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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Judgment reserved on	22.12.2023
Judgment pronounced on	07.02.2024

CORAM

The Hon'ble Mr. Justice SENTHILKUMAR RAMAMOORTHY

(T) OP (TM) No.6 of 2023
(ORA/17/2009/TM/CHN)

&

(T) OP (TM) No.20 of 2023
(ORA/137/2011/TM/CHN)

(T) OP (TM) No.6 of 2023
(ORA/17/2009/TM/CHN)

M/s.Shambhunath & Bros,
 a registered partnership firm having its
 principal place of business at 47,
 Biplabi Anukul Chandra Street,
 Kolkata-700 072.

... Petitioner

-VS-

1.Jai Rajendra Impex Pvt. Ltd.

A company incorporated under the Companies Act,1956
 having its registered office at Plot No.60,
 CIE, Gnadhinar, IDA, Hyderabad-500 037,
 Andhra Pradesh.



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2.The Deputy Registrar, Trade Marks Registry,
Chennai, Intellectual Property Rights Blds.,
Industrial Estate SIDCO RMD, Gowdown Area,
G.S.T. Road, Guindy,
Chennai-600 032.

... Respondents

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PRAYER in (T)OP (TM) No.6 of 2023: Transfer Original Petition
(Trademarks) filed under Sections 47, 57 and 125 of the Trade Marks
Act, 1999, prays (a) an order be passed calling upon the Registrar of



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Trade Marks to send the records, pertaining to the registration of the Trade Mark No.1505280 in Class-11 in favour of the registered proprietor from the Trade Marks Registry to this Court and after examining the same cancel and/or set aside the impugned registration; (b) an order directing cancellation of the registration of the mark “THUFAN” in Tamil made under No.1505280 in Class-11 and directing the records to be rectified by expunging the same from the Register of Trade Marks; and (c) Cost of this application be directed to be paid by the registered proprietor.

PRAYER in (T)OP (TM) No.20 of 2023: Transfer Original Petition (Trademarks) filed under Sections 47, 57 and 125 of the Trade Marks Act, 1999, prays (a) an order be passed calling upon the Registrar of Trade Marks to send the records, pertaining to the registration of the Trade Mark No.1506140 in Class-11 in favour of the registered proprietor from the Trade Marks Registry to this Court and after examining the same cancel and/or set aside the impugned registration; (b) an order directing cancellation of the registration of the mark “THUFAN” in Tamil made under No.1506140 in Class-11 and directing the records to be rectified by expunging the same from the Register of Trade Marks; and (c) Cost of this application be directed to be paid by the registered proprietor.



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In both OPs:

For Petitioner

: Mr.Siddharth Mitra, Senior Advocate
for Mr.Debnath Ghosh, Mr.Goutam
Kumar Ray, Mr.T.K.Jana, Mr.S.Jana
for M/s.C.J.Associates

For Respondent 1

: Mr.Rudraman Bhattacharya
Mr.Atish Ghosh,Mr.Hemant Daswani
Mr.Arindam Chandra
Mr.G.Kanagavel for R1

For Respondent 2

: Mr.C.Samivel, SPC

COMMON ORDER

Background

By these petitions, the petitioner seeks rectification of the register of trade marks by removal therefrom of the trade mark 'THUFAN' which was separately registered in the Tamil and Telugu languages. Since the registration certificates carry the spelling "THUFAN", said spelling is used while referring to the registered trade marks of the first respondent in this order, whereas the spelling 'TOOFAN' is used while otherwise referring to the trade marks.



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2. The petitioner is a registered partnership firm. The petitioner asserts that the firm has carried on the business of manufacturing and marketing electrical fans since 1987, and that the trade mark “TOOFAN” has been applied in relation to the petitioner's goods since then. By asserting that the first respondent herein, which is a private limited company incorporated on 08.12.2005, was the subsequent adopter and user of the nearly identical trade mark 'THUFAN', the petitioner asserts that the said mark was entered in the register in contravention of the applicable provisions of the Trade Marks Act, 1999 (the Trade Marks Act) read with the Trade Mark Rules, 2002 (the 2002 Rules), which were the rules applicable at the time of registration of the impugned marks. The present petitions for rectification were filed in the above facts and circumstances.

Counsel and their contentions

3. Oral arguments on behalf of the petitioner were addressed by Mr.Siddharth Mithra, learned senior counsel, assisted by



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Mr. Debnath Ghosh, learned counsel; and on behalf of the first respondent by Mr. Rudraman Bhattacharya, learned counsel, assisted by Mr. Hemant Daswani. The second respondent was represented by Mr. C. Samivel, learned SPC.

4. Learned senior counsel opened his submissions by pointing out that the word 'TOOFAN' means gust of wind in the Urdu language. Being appropriate for electrical fans, it is stated that the petitioner adopted the trade mark in the year 1987 and has used the said mark openly, honestly and continuously since then.

5. He next submitted that the petitioner became aware some time in October, 2008 that the first respondent had registered the deceptively similar trade mark 'THUFAN' in the Telugu language in respect of electrical goods, including ceiling fans, table fans and wall mounted fans. On further enquiry, the petitioner came to know that the application was advertised in Trade Marks Journal No.1388/0



dated 16.03.2008. The petitioner also ascertained that the registration was obtained by falsely asserting use since 01.01.1976. By pointing out that the first respondent was incorporated on 08.12.2005, learned senior counsel submitted that the impugned registrations were obtained by misrepresentation. After submitting that the 2002 Rules were in force at the time of registration of the impugned trade marks, learned senior counsel submitted that Rule 33 thereof prescribes that any trade mark containing words in a script other than English or Hindi should be accompanied by a translation. He further contended that non-compliance with this mandatory requirement by the first respondent caused immense prejudice to the petitioner because the petitioner was not in a position to oppose the registration of the trade marks in spite of the same being advertised. By relying on Rule 27 of the 2002 Rules, learned senior counsel submitted that an applicant for trade mark registration is required to state the period of use and the person by whom the relevant trade mark was used. He also submitted that the first respondent contravened Rule 27 by



failing to provide this information. By referring to sub-section 1 of Section 18 of the Trade Marks Act and Rule 25(2) of the 2002 Rules, he contended that the first respondent's registrations are liable to be removed from the register of Trade Marks for contravention of the above provisions.

6. Learned senior counsel next contended that the counter statement originally filed by the petitioner before the Intellectual Property Appellate Board (the IPAB) contained an assertion of use since 2003. Later, upon being permitted to apply for amendment, even without the IPAB accepting the proposed amendment, he submitted that the first respondent filed an amended counter asserting use since January, 1976. By referring to the judgment of the Hon'ble Supreme Court in *Hardie Trading v. Addisons Paint & Chemicals Ltd (Hardie Trading)*, 2003 SCC OnLine SC 1006, he submitted that the petitioner qualifies as a person aggrieved both for purposes of Sections 47 and 57 of the Trade Marks Act because the



petitioner adopted and used the trade mark 'TOOFAN' prior to the first respondent, and is in the same line of business as the first respondent. Therefore, he submitted that the petitioner is entitled to an order for rectification.

7. Mr. Rudraman Bhattacharya, learned counsel, responded to the above submissions. He commenced his arguments by dealing with the submissions on amendment. With reference to the order dated 30.11.2012 of the IPAB, learned counsel submitted that both parties were permitted to amend their pleadings and that, pursuant thereto, both parties filed amended pleadings. He also pointed out the nature of amendments made by the first respondent. He then proceeded to explain the devolution of title to the first respondent's trade mark. He submitted that Devi Chand Jain started a business under the name 'Sunlight Electricals' in 1973 and adopted and used the trade mark 'TOOFAN' in 1976 both in the English and Telugu languages. In support of this contention, he referred to invoices



bearing the trade mark, which are contained at C1-C143 of documents filed with the amended counter statement. He then submitted that Devi Chand Jain permitted Sri Shanthilal Jain to use the trade mark 'TOOFAN', and that Sri Shanthilal Jain used the marks since 1985. As evidence of use of the trade mark by Shanthilal Jain, learned counsel referred to invoices at E-25 to E-37 of documents filed with the amended counter statement. He next pointed out that Sri Shanthilal Jain was the father of Dilip Kumar Jain, who is one of the directors of the first respondent.

8. Learned counsel further submitted that Devi Chand Jain also permitted his brother, Sri Lal Chand Jain, who was carrying on business under the name and style 'Aman Marketing Company', to use the trade mark 'TOOFAN' and the said Aman Marketing company was using the trade mark since 1984. As evidence of use by Aman Marketing Company, he referred to invoices at F2 to F17 of documents filed with the amended counter statement. After



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submitting that Devi Chand Jain also permitted another brother, namely, Bharat Jain, to use the trade mark 'TOOFAN' in relation to manufacturing and trading business undertaken under the name and style 'Rajendra Industries', learned counsel pointed out that, upon incorporation in the year 2005, the first respondent acquired proprietorship over the trade mark 'TOOFAN' under a deed of assignment dated 30.03.2006, which was executed by the children of Devi Chand Jain. Upon coming to know that Sunita Industries had also registered the trade mark 'TOOFAN' in English by claiming user since 1987, he submitted that the first respondent also obtained an assignment under deed of assignment dated 3rd March, 2009 from Sunita Industries. In this manner, he submitted that the petitioner became the sole proprietor of the trade mark 'TOOFAN'. Thereafter, the petitioner applied for and obtained registrations of the trade mark in the Tamil, Telugu and English languages.

9. Learned counsel next submitted that the Jain brothers did not



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have a factory to manufacture fans and, therefore, issued job work orders to producers/assemblers of fans in different parts of the country. One such producer/assembler was the petitioner. As evidence thereof, he referred to the stock register of 'C' forms at page No.H-1 of documents filed with the amended counter statement. According to learned counsel, the dispute between the petitioner and the first respondent originated from disputes raised by Aman Marketing Company with regard to the poor quality of goods supplied by the petitioner. The documents annexed to the amended counter statement as L1 to L8 of were referred to in this regard. Once such dispute arose, learned counsel submitted that the petitioner filed Suit No.358 of 2008 before the Hon'ble Calcutta High Court and initially obtained an *ex parte* order, and that such order was vacated by a subsequent order dated 30.06.2010. The suit was dismissed thereafter for non-prosecution. A subsequent suit (C.S.No.133 of 2010) was filed by the petitioner before the Hon'ble Calcutta High Court. By interim order dated 25.07.2011, the Calcutta High Court



recorded *prima facie* findings that the first respondent and its predecessor-in-interest, Sunlight Industries, had used the marks since 1976. Learned counsel asserted that the petitioner had suppressed the aforesaid order.

10. Learned counsel countered the contention that the registration was in contravention of the Trade Marks Act and the 2002 Rules by pointing out that the applications for registration, as originally filed, contained an assertion of use since 1976. Upon receipt of the examination report from the Registrar of Trade Marks, he pointed out that a detailed affidavit was filed by the first respondent stating that Sunlight Electricals are the predecessors-in-title and that such entity used the trade marks since 1976. In response to the allegation that Rule 27 of the 2002 Rules was contravened, he pointed out that Rule 36 of the 2002 Rules enables the applicant to remedy deficiencies in the application upon being put on notice of such deficiencies. In effect, he contended that the failure to provide particulars of the predecessors-in-title at the time of lodging the



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application is a curable defect, and that the defect was cured by the first respondent by providing such information and supporting documents subsequently. In this connection, he referred to documents at A5 to A7 of the counter statement. He also pointed out that the affidavit filed by the first respondent before the Registrar of Trade Marks discloses the deed of assignment executed by the legal heirs of Devi Chand Jain in favour of the first respondent. By relying on the judgment of the House of Lords in *General Electric Company, 1972 (1) WLR 729*, he submitted that the relief of rectification is discretionary and that the Court may refuse to rectify the register even if the trade mark had been entered on the register in contravention of any requirement. With reference to the decision of the IPAB dated 28.01.2010 against Aman Marketing Company, he submitted that the said decision was issued when the *ex parte* injunction of the Calcutta High Court was in operation. Since the suit in which such order was issued was subsequently dismissed on 30.06.2010, he submitted that the order of the IPAB is no longer



material.

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11. By way of rejoinder, learned senior counsel for the petitioner submitted that the documents produced by the first respondent at this juncture cannot be taken into consideration and that these petitions should be decided entirely on the basis of documents produced by the first respondent before the Registrar of Trade Marks. By drawing reference to the documents placed on record by learned SPC on behalf of the Registrar of Trade Marks, learned senior counsel submitted that as regards Application No.1505280, which corresponds to the trade mark in the Telugu language, the alleged affidavit of use of Mr.Dilipkumar Jain is incomplete and Ex.A, which is supposed to be annexed thereto, is not available. As regards Application No.1506140, which is in respect of the trade mark in the Tamil language, he contended that the documents produced do not contain the affidavit of use with particulars of the predecessors-in-interest of the first respondent. He



also pointed out that the letter from the Trade Mark Registry stating that the trade mark would be advertised is subsequent to the publication of the advertisement on 01.11.2008. He concluded his submissions by contending that the impugned marks are liable to be removed from the register of trade marks because these marks were entered on the register without sufficient cause and in contravention of the Trade Marks Act and the 2002 Rules.

Discussion, Analysis and Conclusion:

12. While learned senior counsel for the petitioner relied on the judgment of the Hon'ble Supreme Court in *Hardie Trading* to contend that the petitioner qualifies as a person aggrieved for purposes of maintaining the rectification petitions, the first respondent did not contest this position. For such reason and by also taking into account the lines of business of the parties and their trade marks, I proceed on the basis that the petitioner is a person aggrieved.

13. At the outset, the preliminary objection with regard to the



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amendment of the counter statement is dealt with. The applications filed by the first respondent for registration of trade mark contain an assertion of use from 1976. The counter to the rectification petitions, as originally filed before the IPAB, contained an assertion of use since 2003. An amended counter statement was filed by the first respondent pursuant to the order dated 30.11.2012 of the IPAB. In the amended counter statement, the first respondent narrated the facts relating to the adoption and use of the impugned trade marks from 1976 by Sunlight Electricals and further asserted that said entity is the original predecessor-in-interest from whom title devolves. Both in view of the order of the IPAB permitting the contesting parties to file amended pleadings and because of the assertion of use since 1976 in applications filed before the Registrar of Trade Marks, I conclude that the amended counter statement is liable to be taken into consideration and that it does not fundamentally alter the case set up in defence by the first respondent.



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14. A petition for rectification may be prosecuted either under Section 47 or 57 of the Trade Marks Act. A petition under Section 47 is founded on non-use of a registered trade mark. Since there is no allegation of non-use, this petition is required to be determined with reference to Section 57. Section 57 is 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 Appellate Board or to the Registrar by any person aggrieved, the tribunal 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 Appellate Board or to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as it may think fit.



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(3) The tribunal may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(4) The tribunal, of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).

(5) Any order of the Appellate Board rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.”

15. As is evident from the text of sub-section (1) of Section 57, the Court may cancel or vary the registration of a trade mark on the ground of any contravention or failure to observe a condition entered on the register in relation to such registration. In addition, under sub-section (2) thereof, the Court may expunge or cancel or vary an entry



in the register of trade marks if such entry was made without sufficient cause or is wrongly remaining in the register or if there are any errors or defects in such entry.

16. In this case, the petitioner seeks removal or expunging of the impugned trade marks and not variation or correction in the entry. Such removal is requested for on the ground of alleged contravention and entry and continuance on the register without sufficient cause. In support of the contention with regard to contravention, learned senior counsel relied heavily on Rules 27 and 33 of the 2002 Rules. The said rules are set out below:

27. Statement of user in applications.-An application to register a trade mark shall, unless the trade mark is proposed to be used, contain a statement of the period during which, and the person by whom it has been used in respect of the goods or services mentioned in the application. The Registrar may require the applicant to file an affidavit testifying to such user with exhibits showing the mark as used.



33. Transliteration and translation.-Where a trade mark contains a word or words in scripts other than Hindi or English, there shall be endorsed on the application form and the additional representations thereof, a sufficient transliteration and translation to the satisfaction of the Registrar of each such word in English or in Hindi and every such endorsement shall state the language to which the word belongs and shall be signed by the applicant or his agent.

He also relied on sub-section 1 of Section 18 of the Act, which is also set out below:

“18. Application for registration.-(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark.”

17. On examining Rule 27 of the 2002 Rules, it is clear that an applicant for registration of a trade mark, other than on proposed use basis, is required to provide a statement of the period during which such trade mark was used and details of the person(s) by whom it was used in respect of the goods or services mentioned in the



application. Here, the first respondent applied for registration by asserting use since 1976. Consequently, the first respondent was required to not only state the period from which the trade mark was used but also the person or persons by whom it was used. Although the original application contained a statement asserting use since 1976, it did not provide details as to the person or persons who used the mark since 1976. The question that follows is whether such defect is curable or incurable. It is noticeable from Rule 27 that no consequences are specified with regard to non-compliance with the prescription therein. Learned counsel for the first respondent referred to Rule 36 of the 2002 Rules in this regard, and said Rule is set out below:

*“36. **Deficiencies:** Subject to sub-rule (2) of rule 11, where an application for registration of a trade mark does not satisfy the requirement of any of the provisions of the Act or rules, the Registrar shall send notice thereof to the applicant to remedy the deficiencies and if within one month of the date of the notice the applicant fails to remedy any deficiency so*



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notified to him, the application shall be treated as abandoned."

18. From Rule 36, it appears that the Registrar shall send notice to the applicant if the application does not satisfy the requirement of any of the provisions of the Act or rules and the applicant has an opportunity to remedy such deficiencies within one month from said notice. If the applicant fails to remedy the deficiencies, the application may be treated as abandoned. When Rules 27 and 36 are read together, the only reasonable inference is that non-compliance with Rule 27 may be remedied in terms of Rule 36 by the applicant. Whether the defect was remedied is examined next.

19. Upon being directed to produce the documents relating to the prosecution of the relevant trade marks, learned SPC placed such documents on record. The documents relating to Application 1505280, which pertains to the trade mark in the Telugu script,



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contains the affidavit of Mr.Dilip Kumar Jain. The affidavit is incomplete inasmuch as only the first page is available in the set of documents produced by the Registrar of Trade Marks. Paragraph 3 of the affidavit is as under:

“3. The mark “TOOFAN” applied for registration under application number 1505280 of November 17, 2006 was first adopted in the year 1976 by predecessors of my company Sunlight Electricals of 11-25-368, Main Road, Vijayawada – 1, Andhra Pradesh and by virtue of Deed of assignment dated March 30, 2006 same was assigned to my company in respect of Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying and ventilating purpose including, veiling fans, table fans, wall mounted fans, standing fans, exhaust fans, air conditioners, air coolers, microwave ovens, electric grills, toasters, gas burners, refrigerators and parts thereof and since then same is in use by my company. I attach to my affidavit a notarized copy of said deed of assignment dated March 30, 2006 marked as EXHIBIT A.”



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20. In the above paragraph, the deponent affirmed that the trade mark was first adopted in the year 1976 by the predecessors of the first respondent, Sunlight Electricals. The deponent further affirmed that the first respondent acquired the trade mark under deed of assignment dated 30.03.2006. While the affidavit contains a reference to a notarized copy of the deed of assignment, the said notarized copy is unavailable in the set of papers filed by the Registrar of Trade Marks. The first respondent has, however, made available the complete affidavit, which is contained at A6 to A7 of documents filed along with the amended counter statement. Whether the first respondent placed sufficient evidence on record to establish adoption and use by the predecessors remains to be considered.

21. As evidence of use of the trade mark by Sunlight Electricals, invoices at C-1 to C173 of documents filed with the amended counter statement were relied on, and these invoices span the period 1976 to 2005. As evidence of use of the trade mark by Sri Rajendra Electrical



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Corporation (permitted user of Shantilal Jain) since 1985, invoices at E-2 to E-37 of documents filed with the amended counter statement were relied on. As evidence of use by another permitted user and brother of Devi Chand Jain, Sri Lal Chand Jain, who was carrying on business under the name and style 'Aman Marketing Company', invoices at F2 to F17 of documents filed with the amended counter statement were relied on and these invoices bear dates running from 1995 to 1996. Upon coming to know that Sunita Industries had also registered the trade mark 'TOOFAN' in English by claiming user since 1987, the first respondent asserted that an assignment was obtained under deed of assignment dated 3rd March, 2009 from Sunita Industries and placed such document on record as I-1 of documents filed with the counter statement. When viewed cumulatively, these documents lead to the conclusion that the predecessors-in-interest of the first respondent adopted and used the trade mark 'TOOFAN' prior to the petitioner herein.



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22. Apart from the conclusion that the predecessors-in-title of the first respondent adopted and used the trade mark before the petitioner adopted and used the trade mark, the evidence on record also leads to the conclusion that the contravention of Rule 27 at the time of filing of the trade mark application was subsequently remedied by the first respondent. In this connection, it should be noticed that after the first respondent filed the affidavit of Dilip Kumar Jain along with supporting documents, no objections were raised by the Registrar of Trade Marks with regard to deficiencies in the applications. As regards the contravention of Rule 33, it is noticeable from said Rule that no consequences are specified for the contravention thereof. The evidence on record clearly leads to the inference that the first respondent, through its predecessors-in-title, was the prior adopter and user of the relevant trade mark. As the prior adopter and user of the trade mark, the first respondent was entitled to seek, obtain and maintain registration thereof, and the petitioner is not entitled to the relief of rectification merely on the



basis that a translation of the impugned trade marks, which were registered in the Tamil and Telugu languages, was not provided. The said contravention is not of sufficient gravity to warrant rectification entirely on that basis because, on that sole ground, it cannot be concluded that the entry relating to the impugned trade marks was either made without sufficient cause or that such entry wrongly remains on the register.

23. For reasons set out above, both these rectification petitions are dismissed without any order as to costs.

07.02.2024

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SENTHILKUMAR RAMAMOORTHY J.

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