2025:DHC:5613-DB

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

\+ FAO (COMM) 105/2025, CM APPL. 25863/2025, CM APPL. 25864/2025 & CM APPL. 25865/2025

KAMAL RAHEJA .....Appellant

Through: Dr. Sarbjit Sharma, Adv.

versus

HAHNEMANN PURE DRUG CO. .....Respondent

Through: Mr. Peeyoosh Karla, Mr. Shadman Ali, Mr. K. P. Singh, Mr. Vikrant, Mr. Yashwant Singh Baghel, Mr. Rishabh Thakur and Ms. Lehar, Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR
HON'BLE MR. JUSTICE AJAY DIGPAUL

JUDGMENT (ORAL)

% **08.07.2025**

C.HARI SHANKAR, J.

1. The learned District Judge (Commercial Court-02), Rohini[1] has, by the impugned order dated 7 March 2025, allowed an application under Order XXXIX Rules 1 and 2 filed by the respondent and has dismissed an application under Order XXXIX Rule 4 of the CPC[2] filed by the appellant, as the plaintiff and defendant, respectively, in CS (Comm) 346/2023[3]. By the impugned order, the learned Commercial Court has made the *ex parte ad interim* order dated 8 June 2023, passed by his learned predecessor, absolute. By the order

[1] "the learned Commercial Court" hereinafter
[2] Code of Civil Procedure, 1908
[3] **Hahneman Pure Drug Co. v. Kamal Raheja**

dated 8 June 2023, the appellant, and all others acting on his behalf, were restrained from manufacturing, selling, exporting, displaying, advertising or in any other manner dealing or using the trade mark MARKS GO, or any other identical or deceptively similar trademark in respect of skincare cream and components thereof.

2. Dr. Sarabjit Sharma, appearing for the appellant, raises only one contention. The submission is that, as the Drug License issued to the respondent stands suspended, the respondent is not in a position to commercially exploit the asserted MARKS GO trademark and, therefore, was not justified in seeking an injunction against the appellant.

3. Though no other contention was raised, a brief reference to facts is necessary. The trademark MARKS GO stands registered in favour of the respondent, under the Trade Marks Act, 1999, with effect from 14 September 2010 in Class 5 of the NICE Classification applicable to trademark registration. The registrations are admittedly valid and subsisting. Alleging that, by manufacturing and selling similar products under an identical trademark MARKS GO, the appellant was infringing the registered trademark of the respondent, CS (Comm) 346/2023 stands instituted by the respondent against the appellant before the learned Commercial Court, seeking a decree of permanent injunction, restraining the appellant from using the infringing MARKS GO mark for its products. The suit was accompanied by an application under Order XXXIX Rules 1 and 2 of the CPC, seeking interim injunction, restraining the appellant, pending disposal of the suit, from using the MARKS GO mark. By order dated

8 June 2023, the learned Commercial Court granted an *ex parte ad interim* injunction in favour of the respondent and against the appellant, whereby the appellant was restrained, pending disposal of the Order XXXIX application filed by the respondent, from using the MARKS GO mark. The Appellant filed an application under Order XXXIX Rule 4 of the CPC, seeking vacation of the said interim order. By the impugned order dated 7 March 2025, the learned Commercial Court has allowed the application of the respondent under Order XXXIX Rules 1 and 2, making the *ex parte ad interim* order dated 8 June 2023 absolute, and has correspondingly dismissed the appellants application under Order XXXIX Rule 4 of the CPC.

4. The learned Commercial Court has found that the rival marks are identical, and used for similar products, and that the appellant had not succeeded in pleading acquiescence, on the part of the respondent, to the use of the MARKS GO mark by the appellant, who also enjoyed priority of user of the mark.

5. As already noted, Dr. Sarabjit Sharma, appearing for the appellant, advanced only one submission. He did not contest the merits of the matter, insofar as the aspect of infringement is concerned. The only submission advanced by Dr. Sharma is that, consequent to a show cause notice dated 13 May 2024, issued by the authorities under the Drugs and Cosmetics Act, 1940, and cancellation of the licence whereunder the respondents were manufacturing and selling the products under the mark "MARKS GO", the respondent is in no position to use the mark.

6. Accordingly, he submits that there was no question of granting any injunction in favour of the respondent.

7. He also seeks to submit that the respondent has, consequent to cancellation of the licence, adopted a new mark namely "MARKS OUT".

8. We have considered the submissions, but are constrained to observe that they are completely foreign to the issue of infringement of trademark under the Trade Marks Act.

9. The right to relief against infringement is provided, under Section 28(1)[4], consequent on the factum of registration of a mark. Commercial user of the mark is not required in order for an infringement action to lie.

10. The fact that the registration of the respondent's "MARKS GO" mark under the Trade Marks Act is subsisting is not in dispute.

11. Once the registration of the mark is subsisting, Section 28(1) grants, to the registrant, the right to seek relief against infringement.

12. Infringement, as defined in the various sub-sections of Section 29 of the Trade Marks Act, is not dependent on user, but on registration. Each sub-section of Section 29 commences with the

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[4] **28. Rights conferred by registration**. –
(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

words "a registered trade mark". Thus, the plaintiff's trade mark is required to be registered, and the registration subsisting; nothing more.

13. As such, commercial user of the registered mark is not a *sine qua non* for an infringement action to lie.

14. Lack of commercial user of a registered trade mark does constitute a ground, under Section 47(1)[5] of the Trade Marks Act, to remove the trademark from the register of trademarks, but that is subject to (i) an application being moved by an aggrieved person seeking removal of the mark and (ii) continuous non-user of the mark, by its registered proprietor, for a period of 5 years, up to 3 months prior to the date of the application. In any event, there is no provision which enables the Registrar *suo motu* to remove a mark from the

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[5] **47. Removal from register and imposition of limitations on ground of non-use**. –

(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the High Court by any person aggrieved on the ground either—

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of Section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

Provided that except where the applicant has been permitted under Section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the Registrar or the High Court, as the case may be, is of opinion that he might properly be permitted so to register such a trade mark, the Registrar or the High Court, as the case may be, may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to—

(i) goods or services of the same description; or

(ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.

register of trade marks. It has to be on application by an aggrieved person.

15. There is no provision, in the Trade Marks Act, which can deem a registered trademark not to be registered, or divest the proprietor of a registered trade mark from the rights conferred by Section 28(1) as a consequence of such registration, merely because the mark is not in commercial use. We, therefore, are of the firm view that it is not open to an infringing defendant to escape the consequences of infringement of a registered trade mark on the ground that the proprietor of the registered trade is not subjecting it to commercial use. The defendant would, in that case, have to apply under Section 47(1) to have the registered trade mark removed from the register of trademarks and can only, thereafter, defend the case.

16. Section 28(1) commences with the words "Subject to the other provisions of this Act, the registration of a trade mark shall, *if valid*, give to the registered proprietor of the trade mark the exclusive right…" No doubt, therefore, the right to relief against infringement enures only in favour of the proprietor of a registered trademark, *which is valid*. At the interlocutory injunction stage, however, the plaintiff is only required to establish a *prima facie* case. Section 31(1) of the Trade Marks Act unequivocally provides that the very registration of a trade mark shall be *prima facie* evidence of its validity in all legal proceedings relating to the registered trade mark. Thus, at the interlocutory stage, mere registration of the trade mark of the Plaintiff would suffice to constitute *prima facie* evidence of its validity. It is not open, therefore, to the defendant, at the interlocutory

stage, to ordinarily contend that the plaintiff is not entitled to any injunction against the defendant, even where infringement is found to exist, as the registration of the Plaintiff trade mark is invalid. The Trade Marks Act itself contains provisions[6] in which, even if the ingredients of Section 29 are found to exist, no infringement can be set to take place. It also contains provisions which insulate an infringing defendant from injunction[7]. Short of these provisions, an infringing defendant must suffer the consequences of infringement as envisaged by Section 135(1)[8] of the Trade Marks Act.

17. We may also refer, in this context, to the definition of use of a mark as contained in Section 2(2)(b) and 2(2)(c)[9] of the Trade Marks Act, which make it apparent that the concept of "use of a mark" under the Trade Marks Act is much wider than mere affixation of the mark on products which may be bought and sold in the market.

18. Besides, the cancellation of licence of the respondent has taken place under the Drugs and Cosmetics Act. The respondent may have his remedies against such cancellation and we cannot, at this stage,

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[6] Refer Sections 30(1) and 30(2)(a)

[7] Refer Sections 30(1), 33, 34 and 35

[8] **135. Relief in suits for infringement or for passing off**. –

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in Section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

[9] (2) In this Act, unless the context otherwise requires, any reference—

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(b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;

(c) to the use of a mark,—

(i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;

(ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services;

predict as to whether that cancellation would persist forever.

19. The right to seek relief against infringement, under Section 28(1) read with Section 135(1) of the Trade Marks Act cannot, in any event, be sacrificed at the altar of user.

20. The fact that the respondent may, consequent to the decision of the authority under the Drugs and Cosmetics Act, have adopted another mark is also no embargo on the respondent asserting his right against infringement consequent to the registration of the mark 'MARKS GO'.

21. No other argument has been advanced by Mr. Sharma.

22. We accordingly find no reason to interfere with the impugned order.

23. The appeal is accordingly dismissed.

C. HARI SHANKAR, J.

AJAY DIGPAUL, J.

JULY 8, 2025/an

Click here to check corrigendum, if any