



2024:DHC:6223



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

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Date of Decision: 30.07.2024

+ C.O. (COMM.IPD-TM) 123/2021

IRVINDER KAUR CHADHA SUPREME AGENCIE

.....Petitioner

Through: Mr. Ajay Amitabh Suman, Mr. Shravan Kumar Bansal, Mr. Pankaj Kumar, Mr. Rishi Bansal, Mr. Deepak Srivastava, Mr. Rishabh Gupta, Mr. Mankaran Singh Ahluwalia, Advocates (M:9990389539)

versus

GARNISH ELECTRONICS PVT. LTD. AND ANR.

.....Respondents

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra and Mr. Alexander Mathai Paikaday, Advs.
M: 9810788606
Email: hvscgscdhc@gmail.com

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+ C.O. (COMM.IPD-TM) 173/2021

IRVINDER KAUR CHADHA SUPREME AGENCIEPetitioner

Through: Mr. Ajay Amitabh Sumar, Mr. Shravan Kumar Bansal, Mr. Pankaj Kumar, Mr. Deepak Srivastava, Mr. Risabh Gupta and Mr. Mankaran Ahluwalia, Advs.
M: 9990389539

versus

GARNISH ELECTRONICS PVT. LTD. AND ANR.Respondents

Through: Mr. Harish Vaidyanathan Shankar,



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CGSC with Mr. Srish Kumar Mishra
and Mr. Alexander Mathai Paikaday,
Advs.

M: 9810788606

Email: hvscgscdhc@gmail.com

CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA
MINI PUSHKARNA, J (ORAL)

1. The present petitions have been filed for removal of the trademark 'GARNISH' registered under no. 2970803 and 2970802 in Class 6 in favour of respondent no. 1, for rectification of the register of Trade Marks under Section 47/57/125 of the Trade Marks Act, 1999.
2. This Court has already noted in its previous order that respondent no. 1 has been served through its Trademark Agent and such service is valid in the eyes of law. However, with a view to give opportunity to respondent no. 1, further steps were directed to be taken to serve respondent no. 1, which have been taken by the petitioner.
3. It is noted that by order dated 19th March, 2024, directions had been issued to learned counsel for the petitioner to trace the correct address of respondent no. 1 and take appropriate steps, thereon.
4. Learned counsel appearing for the petitioner has drawn the attention of this Court to the alleged assignment deed dated 3rd November, 2010, purportedly in favour of respondent no. 1, to submit that the address of respondent no. 1 has been given in the said document. He submits that pursuant to the directions of this Court vide order dated 19th March, 2024, the petitioner sent another letter by speed post to the respondent no. 1. Thus, an affidavit has been filed on behalf of the petitioner, wherein, it is stated



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that complete paper book of the petition was sent to the address of respondent no. 1. However, the same has been returned on the ground that no such person resides in the address. The affidavit dated 11th July, 2024 filed by the petitioner reads as under:

“xxx xxx xxx

AFFIDAVIT

I, Rishabh Gupta, aged 29 years, S/o Shri Praveen Kumar Gupta, C/o. United and United, 52, Sukhdev Vihar, Mathura Road, New Delhi – 110025 do hereby solemnly affirm, depose and say as follows:

- 1. That I am one of the advocate for the petitioner, and therefore, can swear this Affidavit.*
- 2. That the subject matter rectification petition is pending adjudication before the Hon'ble Court.*
- 3. That on my instructions and in accordance of Hon'ble Court directions my court clerk namely Mr. Jaspal Singh has sent the complete paper book of the present petition at the new address of the Respondent No. 1, i.e., garnish Electronics Pvt., A-37, Rajouri Garden, New Delhi-110027 (Page 351 of the petitioner documents) as available in the court records. The copy of speed post receipts and tracking reports are attached herewith.*
- 4. That the contents of my above Affidavit are true and correct to my knowledge.*

xxx xxx xxx”

5. Therefore, it is observed that respondent no. 1 cannot be served on any other address. As noted hereinabove, the respondent no. 1 already stands served through Trademark Agent.

6. Accordingly, in view of the aforesaid circumstances, the present petition is taken up for hearing.

7. The facts in brief, as encapsulated in the pleadings, for adjudication of the present matters, are as under:

7.1 Father of the petitioner, i.e., Mr. H.S. Sethi, started his business of trading in “Hydraulic Door Closing Devices” under the name and style of



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‘GARNISH’ traders.

7.2 Mr. H.S. Sethi, adopted the trademark ‘GARNISH’ in relation to “Hydraulic Door Closing Devices”, which was also forming part of his tradename ‘GARNISH’ traders. The same was continuously used in relation to the said goods since 1st December, 1956. The father of the petitioner adopted a stylized manner of representation of the trademark ‘GARNISH’, as follows:

Garnish

7.3 The father of the petitioner registered the trademark ‘GARNISH’ in his favour under registration no. 372690 in Class 7 for “Hydraulic Door Closing Devices”.

7.4 The father of the petitioner assigned the trademark ‘GARNISH’ vide deed of assignment dated 28th January, 1993, in favour of brother of the petitioner, i.e., Shri Gurmeet Sethi, who conducted his business in the name of ‘M/s Galaxy International’.

7.5 Subsequently, the brother of the petitioner, i.e., Shri Gurmeet Sethi, executed a deed of assignment in favour of the petitioner on 3rd June, 1997, thereby assigning the trademark ‘GARNISH’ in her favour.

7.6 Thereafter, some family dispute arose between the petitioner on the one hand and her father, Shri. H.S. Sethi and her brother, Shri Gurmeet Sethi, on the other hand, which culminated into a civil suit, bearing *CS(OS) 1697/2005*, before this Court.

7.7 Afterwards, the petitioner arrived at an amicable settlement with her father and brother, wherein, they recognised the right of the petitioner herein to use the mark/name ‘GARNISH’ since the year 1983. The petitioner



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herein, as defendant in the suit also paid a sum of ₹ 51,00,000/- to her brother, Shri Gurmeet Sethi and also agreed to share 5 % from the annual sales turnover made by the petitioner herein in Northern India, from the sale of the products under the mark/name, 'GARNISH'.

7.8 Accordingly, thereafter the petitioner continued to be owner and proprietor of the trademark 'GARNISH' in relation to its goods and business.

8. On behalf of the petitioner, it is submitted as follows:

8.1 The petitioner is the owner and proprietor the trademark 'GARNISH' and has been honestly, bonafidely and continuously using the same commercially, openly and exclusively to the exclusion of others.

8.2 The petitioner has conducted substantial business under the said

Garnish

trademark. The petitioner has been regularly and continuously been promoting its said trademark through extensive advertisements, publicities, promotions and marketing.

8.3 In view of the petitioner's priority in adoption and use thereof, and goodwill acquired therein, the petitioner's trademark is distinctive and a coined trademark.

8.4 The respondent no. 1 has adopted identical/deceptively similar trademark 'GARNISH', as that of petitioner's trademark. The trademark registered under the impugned registrations in Class 6, in favour of respondent no. 1 has been obtained dishonestly, on the basis of alleged assignment deed dated 3rd November, 2010 in favour of respondent no. 1. The said assignment deed is purportedly a fabricated document, as the



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signatures of the father of the petitioner, are clearly forged.

8.5 The respondent no. 1 has not used the impugned trademark for a long time prior to filing of the present petition. Further, even the purported assigner of the respondent no. 1, had not himself used the alleged assigned registered trademark.

8.6 The petitioner is the prior user of the said trademark, with prior registration in her favour. Further, respondent no. 1 has not shown any user of the trademark in question. Thus, the impugned trademarks registered in favour of the respondent no. 1, are liable to be set aside.

8.7 The trademarks of the petitioner and respondent no. 1 are for similar Class of goods, i.e., “Door Closing Devices”. While the petitioner manufactures “Hydraulic Door Closing Devices”, the respondent no. 1 has registered his trademark for “Door Closing Devices”, which uses mechanical pressure. Therefore, in view of the prior user and prior registration of petitioner’s trademark, the registration in favour of respondent no. 1 would amount to passing off the goods of respondent no. 1, as that of the petitioner.

9. Learned counsel appearing for respondent no. 2, Registrar of Trade Marks submits that the present dispute being a private dispute between petitioner and respondent no. 1, the same may be decided on the basis of documents.

10. Having heard learned counsels for the parties and having perused the record, this Court at the outset notes that the submissions made by the petitioner as regards its prior user, registration, and non-user by respondent no. 1, has remained un-rebutted. There are no documents on record to show the user of the trademark in question by the respondent no. 1.



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11. Perusal of the documents on record show that the trademark in question, i.e., 'GARNISH' was first coined and adopted by the father of the petitioner in the year 1956. The said trademark was firstly assigned by father of the petitioner to her brother by way of assignment deed dated 28th January, 1993. Subsequently, the brother of the petitioner assigned the said trademark in favour of the petitioner vide assignment deed dated 3rd June, 1997. The assignment deed dated 3rd June, 1997 in favour of the petitioner, reads as under:

"xxx xxx xxx"

DEED OF ASSIGNMENT

This deed of assignment is made on this 3rd day of June 1997 between Gurmeet Singh Sethi, Trading as Galaxy International New Delhi (Herein after referred to as 'Assignor') And Irvinder Kaur Chadha trading as, Supreme Agencie, Bombay (Hereinafter referred to as the assignee)

WHEREAS

The assignor is the registered proprietor of the trade mark GARNISH Bearing No. 372690-B in Class 7 in respect of hydraulic closing devices (Hereinafter referred to as 'the said trade mark') not being used.

The assignor is willing to assign and the Assignee is willing to acquire the said trade mark.

NOW THEN THIS DEED WITNESSETH AS FOLLOWS.

1. *In token consideration of Rs. 501/- (Rupees Five hundred & one Only), the receipt whereof the Assignor acknowledges, the assignor assigns unto Assignee the said trade mark along with the goodwill in the business in which the said mark is being used.*

2. *The assignor and the assignee shall take steps to assist each other to bring the name of the assignee the subsequent proprietor in the Registrar of Trade Mark in respect of the said mark.*

IN WITNESS WHEREOF the parties set their hand on the date, month



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& year mentioned above.

xxx xxx xxx”

12. Subsequently, in the family dispute of the petitioner with her father and brother, the petitioner reached a settlement with them, which was incorporated in an application filed in this Court, in suit bearing no. CS (OS) 1697/2005, in the following manner:

“xxx xxx xxx

2. That as per the desire of the Plaintiff and in order to expand his family business, the Defendant i.e. Ms. Irvinder Kaur Chadha (daughter of the Plaintiff) was allowed by the Plaintiff to set up a unit in Chandigarh and use the trade mark/name GARNISH of the plaintiff in the year 1983.

3. That since 1983, some written agreements were entered into between the Plaintiff and Defendant (i.e. daughter of the Plaintiff) with respect to the use of the trade mark/name GARNISH in classes 6 & 7 by the Defendant.

4. That because of some mis-understanding and communication gap, dispute arose between the Plaintiff and Defendant and the Plaintiff filed the present suit.

5. That the Plaintiff and Defendant above named have settled their disputes and have arrived at a settlement in the present suit on the following terms and conditions set out hereinafter:

(a) The Plaintiff recognizes the Defendant's right to use the mark/name GARNISH since the year 1983 which use was with his consent and approval;

(b) The Plaintiff had assigned the mark/name GARNISH in favour of Mr. Gurmeet Singh Sethi, trading as Galaxy International vide deed of assignment dated 28.01.1993 and the same was thereafter assigned by Mr. Gurmeet Singh Sethi in favour of Ms. Irvinder Kaur Chadha, the Defendant herein vide deed of assignment dated 03.06.1997.

(c) The Plaintiff or any one acting for and on his behalf undertake to recognize and does not dispute the rights of the



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Defendant to own and use the mark/name GARNISH in future;

(d) The Defendant is entitled to conduct her business in whatever manner she deems fit by using the mark GARNISH and shall also be entitled to protect it, especially as the Plaintiff himself is old and suffers ill health;

(e) The Defendant would be entitled to getting the mark/ name GARNISH bearing no. 372690 in class 7 assigned in her favour and the Plaintiff does not have any objection to the same;

(f) The Plaintiff undertakes not to cause any hindrance in the business of the Defendant who will be entitled to conduct her business under the mark/ name GARNISH;

(g) The Defendant in consideration of the above has agreed to pay to the Plaintiff a sum of Rs. 51,00,000/- (Fifty One Lakhs Rupees) in terms of the following:

i. Rs. 13,00,000/- (Thirteen Lakhs Rupees) which has already been paid by the Defendant to the Plaintiff and the Plaintiff hereby acknowledges having received the same;

ii. Rs. 7,00,000/- (Seven Lakhs Rupees) which has already been paid by the Defendant to the Plaintiff and the Plaintiff hereby acknowledges having received the same;

iii. Rs. 31,00,000/- (Thirty One Lakhs Rupees) which amount is to be paid by the Defendant to the Plaintiff by or before 30.06.2013;

(h) The Defendant in addition to the above consideration also agrees to pay to the Plaintiff annually a share of 5% from the annual sales turnover made by the Defendant in Northern India from the sale of the products under the mark/name GARNISH.

6. That in consideration of the aforementioned undertakings by the Defendant, the Plaintiff agrees to forego its claim for delivery up, damages, rendition of accounts of profits and costs as mentioned in the Plaint against the Defendant.

7. That in view of the above said terms and conditions, the Plaintiff agrees to unconditionally withdraw the present suit against the Defendant. The Plaintiff also agrees to withdraw all allegations made against the Defendant in any applications or in the plaint.



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xxx xxx xxx”

13. Perusal of the aforesaid clearly shows that the father and brother of the petitioner recognised the right of the petitioner herein in the mark/name ‘GARNISH’. Thus, the petitioner herein was held entitled to conduct her business by using the mark ‘GARNISH’. In consideration of recognition of right of the petitioner herein for use of the mark/name ‘GARNISH’, the petitioner also paid a sum of ₹ 51,00,000/- to her brother.

14. On account of the aforesaid settlement, the said suit was decreed in favour of the petitioner herein vide order dated 29th May, 2012, as under:

“xxx xxx xxx

1. Plaintiff has filed the present suit for permanent injunction restraining infringement of trademark, passing off, copyright, dilution, damages, rendition of accounts, delivery up.

2. It is pointed out by learned counsel for the parties that being a distributor defendant no.2 is not a necessary and proper party. At joint request of counsel for the parties, defendant no.2 is deleted from the array of parties. Let an amended memo of parties be filed.

3. Learned counsel for the parties submit that parties have arrived at an amicable settlement. Counsel for the parties have handed over an application under Order XXIII Rule 3 CPC in Court today. Application is accepted and taken on record. Let this application be registered and numbered. This application is duly signed by the plaintiff, defendant no.1 and their respective counsel. Application is also supported by the affidavits of the plaintiff and defendant no.1.

4. Mr. H.S. Sethi, plaintiff, Mr. Gurmeet Singh, son, and Ms. Harmeet Sethi, daughter of plaintiff, are also present in Court along with their counsel. Ms. Irvinder Kaur Chadha, defendant no.1, who is also the daughter of the plaintiff, is present in Court along with her counsel. Plaintiff and defendant no.1 identify their signatures on the application as well as on the affidavits.

5. It is submitted by the parties that they have arrived at an amicable settlement without any coercion, undue pressure, influence and after understanding the terms of the settlement. It is further submitted that assignment pertains to the trademark/name GARNISH bearing



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no.372690 in Class 7 only.

6. Learned counsel for the parties pray that in view of the settlement present suit may be decreed in terms of the present application marked as Exhibit C-1.

7. Heard learned counsel for the parties and also perused the terms of settlement, which are lawful. Accordingly, as prayed, suit stands decreed in terms of Exhibit C-1, leaving the parties to bear their own costs. Let a decree sheet be drawn up accordingly.

8. At this stage, Mr.A.K. Goel, Advocate has appeared and submits that the trademark GARNISH has been assigned to M/s Garnish Electronics Pvt. Ltd and his client would take appropriate action to safeguard its rights.

9. Application stands disposed of.

I.A.2947/2012 (delay in filing OA 15/2012 - by def.), O.A.15/2012

10. Application and O.A. stand dismissed in view of the suit stands decreed.

I.A.15384/2011 (by plaintiff - for recall of the Order dated 24.8.11) and Crl.M.A.17282/2010 (u/S 340 Cr.P.C. - by plaintiff)

11. Applications stand disposed of in view of the suit stands decreed.”

15. It is to be noted that the aforesaid order dated 29th May, 2012 records that after the suit was decreed in favour of the petitioner herein, counsel for respondent no. 1 herein made a submission subsequently thereto, that the said trademark ‘GARNISH’ had been assigned to respondent no. 1. Thus, it is manifest that the respondent no. 1 was aware of the rights in favour of the petitioner herein, which was recognised and approved by a judicial order, by decree in favour of the petitioner. There is nothing on record to show that the respondent no. 1 filed any appeal against the aforesaid order dated 29th May, 2012, in CS(OS) 1697/2005, which recognised the right of the petitioner herein to the word/mark ‘GARNISH’.

16. It is to be noted that the petitioner herein has been using the said



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trademark continuously and openly, since then. Attention of this Court has been drawn to the documents on record, i.e., sale invoices and brochure of the petitioner for price list of the goods with the mark in question, which shows the continuous user of the mark in question by the petitioner.

17. This Court also notes that the petitioner herein also took steps for entering her name in the register of trademarks, as proprietor of the trademark in question. The application dated 14th October, 2016, made by the petitioner herein, reads as under:

“FORM TM-24

THE TRADE MARKS ACT, 1999

[Request to register a subsequent proprietor of a trade mark or trade marks upon the same devolution of title.

Section 45, rule 68.]

*I (or We) **Irvinder Kaur Chadha** hereby request that my (or our) name may be entered in the Register of Trade Marks as proprietor of Trademark Number: **372690** in class **7** as from the **29/05/2012***

*I am (or we are) entitled to the trade mark by virtue of **Order of Delhi High Court dated 29.05.2012 and Compromise Application dated 29.05.2012** of which the original and an attested copy are enclosed herewith.*

The assignment of the trade mark was not made otherwise than in connection with the goodwill of the business in which the /mark was used (and there is sent herewith a copy of the Registrar's direction to advertise the assignment, a copy of each of the advertisements complying therewith, and a statement of the dates of the issue of any publications containing them).

I declare that the facts and matters stated herein are true to the best of my knowledge, information and belief.

Additional Trademarks(Class):

All communications relating to this application may be sent to the following address in India:

***R.K.DEWAN & CO., Advocates, Trade Marks & Patents Attorneys,
236-237, Vardhman Fashion Mall, Near Bhagwan Mahavir
Hospital, Pitampura, Delhi- 110 034-***



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Dated this 14 October 2016

Digitally Signed

R.K.DEWAN & CO.

*To,
The Registrar of Trade Marks
The Office of the Trade Marks Registry at DELHI”*

18. The documents on record also show that the petitioner herein also took steps for renewal of the mark in question. Communication dated 8th May, 2019 by the petitioner to the Registrar of Trade Marks, regarding authorization of attorney in connection with renewal of trademark, reads as under:

*“ FORMTM-M
THE TRADE MARKS ACT, 1999
Form of Authorization of an Agent
[Section 145; Rule 21]*

I, Irvinder Kaur Chadha, Proprietor, Supreme Agencie, 692, Industrial Area, Phase-I, Chandigarh, hereby authorize Shri K.G.Bansal, M.A, LL.B and Shri S.K.Bansal, Advocates of M/s Delhi Registration Service, Patent and Trade Mark Attorneys, 52, Sukhdev Vihar, Mathura Road, New Delhi- 110 025, to act as our attorneys in connection with renewal of trademark registration no. 372690 in class 07 and other necessary action w.r.t said registered trademark and request that all notices, requisitions and communications relating thereto may be sent to such attorney at the above address.

Dated this 08th Day of May, 2019.

xxx xxx xxx”

19. The petitioner, thereafter, moved a formal request for renewal of the trademark in question. The document, i.e., TM-R dated 20th May, 2019, pertaining thereto, reads as under:

“FORM TM-R



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THE TRADE MARKS ACT, 1999
Application for Renewal/Restoration of registration of a trademark
or for payment of surcharge towards the renewal under the Trade
Marks Act

Temp#:3368131

Temp# :3368131

REQUEST	RENEWAL WITH SURCHARGE
FEE PAID	13500
APPLICANT :	
Applicant Name	H.S.SETHI TRADING AS GARNISH TRADERS PRIVATE LIMITED
Trading As	GARNISH TRADERS PRIVATE LIMITED.
Address	A-37, RAJOURI GARDEN, NEW DELHI - 110 027.
Mobile No	9910017859
Email address	info@unitedipr.com
APPLICANT'S AGENT(if any) :	
Agent Name	DELHI REGISTRATION SERVICE.
Address	52, SUKHDEV VIHAR, MATHURA ROAD, NEW DELHI-110 025.
Address for Service	52, SUKHDEV VIHAR, MATHURA ROAD, NEW DELHI-110 025.
Mobile No	9910017859
Email address	info@unitedipr.com
Nature of the Agent	Agent
Registration No(Bar council Registration No)	
Trade Mark Type	TRADE MARK
Trade Mark No	372690
Class(es)	7
Date	20-May-2019 04:38 PM

Digitally Signed By

KRISHAN GOPAL BANSAL

for DELHI REGISTRATION SERVICE.
[Agent]

20. Consequent upon the petitioner's request, the said trademark 'GARNISH' was renewed and is now valid/renewed upto 24th February, 2029. The renewal certificate clearly shows the said mark to be in use since 1st December, 1956. The document of renewal of the registration of the



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trademark in question, is as follows:

(NOT FOR LEGAL USE)	
As on Date : 18/04/2024	View Registration Certificate
Status : Registered	View TM Application View Additional Representation Sheet
TM Application No.	372690
Class	7
Date of Application	24/02/1981
Appropriate Office	DELHI
State	CHANDIGARH
Country	India
Filing Mode	Branch Office
TM Applied For	GARNISH
TM Category	TRADE MARK
Trade Mark Type	DEVICE
User Detail	01/12/1956
Certificate Detail	Certificate No. 169696 Dated : 31/08/1990
Valid upto/ Renewed upto	24/02/2029
Proprietor name	(1) H.S.SETHI Trading As : GARNISH TRADERS PRIVATE LIMITED. Body Incorporate
Proprietor Address	A-37, RAJOURI GARDEN, NEW DELHI - 110 027.
Email Id	
Attorney name	R.K.DEWAN & CO.[654]
Attorney Address	236/237, VARDHMAN FASHION MALL, NEAR MAHAVIR HOSPITAL, LSC ROAD NO. 43, PITAMPURA, NEW DELHI-34
Goods & Service Details	[CLASS : 7] HYDRAULIC DOOR CLOSING DEVICES.
Publication Details	Published in Journal No. : 938-0 Dated : 01/07/1988

21. Since the renewal was done by the Trade Mark Registry in the name of the father of the petitioner, the petitioner has also proceeded to make an application for substituting her name in the register of trademarks, by an application dated 29th September, 2021, which reads as under:



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DELHI REGISTRATION SERVICE

PATENT AND TRADE MARK ATTORNEYS
52, SUKHDEV VIHAR, MATHURA ROAD,
NEW DELHI - 110 025 (INDIA)
OFFICES ALSO AT : MUMBAI & HYDERABAD

Tel.: ++91-11-26843455, 46560881, 26936783, 23914991, 23952695

Fax: ++91-11-26828578, 2396319

E-mails: unitedmark@unitedipr.com, unitedip@unitedipr.com, drs@unitedipr.com

Website: www.unitedipr.com

29th September, 2021

The Registrar of Trade Marks
Baudhik Sampada Bhavan
Plot No.32, Sector-14
Dwarka
New Delhi – 110 075.

Reg: Recordal application for registered Trade Mark GARNISH under No.372690 in Class 07 in the name of Irvinder Kaur Chadha, Chandigarh.

Dear Sir,

We act on behalf of and under the instruction of the Applicant, Irvinder Kaur Chadha and have to state as under:-

1. We filed an application on Form TM-24 dated 14.10.2016 for bringing the registration in the name of Irvinder Kaur Chadha in view of the High Court order dated 29.05.2012 (passed in Suit No.CS (OS) 1697 of 2005).
2. The said recordal application is still pending and has not yet been allowed.
3. We request you to kindly consider the same and allow the said recordal application as the said matter is unnecessarily pending since long.

Thanking you,

Yours faithfully,
For Delhi Registration Service


(Shраван Kumar Bansal)
Advocate

LVC



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22. Thus, it is seen that renewal of the trademark in question, which was initially adopted and coined by her father, has been done at the behest of the petitioner herein. Further, the documents on record clearly show a valid assignment of the trademark in question, in favour of the petitioner. The said right of the petitioner in the trademark, has been duly recognised by this Court.

23. Merely, because the application of the petitioner for transfer of the registered trademark in her name is still pending with the Registrar of Trade Marks, would not be a disqualification for initiating or maintaining litigation for protection of the registered trademark against infringement and passing off. Thus, holding that an action to protect the violation of trademark can be brought about by a party, even if its application for getting the registered trademark transferred to its name is still pending with the Registrar of Trade Marks, this Court in the case of *M/s Modi Threads Limited Versus M/s Som Soot Gola Factory and Another*, 1990 SCC OnLine Del 375, has held as follows:

“xxx xxx xxx

6.It is true that the plaintiff's application for getting transferred the registered trade mark in its name in the office of the Registrar is still pending but that does not debar the plaintiff to protect the violation of the aforesaid trade mark at the hands of unscrupulous persons by filing an action in court of law for injunction. It is, prima facie, clear to me that during the interregnum period when the application of the plaintiff is kept pending for consideration by the Registrar of Trade Marks the dishonest persons cannot be allowed to make use of the said trade mark in order to get themselves illegally enriched earning upon the reputation built up qua that trade mark by the predecessor-in-interest of the plaintiff. Fortunately there are two judgments of two High Courts supporting this view. In *T.I. Mahommed Zumoon Sahib v. Fathimunnissa @ Bibijan*, AIR 1960. Madras 80, a Division Bench of the said High Court laid down that there is nothing in



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Section 21 or Section 35 which would support the argument that it is only the order of the Registrar under Section 35 which confers a right on the heirs of the original registered proprietor to bring an action for infringement of the trademark. Such an action is, therefore, maintainable even before an order was passed under Section 35. So, the title to the plaintiff accrues, prima facie, on the execution of the assignment deed and all other follow up actions which are required to be taken under the Trade Marks Act do not change the title already acquired in this respect. Hence, it cannot be said that till the plaintiff is able to get the registration of the trade mark transferred in its name the plaintiff cannot bring the suit for injunction restraining the breach of the trade mark by any other unscrupulous person. I entirely agree with the law laid down in this judgment.

xxx xxx xxx”

(Emphasis Supplied)

24. This Court also notes the purported assignment deed dated 28th October, 2010 allegedly executed by father of the petitioner in favour of respondent no. 1. The relevant portion of the said assignment deed is reproduced as under:

“ASSIGNMENT DEED

In respect of RTM No. 1232332 in Class 6 in respect of all goods covered by registration

This Deed of Assignment is made at Delhi this 28th Day of Oct., of 2010 between:-

H.S. SETHI
M/S GARNISH TRADERS
A-37, Rajouri Garden,
New Delhi-110027,
(hereinafter called the “Assignor”)

AND

M/S GARNISH ELECTRONICS PVT. LTD.
(A Company duly regd. Under the Companies Act, 1956)
A-37, Rajouri Garden,
New Delhi-110027,



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(hereinafter called the Assignee)

WHEREAS the Assignor is lawful registered proprietor of the Trade Mark "GARNISH" vide Registration No. 1232332 in Class 6 in respect of Door closers (Non Electric) Door Fittings of Metal, Door Handles of Metal, Door openers of Metal, Door springs of Metal including Common Metals and their alloys Metal Building Material, Transportable, Electric Cables and Wires of Common Metal, Iron Mongry Small Items of Metal Hardware, Pipes and Tubes of Metal Sage, Goods of Common Metal not in other classes.

xxx xxx xxx"

25. Perusal of the aforesaid assignment deed shows that the alleged assignment of trademark in favour of respondent no. 1 was with respect to registration no. 1232332. The record of the trademark registry shows that the said registration number was valid/renewed, only upto 4th September, 2013, on 'proposed to be used basis'. The said registration was not renewed after 4th September, 2013. The document showing the status of the said registration, as being valid/renewed only upto 4th September, 2013, reads as under:

"xxx xxx xxx

As on Date: 19/03/2024

[View Registration Certificate](#)

Status : Registered

[View TM Application /View Additional Representation Sheet](#)

Alert: Trade mark is likely to be removed due to non filing of Renewal request within prescribed time limit in case of any discrepancy contact respective TM Registry.

TM Application No.	1232332
Class	6
Date of Application	04/09/2003
Appropriate Office	DELHI
State	CHANDIGARH
Country	India
Filing Mode	Branch Office
TM Applied For	GARNISH



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<i>TM Category</i>	TRADE MARK
<i>Trade Mark Type</i>	WORD
<i>User Detail</i>	Proposed to be used
<i>Certificate Detail</i>	Certificate No. 513372 Dated : 21/01/2006
<i>Valid upto/Renewed upto</i>	<u>04/09/2013</u>
<i>Proprietor name</i>	(1) H.S. SETHI Trading As: GARNISH TRADERS PRIVATE LIMITED. Single Firm
<i>Proprietor Address</i>	A-37, RAJOURI GARDEN, NEW DELHI – 110 027.
<i>Email Id</i>	
<i>Goods & Service Details</i>	[CLASS : 6] DOOR CLOSERS (NON ELECTRIC), DOOR FITTINGS OF METAL, DOOR HANDLES OF METAL, DOOR OPENERS OF METAL, DOOR SPRINGS OF METAL INCLUDING COMMON METALS AND THEIR ALLOYS METAL BUILDING MATERIAL, TRANSPORTABLE, ELECTRIC CABLES AND WIRES OF COMMON METAL, IRON MONGRY SMALL ITEMS OF METAL HARDWARE, PIPES AND TUYBES OF METAL SAFE, GOODS OF COMMON METAL NOT IN OTHER CLASSES, FALLING IN CLASS 6.
<i>Publication Details</i>	Published in Journal No. : 1328-1 Dated : 07/02/2005

xxx xxx xxx”

(Emphasis Supplied)

26. Thus, fresh registrations by respondent no. 1 in its favour on the basis of an assignment deed *qua* a registration, which was valid upto only 4th September, 2013 and is no longer valid, with no document on record to show the user of the said registration ever, cannot be sustained.

27. Even otherwise, the respondent no.1 has not filed any document to show its user of the mark in question. Therefore, on the basis of non-user also, the impugned registration cannot be sustained. On the other hand, the petitioner has been able to establish her ownership, proprietorship and prior



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user of the trademark in question, which has been done continuously and openly. Furthermore, the sale invoices filed by the petitioner clearly establish the continuous user of the trademark by the petitioner. Besides, the petitioner has been recognised as a registered user by a judicial order of this Court.

28. The impugned trademark in relation to the same Class of goods would deceive and cause confusion *qua* the petitioner's trademark, in the normal course of business activities, as the goods are same, allied and cognate, due to identical and deceptive similarity with the petitioner's registered trademark and owing to common trade channel.

29. In view of the detailed discussion hereinabove, respondent no. 1 cannot be considered as a *bonafide* user of the trademark in question. The respondent no. 1 has not rebutted the various submissions made by the petitioner, which have remained unchallenged. In the petition, the petitioner has made specific averments that the respondent no. 1 has not used the impugned trademark *inter alia* for a period of more than five years and three months, prior to the filing of the present petition. In the absence of any specific denial by the respondent no. 1 on account of non-filing of any reply, the allegation of non-user would be deemed to have been admitted. Thus, in the case of ***DORCO Co. Ltd. Versus Durga Enterprises and Another, 2023 SCC OnLine Del 1484***, it has been held, as follows:

“xxx xxx xxx

*19. In the judgment in Shell Transource Limited v. Shell International Petroleum Company Ltd., 2012 SCC OnLine IPAB 29, it was observed by the IPAB that **the onus of proving “non-user” is on the person who pleads the same. However, when the applicant pleads “non-user”, the respondent must specifically deny it. Therefore, in the absence of a specific denial, it was held that the allegations of “non-user” stood admitted.***



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xxx xxx xxx”

(Emphasis Supplied)

30. Accordingly, it is held that the respondent has failed to rebut the submission of the petitioner that the respondent has not used the impugned trademark in relation to the products for a period of five years, and for a period of three months before the date of the rectification application. Further, the petitioner has been able to establish that the petitioner is the prior user and registered owner of the trademark in question. Hence, the impugned marks are liable to be removed from the Registrar of Trade Marks.

31. Consequently, Trademark No. 2970803 and Trademark No. 2970802, registered in the name of the respondent no. 1 under Class-06, are cancelled. The aforesaid registrations under Class-06 are directed to be removed from the Register of Trade Marks. The website of the Registrar of Trademarks be updated, accordingly.

32. The Registry of this Court is directed to communicate the copy of this Order to the Registrar of Trade Marks, at Email: llc-ipo@gov.in, for compliance.

33. The present petition is allowed and disposed of, in the aforesaid terms.

MINI PUSHKARNA, J**JULY 30, 2024**

Ak/au