
Registrar powers distilled in Blender's Pride

The Supreme court recently delved on the question of Registrar's power to suo moto rectify an entry in the register (as per Section 57 (4) of the Trademarks Act) and if such power is curtailed as per provisions of Section 125 of the Trademarks Act that provides if validity of a registered trade mark is questioned in a suit for infringement, it would be determined on an application for the rectification of the registered trade mark made to the Appellate Board and NOT the Registrar.

Brief Facts of the case:

1. The parties in this case are fighting over the mark '*Blenders Pride*' ('BP'). The genesis of the dispute is an opposition filed by Austin Nichols, a subsidiary of USA-based Pernod Ricard S.A. against Jagatjit Industries application for the mark 'Blenders Pride'.
2. Austin Nichols claims to have coined and adopted the '*Blenders Pride*' ('BP') mark through its licensee M/s Seagram Co. Ltd in 1973, and has been using it since. Further, Austin Nichols claims to be using the mark in India since 1995 through its licensee M/s Seagram Co. Ltd.
3. Jagatjit Industries, had applied for the 'Blenders Pride' mark, and its application was advertised in October 7, 2003. Austin Nichols opposed the appellant's registration, after applying for a one month extension on prescribed form (Form TM-44).
4. Despite Austin's opposition, Jagatjit's mark proceeded to registration. Austin filed a writ petition to remove the appellant's marks from the register soon after they became aware that the registration has been granted. Simultaneously, the Registrar also issued a show cause notice to Jagatjit for *suo moto cancellation* under Section 57(4) of the Trademarks Act, stating that the registration had been issued wrongly, and proposing to rectify the register as per the recommendations of Austin Nichols. The writ petition was disposed off with the Court leaving the matter to the Registrar.
5. Jagatjit challenged the Registrar's order for *suo moto* cancellation stating that the jurisdiction on the issue was limited to the Appellate Board under Section 125 of the Trademarks Act.

Issues:

1. The appellants' argument here was that the rectification proceedings before the Registrar were barred (as per Section 125) as a suit for infringement had already been filed, thus jurisdiction for such proceedings *was argued to be limited to the Appellate Board*. In other words Registrar had no powers to issue suo moto rectification once the infringement proceedings were filed.

2. The *suo moto* show cause was issued by the Mumbai Registrar, while the application itself had been made by the Delhi Registrar. Therefore, another bone of contention was that the Mumbai Registrar did not have the competent jurisdiction to pass the order.

Decision of the Supreme Court:

1. The Court interpreted Section 125 to mean that an *application* for rectification under Section 125 could only be made by the defendant in the infringement case, which was Seagram. Since the defendant was not Austin Nichols, the Court held that Section 125 would have no effect on the present case. In other words Section 125 would apply to party filing the infringement action and in this case it was Seagram.

Further, the Court held that Section 125 would not apply on the facts of this case as it is the duty of the Registrar to maintain the purity of the register, the power of the Registrar to correct his own mistakes under Section 57(4) of the Act is wholly independent of the right of a party to make or not to make an application for rectification of the register referred to in Section 125. Section 125(1) would only apply to applications for rectification of the register, and not to the exercise of *suo moto* powers of the Registrar under Section 57(4).

2. Addressing the issue of the Mumbai Registrar's jurisdiction under Section 57, the Court stated that under the Trademarks Act, there is only one Registrar of Trademarks, situated in Mumbai. The Assistant Registrars of the country, all, therefore, act under the superintendence of the Registrar. Therefore, the Court held, there is no conflict in jurisdiction and the notice issued by the Mumbai Registrar was valid.

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