

**IN THE HIGH COURT OF PUNJAB AND HARYANA AT
CHANDIGARH**

CR No. 6058 of 2015 (O&M)
Date of decision: April 12, 2016

M/s Sarvpriya Tubes Pvt. Ltd. And another

...Petitioners

Versus

M/s Madhav Udyog Pvt. Ltd. and another

...Respondents

CORAM:- HON'BLE MR. JUSTICE K. KANNAN

1. **Whether Reporters of local papers may be allowed to see the judgment ?**
2. **To be referred to the Reporters or not ?**
3. **Whether the judgment should be reported in the Digest?**

Present: Mr. Avnish Mittal, Advocate,
for the petitioners.

Mr. Mayank Mathur, Advocate,
for the respondents.

K. KANNAN, J.

1. Pending a suit for establishing the plaintiff's right to a trade mark Jeevan Jyoti and TNT Steel and for injunction against the defendants from attempting to pass off the goods traded as Jeevan Jyoti, the defendants applied for stay of proceeding contending that the plaintiff had himself applied to the Registrar of Trade mark for rectification of register and since proceedings are still pending, the suit should be stayed. The Trial court observed that in order to invoke Section 124 of the Trade Marks Act (for short '**the Act**'), there has to be a prayer for infringement of trade mark and the proceedings before the Registrar of Trade Mark would have a direct

bearing for an adjudication that would require to be done before the Civil Court. The proceedings before the Civil Court was an action for passing off the defendant's goods as though they were goods that carries plaintiff's trade mark and consequently Section 124 of the Act would not be attracted.

2. The defendants are in revision to contend that the plaintiff's application for interim injunction has been dismissed on a finding that the defendant trade mark as Jeevan Jyoti has also been registered as a trade mark and there was no prima facie case. All the same, since the plaintiff has approached the Registrar of Trade Mark for rectification of register complaining that the trade mark owned by the defendants was deceptive to make it appear as though it was the plaintiff's trade mark, the suit cannot be tried before the conclusion of the proceedings before the Registrar. The learned counsel for the petitioner would refer to the decisions in the the cases Nippon Soda Co. Ltd. Vs. V.P. Goyal and another 2014 (5) RAJ 77 and Siel Edible Oils Ltd. (SEOL) Vs. Khemka Sales (P) Ltd. 2010 (7) RAJ 112. In both these cases, the Courts were considering a suit of the plaintiff complaining of infringement of trade mark and simultaneous proceedings before the Registrar of Trade mark, the Court held that stay ought as a matter of course of reference of Section 124 of the Act.

3. Learned counsel for the respondents points out that the suit is not for an infringement of the trade mark, for, the plaintiff is aware that the defendants have also registered their trade mark and their prayer for rectification for register is more on the ground that there is a deliberate copying of the trade mark. The defendants are immediate neighbors of the plaintiff's place of work and the defendants also knew about the plaintiff's

product being sold in the name of Jeevan Jyoti. The defendant had deliberately obtained a trade mark with similar sound name to pass off the goods as that of the plaintiff. In para 9 of the amended plaint, the contention is the following.

“That even otherwise, the defendants cannot be said to be unaware about the rights of the plaintiff in the trademark 'JYOTI' of which is a prior registered Trademark in favour of the plaintiff within the knowledge of the defendants. Further, at the time of adoption and alleged use of the trademark JEEVAN JYOTI, the defendant were fully aware about the prior rights of the trademark JYOTI of the plaintiff as they are carrying on their business at next door to the plaintiff. The plaintiff has prominently displayed its trademark JYOTI by every means since the year 2000. Therefore, adoption itself as well as alleged use of the mark 'JEEVAN JYOTI' by the defendant is tainted, illegal and likely to cause confusion and deception resulting in passing off.

The defendants deliberately and intentionally adopted the near identical trademark to trade upon the goodwill and reputation of the plaintiff pertaining to the prior adopted, used and registered trademark. The wrongful act of the defendants are solely for the purpose to pass off their offending goods as that of the plaintiffs.”

4. The contention is that in an action for passing off the issue of mere rectification of register cannot serve the purpose and the extent of

evidence and the proposition to be advanced would be different. The learned counsel would refer me to a decision of the Bombay High Court (Nagpur Bench) in M/s Shakti Traders Vs. M/s Shakti Press Ltd. 2008 (5) ALL MR 699. The Bombay High Court had held that Section 124 of the Act relating to stay of proceedings would apply only in a suit for infringement of trade mark but if the suit is primarily based as passing off action under Section 134 (1) (c) the Act, the provision of Section 124 would not be attracted at all. Similar view was also expressed by the Allahabad High Court in Umesh Kumar Gupta and another Vs. M/s Shree Girraj Food Products 2013 AIR (Allahabd) 81.

5. I find the distinction made out by the plaintiff is tenable and I am in respectful agreement with the views expressed by the Bombay High Court and the Allahabad High Court. The decision cited of the Delhi High Court has no bearing to a situation that obtains in this case and also does not address a situation of a suit complaining of passing off action. The order passed by the court below is correct and would require no intervention.

April 12, 2016
prem

(K.KANNAN)
JUDGE