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

Date of decision: 24th July, 2023

+ **C.A.(COMM.IPD-TM) 1/2023 and I.A. 1530/2023, 1532/2023**

ROMIL GUPTA TRADING AS SOHAN LAL
GUPTA

..... Appellant

Through: Mr. Rajshekhar Rao, Sr. Advocate
with Mr. Sagar Chandra, Ms. Shubhie
Wahi, Ms. Ankita Seth and Mr. Amit
Singh, Advocates (M: 8825116948).

versus

REGISTRAR OF TRADE MARKS & ANR. Respondents

Through: Mr. J. Sai Deepak, Mr Vipin Wason,
Mr Avinsh Sharma and Ms Stuti
Wason, Advocates (M:
8010903234).

Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar Mishra,
Mr. Sagar Mehlawat and Mr.
Alexander Mathai Paikaday,
Advocates (M: 9810788606).

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WITH

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W.P.(C)-IPD 10/2023

LANDMARK CRAFTS PRIVATE LIMITED Petitioner

Through: Mr. J. Sai Deepak, Mr Vipin Wason,
Mr Avinsh Sharma and Ms Stuti
Wason, Advocates (M:
8010903234).

versus

UNION OF INDIA THROUGH ITS SECRETARY
& ANR.

..... Respondents

Through: Mr. Rajshekhar Rao, Sr. Advocate
with Mr. Sagar Chandra, Ms. Shubhie



Wahi, Ms. Ankita Seth and Mr. Amit Singh, Advocates for R-3 (M: 8825116948).

Mr. Arjun Mahajan, SPC for UOI, R-4 (M: 8527486543).

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.
2. The present petitions relate to Appellant's mark 'sdHP'

sdHP

which has been rectified/cancelled by the Respondent No. 1-Registrar of Trade Marks vide impugned order dated 15th December, 2022. The said impugned order was stayed by this Court vide order dated 25th January, 2023. The said order reads as follows:

*“11. Mr. Rajshekhar Rao, Senior Counsel for Appellant, submits that the impugned order is ex-facie arbitrary and contrary to the provisions of the Act. He emphasises that in the infringement suit filed by Respondent No. 2 in respect of Appellant's mark before the District Court, injunction was refused. Respondent No. 2 then filed form TM-0 seeking rectification/ cancellation of Appellant's mark, which is presently pending. **Mr. Rao argues that during the pendency of rectification proceedings, there was no basis for the Deputy Registrar to invoke suo moto powers under Section 57(4) of the Act to cancel Appellant's mark.** The Deputy Registrar did not provide Appellant adequate time to respond, and in haste, now removed Appellant's mark, which was on the register for almost two and a half years. That apart, even the complaint, basis*



whereof the impugned order has been passed, is not in conformity with prescribed format.

12. Issue notice. Mr. Geetesh Meena, counsel accepts notice on behalf of Respondent No. 2. He states that Deputy Registrar has decided Respondent No. 2's rectification petition itself by way of the impugned order. He is however unable to support this contention from the documents on record. Mr. Meena states that he received the paper-book only day before yesterday and would need time to examine the record and clarify this issue. Let reply be filed within four weeks from today. Rejoinder thereto, if any, be filed within two weeks thereafter.

13. Issue notice to Respondent No. 1, upon filing of process fee, by all permissible modes, returnable on the next date of hearing. Respondent No.1 shall file reply, if any, within four weeks from the date of service. Rejoinder thereto, if any, be filed within two weeks thereafter.

14. For the reasons noted above, it is directed that till the next date of hearing, the impugned order dated 15th December, 2022, shall remain stayed and Appellant's mark under application No. 3986970 is restored on the register".

3. The Writ Petition bearing no. **W.P.(C)-IPD 10/2023** has been filed by Landmark Crafts Private Limited, seeking early disposal of rectification/cancellation which has been filed under Section 57 of the Trade Marks Act, 1999 before the Respondent No. 1- Registrar of Trademarks.

4. After hearing some submissions, it emerges that the following four proceedings are pending between the different parties:

- i) **C.A.(COMM.IPD-TM) 1/2023** titled **Romil Gupta Trading as Sohan Lal Gupta v. Registrar of Trade Marks & Anr.**
- ii) **W.P.(C)-IPD 10/2023** titled **Landmark Crafts Private Limited**



v. Union of India Through Its Secretary & Anr.

iii) **CS (COMM) 117/2019** titled **M/s Landmark Crafts Private Limited v. M/s Sohan Lal Gupta through its Proprietor Sh. Romil Gupta** before the Id. ADJ (Commercial Court) Karkardooma Court.

iv) **Rectification Application 266607** titled **Romil Gupta Trading as M/s Sohan Lal Gupta v. Landmark Crafts Private Limited** before the Registrar of Trade Marks.

5. A coordinate bench of this Court in **Jumeirah Beach Resort LLC v. Designarch Consultants Pvt. Ltd. (C.O (COMM-IPD-TM) 124/2022, order dated 28th November 2022)** considering the issue of consolidation of proceedings under the provisions of the Trade Marks Act, 1999 and IP Division Rules, 2022 observed as follows:

“10. Section 125(2) empowers the Registrar of Trademarks, at any stage, to refer the matter to the IPAB. The jurisdiction, authority and powers of the IPAB having been transferred to this Court consequent on the enactment of the Tribunals Reforms Act, 2021, the power of reference contained in Section 125(2) of the Trademarks Act would, *proprio vigore*, empower the Registrar of Trademarks to, in an appropriate case, refer the matter to this Court.

11. If the Registrar of Trademarks could refer the matter to this Court, there is no reason why this Court could not direct transfer of the matter to itself, especially where all other connected petitions, including petitions for passing off and cancellation/removal/rectification petitions instituted by Jumeirah against Designarch, which are pending before the IPAB, already stand transferred to this Court.

14. The argument appears, to me, to be hyper



technical. Besides, in all commercial matters, the foremost consideration is expeditious and meaningful disposal of the proceedings, which becomes additionally important where the proceedings relate to intellectual property rights. Confusion is bound to result if the infringement and passing off suit filed by Jumeirah against Designarch, and the rectification/removal proceedings instituted by Jumeirah against Designarch before the IPAB are taken up by this Court and the counter proceedings for removal/rectification instituted by Designarch against Jumeirah pending before the learned Registrar of Trademarks are allowed to continue there. In order for this Court to have a holistic appreciation of the disputes, and to ensure a complete resolution thereof, it is but obvious that all these proceedings should be taken up and heard together.”

6. Therefore, exercising powers of consolidation under Rule 26 of the IP Division Rules and bearing in mind Section 125 of the Trade Marks Act, 1999, in order to avoid multiplicity of the proceeding and conflicting rulings, it is deemed appropriate to direct as under:-

- i) **CS(COMM) 117/2019** which is pending before the Commercial Court in Karkardooma shall stand transferred to this Court to be heard along with **C.A.(COMM.IPD-TM) 1/2023**. Let the suit records be called. Let the suit be numbered, and listed on the next date of hearing before this Court.
- ii) **Rectification No. 266607** dated 24th July, 2019, pending before the Respondent No. 1-Registrar of Trademark seeking rectification of ‘**3986970**’ in Class 6 belonging to the Appellant shall also stand transferred to this Court. The Registrar of Trademark is directed to



transmit the entire record to the Registry.

iii) In view of the fact that the rectification itself is being transferred to this Court, ***W.P.(C)-IPD 10/2023***, by which early hearing of the rectification application was sought, is disposed of as being infructuous.

7. In the meantime, upon the said records being received, if any pleadings are left out, parties are permitted to complete all the pleadings within four weeks.

8. List before the Registrar for completion of pleadings on 22nd September, 2023.

9. List the suit, rectification along with ***C.A.(COMM.IPD-TM) 1/2023*** before the Court on 18th October, 2023.

10. Interim orders to continue.

PRATHIBA M. SINGH
JUDGE

JULY 24, 2023

mr/dn