

**Legal Issues in ‘Jurisdiction of High Court for Filing Trademark
Rectification Petition’**

**Topic: ‘Whether the Jurisdiction of the High Court for filing Trademark
Rectification Petition is determined based on where the Appropriate Office is
situated?’**

Relevant Legal Provisions

❖ *Section 47, The Trade Marks Act, 1999*

“Removal from register and imposition of limitations on ground of non-use-

*(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or **the High Court** by any person aggrieved.”*

(Emphasis supplied)

Relevant Legal Provisions (Contd.)

❖ *Section 57, The Trade Marks Act, 1999*

“Power to cancel or vary registration and to rectify the register-

On application made in the prescribed manner to the [High Court] or to the Registrar by any person aggrieved, the [Register or the High Court, as the case may be,] may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.” (Emphasis supplied)

Relevant Legal Provisions (Contd.)

❖ *Section 125, The Trade Marks Act, 1999*

“Application for rectification of register to be made to [High Court] in certain cases—

(1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff’s trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff questions the validity of the registration of the defendant’s trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register and, notwithstanding anything contained in section 47 or section 57, such application shall be made to the [High Court] and not the Registrar” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ Watkins Mayor & Co. v. Registrar Of Trade Marks [AIR 1952 PUNJAB 266]

“It is true that Abdur Rahman, J., in 'Abdul Ghani Ahmed v. Registrar Of Trade Marks', AIR 1947 Lah 171, said that unless there was a Branch Registry in the Punjab an appeal from the Registrar's decision, whether given at Bombay or Calcutta, did not lie to the Lahore High Court. After considering the two judgments I prefer to follow the view taken by Das, J. The words used in Section 46 are "a High Court" and not "the High Court having jurisdiction. Mr. Gosain submitted that it is a case of 'casus omissus' and that "a High Court" should be read as if the words are "the High Court having jurisdiction." The words "a High Court" are used not only in Section 46 but also in Section 72 of the Act. "High Court" under the Act means a High Court as denned in Sub-section (1) Of Section 219 of the Government of India Act, 1935. In Section 76 the Legislature has used the words "High Court having jurisdiction." (Emphasis supplied)

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“In my opinion, it is not open to this Court to add words in Section 46 which do not exist. The language used in Sections 46 and 72 on the one hand and 76 on the other makes it quite clear that the Legislature deliberately used the words "a High Court" and therefore this Court, in my opinion, will have jurisdiction to decide this matter. I, therefore, overrule this objection and direct that the matter may now be heard.” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ Sri Chamundeeswari Weaving And Trading v. The Mysore Spinning And Manufacturing [AIR1962MAD214]

*“In our opinion, the question of jurisdiction of the High Court to entertain a petition for rectification has first to be decided having regard to the nature of the proceedings. Now, a registered Trade Mark under the Act confers a right of property in the person in whose favor the mark is registered. That ownership arises by virtue of registration. If the registration of a trade mark is impugned under the rectification proceedings, the grievance is either against the Act of registration or against the person who has become the owner thereof by virtue of such registration. **Any application impugning the Mark, and thereby the property rights of the registered owner, should either be filed at the place where the registration is effected or at the place where the owner resides or carries on his business. Apart from these two places, there cannot be any other place in which the grounds for a petition for rectification can be said to arise. On this principle, an application for rectification can be filed only in the High Court within whose jurisdiction the Trade Marks Register is situated or that High Court within whose jurisdiction the owner of the Mark resides or carries on business.**” (Emphasis supplied)*

Relevant Judicial Decisions (Contd.)

❖ Ajay Industrial Corporation v. Shiro Kanao of Ibaraki City [AIR 1983 Del 496]

4 “*The objection raised is that the Delhi High Court has no jurisdiction to entertain these applications and that they ought to have been filed either in the Court at Ahmedabad where the suit filed by the Respondent is pending or at Calcutta where the patents in question stand registered...Sri Anoop Singh suggests it can only be either the place of registration of the patent or the place in which a suit for infringement has been filed, if any, and none else. This does not appear to be correct. It will not be possible to correlate the jurisdiction with the State in which the place of registration of the patent is situate for all registration of patents in India is done only at Calcutta and three or four other cities in India and the elaborate provision in Section 2(i) will be totally superfluous if the intention was to confine jurisdiction to the four or five High Courts having jurisdiction over these cities...Thus, the statutory provisions show that the remedy of seeking the revocation of a patent from a High Court is not correlated to the pendency of an action for infringement but is made available to any person who finds that his commercial interests are likely to be jeopardised or injured by the claims of the owner of a patent.*” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ Girdhari Lal Gupta v. K. Gian Chand Jain [AIR1978DELHI146]

29 *“To my mind, S. 51-A [of the Designs Act, 1911] merely lays down the conditions which would justify cancellation of registration and the person who may seek it. It has no relevance to the Court which may entertain such a petition and it would not, therefore, be proper to read into S. 51-A any principles for the determination of the question of the jurisdiction of the Court. So far as the need for a nexus is concerned, it has its genesis in the principles of general jurisdiction which, to my mind, would be inapplicable because of a clear indication with regard. to jurisdiction in S. 2 (7) of the Act. **Even otherwise, any search for a nexus between the subject-matter and the territory would be superfluous because the dynamic effect of the static entry in the register provides sufficient nexus.**” (Emphasis supplied)*

Relevant Judicial Decisions (Contd.)

Girdhari Lal Gupta v. K. Gian Chand Jain [AIR1978DELHI146]

This is because the static entry in the register maintained in the Registry in Calcutta has, by virtue of the provisions of S. 47 of the Act, a dynamic effect throughout the territory of India in that as a result of registration the person in whose favor the design is registered gets an unrestricted right to use the design implying a prohibition against all persons other than him from the use of the design on pain of prosecution and the civil consequence of damages. What establishes the nexus between the different territories of India and the registration is the fact that the twofold consequence of registration, both positive and negative, operate throughout the territory of India. No further nexus is, therefore, necessary to confer jurisdiction on the High Courts, and if such a nexus was necessary, one would have found appropriate indication of it in the statute itself.” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ Dr. Reddys Laboratories Ltd v. Fast Cure Pharma [2023:DHC:6324]

36.2 “...*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...*” (Emphasis supplied)

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.***” (Emphasis supplied)

Relevant Judicial Decisions

- ❖ **The Hershey Company v. Dilip Kumar Bacha, Trading As Shree Ganesh Namkeen & Anr. [C.O. (COMM.IPD-TM) 179/2023]**

51 “...*this Court is unable to subscribe to the view taken by the ld. Single Judge in Dr. Reddys Laboratories Ltd. v. Fast Cure Pharma (supra):*

- i) The decision of the ld. 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.”*
(Emphasis supplied)

Conclusion

- The term "High Court" has not been defined under Trade Mark Act 1999. This omission creates ambiguity regarding the jurisdictional authority for trademark rectification petitions.
- The legal stance observed by the earlier courts regarding the jurisdiction of a High Court in relation to trademark cancellation petitions is whether the *effect* of registration of a trademark would be felt within the jurisdiction of the said High Court. Therefore, where any person's commercial interests are being affected within the jurisdiction of a High Court, the said High Court shall also have territorial jurisdiction to entertain a trademark cancellation petition.
- Thus, it is hoped that the issue will soon be settled in the light of the dynamic effect of registration of trademark and the term "High Court" will be given a broader meaning.

Thank you!
Questions?

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