

CIVIL MISCELLANEOUS

*Before Kapur, J.*OM PARKASH, *Petitioner.**versus*DAROGHA MAL. *Respondent.*

Civil Miscellaneous No. 425 of 1954

Trade Marks Act (V of 1940) Sections 6, 8, 24—Petition for rectification of register under Sections 46 and 47—Requirements of—Petition after 7 years of the Registration of Trade Mark—When can be entertained.

1955

January, 11th

Held, that under Section 24 a trade mark which has been registered for seven years or more is valid in all respects and is not open to attack under section 46 of the Act except on the ground of fraud or unless it offends against the provisions of Section 8. Sub-section (3) of section 6 as indeed sub-section (2) deals with distinctiveness and section 8(a) also deals with something which is likely to deceive or cause confusion and therefore is not distinctive. As the mark was registered it must be taken that the provisions of section 6(2) and (3) were complied with. In the petition for rectification of the register there being no allegation of fraud and the allegations made not amounting to fraud it does not come within Section 24 of the Trade Marks Act and is thus liable to dismissal.

Imperial Tobacco Company v De Pasquali & Co. (1), followed; *Joshua Wigfull & Sons, Ltd. v. John Jackson & Son, Ltd.* (2), noticed.

Application for the rectification of the Register or the removal of the Trade Mark from the Register, under Sections 46 and 47 of the Trade Marks Act, 1940 by Shri Om Parkash, son of Shree Karam Chand, Partner M/s Parkash Thread Ball Factory, Saddar Bazar, Delhi.

HIRA NAND. for Petitioner.

RADHIKA NARAIN, for Respondent.

(1) (1918) 2 Ch. 207

(2) (1916) 1 Ch. 213

ORDER

Kapur, J.

KAPUR, J. This is an application made by Om Prakash for rectification of the register under sections 46 and 47 of the Trade Marks Act, 1940.

The petitioner alleges that he has been carrying on business in Saddar Bazar, Delhi, of manufacturing thread balls. The opposite party got, in the year 1946, his trade mark registered the cartoon of which is marked as A, that he has been changing his designs and has without disclosing the changes got his trade mark renewed on the 8th April, 1953, and that was done without the true facts being disclosed, that the registration is calculated to prejudice and interfere with the applicant's business and that the opposite party is not entitled to the use of the trade mark. In paragraph 15 he submitted that the registration was calculated to deceive and confuse the customers and it interfered prejudicially in the trade of the applicant and he therefore prayed for rectification of the register by the removal of the trade mark.

The opposite party Darogha Mal has pleaded that such an application is not maintainable because section 24 of the Trade Marks Act is a bar to the application. He has denied that there has been any change in the registered trade mark and has pleaded that he filed a suit for permanent injunction against the petitioner. In reply to paragraph 15 he denies the allegations made therein and also submits that even if they were correct, they are not sufficient for the rectification of the register. He specifically pleaded that the petitioner did not allege that the registration was obtained by fraud and further that he did not state the particulars of the deception or confusion alleged.

The Registrar has also filed his reply which goes to show that Darogha Mal made an application for registration on the 8th April, 1946, which was advertised on the 1st July 1951 and after the registration was sanctioned on the 1st April, 1952, the registration was advertised on the 1st July 1953 as the seven years had passed registration was renewed and he has also pleaded that unless fraud is pleaded or unless the trade mark offends section 8 of the Act, the registration must be taken to be valid; he has referred to a judgment of the Court of Appeal in the *Imperial Tobacco Company v. De Pasquali & Co.* (1), in which it was held that if a mark is not properly registered that is to say a mark which does not satisfy the requirements of section 9 of the Trade Marks Act (corresponding to section 6 of the Indian Act) is not a mark which is dis-entitled to protection in a Court of justice within section 41 of the Trade Marks Act or section 8 of the Indian Act, and that as more than seven years have elapsed since the date of registration, it cannot be attacked on the ground that at the date of the application for registration it was not distinctive.

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Falshaw, J., on the 21st December, 1954, framed a preliminary issue: "Is the petition maintainable in view of the provisions of section 24 of the Trade Marks Act."

I am of the opinion that this petition as framed is incompetent. Section 6 of the Act gives requirements which are requisite for registration. Section 8 lays down the prohibition of registration of certain matters, and when quoted it runs as under—

"8. No trade mark nor part of a trade mark shall be registered which consists of, or

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contains, any scandalous design, or any matter the use of which would—

- (a) by reason of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Court of justice; or
- (b) be likely to hurt the religious susceptibilities of any class of His Majesty's subjects; or
- (c) be contrary to any law for the time being in force or to morality."

Section 24 reads—

"24. In all legal proceedings relating to a registered trade mark, the original registration of the trade mark shall after the expiration of seven years from the date of such original registration be taken to be valid in all respects unless such registration was obtained by fraud, or unless the trade mark offends against the provisions of section 8."

Under section 24 as was held by Falshaw, J. in Civil Original No. 1-D of 1953 a trade mark which has been registered for seven years or more is valid in all respects and is not open to attack under section 46 of the Act except on the ground of fraud or unless it offends against the provisions of section 8.

There is no allegation of fraud excepting what is stated in paragraph 3 which, even if true, would not amount to fraud, but even if it did, there are no particulars as required under rule 4 of Order VI of the Code of Civil Procedure. The only question that arises is whether taking advantage

of section 8 the petitioner is entitled to ask for rectification. I may here say that there are no particulars in the petition as to how the registration causes confusion or interferes prejudicially in the trade of the applicant.

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There is a certain amount of conflict of opinion in England in regard to this matter. Neville, J., in *Joshua Wigfull & Sons, Ltd. v. John Jackson & Son, Limited* (1), said as follows—

“What I have to consider here is whether this is mark which ought to be protected, and as soon as I find out that at the time when it was registered it was mark which ought not to have been protected and ought not to have been registered, I am bound to rectify the Register by removing the mark”.

ASTUBRY, J. in *Imperial Tobacco Company v. De Pasquali & Co.* (2), followed this judgment, but on the matter going up in appeal it was held by the Court of Appeal, that the fact a registered trade mark was, at the time of its registration, not properly registrable as not coming within section 9 of the Trade Marks Act, 1905..... does not render it disentitled to protection in a Court of Justice within the meaning of section 41, and after the lapse of seven years from the date of registration it cannot on that ground be removed from the register under section 35. The judgment of Neville, J., in *Joshua Wigfull & Sons Ltd. v. John Jackson & Sons, Limited* (1), was overruled.

Sub-section (3) of section 6 as indeed sub-section (2) deals with distinctiveness and section 8(a)

(1) (1916) 1 Ch. 213; 33 R.P.C. 97, 102

(2) (1918) 2 Ch. 207

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also deals with something which is likely to deceive or cause confusion and therefore, is not distinctive. As the mark was registered it must be taken that the provisions of section 6(2) and (3) were complied with.

I am, therefore, of the opinion that the petition as framed does not come within section 24 of the Trade Marks Act, and, at any rate, it does not give any particulars which would be sufficient for the purpose of a proper trial of the issues which will arise.

I would, therefore, dismiss this petition as being incompetent, but leave the parties to bear their own costs in these proceedings.