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(T)OP(TM)/349/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 07.11.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)/349/2023
(ORA/35/2020/TM/CHN)

Sheeja Menon
trading as M/s.Shwethas Hygeine Products
No.4, Janakiraman Colony,
Arumbakkam, Chennai 106, Tamil Nadu.

... Petitioner

-vs-

1.M/s. Novel Tissues Pvt Ltd
No.65A, Kaidb Industrial Area,
Hootagalli, Mysore 570186, Karnataka.

2.The Registrar of Trademarks,
Trademarks Registry, Chennai.

... Respondents

PRAYER: Transfer Original Petition (Trade Marks) filed under Sections 47 and 57 of the Trademarks Act, 1999, praying to call for and examine the records of the said registered trade mark no.2298691 in class 16 registered in favour of the Registrant and to cancel the said Registration and to direct the Registrar of Trade Marks to rectify



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the said trade mark No.2298691 in Class 16 in the Register by expunging all the entries relating to the said trade mark no.2298691, and the Registrant be ordered to pay the costs of the present proceedings.

For Petitioner : Mr.A.Swaminathan
for M/s.L.R.Swami Co.

For Respondent 2 : Mr.J.Madanagopal Rao, SPC

For Respondent 1 : No Appearance

ORDER

The petitioner seeks rectification of the Register of Trade Marks in relation to the following device mark,



which was registered as Trade Mark No.2298691 in Class 16 with effect from 13.03.2012.



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2. The petitioner asserts that it devised and adopted the following device mark



and applied the same to cosmetic wet wipes in January 2011 and has used the mark since then. The petitioner further states that an application was filed on 20.05.2011 for registration of the said device mark in Class 3 and that such registration was granted on 09.01.2019 with effect from 20.05.2011.

3. The petitioner further submits that the first respondent was a manufacturer of tissues and that a conversion agreement dated 04.07.2011 was entered into by the petitioner with the first respondent. By referring to the said agreement, learned counsel for the petitioner points out that the recitals thereof record that the petitioner is the sole licensed user of the trade mark. Upon being



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permitted to manufacture tissue papers bearing the said mark for and on behalf of the petitioner, learned counsel submits that the first respondent fraudulently and clandestinely applied for registration of an identical device mark, as that of the petitioner, in Class 16. By referring to the said device mark, learned counsel pointed out that the device mark of the petitioner was copied and that the goods in relation to which such mark is applied are undoubtedly similar goods. Therefore, learned counsel submits that the petition is liable to be allowed and the impugned mark is liable to be removed from the register. In support of use of the mark by the petitioner, learned counsel refers to invoices issued by the petitioner from 19.12.2007 to 29.03.2019. The income tax returns of the petitioner and documents relating to tax registrations obtained by the petitioner were also relied upon.

4. Upon issuing notice to the first respondent and permitting private notice, it was recorded on 30.06.2023 that notice was served



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on the first respondent on 21.06.2023. Therefore, the Registry was directed to print the name of the first respondent in the cause list. At the hearing on 03.10.2023, Mr.Sivaraman Vaidyanathan, learned counsel, submitted that he was engaged in the proceedings before the Trade Marks Registry and sought two weeks' time to obtain instructions. Thereafter, he did not appear at the hearing on 16.10.2023 and is also not present today. In these circumstances, the matter is proceeded with in the absence of the first respondent.

5. The petitioner has placed on record invoices relating to sale of products bearing the mark EASY BATH from 19.12.2007 to 29.03.2019. A certificate from a Chartered Accountant dated 15.05.2018 specifying the annual turnover and advertisement expenses from the sale of products bearing the trade mark EASY BATH from the financial years 2011-12 to 2016-17 has been placed on record.



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6. The conversion agreement dated 04.07.2011 between the petitioner and the first respondent clearly indicates that the petitioner had rights over the trade mark and that the services of the first respondent were availed of for manufacturing products bearing such trade mark. The application for registration of the identical device mark was filed by the first respondent on 13.03.2012, which is subsequent to the date of use and the date of application of the petitioner. This application is in Class 16 with reference to tissue papers. As stated earlier, the marks are identical and are clearly in relation to similar, if not identical, goods. The use of an identical mark by the first respondent in relation to similar goods is likely to cause confusion and, in the facts and circumstances set out above, such registration appears to have been obtained by suppression and not in a *bona fide* manner. Therefore, the entry was made without sufficient cause.



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WEB COPY 7. For reasons set out above, (T)OP(TM)/349/2023 is allowed by directing the Registrar of Trade Marks to cancel the certificate of registration relating to Trade Mark No.2298691 in Class 16 and remove the entry relating thereto from the Register of Trade Marks. This action 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 to costs.

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Index : Yes / No

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