



IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
INTERIM APPLICATION (L) NO. 23211 OF 2025

IN

COMMERCIAL MISCELLANEOUS PETITION (L) NO. 36812 OF
2024

Raman Kwatra

...Petitioner

Versus

Registrar of Trade Marks and Another

...Respondents

Mr. Hiren Kamod a/w. Ms. Dishita Shah i/b. ANM Global, for the
Petitioner/Applicant.

Mr. Yashodeep Deshmukh a/w. Mr. Ashutosh Mishra, Mr. Rutwik Rao, Ms.
Vaidehi Pradeep and Mr. Pratham Gawali, for Respondent No. 1.

Mr. Venkatesh Dhond, Senior Advocate a/w. Mr. Samarth Jaidev, Mr. Pallav
Palit, Mr. Arnav Dasgupta, Mr. Nishant Vyas, Mr. Yagnesh Vyas, Mr. Parth
Choudhary, for the Respondent No. 2.

CORAM : ARIF S. DOCTOR, J.

RESERVED ON : 23rd APRIL 2026

PRONOUNCED ON : 15th JUNE 2026

JUDGEMENT:

1. The captioned Commercial Miscellaneous Petition has been filed under the
provisions of Section 125 of the Trade Marks Act, 1999, (“**the Act**”) and

seeks the removal of the following marks: ‘KEI’ and ‘’ (“**the said**

marks”), from the Register and List of well-known Trade Marks.

2. The Respondents raised preliminary objections to the maintainability of the present Petition and it is therefore useful for context to set out the relevant factual background in which the preliminary objections have been raised.

The Facts in Brief:

3. It is not in dispute that Respondent No. 2 has obtained registration of the said marks from the Trade Mark Registry in New Delhi and has, as the registered proprietor of the said marks filed a Suit (CS Comm) No. 09/2021, in the Delhi High Court (“**the Delhi Suit**”), against the Petitioner for infringement and passing off, *inter alia*, in respect of the said marks.
4. During the pendency of the Delhi Suit, i.e. on 8th February 2023 Respondent No. 2 made an Application for the inclusion of the said marks in the list of the well-known trade marks. This application was allowed. Consequently, the impugned marks were then entered into the list of well-known trade marks.
5. Respondent No. 2 thereafter filed an Interim Application No. 34855 of 2024 in the Delhi Suit to bring on record the inclusion of the said marks after they

were declared as well-known. The Petitioner admittedly opposed the Interim Application by filing a Reply dated 28th November, 2024, in which the Petitioner stated that the Petitioner would be filing a Petition for cancellation of the declaration of the said marks as well-known.

6. It is in the aforesaid context of facts that the present Petition has been filed.
7. However, since both the Respondents have raised preliminary objections to the maintainability of the Petition, it is therefore appropriate to first consider and deal with these preliminary objections.

Preliminary Objections on behalf of Respondent No. 1:

8. Mr. Deshmukh Learned Counsel appearing on behalf of Respondent No. 1 submitted that the present proceedings, insofar as they seek to invoke Section 125 read with Section 57 of the Act, for rectification or removal of the said marks from the list of well-known trade marks, is misconceived and is not maintainable.
9. He then submitted that the statutory scheme of the Act, and the Trade Marks Rules, 2017, (“**the Rules**”) draws a clear and deliberate distinction between:
 - (a) Rectification of the Register of trade marks maintained under Section 6

of the Act, which is governed by Sections 47 and 57 of the Act; and

- (b) Inclusion and removal of trade marks from the list of well-known trade marks, which is governed exclusively by Section 11 of the Act read with Rule 124 of the Rules.

Section 57 empowers rectification only in respect of “the Register”:

10. Mr. Deshmukh then submitted that the expression “Register” is exhaustively defined in Section 2(1)(t) of the Act to mean the Register of trade marks referred to in Section 6 of the Act. He submitted that Section 6 provides for maintenance of a class-wise Register of trade marks containing particulars of registered trade marks and related entries.

The list of well-known trade marks does not form part of the Register under Section 6:

11. He submitted that the inclusion of the list of well-known trade marks as a part of the Register is not contemplated within the statutory framework under the Act since a mark is capable of being included in the list of well-known trade marks without it being registered under the Act. He submitted that consequently, neither Section 57 nor Section 125 were the appropriate

provisions to challenge the inclusion in, or seek rectification of, the list of well-known trade marks.

Removal of trade mark Anchored in Rule 124, not Section 57:

12. He then submitted that the substantive recognition of a trade mark as “well-known” flows from Section 11(6) to 11(9) of the Act and that the procedural machinery for publication, inclusion, and removal of a mark in the list of well-known trade marks was provided exclusively by Rule 124 of the Rules. He pointed out that Rule 124(5) mandates publication and inclusion of a trade mark in the list of well-known trade marks and that Rule 124(6) expressly empowers the Registrar to remove a trade mark from the list if it was included erroneously or it had ceased to be well-known.
13. He pointed out that the Hon’ble Delhi High Court in *Tata Sia Airlines Ltd. v. Union of India*¹ and further in *Kamdhenu Ltd. v. Registrar of Trade Marks*² held that Sub-Rules (5) and (6) enable the Registrar to publish a well-known trade mark in the Trade Marks Journal and include the same in the list of well-known trade marks or then to remove the same if included

¹ Order dated 25 May 2023 in W.P. (C) - IPD 64/2021 & CM APPL. 47831/2019 and 10/2022 passed by Delhi High Court.

² Order dated 6 July 2023 in C.A.(COMM.IPD-TM) 66/2021 passed by Delhi High Court.

erroneously. He thus submitted that while dealing with inclusion and removal from the list of well-known trade marks, the Delhi High Court had anchored the statutory power exclusively in Rule 124(6) and did not discuss or invoke Section 57. He submitted that this constituted a clear judicial recognition that the well-known trade marks list was not treated as part of the Section 6 Register and that removal of a well-known trade mark was governed by Rule 124, and not by rectification under Section 57. He therefore submitted that the legislature had created a self-contained statutory mechanism governing well-known trade marks which was distinct from rectification of the Register under Section 57 and/or Section 125.

Appeal Under Section 91 is the Appropriate Remedy Against Inclusion in list of well-known trade marks:

14. Mr. Deshmukh then submitted that an order of the Registrar directing the inclusion of a trade mark in the list of well-known trade marks is a statutory order having serious civil and commercial consequences, which include mandatory cross-class blocking under Section 11(2); and mandatory refusal duties under Section 11(10).
15. He thus submitted that the impugned order of inclusion therefore is

amenable to statutory appeal under Section 91 of the Act, which provides for an appeal against any order or decision of the Registrar. He submitted that it was well settled that where the Act provides a specific appellate remedy it is only such remedy as prescribed by statute which must be availed by an aggrieved party. He therefore submitted that Section 125 read with Section 57 of the Act cannot be used to collaterally attack or indirectly set aside an order of inclusion to the list of well-known trade marks passed by the Registrar.

Submissions on maintainability and proper statutory remedy in relation to the Rectification Petition under Section 57 read with 125 against the impugned trade marks:

16. Mr. Deshmukh then submitted that the New Delhi Office of the Trade Mark Registry was the appropriate office for the purposes of a Petition filed under Section 125 of the Act. In support of his contention he pointed out that both the Petitioner and Respondent No. 2 have their registered place of business in New Delhi. The respective trade marks registrations were applied for and granted registration by the Trade Mark Registry, in New Delhi, being the Appropriate Office of the Trade Marks Registry under Rule 4 and more

particularly under Rule 4(A)(1) of the Rules 2017.

A prima facie tenability of plea challenging the validity of registration of a trade mark is necessary to invoke S. 57 and S.125:

17. He then submitted that admittedly the Petitioner and Respondent No. 2 are embroiled in a trade mark infringement Suit which is pending before the Delhi High Court. He then submitted that it was unclear from the record as to whether the parties had caused an issue with regard to invalidity of the impugned trade marks to be framed in said pending Suit. He then submitted that a contingency such as the present one was what was squarely covered under Section 124 of the Act. He then placed reliance upon the decision of the Hon'ble Supreme Court in the case of *Patel Field Marshal Agencies v. P.M. Diesels Ltd.*³, which he submitted had authoritatively held that parties may invoke Section 57 or Section 125 of the Act to seek rectification of the register “*only if the Civil Court is satisfied that an issue with regard to invalidity ought to be framed in the suit. Once an issue to the said effect is framed, the matter will have to go to the Tribunal and the decision of the*

³ AIR 2017 SCC 1388.

Tribunal will thereafter bind the Civil Court. If despite the order of the civil court the parties do not approach the Tribunal for rectification, the plea with regard to rectification will no longer survive.”

18. He pointed out that the above position was reiterated by the Kerala High Court in ***Pas Agro Foods v. KRBL Limited***⁴ which held as follows :

“The law is clear on this point. The Petitioner cannot file the above Special Jurisdiction Case under Section 57 of the Act seeking cancellation of the trade mark registration granted to the Respondent No. 1 without framing an issue regarding the invalidity of the registration in C.S.(Comm) No. 78/2025 pending before the District Court, New Delhi, after satisfying the Court of the prima facie tenability of the plea regarding the validity of the registration of the trade mark.”

19. He then submitted that the power of rectification under Section 57 read with Section 125 was exercisable only by the High Court exercising appellate jurisdiction over the Appropriate Office of the Trade Mark Registry, which made the entry relating to the impugned mark. He reiterated that in the instant case it was the Trade Marks Registry in New Delhi and thus the ‘High Court’ under Section 125 of the Act was the Delhi High Court. He

⁴ 2025 SCC OnLine Ker 11104.

submitted that this position was categorically expounded by the Madras High Court in the case of *M/s. Woltop India Pvt. Ltd v. Union Of India*⁵

which he pointed out *inter alia* held as follows :

“Therefore, I conclude that the power of rectification is exercisable only by the High Court exercising appellate jurisdiction over the appropriate office of the Trade Marks Registry, wherein the entry relating to the impugned mark was made. Therefore, even insofar as the Rectification under Section 57 read with Section 125 is concerned, the Delhi High Court is the appropriate forum before which the instant Petition ought to have been filed.”

Basis the above, he submitted that this Court ought not to entertain the present Petition.

Preliminary Objections on behalf of Respondent No. 2:

20. Mr. Dhond, Learned Senior Counsel appearing on behalf of Respondent No. 2, at the outset submitted that the following question is what really falls for determination in the facts of the present case, viz.

“Whether this Court should exercise discretion and entertain an Application for rectification by a person who is a Defendant in an infringement Suit instituted, prior in point of time, in another High Court, by a Plaintiff who is within jurisdiction against the Defendant who has filed the rectification, who is also within jurisdiction of that

⁵ 2025 SCC OnLine Mad 9347.

Court”.

Mr. Dhond then submitted (i) that this Court does not have jurisdiction to entertain the present Petition; and (ii) in the alternative, even assuming this Court has jurisdiction, such jurisdiction ought not to be exercised on the ground of forum conveniens.

21. In support of his first contention, he submitted that use of 'the' before 'High Court' in Section 125 of the Act made evident Parliament's intention to confer jurisdiction upon a single/particular High Court which is linked to the office of the Trade Marks Registry which granted the trade mark registration. He then placed reliance upon the decisions of the Madras High Court in *M/s. Woltop India Pvt. Ltd. v. Union of India*, and the Kerala High Court in *Pas Agro Foods v. KRBL Limited* and *T.T. Salads and Grill LLP v. Secretary, DPIIT*⁶, to point out that it had consistently been held that the power of rectification is exercisable only by the High Court exercising appellate jurisdiction over the appropriate office of the Trade Marks Registry that granted registration. He then also pointed out that the Delhi

⁶ 2025 SCC OnLine Ker 13041.

High Court had, in *Dr. Reddy's Laboratories Ltd. v. Fast Cure Pharma & Anr.*,⁷ additionally recognised the concept of 'dynamic effect', which also recognises that jurisdiction may be attracted on account of the territorial impact or effect of a trade mark. He, however, fairly pointed out that the said decision and the concept of dynamic effect had been doubted by the Delhi High Court in *Hershey Company v. Dilip Kumar Bacha*,⁸ and the matter was now pending consideration before a larger bench.

22. Learned Senior Counsel then submitted that when the law laid down in *Wooltop India Pvt. Ltd* and *Pas Agro Foods* was applied to the facts of the present case, it would be the Delhi High Court which had jurisdiction to decide a Petition for rectification since both the Petitioner and Respondent No. 2 carry on business in Delhi, the underlying trade mark registrations of the said marks were granted by the Trade Marks Registry in Delhi, and a prior Suit for infringement of these very marks was already pending between Respondent No. 2 and the Petitioner before the Delhi High Court.
23. Mr. Dhond, then, in the alternative, submitted that even assuming this Court

⁷ 2023 SCC OnLine Del 5409.

⁸ 2024 SCC OnLine Del 814.

was vested with jurisdiction to decide the present rectification Petition, this Court ought not to do so on the basis of the doctrine of forum conveniens since there already was a prior Suit between the same parties which was pending before the Delhi High Court. He submitted that if this Court were to entertain the present Petition, there would be a strong possibility of conflicting decisions, given the overlap of the issues that would fall for consideration in the present Petition and the Delhi Suit.

24. He then submitted that when Courts are faced with overlapping issues which could potentially give rise to conflicting decisions, the Courts should best ensure that such conflicting decisions do not arise. This he submitted was not only in the interest of the parties to a lis but also in the larger public interest. In support of his contention, he placed reliance upon the decisions in *Karam Chand Thapar and Bros. (Coal Sales) v. Inder Mohan Kapoor*,⁹ *Rooprekha Sales Pvt. Ltd. v. Navkar Buildwell Pvt. Ltd.*,¹⁰ *Krishna Veni Nagam v. Harish Nagam*,¹¹ *GlaxoSmithKline Consumer Healthcare Ltd.*

⁹ 1971 SCC OnLine Cal 6.

¹⁰ 2015 SCC OnLine Cal 4436.

¹¹(2017) 4 SCC 150.

& Ors. v. Heinz India (P) Ltd.,¹² Romil Gupta v. Registrar of Trade Marks & Anr.,¹³ Union of India v. Cipla Limited,¹⁴ and Bharat Nidhi Ltd. v. SEBI.¹⁵ Basis the above, he submitted that this Court did not have jurisdiction as the ‘High Court’ under Section 125 of the Act is the Delhi High Court. Alternatively, he submitted that even if this Court had jurisdiction the same ought not to be excused on the ground of forum conveniens.

Submissions on behalf of the Petitioner:

25. Mr. Kamod, Learned Counsel appearing on behalf of the Petitioner first in dealing with the Preliminary Objections raised by Respondent No. 1, submitted that the attempt on the part of Respondent No. 1 to draw a distinction between the "Register" and the "List" of well-known Trade Marks was plainly misconceived and contrary to the statutory scheme of the Act. He pointed out that Section 11(8) of the Act specifically provided as follows:

“Where a trade mark has been determined to be well known in at

¹² 2009 SCC OnLine Del 9.

¹³ 2023 SCC OnLine Del 4377.

¹⁴ (2017) 5 SCC 262.

¹⁵ 2023 SCC OnLine Del 8073.

least one relevant section of the public in India by any Court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.”

(emphasis supplied)

He thus submitted that it was clear that recognising a mark as a well-known trade mark carries significant statutory consequences similar to those of registration. He submitted that once a mark was declared as a well-known trade mark, it was required to be treated as such “*for registration under the Act,*” as specifically provided in Section 11(8). He therefore submitted that the declaration of a mark as a well-known trade mark conferred substantive rights under the Act, including cross-class protection and mandatory consideration by the Registrar, and these rights flowed from Section 11 of the Act and not from Rule 124, which was merely procedural in nature.

26. Mr. Kamod then, in the context of the above, stated that the jurisdiction for rectification cannot be excluded in the manner suggested by Respondent No. 1. He submitted that Section 57 confers wide powers to correct or remove wrong entries which affect the rights of any party and that Section 125 enables the High Court to exercise such jurisdiction. He submitted that any

interpretation that seeks to insulate the list of well-known trade marks from challenge under Section 125 would therefore render the statutory safeguards provided for in the Act illusory and leave the affected parties without an effective remedy. He thus submitted that an entry recognising a trade mark as well-known and having a clear statutory consequence cannot be rendered immune from challenge or rectification.

27. Mr. Kamod then submitted that the contention of Respondent No. 1 that the Petitioner ought to have filed an Appeal under Section 91 of the Act was fundamentally flawed. In support of this contention, he first pointed out that there was in fact no 'order' since the inclusion of the impugned marks in the Trade Marks Journal was effected by mere publication and not pursuant to any adjudicatory process culminating in a reasoned order. Secondly, he submitted that even if the inclusion was on the basis of a reasoned order the remedy of Appeal under Section 91 would in most cases be illusory since Section 91 mandates that an Appeal must be filed within three months from the date of the order. He pointed out that in most cases, knowledge of the declaration of a mark as well-known or inclusion of such mark in the list of

well-known trade marks would be well after the period of three months had elapsed, and it was thus submitted that the remedy of Appeal under Section 91 would really be illusory.

28. Mr. Kamod submitted that Respondent No. 1's reliance upon the decisions of the Delhi High Court in the case of *Tata Sia Airlines Ltd. v. Union of India* and *Kamdhenu Ltd. v. Registrar of Trade Marks* was entirely misplaced. He first pointed out that neither of the said decisions adjudicated upon nor determined the issue of the maintainability of rectification proceedings under Sections 57 and 125 of the Act. Secondly, he submitted that at best, both decisions only dealt with the procedural framework under Rule 124 only in the context of determination and publication of well-known trade marks. Most importantly, he pointed out that there were no findings or observations in either of the said decisions to support the contention of Respondent No. 1 that jurisdiction under Section 57 stands excluded or ousted, as urged by Mr. Deshmukh. He thus submitted that the said decisions would not aid Respondent No. 1 in any manner.

29. Mr Kamod, in dealing with the contentions of Respondent No. 2, submitted

that Respondent No. 2 had merely taken a bald plea that this Court lacked jurisdiction, unsupported by any statutory provisions or case law. He then took pains to point out that the very fact that Respondent No. 2 had invoked the doctrine of forum conveniens was itself a tacit admission that this Court has jurisdiction.

30. Mr. Kamod then pointed out that the application for declaring the impugned marks as well-known trade marks was filed, processed, and examined by the Trade Marks Registry in Mumbai. He submitted that the inclusion of the impugned marks in the list of well-known trade marks was also effected by the Trade Marks Registry in Mumbai. He thus submitted that “the High Court” as contemplated in Section 125 could only be this Court and no other Court. He submitted that this was not a case of overlapping or concurrent jurisdiction as suggested by Respondent No. 2 but was plainly a case where the statutory framework of the Act specifically provides for a forum, i.e., the High Court, exercising jurisdiction over the Registry that processed and recorded the impugned entry, which he reiterated was the Bombay High Court.

31. Mr. Kamod, in response to the contention that this Court ought not to exercise jurisdiction on the ground of forum conveniens, pointed out that such a contention was wholly misconceived and contrary to the scheme of the Act. He pointed out that the Act does not envisage the transfer or consolidation of rectification proceedings with an infringement Suit pending before another Court. He submitted that, on the contrary, the statutory framework of the Act expressly contemplates that rectification proceedings may proceed independently before the appropriate forum, and where necessary, the infringement Suit may be stayed under the provisions of Section 124 of the Act pending the outcome of such rectification proceedings.
32. Mr. Kamod pointed out that the Act is a self-contained Code which prescribes the forum for rectification under Sections 57 and 125 and that such a statutory prescription cannot be displaced by discretionary considerations of forum conveniens. He submitted that the contention of Respondent No. 2 that all issues ought to be decided by a single Court on account of forum conveniens was contrary to the legislative framework of

the Act. He submitted that this position becomes even clearer when the Act is contrasted with the Patents Act, 1970, i.e., Section 104 and the Designs Act, 2000, i.e., Section 22(4). He reiterated that no such provisions existed under the Act and that this omission was therefore clearly deliberate and reflected the legislative intent that rectification and infringement proceedings were to proceed independently but on coordinated tracks and not necessarily before the same Court.

33. Mr. Kamod submitted that the concept of “dynamic effect” cannot be invoked to confer jurisdiction upon multiple High Courts based on the perceived impact of a mark in different territories. He submitted that such an approach would render the statutory scheme of the Act unworkable and would lead to a multiplicity of proceedings and conflicting decisions. He thus submitted that the Act consciously avoids such uncertainty by anchoring jurisdiction under Section 125 to a specific High Court that has a nexus with the Trade Marks Registry that made the impugned entry on the Register. He submitted that jurisdiction cannot be expanded on the basis of the alleged nationwide or dynamic effect of the mark. This view he

submitted was further fortified by the decision of the Madras High Court in the case of *Woltop India Pvt. Ltd*, which, *inter alia*, held that allowing jurisdiction to be assumed on the basis of “dynamic effect” would lead to jurisdictional chaos and conflicting decisions.

34. He then submitted that since the offices of the Trade Marks Registries were currently located in Mumbai, New Delhi, Calcutta, Chennai, and Ahmedabad, it could only be the High Court exercising appellate jurisdiction over each of these offices, which would have jurisdiction to entertain a Petition for rectification.
35. Mr. Kamod also pointed out that the decision of the Madras High Court in *Pas Agro Foods* followed the earlier decision in *Woltop India Pvt. Ltd* and, *inter alia*, held that the scheme of Sections 47, 57, 91, 124 and 125 of the Act, read with Rules 4 and 5 of the Trade Marks Rules, 2017, makes clear that a rectification petition can only be entertained by the High Court exercising appellate jurisdiction over the appropriate office of the Trade Marks Registry where the impugned mark was registered and that use of the expression 'the High Court' was deliberate and indicative of Parliament's

intention to confer jurisdiction only upon a specific High Court which exercised supervisory jurisdiction over the concerned Trade Marks Registry.

36. Basis the above, he submitted that the statutory scheme under the Act mandates that rectification jurisdiction is anchored to the High Court exercising appellate jurisdiction over the Trade Marks Registry which granted the registration in question. He submitted that any attempt to invoke jurisdiction based on the basis of “dynamic effect” or forum conveniens was therefore plainly contrary to the scheme of the Act and thus liable to be rejected.
37. He submitted that none of the decisions upon which reliance was placed by Respondent No. 2 supported the propositions sought to be advanced on the aspect of forum conveniens or the alleged “dynamic effect”. He submitted that, in fact, a careful perusal of the decisions would demonstrate that they do not lay down any principle that jurisdiction in rectification proceedings can be shifted or declined on grounds of forum conveniens, nor do they endorse the proposition that jurisdiction can be determined based on the nationwide or “dynamic” impact of a trade mark.

38. He submitted that jurisdiction is to be determined by the statutory scheme under the Act and not by discretionary considerations. He further submitted that all the decisions relied upon by Respondent No. 2 pertained to issues concerning registered trade marks in general, and none deal with the specific statutory framework governing well-known trade marks. He therefore submitted that the Respondents' reliance on these authorities was misplaced and did not support the case of the Respondents.
39. Mr. Kamod then submitted that the contention of Respondent No. 2, in substance, was to seek a transfer of the present proceedings to the Delhi High Court. He, however, submitted that such power was vested only in the Hon'ble Supreme Court and that this Court did not have any power to transfer proceedings to any other Court, more so when this Court was the only Court having jurisdiction to entertain and decide the present Petition.
40. As regards the notice dated 24th February 2026, by which the well-known trade mark Section was stated to have been shifted from Mumbai to New Delhi with effect from 25th February 2026, and Mr. Kamod submitted that such a subsequent administrative change can have no retrospective effect so

as to divest this Court of jurisdiction which had validly vested at the time of institution of the present Petition.

41. Mr. Kamod finally submitted that the present Petition is one seeking rectification and removal of the entries of the impugned marks from the list of well-known trade marks maintained by the Registry, whereas the proceeding pending before the Delhi High Court was a Suit for infringement. He submitted that both these proceedings were distinct and independent proceedings governed by separate statutory provisions and that the pendency of the Suit before the Delhi High Court does not in any manner affect the maintainability or jurisdiction of this Court to entertain the present Petition.
42. Basis the above, he submitted that the contention of Respondent No. 2 that this Court should decline jurisdiction on the ground of forum conveniens is wholly unsustainable and liable to be rejected.

REASONS AND CONCLUSIONS:

43. Having heard Learned Counsel for the parties and having considered their rival contentions as also the case law upon which reliance has been placed, I find as follows, viz.

A. I am unable to accept the contention that this Court lacks jurisdiction to entertain the present Petition. It is not in dispute that (i) the application seeking declaration of the said marks as well-known was made and allowed by the Trade Mark Registry in Mumbai and (ii) the Petition has been filed solely under the provisions of Section 125 of the Act. A plain reading of Section 125 of the Act leaves no manner of doubt that the appropriate Court to entertain a rectification Petition is “the High Court” exercising appellate jurisdiction over the Trade Mark Registry that processed and recorded the impugned entry, in this case, as already noted it is the Trade Mark Registry in Mumbai. In these facts, and as held in the case of *Wooltop India Pvt. Ltd.* and *Pas Agro Foods*, it cannot, in my view, be suggested that this Court does not have jurisdiction to entertain the present proceedings.

B. I also find no merit in the contention of Respondent No. 1 that the present Petition is not maintainable under the provisions of Sections 57 and 125 of the Act or that the Petitioner’s remedy is by way of either an appeal under Section 91 of the Act or by invoking Rule 124(6) of the

Trade Marks Rules. It is, to my mind, clear that once a mark is declared well-known, the said mark has all the trappings of a registered trade mark. This is apparent from Section 11(8) of the Act, which expressly provides that once a mark is determined to be well-known, “*the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.*” It is therefore clear that the declaration of a mark as well-known carries with it all the statutory consequences, which would follow and apply to a registered trade mark.

C. Simply put, though prior registration is not necessary for a mark to be recognised/declared as ‘well known’, once a mark is declared as a well-known trade mark, any such mark is deemed to be registered under the provisions of the Act. It is for this reason that the list of well-known trade marks cannot be insulated from the jurisdiction under Section 57 and Section 125 merely because it is reflected in a separately maintained list from the Register of trade marks.

D. In addition to what is noted in (B) and (C) above, I also find merit in the contention of the Petitioner that an Appeal under Section 91 would

not be the appropriate or efficacious remedy for two reasons. Firstly, it is common ground that the declaration of a mark as 'well-known' is effected only by publication and not pursuant to any adjudicatory process culminating in a reasoned order. Thus, there is no order, much less a reasoned order which can be tested in Appeal. Secondly, even assuming that such Order were to exist, the remedy of Appeal in most cases would only be a remedy that is available on paper since the limitation prescribed under Section 91 is three months. Therefore, in cases where knowledge of the declaration of a mark as well-known is beyond the period of three months, the aggrieved party would be precluded from challenging such a declaration. The Petitioner's contention that the remedy of Appeal would in most cases be illusory is, in my view, well founded.

E. I find that the question which is to be determined, and as aptly framed by Respondent No. 2, is not merely whether this Court possesses jurisdiction but whether, given the peculiar facts of the present case, this Court should exercise jurisdiction. In answer to this question I find

much merit in the preliminary objection raised by Respondent No. 2 calling upon this Court not to exercise jurisdiction on the ground of forum conveniens. It is undisputed that (i) Respondent No. 2 has, prior in point of time, filed a Suit in the Delhi High Court for infringement and passing off in respect of the very same marks; (ii) some of the issues which would arise for determination in the present Petition as well as the the Delhi Suit, such as infringement, goodwill, and use of the impugned marks would certainly overlap, and therefore there exists every possibility of conflicting decisions/findings on the same and/or largely overlapping issues; (iii) admittedly both the Petitioner and Respondent No. 2 carry on business within the territorial jurisdiction of the Delhi High Court; (iv) the trade mark registrations of both the impugned marks were applied for and granted by the Trade Marks Registry at New Delhi; and (v) the well-known trade mark Section of the Trade Marks Registry has now admittedly been transferred to New Delhi.

F. In addition to the above, I also find much merit in the contention of Respondent No. 2 that where common or substantially overlapping issues arise in parallel proceedings, Courts should, as far as possible, adopt a course that avoids the possibility of multiplicity of proceedings and conflicting decisions. In this context, reliance placed by Respondent No. 2 on the decisions in *Karam Chand Thapar and Bros. (Coal Sales)*, *Rooprekha Sales Pvt. Ltd.*, *Krishna Veni Nagam, GlaxoSmithKline Consumer Healthcare Ltd.*, *Romil Gupta, Union of India v. Cipla Limited* and *Bharat Nidhi Ltd.* is entirely apposite.

G. I find that the decisions in *M/s. Woltop India Pvt. Ltd.* and *Pas Agro Foods* also make clear that the scheme of the Act is also to avoid multiplicity of proceedings, jurisdictional uncertainty and conflicting decisions in matters concerning rectification and validity of trade marks. Though these decisions were rendered in the context of determining jurisdiction in the context of Sections 47, 57 and 125 of the Act, it is clear that the real issue at hand was the question of competing

adjudications before multiple High Courts in relation to the same marks, which would lead to possibility of conflicting decisions and uncertainty.

H. While the present Petition and the Delhi Suit may be separate and distinct proceedings, as noted in (E) the issues which arise for determination in the Delhi Suit and the present proceedings to some extent will, undoubtedly, overlap. It is also to be noted that even insofar as Sections 124 and 125 of the Act are concerned, the question which is really central to both Sections is the validity of the registration in question. As held by the Hon'ble Supreme Court in the case of *Patel Field Marshal*, the Court before which the infringement Suit is pending must first determine whether the plea of invalidity is prima facie tenable and, if so, frame an issue in that regard and direct the party concerned to pursue rectification proceedings before the appropriate forum. Thus, the underlying purpose of Sections 124 and 125 is to ensure that questions regarding the validity and enforceability of a trade mark are connected to, and adjudicated in accordance with, the infringement proceedings in which the issue of validity arises.

I. Also, and in addition to (E) and (H), it is common ground that the declaration of a mark as “well-known” does not involve the same level of examination as an application for registration of a trade mark. In fact, the Petitioner has conceded that the declaration of a mark as well-known is essentially an administrative/ministerial act that does not entail an adjudicatory process or culminate in a reasoned order. Given this, the forum before which the validity of the underlying registration will be tested is the Delhi High Court. In these facts, I am unable to accept the Petitioner’s contention that the mere fact that the present Petition and the Delhi Suit arise under different statutory provisions is sufficient to treat them as being totally independent for present purposes. While the causes of action may be distinct, both proceedings concern the same parties and the same marks, and involve overlapping questions relating to validity, reputation, distinctiveness and use. Further, even if the infringement claim in the Delhi Suit were to be stayed pending rectification proceedings, the passing off claim would not necessarily stand stayed. Issues relating to reputation, goodwill, distinctiveness and

use may therefore continue to arise before the Delhi High Court, reinforcing the possibility of conflicting decisions on substantially overlapping issues.

J. I find that the contention that the Act constitutes a self-contained Code and, therefore, the doctrine of forum conveniens cannot be taken into consideration also cannot be accepted in absolute terms. Sections 57, 124 and 125 undoubtedly provide the statutory framework governing rectification proceedings. However, nothing in the said provisions can be construed to mean that every High Court, otherwise vested with jurisdiction, must necessarily exercise such jurisdiction irrespective of the factual matrix and irrespective of the possibility of there being conflicting decisions and multiplicity of proceedings when the same can be obviated by another competent forum exercising jurisdiction. In my view, what is of overarching significance and importance is to, as far as possible, ensure that a situation which could potentially give rise to conflicting decisions is avoided. It is thus that I find that the Delhi High

Court would be best suited to decide the issues which fall for determination in the present Petition.

44. Therefore, while this Court does not lack jurisdiction to entertain the present Petition, for the reasons stated above, and more particularly in (E), (G) and (J), I am of the view that the Delhi High Court is the more appropriate and convenient forum for the adjudication of the present Petition.
45. Hence, for the aforesaid reasons, I pass the following Order:

ORDER

- i. The preliminary objection raised by Respondent No. 2 that this Court ought not to, in the facts of the present case, entertain the Petition on the ground of forum conveniens is upheld.
- ii. In light of the above, the Petitioner is at liberty to take steps or file the appropriate proceedings before the Delhi High Court.

[ARIF S. DOCTOR, J.]