

MANU/DE/8453/2006

Equivalent Citation: 2006(32)PTC285(Del)

IN THE HIGH COURT OF DELHI

W.P.(C) 723 of 2006 and C.M. No. 964 of 2006

Decided On: 31.01.2006

Appellants: **Paul Manufacturing Co.**
Vs.

Respondent: **The Assistant Registrar of Trade Marks and Ors.**

Hon'ble Judges/Coram:

Vikramajit Sen, J.

Counsels:

For Appellant/Petitioner/plaintiff: Pratibha M. Singh and B. Dubey, Advs

For Respondents/Defendant: Sudhir Chandra, Sr. Adv. and Rajinder Dhawan, Adv. for Respondent No. 4

Subject: Intellectual Property Rights

Acts/Rules/Orders:

Trade Marks Act, 1999 - Section 3, Trade Marks Act, 1999 - Section 57(2), Trade Marks Act, 1999 - Section 109, Trade Marks Act, 1999 - Section 127; Constitution of India - Article 226, Constitution of India - Article 227

Cases Referred:

Whirlpool Corporation v. Registrar of Trade Marks, Mumbai (1998) 8 SCC 1

Disposition:

Petition dismissed

Case Note:

Intellectual Property Rights - Cancellation of - Registration Certificate - Petition filed for quashing registration certificate granted under Trade Marks Act, 1999 - Admittedly petitioner had two available remedies - Petitioner could either initiate and pursue appeal/rectification application or filed review application as contemplated by Sections 57 (2) and 127 (c) of the Act - Facts revealed that petitioner had already file the review application - Held, once alternative and efficacious remedy available writ petition in which extraordinary powers under Article 226 of the Constitution have been invoked not maintainable - Petition dismissed as withdrawn

Ratio Decidendi:

“ Once alternative and efficacious remedy is available writ petition in which extraordinary powers under Article 226 of the Constitution have been invoked not maintainable.”

JUDGMENT

Vikramajit Sen, J.

1. In this writ petition under Article 226 and 227 of the Constitution of India there is a prayer for issuance of appropriate writ, direction and order in the nature of certiorari and/or any other writ/order quashing the Registration Certificate of the Trade Mark Registration No. 1280913 granted under the Trade Marks Act, 1999 by the Registrar of Trade Marks. It has been asseverated that the Petitioner has filed a Rectification Application before the Intellectual Property Appellate Board (IPAB) which, however, is not functioning due to absence of Coram, and hence the Petitioner has been left with no alternative but to invoke the extraordinary writ jurisdiction of this Court.

2. It has been noted in these proceedings that on 20.10.2005 Joint Secretary, Government of India, had appeared in this Court and had stated that the appointment of the Technical Member (Trade Marks) of the Appellate Board would be carried out within one month. This was not done and time was extended up to 20.1.2006. The appointment of the Technical Member appears to have been made in terms of Order dated 30.1.2006 issued by the Government of India, Ministry of Commerce and Industry, Department of Industrial Policy and Promotion (IPR.II Section).

3. Ms. Pratibha M. Singh, learned counsel appearing on behalf of Petitioner, contends that the Petitioner has

no objection if the writ petition is dismissed as withdrawn with liberty to pursue the Rectification Application before the IPAB. She further contends that since the Petitioner cannot be blamed for the delay which has occasioned entirely due to the failure of the Government to make the necessary appointment, the Petitioner should be protected by means of an interim order.

4. This prayer has strenuously been opposed by Mr. Sudhir Chandra, learned Senior counsel appearing on behalf of Respondent No. 4, His contention is that the Petitioner has two available remedies. Firstly, it can initiate and pursue Appeal/Rectification Application which it has already filed. Secondly, the Petitioner can avail the remedy of a Review as contemplated by Sections 57(2) and 127(c) of the Trade Marks Act. He also contends that while the contesting Respondents have no objection to the withdrawal of the Writ Petition with liberty to pursue the relief before the IPAB, if any interim relief is to be granted, the Respondents should be permitted to argue on the merits of the case.

5. Learned counsel for the Petitioner has contested the availability of remedy before the Registrar. Trade Marks. Reliance has been placed on the pronouncement of the Hon'ble Supreme Court in Whirlpool Corporation v. Registrar of Trade Marks, Mumbai MANU/SC/0664/1998 : AIR1999SC22 and in particular to the following paragraph.

In this background, the phrase before which the proceeding concerned is pending stands out prominently to convey the idea that if the proceeding is pending before the Registrar, it becomes the Tribunal . Similarly, if the proceeding is pending before the High Court, then the High Court has to be treated as the Tribunal . Thus, the jurisdiction of the Registrar and the High Court, though apparently concurrent in certain matters, is mutually exclusive. That is to say, if a particular proceeding is pending before the Registrar, any other proceedings, which may, in any way, relate to the pending proceeding, will have to be initiated before and taken up by the Registrar and High Court will act as the appellate authority of the Registrar under Section 109. It is obvious that if the proceedings are pending before the High Court, the Registrar will keep his hands off and not touch those or any other proceedings which may, in any way, relate to those proceedings, as the High Court, which has to be the High Court having jurisdiction as set out in Section 3, besides being the appellate authority of the Registrar, has primacy over the Registrar in all matters under the Act. Any other interpretation of the definition of Tribunal would not be in consonance with the scheme of the Act or the contextual background set out therein and may lead to conflicting decisions on the same question by the Registrar and the High Court besides generating a multiplicity of proceedings.

6. Prima facie on the strength of the above observations no proceedings are maintainable before the Registrar, Trade Marks, either under Section 57(2) or Section 127(c) of the Trade Marks Act, 1999. In any event it is not open to the Respondents to dictate to the Petitioner which remedy it should avail of. If the Act bestows relief by way of an Appeal/Rectification Application, and this remedy has been initiated, the Petitioner being dominus litis, it cannot be asked to pursue the more limited remedy of a Review.

7. The situation which cannot be ignored is that had the Coram of the IPAB been complete, the Petitioner's Appeal/Rectification Application as well as prayer for interim relief would have come up for consideration much earlier and there would have been no need to file a Writ Petition before this Court. Once an alternative and efficacious remedy is available it would no longer remain a moot question whether a writ petition, in which the extraordinary powers under Article 226 of the Constitution have been invoked, would be maintainable. It is, Therefore, not necessary for this Court to enter upon the merits of the case. The prayer of Mr. Sudhir Chandra to this effect is, Therefore, not acceptable.

8. As prayed for by the Petitioner this writ petition is dismissed as withdrawn with liberty to pursue Rectification Application already filed before the IPAB. It is clarified that any action taken by the Petitioner in the interregnum between the filing of the Appeal or Rectification Application and the consideration of an application for interim relief shall not be viewed to the detriment of the Petitioner. The writ petition as well as the application stand disposed of in these terms.