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

Date of Decision: 11th March, 2024

+ **C.O. (COMM.IPD-TM) 276/2022**

GM MODULAR PVT LTD.

... Petitioner

Through: Mr. Ajay Amitabh Suman,
Mr. Rishabh Gupta, Mr. Deepak
Shrivastava and Mr. Mankaran Singh,
Advocates.

versus

MAYUR ELECTROMECK PVT LTD. AND ANR. ... Respondents

Through: Mr. Amit Kumar, Advocate for R-1.
Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar Mishra,
Mr. Alexander Mathai Paikaday and
Mr. Krishnan V., Advocates.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

JUDGMENT

SANJEEV NARULA J. (Oral)

1. The Petitioner, holding registration of the marks “”,
“”, “” and their formative variants [*collectively*,
“*GM trademarks*”], has filed the present petition being aggrieved with the



registration of the label/ trademark “” under No. 1332839 in class 09 in the name of Respondent No. 1 [*hereinafter*, “*Impugned Mark*”]. The impugned registration covers PVC insulating wires and cables, including motor winding wires – a category directly related to the broader range of electrical appliances, components, goods, accessories, and related services marketed by the Petitioner under their GM trademarks. The Petitioner, asserting rights based on prior use, argues that the Impugned Mark infringes upon their proprietary rights and leads to significant market confusion. This confusion, they contend, erodes the distinctive character and goodwill that the “GM” brand and its related marks have cultivated, thereby impacting Petitioner’s standing in the electrical goods and services sector.

CONTENTIONS OF THE PETITIONER

2. Mr. Ajay Amitabh Suman, counsel for Petitioner, makes the following submissions:

2.1. The Petitioner is predominantly engaged in the business of manufacture and trade of an extensive array of electrical switches, accessories, appliances, and electronic components under the GM



trademarks. This word mark along with the device mark [“”] was honestly coined, conceived and adopted by the Petitioner in the course of trade in 1999, and forms the central element of their corporate identity. The “GM” label has distinctive artistic qualities depicted by its unique presentation, get-up, makeup, lettering style, and colour scheme.



2.2. The Petitioner has secured numerous registrations for their “GM” trademarks across classes, particularly for wires and cables in class 09, which demonstrates their widespread use, recognition, and legal protection in the relevant market segments. The specifics of these registrations are detailed as follows:

Trade Mark	Applica- tion No.	Cla- ss	Date of Application	Logo/ label	Status
GM INDIA	1277293	6	7/4/2004		Regd
GM, INDIA	888186	7	25/11/1999		Regd
GM	934451	7	26/06/2000		Regd
GM	934456	7	26/06/2000		Regd
GMUSIC	1074060	7	16/01/2002		Regd
GM INDIA	888187	9	25/11/1999		Regd
GM	934452	9	26/06/2000		Regd
G MUSIC (LABEL)	1074061	9	16/01/2002		Regd
GM	934454	9	26/06/2000		Regd
GM INDIA	888188	11	25/11/1999		Regd
GM	934453	11	26/06/2000		Regd
GM	934455	11	26/06/2000		Regd
GMUSIC	1074062	11	16/01/2002		Regd



GM INDIA (LABEL)	1277292	17	7/4/2004		Regd
GM (DEVICE)	979183	21	26/12/2000		Regd
GM INDIA (DEVICE)	1252933	37, 38	3/12/2003		Regd

2.3. In addition to the above, the Petitioner holds a copyright registration



for the “GM” label under registration No. A-64280/2003. The wordmark “GM” is also openly and continuously used in the Petitioner’s domain name and e-mail addresses.

2.4. The Petitioner has invested significantly in the promotion and marketing of the GM trademarks, dedicating considerable financial resources to ensure their prominence in the relevant market sectors. As a result, the GM trademarks have become synonymous with Petitioner’s corporate identity and is an essential element of their business branding. The prolonged, continuous, and public utilization of the GM trademarks has generated significant goodwill and a strong reputation, which is exclusively associated with the Petitioner.

2.5. Respondent No. 1 has adopted the Impugned Mark



“GMW”, which possesses deceptive similarity to the Petitioner’s GM trademarks and is used in relation to allied and cognate goods viz. PVC insulating wires and cables, including winding wire for motors included in class 09. Such similarity in the competing marks and manner of use between the Petitioner’s GM trademarks and the Impugned Mark, is likely to cause confusion.



2.6. The Petitioner has established through credible evidence, such as sales invoices dating back to 2001 and extensive documentation of advertisement beginning in 2002, their longstanding precedence in use and registration of the GM trademarks. Conversely, Respondent No. 1 filed for registration of the Impugned Mark on 18th January, 2005, claiming use from 01st January, 2005 and has failed to provide any convincing evidence to show the use of the Impugned Mark.

2.7. Further, the proximity between the date of filing of application for registration (18th January, 2005) and the claimed usage (01st January 2005) raises concerns of veracity of the claimed usage period, suggesting a possible misrepresentation in the application process regarding the actual use of the impugned trademark in commerce prior to its registration. Respondent No. 1's inability to prove their claimed user since 01st January, 2005 illustrates that they have dishonestly and fraudulently obtained the impugned registration. Thus, the Impugned Mark is liable to be removed from the Register.

CONTENTIONS OF RESPONDENT NO.1

3. Mr Amit Kumar, counsel for Respondent No.1, contends that the competing marks are different, negating any basis of confusion between them. On this ground, he asserts that the petition is not maintainable under Section 57 of the Trademarks Act, 1999 since the Petitioner does not meet the criteria of an 'aggrieved person'. His contentions are summarised hereinbelow:

3.1. The present rectification petition is marred by a significant delay on



the part of the Petitioner. Assuming the Petitioner became aware of the Impugned Mark through its publication in the Trademarks Journal No. 1339-1 dated 15th February, 2006 yet, there exists a significant delay of 10 years until the initiation of this rectification petition. Such a prolonged period of inaction suggests a lack of diligence on the part of the Petitioner in protecting their trademark rights, rendering it liable to be dismissed on this ground alone.

3.2 Respondent No. 1, through predecessors-in-interest, coined and adopted the wordmark “GMW” on 01st April, 1981 and has been continuously, extensively, and openly using the Impugned Mark in relation to goods falling in classes 17, 19 and 39 since 1981, and those under classes 09 and 35, since 2005.



3.3. The Impugned Mark is a distinctive device mark “”, featuring three letters “GMW” accompanied with the by-line “POLY SUBMERSIBLE WINDING WIRE”, set against a black background, that has been validly registered under class 09 *w.e.f.* 18th January, 2005. This mark is visually, phonetically, structurally, and conceptually different from the Petitioner’s GM trademarks. The distinguishing factors detailed above offer sufficient points of distinction from the trademarks of the Petitioner cited in the rectification petition. This differentiation is not merely superficial but significantly alters the Impugned Mark’s overall appearance and message, thereby eliminating any potential for confusion among the general public.

3.4. Respondent No. 1 is claiming protection over the mark



“GMW” as a whole, and not exclusively over the letters ‘GMW’ which comprise the label/ device of Respondent No. 1. This is a crucial factor in ascertaining the issue of ‘deceptive similarity’, particularly in view of several judicial precedents interpreting Section 17 of the Trademarks Act that categorically hold that an assessment of competing trademarks must be undertaken in their entirety, considering the marks as whole entities. This principle highlights that the mere use of a portion of a mark by one party does not constitute trademark infringement.¹

3.5. While Respondent No. 1’s application for the Impugned Mark was being processed, Examination Report issued by the Trademarks Registry raised objections under Sections 9 and 11 of the Trademarks Act, *inter alia*



citing the Petitioner’s trademark “GM” [bearing application No. 934452] as a conflicting similar mark. Despite these objections, the distinctiveness of the Impugned Mark as a label was recognized by the Registry, leading to a successful registration.

3.6 Furthermore, the Examination Reports of the Petitioner’s trademark applications for Nos. 934452 and 934454 mentioned the registered trademark “GM” under No. 129621 held by a third-party. In response, the Petitioner unequivocally stated that objections based on the similarity of letters *per se* could be disregarded due to their mark being a device mark, which is visually and graphically distinct from the cited mark. The Petitioner

¹ Reliance was placed upon the judgments in *Super Cassettes Industries Ltd. v. Union of India and Ors.*, DHC Neutral Citation: 2010:DHC:2230 and *M/s D.R. Raanka Bros v. Om Prakash*, dated 23rd February,



is now bound by their own categorically stated position, and cannot credibly challenge the distinctiveness of Respondent No.1's trademark in the current petition.

3.7. Notwithstanding the above, Respondent No. 1 maintains that the packaging and presentation of goods under the Impugned Mark distinctly delineate their origin, effectively eliminating any potential for consumer confusion or deception. The unique combination of get-up, lettering style, colour scheme, and overall trade dress associated with Respondent No.1's goods are markedly different from those of the Petitioner's products. This deliberate differentiation in branding and packaging underscores the clear distinction between the two trademarks, ensuring that consumers can easily recognize and differentiate the source of goods. Consequently, the allegation of passing off, as claimed by the Petitioner, lacks merit due to these substantial and deliberate distinctions in the visual and thematic elements of the trademarks' presentation.

ANALYSIS AND FINDINGS

4. The Court has carefully deliberated upon the arguments advanced by both sides and perused the evidence placed on record.

Is Petitioner a 'person aggrieved'?

5. The Petitioner has demonstrated that they are the registered proprietor of formative "GM" device trademarks in various classes, including classes 07, 09 and 11, since the year 1999. The GM trademarks are used by the Petitioner on a large variety of electronic products, such as switches,

2021 in O.S.A. Nos. 122 and 125 of 2020.



accessories, sockets of several varieties, socket outlets, socket shutters, ordinary switches, push type switches, flush type switches, etc. Numerous documents evincing widespread use and publicity campaigns of the GM trademarks have been produced on record, demonstrating the visibility and recognition of Petitioner's GM trademarks within the electrical goods sector. Therefore, despite its brevity as a two-letter mark, the mark "GM" has, through sustained and extensive use by the Petitioner, come to acquire a distinct secondary meaning and a strong association within the electrical trade. It is a well-recognized principle in trademark law that even brief marks containing letters are entitled to protection, provided they are arbitrary in composition and uniquely identified with a single source.² The critical test for assessing the similarity between trademarks hinges on the potential for consumer confusion or deception. As would be discussed in the forthcoming segment, a comparison of the Petitioner's GM trademarks against the Impugned Mark reveals a substantial risk of consumer confusion. Therefore, the Petitioner, being the owner of the GM trademarks, is clearly a person aggrieved under Section 57 of the Trademarks Act, who can maintain the instant cancellation petition.

Similarity between the contesting marks

6. Similar to the Petitioner's commercial activities, Respondent No.1 has adopted the Impugned Mark in relation to manufacture and trade of wires and cables. Notably, Petitioner holds prior registrations of the marks

² See: J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* and *P.P. Jewellers Pvt. Ltd. v. P.P. Buildwell Pvt. Ltd.*, DHC Neutral Citation: 2009:DHC:4042.



 and “” for *inter alia* wires and cables, dating 25th November, 1999 and 26th June, 2000, respectively.³ While Respondent No. 1 argues that the competing device marks are dissimilar when assessed comprehensively, the Court nonetheless finds there to be substantial resemblance between the rival marks. Respondent No. 1’s reliance on the unique visual and textual components of the Impugned Mark overlooks the fact that “GM”, being the dominant portion of the competing marks, would be recalled by an average consumer with imperfect recollection. The argument posited by them, emphasizing the visual and structural distinctions of the Impugned Mark, fails to fully mitigate the risk that consumers may overlook these differences in the marketplace. When trademarks are encountered in their natural commercial environment, consumers often rely on quick recognition rather than a detailed analysis of each mark’s components. This similarity between the marks is further accentuated by the intersection between the nature of goods and services offered by both parties. Therefore, the resemblance between the rival marks extends beyond mere appearance, to the core attributes that define their identity and recognition in the marketplace. Such close overlap enhances the potential for confusion among consumers, who may struggle to distinguish between the origins of the goods and services offered under these closely associated trademarks. Therefore, even subtle similarities between the “GM” and “GMW” marks, especially given their use in the same class of goods, cannot dispel the possibility of confusion.

³ Under Nos. 888187 and 934452, respectively.



7. Thus, Respondent No. 1's case for distinctiveness, while compelling on its surface, overlooks the broader context within which trademarks operate. The primary function of a trademark is to signify the origin of goods to consumers, and in industries where goods are closely related, even minor similarities between marks can lead to confusion. The addition of the letter 'W' and the specific by-line, though arguably creating visual differences, does not necessarily mitigate the phonetic and conceptual similarities that consumers may perceive between Petitioner's "GM" and Respondent No. 1's "GMW" marks, especially given their application in identical market sectors.

8. While the Court acknowledges that the Impugned Mark successfully passed the examination phase despite initial objections under Sections 9 and 11 of the Trademarks Act, this alone, does not preclude the potential for consumer confusion, which remains a central concern of trademark law. The clearance of the Impugned Mark during its registration process is not infallible. The registration, despite prior objections, does not inherently validate the mark's distinctiveness. The fact that the Impugned Mark was objected to on the basis of similarity to the Petitioner's GM trademarks highlights the potential for confusion, that was also recognized at an early stage.

9. In view of the foregoing, the Court concludes that registration of the Impugned Mark would be contrary to Section 11(1)(b) of the Trademarks Act as it would not be distinctive of Respondent No.1's goods or services.

Non-use of the Impugned Mark by Respondent No. 1

10. The Impugned Mark, although granted registration on 01st February,



2007, has not been shown to have been put to commercial use ever since. To substantiate their use, Respondent No. 1 has presented copies of Income Tax Returns, sales figures since 2006-07 and advertisement expenses between 2010-2016, and an ISO certificate, all of which, do not evidence that Respondent No. 1 employed the Impugned Mark in trade. Their sales figures pertain to an entirely different mark, “MAYUR”. Moreover, in the name of promotional material, Respondent No. 1 has produced two stray advertisements that prominently display the impugned “GMW” mark. Of these, one pamphlet/ advertisement does not bear a date of publication, while the other newspaper advertisement was published only on 10th May, 2016, *i.e.*, after the filing of the present petition. This further underscores the lack of substantial use or recognition of the Impugned Mark in comparison to the established presence and market penetration of the Petitioner’s GM trademarks. Therefore, absent any cogent proof, Respondent No. 1’s claims of open and continuous use of Impugned Mark remain uncorroborated, thereby rendering it liable to be cancelled under Section 47 of the Trademarks Act.

11. Under these circumstances, following the settled law, in order to maintain the purity of the Register, the Court is of the opinion that Respondent No.1’s registration for the Impugned Mark must be cancelled/removed from the Trademarks Register.

RELIEFS

12. In view of the above, the present petition is allowed with following directions:

(a) Registration under the trademark No. 1332839 for the trademark



“” in class 09, is cancelled.

(b) Trademarks Registry is directed to issue an appropriate notification to the above effect.

(c) Registry is directed to supply a copy of the present order to the Trademarks Registry at llc-ipo@gov.in for compliance.

13. The petition is disposed of.

SANJEEV NARULA, J

MARCH 11, 2024/nk

(corrected and released on 26th March, 2024)