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

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Date of Decision: 07.08.2025

+ C.A.(COMM.IPD-TM) 43/2024

CARGILL INCORPORATED

.....Appellant

Through: Mr. Pranay Bali & Ms. Nivrati Gupta,
Advocates.

versus

THE REGISTRAR OF TRADE MARKS

.....Respondent

Through: Mr. Arnav Kumar, CGSC with Ms.
Gitanjali Vohara, Advocate.**CORAM:****HON'BLE MR. JUSTICE TEJAS KARIA****TEJAS KARIA, J. (ORAL)**

1. The present Appeal has been filed on behalf of the Appellant under Section 91 of the Trade Marks, Act (“Act”) read with Rule 156 of the Trade Marks Rules, 2017, aggrieved by the order dated 31.01.2024 (“**Impugned Order**”) passed by the learned Registrar of Trade Marks, Trade Marks Registry, New Delhi against the Trade Mark ‘TOPCITHIN’ (“**Subject Trade Mark**”) under Trade Mark Application No. 470633 in Class 1 (“**Subject Application**”).

FACTUAL BACKGROUND:

2. The Subject Trade Mark was conceptualised and adopted by the Appellant, through its predecessor-in-interest, ‘Lucas Meyer GmbH & Co.’, as early as 1969, when ‘Lucas Meyer GmbH & Co.’ had filed the Trade Mark Application in Germany for the Subject Trade Mark under Application No. 901063 in Class 1 and the registration was granted on 08.01.1973 and



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maintained until 2009.

3. Over the years, the Appellant has acquired all rights, title and interest in the Subject Trade Mark through series of acquisitions and assignments. The Appellant's predecessor-in-interest '*Lucas Meyer GmbH & Co.*' was acquired by '*SWK Trostberg AG*' in 1999, which later merged into '*Degussa AG*' in 2001. The food ingredients operations of '*Degussa AG*' was then acquired by the Appellant's German operations in 2006 and renamed as '*Cargil Texturizing Solutions Deutschland GmbH & Co. KG*' and the Subject Trade Mark also stood assigned through this assignment, which was further assigned to the Appellant.

4. Accordingly, the Appellant was prior and exclusive adopter, owner and suer of the Subject Trade Mark having active registrations across countries internationally since 1985 and has been using the same through its predecessor-in-interest in respect of its lecithin-based products since 1986.

5. In India, the Appellant has been directly using the Subject Trade Mark since 2011 in respect of lecithin for industrial use in the manufacture of food products, personal care products, cosmetics and animal feed; emulsifiers for industrial purposes, emulsifiers for use in the manufacture of cosmetics in Class 1. On 17.10.2020, the Appellant filed the Subject Application for the Subject Trade Mark claiming prior use since 14.02.2011. Thereafter, on 10.11.2020, the Appellant filed a duly executed Affidavit of Prior Use along with relevant evidence in support of the Subject Application.

6. On 19.11.2020 the Subject Application was examined by the Respondent and the Examination Report ("**Examination Report**") in respect of the Subject Application was uploaded on the online records of the Respondent. However, it was submitted that the Exam Report was never



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issued to or received by the Appellant.

7. In the Exam Report, the Respondent raised an objection under Section 11(1) of the Act based on the Mark 'TOPCITHIN' under Registration No. 896028 covering 'Liquid Lecithin Being Bulk Pharmaceutical Preparations' in Class 1 as of 04.01.2000, in the name of '*Lucas Meyer Industries Private Limited*' ("**Cited Mark**").

8. On 07.12.2021, the Appellant filed a detailed Reply to the Examination Report upon detecting that the same was hosted in the online records of the Respondent.

9. The Appellant on 02.12.2021 filed a Rectification Petition No. 273414 in the Application No. 896028 before the Respondent under Sections 47 and 57 of the Act seeking removal of the Cited Mark ("**Rectification Petition**"), which is still pending for consideration before the Respondent.

10. The Respondent issued a hearing notice for Subject Application on 05.12.2023 to the Appellant, fixing a pre-publication hearing on 03.01.2024. On the date of the hearing, the Appellant's Counsel attended the hearing and made oral submissions for registration of the Subject Trade Mark consistent with the submissions in the Reply to Examination Report. The Appellant's Counsel appearing before the Respondent also drew attention of the Respondent to the Rectification Petition filed against the Cited Mark.

11. On 31.01.2024, the Respondent passed the Impugned Order rejecting the Subject Application and refusing the registration of the Subject Trade Mark on the ground of deceptive similarity with the Cited Mark. Being aggrieved by the Impugned Order, the Appellant has filed the present Appeal.



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SUBMISSIONS ON BEHALF OF THE APPELLANT

12. The learned Counsel for the Appellant submitted that the Impugned Order is erroneous as it is based on incorrect observations and reasoning. It was submitted that the Impugned Order incorrectly records that the Counsel for the Appellant had submitted that the Subject Trade Mark is not identical and/or deceptively similar to the Cited Mark. However, no such submissions were made on behalf of the Appellant before the Respondent and such an observation is factually incorrect.

13. The learned Counsel for the Appellant submitted that the Appellant's Counsel appearing before the Respondent did not make any submissions or arguments on the ground of dissimilarity or the respect of Subject Trade Mark and Cited Mark. In fact, in the Reply to the Examination Report mentioned that both the Subject Trade Mark and Cited Mark were identical, however, the Subject Trade Mark has been registered in other countries as far back as 1985 and that the Appellant had already filed Rectification Petition for removal / cancellation of the Cited Mark from the Register of Trade Marks on the ground that the Cited Mark was remaining on the Register of Trade Mark without sufficient cause. Hence, Cited Mark was not bar for registration of the Subject Trade Mark under Section 11(1) of the Act.

14. Hence, the Impugned Order has been passed based on incorrect observations and erroneous understanding of the Appellant's submissions before the Respondent. The Respondent overlooked and failed to take into consideration the actual arguments made on behalf of the Appellant.

15. It was submitted that it is an established principle of law that a decision based on findings that are contrary to the record are liable to be set



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aside. The learned Counsel for the Appellant placed reliance upon the order dated 10.01.2024 of this Court in case of ***Hyclone Laboratorie, Inc. v. Registrar of Trade Mark***, C.A (COMM.IPD-TM) 73/2021 that if the findings are contrary to the record, it vitiates the order of refusal to register the Trade Mark.

16. It was submitted that the rights and interests of the Appellant in the Subject Trade Mark have been gravely prejudiced and compromised by the manifest error in the Impugned Order.

17. It was further submitted that the Respondent also failed to consider that the Appellant was the prior user of the Subject Trade Mark as stated in the detailed Reply to the Examination Report and Affidavit of Prior User, which were completely ignored by the Respondent while passing the Impugned Order. The said submissions were repeated during the oral submissions by the learned Counsel of the Appellant before the Respondent, however, the same were neither recorded in the Impugned Order nor any reason for non-consideration of these submissions was given therein.

18. The learned Counsel for the Appellant has submitted that the Appellant had filed its Reply to the Examination Report on 07.12.2021, wherein the Appellant had placed on record its detail submissions and assertions towards overcoming the objection based on the Cited Mark in the name of '*Lucas Meyer Industries Private Limited*' as of 04.01.2000. The Appellant had also filed an Affidavit of Prior Use along with supporting evidence on 10.11.2020, wherein the Appellant had substantiated the use of the Subject Trade Mark in India since at least 14.02.2011.

19. The learned Counsel for the further submitted that despite the Appellant placing on record its submissions in the Affidavit of Prior Use and



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the Reply to the Examination Report and reiterating the same in the oral submissions during the hearing held on 03.01.2024, the Impugned Order does not record any submissions made by the Appellant or any reason for not considering the said submissions.

20. It was submitted by the learned Counsel for the Appellant that the Impugned Order is unreasoned and non-speaking. The learned Counsel for the Appellant placed reliance on the judgment in ***Mikko Vault LLC v. Registrar of Trade Marks***, Neutral Citation: 2002 DHC 004440, wherein this Court set aside the order as none of the points urged by the appellant in response to the examination report had been considered while passing the impugned order in said case.

21. The learned Counsel for the Appellant submitted that the Respondent erred in refusing the Application under Section 11(1) of the Act on account of the Cited Mark without considering the submissions of the Appellant that:

- i. The Appellant is the prior International adopter and user of the Subject Trade Mark.
- ii. The prior adoption and use of the Subject Trade Mark by the Appellant was through its predecessor-in-interest.
- iii. The registrant of the Cited Mark never had any business / legal association, relationship or affiliation with the Appellant's predecessor-in-interest and did not own any legitimate rights in the Cited Mark.
- iv. The Subject Trade Mark has been used by the Appellant (through its predecessor-in-interest) since 1986 Internationally and in India since 1997. Whereas, the Cited Mark was applied on 04.01.2000 on a '*proposed to be used*' basis and the Registrant did not use the Cited



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Mark till the date of making the Application. Accordingly, the adoption and use of the Subject Trade Mark pre-date the Cited Mark and the Appellant has prior rights in the Subject Trade Mark Internationally and in India.

- v. The Cited Mark is remaining on Register of Trade Marks without sufficient cause and the Appellant has filed the Rectification Petition for its cancellation, which is pending.
- vi. The name of Registrant of the Cited Mark starts with '*Lucas Meyer*', which indicates that the Registrant of the Cited Mark had the knowledge of the Subject Trade Mark at the time of adoption, which was in bad faith.

22. Accordingly, the learned Counsel for the Appellant submitted that the Impugned Order be quashed and set aside and the Subject Application be remanded to the Respondent for fresh examination and consideration after giving opportunity to the Appellant to submit additional evidence / documents and to be heard in accordance with law. Additionally, it was prayed that the Respondent be directed to expedite the determination of the Rectification Petition No. 273414 against the Registration No. 896028 for the Cited Mark and decide the same, prior to deciding the Subject Application.

SUBMISSIONS ON BEHALF OF THE RESPONDENT

23. The learned CGSC for the Respondent submitted that there is no infirmity with the Impugned Order as the Subject Trade Mark is identical with / similar to the Cited Mark on record as mentioned in the Examination Report and by similarity of Marks as well as similarity of goods covered



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under such Marks, there existed a likelihood of confusion in the mind of public. Accordingly, the Subject Application was rightly rejected under Section 11(1) of the Act. As there is no infirmity with the Impugned Order, the Appeal deserves to be dismissed.

ANALYSIS AND FINDINGS

24. The Impugned Order does not consider the submissions and evidence placed on record by the Appellant. The Impugned Order only records that the Subject Trade Mark and the Cited Mark are identical / similar to each other and, therefore, registration of the Subject Trade Mark was rejected under Section 11(1) of the Act. The Impugned Order also records that the learned Counsel for the Appellant, who appeared before the Respondent submitted that the Subject Trade Mark is not identical and / or deceptively similar to the Cited Mark and also there was no similarity of goods under Class 1 of the Act. However, the learned Counsel for the Appellant appearing before this Court submitted that the submission of the Appellant's Counsel appearing before the Respondent is wrongly recorded in the Impugned Order and no such submission was made.

25. In any event, the Reply filed to the Examination Report clearly states that the Cited Mark was identical to the Appellant's prior Subject Trade Mark. Despite this clear statement in the Reply to the Examination Report, the Impugned Order has wrongly recorded the submissions made by the Appellant before the Respondent.

26. A perusal of the Reply to the Examination Report and the Impugned Order clearly shows that none of the submissions made by the Appellant were considered by the Respondent while passing the Impugned Order. The Impugned Order has not provided any reason for not considering the



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submissions made by the Appellant in Reply to the Examination Report with regard to the prior adoption of the Subject Trade Mark by the Appellant Internationally and in India through the predecessor-in-interest of the Appellant. Further, the Impugned Order does not consider the submission that the Cited Mark is remaining on the Register of Trade Marks without sufficient cause and that the Rectification Petition filed by the Appellant for the cancellation of the Cited Mark was pending, when the Impugned Order was passed.

27. Accordingly, the Impugned Order has been passed without considering the submissions made by the Appellant and is contrary to the records before the Respondent. Although the Impugned Order mentions that *“After perusal of all the documents on record and submission made by the applicant / authorized agent it is concluded that.....”*, none of the documents submitted or the submissions made by the Appellant before the Respondent have been considered or even referred in the Impugned Order. This clearly shows that the Impugned Order has been passed without appreciation of the documents and the submissions on record before the Respondent and, therefore, is bad in law.

28. As the submissions made by the Appellant before the Respondent are either wrongly recorded or not considered at all, the Impugned Order deserves to be set aside and the Subject Application is required to be remanded back to the Respondent for fresh consideration after giving opportunity to the Appellant to file additional evidence / documents and hearing the Appellant.

29. In view of the above, the present Appeal is allowed and the Impugned Order dated 31.01.2024 is hereby quashed and set aside. The Subject



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Application is remanded back to the Respondent with the following directions:

- a. The Respondent shall decide the Subject Application afresh after giving an opportunity of hearing to the Appellant.
 - b. The Appellant shall be allowed to furnish and rely upon additional evidence / documents during the fresh examination of the Subject Application.
 - c. The pending Rectification Petition No. 273414 filed in the Application No. 896028 pending before the Respondent is directed to be expedited and shall be decided as expeditiously as possible. It is further directed that the Rectification Petition No. 273414 shall be decided prior to the decision in the Subject Application No. 470633 for the registration of the Subject Trade Mark.
30. The Registry is directed to send a copy of this Order to the Office of Controller General of Patents, Designs and Trade Marks for compliance.
31. The present Appeal is disposed of with the aforesaid directions.

TEJAS KARIA, J

AUGUST 7, 2025

Ap/N