

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

% **Date of Decision: 11<sup>th</sup> November, 2021**

+ C.O. (COMM.IPD-TM) 40/2021, I.A.14647/2021 (of petitioner for stay)

RESILIENT INNOVATIONS PVT. LTD. .... Petitioner

Through: Mr. Rajshekhar Rao, Sr. Adv. with  
Mr. Mohit Goel, Mr. Sidhant Goel,  
Mr. Deepankar Mishra, Mr. Aditya  
Goel and Ms. Sonal Sarada,  
Advocates

Versus

PHONEPE PRIVATE LIMITED & ANR. .... Respondents

Through: Mr. Sandeep Sethi and Mr. Jayant  
K. Mehta, Senior Advocates with  
Mr. Nitin Sharma, Mr. Vaarish K.  
Sawhani, Mr. Ranjeet Singh Sidhu  
and Ms. Smiti, Advs. for D-1.  
Mr. Harish Vaidyanathan Shanker  
and Mr. Syed Husain Adil Taqvi,  
Advs. for UOI.

+ C.O. (COMM.IPD-TM) 41/2021, I.A.14648/2021 (of petitioner for stay)

RESILIENT INNOVATIONS PVT. LTD. .... Petitioner

Through: Mr. Rajshekhar Rao, Sr. Adv. with  
Mr. Mohit Goel, Mr. Sidhant Goel,  
Mr. Deepanker Mishra, Mr. Aditya  
Goel and Ms. Sonal, Advs.

Versus

PHONEPE PRIVATE LIMITED & ANR. .... Respondents

Through: Mr. Sandeep Sethi and Mr. Jayant  
K. Mehta, Sr. Advs. with Mr. Nitin  
Sharma, Mr. Vaarish K. Sawhani,  
Mr. Ranjeet Singh Sidhu and Ms.  
Smiti, Advs. for D-1.

Mr. Harish Vaidyanathan Shanker  
and Mr. Syed Husain Adil Taqvi,  
Advs. for UOI.

+ C.O. (COMM.IPD-TM) 42/2021, I.A.14649/2021 (of petitioner for stay)

RESILIENT INNOVATIONS PVT. LTD ..... Petitioner  
Through: Mr. Rajshekhar Rao, Sr. Adv. with  
Mr. Mohit Goel, Mr. Sidhant Goel,  
Mr. Deepanker Mishra, Mr. Aditya  
Goel and Ms. Sonal, Advs.

Versus

PHONEPE PRIVATE LIMITED & ANR. .... Respondents  
Through: Mr. Sandeep Sethi and Mr. Jayant  
K. Mehta, Sr. Advs. with Mr. Nitin  
Sharma, Mr. Vaarish K. Sawlani,  
Mr. Ranjeet Singh Sidhu and Ms.  
Smiti, Advs. for D-1.  
Mr. Harish Vaidyanathan Shanker  
and Mr. Syed Husain Adil Taqvi,  
Adv. for UOI.

+ C.O. (COMM.IPD-TM) 43/2021, I.A.14650/2021 (of petitioner for stay)

RESILIENT INNOVATIONS PVT. LTD ..... Petitioner  
Through: Mr. Rajshekhar Rao, Sr. Adv. with  
Mr. Mohit Goel, Mr. Sidhant Goel,  
Mr. Deepanker Mishra, Mr. Aditya  
Goel and Ms. Sonal, Advs.

Versus

PHONEPE PRIVATE LIMITED & ANR. .... Respondents  
Through: Mr. Sandeep Sethi and Mr. Jayant  
K. Mehta, Sr. Advs. with Mr. Nitin  
Sharma, Mr. Vaarish K. Sawlani,  
Mr. Ranjeet Singh Sidhu and Ms.  
Smiti, Advs. for D-1.

Mr. Harish Vaidyanathan Shanker  
and Mr. Syed Husain Adil Taqvi,  
Advs. for UOI.

+ C.O. (COMM.IPD-TM) 44/2021, I.A.14651/2021 (of petitioner for stay)

RESILIENT INNOVATIONS PVT. LTD. .... Petitioner

Through: Mr. Rajshekhar Rao, Sr. Adv. with  
Mr. Mohit Goel, Mr. Sidhant Goel,  
Mr. Deepanker Mishra, Mr. Aditya  
Goel and Ms. Sonal, Advs.

Versus

PHONEPE PRIVATE LIMITED & ANR. .... Respondents

Through: Mr. Sandeep Sethi and Mr. Jayant  
K. Mehta, Sr. Advs. with Mr. Nitin  
Sharma, Mr. Vaarish K. Sawlani,  
Mr. Ranjeet Singh Sidhu and Ms.  
Smiti, Advs. for D-1.  
Mr. Harish Vaidyanathan Shanker  
and Mr. Syed Husain Adil Taqvi,  
Adv. for UOI.

+ C.O. (COMM.IPD-TM) 45/2021, I.A.14652/2021 (of petitioner for stay)

RESILIENT INNOVATIONS PVT. LTD. .... Petitioner

Through: Mr. Rajshekhar Rao, Sr. Adv. with  
Mr. Mohit Goel, Mr. Sidhant Goel,  
Mr. Deepanker Mishra, Mr. Aditya  
Goel and Ms. Sonal, Advs.

Versus

PHONEPE PRIVATE LIMITED & ANR. .... Respondents

Through: Mr. Sandeep Sethi and Mr. Jayant  
K. Mehta, Sr. Advs. with Mr. Nitin  
Sharma, Mr. Vaarish K. Sawlani,  
Mr. Ranjeet Singh Sidhu and Ms.  
Smiti, Advs. for D-1.

Mr. Harish Vaidyanathan Shanker  
and Mr. Syed Husain Adil Taqvi,  
Advs. for UOI.

**CORAM:**  
**HON'BLE MS. JUSTICE ASHA MENON**

**J U D G M E N T**

**ASHA MENON, J: (Oral)**

**C.O. (COMM.IPD-TM) 40/2021, I.A.14647/2021**  
**C.O. (COMM.IPD-TM) 41/2021, I.A.14648/2021**  
**C.O. (COMM.IPD-TM) 42/2021, I.A.14649/2021**  
**C.O. (COMM.IPD-TM) 43/2021, I.A.14650/2021**  
**C.O. (COMM.IPD-TM) 44/2021, I.A.14651/2021**  
**C.O. (COMM.IPD-TM) 45/2021, I.A.14652/2021**

**(HYBRID HEARING)**

1. These petitions have been moved for the removal/rectification of trademark Registration Nos.3425319, 3425322, 3425323, 3425317, 3425326 and 3425325 respectively in Classes 36, 9, 35 and 42 from the Register of Trade Marks under Section 57 of the Trade Marks Act, 1999.
2. Mr. Sandeep Sethi, learned senior counsel appearing on advance notice on behalf of the respondent No.1/Phonepe Private Limited has raised a preliminary objection to the maintainability of the present petitions. It is his submission that a prior suit being CS(COMM) 292/2019 is pending between the same parties, in which, in terms of the provisions of Section 124 of the Trademarks Act, 1999, no application has been moved before that Court seeking permission to file the present rectification petitions. Learned senior counsel for the respondent No.1 has

handed over a copy of the written statement filed by the petitioner herein in CS(COMM) 292/2019 and has drawn the attention of the Court to various paragraphs in the written statement to submit that the present petitions, in the absence of permission from the Civil Court were invalidly filed. Reliance has also been placed on the judgment of the Supreme Court in *Patel Field Marshal Agencies v. P.M. Diesels Ltd.*, (2018) 2 SCC 112.

3. Mr. Rajshekhar Rao, learned senior counsel on behalf of the petitioner however, submits that at the time of filing of the rectification petitions, no suit was pending in which any challenge to the validity of the registration of the Trademarks in the name of the respondent no. 1 had been raised. Therefore, there was no occasion for permission. It is further contended that these rectification proceedings could be initiated because even Section 124 of the Trademarks Act, 1999 does not mandate a challenge being raised to the validity of the trademarks in every proceeding for trademark infringement and passing off. It was explained by the learned senior counsel for the petitioner that in CS (COMM) 292/2019, the respondent no.1 being the plaintiff therein, had initiated action against the present petitioner on grounds for infringement and passing off by the use of deceptively similar trademarks. However, the Coordinate Bench of this Court in CS (COMM) 292/2019 had declined any interim relief to them, observing that the Word “Pe” would be “descriptive of the service” being provided. It was submitted by learned senior counsel that in view of these observations, the registration was clearly hit by Section 9(1)(a) of the Trademarks Act, 1999. Therefore, the registration was improper and the present rectification proceedings were

maintainable. It was further submitted that the cause of action in the present rectification proceedings was the filing of objections by the respondent no. 1 herein to the application for registration of the trademark 'Postpe' by the present petitioner and was not connected with CS (COMM) 292/2019 where the question related to the use of the trademark 'BharatPe' by the present petitioner.

4. The Supreme Court in *Patel Field Marshal Agencies (supra)* in has observed:-

*“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 added)*

5. In the present case, though an attempt has been made by the learned senior counsel for the petitioner to distinguish the fact position by submitting that the cause of action is based on the objections filed by the

respondent no. 1 to the registration of 'Postpe' as its trademark by the petitioner and that the previous suit related to 'BharatPe', and that the two cases were different, the fact remains that in the written statement filed in the suit, the present petitioner has itself raised objections with regard to the registration of the Words "Pe", "पे" , "Pay" or "PhonePe" etc. being laudatory and descriptive of the services that were being provided by the plaintiff in that case, namely, the respondent no.1 before this Court. It has also been stated in the written statement that the marks could not have been registered in the first place, thus in effect, challenging the registration of the trademark of the respondent no. 1. In fact, in Para No.51 of the written statement, it has been stated that the Word "Pe" is not an innovative word, because even at the time when the respondent no. 1 adopted the 'PhonePe' Marks, there were already entities who had applied for registration and were using 'phonepe' and 'pe' formative marks.

6. It was also stated that the petitioner herein "reserved its right to file rectification petitions" against all PhonePe registered marks, including, that which have been dishonestly and fraudulently registered by the respondent no. 1 herein. Similarly, in para No.60, it was submitted that the registrations obtained by the respondent no.1 are illegal and are liable to be rectified for which the petitioner would take "adequate steps". Thus, in the written statement, the present petitioner has clearly indicated that it intended to take steps for rectification of the Register and these petitions appear to be in that direction. However, in view of the provisions of Section 124, it is clear that the present petitions could not have been filed without the court framing an issue regarding the validity

of the Trademark in (CS (COMM) 292/2019), as held by the Supreme Court in *Patel Field Marshal Agencies (supra)*.

7. For the aforesaid reasons, the present petitions are dismissed alongwith the pending applications.

8. The judgment be uploaded on the website forthwith.

**(ASHA MENON)**  
**JUDGE**

**November 11, 2021**

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