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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ C.O. (COMM.IPD-TM) 68/2024, I.A. 29888/2024, I.A. 29889/2024,
I.A. 30041/2024, I.A. 30042/2024 & I.A. 30043/2024
CASABLANCA APPARELS PVT LTD Petitioner

Through: Mr. Manu T. Ramachandran, Adv.
(thru VC) with Ms. Salini
Sukumaran, Adv.

versus

POLO LAUREN COMPANY LP & ANR. & ANR.
..... Respondents

Through: Mr. Anirudh Bakhru,
Mr. Siddharth Swain &
Ms. Kannupriya Sabhyarwal, Advs.
for R-1

Mr. Harish Vaidyanathan Shankar,
CGSC, Mr. Srish Kumar Mishra, Mr.
Alexander Mathai Paikaday,
Advocates for R-2

CORAM:
HON'BLE MR. JUSTICE ANISH DAYAL

% **ORDER**
21.05.2024

1. This rectification petition has been filed by petitioner (*Casablanca Apparels Pvt. Ltd.*) seeking rectification of respondent's trademark 'POLO' registered under no. 1277784 in class 25, *vide* application 8th April 2004, granted on 18th January 2023.

2. At the very outset, an issue of maintainability has arisen, in context of the fact that there is a suit [CS (COMM) 523/2022], filed by respondent herein (*Polo/Lauren Company L.P.*) against petitioner, before the District



Judge (Comm Court-02), South District, Saket Court, New Delhi where an *ex parte ad interim* injunction was passed in favour of respondent herein (plaintiff therein) (*Polo/Lauren Company LP*) against petitioner herein (defendant therein) (*Casablanca Apparels Pvt. Ltd.*) on 6th September 2022, which has since been confirmed by order dated 22nd October 2023.

3. In the meantime, during pendency of the suit, an application under Section 124(1)(b)(ii) of Trade Marks Act, 1999 (“**the Act**”) was moved by petitioner herein (defendant in the said suit) before the Trial Court pleading invalidity of the respondent’s mark and approach the High Court for rectification of the Register. On 6th February 2024, the Trial Court adjourned the matter to 15th May 2024; thereafter, on 15th May 2024, posted it for arguments on 8th July 2024, basis of the said application.

4. In response to the issue of maintainability of this petition, as raised by the respondent’s counsel, counsel for petitioner contends that moving an application under Section 124(1)(b) of the Act does not preclude him from approaching this Court, since proceedings under Section 124 are merely for stay and do not curtail / exclude the power of the High Court to address the rectification petition under Section 125 of the Act, or even *suo moto* under Section 57(4) of the Act.

5. Counsel for respondent herein, who appears on advance notice however, vehemently refutes the said submission. *Firstly*, he points out that the issue of pendency of application under Section 124(1)(b)(ii) of the Act is misrepresented by petitioner in para 11 of the petition, where it is stated that petitioner has “*sought leave of the District Judge to approach this Court for filing rectification*” and that “*Ld. District Judge has allowed the application and granted time to apply for rectification of the said registration before this Hon’ble Court*”. This Court notes that this was absolutely contrary to the actual orders passed by the District Judge, as



noted in para 3 above. The application under Section 124(1)(b)(ii) is listed for arguments on 8th July 2024 and no leave has been granted yet nor a finding reached on *prima facie* tenability of the defendant's plea. The procedure to be adopted in these situations is not only evident from the very language of Section 124(1)(b)(ii) itself, but also has been recently reiterated by a Division Bench of this Court in ***Mr. Amrish Aggarwal Trading as M/s Mahalaxmi Product v. M/s Venus Home Appliances Pvt. Ltd. & Anr.***, 2024:DHC:3991-DB.

6. It is quite clear from *inter alia* the following extracts from this decision that the Trial Court which is seized of the suit, is to consider the said application under Section 124(1)(b)(ii) and reach a conclusion regarding *prima facie* tenability of the rectification/invalidity plea sought by defendant, of plaintiff's mark 'POLO'.

"... As we read Section 124 of the 1999 Act as it presently stands, it is manifest that a court trying a suit is placed under a legislative mandate to stay proceedings thereon, if it be apprised of rectification proceedings having been initiated prior to its institution. The only additional qualification which applies is where a plea of invalidity comes to be raised in the course of the suit proceedings itself. In such a situation the Trial Judge is firstly obliged to evaluate the prima facie tenability of the plea as raised and if coming to the conclusion that the challenge would merit further consideration, to stay the proceedings in the pending suit for a period of three months, enabling the applicant to apply to the High Court for rectification of the Register.

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....The expression „prima facie tenable“ essentially requires the Trial Judge to undertake a preliminary examination of the plea of invalidity as opposed to a definitive determination. The aforesaid caveat



essentially appears to have been introduced in order to enable the Trial Judge to dispose of pleas which may be wholly specious or devoid of substance. Thus, if on a preliminary examination itself, the Trial Judge were to come to the conclusion that the plea of invalidity as raised is clearly untenable and merits no further examination, it would be entitled to proceed further in the suit. However, and once the court comes to the prima facie conclusion that the challenge to registration of a mark does merit further examination, it would have to undoubtedly place the suit proceedings in a state of latency and await the outcome of any rectification or cancellation action that may come to be instituted.”

(emphasis added)

7. In view of the above, considering that application under Section 124 of the Act is pending before the Trial Court, this rectification petition, is not maintainable at this stage.
8. Accordingly, this rectification petition is dismissed, with liberty to the petitioner to pursue the application before the Trial Court. It is made clear that this Court has not made any observations on the merits of the case.
9. Pending applications are rendered infructuous.
10. Copy of this judgment be uploaded on website of this Court.

(ANISH DAYAL)
JUDGE

MAY 21, 2024/sm/na