



2025:DHC:10856



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

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Date of Decision: 26.11.2025+ **C.A.(COMM.IPD-TM) 80/2025, I.A. 29176/2025, I.A. 29177/2025, I.A. 29178/2025 & CAV 452/2025****MALKIT SINGH PROPRIETOR MAKHAN FISH
CORNER**

.....Appellant

Through: Dr. Farrukh Khan, Mr. Md. Affan and
Ms. Tanzeela Farheen, Advocates.

versus

**REGISTRAR OF TRADE MARKS TRADEMARKS REGISTRY &
ANR.**

.....Respondents

Through: Ms. Nidhi Raman, CGSC with Mr.
Mayank Sansanwal and Mr. Om Ram,
Advocates for R1.Mr. J. Sai Deepak, Senior Advocate
with Mr. Lakshay Sharma and Ms.
Kaveri Verma, Advocates for R2.**CORAM:****HON'BLE MR. JUSTICE TEJAS KARIA****TEJAS KARIA, J. (ORAL)****INTRODUCTION**

1. The present Appeal under Section 91 of the Trade Marks Act, 1999 (“Act”) read with Rule 125 of the Trade Marks Rules, 2017 has been preferred against the order dated 14.08.2025 (“**Impugned Order**”) passed by the learned Registrar of Trade Marks (“**Respondent No. 1**”) whereby the Appellant’s Mark, ‘MAKHAN FISH CORNER’ (“**Appellant’s Mark**”) registered under Trade Mark No. 2489327 (“**Subject Application**”) under



Class 43 was removed from the Register of Trade Marks pursuant to adjudication of the Rectification Petition No. 283976 (“**Rectification Petition**”) filed by *M/s Makhan Fish Co* (“**Respondent No. 2**”) before Respondent No. 1.

2. By consent of the Parties, this Appeal is taken up for final hearing.

FACTUAL MATRIX

3. The Appellant is a proprietor of a renowned business of providing food and drink services under the Appellant’s Mark since 1962. The Appellant and his family expanded the business under the Appellant’s Mark such as, ‘MAKHAN BANQUET’, ‘MAKHAN RESIDENCY’, ‘HOTEL MAKHAN RESIDENCY’ etc.

4. On 04.03.2013, the Appellant filed the Subject Application for the Appellant’s Mark for food and drink and allied services. The Subject Application was opposed by Respondent No. 2 *vide* Notice of Opposition No. 866649 dated 29.09.2016 (“**Opposition**”). After detailed pleadings and hearings, the Opposition was dismissed by Respondent No. 1 *vide* order dated 21.11.2022. The Appellant’s Mark was duly registered and a Certificate of Registration No. 3155697 was issued on 02.02.2023 (“**Registration**”) to the Appellant.

5. Subsequent to the Registration, Respondent No. 2 filed the Rectification Petition on 03.09.2024 before Respondent No. 1 seeking removal of the Appellant’s Mark from the Register of Trade Marks under Sections 57(1) and 58 of the Act.

6. The hearings for the Rectification Petition before Respondent No. 1 were conducted on 11.06.2025 and 17.07.2025. During the hearing held on



11.06.2025, the Appellant advanced detailed oral submissions. During the hearing on 17.07.2025, the Appellant made further submissions and reiterated objections to the maintainability of the Rectification Petition and substantiated the Appellant's prior adoption and extensive use.

7. Respondent No. 1 *vide* the Impugned Order allowed the Rectification Petition and directed removal of the Appellant's Mark from the Register of Trade Marks.

SUBMISSIONS ON BEHALF OF THE APPELLANT

8. The learned Counsel for the Appellant made the following submissions:

- 8.1. The Impugned Order has been passed without proper appreciation of facts, evidence, and the settled legal position governing Rectification Petition proceedings. Respondent No. 1 has failed to appreciate and consider that Respondent No. 2 primarily operates in Classes 29 and 35 (fish products and commission agency), which are completely different from Class 43 (food, drinks and allied services), in which the Appellant's Mark is registered.
- 8.2. The hearings in the Rectification Petition were conducted before Respondent No. 1 on 11.06.2025 and 17.07.2025, wherein the Appellant advanced detailed oral arguments.
- 8.3. Respondent No. 1, while passing the Impugned Order, erroneously allowed the Rectification Petition, resulting in the removal of the Appellant's Mark from the Register of Trade Marks. Respondent No. 1 failed to observe that the Appellant,



being the lawful proprietor and prior adopter of the Appellant's Mark has established its long-standing use, responsiveness, reputation, and goodwill.

8.4. Respondent No. 1 ought to have disclose the reasons to support his conclusion. The lack of reasons not only prejudices the right if the Appellant to identify grounds of Appeal, but also prevents this Court from discerning how Respondent No. 1 has applied minds and reached the conclusion. The passing of a reasoned and a speaking order is an integral part of the principle of *audi alteram partem*. The learned Counsel for the Appellant relied upon the following decisions in support of this submission:

- *Agriboard International LLC v. Deputy Controller of Patents and Designs*, 2022 SCC OnLine Del 4786
- *Rosemount INC v. Deputy Controller of Patents and Designs*, 2023 SCC OnLine Del 2487
- *Alfred Von Schukmann v. The Controller of Patents, Designs and Trademarks & Ors.*, 2023 SCC OnLine Del 140

8.5. Accordingly, the Impugned Order, suffers from non-application of mind, procedural irregularity, and legal infirmity, and is liable to be set aside.

SUBMISSIONS ON BEHALF OF RESPONDENT NO. 1

9. The learned Counsel for Respondent No. 1 submitted that they shall abide by any direction that may be issued in this Order.

SUBMISSIONS ON BEHALF OF RESPONDENT NO. 2

10. The learned Senior Counsel for Respondent No. 2 made the following



submissions:

- 10.1. Respondent No. 2 has placed on record documents evidencing use of the Mark, 'MAKHAN FISH COMPANY' ("**Subject Mark**") dating back to the year 1981. In contrast, the earliest document filed by the Appellant for the Appellant's Mark pertains to the year 2013, which position stands duly recorded. There is no document on record demonstrating any use of the Appellant's Mark by the Appellant prior to 2013. The Appellant has additionally relied upon third-party affidavits and has produced Chartered Accountant ("CA") certificates purportedly reflecting use of the Appellant's Mark from the year 2001.
- 10.2. The Appellant has no document to show their registration or use prior to 2001 or 2013. In fact, the Subject Application has been filed on 04.03.2013 claiming use since 01.01.1962. Respondent No. 2's registration for the Subject Mark is dated 30.05.2007 under Class 29 and the registration under Class 43 is pending.
- 10.3. The Impugned Order is well reasoned as it holds that:
- "9. It is also evident from the record available that the registered trademark was filed on 04/03/2013 claiming user since 01/01/1962. The registered proprietor has not filed any document showing the use of the impugned mark prior to the applicant for rectification. The earliest document filed by the registered proprietor to show the use of the impugned mark is of the year 2013. However, the applicant for rectification is already a registered proprietor of the trademark "MAKHAN" AND "MAKHAN FISH COMPANY" and has submitted documentary evidence showing the use of the mark*



much prior to the registered proprietor. Therefore, it is evident from the records that the applicant for rectification is the prior user and adopter of the mark.”

- 10.4. The Appellant’s adoption and use of the Appellant’s Mark is dishonest and intended to trade upon Respondent No. 2’s established reputation. The continued sale under the Appellant’s Mark is likely to cause confusion in the course of trade, resulting in erosion of consumer trust and dilution of the distinctive character of the Subject Mark as Respondent No. 2 is a well-known entity.
- 10.5. Respondent No. 2 is engaged in the sale of food products under Class 29, specifically fish-based food items, whereas the Appellant is engaged in the sale of food and drink and allied services under Class 43.
- 10.6. The Appellant’s Mark and the Subject Mark is identical, the product category is identical and the trade channel as also the consumer base is identical.
- 10.7. Accordingly, the present Appeal is liable to be set aside and the Impugned Order shall be upheld.

ANALYSIS AND FINDINGS

11. The present Appeal has been filed challenging the Impugned Order whereby Respondent No. 1 has allowed the Rectification Petition and directed removal of the Appellant’s Mark from the Register of Trade Marks. The core issue before the Court is whether the Impugned Order has been passed in accordance with the statutory requirements under the Act upon proper appreciation of material placed on record by the Parties.



12. The Appellant asserts prior and continuous use of the Appellant's Mark since 01.01.1962 for restaurant, food and drink services under Class 43. The Appellant in order to substantiate such long-standing use and goodwill acquired in the market, the Appellant placed on record documentary evidence including third-party affidavits, CA certificates, and business expansion documents dating back to at least the year 2001. These were specifically relied upon during the hearings held on 11.06.2025 and 17.07.2025 before Respondent No. 1.

13. The perusal of the Impugned Order reveals that Respondent No. 1 has not undertaken any analysis or evaluation of the evidence furnished by the Appellant. The findings proceed on the erroneous assumption that the Appellant failed to file any documents to demonstrate user prior to 2013. This assumption is contrary to the record and demonstrates non-consideration of relevant and material evidence.

14. The Appellant had also raised several substantive objections to the maintainability of the Rectification Petition, including *inter alia*: (i) non-maintainability of the Rectification Petition under Sections 57(1) and 58 of the Act; (ii) misrepresentation of professional capacity by Respondent No. 2's Counsel with improper Attorney Code usage and defective authority; (iii) Respondent No. 2 lacking *locus standi* as it is not a "person aggrieved" under Section 57(1) of the Act; (iv) contradictory and inconsistent user claims made by Respondent No. 2 across earlier proceedings; (v) non-compliance and inadmissibility of Respondent No. 2's evidence filed under Rule 45 of the Trade Marks Rules, 2017; (vi) unreasonable delay particularly after dismissal of the Opposition; (vii) suppression of dismissal



of Opposition proceedings and other material facts; (viii) lawful, *bona fide* adoption, acquired distinctiveness, and statutory validity of the Appellant's Mark; and (ix) documents relied upon by the Appellant particularly, the Evidence by way of Affidavit. None of the above has been considered or appreciated in the Impugned Order.

15. The Impugned Order does not appreciate the distinction between the classes of goods and / or services involved. Respondent No. 2 operates primarily under Classes 29 and 35 (fish products and commission agency), whereas the Appellant operates under Class 43 (food, drink and restaurant services). The likelihood of confusion, a foundational requirement for sustaining rectification, must necessarily be examined considering trade channels, business model, and consumer segmentation. The Impugned Order is entirely silent on this essential aspect.

16. The Impugned Order proceeds on the erroneous assumption that mere similarity of marks, irrespective of class differentiation and commercial realities, is sufficient to justify rectification of the Trade Mark. There is no examination of whether consumers of Class 43 services overlap with consumers of fish products and / or commission agency services under Classes 29 and 35. This failure to undertake such essential analysis renders the finding legally unsustainable.

17. Further, the Impugned Order demonstrates non-application of mind by summarily concluding that no documents evidence the Appellant's Mark use prior to 2013, without examining the documentary evidence placed on record. The third-party affidavits and CA certificates from 2001 submitted by the Appellant are brushed aside as there is no explanation given for



rejecting the Appellant's claim of use since 1962.

18. The Impugned Order also suffers from violation of the principles of natural justice. It contains conclusions without underlying reasons, thereby depriving the Appellant of the right to understand the basis of the adverse findings and meaningful appellate scrutiny as well. A party is entitled not merely to a hearing, but to a reasoned and speaking order, particularly where statutory rights of a registered proprietor are being interfered with.

19. It is trite law that a non-speaking, unreasoned or cryptic order passed or judgment delivered without taking into account the relevant facts, evidence available and the applicable law cannot be sustained.

20. The doctrine of legitimate expectation creates a corresponding duty upon statutory bodies to conduct the proceedings in a manner that is not only fair, but also appears to be fair. It is consistently held that the fundamental requirement of providing the reasons for arriving at a conclusion after duly considering the facts and circumstances of each case and dealing with all the relevant submissions is mandatory. Any decision without giving reasons is contrary to the fundamental tenets of natural justice.

21. Accordingly, the present Appeal is allowed and the Impugned Order dated 14.08.2025 is set aside. Rectification Petition No. 283976 is remanded back to Respondent No. 1 for a fresh decision after an opportunity of hearing to be given to the Parties in accordance with law and consideration of all the material on record.

22. Respondent No. 1 shall decide the Petition preferably within a period of six months from the date of receipt of this Order. It is clarified that no opinion or observation on the merits of either Party's claim of prior



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adoption, user or distinctiveness has been expressed herein. All issues shall remain open for determination by Respondent No. 1 without being influenced by this Order.

23. The Registry is directed to send a copy of this Order to the Office of the Controller General of Patents, Designs and Trade Marks at the e-mail address – llc-ipo@gov.in for necessary compliance.

24. The present Appeal is disposed of in the aforesaid terms. Pending Applications also stand disposed of.

TEJAS KARIA, J

NOVEMBER 26, 2025

sms/N