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

+ **W.P.(C) 9636/2018 & CM Nos. 37483-37484/2018**

AMIT JAIN

..... Petitioner

Through: Mr Vivek Agarwal, Advocate.

versus

THE REGISTRAR OF TRADE MARKS & ANR Respondents

Through: Mr Anurag Ahluwalia, CGSC with
Mr Abhigyan Siddhant, Advocates for
R-1 alongwith Mr Rahul Kumar,
Examiner of TM for UOI.

Mr Sohail Dutt, Sr. Advocate with Mr
Sudarshan Bansal and Mr Avi
Bhandari, Advocates for R-2.

CORAM:

HON'BLE MR. JUSTICE VIBHU BAKHRU

ORDER

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14.09.2018

VIBHU BAKHRU, J

1. The petitioner has filed the present petition under Article 226 & 227 of the Constitution of India, *inter alia*, impugning the order dated 22.03.2018 passed by respondent no.1 (hereafter 'the Registrar'), whereby the Registrar has allowed the interlocutory petition filed by respondent no.2 (Kuljeet Singh Wadhwa) and has renewed the trademark "ZOHRA" (hereafter 'the impugned trademark') under the application no. 1279584 in class 03.

2. The petitioner is engaged in manufacturing and marketing of cosmetic goods under the name of his sole proprietorship concern, M/s Vinayak Industries.
3. On 20.04.2004, a partnership firm – M/s Wadhwa Trading Co. – which consists of two partners, namely, Mr Kulwant Singh Wadhwa and Mr Kuljeet Singh Wadhwa (respondent no.2) applied for the registration of the impugned trademark and was granted the Registration Certificate on 27.10.2005. The registration of the impugned trademark is valid till 20.04.2014.
4. On 23.09.2010, respondent no.2 filed a notarized copy of the Dissolution Deed dated 31.12.2009 along with Form TM-24 informing the Registrar that the said partnership firm was dissolved and he had become the sole proprietor of the firm (M/s Wadhwa Trading Co.). Accordingly, he requested the Registrar to register him as the proprietor of the impugned trademark. The petitioner claims that the said respondent no.2's request was not considered.
5. On 24.12.2017, respondent no.2 filed an Interlocutory Petition along with an affidavit before the Registrar alleging non receipt of notice regarding renewal of the impugned trademark.
6. On 03.01.2018, the petitioner filed a Rectification petition before the Registrar seeking rectification of the impugned trademark, as the impugned trademark was showing as "Registered" on the website of the Trademark Registry, although, according to the petitioner, the same was not renewed.

7. On 01.02.2018, the petitioner filed a Civil Suit bearing no. CS (COMM) 369/2018 under the Trademarks Act, 1991 and the Copyright Act, 1957 against respondent no.2 before a Coordinate Bench of this Court regarding the use of the trademark – ZOHAR.

8. The said suit was disposed of by the Coordinate Bench of this Court on 16.02.2018 by recording respondent no.2's undertaking that he is not using the trademark "ZOHAR" and he would not use the same in future.

9. The petitioner states that respondent no.2's interlocutory petition was taken up on 21.03.2018 and on 22.03.2018, the Registrar had passed an order restoring the impugned trademark. Subsequently, respondent no.2 filed Form TM-R requesting for renewal of the Registration of the impugned trademark under Application No. 1279584 in Class 3.

10. Thereafter, on 04.04.2018, respondent no.2 filed a Civil Suit before the learned ADJ, Karkardooma Courts (being Suit No. 369/2018), *inter alia*, alleging infringement of the impugned trademark by the petitioner. It is stated that respondent no.2 had filed the said suit in his capacity as a registered owner of the impugned trademark.

11. The petitioner now seeks to challenge the restoration/renewal of the impugned trademark in favour of respondent no.2. The petitioner claims that respondent no.2's application for being substituted as a registered proprietor of the impugned trademark had not been allowed and, therefore, he could not have sought its renewal / restoration. The learned counsel appearing for the petitioner earnestly contended that the registration of the impugned trademark in favour of respondent no.2 and its renewal / restoration was

fraudulent as the Dissolution Deed dated 31.12.2009 filed by respondent no.2 with the Registrar was different from the deed filed in the suit instituted by respondent no.2. He contended that production of two different dissolution deeds was *ex facie* fraudulent and, therefore, action of the Registrar in restoring / renewing of the impugned trademark is liable to be set aside.

12. This Court is not persuaded to accept that any interference with the action of the Registrar in restoring/renewing the impugned trademark is warranted. Admittedly, the firm M/s Wadhwa Trading Co. was the registered proprietor of the impugned trademark. The said firm was constituted by two partners – respondent no.2 and his brother Kulwant Singh.

13. Respondent no.2 claims to have acquired the exclusive ownership of the impugned trademark on dissolution of the firm. Plainly, the petitioner has no locus to challenge this assertion. If this assertion was incorrect, the only person having locus to challenge the same would be the brother of respondent no.2. He has not raised any objections in this regard. The question as to how respondent no.2 and his brother have divided their assets amongst themselves is of no concern of the petitioner.

14. Respondent no.2 had also filed the Dissolution Deed dated 31.12.2009 with the Registrar. The petitioner claims that a different document has been produced in the suit although, it is similarly worded. This Court does not consider it apposite to entertain any controversy in this regard in these proceedings, as respondent no.2's brother has not raised any challenge in

this regard. The Registrar has proceeded on the basis that the firm Wadhwa Trading Co. had dissolved and respondent no.2 has taken over all its assets. This Court finds no infirmity with the Registrar in proceeding in such manner as the respondent no.2 had produced a dissolution deed indicating that Mr Kulwant Singh Wadhwa yielded his rights to all assets of the firm Wadhwa Trading Co. in favour of respondent no.2. As observed earlier, respondent nos.2's brother has not objected to the same.

15. It is also relevant to note that respondent no.2 had applied for substitution during the initial term of the registration of the impugned trademark and, therefore, respondent no.2 cannot be faulted in this regard. Although, the impugned trademark has been renewed much after the validity of the same had expired; however, this Court finds no infirmity with such renewal either. In terms of Rule 58 of the Trade Mark Rules, 2017 – which is *pari materia* with Rule 64 (1) of the Trade Mark Rules 2002 – the Registrar is required to issue a notice (in form RG-3) to the registered proprietor of a trademark regarding the approaching date of expiry of the trademark not more than six months prior to the date of expiry of the registration. If the same was not done, the grievance of respondent no.2 was justified and the decision of the Registrar to renew the registration of the impugned trademark was necessary.

16. It is also important to note that in terms of Rule 59 of the Trade Mark Rules, 2017 (*pari materia* to Rule 65 of the Trade Mark Rules, 2002) the Registrar is required to remove the trade mark which has not been renewed and advertise the fact forthwith in the journal. In terms of Rule 66 of the Trade Mark Rules, 2002, on advertisement of such removal, the registered

proprietor has one further opportunity to seek renewal of the trademark. There is no averment in the petition, which indicates that any such advertisement was issued. Further, concededly, the status of the impugned trademark continued to be reflected as registered. In the circumstances, the action of the Registrar renewing the impugned trademark cannot be faulted. (See: *M/s Epsilon Publishing House Pvt Ltd v. Union of India and Ors.*: *W.P.(C) 5568/2017, decided on 18.09.2017*).

17. The petition is unmerited and is, accordingly, dismissed. All the pending applications are also disposed of.

18. It is clarified that nothing stated herein would prejudice the rights and contention of the parties in the action/proceedings instituted by them.

SEPTEMBER 14, 2018
MK/RK

VIBHU BAKHRU, J