
(2019) 08 DEL CK 0126

In the Delhi High Court

Case No : Civil Suits (COMM) No. 1147 Of 2016

Argus Cosmetics Limited

APPELLANT

Vs

Rameshchandra R Pandey & Ors

RESPONDENT

Date of Decision : 09-08-2019

Acts Referred:

Trade Marks Act, 1999 — Section 17, 28(3), 30(2)(c), 30(2)(e), 47, 124

Citation : (2019) 08 DEL CK 0126

Hon'ble Judges : Rajiv Sahai Endlaw, J

Bench : Single Bench

Advocate : Saurabh Srivastava, Ranjeet Singh Sidhu, Vaarish Sawlani, Neeraj Grover, Vasvi Tapriya

Final Decision : Allowed

Judgement

Rajiv Sahai Endlaw, J

IA No.1405/2019 (of plaintiff u/S 124 of Trade Marks Act, 1999)

1. The counsel for the applicant/plaintiff and the counsel for the defendants have been heard.
2. The applicant/plaintiff instituted this suit for permanent injunction restraining infringement of its label mark 'Z' in Class 3 by the defendants, by adopting a label mark also with the alphabets 'ZX' and for ancillary reliefs.
3. The suit was entertained, though no ex-parte injunction granted to the plaintiff owing to the delay on the part of the applicant/plaintiff in instituting the suit.
4. The defendants, in their written statement disclosed registration in their own favour and amended their written statement, successively, to take the pleas with respect to two other registrations granted in favour of the defendants during the pendency of the suit.
5. Finding the label mark of the applicant/plaintiff as well as of the defendants to

be similar / deceptively similar, I have straightway enquired from the counsel for the defendants, why the application should not be allowed.

6. The counsel for the defendants has contended, (i) that the plaintiff, in the replication to the original written statement filed by the defendants disclosing registration in their favour, did not take the plea of invalidity of the registration in favour of the defendants; (ii) that no such plea was taken in the replication filed to the amended written statement disclosing the second registration in favour of the defendant; (iii) that only in the replication of the year 2016 to the subsequent amendment of the written statement, disclosing the third registration in favour of the defendant, has a whisper been made of the registrations in favour of the defendants being wrong, without expressly taking the defence of invalidity; (iv) that as per the dicta of the Supreme Court in *Patel Field Marshal Agencies Vs. P.M. Diesels Ltd.* (2018) 2 SCC 112, the permission under Section 124 of the Trade Marks Act, 1999 is to be granted only if an issue of invalidity is raised in the suit and the question of an issue of invalidity arising in the present suit, in the absence of the material pleas on the part of the plaintiff in its replication in this regard, does not arise; (v) that the plaintiff is aware of at least the first registration in favour of the defendants since 2014, when the first written statement was filed, and this application filed in 2019 is also barred by time; and, (vi) that the plaintiff, in the application under Section 124 of the Trade Marks Act, has taken a plea of non-use but which as per Section 47 of the Trade Marks Act is to be required for a period of five years and three months from the date of registration and which period qua the two registrations in favour of the defendants has not even expired.

7. I have gone through the last replication of the year 2016 filed by the plaintiff, inasmuch as once the pleadings have been amended, it is the amended pleadings only which have to be looked into, along with the condition if any put at the time of allowing the amendment, and the reference to the original pleadings is of no avail. The defendants have not taken any objection to the said replication, on the ground of pleading beyond the amendment permitted. On a reading of the entire replication, it cannot be said that the plaintiff is not pleading or setting up the invalidity of the registrations obtained by the defendants, admittedly after the date of registration in favour of the plaintiff. Though the language may not be as perfect as the counsel for the defendants expects, however such lacuna in expression in English language are to be ignored and what needs to be seen is the substance of the pleadings and the substance of the pleadings does disclose the plaintiff to have taken a plea of the registrations in favour of the defendants being unlawful, wrong and liable to be rejected and the plaintiff reserving right to take appropriate action therefor.

8. Even otherwise, on a comparison of the two marks, *prima facie* merit is found in the plea of the plaintiff, of invalidity of the registrations in favour of the defendants.

9. As far as the pleas of, limitation, and rectification on the ground of non-use

being not maintainable in law, are concerned, admittedly this Court does not have the jurisdiction to adjudicate the pleas of invalidity and the jurisdiction in which respect is exclusively of the Registrar of Trade Marks or of the Intellectual Property Appellate Board (IPAB). The Court thus cannot adjudicate the said arguments and it will be open to the defendants to, in response to the rectification application if any filed by the plaintiff, set up the said defences.

10. The application is thus allowed and disposed of.

11. Needless to state that none of the observations in this order shall influence the findings of the Registrar of Trade Marks or IPAB on the validity of registrations in favour of defendants in the rectification proceedings if any preferred by the plaintiff.

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12. On the pleadings of the parties, the following issues are framed:

(I) Whether the plaintiff is the prior user of the trade mark 'Z' as represented in paragraph 2 of the plaint? OPP

(II) Whether defendant has infringed the plaintiff's registered trade mark bearing No.664382? OPP

(III) Whether the defendant's use of the marks 'RED ZX', 'RAMSON ZX' and/or 'ZX' and/or its packaging/trade dress amounts to passing off its goods as that of the plaintiff's? OPP

(IV) Whether the registrations of defendants mark 'RED ZX' (TM No.1962551), 'RAMSON ZX' (TM No.1929891) and/or 'ZX' (TM No.2020514) are invalid under the Trade Marks Act? OPP

(V) Whether the plaintiff is the owner of original artistic works of the plaintiff's trade dress as represented at pages 3 to 7 of the documents filed by the plaintiff along with the plaint? OPP

(VI) If the plaintiff succeeds in the aforesaid issues, whether the plaintiff is entitled to recover any damages from the defendants and if so in what amount? OPP

13. It is clarified that no separate issue is being framed on the defence stated to have been taken by the defendants of Sections 17, 28(3) and 30(2)(c) & (e) of Trade Marks Act and which defences will be considered in adjudication of Issue No.(II) above.

14. No other issue arises or is pressed.

15. The counsel for plaintiff, on enquiry states that he wants to proceed with the suit on the grounds of passing off and infringement of copyright, at the same time as on the ground of infringement of trade mark.

16. The application of the plaintiff under Section 124 of the Trade Marks Act having been allowed, further proceedings in this suit are adjourned sine die. However, if the plaintiff, within three months hereof does not institute any proceedings for rectification of the trade marks Register for removal of the marks of the defendants, the parties shall have liberty to apply for revival of the suit.