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

+ **CRL.M.C. 5376/2022 & CRL.M.A. 16153/2023**

PARMOD KUMAR JAIN

..... Petitioner

Through: Mr.N.Mahabir, Mr.Chetan Kumar,
Mr.Naveen Gupta and Mr.Prakash,
Advocates

versus

STATE & ORS.

..... Respondents

Through: Ms.Shubhi Gupta, APP for the State.
Insp.Anant Kiran, DIU/L
Ms.Priya Adlakha, Mr.Vikram Rana
and Ms.Rima Majumdar, advocates
for respondents no.2 and 3.
(Mobile 9818202368)

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Date of Decision: 02.06.2023

CORAM:

HON'BLE MR. JUSTICE DINESH KUMAR SHARMA

J U D G M E N T

DINESH KUMAR SHARMA, J. (Oral)

1. Present petition has been filed for quashing of case FIR No. 0189/2022 dated 06.08.2022 registered under Sections 103/104 of Trade Mark Act, 1999 at PS Hauz Qazi.
2. Ld. Counsels for both the parties submit that the present dispute arose from a trade mark issue which has now been amicably settled between the parties. A joint settlement application has been moved by both the parties in terms of the order dated 12.04.2023.

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3. It has been submitted that the petitioner is a trader and importer of Fire Hoses, Fire sprinklers, Fire blankets, Fire Fighting Equipment, Fire Fighting monitors, Fire Extinguishing Apparatus, Fire Beaters, Fire-Fighting Equipment etc. under the trademarks FORCE and AQUA. It has further been submitted that the marks FORCE and AQUA were coined by the Petitioner in the year 2006 and is in commercial use since 2006. It has been submitted that by virtue of the long and continuous use of the trademarks FORCE and AQUA for more than sixteen years the same has acquired secondary meaning, become highly distinctive with the Petitioner only and no one else. It has been submitted that by virtue of prior adoption, prior use coupled with extensive publicity and promotion, the Petitioner has exclusive common law and proprietary interest in the trademarks FORCE and AQUA. It has further been submitted the petitioner is the owner and registered proprietor of the trademarks FORCE and AQUA in relation to their goods/products and services.
4. The respondent no. 2 claims to be a non-profit organization which certifies safety of various articles including fire sprinklers and is the proprietor of certification trademark 'UL' which is claimed to be registered in India. Respondent no. 2 further permits use of the certification trademark UL on fire sprinklers on payment of an annual license fee. Allegedly, on the payment of the same, the petitioner was stated to be entitled to use the aforesaid trademark UL on their articles. Respondent no. 3 is claimed to be a subsidiary of respondent no. 2 and



carries out all business of respondent no. 2 in India under its authorization.

5. The parties submit that the FIR was registered on the basis of a police complaint filed on behalf of UL LLC (inadvertently mentioned as Underwriter Laboratories-UL in the complaint) which is a global safety science company headquartered in Northbrook, Illinois, alleging infringing of trademark 'UL' under the Trademark Act, 1999, on the basis of which, a raid was conducted by the police on 18.08.2022 on the premises of the petitioner and goods were seized. Basis the said complaint the present FIR was registered.
6. It has been submitted that however during the pendency of the present petition, the parties have amicably settled the dispute and the petitioner has issued an undertaking dated 23.03.2023 to respondent nos.2 and 3 which is as under:

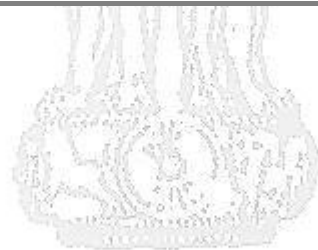
सत्यमेव जयते



In recognition of your ownership and proprietary rights in the certification mark UL, I, **Parmod Kumar Jain** son of Dhan Kumar Jain of the address 96, Ram Vihar, Vikas Marg Extension, Karkardooma, East Delhi, Delhi- 110092, irrevocably state and undertake to you as under:-

1. That I am operating sole proprietorship businesses under the names of M/s Sunrise Impex India, from the address Shop No. 9, 1st floor, Raghu Shree Market, Ajmeri Gate, Delhi- 110006 and M/s R.R. Incorporation from the addresses Shop No. 20, 1st Floor, Raghu Shree Market, Ajmeri Gate, Delhi-110006 and also at Shop No. 8, 1st Floor, Raghu Shree Market, Ajmeri Gate, Delhi- 110006. Under the same firms, I have been importing and trading fire hoses, fire sprinklers, fire blankets, firefighting equipment and monitors, fire extinguishing apparatus, fire beaters, etc., in the brand names of 'Force' and 'Aqua'.
2. That after the termination of my Global Service Agreement with UL Company and Multi-listing agreement with Zhejiang KSFCO Fire Fighting Equipment Co. Ltd. (ML File No. EX28658), I also imported fire sprinklers bearing the unauthorized UL certification mark from Guangwei Fire Fighting Scie Tech Co. Ltd. of the address Nanau, Fujian Province, China, without the permission or authorization of UL Company. Pursuant to which, a raid was conducted at my aforementioned business premises and fire sprinklers bearing unauthorized UL Certification marks were seized by the police and FIR No. 189/2022 was registered against me by P.S. Hauz Qazi, Delhi on August 06, 2022.

I understand and acknowledge that my act of importing and trading fire sprinklers bearing the unauthorized UL certification mark, amounts to infringement of UL Company's registered certification marks and also copyright of UL logo.



सत्यमेव जयते



4. In recognition of your valid intellectual property rights subsisting in the UL Certification Marks and UL trade marks/copyright, I have agreed to henceforth forever refrain from trading/importing/stocking/ possessing/selling/offering for sale any goods, including fire hoses, fire sprinklers, fire blankets, firefighting equipment and monitors, fire extinguishing apparatus, fire beaters, sprinkler hoses, and sprinkler hoses with fittings bearing unauthorized UL Certification Mark, either in India or any part of the world, except without the express written permission and authorization from UL Company.
5. I also agree and undertake that I will not apply for registration of the trade mark UL or any other mark deceptively similar thereto, in respect of my goods, services and business in future. I also undertake not to challenge the validity of the UL Certification Marks, trade marks and copyright in future.
6. I also agree and undertake to take steps for removal of all my business listings, paid as well as unpaid on third party portals, bearing references to the impugned mark UL within a period of 7 days after quashing of the FIR. I also undertake to destroy all my printed stationery carrying references to the mark UL, including but not limited to those on my shop/warehouse(s) premises, in the presence of the representative of UL Company. Snapshots of some of the business listings on third party portals are as under:

1. Link: <https://www.amazon.in/Sunrise-Premium-Flexible-Sprinkler-Approved/dp/B073WF1ZUB>



2. Link: <https://www.amazon.in/Sunrise-Premium-Quality-Tyco-Sprinkler/dp/B073WDZ39C>

TRUE COPY

Paramod Kumar Tan



connect2india.com/Force-Hoses/5890880



Sunrise Impex India Premium Quality Tyco Fire Sprinkler 50 Pcs.

Brand: Tyco



Not available at this time.
We do not know when or if these items will be back in stock.

brand tyco
color Multi
material Other

about this item

- + Tyco make fire fighting sprinklers
- + pendant type
- + 68 degree
- + 1/2" NPT
- + UL and FM approved

3. Link: <https://connect2india.com/Force-Hoses/5890880>



4. Link: <https://forcehoses.com/about-us/>



Pardeep Kumar Jain

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Snapshots of the business stationery, shop/warehouse premises bearing the impugned mark UL is as follows:

Sunrise Impex India

No.9, 1st Floor, Ajmeri Gate, Raghunath Market, Delhi, 110006





RR Incorporation

No. 20, 1st Floor, Raghushree Market Ameri Gate Delhi 110006



7. I agree and undertake to pay UL Company a sum of INR 50,000 as nominal cost for the legal expenses it incurred, in initiating the legal action against me.
8. I agree and undertake that after quashing of the aforesaid FIR, out of the seized inventory those fire sprinklers wherein UL is mentioned only on the cap and not embossed on the body of the fire sprinkler, will be handed over to me after removing the cap, in the presence of the representative of UL Company at the date and time fixed by the Parties.

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9. I agree and undertake that after quashing of the aforesaid FIR, the inventory seized by the police wherein UL is embossed on the body of the fire sprinkler will be handed over by me to the representative of UL Company at the date and time fixed by the Parties for the purpose of destruction. The cost of conducting this destruction will be borne by me, and the destroyed material will be handed over to me for the purpose of selling it as scrap metal. Any fire sprinkler bearing the trade mark FORCE, embossed with the year 2021, will remain with me for disposal/sale.
10. I understand that, subject to compliance of the aforesaid terms, the dispute involved in FIR 189 of 2022 PS Hauz Qazi, Delhi will be amicably resolved and settled. UL Company will consent to the aforementioned FIR to be quashed at the time of hearing of the quashing petition being CRL. M.C. No. 5376 of 2022, filed by me in the Hon'ble Delhi High Court.
11. I confirm and agree that I will abide by this undertaking and this will be applicable on my successors, legal heirs, associates, agents, partners, employees, licensees, sub-licensees, and/or anyone claiming under me directly/indirectly, in any manner.
12. I understand that I have no further claims or demands against UL Company and all disputes and differences have been amicably settled.
13. I hereby expressly state and confirm that the present undertaking is executed by me voluntarily out of my own will, without any duress or any sort of compulsion or undue influence on me, with the spirit to resolve the legal dispute arising from the aforementioned criminal proceedings.

Executant/Deponent
in my Presence

Dated this 07 day of March, 2023 at New Delhi.

7. The parties have also e-filed joint settlement application. Let the physical copy be placed on record. In the settlement application it has been submitted that in view of the settlement, the goods seized during the raid conducted consequent to the registration of the FIR may be released to the petitioner in the presence of the officials of respondent



no.3 for further disposal by the parties in the below manner on the same day of release of goods:

(i) Fire sprinklers wherein UL is mentioned only on the cap and not embossed on the body of the fire sprinkler, will be handed over to the Petitioner after removing the caps.

(ii) Fire sprinklers bearing the trade mark FORCE, embossed with the year 2021, will be handed over to the Petitioner for disposal/sale.

(iii) Fire sprinklers wherein UL is embossed on the body of the fire sprinkler (other than the fire sprinklers mentioned in para (ii) above) will be handed over by the Petitioner to the representative of Respondent No. 3 at the date and time fixed by the Parties for the purpose of destruction, or will be destroyed by the Petitioner in the presence of Respondent No. 3's representative. The cost of this destruction shall be borne by the Petitioner. This destroyed material can then be sold /disposed by the Petitioner as scrap only.

8. In terms of the settlement it has also been agreed that the petitioner shall pay to the respondent no. 2 a sum of Rs. 50,000/- as nominal cost for the legal expenses incurred in initiating the legal proceedings. Learned counsel for the petitioner undertakes that this amount shall be transferred through bank transfer to the respondent no.2 within a week.



9. Learned counsel for respondent nos. 2 and 3 state the respondents have entered into the settlement with the petitioner voluntarily, without any fear, force or coercion.
10. I have considered the submissions. The present complaint stems from a civil dispute of trade mark infringement. The parties have amicably settled all their disputes and no further grievance remain qua the petitioner. In terms of the settlement, the parties no longer wish to pursue the present complaint and have no objection if the same is quashed. Thus no useful purpose will be served in continuing with the present complaint. It has been repeatedly held in catena of judgments that in cases where the possibility of conviction is bleak on account of a compromise between the parties, this Court in its inherent jurisdiction under section 482 Cr.P.C can quash the proceedings to secure the ends of justice or to prevent the abuse of the process of this Court.
11. In terms of the settlement as incorporated in *para 6* of the joint application, the police is directed to release the goods and the same be disposed of in terms of the settlement
12. Taking into account the totality of facts and circumstances of the case, the present FIR No. 0189/2022 dated 06.08.2022 registered under Sections 103/104 of Trade Marks Act, 1999 at PS Hauz Qazi and all subsequent proceedings emanating therefrom are quashed.
13. The petition along with the pending applications stands disposed of.



DINESH KUMAR SHARMA, J

JUNE 02, 2023/rb..



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