

FARAD CONTINUATION SHEET No.
IN THE HIGH COURT OF JUDICATURE AT BOMBAY
NAGPUR BENCH AT NAGPUR

WRIT PETITION NO. 3461/2019

(LABORATE PHARMACEUTICAL INDIA LIMITED **VERSUS** LEBEN LABORATORIES PVT.LTD.)

Office Notes, Office Memoranda of Coram,
appearances, Court's orders of directions
and Registrar's orders

Court's or Judge's orders

Shri S.A. Mohta, counsel for the petitioner.
Mrs. R.S. Sirpurkar, counsel for respondent.

CORAM : A.S. CHANDURKAR, J.

DATE : MAY 03, 2019.

RULE. Heard finally with consent of counsel for the parties.

The petitioner who is the original defendant is aggrieved by the order passed by the trial Court below Exhibit 35 thereby rejecting the application filed by the said defendant under Section 124 of the Trademarks Act, 1999.

The respondent has filed suit seeking relief in the light of infringement of its registered trademark alongwith other consequential prayers. In the complaint, it has been pleaded that by virtue of being the user of 'DSP', the plaintiff is entitled to such user and the defendant needs to be restrained from using the said trademark. The written statement has been filed by the defendant opposing the aforesaid suit. A plea has also been raised that the defendant is a prior user of the said trademark. In the said suit, the defendant filed an application under Section 124 of the said Act praying therein that the proceedings be adjourned for a period of three months to enable the defendants to file appropriate proceedings before the Appellate Board. This application was opposed by the plaintiff and by the impugned order the trial Court has rejected the said application by observing that the same can be considered independently after the issues were framed in the suit.

Heard learned counsel for the parties in support of their respective submissions. Under provisions of Section 124(1)(ii) of the said Act when the trial Court is satisfied that the plea regarding invalidity of registration of the plaintiff or the defendant's trademark is *prima-facie* tenable, it has to raise an issue regarding the same and adjourn the case for a period of three months from the date of framing of such issue to enable the party concerned to apply to the Appellate Board for rectification of the register. Perusal of the impugned order indicates that the trial Court in paragraph 10 thereof has observed that the stage of framing issues would be before the first hearing of the suit and the application for temporary injunction was pending or hearing. It has then observed that the application under Section 124 of the said Act can be independently considered after issues are framed at the proper stage of the proceedings. Referring to the provisions of Section 124(5) of the said Act, it is also observed that the same have an overriding effect. It can thus be seen that the trial Court has not conducted the exercise as contemplated by the provisions of Section 124(1)(ii) of the said Act. In terms of that provision, it has to record satisfaction with regard to the plea as to invalidity of the registration of the trademark of the plaintiff or the defendant and thereafter raise an issue in that regard. As the application in question has not been considered in the light of aforesaid provision, the impugned order is liable to be set aside on that count. The application therefore warrants re-consideration.

In that view of the matter, the order passed by the trial Court below Exhibit 35 dated 22.04.2019 is set aside. The trial Court shall re-consider that application in the light of provisions of Section 124(1)(ii) of the said Act on its own merits and in accordance with law. In the light of provisions of Section 124(5) of

the said Act, the trial Court is free to proceed with the adjudication of the injunction application.

Rule is made absolute in aforesaid terms. Authenticated copy of the order is granted to learned counsel for the respondent, on request.

JUDGE

APTE