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

Date of decision: 22nd June, 2020

+ **C.R.P. 52/2020 & CM APPLs. 12994-95/2020**

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, Advocate.

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been held through video conferencing.
2. The present petition has been filed challenging the impugned order dated 4th February, 2020 by which the application under Order VI Rule 17 CPC filed by the Petitioner/Defendant (*hereinafter*, “*Defendant*”) has been dismissed by the Commercial Court.
3. The brief background is that the Respondent/Plaintiff - Mr. Baldev Singh (*hereinafter*, “*Plaintiff*”) filed a suit for infringement and passing off in respect of his trademark in numerical number ‘687’ against the Defendant - Apex Shoe Company Pvt. Ltd. The said suit was first listed on 18th January, 2016 when an *ex parte* ad interim injunction was granted against the Defendant. In the written statement, the Defendant claimed that the Plaintiff’s claim of user from 1998 was incorrect, however, no pleadings in respect of the invalidity of the Plaintiff’s registration was taken. The

following issues were framed on 15th December, 2016:

“1. Whether this suit of the plaintiff deserves to be dismissed on account of delay and laches in so far as the defendant is using Trademark "6087" since July 2014 to the knowledge of the plaintiff? OPD.

2. Whether plaintiff is entitled to decree of injunction restraining the defendants and their subjects from dealing with or disposing of the merchandise containing Trade Mark '687'? OPP.

3. Whether plaintiff is entitled to decree of delivery up of impugned goods containing Trade Mark '687'? OPP.

4. Whether plaintiff is entitled to Rendition of accounts and damages on account of profits made by the defendant by sale of goods containing Trade Mark '687'? OPP.

5. Relief.”

4. Thereafter, the Plaintiff led evidence which concluded on 9th March 2017. The Defendant, first filed an a petition before the IPAB seeking cancellation of the Plaintiff’s trade mark. It thereafter filed an application under Section 124 of the Trademarks Act, 1999, and sought stay of the suit proceedings on the ground that it has sought rectification of the Plaintiff’s mark. The application was heard on 9th July, 2018 and vide the said order, *inter alia*, due to the the fact that the Defendant never pleaded invalidity of the Plaintiff’s registration in its pleadings, the Trial Court dismissed the application. The rectification petition which was filed by the Defendant was thereafter withdrawn in view of the law laid down in ***Patel Field Marshal Agencies and Ors. v. PM Diesels Ltd. & Ors., 2017 (13) SCALE 783***. The trial of the suit was completed on 28th October, 2017.

5. The Defendant thereafter filed another application under Order XIV, Rule 5 CPC r/w Section 124 of the Trademarks Act, 1999 seeking framing of an additional issue of invalidity of the mark in view of the prevalent legal position. The said application was rejected on 8th January, 2019 and the revision against the said order was also dismissed on 22nd August, 2019.

6. The Defendant did not stop there. It then filed an application under Order 6 Rule 17 CPC r/w Section 151 CPC seeking to add a plea in the written statement in respect of invalidity of the mark, which was rejected by the Trial Court.

7. A perusal of the Commercial Court's order shows that due to the dismissal of the revision petition challenging the rejection of the Section 124 application and also in view of the fact that the trial in the case had already concluded, the amendment application was dismissed.

8. Mr. Abhishek Malhotra contends that the Defendant has not had an opportunity to raise the issue of invalidity as, admittedly due to the fluctuating legal position on Section 124, the Defendant had to withdraw the petition for cancellation filed before the IPAB. Thus, the invalidity plea which was raised by the Defendant much prior to conclusion of evidence has not been adjudicated at all. On the other hand, Mr. Mahir Malhotra submits that there is no plea in the written statement. Without a plea, the Defendant cannot be allowed to raise it at this stage.

9. Heard Ld. Counsels for the parties. The suit is one for infringement of trade mark and passing off. The Plaintiff is suing on the strength of its trade mark registration. The Defendant, if it intended to challenge the validity of the mark, ought to have raised the plea of invalidity in the written statement and having not done so, it cannot wait for all these years to move an

amendment. The order of the Ld. Single Judge dated 22nd August 2019 in CRP 80/2019, does not give any permission to the Defendant to amend the written statement. It categorically records that in the absence of a plea questioning validity, no issue in respect thereof can be struck.

10. This Court does not find any infirmity in the order passed by the Trial Court to the extent that too much water has flown under the bridge since the inception of the suit. The evidence of both the parties already stands concluded. The Court has perused the written statement, the Defendant has only pleaded that the user of the Plaintiff has not been established and denied the same. The invalidity of the trade mark has not been pleaded. Permitting an amendment at this stage would completely put the clock back and would be contrary to the mandate of Order 6 Rule 17 CPC.

11. Though the impugned order does not call for any interference it is reiterated that while adjudicating issues which have been settled in the matter, especially Issue No.2, the Trial Court would definitely bear in mind the settled legal principle that the Plaintiff has to establish user of the mark as pleaded and mere registration of the trademark would does not itself constitute evidence of use.

12. No further orders are called for in this matter. A prayer is made for reduction of costs considering the nature of the dispute. This Court is not inclined to set aside the costs.

13. With these observations, the petition and all pending applications are disposed of.

PRATHIBA M. SINGH
JUDGE

JUNE 22, 2020/dj/T