

ORDER SHEET
IN THE HIGH COURT AT CALCUTTA
Special Jurisdiction
ORIGINAL SIDE

TMA/5/2022

ITC LIMITED
VS
KHAYRUL BASHAR AND ANR.

BEFORE:

The Hon'ble JUSTICE RAVI KRISHAN KAPUR

Date : 30th November, 2022.

Appearance:
Mr. Ranjan Bachawat, Sr. Adv.
Mr. D.N. Chunder, Adv.
Mr. Manosij Mukherjee, Adv.
Mr. D. Dawn, Adv.

The Court : This application is filed inter alia seeking removal and/or expungement of the trade mark No. 4270201 “NEEMYLE” (device) registered in Class 3 proposed to be used in respect of bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.

Despite service, the respondent no.1 has chosen to remain unrepresented.

The petitioner is the registered proprietor, prior adopter and user of the coined trademark “NIMYLE” since 1996 in respect of goods registered in Class 3. The petitioner is also the registered proprietor of the trademark “NIMYLE” having registration nos. 2148683 and other “NIMYLE” formative trademarks bearing registration no. 2731972, registration no. 2731973 and registration no. 2731974 respectively. The mark “NIMYLE” is being used by the petitioner continuously and extensively since the year 1996 by the petitioner and its predecessor-in-interest, Arpita Agro Products Private Limited. The documents evidencing assignment of the rights of the

trademark "NIMYLE" in favour of the petitioner on April 19, 2018 have been duly filed and such requests have been recorded by the Trade Marks Registry.

By virtue of extensive, and continuous use as well as substantial efforts in the marketing and promotion, of the product "NIMYLE", the product of the petitioner has acquired tremendous goodwill and reputation in the market and as such the same is exclusively identified with the petitioner.

It is contended on behalf of the petitioner that the impugned registration being Trade Mark no.4270201 of the mark NEEMYLE in favour of the respondent no.1 has been obtained wrongfully. There was no proper nor adequate search which has been conducted by respondent authorities prior to grant of such registration in favour of the respondent no.1. All such mandatory requirements have been not adhered to by the respondent no.2. It is also contended on behalf of the petitioner that, the respondent has obtained registration of the impugned mark through misrepresentation and by making false representation regarding proprietorship of the impugned mark. The class of customers and trade channels of the goods covered under the impugned mark are also identical and as such the likelihood of confusion and/or deception is overt and irrefutable. Thus, the impugned registration is not bona fide, without sufficient cause and has been wrongly entered and continues to remain on the Register. The subsistence of the impugned mark on the Register is also against public interest.

In my view, in granting the impugned registration of the mark "NEEMYLE" in favour of the respondent no.1 has been obtained wrongfully and contrary to law. The Search Report relied on by the respondent

authorities prior to granting of the impugned mark is ex facie incorrect and false. It was incumbent on the respondent no.2 to carry out adequate and diligent searches of earlier marks applied for or registered in respect of same or similar goods, identical with or deceptively similar to the impugned mark before grant of the impugned registration. Under the provision of Section 11 of the Trade Mark Act, 1999 read with Rule 33 of the Trade Marks Rules 2017, it was the duty of the Registrar of Trade Marks to thoroughly examine the application placed by the respondent no.1 and make an elaborate and proper search of earlier registered and pending trademarks which are identical or similar to the impugned mark. Thus, the respondent no.2 was obliged to prepare a comprehensive report and search all similar/identical registrations and other pending marks.

In my view, the respondent no.2 has failed to follow the prescribed mandatory requirements laid down under the Trade Marks Act, 1999 and the Rules framed thereunder and conduct a proper investigation. In any event, the continuance of the impugned mark in the Register is also against public interest and affects the goodwill and reputation of the prior registered mark of the petitioner.

In view of the aforesaid, the application for rectification is allowed with a direction on the respondent no.2 to cancel, remove and expunge the entry relating to the impugned mark "NEEMYLE" registered under No. 4270201 in Class 3.

With the aforesaid directions, TMA/5/2022 stands allowed.

(RAVI KRISHAN KAPUR, J.)