

**(2010) 12 IPAB CK 0010**

**In the Intellectual Property Appellate Board**

**Case No :** M.P. Nos. 33, 34/10 In ORA/252, 253/09/TM/DEL

Kamadhenu Realtors Pvt. Ltd.

APPELLANT

Vs

Kamadhenu Ispat Limited

RESPONDENT

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**Date of Decision :** 24-12-2010

**Acts Referred:**

Trade Marks Act, 1999 — Section 124

**Citation :** (2011) 46 PTC 93 (IPAB)

**Hon'ble Judges :** S. Usha, J; Syed Obaidur Rahaman, Technical Member

**Bench :** Division Bench

**Final Decision :** Dismissed

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**Judgement**

S. Usha, J

1. The main rectification application was filed for removal of the trade mark Kamadhenu (word per se) in class 36 and class 37 under Nos. 1314265 and 1240486 respectively.

2. Miscellaneous petition No. 33 and 34/10 is filed by the Respondent under the provisions of Section 124 of the Trade Marks Act, 1999 (hereinafter referred to as the Act) to dismiss the original rectification application Nos. 252 and 253/09 respectively. As the facts, issues, parties are same, both the matters were heard together with the consent of both the counsel and a common order is passed.

3. The Petitioner herein stated that they had filed a civil suit bearing C.S. (OS) No. 1455 of 2008 where the Respondent had filed the written statement on 6.12.2008. The instant rectification applications were filed on 24.09.2009, challenging the registration which was subsequent to the filing of the suit. As per Section 124 of the Act, the Respondents herein ought to have

taken leave of the High Court of Delhi, where the suit was pending to file this instant application for rectification.

4. In view of the fact that there has been non-compliance of Section 124 of the Act on the part of the Petitioner, the instant rectification petition is liable to be dismissed. Balance of convenience lies in favor of the Petitioner and against the Respondent. The instant rectification application is *ex-facie* not maintainable. In the interest of justice, equity and good conscience the present miscellaneous petition be allowed.

5. The Respondent herein filed their reply to the miscellaneous petition denying the averments made in the miscellaneous petition. The Respondent then relied on the judgment reported in 2008 (38) PTC 576 (Mad) DBB. *Mohamed Yourself v. Prabha Singh Jaswant Singh and Ors.* and stated based on the said findings in the judgment the leave to file the instant application was not necessary. The miscellaneous petition be dismissed with exemplary costs.

6. The learned Counsel for the Petitioner brought to our notice the civil suit filed by the Respondent against the Petitioner. In the suit the Petitioner had mentioned that the trade mark 'KAMADHENU' is duly registered under the provisions of the Act. Then the Petitioner pointed out at para 8 of the written statement filed in the suit where the Respondent had raised the validity of the registration. The counsel then relied on the Judgments reported in 2008 (34) PTC 469 Del *Astrazeneca UK Ltd. and Anr. v. ORCHID Chemicals & Pharmaceuticals Ltd.* Md. Shariq Pro. Honor Manufacturing Co. v. Fair International and M.P. No. 215/09 in ORA/147/2007/TM/DEL.

7. The learned Counsel for the Respondent submitted that the civil suit was filed in the year 2008 in CS (OS) No. 1455/08 against Kamadhenu group of companies whereas the applicant herein is Kamadhenu Realtors who is not a party to the suit. The rectification application has been filed in the year 2009. The observation made in the *Aztrazeneca* case (*supra*) is not applicable. The counsel mainly relied on judgment reported in 2008 (38)PTC 576 (*supra*) and submitted that as per the observation of the Madras High Court there was no need for permission to be taken from the civil court for filing this instant rectification application. As per the provisions of Section 124 of the Act, there is no specific provision as to obtaining leave of the civil court where the suit is pending to file an application for rectification.

8. In rejoinder to the arguments of the Respondent, the Petitioner submitted that the Respondent had not pleaded in the reply to the miscellaneous petition that the Defendant in the suit and the applicant herein are different but now has made a new submission. In this regard the counsel drew our attention to the pleadings made in the written statement to the plaint in CS (os) No. 1455/08 the Respondent had stated that the Plaintiff it appears has erroneously filed a suit against a non-existing entity, Kamadhenu Group of companies, which is arrayed and named as the sole Defendant in the cause title of the plaint. In the absence of the name of the necessary party having been impleaded in the present suit and it is respectfully submitted that the Plaintiff is disentitled to any relief's as prayed for. It is further submitted that without imploding the actual and necessary Defendant viz. Kamadhenu Realtors Pvt. Ltd. and other companies / firms as a party Defendants, the Plaintiff's suit is bad in law for it suffers from non-jointer and / or mis-joinder of parties.

9. We have heard and considered the arguments of both the counsel and have carefully gone through the pleadings and documents.

10. On perusal of documents we find that the Respondent has raised the validity of the impugned registration as well admitted that the Defendant therein is not the party concerned and it is only the Respondent herein. In such a case we do not find any force or reason for the submission of the

Respondent that parties are different. The counsel for Respondent has also not disputed the fact that the validity of the registration has been raised.

11. In many number of Judgments, this Board has held that even the Board is of view that there is no provision or condition that the prior leave to be

obtained for filing an application for rectification from the civil court where the suit is pending, in the Act. But owing to the observations made in the

Astrazeneca case (supra) Delhi High Court, we are bound by the jurisdictional High Court's observation. It is worth quoting the same.

The provisions which would be applicable to the facts and circumstances of the present case are those which envisage that where the application for

rectification of the order in such proceedings is not pending, then a party seeking rectification applies for rectification, subject to a prima-facie

satisfaction of the Court regarding invalidity of the registration of the mark of the opposite para, The Appellants/Plaintiffs therefore could not have

filed an application for rectification showing establishing and obtaining prima-facie satisfaction of the court that they have sufficient material to be able to invalidate the registration of the mark of the Respondent/Defendant. The aforesaid' rectification proceedings which is filed is still pending for consideration. Therefore, learned single judge was justified in not staying the suit. Once a suit for infringement of Trade Mark is instituted the objector gets a right to move an application for rectification after the Civil Court, trying the suit based on infringement of the Trade Mark, has examined prima facie tenability of the plea with respect to invalidity of the registered mark and makes an order raising an issue in the suit. If no plea as to invalidity of registered Trade Mark is raised in the infringement suit no question of filing rectification application arises. The parties to the suit must adhere to the procedure prescribed in Section 124 with respect to the filing of rectification proceedings. The question of determination of issue as to invalidity of the registered mark and abandonment of it due to non-prosecution are interwoven in the scheme of the Act, Therefore, if there is abandonment of the plea as to the validity of the mark albeit for the purposes of the suit the objector is not entitled to move rectification application as he would have disentitled himself to plead for judgment in the light of the decision, if any, obtained dehorn the procedure prescribed therefore under Section 124. In case a plea is deemed to have been abandoned, the only remedy of the party concerned may be to approach that very court to extricate him from the consequence of abandonment, or higher forum. 11.

Based on the above observation, we are of the opinion that the Respondent/applicant has not obtained the leave of the court and the application for rectification is not maintainable. The counsel for Respondent vehemently relied on the judgment of the Madras High Court in Md. Yousuff's case (supra) and stated that the leave is not necessary. But going by the view of the Delhi High Court, we are not agreeable with the arguments of the counsel and the view of the Madras High Court is of no relevance herein the instant case.

12. The suit has been filed in the year 2008 to which the Respondent herein has filed in the year 2008 where the issue of validity of the registration has been raised. The rectification application has been filed in the year 2009. In such circumstances, the Respondent should have taken leave of the civil court before filing this application for rectification.

13. Therefore, M.P. Nos. 33 and 34/10 are allowed. Consequently the ORA Nos. 252 and 253/09/TM/DEL are dismissed. However, there shall be no order as to costs.