

MANU/CP/0003/2009

Equivalent/Neutral Citation: 2009(40)PTC724(CB)

BEFORE THE COPYRIGHT BOARD

F. Nos. 1-17/2008-CRB(WZ) and 1-33/2008-CRB(WZ)

Decided On: 04.03.2009

D.K. Electrical of Gala No. 1 **Vs.** Sancheti Appliances Pvt. Ltd.

Hon'ble Judges/Coram:

Raghubir Singh, Chairman, M.S. Sullar, Rajendra Kumar Mishra and R. Ragupathi, Members

Counsels:

For Appellant/Petitioner/Plaintiff: Sanjeev Singh, Counsel

For Respondents/Defendant: S.K. Bansal, Counsel

ORDER

1. These two applications under Section 50 of the Copyright Act, 1957 are for removal of entries registered under Nos. A-78420/2007 and A-78421/2007 respectively. Both the matters were heard together on 27th January, 2009 at New Delhi.

2. Petitioner in the first case, M/s. D.K. Electricals in its petition has submitted that the Respondent has filed Civil Suit (O.S.) No. 1529 of 2006 in order to prevent the Petitioner from enforcing its rights in the trademark PRETTY. Respondent has also taken out an application for injunction under Order 39, Rules 1 and 2 read with Section 151 of the Code of Civil Procedure. Petitioner replied thereto. Respondent in or around the first week of November, 2006 also filed an application for cancellation of the Petitioner's trademark PRETTY under number 622754. Artistic work under number A-78420/2007 in the name of the Respondent is identical to the prior published artistic work of the Petitioner. Petitioner has submitted that the impugned work lacks originality and registration is in violation of Rule 16(3) of the Copyright Rules, 1958 since the Respondent filed the civil suit against the Petitioner on 2nd August, 2006 involving the trade mark PRETTY to which the Petitioner filed a written statement alongwith counter claim on 23rd February, 2007.

3. Respondent in its written statement has claimed its long use of trade mark PRETTY for its products. It has submitted as to its filing a civil suit bearing No. C.S(O.S) 1529 of 2006 before the Hon'ble Delhi High Court praying inter alia for passing a decree of permanent injunction restraining the Petitioner from passing off and violation of the Respondent's trademark PRETTY and infringement and passing off Respondent's copyright in the PRETTY label. Respondent has generally denied the averments of the Petitioner in its petition. Respondent company has filed an application dated 19.1.2009 under Section 69 of the Indian Partnership Act, 1932 and Order 30 Code of Civil Procedure as read with Section 151 Code of Civil Procedure submitting that the rectification application is not maintainable. Petitioner in its reply has submitted that the provisions of Section 69 of the Indian Partnership Act are not applicable in the instant case, as the same are concerned with matters arising out of contractual obligations. In matter of Order 30 Code of Civil Procedure, the Petitioner mentioned the names of three partners of the firm alongwith their addresses. It has enclosed a copy of the partnership

deed as well.

4 . Learned Counsel for the Petitioner submitted that the instant application is in pursuance of a statutory right and not a right flowing from a contract. Hence, the matter does not fall within the mischief of Section 69 of the Indian Partnership Act, 1932. He further submitted that the provisions of Order 30 relating to making available the names and addresses of the partners of the Petitioner partnership concerned to the Defendant are not applicable in the instant matter. However, he submitted that he has already made the relevant information available to the Respondent. He submitted that the main issue involved is violation of Rule 16(3) of the Copyright Rules, 1958. He submitted that the Petitioner is using the label PRETTY since 1992. It got its trade mark registration vide number 622754 dated 22.3.2004. Having come to know about the infringement of its mark, it filed police complaint on 22.7.2006. Respondent filed a Civil Suit (O.S.) No. 1529 of 2006, namely, Sancheti Appliances Private Ltd. v. M/s. D.K. Electricals in order to prevent the Petitioner from enforcing its rights in the trademark PRETTY. Respondent filed an application for the registration of the trademark PRETTY on 31st July, 2006 claiming user since 1980. Respondent filed passing off civil (O.S.) No. 1529 of 2006 relating to PRETTY on 2.8.2006. Respondent filed rectification application relating registered trade mark of the Petitioner No. 622754 on the subject matter PRETTY in the first week of November, 2006. Application dated 1.1.2007 for the impugned registration was filed in the Copyright registry on 8.1.2007 which was granted on 13.2.2007. Learned Counsel made further submissions for the lackness of the originality of the impugned artistic work.

5 . Learned Counsel for the Respondent, at the outset, dealt with the gamut of provisions relatable to Rule 16(3) of the Copyright Rules, 1958. He submitted that the rule was amended in 1992 and the rule does not envisage protection to pirators. Protection is envisaged for a genuine objector. He submitted that the impugned application is dated 1.1.2007 and the Petitioner filed its counter to the passing off suit filed in August, 2006 only on 23.2.2007. He drew our attention to the rival contentions of the Petitioner and the Respondent herein in C.S(O.S) 1529 of 2006 before the Hon'ble Delhi High Court. He drew our attention to the labels of both contending parties exhibited at pages 31 and 32 of the written statement of the Respondent. He submitted that the registration of trade mark of the Petitioner is of 1994. He argued that the contention is about the artistic work and not of a brand. In this connection he drew our attention to para 2 of the petition of the applicant wherein he has claimed as a prior user of the trade mark. Petitioner has claimed as a prior and original author of the artistic work in the trademark PRETTY under para 24 of petition. Hence a self conflicting proposition. He again emphasized that a distinction has to be made in between a pirator and creator. He drew our attention to page 371 of paper book wherein is placed the copy of the Trade Mark Journal No. 1329 Suppl (1) dated April 15, 2005 whereunder the application of the Petitioner was advertised under number 622754 as 'Proposed to be used'. He submitted that no evidence except the invoice of sale has been produced to show actual use. He took us to pages 99, 121 and 153 of the compilation of the Petitioner wherein certain references as to the use of label Pretty has been mentioned. Learned Counsel contended that these are not creditable evidences being a letter of communication to the Department of Central Excise, a price list and a letter from the dealer.

Learned Counsel drew our attention to the last partnership deed dated 14th April, 2007 whereunder Shri Jayant Kumar Jain has retired from partnership. The said Jayant Kumar Jain, as an individual, had filed a civil suit against the Respondent herein in Calcutta High Court alleging infringement of its trade mark Pritarm. Learned Counsel drew our

attention to para 10 of *Arora Associates v. Surinder Prakash Gupta*, 2007 (34) PTC 704 (CB) where this Board, in face of insufficiency of evidence adduced on the part of the Petitioner, had reached the conclusion that the Respondent could not have had the knowledge about the Petitioner's existence as a person interested in the subject matter of the artistic works under challenge and thus attracting provisions of Rule 16(3) of the Copyright Rules, 1958. Learner counsel, in addition, relied upon *Haldiram Bhujawala v. Anand Kumar Deepak Kumar*, MANU/SC/0144/2000 : AIR 2000 SC1287, *Milestone Entertainment Private Ltd. v. Anamika Sood*, 2001 PTC 141 (Bom), *Castrol Ltd. v. AK. Mehta*, 1997 PTC (17) (DB), *Jabbar Ahmed v. Prince Industries*, MANU/DE/0498/2003 : 2003 (26) PTC 576 (Del), *Lal Babu Priyadarshi v. Badshah Industries*, 2002 (25) PTC 173 (Pat.) (DB), *Deoki Hosier Factory v. Chittaranjan Kumar Tarvey*, 2008 (37) PTC 168 (CB), *Aurio Pharma Laboratories v. Prem Pathak*, MANU/CP/0011/2008 : 2008 (37) PTC 192 (CB), *Mars Incorporated v. Monica Galaxy Pvt. Ltd.*, MANU/CP/0015/2008 : 2008 (37) PTC 617 (CB), *Triloki Nath Gupta v. Durga Prasad Gupta*, MANU/CP/0003/2004 : 2004 (29) PTC 759 (CB), *Bata India Ltd. v. Khadim Holdings Pvt. Ltd.*, MANU/CP/0009/2008 : 2008 (37) PTC 171 (CB), *Kwality Ice Cream v. India Hobby Centre*, 1993 PTC 29, *Sakthi Kulangara Match Workers Industrial Co-operative Society Ltd. v. Arason Match Industries*, MANU/CP/0001/2006 : 2006 (33) PTC 542 (CB), *Hindustan Pencil Private Ltd. v. Universal Trading Company*, 1999 PTC (19) 379 and *Kickapoo Company v. Perry Bottling Company* 2000 PTC 477. In concluding submissions, the Learned Counsel emphasized that the protection of Rule 16(3) is not available to the Petitioner since it is not the rival claimant of the Respondent.

6. Counsel for the Petitioner, in reply, broadly reiterated the submissions earlier made. He drew our attention to a copy of price list of the Petitioner placed at page 128 of Petitioner's paper book showing the artistic work Pretty in relation to their products. He took us to the copies of the complaint filed with the police on 22.7.2006 placed at pages 141 and 142. He put reliance upon *Sakthi Kulangara Match Workers Industrial Co-operative Society Ltd. v. Arason Match Industries*, MANU/CP/0001/2006 : 2006 (33) PTC 542 (CB).

7. The first thing which needs our immediate attention is as to the maintainability of the application in face of the objections as to compliance of Order 30 of the Code of Civil Procedure and Section 69 of the Indian Partnership Act, 1932. Order 30, Rules 1 and 2 of Code of Civil Procedure obligates Petitioner to provide the names and addresses of the partners of the Petitioner-partnership firm. Petitioner is in compliance of the provisions in this regard-it having provided the relevant information to the Respondent. It is settled that non-eligibility of suing by an unregistered partnership is in relation to obligations arising out of a contract and not obligations arising out of common law or statutory provisions. This matter has been recently decided by this Board in *Chhaya Industries v. Lucknow Gramodyog Sansthan*, 2008 (38) PTC 514 (CB) relying upon *Haldiram Bhujawala and Anr. v. Anand Kumar Deepak Kumar and Anr.*, MANU/SC/0144/2000 : AIR 2000 SC 1287 : 2000 PTC (20) 147 (SC). There is nothing in the pleadings to infer that the Petitioner is a pirator of the artistic work. Notwithstanding this fact, there is nothing in Rule 16(3) of the Copyright Rules, 1958 denying the benefit under that rule to someone being a pirator who is otherwise entitled thereto. This leads us immediately to the main legal proposition raised herein relating to the violation of Rule 16(3) of the Copyright Rules, 1958. Amendment made in 1992 has further widened the gamut of Rule 16(3) and Form IV as has been held by this Board in *Bata India Ltd. v. Khadim Holdings Pvt. Ltd.* MANU/CP/0009/2008 : 2008 (37) PTC 171 (CB). This is with a higher purpose of maintaining the purity of the register and for that purpose to enable all who can contribute in that regard to make their

observations. In any case, the Registrar of Copyright, being a quasi-judicial authority, is competent enough to scan through the interests of a pirator, if there be any, at the stage of hearing. Shutting sunlight at this stage is dangerous. In face of the Respondent having filed a suit of passing off for the same label, being the same subject matter, against the Petitioner on it was obligatory upon it, before filing the impugned application on to give a notice to the Petitioner to enable it to come before the Registrar to file any objections.

8. Registration number A-78421/2007 relates to artistic work WINNER. Facts in this matter are broadly similar. Accordingly, counsel from both side relied upon the arguments made in the first case in relation to this case also. Petitioner is a proprietary concern and the Respondent is the same as in relation to the other e impugned registration. Herein also, impugned application for registration of artistic work WINNER is preceded by a civil suit as to passing off filed by the Respondent against the Petitioner resulting into the same situation as we have concluded in relation to the first case.

9. Accordingly, we order for the expunction of both the entries from the Register. No order as to costs.

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