The Jurisdictional Dilemma Surrounding the Intellectual Property Appellate Board

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Though the IPAB was constituted as a specialized alternative tribunal to the High Courts in patent and trademark disputes, there are concerns as to its precise role in the existing judicial hierarchy. In light of the jurisdictional overlap between the IPAB and the Registrar of Trade Marks or Controller of Patents as the case may be, concerns have been raised as to the appellate nature of the Board. The situation is further complicated by the conflicting relationship the IPAB shares with the High Courts or District Courts in context of suits for infringement. Whether a litigant in a suit for infringement before the appropriate High Court or district court ought to seek a leave of the said court as to the \textit{prima facie} tenability of the plea of rectification of the plaintiff’s trademark before initiating necessary proceedings before the IPAB or the Registrar? The present paper is an endeavour to address the two cited concerns through an analysis of the judicial decisions on the highlighted issues. From a broader perspective, it is an attempt to understand the positioning of the IPAB in relation to the multiple judicial and quasi-judicial authorities functioning within its proximity.

\textbf{Keywords}: IPAB, jurisdiction trademark, patent, infringement

The Intellectual Property Appellate Board (IPAB) was established by the Central Government in 2003, vide a Gazette Notification,\textsuperscript{1} to hear and decide all appeals from the decisions and orders of the Registrar which under the previous Acts came within the jurisdiction of the High Courts.\textsuperscript{2} In addition to entertaining such appeals, the IPAB can also entertain original applications for rectification of the register under Section 57 of the Trade Marks Act, 1999 [TM Act], and Section 71 of the Patents Act, 1970 as the case may be. The provisions relating to IPAB are contained in Sections 83-100 of the TM Act, but also apply to proceedings under the Patents Act.

The primary object behind conceptualizing and establishing the IPAB was to create a specialized appellate mechanism capable of providing speedy disposal of appeals and rectification applications,\textsuperscript{3} and simultaneously lessen the litigation burden on the High Courts. This is best evidenced by two provisions of the TM Act. \textit{First}, Section 93, TM Act provides that “no court or other authority shall have or, be entitled to, exercise any jurisdiction, powers or authority in relation to the matters referred to in sub-Section(1) of Section 91.”\textsuperscript{4} \textit{Second}, Section 100, TM Act provides that “[a]ll cases of appeals against any order or decision of the Registrar and all cases pertaining to rectification of register, pending before any High Court, shall be transferred to the Appellate Board… and the Appellate Board may proceed with the matter either \textit{de novo} or from the stage it was so transferred.”\textsuperscript{5}

Therefore, it will not be inaccurate to say that the IPAB was intended to serve as a more efficient alternative to the High Courts in matters involving trade mark and patent rights. However, the situation is made complex by the overlapping jurisdiction of the IPAB on one hand, and the Registrar of Trade Marks or the Controller of Patents, as the case may be, on the other. The Act is also silent as to whether appeals against the decisions of the IPAB will lie to the High Court.\textsuperscript{6}

In this context, it is intended to study the positioning of the IPAB in the existing judicial structure in India. The purpose is to assess the appellate role performed by the IPAB and study its relationship with the High Court, the forum it sought to replace in intellectual property matters, as well as the Registrar of Trade Marks and the Controller of Patents. While doing so, two aspects in particular will be examined, the first of them being relatively less contentious. In the first chapter the precise contours of the appellate role performed by IPAB \textit{vis-à-vis} the Registrar of Trade Marks and the Controller of Patents will be assessed. This aspect is significant in light of the overlap in jurisdictions of the said forums under the Trade Marks Act, 1999 and the Patents Act, 1970.

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In the second chapter, the focus shifts to the more contentious issues arising from the jurisdictional overlap between the IPAB and High Courts. Particularly, answers will be sought as to whether is it necessary for a party appearing before a High Court or an appropriate civil court in an infringement proceeding to seek the leave of the said court before initiating rectification/revocation proceedings before the IPAB?

The Appellate Role of the IPAB

Section 91 of the TM Act provides that “[a]ny person aggrieved by an order or decision of the Registrar under this Act, or the rules made there under may prefer an appeal to the Appellate Board within three months from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal.” Similarly, an appeal shall lie to the Appellate Board from, inter alia, any decision, order or direction of the Controller or Central Government under Section15 and Section 25(4) of The Patents Act, 1970 [Patents Act]. These provisions prima facie affirm the appellate role performed by the IPAB vis-à-vis the Registrar of Trade Marks and the Controller of Patents. However, the exact nature of this role remains unclear in light of the instances where both the IPAB, and the Registrar or the Controller as the case may be, are competent forums to exercise their jurisdiction.

In context of patent law, in 2008, the Supreme Court of India was required to opine on the relationship between the IPAB and the Controller of Patents in J Mitra & Co v Assistant Controller of Patents and Design. Though the case primarily considered the peculiar situation created by a delay in enforcement of the amended Section 116 and 117A, Patents Act, the observations made therein are significant. The apex court had noted that, “By Patents (Amendment) Act, 2005 for the first time a dichotomy was inserted in the Patent Law by providing vide Section 25(1) for ‘opposition to post-grant’ and vide Section 25(2) for ‘opposition to post-grant’ of patent the Legislature intended an appeal under Section 117A(2) to the Appellate Board from any decision, order or direction of the Controller, inter alia, under Section 25(4) the Legislature intended that there shall be only one statutory appeal against grant of patent. The Legislature intended to obliterate appeal from ‘pre-grant proceedings’, which existed earlier.”

This makes it sufficiently clear that the IPAB exercises appellate jurisdiction over the Controller with respect to the post-grant opposition orders, irrespective of whether the opposition is successful or not. However, the jurisdiction of the IPAB with respect to a pre-grant opposition was further elucidated upon by Justice Muralidhar of the Delhi High Court in 2010 in UCB Farchim v CIPLA Ltd.

In UCB Farchim, an application for the grant of patent was refused by the Assistant Controller of Patents, who instead found merit in the pre-grant opposition. In response, the aggrieved applicant invoked the writ jurisdiction of the Delhi High Court. The question before the court was whether an appeal to the IPAB is maintainable against an order of the Assistant Controller refusing the grant of patent due to a pre-grant opposition? In deciding this question, Muralidhar drew a pertinent distinction between a successful and an unsuccessful pre-grant opposition.

As regards, persons who have not succeeded in the pre-grant opposition stage to prevent a grant of patent, the Court noted that as long as these are persons interested, within the meaning of Sections 25(2) and 64, Patents Act, their remedy is to file a post-grant opposition and await the decision of the Controller. If they are still aggrieved by that decision, they can file an appeal before the IPAB in under Section 117A or file for revocation under Section 64. However, there is no direct appeal to the IPAB maintainable from such an order.

Significantly, the Court’s analysis did not end there. In a situation where a pre-grant opposition is accepted and the grant of patent is refused, the court noted that although the decision is one taken under Section 25(1), it is in effect a decision under Section 15, Patents Act. Section 15 provides that “[w]here the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.”

Interestingly, Section 117A, Patents Act, 1970 permits an appeal to the IPAB from an order of the Controller under Section 25(4) of the Act dealing with post-grant oppositions, but not pre-grant oppositions. However, Section 117A does provide for an appeal to
the IPAB against the decision of the Controller under Section 15 of the Act, refusing a grant of patent in case a pre-grant opposition is considered to hold merit. Accordingly, a conjoined reading of *J Mitra* and *UCB Farchim* implies that the IPAB will exercise its appellate jurisdiction over the Controller of Patents in the following two circumstances, and no other:

(i) Under Section 25(4), Patents Act, 1970 against *any* order pertaining to a post-grant opposition filed by an interested person irrespective of the outcome.

(ii) Under Section 15, Patents Act, 1970 if the pre-grant opposition is successful resulting in the rejection of the patent application.

It must be noted that mere success of a pre-grant opposition is insufficient for the IPAB to have appellate jurisdiction over the Controller because even if the opposition is successful, the Controller can require the patent application to be amended to his satisfaction and eventually grant the patent, instead of rejecting it outright. In such circumstance, no appeal to the IPAB will be maintainable. Thus, it is imperative that in addition to the pre-grant opposition being successful, there must be an order under Section 15 of the Patents Act, which refuses the grant of a patent.

In context of the trade mark law, the position is relatively clearer. In *Costa & Co Pvt Ltd v Union of India*, Vipin Sanghi, Justice of the Delhi High Court faced with a question pertaining to the power of the IPAB to transfer to itself the rectification applications pending before the Registrar that involve substantial evidentiary overlap, even though there was no statutory basis to exercise such power. In response, Justice Sanghi relied on the decision of the Supreme Court of India in *Tirupati Balaji Developers Pvt Ltd v State of Bihar*, which dealt with the powers of the apex court *qua* the High Courts, which held that the conferral of appellate jurisdiction carries with it certain consequences as a necessary concomitant of that power. This includes the power to exercise incidental and ancillary powers without which the conferral of the principal power can be rendered redundant. Further, mere existence of appellate jurisdiction obliges the lower jurisdiction to render all of its assistance to the higher jurisdiction to enable the exercise of appellate jurisdiction effectively and the superior forum may issue a stay order or restraint order or may suspend, expedite or regulate the proceedings in the subordinate forum. In the absence of same, the hierarchy becomes meaningless. Placing reliance on such reasoning, the Court held that the IPAB, being an appellate authority by virtue of Section 91, TM Act, had the power to transfer to itself the rectification applications pending with the Registrar. The rationale adopted therein was three-fold.

*First*, in case of a rectification application, the order of the Registrar is subject to an appeal to the IPAB by the aggrieved party. Thus, ultimately, it is the view of the IPAB which would be final and binding upon the parties. Second, while exercising its appellate authority, it would be problematic if the IPAB cannot take cognizance of the fact that there are multiple proceedings pending between the same parties, involving the same issues, and take appropriate measures to preserve consistency in the decision making process; simultaneously, saving the parties from harassment and excess costs of litigation. However, it is the third ground of reasoning devised by the court that is novel as well as most persuasive.

*Third*, Section 125(2), TM Act authorizes the Registrar to transfer any rectification application to the IPAB at any stage of the proceedings if he thinks fit. However, every transfer order given by the Registrar, including an order refusing to transfer a pending application to the IPAB, is appealable by reason of Section 91, TM Act. Relying on the same, the Court reasoned that in such an appeal under Section 91, the IPAB is competent to arrive at a conclusion that the Registrar ought to have referred the pending application to the Board in the first place. As such, the IPAB can direct the Registrar to refer to it the pending applications, and if it has the jurisdiction to pass such an order in appeal, then there is no reason why it cannot do so otherwise in proceedings pending before it. Finally, the Court concluded that:

“the absence of a specific provision in the Act vesting supervisory jurisdiction in the Appellate Board over the functioning of the Registrar, and the absence of a provision vesting the jurisdiction in the Appellate Board to transfer pending cases before the Registrar to itself, or from one Registrar to another, shows that the Parliament was desirous of maintaining sufficient autonomy in the working of the office of the Registrar… Considering the aforesaid aspects, I am of the view that the Appellate Board is empowered to transfer the rectification proceedings pending before
the Registrar under Section 47 or 57 of the Act, albeit in appropriate cases where there are proceedings pending before it involving the same parties; concerning the same subject matter; substantially the same evidence and raising the same issues. It may exercise this jurisdiction after considering the relevant aspects as enumerated by the Supreme Court, unless it appears to the Appellate Board that the request made by one or the other person to seek the transfer of proceedings pending before the Registrar to itself has been made *mala fide*; to abuse the process of the Court, or for other purposes.²³

In conclusion, despite there being a jurisdictional overlap, the cited judicial pronouncements positively affirm the extent of appellate jurisdiction exercised by the IPAB over the Registrar and the Controller of Patents under varying circumstances.

**Jurisdictional Conflicts between the IPAB and High Courts/District Courts**

If the above conclusion is considered along with the fact that the IPAB was intended to serve as an alternative to High Courts, then there appears to be a limited scope for any jurisdiction conflict between the two judicial authorities. However, the existing judicial set-up fails to grant sufficient autonomy to special tribunals, running contrary to the very purpose behind their establishment, i.e. efficiency and speedy dispute resolution.

In *L Chandra Kumar v Union of India*,²⁴ the Supreme Court of India had the opportunity to comment on the relationship between the High Courts and administrative tribunals. The apex court held that the power vested in High Courts that allows them to exercise judicial superintendence over courts and tribunals is a part of the basic structure of the Constitution. As such, the tribunals established under ordinary legislations cannot exercise the power of judicial review in a manner so as to exclude the High Courts or the Supreme Court under Article 226 or 32 of the Indian Constitution respectively.²⁵ Subsequently, the Apex Court in *Surya Raj v Ram Chander Rai*²⁶ extended this rationale to all tribunals entertaining private litigation. As evident by the numerous writ petitions filed against the Appellate Board’s decisions, this includes the IPAB as well. Hence, despite serving as an appellate tribunal and as an alternative to High Courts, the IPAB decisions are subject to the writ jurisdiction under Article 226, and as decided by the Apex Court in *Infosys Technologies Ltd v Jupiter Infosys Ltd*,²⁷ even under Article 136 of the Indian Constitution.²⁸ The blurring of the IPAB’s relationship with High Courts often places the two forums at loggerheads. However, in this paper, the author does not intend to either comment on the decision in *L Chandra Kumar*, or the maintainability of a writ under Article 226 against an IPAB order, or the decision in *Jupiter Infosys Ltd*. Instead, a specific conflict between the IPAB and the High Courts (or civil courts with the requisite pecuniary jurisdiction) due to a potential jurisdictional overlap is addressed.

It is relevant to note that only High Courts and district courts, not the IPAB, are competent to entertain a suit for trademark or patent infringement, as the case may be.²⁹ In such proceedings, the defending party often takes up a defence that the complained mark is registered under the TM Act,³⁰ or that the plaintiff’s trademark is invalid. Likewise, in patent proceedings, the defending party often tends to file a counter claim seeking revocation of the Plaintiff’s patent. However, a similar application for rectification of the register or revocation of the patent, as the case may be, can be filed either before the Registrar/Controller, or the IPAB involving identical considerations of facts and law. As evident, this creates an ambivalent situation where two legal proceedings involving identical questions are pending simultaneously before the IPAB, and the High Court or district court. In such scenario, it becomes imperative to stay one proceeding in light of the other to avoid duplicity of proceedings and two potentially conflicting judicial decisions.

In context of patent law, the above predicament was addressed by the Supreme Court of India in *Dr Aloys Wobben v Yogesh Mehra*,³¹ wherein, the Respondents had filed multiple revocation petitions before the IPAB, seeking revocation of patents held in the name of the Appellant. In response, the Appellant filed ten patent infringements suit before the Delhi High Court against the Respondents. Predictably, in all ten suits, the Respondents filed counter-claims, reiterating their relief of revocation of the Appellant’s patents. Additionally, the Respondent filed another four revocation petitions against the Appellant before the IPAB.

Intertwined in this web of litigations, the Appellant argued before the Apex Court that where a counter-claim has been instituted by a Defendant in response to a suit for patent infringement in the High Court, there can be no further proceeding in the revocation
petition filed before the IPAB, notwithstanding whether such revocations petitions were instituted prior or subsequent to the filing of the suit for patent infringement. It was also contended that the jurisdiction of a High Court to decide a counter-claim for revocation was exclusive, and could not be ousted merely by initiating proceedings simultaneously before the IPAB. In such a case, the Apex Court accepted the Appellant’s contention “that the liberty granted to any person interested to file a revocation petition to challenge the grant of a patent to an individual cannot be adopted simultaneously by the same person, i.e., firstly, by filing a revocation petition, and at the same time, by filing a counter-claim in a suit for infringement.”

Having held as above, the next question, which consequently arose, pertained to the aspect of stay of proceedings. In other words, which of the two parallel proceedings, i.e. the counter claim pending before the High Court or the revocation petition pending before the IPAB, ought to be continued at the expense of the other? Relying on the doctrine of res sub-judice, as enshrined in Section 10 of the Code of Civil Procedure, 1908, the Apex Court concluded that:

“where an issue is already pending adjudication between the same parties, in a Court having jurisdiction to adjudicate upon the same, a subsequently instituted suit on the same issue between the same parties, cannot be allowed to proceed. A similar question arises for consideration before this Court, in the present controversy. If the Respondents in their capacity as ‘any person interested’ had filed a revocation petition before the institution of an infringement suit, they cannot be permitted to file a counter-claim on the same cause of action. The natural conclusion in the above situation would be [that] the validity of the grant of the patent would have to be determined in the revocation petition… in the above situation, while the revocation petition will have to be permitted to be pursued, the counter claim cannot be permitted to be continued. Therefore, in the above eventuality, it is apparent that the situation would be resolved in the same manner as it would have been resolved in cross-suits filed by the rival parties, before different jurisdictional courts.”

As such, where the grant of a patent is under challenge simultaneously before the High Court in a patent infringement suit on the one hand, and before the IPAB in a revocation petition, the proceeding which is subsequent in time will be rendered unsustainable in law in light of the legal proceeding, which was prior in time. Applying such rationale to the factual scenario before it, the Apex Court finally decided that:

“In cases where the infringement suit(s) was/were filed by the Appellant herein… before the revocation petition(s) was/were filed by the Respondents… the Respondents had the right to file counter-claim(s) to seek revocation of the patent, under the strength and authority emerging from Section 64(1) of the Patents Act. Having once filed a counter-claim, in response to the infringement suit(s)… it would not be open to the Respondents herein… to file revocation petition(s)… As such, revocation petitions filed later in point of time, than the institution of the infringement suit, would be unsustainable in law. In such cases, the prayer for revocation of the patent shall be adjudicated, while disposing of the counter-claim filed by the Respondents.”

While the Apex Court had to rely upon Section 10 of the Code of Civil Procedure, 1908 to arrive at its conclusions in context of patent law, no such reference is merited while addressing the same issue when it comes to trade mark law. Indeed, as was argued by the Appellant in Aloy Wobben, “a similar situation, as the one which has arisen in the present controversy, has been dealt with by the legislature under the [TM Act], inasmuch as, Section 124 gives power to the concerned court to stay the proceedings in a suit for infringement of a trademark, pending final disposal of proceedings for rectification of the trade mark initiated by the Defendants before the [IPAB]… [However] no such protective measure has been provided for by the legislature under the Patents Act.” While the same is true, interpretation of Section 124 has nonetheless stirred its share of controversy in various judicial corridors.

Section 124 (1) (i), TM Act, 1999 states that in any suit for infringement of a trademark, if the defendant pleads either that the complained mark is already registered under the TM Act or that the plaintiff’s trademark is invalid, and wherein any proceeding for rectification of the register in relation to the plaintiff’s or the defendant’s trademark is pending before the IPAB or Registrar, then the suit for infringement shall be stayed pending the final disposal of such proceedings.

The aforesaid provision came for interpretation before the Delhi High Court in Arun Colour Chemicals v Mithumal Essence Mart. In the said
conformity with the same.

and this Court is required to dispose of the suit in rectification proceedings would then bind the parties deciding those issues. The final order in the rectification proceedings under Section 124(4) before concerned, this Court has to await the outcome of the valid registration of an identical mark in its favour is concerned, this Court has to await the outcome of the rectification proceedings under Section 124(4) before

Posed with this dilemma, the court noted that as far as the question of infringement of the plaintiff’s trademark and defence of the defendant that it has a valid registration of an identical mark in its favour is concerned, this Court has to await the outcome of the rectification proceedings under Section 124(4) before deciding those issues. The final order in the rectification proceedings would then bind the parties and this Court is required to dispose of the suit in conformity with the same.39 Thus, it becomes clear that the TM Act, via Section124(1)(i), grants priority to the rectification proceedings pending before the IPAB or the Registrar over a suit for infringement pending before a High Court or a district court if the former is prior in time.

Section 124 (1) (i), however, is limited in its scope. It caters to a situation where application for rectification is already pending before the Registrar or the IPAB at the time of filing a suit for trademark infringement. The appropriate mechanism to deal with an application for rectification that does not pre-date an infringement suit is altogether different, and is provided for in Section 124(1)(ii), TM Act, 1999. It provides that in any suit for infringement of trademark,

(i) If the defendant pleads either of the two aforementioned defences; and

(ii) If no such proceedings are pending either before the Registrar or the IPAB; and

(iii) The court is satisfied that the plea regarding the invalidity of the registration of the plaintiff’s or defendant’s trademark is prima facie tenable

then the court shall raise an issue regarding the same, and adjourn the case for three months from such date of framing the issue in order to enable the party concerned to apply to the IPAB for rectification of the register.40 In such situation, the issue of the validity of the registration of the concerned trademark shall be determined only on an application for rectification of the register before the IPAB, and not the High Court or the district court before which the suit for infringement is pending.41

Though the language of Section 124(1) (ii) is clear, questions have been raised time and again as to the operation of this provision. Specifically, courts have been faced with the question that if no rectification proceedings are pending in any forum at the time of initiating a suit for infringement of trademark, whether is it necessary for a party to seek the leave of the High Court or the district court before which the infringement proceedings are pending, in order to file an application for rectification of the register before the IPAB in accordance with Section 125(1), TM Act?

In Puma Stationers Pvt Ltd v Hindustan Pencils Ltd,42 the Division Bench of the Delhi High Court was faced with the same question. Therein, the Bench rather surprisingly did not make any reference to Section 124(1)(ii), but chose to rely upon decisions relating to The Trade and Merchandise Marks Act, 1958. For instance, the judgment cites the decision in Chandra Bhan Dembla Trading, Delhi v Bharat Sewing Machine Co,43 which held that though a rectification application was filed subsequent to the institution of the infringement suit, “once such proceedings are filed, for the purpose of stay the fact that they are subsequent to the suit would be immaterial.”44 Blindly adopting this rationale, the Court decided that “where an application for rectification/cancellation of a registered trade mark is pending before the statutory authority, the High Court is obliged to stay further proceedings in the suit pending before it pursuant to Section 124(1) of the Trade Marks Act, 1999 [irrespective of whether it was filed before or after the suit for infringement].”45

What renders the decision in Puma Stationers surprising is that it did not discuss the 2007 decision of the same court in Astrazeneca UK Ltd v Orchid Chemicals & Pharmaceuticals Ltd.46 Therein, Justice Kumar rightly relied on a literal interpretation of the TM Act to hold that,

“Under Section 124(b), if the application for rectification is already pending, the suit can be stayed pending final disposal of such proceedings. In case the application for rectification or any such proceedings is not pending, then a party seeking rectification can apply for rectification subject to prima facie satisfaction of the Court regarding invalidity of the registration of the mark of the opposite party. In the present case, the plaintiffs, however, have sought rectification of the trade mark of the defendant by filing an application first to the
Registrar and thereafter to the Appellate Board without seeking prima facie satisfaction of this Court… On plain reading of this provision, it is apparent that the plaintiffs could not file the application for rectification without showing and obtaining a prima facie satisfaction of the Court about their plea of the invalidity of the registration of the mark of the defendant.”

The single judge relied on a similar line of reasoning adopted by a Division Bench of the Gujarat High Court in Patel Field Marshal Agencies v P M Diesels Ltd, which had noted that if no proceedings for rectification are pending at the time of raising the plea of invalidity, the prosecution of such plea by the person raising it depends on prima facie satisfaction of the Court as to the tenability of this plea. Thereafter, if the plea is found to be prima facie tenable and an issue is raised to that effect, then the matter is to be adjourned for three months to enable the person raising such plea to approach the High Court concerned with a rectification application. However, if the rectification proceedings are not already pending and the Court is not even prima facie satisfied about the tenability of the plea raised before it, the matter rests there.

This decision was followed by another decision of the Delhi High Court in Kamadhenu Realtors Pvt Ltd v Kamadhenu Ispat Ltd in 2011, surprisingly, without any mention of the Division Bench’s decision in Puma Stationers. Nonetheless, despite this inconsistency, the Delhi High Court appears to entertain the view that a party to an infringement suit must seek the leave of the High Court or the district court before which the suit is pending to file an application for rectification before the IPAB or the Registrar.

However, in stark contrast, the Madras High Court in B Mohamed Yousuff v Prabha Singh has adopted a position contrary to the Division Bench. In the above case concluded that Section 124 (1)(b)(ii), TM Act is only an enabling provision that operates in relation to the stay of civil suit, and does not impose a restriction upon the right of a person to seek rectification of the Register. To justify this conclusion, the Court further opined that,

“[T]he requirements spelt out in Section 124 (1)(b)(ii) should be read as the requirements for the grant of a stay of the suit and not as a requirement or pre-condition for filing an application for rectification. The plain reading of [the provision] shows that it does not mandate a party to obtain the leave of the Court or an order of the Court for filing an application for rectification. The right to file an application for rectification is a statutory right conferred upon a party who is aggrieved by an entry made in the Register. The said statutory right cannot be curtailed except by the very provisions of the statute.”

Relying upon this decision, even the IPAB arrived at a similar conclusion in Jeet Biri Manufacturing Co Ltd v Pravin Singhal. In addition to the reasoning endorsed by the Madras High Court, Justice Prabha Srivevan of the IPAB further noted that if the law requires a party to seek leave, then it must state the circumstances in which the leave can be refused. However, since Section 124 fails to do so, then the very idea of seeking the leave of the court to file a rectification application before the IPAB is a brutum fulmen, or an empty threat. This statutory pre-condition is both logical and necessary; the reasons being two-fold.

First, in the absence of such requirement, a defendant in a suit for infringement of a registered trademark can file a rectification application before the IPAB to delay the proceedings indefinitely as the infringement suit shall be stayed until the final disposal of the rectification application. The same necessarily works to the detriment of the plaintiff as the inefficient functioning of the IPAB, is no secret. Moreover, as was observed by the IPAB itself in Jeet Biri, albeit in a different context, “unlike Tribunals which have separate Benches for each zone, and therefore, bound by the jurisdictional High Court, Intellectual Property Appellate Board exercises its jurisdiction all over India but only sits in Circuit.” In this regard, one must not lose sight of the fact that “[t]hough the IPAB conducts hearings at four other places — Delhi, Mumbai, Kolkata and Ahmedabad — besides Chennai, the government has not provided any accommodation for the regular sitting of the Board.”
It then does not come as a surprise that proceedings before the IPAB, despite the best endeavours of the members of the Board, are often tedious and delayed, providing the perfect opportunity for litigants to engage in dilatory tactics and frivolous applications for strategic benefits.

Ironically, Justice Prabha Sridevan, in her Report submitted to the Madras High Court\(^6\) in June 2011, mere one month before the Jeet Biri judgment, had affirmed the insufficiency of the infrastructure at the IPAB. She stated that “the object of setting up tribunals is speedy disposal and it is impossible to achieve that if IPAB has to face a battle for survival every day.”\(^5\) Similarly, in her post-retirement editorial in The Hindu\(^5\) in November 2014, she again acknowledged that the IPAB is not equipped to ensure swift and speedy disposal of cases as its infrastructure strength has not been enhanced to meet the increase in the number of cases. Despite being aware of such dark realities concerning the functioning of the IPAB, these considerations did not play a role in her appreciation of the purpose behind the Section 124(1)(ii), TM Act. Though such concerns stand mitigated by the directions of the Delhi High Court towards the setting up of a permanent place in Delhi for the IPAB to carry on its functions,\(^5\) they still remain legitimate.

Second, the *prima facie* assessment of a High Court or the civil court under Section 124(1)(ii) as to the tenability of the defence raised by a party concerning the validity of a registered trademark need not have any bearing on the IPAB’s determination of the framed issue; a concern that was raised in the Jeet Biri case. This is because the Delhi High Court in *United Biotech Pvt Ltd v Orchid Chemicals Ltd*\(^6\) had already held, albeit in a different context, that in a suit for passing off or infringement, the High Court is often required to arrive at a *prima facie* conclusion on the basis of the materials placed on record at that stage. This, however, is not a final determination. It is only tentative and would not bind the Court at the stage of final determination of the suit. Similarly, as regards the IPAB, while it is necessary to show due adherence to the principles of comity of jurisdiction, the same does not in any manner suggest that the IPAB be bound by the orders of the High Court as to a *prima facie* case at a preliminary stage.\(^6\)

In this light, the position taken by the Madras High Court and the IPAB in the two cited cases appears to be erroneous, and contrary to the objectives sought to be achieved by Section 124(1), TM Act. Instead, the author is inclined to agree with the interpretation endorsed in *Astrazeneca UK Ltd* and *Kamadhenu Realtors Pvt Ltd* as the same is not only pragmatic, but also derives its strength from the language of the relevant statutory provisions. Likewise, despite the absence of a provision analogous to Section 124 of the TM Act, in the Patents Act, 1970, the reasoning and conclusions of the Apex Court in *Aloys Wobben* are sound, and further the objectives of efficient resolution of disputes pertaining to patents litigation.

**Conclusion**

The above exercise illustrates that though the positioning of the IPAB *vis-à-vis* the Registrar of Trade Marks or the Controller of Patents, as clarified by multiple judicial pronouncements, does not provide a cause for concern, it is difficult to arrive at a similar conclusion as regards the jurisdictional conflicts of the IPAB with High Courts or district courts entertaining a suit for infringement. In the latter circumstance, while the language of Section 124 of the TM Act seems to provide a workable solution, the conflicting judicial decisions as to the interpretation of the said provision leaves a lot to be desired. Against the backdrop of such conflicting decisions, and for the reasons elucidated above, the most appropriate approach is to require a litigant in a suit for infringement to seek the leave of the district court for infringement to seek the leave of the district court, before which the said suit is pending, upon showing that the plea of rectification is *prima facie* tenable, prior to initiating the necessary rectification proceedings before the IPAB or the Registrar as the case may be. A position to the contrary will not only lead to avoidable delay in the infringement proceedings, but will also run contrary to the statutory mandate.

While there is ample cause for concern in context of TM Act, no such concerns persist while addressing the same issue in relation to patent law. The Apex Court’s reliance on the principle of *res sub judice* in *Aloys Wobben* ensures that once a person opts to challenge the grant of a patent to another either before the IPAB in a revocation petition, or before the High Court in a patent infringement suit, (s)he is not entitled to raise the same challenge in a subsequent proceeding. In fact, it is conceivable that despite being in context of patent law, the said decision will go a long way in calming the uncertainty created by the conflicting decisions of the High Courts and IPAB while interpreting Section 124 of the TM Act.
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