also At A-11, Suryapur Soc Opp Jain Derasar,
Rander Road, Surat- 395 009 Gujarat.

.. Respondents

Common Prayer: Writ Petitions (IPD) filed under Article 226 of the Constitution of India for issuance of Writ of Mandamus directing respondents 1 to 4 to transfer the rectification petitions bearing Nos.272370 & 272372 initiated against Trademark Registration bearing Nos.4376003 in class 27 & 4545395 in class 35 filed by the petitioner before the 4th respondent to the files of the Intellectual Property Division of this Hon'ble Court.

In both WPs.

For petitioner : Mr.Navod Prasannan
for Mr.M.S.Bharath

For R1 to R4 : No appearance

For R5 : Mr.R.Sathish Kumar

COMMON ORDER



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The writ petitioner filed C.S.(Comm.Div.)No.199 of 2023 against several parties, including the 5th respondent in these writ petitions. In the civil suit, the petitioner herein has sought remedies in respect of alleged infringement of trade mark and passing off.

2.On the ground that the said civil suit is pending before this Court, by these two writ petitions, the petitioner seeks a direction to respondents 1 to 4 to transfer rectification petition Nos.272370 & 272372, which are pending before the 4th respondent, the Registrar of Trade Marks, Ahmedabad, to this Court (the IPD).

3.These writ petitions were filed after requesting the 4th respondent, by letter dated 30.05.2024, to exercise powers under Section 125(2) of the Trade Marks Act, 1999 (the TM Act) and transfer the pending rectification petitions to the IPD of this Court.

4.Since the maintainability of these writ petitions was questioned,



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learned counsel for the petitioner addressed arguments thereon. His first contention was that it is just and necessary to consolidate proceedings, as provided in Rule 14 (1) of the Madras High Court Intellectual Property Division Rules, 2023 (the MHC IPD Rules) so as to enable the expeditious disposal of both the rectification petitions and the suit. In spite of making a request to the Registrar of Trademarks, he submits that no action has been taken thereon. His next contention is that the Hon'ble Supreme Court could not have been approached seeking such transfer because neither Article 139A of the Constitution of India nor Section 25 of the Code of Civil Procedure, 1908 (the CPC) applies in the facts and circumstances.

5. As regards the power of this Court, by referring to Article 226 of the Constitution of India, learned counsel submits that power may be exercised by this Court provided cause of action arises within the jurisdiction of this Court irrespective of the place of office of the authority to whom the writ is to be issued. He also relies upon the parliamentary debate preceding the amendment to Article 226 to substantiate the contention that the amendment was effected with the object of enabling High Courts across



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the country to exercise jurisdiction over authorities, subject to the cause of action arising within jurisdiction, irrespective of the place from which the authority functions.

6. After pointing out that the rectification petitions were filed prior to the suit and that these petitions have not been disposed of in spite of the lapse of several years, learned counsel submits, in conclusion, that the interest of justice warrants that power be exercised under Article 226 to enable the consolidation and expeditious disposal of all the proceedings.

7. In response, learned counsel for the 5th respondent submits that it is incorrect to contend that only this Court is in a position to exercise jurisdiction. By pointing out that the immediate trigger for filing the writ petitions is the alleged failure of the Registrar of Trade Marks, Ahmedabad, to act on letter of the petitioner requesting transfer, learned counsel submits that a writ petition could have been lodged before the Gujarat High Court seeking early consideration and disposal of the letter requesting transfer. He further submits that neither party has applied for a stay of the suit pending



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before this Court and that, therefore, there is no impediment for the continued prosecution of the suit. The last contention of learned counsel is that the appropriate office of the Trademarks Registry is defined in Rule 4 of the Trade Mark Rules, 2017 (the TM Rules). Therefore, he submits that the High Court with jurisdiction over the appropriate office wherein the relevant trade mark was registered is the jurisdictional High Court for the purposes of exercising powers of rectification under Sections 47 & 57 of the TM Act.

8. Upon consideration of the rival contentions, the first aspect to be recognised is that the petitioner seeks a discretionary public law remedy, albeit by invoking the constitutional power under Article 226 of wide amplitude.

9. Given the nature of relief claimed in these petitions, two issues are required to be examined. The first relates to the power of this Court to direct the Registrar of Trademarks, Ahmedabad, to transfer the pending rectification petitions to the file of this Court. The second - probably more important - relates to the jurisdiction of this Court to exercise power under



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Sections 47 & 57 of the TM Act in relation to trade marks that were registered by the Registrar of Trademarks, Ahmedabad. I propose to deal with the second issue first.

10. Sections 47 & 57 of the TM Act deal with the power of rectification. After the said provisions were amended pursuant to the Tribunals Reforms Act, 2021 (the Tribunals Reforms Act), the expression “Appellate Board” was replaced with the expression “High Court” in both these provisions. Significantly, in both provisions, the definite article “the” qualifies the words “High Court”. Section 91, the provision dealing with appeals to the High Court from a decision of the Registrar, and other provisions (such as Sections 124 and 125) dealing with the High Court in the TM Act also use the definite article “the” to qualify the words “High Court”. In my view, the use of the definite article “the” both in Sections 47 & 57 underscores Parliament's intention to confer such jurisdiction on a particular High Court. In Section 2(1)(s), the TM Act defines the expression “prescribed means” “in relation to proceedings before a High Court prescribed by Rules made by **the** High Court.” (emphasis added).



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11. From the above, it is clear that the indefinite article 'a' is used in the TM Act when the reference is generic, i.e. not to a particular High Court, whereas the definite article “the” is used when Parliament intends to refer to a particular High Court. The rationale for using the indefinite article “a” in the first limb of Section 2(1)(s) is not far to seek. The identity of the particular High Court vested with *inter alia* the power of rectification or appellate power would vary depending upon the location of the office of the Trade Marks Registry, which made the entry or decision relating to the relevant trademark. Since the offices of the Trade Marks Registries are currently located in Mumbai, New Delhi, Calcutta, Chennai, and Ahmedabad, it could be the High Court exercising appellate jurisdiction over each of these offices. Consequently, proceedings under the TM Act could lie before any of these High Courts, and rules may be framed by any of these High Courts in respect thereof. In fact, such rules have been framed by the Delhi High Court, Calcutta High Court and this Court.

12. The TM Act confers the power of rectification not only on the High Court, but also on the Registrar of Trade Marks. If the TM Rules are



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examined, as pointed out by learned counsel for the 5th respondent, the appropriate office of the Trade Marks Registry is defined in Rule 4. When Sections 47 and 57 are read with Rule 4, it is beyond doubt that an application for rectification either under Sections 47 or 57 would only lie before the office of the Trade Marks Registry within whose territorial limits the principal place of business, as entered in the register, of the registered proprietor is situated. The principal place of business of the registered proprietor of the impugned marks, in these cases, is Surat, Gujarat, and the appropriate office is the office of the Trade Marks Registry, Ahmedabad. Therefore, the rectification petitions were filed by the petitioner before the Registrar of Trade Marks, Ahmedabad.

13. In *Adiuvo Diagnostics Private Limited v University Health Network*, Order dated 27.09.2023 in *W.M.P(IPD) No.5 & 7 of 2023 in W.P(IPD) No.23 of 2023*, which was upheld in *University Health Network v. Adiuvo Diagnostics Private Limited, 2024 SCC OnLine Mad 185*, this Court concluded that the appropriate Patent Office, as defined in Rule 4 of the Patent Rules, does not control the exercise of writ jurisdiction by this Court.



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In these cases, however, the larger issue that arises is whether statutory jurisdiction, as opposed to jurisdiction under Article 226 of the Constitution, under Sections 47 & 57 can be exercised by this Court even if it were to be assumed that the power of transfer can be exercised under Article 226.

14. Since the object of a rectification petition is to examine whether rectification of an entry relating to a registered trade mark is warranted, it stands to reason that the particular High Court referred to in Sections 47 and 57 is the High Court exercising appellate jurisdiction over the Registrar of Trade Marks, who made the impugned entry. Rule 4 also points in the same direction as regards the particular Registrar of Trade Marks. Any other interpretation, whether on the basis of the dynamic effect of the registration or otherwise, would result in jurisdictional chaos because “any person aggrieved” is entitled to petition to rectify the register. Therefore, if it were to be concluded that such petitions may be filed before any High Court, multiple rectification petitions to rectify a particular entry of registration of a trade mark could be filed by different aggrieved persons before different High Courts leading to the possibility of conflicting decisions and great uncertainty.



WEB COPY 15. Justifying such transfer only for the limited purpose of consolidation with a pending suit is also not in consonance with the scheme of the TM Act for reasons set out below. Learned counsel for the petitioner placed reliance on Rule 14(1) on the MHC IPD Rules to contend that it confers the power of consolidation on this Court. The said Rule is evidently intended to enable the consolidation of proceedings pending before courts or authorities over whom this Court exercises supervisory jurisdiction. Therefore, the request of the petitioner cannot be countenanced by referring to and relying upon Rule 14. In addition, the statute confers jurisdiction to receive suits relating to trade marks on all jurisdictional civil (commercial courts and commercial divisions after the enactment of the Commercial Courts Act, 2015) courts not inferior to a District Court. Except for five High Courts, no other High Court exercises original jurisdiction. Hence, outside the territorial limits of the original jurisdiction of these five High Courts, suits are filed before the jurisdictional District Court. Even if there is a connected rectification petition, it cannot be consolidated with the suit in that situation.



WEB COPY 16. The TM Act deals with this scenario in Section 124 by providing that the suit be stayed until the rectification petition is decided. Once the validity of registration of the trade mark is decided in the rectification petition, the statute provides for the suit to be proceeded with on that basis thereafter, and conflict is thereby obviated. The only exceptions are where the rectification petition is also pending before the same High Court or where the rectification petition is pending before the Registrar of Trade Marks over whom the High Court exercises appellate jurisdiction and the suit is before that High Court. In both the above situations, consolidation is appropriate.

17. Therefore, I conclude that the power of rectification is exercisable only by the High Court exercising appellate jurisdiction over the appropriate office of the Trade Marks Registry, wherein the entry relating to the impugned mark was made. A learned single Judge of this Court had taken a contrary view in *Nippon Paint Holdings Co. Ltd. and another v. Suraj Sharma*, MANU/TN/1388/2024, (*Nippon Paint Holdings*) *inter alia* by

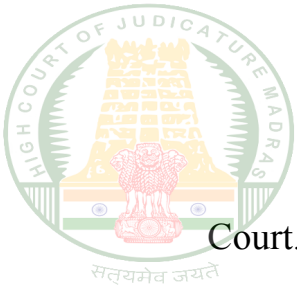


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agreeing with the view of the Delhi High Court in *Dr.Reddy's Laboratories Ltd. v. Fast Cure Pharma and others*, 2023 SCC OnLine Del 5409, and by not endorsing the view in *The Hershey Company v. Dilip Kumar Bacha and others*, MANU/DE/0904/2024. The order in *Nippon Paint Holdings* was stayed by the Hon'ble Supreme Court in *Suraj Sharma and another v. Nippon Paint Holdings Co. Ltd. and another*, order dated 10.05.2024 in *Special Leave to Appeal (C) No.10454 of 2024*, and the stay operates as on date. *Nippon Paint Holdings* was not cited before me perhaps because of the stay. For reasons aforesaid, I am unable to endorse the view in *Nippon Paint Holdings*.

18. In view of the above conclusion, it is unnecessary to examine whether this Court can exercise power under Article 226 over the Registrar of Trade Marks, Ahmedabad. Even otherwise, as stated at the outset, the petitioner seeks a discretionary public law remedy. From the facts on record, it follows that the immediate trigger for filing these writ petitions was the alleged failure of the Registrar of Trademarks to act on the request by the petitioner to transfer the pending rectification petitions to the file of this



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Court. The petitioner has more than one alternative remedy, including by seeking the expeditious disposal of the pending rectification petitions by filing appropriate petitions before the Gujarat High Court.

19. For reasons aforesaid, these writ petitions are disposed of by declining to grant the remedy prayed for, but by leaving it open to the petitioner to file petitions before the Gujarat High Court for the expeditious disposal of the pending rectification petitions or for any other appropriate relief. No costs.

20.02.2025

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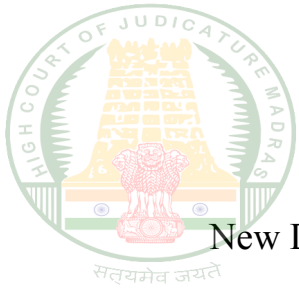
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Internet : Yes / No
Neutral Citation: Yes / No

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To

1.Union of India
Through its Secretary,
Ministry of Commerce and Industry,
Department for Promotion of Industry
and Internal Trade Udyog Bhawan,

14/16



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New Delhi-110 011.

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2. Controller General of Patents, Designs
and Trademarks,
Office of the Controller General of Patents,
Designs & Trademarks, Registry,
Boudhik Sampada Bhawan,
S.M. Road, Antop Hill, Mumbai- 400 037.

3. The Registrar of Trademarks,
Trademarks Registry Mumbai,
Boudhik Sampada Bhawan,
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4. The Registrar of Trademarks,
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