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

+ **CS(COMM) 385/2017 & I.A. 6548/2017**

M/S STEELBIRD HI-TECH INDIA LTD.Plaintiff

Through: Mr. Vardaan Anand, Adv.
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Email:
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versus

MR. ASHISH DHALL & ANR.Defendants

Through: Mr. Abhinav Sharma and Mr.
Mahender Shukla, Advs.

**CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA**

**ORDER
12.09.2024**

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1. The present suit has been filed seeking permanent injunction restraining the defendants from using the impugned trademark/trade name 'STEELBIRD' or any other similar mark.
2. The case canvassed on behalf of the plaintiff, is as follows:
 - i. The plaintiff is a prominent Indian manufacturer of helmets, pannier boxes and auto accessories since 1964.
 - ii. The plaintiff is the proprietor of the trademark "STEELBIRD", which was adopted by the plaintiff in the year 1964. Since then, the plaintiff has been using the said trademark continuously and extensively in respect of its



goods, and more specifically, the helmets.

iii. The 'STEELBIRD' trademark is a coined mark. It is fanciful and arbitrary mark in relation to helmets and auto accessories, hence, is inherently distinctive. Over the years, the plaintiff has expanded its business under the 'STEELBIRD' mark into various sectors, including, entertainment, fashion and food.

iv. The mark 'STEELBIRD' forms the key, essential and dominant part of the corporate name and trading style of the plaintiff and the plaintiff's group companies. Thus, people not only in India but the around the world, recognize and associate the word 'STEELBIRD', when occurring in the corporate name/trading style/trade name of any company, as belonging to the plaintiff.

v. The plaintiff is also the registered proprietor of the said word and device marks in India, details of which, as given in the plaint, are as follows:

Trademark	Registration No.	Class	Date of Registration	Goods
STEELBIRD	1180255	12	05.03.2003	Accessories & fitments for use in automobiles included in Class 12.
STEELBIRD	1332831	9	18.01.2005	Helmets (Protective), their parts & Fittings included in class 9
STEELBIRD	481778	27	27.11.1987	Mats and mattings included in class 27.
STEELBIRD	354329	7	10.10.1979	Filters being parts of engines of motors and of machines



STEELBIRD	367425	9	10/10/1980	Helmets (firemens) and helmets (protective for motor cyclists) included in class 9.
STEELBIRD	278745	12	06/03/1972	Filter, filter elements and other parts and fittings of motor land, air and water vehicles.
	1359446	9	25/05/2005	Helmets (protective), their parts & fittings, included in class 9.

vi. The trademarks in favour of the plaintiff are duly renewed and subsisting as on date. Therefore, by virtue of the registrations, the plaintiff has the exclusive right to use the said trademarks in relation to the goods in respect of which the trademarks are registered.

3. By virtue of long, continuous and valuable user, the plaintiff is the owner of the trademark 'STEELBIRD' on account of which, it alone is entitled in law to use the said trademark on goods of the aforesaid description as well as other allied and cognate goods.

4. In the month of May, 2017, the plaintiff's representative came across



the defendants' application for the device mark/logo under no. 2068801 dated 15th December, 2010 in respect of "*stainless steel kitchen sinks and sanitary goods*" in Class 11.



5. The defendants are dealing in kitchen appliances, kitchenware and sanitary goods bearing the impugned mark which is identical to the plaintiff's registered and well know trademark 'STEELBIRD'. Thus, the present suit was filed.

6. Vide order dated 26th May, 2017, injunction was granted in favour of the plaintiff and against the defendants, thereby restraining the defendants from using the impugned trademark/ trade name 'STEELBIRD'.

7. Learned counsel appearing for the defendants submits that after the injunction in the year 2017, the defendants have not used the mark 'STEELBIRD'. It is submitted that the defendants are carrying on their business by using another mark, i.e., KOHINOOR.

8. Learned counsel appearing for the plaintiff submits that he has no objection to the defendants using the mark KOHINOOR.

9. Learned counsel appearing for the defendants on instructions further undertakes that he shall not use the trademark 'STEELBIRD' in future as well.

10. The defendant is bound by the aforesaid undertaking.

11. In view of the undertaking given by the defendant, this Court is of the view that the matter can be closed at this stage, and a decree can be passed in favour of the plaintiff.

12. Learned counsel appearing for the defendants submits that defendants are small-time businessmen. He, thus, submits that since the suit is being closed on the statement and undertaking of the defendants, no Cost/Damages be imposed upon them.

13. Having heard learned counsel for the parties and considering the facts and circumstances of the case, the following directions are issued:



- i. A decree of permanent injunction is passed in favour of the plaintiff and against the defendants thereby restraining the defendants, their principal officers, partners, servants, representatives and agents or any of them, from using the impugned trademark/ trade name 'STEELBIRD' and/or any mark that is deceptively or confusingly similar to the plaintiff's trademark 'STEELBIRD' in any manner whatsoever, on goods or services, not originating from the plaintiff.
- ii. The registrations in favour of the defendants for the device mark/logo 'STEELBIRD' registered under no. 2068801 dated 15th December, 2010 in respect of '*stainless steel, kitchen sinks and sanitary goods*' under Class 11 and registration of the device mark/logo 'STEELBIRD', in favour of the defendants vide no. 867447 dated 27th February, 2015 in Class 11, is hereby cancelled.
- iii. The Registrar of Trademarks is directed to delete the entries of registration no. 2068801 in Class 11 and registration no. 867447 in Class 11 from the Register of Trademarks.
- iv. Appropriate notification shall be issued by the Registrar of Trademarks, in this regard.
14. Suit is decreed, in terms of the aforesaid.
15. Decree Sheet be drawn up.
16. It is clarified that this Court has not expressed any opinion on the entitlement of the defendants for using the mark 'KOHINOOR'.
17. The Registry is directed to supply a copy of the present order to the Office of the Controller General of Patents, Designs and Trade Marks of India, on E-mail ID: llc-ipo@gov.in, for compliance.



18. The suit is accordingly disposed of, along with the pending application.

MINI PUSHKARNA, J

SEPTEMBER 12, 2024/kr