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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 07.12.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)/537/2023
(ORA/SR.63/2018/TM/CHN)

The Scotch Whisky Association
1st Floor, Quartermile Two, 2 Lister Square,
Edinburgh, EH3 9GL, Scotland,
United Kingdom.

... Petitioner

-VS-

1.Shiva Distilleries Limited
45 and 252, Mettupalayam Road,
Coimbatore - 641 043.
And
Fatehchand C. Shah and Co.
"A" Aidun Building,
5th Floor,
1st Dhobi Talao, Mumbai - 400 002.

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

... Respondents



WEB CONTENT

PRAYER: Transfer Original Petition (Trade Marks) filed under Sections 47, 57 of the Trade Marks Act, 1999, praying that the instant cancellation petition be allowed and the entry in the Register in respect of the Impugned Mark MACREAL under registration No.1842884 in Class 33 in the name of Respondent No.1 be removed from the Register of Trade Marks and a copy of its publication of such removal be sent to the Registrar of Geographical Indications as per Rule 76 of the GI Rules.

For Petitioner : Mr.Arun C.Mohan
for M/s.K and S Partners

For Respondent 1 : No Appearance

For Respondent 2 : Mr.A.R.Sakthivel, SPC

ORDER

The petitioner seeks rectification of the Register of Trade Marks with regard to the mark "MACREAL", which was registered under Trade Mark No.1842884 in Class 33 in the name of the first respondent.



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2. The petitioner is the Scotch Whisky Association, which represents the interest of Scotch Whisky producers across the world. By relying on the registration of "Scotch Whisky" as a geographical indication in India, the petitioner asserts that it is a "person aggrieved" by the registration of the impugned mark.

3. The bailiff's report records that notice was served on the first respondent on 21.10.2023. The said report contains the signature and rubber stamp of the first respondent. In spite of service of notice and the name of the first respondent being printed in the cause list, the first respondent remains unrepresented. Therefore, the matter is proceeded with in the absence of the first respondent.

4. Learned counsel for the petitioner submits that India is one of the largest importers of "Scotch Whisky" by value. By relying on



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data set out in the paper book, learned counsel submits that the value of import in India in the year 2015 is 84,803,817 Great Britain Pounds (GBP). He further submits that the letters 'MAC', which form the prefix of the impugned mark, are commonly used by Scottish clans. Consequently, he submits that many scotch whisky brands contain the prefix 'MAC'. By way of examples, he refers to the MACHALLAN, WHYTE & MACKAY, MACKENZIE and the like.

5. After applying for and obtaining registration of the impugned mark on 22.07.2009 on a "proposed to be used" basis the petitioner asserts that the mark was never used by the first respondent. In support of this assertion, learned counsel referred to the affidavit filed by Mr. Bhupinder Singh Bindra, investigator, on 02.05.2018, wherein he stated that he carried out an investigation on 23.06.2017 and concluded that the first respondent or its subsidiaries do not manufacture any product under the mark MACREAL.

6. Under Section 47(1) of the Trade Marks Act, 1999 (the Trade



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Marks Act), a mark is liable to be removed from the register, either if such mark is registered without any *bona fide* intention on the part of the applicant for registration to use the mark in relation to the relevant goods or services and there was no *bona fide* use of the said trade mark up to three months before the date of the application; or if, up to a date ending three months prior to the date of application, for a continuous period of not less than five years, there was no use of the trade mark.

7. The record discloses that the trade mark was registered with effect from 22.07.2009 on a "proposed to be used" basis. The petition for rectification was filed on 02.07.2018. In support of the assertion of non-use, the affidavit of the investigator was relied upon. In spite of being put on notice, the first respondent has chosen not to contest the proceedings. In effect, there is no evidence of use of the impugned mark by the first respondent since the date of registration. In these facts and circumstances, the impugned mark is liable to be removed from the register as per Section 47(1)(b) of the Trade Marks



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8. For reasons set out above, (T)OP(TM)/537/2023 is allowed by directing the Registrar of Trade Marks to remove the Trade Mark No.1842884 in Class 33 from the Register of Trade Marks and to cancel the certificate of registration relating thereto. These actions 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.

07.12.2023

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Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No

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