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

+ LPA 270/2024 & CM APPL. 20376-379/2024

**SHRI VINAY RATHI & ORS.**

..... Appellants

Through: Mr.Jayant K Mehta, Sr Advocate with  
Mr.Kapil Wadhwa, Ms.Tejasvini Puri  
and Ms.Vasanthi Hariharan, Advs.

versus

**MR DHANANJAY RATHI & ORS.**

..... Respondents

Through: Mr.Rajshekhar Rao, Sr Advocate with  
Mr.Karan Bajaj, Mr.Rupin Bahl,  
Ms.Aastha Arora and Mr. Rajaxshi  
Roy, Advs. for R-1.

**CORAM:**

**HON'BLE MR. JUSTICE VIBHU BAKHRU**

**HON'BLE MS. JUSTICE TARA VITASTA GANJU**

**ORDER**

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**05.04.2024**

1. The appellants have filed the present appeal impugning the order dated 31.01.2024 passed by the learned Single Judge in CS(COMM) No.267/2022 captioned *Mr.Dhananjay Rathi v Shree Vasu Steels Pvt Ltd & Ors* whereby the learned Single Judge had returned the finding that the registration of the trademark *RATHI* in favour of the appellants is *prima facie* invalid. It is the appellants' grievance that the said finding, although *prima facie*, has been rendered without considering his contentions.

2. Indisputably, the appellants are the registered owner of the trademark *RATHI*, which has remained on the register since the year 1984. It is also not in dispute that the respondents were fully aware of the said registration and have acquiesced to the same. Section 33 of the Trademarks Act, 1999 sets out the effect of acquiescence. The said section is reproduced below for ready reference.



‘33. Effect of acquiescence.

(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark--

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark was not applied in good faith.

(2) Where sub-section (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark, or as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark may no longer be invoked against his later trade mark.’

3. It is apparent from reading of sub section (1) of Section 33 of the Trademarks Act, 1999 that when the proprietor of an earlier trademark – which is in this case the respondents claim they are – have acquiesced for continuous period of five years in the use of the registered trademark being aware of that use – which in this case is also admitted fact – the proprietor of an earlier trademark shall no longer be entitled on the basis of an earlier trademark to either apply for declaration that the registration of the later trademark is invalid or oppose the use of the later trademark in relation to the goods or services in relation to which it has been used.

4. The impugned order indicates that the same has not been considered. At this stage, Mr.Rajshekhar Rao, the learned senior counsel appearing for the respondents requests that the impugned order be set aside and the parties be given the liberty to re-argue the matter before the learned Single Judge.



5. In view of the above submissions, the impugned order dated 31.01.2024 is set aside. Consequently, the IA No.11562/2022 in CS (COMM) No.267/2022 is also restored before the learned Single Judge for decision afresh.

6. The appeal stands disposed of in the above terms. All Pending applications also stands disposed of.

**VIBHU BAKHRU, J**

**TARA VITASTA GANJU, J**

**APRIL 05, 2024**

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*Click here to check corrigendum, if any*