

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

COMMERCIAL MISCELLANEOUS PETITION NO. 27 OF 2022

Samata Lok Sansthan Trust

...Petitioner

Versus

Institute for Technology and Management Trust
and Anr.

...Respondents

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 105 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 104 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 120 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 117 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 152 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 59 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 543 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 875 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 880 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 890 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 901 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 909 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 926 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 927 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 932 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 102 OF 2022

WITH
LEAVE PETITION NO. 211 OF 2015
 WITH
LEAVE PETITION NO. 228 OF 2015
 WITH
NOTICE OF MOTION NO. 512 OF 2016
 WITH
NOTICE OF MOTION NO. 33 OF 2015
 IN
COMMERCIAL IP SUIT NO. 102 OF 2015
 WITH
COMMERCIAL MISCELLANEOUS PETITION NO. 1296 OF 2022

- Mr. Hiren Kamod a/w Mr. Nishad Nadkarni, Mr. Aasif Navodia, Ms. Khushboo Jhunjhunwala, Ms. Jaanvi Chopra and Ms. Rakshita Singh i/b Khaitan & Co., for the Petitioner.
- Mr. Shashank Sardesai i/b Bharati Aindley, for the Respondents/Plaintiff.

CORAM : MANISH PITALE, J.

DATE : 25th MARCH, 2025.

P. C. :

COMMERCIAL IP SUIT NO. 102 OF 2015

1. In the order dated 17th March 2025, this Court had referred to the judgment of the Supreme Court in the case of **Patel Field Marshal Agencies Ltd. v. P. M. Diesels Ltd.**,¹. The learned counsel appearing for the defendant relied upon the said judgment and submitted that this Court may frame an appropriate issue in the backdrop of the challenge raised on behalf of the defendant in the context of the registered trademarks of the plaintiffs i.e. ITM labels/logo marks. On the said date, a suggestion had come from the learned counsel for the plaintiffs that this Court may consider framing all the issues that would arise for consideration alongwith the issue being pressed on

1 (2018) 2 SCC 112

behalf of the defendant. In that light, this Court granted liberty to the learned counsel for the rival parties to exchange draft issues in order to assist this Court in framing all the issues. The proceedings were adjourned to today.

2. Today, the learned counsel for the plaintiffs is seeking short adjournment to place before this Court draft issues, which according to the plaintiffs, arise in the facts and circumstances of the present. In response, the learned counsel for the defendant submits that while other issues can be framed subsequently, this Court may consider framing the most crucial issue that arises in the present case, particularly in the backdrop of the fact that 17 rectification petitions filed on behalf of the defendant, in respect of the 17 registered labels/logo marks being asserted by the plaintiffs in the present proceedings, are held up and lying dormant in the absence of leave from this Court, as also in the absence of an appropriate issue being framed in that regard.

3. This Court finds substances in the contention raised on behalf of the defendant. Accordingly, this Court has considered the pleadings on record. The pleadings show that the plaintiffs are asserting proprietary rights in 17 ITM labels/logo marks. The details of registrations have been given in paragraph No.6 of the plaint in the form of a table.

4. In paragraph No.3 of the written statement, the defendant, has

incorporated specific pleadings. It is stated on behalf of the defendant while raising a challenge to the validity of the aforesaid registrations of the trademarks of the plaintiffs, *inter alia*, that ITM *per se* could not have been registered as a trademark and that several parties are using the alphabets/letters ITM and therefore, the trademarks of the plaintiffs could not have been registered. It is emphasized that on the basis of the registration of the label marks / logo marks of the plaintiffs, they are not entitled to claim exclusivity in “ITM.”

5. It is also specifically stated in the written statement that the defendant initiated the process of filing cancellation proceedings before the Intellectual Property Appellate Board (IPAB).

6. It is an admitted position that 17 rectification petitions were filed in the year 2015, which are pending consideration. But, in the light of the law laid down by the Supreme Court in the case of **Patel Field Marshal Agencies Ltd. v. P. M. Diesels Ltd., (supra)**, unless this Court frames an issue resulting in leave being granted to the defendant to pursue the rectification petitions, the same would remain dormant or in abeyance.

7. Considering the pleadings on record, this Court is satisfied that an issue can be framed as regards the question of validity of the registered label/logo marks of the plaintiffs.

8. Accordingly, the following issue is framed:
- “1. *Whether the Plaintiffs’ trade marks bearing registration Nos.1298324, 1311086, 1360718, 1452667, 919800, 919799, 974932, 1452666, 1733069, 1733071, 1733072, 1733073, 1733074 1733075, 1982946, 1982947 and 1733070 forming subject matter of the present suit are invalid?*”
9. As a consequence of framing of the above issue, in terms of Section 124 of the Trade Marks Act, 1999, further proceedings in the instant suit shall remain stayed until final disposal of the rectification petitions.
10. In the present case, the rectification petitions were filed in the year 2015, which were originally were filed before IPAB, but with the change of law and winding up of the IPAB, the petitions stood transferred to this Court and they have been renumbered. The advocates representing the parties are at liberty to inspect the record and to ensure that pleadings in the rectification petitions are complete. They are also granted liberty to set right the record of this Court in terms of pagination and incorporation of all the pleadings in the rectification petitions etc., so that when the rectification petitions are taken up for hearing, this Court is assisted in a proper manner.
11. List the rectification petitions for directions on 30th April, 2025.

(MANISH PITALE, J.)