



2025:DHC:5104



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

% **Reserved on: April 29, 2025**
Pronounced on: July 01, 2025

+ **C.A.(COMM.IPD-TM) 44/2024, I.A. 31273/2024-Stay**

AVIENT SWITZERLAND GMBH

.....Appellant

Through: Mr. Peeyoosh Kalra, Mr. Amol Dixit
and Ms. Pragati Agrawal, Advocates.

versus

TREADFAST VENTURES & ANR.

.....Respondents

Through: Mr. Anshul Goel and Mr. Ashok Goel,
Advocates for R-1.

CORAM:

HON'BLE MR. JUSTICE SAURABH BANERJEE

J U D G M E N T

Preface:

1. The appellant/ original applicant before the Trade Marks Registry, New Delhi¹ has preferred the present appeal under Section 91 of the Trade Marks Act, 1999² assailing the order dated 12.02.2024³ passed by the learned Assistant Registrar of Trade Marks⁴, whereby the application bearing no.1336157 of the appellant for the trademark 'RENOL' in *Class* 2 has been refused and the opposition bearing no.880655 of the respondent no.1/ original opponent before the Registry, who is the owner of the trademark 'REINOL' in *Class(es)* 1 and 3, has been allowed.

¹ hereinafter referred to as "**Registry**"

² hereinafter referred to as "**TM Act**"

³ hereinafter referred to as "**impugned order**"

⁴ hereinafter referred to as "**respondent no.2**"



Brief Conspectus:

2. As per appellant, one Clariant AG, the appellant herein/ current proprietor/ successor-in-interest i.e. Avient Switzerland GMBH, assigned all its rights, title and interest in the trademark ‘RENOL’ to it *vide* a Deed of Assignment executed on 21.01.2020. The present appeal has been filed through them.

3. The said appellant, Avient Switzerland GMBH, is one of the world’s leading company specialising in chemicals, which operates into four business areas namely, ‘care chemicals’, ‘natural resources’, ‘catalysis’, and ‘plastics and coatings’. The appellant was formed in the year 1995 as a spin-off from the chemical company namely, ‘Sandoz’ (a company established in the year 1886, in Basel). In connection with its worldwide business, the appellant owns and uses several trademarks, prominent amongst which is the trademark ‘RENOL’, adopted in the year 1905 which has since been used in various countries across the globe.

4. For carrying on with its business activities and safeguarding its rights, the appellant has filed applications and/ or secured registrations for the trademark ‘RENOL’ in numerous countries, with the earliest registration dating back to the year 1905 in Germany. Further, the appellant claims to have been using the trademark ‘RENOL’ in India, since the year 2001.

5. The appellant’s predecessor-in-interest filed an application bearing no.1336157 before the Registry on 03.02.2005 for registration of the mark ‘RENOL’ in *Class* 2, with a priority claim being of 11.08.2004 (based on the convention application bearing no.55376/2004) in respect of “*paints*,



varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists; colorants, in particular colorants for resins; colorant preparations, in particular colorant preparations containing organic or inorganic pigments or dyestuffs and carrier material”.

6. Subsequent thereto, the said application was scrutinised and an Examination Report was issued on 25.02.2005 wherein none of the trademark registrations of the respondent no.1 were cited as conflicting marks by the Registry.


7. Thereafter, the appellant’s predecessor-in-interest filed its reply to the Examination Report along with a request on Form-16 to correct/ modify the user claim since 26.12.2001. Subsequent thereto, the appellant’s predecessor-in-interest i.e. Clariant AG also filed a request on Form-16 dated 18.05.2005 to amend/ restrict the specification of goods to “*Colorants, in particular colorants for resins; colorant preparations, in particular colorant preparations containing organic or inorganic pigments or dyestuffs and carrier material”.*


8. The Registry appointed hearings in the matter on 13.08.2014, 04.06.2015, 22.09.2015 and 04.11.2015 whereafter, the appellant’s predecessor-in-interest filed an affidavit of Dr. Birgit Wust and Mr. Rolf Lengweller on 28.10.2016 substantiating use of the trademark ‘RENOL’ since 26.12.2001 in India. Thereafter, another hearing was appointed on 02.11.2016, whereafter the trademark ‘RENOL’ under application bearing



no.1336157 came to be advertised in the Trade Marks Journal bearing no.1771-0 on 14.11.2016.

9. Subsequent thereto, on 15.03.2017, the respondent no.1 filed a Notice of Opposition bearing no. DEL-880655 against registration of the trademark 'RENOL' under application bearing no.1336157, contesting the same on the basis of prior registration of its trademark 'REINOL' (under registration

nos.428103 and 554206 in *Classes* 1 and 3 respectively),  (under registration no.670476 in *Class* 1), 'RIO-REINOL' (under registration

 no.441817 in *Class* 1) and (under Registration no.502188 in *Class* 1) and that the said marks have been used by the respondent no.1 and/ or its predecessor-in-interest since 1984 and 1991 in respect of goods falling in *Class(es)* 1 and 3 respectively, to which the appellant's predecessor-in-interest filed its counter statement on 27.10.2017.

10. Thereafter, on 26.02.2018, the appellant's predecessor-in-interest's attorney received a letter dated 23.02.2018 from the respondent no.1's Agent stating that the respondent no.1 does not wish to adduce any evidence in support of the Opposition and would instead rely on the grounds stated in the Notice of Opposition under *Rule 45* of the Trade Marks Rules, 2017⁵ with liberty to adduce evidence at a later stage.

⁵ hereinafter referred to as "*TM Rules*"



11. The appellant's predecessor-in-interest filed its affidavit of evidence under *Rule 46* of the TM Rules in support of the subject application on 25.04.2018. The matter was listed for hearing on 07.11.2019, 20.10.2022, 21.11.2022 and 21.06.2023, wherein arguments were heard, and the impugned order has been passed.

12. *Vide* the impugned order, the Opposition bearing no.DEL-880655 filed by the respondent no.1 was allowed and the application bearing no.1336157 filed by appellant for registration of the trademark 'RENOL' was rejected.

13. Aggrieved thereby, the appellant by way of the present appeal prayed for setting aside of the impugned order.

Submissions on behalf of the Appellant:

14. Mr. Peeyoosh Kalra, learned counsel for the appellant submitted that even though the Invoice bearing no.184644 dated 16.12.2001 issued by the subsidiary of the appellant's predecessor-in-interest i.e. Clariant (India) Limited, clearly evidenced sale of goods under the trademark 'RENOL', and which was filed alongwith the affidavit of Dr. Birgit Wust and Mr. Rolf Lengweller on 28.10.2016 was already on record, the issue *qua* the remaining documents filed by the appellant being illegible and/ or being filed after the closure of the evidence without following the due process of law, were irrelevant. As per Mr. Peeyoosh Kalra, the respondent no.2 erred in holding that the appellant failed to prove the user claim since 2001 and that it has instead been using the trademark 'RENOL' since the year 2006. In effect, the same is contrary to the records of the Registry and is an error apparent on the face of the record.



15. Mr. Peeyoosh Kalra further submitted that since the appellant's predecessor-in-interest had honestly adopted and registered the trademark 'RENOL' more than a century ago i.e. in the year 1905, it was a prior adopter, having its registration since the year 1905 in Germany along with several international jurisdictions of the trademark 'RENOL'. Moreover, the appellant has also been extensively and uninterruptedly using the trademark 'RENOL' ever since. The appellant's predecessor-in-interest had adduced cogent documents in order to establish its user claim of the trademark 'RENOL' since the year 2001 in India, and since the turnover of the appellant's products under the trademark 'RENOL' starting with USD 46,901 (approx. INR 3.9 million) in the year 2001 and going up to USD 12.79 million (approx. INR 1 billion) for the year 2017 in India alone, the respondent no.2 erred in holding that the appellant had not proved its claim of proprietorship of the trademark 'RENOL' by adducing any evidence under *Section 18* of the Act. In view of the aforesaid facts, there is no doubt whatsoever with regard to the proprietorship of the appellant.

16. Mr. Peeyoosh Kalra then submitted that reliance by the respondent no.2 upon *Century Traders vs. Roshan Lal Duggar & Co.*⁶ in view of the aforesaid is thus misplaced.

17. Mr. Peeyoosh Kalra also submitted that in view of the aforesaid, the respondent no.2 erred in summarily adjudicating the Opposition proceedings and refusing the appellant's application solely on the ground that the appellant failed to adduce cogent evidence in support of user claim. More so,

⁶ F.A.O (O.S) 46/1976



since the online records available on the website of the Registry for the respondent no.1's trademark 'REINOL' reveal that it never adduced even a single document in support of its use of the trademark 'REINOL' in respect of any goods whatsoever or for that matter establishing any of its claims as set out in the Notice of Opposition.

18. Mr. Peeyoosh Kalra further submitted that in the opposition proceedings also the respondent no.1, *admittedly*, filed a letter expressing its desire to not file any evidence in support thereof and instead sought to rely upon the grounds stated in the Notice of Opposition under *Rule 45* of the TM Rules. Here also, the position is the same, as the respondent no.1 has not filed anything in support thereof.

19. Mr. Peeyoosh Kalra, then, relying upon *Corn Products Refining Co. vs. Shangrila Food Products Ltd.*⁷ submitted that in absence of any documentary support of the so-called claim made by the respondent no.1 herein is a mere assertion of prior registration, which, as per settled position of law, is not enough, as mere presence of a mark in the Register of Trade Marks itself does not prove its user.

20. Mr. Peeyoosh Kalra further submitted that, in any event, the appellant and the respondent no.1 operate in different *Class* of goods and services and the respondent no.1 has filed the Notice of Opposition on the basis of registration of the trademark 'REINOL' in *Class(es)* 1 and 3, whereas the appellant has sought registration under *Class* 2, wherein the appellant is the prior adopter and user.

⁷ 1959 SCC OnLine SC 11



21. Lastly, Mr. Peeyoosh Kalra relying upon ***Gupta Enterprises vs. M/s. Gupta Enterprises & Anr.***⁸ submitted that it is a settled position of law that wherein the Opposition is based on the alleged registration and/ or use and/ or reputation of its trademark, the burden of establishing the same lies upon the opponent, the respondent no.1 herein, who has failed to discharge the same.

Submissions on behalf of the Respondent No.1:

22. Mr. Anshul Goel, learned counsel for the respondent no.1 on the other hand, supporting the impugned order submitted that the respondent no.1 is the prior adopter and user as also the registered proprietor of the ‘REINOL’ formative marks under *Class(es)* 1 and 3 in India, and the earliest registration thereof is dating back to the year 1984 in *Class* 1 and the year 1991 in *Class* 3. Each of the said registration(s) is/ are valid and subsisting as on date.

23. Further, relying upon ***Patel Field Marshal Agencies & Ors. vs. P.M. Diesels Ltd. & Ors.***⁹, Mr. Anshul Goel submitted that as per *Section 31* of the TM Act, registration is *prima facie* evidence of validity and the issue of validity can only be dealt with under rectification proceedings, and since there is no opposition and/ or rectification proceedings pending against the respondent no.1’s trademark ‘REINOL’, the said trademark is valid.

24. Mr. Anshul Goel further submitted that the appellant has filed application for registration of a deceptively similar trademark ‘RENOL’ in complete bad faith despite having knowledge of the earlier registrations of

⁸ AIR 1998 Delhi 232

⁹ MANU/SC/1509/2017



the trademark ‘REINOL’ in *Class(es)* 1 and 3 of the respondent no.1, particularly when the registrations are much prior to the user claim of the trademark ‘RENOL’ as sought in the application. Moreover, since the appellant herein has sought registration in *Class* 2, and the respondent no.2 has due registrations in *Class(es)* 1 and 3, which are relating to allied and cognate goods, the trademark ‘RENOL’ of the appellant is liable to be truck off.

25. Mr. Anshul Goel then submitted that since the goods of the appellant and the respondent no.1 are sold through the same trade channels and have common end users and customers, there is a likeliness of confusion and deception being caused in the minds of an average man with imperfect recollection.

26. In any event, as per Mr. Anshul Goel, the test laid down under *Section 11* of the TM Act is of similarity/ identity and/ or likelihood of confusion/ association of the competing marks and goods and does not require them to be falling in the same class.

27. Mr. Anshul Goel also submitted that the appellant initially filed application bearing no.1336157 on 03.02.2005 on a “*proposed to be used*” basis, only to later amend the user claim to 26.12.2001 on 01.04.2005, *albeit*, without any documents with the affidavit of evidence under *Rule 46* of the TM Rules therewith on 25.04.2018.

28. Mr. Anshul Goel then submitted that the appellant cannot be permitted to rely upon the evidence filed by it as it was in non-compliance of *Rule 46* of the TM Rules.



29. Mr. Anshul Goel further submitted that since the trademark law is territorial in nature, it was the duty of the appellant to prove its user claim in respect of the goods claimed in India. Not having done so, the application of the appellant has rightly been rejected by the respondent no.2. Relying upon ***Toyota Jidosha Kabushiki Kaisha vs. Prius Auto Industries Ltd.***¹⁰ Mr. Anshul Goel submitted that the trademark registrations in foreign jurisdiction is not enough to show spillover reputation in India and/ or to claim prior use in India. As per Mr. Anshul Goel, the appellant has made false user claim of the trademark 'RENOL' in India since the year 2001, which has rightly been dealt with by the respondent no.2.

30. Lastly, in support of the aforesaid, Mr. Anshul Goel relied upon ***Corn Products Refining Co. (Supra), FDC Limited vs. Docsuggest Healthcare Services Pvt. Ltd. & Ors.***¹¹ and ***Minda Spectrum Advisory Limited & Ors. vs. Minda Oils India Pvt. Ltd. & Ors***¹².

Analysis & Findings:

31. This Court has heard Mr. Peeyoosh Kalra, learned counsel for the appellant and Mr. Anshul Goel, learned counsel for the respondent no.1 however, there was no representation by anyone on behalf of the respondent no.2, and has also gone through the documents on record along with the relevant judgments on the issues cited therewith.

32. For any Opposition proceedings, as per settled position of law an opponent/ the respondent no.1 can lead evidence under *Rule 45* of the TM

¹⁰ MANU/SC/1619/2017

¹¹ MANU/DE/0011/2017

¹² MANU/DE/3612/2022



Rules and the non-filing thereof means that the Examiner is to proceed on the basis of mere averments/ pleadings in the Notice of Opposition made by the said opponent/ respondent no.1, which will lead to its own consequences. The veracity of the said averments/ pleadings are to be tested on the anvil of facts and circumstances involved, more so, since the opponent/ respondent no.1 for substantiating the claim made, has to first lead evidence and prove the exclusive right. In fact, a learned Single Judge of this Court in ***M/s. Gupta Enterprises vs. M/s. Gupta Enterprises & Anr.***¹³ held as under:-

“9. ... *It is well-settled principle of law that in an opposition proceedings the onus is ultimately upon the applicant to establish that he is entitled to the registration of the trade mark applied for. Where the opposition is based on the alleged registration of the trade mark or the use and reputation of the opponent's trade mark or on any other fact, the onus of establishing those facts lies upon the opponent. It is only when the opponent initially discharges his onus that the burden shifts to the applicant.*

10. ... *It cannot be disputed that registration of trade mark gives to registered proprietor the exclusive right to use the said trade mark in connection with the goods registered. If there is any invasion of this right by any person the registered proprietor can protect his right by opposing the same. For initiating any such action he has prima facie to lead evidence and prove his exclusive right. But Kewal Krishan failed to prove registered proprietor of the trade mark “GUPTA” nor he could prove that he was prior use of this mark.*”

[Emphasis supplied]

33. Therefore, in view of the aforesaid, it is clear that the onus of establishing the claim of proprietorship in opposition proceedings clearly vested with the opponent/ respondent no.1.

¹³ AIR 1998 Del 232



34. In the present proceedings, non-filing of evidence by the said opponent/ respondent no.1 could prove fatal, more so, since the appellant had filed Invoice bearing no.184644 dated 16.12.2001 issued by the subsidiary of the appellant's predecessor-in-interest i.e. Clariant (India) Limited, clearly evidencing sale of goods under the trademark 'RENOL' filed along with the affidavit of Dr. Birgit Wust and Mr. Rolf Lengweller on 28.10.2016, and the respondent no.1, *admittedly*, chose not to file any evidence in support of its Notice of Opposition/ any document(s) in support of its use of the trademark 'REINOL' in respect of any goods whatsoever either alongwith its application seeking registration thereof or in the opposition proceedings or before this Court at any stage. Clearly, the said Invoice bearing no.184644 dated 16.12.2001 issued by the subsidiary of the appellant has been ignored by the respondent no.2.

35. In any event, filing of Notice of Opposition itself cannot be/ is not thus, a sufficient ground for the Examiner for proceeding with allowing any Opposition proceedings. More so, since the appellant is not a fly by night operator and was having worldwide registrations with continuous and uninterrupted usage of the trademark "RENOL" since and from the year 1905 till to-date.

36. In the present proceedings, where the respondent no.2 was *admittedly* dealing with bare assertions/ averments without any supporting evidence/ document(s) corroborating/ substantiating them in the Opposition proceedings initiated by the respondent no.1, there was no reason/ cause/ occasion for it to have allowed the said Opposition proceedings. In any event,



the respondent no.1 could not have been/ cannot be allowed to enjoy trafficking of its trademark by stretching the benefit of being registered in a particular *Class(es)* involving allied and cognate goods. This, in fact when the Hon'ble Supreme Court, while dealing with the said aspect, held in ***Vishnudas Trading vs. Vazir Sultan Tobacco Co.***¹⁴ “... ..that registration of a trade mark cannot be held to be absolute, perpetual and invariable under all circumstances”.

37. More so, when as per the settled position of law, mere registration of a trademark and its presence in the Register of Trade Marks in itself is not sufficient. Reliance in this regard is placed upon ***Corn Products Refining Co. (Supra)*** wherein the Hon'ble Supreme Court observed that “... ..Now of course the presence of a mark in the register does not prove its user at all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register.”, citing the law laid down in ***Beck, Kollar & Co. 64 RPC 76*** wherein it has been held that “... ..But when the same question comes before the Registrar in opposition proceedings, it appears to me that he is no longer in a position to make any presumption as regards the surrounding circumstances, but that before he can draw the suggested inference based upon the user of other marks either in the applicant's or the opponent's favour, any such user must be established by evidence (see, e.g. *Harrods Ltd.'s Application*, 52 RPC, p. 70, 1. 39-p. 71, 115, where the

¹⁴ (1997) 4 SCC 201



Registrar refused to draw the necessary inference in favour of the applicants in the proceedings).”.

38. Also, the Hon’ble Supreme Court in ***Century Traders (supra)*** held that “... ..*for the purpose of claiming proprietorship of a mark, actual use of the mark under such circumstances such as showing an intention to adopt and use it as a Trade Mark. A mere casual, intermittent or experimental use may be insufficient to show an intention to adopt the mark as a Trade Mark for specific article or goods... ..*”. Therefore, it was incumbent upon the respondent no.1 to have led due, proper and cogent evidence to substantiate/ corroborate its averments/ pleadings made in the Notice of Opposition before the respondent no.2.

39. A bare reading of the impugned order reveals that since the aforesaid aspect has not been considered at all, there is/ are no finding(s) thereon by the respondent no.2. The Opposition proceedings have been allowed on the basis of ‘alleged’ user claimed by the respondent no.1, while ignoring that of the appellant. If the impugned order is allowed to subsist it will render the provisions *qua* filing of evidence in the Opposition proceedings *otiose* as they will depend on what is filed on record. If at all, in the present Opposition proceedings, the respondent no.2 ought to have holistically dealt with all the document(s) on record before it and rendered a definitive/ reasoned finding thereon. Alas! the same is missing in the impugned order.

40. Thus, the impugned order cannot be sustained in the eyes of law. As such, this Court needs not to go into the other submissions made by the learned counsel for the parties.



41. Resultantly, the opposition proceedings bearing no.880655 of the respondent no.1/ original opponent *qua* the trademark application bearing no.1336157 of the appellant is remanded back to the Registrar of Trade Marks for adjudication afresh by the Examiner on merits and in accordance with law with a direction to dispose of the same *preferably* within a period of *six months* from the date of receipt of the present judgment. Needless to say, during the said period of *six months*, no unnecessary adjournment be sought and/ or granted.

42. Since this Court has not expressed any opinion on the merits of the case, the Registrar of Trade Marks shall be free to proceed with the matter without being influenced by any of the observation herein above, in accordance with law.

43. Accordingly, the present appeal is allowed and the impugned order dated 12.02.2024 passed by the respondent no.2 is set aside. The appeal alongwith the pending application is accordingly disposed of.

44. A copy of this judgment be forwarded to the Registrar of Trade Marks for compliance.

SAURABH BANERJEE, J

JULY 01, 2025/AB