



W.P.No.12314 of 2021

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON : 01.08.2024

PRONOUNCED ON : 14.10.2024

CORAM

THE HONOURABLE **DR. JUSTICE ANITA SUMANTH**

WP.No.12314 of 2021

and

W.M.P.Nos. 13099 & 21916 of 2021 & 14515 of 2022

M/s.Shaktiman Equipments Private Limited
Rep. by its Director Mr.R.Sundarakrishnan
Flat No.78-B 1st Floor,
Geaso Housing Colony 1st Main Road,
Ayanambakkam Chennai.

... Petitioner

Vs.

- 1.Union of India,
Rep by its Secretary,
Ministry of Corporate Affairs,
5th Floor A Wing Shastri Bhawan,
New Delhi- 110 001.
- 2.The Regional Director / Southern Region,
Ministry of Corporate Affairs
5th Floor Shastri Bhawan,
26 Haddows Road,
Chennai- 600 006.
- 3.M/s.Tirth Agro Technology Private Limited
Shaktiman, Survey No.108/1,
Plot No.B NH-27, Nr.Bharudi Toll Plaza



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Bhunava (Village), Gondal Rajkot,
Gujarat- 360 311.

... Respondents

PRAYER: Writ Petition filed under Article 226 of the Constitution of India praying to issue a Writ of Certiorari, to call for the entire records of the order of the 2nd respondent in his order CA.No.11/ Sec.16/RD (SR) / 2020- 21 dated 09.04.2021 and to quash the same as being illegal and unsustainable in law.

For Petitioner : Mrs.N.Kavitha Rameshwar

For Respondents : Mr.T.L.Thirumalaisamy (for R1 & R2)
Central Government Standing Counsel

Mr.Navod Prasannan
For M/s.Giria Laws (for R3)

ORDER

The petitioner had challenged an order dated 09.04.2021 of R2 being the Regional Director, Ministry of Corporate Affairs, directing it to change its name within three months from that date.

2. One M/s.Tirth Agro Technology Private Limited (R3) had approached R2 with a petition under Section 16 of the Companies Act, 2013 (Act) for rectification of the name of the petitioner. The petition has come to be accepted on the ground that the trademark of the petitioner (Shaktiman) is identical to the trademark of R3 and hence seeking a direction to the petitioner to change its name.



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3. Before R2, the arguments of R3, as reiterated before me, were that R3 was incorporated as a private limited company on 26.07.2000. It is engaged in the manufacture of machinery, plant, equipment, tools and implements for the agricultural industry. It is the registered owner of the trademark 'Shaktiman' for various classes of products under the Trademarks Act, 1999 ('in short, 'TM Act'). In all, it holds the trademark 'Shaktiman' both as a word mark as well as a label mark for various classes of goods as follows:-

<i>Trademark No.</i>	<i>Trademark Name</i>	<i>Class</i>	<i>Status</i>
209541	Shakthiman	7	Registered
990334	Shakthiman	7	Registered
1419724	Shakthiman	7	Registered
2277146	Shaktiman Label	1	Registered
2277149	Shaktiman Label	2	Registered
2277150	Shaktiman Label	3	Registered
2277151	Shaktiman Label	4	Registered
2277152	Shaktiman Label	5	Registered
2277153	Shaktiman Label	6	Registered
2277155	Shaktiman Label	8	Registered
2277156	Shaktiman Label	9	Registered
2277157	Shaktiman Label	10	Registered
2277158	Shaktiman Label	11	Registered
2277160	Shaktiman Label	13	Registered
2277162	Shaktiman Label	15	Registered
2277163	Shaktiman Label	16	Registered
2277164	Shaktiman Label	17	Registered
2277165	Shaktiman Label	18	Registered
2277166	Shaktiman Label	19	Registered
2277167	Shaktiman Label	20	Registered
2277169	Shaktiman Label	22	Registered
2277170	Shaktiman Label	23	Registered
2277171	Shaktiman Label	24	Registered
2277172	Shaktiman Label	25	Registered
2277173	Shaktiman Label	26	Registered
2277174	Shaktiman Label	27	Registered



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2277175	Shaktiman Label	28	Registered
2277176	Shaktiman Label	29	Registered
2277177	Shaktiman Label	30	Registered
2277179	Shaktiman Label	32	Registered
2277180	Shaktiman Label	33	Registered
2277181	Shaktiman Label	34	Registered
2277182	Shaktiman Label	35	Registered
2277183	Shaktiman Label	36	Registered
2277184	Shaktiman Label	37	Registered
3276155	Shakthiman Supreme	7	Registered
3857624	Shakthiman Bale Master 150	7	Registered
3857627	Shaktiman Paddy Master 3776	7	Registered
4007957	Shaktiman Cotton Master 8037	7	Registered

4. In addition, R3 has also been using the mark ‘Shaktiman’ abroad, having registered it as a word mark and trademark in several countries, including USA, Vietnam, Philippines, South Africa, Israel and China. It has been using the marks from 1961 and has established a reputation with such use, garnering significant goodwill.

5. Moreover, having used the mark over six decades, the trademark ‘Shaktiman’ has acquired a secondary meaning in the agricultural industry associated with R3. The turnover of R3 from the year 2011–12 to 2019–20 had expanded from a sum of Rs.447.75 crores to Rs.777.53 crores and its turnover till October 2020 is a sum of Rs.829.81 crores.

6. While so, the petitioner, which was incorporated in 2012, had also commenced use of the trademark ‘Shaktiman’. According to R3, such usage



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was in contravention of Rule 8A(1)(d) of the Companies (Incorporation) Rules, 2014 ('Rules'). R3 had issued cease and desist notices to the petitioner as well as other parties, who had also been using identical / deceptively similar trade names. In some cases, civil courts had been approached seeking redressal and in the case of the petitioner, R3 had approached R2 seeking rectification of trademark used by the petitioner.

7. Before R2, the petitioner had submitted that the company was incorporated for the business of manufacturing and trade in generators, diesel engine and spare parts and export and import of generators, diesel engines and spare parts. It is also engaged in carrying out technical reviews and assessments of environmental friendly and energy efficient products as well as other products relevant to the building industry.

8. According to the respondent, it has carried out due diligence at the time of adoption of the name 'Shaktiman' finding that there was no other registered company carrying on a business similar to its own business using such a brand name. It was hence a bonafide user of the corporate name 'Shaktiman'. The petitioner has argued that it had 25 years of experience in the business and had acquired significant goodwill and reputation of its own. It is an admitted fact that its application for registration of the trademark / trade



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name, 'Shaktiman' were pending registration before the Registrar of Trademarks, with opposition from various third parties, including the petitioner,.

9. The petitioner further argued that 'Shaktiman' was a composite mark containing a name, a device as well as other features and hence there could be no right claimed in respect of any one component of a composite mark. In addition, the petitioner pointed out that the mark 'Shaktiman' was used by several entities, some of them claiming use, from even prior to that of R3. That apart, R3 had not made any application to register the term 'Shaktiman' as a well-known mark and hence cannot claim exclusive right over the same. The petitioner denied the allegations of piggy-backing on the reputation and goodwill of R3.

10. After detailed hearing, R2 accepted the application concluding that R3 had established prior use of the mark from 1961 onwards. The authority held that use of the same mark by the petitioner would be contrary to the dictat of Section 16(1)(d) of the Act as well as Rule 8(2)(ii) of the Rules. Thus, there was a direction to the petitioner to change its name within three months from date of order, as against which, the present writ petition has been filed.



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11. The petitioner relies on the case of *Prof.D.Aravindakshan Edayineth v. Union of India and others* [WP(C)No.4134 of 2014, decision dated 05.06.2016]. R3 relies on the following cases:

- (i) *Kothari Products Ltd. v. Registrar of Companies and others* (2000 SCC OnLine All 1073)
- (ii) *Simplilearn Solutions Private Limited v. Simplilearn Education Consulting Private Limited* (MANU/DEOR/45103/2022)
- (iii) *Prof.D.Aravindakshan Edayineth v. Union of India and Others* (2015 SCC OnLine Ker 16657)
- (iv) *CGMP Pharmaplan Pvt. Ltd. v. Regional Director, Ministry of Corporate Affairs and Ors.* (MANU/DE/2116/2010)
- (v) *Surya Elevators and Escalators India Private Limited v. Union of India and others* (MANU/KA/2353/2012)
- (vi) *Vardhaman Crop. Nutrients Private Limited v. Union of India and Others* (MANU/PH/1215/2015)
- (vii) *Intelgain Technologies Pvt. Ltd. v. Regional Director, Western Region, Ministries of Corporate Affairs and Others* (MANU/MH/1405/2013)
- (viii) *Kilburn Electricals Ltd. and Others v. Regional Director, Company Law Board and Others* (MANU/TN/0279/1999)
- (ix) *Lavasa Corporation Ltd. v. Lavasa Visuals Private Limited* (MANU/MH/2185/2013)
- (x) *Lords Insulations India Private Limited v. The Regional Director, Department of Company Affairs and Others* (MANU/TN/0954/2004)
- (xi) *Mindtree Limited and Others v. The Regional Director, Northern Region, Ministry of Corporation Affairs and Others* (MANU/PH/3731/2014)



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(xii) *Mondelez Foods Private Limited v. The Regional Director (North), Ministry of Corporate Affairs & Others* (2017 DHC 3382)

(xiii) *Montari Overseas Limited v. Montari Industries Limited* (MANU/DE/0513/1995)

(xiv) *Raymond Pharmaceuticals Pvt. Ltd. v. Union of India and Others* (2022 (6) Bom CR6)

12. Heard Mrs.N.Kavitha Rameshwar, learned counsel appearing for the petitioner, Mr.T.L.Thirumalaisamy, learned Central Government Standing Counsel for R1 & R2 and Mr.Navod Prasannan, learned counsel for M/s.Kria Law for R3.

13. The facts are more or less admitted. The petitioner was incorporated on 02.11.2012 under the name and style of 'Pioneer Generators Private Limited' and it was only on 06.09.2019 that it had changed its name from 'Pioneer Generators Private Limited' to 'Shaktiman Equipments Private Limited'. The petitioner has applied for registration of the name 'Shaktiman' under Clauses 7 and 37 for various products and services. On the other hand, R3 has been in business since the year 1961 and has been using the term 'Shaktiman' consistently since 2001.

14. Undoubtedly, the businesses of the petitioner and R3 are different and they deal with different categories of products and goods. The mark used by R3 is stated to be a corporate name and trade mark and since the petitioner



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is engaged in manufacturing of heavy machinery, it has been pointed out that the description of 'Shaktiman', being of a strong individual, as well as the term 'Shaktiman', itself meaning 'strong man', is more appropriate for its business.

15. The first argument of R3 turns on the aspect of prior use, which in the considered opinion of the Court, is well founded. There is no dispute on the position that R3 has been using the term 'Shaktiman' since 2001 consistently and has established a market for its product under that brand name.

16. In *MindTree Limited and others* (supra) a challenge was laid to the use of the name 'MindTree Eduvation Private Limited' as being identical with, or nearly resembling the registered trademark 'MindTree Limited'. The defence taken was that the one additional word, namely, Eduvation, made all the difference. The Punjab and Haryana High Court considered the challenge in the backdrop of Sections 20 and 22 of the Companies Act, 1956, Section 20 dealing with 'Companies not to be registered with undesirable name' and Section 22 dealing with rectification of name.

17. The Court held that Sections 20 and 22 would have to be read co-terminus and that the authority had erred in seeing a difference merely by reason of the fact that the word 'MindTree' was suffixed with the word



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Eduvation. The authority was hence directed to rectify the name of the Company dropping the name 'MindTree'.

18. In the case of *Mondelez Fruits*, the party had sought a registration of the name 'Mondelez' which was a distinctive part of the names of both the parties. A representation made to the authority had been rejected for the reason that the applicant was not the owner of the trade name 'mondelez' and since the authority was of the view that the jurisdiction to issue directions under Section 22(1)(i) of the Act had expired on 10.09.2013.

19. That respondent had defended the choice of the name 'Mondelez' stating that the Directors considered that name to be lucky for business transactions. The authority rejected the application and as against the order of rejection, a writ petition had been filed which came to be allowed by the Delhi High Court noticing that the word used by both parties, that is, 'mondelez', was identical, and the authority would hence have the jurisdiction to direct the respondent to change the name.

20. In *Montari Overseas Limited*, the learned Single Judge had, pending suit, enjoined the defendant from using the term 'Montari' or any other word similar thereto, as part of its corporate name. In appeal against the interim order, the Division Bench upheld the order of the learned Single Judge noticing



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the identity between the term 'Montari' used by both parties and holding that adoption of a similar trade name was likely to result in appropriation of the reputation and goodwill of the defendant.

21. In *Raymond Pharmaceuticals Private Limited*, a case decided by a learned Judge of this Court, the tussle was in respect of the word 'Raymond'. The applicant had sought rectification under Section 22 of the Act for change of name on the ground that the word/name 'Raymond' was identical with its own trade name. The application had been allowed as against which the writ petition was filed.

22. The settled position is thus two-fold, firstly, that a right to a name/mark vests in a prior user of that name/mark and secondly, that similarity/identity of a name/mark would be a bar against adoption of that name/mark by a subsequent user. On both counts, the petitioner fails as R3 has established usage of the name 'Shaktiman' since 2001 long prior to the petitioner adopting the same name.

23. Apart from the identity in name, one of the issues raised related to the interplay between Section 29 of the Trade Marks Act qua the registered trade mark and Section 22 of the Companies Act dealing with rectification of names. Nothing turns on this argument as, while the remedy for infringement of trade



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mark under Section 29 is a suit for infringement, the remedy for rectification of name is under Section 22. The two remedies operate in different fields and there is no quarrel in regard to this proposition.

24. Section 9 of the Act sets out certain grounds that operate as absolute bars for refusal of registration and one such bar, in terms of Section 9(2)(a) relates to confusion that may be caused by virtue of registration of the same mark by another entity. R3 has argued that since the word 'Shaktiman' is identical to its word mark, it would cause confusion in the minds of the public.

25. The defence of the petitioner is that 'Shaktiman' is a descriptive word and there could hence be no confusion seeing as the products dealt with by the two companies are entirely different and distinct. To illustrate the differences in the product dealt with by them, the petitioner would rely on the trade mark classification of goods, where Clause 7 relates to various machines including agricultural implements other than hand operated implements, and Section 37 deals with building construction and installation services.

26. Before addressing this point, I extract Rule 8(2)(a)(ii) that reads as follows:

'8. Undesirable names.-

(2) (a) The name shall be considered undesirable, if -



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(i)

(ii) *it includes the name of a registered trade mark or a trade mark which is subject of an application for registration, unless the consent of the owner or applicant for registration, of the trade mark, as the case may be, has been obtained and produced by the promoters'*

27. On a careful perusal of both Section 22 and Rule 8(2)(a)(ii), I find no exception carved out permitting the use of identical names even if the business/products to which such name relates, were to be different. Hence, similarity beyond acceptable limits or identity in name, is a bar across trades and businesses and there is no merit in the argument that the same brand/trade name may be used by entities engaged in different trades or dealing in different products.

28. Admittedly, R3 has registered the word 'Shaktiman' under Clauses 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 13, 15, 16, 17, 18, 19, 20, 22, 23, 24, 25, 26, 27, 28, 29, 30, 32, 33, 34 and 35 and has also been using the term continuously since 2001. Rule 8 as above, categorically stipulates that the use of a registered trade mark by any other person is undesirable.

29. Reliance by the petitioner on a decision of the Kerala High Court in the case of *Prof.D.Aravindakshan Edayineth* (supra) is misconceived. The petitioner and the respondents in that matter, both claimed rights to the name



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'Agastya Bio Limited'. The learned Judge holds in conclusion that the two names are identical and hence the attempt of that petitioner to register a company with the identical name of 'Agastya Bio-Tech Limited' was unacceptable. This case supports the arguments of R3 rather than the petitioner.

30. In light of the detailed reasoning as above, this writ petition is dismissed and the impugned order of R2 dated 09.04.2021, is confirmed.

14.10.2024

Index : Yes
Speaking Order
Neutral citation : Yes
vs

To

- 1.The Secretary,
Ministry of Corporate Affairs,
5th Floor A Wing Shastri Bhawan,
New Delhi- 110 001.
- 2.The Regional Director / Southern Region,
Ministry of Corporate Affairs
5th Floor Shastri Bhawan,
26 Haddows Road,
Chennai- 600 006.



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DR.ANITA SUMANTH,J.

VS

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W.M.P.Nos. 13099 & 21916 of 2021 & 14515 of 2022

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