

(2022) 08 DEL CK 0120

In the Delhi High Court

Case No : C.A. (COMM.IPD-TM) No. 125 Of 2021

Ruptech Educational India

APPELLANT

Vs

Registrar Trade Marks ?

RESPONDENT

Date of Decision : 18-08-2022

Acts Referred:

Trade Marks Act, 1999 — Section 11

Citation : (2022) 08 DEL CK 0120

Hon'ble Judges : Prathiba M. Singh, J

Bench : Single Bench

Advocate : Daves Vashishtha, Sharabh Srivastava, Harish V. Shankar, Srish Kumar Mishra, Sagar Mehlaawat, Alexander Mathai Paikaday

Final Decision : Disposed Of

Judgement

Prathiba M. Singh, J

1. This hearing has been done through hybrid mode.
2. The present appeal has been filed by the Appellant - Ruptech Educational India, which is engaged in providing educational and allied services. The Appellant operates under the well-known mark 'SCOTTISH HIGH INTERNATIONAL SCHOOL', as a day boarding Senior Secondary School, which was set up in 2005. The Appellant claims to have many similar registered trademarks in various classes, such as 'SCOTTISH HIGH', bearing application no. 1813509, which was a multi-class application, and 'SCOTTISH HIGH INTERNATIONAL SCHOOL', bearing application no. 1446026, in Class 25.
3. One such mark which the Appellant applied for on 2nd January, 2018, is 'SCOTTISH HIGH EARLY YEARS', bearing application no. 3717101. The said mark was applied for in respect of services falling in Class 41, viz., 'Education; providing of training; entertainment; sporting and cultural activities; boarding schools; books publication of camp services; correspondence courses; educational examinations' etc.

4. An examination report issued by the Trademark Registry on 27th January, 2018, cited two other trademarks bearing nos. 3608272 and 3613387, in Class 41. The marks were 'SCOTTISH HIGH EARLY YEARS NURTURING CREATIVITY' and 'SCOTTISH EARLY YEARS' respectively. The same were applied for by one Ms. Mansi Aggarwal from Delhi. Apart from these two marks, no other conflicting marks were cited in the examination report. The same was replied to by the Appellant on 27th February, 2018. However, vide the impugned order, dated 5th January, 2021, the mark was rejected under Section 11 of the Trade Marks Act.

5. Mr. Vashishth, Id. Counsel appearing for the Appellant submits that the concerned applicant, Ms. Mansi Agarwal, whose marks were cited against the Appellant's mark, has already withdrawn the aforementioned trademark applications. In fact, a suit being CS(COMM) 639/2018 titled Ruptech Educational India Vs. Mansi Aggarwal, was filed against the said person. Thereafter, the matter had been sent for mediation to attempt an amicable resolution of the disputes between the parties. Vide order dated 4th May, 2022, a settlement agreement dated 8th December, 2021 was taken on record in the said suit. The same has been handed across to the Court today, by the Id. Counsel. As per the said settlement, the applicant had agreed to withdraw the two aforementioned applications filed by her.

6. It is submitted by the Id. Counsel for the Respondent, that pursuant to the order dated 4th May, 2022, which decreed the suit in terms of the settlement, the applicant has also withdrawn the said two applications. This is also evident from the status shown on the website of the trademarks registry, as on 3rd August, 2022.

7. The Court has perused the order dated 4th May, 2022 passed in the suit filed by the Appellant against Ms. Mansi Aggarwal, who was the Defendant in the said suit. The said order records that the parties have resolved their disputes vide settlement agreement dated 8th December 2021. The terms of the Agreement have also been recorded in the said order. The relevant terms are extracted below:

"1 Learned counsels appearing on behalf of the parties submit that the parties have amicably resolved their inter se disputes before the Delhi High Court Mediation and Conciliation Centre. A Settlement Agreement in terms of the settlement incorporated in paragraph F(1) to (16) of the Settlement.

"1. The Second Party acknowledges the statutory and common law rights of the First Party in the SCOTTISH formative trade marks referred to in the Plaint of the present Commercial Suit and the Second Party undertakes to never object to the use and/or registration of the SCOTTISH formative trade marks owned and/or registered and/or used by the First Party in any manner whatsoever before any judicial and/or quasi-judicial authority in the future.

2. The Second Party undertakes to never seek registration or claim any proprietary rights, legal title or ownership or any interest whatsoever, before any

judicial authority or otherwise, over the word "SCOTTISH" per se and/or in any mark/name consisting of the word "SCOTTISH" and/or any word similar to "SCOTTISH" and/or any mark/name which is identical to the First Party's registered trademarks as specified in the Plaint in the commercial suit.

3. The Second Party undertakes that within 10 working days of signing of this agreement, the Second Party will make appropriate communication/representation to the Trade Marks Registry for immediate withdrawal of its following Trade Mark Applications:

MARK

APPLICATION NO. AND DATE

CLASS

STATUS

USER CLAIM

3608271 dated 08/08/2017

41

Opposed

Proposed to be used

SCOTTISH EARLY YEARS

41

Opposed

Proposed to be used

The Second Party agrees to provide to the First Party or its counsel, relevant documentary proof that the necessary correspondence/communication for withdrawal of the above applications and/or any other application pending before the Trade Marks Registry for registration of a mark consisting of the word "SCOTTISH" or any word similar to "SCOTTISH" has been made by the Second Party to the Trade Marks Registry. Without Prejudice, the Second Party is entitled to use the tree device per se, if required.

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2. This Court has perused the terms of settlement and the same are found to be lawful.

3. Suit stands decreed in terms of the Settlement Agreement dated 08.12.2021. Terms of the Settlement Agreement shall form part of the decree.

4. Needless to state, the parties concerned shall remain bound by the terms of the Settlement Agreement and the undertakings given therein. "

8. Subsequent to the above order, vide letters dated 25th May, 2022, the Defendant in the suit has withdrawn the said two trade mark applications filed by her. Pursuant to the said letters, two orders dated 8th July, 2022 and 12th July, 2022, have also been passed by the Examiner of Trade Marks, directing withdrawal of the said applications. The status of these applications as reflected on the website of the Trade Marks Registry, as on 3rd August 2022, which has been handed to the Court today, also shows that the said applications have been 'Withdrawn'.

9. Mr. Harish V. Shankar, Id. CGSC submits that on the date when the order was passed, the applications were still alive.

10. Considering the fact that the applications which were cited against the Appellant's mark stand withdrawn, the objection under Section 11 would no longer be valid. Accordingly, the impugned order dated 5th January, 2021, is set aside. The application of the Appellant bearing no. 3717101, in class 41, is directed to be advertised in the trademarks journal. Upon advertisement, the said application shall proceed in accordance with law.

11. The observations in the present order shall not in any manner affect any opposition proceedings, if any, filed by any third party, after the mark is advertised.

12. The appeal is disposed of in the above terms.