IP India News by KRISHNA SAURASTRI Associates

From The Editor's Desk



Dear Friend,

Welcome to the First Issue of the "**IP India News**"! We hope you will find this a useful update on Intellectual Property in India

We are living in exciting fast paced times, in an age where global connectivity is instantaneous, where knowledge economics is propelling the progress and development of companies and countries. Slowly and steadily the focus has shifted from tangibles to intangibles. Intellectual Property protection and management has become key driver for building and sustaining competitive advantage and achieving superior performance. All 'creations of the mind' require legal protection through patents, trademarks, copyrights, designs. Intellectual Property (IP) is the fuel that powers the engine of prosperity, fostering invention and innovation. The increasing importance of IP is forcing countries and companies alike to actively manage and protect their IP.

I would like to thank everyone who has supported this edition by providing useful information.

Yours Sincerely,

Ms. Richa Pandey

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IP Scoop

Bombay High Court pronounces on Personal Jurisdiction in Cyberspace and use of trade mark in meta-tags - from our corner



Recently, the Hon'ble Bombay High Court in *People Interactive (I) Pvt. Ltd. vs. Gaurav Jerry and Ors.*, dealt extensively with use of trade mark in meta-tags for the first time and also discussed the issue relating to personal jurisdiction in cyberspace. A copy of the order can be found *here*.

Facts

Plaintiff provides online matrimonial and matchmaking services under the well-known brand Shaadi.com. Plaintiff came across a rival domain name and/or trade mark ShaadiHiShaadi.com in respect of identical services of online matrimonial and matchmaking services and therefore, initiated legal proceedings by filing a suit against the Defendants seeking injunction against them from using the mark and domain name ShaadiHiShaadi.com or any other word or expression identical with or deceptively similar to the Plaintiff's registered trade mark Shaadi.com in respect of matrimonial and matchmaking services, online as well as offline. The rival marks of the Plaintiff and the Defendant are as shown above.

Contentions

The advocates for the Plaintiff contended that the Plaintiff being the owner of registered trade marks Shaadi.com and Shadi.com, the Plaintiff has statutory, proprietary and common law rights in the said marks by virtue of which the Plaintiff is entitled to restrain others from using names or marks that are deceptively or confusingly similar to those of the Plaintiff. It was further contended that the mark of the Defendant is deceptively and confusingly similar to the Plaintiff's marks and Defendants have even adopted a similar tagline which is likely to create confusion in the minds of the public.

Plaintiff also relied upon the web analysis conducted by them of Defendants' impugned domain www.shaadihishaadi.com which showed that Defendants were diverting as much as 10.33% of the internet traffic away from the Plaintiff's website to their website by use of trade mark Shaadi.com and 4.67% of the internet traffic by use of domain name www.shaadi.com.

Judgment

The Plaintiff's application for grant of urgent ad-interim reliefs was heard ex-parte as the Defendants did not appear at the time of hearing in spite of being served with a notice.

Upon hearing the advocates for the Plaintiff, Hon'ble Mr. Justice G.S. Patel compared the rival marks and found that the impugned mark of Defendant No. 1 is bound to create deception and confusion amongst visitors visiting Defendant No.1's website and the visitors are bound to mistake Defendant No.1's website for a branch, division or variation of Plaintiff's reputed website.

Relying on the web analysis conducted by the Plaintiff of the Defendant No.1's infringing domain www.shaadihishaadi.com, the Hon'ble Court observed that Defendant No.1 is illicitly plugging the Plaintiff's mark Shaadi.com and domain name www.shaadi.com in meta-tags of web-pages of its domain name to divert internet traffic away from the Plaintiff's website to his impugned website www.shaadihishaadi.com and such use is nothing but hijacking Plaintiff's reputation and goodwill.

The Hon'ble Court was thus pleased to grant an ad-interim injunction in favour of the Plaintiff in respect of infringement and passing off of Plaintiff's registered trade mark Shaadi.com restraining the Defendant No.1 from using the trade mark and domain name ShaadiHiShaadi.com in any manner,

including use in meta-tags. Court further directed the domain name registrar, who was a party to the suit, of the impugned domain name to deregister or terminate the registration of the impugned domain name ShaadiHiShaadi.com.

Comments

The Hon'ble Bombay High Court recognized the importance of meta-tags in this continuously evolving digital era and held that use of trade mark in meta-tags constitutes infringement and passing off. The Hon'ble Court also observed that in an action for passing off, court will have jurisdiction to entertain a suit even if the Defendant resides and carries on business outside the jurisdiction of Court provided the Defendant's website is an interactive website and is globally accessible from anywhere, including the place where the suit is filed. Precedents like this will certainly clear the ambiguity over unchartered issues relating to the use of trade mark in cyberspace especially in meta-tags.

Similar order was subsequently passed in *People Interactive (I) Pvt. Ltd. vs. Ammanamanchi Lalitha Rani & Ors.* A copy of the order can be found here. In this case, the rival marks were Shaadi.com and Get Shaadi.com. The Hon'ble Bombay High Court upon comparing the marks, found the impugned mark deceptively and confusingly similar to the Plaintiff's mark and thus, restrained the Defendants from using the mark and/or domain Get Shaadi.com and directed the domain name Registrar, who registered the impugned domain name of the Defendant Nos.1 & 2, to deregister or terminate the registration of the impugned domain name www.getshaadi.com.

Bombay High Court grants injunction for infringement of a Process Patent



Recently, the Hon'ble Bombay High Court in *CTP Environment S.A.S vs. Santro Technologies Ltd. & Ors.* was pleased to grant ad-interim reliefs in favour of the Plaintiff restraining the Defendants from using a process that was identical with and/or substantially similar to the process patent of the Plaintiff in India. A copy of the order can be found here.

Facts

The Plaintiff is a French company and the Defendant No.1 is an Israeli company having its office in Mumbai and the Defendant No.2 is a majority shareholder of the Defendant No.1. The Plaintiff has registered a process Patent No. 236532 relating to a novel method of cleaning furnaces 'online' i.e. without completely shutting down the furnace as the earlier technologies were usable only when the furnace was completely offline. The Defendants are providing similar services of cleaning furnaces online whose process is alleged to be identical with or substantially similar to the Plaintiff's patent which is an infringement of the Plaintiff's said process patent.

Issue

Whether the process used by the Defendants is identical with or substantially similar to the Plaintiff's patent and thus, amounting to infringement of the Plaintiff's Patent?

Plaintiff's Contention

Plaintiff contended that the Defendant No.1 through its website is offering competing and infringing services which is identical with and/or substantially similar to the Plaintiff's patent. The brochures and other advertising material used by the Defendants also appear to be similar to the Plaintiff's patent. Plaintiff further relied upon an expert opinion of Dr. C.S. Mathpathi, an Assistant Professor in Department of Chemical Engineering at Institute of Chemical Technology, Mumbai, who in unequivocal terms concluded that there is a high likelihood that Defendants' process is same or substantially similar to the Plaintiff's patent.

Judgment

The Plaintiff's application for grant of urgent ad-interim reliefs was heard ex-parte as the Defendants failed to appear at the time of hearing in spite of being served with a notice. The Hon'ble Court upon hearing the Plaintiff and on the basis of expert opinion of Dr. C.S. Mathpathi, held that prima facie the process used by the Defendants is identical with and/or substantially similar to the Plaintiff's patented process and thus, restrained the Defendants from using the infringing process or using, offering for sale, selling or importing for those purposes the product obtained directly by that process or any such, further and / or any other process similar to the said patent of the Plaintiff in India.

Impetus

Indian Patent Office Issues the much awaited Examination Guidelines for Pharmaceuticals



When we foray into the world of pharmaceutical patents, many contentions raise their heads. Once the product patent regime came into force in India, the road ahead seemed fraught with difficulties. Time and again the doors of the courts have been knocked for explanation, for intervention and for redressal. In view of the same, the endeavor of the Government to bring out pharmaceutical guidelines is worth applause. A copy of the guidelines published by the Indian Patent Office on October, 29, 2014 can be found *here*

We would like to bring out the highlights of the pharmaceutical guidelines.

Novelty

As regards Assessment of Novelty, it has been stated that while assessing novelty, it is generally not permitted to combine separate items of prior art together, unless such combination has specifically been suggested or essentially linked to one another. If a Markush formula covers innumerable compound and if some of the compound fall within one prior art and certain other compounds fall within another prior art, in such cases all these prior art documents are to be cited. A generic disclosure in the prior art may not necessarily take away the novelty of the specific disclosure. A specific disclosure in the prior art takes away the novelty of generic disclosure.

Markush Claims

While examining Markush claims, the complete specification should be critically examined whether:

(i) it discloses best representatives, as known to the applicant, of the possible embodiments ;
(ii) such embodiments share a common use or property;
(iii) such possible embodiments share common structure;
(iv) physical and/ or chemical properties of best representatives of such embodiments known to the applicant are disclosed;
(v) test conducted for the representatives of such embodiments known to the applicant is provided;
(vi) in case of product claims at least one process for preparing the compounds has been disclosed enabling the whole scope of the invention.

Moreover, if any one of (i) to (vi) are not met such a Markush claims may be objected under 'Unity of invention' and "Insufficiency of Disclosure" depending on the circumstances.

Furthermore, the report also says that while assessing the sufficiency of disclosure, it must be ensured that the best method for performing the invention known to the applicant is described so that the whole subject- matter that is claimed in the claims, and not only a part of it, must be capable of being carried out by skilled person in the relevant art.

Inventive Step

Inventive step is determined vis-à-vis any matter published in any document anywhere in the world

or any use before the priority date of the claim. Mosaicing of prior art documents is permissible in the context of inventive step.

Industrial Applicability

With regard to industrial applicability, the report states that as per Section 2(1)(ac) of the Act, the expression ''capable of industrial application'', in relation to an invention, means that the invention is capable of being made or used in an industry. The specification should disclose the usefulness of industrial applicability of an invention in a distinct and credible manner unless the usefulness and industrial applicability of the invention is already established, either in explicit or in implicit manner. Mere speculative use or vague and speculative indication of possible objective will not suffice.

Section 3(d)

The stand taken by the Patent Office with respect to Section 3(d) is the same as that of the Hon'ble Madras High Court in Paragraph 180 of the order, it was held: What is "efficacy"? Efficacy means "the ability to produce a desired or intended result". Hence, the test of efficacy in the context of Section 3(d) would be different, depending upon the result the product under consideration is desired or intended to produce. In other words, the test of efficacy would depend upon the function, utility or the purpose of the product under consideration. Therefore, in the case of a medicine that claims to cure disease, the test of efficacy can only be "therapeutic efficacy" .It may be noted that the text added to Section 3(d) by the 2005 amendment lays down the condition of "enhancement of the known efficacy". Further, the explanation requires the derivative of "differ significantly in properties with regards to efficacy". What is evident, therefore, is that not all advantageous or beneficial properties are relevant, but only such properties that directly relate to efficacy, which in case of medicine, as seen above, is its therapeutic efficacy. While dealing with the explanation as provided in Section 3(d), it must also be kept in mind that each of the different forms mentioned in the explanation have some properties inherent to that form, e.g., solubility to a salt and hygroscopicity to a polymorph. These forms, unless they differ significantly in property with regard to "therapeutic efficacy", are expressly excluded from patentability. Hence, the mere change of form with properties inherent to that form would not qualify as "enhancement of efficacy" of a known substance. In other words, the explanation is meant to indicate what is not to be considered as therapeutic efficacy.

Composition Claims

Claims related to compositions obtained by mere admixture resulting in aggregation of the properties of the individual components are not patentable under section 3(e) of Act. However, in a composition if the functional interaction between the features achieves a combined technical effect which is greater than the sum of the technical effects of the individual features, it indicates that such a composition is more than a mere aggregation of the features.

INN Names

It is to be noted that quite often the claims of the pharmaceutical compound involve derivation of known compound having established pharmaceutical activities. Also, it has been observed that such pharmaceutical substance have already been assigned generic names (International Non- proprietary Names, INN). When the patent specification under examination disclose such INNs, the report states that the examiner should search the prior art on the basis of such INNs as well

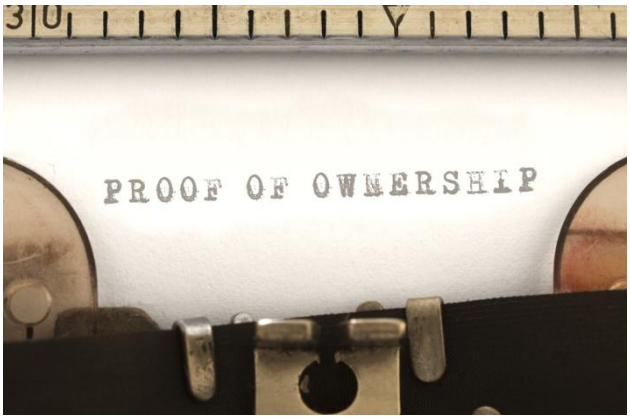
Intermediates

The report stresses on the following points with respect to intermediates –

- To satisfy unity of invention between intermediate and final products when any one or both the structure are not known, there should be sufficient evidence to conclude that the intermediate and final product are technically closely interrelated such that the intermediates contain the same essential element as the final product or incorporate as essential element into the product.
- Different intermediate products used in different processes for the preparation of the final product, satisfy unity of invention provided that they have the same essential structural element.
- To satisfy unity of invention the intermediate and final products should not be separated, in the process by an intermediate which is not new.

- Different intermediates for different structural parts of the final product, do not satisfy unity of invention.
- To satisfy unity of invention where the intermediate and final products are families of compound, each intermediate compound should correspond to a compound claimed in the family of the final products.

Proof Of Right for filing Patent applications in India



When an application for a patent is made at the Indian Patent office ("IPO") by virtue of an assignment of the right to apply, the IPO requires the submission of the proof of right. It has been observed that most applicants did not follow the practice of filing the proof of right and generally, no objections were raised by the IPO especially in cases of Convention applications

However, the IPO raised an objection regarding the proof of right in the examination report of Application No.794/CHE/2006 and it was held that the applicant had failed to fulfill the requirements of the Indian Patents Act, 1970 ("the Act") by not obtaining the signatures from the inventors on Form 1 or by not filing the assignment deed from the inventors or any other documents in support of their right to make the application in India. The order was appealed and the Intellectual Property Appellate Board (IPAB) in its order of 28th October, 2013 in *NTT DoCoMo v Controller of Patents* held that the applicant had not submitted the proof of right to make the application for a Patent. A copy of the order can be found *here*.

The IPAB order seems to be in accordance with Chapter 3 of the Manual of Patent Practice and Procedure, 2011 ("the Manual") which mentions-

"Wherever, the inventor(s) is/are not the applicant, a proof of right to apply by way of an endorsement in the Application form (Form 1) or an assignment deed shall be submitted."

In case, the Applicant has not furnished such proof of right, the Applicant could expect to be informed about it by the IPO, since the Manual mentions "…the Office checks for proof of right to file the application. If the proof of right is not filed along with the application, it shall be filed within a period of six months from the date of filing of the application. Otherwise, the applicant shall file the same along with a petition under Rule 137/138".

Furthermore, in some instances, the applicant may receive an objection regarding the proof of right along with the First examination report (FER) and the same would be required to be submitted within twelve months from the date of receipt of the objection and a petition under rule 137/138 of the Patents Rules, 2003 ("the Rules") would not be acceptable.

The Controller's decision of 7th February, 2013 in the matter of Application No. 6734/DELNP/2006 provides guidance in such situations wherein an assignment was filed along with a petition for condoning the delay for submitting an assignment. The assignment along with the petition was rejected since the same was barred by limitation as is specified in Section 21 of the Act.

It would also be practical to evaluate the options available wherein the Applicants have not submitted the proof of right within six months from the date of filing the application with the IPO, and when the IPO has also not required the applicant to submit the proof of right. The issue of non filing of

the proof of right due to omission of inventor's signatures would be considered a procedural irregularity and could be condoned since the same would be within the powers of the Controller under Rule 137 of the Rules.

The Applicant could also be faced with a situation wherein the Form 1 filed with the IPO did not include the signatures of the inventors. However, the Patent was granted by the IPO without any objection regarding the same. In such cases, the Applicant may wish to know whether such a mistake could be rectified after the grant, especially in view of the fact that one of the grounds for revocation of the Patent includes that the Patent was granted on the application of a person not entitled under the provisions of this Act to apply. It seems that such a mistake can be rectified at a later stage. In *All India Reporter Ltd. And Anr vs. Ramchandra Dhondo Datar (AIR 1961 Bom 292)*, the Bombay High Court held that the absence of signature or verification in the plaint can be cured even at the appellate stage of the suit and such correction will take effect from the date on which the original suit was filed. This decision has also been referred to in *Vidyawati Gupta and Ors. vs. Bhakti Hari Nayak and Ors. (AIR2006SC1194)*, where the Supreme Court reiterated that the removal of defect in filing the plaint relates back to the date of filing the plaint. The fact that these are established principles as far as the civil matters are concerned and would also be applicable to Patent matters has been addressed by the Delhi High Court in *Tianjin Dishili Investment Vs Union Of India (W.P.(C) No.5633/2011)*, which mentioned that errors of similar nature are merely an irregularity and do not affect the institution of a proceeding. It was mentioned that there was no reason for a more stringent view be taken in the proceedings under the Act especially when no prejudice is shown to have been caused to anyone.

Therefore, the issue regarding the proof of right seems to be a non-compliance of a procedural formality and may lead to disastrous consequences. The issue of the proof of right can be overcome by submission of an executed Form 1 or by the submission of an assignment. It is expected that a certified copy of the employment agreement stipulating that the rights to the Intellectual Property including the rights to file an application for a Patent are assigned to the employer, may be acceptable as the proof of right. It is also expected that the signed invention disclosure form acknowledging the obligation to assign any rights, title and interest in the invention to the employer could be used as evidence of the assignee's right to prosecute the Patent application. It would be interesting to observe the further developments in law regarding the proof of right.

Jurisdiction of Court in a Composite Suit





In a recent judgment pronounced by the Hon'ble Supreme Court in *M/s. Paragon Rubber Industries Ltd. Vs. M/s. Pragathi Rubber Industries*, the Hon'ble Court decided the controversy relating to Composite Suit i.e. suit having multiple cause of actions. Though, the present case is decided under the erstwhile Trade & Merchandise Marks Act, 1958. The judgment is still relevant for enforcement of the IP rights as it discusses about the proper forum for the enforcement of the IP Rights. A copy of the judgment can be found *here*.

Facts

In the year 2001, the Plaintiff i.e. M/s. Paragon Rubber Industries Ltd. who is located in Kottayam filed a suit against the Defendants i.e. M/s. Pragathi Rubber Industries, who are located in Jallandhar, Punjab at District Court, Kottayam, Kerala claiming reliefs under the Copyright Act, 1957 and the Trade & Merchandise Marks Act, 1958. The Defendant filed an application for rejection of the plaint for

want of territorial jurisdiction. The learned District Judge dismissed the application with the observation that issue of jurisdiction will be decided at final stage of the suit. The Defendant filed a Civil Revision Petition before the Hon'ble High Court of Kerala; vide its order dated June 16, 2004, the Hon'ble High Court allowed the revision petition and directed the learned judge to decide the issue of the territorial jurisdiction afresh. In view of the directions, the learned District Judge treated the issue of jurisdiction as preliminary issue and held that it has jurisdiction to entertain the suit in view of Section 62(2) of the Copyright Act, 1957. The Defendant challenged the aforesaid Order in the High Court of Kerala. The Hon'ble High Court held that the instant composite suit encompassing the Copyright Act, 1957 and Trade & Merchandise Marks Act, 1958 would not be maintainable for lack of jurisdiction under the Trade & Merchandise Marks Act, 1958 (in spite of jurisdiction under the Copyright Act, 1957), the High Court set aside the aforesaid order passed by the learned District Judge. However, the Plaintiff was given the liberty to amend the plaint. Both the Plaintiff and the Defendants appealed against the Order of the High Court of Kerala.

Issue

Whether a court has jurisdiction to entertain cause of actions in terms of both the Copyright Act, 1957 and the Trade & Merchandise Marks Act, 1958 when the court only has jurisdiction to entertain one cause of action in terms of Section 62(2) of the Copyright Act, 1957?"

Plaintiff's Contention:

1. The suit is maintainable in its form before the learned District Judge, Kottayam for the violation of the copyright in view of Section 62(2) of the Copyright Act, 1957.
2. High Court has wrongly held that the composite suit claiming reliefs under Copyright Act, 1957 and Trade & Merchandise Marks Act, 1958 would not be maintainable.

Defendant's Contentions

1. It is admitted by the Plaintiff that neither the Defendant's goods are available in Kottayam, nor the Defendant resides or carries on business within the jurisdiction of the District Court, Kottayam.

2. The present suit shall be governed as per the provisions of the Trade & Merchandise Marks Act, 1958 and not Trade Marks Act, 1999.

Observations:-

It is observed by the Hon'ble Court that even though the Plaintiff was aware that the District Court Kottayam will have no jurisdiction under the Trade & Merchandise Marks Act, 1958; but tried to camouflage the same by confusing it and mixing it up or intermingling it with the relief contained under the Copyright Act, 1957. From the averments made in the Plaint, it is apparent that the Plaintiff had filed a composite suit and such a suit is not maintainable unless the court has jurisdiction to entertain the suit in relation to the entire cause of actions and the entire reliefs claimed.

Judgment

Order II, Rule 3 of the Code of Civil Procedure, 1908 contemplates uniting several causes of action in the same suit. The cause of action for infringement of copyright and the cause of action for infringement of trade mark or a cause of action for passing off are different. Even if one cause of action has no nexus with another, indisputably Order II, Rule 3 of the Code will apply. However, the application of Order II, Rule 3 of the Code will not ipso facto confer jurisdiction upon a Court which it otherwise does not enjoy. In other words, Order II, Rule 3 will not confer a Court with jurisdiction under 1958 Act when the Court does not enjoy such a jurisdiction. A composite suit is not maintainable unless the Court enjoys the jurisdiction to entertain the suit in relation to the entire cause of action and the entire relief. Considering Dhodha House Vs. S.K.Maingi (2006) 9 SCC 41 and Dabur India Ltd. vs. K.R. Industries (2008) 10 SCC 595; the Hon'ble Court held as follows "….for the purpose of invoking the

jurisdiction of the court in a composite suit, both the causes of action must arise within the jurisdiction of the court which otherwise had the necessary jurisdiction to decide all the issues. However, the jurisdiction cannot be conferred by joining two causes of action in the same suit when the court has jurisdiction to try the suit only in respect of one cause of action and not the other." The Hon'ble Court further held that while enacting the erstwhile Trade & Merchandise Marks Act, 1958, the Parliament was aware of the provisions of the Copyright Act, 1957. The Parliament did not choose to provide a similar provision in 1958 Act. Such an omission was a conscious omission and was, therefore, clear and explicit. On the other hand, while enacting the Trade Marks Act, 1999, the Parliament provided for an additional forum by enacting Section 134 (2) of the Trade Marks Act. It is a settled position that the Court shall not readily presume the existence of jurisdiction of a court which is not conferred by the statute. The Instant Judgment held that the Plaintiff could not take advantage of Section 134(2) of the Trade Marks Act, 1999. [Although, the 1999 Act was enacted on 30th December, 1999, the same came into force on September 15, 2003. Since the suit in this case was filed on March 19, 2001, it was adjudicated under the erstwhile Trade & Merchandise Marks Act, 1958].

Comments

The judgment reiterates the old principle of law that a composite suit will not entitle a Court to entertain a suit in respect whereof it has no jurisdiction, territorial or otherwise, as the law is well settled that the decree or judgment passed by the court having no jurisdiction to entertain the same shall be nullity. The judgment is relevant even in present scenario as the remedy of passing off under the Trade Marks, 1999 can be availed only after complying with the provisions of Section 20 of the Code of Civil Procedure, 1908, otherwise the composite suit of infringement and passing off cannot be availed by filing the suit under the provision of Section 134 of the Trade Marks Act, 1999.

IP Spectator

Bristol-Myers Squibb (BMS) Denied Interim Injunction Against Mylan for the export of HIV DRUG

Hyderabad Trial Court, on September 26, 2014, denied an interim injunction to Bristol-Myers Squibb (BMS) in a suit against Mylan regarding the export of HIV Drug Atazanavir to Venezuela. Earlier, BMS was denied an ex-parte interim injunction by the Trial Court, following which BMS approached the High Court and secured a status quo order.

The order of the High Court was challenged by Mylan and the High Court amended the order to restrict exporting of the drug to 1/8th of the purchase order subject to a sum of Rupees Thirty Lakh being deposited by Mylan with the Court. The High court further directed the Trial Court to hear and conclude the interim injunction application within a period of three weeks.

Taking the defence of Public Interest, Mylan argued that the export of a HIV drug to a sovereign government, pursuant to an order from WHO, did not amount to sale for commercial purposes only. After the dismissal of the interim injunction application by the Hyderabad Trial Court, BMS filed an appeal on September 29, 2014.

Protecting Quasi Judicial Authorities from Executive



Recently, Clause No. 3 of a notification issued by the Controller of Patents, Designs and Trade Marks

(Controller General) relating to amendment in application for registration of trade mark was challenged before the Hon'ble Delhi High Court in *Intellectual Property Attorneys Association vs. Union of India & Anr*. The Hon'ble Court was pleased to set aside the impugned Clause No.3 of the notification and held that statutory discretion vested in quasi-judicial bodies cannot be interfered with by higher executives. A copy of the order can be found *here*.

Facts

A writ petition was filed by the Petitioner challenging the validity of Clause No. 3 of the Office Order No.16 of 2012-2013 dated 8th June, 2012 issued by the Controller General, the relevant part of which states that "*No request for amendment shall be allowed which seeks substantial alteration in the application for registration of trademark. The substantial amendment in the trademark, proprietor details, specification of goods/services (except deletion of some of the existing items), statement as to the use of mark shall not be permitted.*"

Contentions

The Petitioner commenced its arguments by contending that the impugned Clause is in the nature of a 'general order' as to which amendments to the application for registration of a trade mark are not to be allowed. However, the court pointed out that the real controversy which arises is that when the Statute confers on the Registrar, the power to permit correction of 'any error' in or in connection with the application or to permit an amendment of the application, whether the Controller General by a general order in the nature of a guideline can direct as to which of such amendments shall not be allowed; and whether the power exercised by the Registrar under Section 22 of the Act would be quasi-judicial power or administrative power? The reason for the same being that if Registrar's powers are quasi judicial in nature, the Controller General even though higher in hierarchy than the Registrar, cannot dictate to the Registrar the manner in which the quasi-judicial power are to be exercised.

The Petitioner contended that the nature of power exercised by the Registrar under Section 22 would be quasi-judicial in nature since as per Section 2(ze) of the Act, Registrar is a tribunal; Registrar has all powers of a civil court for the purpose of receiving evidence, administering oaths, enforcing attendance of witness, compelling discovery and production of documents and issuing commission for examination of witnesses; Registrar before exercising any discretionary or other powers vested in him to a person is required to give such a person an opportunity of being heard; Registrar's order or decision under the Act provides for a remedy of appeal; and an order under Section 22 of the Act in the course of registration of trademarks under Section 9 and 11 of the Act is in exercise of a quasi-judicial power.

The Respondents argued that it is not as if the applicant is barred from seeking registration on the basis of particulars which he seeks to change and it is open to the applicant to abandon the application in which amendment is sought and to file a fresh application with changed particulars.

Judgment

The court held that the power exercised by the Registrar of Trademarks is a quasi judicial power and not an administrative power and thus, the impugned Clause No.3 of the said Office Order issued by the Controller General was struck down by the Hon'ble Court. The Hon'ble Court further held that the Registrar shall decide the applications for amendment to the application for registration of trade mark on case to case basis.

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