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

+ C.O. (COMM.IPD-TM) 301/2022

MR. NADIR RIZVI, S/O MOHD. AHMED RIZVI M/S. AMROHA
MEHNDI UDHYOGPetitioner

Through: Mr. Pranav Gupta with Mr. Rahul
Verma and Mr. Mohd Arif,
Advocates.
(M): 8851953920
Email: pranavguptaadvocate@gmail.com

versus

RAFIQ AHMED M/S. SPECIAL RUQUAYYA HINA ZULFI AND
THE REGISTRAR OF TRADEMARKSRespondent

Through: Mr. Junaid Alam, Advocate.
Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar Mishra,
Mr. Alexander Mathai Paikadey and
Mr. Sagar Mehlawat, Advocates.

+ C.O. (COMM.IPD-TM) 469/2022

AMROHA MEHNDI UDHYOG, OPP. NAGAR PALIKA DISTT.
AMROHA, UPPetitioner

Through: Mr. Pranav Gupta with Mr. Rahul
Verma and Mr. Mohd Arif,
Advocates.
(M): 8851953920
Email: pranavguptaadvocate@gmail.com

versus



RAFIQ AHMED M/S SHAHJI GENERAL STORE, MOHALLA
BASAWAN GANJ, AMROHA, DISTT. J.P. NAGAR,
UPRespondent

Through: Mr. Junaid Alam, Advocate.
Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar Mishra,
Mr. Alexander Mathai Paikadey and
Mr. Sagar Mehlawat, Advocates.

CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA

ORDER
16.08.2024

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1. The present petitions have been filed under Section 47 and 57 of the Trademarks Act, 1999, seeking removal from the Register of Trade Marks, the mark, 'HINA ZULFI', registered in favour of Respondent No.1 in Class 03, vide registration nos. 2496714 and 2559357, respectively.
2. By order dated 31st July, 2024, it has been noted that a *suit bearing No. 1/2016* is pending in District Court, Jyotiba Phule Nagar, Amroha filed on behalf of the respondent. This Court has also noted that *suit bearing No. 01/2013* filed on behalf of the petitioner herein, already stands dismissed vide order dated 22nd April, 2022, passed by the Additional District Judge, Jyotiba Phule Nagar, Amroha.
3. Learned counsel appearing for the respondent had raised the objection that the present rectifications petitions have been filed without seeking leave of the Court under Section 124(1) (ii) of the Trade Marks Act, 1999. Considering the submission made by learned counsel for the respondent, liberty had been granted to the petitioner to seek instructions in this regard.
4. Today, learned counsel appearing for the petitioner submits that he



has not been able to obtain the requisite documents.

5. Learned counsel appearing for the respondent reiterates the submission that no leave of the Court has been taken by the petitioner, in the prior suit of the respondent.

6. Having heard learned counsels for the parties, this Court notes Section 124 of the Trade Marks Act, 1999, which reads as under:-

“124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc.-

(1) Where in any suit for infringement of a trade mark –

(a) the defendant pleads that registration of the plaintiff’s trade mark is invalid, or

(b) the defendant raises a defense under clause (e) of sub-section (2) of section 30 and the plaintiff pleads the invalidity of registration of the defendant’s trade mark.

The court trying the suit (hereinafter referred to as the court) shall,-

(i) if any proceedings for rectification of the register in relation to the plaintiffs or defendant’s trade mark are pending before the Registrar or the Appellate Board, stay the suit pending the final disposal of such proceedings.

(ii) If no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff’s or defendant’s trade mark is prima facie tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the High Court for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b) (ii) of sub-section (1) within the time specified therein or within such extended time as the court may for sufficient cause allow, the trial of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the



Court shall dispose of the suit conformably to such order insofar as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the Court from making any interlocutory order (including any order granting an injunction, directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.”

(Emphasis Supplied)

7. Reading of the aforesaid section clearly shows that in case any suit for infringement of a trademark has been filed, then, the defendant therein, has to plead that registration of the trade dress/trade mark of the plaintiff in the suit, is invalid. It is only when the defendant raises such a defence and the Court trying the suit frames such a question, that the party concerned can file the rectification proceedings.

8. The procedure under Section 124 of the Trade Marks Act, 1999 is required to be followed, before filing any rectification proceedings. Since, no such procedure has been followed in the present case in terms of the submission made by learned counsel appearing for the respondent, which the petitioner has not been able to rebut, the present petitions are clearly not maintainable.

9. Accordingly, the present petitions are dismissed, with liberty to the petitioner to file appropriate petitions, after following the procedure under Section 124 of the Trade Marks Act, 1999.

MINI PUSHKARNA, J

AUGUST 16, 2024

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