



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 17.11.2023

CORAM:

THE HON'BLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

(T) CMA (TM) No.25 of 2023(OA/10/2013/TM/CHN)

&

(T)CMP(TM). 12 of 2023

Sony Group Corporation

also trading as Sony Corporation

1-7-1 Konan, Minato-ku, Tokyo,

108-0075 Japan.

... Appellant

(Amended as per order dated 31.08.2023 in
CMP (TM) No.1/2023)

v.

1. Walkman Rubber Industries,

15/1440 D-Part Kundunghat,

Calicut -673 003, Kerala (state)

... 1st Respondent

2. Deputy Registrar of Trade Marks

IPR Building,

Industrial Estate

SIDCO RMD Godown Road

Near Eagle Flask Factory

GST Road, Guindy,

Chennai - 600 032.

... 2nd Respondent

PRAYER: This Transfer Civil Miscellaneous Appeal (trade marks) filed under Section 91 of the Trade Marks Act, 1999 in respect of goods or services falling in one class, prays that (i) The order dated August 03, 2012, passed by Respondent No. 2/learned Deputy



Registrar communicated vide official letter no. TOP/ No /1548 dated September 25, 2012, received on **October 03, 2012** may kindly be set aside and consequently opposition bearing 721558 filed by the Appellant / Opponent may kindly be allowed and resultantly, application no. 681154 filed for registration of trade mark WALKMAN (label) be refused registration; and (ii) order costs of proceedings in favour of the Appellant/Opponent.

For Appellant : Ms.Anuradha Salhotra
for M/s.Rahul Chaudhry
and Partners

For Respondents : No appearance for R1
Mr.M.Karthikeyan for R2

JUDGMENT

Background

The appellant assails an order dated 03.08.2012 by which Opposition No.MAS-721558 was rejected and Application No.681154 for registration of the following device mark was accepted for registration:





2. The appellant opposed the registration of the device mark extracted above by relying on its prior registration of the word mark WALKMAN in Class 25 under Trade Mark No.433960 with effect from 16.02.1985. The appellant also opposed the registration by asserting that its trade mark is a well-known trade mark. In response to the notice of opposition of the appellant, the first respondent herein filed a counter statement and asserted that the appellant's mark is applied in relation to portable audio systems and not in relation to footwear. Since the goods to which the first respondent's mark is applied are not similar to the goods to which the appellant's mark is applied, the first respondent stated that the opposition is without merit. As regards the registration under Class 25, the first respondent stated that the appellant has not applied the trade mark in relation to goods in Class 25 and that the mark is liable to be removed from the Register of Trade Marks under Section 47 of the Trade Marks Act, 1999 (the Trade Marks Act). After hearing both parties and considering the evidence placed on record, the opposition was rejected by the impugned order. The present appeal arises under the said facts and circumstances.



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Contentions

3. Learned counsel for the appellant submitted that the appellant is a world-renowned manufacturer of consumer electronics products. In the year 1979, learned counsel submitted that the appellant coined and adopted the trade mark WALKMAN in relation to portable audio systems. The said trade mark acquired high reputation and goodwill on account of open and continuous use globally. The appellant exported portable audio systems under the trade mark WALKMAN into India and also promoted the said products in India. On 10.10.1980, the appellant obtained the registration for the trade mark WALKMAN in India under Class 9 as Trade Mark No.367422. About five years later, on 16.02.1985, registration of the trade mark WALKMAN was also obtained in Class 25 under Trade Mark No.433960 in respect of clothing, including boots, shoes, and slippers.

4. In view of the registration obtained by the appellant in Class 25, especially in relation to boots, shoes and slippers, learned



counsel submitted that the application of the first respondent herein for registration of a deceptively similar mark in Class 25 in relation to footwear should have been rejected. In support of this contention, learned counsel referred to and relied upon subsections 1 and 3 of Section 11 of the Trade Marks Act. Learned counsel contended that the registered proprietor of an earlier trade mark has the statutory right to the exclusive use of such trade mark under Section 28(1) of the Trade Marks Act and, therefore, the application should have been rejected on the basis of opposition by the appellant. Indeed, learned counsel submits that the application should have been rejected even *de hors* such opposition because a statutory duty is imposed on the Registrar of Trade Marks to refuse an application for registration if an identical or deceptively similar prior mark is already on the register.

5. With reference to the findings in the impugned order that the appellant had not used the trade mark in relation to footwear, learned counsel submitted that use of the earlier mark is not relevant for purposes of Section 11 of the Trade Marks Act. In support of these submissions, learned counsel referred to and



relied upon the following judgments for the propositions indicated

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(i) *Gujarat Bottling Co. Ltd. (GBC) & Others v. Coca Cola Co. & Others (Gujarat Bottling)*, (1995) 5 SCC 545, wherein, in the context of a licence agreement containing a negative covenant and a subsequent registered user agreement, the Hon'ble Supreme Court held that the negative covenant is enforceable by way of an interim injunction and observed in course of the judgment that statutory rights are conferred on the registered proprietor of the mark, which enable such registered proprietor to sue for infringement irrespective of whether the mark is used.

(ii) *PEPS Industries Private Limited v. Kurlon Limited (PEPS Industries)*, 2022 SCC OnLine Del 3275, wherein, at paragraph 37, the Delhi High Court held that the registration of a trade mark provides *prima facie* evidence of its validity unless such validity is questioned in appropriate proceedings.

(iii) *Ciba-Geigy Ltd. v. Torrent Laboratories Pvt. Ltd. & Another (Ciba-Geigy)*, 1992 SCC Online Guj 187, wherein, at



paragraphs 4 and 5, the Gujarat High Court held that even whether there is no use of the mark for five years, the protection and the rights of the proprietor thereof are not automatically taken away and the procedure of rectification under the applicable provisions of the Trade Marks Act should be adopted.

(iv) *RSPL Health Pvt. Ltd. v. Reckitt and Colman (Overseas) Hygiene Home Ltd(RSPL Health)*, 2023 SCC OnLine Del 5154 , wherein, at paragraph 19, the Delhi High Court held that the actual use of the relevant mark is not relevant for purposes of adjudicating whether there are relative grounds for refusal under Section 11(1) of the Trade Marks Act.

(v) *Glenmark Pharmaceuticals Ltd. v. Signova Pharma (P) Ltd. & Another*, 2016 SCC OnLine Bom 4295, wherein, at paragraph 14, the Bombay High Court concluded that honesty of adoption is wholly irrelevant once the Court arrives at a finding that there is deceptive similarity especially in the context of the subsequent user not conducting a search of the marks already existing on the register of trade marks.

(vi) *Banana Brand Works Private Ltd. v. Kavan Antani*, 2016



SCC OnLine Mad 11319, wherein, at paragraphs 10.1 and 13.2, this

Court held that the conduct of the party is important and that if a party did not conduct a search before adopting a mark, it is a relevant factor with regard to drawing inferences on the intention to deceive.

6. Apart from asserting that the appellant is entitled to object to the registration of a deceptively similar later mark under sub-sections 1 and 3 of Section 11 of the Trade Marks Act, learned counsel further submitted that the appellant is also entitled to protection under sub-section 2 of Section 11. In order to substantiate this contention, learned counsel referred to the affidavit filed by the appellant in support of its opposition and pointed out that the appellant had set out details of the consolidated worldwide sales figures of goods branded WALKMAN for the period 1991 to 2007 and that the appellant had also set out the Indian sales promotional figures of WALKMAN for the period from 1991 to 2007. Although there were import restrictions on goods manufactured abroad at the relevant point of time, learned counsel submitted that portable audio systems



bearing the trade mark WALKMAN were imported into India, especially Kerala, from Japan and the other parts of the world. As a result, learned counsel submitted that the trade mark had acquired trans-boundary reputation and also qualifies as a well-known trade mark under the Trade Marks Act.

7. On the basis of the above submissions, learned counsel submitted that the impugned order is liable to be set aside and that the findings recorded therein are contrary to the provisions of the Trade Marks Act.

8. At the hearing on 16.08.2023, it was recorded that the appellant had placed on record an affidavit of service, and that the documents annexed thereto indicate that notice was served on the first respondent on two addresses on 31.07.2023 and 01.08.2023. It was also recorded that the first respondent was served by e-mail. In spite of service of notice and the name of the first respondent being printed in the cause list, the first respondent remained unrepresented. The matter was proceeded with in the absence of the first respondent in these facts and circumstances.



Discussion, analysis and conclusions

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9. The first question that arises for consideration on the basis of the contentions advanced by learned counsel for the appellant is whether use of the relevant mark by the opponent is a material consideration while deciding the opposition. In order to answer this question, it is necessary to extract sub-sections 1 and 3 of Section 11 of the Trade Marks Act on which reliance was placed by learned counsel for the appellant. Sub-sections 1 and 3 of Section 11 are as under:

“(1) Save as provided in section 12, a trade mark shall not be registered if, because of--

(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.(emphasis added).

....

(3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented--



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(a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or
(b) by virtue of law of copyright."

10. As is evident from Sub-section 1 of Section 11, if there exists a likelihood of confusion on the part of the public, including by way of association with the earlier trade mark, the registration of the later mark should be refused in the following situations:

(i) Where the later mark is identical to the earlier trade mark and the goods or services covered by the two trade marks are similar.

(ii) Where the later mark is similar to an earlier trade mark and the goods or services covered by the two trade marks are identical or similar.

Sub-section 3 of Section 11 is attracted if the registration of the trade mark is liable to be prevented by virtue of any law, particularly the law of passing off in relation to an unregistered trade mark, or by virtue of the law of copyright.



11. The Registrar of Trade Marks examines an application for registration at two stages. The first stage is when the application is examined to decide if it should be accepted for advertisement. At this stage, the Registrar conducts a search of the marks existing on the Register of Trade Marks and raises objections either on the absolute grounds prescribed in Section 9 of the Trade Marks Act, or, if there are conflicting marks, on the basis of the relative grounds prescribed in Section 11 thereof. At this pre-advertisement stage, evidence of use by the applicant would be relevant only if the applicant asserts use from a date pre-dating the date of application. It is needless to say that if an application is filed on a 'proposed to be used' basis, evidence of use would not be relevant. The next stage at which the application for registration is considered is subsequent to advertisement. Therefore, at this stage, it is open to a prior use of the identical or similar mark to oppose the registration of the later mark.

12. In this case, the appellant opposed the registration subsequent to advertisement. In response to the appellant's notice of opposition, the first respondent filed its counter statement. In



paragraph 7(b), in relevant part, the first respondent stated as under:

“ In this regard, we submit that the said trade mark ought to be removed from the records of the registry for non use and that the opponents have no rights to claim exclusive rights over the word “Walkman” in respect of the said goods.”

Likewise, in paragraph 7(f), the first respondent stated, in relevant part, as under:

“ With regard to the contention that the opponents are the registered proprietors of the trade mark in respect of goods in class 25 since the year 1985, we reiterate that the said trade mark ought to be removed from the records of the Registry on account of non use as the opponents have not been manufacturing or marketing any of the goods in India in class 25 in respect of which they have secured registration and we have the option of filing for rectification of the mark. We submit that the opponents have no rights in law to prevent us from registering our distinctive trade mark in respect of our products which are absolutely of no concern to the business of the opponents.”

13. From the above pleadings, it is clear that the first



respondent alleged non-use of the appellant's mark in respect of goods in Class 25 and further stated that the mark is liable to be removed from the register for non-use under the applicable provisions of the Trade Marks Act. In the face of the allegation of non-use by the first respondent, the appellant should have provided evidence of use of the mark in Class 25. Such evidence of use is not found in the records of the case. Instead, learned counsel for the appellant contended that evidence of use is irrelevant for purposes of deciding objections on the basis of an earlier registered trade mark. As discussed earlier, evidence of use is not always relevant for purposes of Section 11 because in certain circumstances, such as scrutiny at the pre-advertisement stage of an application on a 'proposed to be used' basis, evidence of use would be unavailable. By contrast, in this situation, the first respondent alleged non-use by the appellant and, therefore, the appellant had the opportunity to refute by adducing evidence of use.

14. In view of the statutory mandate in sub-section 1 of Section 11 of the Trade Marks Act to examine whether there exists



a likelihood of confusion on the part of the public by use of the later mark, evidence of use becomes material. Put differently, on the facts of this case, if there was evidence that the earlier mark was being applied in relation to goods in Class 25, especially footwear, it would become difficult to discount the likelihood of confusion on the part of the public. On the other hand, more generally, if the earlier mark was not being used in relation to similar goods or services, except if the earlier mark is well-known through use in relation to dissimilar goods or services and, consequently, goods/services agnostic associational risks become likely, the likelihood of confusion on the part of the public becomes remote, if not non-existent. For reasons set out above, I do not concur fully with the broad proposition laid down in *RSPL Health*.

15. Learned counsel for the appellant also asserted that non-use is relevant only for purposes of a rectification petition under Section 47 of the Trade Marks Act by pressing into service the judgments in *PEPS Industries* and *Ciba-Geigy* in support of this



contention. Without doubt, a registered trade mark may only be removed from the Register of Trade Marks pursuant to a rectification action either under Sections 47 or 57 of the Trade Marks Act. The sequitur thereof is that the appellant's trade mark cannot be removed from the Register of Trade Marks except in accordance with the provisions of the above mentioned sections of the Trade Marks Act. However, the above does not support the inference that non-use of the earlier mark in relation to the relevant goods is irrelevant or immaterial for purposes of deciding whether there are relative grounds for refusal under Section 11 of the Trade Marks Act. On this issue, it should also be noticed that a trade mark is liable to be removed from the register if there is no *bona fide* intention to use or non-use for not less than the period prescribed in Section 47 of the Trade Marks Act. Besides, the Registrar and the High Court have the *suo motu* power under Section 57(4) of the Trade Marks Act to rectify for any contravention or failure to observe a condition, and this would extend to non-use after registration.



16. The appellant also contended that registration confers on a registered proprietor the rights prescribed in Sections 28 & 29 of the Trade Marks Act, and that the exercise of such proprietary rights is not conditional upon use. In support of this contention, the judgment of the Supreme Court in *Gujarat Bottling* was relied on. *Gujarat Bottling* was a judgment pronounced in the factual context of a licence agreement permitting GBC to function as a franchisee of the Coca Cola Company in India and as the licensed user of its trade marks and a registered user agreement under which GBC was the registered user of the trade marks. Thus, it was certainly not a case of non-use of the relevant trade marks and the reliance on an observation therein is misplaced. Section 28 of the Trade Marks Act provides that the registration of a valid trade mark would give to the registered proprietor of the trade mark the exclusive right to use the trade mark in relation to the goods or services in respect of which the trade mark is registered. The text of this provision underscores the exalted position accorded to the use of a trade mark under the Trade Marks Act. At the foundational level, a trade mark is intangible property which



qualifies as a chose in action. As a chose in action, the rights granted to a registered proprietor are required to be enforced by action such as use, either directly or through a registered or permitted user, or in the form of an infringement action if there is unauthorised use. Since registration confers a statutory right to exclusive use, when a registered proprietor sues for infringement, it would be necessary for such proprietor to establish use, if not by the proprietor, at least by a registered or licensed user of such mark. This becomes clear on examining sub-section 2 of Section 29 which, similarly to Section 11(1), also contains the requirement that the use by a person who is not the registered proprietor or registered or permitted user would qualify as infringing use if it is likely to cause confusion on the part of the public, including by way of association with the registered trade mark.

17. For reasons set out above, I am unable to accept the contention that non-use of the earlier registered trade mark is irrelevant or immaterial for purposes of making a determination under Section 11(1) of the Trade Marks Act. The question relating to whether the appellant's trade mark is a well-known trade mark



remains to be addressed.

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18. The expression “well-known trade mark” is defined in Section 2(1)(zg) of the Trade Marks Act as under:

“(zg) “well-known trade mark”, in relation to any goods or services means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between the goods or services and a person using the mark in relation to the first-mentioned goods or services.”(emphasis added)

Sub-section 2 of Section 11, which is set out below, becomes applicable in the context of a well-known trade mark.

(2) A trade mark which –

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor,

shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.



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19. As is evident from subsection 2 of Section 11, a well-known trade mark is entitled to protection even if the goods or services to which such trade mark is applied are not similar to the goods or services to which the later mark is applied. Given the width of protection, a person asserting well-known status is required to satisfy the requirements of Section 2(1)(zg) read with the non-cumulative and illustrative criteria set out in sub-sections 6 to 10 of Section 10 of the Trade Marks Act. Sub-sections 6 to 10 are as under:

“(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including –

(i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;

(ii) the duration, extent and geographical area of any use of that trade mark;

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that



trade mark under this Act to the extent they reflect the use or recognition of the trade mark;

(v) the record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any Court or Registrar under that record.

(7) The Registrar shall, while determining as to whether a trade mark is known or recognised in a relevant section of the public for the purposes of sub-section (6), take into account –

(i) the number of actual or potential consumers of the goods or services;

(ii) the number of persons involved in the channels of distribution of the goods or services;

(iii) the business circles dealing with the goods or services,

to which that trade mark applies.

(8) Where a trade mark has been determined to be well-known in at least one relevant section of the public in India by any Court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.

(9) The Registrar shall not require as a condition, for determining whether a trade mark is a well-known trade mark, any of the following, namely: –

(i) that the trade mark has been used in India;

(ii) that the trade mark has been registered;

(iii) that the application for registration of the trade mark has been filed in India;

(iv) that the trade mark –

(a) is well known in; or

(b) has been registered in; or

(c) in respect of which an application for registration has been filed in, any jurisdiction other than India; or



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(v) that the trade mark is well-known to the public at large in India.

(10) While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall –

(i) protect a well-known trade mark against the identical or similar trade marks;

(ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark."

20. The well-known status of an opponent's trade mark should be determined as of the date of the application for registration which, in this case, is 22.09.1995. In the affidavit filed in support of the opposition, the appellant has set out the sales turnover from the global sales of products bearing the trade mark WALKMAN for the years 1991 to 2007. As regards India, sales promotional figures are set out for the same period but only brochures were placed on record in corroboration. Apart from the above data, a list of countries in which the appellant's trade mark was registered, the registrations obtained in India and some overseas jurisdictions for its trade mark and promotional material were placed on record. However, apart from providing the above, the appellant has not placed on record documents to prove the number of and geographical spread of consumers of its products



in India or the extent and geographical spread of the advertising and promotional campaigns in India. Although some persons in India of a certain vintage will certainly recall the brand WALKMAN in relation to portable audio systems, in the absence of sufficient evidence to satisfy the requirements of Section 2(1)(zg) read with sub-sections 6 to 10 of Section 11 of the Trade Marks Act, I am unable to conclude that the appellant's trade mark is a well-known mark. This conclusion is, however, subject to the qualification that no declaration is being made that the trade mark was not well-known either as on 22.09.1995 or otherwise and, therefore, it would be open to the appellant to place adequate evidence of the satisfaction of the criteria in Section 11, if required in any other case.

21. Turning to the impugned order, the Registrar of Trade Marks concluded as under in the unnumbered 2nd paragraph at internal page 8 of the order:

“The rival goods are dissimilar goods. The applicant is famous for 'hawai chappal' and the mark 'Walkman' logo itself was applied for “boots, shoes,



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Chappals" for sale in the State of Kerala only. The opponent has obtained registration under No.433960 in Class-25 in respect of "clothing including boots, shoes and slippers', they have not filed any evidence to show the actual use of the mark WALKMAN in relation to goods. The adoption of the mark WALKMAN and use of the mark of the applicant is established as they are a firm of rubber manufactures. They are marketing high quality rubber and rubber products and trading as Walkman Rubber Industries. They have applied for Walkman Super & logo. The claim of use is proved in their evidence and they have filed sales invoices, advertisement materials and other related documents in support thereof."

At internal page 9 of the order, the Registrar held as follows:

"The non-use of mark is fatal; it would amount to non-recognition. The word WALKMAN refers mainly to the portable audio cassette player. I am of the view that using of applicant mark in the State of Kerala will not create confusion and/or deception amongst the purchasers that there is no connection between applicant and opponent business. Further, the opponent objections raised in the instant proceeding by the opponent is not appropriate. On perusal of available records placed before



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me, I am of the view that the adoption of applicant's mark is bonafide and they have established the user of their mark and they are eligible to get registration under the Act."

22. In effect, the Registrar held that the first respondent used the device mark in relation to goods such as boots, shoes, slippers for sale in the State of Kerala; that the appellant used the mark mainly in relation to portable audio cassette players; and that there is no evidence of use of the appellant's trade mark in respect of goods in Class 25. The Registrar further held that the use of the 1st respondent's mark in the State of Kerala will not create confusion and/or deception among the purchasers as there is no connection between the businesses of the first respondent and the appellant. On that basis, the opposition was rejected.

23. For reasons set out above, I find no reason to interfere with the impugned order of the Registrar. (T)CMA(TM) No.25 of 2023 is, therefore, dismissed without any order as to costs. Consequently, (T)CMP(TM) No. 12 of 2023 is also dismissed.



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