

**IN THE COURT OF SHRI PRITAM SINGH
DISTRICT JUDGE-04, SOUTH EAST DISTRICT
SAKET COURTS, NEW DELHI**

**TM 1450/16
M/S IZUK IMPEX VS. M/S FIVE STAR HEALTH CARE LLP**

ORDER

1. By this order, I shall dispose of the application filed on behalf of the plaintiff under section 124 Trademarks Act 1999 r/w section 151 CPC for framing of issues regarding invalidity of registered trademark 5 Star of the defendant.
2. It is stated in the application that the defendant, in Para No.5 of preliminary objection of the Written statement alleged itself to be registered proprietor of Trademarks 5 STAR of the Defendant under No.415314 and 496778 in class 03. The Defendant also took defense under Section 28 (3) and Section 32 (2) (e) of the Trademarks Act 1999. The relevant portion of written statement is reproduced as under:

"5. Without prejudice to the above, the defendant submits that suit filed by the plaintiff alleging infringement of its alleged registered trade mark(s) is not maintainable and is liable to be dismissed as the same is barred under the provisions of Section 28(3) read with Section 30 (2) (e) of Trade Marks Act, 1999. It is submitted that the defendant is the registered proprietor of the trade mark 5 STAR under nos. 415314 and 496778 in class 3 and various other marks, details whereof are mentioned here-in-below and as such the suit filed by the plaintiff seeking relief of infringement of trademark is liable to be dismissed and/or rejected under the provisions of Order VII Rule 11 (a) & (d) of the Code of Civil Procedure, 1908."

3. It is further stated that the plaintiff, while filing the replication, has specifically denied that assertions of the Defendant regarding validity of its registered trademark. The Plaintiff also denied the impugned Registered Trademarks of the Defendant to be valid. The relevant portion of the replication is reproduced as under:

"5-7. That the contents of Para Nos.5-7 are wrong and denied. What has been stated hereinabove may be referred to. It is denied that the Suit is barred under the Provisions of Section 28(3) read with Section 30 (2) (e) of the Trade Mark Act, 1999, as alleged. The Defendant's claimed regarding proprietorship and valid registration of the impugned trade mark 5 STAR are denied. It is denied that the Defendant is having any valid or lawful registrations. Even assuming that there is any such registration, it is liable to be rectified/removed/cancelled from the register of Trademarks. It is denied that the Suit filed by the Plaintiff is liable to be dismissed or rejected under provisions of order VII Rule 11 (a) & (d) of CPC. The defendant's alleged non-maintenance of infringement of Copyrights in plaintiff's Packaging is denied. It is denied that the impugned packaging of the defendant is entirely different from the said packaging of the Plaintiff. It is denied that there is similarity in get up or far out or color combination of the impugned packaging, as alleged. The defendant's regarding misconception of Plaintiff's infringement of copyrights is denied. The defendant's alleged tall claim is denied. It is denied that the Plaintiff has failed to file any cogent documentary evidence in support of its case. It is denied that the works of the Plaintiff do not qualify to be original artistic works within the meaning of the Copyright Act, 1957, as alleged. The defendant is actually infringing the Plaintiff's copyrights. The defendant is put to strict proof of the averments made in para under reply."

4. It is further stated that besides, challenging the validity of the impugned Registrations of the Defendant in the afore

mentioned Paras, the Plaintiff has also taken other specific grounds challenging the validity of the impugned registrations. The details there of are furnished as under:

- i. The Plaintiff denied the averments of the Defendant regarding both the competing trademarks to be different [Para wise reply to Para 3 of preliminary objections @Pg. 2 of the Replication].*
- ii. The Plaintiff reiterated that both the competing trademarks/labels of the parties in question are identical with/deceptively similar [Para wise reply to Para 4 of preliminary objections @Pg. 2-3 of the Replication].*
- iii. The plaintiff reiterated that both the competing marks/labels of the parties in question are identical /deceptively similar [Para wise reply to Para 4 of preliminary objections @Pg. 2-3 of the Replication].*
- iv. The Plaintiff reiterated the possibility of confusion and deception in the market vis-à-vis use of impugned adoption and use of the defendant. [Para wise reply to Para 8 of preliminary objections @Pg. 4 of the Replication].*
- v. The Plaintiff reiterated that the defendant is guilty of infringement and passing off. [Para wise reply to Para 9 of preliminary objections @Pg. 5 of the Replication].*
- vi. The Plaintiff denied the alleged proprietorship of the defendant in the impugned Trademark [Para wise reply to Para 22 @Pg. 21 of the Replication].*
- vii. The Plaintiff reiterated the allegation of falsification, unfair and unethical trade practices, passing off, on the part of the defendant. [Para wise reply to Para 22 @Pg. 223 of the Replication].*

5. It is further stated that from the afore mentioned pleadings of the Plaintiff, it is apparent that the Plaintiff has taken sufficient ground assailing the invalidity of impugned rights of the defendant in the impugned registered Trademarks.

6. It is further stated that the plaintiff has already filed

cancellation petitions against registered trademarks of the Defendant before the IPAB which have now been transferred to IP Division of Hon'ble Hig Court of Delhi and renumbered as C.O. (COMM.IPD-TM) 9/2021 and C.O. (COMM.IPD-TM) 747/2022. Both matters are listed before the Hon'ble High Court of Delhi on 25.01.2023.

7. It is prayed that the issue regarding invalidity of the both of afore mentioned registered Trademarks of the Defendant namely 5 STAR of the Defendant under No.415314 and 496778 in 03 may kindly be framed.
8. Reply to the application was filed on behalf of the defendant. It is stated in the reply that the application filed by the Plaintiff is not maintainable and is liable to be dismissed as the Defendant is the lawful registered proprietor of the trademark 5 star under nos. 413314 and 496778 in class 3 and the same are rightly subsisting on the register.
9. It is further stated that the issue of invalidity has been already abandoned by the plaintiff upon withdrawal of the cancellation proceedings filed in the Hon'ble High Court of Delhi being C.O.(COMM.IPD-TM) 69/2021 and C.O. (COMMIFD-TM) 747/2022 vide order dated 21.4.2003. Such withdrawal was done by the Plaintiff after the filling of the application under reply and upon such withdrawal the present application has become infructuous. It is further stated that the withdrawal was done by the Plaintiff after some arguments on merits in the said petitions before the Hon'ble

High Court of Delhi and after the Hon'ble Court had indicated that the plaintiff's petition had no merits. The Plaintiff having once withdrawn the cancellation petitions without seeking any leave under Order 23 Rule 1, is barred from raising the same issue again and in view of such legal bar the present application seeking framing of such issue is infructuous and is liable to be dismissed.

10. It is further stated that the application of the Plaintiff is even otherwise not maintainable as the Plaintiff had already without seeking the leave of this Hon'ble Court instituted two cancellation petitions before the erstwhile IPAB, which itself were time barred and such petitions when transferred to the Hon'ble High Court of Delhi were withdrawn on 21.4.23 when after some arguments, the Hon'ble High Court indicated that there were no merits in the cancellation petitions.
11. It is further stated that the application seeking the framing of issue of invalidity is even otherwise not maintainable in as much as the Plaintiff has not sufficiently pleaded the invalidity of the Defendant's registered trade mark(s) in the Replication and is relying upon mere evasive denials. The Plaintiff has been unable to demonstrate any prima facie tenability of the proposed issue and is thus not entitled to press for framing of the issue as sought for in the present application. It is prayed that the application may kindly be dismissed.
12. Ld. Counsel for the plaintiff states that the plaintiff

has moved the present application under Section 124 of the Trademarks Act 1999 since the present case squarely falls within the ambit of Section 124 (1)(b)(ii) wherein the defendant has taken a defence of Section 30(2)(e) in its written statement and the plaintiff has thereafter pleaded invalidity of the registration of the defendant's trademark in its replication.

13. Ld. Counsel for the plaintiff further states that this court while considering the plea of invalidity only has to take a prima facie view of the tenability of the same. The word tenable as used in Section 124(1)(ii) cannot be accorded too rigid an interpretation. Ld. Counsel for the plaintiff further states that in Patel Field Marshal Agencies, the Hon'ble Supreme Court has clearly held that the task of examining the merits, or otherwise, of the plea of invalidity, whether raised by the plaintiff or the defendant, is on the Court or authority which would deal with the rectification proceedings. Patel Field Marshal Agencies clearly requires the task of examining the merits of the plea of invalidity of the mark to be entirely discharged by the authority hearing the rectification. The suit court, even while holding the challenge to validity to be prima facie tenable and, consequently, adjourning the matter, is not, as per Patel Field Marshal Agencies, to enter into the merits of the plea. Ld. Counsel for the plaintiff relied upon the following rulings:-

1. Patel Field Marshal Agencies versus P.M. Diesels Ltd. (2018) 2 SCC 112.
 2. Dharampal Satyapal Limited versus Mr. Basant Kumar Makhija & Ors. 2023: DHC:7667.
 3. Izuk Impex v. Five Star Healthcare (P) Ltd. passed by Hon'ble High Court of Delhi in C.O.(COMM.IPD-TM) 69/2021 on 20.10.2022.
 4. Izuk Chemical Works v. Babu Ram Dharam Prakash (2007) 35 PTC 28.
 5. Casablanca Apparels Pvt. Ltd. v. Polo Lauren Company LP passed by Hon'ble High Court of Delhi in C.O. (COMM.IPD-TM) 68/2024 on 21.05.2024.
 6. Order dated 25.10.2025 passed by the Ld. District Judge (Commercial-02), South, Saket Court.
- 14.Ld. Counsel for the defendant states that during the pendency of the present suit, the plaintiff filed two cancellation petitions before the Intellectual Property Appellate Board, which were later on transferred to the Hon'ble High Court of Delhi bearing no.C.O. (COMM.IPD-TM) 69/2021 and C.O.(COMM.IPD-TM) 747/2022. Ld. Counsel for the defendant further states that on 21.04.2023, the Hon'ble High Court of Delhi after hearing some arguments on behalf of the parties, indicated that the plaintiff had no case for cancellation of defendant's registrations. Pursuant thereto, the plaintiff being the petitioner therein withdrew such petitions. Ld. Counsel for

the defendant further states that such withdrawal was without moving any application under Order 23 Rule 1 of the CPC and was on oral request of the counsel after having made "some submissions". Ld. Counsel for the defendant further states that while directing such rectification petitions to be "dismissed as withdrawn", no permission under Order 23 Rule 1(4) CPC or any other leave or liberty was granted to the plaintiff to pursue the present application to seek the framing of the issue as sought as the said issue is deemed to have been abandoned on the withdrawal of the Rectification petitions. The Plaintiff can no longer continue to pursue the claim the invalidity of the defendant's marks when the said claim is barred under the principles of Res Judicata and under the principles of Order 23 Rule 1 (4). In fact upon the passing of the Order dated 21.4.2023, the present application became infructuous and ought not to be pursued by the Plaintiff.

- 15.Ld. Counsel for the defendant further states that the Defendant further relies upon S.11 of the CPC and the judicial principle of "Constructive Res Judicata" to seek the dismissal of the Plaintiff's application under S. 124 practically seeking leave to reinstitute the rectification petition which rectification petitions admittedly were filed and were withdrawn before the Hon'ble High Court without being granted any permission as provided under

Order 23 Rule 1 (4) CPC. Ld. Counsel for the defendant further states that even otherwise, the claim of the plaintiff to seek invalidity of the defendant's registrations is time barred in as much as the Written Statement was filed by the Defendant in July, 2015 and despite such knowledge (which knowledge as per the Defendant was there even much prior to the filing of the suit) the Cancellation petition was not filed within the prescribed period of limitation. In the present case, the claim of invalidity of the Defendant's trademarks being raised now suffers from inordinate delay, laches and acquiescence.

16.Ld. Counsel for the defendant further states that further, even on merits the plaintiff has not been able to establish any prima facie tenability of its claim to seek invalidity of the Defendant's Trade mark Registrations under nos. 415314 and 495778 in Class 3 registered since 1983 & 1988 respectively as the alleged marks of the Plaintiff being labels of MOON STAR, MOON & STAR and/or MOONSTAR are totally different and distinct from the mark 5 STAR of the Defendant. Mere vague and baseless pleading of invalidity in the Replication does not entitle the Plaintiff to seek prima facie tenability of its plea. No sufficient pleadings qua invalidity justifying framing of an issue exist on record. Ld. Counsel for the defendant relied upon the following rulings:-

1. VIP Pharmaceuticals Pvt. Ltd. vs. Rhydburg

Pharmaceuticals Ltd. 2024 SCC Online Del 6425

2. MJ Exporters v. UOI 2021 13 SCC 543.
3. Khoday Distilleries Ltd. v. The Scotch Whiskey Association 2008 (9) Scale 40.
17. Arguments heard. Record perused and considered.
18. Section 124 of Trade Mark Act, 1999 reads as under:-

Section 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 defence 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 plaintiff's or defendant's trade mark are pending before the Registrar or the ¹[High Court], 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 ¹[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 so 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 in so far 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.

19. The case in hand is covered by clause (b) of Section 124 (1) of Trade Mark Act, 1999 as the defendant has raised a defence under clause (e) of sub-section 2 of Section 30 that defendant is the registered proprietor of the Trade Mark '5 STAR' under number 415314 and 495778 in Class 3 and the plaintiff has pleaded the invalidity of the registration of the defendant's trademark. The question arises whether the plea of the plaintiff regarding invalidity of the registration of the defendant's trademark '5 STAR' under number 415314 and 495778 in Class 3 is *prima facie* tenable. Considering the material on record this court is satisfied that the plea regarding invalidity of registration

of defendant's trademark is *prima facie* tenable and raises a issue regarding the same.

20. The contention of Ld. Counsel for the defendant that though, the Hon'ble High Court of Delhi vide its order dated 21.04.2023 allowed the plaintiff to withdraw its cancellation petition, however, no permission under Order 23 Rule 1(4) CPC was granted to the plaintiff, therefore, plaintiff cannot raise the issue of invalidity of the defendant's trademark before this court by way of application in hand. This contention has no substance because the Hon'ble High Court of Delhi has allowed the plaintiff to withdraw its petition without prejudice to its rights and contentions, therefore, it cannot be said that the plaintiff cannot file the application in hand challenging the validity of the defendant's trademark. The application in hand is neither barred by Order 23 Rule 1(4) CPC nor by the Principle of Res Judicata as issue of invalidity of defendant's trademark has not been decided by any court till date.

21. The further contention of the Ld. Counsel for the defendant that the written statement was filed by the defendant in the month of July, 2015 and despite coming to know that defendant is registered proprietor of trademark 5 STAR the plaintiff has not taken any steps for about eight years and moved the application in hand on 02.05.2023 and therefore, the same is also barred by limitation. This

contention has also no substance because Section 124 of Trade Mark Act does not provide any period of limitation to the raise the issue of invalidity of registration of trademark.

22. The rulings relied upon by the Ld. Counsel for the defendant are not applicable to the facts of the case in hand. The rulings *VIP Pharmaceuticals Pvt. Ltd. vs. Rhydburg Pharmaceuticals Ltd.* (supra) and *MJ Exporters v. UOI* (supra) pertain to Order 23 Rule 1(4) CPC. However, as discussed above Order 23 Rule 1(4) CPC is not applicable as Hon'ble High Court of Delhi has allowed the plaintiff to withdraw its petition without prejudice to its right and contentions.

23. In view of the above discussions, the application U/s 124 Trade Mark Act r/w Section 151 CPC is allowed.

**Announced in the open Court on
this 7th day of November, 2025**

**(PRITAM SINGH)
District Judge-04/South-East
Saket/Delhi**