IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 15.09.2023

CORAM:

THE HON'BLE MR. **JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)OP(TM) No. 371 of 2023 (ORA/77/2020/TM/CHN),
(T)OP(TM) No. 372 of 2023 (ORA/79/2020/TM/CHN),
(T)OP(TM) No. 373 of 2023 (ORA/85/2020/TM/CHN),
(T)OP(TM) No. 374 of 2023 (ORA/86/2020/TM/CHN),
(T)OP(TM) No. 417 of 2023 (ORA/83/2020/TM/CHN),
(T)OP(TM) No. 418 of 2023 (ORA/84/2020/TM/CHN),
(T)OP(TM) No. 419 of 2023 (ORA/87/2020/TM/CHN),
(T)OP(TM) No. 436 of 2023 (ORA/82/2020/TM/CHN),
(T)OP(TM) No. 437 of 2023 (ORA/80/2020/TM/CHN),
(T)OP(TM) No. 438 of 2023 (ORA/81/2020/TM/CHN)
&
(T)OP(TM) No. 459 of 2023 (ORA/78/2020/TM/CHN)

M/s.White House, a Partnership Firm
rep by its Partner, Mohamed Yunus 1096,
EVR Periyar Road,
Periamet, Chennai 600 003 ... Petitioner in all OPs

Vs.

1.White House Apparels Private Limited
2-4-542, 1st Floor, Ramgopalpet,
Secunderabad 500003, AP India.

2.The Registrar of Trade Marks
Intellectual Property Office,

G.S.T.Road, Guindy,
Chennai 600 032. ... Respondents in all OPs

PRAYER in (T)OP(TM) No. 371 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 125 of the Trademarks Act, 1999, prays the present application be allowed and the subject Trade Mark No.999040 in class 25 be removed from the Register.

PRAYER in (T)OP(TM) No. 372 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 125 of the Trademarks Act, 1999, prays the present application be allowed and the subject Trade Mark No.2716096 in class 25 be removed from the Register.

PRAYER in (T)OP(TM) No. 373 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 125 of the Trademarks Act, 1999, prays the present application be allowed and the subject Trade Mark No.2283785 in class 35 be removed from the Register.

PRAYER in (T)OP(TM) No. 374 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 125 of the Trademarks Act, 1999, prays the present application be allowed and the subject Trade Mark No.2283771 in class 24 be removed from the Register.

PRAYER in (T)OP(TM) No. 417 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 125 of the Trademarks Act, 1999, prays the present application be allowed and the subject Trade Mark No.2716101 in class 35 be removed from the Register.

PRAYER in (T)OP(TM) No. 418 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 125 of the Trademarks Act, 1999, prays the present application be allowed and the subject

Trade Mark No.2283777 in class 24 be removed from the Register.

PRAYER in (T)OP(TM) No. 419 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 124 of the Trademarks Act, 1999, prays the present application be allowed and the subject Trade Mark No.1997366 in class 24 be removed from the Register.

PRAYER in (T)OP(TM) No. 436 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 125 of the Trademarks Act, 1999, prays the present application be allowed and the subject Trade Mark No.2283773 in class 35 be removed from the Register.

PRAYER in (T)OP(TM) No. 437 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 125 of the Trademarks Act, 1999, prays the present application be allowed and the subject Trade Mark No.1997370 in class 25 be removed from the Register.

PRAYER in (T)OP(TM) No. 438 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 125 of the Trademarks Act, 1999, prays the present application be allowed and the subject Trade Mark No.2283778 in class 25 be removed from the Register.

PRAYER in (T)OP(TM) No. 459 of 2023: This Civil Miscellaneous Appeal filed under Sections 47, 57 & 125 of the Trademarks Act, 1999, prays the present application be allowed and the subject Trade Mark No.2283772 in class 25 be removed from the Register.

For Appellant : Mr.B.Karthik
for M/s. Lencorp Legal

For 1st Respondent : Mr.Vinod A.Bhagat
for M/s.Arjun T. Bhagat & Co.

For 2nd Respondent : Mr.K.Subbu Ranga Bharathi,
Central Govt. Standing Counsel

COMMON ORDER

On 07.01.2020 and 14.01.2020, respectively, the petitioner filed three applications for registration of the word mark 'WHITE HOUSE' under classes 24, 25 and 35. In the examination report, objections were raised by the Registrar of Trade Marks by citing marks registered in favour of the first respondent. In the reply thereto, the petitioner asserted use of the relevant mark from 1963 but proceeded to state that the mark applied for and the cited marks are visually and phonetically dissimilar. These petitions for rectification were filed in the above factual context.

2. Oral arguments on behalf of the petitioner were addressed by Mr.B.Karthik, learned counsel; on behalf of the first respondent by Mr.Vinod Bhagat, learned counsel; and on behalf of the second respondent by Mr.Subbu Ranga Bharathi, learned Central Government Standing Counsel.

3. Learned counsel for the petitioner asserted that the petitioner has used the mark 'WHITE HOUSE' from 01.04.1963 in relation to apparel and textiles. In support of this contention, learned counsel relied upon the acknowledgement of registration of the partnership firm, M/s.White House, on 18.09.1981. He also placed for consideration the certificate of incorporation of an entity called 'White House Process Private Limited' on 05.10.1990. The extract from the Register of Firms with regard to the firm 'WHITE HOUSE' was also placed for consideration. Learned counsel relied on the registration certificate issued in the name of the exporter, WHITE HOUSE, by the Apparel Export Promotion Council (the AEPC) and pointed out that it establishes registration on 27.06.1985. The application submitted by the petitioner to the Reserve Bank of India for allotment of an Import Export Code was also placed for consideration.

4. By relying upon certificates issued by a Chartered Accountant, learned counsel submitted that the petitioner had a turnover of about Rs.81,35,038.03 in the financial year 1984-85. In

the financial year ended 31.03.1988, the turnover increased to Rs.2,50,50,559.03 and in the following financial year (ended 31.03.1989) it further increased to Rs.3,72,22,325.63. After pointing out that the turnover was about Rs.36,49,98,225.00 for the financial year ended 31.03.1999, learned counsel referred to invoices relating to the export of goods by the petitioner. In particular, he pointed out that the invoice dated 22.04.2015 bears the mark 'WHITE HOUSE'.

5. Based on the above evidence, learned counsel contended that the petitioner is the prior user of the mark 'WHITE HOUSE' and that the rights of a prior user override the rights of a subsequent user although such subsequent user may have obtained registration in respect of the relevant marks. In support of this contention, learned counsel relied upon the judgment of the Hon'ble Supreme Court in *Syed Mohideen v. P.Sulochana Bai, (2016)(2) SCC 683.* With regard to the application of the mark to goods which are the subject of export, learned counsel relied on Section 56 of the Trade Marks Act, 1999 (the Trade Marks Act). He

further relied on the judgment of the Bombay High Court in *Wockhardt Limited v. Eden Healthcare Private Limited*, particularly paragraph 22 thereof. Learned counsel concluded his submissions by contending that use of the mark as the trading style would also qualify as use at least for purposes of class 35, and that all the entries in relation to the mark 'WHITE HOUSE' in the name of the first respondent should be directed to be removed from the register.

6. In response to these submissions, learned counsel for the first respondent contended that the said respondent had used the mark 'WHITE HOUSE' from the year 1994. In support of this contention, he relied on the registration certificates. As regards the petitioner, he contended that the petitioner had not provided any evidence of application of the mark 'WHITE HOUSE' to goods until about April 2015. By contrast, learned counsel contended that the first respondent has placed on record invoices dating from May 1994. Learned counsel for the first respondent further submitted that the petitioner advertised products bearing the

mark 'WHITE HOUSE' extensively. In order to substantiate such contention, invoices issued by advertising agencies were relied upon. Learned counsel also relied on the advertisements published in the print media.

7. After honestly adopting the mark by drawing on two common English words, learned counsel submitted that the mark was used openly, honestly and continuously over an extended period of time. He further submitted that whenever an identical or deceptively similar mark was attempted to be registered by third parties, the first respondent opposed such registration before the Trade Marks Registry.

8. The next contention of learned counsel was that the petitioner responded to the examination report by contending that the petitioner's mark is visually and phonetically different from that of the petitioner. In proceedings before this Court, he contended that the petitioner did a *volte face* and contended that the petitioner is the prior user of the mark. As regards the reliance

on Section 56 of the Trade Marks Act by learned counsel for the petitioner, learned counsel for the first respondent submitted that Section 2(2)(c) of the Trade Marks Act makes it abundantly clear that a mark should be used either in relation to goods or services to qualify as use of the mark for purposes of the Trade Marks Act. Consequently, learned counsel contended that the reliance on Section 56 by learned counsel for the petitioner is misplaced.

9. In conclusion, learned counsel for the first respondent reiterated that the first respondent is the prior user of the mark and that such mark was used extensively from the year 1994 and that about 20 registrations were obtained by the first respondent in classes 24, 25 and 35. Therefore, learned counsel submitted that these petitions are completely devoid of merit and are liable to be dismissed.

10. Upon taking stock of the rival contentions, the principal question that arises for consideration is whether the petitioner has established prior use of the mark 'WHITE HOUSE'.

In order to answer this question, the evidence placed on record by the petitioner should be examined. The petitioner relied on the acknowledgement of registration of the partnership firm "M/s.White House" on 18.09.1981. This document establishes that a partnership firm was registered on the said date under the name and style of "M/s.White House". Similarly, the petitioner relied upon the certificate of registration issued by the AEPC. This certificate provides evidence that an exporter under the name and style of 'WHITE HOUSE' was registered by the AEPC on 27.06.1985. Multiple certificates from the Chartered Accountant of the petitioner firm were placed on record and relied upon. Each of these certificates specifies the export turnover of the petitioner during specific financial years. In addition, some of the certificates indicate the products that were exported by the petitioner and the turnover accrued from the export of specific products. None of these certificates provide evidence that the mark 'WHITE HOUSE' was applied in relation to the products exported by the petitioner.

11. Turning to the invoices that were relied upon by the petitioner, the first of these invoices is dated 21.07.2010. Under the column 'mark', the abbreviation, W & H, is set out. The first invoice bearing the mark 'White House' is the invoice dated 22.04.2015. When these invoices are compared and contrasted with the invoices placed on record by the first respondent, it is evident that the invoices of the first respondent are from May 1994 onwards and precede the invoices placed on record by the petitioner by about two decades.

12. Learned counsel for the petitioner relied on Section 56 of the Trade Marks Act to contend that proof of export of goods from 1984-1985, in the form of certificates issued by the Chartered Accountant, would qualify as use for purposes of Section 56 of the Trade Marks Act. Section 56(1) is set out below:

" 56. Use of trade mark for export trade and use when form of trade connection changes. –

(1) The application in India of trade mark to goods to be exported from India or in relation to services for use

outside India and any other act done in India in relation to goods to be so exported or services so rendered outside India which, if done in relation to goods to be sold or services provided or otherwise traded in within India would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods or services for any purpose for which such use is material under this Act or any other law."

13. Section 56 provides that the application in India of a trade mark to goods exported from India or in relation to services for use outside India would be deemed to be use of the trade mark for purposes of the Trade Marks Act. Thus, the foremost requirement for the applicability of sub section (1) of Section 56 is the application in India of the trade mark to goods or services, as the case may be. As noticed earlier, the petitioner did not provide any evidence of the application of the trade mark to goods until about 22.04.2015. The certificates that were relied upon by the petitioner do not constitute evidence of the application of the mark 'WHITE HOUSE' to goods that were exported by the petitioner. Especially when Section 56 of the Trade Marks Act is

read in the context of Section 2(2)(c) thereof, the conclusion that follows is that the petitioner failed to provide any evidence of use until about April 2015. As a corollary, I conclude that the first respondent's use of the mark preceded use by the petitioner by several years.

14. For reasons set out above, it cannot be said that entries were made in the Register of Trade Marks without sufficient cause. Therefore, all these rectification petitions are dismissed without any order as to costs.

15.09.2023

Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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SENTHILKUMAR RAMAMOORTHY, J.

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