

Neutral Citation No. - 2025:AHC:101729

A.F.R.

Reserved On:- 15.5.2025

Delivered On:- 01.07.2025

Case :- MATTERS UNDER ARTICLE 227 No. - 8521 of 2024

Petitioner :- M/S Sterling Irrigations And 3 Others

Respondent :- Ms Bharat Industries

Counsel for Petitioner :- Prateek Kumar

Counsel for Respondent :- Ajay Kumar Pandey, Chhaya Gupta, Sujeet Kumar

Hon'ble Neeraj Tiwari, J.

1. Heard Sri Prateek Kumar, learned counsel for the petitioners and Ms. Chhaya Gupta, learned counsel for the respondent.
2. Present petition has been filed for setting aside the impugned order dated 6.5.2024 passed by the learned Commercial Court No.2, Agra in Original Suit No. 04 of 2015 (M/s. Bharat Industries vs. M/s Sterling Irrigation and others)
3. Pleadings are exchanged between the parties. With the consent of parties, writ petition is being decided at the admission stage itself.
4. Brief facts of the case are that petitioners-defendants has published notice in Amar Ujala on 18.6.2015 for transfer of registered trademark. Feeling aggrieved by that, respondent-plaintiff has filed Original Suit No. 4 of 2015 under Section 134 of The Trade Marks Act, 1999 (hereinafter referred to as Act, 1999) upon which petitioners-defendants have filed written submission alongwith counter claim on 15.12.2015. Thereafter, respondent-plaintiff filed reply to the counter claim on 31.5.2016. On the basis of pleadings made by both the parties, learned trial Court vide its order dated 22.8.2016 had framed issues. During the pendency of suit, petitioner-defendant has filed rectification application on 1.8.2019 under Section 25(a) of Act, 1999 before the Registrar, Trademark, Kolkata whereas respondent-plaintiff has also filed rectification application under Section 25(a) of Act, 1999 before the Registrar, Trademark, Delhi on

16.11.2023. Thereafter, respondent-plaintiff has filed Application No.196 C on 1.3.2024 to stay the defendants' counter claim (paper no. 20Ga) bearing case no. 11 of 2023. Petitioner-defendant has filed reply to the said application on 6.3.2024 and thereafter respondent-plaintiff has also filed rejoinder reply to the defendants' reply dated 6.3.2024 on 21.3.2024. Learned Commercial Court vide impugned order dated 6.5.2024 has stayed the proceedings of counter claim No. 11 of 2023 as well as Original Suit No. 4 of 2015. Hence, the present petition.

5. Learned counsel for the petitioners-defendants submitted that present suit has not been filed for infringement of trademark rather it has been filed for permanent injunction. Likewise, counter claim has also not been filed for infringement of trademark rather it was filed for prohibitory injunction whereas Section 124 of Act, 1999 is only applicable in case suit is filed for infringement of trademark, therefore, provision of Section 124 of Act, 1999 shall not be applicable in the present case. He also pointed out that nature of suit has to be seen from the prayer i.e. relief clause and from perusal of the prayer, it is apparently clear that counter claim and suit were filed for permanent injunction as well as prohibitory injunction and not for infringement of trademark. In support of his contention, he has placed reliance upon the judgment of this Court in the case of ***Umesh Kumar Gupta and another vs. M/s Shree Girraj Food Products*** reported as ***2013 (2) AII WC 2023***.

6. He next submitted that Section 124 of Act, 1999 is applicable for stay of proceedings, where the validity of registration of trade mark is questioned. In the present case, from perusal of the pleadings as well as prayer either in the suit or in the counter claim, validity of registration of trademark has not been challenged by either side, therefore, this provisions would also not applicable.

7. He next submitted that assuming it not admitting, if it is the case of suit for infringement of trademark, as per Section of 124(1)(b)(i) of Act, 1999, if the proceedings is pending for rectification of the register of

trademark before the Registrar or the High Court before filing of suit, proceedings shall be stayed till final disposal of such proceedings. Further, as per Section 124(1)(b)(ii), if no such proceedings is pending and same has been filed during the pendency of suit, In that case, if the Court is satisfied that the plea regarding the invalidity of registration of trademark is *prima facie* tenable, Court shall frame an issue regarding the same and adjourn the case for a period of three months from the date of framing the issue in order to enable the party concerned to apply before the High Court for rectification of the register. In the present case, no issue has been framed by the Commercial Court, while staying the proceedings under Section 124 of Act, 1999. In support of his contention he has placed reliance upon the judgment of Apex Court as well as Delhi High Court in the cases of *Patel Field Marshal Agencies (Supra) and Ors. vs. P.M. Diesels Ltd. And others* reported as *AIR 2017 SC 5619* and *Abbott Healthcare Pvt. Ltd. Vs. Raj Kumar Prasad and others* reported as *2017 DHC 7479-DB*.

8. Learned counsel for the petitioner further submitted that in case of suit for infringement of registered trademark in terms of Section 125 of Act, 1999, rectification application can only be filed before the High Court and not before the Registrar, but in the present case, undisputedly it has been filed before the Registrar. In support of his contention, he has placed reliance upon the judgment of Apex Court in the case of *Jagatjit Industries Limited vs. Intellectual Property Appellate Board and others* reported as *2016 (4) SCC 381*. He lastly submitted that in light of above facts as well as law laid down, order impugned is bad and liable to be set aside.

9. Per contra, Ms. Chhaya Gupta, learned counsel for the respondent vehemently opposed the submission and submitted that undisputedly at the time of filing of suit and counter claim, it was not for infringement of trade mark rather it was filed for injunction as earlier stated, but after filing of rectification application, in light of Section 29 and 30(2)(e) of

Act, 1999, it shall be treated to be suit for infringement of trade mark. She also pointed that in light of Order 7 Rule 7 of CPC, while deciding the nature of suit, entire plaint is required to be seen and not only prayer. Undisputedly, in paragraph 30 of the plaint, defendant plaintiff has mentioned the word 'infringement'. Likewise petitioner-claimant has also mentioned the word 'infringement' at least in three paragraphs, therefore, in light of such facts as well as legal position, suit has to be treated for infringement of trade mark and Section 124 of Act, 1999 would be applicable.

10. She has also opposed the second argument made by the learned counsel for the petitioner and submitted that issues were already framed much earlier on 22.8.2016 and issue nos. 9 and 16 are relevant for this purpose, therefore, there is no occasion for the Court to frame the issue again. She also submitted that even if issues are not framed, suit cannot be dismissed in light of Order 14 Rule 1 of CPC. In support of his contention, she has placed reliance upon the judgment of Apex Court in the cases of *Nedunuri Kameswwamma vs. Sampbba Rao* reported in *1963 0 AIR (SC) 884* and *Kannan (dead) by Lrs. And other vs. V.S. Pandurangam (dead) by Lrs and others* reported as *(2007) 15 SCC 157*.

11. Demolishing the third argument of learned counsel for the petitioner, she submitted that undisputedly rectification application has to be filed before the High Court, but in case it has been filed before the Registrar and if Registrar thinks fit, he may refer the application at any stage of proceedings before the High Court, therefore, once rectification application may be sent to High Court at any stage, argument of learned counsel for the petitioner is not sustainable. In support of her contention, she has placed reliance upon the judgment of Madras High Court in the case of *Asia Match Company Pvt. Ltd., vs Deputy Registrar of Trade Marks & GI, Trade Marks Registry, Intellectual Property Office Building G.S.T. Road, Guindy and another* reported as *2023:MHC:5361*.

12. In the rejoinder argument, learned counsel for the petitioner reiterated that it is not the suit for trade mark rather it was filed for prohibitory injunction and mere filing of any application under any provision of law before the Commercial Court, that can not change the nature of suit. So far as framing of issues on 22.8.2016 is concerned, he pointed out that those issues were framed after filing of written submission under Order 14 Rule 1 of CPC. In the present case, issues has to be framed by the Commercial Court after filing of application under Section 124 of Act, 1999. Both the issues framed under Order 14 Rule 1 of CPC and Section 124 of Act, 1999 are entirely different, therefore, issue so framed earlier is having no concern with the issue required to be framed under Section 124 of Act, 1999. So far as third argument of learned counsel for the respondents is concerned, he submitted that undisputedly Registrar may refer the application before the High Court under Section 125(2) of Act, 1999, but undisputedly, till date reference has not made to the High Court, therefore, rectification application itself is not maintainable.

13. I have considered the rival submissions advanced by the learned counsel for the parties and perused the record as well as judgment relied upon.

14. The basic issue before this Court is about the applicability and interpretation of Sections 124 & 125 of Act, 1999. For ready reference Sections 124 & 125 are being quoted below:-

“124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc.— (1) Where in any suit for infringement of a trade mark—

a) the defendant pleads that registration of the plaintiff’s trade mark is invalid; or

b) the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff pleads the invalidity of registration of the defendant’s trade mark,

the court trying the suit (hereinafter referred to as the court), shall,—

i) if any proceedings for rectification of the register in relation to the plaintiff’s or defendant’s trade mark are pending before the Registrar or the

Appellate Board, stay the suit pending the final disposal of such proceedings;

(ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is prima facie tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the Appellate Board for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b) (ii) of sub-section (1) within the time specified therein or within such extended time as the court may for sufficient cause allow, the trial of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.

125. Application for rectification of register to be made to Appellate Board in certain cases.—

(1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register and, notwithstanding anything contained in section 47 or section 57, such application shall be made to the Appellate Board and not to the Registrar.

(2) Subject to the provisions of sub-section (1), where an application for rectification of the register is made to the Registrar under section 47 or section 57, the Registrar may, if he thinks fit, refer the application at any stage of the proceedings to the Appellate Board.

15. First argument of learned counsel for the parties is about the nature of suit, as to whether it is suit for infringement of trade mark or not. From the perusal of the prayer of the suit as well as counter claim, it is apparently clear that both are only for permanent injunction as well as

prohibitory injunction and opposite to that learned counsel for the respondents relying upon the Order VII Rule 7 of CPC, submitted that nature of suit has to be seen from the plaint not from the prayer. From the headlines of Section 124 of Act, 1999, it is clear that to invoke the provision of Section 124 of Act, 1999 there must have been challenge the validity of registration of trade mark. In the present case, it is apparently clear that nothing has been challenged in the suit as well as counter claim rather injunctions have only been sought.

16. I have perused the Order VII Rule 7 of CPC, which is being quoted hereinbelow:-

“7. Relief to be specifically stated.-Every plaint shall state specifically the relief which the plaintiff claims either simply or in the alternative, and it shall not be necessary to ask for general or other relief which may always be given as the Court may think just to the same extent as if it had been asked for. And the same rule shall apply to any relief claimed by the defendant in his written statement.”

17. From perusal of the same, it is apparently clear that relief clause in the plaint should be specific either simply or alternative in the plaint as well as counter claim. It does not say to go through the pleadings for ascertaining the nature of suit rather it only clarifies that relief clause should be specific.

18. I have also perused the prayer of the plaint as well as counter claim. Same are being quoted hereinbelow:-

Prayer of Plaint:-

“A. The defendants be restrained by means of permanent injunction from using the trade name/ trade mark 'Bharat Industries' or any other identical or deceptively similar names in their businesses or their products in any manner whatsoever either in making advertisements of their business or by printing or putting or affixing levels or otherwise the above name 'Bharat Industries' on their polythene bags, boxes, containers in which they sell their products or on the products and the defendants be restrained from passing off their goods as those of the plaintiffs.

B. The defendants be directed to deliver up for description all the polythene bags, boxes, containers & levels, etc. on which the name 'Bharat Industries' or other identical or deceptively similar names have been used by the defendants and to remove such names also from their products and if they

fail to do so, such polythene bags, containers, levels & products, etc. of the defendants be confiscated & destroyed.

C. Costs of the suit be awarded to the plaintiff as against the defendants.

D. Any other relief, which the court thinks fit, be also granted to the plaintiff

Prayer of counter claim:-

“A. That a decree of permanent prohibitory injunction be passed in favour of the defendants are against the plaintiff, restraining the plaintiff from using the trade mark ‘Bharat’ or identical & deceptively similar trade mark including ‘Bharat Industries’ or ‘Bharat Industries ESTD 1972’ on their products in any manner whatsoever.

B. That the plaintiff be ordered to render true & proper accounts of profits earned by it during last three years by use of trade mark ‘Bharat Industries or ‘Bharat Industries ESTD 1972’ and after proper calculation, decree be passed in favour of the defendants against the plaintiff. The remaining court fees on more than Rs. 10 Lakh will be paid in execution side.

C. That the plaintiff be ordered to deliver/destroy all the Labels, Stickers, Letter Heads, etc. containing Mark ‘Bharat Industries or ‘Bharat Industries ESTD 1972’.

D. That the costs of the counter claim be awarded to the defendants as against the plaintiff.

E. That any other relief; which the Hon’ble Court may deem fit & proper in the circumstances of the counter claim, be also granted to the defendants as against the plaintiff.”

19. From perusal of the prayers of the plaint as well as counter claim, it is clear that there is no prayer questioning the validity of registration of trade mark rather it has been filed only for injunction. The identical issue has been considered by this Court in the judgment of ***Umesh Kumar Gupta (Supra)***. Relevant paragraph Nos. 20, 21 and 29 of the said judgment are quoted below:-

“20. The entire reading of the plaint and relief claimed therein demonstrates that it is a suit for decree of permanent injunction restraining the defendants to the suit from marketing their Namkeen products under the name "Chacha Aur Chaudhary" which is identical and deceptively similar to the registered trademark of the plaintiff "Chacha Chaudhary".

The relief clause as contained in the plaint reads as under:-

“अ—यह कि जरिये निषेधा स्थाई, प्रतिवादीगण एवं उनके एजेंटों, सहायकों एवं माल विक्रेताओं को वर्जित किया जावे कि वो वादी के नमकीन उत्पाद “चाचा चौधरी” के पैक एवं पैकेज से मिलते जुलते एवं डिसेटिवली नमकीन उत्पाद “चाचा और चौधरी” के पैक एवं पैकेज में बनाने और बेचने तथा वादी के उक्त उत्पादों को अपने छदम उत्पाद से पासिंग आफ करने से एवं वादी के ट्रेड पंजीकरण अधिकारों में कोई भी हस्तक्षेप करने से बाज रहे।

ब—यह कि प्रतिवादीगण को निर्देश दिया जावे कि वो वादी के नमकीन उत्पाद “चाचा चौधरी” से मिलते जुलते एवं डिसेप्टिवली सिमिलर “चाचा और चौधरी” से समस्त भरे व खाली पाउच उनके डिब्बे तथा उन्हें बनाने के सम्बन्ध में प्रयुक्त समस्त माल मैटेरियल एवं स्टेशनरी वादी के हवाले कर दे हर सूरत कासिर रहने उनका नकली व छदम माल और मैटेरियल जब्त किया जाकर वादी को हस्तगत कराया जावे।”

21. The plaintiff in the relief clause has clearly asked for the passing off the goods and services and an injunction in that regard.

29. In the totality of the above facts and circumstances, notwithstanding the other reasons recorded by the court below in rejecting the application under Section 124 of the Act, I am of the opinion that as the suit in question is not one for infringement of the trademark, it is not liable to be stayed in exercise of power under Section 124 C.P.C.”

20. From perusal of the aforesaid judgment, it is clear that nature of suit has to be ascertained from the prayer and in light of prayer of suit and counter claim, there is no doubt that it has been filed for injunction only. Even after going through the contents of plaint and counter claim, not a single word has been stated questioning the validity of registration of trade mark, therefore, this Court is of the view that suit in question is not for the infringement of trade mark, therefore, Section 124 of Act, 1999 is not applicable. In light of such fact, stay of proceedings is also bad and liable to be set aside.

21. Now coming to the second argument, treating this case as suit for infringement of trade mark. Section 124(1)(b)(I) of Act, 1999 clearly provides that in case at the time of filing of suit, any proceedings for rectification of register of plaintiff defendant's trade mark is pending before the Registrar or the High Court, proceedings shall be stayed. In the present case, at the time of filing of suit, undisputedly no such proceedings was pending, therefore, this would not be applicable. Now coming to the Section 124(1)(b)(II) of Act, 1999, here again it is undisputed that during the pendency of suit, rectification application has been filed by both the parties i.e. plaintiff and defendant, therefore, Section 124(1)(b)(II) would also not be applicable in the present case, which says that in case initiation of such proceedings, it is required on the part of Court to frame issues and stay the proceedings for three months to enable the party concerned to apply before the Court for rectification of register.

Once the application 196-C was filed before the Commercial Court, it is also required on the part of Court that after taking cognizance of rectification proceedings pending before the Registrar, issues should have been framed prior to staying the proceedings, but undisputedly no issues have been framed. Therefore, argument of learned counsel for the respondents is not sustainable, which refers about the framing of issue vide order dated 22.8.2016.

22. I have perused the order of Commercial Court dated 22.8.2016 in which issues were framed under Order 14 Rule 1 of CPC after filing of written submission. Those are issues, while deciding the same, Court is required to return his findings. So far as issue, which is to be framed under Section 124 of Act, 1999 is entirely different. It has to be framed only after taking cognizance of proceedings of rectification application and Court while framing the issues is not supposed to decide the same, but only stay the proceedings. In fact, framing of issue is only for the purpose of staying the proceedings. Therefore, once it is brought into knowledge of Court through application No.196-C, it is mandatory on the part of Court to frame issues first and then stay the proceedings, but undisputedly issues have not been framed. This point has also considered by the Apex Court in the matter of **Patel Field Marshal Agencies (Supra)**. Relevant paragraph of the said judgement is being quoted hereinbelow:-

“30. The intention of the legislature is clear. All issues relating to and connected with the validity of registration has to be dealt with by the Tribunal and not by the civil court. In cases where the parties have not approached the civil court, Sections 46 and 56 provide an independent statutory right to an aggrieved party to seek rectification of a trade mark. However, in the event the Civil Court is approached, inter alia, raising the issue of invalidity of the trade mark such plea will be decided not by the civil court but by the Tribunal under the 1958 Act. The Tribunal will however come into seisin of the matter 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 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.

23. The Delhi High Court in the matter of ***Abbott Healthcare Pvt. Ltd. (Supra)*** has followed the judgment of Apex Court in the matter of ***Patel Field Marshal Agencies (Supra)***. Relevant paragraph of the said judgment is quoted hereinbelow:-

“28. From the aforesaid analysis of the dicta of the Supreme Court in Patel Field Marshal Agencies supra, my view is re-enforced that without an issue having been urged and framed, this Court cannot in exercise of powers under Section 124 stay the proceedings in the suit as is the want of the plaintiff. It is only after an issue qua invalidity of registration is framed that the legislature has provided for stay of proceedings in the suit to avoid the Civil Court as well as IPAB both adjudicating the same question and to avoid duplicity/multiplicity. To the said extent, Section 124 is akin to Section 10 of the CPC albeit that even if proceedings before the IPAB have not been instituted prior to the institution of the suit, IPAB is given supremacy in deciding the question of rectification.”

24. I have also perused the judgment of Apex Court in the cases of ***Nedunuri Kameswwaramma (Supra)*** and ***Kannan (dead) (Supra)*** placed by the learned counsel for the respondent. Relevant paragraph of the aforesaid judgments are being quoted hereinbelow:-

Nedunuri Kameswwaramma (Supra):-

“6. On the first point, we do not see how the suit could be ordered to be dismissed, for, on the facts of the case, a remit was clearly indicated. The appellant had already pleaded that this was jeroyti land, in which a patta in favour of her predecessors existed, and had based the suit on a kadapa, which showed a sub-tenancy. It was the respondent who had pleaded that this was a Dharmila inam and not jeroyti land, and that he was in possession of the kudiwaram rights though his predecessors for over a hundred years, and had become an occupancy tenant. Though the appellant had not mentioned a Karnikam service inam, parties well understood that the two cases opposed to each other were of Dharmila Sarvadumbala inam as against a Karnikam service inam. The evidence which has been led in the case clearly showed that the respondent attempted to prove that this was a Dharmila inam and to refute that this was a Karnikam service inam. No doubt, no issue was framed, and the one, which was framed, could have been more elaborate ; but since the parties went to trial fully knowing the rival case and led all the evidence not only in support of their contentions but in refutation of those of the other side, it cannot be said that the absence of an issue was fatal to the case, or that there was that mis-trial which vitiates proceedings. We are, therefore, of opinion that the suit could not be dismissed on this narrow ground, and also that there is no need for a remit, as the evidence which has been led in the case is sufficient to reach the right conclusion. Neither party claimed before us that it had any further evidence to offer. We therefore, proceed to consider the central point in the case, to which we have amply referred already.”

Kannan (dead) (Supra)

11. By a series of decisions of this Court it has been settled that omissions to frame an issue as required under Order XIV Rule 1 C.P.C. would not vitiate the trial in a suit where the parties went to trial fully knowing the rival case and led evidence in support of their respective contentions and to refute the contentions of the other side vide Nedunuri Kameswaramma vs. Sampati Subba Rao 4, AIR 1963 SCC 884.”

25. From perusal of the judgment, it is apparently clear that issue so referred hereinabove, having no concern with Section 124 of Act, 1999 rather it refers issues framed under Order 14 Rule 1 of CPC. As discussed earlier, issues framed under Section 124 of Act, 1999 and under Order 14 Rule 1 of CPC are entirely different and having different meaning, therefore, this would not come into the rescue of learned counsel for the respondents.

26. Therefore, in light of facts as well as provisions of law laid down by the Court even in case suit is treated to be suit for infringement of trade mark, issues have not been framed as required under Section 124(1)(b) (II), therefore, order is bad on this ground and liable to be set aside.

27. Now the other argument made by the learned counsel for the parties about the filing of rectification application for register of trade mark before the High Court as provided Under Section 125 of Act, 1999. From perusal of Section 125 of Act, 1999, it is apparently clear that it has to be filed before the High Court and not before the Registrar. In the present case, it is also undisputed between the parties that applications were filed before the Registrar, Trade Mark, Calcutta & Delhi, which are having no authority in light of Section 125 of Act, 1999. Therefore, such filing is not in accordance with law and applications are not maintainable.

28. So far section 125(2) is concerned, in case applications has been filed before the Registrar for trade mark as the present case is, it is required on the part of Registrar to refer the application to High Court . Here again undisputedly, same has not been referred to the High Court, therefore, once the application is pending before the Registrar, those are

not maintainable in terms of Section 125 of Act, 1999. Therefore, in such facts as well as provision of law, proceedings cannot be stayed under Section 124 of Act, 1999.

29. I have perused the judgment of Apex Court in the matter of ***Jagatjit Industries Limited (supra)*** relied by learned counsel for the petitioners. Relevant paragraph of the said judgment is being quoted hereinbelow:-

“23. The scheme under Section 124 is of great importance in understanding the scope of Section 125. It is clear that where proceedings for rectification of the register are pending before the filing of the suit for infringement in which the defendant pleads that the registration of the plaintiff’s trademark is invalid, such proceedings may be made either before the Registrar or before the Appellate Board, in view of Section 57(1) and (2) of the Act. But, if rectification proceedings are to be instituted after the filing of such suit for infringement in which the defendant takes the plea that registration of the plaintiff’s trademark is invalid, then rectification proceedings can only be taken before the Appellate Board and not before the Registrar.

30. I have also perused the judgment of Madras High Court in the case of ***Asia Match Company Pvt. Ltd. (Supra)*** placed by the learned counsel for the respondent. Relevant paragraphs of the said judgments are being quoted hereinbelow:-

5. This case hinges on the interpretation of Section 125 of the Trade Marks Act. Section 125 is set out below:

125. Application for rectification of register to be made to High Court in certain cases:

(1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff-s trade mark is questioned by the defendant or where in any

such suit the defendant raises a defence under clause (e) of sub~section (2) of section 30 and the plaintiff questions the validity of the registration of the defendant-s trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register and, notwithstanding anything contained in section 47 or section 57, such application shall be made to the High Court and not to the Registrar.

(2) Subject to the provisions of sub~section (1), where an application for rectification of the register is made to the Registrar under section 47 or section 57, the Registrar may, if he thinks fit, refer the application at any stage of the proceedings to the High Court.

Sub Section (1) of Section 125 applies in two situations. The first of these is when the defendant in a suit for infringement questions the validity of registration of the plaintiff-s trade mark. The second situation is where the

defendant in a suit for infringement raises a defence on the basis of clause (e) of sub-section (2) of Section 30 by relying on the registration of such defendant. In both the above situations, if a rectification petition were to be filed subsequently, such rectification petition would only lie before the High Court and not before the Registrar. Therefore, learned counsel for the 2nd respondent is correct in submitting that sub-section (1) of Section 125 applies when the rectification petition is filed subsequent to the civil suit. The provision clearly prescribes that the rectification petition shall only be filed before the High Court in that situation.

8. In a situation where the rectification petition was filed prior to the institution of the civil suit, sub-section (2) of Section 125 undoubtedly empowers the Registrar to transfer the application at any stage of the proceedings to the High Court. By referring to the pending civil suit, the petitioner made such request to the Registrar in September 2023. Especially in view of the fact that the final order made in the rectification proceeding is binding on the civil court in terms of sub-section (4) of Section 124 of the Trade Marks Act, in situations where a civil suit is pending, it is appropriate that the Registrar exercises discretionary power under sub-section (2) of Section 125 by acceding to a request for transfer. Therefore, this is a fit case to direct the Registrar to transfer the rectification petition.

31. From perusal of the both the judgments, it is clear that during the pendency, if rectification application is to be filed, same has only been filed before the High Court and not before the Registrar. Not only this, in case it is pending before the Registrar, he is required on his part to transfer the same before the High Court. Law is very well settled that only High Court is having authority to decide the rectification application filed under Sections 124 & 125 of Act, 1999.

32. Therefore, under such facts and circumstances of the case as well as law laid down by the Apex Court as well as this Court, impugned order dated 6.5.2024 is not sustainable and hereby quashed. Petition is **allowed**.

33. No order as to costs.

Order Date :-01.07.2025

Junaid