

OCD-19

IPDATM/4/2024
IN THE HIGH COURT AT CALCUTTA
COMMERCIAL DIVISION
ORIGINAL SIDE

Super Smelters Ltd.
Versus
Rekha Tayal &Anr.

Before:
The Hon'ble Justice RAVI KRISHAN KAPUR
Date: 17thDecember 2024

Appearance:
Mr. Sourojit Dasgupta, Advocate
Mr. Dhruv Chadha, Advocate
Mr. Victor Dutta, Advocate
for the petitioner

The Court: Despite substituted service, the respondents remain unrepresented even in the second call.

This is an application filed for rectification under section 47 (1)(a) read with section 57(1) and (2) of the Trade Marks Act, 1999.

Briefly, the applicant is a leading manufacturer and distributor of TMT Bar and Rods primarily used in the metal industry. Such goods have been classified under Class 6 of the International Nice Classification.

In or about 1999, the petitioner had coined and adopted the mark "SUPER SHAKTI" where the word "SUPER" is an essential and distinctive feature of its product. The petitioner has been extensively, continuously and uninterruptedly using such marks since 1999. It is contended that, due to superior quality of its product "SUPER SHAKTI" has gained immense goodwill and reputation in the market. The petitioner is also the prior adopter and lawful owner and proprietor of

the said mark. The petitioner had also contemporaneously applied for registration of the mark “SUPER SHAKTI” in various forms and has been granted registration thereof. The Details of the various registrations granted in favour of the petitioner in respect of the said mark “SUPER SHAKTI” are set out hereinbelow:

<u>Application/ Registration No</u>	<u>Date</u>	<u>Class</u>	<u>Mark (Graphical representation)</u>	<u>Status</u>
2431526	22.11.2012	6		Registered
3447329	03.07.2017	6		Registered
4412279	14.12.2020	6		Registered
4412280	14.09.2020	6		Registered

The impugned mark “SUPER SHAKTI” was filed for registration on April 24, 2023 and the same was granted on 13 March, 2024. Admittedly, the impugned mark has never been used. It is alleged that the impugned mark has been registered with the ulterior and oblique intent of trafficking and taking advantage of the petitioner’s trademark. It is contended that the impugned mark is phonetically identical and deceptively similar. There is every likelihood

of deception and confusion. The impugned mark is in respect of the similar goods. In view of the above, the registration granted in favour of the private respondent is liable to be cancelled. Accordingly, the petitioner has applied for cancellation of the registration granted in favour of the impugned mark.

For convenience, the relevant sections of the Trade Marks Act, 1999 and the Rules framed thereunder are set out hereinbelow:

“47. Removal from register and imposition of limitations on ground of non-use. – (1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the [High Court] by any person aggrieved on the ground either –
 (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the applicant; or

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 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.”

“Rule 33. Examination, Objection to acceptance, hearing. – (1) The Registrar Shall cause the application to be examined as

per provisions of the Act, wherein a search shall also be conducted amongst the earlier trade marks, registered or applied for registration, for the purpose of ascertaining whether there are on record in respect of the same goods or services or similar goods or services any trade mark identical with or deceptively similar to the trade mark applied for. The Registrar may cause the re-examination of the application including research of earlier trade marks at any time before the acceptance of the application but shall not be bound to do so.”

The Examination Report relied on by the Registrar in granting the registration of the impugned mark does not take into consideration the fact that the prior mark of the petitioner SUPER SHAKTI was already on the Register. This is a glaring error and omission in the grant of the impugned registration in favour of the respondent no. 1.

The adoption and registration of the impugned mark is nothing but a deliberate and wilful attempt to *ride* on the goodwill and reputation of the petitioner’s mark “SUPER SHAKTI”. The same cannot by any stretch of imagination be said to be coincidental or bona fide. The respondent no.1 could not have even contemplated adopting the impugned mark without being aware of the petitioner’s prior registration. It is obvious that the respondent no.1 has acted in bad faith and with dishonest intent in adopting the impugned mark which is deceptively identical to the petitioner’s mark “SUPER SHAKTI”. The impugned mark mars the purity of the Register and continuance of the same is against public interest.

Even a cursory examination of the data base of the respondent authorities would reveal the existence of the petitioner’s mark. There is no mention of the petitioner’s mark in the First Examination Report

relied on by the respondent authorities in granting the impugned registration and this is fatal. The impugned mark is phonetically, alphabetically and deceptively similar to that of the petitioner's product. The impugned mark is also being used in respect of identical and similar goods. There is every likelihood of confusion and deception if the respondent no.1 is permitted to use the impugned mark. In view of the above, the impugned registration of the mark "SUPER SHAKTI" bearing Trade Mark Registration No.5909429 in class 6 in its entirety could not have been allowed by the respondent no.2.

In such circumstances the registration of the impugned mark is in material contravention of the Act and the Rules framed thereunder.

The petitioner has been able to demonstrate a strong prima facie case on merits. The balance of convenience and irreparable injury is also in favour of granting prayers as prayed for herein.

In view of the above, there shall be an order in terms of prayers (a) and (b) of the Notice of Motion. The ad interim order dated 1st October 2024 stands confirmed to the above extent.

With the above directions, IPDATM/4/2024 stands disposed of.

(RAVI KRISHAN KAPUR, J.)