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

+ **C.R.P. 80/2019 and CM APPL. 15297/2019**

APEX SHOE COMPANY PVT LTD

..... Petitioner

Through: Mr Abhishek Malhotra, Mr Himanshu
Deora and Mr Shashwat Rakshit,
Advocates.

versus

BALDEV SINGH

..... Respondent

Through: Mr Mahir Malhotra, Mr Vipul Yadav
and Mr Satish Kumar, Advocates.

CORAM:

HON'BLE MR. JUSTICE VIBHU BAKHRU

ORDER

% **22.08.2019**

CM No. 15298/2019

1. Allowed, subject to all just exceptions.
2. The application is disposed of.

C.R.P. 80/2019 and CM APPL. 15297/2019 (stay)

3. The petitioner has filed the present petition, *inter alia*, impugning an order dated 08.01.2019 declining the petitioner's application filed under Order XIV Rule 5 of the Code of Civil Procedure, 1908 (CPC), read with Section 124 of the Trademarks Act, 1999 for framing an additional issue with regard to the validity of the trademark No. 687 and for staying the proceedings in Suit (TM) No. 13688/2016.
4. The Trial Court declined to strike another issue as the same did not arise from the pleadings filed by the parties.
5. The respondent had filed the suit for infringement of its registered trademark, passing off and rendition of accounts. The respondent is a

registered proprietor of the trademark – 687 which is fixed on the sole of the footwear manufactured by the respondent (plaintiff in the suit). The said registered trademark bearing no. 1461648 in Class 25, was registered on 12.06.2006 and is valid and subsisting. The petitioner (defendant in the suit) had opted a trademark bearing no. 6087, which the plaintiff claimed was deceptively identical to his trademark.

6. The defendant (petitioner herein) filed a written statement contesting the aforesaid suit. Concededly, the petitioner did not question the validity of the registration of the trademark 687 in favour of plaintiff (respondent herein). The Court struck the issues on 16.12.2016 and appointed a Local Commissioner for recording the evidence between the parties.

7. The recording of the plaintiff's evidence was concluded on 09.03.2017. It is the petitioner's case that the plaintiff (respondent herein) could not substantiate the use of his trademark from the year 1998 onwards as asserted by him in the plaint. Since the plaintiff had obtained the registration of the trademark by claiming prior use since 1998, according to the petitioner, the said registration was liable to be cancelled.

8. On 20.03.2017, the petitioner filed an application for cancellation/rectification of the trademark with Intellectual Property Appellate Board (IPAB). The petitioner withdrew the said application on 10.07.2018, with liberty to file, once an issue regarding validity of the trademark was framed in the pending suit, or the suit was decided in favour of the petitioner.

9. The petitioner also filed an application under Section 124 of the Trademarks Act, 1999 before the Trial Court. The learned Trial Court dismissed the said application by an order dated 09.07.2018. The Trial Court

held that the petitioner had abandoned its right to seek stay of the suit. The said order has become final as the petitioner has not assailed the same.

10. Thereafter, on 13.09.2018, the petitioner filed an application under Order XIV Rule 5 of the CPC, *inter alia*, praying for framing of an additional issue. The said application has been rejected by the impugned order.

11. It is the petitioner's case that it was not aware of the relevant facts to challenge the validity of the registration at the time when it filed its written statement. It is stated that the material facts necessary to challenge the validity came to light only on conclusion of the recording of the plaintiff's evidence.

12. It is also contended on behalf of the petitioner that at the material time the petitioner could file an application challenging the validity of the registration before the Intellectual Property Appellate Board (IPAB) without raising the said issue in the suit. The said course was no longer available to the petitioner by virtue of the decision of the Supreme Court rendered in ***Patel Field Marshal Agencies & Ors. v. P.M. Diesels Ltd. & Ors.: 2018 (73) PTC 15 (SC)***. In view of the above decision, the only remedy available to the petitioner was to seek the framing of an additional issue in the pending suit and thereafter, approach the IPAB.

13. The contentions advanced by the petitioner are unpersuasive. Concededly, there are no averments in the written statement challenging the validity of the registration of the trademark granted in favour of the respondent (plaintiff in the suit). Clearly, in the absence of any pleading questioning the validity of the registration granted in favour of the plaintiff, no issue to the said effect could be struck. The entire approach of the

petitioner seeking the framing of an additional issue, which does not arise from the pleadings filed by the parties, is misconceived.

14. In view of the above, this Court finds no reason to interfere with the order. The petition is, accordingly, dismissed. The pending application is also dismissed.

VIBHU BAKHRU, J

AUGUST 22, 2019

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