

Jumeirah Beach Resort Llc vs Designarch Infrastructure Pvt Ltd. & ... on 28 November, 2022

Author: C.Hari Shankar

Bench: C.Hari Shankar

\$~13, 14 & 19(Original)
* IN THE HIGH COURT OF DELHI AT NEW DELHI
+ C.O. (COMM.IPD-TM) 124/2022
JUMEIRAH BEACH RESORT LLC Plaintiff
Through: Mr.Raghav Vig, Mr.Naqeeb
Nawab, Mr.Himanshu Deora and
Ms,.Gunjan Paharia, Advs.

versus

DESIGNARCH INFRASTRUCTURE PVT LTD. & ANR
..... Defendants
Through: Ms.Shwetaree Majumder,
Ms.Diva Arora, Mr.Rohan Krishna Seth,
Advs.

+ C.O. (COMM.IPD-TM) 315/2022
JUMEIRAH BEACH RESORT LLC Plaintiff
Through: Mr.Raghav Vig, Mr.Naqeeb
Nawab, Mr.Himanshu Deora and
Ms,.Gunjan Paharia, Advs.

versus

DESIGNARCH CONSULTANTS PRIVATE LIMITED AND
ANR Defendants
Through: Ms.Shwetaree Majumder,
Ms.Diva Arora, Mr.Rohan Krishna Seth,
Advs.
Mr.Harish Vaidyanathan Shankar, CGSC
with Mr.Srish Kumar Misra, Mr.Sagar
Mehlawat, Mr.Alexander Mathai Paikaday,
Advs.

+ CS(COMM) 124/2021 & I.A.19885/2022
JUMEIRAH BEACH RESORT LLC Plaintiff
Through: Mr.Raghav Vig, Mr.Naqeeb
Nawab, Mr.Himanshu Deora and
Ms,.Gunjan Paharia, Advs.

versus

Signature Not Verified

C.O. (COMM.IPD-TM) 124/2022 & connected matters

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By: SUNIL SINGH NEGI
Signing Date: 29.11.2022
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DESIGNARCH CONSULTANTS PVT LTD. AND ANR.

..... Defendants

Through: Ms. Shwetasree Majumder,
Ms. Diva Arora, Mr. Rohan Krishna Seth,
Advs.
Mr. Harish Vaidyanathan Shankar, CGSC
with Mr. Srish Kumar Misra, Mr. Sagar
Mehlawat, Mr. Alexander Mathai Paikaday,
Advs.

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR
ORDER

% 28.11.2022

1. These matters were listed today consequent to the order dated 29th August 2022 passed by the predecessor Bench.

2. This Court is presently seized with one suit and two petitions under Section 47 and 57 of the Trademarks Act, 1999.

3. C.O. (COMM.IPD-TM) 124/2022 has been filed by the plaintiff Jumeirah Beach Resort LLC ("Jumeirah") against the defendant Designarch Infrastructure Pvt. Ltd. ("Designarch") alleging infringement and passing off by the defendant of the mark 'BURJ AL ARAV'. C O (COMM.IPD-TM) 124/2022 and C O (COMM.IPD-TM) 315/2022 have been instituted by Jumeirah against Designarch, directed against the mark 'BURJ NOIDA' and the logo used by the defendant in that regard, seeking rectification of the register of trademarks and removal of the said mark from the register of Trademarks.

4. C O (COMM.IPD-TM) 124/2022 and C O (COMM.IPD-TM) 315/2022 were earlier pending before the Intellectual Property Appellate Board (the IPAB) and have been transferred to this court consequent to the enactment of the Tribunal Reforms Act, 2021.

C.O. (COMM.IPD-TM) 124/2022 & connected matters page 2 of 7

5. Ms. Majumder, learned Counsel for the defendant Designarch Consultants Pvt. Ltd. submits that, prior to the institution of the aforesaid suit and rectification/removal petitions by Jumeirah against Designarch, Designarch had already filed five cancellation petitions, seeking rectification/removal, from the register, of the plaintiff's 'BURJ AL ARAV' mark in five different classes vide Rectification Nos. 269279, 269280, 269281, 269282, 269283 directed against the plaintiff's marks in Classes 35, 36, 39, 42 and 41 respectively.

6. The order dated 29th August 2022, passed by the predecessor Bench in the present proceedings already notes that it would be appropriate that the said proceedings be transferred to this Court, especially as the rectification/removal petitions filed by Jumeirah against Designarch before the IPAB already stand transferred.

7. The matters were listed today only because there is no specific provision whereunder a rectification/removal proceeding pending before the Registrar of Trademarks can be transferred to this Court.

8. Having heard learned Counsel, I see no difficulty in directing the said transfer. The appeal, against the decision of the Registrar of Trademarks admittedly lay, during the time it was in existence, to the IPAB. All appeals before the IPAB stand transferred to this Court consequent to the Tribunals Reforms Act, 2021. This Court, therefore, is effectively the successor of the IPAB with respect to appeals filed against decisions of the Registrar of Trademarks.

9. Besides, Ms.Majumder has drawn my attention to Section 125 of the Trademarks Act which reads thus:

C.O. (COMM.IPD-TM) 124/2022 & connected matters page 3 of 7 "125. Application for rectification of register to be made to Appellate Board in certain cases.--

(1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit 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 of the trade mark concerned shall be determined only on an application for the rectification of the register and, notwithstanding anything contained in section 47 or section 57, such application shall be made to the Appellate Board and not to the Registrar.

(2) Subject to the provisions of sub-section (1), where an application for rectification of the register is made to the Registrar under section 47 or section 57, the Registrar may, if he thinks fit, refer the application at any stage of the proceedings to the Appellate Board."

10. Section 125(2) empowers the Registrar of Trademarks, at any stage, to refer the matter to the IPAB. The jurisdiction, authority and powers of the IPAB having been transferred to this Court consequent on the enactment of the Tribunals Reforms Act, 2021, the power of reference contained in Section 125(2) of the Trademarks Act would, proprio vigore, empower the Registrar of Trademarks to, in an appropriate case, refer the matter to this Court.

11. If the Registrar of Trademarks could refer the matter to this Court, there is no reason why this Court could not direct transfer of the matter to itself, especially where all other connected petitions, including petitions for passing off and cancellation/removal/rectification petitions instituted by

Jumeirah against Designarch, which are pending before the IPAB, already stand transferred to this Court.

12. Rule 26 of the Delhi High Court Intellectual Property Rights C.O. (COMM.IPD-TM) 124/2022 & connected matters page 4 of 7 Division Rules, 2022 ("the IPD Rules" hereinafter) reads thus:

"26. Consolidation of IPR subject matters or cases or proceedings or disputes - Where there are multiple proceedings relating to the same or related IPR subject matter, irrespective of whether the said proceedings are between the same parties or not, the Court shall have the power and the discretion, wherever appropriate, to direct consolidation of proceedings, hearings, and also to direct consolidated recording of evidence/common trial and consolidated adjudication. If the Court is of the opinion that any matter pending before a Commercial Court is to be consolidated with a matter pending before the IPD, it may exercise powers of transfer under Section 24, Code of Civil Procedure, 1908 for transfer and consolidation of such matter to itself."

13. Though he did not oppose the suggestion to transfer the rectification/removal proceedings instituted by Designarch against Jumerirah and presently pending before the learned Registrar of Trademarks to this Court, Mr. Raghav Vig, learned Counsel for the plaintiff, nonetheless, drew my attention to Rule 26 of the IPD Rules, to point out that the Rule only envisaged transfer or consolidation, with a matter pending before the IPD, of any matter pending before a commercial court. His submission is that, as the office of the learned Registrar of Trademarks cannot be treated as a "Commercial Court", stricto sensu, Order XXVI may not empower this Court to direct consolidation, with matters pending before the IPD in this Court, of matters which are pending before the learned Registrar of Trademarks.

14. The argument appears, to me, to be hyper technical. Besides, in all commercial matters, the foremost consideration is expeditious and meaningful disposal of the proceedings, which becomes additionally important where the proceedings relate to intellectual property rights. Confusion is bound to result if the infringement and passing off suit filed by Jumeirah against Designarch, and the rectification/removal proceedings instituted by Jumeirah against Designarch before the C.O. (COMM.IPD-TM) 124/2022 & connected matters page 5 of 7 IPAB are taken up by this Court and the counter proceedings for removal/rectification instituted by Designarch against Jumeirah pending before the learned Registrar of Trademarks are allowed to continue there. In order for this Court to have a holistic appreciation of the disputes, and to ensure a complete resolution thereof, it is but obvious that all these proceedings should be taken up and heard together.

15. That apart, there is also some substance in the submission of Ms. Swetasree Majunder, learned Counsel for Designarch, to the effect that the restrictive wording of the second sentence in Rule 26 of the IPD Rules cannot restrict the ambit of the first sentence, which permits consolidation of "proceedings", "where there are multiple proceedings relating to the same or related IPR subject matter". She points out that the first sentence in Rule 26 does not restrict the power of the Court to consolidate proceedings based on the forum before which the proceedings are pending.

16. Prima facie, there is substance in the submission. The intent and purpose of Order XXVI, howsoever it may be worded, is obviously to ensure that proceedings relating to the same or related IPR subject matters are heard together and that, if any such proceeding(s) are pending before the IPD of this Court, all connected and related proceedings should also be taken up by it.

17. Following the aforesaid discussion, the learned Registrar of Trademarks is directed to transmit, to the Registry of this Court, the complete physical records of the five applications filed by Designarch against Jumeirah, within a period of eight weeks from today. On the C.O. (COMM.IPD-TM) 124/2022 & connected matters page 6 of 7 physical files being received, the Registry would scan them, convert them into electronic files and provide electronic copies of the records of the said petitions to learned Counsel for both sides.

18. List all these matters on 10th January 2023.

I.A.19885/2022 in CS (Comm) 124/2021

19. This application is opposed by Ms. Majumder.

20. She also submits that the video recording which this application seeks to place on record has not been provided to her.

21. Learned Counsel for the plaintiff undertakes to provide, during the course of the day, pen drives containing the video recording which this application seeks to bring on record to Ms. Majumder as well as to the Court Master.

22. Reply to the application, if any, be filed within two weeks with advance copy to learned Counsel for the applicant who may file rejoinder within two weeks thereafter.

23. Re-notify the application for disposal on 10th January 2023.

24. Dasti C.HARI SHANKAR, J NOVEMBER 28, 2022/kr C.O. (COMM.IPD-TM) 124/2022 & connected matters