



**HIGH COURT OF JUDICATURE FOR RAJASTHAN AT
JODHPUR**

S.B. Civil Writ Petition No. 18461/2023

1. M/s. Lotus Organic Care, Plot No. F-419, Riico Growth Center Bhilwara (Raj.) Through Prop. Shri Harish Dadhich S/o Shri Govindlal Ji Dadhich, R/o M/s Lotus Organic Care Plot No. F-419, Riico Growth Center Bhilwara.
2. Shri Harish Dadhich S/o Shri Govindlal Ji Dadhich, Aged About 40 Years, Prop. Of M/s. Lotus Organic Care, Plot No. F-419, Riico Growth Center Bhilwara (Raj.).

-----Petitioners/Defendants

Versus

M/s. Aadhar Products Pvt. Ltd., Factory F-264, F-264-A Riico Industrial Area Gudli, Tehsil Mawli, District Udaipur (Raj.) Through Authorized Representative Navneet Ladha S/o Shri Rameshchandra Ji Ladha, Aged About 24 Years, Presently General Manager (Finance And Accounts).

-----Respondent/Plaintiff

For Petitioner(s)	:	Mr. Divyanshu Choudhary Mr. Vineet R.Dave
For Respondent(s)	:	Dr. Ashok Soni, Sr. Adv. assisted by Ms. Sonali Vyas, Mr. Aman Soni, Mr. Yash Dadhich & Mr. Romil Bagrecha

HON'BLE MR. JUSTICE VINIT KUMAR MATHUR

Order

REPORTABLE

16/05/2024

1. Heard learned counsel for the parties.
2. The present writ petition has been filed against the order dated 19.10.2023 passed by the learned Additional District and Sessions Judge, Mawli, District Udaipur in Civil Suit No.62/2022 (17/2018), whereby the application preferred by the petitioner



under Section 124 of the Trademarks Act, 1999 (hereinafter referred to as the 'Act of 1999') has been rejected.

3. Briefly noted the facts giving rise to the present writ petition are that the respondent-plaintiff filed a suit for infringement and passing off of its registered label trademarks (1961814 & 2551769) before the learned trial court. In the suit filed by the respondent-plaintiff, the summons were issued. The petitioner-defendant filed written statement to the suit preferred by the respondent-plaintiff. The trial court framed the issues on 09.10.2022. Thereafter, on the application moved by the respondent-plaintiff as well as by the petitioner-defendant, an additional issue was framed by the trial court on 23.02.2023. After framing of the issues by the learned trial court, the petitioner preferred an application under Section 124 of the Trademarks Act, 1999 for staying the suit proceedings on the ground that the petitioner proposed to file a rectification application against the Trademarks Nos.1961814 & 2551769 of the respondent-plaintiff. On the application, the learned trial court heard the counsel for the parties and rejected the same vide order dated 19.10.2023. Hence, the present writ petition has been filed.

4. Learned counsel for the petitioner submits that the learned trial court has committed an error in passing the order dated 19.10.2023 as the specific provisions of Section 124 (1) (ii) have not been taken note of while appreciating the facts in the present case. Learned counsel submits that the trial court was under an obligation to prima facie get itself satisfied for tenability of the submissions made in the written statement as well as in the application preferred under Section 124 with respect to the



rectification application and proceedings to be undertaken by the petitioner before the appropriate forum. He submits that in paragraph 2 and 2-4 of the written statement, the basic foundation has been laid by the petitioner with respect to the plea of validity of the rectification application to be preferred before the appropriate forum. He, therefore, submits that the learned trial court has committed an error while not appreciating the contentions raised by the petitioner in the written statement with respect to the prima facie tenability of the plea of invalidity of the Trademark used by the plaintiff-respondent. He, therefore, prays that the writ petition may be allowed and the order dated 19.10.2023 may be quashed and set aside.

5. Per contra, the learned Sr. Counsel for the respondent vehemently opposed the submissions made by the counsel for the petitioner and submits that the learned trial court has dealt with the issue in detail and has rightly come to the conclusion that prima facie tenability of the submissions made before the trial court in the written statement is not made out to bring home the case of the petitioner under the ambit of Section 124 (1) (ii) and, therefore, the contentions raised by the petitioner in the written statement are not sufficient to satisfy the mandate of prima facie tenability of the contentions with respect to the invalidity of the trademark of the plaintiff-respondent to be canvassed in the rectification application to be preferred before the appropriate forum. The learned counsel submits that the learned trial court has taken note of the submissions and has rightly come to the conclusion that the same are not sufficient for prima facie



satisfying the trial court regarding the tenability of the rectification application before the appropriate forum.

6. Learned Sr. Counsel further submits that Section 124 is applicable only in the cases where the suit for infringement of the trademark is under consideration. In the present case, since the plaintiff has preferred a suit for infringement as well as passing of, therefore, learned Sr. Counsel alternatively prays that the learned trial court may be allowed to proceed with the suit proceedings on the issue framed with respect to the prayer for passing is concerned.

7. I have considered the submissions made at the Bar and have gone through the relevant record of the case.

8. For better appreciation of the facts and issue, it is worthwhile to reproduce Section 124 (1) (ii) of the Act of 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).....

(b).....

(i).....

(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.”

9. As per the mandate of law, particularly Section 124 (1) (ii), it is incumbent upon the trial court that in a pending suit, if an application under Section 124 is filed, then prima facie it has to satisfy with respect to the invalidity of the registration of the plaintiff's/defendant's trademark. The trial court has to take into



account the pleadings made on behalf of the applicant for reaching its prima facie satisfaction for tenability of the same.

10. In the present case, the learned trial court has taken note of the pleadings made in the written statement of the petitioner and has come to the conclusion that the same are not prima facie tenable to bring home the satisfaction of the trial court for framing the issues with respect to the invalidity of the registration of the plaintiffs trademark and thus, the learned trial court has rejected the application. It is worthwhile to reproduce the pleadings made by the petitioner-defendant in the written statement, particularly paragraph 2 and 2-4, which reads as under:

"2. यह है कि, वादी कम्पनी ने अपने वाद-पत्र को देरी से प्रस्तुत किए जाने का कोई कारण स्पष्ट नहीं किया है, जबकि प्रतिवादी वर्ष 2007 से ही अपने व्यवसाय कर रहा है और वादी कम्पनी की जानकारी में वर्ष 2012 से ही आ चुका है। प्रतिवादीगण द्वारा Delite नाम से वॉशिंग पाउडर का व्यवसाय किया जा रहा है। प्रस्तुत वाद महत्वपूर्ण तथ्यों का दोहराव छिपा कर कपटपूर्ण उद्देश्य से प्रस्तुत किया गया है। वादी द्वारा वाद में प्रस्तुत ट्रेडमार्क का पंजीयन भी ट्रेडमार्क अधिनियम के प्रावधानों के विरुद्ध असल स्थिति का छिपाव करते हुए प्राप्त किया है। वादी के ट्रेडमार्क का पंजीयन ही प्रथम दृष्टया अवैध प्रतीत होता है। प्रस्तुत वाद माननीय न्यायालय के समक्ष स्वच्छ हाथों से पेश नहीं किया गया है। माननीय सर्वोच्च न्यायालय द्वारा पारित निर्णयों के प्रकाश में विधि का यह नियम सुस्थापित है कि, A litigant who attempts to pollute the stream of justice or who touches the pure fountain of justice with tainted hands] is not entitle to any relief whether interim or final."

"2-4. यह है कि, वाद के पद संख्या 2, 3 व 4 में वर्णित तथ्य जिस तरह से घुमा-फिराकर अंकित किये हैं, अस्वीकार है। वादी कम्पनी डिसाईड नामक वॉशिंग पाउडर का उत्पादन व विपणन 2006 से कर रही हो, अस्वीकार है। वादी कम्पनी द्वारा डिसाईड वॉशिंग पाउडर का जिस पैकेजिंग में विपणन किया जाता है, उस पैकेजिंग का कलर कॉम्बिनेशन, डिजाईन इत्यादि भी अपना विशेष महत्व रखते हैं, परंतु वादी कम्पनी के प्रोडक्ट की पैकेजिंग, कलर कॉम्बिनेशन, डिजाईन इत्यादि उपभोक्ताओं के मन-मस्तिष्क में एक विशेष छवि व साख बना चुके हो, पूर्णतया अस्वीकार है। ट्रेडमार्क रजिस्ट्री के इन्टरनेट पर उपलब्ध डाटा बेस के अवलोकन से प्रथम दृष्टया यह स्पष्ट है कि वादी



वर्ष 2006 में प्रथमतः जो लेबल ट्रेडमार्क का अंगीकरण किया है, वह वाद में प्रस्तुत ट्रेडमार्क से भिन्न है। वादी द्वारा वर्ष 2006 में जो लेबल ट्रेडमार्क डिजाईड के पंजीकरण के आवेदन, प्रार्थना-पत्र प्रस्तुत किये हैं, वह "Proposed to be used category" में किये हैं। वर्ष 2013 में भी वादी कम्पनी द्वारा जो फौजदारी प्रकरण दायर किया था उसमें वादी कम्पनी ने अपने किसी अन्य ट्रेडमार्क का उल्लंघन होना नहीं बताया है। इस प्रकरण के एक माह पश्चात् वादी कम्पनी ने प्रस्तुत वाद की विषयवस्तु ट्रेडमार्क संख्या आवेदन प्रार्थना-पत्र प्रस्तुत किया, ऐसी स्थिति में वादी द्वारा इस ट्रेडमार्क डिजाईन, कलर कॉम्बिनेशन इत्यादि 03.03.2006 से ही उपयोग करना पूर्णतया अस्वीकार है। वादी का यह कथन कि वर्ष 2006 से डिजाईड मार्क Uninterrupted and Continuous Use के कारण घर-घर पहचाना जा रहा है, अस्वीकार है। विधि के सुस्थापित नियमों के अनुसार किसी भी सामान्य प्रज्ञा व्यक्ति के लिए ट्रेडमार्क की ख्याति व प्रसिद्धि उसे लगातार, खुले एवं विस्तृत रूप से काम लेने पर ही प्राप्त होती है। वादी द्वारा समय-समय पर अपने लेबल ट्रेडमार्क डिजाईड को बदला गया है एवं रजिस्ट्रार द्वारा वादी के ट्रेडमार्क के सम्बन्ध में जो नियम व प्रतिबन्ध लगाये हैं, वह वादी को प्रदान पंजीकरण की परिसीमा तय करते हैं। वादी द्वारा उक्त ट्रेडमार्कों के उपयोग के सम्बन्ध में कोई साक्ष्य शपथ-पत्र भी पेश नहीं किया है। वादी के लेबल ट्रेडमार्क डिजाईड संख्या 1961814 एवं 2551769 का पंजीयन अवैध है व असल तथ्यों को छिपाकर प्राप्त किया गया है। प्रस्तुत वाद में जो Artistic Work कॉपीराइट नम्बर A-112252/2014 का आवेदन भी उक्त फौजदारी प्रकरण के पश्चात् किया गया है। वादी द्वारा प्रस्तुत वाद व्यापारिक ईर्ष्या के चलते व असल उपयोग के तथ्यों को छिपाकर प्रस्तुत किया है। उपरोक्त तथ्यों से यह भली-भांति प्रमाणित है कि, वादी का कथन कि, डिजाईड मार्क के समान किसी भी मार्क को वादी कम्पनी के डिजाईड से जोड़कर देखा जा सकता है व वर्तमान में देखा जा रहा है, पूर्णतया गलत एवं मिथ्या है।"

11. A bare perusal of the aforequoted paragraphs clearly show that the petitioner has made pleadings to satisfy the factum of prima facie showing before the trial court that the registration made in favour of the respondent-plaintiff is invalid. The learned trial court was only required to prima facie satisfy itself with respect to the pleadings taken in the written statement to the effect that the trademark of the plaintiff is invalid. If such pleadings are taken, then the petitioner-defendant was well within its right to get the benefit of Section 124 taking leave of the trial



court for taking recourse of filing the application for rectification against the trademark of the petitioner. The learned trial court was not required to measure the sufficiency or insufficiency of the evidence or other factors for adjudicating the factum of the success or failure of the rectification application. Since the rectification proceedings are required to be undertaken at a different forum and the parameters for the same will stand on different footings, therefore, the learned trial court was only required to record prima face satisfaction with respect to the pleadings made in support of the invalidity of the trademark of the plaintiff.

12. This Court is further of the view that while deciding the application under Section 124, the trial court is not required to appreciate, evaluate and discuss in detail the evidence in support or against the rectification application. It just has to prima facie record its satisfaction with respect to the invalidity of the trademark of the plaintiff/defendant and prima facie tenability of the same.

13. In the present case, this Court is satisfied that the pleadings taken in the above mentioned paragraphs are sufficient to show that the application preferred under Section 124 was required to be accepted.

14. In view of the discussion made above, the writ petition merits acceptance and the same is allowed. The order dated 19.10.2023 is quashed and set aside and further proceedings in Suit No.62/2022 pending before Additional District and Sessions Judge, Mawli, District Udaipur qua the prayer for infringement are



stayed and the petitioner is allowed to undertake the process for filing the rectification application as per law.

15. It is also made clear that the suit proceedings with respect to the passing off preferred by the respondent-plaintiff shall continue on the issues framed thereunder.

16. Stay petition as well as other pending applications, if any, shall stand disposed of.

(VINIT KUMAR MATHUR),J

52-/Vivek Mishra/-

