

MANU/GJ/0003/2015

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IN THE HIGH COURT OF GUJARAT AT AHMEDABAD

Special Civil Application No. 13630 of 2013

Decided On: 06.01.2015

Kaveri Hotels Private Limited **Vs.** Intellectual Property Appellate Board

Hon'ble Judges/Coram:

Paresh Upadhyay, J.

Counsels:

For Appellant/Petitioner/Plaintiff: S.N. Soparkar, Senior Advocate and Pratik Y. Jasani, Advocate

Case Note:

Intellectual Property Rights - Registration application - Validity of amendment - Sections 21(2) and 22 of Trade Marks Act, 1999 - Present petition filed for challenging order whereby, Registrar had allowed request for amendment of applications for registration and had not abandoned same - Whether Registrar had committed any error by allowing request for amendment of applications for registration and by not treating said applications as having been abandoned in view of Section 21(2) of Act - Held, Section 22 of Act confers power of amendment on Registrar - Court found that Registrar had not committed any error in exercise of said powers - Further, Board, which was statutory authority, had also gone into this aspect and had not found any illegality in said decision of Registrar - For abandon of application, it was contended on assumption that there was no counter statement to notice of opposition of Petitioner - However, counter statement was filed by Respondent - Therefore, order of Registrar was valid and could not be interfered - Petition dismissed. [para 6]

JUDGMENT

Paresh Upadhyay, J.

1. Challenge in this petition is made to:--

"(i) The common order dated 29.01.2010 passed by the Deputy Registrar of Trade Marks, Ahmedabad - respondent No. 3 disposing of the interlocutory petitions dated 19.11.2009 and request on Form TM-16 dated 09.07.2004 & 30.03.2005 in Applications No. 1073208 & 1253884, respectively. The Deputy Registrar has, by the said order, allowed the request on Form TM-16 and disallowed the interlocutory petitions dated 19.11.2009 filed by the present petitioner before it.

(ii) The above order was challenged by the present petitioner before the Intellectual Property Appellate Board - respondent No. 1, and the Board has also confirmed the order passed by the Deputy Registrar of Trade Marks vide its order No. 83/2013 dated 15.04.2013 in OAs No. 1 & 2/2012/TM/AMD and M.Ps. No. 66 & 67 of 2012."

It is these orders, which are challenged in this petition. It is noted that, the proceedings of the main applications, being Applications No. 1073208 & 1253884 are still pending for adjudication before the Deputy Registrar of Trade Marks, Ahmedabad.

2. Heard Mr. S.N. Soparkar, learned senior advocate with Mr. Pratik Y. Jasani, learned advocate for the petitioner and Mr. S.K. Bansal, learned advocate for Mr. Harshadray A. Dave, learned advocate for the contesting respondent No. 2.

3.1 Facts, as emerging from record, and as reflected in the impugned orders, which are relevant for the purpose of deciding this petition, are as under.

3.2 An application for registration of a trade mark was filed on 11.01.2002 with the office of the Registrar of Trade Marks at Ahmedabad by one Mr. Gulraj Vaswani, as the proprietor of CHOKHI DHANI, to register the mark (logo) 'Chokhi Dhani' in respect of 'food items, ready to serve food' (Class-30). The said application came to be registered as Application No. 1073208. Before acceptance, as required under the law, the said mark was advertised in the Trade Marks Journal No. Mega (2) dated 25.09.2003.

3.3 Second Application was filed by the same person on 08.12.2003 with the same mark for registration under Class-42. The said application came to be registered as Application No. 1253884. The said mark was advertised in the Trade Marks Journal No. 1327 Supp (2) dated 10.01.2005.

3.4 The original applicant Mr. Gulraj Vaswani, Proprietor of M/s. Chokhi Dhani entered into an agreement with M/s. Pink Pearl Leisure & Amusement Pvt. Ltd., on 08.04.2004. Thereby, the business of Mr. Gulraj Vaswani was taken over by the Company. Consequential application, praying for correction in the name of the applicant also came to be made to the Registrar in Form TM-16. The said Company has thereafter changed its name to 'Chokhi Dhani Resorts Pvt. Ltd.'.

3.5 In the meantime, the present petitioner filed the notice of opposition, opposing the grant of registration of the applications. Against the said opposition, counter statement was filed on behalf of the present respondent No. 2.

3.6 The said objections of the present petitioner are yet to be considered on merits by the Authorities below. For this reason, details in that regard are not reflected here.

3.7 During pendency of applications in Form TM-16 for correction and amendment in the name of the applicant in view of taking over the business by the Company i.e. the present respondent No. 2, applications were filed by the present petitioner before the Registrar taking a stand that, since Mr. Gulraj Vaswani has not filed counter statement to the opposition, in view of provisions of Section 21(2) of the Trade Marks Act, 1999, the applications (being Applications No. 1073208 & 1253884) be deemed to have been abandoned by the applicant.

3.8 The Registrar has allowed the change in name of the applicant (TM-16) and has rejected the argument of the present petitioner that, no counter statement to the opposition is filed on behalf of the original applicant and thereby in view of provisions of Section 21(2) of the Trade Marks Act, 1999, the applications (being Applications No. 1073208 & 1253884) be deemed to have been abandoned by the applicant. As noted above, it is only this part, which is the scope of this petition.

3.9 Further, the said order of the Registrar was already questioned before the Statutory Authority i.e. the Board. The Board has refused to interfere for the reasons recorded by

it. The matter is large open before the Registrar, on merits, including the opposition of the present petitioner on merits.

4. Learned senior advocate for the petitioner has submitted that, no opposition came either in the name of, or under the power of, or on behalf of the original applicant and therefore the same was fatal in view of mandatory provision of Section 21(2) of the Act. It is also submitted that, the counter statement to the opposition was filed by the third party, a stranger to the proceedings. It is further submitted that, the original applicant had not authorised the present respondent No. 2 to file counter statement or had agreed to the counter statement to the opposition. It is further submitted that, the amendment, as contemplated under Section 22 of the Act, would not mean substitution of the applicant altogether and therefore, the request on behalf of the original applicant in TM-16 ought not to have been allowed by the Registrar. It is submitted that, the impugned orders be quashed and set aside. Learned advocate for the petitioner has also addressed the Court at length and in support of his submissions and reliance is placed on the following decisions.

"(1) Gopal Krishan v. M/s. Mex Switchgear Pvt. Ltd. and another - 1993 PTC-1 Vol. XIII.

(2) Nizar Sadaruddin Khoja v. Vaibhav Construction and others - MANU/GJ/0302/1997 : 1997 (2) GLR 1521.

(3) Devkinandan Lal v. Jogendra Prasad - MANU/BH/0015/1980 : AIR 1980 PATNA - 71.

(4) Archie Comic Publications, Inc. v. Purple Creations Pvt. Ltd. and others - MANU/DE/0635/2008 : 2008 (37) PTC 279 (Del.).

(5) Pandit Rudranath Mishir v. Pandit Sheo Shankar Missir - MANU/BH/0014/1983 : AIR 1983 PATNA 53.

(6) Kedarnath Kanoria v. Khaitan Sons and Co. -MANU/WB/0102/1959 : AIR 1959 Calcutta 368.

(7) Oberai Forwarding Agency v. New India Assurance Company Ltd. and another - MANU/SC/0063/2000 : (2000) 2 SCC 407.

(8) Economic Transport Organization, Delhi v. Charan Spinning Mills Pvt. Ltd. and another - MANU/SC/0113/2010 : (2010) 4 SCC 114.

(9) Sanjeeva Reddi v. Johanputra Reddi - MANU/AP/0060/1972 : AIR 1972 Andhra Pradesh 373.

(10) Avinash Kumar Chauhan v. Vijay Krishna Mishra -MANU/SC/8502/2008 : AIR 2009 SC 1489 (1).

(11) Scientific Soap Works and another v. Dalsukhbhai Mangaldas Shah and another - MANU/MH/0018/1958 : AIR 1958 Bombay 47."

5. On the other hand, learned advocate for the respondent No. 2 has submitted that the petitioner does not have any case on merits and therefore even after about a decade, the matter is contested only on technicality and the matter is not permitted to be heard on merits. It is submitted that, the trademark is a property and the same is taken over by the successor in title and there is no dispute between the original applicant and the

respondent No. 2 and the bridging documents were very much on record to satisfy the authorities below that it is only the present respondent No. 2 who would have locus to proceed further with the proceedings in question. It is submitted that, the authorities below have gone into the question in detail and cogent reasons are recorded in the impugned orders and no interference be made by this Court. It is submitted that, this petition be dismissed. Learned advocate for the respondent No. 2 has also addressed the Court at length on merits of the matter and has relied on the following authorities.

- "(1) Sun Pharmaceuticals Industries Limited v. Cipla Limited - MANU/DE/1527/2008 : (2009) (39) PTC 347 (Del.)
- (2) Rangoli Chemfoods Pvt. Ltd. & Ors v. Indo Brine Industries Ltd. - MANU/GJ/0955/2012 : 2013 (53) PTC 606 (Guj.)
- (3) Hem Corporation Pvt. Ltd. & Ors v. ITC Limited -MANU/MH/0535/2012 : 2012 (52) PTC 600 (Bom.)
- (4) Monghibai v. Cooverji Umersey MANU/PR/0023/1939 : AIR 1939 Privy Council 170.
- (5) Dhurandhar Prasad Singh v. Jai Prakash University and Ors. - MANU/SC/0381/2001 : AIR 2001 SC 2552
- (6) Amit Kumar Shaw v. Farida Khatoon - MANU/SC/0284/2005 : AIR 2005 SC 2209
- (7) Radico Khaitan Ltd. v. Brima Sagar Maharashtra Distilleries Ltd. - MANU/DE/3230/2014 : 2014 (60) PTC 405 (Del)
- (8) Niau v. Kunwar Sen (S.A. No. 1159 of 1957) - 1966 ALJ 135.
- (9) Harmohan Singh v. Gurbax Singh - MANU/DE/0615/2001 : 2001 PTC 629 (Del).
- (10) Harsh Vardhan Rastogi v. Champion Publications -MANU/DE/2162/2007 : 2007 (35) PTC 365 (Del.).
- (11) Wander Ltd. v. Antox India (P) Ltd.-MANU/SC/0595/1990 : 1991 (11) PTC 1
- (12) Cinni Foundation v. Raj Kumar Sah & Sons & Anr. -MANU/DE/2304/2009 : 2009 (41) PTC 320 (Del.)
- (13) Bloomfield Co. Ltd. v. Bagaria Business (P). Ltd. -MANU/WB/0387/2001 : AIR 2002 Calcutta 85."

6.1 Having heard learned advocates for the respective parties and having gone through the material on record, this Court finds as under.

6.2 The point for consideration before this Court is, as to whether the Registrar has committed any error (i) by allowing the request for amendment of the applications for registration in Form TM-16, and further (ii) by not treating the said applications (being Applications No. 1073208 and 1253884) as having been abandoned in view of Section 21(2) of the Act. Though arguments are advanced in detail and number of authorities are cited by both the sides, the scope of this petition, as noted above, is very limited,

since not only the original applications for registration are yet to be considered by the Registrar, even the objections of the present petitioner are also yet to be considered on merits by the said Authority.

6.3 So far the grievance against the amendment in the application, as permitted by the Registrar is concerned, Section 22 of the Act confers that power on the Registrar and considering the totality, this Court finds that the Registrar has not committed any error in exercise of the said powers. Further, the Board, which is the statutory authority, has also gone into this aspect and has not found any illegality in the said decision of the Registrar. This Court does not see any legal infirmity either in the decision of the Registrar or of the Board which is questioned in this petition. It also needs to be recorded that, trade mark is a property and there is no prohibition of passing on the title over it by its original applicant to another person, and in the event the change as sought for in this case is not permitted, a vacuum like situation may crop up, since the original applicant may not have locus or atleast interest to proceed with the application, and the person/entity stepping into his shoes would be condemned as a stranger to the proceedings. The procedural law cannot be stretched to make the proceedings on merits otiose.

6.4 So far challenge to the rejection of the interlocutory petitions of the present petitioner by the Registrar is concerned, the same is without any substance for the reason that the thrust thereof was that, in view of Section 21(2) of the Act, the applications should have been deemed to have been abandoned. It was so contended on the assumption that there was no counter statement to the notice of opposition of the present petitioner. It is not that there was no counter statement to the notice of opposition, but it was filed by the entity which had taken over the business of the original applicant. Amendment application in that regard was already filed before the Registrar, which the Registrar has subsequently allowed. In view of this, the argument of the petitioner that it is the original applicant, who should have filed counter statement to the opposition, and having failed to do so, the applications should be deemed to have been abandoned was based on the ill-assumed rejection of amendment applications. The agreement between the original applicant and the present respondent No. 2 is on record. Further, the Registrar has asked for the affidavit of the original applicant to avoid any complication as perceived by the petitioner. This Court had, during the course of hearing, also inquired from the respondent No. 2 in that regard. In response thereto, the affidavit of the original applicant dated 20.12.2014, as asked for by the Registrar, was also presented to the Court, however, the original thereof is returned to the learned advocate for the respondent No. 2 to present it before the Registrar. This Court has gone through the contents thereof, after giving copy thereof to the learned advocate for the petitioner, for the limited purpose of satisfying conscience with regard to the exercise of power by the Registrar. On this additional count also, this Court finds that the Registrar has exercised his powers with due diligence, which is questioned in this petition.

6.5 For all these reasons, this petition needs to be dismissed. It is noted that, both the learned advocates have addressed the Court at length and have also relied on number of authorities to substantiate each legal submission, however, as noted above, the scope of this petition is very limited and therefore, only those arguments are considered which are relevant for the purpose of deciding the point which has fallen for consideration before this Court. For this reason, all those arguments are not reflected or the authorities are not discussed in this order.

6.6 So far the argument of learned advocate for the petitioner that, no opposition came

either in the name of, or under the power of, or on behalf of the original applicant and therefore the same was fatal in view of mandatory provision of Section 21(2) of the Act is not well founded in the present case. The argument that the counter statement to the opposition was filed by the third party is also not well founded in view of the material on record. The objection that the original applicant had not authorised to file counter statement or had agreed to the counter statement to the opposition is non-existent in the present facts. Thus, none of the contentions raised on behalf of the petitioner would take the case of the petitioner further. The authorities cited, as noted above, would not help the petitioner in the facts noted above.

6.7 Considering the totality this petition needs to be dismissed.

7 . For the reasons recorded above, this petition is dismissed. Rule is discharged. Interim relief granted earlier is vacated.

8. At this stage, learned advocate for the petitioner has submitted that, by the interim order of this Court dated 04.10.2013, proceedings in question before the Deputy Registrar of Trade Marks was stayed and the said interim protection be continued for some time. Learned advocate for the respondent has opposed this request. Considering the totality, it is ordered that, the interim relief granted by this Court vide order dated 04.10.2013 shall continue till 06.02.2015.

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