



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 19.09.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/3/2023
(OA/37/2010/TM/CH)
(T)CMA(TM)/53/2023
(OA/30/2015/TM/CH)

(T)CMA(TM)/3/2023:

M/s.Hindustan Unilever Limited,
(Formerly Known as Hindustan Lever Limited)
165/166, Backbay Reclamation Mumbai 400 025.

Also at: Unilever Home
BD Sawant Marg,
Chakala, Andheri, East Mumbai 400 099.

... Appellant

-VS-

1.The Deputy Registrar of Trade Marks,
Trade Marks Registry,
Chennai.

2.P.C.Thahir,
Trading as Aghin Chemicals & Cosmetics,
13/750, Annie Hall Cross Road,
Calicut, Kerala - 673 002.

... Respondents



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PRAYER: Transfer Civil Miscellaneous Appeal (Trade Marks) filed under Sections 91, 92 of the Trade Marks Act, 1999, praying that an order be passed setting aside the impugned order dated 29th March 2010 passed by the Learned Deputy Registrar of Trade Marks and Impugned order dated 29th March 2010 be set aside and remand matter for reconsideration to the first respondent with a direction to re-consider the matter on established principle of laws.

For Appellant : Mr.K.Premchandar,
Ms.Madhu Rewari,
Mr.L.Ram Prasad
for M/s.Anand and Anand

For Respondent 1 : Mr.C.Samivel, SPC

For Respondent 2 : Mr.Perumbulavil Radhakrishnan

(T)CMA(TM)/53/2023:

M/s.P.C.Thahir,
Trading as Aghin Chemicals & Cosmetics,
Indian, having office at 13/750, Annie Hall Cross Road,
Calicut, Kerala - 673 002. ... Appellant



-VS-

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1.M/s.Hindustan Unilever Limited,
Hindustan Lever Limited,
165/166, Backbay Reclamation,
Mumbai 400 020.

2.The Deputy Registrar of Trade Marks,
Trade Marks Registry,
Intellectual Property Building,
Guindy, Chennai - 600 032.

... Respondents

PRAYER: Transfer Civil Miscellaneous Appeal (Trade Marks) filed under Section 91 of the Trade Marks Act, 1999, praying to modify the order of the Hon'ble Deputy Registrar, Trade Marks dated 29th March 2010 passed in Application No.757598 in Class 3 in the name of Mr.P.C.Thahir, Trading as Aghin Chemicals and Cosmetics Indian, having office at 13/750, Annie Hall Cross Road, Calicut - 673 002, Kerala and Opposition No.MAS-721068 filed by Hindustan Unilever Ltd., Hindustan Lever House, 165/166, Back Bay Reclamation, Mumbai - 400 020, to proceed for registration without any restrictive condition such as limiting the goods as detergent powder in Class 3 for sale in Kerala only and allow this appeal.



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For Appellant : Mr.Perumbulavil Radhakrishnan

For Respondent 1 : Mr.K.Premchandrar,
Ms.Madhu Rewari,
Mr.L.Ram Prasad

For Respondent 2 : Mr.C.Samivel, SPC

COMMON JUDGMENT

By order dated 29.03.2010 Trade Mark Application No.757598 was allowed subject to the restriction that the marks be applied only in relation to goods sold in the State of Kerala. The opponent before the Trade Marks Registry has assailed the order in (T)CMA(TM)/3/2023 and the applicant has sought a modification of the impugned order in (T)CMA(TM)/53/2023. Since both appeals arise out of a common order, they are disposed of by this common judgment.



WEB COPY 2. The first respondent herein applied for registration of the following device mark



in Application No.757598, which was filed on 17.06.1997. The said application claimed use since 02.06.1997 in relation to detergent powder. The application was accepted for advertisement and such advertisement was published on 01.08.2007. Pursuant thereto, the opponent issued notice of opposition on 27.02.2008 under Opposition No.MAS-721068. After a hearing on 10.02.2010, the order impugned herein was issued.

3. Learned counsel for the opponent submitted that the impugned order does not take into account the extensive evidence



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adduced by the opponent in support of its opposition. In order to substantiate this contention, learned counsel referred to and relied upon certificates of registration obtained by the opponent's predecessor-in-interest in respect of the trade mark SUNLIGHT on 19.10.1948 and the registration obtained in respect of mark SUN on 16.08.1954. Learned counsel also invited my attention to the sales turnover and advertisement expenditure from the sale of detergent powder / cakes / bar soaps bearing the word and device mark SUNLIGHT between 1994 and 1997. Likewise, learned counsel also placed for consideration the sales turnover and advertisement expenditure between the years 1980 - 1991 from the sale of products bearing the aforesaid marks.

4. Although the above evidence was placed before the Registrar of Trade Marks, learned counsel contended that the operative portion of the impugned order does not engage with the evidence on record



or provide any reasons for rejecting the opposition on the basis of such evidence.

5. As regards the evidence adduced by the applicant, learned counsel submitted that use was claimed in the application from 02.06.1997, whereas the invoices submitted by the applicant are from 01.04.1998 onwards. For the above reasons, learned counsel concluded that the impugned order is liable to be set aside and the matter remanded for reconsideration.

6. In response to these contentions, Mr.Perumbulavil Radhakrishnan, learned counsel for the applicant, submitted that the application was filed on 17.06.1997, whereas the hearing took place in February 2010. Consequently, he contended that the applicant was entitled to rely upon evidence of use subsequent to the date of application. He also pointed out that the opponent had filed a Civil Suit (C.S.No.862 of 2010) before the Bombay High Court to restrain



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use of the mark SUN PLUS by the applicant and that the application for interim injunction was rejected by the Bombay High Court. In these circumstances, learned counsel concluded his submissions by stating that the impugned order calls for interference only insofar as restriction on the territory of use is concerned.

7. The impugned order is about 8 pages in length. However, the operative portion thereof is confined to pages 6 to 8, and the key conclusions from the operative portion of the order are set out below:

"The 1st objection taken by the Opponent that the Trade Mark is not capable of distinguishing the goods from the Applicants during the course of trade. I have examined the objections made by the Opponents and arguments made by the Ld' Counsel of the Applicants Kerala. Hence I am not able to sustain the objection of the Opponents under Section 11(1)(a) as a Trade Mark as a whole is different to the Opponent marks.

Moreover, the Applicants has claimed the



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use of the mark and filed sufficient evidence to establish their concurrent use of Label mark since the adoption in respect of goods detergents. In special circumstances, the Applicants are entitled for Registration under Section 12 of the Trade Marks Act subject to the conditions as Register may think fit.

I have gone through the record available before the Tribunal and come to the conclusion that the Applicants have established their rights of Proprietorship atleast in the state of Kerala on the basis of long use, where the Hon'ble Court also recognized their Intellectual property rights under Trade Mark SUN PLUS. Hence, the Applicants are the proprietor of the mark SUN PLUS label under Section 18(1) of the Act. In the above circumstances I have to use my discretionary power under Section 18(4) of the Trade Marks Act, 1999 as the Applicants have established their Proprietorship under Trade Mark SUN PLUS Label in respect of detergents in the State of Kerela. Hence, the Application is accepted for Registration



and goods to be confined to read as detergent powder included in Class 3 for sale in the State of Kerala only."

8. From the above, it is evident that the first conclusion of the Registrar of Trade Marks was that the trade mark of the applicant is different from the opponent's mark. Other than recording such conclusion, no reasons are set out as to the basis for such conclusion. The second conclusion is that the applicant is an honest and concurrent user and, therefore, entitled to the benefit of Section 12 of the Trade Marks Act, 1999. Once again, such conclusion was not drawn after dealing with the evidence placed on record by the contesting parties. The third conclusion is that the record discloses that the applicant has established proprietorship in the State of Kerala on the basis of long and extended use. This conclusion was also drawn without engaging with the evidence.



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9. Consequently, the impugned order is unsustainable and is, hereby, set aside. It is pertinent to notice that the interim application in the suit filed by the opponent in Bombay was rejected and although an appeal appears to have been filed against such order, admittedly, there is no stay as on date. Therefore, the remand of this matter for reconsideration would not come in the way of use of the relevant mark by the applicant unless decided otherwise in appellate proceedings. By taking these facts and circumstances into account, I direct the Registrar of Trade Marks to provide a reasonable opportunity to both parties and issue a reasoned order reckoning the evidence already placed on record within a maximum period of *three months* from the date of receipt of a copy of this order. Both the appeals are disposed of on the above terms without any order as to costs.

19.09.2023

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Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes/No



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SENTHILKUMAR RAMAMOORTHY,J

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