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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 26.09.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)/308/2023
(ORA/23/2019/TM/CH)

Societe Des Products Nestle S.A
1800, Vevey,
Canton of Vaud,
Switzerland.

... Petitioner

-VS-

1.Shahul Hameed K.T
Proprietor, M/s.Amal Trade Associates,
Thanikkal Kodur P.O.,
Malappuram District, Kerala - 676 504.

2.The Registrar of Trade Marks,
Boudhik Sampada Bhawan,
G.S.T.Road, Guindy,
Chennai - 600 032.

... Respondents

PRAYER: Transfer Original Petition (Trade Marks) filed under Sections 57(2) of the Trade Marks Act, 1999, praying to pass an order directing the Respondent No.2 to cancel trade mark registration No.2418257 in class 30 in the name of the Respondent No.1.



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For Petitioner : Mr.Manish Kumar Mishra
for M/s.INTTL Advocare

For Respondent 1 : No Appearance,
Notice served on 21.08.2023

For Respondent 2 : Mr.M.Karthikeyan, SPC

ORDER

The petitioner seeks cancellation of the certificate of registration relating to Trade Mark No.2418257 in class 30 and for the removal of the entry relating thereto from the Register of Trade Marks.

2. On 25.08.2023, it was recorded that private notice was served on the agent of the first respondent on 14.08.2023. On 08.09.2023, it was recorded that notice was served on the first respondent on 21.08.2023, as per bailiff's report dated 21.08.2023. In order to provide a further opportunity to the first respondent, the matter was



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listed today. The first respondent continues to remain unrepresented in spite of service of notice. The name of the first respondent is also printed in the cause list. In these circumstances, the matter is proceeded with in the absence of the first respondent.

3. The petitioner is the registered proprietor of the word and device mark



By asserting that the petitioner is a person aggrieved by the dishonest adoption of the following device mark,



the present petition was filed.

4. Oral arguments on behalf of the petitioner were made by Mr.Manish Kumar Mishra, learned counsel. Learned counsel for the petitioner invited my attention to paragraph 9E of the petition and



traced the history of the trade mark NESTEA. In particular, he pointed out that the registrations were obtained in respect of such mark in multiple jurisdictions overseas based on applications filed as early as on 24.08.1945. As regards India, he pointed out that the first application was filed on 19.09.2003 in class 30 by claiming user from 01.01.1992. In support of these submissions, he placed for consideration the list of registrations obtained outside India (pages 88 to 210 of Volume 1 of the paper book). He also placed for consideration registrations obtained in India (pages 332 to 343 of Volume 2 of the paper book).

5. With regard to use of the mark, learned counsel adverted to the invoices at pages 212 to 223 of volume 2 and to the certificate issued by an independent Chartered Accountant as regards the turnover from the sale of products bearing the trade mark NESTEA between 2001 and 2005 and the expenditure incurred towards advertising / promotion for the above period.



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6. In this factual context, learned counsel submitted that the adoption of the mark NESTY by the first respondent for identical goods, namely, tea, was undoubtedly dishonest. By turning to the registration certificate of the first respondent, learned counsel pointed out that the trade mark was registered with effect from 27.10.2012 on the basis of an application asserting use from 30.07.2009. He further submitted that such registration was valid up to 27.10.2022. Since the adoption was dishonest and subsequent, he concluded his submissions by contending that the impugned mark is liable to be removed from the Register of Trade Marks.

7. On comparison, the trade mark of the petitioner and that of the first respondent are undoubtedly deceptively similar. Indeed, phonetically, it is difficult to distinguish the two marks. It should also be noticed that the first respondent has also adopted the device of three leaves, which is part of the petitioner's mark. Even as per the



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application filed by the first respondent for registration, the user claim is from 30.07.2009. By contrast, the user claim in India of the petitioner is from the year 1992. The certificate of the Chartered Accountant provides evidence of sale of products bearing the trade mark NESTEA from the year 2001. In these circumstances, it is beyond doubt that the petitioner is the prior user of the trade mark. By taking into account the following: the trade mark of the first respondent was adopted subsequently without explanation for such adoption; the marks are deceptively similar; and the goods concerned are not merely similar but identical, I conclude that the impugned mark was entered on the register without sufficient cause. Consequently, the trade mark of the first respondent is liable to be removed from the register.

8. For reasons set out above, (T)OP(TM)/308/2023 is allowed by directing the Registrar of Trade Marks to cancel the certificate of registration pertaining to Trade Mark No.2418257 in class 30 and to



remove the entry relating thereto from the Register of Trade Marks.

These actions shall be completed within a maximum period of *four weeks* from the date of receipt of a copy of this order. There shall be no order as to costs.

26.09.2023

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Index : Yes / No

Internet : Yes / No

Neutral Citation : Yes / No



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