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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
Ms. Ria Dhawan, Advs.

versus

SH. GAUTAM TANK AND ORS Defendants

Through: Mr. G.D. Bansal, Mr. Arnav
Goyal, Mr. Rohan Swarup and Mr. Sanyam,
Advs.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

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ORDER
06.09.2023

1. Orders in this matter were reserved for being pronounced on 11 September 2023. During the course of study of the record, the Court has come across an interesting issue.

2. The defendants' SUPER POSTMAN mark was not registered at the time when the suit was filed by the plaintiff. During the course of the pendency of the suit, the defendants' mark got registered. The plaintiff moved IA 15906/2023 under Section 124(1) of the Trade Marks Act, 1999, assailing the validity of the defendants' mark, seeking framing of the issue in that regard and adjournment of the suit by three months in order to enable the plaintiff to challenge the defendants' mark by way of rectification proceedings.

3. When the said application came up for hearing, the defendants pleaded that, prior to the plaintiff challenging the validity of the defendants' mark, Section 124(1)(b) requires the defendants to, in the first instance, raise a defence under Section 30(2)(e), by pleading



registration of the impugned  as a defence  : alleged infringement. Learned Counsel for the defendants submitted that as he is not pleading the registration of his mark as a defence against the plaintiff's infringement suit, but is only raising non-user of the plaintiff's mark as a ground to oppose the suit, Section 124 would not apply. Recording the said statement, the Section 124 IA 15906/2023 was dismissed by this Court *vide* order dated 22 August 2023.

4. Subsequently, arguments were finally heard and the suit was reserved for orders to be pronounced on Monday.

5. After reserving orders, however, I have had my doubts as to whether the Court can ignore the fact of registration of the defendant's mark, even if the defendant does not specifically raise a defence under Section 30(2)(e), as the fact of registration of the defendant's mark is now part of the record, having been disclosed in IA 15906/2023. If the defendant's registration is to be taken into account, the Court is proscribed, under Section 28(3) from granting an injunction to the plaintiff on the ground of infringement. That, however, would result in a situation in which, while the defendant's registration would act against the plaintiff in the matter of obtaining an injunction, the plaintiff would stand foreclosed from challenging the defendant's mark as the Section 124 application was not maintainable.

6. One possible solution which suggested itself to me was that the plaintiff can independently challenge the defendant's registration under Section 57 of the Trade Marks Act. Whether the plaintiff can do so, however, would have to be decided after appreciating the law laid down by the Supreme Court in *Patel Field Marshal Agencies v. P.M.*

Diesels Ltd¹.



7. As this issue is somewhat intricate, I have requested Ms. Swathi Sukumar and Mr. Kaustubh Shakkwar, learned Counsel who are present in the Court, to assist the Court in this regard.

8. Let a copy of this order be provided to Ms. Swathi Sukumar and Mr. Kaustubh Shakkwar, so that they could provide their suggestions on 11 September 2023. The Court Master is also directed to intimate learned Counsel for the parties of this order and email the order to both of them.

C.HARI SHANKAR, J

SEPTEMBER 6, 2023

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¹ (2018) 2 SCC 112
CS(COMM) 386/2023