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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **FAO(OS) 116/2016 & CM 13152/2016(stay)**

M/S SATYADEVA BOKARO & ANR

..... Appellants

Through : Ms Julien George with Mr Dhavish Chitkara

versus

M/S SACHDEVA COLLEGE LIMITED

..... Respondent

Through : Mr Hemant Daswani with Ms Paulami Ganguly

CORAM:

HON'BLE MR. JUSTICE BADAR DURREZ AHMED

HON'BLE MR. JUSTICE ASHUTOSH KUMAR

ORDER

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01.08.2016

This appeal is directed against the judgment dated 28.03.2016 delivered by a learned Single Judge of this Court in IA 3976/2016, which was an application filed under Order 7 Rule 10, Order 7 Rule 11 and Order 14 Rule 2 of the Code of Civil Procedure, 1908 (hereinafter referred to as the 'CPC').

The suit was filed by the respondent, *inter alia*, on two counts – one of infringement of trade mark and the second was a passing off action. The plaintiff/respondent has the registered trade mark 'Sachdeva New P.T. College'. The appellant/defendant has a registered trade mark 'Satyadeva Bokaro'. Both the trade marks have been registered and are under Class 41 for educational institutions.

The point that was raised by the appellant/defendant in the said application was that since both the parties were holders of registered trade marks, in view of Section 28(3) of the Trade Marks Act, 1999, neither could sue the other to claim exclusivity over their respective trade marks. Therefore, the action of infringement would not lie at all.

Insofar as the plea of passing off is concerned, it was contended on behalf of the appellant that there is no averment in the plaint with regard to any alleged attempt of passing off on the part of the appellant/defendant in Delhi. If at all, the allegations of passing off would be relatable to Bokaro, where the appellant/defendant has set up the 'Satyadeva Bokaro Coaching Centre'.

We have heard the learned counsel for the parties. We are of the view that infringement action *per se* does not lie because of the provisions of Section 28(3) of the Trade Marks Act, 1999. However, the learned Single Judge is right in observing that the plaint cannot be rejected in part and, therefore, there could be no order of rejection of the plaint under Order 7 Rule 11 CPC. However, we find that the surviving cause of passing off would only be relatable to Bokaro because the alleged passing off on the part of the appellant/defendant is limited to Bokaro. This is so because the appellant/defendant does not have any educational institution outside Bokaro and particularly in Delhi.

In these circumstances, the appropriate course of action would be to allow the application IA 3976/2016 under Order 7 Rule 10 CPC by returning the plaint of the respondent/plaintiff for filing the same in the appropriate court at Bokaro. It is so ordered.

The appeal is disposed of in these terms.

BADAR DURREZ AHMED, J

**AUGUST 01, 2016
SR**

ASHUTOSH KUMAR, J