
(2010) 03 DEL CK 0294

In the Delhi High Court

Case No : Writ Petition (C) 639 of 2010 and CM 1350 of 2010, W.P. (C) 640 of 2010 and CM 1352 of 2010, W.P. (C) 12795 of 2009 and CMs 13563-64/09, 2690 of 2010, W.P. (C) 12796 of 2009 and CMs 13565-66/09, 2683 of 2010, W.P. (C) 12797 of 2009 and CMs 13567-68/09, 268

P.P. Buildwell Pvt. Ltd.

APPELLANT

Vs

Central Govt. of India and Another

RESPONDENT

Date of Decision : 17-03-2010

Acts Referred:

Trade Marks Act, 1999 — Section 124, 124(1), 30(2)(e)

Citation : (2010) 44 PTC 404

Hon'ble Judges : Dr. S. Muralidhar, J

Bench : Single Bench

Advocate : Shailen Bhatia and A.P.S. Jadaun, for the Appellant; Atul Nanda, Gaurav Gupta, Sanjay Bhardwaj for the Respondent No. 1, Sudhir Chandra Hemant Singh, Manish K. Mishra, Mamta Jha for the Respondent No. 2, Sachin Datta and Manikaya Khanna, for the Respondent No. 1 in W.P. (C) 12795/2009 and CMs 13563-64/09, 2690/2010, for the Respondent

Final Decision : Dismissed

Judgement

S. Muralidhar, J.—These petitions arise out of common facts and are accordingly disposed of by this common order.

2. The Petitioner P.P. Buildwell Pvt. Ltd. (hereinafter "P.P. Buildwell") is engaged in the business of real estate including developing buildings and structures and constructing commercial complexes. On 13th September 2004 it applied for registration of its service marks "P.P. Mall" and "P.P. Shopping Mall". The Petitioners were granted registrations for the said two marks on 17th December 2005 by the Registrar of Trademarks.

3. Respondent No. 2 P.P. Jewellers Pvt. Ltd. (P.P. Jewellers) incorporated on 2nd August 2004 in Delhi, carries on business as jewellers and manufacturers of

jewellery and dealers in diamond, gem, jewel and precious stones etc. P.P. Jewellers claims that the mark "P.P." forming part of its mark "PPJ" is its house mark and trademark. P.P. Jewellers filed a suit, CS (OS) No. 19 of 2005 (titled "P.P. Jewellers Pvt. Ltd. v. P.P. Buildwell Pvt. Ltd.") seeking a permanent injunction to restrain the Petitioner from using the trademark and house mark "PP" or any other mark identical or deceptively similar to the said mark PP" in relation to the offering for sale, advertising, and in any manner dealing with in any services. In short the aforementioned suit filed by P.P. Jewellers against the Petitioner was one for passing off.

4. The Petitioner states that it filed a written statement in the said suit claiming that the trade activities of P.P. Jewellers and P.P. Buildwell were different in every aspect and that use of the letter "PP" in relation to jewellery did not confer any right on the P.P. Jewellers to claim exclusive right to the use of the mark "P.P." in respect of all description of goods, businesses or services.

5. In January 2008 an application, IA No. 1175 of 2008, was filed by PP Jewellers in the said suit CS (OS) 19 of 2005 under Order VI Rule 17 CPC seeking to amend the plaint. The facts sought to be brought on record were that apart from the common law right in the trade mark "PP", P.P. Jewellers was also the registered proprietor of the trademark "P.P. Jewellers" along with the PPJ logo by virtue of trade mark registration granted in its favour in Class 14 under registration No. 507596 as on 27th March 1989. It is also pointed out that P.P. Jewellers is also the registered proprietor of the trademark "PP" in various classes including Class 14 under various registration numbers. The copies of the registration certificates were sought to be relied upon. It was mentioned that the P.P. Jewellers also filed an application for registration of the trademark "PP" vide application No. 1305374 in respect of services in Class 37 (building, construction etc.) which was pending in the Trade Marks Registry (hereinafter "Registry"). Consequently the Plaintiff/Respondent herein sought to include a prayer for infringement and also valued the suit as one for infringement. The prayer clause in the plaint was sought to be amended to include a prayer for infringement. In other words, by way of the said amendment application, the P.P. Jewellers sought to make the passing off suit into one for infringement as well.

5. However, when IA No. 1175 of 2008 was listed before the Court on 21st July 2008, P.P. Jewellers sought leave to withdraw the application "with liberty to file a fresh application clearly spelling out the additions, subtractions and substitutions sought to be made by the Plaintiffs in the plaint". IA No. 1175 of 2008 was dismissed by this Court as withdrawn with liberty as prayed for. Consequently, the suit CS (OS) 19 of 2005 continued to be one for passing off.

6. On the next date, i.e., 6th August 2008 this Court heard IA No. 9301 of 2008 filed by P.P. Jewellers under VI Rule 17 Code of Civil Procedure, and passed the following order:

Learned Counsel for the Plaintiffs submits that though he had sought leave to

withdraw IA No. 1175/2008 with liberty to file a fresh application after clearly identifying the proposed amendments to the plaint, in order to expedite the hearing in injunction application bearing IA No. 132/2005 the Plaintiffs do not wish to file any fresh interim application for amendment of the plaint. Application is disposed of taking on record the aforesaid statement of the learned Counsel for the Plaintiffs.

7. A further IA 1173/2008 filed under Order VI Rule 17 CPC by P.P. Jewellers was dismissed as withdrawn.

8. On the above date, i.e., 6th August 2008, an application, IA No. 9371 of 2008 filed by the Defendant under Order VI Rule 17 CPC seeking to amend the written statement was heard and the following order was passed on the said application:

Notice Mr. S.K Bansal, Advocate accepts notice on behalf of the Plaintiffs and states that the Plaintiffs have no objection to the amendment being allowed, subject to their right to raise such pleas as may be available to them in law. He further states that he has no objection to IA No. 456/2007 also being allowed I the same terms. Accordingly, both the aforesaid applications for amendment filed by the Defendant are allowed, subject to the right of the Plaintiffs to raise such pleas as may be available to them in law. IA Nos. 456/2007 and 9371/2008 stand disposed of accordingly.

9. The amended written statement dated 2nd April 2008 was taken on record. By the said amendment to the written statement, the Petitioner herein P.P. Buildwell brought on record the fact that it had been granted registration for "P.P. Mall" and "P.P. Shopping Mall" in the manner indicated hereinbefore.

10. P.P. Jewellers filed before the Intellectual Appellate Property Board (IPAB) two rectification applications being ORA No. 42 and 43/2007/TM/DEL in March 2007 for rectification of the Petitioner's (P.P. Buildwell's) trademark registration Nos. 1308302 and 1308303 in Class 37. P.P. Buildwell filed MP Nos. 84 and 85 of 2008 to seek dismissal of the aforementioned two rectification applications filed by P.P. Jewellers on the ground that P.P. Jewellers did not take prior permission of this Court in CS (OS) 19 of 2005.

11. These applications were resisted by P.P. Jewellers on the ground that Section 124 of the TM Act is not applicable as the suit remains one for passing off. Agreeing with the submission of P.P. Jewellers, M.P. Nos. 84 and 85 of 2008 filed by the Petitioner were dismissed by the IPAB by an order dated 31st October 2008 and the two rectification applications of P.P. Jewellers, ORA Nos. 42 and 43/2007, were allowed to proceed. The said order dated 31st October 2008 passed by the IPAB has been challenged by the Petitioner by filing Writ Petition (Civil) Nos. 12796 and 12836 of 2009.

12. It is stated that in May 2008 P.P. Buildwell filed oppositions against 26 applications made by the P.P. Jewellers for registration of the trademark "PP" in various classes of goods and services. The Petitioners filed before the IPAB

several rectification applications against P.P. Jewellers for cancelling the trademark "PP" registered in favour of P.P. Jewellers in several classes of goods. These were numbered as ORA Nos. 85 to 91, 102 and 117 to 119/2008/TM DEL. In the said rectification applications P.P. Jewellers filed several applications seeking dismissal of the said rectification applications filed by the Petitioner on the ground that P.P. Buildwell had not sought prior permission of this Court u/s 124 of the Trade Marks Act, 1999 (TM Act). By an order dated 25th August 2009, the IPAB accepted the above plea of P.P. Jewellers and dismissed the Petitioner's rectification applications. These orders dated 25th August 2009 have been challenged by P.P. Buildwell in Writ Petition (Civil) Nos. 12795, 12797, 12798, 12799, 12800, 12801, 12802, 12815, 12817 and 12819 of 2009.

13. Thereafter, P.P. Buildwell filed review petitions before the IPAB seeking recall of the aforementioned order dated 31st October 2008 on the ground that while its applications for rectification of the marks of P.P. Jewellers were dismissed on the ground that P.P. Buildwell had to seek prior permission of the court u/s 124 TM Act, 1999 the rectification applications filed by P.P. Jewellers against the registrations granted in favour of P.P. Buildwell were allowed to proceed. Reliance was placed on the order dated 25th August 2009 passed by the IPAB. However, the review petitions were dismissed by the IPAB by a common order dated 16th November 2009 holding that the IPAB had no such power of review. The said order dated 16th November 2009 has been challenged by P.P. Buildwell in WP (C) Nos. 639 and 640 of 2010.

14. This Court has heard the submissions of Mr. Shailen Bhatia, the learned Counsel for P.P. Buildwell and Mr. Sudhir Chandra, the learned Senior Counsel appearing for P.P. Jewellers.

15. There are two broad issues that arise for consideration. The first concerns the validity of the orders dated 25th August 2009 passed by the IPAB whereby rectification applications filed by the Petitioner PP Builwell have been dismissed on the ground that it did not seek prior permission of this Court in the pending suit CS (OS) 19 of 2005 u/s 124 of the TM Act, 1999. As a corollary, the validity of the orders dated 31st October 2008 passed by the IPAB allowing the rectification petitions filed by P.P. Jewellers against the Petitioner P.P. Buildwell to proceed is challenged on the ground that by the same yardstick, those rectification applications were also required to be dismissed by the IPAB.

16. The second broad issue is whether the IPAB has the power to review its own orders and whether the order dated 16th November 2009 passed by it, holding that it does not, requires to be interfered with.

17. The suit, CS (OS) No. 19 of 2005 filed by P.P. Jewellers against P.P. Buildwell remains till date a suit for passing off. The contention of learned Counsel for the Petitioner is that once a defence is taken u/s 30(2)(e) of the TM Act, 1999 by a Defendant in such a suit, then in terms of Section 124(1) of the TM Act, 1999 prior permission would have to be taken by the Plaintiff to file a rectification

application if it pleads the invalidity of the registration of the Defendant's trade mark.

18. This Court is not able to accept the above contention. The opening words of Section 124(1) of the TM Act, 1999 state "where in any suit for infringement of a trade mark...". Unless the suit is one for infringement, there is no question of Section 124 applying. The fact that CS (OS) NO. 19 of 2005 is only one for passing off till date, is a matter of record. Consequently the decision dated 31st October 2008 of the IPAB that no prior permission was required to be taken by the P.P. Jewellers u/s 124 of the TM Act, 1999 to maintain its applications for rectification of the Petitioner's registered trademarks, does not call for interference.

19. Mr. Sudhir Chandra, the learned Senior Counsel, appearing for the P.P. Jewellers contended that it was the Petitioner herein who had characterized the pending suit as one for infringement in the pleadings before the IPAB. It was on account of a statement made by the Petitioner itself that the IPAB was invited to return the finding in its order dated 25th August 2009 that P.P. Buildwell ought to have obtained prior permission of this Court u/s 124 of the TM Act, 1999 to challenge the registrations granted in favour of P.P. Jewellers.

20. This court is of the view that whatever may have been the mistaken understanding of either party, the fact of the matter is that the suit is one for passing off. There was no question of P.P. Buildwell having to obtain prior permission of this Court u/s 124 TM Act to file applications seeking rectification of the registered trademarks of P.P. Jewellers.

21. Consequently, the orders dated 25th August 2009 passed by the IPAB rejecting the Petitioner's rectification applications are hereby set aside. All the Petitioner's rectification applications will stand restored to the file of the IPAB for being decided on merits.

22. Mr. Shailen Bhatia draws the attention of this Court to an order dated 10th February 2009 passed by the IPAB whereby it was directed that all the rectification applications filed by the Petitioners, as well as the ones filed by the P.P. Jewellers, should be clubbed and heard together. That order, however, was not implemented in view of the subsequent developments. This Court directs that the Petitioner's rectification applications which have been restored, will be listed by the IPAB along with pending rectification applications of P.P. Jewellers and be heard together by the IPAB.

23. As regards the petitions, WP (C) Nos. 639 and 640 of 2010 filed by the Petitioner, challenging the orders dated 16th November 2009 passed by the IPAB rejecting the review petitions filed by the Petitioner, this Court does not find it necessary to examine the correctness of the said order since it has upheld the validity of the order dated 31st October 2008, the review of which was sought by the Petitioner. This Court does not therefore think it necessary to answer the question whether the IPAB could have reviewed its orders. The question of law

that arises from the said order dated 16th November 2009 is left open for decision in an appropriate case.

24. The Writ Petition (Civil) Nos. 12796 and 12836 of 2009 challenging the order dated 31st October 2008 are dismissed. Applications also stands dismissed.

25. Writ Petition (Civil) Nos. 639 and 640 of 2010 challenging the order dated 16th November 2009 are dismissed. Applications also stands dismissed.

26. WP(C) Nos.12795, 12797, 12798, 12799, 12800, 12801, 12802, 12815, 12817 and 12819 of 2009, challenging the order dated 25th August 2009 are allowed. Applications also stands disposed of. A copy of this order be sent to the IPAB forthwith.