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

+ CS(COMM) 361/2018, I.A. 4575/2005 & I.A. 16151/2023

NADEEM MAJID OOMERBHOY ..... Plaintiff

Through: Mr. Tahir Ashraf Siddiqui and  
Mr. Ashirvad Kr. Yadav, Advs.

versus

SH. GAUTAM TANK AND ORS ..... Defendants

Through: Mr. G.D. Bansal, Mr. Rohan  
Swarup, Mr. Kunal Vats and Mr. Sanyam  
Suri, Advs.

Ms. Swathi Sukumar and Mr. Kaustubh  
Shakkarwar, learned *amici curiae*

**CORAM:**

**HON'BLE MR. JUSTICE C.HARI SHANKAR**

**JUDGMENT(ORAL)**

**11.09.2023**

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1. A strange and unprecedented situation has arisen before this Court in the present case, for which no ready solution appears to be available, either in statute or in precedent. With the valuable aid and assistance of learned *amici curiae* Ms. Swathi Sukumar and Mr. Kaustubh Shakkarwar, the Court has attempted to work out a via media, which appears, to the Court, to conform to the statutory dictates and also ensure justice to the parties. The Court expresses, at the outset, its gratitude to the learned *amici* for the assistance rendered by them.

2. This is an 18-year-old suit in which, owing to circumstances for



which no one can really be said to be responsible, an application dated 29 April 2004, filed by the defendants for registration of the impugned word mark SUPER POSTMAN has come to be allowed by the Trade Marks Registry after 19 years, on 13 February 2023. At the time when the suit was filed, the application of the defendants, seeking registration of the impugned mark, was pending with the Trade Marks Registry, and a specific assertion to that effect is to be found in the replication filed by the plaintiff. The application came to be allowed, and the mark registered, on 13 February 2023. Though this fact is not reflected in the plaint, written statement or replication, by way of any suitable amendment, it has come on record in IA 15906/2023, filed by the plaintiff under Section 124<sup>1</sup> of the Trade Marks Act, 1999. It cannot, therefore, be ignored, though Mr. Siddiqui, learned Counsel for the plaintiff, would exhort the Court to do so.

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<sup>1</sup> 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 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 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.



3. The plaintiff, in the suit, alleges that, by using the mark SUPER POSTMAN, in respect of edible groundnut oil, the defendants are infringing the registered trademark of the plaintiff, which is POSTMAN, also used for edible groundnut oil. Allegations of using a deceptively similar trade dress have also been levelled.

4. Consequent to the registration of the SUPER POSTMAN word mark in favour of the defendants on 13 February 2023, the plaintiff filed IA 15906/2023 under Section 124(1)(b) of the Trade Marks Act, questioning the validity of the registration granted to the defendants and seeking framing of an issue in that regard and adjournment of the suit so that the plaintiff could file rectification proceedings against the grant of the registration to the defendants' SUPER POSTMAN trademark.

5. In doing so, however, the plaintiff failed to notice the fact that, before a Court can proceed to frame any issue on the challenge to the defendants' trade mark by the plaintiff or adjourn the suit in order to enable the plaintiff to challenge the defendants' trademark by way of rectification proceedings, Section 124 envisages a specific protocol. Section 124(1) applies where there is a pending suit for infringement of a trademark. Clause (b) thereof, *envisages, in the first instance, the defendant raising a defence under Section 30(2)(e)*<sup>2</sup>. *If such a defence*

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<sup>2</sup> 30. Limits on effect of registered trade mark.—

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(2) A registered trade mark is not infringed where –

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(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.



*is raised*, and the plaintiff pleads invalidity of the registration granted to the defendant, *then* Section 124(1)(ii) requires the Court to examine whether the challenge, by the plaintiff, to the defendant's trademark is tenable. If the Court finds that the challenge is tenable, the Court is required to frame an issue in that regard and adjourn the suit by three months in order to enable the plaintiff to file a rectification proceeding challenging the defendant's trademark.

6. The entire exercise has, therefore, to commence with a defence being raised by the defendant under Section 30(2)(e) of the Trade Marks Act. In other words, the defendant should, in its written statement or elsewhere, take a defence that, as its trademark is registered, the defendant cannot be held to have infringed the plaintiff's registered trade mark. The registration of the defendants' trade mark must, therefore, be pleaded as a defence, by the defendants, for Section 124(1)(b) and, along with all its statutory sequelae, to apply.

7. Absent a Section 30(2)(e) defence on the part of the defendants, therefore, the portals of Section 124 stand firmly barred to the plaintiff.

8. When IA 15906/2023 came up for hearing before this Court on 22 August 2023, Mr. G.D. Bansal, learned Counsel for the defendants, pointed out that no defence under Section 30(2)(e) has been taken by him. On a perusal of the record, this position is found to be correct, as the written statement was filed at a stage when the defendants' mark was as yet unregistered and there is no further pleading by the



defendants, after they have secured registration of the impugned SUPER POSTMAN mark, relying on the registration in its defence.

9. No defence under Section 30(2)(e) having been taken by the defendants, the question of proceeding further with Section 124 would not arise. The application under Section 124, having been filed even without a defence being taken by the defendants under Section 30(2)(e) was, therefore, fundamentally misconceived and was accordingly dismissed *vide* order dated 22 August 2023.

10. Having done so, however, the Court was faced with a quandary.

11. Section 29 of the Trade Marks Act specifically envisages, in each of its clauses, infringement only by a person who is *not* the holder of a registered trademark. Section 30(2)(e) also clearly holds that use of a trademark which is registered would not amount to infringement. The fact that the defendants' trademark is registered is now part of the record and the Court cannot possibly shut its eyes to this fact.

12. By operation of Section 23(1)<sup>3</sup> of the Trade Marks Act, the registration of the SUPER POSTMAN trademark granted to the defendants dates back to 29 April 2004 which was the date of

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<sup>3</sup> 23. **Registration.** –

(1) Subject to the provisions of Section 19, when an application for registration of a trade mark has been accepted and either –

(a) the application has not been opposed and the time for notice of opposition has expired; or

(b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the Central Government otherwise directs, register the said trade mark within eighteen months of the filing of the application and the trade mark when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of Section 154, be deemed to be the date of registration.



application. The defendants' SUPER POSTMAN trademark is, thus, deemed to be registered with effect from 29 April 2004, i.e., even prior to the filing of the present suit.

**13.** The statutory mandate, contained in Section 29 and Section 30(2)(e), is perfectly clear. Infringement, per Section 29, can only be by a person who is *not* the holder of a registered trademark. Also, per Section 30, use of a trademark, by virtue of the registration granted to it, can never be infringement, even if it is identical to an existing trademark. In a sense, Sections 29 and 30(2)(e) are alter egos of one another.

**14.** As such, any finding by the Court, that the defendants are infringing the plaintiff's registered trademark, would be a clearly illegal order, and in the teeth of Section 29(1) and Section 30(2)(e) of the Trade Marks Act.

**15.** Mr. Siddiqui, learned Counsel for the plaintiff sought to submit that, as the defendants have, before this Court, on 22 August 2023, clearly said that it was *not* raising a Section 30(2)(e) defence, the Court could proceed to decide the issue of infringement ignoring the fact of the registration of the word mark SUPER POSTMAN, granted to the defendants on 13 February 2023.

**16.** I cannot agree.

**17.** To my mind, *there is a complete proscription on a Court passing an order which it knows to be illegal.* A Court cannot



consciously pass an illegal order. The plaintiff seeks an injunction against the defendants on the premise that the defendants are infringing the plaintiff's registered trade mark POSTMAN, by using the mark SUPER POSTMAN. Mr. Siddiqui presses the claim. No order, as sought by the plaintiff, can be passed by this Court so long as the defendants continue to remain holder of a registration in respect of the impugned mark SUPER POSTMAN. To grant the reliefs sought in the plaint, therefore, the Court would, necessarily have to hold, in the first instance, that the registration of the mark SUPER POSTMAN, as granted to the defendants on 13 February 2023, is invalid. Else, the Court would be returning a finding of infringement against the holder of a registered trade mark, which, as already noted, Section 29 and Section 30(2)(e) completely proscribe.

**18.** In the understanding of this Court, Section 29(1) and Section 30(2)(e) are not dependent on a defence being taken by the defendant. They set out a legal position, which is that infringement can only be by a person who is not the holder of a registered trademark and that the use of a registered trademark can never amount to infringement even if it is identical to an earlier existing trademark. Any finding of infringement by the holder of a registered trademark is, therefore, *per se* illegal and unknown to the Trade Marks Act. Needless to say, therefore, the plea of Mr. Siddiqui that, in view of the statement made by Mr. Bansal on 22 August 2023, the Court can go ahead and return a finding of infringement against the defendants, even though the defendants' trademark is registered, by ignoring the fact of such registration cannot, therefore, sustain for an instant.



19. Section 28(3)<sup>4</sup> is also relevant in this context, as it disentitles the holder of a registered trademark from claiming exclusivity in respect thereof, against a person who is also the registrant of an identical, or deceptively similar, trademark. The right conferred by Section 28(1), on the plaintiff, as the holder of a registered trademark, to obtain relief against infringement thereof is, therefore, subject to the exception contained in Section 28(3), where the allegedly infringing mark is also registered in favour of the defendant. One may refer, in this context, to para 27 of the judgment of the Supreme Court in *S. Syed Mohideen v. P. Sulochana Bai*<sup>5</sup>, which reads thus:

“27. Sub-section (3) of Section 28 with which we are directly concerned, contemplates a situation where two or more persons are registered proprietors of the trade marks which are identical with or nearly resemble each other. It, thus, postulates a situation where same or similar trade mark can be registered in favour of more than one person. On a plain stand-alone reading of this Section, it is clear that the exclusive right to use of any of those trade marks shall not be deemed to have been acquired by one registrant as against other registered owner of the trade mark (though at the same time they have the same rights as against third person). Thus, between the two persons who are the registered owners of the trade marks, there is no exclusive right to use the said trade mark against each other, which means this provision gives concurrent right to both the persons to use the registered trade mark in their favour. *Otherwise also, it is a matter of common sense that the plaintiff cannot say that its registered trade mark is infringed when the defendant is also enjoying registration in the trade mark and such registration gives the defendant as well right to use the same, as provided in Section 28(1) of the Act.*”

(Emphasis supplied)

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<sup>4</sup> 28. **Rights conferred by registration.**—

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(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

<sup>5</sup> (2016) 2 SCC 683





**20.** As such, in the knowledge of the fact that the defendants are the holder of a registered trademark and that the registration dates back to 29 April 2004, the Court cannot today hold the defendants to be infringing the plaintiff's trademark unless the Court finds the registration of the defendants' trademark to be invalid.

**21.** Inasmuch as a specific issue regarding infringement already stands framed by this Court on 1 December 2008 and the plaintiff is pressing its case of infringement against the defendants, the Court has necessarily to examine the issue of validity of the defendants' trade mark.

**22.** That exercise cannot, however, be carried out under Section 124, as already noted, the defendants have not raised a specific defence under Section 30(2)(e), thereby disentitling the plaintiff to the benefit of the said provision.

**23.** At the same time, it would be wholly iniquitous to deny, to the plaintiff, a chance to question the validity of the registration of the SUPER POSTMAN mark in favour of the defendants. Inasmuch as the said registration, if valid, acts as an insurmountable hurdle to the plaintiff securing any relief against infringement, the plaintiff has necessarily to be afforded an opportunity to question the validity of the said registration, if the scales of justice are to remain equipoised.

**24.** The Court has also examined the judgment of the Supreme Court in *Patel Field Marshal Agencies v. P.M. Diesels Ltd.*<sup>6</sup>, which contains a detailed analysis of Section 111 of the Trade and

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<sup>6</sup> (2018) 2 SCC 112



Merchandise Marks Act, 1958 which is *pari materia* with Section 124 of the Trade Marks Act, 1999, to see if some guidance could be obtained therefrom. The decision does not, however, unfortunately, seem to help in the peculiar facts which are before this Court.

25. The Court, in *Patel Field Marshal Agencies*<sup>6</sup>, framed the issue arising before it thus:

“In a situation where a suit for infringement is pending wherein the issue of validity of the registration of the trade mark in question has been raised either by the plaintiff or the defendant and no issue on the said question of validity has been framed in the suit or if framed has not been pursued by the party concerned in the suit by filing an application to the High Court for rectification under Section 111 read with Section 107 of the Trade and Merchandise Marks Act, 1958, whether recourse to the remedy of rectification under Sections 46/56 of the 1958 Act would still be available to contest the validity of the registration of the trade mark.”

26. Paras 28 to 34 of *Patel Field Marshal Agencies*<sup>6</sup>, which contain its *ratio decidendi*, may be reproduced thus:

“28. *In cases where in a suit for infringement of a registered trade mark the validity of the registration of the trade mark is questioned either by the plaintiff or by the defendant*, Section 107 of the 1958 Act provides that an application for rectification shall be made to the High Court and not to the Registrar notwithstanding the provisions contained in Section 46 or Section 56 of the 1958 Act. This would seem to suggest that in such cases (where a suit for infringement is pending) the legislative scheme is somewhat different.

29. The above seems to become more clear from what is to be found in Section 111 of the 1958 Act which deals with “stay of proceedings where the validity of registration of the trade mark is questioned”. The aforesaid provision of the 1958 Act specifically provides that if a proceeding for rectification of the register in relation to the trade mark of either the plaintiff or the defendant is pending before the Registrar or the High Court, as may be, and a suit for infringement is filed wherein the aforesaid plea is raised either by the defendant or by the plaintiff, the suit shall remain stayed. *Section 111 further provides that if no proceedings for rectification are pending on the date of filing of the suit and the issue of validity of the registration of the plaintiff's or the*



*defendant's trade mark is raised/arises subsequently and the same is prima facie found to be tenable, an issue to the aforesaid effect shall be framed by the civil court and the suit will remain stayed for a period of three months from the date of framing of the issue so as to enable the party concerned to apply to the High Court for rectification of the register.* Section 111(2) of the 1958 Act provides that in case an application for rectification is filed within the time allowed the trial of the suit shall remain stayed. Sub-section (3) of Section 111 provides that in the event no such application for rectification is filed despite the order passed by the civil court, the plea with regard to validity of the registration of the trade mark in question shall be deemed to have been abandoned and the suit shall proceed in respect of any other issue that may have been raised therein. Sub-section (4) of Section 111 provides that the final order as may be passed in the rectification proceeding shall bind the parties and the civil court will dispose of the suit in conformity with such order insofar as the issue with regard to validity of the registration of the trade mark is concerned.

30. Following well-accepted principles of interpretation of statutes, which would hardly require a reiteration, the heading of Section 111 of the 1958 Act i.e. “Stay of proceedings where the validity of registration of the trade mark is questioned, etc.”, cannot be understood to be determinative of the true purport, intent and effect of the provisions contained therein so as to understand the said section to be contemplating only stay of proceedings of the suit where validity of the registration of the trade mark is questioned. Naturally, the whole of the provisions of the section will have to be read and so read the same would clearly show lack of any legislative intent to limit/confine the operation of the section to what its title may convey.

31. Rather, from the résumé of the provisions of the 1958 Act made above, it becomes clear that all questions with regard to the validity of a trade mark is required to be decided by the Registrar or the High Court under the 1958 Act or by the Registrar or the IPAB under the 1999 Act and not by the civil court. The civil court, in fact, is not empowered by the Act to decide the said question. Furthermore, the Act mandates that the decisions rendered by the prescribed statutory authority [Registrar/High Court (now IPAB)] will bind the civil court. At the same time, the Act (both old and new) goes on to provide a different procedure to govern the exercise of the same jurisdiction in two different situations. In a case where the issue of invalidity is raised or arises independent of a suit, the prescribed statutory authority will be the sole authority to deal with the matter. However, in a situation where a suit is pending (whether instituted before or after the filing of a rectification application) the exercise of jurisdiction by the



prescribed statutory authority is contingent on a finding of the civil court as regards the prima facie tenability of the plea of invalidity.

32. Conversely, in a situation where the civil court does not find a triable issue on the plea of invalidity the remedy of an aggrieved party would not be to move under Sections 46/56 of the 1958 Act but to challenge the order of the civil court in appeal. This would be necessary to avoid multiple proceedings on the same issue and resultant conflict of decisions.

33. The 1958 Act clearly visualises that though in both situations i.e. where no suit for infringement is pending at the time of filing of the application for rectification or such a suit has come to be instituted subsequent to the application for rectification, it is the Registrar or the High Court which constitutes the tribunal to determine the question of invalidity, the procedure contemplated by the statute to govern the exercise of jurisdiction to rectify is, however, different in the two situations enumerated. Such difference has already been noted.

34. The intention of the legislature is clear. All issues relating to and connected with the validity of registration has to be dealt with by the Tribunal and not by the civil court. In cases where the parties have not approached the civil court, Sections 46 and 56 provide an independent statutory right to an aggrieved party to seek rectification of a trade mark. However, in the event the civil court is approached, inter alia, raising the issue of invalidity of the trade mark such plea will be decided not by the civil court but by the Tribunal under the 1958 Act. The Tribunal will however come into seisin of the matter only if the civil court is satisfied that an issue with regard to invalidity ought to be framed in the suit. Once an issue to the said effect is framed, the matter will have to go to the Tribunal and the decision of the Tribunal will thereafter bind the civil court. If despite the order of the civil court the parties do not approach the Tribunal for rectification, the plea with regard to rectification will no longer survive.”

(Emphasis supplied)

27. It is important to note that, in *Patel Field Marshal Agencies*<sup>6</sup>, the Supreme Court was concerned *with a challenge, by the defendant, to the validity of the plaintiff's trademark*. As such, the question of application of Section 30(1)(d) of 1958 Act [equivalent to the present Section 30(2)(e)], as a defence raised by the defendant, never arose for consideration. *Patel Field Marshal Agencies*<sup>6</sup>, therefore, dealt with a



situation in which the ingredients of Section 111 of the 1958 Act stood satisfied and, therefore, the provision applied. The decision cannot, therefore, be taken to be an authority for the proposition that, even without the defendant taking a Section 30(2)(e) in the first instance, the plaintiff could, by straightaway challenging the validity of the defendant's registration, galvanize Section 124 into action.

**28.** The principle, which has its roots in *Taylor v. Taylor*<sup>7</sup> and which stands reiterated, thereafter, times without number including, classically, by the Privy Council in *Nazir Ahmed v. King Emperor*<sup>8</sup> and by the Supreme Court in *Singhara Singh v State of U.P.*<sup>9</sup>, that, where the statute requires a thing to be done in a particular manner, that thing must be done in that manner alone, or not done at all, all other modes of doing that thing being necessarily forbidden, may be regarded, by now, as fossilised in legal lore. Equally well-settled are the principles that the precedential value of a pronouncement of the Supreme Court, under Article 141 of the Constitution of India, has to be assessed in the light of the facts, and the issue with which the Supreme Court was concerned<sup>10</sup>, and that judgments of the Supreme Court are not to be likened to theorems of Euclid<sup>11</sup>.

**29.** The Supreme Court was essentially concerned, in *Patel Field Marshal*<sup>6</sup>, with the issue of the appropriate authority which could examine the issue of validity of the trademark under challenge,

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<sup>7</sup> (1875) 1 Ch D 426

<sup>8</sup> AIR 1936 PC 253

<sup>9</sup> AIR 1964 SC 358

<sup>10</sup> Refer *Director of Settlements v. M.R. Apparao*: (2002) 4 SCC 638

<sup>11</sup>Refer *Haryana Financial Corporation v. Jagdamba Oil Mills*, (2002) 3 SCC 496 ; *Indian Oil Corporation Ltd. v. Shree Ganesh Petroleum* , (2022) 4 SCC 463 ; *Madras Bar Association v. U.O.I.*, (2022) 12 SCC 455, *Chintels India Ltd. v. Bhayana Builders Pvt. Ltd.*, (2021) 4 SCC 602



whether of the plaintiff or of the defendant, where an infringement suit already stood filed. The Supreme Court ultimately held that it would be the Tribunal – which was, by the time the Supreme Court passed the judgment, the Intellectual Property Appellate Board (IPAB) – which alone could examine and decide the issue.

**30.** With the enactment of the Tribunals Reforms Act, 2021 the power of the learned IPAB to decide rectification petitions is now exercised by this Court.

**31.** The learned *amici* are *ad idem* that the Court cannot shut its eyes to the fact that the defendants have registration of the impugned SUPER POSTMAN trademark, in the face of Sections 28(3), 29 and Section 30(2)(e). They also agree that Section 124 would not apply as there is no specific defence taken by the defendants under Section 30(2)(e).

**32.** Learned *amici* have suggested that one way forward would be for this Court to exercise the jurisdiction vested in it by Section 57(4)<sup>12</sup> of the Trade Marks Act.

**33.** The plaintiff has already manifested its intention to question the validity of the registration of the defendants' SUPER POSTMAN trademark. That challenge, however, was raised under Section 124, which is not applicable in the facts of the present case. Inasmuch as such a challenge has specifically been raised, and Section 29(1) and

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<sup>12</sup> 57. Power to cancel or vary registration and to rectify the register.—

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(4) The Registrar or the High Court, as the case may be, of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).



Section 30(2)(e) proscribe the Court from returning any finding of infringement without in the first instance invalidating the defendants' registration, the Court is inclined to accept the suggestion of learned *amici* and to examine the validity of the defendants' trademark in exercise of the *suo motu* powers conferred on it by Section 57(4), which is vested in it independent of Section 124. I may refer, in this context, to para 26 of the judgment in *Jagatjit Industries Ltd. v. Intellectual Property Appellate Board*<sup>13</sup>:

“26. Secondly, the Division Bench of the High Court is also correct in reasoning that Section 125(1) would only apply to applications for rectification of the register, and not to the exercise of *suo motu* powers of the Registrar under Section 57(4). The reason is not hard to seek. If the Registrar is barred from undertaking a *suo motu* exercise under Section 57(4) to maintain the purity of the register, there could conceivably be cases where a defendant, after raising the plea of invalidity in a suit for infringement, chooses not to proceed with the filing of a rectification petition before the Appellate Board. This may happen in a variety of circumstances: for example, take the case where, after raising the plea of invalidity in a suit for infringement, the matter is compromised and the defendant therefore does not file a rectification petition before the Appellate Board. The Registrar's power to maintain the purity of the register of trade marks would still remain intact even in such cases, as has been held by the judgment in *Hardie case*<sup>14</sup>.”

**34.** In that view of the matter, list this matter on 31 October 2023 to hear both sides on the aspect of validity of the registration granted to the defendants' SUPER POSTMAN trademark on 13 February 2023. As Mr. Bansal, learned Counsel for the defendants is present, this order shall be treated as notice to him, as envisaged by Section 57(4).

**35.** In the meanwhile, both sides are directed to place on record notes or submissions regarding the validity of the registration of the

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<sup>13</sup> (2016) 4 SCC 381

<sup>14</sup> Refer *Hardie Trading Ltd. v. Addisons Paint & Chemicals Ltd.*, (2003) 11 SCC 92





trademark SUPER POSTMAN as granted to the defendants on 13 February 2023.

**36.** The Registry is also directed to requisition the file wrapper and record of Application No. 1281470 filed by the defendants which culminated in the grant of registration to the defendants of the SUPER POSTMAN mark on 13 February 2023.

**37.** It is made clear that the Court is calling for the record only so as to expedite matters and would refer to it only should the need arise, after considering the grounds of challenge which the plaintiff may seek to urge.

**38.** Re-notify on 31 October 2023.

**C.HARI SHANKAR, J**

**SEPTEMBER 11, 2023**

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