



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 18.08.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)/265 to 269/2023
(ORA/20 to 24/2018/TM/CH)
(T)OP(TM)/335/2023
(ORA/19/2018/TM/CH)

Feroke Boards Limited,
4/239, PO, Karad, (Via) Farook College,
Malappuram - 673 632, Kerala.

... Petitioner in all OP's

-vs-

1.Universal Hardware,
KP IV/517, 518, 519, 520, 521,
Area Code, -Mukkom Road,
Kuttooli, Valillapuzha Post,
Malappuram, Kerala - 673 639.

2.The Registrar of Trade Marks,
Trademark Registry,
Chennai.

... Respondents in all OP's

COMMON PRAYER: Transfer Original Petition (Trademarks) filed under Sections 57(1) and 57(2) of the Trademarks Act, 1999, praying to allow the rectification applications by removing/expunging the entry relating to 3219798, 3502492, 3223976, 3504450, 3504449 and



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3223596, respectively, in class 19 from the Register of Trade Marks and award costs of these proceedings to the applicant.

For Petitioner : Mr.K.Premchandrar, Mr.N.C.Vishal
in all OP's for M/s.Anand and Anand

For Respondent 1 : No Appearance
in all OP's

For Respondent 2 : Mr.A.R.Sakthivel, SPC
in all OP's

COMMON ORDER

In this batch of six rectification petitions, notice was served privately on the first respondent on 19.06.2023. Therefore, the Registrar was directed to print the name of the respondent in the cause list. Upon taking note of the bailiff's report, it was also recorded that Court notice was served on the first respondent on 27.06.2023. In those circumstances, in spite of the absence of the first respondent, the matter was proceeded with on 08.08.2023 when



learned counsel for the petitioner presented his arguments. In order to provide one further opportunity to the first respondent, the matter was adjourned until today. At the hearing today, once again, there is no representation.

2. Learned counsel for the petitioner invited my attention to the legal use certificate granted to the petitioner in respect of the word mark 'FEROPLY'. The said certificate records that the mark is proposed to be used as on the date of application, namely, 18.04.1990. He also placed for consideration the legal use certificate in respect of the word and device marks FERO BOARD, FERO WOOD, FERO FURN, FERO SHOPPE, FERO DOOR and FERO. He pointed out that these registrations were in class 19, 20 and 35 pertaining to materials used in buildings and construction. Learned counsel further submitted that the petitioner commenced use of the marks shortly after applying for registration in the year 1990. In support of use from the year 1990, he placed reliance on the legal use certificate



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issued in relation to the word mark FEROPLY and pointed out that such legal use certificate specified use from 18.04.1990.

3. Learned counsel next contended that the first respondent adopted the identical marks FERO and FEROPLY initially and even applied for registration of the same. Therefore, the petitioner filed a civil suit in O.S.No.3 of 2016 before the District Court at Manjeri and obtained an order of injunction restraining use of the impugned marks. In those circumstances, the first respondent abandoned the marks FERO and FEROPLY. According to learned counsel, the first respondent, thereafter, dishonestly adopted the deceptively similar word and device marks MKFEROPLY, MKFEROCLUB and MKFEROGOLD. Since the petitioner did not notice the advertisement in relation to the said marks, the marks came to be registered. Hence, these petitions were filed before the erstwhile Intellectual Property Appellate Board. In response to these petitions, the first respondent filed a counter statement. In the said counter



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statement, the first respondent asserted that the word and device marks adopted by it are unique and novel in as much as the letters MK correspond to the initials of Mr.MK.Fasil, who is a partner of the partnership firm, Universal Hardware. The first respondent further stated that the word FERO was adopted because 'F' stands for Fasil and 'R' stands for Raseela while the letter "O" represents the Universal Globe. Therefore, the first respondent stated that its marks are distinctive.

4. The documents on record disclose that the petitioner adopted the word and device marks "FERO" and FEROPLY from 18.04.1990. The documents on record further disclose that applications for registration of these marks were made shortly prior to the use of the marks and registrations were obtained in class 19, 20 and 35 in relation to plywood and boards. The first respondent carries on the same business. The record further discloses that the first respondent also initially adopted the marks FERO and FEROPLY. The use of such marks was abandoned by the first respondent after the



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petitioner instituted civil proceedings to restrain the use of such marks.

5. In those circumstances, the first respondent appears to have adopted the impugned marks by adding the letters MK and a device to form composite marks containing the words FERO or FEROPLY, as the case may be. While the explanation proffered by the first respondent as regards the use of the letters MK may be acceptable, the explanation with regard to the adoption of composite marks with the words or elements FERO and FEROPLY is unacceptable. In view of the first respondent's knowledge of prior use of the marks FERO, FEROPLY, FERODOOR and the like by the petitioner herein, the adoption of the impugned marks cannot be characterized as honest. In this regard, it bears repetition that the petitioner and the first respondent are carrying on near identical businesses and the impugned marks are being applied to identical products. Such use is likely to cause confusion and deceive consumers as regards source.



As the prior user with registration in respect of word and device marks containing the words FERO and FEROPLY, the petitioner is entitled to an order of rectification.

6. For reasons set out above, these petitions are allowed. Consequently, the Registrar of Trade Marks is directed to remove the entry relating to Trademark Nos.3219798, 3502492, 3223976, 3504450, 3504449 and 3223596 in class 19 from the Register of Trademarks and take all consequential actions. This exercise shall be completed within a period of *six weeks* from the date of receipt of a copy of this order.

18.08.2023

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Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes / No



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