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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
INTERIM APPLICATION NO. 2031 OF 2026
IN
COMMERCIAL (IP) SUIT NO. 230 OF 2015

1. Kothrud Mitra Newspapers Pvt. Ltd.
   having its office at S. No. 18/2,
   Sudarshan Park, Ingalenagar,
   Warje Octroi Post
   Karve Nagar, Pune-411 052.

2. Sunnjoy Manohar Dahake
   Publisher of Defendant No. 1,
   having his office at S. No.18/2
   Sudarshan Park, Ingalenagar,
   Warje Octroi Post, … Applicants
   Karve Nagar, Pune-411 052. (Org.Defendants)

RAJESHWARI RAMESH PILLAI
Digitally signed by RAJESHWARI RAMESH PILLAI
Date: 2026.10.21 19:22:17 +0530

IN THE MATTER BETWEEN

1. Metropolitan Media Company Ltd.
   A company incorporated under the
   Provisions of Companies Act 1956
   Having its registered office at No. 4,
   Pampa Mahakvai Road, Chamrajpet
   Bengaluru-560 018.

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2. Bennett Coleman and Company Limited
Public Limited company under the
Companies Act, 193, the Times of India
Building, Dr. D. N. Road, Mumbai-400 001

3. Lexicon Media Private Limited
S.No. 46/5, Aga Nagar Society,
Wadgaonsheri, Nagarroad,
Pune-411 014. …Plaintiffs

Vs.

1. Kothrud Mitra Newspapers Pvt. Ltd.
having its office at S. No. 18/2,
Sudarshan Park, Ingalenagar,
Warje Octroi Post
Karve Nagar, Pune-411 052.

2. Sunnjoy Manohar Dahake
Publisher of Defendant No. 1,
having his office at S. No.18/2
Sudarshan Park, Ingalenagar,
Warje Octroi Post,
Karve Nagar, Pune-411 052. … Defendants

Mr. Rashmin Khandekar a/w. Mr. Anand Mohan, Mr. Hardik Sampat, Ms. Charu Shukla, Ms.Kanan Soni i/b. Ms. Charu Shukla for the Plaintiffs.

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Mr. Jehaan Mehta a/w. Mr. Sujit Lahoti, Ms. Nidhi M. Jain i/b. M/s. Sujit Lahoti and Associates for the Defendants in COMIP/230/2015 and for the Applicant in IA/2031/2026.

CORAM : GAURI GODSE, J.

RESERVED ON : 21st JULY 2026

PRONOUNCED ON : 21st OCTOBER 2026

JUDGMENT :

1. When the suit was called out for final arguments, learned counsel for the plaintiffs submitted that the defendants have filed a rectification application before the Trade Mark Registry. He submitted that the application was wrongly filed before the Trade Mark Registry; however, only to bring on record the factual aspects noted by the plaintiffs, he mentioned it before the court.

2. Learned counsel for the defendants therefore prayed for time to file an application under Section 124 of the Trade Marks Act, 1999 ("Trade Marks Act") seeking a stay of further proceedings in the suit on the ground of pendency of the rectification applications under Sections 47 and 57 of the Trade Marks Act. The defendants were therefore granted time to take steps. Thereafter, the defendants filed this

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interim application seeking a stay of further proceedings in this suit till final disposal of their rectification application. In the alternative, the defendants prayed to raise an issue regarding the invalidity of the plaintiff's trade mark and to defer the suit for three months from the date of framing of an issue to enable them to apply to the appropriate forum for rectification of the register.

3. The suit is filed for permanent injunction restraining the defendants from directly or indirectly using and allowing any use of the trade marks “Pune Mirror” and “KM Kothrud Mirror” or any other mark similar and/or deceptively similar to the plaintiffs’ registered trade marks “Pune Mirror” and “Sunday Pune Mirror”. The plaintiffs have also prayed for an injunction restraining the defendants from using any other mark of the plaintiffs containing the word “Mirror”. The plaintiffs have further prayed for Rs. 100,00,00,000/- as damages for the alleged infringement of the plaintiffs’ registered trade marks.

4. To decide the defendants’ application, it is necessary to consider the rival pleadings and the issues involved in the suit.

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PLEADINGS IN THE PLAINT:

5. The plaintiffs claim rights in the registered trade marks, “Pune Mirror” and “Sunday Pune Mirror” as well as other registered “Mirror” formative trademarks such as “Mumbai Mirror”, “Sunday Mumbai Mirror”, “Ahmedabad Mirror”, “Bangalore Mirror on Saturday” and “Bangalore Mirror on Sunday”. The plaintiffs claim to have a non-exclusive license to use the word/mark “Mirror”, per se, for newspapers and related goods and services, including other “Mirror” formative marks bearing different city names.

6. The suit is filed to prevent the defendants from infringing and passing off by using the registered trade marks “Pune Mirror” and “Sunday Pune Mirror”. The plaintiffs claim to have the marks “Pune Mirror” and “Sunday Pune Mirror” registered in Class 9, Class 16, and Class 41 of the Fourth Schedule to the Trade Marks Rules. The plaintiffs pleaded the particulars of the websites by the title names of the registered trade marks and the particulars of the advertising and publications of the newspapers with the word “Mirror”. The plaintiffs have alleged that the defendants' adoption of the trademarks Pune Mirror and KM Kothrud Mirror caused

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confusion and deception in the minds of the public. According to the plaintiffs, the defendants adopted the impugned trade marks with the intent to commercially exploit and trade on the goodwill and reputation of the plaintiffs' “Mirror” trade marks.

PLEADINGS IN THE WRITTEN STATEMENT:

7. The defendants have filed the written statement and pleaded that the Registrar of Newspapers for India (“RNI”), being the constituted authority appointed by the Central Government under Section 19(a) of the Press and Registration of Books Act, 1867 (“the said PRB Act”), is vested with the powers of issuing a Certificate of Registration in respect of the newspapers. After receiving the declaration under Section 6 of the said PRB Act, the authority de-blocked the titles “Pune Mirror” and “Sunday Pune Mirror”, which were verified in the plaintiffs’ names on 24th January 2008. After the title verification, plaintiff no. 2 failed to file the requisite declaration and other compliances within the prescribed period; the titles were then blocked with effect from 25th January 2010 and 17th February 2010. The defendants thus pleaded that they filed an application for a declaration of title in their favour and that the title of “Pune

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Mirror" was approved in their favour. The defendants thus contended that they published Volume I, Issue I of Pune Mirror, a fortnightly newspaper and applied for registration of title.

8. Considering the defendants' compliance and the procedures for registration, a certificate of registration is issued in their favour in accordance with Section 19 of the said PRB Act. Plaintiff no. 2 applied under Section 8B of the PRB Act for cancellation of the defendant's title, "Pune Mirror". The defendants applied for a prohibitory order to stop the "Pune Mirror" supplement published by Plaintiff No. 2 and to stop the plaintiffs' registration process for the title "Pune Times Mirror". The defendants pleaded that Plaintiff No. 2 did not complete the registration process and that the RNI deblocked the plaintiff's title. Similarly, the plaintiff's other titles have also been deblocked; thus, the plaintiffs are not entitled to seek any relief based on the registered trade marks.

9. The defendants denied that the plaintiffs had registered the titles "Pune Mirror" and "Sunday Pune Mirror" in their own name under Class 16 of the Trade Marks Rules. The

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Registration Certificate of Marks “Pune Mirror” is in respect of Class 9 and 41. For Class 16, the plaintiffs relied on an application for registration dated 18th November 2008 bearing No. 1754729, for the mark “IDEA-I”. The defendants denied that the plaintiffs are publishing the newspaper “Pune Mirror”. The defendants relied upon the registration of “Pune Mirror” and “KM Kothrud Mirror” with the Registrar of Newspapers under the PRB Act.

SUBMISSIONS ON BEHALF OF THE DEFENDANTS:

10. Learned counsel for the defendants submitted that the plaintiffs have not been using the trade marks continuously and exclusively. Hence, in view of the lack of bona fide use of the trade marks and the defendants’ continuous, exclusive, and uninterrupted use of the title “Pune Mirror”, the plaintiffs are not entitled to seek any injunction or damages against the defendants.

11. According to the defendants, the registration of the plaintiffs' trade mark is ex facie invalid, illegal and not bonafide. Hence, the defendants have filed an application for rectification/cancellation of the trade mark before the Trade Marks Registry on the ground of no bonafide use for a

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continuous period of five years. The defendants have relied on three rectification applications. One rectification application is dated 16th March 2024 in respect of the plaintiffs' trade mark "Pune Mirror" in Class 41, the second rectification application filed on 27th September 2023 in respect of the plaintiffs' trade mark "Sunday Pune Mirror" in Class 16 and the third rectification application dated 22nd July 2024 in respect of the plaintiffs' trade mark "Sunday Pune Mirror" in Class 41. It is therefore submitted on behalf of the defendants that the plaintiff's trade marks are invalid and, since the proceedings are pending, the suit must be stayed under Section 124 of the Trade Marks Act.

12. To support his submissions, learned counsel for the defendants relied on this Court's decision in ***Franco India Pharmaceuticals Private Limited vs. Corona Remedies Private Limited***[1] ("***Franco India Pharmaceuticals***"). He submitted that this Court has discussed the decision of the Apex Court in ***Patel Field Marshal Agencies and Another vs. P. M. Diesels Limited and Others***[2], ("***Patel Field Marshal***"), emphasising that the Court would refuse to frame an issue under Section 124 of the Trade Marks Act only in a situation

1 2025 SCC OnLine Bom 1007
2 (2018) 2 SCC 112

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to further the cause of justice by eliminating false, frivolous and untenable claims of invalidity. This Court has taken a view that, for applying the position of law as held in ***Patel Field Marshal***, it was found in the facts of the case before this Court that the plea raised on behalf of the defendants did satisfy the lower prima facie case tests, and certainly it was not a case of false, frivolous and untenable claims regarding invalidity raised on behalf of the defendants. Learned counsel for the defendants submits that in view of the similar facts of this case, the view taken by this Court in ***Franco India Pharmaceuticals*** would squarely apply to stay further proceedings of the suit.

13. Learned counsel for the defendants submitted that in ***Patel Field Marshal*** the Apex Court held that in a situation where a suit inter alia raising the issue of validity of the trade mark is pending whether instituted before or after the filing of the rectification application, the exercise of jurisdiction by the prescribed authority is contingent on the findings of civil court as regards the prima facie tenability of the plea of invalidity. He therefore submitted that the Apex Court has held that the right to seek rectification under Sections 47 and 57 of the

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Trade Marks Act does not stand extinguished where, in a suit for infringement, a plea of invalidity is found to be prima facie tenable. It is held that the only difference is that, under Sections 47 and 57 of the Trade Marks Act, the aggrieved party can move the Registry for rectification, and in the latter situation, i.e. where the suit is pending, the Intellectual Property Appellate Board ("IPAB") alone has exclusive jurisdiction, to the exclusion of the Registry. Learned counsel for the defendants submitted that in view of the amendment, such an application would now lie before the High Court.

14. Learned counsel for the defendants relied upon the pleadings in paragraphs 4 and 5 of the written statement to support his submissions that non-use of the registered trade mark is a ground of invalidity. Hence, a plea can be raised at any time by filing an affidavit, as this Court held in ***Cipla Limited vs. Cipla Industries Pvt. Ltd. and Another***[3] ("***Cipla***"). He further submits that, even under Order XIV of the CPC, a plea can be raised to frame an issue on the invalidity of the plaintiffs' registered trade marks. In such an event, the defendants would be entitled to file an appropriate application before the High Court in accordance with law for

3 2014 SCC OnLine Bom 5107

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rectification, and, in such circumstances, the further proceedings in this suit must be stayed.

SUBMISSIONS ON BEHALF OF THE PLAINTIFFS:

15. Learned counsel for the plaintiffs opposes this application on the ground that it is malafide application filed at the fag end of the final arguments in the suit. Hence, the frivolous, untenable, and casual nature of the objection raised on behalf of the defendants shows a clear abandonment of any right to raise such a plea. The suit was filed on 27th January 2015, and the defendants filed their written statement on 14th June 2019. The issues were framed on 24th November 2020 and were recasted on 16th April 2024. The plaintiffs' affidavit of evidence was taken on record on 10th March 2022, and the defendants' evidence affidavit on 30th August 2023. Thereafter, the defendants amended the written statement on 30th April 2024. The evidence of both the parties was closed on 26th August 2025.

16. Learned counsel for the plaintiffs therefore submits that, by their conduct, the defendants have abandoned the plea of invalidity, if any. The defendants could have raised such a plea; however, they did not raise it until the final

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hearing of the suit. Hence, such a plea cannot be entertained at this stage. He further submits that the rectification applications filed by the defendants are bad in law. The contentions of non-use of the plaintiffs' trade marks are pleaded from 2009 and/or 20th January 2024 with reference to the registration under the PRB Act. Hence, the defendants have raised no fresh plea to seek a stay of the suit under Section 124. The allegation of non-user has been pleaded in the written statement. Hence, on this ground, the defendants cannot raise a fresh plea and seek a stay of the proceedings.

17. To support his submissions on the maintainability of such an application, learned counsel for the plaintiffs relied upon the decisions of the Apex Court in ***Kanwar Singh Saini vs. High Court of Delhi***[4] ("***Kanwar Singh Saini***"), ***Harshad Chiman Lal Modi vs. DLF Universal Ltd and Another***[5] ("***Harshad Modi***"), ***Kiran Singh and Others vs. Chaman Paswan and Others***[6] ("***Kiran Singh***"), ***M. Murali vs. Sri Krishna Sweets Private Limited*** ("***M. Murali***")[7], ***Country Inn Private Limited vs. Country Inns and Suites by Carlson, Inc and Anr.*** ("***Country Inn***")[8], and ***Hardie Trading Ltd. and***

4 (2012) 4 SCC 307
5 (2005) 7 SCC 791
6 (1954) 1 SCC 710
7 2020 SCC OnLine Mad 1070
8 2018 SCC Online Del 8549

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Another v. Addisons Paint and Chemicals Ltd. ("*Hardie Trading*")[9].

18. Learned counsel for the plaintiffs submitted that the post-suit rectification application can be filed only in the High Court. Hence, in the absence of a valid and proper application for rectification, the mere pendency of an application before an incompetent authority cannot be a ground to stay further proceedings. In the absence of basic foundational pleadings raising any ground of invalidity, there is no question of applying the provisions of Section 124 to stay further proceedings on the ground of pendency of an invalid application filed before the incompetent authority.

19. Learned counsel for the plaintiffs submitted that the plea of non-use in the present case is unsupported by any prima facie evidence and is a false and untenable plea that would not even fall within the category of a low-threshold plea. He therefore submits that an application under Section 124(1)(i) or any alternative prayer for framing issues and seeking adjournment under Section 124(1)(ii) is not available to the defendants. He further submitted that, in the absence of any specific plea, no question would arise of framing the

9 (2003) 11 SCC 92

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additional issue and permitting the defendants to file an appropriate application.

20. Learned counsel for the plaintiffs submitted that the plaintiffs have a strong case and are likely to succeed in the suit. Hence, to avoid a final decree in the suit, this is an attempt by the defendants to stall further hearing of the suit. Hence, learned counsel for the plaintiffs submitted that in the absence of any prima facie evidence of non-user or invalidity, the further proceedings of the suit cannot be stayed at this stage. Hence, the application be rejected, and the suit be heard on merits.

LEGAL POSITION:

21. In ***Patel Field Marshal***, the defendants (the appellants in the Apex Court) contested the plaintiff's (the respondents in Apex Court) claims on the ground of jurisdiction as well as on merits. In the written statement, the defendants also contested the validity of the registration of the plaintiff's trade mark "Field Marshal" and claimed that the same was liable to be rectified in the trade mark register. An issue to that effect was framed in the suit. The defendants had filed three rectification applications under Sections 46/56 of the Trade

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and Merchandise Marks Act, 1958 ("the 1958 Act") for removal and cancellation of the three trade marks registered in favour of the plaintiff. The learned Single Judge of the High Court of Gujarat dismissed the three applications; the Division Bench confirmed the order. The said orders were the subject matter of challenge in the Apex Court. The Apex Court observed that Sections 46, 56, 111 and 107 of the 1958 Act correspond to Sections 47, 57, 124 and 125 of the 1999 Act.

22. The Apex Court in ***Patel Field Marshal*** held that Section 111 of the 1958 Act (Section 124 of the 1999 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. It is further held 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

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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. It is held that sub-section (3) of Section 111 (Section 124(3) of the 1999 Act) provides that, if no such application for rectification is filed despite the order passed by the civil court, the plea regarding the validity of the registration of the trade mark in question shall be deemed abandoned.

23. In ***Franco India Pharmaceuticals***, this Court held that, while exercising jurisdiction under Section 124 of the Trade Marks Act, it must examine whether the claim of invalidity of the trade mark registration, raised on behalf of the defendant, is false, frivolous, and untenable. If the court is to reach the aforesaid conclusion, it must accept the contentions raised on behalf of the plaintiff, and such an issue cannot be framed. It is further held that if the defendant successfully passes the test of prima facie tenability of its plea regarding invalidity of the registration of the plaintiff's trade marks, such an issue will have to be framed. Thus, the pleadings must

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first be examined to determine whether the defendant has raised a specific plea regarding the invalidity of the registration of the plaintiff's trademark.

24. In ***Franco India Pharmaceuticals***, this Court referred to the legal principles laid down by the Full Bench of this Court in ***Lupin Ltd Vs Johnson and Johnson*** ("***Lupin***")[10]. Before the Full Bench, the question was whether the Court can consider the invalidity of the plaintiff's trade mark registration at an interlocutory stage when the defendant raises the defence of invalidity of registration in an infringement suit. The Full Bench concluded that the court has a limited window in such situations and would not be powerless to refuse to grant an injunction where the trade mark registration is found to be ex facie illegal, fraudulent, or shocking to the conscience of the court. By referring to the Full Bench's decision, this Court held that the Full Bench contemplates a very high threshold. But in discussing the scope of the Court's jurisdiction, the Full Bench referred to Section 124 of the Trade Marks Act and, in that context, used the expression low threshold prima facie case.

25. It is thus held by this Court in ***Franco India***

10 **2014 SCC OnLine Bom 4596**

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Pharmaceuticals that, as per the law laid down by the Full Bench, the test of prima facie tenability contemplated under Section 124(1)(b)(ii) of the Trade Marks Act is a low threshold prima facie case test. It is further held that it is lower than the prima facie case test a plaintiff must satisfy when pressing for interim reliefs before the court in the context of a rival having a registered trade mark. This Court thus held that while considering the question of framing an issue regarding the invalidity of a registered trade mark under Section 124(1)(b)(ii), the court has to apply a low threshold prima facie case test.

26. This Court, in ***Franco India Pharmaceuticals,*** thus concluded that, as per the law laid down by the Apex Court in ***Patel Field Marshal***, the court would refuse to frame an issue under Section 124 only in situations to further the cause of justice by elimination of false, frivolous, and untenable claims of invalidity. This Court therefore, by applying the well-settled position of law, found that in the facts and circumstances of the case, the plea raised on behalf of the defendant did satisfy the low threshold prima facie case test and it was certainly not a case of false, frivolous or untenable claims

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regarding invalidity being raised on behalf of the defendant. Accordingly, this Court framed the issue and stayed further proceedings in the suit, granting liberty to the defendant to pursue the rectification application in accordance with law.

27. In ***Cipla***, the suit was filed urging that the defendants were infringing the plaintiff's registered trade mark. Although the plaintiff had not used the word 'invalid' qua the impugned registration of the defendants, it averred that it would take appropriate steps to remove the impugned registration before the appropriate forum. The defendants raised a defence under clause (e) of sub-section (2) of Section 30 of the Trade Marks Act. The plaintiff applied under Section 124 for a stay of the suit on the ground of a pending rectification application against the impugned registration of the defendants. This Court held that a defence or plea by the defendant can be raised by an affidavit and/or other application and does not have to be by way of a written statement alone. It is observed that Section 124(1)(b) of the Act contemplates a situation where, "the Defendant raises a defence under clause (e) of Sub-section (2) of Section 30 and the Plaintiff pleads the invalidity of the registration of the defendant's trade mark". In

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the context of the plaintiff's application for stay, this Court accepted the submissions on behalf of the plaintiff that the acts of raising a defence by the defendant and subsequent challenge to the validity of the defendant's mark by the Plaintiff are sequential, i.e. the challenge contemplated is one which is raised after the filing of the plaint and as such 'plead' as used can never mean the plaint at all, as it contemplates the plea being raised subsequent to the filing of the plaint; hence, it would always be open to the plaintiff to raise the plea of invalidity by way of an affidavit or otherwise seeking stay of the Suit in respect of infringement so that appropriate proceedings may be filed, despite the plaint having no pleading in this regard.

28. This Court further held that the orders contemplated by sub-section (5) of Section 124 are usually made before the trial of an action in interlocutory proceedings. Accordingly, the interlocutory application for stay of the Suit is not premature, and the question of the defendant filing a written statement does not arise. It is therefore held that 'pleads' in Section 124(1)(b) of the Act cannot mean only the plaint or written statement.

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29. This Court further held that Section 125 states that where in a suit for infringement of a registered trade mark, the defendant raises a defence under clause (e) of sub-section 2 of Section 30, and the plaintiff 'questions' the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration shall be determined only on the application for rectification made to the Appellate Board and not the Registrar. This Court held that the language of Section 125 is identical to Section 124, save and except that instead of the word 'pleads' as used in Section 124, Section 125 uses the word 'questions', which also shows that "pleads" in 124(1)(b) of the Act cannot be given a restricted meaning. The Court held that Section 124 of the Act was enacted to avoid multiplicity of proceedings.

30. It is further held that the Court does not have the power to finally adjudicate upon the validity and/or invalidity of a registered trade mark, and Section 124(4) of the Act expressly states that 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 in conformity with such order, in so far as it relates

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to the issues as to the validity of the registration of the trade mark. This Court, thus, held that it would run against the scheme of the Act to continue with the trial of the suit in respect of infringement, as no final finding can be rendered by the civil Court in the absence of adjudication by the IPAB of the plaintiff's application seeking rectification of the impugned mark.

31. In ***Kiran Singh***, the Apex Court held that a decree passed by a court without jurisdiction is a nullity, and that its invalidity could be set up whenever and wherever it is sought to be enforced or relied upon, even at the stage of execution and even in collateral proceedings. It is held that a defect of jurisdiction, whether it is pecuniary or territorial, or whether it is in respect of the subject-matter of the action, strikes at the very authority of the court to pass any decree, and such a defect cannot be cured even by consent of parties. It is held that when the Court is *coram non judice*, its judgment and decree would be a nullity. This view is followed in ***Harshad Modi***. In ***Kanwar Singh Saini***, the Apex Court held that when a statute gives a right and provides a forum for adjudication of rights, a remedy must be sought only under the provisions

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of that Act.

32. In ***M. Murali***, the Madras High Court held that there is a clear difference between removal of registration and rectification of registration, and that invalidity of registration on the ground of non-user must be specifically pleaded to fall within the purview of Section 124.

33. In ***Country Inn Private Limited***, the Delhi High Court discussed the legal principles settled by the Apex Court in ***Patel Field Marshal*** on abandonment of plea of invalidity of registration. The Apex Court held that after framing an issue under Section 124 on invalidity of registration, when the suit is stayed to enable the defendant to file the appropriate application, and the defendant fails to do so within the time granted, such a plea stands abandoned. By relying on these principles, the Delhi High Court held that trial of the suit starts after framing issues and the commencement of leading evidence on the issues framed; therefore, a stay of trial is before the commencement of trial, not after. The Delhi High Court thus held that once the defendant in an infringement suit does not seek framing of an issue of invalidity of the plaintiff's registration before the commencement of trial, then

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the defendant is deemed to have abandoned its right to question the validity of the registration of the plaintiff's trademark and such right to question the plaintiff's registration is lost and will no longer survive.

34. In ***Satyam Infoway Ltd.***, the principal question raised before the Apex Court was whether internet domain names are subject to the legal norms applicable to other intellectual properties, such as trade marks. In the context of domain names, the Apex Court explained the theory of passing off. In ***Hardie Trading Ltd.***, the Apex Court held that if the ground for rectification is merely non-use under Section 46 of the Trade Marks Act, it is not really on account of any public mischief by way of an incorrect entry. The Court held that non-use does not, by itself, render the entry incorrect, but it gives a person whose interest is affected the right to apply for its removal. The Apex Court held that under Section 46(1)(*b*) of the Trade Marks Act, an application for removal of a registered trade mark will be allowed only if a continuous period of five years or longer has elapsed up to the date of one month prior to the date of the application during which there was no bona fide use by the proprietor of the trade

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mark sought to be removed. The Apex Court held that there is a distinction between the intention to abandon, which is part of the "no bona fide use in relation to those goods" in sub-section (1) of Section 46, which gives a cause for removal of the trade mark and the intention to use under sub-section (3) of Section 46, which provides a special defence to the registered proprietor and is inferred from the existence of special circumstances.

ANALYSIS AND CONCLUSIONS:

35. The dispute is regarding the use of the plaintiff's registered trade marks "Pune Times Mirror" and "Sunday Pune Times Mirror". In addition to these two trade marks, the plaintiffs also claim ownership of other registered trade marks with the word 'Mirror', as described in the suit. The plaintiffs claim they began using the word "Mirror" when they introduced the newspaper "Mumbai Mirror" in May 2005. The plaintiffs claim to have launched "Pune Mirror" on 7th April 2008 and "Sunday Pune Mirror" on 6th April 2008 in Pune. The plaintiffs rely on the Trade Mark registration certificates dated 18th November 2008 for "Pune Mirror" and "Sunday Pune Mirror".

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36. The defendants claim to have been publishing a fortnightly newspaper named “Pune Mirror” from 1st October 2010. The defendants rely upon the registration certificate issued on 14th December 2010 by the RNI under the PRB Act. The defendants pleaded the particulars of the proceedings before the RNI under the PRB Act and the notice issued by the Press Council of India. The defendants alleged that the plaintiffs’ title was deblocked as the plaintiffs did not complete the registration process before the RNI. The defendants have raised a vague ground disputing the plaintiffs’ registration certificate for the trademark “Pune Mirror”.

37. The defendants have raised grounds regarding their fortnightly newspaper published under the name “Pune Mirror” and have thus contended that the plaintiffs’ case of trademark infringement and/or passing off would not hold a good ground in light of the provisions of the Trade Marks Act. Thus, basically, the defendants have raised contentions to support their claim of genuine use of the term “Mirror” in publishing the fortnightly newspaper “Pune Mirror”.

38. The defendants have not raised a plea regarding the

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invalidity of registration of the plaintiffs' trade marks; hence, no such issue was framed in this suit. The issues framed are based on the rival pleadings regarding alleged infringement and passing off action and the defendants' plea of a genuine use of the trade mark "Pune Mirror". The defendants filed rectification applications after this suit; however, they never pleaded the same in the written statement. As contended in the application for stay under Section 124, the defendants filed rectification applications in 2023 and 2024 under Sections 47/57 of the Trade Marks Act by alleging no bonafide use of the registered trade marks by the plaintiffs. All the applications are filed before the Registrar of Trade Marks.

39. Under Section 125 of the Trade Marks Act, when, in a suit for infringement of a registered trade mark, the defendant questions the validity of the plaintiff's trade mark registration, the issue as to the validity of the registration of the trade mark concerned shall be determined by filing an application before the High Court. Hence, the defendants' rectification applications before the Registrar are not tenable. Hence, rectification applications pending before an

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incompetent authority cannot be a ground to stay the suit under Section 124 of the Trade Marks Act.

40. The alternative prayer for framing an issue and then permitting the defendants to apply to the appropriate forum for rectification of the register is on the ground that even by a separate application the plea of invalidity can be raised. The defendants' counsel relied upon this Court's decision in ***Cipla*** to support the submissions that raising a plea cannot be restricted to pleading in the written statement. In ***Cipla***, this Court's observations on the plea of invalidity are in the context of an application under Section 124 filed at the pre-trial stage. Therefore, this Court explained the situations for grant of stay of the trial by holding that Section 124(4) expressly states that 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 in conformity with such order, in so far as it relates to the issues as to the validity of the registration of the trade mark. This Court thus held that it would run against the scheme of the Act to continue with the trial of the suit in respect of infringement as no final finding can be rendered by

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the court in that regard.

41. Hence, the view taken in ***Cipla***, that 'plead' as used in Section 124(1)(b) cannot be restricted to the plaint or written statement alone, is in the context of a pre-trial stage. The decision in ***Cipla*** does not deal with a situation post framing of issues and completion of trial. Hence, in my view, the said decision would not apply to the facts of this case. In the present case, the application under Section 124 is filed at the stage of final arguments of the suit after the evidence is closed. No ground of invalidity is pleaded in the application that could not be pleaded in the written statement.

42. Another aspect regarding abandonment of the issue of invalidity needs to be considered. Learned counsel for the plaintiffs relied upon the decision of the Delhi High Court in ***Country Inn Private Limited*** to support his submissions that the defendants did raise the contention of non-use of the trade mark by the plaintiffs; however, never pressed for framing an issue on the invalidity of the plaintiff's registered trademark on the ground of no bona fide use as contemplated under the Trade Marks Act. Hence, according to the learned counsel for the plaintiffs, it would amount to

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abandonment of such a plea. I do not find any substance in the arguments raised on abandonment of the plea.

43. In view of the law laid down in ***Patel Field Marshal,*** when the suit is stayed after framing an issue on the invalidity of registration to enable the defendant to file the appropriate application, and the defendant fails to do so within the time granted, such a plea stands abandoned. The Delhi High Court in ***Country Inn Private Limited*** applied the same principles by holding that a stay of trial is before the commencement of trial, and not after; hence, before the commencement of trial, if such an issue is not raised, then the defendant is deemed to have abandoned its right to question the validity of the registration of the plaintiff's trademark. However, Section 124 provides for a stay of proceedings, and not a trial. Hence, in view of the law laid down by the Apex Court in ***Patel Field Marshal***, the theory of abandonment of the plea will apply only when the issue is framed by the civil court and the defendant takes no steps to challenge the validity within the time granted by the court. Hence, the Delhi High Court's decision relied upon by the learned counsel for the plaintiffs would not bind this Court.

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44. In light of the well-settled legal principles discussed above, unless this Court records a prima facie finding that an issue of invalidity of the registered trade marks arises in the suit, the question of staying the suit to determine an issue of invalidity by the competent forum would not arise. Such a prima facie finding for framing an issue for trial can be recorded only based on the rival pleadings, that is, the plaint and the written statement. Therefore, if the court does not frame an issue on invalidity while framing issues, but later finds that such an issue arises from the rival pleadings, it may frame an additional issue necessary for a fair trial, provided it arises from the pleadings.

45. In ***Patel Field Marshal***, the Apex Court held that all issues relating to and connected with the validity of registration have to be dealt with by the Tribunal and not by the civil court, and 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 only if the civil court is satisfied that an issue with regard to invalidity ought to be framed in the suit. Thus, as per well-established legal principles, once a suit relating to

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the registered trade mark is pending, the defendant can be permitted to apply for rectification only if the civil court frames the issue of invalidity.

46. The question to be decided in the present case is whether the defendant has made out even a low threshold prima facie case of invalidity of the plaintiffs' registered trade marks. In light of the legal principles as discussed in the above paragraphs by referring to the decisions of the High Courts and the Apex Court, a civil court would refuse to frame an issue under Section 124 only in situations to further the cause of justice by elimination of false, frivolous, and untenable claims of invalidity. It is also a well-settled legal principle as discussed in the above paragraphs that the civil court does not have the power to finally adjudicate upon the validity and/or invalidity of a registered trade mark, and Section 124(4) of the Act expressly states that 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 in conformity with such order, in so far as it relates to the issues as to the validity of the registration of the trade mark. Thus, the civil

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Court cannot render any final finding on rectification of the impugned mark. However, the question of permitting the defendant to apply for rectification would arise only if an issue of invalidity arises in the suit.

47. In the present case, the defendants have pleaded regarding their use of the trade mark “Pune Mirror”. All the defendants' pleadings concern denying and opposing the plaintiff's allegations of trade mark infringement and passing off. The defendants have not raised any plea on the invalidity of the plaintiffs’ registered trade marks either on the ground of no bona fide use or otherwise. The defendants have pleaded the particulars regarding the proceedings before RNI under the PRB Act, but have not raised any plea on no bonafide use of the registered trade marks in the context of the Trade Marks Act.

48. The PRB Act is a special statute governing publication of newspapers. Therefore, a plea raised regarding proceedings under the PRB Act would not *ipso facto* constitute a plea on the invalidity of the registered trade marks under the Trade Marks Act. Registration of title under the PRB Act would not itself constitute a ground to seek

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rectification of the register under the Trade Marks Act or raise a plea of invalidity of registered trade marks under the Trade Marks Act. Invalidity of a registered trade mark must be in relation to registration under the Trade Marks Act and not merely on the ground of another statutory registration or non-registration. Therefore, a plea of invalidity on the ground of non-use must be framed with reference to the provisions and requirements under the Trade Marks Act.

49. In the present case, the defendants have raised neither a low-threshold prima facie case nor any challenge to the validity of the plaintiffs' registered trade marks in relation to the provisions of the Trade Marks Act. Hence, no issue on invalidity of the plaintiffs' registered trade marks arises in the present suit. Hence, the question of granting stay of the suit to enable the defendants to challenge the validity of the plaintiffs' registered trade marks does not arise in the present suit. The defendants have filed this application at the fag end of the suit, that is, at the time of final arguments. Hence, merely stating in the application under Section 124 that the plaintiffs' registered trade marks are invalid cannot be a ground to frame an issue and stay this suit.

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50. The application is devoid of any merit. For the reasons recorded above, the interim application is rejected.

51. The suit be listed for final arguments before the court having assignment.

[GAURI GODSE, J.]

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