



(T)OP(TM)/305/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 18.12.2023

WEB COPY

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)/305/2023
(ORA/20/2019/TM/CHN)

M/s. V.Vidhya Industries,
A registered Partnership Firm,
No.6/1, Nehru Street, Avinashi Road,
Peelamedu, Coimbatore-641 004.

... Petitioner

-VS-

1. K.K.RAJAN,
Trading as Sharp Industries,
No.801/1A, Sitra Road,
Sharp Nagar,
Kalappatti, Coimbatore - 641 048.

2. The Registrar of Trade Marks,
Office of the Trade Marks Registry,
IPR Building, SIDCO Industrial Estate,
G.S.T.Road, Guindy, Chennai-600 032.

... Respondents

PRAYER: Transfer Original Petition (Trade Marks) filed under Sections 9(1)(a), 9(2)(a), 11(1), 11(2), 18(1), 57(1) & 57(2) of the Trade



(T)OP(TM)/305/2023

Marks Act, 1999, praying to the Hon'ble Court to remove/expunge/rectify/cancel the entry relating to the trade mark SHARP FORCE under Trade Mark Registration No.3601398 in Class 7.

For Petitioner : Ms.S.Suba Shiny

For R1 : Mr.R.Sathish Kumar
for M/s.Altacit Global

For R2 : Mr.K.Subbu Ranga Bharathi, CGSC

ORDER

The petitioner seeks rectification of the Register of Trade Marks by removing or expunging the entry relating to the trade mark "SHARP FORCE", which was registered under Trade Mark No.3601398 in Class 7.

2. The petitioner asserts that it is a manufacturer and trader of motors and pumps of different kinds. In relation to the aforesaid goods, the petitioner claims that it adopted the trade mark "SHARP FORCE" and commenced using the said trade mark from the year 2011. The petitioner also states that its sales turnover by use of the



(T)OP(TM)/305/2023

said trade mark was substantial and that it also incurred significant advertising expenditure. Upon receipt of a notice from the 1st respondent on 04.01.2019, the petitioner realised that the 1st respondent was a subsequent user of the identical trade mark "SHARP FORCE". The present petition for rectification was filed in the said facts and circumstances.

3. Oral submissions on behalf of the petitioner were advanced by Ms.S.Suba Shiny, learned counsel, and on behalf of the 1st respondent by Mr.R.Sathish Kumar, learned counsel. The Registrar of Trade Marks was represented by Mr.K.Subbu Ranga Bharathi, learned CGSC.

4. Learned counsel for the petitioner submitted that the petitioner's trade mark was adopted and put to use in the year 2011. In support of this submission, she invited my attention to the invoices at pages 28 to 201 of the paper book. With specific reference



(T)OP(TM)/305/2023

to Invoice No.5216 dated 07.01.2011, learned counsel submits that it constitutes evidence of use from January 2011. By also pointing out that there are invoices issued in each of the subsequent years leading up to the date of filing of the rectification petition, learned counsel submitted that these invoices clearly establish that the petitioner adopted and used the trade mark "SHARP FORCE" prior to the 1st respondent.

5. As regards the 1st respondent, learned counsel submitted that the 1st respondent adopted and used the trade mark "SHARP". By referring to the invoice dated 04.05.2018 at page 7 of the typed set of the 1st respondent, learned counsel pointed out that the invoice does not establish use of the trade mark "SHARP FORCE". In particular, learned counsel pointed out that the trade mark "SHARP" is used therein and, thereafter, the capacity and type of pump are mentioned by describing the same as 0.50 HP Force Self Priming Pump 1P. Learned counsel submits that all the other invoices submitted by the



(T)OP(TM)/305/2023

1st respondent are similar. Therefore, learned counsel submits that the 1st respondent's use is not only subsequent, but also that the 1st respondent did not use the trade mark as registered.

6. According to learned counsel, the type of use indicated by invoices relied on by the 1st respondent contravenes Section 57 of the Trade Marks Act, 1999 (the Trade Marks Act), and consequently constitutes sufficient cause to rectify the register by removing the entry relating to the impugned trade mark. In support of these submissions, learned counsel referred to and relied upon the judgment of the Supreme Court in *Neon Laboratories Limited v. Medical Technologies Limited and others*, (2016) 2 SCC 672, particularly paragraph 10 thereof.

7. Learned counsel for the 1st respondent made submissions in response and to the contrary. The first contention of learned counsel was that the petitioner did not initiate any action in respect of the



(T)OP(TM)/305/2023

trade mark impugned herein until the petitioner received the lawyer's notice dated 04.01.2019 threatening proceedings for infringement and passing off. Learned counsel pointed out that the petitioner filed the following as a reaction to and subsequent to the said lawyer's notice: an application for registration of its trade mark; a civil suit; and the present rectification petition.

8. Turning to the evidence relied upon by the petitioner, learned counsel submitted that each invoice, starting from the invoice at page 28 of the paper book, contains the word "SHARP FORCE" above the description of the products. By pointing out that the petitioner opted not to adduce oral evidence, learned counsel submitted that the originals of these invoices are not on record, the genuineness of these documents is open to question and that the petitioner failed to prove these documents.



(T)OP(TM)/305/2023

9. The next submission of learned counsel was that the 1st respondent is a partnership firm, which was registered by the jurisdictional Registrar of Firms on 04.04.1983 under the name “Sharp Industries”. By also referring to the registration certificate issued by the National Small Industries Corporation Limited, he pointed out that the trading style of the petitioner was M/s.Sharp Industries from inception. He also referred to and relied on advertisements published for SHARP pumps by the 1st respondent, including the advertisement placed in the English daily, The Hindu, issue dated 28.07.1996. As regards the invoices of the 1st respondent, learned counsel submitted that invoices issued from 28.09.2013 are on record and that these invoices evidence use of the trade mark “SHARP FORCE”, albeit the capacity of the pump in question is indicated between the words SHARP and FORCE.

10. According to learned counsel, the petitioner cannot succeed without establishing that it is an aggrieved person and that it has a



(T)OP(TM)/305/2023

superior right over the trade mark. By referring to the definitions of the words 'mark' and 'trade mark' under the Trade Marks Act, learned counsel relied upon the judgment of the Bombay High Court in *Kirloskar Diesel Recon Pvt. Ltd. and another v. Kirloskar Proprietary Limited and others*, 1995 SCC OnLine Bombay 312, particularly paragraph 9 thereof, for the principle that the use of a trade name also qualifies as use of a mark and trade mark under the Trade Marks Act. He also placed for consideration the judgment of this Court in *Sharp Kabushiki Kaisha v. Sharp industries and another*, (T)CMA(TM)/5/2023, judgment dated 21.11.2023, particularly paragraph 24 thereof, wherein it was noticed that the 1st respondent is carrying on business under the trading name “Sharp Industries” from 04.04.1983.

11. The next submission of learned counsel was that the petition was filed only under Section 57 of the Trade Marks Act and that non-use was not one of the grounds for rectification. Learned



(T)OP(TM)/305/2023

counsel also submitted, in this regard, that Section 57 cannot be construed in such a manner as to enable a party to circumvent the conditions which under Section 47 may be invoked.

12. Based on the rival contentions, the first question that falls for consideration is whether the petitioner qualifies as a person aggrieved for purposes of Section 57 of the Trade Marks Act. The documents on record indicate that the petitioner adopted and used the trade mark "SHARP FORCE" in relation to different kinds of pumps. The 1st respondent is also admittedly in the same line of business. It is also a matter of record that the 1st respondent issued a lawyer's notice dated 04.01.2019 to the petitioner alleging infringement and called upon the petitioner to immediately cease and desist from using the trade mark "SHARP FORCE". The Hon'ble Supreme Court interpreted the expression "person aggrieved" in the context of Sections 47 and 57 in *Hardie Trading Ltd. & another v. Addisons Paint & Chemicals Ltd.*, (2003) 11 SCC 92, and concluded that



(T)OP(TM)/305/2023

the expression should receive a wider construction in relation to a petition under Section 57. In the facts and circumstances outlined above, I have no hesitation or doubt in concluding that the petitioner qualifies as a person aggrieved.

13. The next question that arises for consideration is whether the register is liable to be rectified at the instance of the petitioner. Section 57(1)&(2) are relevant in this regard and are set out below:

“57. Power to cancel or vary registration and to rectify the register

(1) On application made in the prescribed manner to the High Court or to the Registrar by any person aggrieved, the Registrar or the High Court, as the case may be, may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any



entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the High Court or to the Registrar, and the Registrar or the High Court, as the case may be, may make such order for making, expunging or varying the entry as it may think fit."

As is evident from the above provisions, the issues to be considered are whether the 1st respondent violated a condition imposed while granting registration and, consequently, contravened sub-section (1) of Section 57; or whether the entry relating to Trade Mark No.3601398 was made without sufficient cause or wrongly remains on the register.

14. The main grounds on which the petitioner seeks rectification are that the 1st respondent adopted the mark later than the petitioner and that the 1st respondent is not using the mark as registered. The earliest invoice referred to by the petitioner is dated 07.01.2011. Although learned counsel for the 1st respondent disputed



(T)OP(TM)/305/2023

the authenticity of these invoices, I find that multiple invoices have been placed on record by the petitioner, including invoices relating to the sale of products bearing other trade marks, such as in the invoices at pages 40 and 41 of the documents filed by the petitioner. When considered cumulatively, I am inclined to accept these invoices as evidence that the petitioner commenced use of the product bearing the trade mark “SHARP FORCE” in the year 2011. By contrast, the earliest invoice of the 1st respondent is dated 28.09.2013. Whether earlier use by the petitioner justifies rectification falls for consideration next.

15. Thus, both parties carry on the business of making pumps. While the 1st respondent started using the trade mark “SHARP” in relation thereto earlier, the petitioner adopted and used the trade mark “SHARP FORCE” about two years prior to the 1st respondent. Since the petitioner and the 1st respondent carry on near-identical businesses and operate from Coimbatore, the only reasonable



(T)OP(TM)/305/2023

inference that follows is that the petitioner chose not to act until receipt of the lawyer's notice from the 1st respondent in spite of being aware of the business of the 1st respondent and the use of the impugned trade mark in relation thereto, at least in the manner indicated by the 1st respondent's invoices.

16. The other significant aspect to be taken into account is the admitted position that the 1st respondent was registered as a partnership firm under the trading name "Sharp Industries" on 04.04.1983 and continues to carry on business under that name. The advertisements relied on by the 1st respondent disclose that the trade mark SHARP was used in the print media in relation to pumps in the year 1996. Apart from proof of registration of the word mark "SHARP FORCE", the 1st respondent has also placed on record the registrations obtained by it for the word and device mark "SHARP GARUDA". When all the above facts and circumstances are taken into account, the adoption of the trade mark "SHARP FORCE" is honest and *bona fide*.



(T)OP(TM)/305/2023

WEB COPY 17. After such honest adoption, the documents on record indicate that the mark was used. Merely because the mark was used by specifying the capacity of the pumps between the words “SHARP” and “FORCE”, I am not inclined to construe such use as a contravention justifying rectification. As regards alleged non-use, I accede to the contention of learned counsel for the 1st respondent that Section 57 cannot be construed as permitting a challenge for non-use without complying with the conditions prescribed in such regard by Section 47.

18. Section 12 of the Trade Marks Act permits the Registrar to register an identical or similar later trade mark in relation to identical or similar goods or services either if there is honest concurrent use or other special circumstances. In my view, in spite of being the later user of the trade mark “SHARP FORCE”, the 1st respondent is entitled to the benefit of Section 12 of the Trade Marks Act.



(T)OP(TM)/305/2023

Consequently, the petitioner is not entitled to rectify the register by removing the trade mark “SHARP FORCE” from such register.

19. (T)OP(TM)/305/2023 is disposed of on the above terms without any order as to costs.

18.12.2023

Index : Yes / No

Internet : Yes / No

Neutral Citation : Yes / No

kj



WEB COPY



(T)OP(TM)/305/2023

SENTHILKUMAR RAMAMOORTHY,J.

Kj

(T)OP(TM)/305/2023
(ORA/20/2019/TM/CHN)

18.12.2023