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(T)OP(TM)/316/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 11.12.2023

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)/316/2023
(ORA/34/2019/TM/CHN)

Suzlon Energy Limited
One Earth, Opp.Magarpatta City,
Hadapsar, Pune, Maharashtra 411028.

... Petitioner

-VS-

1.Suzlon Cotton Mills Private Limited,
D.No.275, S.F.No.341, P.C.K.Nagar,
Chettipalayam Road,
Palladam-641 664,
Coimbatore District, Tamil Nadu.

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

... 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 Register of Trade Marks by removing the registration of the Trade Mark No.1502401 in Class 25 for the mark "SUZLON" registered in the name of Suzlon Cotton Mills Private Limited.



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For Petitioner : Mr.Rajesh Ramanathan
for M/s.AZB and Partners

For R1 : No appearance

For R2 : Mr.S.Janarthanam, SPC

ORDER

By order dated 09.08.2023 in (TM)A No.2/2023, the petitioner was permitted to effect service of notice on the 1st respondent by substituted service. On 07.09.2023, the petitioner placed on record the affidavit of service dated 31.08.2023 enclosing proof of effecting service on the 1st respondent by publication in the English daily, The Hindu, Coimbatore Edition, on 30.08.2023. The same was accepted as sufficient service on the 1st respondent. Even thereafter, the 1st respondent continued to remain unrepresented. Therefore, the matter is proceeded with in the absence of the 1st respondent.

2. The petition was filed to rectify the Register of Trade Marks by removing the following mark from the said register:



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3. The petitioner is a listed company, which is engaged in the business of generating power from renewable sources. The petitioner asserts that it conceived and coined the mark “SUZLON” by drawing on the letters “suz” from the word “suz-bhuz” meaning intelligence and combining it with the letters “LON” representing “LOAN”. The petitioner asserts that it adopted this invented mark in the year 1987 and that it was originally applied by the petitioner's predecessor-in-interest in relation to textile and yarn making business. Later, in the year 1995, the said mark was applied in relation to the renewable energy business.

4. Learned counsel for the petitioner invited my attention to paragraph 8 of the petition, where details of the registered trade marks of the petitioner are set out. He points out that the first of such registrations was with effect from 10.07.2003. With reference to paragraph 10 of the



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petition, learned counsel points out that the petitioner has 36% market share in the wind energy sector in India. He also points out that the petitioner had received several contracts from reputed companies for the supply of turbines. With reference to paragraph 16 of the petition, learned counsel points out that the turnover of the company was about Rs.857.50 Crores in the financial year 2003-2004; that this increased to a sum of Rs.7,985.73 Crores in the financial year 2006-2007; and further increased to about Rs.19836 Crores in the financial year 2014-2015. By referring to an article on the company, learned counsel points out that the petitioner is a leading wind power company; that it employs over 13,000 people in 33 countries; and has been the market leader for the last 11 years consecutively by installing over 4800 MW of wind turbine capacity.

5. Learned counsel also pointed out that the application for registration by the 1st respondent was filed on 08.11.2006 and that the petitioner's trade mark qualified as a well-known mark even as on the said date as per Section 2(1)(zg) of the Trade Marks Act, 1999 (the Trade Marks Act), read with relevant sub-sections of Section 11 thereof. He also



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submitted that the petitioner had issued a notice to the 1st respondent before filing the present petition and had also filed an opposition before the Registrar of Trade Marks.

6. At the outset, it should be recognised that the petitioner's mark “SUZLON” is an invented mark. Reference may be made in this regard to the explanation provided by the petitioner with regard to the manner in which the mark was coined by drawing on the words “suz-bhuz” and “loan”. As an invented mark, it should be further recognised that the mark has no relation whatsoever to the goods or services in relation to which the mark is applied in the renewable energy sector.

7. The impugned mark is applied by the 1st respondent in relation to textiles, garments and other goods in Classes 24 and 25. These goods cannot be considered as similar to the goods or services in respect of which the petitioner applies the mark. Therefore, the question that arises for consideration is whether the petitioner's trade mark meets the threshold of a well-known trade mark. Section 2(1)(zg) of the Trade Marks Act defines a well-known trade mark as under:



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“(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 those goods or services and a person using the mark in relation to the first-mentioned goods or services. ”

8. Sub-section (2) of Section 11 enables the proprietor of a well-known trade mark to object to the registration of a subsequent mark even if such subsequent mark is applied to dissimilar goods or services. The criteria for determination of whether the trade mark is well-known are specified in sub-sections (6) to (10) of the Trade Marks Act. Sub-sections (2) & (6) to (10) are set out below:

“(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



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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.

(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 that 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



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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.

(11) Where a trade mark has been registered in good faith disclosing the material informations to the Registrar or where right to a trade mark has been acquired through use in good faith before the commencement of this Act, then, nothing in this Act shall prejudice the validity of the registration of that trade mark or right to use that trade mark on the ground that such trade mark is identical with or similar to a well-known trade mark."

9. On examining the above provisions, it is clear that the determination as to whether a mark is well-known should be made with reference to its popularity among the relevant section of the public. Indeed, sub-section 9(v) underscores that the Registrar is not required to impose the



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pre-condition that the trade mark is well-known to the public at large in India. When Section 2(1)(zg) is read with sub-sections (6) & (7) of Section 11, it is evident that the determination as to whether the trade mark is well-known should be made with reference to factors such as the number and geographical spread of users, the extent of advertising, registrations obtained and the like. The enumerated criteria are both non-exhaustive and non-cumulative.

10. Applying the said criteria to the facts and circumstances of this case, the petitioner has placed on record the sales turnover. In the financial year 2006-2007, which was the relevant financial year with reference to the date of filing of the application of the registration of the impugned trade mark, the turnover of the petitioner was Rs.7,985.73 Crores. The petitioner has also placed on record documents indicating that it had a global market share of 9.8% between 2005-2008 and was the market leader in India for 11 consecutive years. The petitioner has further indicated that it had installed over 4800 MW of wind turbine capacity during the relevant period. It should also not be lost sight of that the corporate name of the petitioner



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contains the mark “SUZLON” and being a listed company, the shares are traded on the bourses.

11. When the above facts and circumstances are taken into consideration, I conclude that the petitioner's mark is well-known. Therefore, the petitioner is entitled to protection on a goods/services agnostic basis. The documents on record clearly indicate that the petitioner is the prior use of the mark. The 1st respondent has adopted a mark which is nearly identical to that of the petitioner. The 1st respondent has also failed to enter appearance and explain the reasons for adoption of a mark, which was coined by invention by the petitioner. If the 1st respondent's mark is allowed to remain on the register in such circumstances, it will be detrimental to the distinctive character of the petitioner's trade mark.

12. Therefore, (T)OP(TM)/316/2023 is allowed by directing the Registrar of Trade Marks to rectify the register by removing Trade Mark No.1502401 in Class 25 from the Register of Trade Marks and to cancel the certificate of registration relating thereto. These actions shall be completed



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

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Index : Yes / No

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SENTHILKUMAR RAMAMOORTHY,J.

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