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(T)OP(TM)/293/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 22.11.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)/293/2023
(ORA/6/2019/TM/CHN)

M/s.V-Guard Industries Ltd,
a Public Limited Company
incorporated under the Indian
Companies Act, 2013, No.42/962,
Old No.33/2905 F,
Vennala High School Road,
Vennala PO, Kochi-682 028,
Kerala State,
Represented by their Vice President-Marketing,
Mr.Deepak Augustine.

... Petitioner

-VS-

1.Akash Gupta

2.Registrar of Trade Marks,
Chennai, Intellectual Property Office Building,
GST Road, Guindy, Chennai-32.

... Respondents

PRAYER: Transfer Original Petition (Trade Marks) filed under
Section 57 of the Trade Marks Act, 1999, praying to the Hon'ble Court
to rectify the impugned entry relating to the trade mark



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THE-GUARD under Trade Mark No.3666781 in Class 11.

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For Petitioner : Mr.Bovan Cherian Varkey
for M/s.Marks and Rights

For R1 : No appearance

For R2 : Mr.T.V.Krishnamachari, SPC

ORDER

The petitioner seeks to rectify the entry relating to the trade mark THE-GUARD under Trade Mark No.3666781 in Class 11 by removing the same from the Register of Trade Marks.

2. The petitioner asserts that it coined and adopted the mark V-GUARD in the year 1977 through its predecessor-in-interest. Later, the predecessor-in-interest/proprietorship under the name and style of M/s.V-Guard Industries was converted into a limited company, namely, the petitioner herein. The petitioner has set out details of the registrations obtained by it for the trade mark V-GUARD and its formative marks in various classes at para-9(iv) of the petition. At para-9(v), the petitioner has set out the sales turnover from the sale



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of goods bearing the trade mark V-GUARD between the financial years 1996 - 1997 to 2017- 2018. The advertising expenditure incurred over the same period has also been set out. The present petition was filed after the petitioner became aware that the 1st respondent herein had obtained registration in respect of the mark THE-GUARD on a “proposed to be used” basis with regard to table fans and ceiling fans in Class 11 under Trade Mark No.3666781 with effect from 30.10.2017.

3. In support of the assertions in the petition, learned counsel for the petitioner invited my attention to the registration certificates of the petitioner under Class 11 in respect of appliances for lighting, heating, cooking; water heaters, geysers; and all types of fans, including ceiling, table, exhaust, cooling and extractor fans. He also referred to invoices issued in respect of the sale of products bearing the trade mark V-GUARD. With specific reference to pages 70 and 79 of the typed set, he pointed out that these invoices relate to the sale of electric fans. Learned counsel also referred to the advertisements of



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goods bearing the petitioner's trade mark and contended that the petitioner's trade mark had acquired high reputation. In this regard, learned counsel also pointed out the petitioner's trade mark was determined to be a well-known trade mark by the II Additional District Judge, Ernakulam, in O.S.No.12 of 2013 on 22.11.2016.

4. Learned counsel submitted that the impugned trade mark is deceptively similar and that confusion would be caused in the minds of the public, if the said trade mark continues to remain on the register. Therefore, he submitted that the impugned mark is liable to be removed from the Register of Trade Marks.

5. On 18.08.2013, learned counsel for the petitioner placed on record the affidavit of service relating to service on the 1st respondent. The documents annexed to such affidavit indicated that notice was served on the 1st respondent on 28.07.2023. In spite of service of notice, there was no representation for the 1st respondent. Therefore, the Registry was directed to print the name of the 1st



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respondent in the cause list. In spite of the same, the 1st respondent continued to remain unrepresented, and the matter is proceeded with in the absence of the 1st respondent in the said facts and circumstances.

6. The petitioner asserts use of the trade mark V-GUARD from 1977. As evidence of use, the petitioner has placed on record a large number of invoices. These invoices relate to the sale of several electrical appliances. Significantly, invoices relating to the sale of electric fans have also been placed on record. The petitioner has also provided details of the turnover from the sale of goods bearing the mark V-GUARD from the financial years 1996-1997 to 2017-2018 and the expenditure incurred towards advertising the brand during the said period. The details provided indicate that the turnover is significant and the advertising expenditure is large. The petitioner has also set out the details of registrations obtained by it in multiple classes including Class 11. The relevant registration certificates are on record. The judgment of the II Additional District Judge,



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Ernakulam, in O.S.No.12 of 2013 contains a determination that the petitioner's trade mark is a well-known mark. As a consequence, the petitioner would be entitled to protect its mark even when used in relation to dissimilar goods. In any event, on the facts of this case, it appears that the 1st respondent has used the mark THE-GUARD in respect of identical goods.

7. When the petitioner's mark is compared with the impugned mark, the conclusion is that the public would be confused with regard to origin and association of the mark. Therefore, this petition is liable to be allowed as prayed for.

8. For reasons set out above, (T)OP(TM)/293/2023 is allowed by directing the Registrar of Trade Marks to cancel the certificate of registration pertaining to Trade Mark No.3666781 in Class 11 and to remove the entry relating thereto from the Register of Trade Marks. These actions shall be completed within a period of *four weeks* from the date of receipt of a copy of this order. There shall be no order as



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to costs.

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SENTHILKUMAR RAMAMOORTHY,J.

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