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IN THE HIGH COURT OF DELHI AT NEW DELHI*Reserved on: 11th October, 2023**Date of decision: 9th February, 2024*

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C.O. (COMM.IPD-TM) 179/2023

THE HERSHEY COMPANY

..... Petitioner

Through: Mr. Urfee Roomi, Ms. Apoorva Bharati, Ms. Anuja Chaudhury, Mr. Ritesh Kumar, Mr. Anubhav Chhabra & Ms. Radhika Arora, Advs. (M: 9811600017)

versus

DILIP KUMAR BACHA, TRADING AS SHREE GANESH
NAMKEEN & ANR

..... Respondents

Through: Mr. Harish Vaidyanathan Shankar, CGSC, with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advs. Mr. Rajshekhar Rao, Sr. Adv. with Mr. Kapil Wadhwa, Mr. R. V. Yogesh, Ms. Sindoor VNL, Ms. Vishakha Gupta, Ms Twinkle Rathi, Mr. K. V. Pawan Kumar, Ms. Tejasvini Puri, & Ms. Vasanthi Hariharan, Advocates. (M: 9533864588)

WITH

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C.O. (COMM.IPD-TM) 778/2022 and I.A. 20333/2022

KOHINOOR SEED FIELDS INDIA PVT LTD

..... Petitioner

Through: Mr. Adarsh Ramanujan, Ms. Sulekha Agarwal, Ms. Soumya Singh, Mr. Saurav Agarwal, Mr. Shantanu Agarwal & Mr. Skanda Shekhar, Advs. (M: 8860193982)

versus

VEDA SEED SCIENCES PVT. LTD. & ANR. Respondents



Through: Mr. Harish Vaidyanathan Shankar, CGSC, with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advs. (M: 9810788606)
Mr. Rajshekhar Rao, Sr. Adv. with Mr. Kapil Wadhwa, Mr. R. V. Yogesh, Ms. Sindoor VNL, Ms. Vishakha Gupta, Ms Twinkle Rathi, Mr. K. V. Pawan Kumar, Ms. Tejasvini Puri, & Ms. Vasanthi Hariharan, Advocates.

WITH

+ **C.O. (COMM.IPD-TM) 782/2022 and I.A. 20524/2022**

KOHINOOR SEED FIRLDS INDIA PVT LTD Petitioner

Through: Mr. Adarsh Ramanujan, Ms. Sulekha Agarwal, Ms. Soumya Singh, Mr. Saurav Agarwal, Mr. Shantanu Agarwal & Mr. Skanda Shekhar, Advs.

versus

VEDA SEED SCIENCES PVT LTD & ANR. Respondents

Through: Mr. Harish Vaidyanathan Shankar, CGSC, with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advs.
Mr. Rajshekhar Rao, Sr. Adv. with Mr. Kapil Wadhwa, Mr. R. V. Yogesh, Ms. Sindoor VNL, Ms. Vishakha Gupta, Ms Twinkle Rathi, Mr. K. V. Pawan Kumar, Ms. Tejasvini Puri, & Ms. Vasanthi Hariharan, Advocates.

WITH

+ **C.O. (COMM.IPD-TM) 783/2022**

KOHINOOR SEED FIELDS INDIA PVT LTD Petitioner

Through: Mr. Adarsh Ramanujan, Ms. Sulekha Agarwal, Ms. Soumya Singh, Mr.



Saurav Agarwal, Mr. Shantanu
Agarwal & Mr. Skanda Shekhar,
Advs.

versus

VEDA SEED SCIENCES PVT LTD & ANR. Respondents

Through: Mr. Harish Vaidyanathan Shankar,
CGSC, with Mr. Srish Kumar Mishra,
Mr. Sagar Mehlawat and Mr.
Alexander Mathai Paikaday, Advs.
Mr. Rajshekhar Rao, Sr. Adv. with Mr.
Kapil Wadhwa, Mr. R. V. Yogesh, Ms.
Sindoor VNL, Ms. Vishakha Gupta,
Ms Twinkle Rathi, Mr. K. V. Pawan
Kumar, Ms. Tejasvini Puri, & Ms.
Vasanthi Hariharan, Advocates.

AND

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C.O. (COMM.IPD-TM) 151/2022

LIBERTY FOOTWEAR COMPANY Petitioner

Through: Mr. Kapil Wadhwa, Ms. Surya
Rajappan, Ms. Tejasvini Puri & Ms.
Vasanthi Hariharan, Advs. (M:
9891929028)

versus

LIBERTY INDUSTRIAL GROUP PTE LTD. & ANR... Respondents

Through: Mr. Gautam Wadhwa, Adv. for R-1.
(M: 9871444784)
Mr. Harish Vaidyanathan Shankar,
CGSC, with Mr. Srish Kumar Mishra,
Mr. Sagar Mehlawat and Mr.
Alexander Mathai Paikaday, Advs.

Advocates assisting the Court:

Mr. Alankar Kirpekar and Mr. Arun C Mohan, Amicus Curiae
Mr. Vaibhav Vutts, Mr. Aditya Gupta and Mr. Nikhil Sharma,
Advocates.



**CORAM:
JUSTICE PRATHIBA M. SINGH**

JUDGMENT

Prathiba M. Singh, J.

Background

1. The present batch of matters highlight a significant issue that has come to the attention of this Court concerning its jurisdiction to consider rectification/cancellation petitions under Section 57 of the Trade Marks Act, 1999 (*hereinafter 'the 1999 Act'*), following the enactment of the Tribunal Reforms Act, 2021.
2. In the present batch, there are a total of five rectification petitions filed under Section 57 of the 1999 Act:
 - ***C.O. (COMM.IPD-TM) 151/2022,***
 - ***C.O. (COMM.IPD-TM) 778/2022,***
 - ***C.O. (COMM.IPD-TM) 782/2022,***
 - ***C.O. (COMM.IPD-TM) 783/2022,***
 - ***C.O. (COMM.IPD-TM) 179/2023***
3. A brief background of the petitions is captured as follows:

<i>C.O. (COMM.IPD-TM)-151/2022: Liberty Footwear Co. v. Liberty Industrial Group Pte Ltd.</i>	
<i>Impugned mark</i>	'LIBERTY STEEL' (device mark) TM Application No. 3559438 dated 29 th May, 2017
<i>Appropriate Office of the impugned mark</i>	Mumbai
<i>Respondent's place of</i>	Singapore



<i>business</i>	
<i>Petitioner's place of business</i>	Registered Address: Karnal, Haryana Also at: Punjabi Bagh West, New Delhi
C.O. (COMM.IPD-TM)-778/2022: M/s. Kohinoor Seeds Fields India Pvt. Ltd. v. M/s. Veda Sciences Pvt. Ltd.	
<i>Impugned mark</i>	'VEDA BASANT GOLD' (device mark), TM Application No. 5078923 dated 7 th August, 2021
<i>Appropriate Office of the impugned mark</i>	Chennai.
<i>Respondent No. 1's place of business</i>	Guntur, Andhra Pradesh.
<i>Petitioner's place of business</i>	Registered Office in Shalimar Bagh, New Delhi
C.O. (COMM.IPD-TM)-782/2022: M/s. Kohinoor Seeds Fields India Pvt. Ltd. v. M/s. Veda Sciences Pvt. Ltd.	
<i>Impugned mark</i>	'VEDA TADAAKHA GOLD' (device mark) TM Application: 5078922 dated 7 th August, 2021
<i>Appropriate Office of the impugned mark</i>	Chennai.
<i>Respondent No. 1's place of business</i>	Guntur, Andhra Pradesh.
<i>Petitioner's place of business</i>	Registered Office in Shalimar Bagh, New Delhi
C.O. (COMM.IPD-TM)- 783/2022: M/s. Kohinoor Seeds Fields India Pvt. Ltd. v. M/s. Veda Sciences Pvt. Ltd.	



<i>Impugned mark</i>	‘VEDA SADANAND GOLD’ (device mark) TM Application: 5078921 dated 7 th August, 2021
<i>Appropriate Office of the impugned mark</i>	Chennai.
<i>Respondent No. 1’s place of business</i>	Guntur, Andhra Pradesh.
<i>Petitioner’s place of business</i>	Registered Office in Shalimar Bagh, New Delhi
<i>C.O. (COMM.IPD-TM) 179/2023: The Hershey Co. v. Dilip Kumar Bacha, Trading as Shree Ganesh Namkeen</i>	
<i>Impugned mark</i>	‘HARSHY’ (device mark) TM Application No. 3897902 dated 25 th July, 2018
<i>Appropriate Office</i>	Mumbai
<i>Respondent’s place of business</i>	Cat Road, Indore, Madhya Pradesh
<i>Petitioner’s place of business</i>	Pennsylvania, U.S.A.

4. A brief background of these petitions is that in ***C.O. (COMM.IPD-TM) 151/2022***, on 22nd December, 2022, notice was issued to the Liberty Industrial Group Pte. Ltd. Thereafter, on 18th July, 2023, this petition was directed to be listed before this Court on 20th July, 2023 along with ***C.O. (COMM.IPD-TM) 778/2022***.

5. In ***C.O. (COMM.IPD-TM) 778/2022***, ***C.O. (COMM.IPD-TM) 782/2022***, notice was issued to Veda Seed Sciences Pvt. Ltd. on 6th December, 2022. In ***C.O. (COMM.IPD-TM) 783/2022***, notice was issued on 5th January, 2023 to Veda Seed Sciences Pvt. Ltd. Thereafter, vide order dated 12th July, 2023, the above rectification petitions were directed to be listed along with



C.O.(COMM.IPD-TM) 179/2023.

6. In ***C.O.(COMM.IPD-TM) 179/2023***, vide order dated 5th July, 2023, this Court issued notice to the Respondent-single proprietorship concern, therein, i.e. Dilip Kumar Bacha trading as Shree Ganesh Namkeen. While issuing notice in the said rectification petition, this Court posed a query to the Id. Counsel appearing for the Petitioner, regarding the maintainability of the petition before this Court, as the Appropriate office of the Trade Marks Registry in terms of Rule 4 of the Trade Marks Rules, 2017 (*hereinafter, '2017 Rules'*) for the subject mark therein being 'HARSHY', is the Office of the Trade Marks Registry located in Mumbai.

7. On the said date, this Court noted that the 1999 Act did not specifically define '*High Court*' under Section 57 of the Trade Marks Act, 1999. And thus expressed a *prima facie* opinion that the appropriate High Court for the rectification petition under Section 57 of the 1999 Act would be one within whose jurisdiction the Appropriate office of the Trade Marks Registry office is located, which in this case was the Bombay High Court.

8. Nevertheless, given the implications of the Tribunal Reforms Act, 2021 (*hereinafter, 'TRA'*), the Court allowed the Petitioner in ***C.O.(COMM.IPD-TM) 179/2023*** to make further submissions on this matter. Further, considering the large scale impact of the interpretation adopted, the Court appointed Id. Counsel Mr. Arun Mohan from the Madras High Court and Id. Counsel Mr. Alankar Kirpekar from the Bombay High Court, as *amici curiae* to assist the Court in this matter. The relevant portions of the said order are extracted below:

“5. At the outset, the Court put a query to Id. Counsel for the Petitioner as to how the present cancellation



petition would be maintainable, as the appropriate office of the Trade Marks Registry for the said subject mark is the Office of the Trade Marks Registry in Mumbai. Ld. Counsel for the Petitioner seeks to draw a parallel with the designation of 'High Court' under Section 2(1)(i) of the Patents Act, 1970, and seeks to rely upon the decision of this Court in Dr. Reddys Laboratories v. Controller of Patents (2022/DHC/004746).

6. *Heard. Prima facie, in the opinion of this Court, insofar as the subject trademark is concerned, since the Act does not define the expression 'High Court', the High Court before which the cancellation petition by the Petitioner would lie, would be the High Court within whose jurisdiction the appropriate office of the Trade Marks Registry qua the subject registration, would be located - in this case, the Bombay High Court.*

7. However, considering the fact that this issue has arisen after enactment of the Tribunal Reforms Act, 2021, it is deemed appropriate to permit the Petitioner to make submissions on this issue. The Petitioner is also permitted to file a written note of arguments, along with the provisions of law as also any other decisions that he wishes to rely upon. If any other member of the Bar wishes to make submissions on this aspect, they are free to do so.

8. *Considering the nature of the issues involved, Mr. Arun Mohan, Advocate (M:9600020715) from Chennai, and Mr. Alankar Kirpekar, Advocate (M:9323166787) from Mumbai are appointed as amici curiae to assist the Court in this matter. The Registry of the Court, and Ld. Counsel for the Petitioner to inform them of this Order. The amici curiae shall file a note of their submissions at least two days before the next date of hearing.*

9. *The Registry of the Court is directed to give intimation of the filing of the present petition to the*



Respondent through all modes including through email. The service shall be also affected through email on the trademark agent for the Respondent Ms. Rukmani Dhangar [23979], with the following contact details: Email address: Siddhivinayakassociates2018@gmail.com Address: 201, Siddhivinayak Associates, Sterling Arcade, Near Janjirwala Square, Indore-452001

9. Thus, after noting the jurisdictional issue related to the maintainability of the rectification petition of the subject trade marks as above, the Court has from time-to-time heard submissions pertaining to this matter. Further, vide order dated 11th October, 2023, the suit *CS(COMM) 828/2022* was de-tagged from the cancellation petitions being *C.O. (COMM.IPD-TM) 783/2022 and C.O. (COMM.IPD-TM) 782/2022*. The said exercise has been crucial due to the complexities arising from the absence of a clear definition of ‘High Court’ in the 1999 Act, particularly following the enactment of the TRA.

10. On behalf of the Petitioners, Id. Counsels Mr. Urfee Roomi, Mr. Adarsh Ramanujan, Mr. Saurav Agarwal made their submissions before the Court.

Submissions of Mr. Urfee Roomi, Id. Counsel for the Petitioner in C.O. (COMM.IPD-TM) 179/2023.

11. Id. Counsel for the Petitioner in *C.O. (COMM.IPD-TM) 179/2023*, Mr. Urfee Roomi primarily argues that this Court has jurisdiction to hear the rectification petition. He has made the following submissions:

- The Parliament has deliberately not included a provision similar to Section 3 of the Trade and Merchandise Marks Act, 1958 (*hereinafter, ‘1958 Act’*) while enacting the TRA. Section 3 of the 1958 Act clearly determines jurisdiction of the High Court, but a conscious omission in this regard has to be given effect to under 1999 Act, as amended by the



TRA. Reliance is placed on *BALCO v. Kaiser Aluminium Technical Services Inc.*¹ to argue that the Court cannot proceed on the assumption that there has been a mistake by the legislature. It has to be presumed that the manner in which the 1999 Act or any other statute has been enacted, is what the legislature intended to do.

- The use of the expression '*the High Court*' in Section 57 of the 1999 Act should effectively be interpreted to mean the High Court *having* jurisdiction. Jurisdiction could be conferred upon a High Court in various forms, including through the dynamic effect of the legislation granted to a proprietor. Given that the effect of such registration extends nationwide, it would be impermissible for the Court to restrict the jurisdiction exclusively to the particular High Court where the Appropriate office is located. Such limitation would also be contrary to the ethos of the Commercial Courts Act, 2015. If the proposition that only five High Courts where the Appropriate office is located are entitled to look into the rectification petitions, would be accepted, it would restrict the rectification petitions to the said five High Courts, potentially leading to higher pendency in the said High Courts as well.
- The convenience of the parties who can invoke the jurisdiction of a High Court would also have to be borne in mind, and the same should not be restricted to the High Court where the Appropriate office is located. A parallel is drawn in *C.O. (COMM.IPD-TM) 179/2023* where the applicant is located in Madhya Pradesh, to argue that the Madhya Pradesh High Court ought to also be held to have jurisdiction to deal

¹ (2012) 12 S.C.R. 327 (paragraphs 60-61)



with cancellation petitions, if the Petitioner chooses to invoke the jurisdiction of the said High Court.

- The 1999 Act offers considerable flexibility for filing trade mark-related suits, whether for infringement under Section 134 of the 1999 Act or against groundless threats under Section 142 of the 1999 Act. Consequently, there's no justification for limiting jurisdiction in cancellation petitions.
- Reliance is placed upon Rule 4 and Rule 2(l)(iv) of the Delhi High Court Intellectual Property Rights Division Rules, 2022 (*hereinafter 'IPD Rules'*) to argue that under Rule 2(l)(i), all cancellation petitions can be entertained by IP Division, however Rule 2(l)(iv) provides that all pending proceedings before the IPAB relating to Delhi jurisdiction shall be transferred to the Delhi High Court. It is thus submitted that the present petition is maintainable before this Court.
- Reliance is also placed on the decision of the Id. Full Bench of this Court in ***Girdhari Lal Gupta v. K. Gian Chand Jain***², where the Court dealt with the expression '*the High Court*' and emphasized the significance of using the definite article '*the*' before High Court under Section 51-A of the Designs Act, 1911. The Court held that this usage indicates that it is not just any High Court but specifically the High Court with a nexus to the subject-matter or cause of action that has jurisdiction. In other words, the Court's jurisdiction is fixed based on the connection between the subject-matter or cause of action and the territory within the local jurisdiction of that particular High Court. The

² AIR 1978 Delhi 146



ld. Counsel relies on this interpretation to argue that this Court should adopt a similar approach when determining jurisdiction in the context of the case at hand.

Submissions of Mr. Adarsh Ramanujan, ld. Counsel for the Petitioners/Plaintiff in C.O. (COMM.IPD-TM) 778/2022, C.O. (COMM.IPD-TM) 782/2022, C.O. (COMM.IPD-TM) 783/2022.

12. Mr. Adarsh Ramanujan, ld. Counsel for the Petitioners in *C.O. (COMM.IPD-TM) 778/2022*, *C.O. (COMM.IPD-TM) 782/2022*, and *C.O. (COMM.IPD-TM) 783/2022* has made his submissions. On the question of jurisdiction, he submits that three views that can be taken :-

- i) that only **five** High Courts where the Appropriate offices are located, would have the jurisdiction to entertain cancellation petitions.
- ii) that **any** High Court situated in the country would have jurisdiction.
- iii) the view laid down by the Full Bench in *Girdhari Lal (supra)* i.e. it is those High Courts where the legal injury occurs, and which have a territorial nexus to the dispute or where the cause of action arises, that can entertain rectification/cancellation petitions.

Ld. Counsel submits that a middle ground needs to be considered while deciding the jurisdiction issue.

13. Ld. Counsel made the following submissions:

- The Patents Act of 1970 and the Act of 1999 both envisage the High Court's exercise of original jurisdiction in matters of revocation and cancellation petitions, respectively. In addressing petitions under Section 57 of the 1999 Act, the Court is not engaged in the exercise of either its appellate jurisdiction or its writ jurisdiction, nor does it apply



the principles that govern suits. Rather, these are 'original' petitions filed for the purpose of seeking the cancellation of the impugned registration.

- The 1999 Act consolidates and amends the existing trade marks law, and is, thus, a self-contained code. The legal position in respect of such consolidating statutes has been repeatedly settled by the Supreme Court for example in *Innovative Industries v. ICICI Bank*³, in the context of the Insolvency and Bankruptcy Code, 2016 ('IBC'). The Court should not place reliance on the definition of 'High Court' under Section 4 of the 1958 Act.
- Section 57 of the 1999 Act provides for filing of rectification petitions either before the High Court or before the Registrar. As far as the Registrar is concerned, Rule 4 of the 2017 Rules clearly state that only that Office where the Appropriate office is situated can exercise jurisdiction to entertain such a petition. However, in respect of High Courts, the terminology used is '*the High Courts*', and the same is not limited by the territorial nexus as prescribed in Rule 4 of the 2017 Rules.
- Further, the definition of 'High Court' under Article 366(14)(a) of the Constitution of India, merely, means that a High Court could be any High Court, located in any territory as constituted under the Constitution of India. Further, Article 214 of the Constitution of India is, merely a listing of all the High Courts. The broad listing of High Courts under the Constitution of India does not automatically grant

³ 2017 8 SCR 33, paragraph 53 at page 103



jurisdiction to every High Court. Even under the Trade Marks Act, 1940 (*hereinafter*, '1940 Act') which referred to Section 219 of the Government of India Act, 1935 (*hereinafter*, 'GoI Act'), confusion prevailed between decisions rendered by various High Courts. The same was considered by the '*Report of Shri. Justice N. Rajagopala Ayyangar on Trade Marks Law Revision, 1995 (Government of India, Ministry of Commerce and Industry)*' (*hereinafter*, '1955 Ayyangar Committee Report'). He submits that the said Ayyangar Report, clearly opined that this jurisdictional conflict required that '*High Court*' ought to be defined, and clarity ought to be given. As a result of this recommendation, '*High Court*' was defined in the 1958 Act under Section 2(h), which no longer exists under the 1999 Act. To support this submission, reference is made to paragraphs 41 to 43 of the 1955 Ayyangar Committee Report. Further, to illustrate the nature of the conflict that led to the revision of the 1940 Act, reliance is placed on *Chamundeeswari Weaving and Trading Co., (Pte) Ltd. v. Mysore Spinning and Manufacturing Co. Ltd.*⁴ and *Watkins Mavor & Co. v. Registrar of Trade Marks Bombay*⁵.

- Thus, the position prevalent under the 1940 Act would, in fact, be similar to the present position except the two decisions which, according to him, have a bearing under 1999 Act while deciding as to what would be the High Court for exercising jurisdiction. The first decision relied upon is *Terapalli Dyvasahata Kumar v. S. Kanthu*

⁴ AIR 1959 Mad. 251

⁵ AIR 1952 Punj. 266



Raju⁶. The said decision is asserted to be applicable in the present case, where the term '*the High Court*' is used in the 1999 Act, without a specific definition within the Act, suggesting that it should be construed based on its general meaning as understood in law.

- Reliance is placed on **Girdhari Lal Gupta (supra)** where the Id. Full Bench held that no High Court can exercise jurisdiction without territorial jurisdiction. In the said decision, it was emphasized that the legislature could not have intended to empower a Petitioner under Section 51-A of the Designs Act, 1911 with the ability to harass the Respondent. Allowing such a petition to be filed in any High Court in India would enable the Petitioner to choose a Court where the Respondent would find it most challenging to defend their case. The legislature cannot be assumed to have intended to deviate from the fundamental concept of jurisdiction and create a provision that could be misused and result in no benefit for anyone involved. Thus, **Girdhari Lal's** ruling clarifies that a High Court cannot have jurisdiction without territorial nexus.
- In addition, it is argued that in **Girdhari Lal (supra)**, the Court is conscious of the fact that the effect of a registered design under the Designs Act, 1911 could be both the static effect where the Design is registered, and the dynamic effect where the effect of the Design is felt. Therefore, there is no reason why the same rationale ought not to be applied under the 1999 Act. To buttress his argument, Id. Counsel also relies upon **Dr. Reddy's Laboratories Ltd. v. Controller of Patents**⁷.

⁶ 2018 (11) SCC 769, paragraphs 13, 18

⁷ 2022/DHC/4746, paragraph 83



- The last submission is that even under the 1999 Act when Section 3 of the 1958 Act was not retained, the constitution of the IPAB was contemplated by the legislature to be only one forum for the entire country. In fact, Section 84 of the 1999 Act makes it very clear that it was up to the Central Government to notify only for the purposes of sittings and distribution of work, but never for the purposes of conferring territorial jurisdiction. The notifications issued under the 1999 Act when the IPAB was functioning are relied upon to argue that the only notification which was issued was under Section 84(2) of the 1999 Act, and not under Section 84(4) of the 1999 Act. The distribution of work was never considered necessary even under the 1999 Act by the legislature and thus, even today, the same position ought to prevail. Any distribution of work by the IPAB itself as part of its practice for the purpose of administrative convenience cannot override the parliamentary intent of the legislature. Practice of the IPAB, as referred to in *Midas Hygiene Industries Ltd. v. Sudhir Bhatia (IPAB)*⁸ and *Girdhari Lal (supra)* is relied upon.
- A perusal of the petitions, *inter alia*, demonstrates that the impugned marks have pan-India dynamic effect, that the Petitioner has commercial interests in the matter. That its registered office is in Delhi, and that it principally carries on business in Delhi. The Petitioner's prior trade mark registrations, that were later abandoned, were with the Delhi Trade Marks Registry. Thus, the present rectification petitions are also maintainable before this Court.

⁸ 2008 SCC Online IPAB 82



Submissions of Mr. Saurav Agarwal, Id. Counsel for the Petitioners/Plaintiff in C.O. (COMM.IPD-TM) 778/2022, C.O. (COMM.IPD-TM) 782/2022, C.O. (COMM.IPD-TM) 783/2022

14. Mr. Saurav Agarwal, Id. Counsel has made the following submissions:

- The expression, '*the High Court*' has to be read in a manner so as to mean the High Court having jurisdiction, which in effect would mean High Court having jurisdiction including under Section 20 of the CPC. Section 57 of the 1999 Act is an original proceeding of a civil nature, and thus, has all trappings of a civil suit, thus, Section 20 would be applicable. The proprietor of a registered trade mark can be sued even where he resides, for example in a case where the Plaintiff and the Defendant are registered owners of a mark.
- The 1999 Act grants owners/proprietors rights across India. There is nothing to indicate that there has to be jurisdictional certainty for the trade mark owner insofar as cancellation petitions are concerned. Section 134 of the 1999 Act provides an additional forum as to where a suit for infringement can be filed, but cannot be read to mean as prescribing a place where the trade mark owner can be sued.
- Under Section 57 of the 1999 Act, '*any aggrieved person*' can file for cancellation or rectification, which provides for a cause of action, and therefore, tying into the cause of action principle of Section 20 CPC. This principle aligns with Article 226 of the Constitution of India. While there can be no doubt that *forum non conveniens* can be applied by the Court, but the inherent existence of jurisdiction cannot be challenged. Further, following *Hardie Trading Ltd. v. Addisons Paint*



*and Chemicals Ltd.*⁹, the term ‘*person aggrieved*’ should be liberally interpreted. *Casus Omissus* should only apply if necessary, and if they prevent absurd results, which is not the case here. Thus, ‘*the High Court*’ has to be ‘*any High Court*’ having jurisdiction and such jurisdiction could exist even due to Section 20 CPC.

- Practical implications, including increased filings cannot be the basis to decide this legal issue. Reliance is placed upon the *State of Maharashtra v. Atlanta Holdings*¹⁰.
- Reference is made to Section 6 of the 1999 Act to argue that the Register of Trade Marks is no longer a physical register. It is a computerized register and can exist anywhere. It is also accessible from any location. Thus, to tie the mark to a physical register, which may have been the concept in the earlier regime, is no longer applicable.
- The whole purpose of the 1999 Act is to give flexibility and for having a single computerized register for registration with equal rights, thus, any interpretation based on an earlier enactment, which was a completely different regime, cannot be used in the present case.
- Reliance is placed upon the following judgments:
 - (i) *Caterpillar Inc. v. Kailash Nichani*¹¹
 - (ii) *Hardie Trading Ltd. (supra)*
 - (iii) *Shiv Shakti Co-operative Housing Society, Nagpur Vs. Swaraj Developers*¹²

⁹ (2003) 11 SCC 92

¹⁰ 2014 (11) SCC 619, paragraph 27

¹¹ 2001 SCC OnLine Del 1536

¹² (2003) 6 SCC 659



Submissions of Mr. Rajshekhar Rao, Id. Counsel for the Respondent No. 1 in C.O. (COMM.IPD-TM) 778/2022, C.O. (COMM.IPD-TM) 782/2022, C.O. (COMM.IPD-TM) 783/2022.

15. Mr. Rajshekhar Rao, Id. Sr. Counsel has made the following submissions:

- The submission is that the rectification petitions under Section 57 of the 1999 Act is not tied to the forum of the suit. Section 97 of the 1999 Act clearly supplants the existing framework and prescribes that a rectification petition can be filed before the High Court as prescribed. Once the High Court has passed judgment, the Registrar is required to give effect to the order. Therefore, the High Court in question must be one that exercises jurisdiction over the relevant Registrar's office. Section 3 of the 1999 Act contemplates the appointment of one Registrar; however, the Central Government may appoint other officers to discharge functions under the overall superintendence of the Registrar, indicating that the 1999 Act envisages a single Registrar.
- The Constitution of India also recognises the principles of territoriality as clear from a reading of Article 226. The only exception is Article 226 (2) of the Constitution of India, which allows High Courts to pass orders even if the concerned Department or Government is not located within its territorial limits. It is, further, emphasized that Section 124 of the 1999 Act takes care of any potential mischief that may be possible due to two forums exercising jurisdiction. It is the settled position that Section 124 of the 1999 Act permits the Court dealing with an infringement suit to stay proceedings upon the filing of a cancellation or rectification petition, thus eliminating the possibility of conflicting



rulings. The statute cannot be read in such a manner so as to lead to multiple cancellation petitions in different High Courts, which the trade mark owner/proprietor would have to defend. The right to revoke is vested in the High Court, and it is exercised by the High Court that has jurisdiction over the Appropriate office.

- The fundamental question is whether, following the passage of the TRA, the situation as it was under the 1940 Act should be reinstated, or if the approach under the 1958 Act should be considered relevant. In his submission, the approach under the 1958 Act should be applicable for the present purposes, as there is no provision in the 1999 Act equivalent to the proviso of Section 104 of the Patents Act, 1970. Furthermore, when a cancellation or rectification is filed concerning a trade mark, the 1999 Act does not envisage consolidating such rectification or cancellation with an action for infringement.
- Section 3 of the 1999 Act titled '*Appointment of Registrar and other officers*' could be interpreted in one of three ways. The first interpretation suggests that since the statute contemplates only one Registrar, headquartered in Mumbai, jurisdiction would solely lie with the High Court where the Registrar's head office is located. The second interpretation considers the 'Appropriate office', implying that the five High Courts with jurisdiction over these offices would have the authority. The third interpretation, based on Section 20 CPC, suggests that the rectification or cancellation petition could be filed before any High Court, based on the cause of action. However, the last interpretation could lead to considerable confusion and uncertainty, as it might result in multiple rectifications and cancellations before



different jurisdictions, affecting the consistency of approaches towards trade mark rights.

- He gives the example of Ahmedabad Appropriate office where the Gujarat High Court does not enjoy original jurisdiction and, thus, if the Appropriate office is Ahmedabad, only the cancellation would lie before the High Court and not the suit. In effect, if the Petitioner's argument is accepted, then the Court would by way of a decision, confer civil jurisdiction on a Court which does not have an Original Side. The 1999 Act contemplates suits and rectification petitions before different Courts and the same would not be inconsistent with the statute. Furthermore, the TRA significantly impacts High Courts by transferring the powers of the IPAB for all IPR cancellations and rectifications to the High Courts. The TRA also includes Section 34, authorizing the Central Government to make provisions for resolving any difficulties.

Submissions of Mr. Harish V. Shankar, Id. CGSC.

16. Mr. Harish V. Shankar, Id. CGSC, representing the Office of the Controller General of Patents, Designs and Trade Marks (*hereinafter*, 'CGPDTM'), made the following two-fold submission:

- Firstly, an examination of Section 57 of the 1999 Act in conjunction with Rule 4 of the 2017 Rules reveals that the Registrar and the High Court have concurrent jurisdiction over cancellation petitions. Consequently, the definition of 'Appropriate office' should not be interpreted differently for the Registrar and the High Court. The link between the 'Appropriate office' and either the Registrar or the High Court must be consistent, as outlined in Rule 4 of the 2017 Rules, for



any cancellation petition. These provisions should be read holistically, and *casus omissus* should not be readily inferred, as established by the Supreme Court in *Maulavi Hussein Haji Abraham Umari v. State Of Gujarat*¹³.

- Secondly, there is no omission requiring judicial intervention when Rule 4 of the 2017 Rules and Section 57 of the 1999 Act are read together.
- He finally relies upon the Statement of Objects and Reasons (*hereinafter*, 'SOR') of the Tribunals Reforms Bill 2021, which explicitly states that the said Bill's intention was to ensure that those High Courts, which would have otherwise dealt with these matters, are vested with the jurisdiction to continue doing so. Therefore, there was no legislative intent to create a new set of High Courts or to vest other High Courts, which previously did not have jurisdiction, with the authority to handle cancellation petitions. The relevant extract of the SOR is as follows:

“2. In the second phase, analysis of data of the last three years has shown that tribunals in several sectors have not necessarily led to faster justice delivery and they are also at a considerable expense to the exchequer. The Hon'ble Supreme Court has deprecated the practice of tribunalisation of justice and filing of appeals directly from tribunals to the Supreme Court in many of its judgements, including S.P Sampath Kumar versus Union of India (1987) 1 SCC 124, L. Chandra Kumar versus Union of India (1997) 3 SCC 261, Roger Mathew versus South Indian Bank Limited (2020) 6 SCC 1 and Madras Bar Association versus Union of India and

¹³ 2004 (6) SCC 672, paragraph 21



another (2020) SCC Online SC 962. Therefore, further streamlining of tribunals was considered necessary as it would save considerable expense to the exchequer and at the same time, lead to speedy delivery of justice.

3. Accordingly, the Tribunals Reforms (Rationalisation and Conditions of Service) Bill, 2021 was introduced in Lok Sabha on the 13th February, 2021 proposing to abolish certain more tribunals and authorities and to provide for a mechanism to file appeal directly to the Commercial Court or the High Court, as the case may be. However, as the Bill could not be passed in the Budget Session of Parliament and there was an immediate need for legislation, the President promulgated the Tribunals Reforms (Rationalisation and Conditions of Service) Ordinance, 2021 on 4th April, 2021 under clause (1) of article 123 of the Constitution.

4. The Tribunals Reforms (Rationalisation and Conditions of Service) Bill, 2021 which seeks to replace the Tribunals Reforms (Rationalisation and Conditions of Service) Ordinance, 2021 (Ord. 2 of 2021), inter alia provides for—

...

(ii) abolition of tribunals or authorities under various Acts by amending the Cinematograph Act, 1952, the Copyrights, Act, 1957, the Customs Act, 1962, the Patents Act, 1970, the Airport Authority of India Act, 1994, the Trade Marks Act, 1999, the Geographical Indications of Goods (Registration and Protection) Act, 1999, the Protection of Plant Varieties and Farmers' Rights Act, 2001, the Control of National Highways (Land and Traffic) Act, 2002;

(iii) transfer of all cases pending before such tribunals or authorities to the Commercial Court or the High Court, as the case may be, on the appointed date;"



Submissions of Mr. Kapil Wadhwa, Id. Counsel for the Respondent in C.O. C.O. (COMM.IPD-TM) 151/2022.

17. Mr. Kapil Wadhwa, Id. Counsel for the Respondent in *C.O. (COMM.IPD-TM) 151/2022* submitted as follows:

- that the expression '*the High Court*' ought to be given the same meaning, whether in the context of Sections 47 and 57 of the 1999 Act or in the context of Sections 91 and 92 of the 1999 Act. The term '*High Court*' cannot be given different meaning for the purposes of appeals under Section 91 of the 1999 Act and for the purposes of rectification/cancellation proceedings under Section 57 of the 1999 Act.
- He submits that going by *Godrej Sara Lee Limited v. Reckitt Benckiser Australia Pty Ltd*¹⁴ decision of the Supreme Court, the Court ought to take an interpretation that would be the same in respect of the cancellation proceedings and appeals.
- He further submits that in the judgment passed by the Coordinate Bench in *Dr. Reddys Laboratories Ltd. v. Fast Cure Pharma*¹⁵, the reasoning was based on the SOR of the Tribunals Reforms Bill, 2021. The Id. Single Judge noted that one of the reasons for the said Bill's enactment was the belief that the workload of the High Courts would not decrease and that the same High Courts would continue to adjudicate such cases even after the IPAB was enacted. However, the Coordinate Bench did not accept this reasoning in the SOR, and this was a key factor influencing their decision.

¹⁴ (2010) 2 SCC 535

¹⁵ 2023: DHC: 6324



18. On the above aspect, Mr. Adarsh Ramanujan, Id. Counsel submits that the convenience of the proprietor could have an impact on both sides, as proprietors on a number of occasions, choose to file infringement and passing off actions before a particular High Court, which may be away from the Court where the mark is registered. If the jurisdiction is kept flexible, then the cancellation petition can be heard by the same High Court, where the suit filed by the proprietor is pending. In addition, he submits that while Section 134 of the 1999 Act, protects the interests of the proprietor, under Section 57 of the 1999 Act in terms of *Hardie Trading Ltd. (supra)*, the interest of the general public also has to be kept in mind.

Submissions on behalf of the Counsels assisting the Court

19. Id. Counsels Mr. Vaibhav Vutts, Mr. Aditya Gupta and Mr. Nikhil Sharma appeared to assist this Court in the present matter.

Submissions of Mr. Vaibhav Vutts, Id. Counsel.

20. Mr. Vaibhav Vutts, Id. Counsel points out and relied upon Section 5 of the 1999 Act and Rules 4 to 8 of the 2017 Rules. He makes the following submissions:

- Rule 4 of the 2017 Rules specifies the criteria for determining the Appropriate office of the Trade Marks Registry for various trade mark-related proceedings, depending on the registered or pending status of the trade mark application and the location of the registered proprietor's or applicant's principal place of business in India. Rule 5 of the 2017 Rules provides that regardless of any changes in the location of the principal place of business or address for service of the registered proprietor or the applicant, the Appropriate office for any trade-mark-related proceedings would remain the same as determined, based on the



criteria specified at the notified date or the date of filing the application, as the case may be. The jurisdiction of the Trade Marks Registry would not be affected by such changes. Further, under Rule 6 of the 2017 Rules, for every trade mark already listed on the register at the notified date or registered afterward, the concerned Registrar shall record the Appropriate office of the Trade Marks Registry in the register. The Registrar has the authority to correct any errors in this entry if needed. In terms of Rule 7 of the 2017 Rules, all applications and proceedings pending before the Registrar, at the notified date concerning a trade mark shall be considered as transferred to the Appropriate office of the Trade Marks Registry.

- The scheme of the 2017 Rules would show that once the trade mark application is filed in a particular Office of the Trade Marks Registry, which is determined on the basis of the factors set out in Rule 4 of the 2017 Rules, it cannot be usually changed except under extraordinary circumstances. In fact, Rule 5 Trade Marks Rules, 2017 goes on to stipulate that even if the principal office, place of business or address for service is changed after the filing of the application or the grant of registration, the Appropriate office would still not be changed.
- The Appropriate office has been granted various powers under the 2017 Rules, including correction of any errors in any entries, making necessary amendments, handing the service and leaving of documents under Rule 8 of the 2017 Rules. It is mandatory that these actions have to be carried out by the Appropriate office. Furthermore, Rule 4 of the 2017 Rules stipulates that any application pending at the time when the 2017 Rules were enacted, would also be transferred to the Appropriate



office. Thus, the location of the Appropriate office determines the High Court which would exercise jurisdiction for the purposes of appeals, and as such proceedings are considered a continuation of the original proceedings. In the same manner, jurisdiction for entertaining rectification petitions under Section 57 of the 1999 Act should be determined on the basis of the location of the Appropriate office and ought to be filed before the High Court which exercises jurisdiction over the Appropriate office.

- The extant scheme under the 1999 Act, as it stood before the introduction of the TRA, was highlighted. It was submitted that, prior to the TRA, the IPAB was vested with the jurisdiction to entertain appeals under Section 91 of the 1999 Act. Drawing a parallel, it was stated that even the IPAB, a specialized forum for such matters, held hearings at locations where the Appropriate office was situated. Hence, even during the IPAB's regime, the jurisdiction for rectification petitions was clearly defined and not subject to flexibility. The said approach was designed to prevent the potential misuse of invoking the jurisdiction of various High Courts across the country based on the cause of action.
- It is submitted that if cause of action would be the sole determining factor for jurisdiction, then the registered proprietor, even on the issuance of a cease-and-desist notice, could potentially be dragged to different High Courts in the country. Such a situation is not contemplated under the 1999 Act and the 2017 Rules.
- One of the anomalies in the 1999 Act, as highlighted by referring to provisions of Chapter IVA, Section 36A to 36G of the 1999 Act is in



respect of applications filed under the Protocol relating to the Madrid Agreement Concerning the International Registration of the Marks adopted at Madrid on 27th June 1989 (hereinafter, '*Madrid Protocol*') where under Section 36C of the 1999 Act, international applications under the Madrid Protocol have to be dealt with by the '*head office of the Trade Marks Registry or such branch of the Trade Marks Registry*' as may be notified by the Central Government. Under this provision, till date, no notification has been issued, leading to all international applications being handled exclusively by the head office of the Trade Marks Registry located at Mumbai. This situation is causing inconvenience to both applicants and trade mark lawyers.

- The above situation is also causing a ripple effect in respect of the High Courts, which can exercise jurisdiction over disputes arising over international applications. Thus, there is an urgent need for the Central Government to duly issue a notification making Rule 4 of the 2017 Rules applicable even for applications under the Madrid Protocol. Thus, it is his submission that this anomaly deserves to be rectified by the Central Government. A reference is made to a public circular issued by the Registry of Trade Marks in January, 2018, that in cases where hearings are to be called for in applications filed under the Madrid Protocol, the hearing is fixed at the Appropriate branch of the Trade Marks Registry where the address for service of the applicant is located.
- Therefore, it is argued that under Rule 4 of the 2017 Rules the branch of the Trade Marks Registry which exercises the jurisdiction is decided on the basis of the '*territorial limits*' of the principal place of business



or the address of service, etc. Thus, territoriality continues to be maintained under the 1999 Act after the TRA has been enacted.

Submissions of Mr. Aditya Gupta, Id. Counsel.

21. Mr. Aditya Gupta, Id. Counsel assisting the Court has filed his written submissions, along with the relevant judgments. The following are his submissions:

- Two issues that arise for consideration, **firstly**, whether the Delhi High Court has jurisdiction over petitions seeking rectifications of marks granted by a Trade Mark Registry located outside New Delhi. **Secondly**, what would be the effect of the High Court not being defined in the 1999 Act.
- The Id. Full Bench of the Patna High Court in **Paritosh Kumar Pal v. State of Bihar**¹⁶ considered the applicability of the CPC to the Industrial Disputes Act, 1947 and has held that though the same may not be strictly applicable, the broad general principles which govern jurisdiction under CPC, would be applicable even to proceedings under the Industrial Disputes Act, 1947. He, thus, submits that the test ought to be ‘*substantiality*’ of the cause of action. Relying upon the said test, it is argued that even the Delhi High Court in **Federal Express Corporation v. Fedex Securities Ltd.**¹⁷ has taken the view that if a trivial or an insignificant part of the cause of action arises in Delhi, the Court would not have jurisdiction. Therefore, as long as the substantiality of the cause of action is considered, the concern that relaxing jurisdiction would lead to increased pendency is mitigated. In

¹⁶ 1984 SCC OnLine Pat 345.

¹⁷ 2017 SCC OnLine Del 7906.



this backdrop, he submits that *Girdhari Lal (supra)* applied the principle of dynamic effect.

- In the context of criminal cases, in *Madan Mohan Sahu v. State of Orissa*¹⁸. the High Court of Orissa has clearly held that if the High Court is not defined in the statute, it would be the High Court having territorial jurisdiction over the offence. Since the TRA aims to increase access to justice for litigants, jurisdiction should not be restricted to the Registry where the trade mark was granted. He submits that infringement actions are often filed before various High Courts, and the cancellation petition, even if the mark is not registered in that particular High Court's jurisdiction, should be filed and heard alongside the suit. This approach would prevent the multiplicity of proceedings and necessitates a flexible stance towards jurisdiction in cancellation petitions.
- He, further, submits that access to Courts, and justice was the one of the salutary principles based on which the 1999 Act was enacted and, thus, any interpretation which would indicate the contrary, ought to be avoided. He, further, submits that the term '*the High Court*' means the High Court, which has territorial jurisdiction and not much emphasis can be laid on the fact that article '*the*' is used in place of '*a*'.

Submissions of Mr. Nikhil Sharma, Id. Counsel.

22. Mr. Nikhil Sharma, Id. Counsel, appearing for the Applicant-Jyothy Labs Limited in *C.O. (COMM IPD-TM)71/2023 titled 'Jiva Ayurvedic Pharmacy Limited v. Jyothy Labs Limited'*, has assisted the Court, as his

¹⁸ 1995 SCC OnLine Ori 329.



client would be affected by the decision that may be rendered in these petitions. He has made the following submissions:

- The Parliamentary Debate in the Rajya Sabha on 5th May, 1958, regarding the 1958 Act, reveals the clear legislative intent regarding jurisdiction, as expressed by the then Minister of Commerce. It was emphasized that the trade mark owner should not be subjected to hardship by allowing the trade mark to be challenged in any High Court. This rationale was applied both to appeals and rectification petitions. The same legislative intent continues even under the 1999 Act during the functioning of the IPAB. The enactment of the TRA cannot take away this legislative intent by not defining the term '*the High Court*'.
- It is evident that the omission of definition of 'High Court' in TRA is a result of accident/oversight and not a result of deliberate omission done by the legislature. Thus, it is a classic case of *casus omissus*, where due to the manner in which the TRA has been enacted without much debate, the High Court definition may have been inadvertently missed out. The submission, therefore, is that the term '*High Court*' as defined under the 1958 Act should continue to govern the same interpretation even after the TRA.

Submissions on behalf of the Id. Amici Curiae

23. Mr. Alankar Kirpekar, Id. Counsel from the Bombay High Court, and Amicus Curiae appointed by this Court, made the following submissions:

- Firstly, he emphasized that various IP statutes establish separate regimes and mechanisms. The schemes of the said statutes differ from one another, and it is not permissible for the Court to import the



definition of '*High Court*' as provided under Section 2(1)(i) of the Patents Act, 1970 into the 1999 Act. Reliance is placed upon the decision of the Bombay High Court in *Lupin v. Johnson and Johnson*¹⁹ to emphasize this position.

- Secondly, while the word '*Tribunal*' was amended under Section 57 of the 1999 Act owing to the TRA, the expression used is 'the *High Court*' rather than 'a *High Court*' or 'any *High Court*' (*emphasis supplied*). He contends that since '*High Court*' is not defined within the 1999 Act, the use of the definite article 'the' before '*High Court*' implies that petitions under Section 57 of the 1999 Act for cancellation/rectification are maintainable only before one High Court, rather than multiple High Courts.
- He further urged the Court to consider the definition of High Court under the Constitution of India. Thus, the explanation '*the High Court*' can mean any of the following three -
 - i. The expression '*High Court*' as defined as under Article 214 of the Constitution of India;
 - ii. The expression '*High Court*' as defined under the special IP statutes viz. 1999 Act, Patents Act, 1970 and so on.
 - iii. The expression '*High Court*' as per any procedural law such as the CPC or the CrPC.
- Trade mark law in India is governed by a specific statute, namely the 1999 Act, which notably does not define '*High Court*'. Furthermore, with the removal of the definition of '*Tribunal*' under Section 2(1)(ze)

¹⁹ AIR 2015 Bom 50, paragraphs 37 & 38



of the 1999 Act by the TRA, determining the appropriate High Court for deciding rectification petitions requires considering the Office of the Trade Mark Registry, where the trade mark was registered.

- Reliance is placed upon the decision delivered by the Seven Judge Constitution Bench of the Supreme Court in *Khajoor Singh v. Union of India*²⁰, where the Supreme Court examined the Article 226 of the Constitution of India, as it then existed, prior to the enactment of the Constitution (Forty-second Amendment) Act, 1976 (*hereinafter, '42nd Amendment Act'*). The Supreme Court categorically held that the place where the effect of a particular act may be felt, would not come under the jurisdiction of that High Court. The jurisdiction of the High Court under Art. 226 of the Constitution, properly construed, depends not on the residence or location of the person affected by the order but of the person or authority passing the order and the place where the order has effect cannot enter into the determination of such jurisdiction.
- Following *Khajoor Singh (supra)*, the provision of Article 226(2) of the Constitution of India was added through the 42nd Amendment Act. The amendment introduced the concept of cause of action in writ jurisdiction. Specifically, Article 226 of the Constitution of India, as amended by the 42nd Amendment Act, vested in 'any' High Court the power of exercising jurisdiction in respect of any government or authority within its territory, where the cause of action, wholly or partly arose. This provision clearly stipulates that it applies notwithstanding the seat of such government or authority. Thus, the flexibility, which

²⁰ AIR 1961 SC 532, paragraph 13.



was introduced through Article 226(2) of the Constitution of India, which was later interpreted by the Supreme Court in *Kusum Ingots and Alloys Ltd. v. Union of India*²¹, would not be applicable in the present case, where the concept of cause of action, dynamic effect etc. is not recognized.

- In effect, the concept of dynamic effect or cause of action, is totally alien to Section 57 of the 1999 Act. He submits that even if both the parties consent to vesting a High Court with the jurisdiction to cancel a mark, such cancellation would be without jurisdiction, if the High Court is not the High Court which exercises jurisdiction over the Office, where the mark is registered.
- Any interpretation contrary to this would be prejudicial to the registered proprietor. For example, even the mere citation of a mark in an examination report could create a cause of action, leading to a cancellation petition being filed in an entirely different High Court, one where a third-party applicant is affected by the trade mark registration. This would also imply that multiple High Courts could handle cancellation petitions for a single registration.
- Therefore, when a special statute prescribes a specific manner or method for performing a particular action, the Office or the High Court should adhere to that prescribed procedure.
- Although the Trade Marks Registry has five offices under Section 5(2) of the 1999 Act and can be considered a single entity, it does not imply that any High Court can exercise jurisdiction over any mark. The literal

²¹ AIR 2004 SC 2321.



and purposive interpretation necessitates that the High Court interprets 'the High Court' as none other than the High Court where the trade mark was registered.

24. Thus, according to Mr. Kirpekar, Id. *Amicus*, the questions that arise before the Court in the present batch of matters stand answered in the following terms:

“a. Whether Hon’ble High Court at Delhi has jurisdiction to entertain the Petition seeking rectification of a Trade Mark bearing Trade Mark Application No.3897902 registered by Trade Mark Registry, Mumbai, in favour of the Respondent having his registered address in the State of Madhya Pradesh?

Ans: *If the aforesaid interpretation of Khajoor Singh (Supra) and Kusum Ingots and Alloys Ltd (Supra) are correct and considered as applicable to the term ‘The High Court’ and its power then, it can be stated that the respective ‘High Court’ having jurisdiction over the respective Trade Mark Registry is the appropriate ‘High Court’ within the meaning of Section 57 of the Trade Marks Act, 1999 as amended by Tribunal Reforms Act, 2021. The cause of action and effect of registration over the ‘Person Aggrieved’ beyond the territorial limits of the ‘High Court’ are not the relevant considerations u/s. 57 of the Trade Marks Act, 1999.*

b. Whether the Petitioner claiming to be ‘Person Aggrieved’ and on the basis of the residence / address / location of the Petitioner in Delhi is entitled to maintain a Rectification Application u/s.57 of Trade Marks Act, 1999 before this Hon’ble High Court?

Ans: *Since the Answer to the Issue No.1 is negative, then the Answer to this issue is also negative. In the present case, since the Registration is granted by the Registrar of Trade Mark (Mumbai), the ‘High Court’ within the*



meaning of Section 57 of Trade Marks Act, 1999 shall be the 'High Court, Bombay'.

c. Whether the Petitioner can maintain the Petition before this Hon'ble Court u/s.57 of Trade Marks Act, 1999 for the reasons that u/s. 5 (2) of Trade Marks Act, 1999, the Trade Mark Registry has a branch office at Delhi?

Ans:- That, the Registrar of Trade Marks has its Head Office in Mumbai and there are four branches at Delhi, Kolkata, Chennai and Ahmedabad. If, amenability of the particular authority is the criteria then it can be argued that, the 5 (Five) High Courts viz. High Court, Bombay (Mumbai), High Court Delhi, High Court, Calcutta (Kolkata), High Court Madras (Chennai) and High Court Gujarat (Ahmedabad) would have jurisdiction to try and entertain any Application in respect of any Trade Mark Registration granted by any Trade Mark Registry. On plain reading of Section 57 of Trade Marks Act, 1999 as amended it doesn't appear that, the intention of legislature is to vest the powers on any of the aforesaid 5 (Five) High Courts to cancel registration granted by the Trade Mark Registry beyond the territorial limits of 'The High Court', otherwise, the wording would have been somewhere reflecting such intention by usage of words 'Any registration granted by Any branch office of Trade Mark Registry'.

d. Whether the Petitioner can draw any parallel with the designation of 'High Court' under 2 (1) (i) of Patents Act, 1970 or import any definition of High Court from Patents Act, 1970 within the Trade Marks Act, 1999?

Ans :- It is a trite law that, the definition of 'High Court' under Patents Act, 1970 cannot be imported and read into the Trade Marks Act, 1999.

....



g. What is the effect of repeal of the definition of 'High Court' from the General Clauses Act, 1897 by virtue of amendment to the General Clauses Act, 1977?

Ans:- The effect of repeal of definition of 'High Court' from General Clauses Act, 1977 is to interpreted as follows:

- ***In absence of any specific definition of 'High Court' under the Trade Marks Act, 1999, the 'High Court' shall be given its plain meaning under Article 214 of Constitution of India;***
- ***The 'High Court' if defined under a Special or General Enactment shall be given its meaning as provided under the said statute and not otherwise.***
- ***The importation of definition of 'High Court' from one statute into another for interpretation of any provision of any statute is impermissible.***
- ***The full bench of Hon'ble High Court in Lupin Versus Johnson and Johnson³ , reported in AIR 2015 Bom 50 [Please refer to Para 38] has specifically and categorically come to the conclusion that the provisions of The Trade Marks Act, 1999, are not in peri materia to the provisions of Patents Act, 1970 and/or Designs Act, 2000.***
- ***In view of the above, the provisions of Section 57 of the Trade Marks Act, 1999 are required to be interpreted de hors the interpretation of any provisions of Patents Act, 1970.***

25. Mr. Arun Mohan, the Id. Amicus Curiae, from Chennai, commenced his submissions by referring to the 1940 Act. According to Section 46(1) of the 1940 Act, the cancellation of a registration could be effected by the High Court or by the Registrar. Under Section 2(d) of the 1940 Act, 'the High Court' was defined with reference to Section 219 of the GoI Act. Id. Amicus



proceeded to make the following submissions:

- The existing position under the 1940 Act, was considered to be unfavourable in India by the 1955 Ayyangar Committee Report. The said Report opined that the identity of the High Court, to which resort ought to be had for filing of the rectification petition, was not indicated with certainty under the 1940 Act. Thus, the 1955 Ayyangar Committee Report recommended establishing a territorial connection between the location of the Register of Trade Marks (defined under Section 4 of the 1940 Act) and the respective High Court. Consequently, it was opined that the High Court within whose jurisdiction the trade mark registration is obtained, should be the one to exercise jurisdiction over rectification petitions. This was also emphasised with the rationale, by the 1955 Ayyangar Committee Report that the High Court, which can exercise Appellate jurisdiction, ought to be the High Court which can also deal with the rectification petitions. Reliance is placed on paragraphs 41 to 43 of the 1955 Ayyangar Committee Report for this proposition. The relevant portions are extracted below:

“41. The first matter relates to applications for rectification under sections 37, 38, and 46 of the Act. The Trade Marks Act 1940, in line with the U.K. Act of 1938 vests in an applicant the option of applying either to the Registrar or the High Court for the rectification of the register. While there is no difficulty in locating the first mentioned forum, the identity of the High Court to which resort must be had in order to file the application for rectification is not indicated with any certainty. Though the definition of a High Court in section 2(d) of the Act appears comprehensive enough to include every High Court in the country, it cannot be that without any territorial connection between the locus of the Register



which is sought to be rectified and a particular High Court, that High Court could obtain jurisdiction to pass an order for rectification. Different views have been held as to what nexus is necessary to attract the jurisdiction of a High Court to any particular case. But without going into the correctness of the several views entertained by different Judges, it appears to me to be expedient to specify with certainty the High Court which will have jurisdiction in any particular case.

*42. The second matter relates to proceedings taken in pursuance of an order of the Registrar under section 10(3). Section 10(3) provides for orders by the Registrar referring parties to a “competent Court” to decide which among the applicants before him is entitled to have the mark registered. What that “competent Court” is, however, is not indicated by the section. The normal rule of construction would be that it is the Court which would have territorial and pecuniary jurisdiction under the provisions of enactments like the Civil Procedure Code and the Civil Courts Act. **But there might be appeals from the orders of the Registrar under section 10(3) questioning the propriety of his order referring the parties to a Court, and such appeals, lie only to a High Court. It is undesirable and would lead to complications if an appeal from the Registrar’s order should lie to one Court while the proceeding which might be taken in pursuance of his directions by a party who accepts that order has to be proceeded with in another Court. To resolve this possibility of conflict it would be necessary to make a provision directing that original proceedings under section 10(3) as well as appeals from the Registrar’s order under that section should both be heard by the same Court.** It appears to me that the law requires to be amended in this regard so as to avoid the difficulties. I have mentioned above.*

43. The third matter relates to appeals from the Registrar’s orders. The Act in general terms lays down



*that every order or direction of the Registrar passed under this Act or the rules framed thereunder is subject to an appeal to the High Court having jurisdiction. Which exactly is the High Court which could entertain and deal with appeals is, however, left in doubt. The head office of the Registry is located at Bombay with branch offices at Calcutta and Bangalore. One view might be that it is only the High Courts of Bombay, Calcutta, and Mysore that would have jurisdiction to entertain appeals from an order or direction of the Registrar. Whether this is the proper construction or whether orders passed by the Registrar while having hearings at any other place should be subject to an appeal to the High Court having jurisdiction over the place where the matter is heard, or whether such appeals could lie to any High Court irrespective of the place where the matter was heard by the Registrar, is left to be guessed. **There is much to be said for the view expressed by Abdur Rahman J. in the Lahore-High Court (in A.I.R. 1947 Lah. 171), where in dealing with the jurisdiction of a High Court to entertain an appeal from the Registrar's orders under section 76, he held that only that High Court would have appellate jurisdiction within whose territorial jurisdiction the Registrar who passed the order in question, has his office. There has been a conflict of opinion among the several High Courts as to the exact connotation of the expression "the High Court having jurisdiction" in section 76 of the Act. Without trying to resolve this conflict. I consider that it is proper and expedient that the Act should with clearness determine and provide that appeals shall be entertained by one Court only and indicate this with certainty.***

- Agreeing with Id. Amicus Mr. Kirpekar, Id. Amicus Mr. Mohan also distinguished between the rights under the Patents Act, 1970 and the Designs Act, 1999, on the one hand, and the rights related to passing off in respect of the trade marks. Further, unlike the Patents Act, 1970,



both the 1999 Act as well as the Copyright Act, 1957 have jurisdiction clauses *viz.* Section 134 of the 1999 Act & Section 62 of the Copyright Act, 1957 respectively, which completely reversed the applicable jurisdictional scheme under Section 20 CPC. The autonomy afforded to the right holder in determining its choice of jurisdiction for an infringement action is thus, markedly unique. Thus, the interpretation of Section 57 of the 1999 Act, that this Court should adopt, ought to take into account these principles. Any interpretation leading to jurisdictional uncertainty for a registered proprietor, would be contrary to the scheme of the 1999 Act itself.

- In light of the 1955 Ayyangar Committee Report, 1958 Act was enacted, which clearly defines ‘*the High Court*’ under Section 2(h), in conjunction with Section 3 of the 1958 Act. According to Section 3, titled “*High Court having jurisdiction under Section 3*”, the principal place where the applicant or registered proprietor is located, determines the relevant High Court. The said interpretation of Section 3 of the 1958 Act was upheld by the Andhra Pradesh High Court in ***Habeeb Ahmad v. Registrar of Trademarks, Madras***²², wherein it was held that, as far as rectification petitions are concerned, only the four High Courts where the respective Trade Marks Registry are located could exercise jurisdiction. In turn, ***Habeeb Ahmad (supra)*** relied upon the decision of the Madras High Court in ***Chunulal v. G.S. Muthiah***²³, which established the same principle.

²² AIR 1966 AP. 102

²³ AIR 1959 Mad. 359



- The primacy of trade mark owners/proprietors in determining jurisdiction is the essence of the 1999 Act, and it should not lead to undue inconvenience for them. If a cease-and-desist notice is issued, allowing the notice receiver to file a cancellation in any High Court would result in significant inconvenience to the trade mark owners/proprietors, which goes beyond the intent of the 1999 Act.
- Further, the Court should consider the principle laid down in *Heydon's Case*²⁴, as applied in *Indian Performing Rights Society Limited v. Sanjay Dalia*²⁵, to interpret the 1999 Act within its overall scheme. In *IPRS v. Sanjay Dalia (supra)*, the Supreme Court adopted such an interpretation and held that a purposive construction should be used to prevent any potential mischief.
- The conclusions of the Id. Amicus Mr. Arun Mohan are as follows:

“Conclusion:

a. Summarizing the foregoing, it is humbly submitted that the 1940 Act had a noticeable lacuna pertaining to the issue of which High Court would have territorial jurisdiction to hear cancellation applications. This anomaly was highlighted by the Ayyangar Committee Report, 1955, the contents of which have been reproduced hereinabove. Considering the recommendations therein, the Parliament passed the 1958 Act and delineated the High Courts within whose jurisdiction the office of registrar of trademarks is situate. This delineation of five High Courts (Delhi, Mumbai, Chennai Kolkata and Ahmedabad) is within the scheme of Article 226 of the Constitution of India 1950, given that the respective jurisdictional High Courts would have to call for records, and issue

²⁴ (1584) 76 ER 637

²⁵ (2015) 10 SCC 161



directions to comply with the provisions of the Act. **The 1999 Act telescoped the functions of these five High Courts having territorial correlation with the five trademark registries into the IPAB, which sat only at the places where the trademark registry was located.**

b. When the Tribunal Reforms Act, 2021 was enacted, it would axiomatically follow that the **powers of the IPAB in respect of appellate and cancellation proceedings would devolve only unto these five High Courts** which is the territorial scheme underpinning the 1958 and 1999 Acts.

...

d. This is practically effected as well, considering that the Central Government after abolishing the IPAB has directed that all pending matters in the IPAB be divided territorially only within the five High Courts which exercise territorial jurisdiction over the five trademark registries. Therefore, there has been complete consistency in the understanding of the legislature and the executive in the applicable territorial scheme of the Act, which, in my opinion, cannot be interfered with.”

Decision of the Coordinate Bench in *Dr. Reddys Laboratories Ltd. v. Fast Cure Pharma (supra)*

26. During the pendency of the present petitions before this Court, vide judgment dated 4th September, 2023, a ld. Single Judge of this Court in ***Dr. Reddys Laboratories Ltd. v. Fast Cure Pharma (supra)*** has taken the view that applications under Section 47 or Section 57 of the 1999 Act, as also under Section 124(1)(ii) of the 1999 Act, would be maintainable not only before the High Courts within whose jurisdiction the offices of the Trade Mark Registry which granted the impugned registrations are situated, but also before the



High Courts within whose jurisdiction the dynamic effect of the impugned registration is felt by the Petitioner. According to the Id. Single Judge, the dynamic effect of the impugned registrations having been felt by the Petitioners before this Court, petitions were found to be maintainable.

27. Considering that the present petitions raise identical questions before this Court, the decision in *Dr. Reddys Laboratories Ltd. (supra)* requires attention of this Court.

28. Further, as held by the Supreme Court in the *State of Punjab v. Devans Modern Breweries Ltd.*²⁶, judicial discipline and propriety demands that a decision made by a Coordinate Bench of the same High Court ought to be respected and is considered to be binding. However, this is subject to the right of a bench of equal authority to adopt a different view and refer the question to a larger bench for consideration.

29. In *Dr. Reddys Laboratories Ltd. (supra)*, the question before the Id. Single Judge was whether a petition under Section 47 or 57 of the 1999 Act, should be filed exclusively in the High Court having territorial jurisdiction over the office of the Trade Mark Registry where the impugned mark was registered. Alternatively, could such a petition be filed before another High Court, specifically, before this Court?

30. The findings and conclusions of the Id. Single Judge can be broadly summarized in the following terms:

- Following the principle of *expressio unius est exclusio alterius*, if the 1999 Act had specified a particular High Court for exercising jurisdiction under Sections 57 of the 1999 Act, then other High Courts

²⁶ (2004) 11 SCC 26



would stand excluded. However, the 1999 Act does not expressly exclude any High Court from exercising jurisdiction under Section 57 of the 1999 Act. Thus, there is “*no express statutory proscription against any High Court exercising jurisdiction*” either under Section 47 or 57 of the 1999 Act²⁷.

- In ***Girdhari Lal Gupta (supra)***, the Id. Full Bench noted that the legislature's decision not to restrict the jurisdiction for canceling the registration of a design (under the Designs Act, 1911) to only the High Court having jurisdiction over the particular Controller's Office (which granted the registration), likely indicated an intention not to confine jurisdiction to a single High Court²⁸. Further, the decision of the Supreme Court ***Kusum Ingots (supra)***, laid emphasis on the intrinsic relationship between the situs of a litigation, or an executive action under challenge, and its dynamic effect as felt by the litigant. The said intrinsic relation is now well embedded in law. The relevant portion is extracted below:

“30.4 The Full Bench, notes at the outset, in para 7, that the reason for the legislature for not confining, in the P & D Act, the jurisdiction to cancel the registration of a design only to the High Court having jurisdiction over the office of the Controller of Designs which granted registration, could only be that the legislature did not intend to confine jurisdiction to one High Court alone. At the same time, the Full Bench held that Section 51-A of the Designs Act could not be so interpreted as to permit the petitioner to file the cancellation petition before any High Court of his choice.”

²⁷ 2023: DHC:6324, paragraph 25.

²⁸ 2023: DHC:6324, paragraph 30.4.



30.5 *The real question to be addressed, according to the Full Bench, was the **identification of the situs of the High Court which had a real connection with the subject matter over which the jurisdiction was to be exercised. At the same time, it was held that the subject matter could not be treated as merely the registration and continuance of the registration of the design.** That was only the “static effect” of the registration. Inasmuch as the registration of a design gave the registered proprietor the right to enjoy monopoly over the design over all territories of India to which the P & D Act applied, the impact of the registration, constituting its “dynamic effect”, travelled beyond the place of registration.*

30.6 The Full Court went on to hold, therefore, that the cancellation petition could be filed either before the Court having jurisdiction over the Controller who registered the design, or over any petitioner who suffered the dynamic effect of the registration of the design.

...

30.7 *Kusum Ingots & Alloys Ltd v. U.O.I.– which is considered a watershed decision in territorial jurisdiction jurisprudence in the **context of writ petitions** – examined the issue of whether a writ petition, challenging a legislative enactment which had been applied by a judicial or executive authority to the prejudice of the petitioner, could be filed at Delhi, even though the petitioner was not located within the jurisdiction of this Court and had felt no effect of the legislation within such jurisdiction, merely because the situs of the Union legislature, which enacted the legislation, was in Delhi. **Answering the issue in the negative, the Supreme Court held that a writ petition would lie, not before the High Court having jurisdiction over the legislature which enacted the legislation, but over the location of the litigant who felt the effect of the legislation by the passing of the***



judicial or executive order based on the impugned legislation – which is what Girdhari Lal Gupta terms “the dynamic effect”. The intrinsic relationship between the situs of a litigation, or an executive action under challenge, and its dynamic effect as felt by the litigant is, therefore, fossilized in the law.”

- Applying *Girdhari Lal Gupta (supra)*, a rectification petition can be filed in any Court, within whose jurisdiction the dynamic effect of the registration of the Defendant’s trade mark is experienced. The said position is contingent upon the Petitioner proving that they are suffering the dynamic effect of the registration within that jurisdiction, either by actually accessing the impugned mark there, intending to do so, or, as in certain cases, where the impugned registration acts as an impediment to the petitioner securing their own mark's registration. Further, the Id. Single Judge observes as under:

30.11 To reiterate the note of caution sounded in para 9 of Girdhari Lal Gupta, however, that cannot justify a litigant petitioning a Court, for cancellation or removal of the respondent’s mark, before which he is neither feeling, nor is likely to feel any effect. That a provision of law cannot arm a litigant with a means of harassing his opponent is also trite; apart from Girdhari Lal Gupta, one may refer, in this context, to Ultra Home Construction Pvt Ltd v. Purushottam Kumar.

30.14 In the present case, however, the petitioner, in each of these petitions, is experiencing the dynamic effect of the registration of the impugned trade mark in favour of Respondent 1, within the jurisdiction of this Court. The petitions would, therefore, be maintainable before this Court even for that reason.

30.15 The position of law enunciated in Girdhari Lal Gupta, when applied to the Trade Marks Act, would,



therefore, in my view, render these petitions maintainable before this Court”.

- When enacting the TRA and restoring the High Court's power to adjudicate on rectification/cancellation petitions under Section 57 of the 1999 Act, the legislature did not endorse limiting jurisdiction exclusively to the High Court having jurisdiction over the Office of the Trade Marks Registry, which granted the said registration. Thus, the 1955 Ayyangar Committee Report and its recommendations, seen in the backdrop of the 1999 Act as amended by the TRA, indicates that the jurisdiction under Section 57 of the 1999 Act is not exclusively vested with the High Court having jurisdiction over the location of the Trade Marks Registry that granted registration to the impugned mark²⁹. Thus, it is observed as under:

*“31.7 Of stellar significance, in this background, is the fact that the legislature, while again clothing the “High Court” with powers of removal under Section 47, or rectification/cancellation/modification under Section 57 and Section 124(1)(ii), did not re-introduce the definition of “High Court” and “High Court having jurisdiction”, as found place in Section 2(d) and 3 of the 1958 TMMA. **The legislature, while enacting the Tribunals Reforms Act, and reviving power with the High Court to adjudicate on removal applications under Section 47 and rectification/cancellation applications under Section 57, did not approve of the proposal of restricting the jurisdiction only with the High Court having jurisdiction over the office of the Trade Marks Registry which granted registration.** The Ayyangar Committee report and its recommendations, seen in the backdrop of the Trade Marks Act, 1999 as*

²⁹ 2023: DHC:6324, Paragraph 31.7.



*amended in 2021, would, therefore, indicate that the **jurisdiction under Section 47, 57 or 124 (1)(ii) is not vested only with the High Court having jurisdiction over the situs of the Trade Marks registry which granted registration to the impugned mark.** ”*

- On the aspect of Rule 4 of the 2017 Rules, the said Rule does not address the jurisdiction of the High Court, but rather concerns the competence of the Office of the Trade Mark Registry to cancel, vary, or modify a trade mark registration under Section 57 of the 1999 Act. It states that only the particular Office that granted a particular registration has the authority to modify it. Further, the said Rule 4 does not influence the determination of the appropriate High Court's jurisdiction under Sections 57 or 124 of the 1999 Act³⁰. On this aspect, the observations are as follows:

“33.1 Mr. Vaidyanathan’s reliance on Rule 4 of the Trade Marks Rules in fact defeats the case that he seeks to espouse. Plainly read, Rule 4 does not deal with the jurisdiction of the High Court at all. It deals with the issue of the office of the Trade Mark Registry which would be competent to remove a trade mark under Section 47 or cancel or vary the registration of the trade mark under Section 57 of the Trade Marks Act. What is provided in Rule 4 is, in fact, but obvious. It is obvious that one office of the Registry of Trade Marks cannot possibly cancel, vary or modify a registration granted by another office. All that Rule 4 provides, is therefore, that the power to cancel, vary or modify the registration granted by a particular office of the Registrar of Trade Marks would vest only with that office and none other.

33.2 This Rule cannot, therefore, be possibly have any impact on the situs of the High Court which, under

³⁰ 2023: DHC:6324, Paragraph 33.1, 33.2.



Sections 57 or 124 of the Trade Marks Act would have the jurisdiction to examine a challenge to the validity of a registered trade mark. For the reasons aforesaid, that jurisdiction would vest not only with the High Court within whose jurisdiction the registering office of the Trade Mark Registry is located, but also with the High Court within whose jurisdiction a challenger experiences the dynamic effect of the registration.

33.3 Indeed, if the legislature intended to make Rule 4 of the Trade Marks Rules also applicable to the High Court which would have jurisdiction to adjudicate on an application for rectification of the register and cancellation of a registered trade mark, there is no reason why it would not have expressly said so. When I posed this query to Mr. Vaidyanathan, his response was that the situs of the High Court which would have jurisdiction to adjudicate on the rectification petition under Section 57 is clear even from the provision, by use of the words “the High Court”.

- The use of the term ‘the High Court’ in Section 57(1) of the 1999 Act does not necessarily refer to a specific High Court. The term ‘the’ is a general article and does not imply that only the High Court with jurisdiction over the Office that granted the impugned mark's registration can adjudicate on its validity. The relevant portions of the decision are set out below³¹:

“33.4...

To my understanding, the definitive article “the” ordinarily refers to something to which reference has been made earlier. If, therefore, earlier in Section 57 of the Trade Marks Act, there was reference to any particular High Court, then, by using the words “the High Court”, later in the said provision, the reference

³¹ 2023: DHC:6324, paragraph 33.4, 33.5.



would relate back to the High Court to which the earlier part of the provision alluded. There is, however, no reference to any particular High Court before the use of the words “the High Court” in Section 57(1) of the Trade Marks Act. The use of the word “the” cannot, therefore, be accorded more importance than it commands, which is basically only a means of designating a High Court, for which no article other than “the” would have been sufficed or been apposite in the context. In any event, the use of the article “the” before “High Court” in Section 57(1) cannot legitimately lead to an inference that it is only the High Court which has jurisdiction over the office of the Registrar of Trade Marks, which granted registration of the impugned mark, which can adjudicate on its validity.

33.5 In the absence of any provision analogous to Rule 4 of the Trade Marks Rules, designating any particular High Court as competent to exercise jurisdiction under Section 47 or Section 57 of the Trade Marks Act, there is no justification to create any such designation by judicial fiat. Apparently, the intent of the legislature was not to limit the jurisdiction, under Section 47 or Section 57, to any particular High Court.”

- In relation to the SOR of the Tribunal Reforms Bill, Paragraph 4 of the SOR neither explicitly nor implicitly suggests a limitation on the jurisdiction to entertain rectification petitions. It only indicates that the abolished Tribunals failed to alleviate the High Courts’ workload³².
- While the 1999 Act confers the power of cancellation, variation, or modification of a mark on both the Registrar and the High Court, this does not necessitate that their geographical locations be the same³³.

Thus, on this aspect, the observations are extracted below:

³² 2023: DHC:6324, paragraph 34.

³³ 2023: DHC:6324, paragraph 36.2, 36.3.



“36.2 I may note, there, that there appears to be an unjustified conflation of these two issues, in the arguments advanced by learned Counsel for the respondents. An impression seems to be existing, in their mind, that the High Courts, within whose jurisdiction the office of the Registry of Trade Marks which could exercise jurisdiction, whether under Section 47 or under Section 57, could alone exercise such jurisdiction. **There is no legal basis for such a presumption. The power of removal (under Section 47), or of cancellation, variation or modification (under Section 57), of the impugned mark, is undoubtedly conferred, by the statute, both on the Registrar and on the High Court. That does not mean, however, that the geographical location of the Registrar and the High Court must be the same.** Nor does it mean that the High Court, which could exercise jurisdiction, under these provisions, must necessarily be the High Court having territorial dominion over the Registrar. The prefixing of “High Court”, in Section 47(1) or 57(1) by the definite article “the” certainly does not lead to any such inference, at least as per any known principle of grammar or syntax.

36.3 Thus, though the Registrar, who could exercise jurisdiction under Section 47 or Section 57 would undoubtedly be the Registrar who granted registration to the impugned mark, the High Court which could exercise such jurisdiction would not only be the High Court having territorial dominion over such Registrar, but also any High Court within whose jurisdiction the petitioner experiences the dynamic effect of the registration.”

Analysis

31. The present batch of petitions raise an important legal issue concerning the interpretation of the term ‘The High Court’ as applicable to rectification/cancellation petitions *qua* trade marks under Section 57 of the



1999 Act. Before going into the specifics, some background is essential.

32. Trademark law in India was initially governed by the 1940 Act, which contained provisions in respect of High Courts and the powers of the High Courts. The provisions are as follows:

i) Section 2(d) of the 1940 Act read with Section 219 of the GoI Act dealing with the definition of High Court.

ii) Section 46 of the 1940 Act vested power of cancellation/rectification petitions with the High Courts.

iii) Section 76 of the 1940 Act, dealt with appeals to the High Courts.

33. Thereafter, the 1940 Act was replaced with the 1958 Act, wherein also, the term 'High Court' was defined as under:

"2...

(h) "High Court" means the High Court having jurisdiction under Section 3;

...

3. The High Court having jurisdiction under this Act shall be the High Court within the limits of whose appellate jurisdiction the office of the Trade Marks Registry referred to in each of the following cases is situate, namely :-

(a) in relation to a trade mark on the Register of Trade marks at the com-mencement of this Act, the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the proprietor of the trade mark as entered in the register at such commence-ment is situate;

(b) in relation to a trade mark for which an application for registration of pending at or is made on or after the commencement of this Act, the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the applicant as disclosed in his application is situate;

(c) in relation to a trade mark registered in the names of



joint proprietors before the commencement of this Act, the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the proprietor whose name is entered first in the register at such commencement as having such place of business is situate;

(d) in relation to a trade mark for which an application for registration in the names of joint proprietors is pending at or is made on or after the commencement of this Act, the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the proprietor whose name is first mentioned in the said application as having such place of business is situate;

(e) where the registered proprietor or the applicant for registration as afore-said has no place of business in India or where none of the jointly registered proprietors or none of the joint applicants as aforesaid has any place of business in India, the office of the Trade Marks Registry within whose territorial limits--

(i) in relation to trade mark on the Register of Trade Marks at the commencement of this Act, the place mentioned in the address for service in India as entered in the register at such commencement;

(ii) in relation to a trade mark for which an application for registration is pending at or is made on or after such commencement, the place mentioned in the address for service in India as specified in the application, is situate.”

34. Even under the above 1958 Act, powers were vested with the High Court for dealing with the following types of proceedings:

- i) Rectification/cancellation petitions under Section 56 of the 1958 Act.
- ii) Appeals under Section 109 of the 1958 Act.
- iii) Writ petitions arising out of proceedings before the Office of the



Trade Marks Registry.

35. Under the 1958 Act, the legal position was clearly established in *Habeeb Ahmad (supra)*, which, in turn, relied on *Chunulal (supra)*. It was held that the High Court with the jurisdiction to exercise power in relation to cancellation/rectification petitions, as well as appeals, would be the High Court within whose jurisdiction the application for trade mark registration was filed. Thus, both the decisions laid down the principle of territoriality when considering the jurisdiction of the High Court to entertain rectification petitions.

36. In *Habeeb Ahmad (supra)*, the High Court of Andhra Pradesh while interpreting Section 3 of the 1958 Act, held as follows:

“If a person wishes to apply for the registration of a mark he should go to the office which has jurisdiction over the area in which he has his principal place of business proceedings can be taken up only in the High Court having jurisdiction that is to say, if a trader has registered his trade mark in Bombay, then rectification proceedings will take place only in the office at Bombay or in the High Court at Bombay”

37. Similarly, the Id. Division Bench of the Madras High Court in, *Chunulal (supra)* observed as follows:

“...as the office of the Registrar of Trade Marks is situated in Bombay, the register of Trade Marks is kept at Bombay and the rectification is made in that register, it must be held that the High Court having jurisdiction in the matter is the High Court at Bombay and not the High Court at Madras.”

38. Under the Trade Mark Rules, 1959, the Appropriate office for registration of marks was divided as under:



<u>Mumbai</u>	<i>The State of Maharashtra, Madhya Pradesh, Chhattisgarh and Goa</i>
<u>Ahmedabad</u>	<i>The State of Gujarat and Rajasthan and Union Territories of Daman, Diu, Dadra and Nagar Haveli.</i>
<u>Kolkata</u>	<i>The State of Arunachal Pradesh, Assam, Bihar, Orissa, West Bengal, Manipur, Mizoram, Meghalaya, Sikkim, Tripura, Jharkhand and Union Territories of Nagaland, Andaman & Nicobar Islands.</i>
<u>New Delhi</u>	<i>The Union Territories of Jammu & Kashmir and Ladakh, Punjab, Haryana, Uttar Pradesh, Himachal Pradesh, Uttarakhand, Delhi and Union Territories of Chandigarh</i>
<u>Chennai</u>	<i>The state of Andhra Pradesh, Telangana, Kerala, Tamilnadu, Karnataka and Union Territories of Pondicherry and Lakshadweep Island</i>

39. Thus, if for example – a trade mark applicant based out of Kerala filed a trade mark application before the Chennai Office of the Trade Mark Registry, the jurisdiction for cancellation petitions, appeals and writ petitions, according to Section 3 of the 1958 Act vested in the Madaras High Court. The High Court exercising jurisdiction over the Appropriate office was the jurisdictional High Court, in respect of cancellation /rectification petitions under the 1958 Act.

Position under the 1999 Act when the IPAB was established:

40. The 1958 Act was replaced with the 1999 Act, which created a whole new framework by establishing the IPAB. The IPAB was constituted under Section 83 of the 1999 Act, and had its headquarters in Chennai, Tamil Nadu. However, IPAB Benches would hold hearings as per the jurisdiction of the Appropriate office of the trade mark application/registration or if parties gave consent, the Bench would hold hearings in any other jurisdiction as well. The IPAB Rules, however, contemplated the mention of the Appropriate office in



the index from itself. A sample IPAB form is extracted herein below:



DEPARTMENT FOR PROMOTION OF INDUSTRY AND INTERNAL TRADE
MINISTRY OF COMMERCE & INDUSTRY
G-62 to 67 & 196 to 204, August Kranti Bhawan,
Bhikaji Cama Place, New Delhi – 110 066.

SUBJECT: TRADE MARKS, JURISDICTION: DELHI, YEAR 2021

IPAB CASE NO.: SR.NO.21/2021/TM/DEL

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A perusal of the above would show that the numbering of the matters before the IPAB itself consisted of the jurisdiction such as AMD, BOM, DEL, KOL & MAD, etc.,

41. Under the 1999 Act, the term 'High Court' was no longer defined in



view of the establishment of the IPAB. However, broadly, the same procedure followed under the 1958 Act was continued even under the 1999 Act, *albeit* under the IPAB or its benches.

Enactment of Tribunals Reforms Act, 2021

42. In April, 2021, initially by way of the Tribunals Reforms (Rationalisation and Conditions of Service) Ordinance, 2021 and, thereafter, by the TRA, the IPAB was abolished. With the abolition of the IPAB, all powers previously vested in the IPAB reverted to the High Court. However, this transition occurred with a significant omission: the TRA did not define the term '*the High Court.*' The powers now vested in the High Court, which pertain to the handling of cancellation/rectification petitions, are contained in Sections 47 and 57 of the 1999 Act, and Section 91 of the 1999 Act for entertaining appeals from the Trade Marks Registry.

43. It also deserves to be noted that while the High Courts have powers under the 1999 Act, the Registrar of Trade Marks concurrently exercises powers under Sections 47 and 57 of the 1999 Act for cancellation/rectification. The question that arises is whether rectification/cancellation petitions can be filed before any High Court where the cause of action arises, or whether they should be governed by the appropriate office handling the trade mark application or registration.

44. There are a total of six cases in which the Court has heard submissions of the parties. The brief facts of each rectification petition are as under:

- In ***C.O. (COMM.IPD-TM)-151-2022***, the Petitioner-Liberty Footwear Co. seeks rectification of the Respondent's mark- 'LIBERTY STEEL' bearing registration no. 3559438 dated 29th May, 2017 in Class 6. The



Appropriate office of the impugned mark 'LIBERTY STEEL' is the Trade Marks Registry located in Mumbai.

- In **C.O. (COMM.IPD-TM)-778 /2022**, the Petitioner-Kohinoor Seeds Fields India Pvt. Ltd. seeks rectification of the Respondent's mark- 'VEDA BASANT GOLD' bearing registration no. 5078923 dated 7th August, 2021 in Class 31. The Appropriate office of the impugned mark 'VEDA BASANT GOLD' is the Trade Marks Registry located in Chennai.
 - In **C.O. (COMM.IPD-TM)-782/2022**, the Petitioner-Kohinoor Seeds Fields India Pvt. Ltd. seeks rectification of the Respondent's mark- 'VEDA TADAAKHA GOLD' bearing registration no. 5078922 dated 7th August, 2021 in Class 31. The Appropriate office of the impugned mark 'VEDA TADAAKHA GOLD' is the Trade Marks Registry located in Chennai.
 - In **C.O. (COMM.IPD-TM)-783/2022**, the Petitioner-Kohinoor Seeds Fields India Pvt. Ltd. seeks rectification of the Respondent's mark- 'VEDA SADANAND GOLD' bearing registration no. 5078921 dated 7th August, 2021 in Class 31. The Appropriate office of the impugned mark 'VEDA SADANAND GOLD' is the Trade Marks Registry located in Chennai.
 - In **C.O. (COMM.IPD-TM)-179/2023**, the Petitioner-The Hershey Company seeks rectification of the Respondent's mark- 'HARSHY' bearing registration no. 3897902 dated 25th July, 2018 in Class 31. The Appropriate office of the impugned mark 'HARSHY' is the Trade Marks Registry located in Mumbai.
45. Various counsel representing the parties, and those who have assisted



the Court, have presented their respective submissions. The decision on these issues would significantly influence how such petitions are filed/entertained before the different High Courts. Broadly, the issues raised by counsels for Petitioners include:

- i) The absence of a definition of '*the High Court*' in Section 57 of the 1999 Act suggest that the jurisdiction of the High Court should be determined based on principles similar to those in Section 20 of CPC;
- ii) The jurisdiction for suits regarding infringement and passing off related to trademarks is governed by Section 20 of the CPC. Therefore, determining the jurisdiction for handling cancellation/rectification petitions under Section 57 of the 1999 Act should follow a similar approach;
- iii) Every High Court, where the dynamic effect of impugned trade mark registration is felt, would have jurisdiction as per the decision in *Girdhari Lal Gupta (supra)*;
- iv) The absence of a definition for '*the High Court*' in the TRA implies that the legal framework established under the 1940 Act would remain applicable, rather than the framework under the 1958 Act. There is deliberate omission of a provision similar to Section 3 of the 1958 Act in the TRA, which indicates legislative intent under the 1999 Act.
- v) Generally, when a suit for infringement or passing off is filed, the same High Court ought to also handle the rectification petition, to avoid conflicting judgments and prevent multiple proceedings. Regard must be given to the fact that even after the



enactment of the TRA, Section 124 of the 1999 Act — which provides for the stay of proceedings when the validity of the registration of the trademark is questioned — has not been amended by the TRA.

- vi) Emphasis is laid on the convenience of parties and the need for flexibility in jurisdiction, opposing restriction to only High Courts where the Appropriate office is located. It is also argued that the intent of the 1999 Act is to protect the trade mark proprietor.

46. Based on the submissions above, and considering *Girdhari Lal Gupta (supra)*, the position that emerges is that, as per the Petitioners, jurisdiction to entertain rectification petitions under Section 57 of the 1999 Act could reside either with all High Courts where the dynamic effect of the impugned registration is felt, or solely with any of the five High Courts where the Appropriate office of the Trade Marks Registry is located.

47. *Per contra*, the perspective of some counsels who oppose such a broad interpretation is as follows:

- i) The trade mark proprietor or the applicant cannot be dragged to a High Court of inconvenient jurisdiction, as it would harm small businesses, SMEs, startups, etc., for whom it would be difficult to defend such litigation.
- ii) The broad and elastic interpretation of the dynamic effect of a trade mark could lead to the concentration of trade mark cases in only a few jurisdictions.
- iii) The High Court exercising jurisdiction ought to be such High Court under whose overall superintendence the Appropriate



- office of the Trade Marks Registry falls, akin to the powers exercised under Article 226/227 of the Constitution of India;
- iv) Since the Registrar of the Trade Mark Office, which can entertain such petitions, is governed under Rule 4 of the 2017 Rules by the Appropriate office, the jurisdictional High Court cannot be any different;
 - v) Vesting of powers in every High Court to deal with cancellation/rectification petitions could lead to prohibitive costs to the applicant or the registrant of the impugned mark;
 - vi) Despite the amendment of the 1999 Act by the TRA, the decision to keep Section 124 of the 1999 Act largely unchanged—except for substituting ‘Appellate Board’ with ‘High Court’—implies that the High Court with jurisdiction over the Registrar's office, where the trademark is registered and subject to rectification, should handle such cases. Further, the fact that Sections 3 and 4 of the 1999 Act, as well as Rule 4 of the 2017 Rules, remain unamended, further supports this legislative intent.
 - vii) Taking the view as suggested by the Petitioners, may lead to forum shopping, where the Petitioner may choose a High Court based on the perceived advantages, rather than on connection based on territoriality.
 - viii) The framework governing patents under Patents Act, 1970 is distinct from trade marks and copyrights. The provisions applicable to patents in terms of the Patents Act, 1970 cannot be extended to the provisions governing jurisdiction under the 1999 Act. The Patents Act, 1970 operates differently, as evidenced by



Section, which allows the High Court (and previously the Appellate Board or High Court) to revoke patents on specific grounds. The said legislative distinction between the Patents Act, 1970, and the 1999 Act, has been recognized by the Court, indicating the Parliament's intention to treat the said two legislations differently. Further, decision of this Court in *Dr. Reddy's (supra)*, pertaining to the Patents Act, 1970 ought not be used to interpret the provisions of jurisdiction under Section 57 of the 1999 Act.

- ix) The decision of the Id. Full Bench in *Girdhari Lal Gupta (supra)*, which involves the interpretation of the Designs Act, 1911, is not a suitable benchmark for determining jurisdiction under the 1999 Act, as it did not originally consider the creation or dissolution of IPAB. The situation created by TRA is completely unique.
- x) That the lack of a definition for 'High Court' in the TRA is due to an accidental oversight, rather than a deliberate omission by the legislature. There was no legislative intent to change the principle prevalent both under the 1958 Act as also under the 1999 Act, even when the IPAB was functioning. Thus, given this oversight, the Court should interpret the provisions of the 1999 Act as they currently exist in a harmonious manner, considering the context and purpose of the statute to ensure it remains meaningful. Reconciling the provisions of the 1999 Act aligns with the intended remedy provided by the statute.
- xi) Interpreting the 1999 Act, as amended by the TRA, in a way that



allows filing an application for rectification/cancellation before any High Court based on where the cause of action arises or where the dynamic effect of the registration is felt, could create a significant anomaly. Such interpretation could lead to an absurd situation where, while a registered proprietor can enforce rights under 1999 Act through a District/High Court under Section 134 of the 1999 Act based on residence, business location, or place of work, they might face severe inconvenience in protecting those rights. They could be forced to validate their registered marks before different High Courts across the country, which is unlikely to have been the Parliament's intention.

- xii) The appeals against the order of the Trade Mark Registry can only lie before the High Court under whose jurisdiction, the Appropriate office of the trademark registry would fall. Thus, for the purpose of appeals, the same expression '*the High Court*' cannot be given different meanings in Sections 47/57 of the 1999 Act on the one hand and Section 91 of the 1999 Act on the other hand. The expression has to be construed uniformly in the entire 1999 Act.
- xiii) The principle from *Heydon's Case*, as applied in the *Indian Performing Rights Society Limited v. Sanjay Dalia (supra)*, suggests that the Court should interpret the 1999 Act by considering its overall scheme and purpose, and to prevent any mischief that was sought to be curtailed. Applying this principle to the 1999 Act, especially after its amendment by the TRA, would mean interpreting it in a way that, upholds the practical



utility of trade mark law and ensure that trade mark rights are effectively protectable.

48. Some of the above issues have been considered by the Id. Single Judge in in *Dr. Reddy Laboratories Ltd. (supra)*, which in turn placed reliance on *Girdhari Lal Gupta (supra)*, rendered under the Designs Act, 1999. It is to be noted that the said decision in *Girdhari Lal Gupta (supra)* has also been followed by this Court in *Dr. Reddys Laboratories v. Controller of Patents (supra)* the context of the Patents Act, 1970, after enactment of the TRA. However, unlike the 1999 Act, the both the Patents Act, 1970 and the Designs Act, 2000, the term '*High Court*' has been defined. In both these statutes, the term '*High Court*' is defined as under:

Section 2(1)(i) of the Patents Act, 1970

“(i) “High Court”, in relation to a State or Union territory, means the High Court having territorial jurisdiction in that State or Union territory, as the case may be”

Section 2(e) of the Designs Act, 2000

(e) “High Court” shall have the same meaning as assigned to it in clause (i) of section 2 of the Patents Act, 1970 (39 of 1970)

49. As can be seen from the above, both in the Patents Act, 1970 and in the Designs Act, 2000, the term '*High Court*' has been defined. However, under the 1999 Act, the term '*High Court*' has not been defined. The omission of a definition for '*High Court*' within the 1999 Act, unlike its counterparts in the Patents Act, 1970 and the Designs Act, 2000 raises questions about the legislative intent and the jurisdictional scope of this Court to entertain rectification petitions under the 1999 Act. The inconsistency in defining '*High*



Court' across different IP statutes laws introduces a significant challenge in harmonizing the jurisdictional approach for rectification petitions under the 1999 Act. Thus, the applicability of *Girdhari Lal Gupta (supra)* in the context of the 1999 Act, as amended by the TRA, falls for consideration.

50. The Id. Single Judge in *Dr. Reddys Laboratories Ltd. v. Fast Cure Pharma (supra)* has followed the position in *Girdhari Lal Gupta (supra)* and taken a view that rectification petitions would be maintainable not only before the High Courts within whose jurisdiction the offices of the Trade Mark Registry which granted the impugned registrations are situated, but also before the High Courts within whose jurisdiction the dynamic effect of the impugned registration is felt by the Petitioner. Thus, the Id. Single Judge held that since dynamic effect of the impugned registrations was felt by the Petitioners before this Court, these petitions were maintainable before it.

51. However, for the following reasons, this Court is unable to subscribe to the view taken by the Id. Single Judge in *Dr. Reddys Laboratories Ltd. v. Fast Cure Pharma (supra)*:

- i) The decision of the Id. Full Bench in *Girdhari Lal Gupta (supra)* is inapplicable to the present context of interpreting jurisdiction under the 1999 Act, primarily because it pertains to the interpretation of the Designs Act, 1911. The Designs Act, 1911, as considered, did not encompass provisions related to the establishment or abolition of Appellate Tribunals such as the IPAB, a feature central to the 1999 Act, particularly after the TRA. Further, the scheme of the 1999 Act, is different from the scheme envisaged under the Patents Act, 1970, especially due to the nature of rights and remedies provided for. In this context, the Id. Full Bench of the



Bombay High Court in *Lupin Ltd. (supra)* held that the framework governing trade marks significantly differs from that of designs, and patents. The relevant portion of the decision is set out below:

*“38. Though the argument may appear prima facie attractive, it needs to be remembered that the Designs Act, 1911 and the Patents Act, 1970 do not contain the provisions of Sections 28 and 31 to be found in the Trade Marks Act, 1999. **It is for this reason that section 22 of the Designs Act and section 107 of the Patents Act provide that every ground on which registration of a design can be cancelled under section 19 of the Designs Act or every ground on which the patent may be revoked under section 64 of the Patents Act shall be available as ground of defence. We, therefore, find that the scheme of the Trade Marks Act is quite different from the scheme of the Designs Act and the scheme of the Patents Act.** As per the well-settled principles of statutory interpretation, the provisions in one statute are not to be interpreted by reference to the provisions in another statute.”*

- ii) The present batch of petitions are not a consequence of changes or amendments made to the substantive rights of trade mark proprietors under the 1999 Act. The present petitions are filed due to the effect of the TRA on the rights of the proprietors as also on the ground of being ‘*persons aggrieved*’. The impact of the TRA on the 1999 Act is distinct and should be considered separately from the effect of a trade mark registration. As is clear from the above extract SOR, the TRA primarily focused on the abolition of certain tribunals and the redistribution of their functions to existing judicial



bodies, whereas, the effect of an impugned registration pertain more to the practical implications on businesses and individuals involved in trade mark disputes. Thus, the TRA never intended to disturb or add to the existing rights and remedies under the 1999 Act. As per the SOR, the intention was limited- to abolish certain more tribunals and authorities and to provide for a mechanism to file appeal directly to the Commercial Court or the High Court, as the case may be. In the opinion of this Court, this characteristic of the TRA deserves to be recognized.

- (iii) The application of the ‘dynamic effect’, as interpreted by the Id. Full Bench in *Girdhari Lal Gupta (supra)*, presumes *casus omissus*, which was not the intention of the Legislature. Although the Id. Single Judge in *Dr. Reddys Laboratories Ltd. v. Fast Cure Pharma (supra)* acknowledges the principle of *expressio unius est exclusio alterius* (meaning: the express mention of one thing excludes all others), the application of the dynamic effect concept seems to contradict this legal maxim. The said approach potentially expands the scope beyond the explicit provisions, indirectly filling gaps that the Legislature did not address.
- iv) Paragraph 47 of the decision of the Id. Single Judge proposes a distinct framework for entertaining rectification petitions by the High Court compared to the Registrar of Trade Marks. According to this Court, such an approach, however, does not fully consider the implications of the term “or” within Sections 47, 57 and 91 of the Trade Marks Act, 1999, which implies a choice rather than a distinction in the procedure to be followed in entertaining such



- petitions. Additionally, the 1999 Act itself does not provide any guidance on whether the jurisdiction applicable to the High Court should diverge from that of the Registrar, leaving room for interpretation. Such absence of any guidance raises doubts about the basis for such a differentiated approach.
- v) The approach recommended by the Id. Single Judge, which allows different High Courts to exercise original jurisdiction over rectification petitions, raises questions regarding the interpretation and application of the 1999 Act. One of the implications of such an approach as suggested is that different High Courts would be conferred with original jurisdiction to entertain original rectification petitions, for which there is no clear indication from the scheme of the 1999 Act itself. Under the Patents Act, 1970, if a counter claim is filed then the patent dispute automatically moves to the concerned High Court. In such a situation, all High Courts where patent disputes are received or filed, would in effect be exercising original jurisdiction under the Patents Act, 1970. However, insofar as cancellation petitions are concerned, such an intent is not borne out from the 1999 Act or the TRA– though the spread of trade mark disputes across the country to all High Courts could be a positive move. The basis however needs to exist in the legislation.

52. In view of the significance of the issues raised in these cases, including the question as to whether *Girdhari Lal Gupta (supra)* would be applicable in the context of the 1999 Act, as amended by the TRA, this Court is of the opinion that the issues deserve to be considered by a larger Bench, as the said



decision was rendered by a Full Bench of this Court.

53. Accordingly, let these matters be placed before Hon'ble the Acting Chief Justice for constitution of a larger Bench for deciding the following questions:

- i) Whether the decision of the Id. Full Bench in *Girdhari Lal Gupta (supra)*, rendered under the Designs Act, 1911, would be applicable in the context of the Trade Marks Act, 1999 as amended by the Tribunal Reforms Act, 2021, for determining jurisdiction of a High Court under Section 57 of the 1999 Act?
- ii) Whether the jurisdiction of the High Court under Section 57 of the 1999 Act would be determined on the basis of the Appropriate office of the Trade Mark Registry, which granted the impugned trade mark registration?
- iii) Whether the expression '*the High Court*' can be differently construed in Sections 47, 57 and 91 of the 1999 Act?

54. Let the present petitions be placed before the Hon'ble the Acting Chief Justice for constitution of an appropriate Bench to decide these questions and any other questions that may arise.

55. These matters shall not be treated as part-heard matters.

PRATHIBA M. SINGH
JUDGE

FEBRUARY 9, 2024

Rahul/dn