

**3 SCOB [2015] HCD 93****High Court Division  
(Civil Revisional Jurisdiction)**

CIVIL REVISION NO. 1204 OF 2012

**Abul Khair Tabbaco and others**  
... Petitioners

-Versus-

**Registrar of Taxes and others**  
... Opposite Party

Mr. Tanjib-ul-Alam, Advocate

..... For the Petitioners

Mr. A. M. Aminuddin, Advocate,

..... For Opposite Party

Heard on- 27.07.2015, 16.08.2015

Judgment dated: 23.08.2015

**Present:****Mr. Justice Borhanuddin****Trade Marks Act, 2009****Section 102:****When rectification proceeding is pending before this court, Suit for infringement of Trademark pending in the Court below should be stayed in view of Section 102 of the Trade Marks Act, 2009. ... (Para 16)****Judgment****Borhanuddin, J:**

1. This Rule has been issued calling upon opposite parties to show cause as to why order no.20 dated 23.02.2012 passed by the learned Additional District Judge, 2<sup>nd</sup> Court, Dhaka, in Title Suit No. 45 of 2010, should not be set aside and/or such other or further order or orders passed as to this court may seem fit and proper.

2. Facts relevant for disposal of the rule are that opposite party no.2 herein as plaintiff instituted Title Suit No.45 of 2010 in the Court of learned District Judge, Dhaka, praying for perpetual injunction against infringement of Trade Marks and passing off goods under the Trade Marks Act, 2009, impleading the petitioner as defendant no.1 contending inter alia that the plaintiff company incorporate in Bangladesh having engaged in the business of manufacturing and marketing tobacco and registered proprietor of the brand and trademark BRISTOL with its design and get up; The Trade Mark has been registered in the office of the Registrar of Trade Marks as TM 25519 dated 21.06.1987 under Class 34; The name BRISTOL was first registered by the plaintiff in 1942 and thereafter with changing demand of the consumers, new packs of BRISTOL cigarettes were introduced; On 06.08.2009, plaintiff applied for Trade Mark registration of a new pack design of BRISTOL and obtained value added tax (hereinafter called 'VAT') approval in this regard; On 10.08.2010, plaintiff again applied for Trade Mark registration of a new pack design as BRISTOL; By virtue of long usage and registration of the mark BRISTOL in respect of cigarettes, plaintiff has acquired exclusive right over the trade mark BRISTOL alongwith its design, style and get up; Recently plaintiff came to know that the defendant no.1 distributing leaflets in various trade outlets across the country introducing a new product namely BRISDOL with almost same get up as plaintiff's product BRISTOL; Plaintiff requested defendant no.2 in writing with copies to the defendant no.3 and other concerned authorities not to grant approval of the Mushak-1 form of BRISDOL submitted by defendant no.1; Defendant nos.2 and 3 have not replied; In

the meantime, defendant no.1 started manufacturing and marketing similar goods by adopting BRISDOL as a trade mark with similar colour, design and get up; Defendant no.1 by using a deceptively and phonetically similar trade mark infringing trade mark of the plaintiff and also passing of their product as the product of plaintiff and thus infringing plaintiff's intellectual property right and causing irreparable loss and damage to the plaintiff; Hence, the suit.

3. Defendant no.1 filed written statement denying material allegations made in the plaint and contending interalia that the defendant is a limited company incorporated in Bangladesh under the Companies Act and engaged in the business of manufacturing and marketing various tobacco products in Bangladesh since 1998; In course of business, defendant adopted its trademark BRISDOL and started using the same on its product; On 27.09.2010, defendant applied to the Commissioner of Customs, Excise and VAT, Comilla Division for fixation of price of the goods contains 10 sticks in a pack and VAT authority determined and fixed the value vide memo dated 05.10.2010; Defendant applied to the Registrar of Trade Marks for a report whether any application pending for trademark similar to or identical with the defendant's trademark BRISDOL; No report was available indicating that there is any registered trademark BRISDOL; Following the search, defendant applied to the Registrar of Trademarks for registration of its trademark BRISDOL on 27.09.2010 and the same has been registered as Trademark Application No.136200 under class 34; Defendant's further applied for amendment of the application in prescribed form TM-16 on 13.10.2010; Following fixation of retail price by the VAT authority and by virtue of pending application before the Registrar of Trade Marks, defendant manufactured and marketed its products bearing the trade mark BRISDOL in the month of September, October 2010 and paid huge amount of revenue to the Government exchequer; Upon enquiry, defendant came to know that plaintiff applied for the first time on 19.08.2009 for fixation of price of cigarettes bearing the trademark BRISTOL containing 20 sticks in each pack; VAT authority in the course of price fixation process afforded a hearing wherein plaintiff confirmed that the trademark BRISTOL has not been used for the last 22 years which is apparent from averments of the plaint filed by the plaintiff; As such, plaintiff's trademark is liable to be struck off from the register; Though plaintiff obtained price declaration for BRISTOL in the month of September, 2009, it never marketed its product under the said brand name until the defendant produced and marketed its product with trade mark BRISDOL on 27.09.2010 and obtained price approval from the VAT authority on 05.10.2010; Defendant no.1 manufacturing and marketing its product under trade name of BRISDOL indentifying the same as a product of Abul Khair Tobacco Company Limited as such, there had not been any infringement of any trademark of the plaintiff inasmuch as the plaintiff had lost its trademark due to non use of the same for a long time; Furthermore, design and get up of the defendant's product is distinctive and dissimilar from that of the plaintiff's as such, there had not been any violation on the part of the defendant of any provision of the Trademarks Act, 2009; Defendant is the prior user of the trademark BRISDOL; Suit is liable to be dismissed.

4. On 23.03.2012, defendant no.1 filed an application in the suit under Section 102 of the Trademarks Act, 2009 read with section 10 of the Code of Civil Procedure praying for stay proceeding of the suit contending interalia that defendant no.1 being petitioner filed Trademarks Application No.5 of 2010 impleading the plaintiff as opposite party in the High Court Division of Bangladesh Supreme Court under Section 98(1) read with section 42(1)(Kha) of the Trade Marks Act, 2009, for rectification of the Register of Trade Marks by way of striking off the Trade Marks No.10335 in Class-34 and being application no.135119 dated 10.08.2010. Upon hearing the applicant, this Division issued rule and stayed operation of the Registration of Trademark no.10335 dated 11.11.1942, Trade Mark No.25519 dated

21.06.1987 and Trade Mark No.28744 dated 10.05.1989 in respect of BRISTOL under Class-34, for a period of 3(three) months vide order dated 31.10.2010. Being aggrieved, Opposite party no.2 of the application i.e. plaintiff of the Title Suit filed Civil Petition for Leave to Appeal No.2527 of 2010. After hearing the petitioner, Appellate Division stayed operation of the order passed by the High Court Division till 31.3.2011. As such, proceeding of Title Suit No.45 of 2010 for infringement of trademark is required to be stayed till disposal of the rectification proceeding pending in the apex court.

5. After hearing the parties and perusing relevant papers/documents, learned Additional District Judge, 2<sup>nd</sup> Court, Dhaka, rejected the application holding that Title Suit and Trademarks application are two different type of cases with separate relief.

6. Having aggrieved by and dissatisfied with the order, defendant no.1 as petitioner preferred this revisional application under section 115(1) of the Code of Civil Procedure and obtained the present rule with an order of stay.

7. Mr. Tanjib Ul Alam appearing with Mr. Md. Hassan Habib, learned advocate for the petitioner by filing supplementary affidavit annexing Trade Marks Application no.5 of 2010 with annexures appended thereof and the order passed by the Appellate Division in Civil Petition for Leave to Appeal No.2527 of 2010 submits that the court below committed an error of law resulting in an error in the decision occasioning failure of justice in passing the impugned order without considering that the Title Suit for infringement of trademark is required to be stayed till disposal of the rectification proceeding regarding the trademark now pending in the High Court Division. He also submits that the court below committed an illegality in not considering that the matter in issue in Title Suit No.45 of 2010 is directly and substantially an issue in the Trade Marks Application no.5 of 2010 and as such, proceeding of Title Suit should be stayed till disposal of the Trade Marks Application by the High Court Division. He again submits that a suit for infringement of the trademark with regard to validity of registration between the parties should be stayed under Section 102 of the Trademarks Act, 2009, read with Section 10 of the Code of Civil Procedure when rectification proceeding regarding the same Trade Mark is pending in the higher court. He next submits that the fact that trademark application filed after institution of the suit is immaterial for the purpose of stay. He further submits that court can stay proceeding of a suit even if it does not come within the purview of section 10 of the Code of Civil Procedure for ends of justice to avoid unnecessary harassment to any party. In support of his submissions, learned Advocate referred to the case of Chandra Bhan Dembla Trading, Delhi, vs. Bharat Sewing Machine Co., Bikaner, reported in AIR 1982 Delhi, 230 and the case of Mst. Arifa Begum vs. Khulque Mohammad Naqvi, reported in 21 DLR (WP) 209.

8. On the other hand Mr. A. M. Aminuddin with Mr. M. Mushfiqur Rahman, learned advocates appearing for the opposite party no.2 submits that Appellate Division vide order dated 15.05.2013 passed in Civil Petition for Leave to Appeal No.2527 of 2010 send the Trade Marks Application no.05 of 2010 to this Division for early disposal on merit but the petitioner did not take any step for hearing of the application. He also submits that if the Title Suit is stayed till disposal of the Trade Marks Application then the opposite party no.2 shall suffer irreparable loss and injury inasmuch as Title Suit is filed for permanent injunction against infringement of trademark and passing of goods by the defendant no.1.

9. Heard the learned advocates. Perused revisional application, supplementary affidavit and annexures appended thereof.

10. It appears that upon hearing the Trade Marks Application no.5 of 2010 filed by the petitioner, this Division issued rule and also stayed operation of the registration of the opposite party no.2 relating to its product under trade name BRISTOL for a period of 3(three) months. Against the order, opposite party no.2 as petitioner filed Civil Petition for Leave to Appeal No.2527 of 2010 before the Appellate Division of this court and prayed for stay of the order passed by this Division. Upon hearing the petitioner, Hon'ble Judge-in-Chamber stayed order of this Division till 31.03.2011. After hearing the parties, Appellate Division disposed of the leave petition with following observation:

*“Upon hearing the learned Advocate, we are of the view that the ends of justice would be best served, if the Rule itself is disposed of on merit by the High Court Division.*

*Let this rule be heard and disposed of by the High Court Division as early as possible. The parties, if so advised may take steps for early disposal of the said Rule without any adjournment. However, the order of stay granted earlier by the learned Judge in Chamber be continued till disposal of the said Rule”.*

11. It is apparent that in spite of said order by the Appellate Division, neither the petitioner nor the opposite party no.2 took step for disposal of the Trademarks Application no.5 of 2010.

12. Opposite party no.2 as plaintiff instituted Title Suit no.45 of 2010 for permanent injunction against infringement of the trademark and passing off goods under the Trade Marks Act, 2009, claiming defendant no.1 of the suit infringing plaintiff's intellectual property right and thereby causing irreparable loss to the plaintiff.

13. On the other hand, defendant no.1 of the suit i.e. present petitioner filed written statement denying the allegation contended that defendant is the prior user of the trademark BRISDOL, design and get up of the same is distinctive and different. Further contending that plaintiff did not use the trademark BRISTOL for a long period of 22 years as such, defendant's trademark is liable to be struck off from the register.

14. The petitioner filed Trade Marks Application no.5 of 2010 under Section 98(1) read with Section 42(1) l(Kha) of the Trade Marks Act, 2009 for rectification of the Register of Trade Marks. After filing written statement, defendant no.1 of the Title Suit filed an application under Section 102 of the Trade Marks Act, 2009 read with Section 10 of the Code of Civil Procedure to stay proceeding of the suit till disposal of the Trademark Application.

Section 102 of the Trade Marks Act runs as follows:

***“102. Stay of proceeding where the validity or registration of the trademark is questioned-(1) Where in any suit for the infringement of a trademark, the defendant pleads that the registration of the plaintiff trademark is invalid; or the plaintiff pleads the invalidity of the registration of the defendant's trademark, the Court trying the suit hereinafter referred to as the Court, shall:***

*(a) if any proceedings for rectification of the Register in relation to the plaintiffs or defendant's trademark are pending before the Registrar or the High Court Division, stay the suit pending the final disposal of such proceedings.*

*(b) if no such proceedings are pending and the Registrar is satisfied that the plea regarding the invalidity of the registration of the plaintiffs or defendant's trademark is prima facie tenable, raise an issue regarding the same and adjourn the case for a period of 3(three) months from the date of framing of the issue in*

*order to enable the party concerned to apply to the High Court Division for rectification of the Register.”*

15. Since plaintiff instituted Title Suit no.45 of 2010 praying permanent injunction against the defendant no.1 i.e. petitioner of the Trademark Application for infringement of Trade Mark and passing off goods under the Trade Marks Act and the defendant of said suit as applicant filed Trademark Application no.5 of 2010 before this Division under Section 98(1) read with Sections 48(1)(kha) of the Trade Marks Act, for rectification of the register of Trade Marks, I cannot agree with the finding of court below that Title Suit filed by the plaintiff and the Trademarks application filed by the defendant no.1 of the suit as applicant are two different type of cases and reliefs are also different.

16. It appears that Title Suit no.45 of 2010 and Trademarks Application no.05 of 2010 are between the same parties challenging Trademark of one another. Defendant no.1 stated in his written statement that plaintiff did not use the trademark for the last 22 years as such plaintiff's trademark is liable to be struck off from the register. Defendant no.1 of the suit as applicant filed Trade Marks Application no.05 of 2010 under Section 98(1) read with Section 42(1)(kha) of the Trade Marks Act, 2009, for rectification. Title Suit and Trade Marks Application arising out of same dispute between the same parties. Suit is for infringement of Trade Mark and Application is for rectification challenging validity of registration of Trade Marks of each other. When rectification proceeding is pending before this court, Suit for infringement of Trademark pending in the Court below should be stayed in view of Section 102 of the Trade Marks Act, 2009. I find support of this view in the case of Chandra Bhan Dembla Trading, Delhi, -Vs- Bharat Sewing Machine Co. Bikaner, reported in AIR 1982 DELHI 230, wherein it is held:

*“A suit for infringement of trademarks in which the contest between the parties is with regard to validity of registration of each other, can be stayed when rectification proceedings regarding the trademarks are pending.”*

17. Under the facts and circumstances of the case and for the reasons stated above, I am of the view that Court below committed an error of law resulting in an error in the decision occasioning failure of justice in passing the impugned order.

18. Accordingly, rule is made absolute.

19. Order dated 23.02.2012 passed by the learned Additional District Judge, 2<sup>nd</sup> Court, Dhaka, in Title Suit no.45 of 2010 is set aside.

20. Order of stay granted at the time of issue of the Rule and extended from time to time is hereby vacated.

21. In view of the order passed by the Appellate Division, the parties are directed to take necessary step for early hearing of Trade Marks Application no.5 of 2010.