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(TM)A/40/2023

N.SESHASAYEE, J.

The present Application is taken out under Rule 14 of the IPD Rules for transfer of certain pending rectification petitions before the Registrar of Trade Marks/the second respondent herein.

2.The applicant herein has registered as many as 35 marks, out of which, 6 marks were registered under clause 9. The first respondent is introduced as a small time manufacturer headquartered in Gurgaon and it has registered one mark under clause 9 and has applied for registration of 2 other marks, which is disputed by certain sister concerns of the first respondent. The first respondent had registered its mark in 2009 and has been using the mark since 2007.

3.While so, on 10.12.2021, the applicant herein had issued a cease and desist notice on the first respondent and required it to stop using the



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mark. Wasting no time, the first respondent had moved the second respondent herein on 25.01.2022 with 4 applications for rectification as regards 4 out of 6 marks which the applicant had registered under clause 9. Subsequently, on 24.04.2022, the applicant herein has laid C.S.No.82 of 2022 for infringement and for reliefs associated therewith and this case is now pending before the Commercial Division of this Court. In that suit, the applicant herein has taken out several applications and it may not be necessary to dwell deep into each of these applications. In some critical applications, the applicant herein has lost and some of these orders were also confirmed by the Commercial Appellate Division of this Court. Indeed, the applicant's application in A.No.4257 of 2022, taken out in the pending civil suit, seeking leave to file a rectification petition itself has been dismissed on 21.03.2023.

4.Be that as it may, the first respondent had taken out an Application



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in A.No.6824 of 2023 for stay of the suit under Section 124(1)(i) of the Trade Marks Act to stay the suit till the disposal of the four rectification petitions pending before the second respondent.

5.It is in this backdrop, the plaintiff in the civil suit had come out with the present application seeking transfer of the four pending rectification applications to the file of this Court. This Court is informed that the applicant herein had also moved the Registrar of Trademarks with an Application on 18.08.2023 for transferring the rectification petitions under Section 125 of the Act to the file of this Court, but no action seem to have been taken on the same.

6.The prayer for transfer of the rectification petitions referred to in this Application is opposed by the first respondent principally on the ground that it is devoid of any bonafides. The learned counsel for the first respondent carefully took this Court to the facts that were



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narrated herein above to suggest that till date the applicant has not filed any rectification petition and that it is a rouse to delay things. In other words, the learned counsel submitted that the game is a mismatch between somebody who is a heavy weight and somebody who is only a small time manufacturer located in Delhi with a moderate market for his products and in deed, the first respondent also has a bonafide certificate issued to him.

7.Rival submissions are carefully weighted.

8.Ultimately, this issue relate to rectification of registration for which the applicant would have taken out at least 4 separate petitions which need to be decided by some authority with competent jurisdiction and it should not be lost site of that there is another civil suit which is pending trial. In a scenario such as this, it will be only advantageous if all the materials are heard by this Court (This High Court has not



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taken any decision at this point of time for consolidation of the rectification petitions and the pending Civil Suit) and the issue as to whether there is any malafide intension involved, may not be very germane at this point of time. May be it will have some bearing later during the enquiry of these petitions.

9. In view of the same, this Court allows this Application and directs the transfer of the physical records of Rectification proceeding numbers 274075, 274074, 274076 & 274073 pending before the Trademarks Registry, Chennai to the file of this Court, within a period of four weeks from the date on which the order is uploaded in the official website.

11.01.2024

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Note: Issue order copy on 12.01.2024

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