

MANU/DE/0223/2007

Equivalent Citation: MIPR2007(1)187, 2007(34)PTC416(Del)

IN THE HIGH COURT OF DELHI

W.P.(C) No. 23545/2005 and C.M. No. 14453/2006

Decided On: 14.12.2006

Appellants: **Times Publishing House Limited**
Vs.

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

Hon'ble Judges/Coram:

Anil Kumar, J.

Counsels:

For Appellant/Petitioner/plaintiff: Mukul Rohtagi and Sanjay Jain, Sr. Advs., Pratibha M. Singh and Arjun Mitra, Advs

For Respondents/Defendant: Monica Garg, Adv. for the Respondent No. 3

Subject: Intellectual Property Rights

Acts/Rules/Orders:

Trade Marks Act, 1999 - Section 57(4), Trade Marks Act, 1999 - Section 100

Disposition:

Application allowed

Case Note:

Intellectual Property Rights - Application for impleadment as a party - In writ petition wherein the petitioner had challenged the suo motu cancellation order by Registrar- under Section 57(4) of Trade Marks Act of the registration of "Financial Times" in the name of the Petitioner - Ground that the applicant was registered proprietor of Trade Mark "Financial Times" and FT in India and several countries- petitioner's application for cancellation of the applicant's mark was also pending before IPAB - In such circumstance the applicant a necessary party - As the petitioner's registration would not be conclusively determined without the applicant being party - Application allowed - Applicant necessary party

Ratio Decidendi:

"Any party on whom the outcome of a proceeding would have substantial ramification is a necessary party and a proper party is one in whose absence an effective order can be made but whose presence is necessary for a complete and final decision on the question involved in the proceeding such party deserves to be imp leaded in such proceeding."

ORDER

Anil Kumar, J.

1. The applicant, Financial Times Limited, proprietor of Trade Mark "Financial Times" and FT has sought impleadment in the writ petition filed by the petitioner against the order of the Registrar of Trade Marks canceling the petitioner's Trade Mark "Financial Times" suo moto under Section 57(4) of Trade Marks Act, 1999.

2. The applicant, Financial Times Limited, contended that their trade mark "Financial Times" is registered in many countries including India and in India it is registered as Trade Mark No. 468937 in Class 16 since March 9, 1987.

3. The applicant's contention is that he became aware of petitioner publishing the newspaper under the title "Financial Times". According to the applicant, since the petitioner became aware of applicant's prior registration of trade mark "Financial Times", anticipating legal action from the applicant, filed an application for cancellation on 1st December, 1993 being C.O. No. 23 of 1993 against the registration of Trade Mark of the applicant. On account of Trade Marks Act, 1999, the cancellation proceedings of the petitioner have been transferred under Section 100 of the said Act and are pending before Intellectual Property Appellate Board.

4. The learned Registrar of Trade Mark had suo moto taken action and cancelled the trade mark of the Petitioner under Section 57(4) of Trade Marks Act, 1999 and against the said order the present Writ Petition has been filed by the Petitioner, however, the applicant has not been imp led as a party though, according to the applicant, he is a necessary party to the present writ petition as the outcome of the present writ petition will affect the rights of the applicant and the registration of the trade mark of the Petitioner cannot be decided conclusively without deciding the contentions and pleas of the applicant whose trade mark was registered on 9th March, 1987.

5. The application is contested by the petitioner contending that the applicant is not a necessary party as the order challenged is suo moto cancellation of the petitioner's Trade Mark and before the Registrar, who cancelled the registration of the trade mark of the petitioner suo moto, the applicant was not a party and consequently the applicant should not be imp led as a party. It was also contended that in order to protect his proprietary rights, the applicant has already filed a cancellation petition which is now pending before the Intellectual Property Appellate Board. The petitioner has also placed reliance on a civil suit filed before the City Civil Court, Bangalore seeking an injunction and the petitioner's use of mark "Financial Times" which was dismissed after trial and an appeal is pending on behalf of applicant before the Karnataka High Court.

6. All the parties which may be affected by any litigation must be imp led so that the rendering of justice is not hampered. Petitioner is bound to sue every possible adverse claimant in the same proceedings to avoid multiplicity of proceedings and needless expenses. All persons against whom the right to relief is alleged to exist may be joined as Respondents in the petition. Even the Court may at any stage of the proceedings direct addition of parties. A party can be joined as Respondent even though the Petitioner does not think that he has any cause of action against him. It is open to the Court to add at any stage of the proceedings a necessary party or a person whose presence before the Court may be necessary in order to enable the Court to effectually and completely adjudicate upon and settle all the questions involved in the legal proceedings. The Court has wide discretion to meet every case of defect of parties and is not affected by the inaction of the Petitioner to bring the necessary parties on record. The question of impleadment of a party can be decided in a writ petition on the principle of Order 1 Rule 10 which provides that only a necessary or a proper party may be added. A necessary party is one without whom no order can be made effectively. A proper party is one in whose absence an effective order can be made but whose presence is necessary for a complete and final decision on the question involved in the proceeding. The addition of parties is generally not a question of initial jurisdiction of the Court but of a judicial discretion which has to be exercised in view of all the facts and circumstances of a particular case.

7. In order to ascertain whether a person is a necessary party or not what is to be seen is whether in absence of such person, conflicting order may be passed by the Court. The only reason which makes it necessary to make a person a party to an action is so that he should be bound by the result of the action and the question to be settled. The question to be settled must be a question which cannot be effectually and completely settled unless he is a party. A line has been drawn on a wider construction of the rule between the direct interest or the legal interest and commercial interest. It is, Therefore, necessary that the person must be directly or legally interested in the action in the answer, i.e., he can say that the litigation may lead to a result which will affect him legally that is by curtailing his legal rights.

8. In case the writ petition is allowed and the suo moto order of cancellation of the trade mark of the petitioner is set aside, it will revive the trade mark of the petitioner "Financial Times". The application of cancellation by the applicant of the trade mark of the petitioner is also pending before the Intellectual Property Appellate Board. Though the order impugned was passed by the Registrar suo moto and the applicant was not a party, however, it cannot be doubted that the decision regarding the suo moto cancellation of the petitioner's trade mark would also have substantial ramification on the rights of the applicant who is also seeking cancellation of the trade mark of the petitioner. Applying the principles and the test laid down by the Courts as stated hereinabove, the inevitable inference is that the petitioner is a necessary party and in any case shall be an appropriate party in the facts and circumstances. The petitioner is unable to point out as to how any prejudice shall be caused to the petitioner, in case the applicant is imp led as a party to the present petition.

9. In the totality of facts and circumstances, the applicant is a necessary party and it will be just and equitable to implead the applicant as respondent No. 4 to the present petition.

10. Consequently the application of the applicant is allowed and he is imp led as respondent No. 4 to the present writ petition.

11. A complete set of paper book be supplied to the learned Counsel for the respondent No. 4 who seeks time to file the counter affidavit. Counter affidavit be filed within four weeks. Rejoinder, if any, within four weeks thereafter.

