HIGH COURT OF JUDICATURE FOR RAJASTHAN AT JODHPUR

S.B. Civil First Appeal No. 404/2022

Kutbuddin Kanorwala S/o Shri Akbar Ali, Aged About 62 Years, Sole Proprietor, M/s Z.A. Kanorwala, Having Address At- 01, 05, 06, Theosophical Society Lodge, Chamanpura, Shiksha Bhawan Circle, Udaipur- 313001 (Raj.)

----Appellant/Plaintiff

Versus

1. Zakir Hussain Kanorwala S/o Akbar Ali, Aged About 81 Years, Sole Proprietor-M/s Z.A. Kanorwala, Having Address At 26/811, Photowala Bari, Sawa Mandir, Purana Fatehpura, Udaipur-313004 (Raj.)
2. M/s Upkar Thok Bhandar, Through Its Proprietor Shri Hakimuddin Kanorwala S/o Shri Zakir Hussain Kanorwala, Age 50, Having Address At A-001, GLG Complex, Fatehpura, Udaipur- 313004 (Raj.)

----Respondents/Defendants

For Appellant(s)	:	Dr. Ashok Soni, Sr. Advocate assisted by Mr. Aman Soni Mr. Divyanshu Choudhary Ms. Sonali Vyas Mr. Romil Bagrecha Mr. Yash Dadhich Ms. Divya Purohit
For Respondent(s)	:	Mr. G. D. Bansal, through VC Mr. Prateek Charan Mr. Dharmendra Kumar Gupta

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HON'BLE MR. JUSTICE VINIT KUMAR MATHUR

JUDGMENT

REPORTABLE

Judgment reserved on: 09/05/2024

Judgment pronounced on: 23/05/2024

1. With the consent of the learned counsel for the parties, the present appeal is being heard and decided finally at this stage by this judgment.

2. The present first appeal has been filed by appellant-Kutbuddin against the order dated 02.09.2022 passed by Additional District Judge No.1, Udaipur (for short "the trial Court"), whereby, the application preferred by defendant-respondent No.1- Zakir Hussain under Section 28(3), Section 29 and Section 30 (2)(e) of the Trademark Act, 1999 (hereinafter referred to as "the Act") had been allowed and the suit preferred by the appellant-plaintiff as well as the counter claim filed by the defendant-respondent No.1 had been dismissed.

3. Briefly, the facts necessary to be noted in the present first appeal are that on 01.01.1979, a partnership firm namely M/s. Z.A. Kanorwala was founded by the partners Mr. Zakir Hussain Kanorwala (respondent No.1 in the instant appeal) and Mr. Abbas Ali Kanorwala, who adopted a distinctive trade mark "ZK" (label) in respect of business of manufacturing, trading, marketing, offering for sale and selling of all kinds of spices falling in class 30 for the goods-spices vide Registration No.481894 on 30.11.1987.

4. In the month of April, 2005, Mr. Abbas Ali retired from the partnership firm and the present appellant-plaintiff- Kutbuddin Kanorwala was inducted as a partner of the partnership firm M/s. Z.A. Kanorwala vide partnership deed dated 01.04.2005.

5. On 31.08.2006, the partnership firm M/s. Z.A. Kanorwala was dissolved. The dissolution deed dated 31.08.2006 clearly shows that Kutbuddin Kanorwala would continue the said business as a sole proprietor under the same name and style i.e. M/s. Z.A. Kanorwala; Kutbuddin Kanorwala would be entitled to sole and exclusive ownership and can use trade mark "ZA", the partnership

firm's name M/s. Z.A. Kanorwala and trade marks alongwith goodwill; the outgoing partner Zakir Hussain Kanorwala would have no right, title and interest in the firm M/s. Z.A. Kanorwala and/or the partnership firm's trade marks.

6. After the said dissolution of the erstwhile partnership firm, as a consequence, the erstwhile partner Mr. Zakir Hussain Kanorwala, the respondent-defendant No.1 had written an application dated 01.09.2006 under his signature to the Commercial Tax Officer, Udaipur to cancel Sales Tax Licence in the name of the erstwhile partnership firm. He had also written a letter dated 02.09.2006 to the Manager, Punjab National Bank, Chetak Circle, Udaipur for closure of the current account in the name of partnership M/s. Z.A. Kanorwala. The respondent-defendant- Zakir Hussain Kanorwala also addressed a communication dated 03.02.2010 to the Secretary, Krishi Upaj Mandi Samiti, Udaipur for changing the permanent licence and an affidavit dated 06.03.2010 to provide 'No Objection Certificate' for changing of shop licence. In these circumstances, the appellant-plaintiff continued with his business of proprietor firm M/s. Z.A. Kanorwala with the trade mark "ZK (label)". Thereafter, the present appellant-plaintiff filed two more applications for grant of trade marks and the same were allowed by the official respondents as "ZK" and "Upkar Spices".

7. In the year 2013, the defendant-respondent No.1- Zakir Hussain Kanorwala filed a suit for dissolution and rendition of accounts against the present appellant-plaintiff in the District Court, Udaipur, which was transferred to the Additional District Judge No.1, Udaipur being Civil Suit No.125/2013 and the same is

pending consideration till today. No interim order in the said suit with respect to the trade marks of the erstwhile partnership firm has been passed.

8. In the year 2017, one more suit was filed by the respondent No.1- defendant Zakir Hussain Kanorwala against the present appellant for permanent injunction in the District Court, Udaipur which stands transferred to the court of Additional District Judge No.2, Udaipur. In the said suit, an application for temporary injunction was filed against the present appellant-plaintiff for restraining him to use the trade mark "Upkar Spices" and the trade name Z.A. Kanorwala and its logo "ZK" but the same was dismissed vide order dated 05.10.2019. Against the order dated 05.10.2019, an appeal was also filed before this Court which is pending consideration. Besides this, there are other litigations which are pending consideration between the parties.

9. The trade mark "Upkar Spices" vide registration No.1034169 in class 30 was registered in the name of erstwhile partnership firm M/s. Z.A. Kanorwala. The appellant-plaintiff being the sole proprietor of the firm filed TM-24 (for transfer of trade mark and registration as a subsequent proprietor) in respect of trade mark "Upkar Spices". The Registrar, Trade Marks was pleased to allow the Form TM-24 vide order dated 12.02.2018 in favour of the present appellant by overruling the objections filed by the erstwhile partner respondent No.1- Zakir Hussain Kanorwala. In these circumstances, the trade mark "Upkar Spices" vide No.1034169 in class 30 now stands registered in the name of

appellant- Kutbuddin Kanorwala, the sole proprietor M/s. Z.A. Kanorwala.

10. In nutshell, the appellant-plaintiff is holding the registered trade mark of "UPKAR Spices" vide registration No.1034169 in class 30 for spices and "ZK (label)" vide Registration No.481894 in respect of spices in class 30 in trade name M/s. Z.A. Kanorwala, since the same is being used by the appellant-plaintiff.

11. It is also noted that the respondent-defendant vide application No.2276741 got registered the trade mark "ZK" with "Upkar Spices" in respect of spices in services under class 35.

12. In these circumstances, since the defendant was misusing the registered trade mark of the appellant-plaintiff, the present appellant filed a suit for permanent injunction for restraining the respondent No.1 from infringement and passing off the label trade mark No.1034169 "Upkar Spices" and in respect of trade mark No.481894 "ZK" in class 30.

13. During the pendency of the suit, an application was filed by the defendant-respondent No.1 under Section 28(3), Section 29 & Section 30(2)(e) of the Act. Learned Court below, after hearing the counsel for the parties, allowed the application preferred by the respondent-defendant and dismissed the suit filed by the present appellant-plaintiff, and the counter claim filed by the defendant-respondent No.1 too has been dismissed vide order dated 02.09.2022. Hence, the present appeal has been filed.

14. Dr. Ashok Soni, learned Senior Counsel for the appellant submitted that the suit preferred by the appellant-plaintiff cannot be dismissed on the application preferred by the respondent-

defendant for dismissal of the suit under Sections 28(3), 29 & 30(2)(e) of the Act for the simple reason that sub-section (3) of Section 28 of the Act will have to be read in conjunction with sub-section (1) of Section 28 of the Act, wherein, the registration is clearly provided for "Goods" and "Services" separately and since the appellant-plaintiff has been registered under the category of Goods i.e. Class 30, therefore, the registration of the similar trademark for the services under class 35 will have no bearing and, therefore, the registration of the respondent-defendant for the same trademark but in different class i.e. 35 cannot be a ground for dismissal of the suit under sub-section (3) of Section 28 read with Sections 29 & 30 (2)(e) of the Act.

15. Learned Senior Counsel further submitted that since the appellant-plaintiff's trademarks had been registered under class 30 which specifically provides for a separate class in the category of "Goods" and registration of trade mark of the respondent-defendant-No.1 is for the services provided by him though for the same trademark but in different category i.e. class-35, therefore, the same cannot be held to be not maintainable under Section 28 (3), 29 & 30 (2) (e) of the Act.

16. The learned Sr. Counsel also submitted that a bare perusal of the pleadings of the suit shows that the prayer for infringement and passing off is very much present in the plaint. The rights emanating from the common law shall remain undisputed by enactment of Section 28 (3) of the Act as the suit for passing off the action cannot be dismissed, even where both the rival parties are registered holder of an identical trade mark, therefore, the

learned trial court has committed an error while dismissing the entire suit on the application preferred by the respondent-defendant under Section 28 (3) of the Act. The suit for passing off is still maintainable, even if the registered trade marks are identical and will not be hit by the provisions of Section 28(3) of the Act.

17. Learned Senior Counsel submitted that the application preferred by the respondent-defendant is akin to an application preferred under Order 7 Rule 11(d) of the CPC and therefore, the learned trial court has rejected the suit on that ground, however, on a bare perusal of the pleadings shows that the suit preferred by the appellant-plaintiff cannot be dismissed without framing of the issues and adjudicating the same after recording the evidence.

18. Learned Senior counsel further submitted that the registration granted in favour of the respondent-defendant is also challenged by the appellant-plaintiff which is pending consideration before the Gujarat High Court, although, no interim order has been passed but the learned counsel submitted that the suit of the appellant cannot be dismissed on this ground also as no finality has been attained with respect to the registration of trade mark by the defendant and therefore, the learned trial court has committed an error while rejecting the suit without adjudicating the same on merit.

19. In support of his contentions, the learned counsel for the appellant-plaintiff has relied upon the following judgments:-

(i) S. Syed Mohideen Vs. P. Sulochna Bain (2016) 2 SCC 683.

(ii) Rana Steels Vs. Ran India Steels P. Ltd.,2008 (102) DRJ 503.

(iii) A. Kumar Milk Foods P. Ltd. vs. Vikas Tyagi & Anr., 2013 SCC OnLine Del 3439:(2013) 55 PTC 469.

20. Per contra, Mr. G. D. Bansal, learned counsel through VC assisted by Mr. Dharmendra Kumar Gupta & Mr. Prateek Charan for the respondent– defendant vehemently submitted that since the respondent-defendant has also obtained a registered trade mark "ZK" vide Registration No.2276741 under Class 35, therefore, no suit against the holder of a registered trade mark is maintainable as mandated under Sections 28(3), 29 and 30(2)(e) of the Act. The learned counsel for the respondents vehemently submitted that a plain reading of sub-section (3) of Section 28 of the Act, shows that where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons, therefore, in these circumstances, since both appellant-plaintiff and respondent-defendant are having registered trade marks which are identical, the appellant-plaintiff cannot file a suit for infringement against the respondent-defendant as the same is barred against the respondent-defendant and therefore, no error has been committed by the learned trial court while allowing the

application preferred by the respondent-defendant under Sections 28(3), Section 29 and Section 30(2)(e) of the Act.

21. Learned counsel for the respondents vehemently submitted that even as per Section 29 of the Act, there is no question of infringement for the use of the same trade mark as the respondent-defendant is also registered holder of a trade mark and therefore, as per Section 29 of the Act, if the same is used "in the course of trade", it will not be considered infringement of the trade mark of the plaintiff's registered trade mark as the words used in this Section does not make any distinction between "Goods" and "Services".

22. Learned counsel further submitted that as per Section 30(2)(e) of the Act, if a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act will not be considered an infringement of other registered trade mark holder and therefore, in the present case, since the respondent-defendant is having a registered trade mark in his favour, he cannot be sued by the appellant-plaintiff for infringement of the trade mark registered by the respondent-defendant.

23. Learned counsel for the respondent-defendant in nutshell submitted that since both the plaintiff and the defendant are registered trade marks holders, therefore, the suit filed by the appellant-plaintiff against the defendant is not maintainable.

24. Learned counsel for the respondent-defendant submitted that a composite suit seeking the relief for infringement and

passing off is not maintainable and, therefore, the composite suit filed by the appellant-plaintiff is liable to be dismissed.

25. Learned counsel further submitted that the respondent-defendant cannot be stopped from using the trade mark in the present case as the same is registered under Class 35 and the plaintiff's registration of trade marks are under Class 30.

26. In support of his contentions, learned counsel for the respondent-defendant relied upon the following judgment in the cases of

(1) M/s. LION Dates Impex Pvt. Ltd. v. P. Mohammed Ibrahim (C.S. No.799/2014 decided on 10.03.2020)

(2) P.M. Diesels Private Limited vs. Thukral Mechanical Works (Delhi) (Suit No.2408 of 1985 decided on 19.01.1988)

(3) Kent RO System Ltd. vs. Gattubhai reported in 2022(90) PTC 257, and

(4) Micolube India Ltd. v. Maggon Auto Centre (Delhi) reported in 2008(36) PTC 231.

27. I have considered the submissions made at the Bar and have gone through the relevant record of the case including the order impugned dated 02.09.2022.

28. The detailed facts mentioned in the preceding paras show that the appellant-plaintiff is having two registered trade marks, namely, "Upkar Spices" having registration No.1034169 & "ZK" having registration No.481894 which are registered under Class 30. At the same time, the respondent-defendant is having a registered trade mark "ZK" registered under Class 35 with the

registration No.2276741. Since the registered trade mark "ZK" of the appellant-plaintiff was being misused by the respondent-defendant, therefore, a suit was preferred by him before the learned trial court for infringement and passing off.

29. During the pendency of the suit proceedings, the respondent-defendant filed an application under Section 28(3), Section 29 and Section 30(2)(e) of the Act which was allowed vide order dated 02.09.2022 and dismissed the suit preferred by the appellant-plaintiff as well as the counter claim filed by the respondent-defendant. A perusal of the order impugned shows that the learned trial court has dismissed the suit only on the ground that the appellant-plaintiff and respondent-defendant are holding the registered trade marks which are of the same/identical style/ nature, therefore, the suit filed by the appellant - plaintiff is not maintainable in view of Section 28(3), Section 29 and Section 30(2)(e) of the Act. The registration of the trade mark of the respondent-defendant weighed heavily in the mind of the trial court while allowing the application above.

30. It will be worthwhile to reproduce Sections 28, Section 29 and Section 30(2)(e) of the Act, which read as under:-

> **"28. Rights conferred by registration.**—(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.
>
> (2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.
>
> **(3) Where two or more persons are registered proprietors of trade marks, which are identical**

with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor."

"29. Infringement of registered trade marks.—(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which —

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labeling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly."

"30. <u>Limits on effect of registered trade mark.</u>—(1) Nothing in section 29 shall be construed as preventing the use of a registered trade mark by any person for the purposes of identifying goods or services as those of the proprietor provided the use—

(a) is in accordance with honest practices in industrial or commercial matters, and

(b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.

(2) (a) …..
(b) …..
(c) …..

(d) …..

(e) **the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act."**

31. A reading of sub-section (1) of Section 28 of the Act shows that the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act. Sub-section (1) of Section 28 very clearly signifies the registration of a trademark in two streams i.e. "Goods" and Services", therefore, the intention of the legislature is very clear that one will not overlap/interchange the other. In the present case, since the appellant-plaintiff is holding the registered trademarks in the Class 30 which is categorized as 'Goods' and the respondent-defendant is having registered trade mark under Class 35 which is categorized as 'Services', therefore, both will have independent field of operation and therefore, in the opinion of this Court, the same will not have any overlapping effect with each other. Sub-section (3) of Section 28 of the Act will have to be read in conjunction with sub-section (1) of Section 28 of the Act. Sub-section (3) to Section 28 of the Act refers to a particular class and therefore, when two or more persons are registered proprietors of trademarks which are identical or nearly resemble with each other, will be taken to be in that particular class and, therefore, sub-section (3) of Section 28 of the Act will not come in the way for

maintaining the suit filed by the appellant-plaintiff against the respondent-defendant as both are holding registration in different classes.

32. Hon'ble Delhi High Court in the case of ***A. Kumar Milk Foods P. Ltd. Vs. Vikas Tyagi & Anr.*** Reported in ***2013 SCC Online Del 3439***, observed as under:

> "28. Section 28(3) of the TM Act cannot be interpreted in a manner that would be contrary to the above scheme of the Act and Rules. In other words Section 28(3) of the TM Act should be understood as not permitting an infringement action being brought by one registered proprietor against another only where two conditions are satisfied: one, that the two registered marks "are identical with or nearly resemble each other"; and two, they are in respect of the same class of goods and services. This will be in conformity with the object of Section 28(1) read with Section 29 of the TM Act which seeks to grant protection to the registered proprietor of a mark from infringement in respect of the goods for which registration is granted."

33. The argument of learned counsel for the respondent – defendant that Section 29 of the Act also prohibits to bring in a suit for infringement against the registered trade mark holder "in the course of trade", is noted to be rejected on the ground that Section 29 of the Act speaks about infringement of the rights of a registered trade mark holder by an unregistered trade mark holder during the course of trade and therefore, there is no distinction between "Goods" and "Services" in that case. The words during the "course of trade" used in this section does not make any distinction if an unregistered trade mark holder is violating the

right (infringement) of a registered trade mark holder. In the opinion of this Court, the argument of the learned counsel for the respondent-defendant is having no application in the present set of facts where trade marks of both the appellant-plaintiff and respondent-defendant are registered for clear and distinct classes and therefore, for the same reasons, the learned trial court has also committed an error while considering Section 30 (2) (e) of the Act that rights of a registered trade mark holder are not infringed where the use of trademark, being one or two or more persons registered under this Act. It is no doubt that both the trademarks of the appellant- plaintiff and defendant are registered but they are registered under different classes in respect of 'Goods' & 'Services' and, therefore, Section 29 and Section 30 (2) (e) are having no application.

34. Hon'ble the Supreme Court in the case of ***S. Syed Mohideen vs. P. Sulochana Bai reported in*** ***(2016) 2 SCC 683*** observed as under:-

> "Section 28(3) of the Act provides that the rights of two registered proprietors of identical or nearly resembling trademarks shall not be enforced against each other. However, they shall be same against the third parties. Section 28(3) merely provides that there shall be no rights of one registered proprietor vis-a-vis another but only for the purpose of registration. The said provision 28 (3) nowhere comments about the rights of passing off which shall remain unaffected due to overriding effect of Section 27(2) of the Act and thus the rights emanating from the common law shall remain undisturbed by the enactment of Section 28(3) which clearly states that the rights of one registered proprietor shall not be enforced against the another person."

35. The Delhi High Court in the case of ***Rana Steels vs. Ran India Steels Pvt. Ltd. Reported in 2008 (102) DRJ 503*** observed as under:

> 22. Since the defendant has taken the defense of Section 30(2)(e), it also needs to be taken note of. This provision stipulates that a registered trade mark is not infringed where there is use of a registered trade mark, being one of two or more trade marks registered under the said Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under the said Act. Thus, where there are two registered trade marks, which are identical or nearly resemble each other, the use of such trade marks by their respective registered proprietors would not amount to infringement of the others' registered trade mark. But, when can there be registration of marks which are identical or similar? Section 9 of the said Act, inter alia, absolutely prohibits the registration of trade marks which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person. Section 11(1), save as provided in Section 12, also conditionally prohibits the registration of a trade mark if, because of its (a) identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or (b) similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark. Section 12 permits the registration of trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services in cases of honest concurrent use or of other special circumstances. It is obvious that where identical or similar trade marks are registered in relation to the same or similar goods or services in exercise of the powers under Sections 11 and 12, the use of such marks by their respective proprietors would not amount to infringement. This is what is specifically provided for under Section 30(2)(e).
>
> 23. But, does Section 30(2)(e) also cover cases where identical or similar trade marks are registered in respect of different classes of goods or services? The answer is - No. Section 28 deals with the rights conferred by registration. And, it has already been clarified that the use of a registered mark must be in relation to the goods or services in respect of which the trade mark is registered. It follows that where the goods or services, in respect of

> which two or more identical or similar (nearly resemble) marks are registered, are different then Section 30(2)(e) does not come into play. The question of infringement would, itself, not arise as the registered marks would be used in respect of different classes of goods or services by their respective proprietors."

36. This Court also takes note of the fact that the suit filed by the appellant- plaintiff is for the relief of infringement and passing off both and, therefore, as per mandate of Section 27 of the Trademarks Act, 1999, the suit for passing off cannot be dismissed by invoking provisions of Section 28(3), Section 29 and Section 30(2)(e) of the Act as the suit for passing off is not affected by the fact that the respondent-defendant and appellant-plaintiff are having similar trademarks registered or not.

37. It is also noted that on one hand, the respondent- defendant has filed a suit for dissolution of the partnership and rendition of accounts considering himself to be a partner in the firm M/s Z.A. Kanorwala and on the other hand, he has secured a registration under Class 35 of the Trademarks "ZK" registration No.1276741. It is also noted that registration of the trademark is challenged by the appellant- plaintiff by filing a rectification application and the same is also pending consideration before the Hon'ble Gujarat High Court. Therefore, in the considered opinion of this Court, the application preferred by the respondent-defendant under Section 28(3), Section 29 and Section 30(2)(e) of the Act cannot be invoked for dismissal of the suit without adjudicating the suit on merit by framing of the issues and after evaluating the evidence on record. The learned trial court has committed an error while deciding the application in a similar fashion to the provisions of

Order 7 Rule 11(d) of the Code of Civil Procedure, 1908. The matter requires adjudication after framing of the issues and evaluating the evidence on merit.

38. Learned counsel for the respondents though has submitted that the composite suit is not maintainable, but he has not supported his arguments by any provision of law or any judgment in support of his contentions, therefore, the same is noted to be rejected. Besides, this Court feels that there is no provision which prohibits filing of the suit with the prayers of passing off and infringement.

39. The judgments relied upon by the learned counsel for the respondents are having no application in the present set of facts and, therefore, they are clearly distinguishable from the facts of the present case.

40. In view of the discussion made above, the first appeal merits acceptance and the same is allowed. The order dated 02.09.2022 is quashed and set aside. As the suit is pending consideration since the year 2020, therefore, the learned trial court is directed to decide the pending suit within a period of one year from the date of receipt of a certified copy of this judgment in accordance with law.

41. Needless to say, the counter-claim filed by the respondent-defendant shall also be revived and also be decided along with the suit proceedings.

(VINIT KUMAR MATHUR),J

Anil/Vivek Mishra/-