



2025:DHC:1451



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**% *Date of decision: 27th February, 2025*

+ C.O. (COMM.IPD-TM) 542/2022

VEEKESY RUBBER INDUSTRIES PVT LTD.Petitioner

Through: Mr. Ashutosh Kumar, Mr. Ishaan George, Mr. Swarnil Dey, Dr. Rukma George, Mr. Archit Jain & Mr. Ashhab Khan, Advocates.

versus

KAMAL BANSAL

....Respondent

Through: None.

CORAM:**HON'BLE MR. JUSTICE AMIT BANSAL****AMIT BANSAL, J. (Oral)**

1. The present rectification petition has been filed under Sections 47, 57, and 125 of the Trade Marks Act, 1999 (hereinafter, 'the Act') seeking removal of the trademark 'VKG' bearing trademark registration no. 2092681 in Class 25, from the Register of Trade Marks.

PROCEEDINGS IN THE PETITION

2. Notice in the present petition was issued by the erstwhile Intellectual Property Appellate Board (IPAB). Despite service, the respondent no.1 failed to appear before the IPAB. Thereafter, the present petition was received on transfer after the abolition of the IPAB pursuant to the Tribunal Reforms Act, 2021.



3. Court notice was issued to the parties by this Court on 22nd April, 2022. However, none appeared on behalf of the respondents.
4. The petitioner filed an affidavit of service dated 9th March, 2023, asserting that the Trade Mark Agent of the respondent no.1 had been served *via* speed post and e-mail.
5. Thereafter, this Court *vide* order dated 26th July, 2023, directed the Registry to effect service through WhatsApp on the respondent no.1.
6. *Vide* order dated 11th December, 2023, it has been recorded that the respondent no.1 had been served on 4th November, 2023 by the Registry through WhatsApp. As per the affidavit of service of the petitioner, the respondent no.1 had been served through WhatsApp on 25th September, 2023. In the same order, the respondent no.1 was granted final opportunity to file reply by 16th December, 2023.
7. Neither any reply was filed on behalf of the respondent no. 1, nor any appearance was made on behalf of the respondent no. 1. Consequently, the respondent no.1 was proceeded against *ex-parte vide* order dated 18th December, 2023.

BRIEF FACTS

8. Brief facts leading to the filing of the present petition are as follows:
 - 8.1. The petitioner company is a part of the VKC group of companies. The VKC group was established in the year 1984 and has been engaged in the business of manufacturing and marketing footwear in India.
 - 8.2. The petitioner is the registered proprietor of trademark 'VKC' bearing registration no.1574632 in class 25, in respect of footwear (including Hawaii slippers) with effect from 2nd July, 2007. The petitioner conceived and adopted the aforesaid mark in a *bona fide* manner from the name of the



founder of the VKC Group, Mr. V.K.C. Mammed Koya. The petitioner has been continuously using the said mark in India since 1985 through its predecessor-in-title, in respect of footwear and parts of footwear.

8.3. The 'VKC' mark has been used by the petitioner independently and also in conjunction with words such as 'Pride', 'Lite', 'Stile', 'Slipon', 'Smartak', 'Junior' and 'Trendz' in respect of different category/range of footwear and parts of footwear. The trademark registrations of the petitioner in respect of 'VKC' mark and its formative marks remain valid and subsisting.

8.4. The petitioner's products bearing the said mark are marketed in India through its 439 dealers spread all across India. The petitioner also exports the said products to various countries around the world.

8.5. The sales turnover of the petitioner's products bearing the mark 'VKC' for the period 2003-2013 has been filed along with the petition (*page 106 of the documents filed with the petition*). The petitioner's products bearing the mark 'VKC' had annual sales of Rs. 868 crores (approx.) in the year 2012-2013.

8.6. The aforesaid products of the petitioner bearing the 'VKC' mark and its formative marks have been extensively advertised and promoted through print media, mailers, newsletters, trade shows, seminars and websites having widespread reach and circulation. Due to long and continuous usage of the mark 'VKC', the petitioner has acquired immense goodwill and reputation.

8.7. The respondent no.1 was granted registration of the mark 'VKG' (hereinafter referred to as "the impugned mark") *vide* registration no. 2092681 in respect of all types of footwears under Class 25 in India. The application for registration of the impugned mark was filed on 1st February,



2011 claiming user from 7th January, 2011.

SUBMISSIONS OF THE PETITIONER

9. Mr. Ashutosh Kumar, counsel appearing on behalf of the petitioner, submits that the petitioner is the prior adopter and prior user of the trademark 'VKC', using the said mark since 1985 through its predecessor-in-title whereas, the respondent no.1 had applied for registration of the impugned mark with user claim since 7th January, 2011.

10. He further submits that the impugned mark is violative of Section 9(2)(a) of the Act as it is likely to deceive the public and cause confusion in the market due to its similarity with the petitioner's mark 'VKC' being used in respect of same goods.

11. It is further submitted that impugned registration is contrary to Section 11(1) of the Act as the impugned mark is structurally, visually and phonetically similar to the petitioner's prior mark 'VKC' and also amounts to passing off the respondent no. 1's products as those of the petitioner.

12. Pursuant to the query put forth by the Court on 13th March, 2023, the petitioner conducted further investigation which revealed that the respondent no.1's products are not available in the market despite having registered the impugned mark under Class 25 and subsequent applications filed to renew the impugned mark. The user claim of respondent no.1 is false and, therefore, the respondent no.1 cannot claim to be owner of the mark under Section 18 of the Act. In this regard, reliance has been placed on ***H&M Hennes & Mauritz AB and Ors. v. HM Megabrand Pvt. Ltd. and Ors.***, 2018:DHC:3620.

13. Accordingly, the petitioner has filed the present petition.

ANALYSIS AND FINDINGS



14. I have heard counsel for the petitioner and also perused the record of the present petition.

15. The respondent no.1 has not filed its reply to the present petition, which indicates that it has nothing substantial to put forth on merits, by way of a response to the averments made in the petition. In view of the above, the averments made in the petition are deemed to be admitted.

16. In *H&M Hennes & Mauritz AB and Ors. v. HM Megabrand Pvt. Ltd. and Ors.*, 2018:DHC:3620 [decided on 31.05.2018], a Co-ordinate bench of this Court has held that mere presence of a mark in the Register does not prove use. The relevant paragraph of the said judgment is set out below:

“14. Qua question (VI) above, this Court in Express Bottlers Services Pvt. Ltd. Vs. Pepsico Inc. 1989 (9) PTC 14 and Century Traders Vs. Roshan Lal Duggar & Co. AIR 1978 Delhi 250 (DB), besides in Prakash Roadline Ltd. and Pankaj Goel supra cited by the plaintiffs, held that mere presence of mark in register (or of a name on the records of Registrar of Companies) does not prove use and a proprietor of a trade mark is not expected to pursue each and every insignificant infringer. It thus follows that use, even if any by others of the alphabets ‘HM’ or ‘H&M’ as part of their trade mark/ trade name, cannot deprive the plaintiffs, if otherwise found entitled to interim injunction against the defendants of such injunction. Reference may also be made to P.M. Diesels Vs. S. M. Diesels AIR 1994 Delhi 264 holding that in a suit for infringement, it is the right of the two parties before the Court only which are to be examined and not qua others.”

[Emphasis supplied]

17. From the averments made in the petition and the documents on record, the petitioner has established that it is the prior registered proprietor and a prior user of the mark ‘VKC’ formative marks since the year 1985



through its predecessor. As per the registration certificate granted in favour of the petitioner, the petitioner has claimed user from 1985 (*filed as document along with the petition at page 39*). The petitioner has also filed invoices from the year 2006 to establish its user claim (*filed as document along with the petition at pages 107-130*).

18. On the other hand, even though the respondent no.1's mark has been registered in 2012, the respondent no.1 did not file any invoices or any other documents evidencing the user of the impugned mark. Therefore, the mark is liable to be removed on the ground of non-user.

19. In this regard, reference may be made to an earlier decision passed by this Bench in *DORCO Co. Ltd. v. Durga Enterprises and Another*, 2023 SCC OnLine Del 1484 wherein this Court had ordered the removal of the mark on the ground of non-user. The relevant observations from *DORCO* (supra) are set out below:

“8. In the judgment in Shell Transource Limited v. Shell International Petroleum Company Ltd., 2012 SCC 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.

9. In the present case, the allegations of “non-user” against the respondent no.1 stand admitted in the absence of a specific denial of the same and the impugned trademark is liable to be removed from the Register of Trade Marks on account of “non-user” as contemplated under Section 47(1)(b) of the Act.

*10. From the facts detailed above, it is clear that the petitioner is the proprietor of the impugned trademark. **The respondent no.1 cannot claim to be the proprietor of the impugned trademark as there is nothing to show as to how the impugned trademark has been adopted by the respondent no.1.** Therefore, the application for registration of the impugned trademark is in contravention of Section 18(1) of the Act. In fact, the registration of the petitioner's identical mark in respect of similar*



goods, was pending in India and was also cited as a conflicting mark in the examination report issued in the application for registration of the impugned trade mark. Therefore, as per Sections 9(1)(a) and 11(1)(a) of the Act, the registration of the impugned trademark could not be granted.”

[Emphasis supplied]

20. Furthermore, the petitioner has established that it has adopted the mark ‘VKC’ in a *bonafide* manner from the name of the founder of the VKC Group, Mr. V.K.C. Mammed Koya. The petitioner has also filed on record its sales turnover from the financial year 2003-2004 till 2012-2013 to show its goodwill and reputation in the market.

21. The adoption and the use of the impugned trademark ‘VKG’ by the respondent no.1, which is very similar to the trademark ‘VKC’ of the petitioner, is likely to create confusion in the market. Not only is the trademark of the respondent no.1 confusingly/deceptively similar to the petitioner’s prior adopted, registered trademark ‘VKC’ and its formative marks but the nature of the goods of the petitioner and the respondent no.1 are identical, i.e. footwear falling in Class 25.

22. In view of the discussion above, it is clear that the impugned trademark has been adopted by the respondent no.1 dishonestly to trade upon the established goodwill and reputation of the petitioner and to project itself to be associated with the petitioner. Therefore, the continuation of the impugned registration on the Register of Trade Marks is in contravention of the provisions of Sections 9, 11 and 18 of the Act and is liable to be cancelled under Sections 47 and 57 of the Act.

23. Accordingly, the present petition is allowed and the Trade Mark Registry is directed to remove the impugned registered trademark ‘VKG’ bearing trademark registration no.2092681 in Class 25 from the Register of



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Trade Marks.

24. The Registry is directed to send a copy of the present order to the Trade Mark Registry at e-mail - llc-ipo@gov.in for compliance.

FEBRUARY 27, 2025

at

AMIT BANSAL, J