



IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 21.11.2024

Pronounced on : 28.11.2024

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

(T) OP (TM) No.139 of 2023

Mankind Pharma Limited,
Okhla Industrial Estate,
Phase-III, New Delhi – 110 020.

.. Petitioner

vs.

1.Micor Labs Limited,
A-Wing, Queens Road (opp.Indian Express),
Bangalore – 560 001.

2.The Registrar of Trade Marks,
Trade Marks Registry,
Chennai. \

.. Respondents

Prayer: This petition is filed under Sections 57/125 of the Trade Marks Act, 1999, seeking to remove the entry made in respect of trademark number 955510 of September 13, 2000, for the mark 'DOLOBENE' in class 05 from the Register.

For Petitioner : Mr.Hemant Daswani
for M/s.Daswani and Daswani

For R1 : Mr.T.Sai Krishnan
For R2 : Mr.S.Janarthanam, SPCGSC



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ORDER

This petition has been filed under Section 57 of Trade Marks Act, 1999 (in short “the Act”) seeking to rectify the Trade Mark registration obtained by the 1st respondent in respect of the Trade Mark 'DOLOBENE'. According to the petitioner, the said Trade Mark 'DOLOBENE' is deceptively similar to that of the applicant's trade mark 'DOLOBAN'.

2.The following are the undisputed facts:

a)The petitioner and the 1st respondent are both Pharmaceutical Companies. The petitioner obtained Trade Mark Registration for its mark 'DOLOBAN' in the year 1994 and while obtaining registration, the petitioner had disclosed that they have been using the mark 'DOLOBAN' from the year 1993.

b)The registration of the petitioner's mark 'DOLOBAN' under the Trade Marks Act got expired on 03.02.2004. The petitioner did not renew the registration for a further period under the Trade Marks Act, 1999.

c)The 1st respondent who is also in the pharmaceutical business of manufacturing pharmaceutical products obtained Trade Mark Registration for its Trade Mark 'DOLOBENE' in the year 2004. While applying for Trade Mark Registration for 'DOLOBENE' in their application, they had disclosed that they



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have been using the said Trade Mark since the year 2000.

d)The petitioner in the year 2007 filed a fresh Trade Mark application for its Trade Mark 'DOLOBAN'. In the fresh application, the petitioner had claimed once again that they have been using the mark 'DOLOBAN' since 01.04.1993.

e)An opposition petition was filed by the 1st respondent before the Trade Marks Registry opposing the grant of registration for the petitioner's mark 'DOLOBAN'. The said opposition petition is still pending.

f)The petitioner has not raised any dispute with regard to the usage of other 'DOLO' series of marks by the 1st respondent, but restricts its opposition/objection only to the usage of the Trade Mark 'DOLOBENE' by the 1st respondent.

3.The learned counsel for the petitioner would submit that the petitioner is a prior user of the Trade Mark 'DOLOBAN' as the petitioner has been using the said Trade Mark from 1993 onwards, whereas, the 1st respondent even as per its own application seeking for registration of their trade mark claims that they have been using the Trade Mark only from the year 2000. Therefore, according to the learned counsel for the petitioner, the petitioner, as a prior user of the Trade Mark and due to the petitioner's contention that the 1st respondent's Trade Mark is deceptively similar to that of the petitioner's Trade Mark, the petitioner is entitled to seek for rectification/cancellation of the 1st respondent's Trade Mark as per the provisions



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of Section 57 of the Trade Marks Act, 1999.

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4.The learned counsel for the petitioner would also submit that since the petitioner and the 1st respondent are both in the Pharmaceutical business and the Trade Marks which are the subject matter of dispute are being used in the pharmaceutical industry, the usage of the Trade Mark 'DOLOBENE' by the 1st respondent will cause confusion in the minds of the consumers and therefore, the Trade Mark Registration obtained by the 1st respondent for the Trade Mark 'DOLOBENE' has to be cancelled under Section 57 of the Trade Marks Act.

5.The learned counsel for the petitioner also drew the attention of this Court to the opposition petition filed by the 1st respondent to the second Trade Mark Registration application submitted by the petitioner in the year 2007 and would submit that the 1st respondent has admitted that there is deceptive similarity between the petitioner's Trade Mark and the 1st respondent's Trade Mark and therefore, having admitted deceptive similarity, the question of seeking for Trade Mark registration by the 1st respondent for its Trade Mark 'DOLOBENE' does not arise. According to him, the Trade Marks Registry has arbitrarily and by total non-application of mind granted registration for the 1st respondent's Trade Mark 'DOLOBENE' and therefore, necessarily it has to be cancelled by this Court.



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6.The learned counsel for the petitioner would submit that the 1st respondent cannot approbate and reprobate and take inconsistent stands. According to him, the 1st respondent has taken inconsistent stands viz., one before the Trade Marks Registry and the other before this Court in the counter filed by them to this petition.

7.The learned counsel for the petitioner also drew the attention of this Court to the various invoices filed by the petitioner before this Court to establish that the petitioner has been using the Trade Mark 'DOLOBAN' continuously ever since 1993. He would also submit that the said invoices are genuine invoices. According to the learned counsel for the applicant, since no oral evidence has been let in by the 1st respondent disputing those invoices, the same are deemed to be genuine ones. He would also submit that the petitioner is the fifth largest Pharmaceutical Company as of today in India.

8.On the other hand, the learned counsel for the 1st respondent would submit that the improper conduct of the petitioner is required to be looked into while adjudicating this petition. He would submit that the Trade Mark Registration in respect of the 1st respondent's Trade Mark was obtained in the year 2000 itself,



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whereas, this application seeking for rectification under Section 57 of the Trade Marks Act was filed before the IPAB only in the year 2014, after a lapse of almost 14 years from the date of registration of the 1st respondent's Trade Mark.

9.The learned counsel for the 1st respondent would also submit that on the ground of acquiescence and delay as per the provisions of Section 33 of the Trade Marks Act, the question of entertaining this application does not arise. He would submit that since this petition has been filed after an inordinate delay of fourteen years from the date of the registration of the 1st respondent's Trade Mark, it is hit by Section 33 of the Trade Marks Act, 1999. According to him, the petitioner who is also in the pharmaceutical business is aware of the usage of the Trade Mark 'DOLOBENE' by the 1st respondent. Therefore, according to him, they are statutorily barred from filing an application under Section 57 of the Trade Marks Act, 1999, on the ground that they have not filed their rectification application within a period of five years from the date of registration of the 1st respondent's Trade Mark.

10.The learned counsel for the 1st respondent would also submit that the petition filed under Section 57 of the Trade Marks Act by the applicant is not maintainable as it does not satisfy the requirements stipulated therein. According



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to him, as per Section 57 of the Act, the petitioner must satisfy that the registration has been obtained on the ground of any contravention or failure to observe a condition entered in the register in relation thereto. According to him, the petitioner has not satisfied any of the conditions as prescribed under Section 57 of the Trade Marks Act and therefore, this petition should not be entertained by this Court.

11.However, on the contrary, the learned counsel for the petitioner would rely upon Section 57(2) of the Trade Marks Act, 1999 and would submit that if sufficient cause is shown for filing an application under Section 57 of the Trade Marks Act, this application filed by the applicant can be entertained by this Court.

12.Insofar as the 'DOLO 650' registration obtained by the 1st respondent is concerned, the learned counsel for the 1st respondent while referring to the counter affidavit filed by the 1st respondent in this petition would submit that a categorical assertion has been made by the 1st respondent that they have been using the Trade Mark 'DOLO 650' for their pharmaceutical product ever since 1986, though they had obtained Trade Mark registration in the year 1987.



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13.The learned counsel for the 1st respondent drew the attention of this Court to the annexures filed along with the counter affidavit and would submit that as seen from the said annexures, the 1st respondent has obtained Trade Mark registration for 'DOLO' series which includes ten marks. He would submit that since the word 'DOLO' has attained distinctiveness, the 1st respondent has exclusive right to use the 'DOLO' series of Trade Marks.

14.By way of reply to the submission made by the learned counsel for the 1st respondent as referred *supra*, the learned counsel for the petitioner would submit as follows:

a)No plea was taken by the 1st respondent in its counter affidavit that there was acquiescence and delay on the part of the petitioner for the usage of the Trade Mark 'DOLOBENE' by the 1st respondent. Therefore, the question of raising that issue during the course of the arguments by the 1st respondent's counsel cannot be entertained by this Court. He would submit that only if such a plea was taken in the counter affidavit, the petitioner would have been put on notice about the said defence and there would have been a necessity for the petitioner to rebut the same. Since such a plea was not taken, there is no necessity for the petitioner to rebut the plea of acquiescence and delay taken for the first time during the course of the



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submission made by the learned counsel for the 1st respondent before this Court today.

b) Similarly, the learned counsel for the petitioner would further submit that the submission that the petitioner had slept over its rights is a submission made for the first time before this Court without any plea having been taken in the counter affidavit filed by the 1st respondent before this Court.

c) The learned counsel for the petitioner would further submit that as per Section 57(2) of the Trade Marks Act, 1999, this Court is having the power to adjudicate with regard to deceptive similarity between two Trade Marks and therefore, there is no statutory bar for this Court to allow this petition as prayed for by the petitioner.

15. The learned counsel for the petitioner drew the attention of this Court to the following authorities in support of his contentions:

- a) **Cadila Health Card Ltd vs. Cadila Pharmaceuticals** reported in (2001) 5 SCC 73.
- b) **Dart Industries Inc vs. Cello Plastotech** reported in 2017 SCC Online Mad 1851.
- c) **Zino Davidoff SA vs. Mahendra Kumar** reported in 2011 SCC Online Kar 125.
- d) **Sun Pharmaceutical Industries vs. DWD Pharmaceuticals** reported in 2022 SCC Online Del 4015.



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16. In support of the submissions made by the learned counsel for the 1st respondent, he relied upon the following authorities:

- a) **Khoday Distilleries Limited (Now known as Khoday India Limited) vs. Scotch Whisky Association and Others** reported in **(2008) 10 SCC 723** and
- b) The Division Bench judgment of this Court dated 16.02.2012, in the case of **Rhizome Distilleries Pvt., Ltd., vs. Union of India and others** reported in **2012 2 LW 204**.

DISCUSSION:

17. This Court for the purpose of adjudicating this rectification petition filed under Section 57 of the TM Act, framed the following issues on 03.04.2024:-

- (i) Whether the mark of the registered proprietor DOLOBENE is similar to the prior adopted mark of the Petitioner's DOLOBAN?
- (ii) Whether the registration granted to the registered proprietor is against the provisions of Section 57 of the Trade



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Marks Act, 1999 and thus liable to be cancelled?

(iii) Whether the allegation of infringement is attracted against the registered proprietors?

(iv) Whether the rectification applicant had prior usage over the mark “Doloban” over the registered proprietor's mark of “Dolobene”?

18. In the era of globalization, it has become increasingly common for infringers to device similar/identical trademarks to ride upon the goodwill and reputation, which has been painstakingly built by registered proprietors. A registered proprietor of a trademark is required to remain cautious with respect to misuse of his or her trademark by others, failing which, the registered proprietor may be disentitled from taking any legal action against the alleged offenders. Such disentanglement, referred to as ‘acquiescence’, therefore, is a concept that every trademark owner must know and understand.

19. Acquiescence has been defined under Section 33 of the Trade Marks Act, 1999, and from the said provision, the following proposition can be culled out:-



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(a) Where the proprietor of the earlier trademark has acquiesced for a continuous period of 5 years in the use of a registered trademark, being aware of that use, he shall no longer be entitled on the basis of that earlier trademark --

(a) to apply for a declaration that the registration of the later trademark is invalid, or

(b) to oppose the use of the later trademark in relation to the goods or services in relation to which it has been used, unless the registration of the later trademark was not applied in good faith.

20. In order to successfully establish the defence of acquiescence, the proprietor of the later trademark will be required to establish the following;

(a) that the proprietor of the earlier trade mark had prior knowledge of the use of the later trade mark; and

(b) that the proprietor of the earlier trade mark encouraged that course of action, either by statements or conduct.

21. The term 'encouragement' here may include inaction on part of the proprietor of the earlier trade mark to send any legal notice to the proprietor of the



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later trade mark expressing objection towards such use of a similar trade mark or filing of an opposition/rectification before the Trade Marks Registry objecting registration of such trade mark. The proprietor of later trade mark, thus, must show that despite the knowledge of such use of the later mark, the proprietor of earlier trade mark chose not to take any action against the proprietor of the later mark for more than 5 years and such inaction by the proprietor of the earlier trade mark encouraged the proprietor of the later trade mark to continue use of such mark.

22. It is well settled law as laid down by various decisions of the Constitutional Courts that when a suit for infringement/passing off is instituted before a Court of law, the burden of proof towards availing the defense of acquiescence lies on the defendant. In addition, the defendant may also be required to prove that the adoption and use of the later trade mark has been made in good faith and the defendant had no intention to ride upon the goodwill and reputation associated with the earlier trade mark.

23. The Hon'ble Supreme Court in the case of ***Power Control Appliances Vs. Sumeet Machines Pvt. Ltd. [1994 SCC (2) 448]*** held that “Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a



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course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name etc. It implies positive acts; not merely silence or inaction such as is involved in laches.”

24. Further, the Hon'ble Supreme Court in the case of ***Ramdev Food Products (P) Ltd. Vs. Arvindbhai Rambhai Patel and others [2006 (8) SCC 726]*** held that “Acquiescence is a facet of delay. The principle of acquiescence would apply where: (i) sitting by or allowing another to invade the rights and spending money on it; (ii) it is a course of conduct inconsistent with the claim for exclusive rights for trade mark, trade name, etc.”

25. The Hon'ble Supreme Court has clarified in the aforesaid decisions that acquiescence is a form of delay where the proprietor of an earlier trademark allows the proprietor of the later mark to build its mark over the course of time by spending money, time, and effort without asserting its exclusive rights associated with it and such conduct could also be implied by positive acts.

26. The law relating to acquiescence as provided under Section 33 of the Trade Marks Act, 1999, serves to safeguard and protect the rights of a trademark user who has invested time, money, and effort in developing a business and a



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brand in good faith and without the knowledge that the mark is similar to that of an earlier registered mark. The law of acquiescence thus prevents the later user from any injustice that may be caused upon the user by taking away the proprietary rights in the trademark being used for more than five years. The law requires the registered proprietors to be vigilant towards the misuse of their registered trade mark and to take timely action against such misuse or attempts to register a similar mark. It is to be kept in mind that where the intention towards the adoption and use of the trade mark by the later user is genuine and made in good faith, the use of such trade mark by the later user cannot be restrained by the registered proprietor.

27. A trademark is considered abandoned when owner no longer actively uses it and this means that the owner has given up the right over the trademark and it can be used or registered by any third party. Some reasons for abandonment of a trademark are;

- (a) missing the renewal deadline;
- (b) not complying with the statutory timeline;
- (c) voluntarily withdrawing the trademark;
- (d) failing to meet regulatory requirements, such as, office requirement;
- (e) a trademark is presumed abandoned if it has not been used for three



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consecutive years;

(f) the owner has to prove that the trademark was in use or that they intended to resume use, but, the burden is on them; and

(g) if a trademark is abandoned due to non-renewal, the owner can file an application for restoration within one year; and after that, they must file a new application for the trademark.

28. The trademark renewal is governed by Section 25 of the Act. Though Section 25 deals with duration, renewal, removal and restoration of trademark registration, it establishes the legal framework for ensuring the validity of registered trademarks and the corresponding trademark rules specify the procedure for renewal. Section 25 of the Act reads as follows:-

25. Duration, renewal, removal and restoration of registration.

(1) The registration of a trade mark, after the commencement of this Act, shall be for a period of ten years, but may be renewed from time to time in accordance with the provisions of this section.

(2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period and subject to payment of the prescribed fee, renew the



registration of the trade mark for a period of ten years from the date of expiration of the original registration or of the last renewal of registration, as the case may be (which date is in this section referred to as the expiration of the last registration).

(3) At the prescribed time before the expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with the Registrar may remove the trade mark from the register:

Provided that the Registrar shall not remove the trade mark from the register if an application is made in the prescribed form and the prescribed fee and surcharge is paid within six months from the expiration of the last registration of the trade mark and shall renew the registration of the trade mark for a period of ten years under sub-section (2).

(4) Where a trade mark has been removed from the register for non-payment of the prescribed fee, the Registrar shall, after six months and within one year from the expiration of the last registration of the trade mark, on receipt of an application in the prescribed form and on payment of the prescribed fee, if satisfied that it



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is just so to do, restore the trade mark to the register and renew the registration of the trade mark either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of ten years from the expiration of the last registration.

29. Under Section 25(1) of the Act, the registration of a trade mark shall be for a period of ten years. This period begins from the date of application or the last renewal of registration, whichever is applicable. Therefore, the trademark owners must ensure that their trademarks are renewed periodically.

30. A trademark renewal is essential to ensure the continued protection and ownership of a trademark and intellectual property rights. Failure to renew a trademark can have significant implications for businesses, including:

Loss of statutory protection: If a trademark registration is not renewed, it may be removed from the register by the Registrar of trademarks. This could result in the loss of statutory protection and exclusive rights associated with the trademark, leaving the mark vulnerable to exploitation by competitors.

Loss of right to sue for infringement: Without a valid trademark registration, businesses may face challenges in enforcing their rights against unauthorised use of their trademark. Renewal helps maintain the legal presumption of title and



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ownership, strengthening the trademark's position in case of a dispute or litigation.

Impact on reputation: A lapsed trademark registration could undermine the credibility and reputation of a trademark, leading to loss of trust among consumers. Renewal demonstrates a commitment to maintaining the integrity and authenticity of the trademark, enhancing its value and recognition in the marketplace.

31. The consequences of failing to renew a trademark extend beyond mere removal from the register. The loss of registration status entails the forfeiture of statutory rights conferred upon registered trademark owners. Without a valid registration, the owner relinquishes the exclusive right to use the mark in connection with the designated goods or services, as well as the ability to enforce trademark rights against infringers through infringement action. Moreover, the absence of registration makes it more difficult for owners to assert ownership and protect their rights effectively.

32. This Court, after analyzing the relevant provisions of Trade Marks Act, 1999, required for the purpose of adjudicating the case on hand, is now going to discuss the merits of this rectification petition filed under Section 57 of the Act.



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33. As seen from the undisputed facts, which have been recorded by this Court in the opening paragraphs of this order, the petitioner is not entitled to seek for rectification of the first respondent's trademark 'DOLOBENE' for the following reasons:-

(a) The petitioner cannot claim to be a prior user and cannot avail the benefit of Section 34 of the Act, which deals with the rights of a prior user of a trademark, as the trademark in question must be in continuous use to statutorily claim the benefit of prior user. In the case on hand, the first respondent has disputed that the petitioner has been in continuous use of the trademark 'DOLOBAN'. Though certain invoices have been produced by the petitioner before this Court along with this petition for the purpose of establishing that the petitioner has been in continuous use of the trademark 'DOLOBAN', the said invoices, which are disputed by the first respondent, cannot be accepted by this Court without any oral evidence with regard to the genuineness of those invoices. The petitioner has also not chosen to let in any oral evidence for the purpose of proving that they are in continuous usage of the trademark 'DOLOBAN', despite the fact that they had not renewed the trademark registration for the trademark 'DOLOBAN', which got expired on 03.02.2004 itself. Unless and until oral evidence is let in by the petitioner in support of the invoices placed on record



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before this Court, the first respondent will not get an opportunity to cross-examine the petitioner's witness with regard to genuineness of the supporting invoices, as a categorical defence has been raised by the first respondent that the supporting invoices produced by the petitioner are not genuine ones. Excepting for producing the so-called invoices, there are no other documents produced by the petitioner before this Court in the form of income tax returns, bank statement and other statutory records to prove that the petitioner has been continuously using the trademark 'DOLOBAN', despite the fact that the trademark registration in respect of the said mark got expired as early as on 03.02.2004 itself.

34. For adjudicating the case on hand, it is required for this Court to analyze Section 34 of the Trade Marks Act, 1999, which is extracted hereunder:-

34. Saving for vested rights.

Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior--

(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or



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(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his;

whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark.

35. Section 34 provides certain rights to the prior user of a mark in relation to goods or service sold/offered under the mark. Further, based on the said use of the mark by the prior user, any subsequent registered user of the registered trademark in relation to the identical/similar goods or services is not allowed to exercise its rights as conferred under Section 28 of the Act. Section 28 of the Act deals with rights of the registered proprietor. Section 34 of the Act acts as an exception to Section 28 of the Act. As per Section 28 of the Act, it is clear that the registered proprietor of a trademark will be vested with exclusive rights to use the trademark in relation to the goods or services, and stop other parties using the identical or similar mark being used in relation to the identical/similar goods or services. However, Section 34 of the Act, extracted supra, stands as an exception to the aforesaid exclusive rights of the registered proprietor and protects the rights of the prior user in a mark used in relation to the identical/similar goods or



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services as that of the registered proprietor. Section 34 provides that the rights of a prior user shall be protected under the Act from being violated by a registered user, i.e., the registered proprietor of an identical or deceptively similar mark granted registration for identical/similar goods or services. The rights of a prior user of the mark is thus kept on a higher pedestal than that of the registered proprietor of a trademark who was granted registration later. However, in order to claim protection under Section 34, the prior user needs to satisfy the following key requirements: -

- (a) the trademark must be ‘used’ by the owner to qualify as the prior user;
- (b) the trademark must be in continuous use within the geographical boundaries of India by its owner;
- (c) the use of the trademark must be in relation to the goods or services covered in the application by the registered proprietor; and
- (d) the trademark must be in use from a prior date as compared to the date of use by the subsequent user/ registered proprietor.

36. It is clear from Section 34 of the Act that ‘Use’ refers to the continuous use of a trademark in relation to the goods or services for which the trademark is applied. User date is the date from which the trademark is actually being used in trade with respect to the goods or services. Mere adoption, (creation of the mark



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for future use) is not enough to claim use/right over the mark.

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37. For coming to the conclusion that the user is a prior user, the following aspects have to be satisfied;

(a) date of adoption of the mark and when it was put to use;

(b) whether there is an actual sale of the applied goods/services under the trademark;

(c) relevance of the use of the trademark in relation to the non-sales activity, *inter-alia*, promotion/advertisement of the goods/services under the trademark, the samples of goods distributed under the mark for collecting the consumer/customer's feedback; and other similar activities which might establish whether the goods/service has actually been rendered in commerce under the trademark and known to the public.

38. A few examples of evidentiary documentation that can be used in establishing the use of the trademark in commerce are as follows:-

(a) Documents evidencing advertising expenditure vis-à-vis goods/services under the trademark;

(b) Sales turnover of goods/services under the trademark;

(c) Brochures, purchase orders, invoices for the sale/purchase of the



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goods/services under the trademark;

(d) Domain names and websites reflecting the use of the trademark vis-à-vis goods/services.

39. In the case on hand, excepting for production of invoices in respect of the alleged sales effected under the trademark 'DOLOBAN', which the first respondent has disputed its genuineness, the petitioner has not disclosed in the petition its sales turn over from the date of registration of its trademark 'DOLOBAN', i.e, from 1994, till the date of filing of this petition. The petitioner has also not disclosed in the petition its sales turnover in respect of the trademark 'DOLOBAN' from 03.02.2004, being the date of expiry of the petitioner's trademark 'DOLOBAN', till the date of filing of this petition. There are also no undisputed supporting documents produced by the petitioner to support their claim that they are in continuous usage of the trademark 'DOLOBAN', despite the trademark registration for the said mark having got expired on 03.02.2004 itself.

40. Admittedly, the first respondent is using the other DOLO series of trademarks and the details of the registrations obtained by them are set-out hereunder:-

<i>Sl.No.</i>	<i>Mark</i>	<i>Registration No.</i>
1.	Dolopar Plus	316583



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<i>Sl.No.</i>	<i>Mark</i>	<i>Registration No.</i>
2.	Dolo 650	481600
3.	Dolobak	440326
4.	Dolowin	453929
5.	Dolocold	670808
6.	Dolozox	772240
7.	Dolopar Gel	852460
8.	Dolo Suspension	973181
9.	Delokoff	1316608
10.	Doloprox	1261833

41. Admittedly, the petitioner does not have any objection for the aforesaid marks of the first respondent, but, has objected only to the usage of the trademark 'DOLOBENE' by the first respondent. According to the petitioner, being a prior user and the trademark 'DOLOBENE' being deceptively similar to the petitioner's trademark 'DOLOBAN', the first respondent is not legally entitled to use the trademark 'DOLOBENE'.

42. As highlighted above, the registered proprietor of a trademark is required to remain cautious with respect to misuse of his/her trademark by others, failing which, the registered proprietor may be disentitled from taking any legal action against the alleged offenders on the ground of acquiescence as defined under Section 33 of the Act. As per Section 33 of the Trade Marks Act, 1999, where the proprietor of an earlier trade mark has acquiesced for a continuous



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period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark —

(a) to apply for a declaration that the registration of the later trade mark is invalid, or;

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark was not applied in good faith.

43. In the case on hand, both the petitioner as well as the first respondent are leading pharmaceutical companies. Admittedly, both of them are manufacturing similar types of drugs. Both 'DOLOBAN' and 'DOLOBENE' are similar kinds of drugs. The first respondent has obtained registration for its trademark 'DOLOBENE' in the year 2004 itself. While applying for trademark registration for 'DOLOBENE', the first respondent had disclosed that they have been using the said trademark ever since 2000. The petitioner's trademark registration for its trademark 'DOLOBAN' got expired as early as 03.02.2004 itself and subsequently, it has got lapsed as the petitioner did not choose to renew the trademark registration within the statutory period as provided under the Trade Marks Act. Only in the year 2007, the petitioner applied for fresh trademark registration in



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respect of its very same trademark 'DOLOBAN'. Though they have claimed in their fresh trademark application that they have been using the trademark 'DOLOBAN' since 01.04.1993, as observed earlier, the documents produced by the petitioner before this Court are not sufficient to prove that they have been in continuous usage of the mark 'DOLOBAN' since 1993 onwards.

44. Intermittent prior use, as the name suggest, means that though the trademark was previously used, it was not used continuously. Intermittent use means occasional use of the trademark. A plain reading of Section 34 of the Act reveals that in order to invoke Section 34 of the Act and to establish right of a prior user, the prior use of the mark has to be continuous and it cannot be intermittent. As observed earlier, since there is no oral and documentary evidence let in by the petitioner for the purpose of proving that the petitioner is the prior user, the question of entertaining this petition does not arise. The first respondent has obtained registration of its trademark 'DOLOBENE' as early as in the year 2004 itself and while applying for the said trademark, the first respondent had also disclosed that they have been using the said trademark since 2000. However, surprisingly, this petition for rectification under Section 57 of the Act was filed only in the year 2014, i.e., after a lapse of 14 years from the date of registration of the first respondent's trademark 'DOLOBENE'. Having allowed the first



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respondent to use the said mark beyond 5 years, the statutory principle of acquiescence as adumbrated under Section 33 of the Act would apply and hence, the rectification petition filed by the petitioner is hit by Section 33 of the Act – acquiescence.

45. The distinctiveness of a trademark indicates an exceptional quality of being easily recognizable distinguishing a specific mark from the multitude of symbols and signs that are available in the market. It is a silent ambassador that speaks volumes about the brand's values, quality and promise. Distinctiveness in the realm of trademarks refers to the capacity of a mark to set a particular product or service apart from others in the market place. Distinctive trademark possesses the remarkable capacity to not only identify but also unequivocally distinguish the goods or services associated with one entity from the diverse array of products and services provided by others. What is meant by 'distinctive' is that when you see the name, your mind immediately refers to the person or company who sold or manufactured the article and to that one person or firm or company alone.

46. The distinctiveness of a trademark is determined on the basis of the following factors:

- (i) The strength of evidence of use.
- (ii) The extent to which competitors in the same trade



must use the trademark, and

- (iii) The extent to which the consumers of relevant goods or services may be in contact with the trademark.

47. Section 28 of the Act gives exclusive right to the use of the trademark to the registered proprietor, subject to other provisions of the Act. In the case on hand, the first respondent is the registered proprietor of a series of marks having prefix 'DOLO'. The first respondent has also produced the trademark registration certificate obtained by them for the trademark 'DOLO 650', which reveals that the first respondent is using the said trademark since 1986, and the registration of the said trademark dates back to the year 1987. The said fact is also not disputed by the petitioner. The first respondent has also filed its opposition to the registration of the petitioner's trademark 'DOLOBAN', when the petitioner, who had not renewed the earlier registration within the statutory period, applied for fresh registration in the year 2007 for its trademark 'DOLOBAN'. It is also to be noted that in the reply statement to the counter statement filed by the first respondent, the petitioner stated that they do not have any objection for the first respondent to use 'DOLO' series of marks, excepting for 'DOLOBENE'.

48. As seen from the pleadings averred in the rectification petition dated



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16.04.2014 filed by the petitioner, there is no whisper about the date of knowledge of the petitioner as regards the registration of the trademark 'DOLOBENE' in favour of the first respondent. Only through the written submission filed by the petitioner and during the course of arguments, it is sought to be projected for the first time as though the petitioner was not served with notice of opposition by the Registrar of Trademarks and as if they discovered the opposition from the website and filed their counter on 08.04.2013 to the said opposition. On the ground of inordinate delay of 14 long years in filing this rectification petition, which has not been properly explained, this petition has to be dismissed on the ground of delay and laches and on the ground of acquiescence by applying Section 33 of the Act.

49. This rectification petition has been filed by the petitioner on the ground that the first respondent is guilty of passing off, as, according to the petitioner, by using the trademark 'DOLOBENE', the first respondent is riding over the goodwill and reputation of the petitioner's trademark 'DOLOBAN', which, according to the petitioner, the trademarks 'DOLOBAN' and 'DOLOBENE' are deceptively similar marks, but, since the petitioner is the prior user of the trademark 'DOLOBAN', the first respondent is prohibited from using the trademark 'DOLOBENE' as per the provisions of Section 34 of the Act, which gives exclusive right to use the trademark if the proprietor is a prior user.



50. As highlighted above, Section 33 of the Act deals with acquiescence.

Having allowed the first respondent to use its trademark 'DOLOBENE' for almost 14 long years continuously, the question of cancelling the first respondent's trademark under Section 57 of the Act does not arise, since the statutory protection of acquiescence granted under Section 33 of the Act overrides the rights granted to a prior user under Section 34 of the Act. The petitioner has also voluntarily decided not to let in oral evidence in support of its contentions.

51. When the first respondent has already obtained trademark registration for its 'DOLO' series of marks as listed out in this order earlier and the petitioner has chosen to file this rectification petition only after a long lapse of 14 years from the date when the first respondent obtained registration for its trademark 'DOLOBENE', the question of entertaining this petition, without there being any iota of evidence with regard to the alleged statutory violation said to have been committed by the first respondent, does not arise.

52. In the case of *Khoday Distilleries Limited Vs. Scotch Whisky Association and others* [(2008) 10 SCC 723], though it was held that Article 137 of the Limitation Act, 1963, is not applicable to the rectification proceedings, but,



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the principles of acquiescence and/or waiver do apply. The case on hand is one such case where the rectification petition has been filed by the petitioner after 14 long years from the date when the first respondent obtained trademark registration for its trademark 'DOLOBENE'. Therefore, on the ground of acquiescence and/or waiver as per Section 33 of the Act, the instant petition is not maintainable.

53. In *Rhizone Distilleries Pvt. Ltd. Vs. Union of India and others [2012 (2) LW 204]*, the Division Bench of this Court has made it clear that a mark should not be dissected or split into its components parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. In the said decision, the Division Bench held that if the trademark of the petitioner therein, namely, 'RHIZOME'S IMPERIAL GOLD' is compared with the mark of the respondent therein, namely, 'IMPERIAL BLUE' without making any dissection or splitting up the word into several words, then it would not cause any confusion in the minds of the purchasers. In the case on hand also, the marks 'DOLOBAN' and 'DOLOBENE' cannot be dissected to find out whether there is deceptive similarity or not. In the case on hand, the first respondent has been using the marks having prefix 'DOLO' for a long number of years even prior to the usage of the trademark 'DOLOBAN' by the petitioner. Even according to the petitioner, the only drug sold and manufactured by them by using the prefix



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'DOLO' is 'DOLOBAN', whereas the first respondent is the manufacturer of several drugs and some of their trademarks having prefix 'DOLO' are in usage much prior to the usage by the petitioner in respect of its trademark 'DOLOBAN'. Therefore, the ratio laid down in *Rhizone Distilleries (cited supra)* protects the interest of the first respondent rather than the petitioner.

54. The decisions relied upon by the learned counsel for the petitioner, namely,

- (a) Cadila Health Card Ltd vs. Cadila Pharmaceuticals reported in (2001) 5 SCC 73;
- (b) Dart Industries Inc vs. Cello Plastotech reported in 2017 SCC Online Mad 1851;
- (c) Zino Davidoff SA vs. Mahendra Kumar reported in 2011 SCC Online Kar 125; and
- (d) Sun Pharmaceutical Industries vs. DWD Pharmaceuticals reported in 2022 SCC Online Del 4015.

have culled out the principles to satisfy for initiating passing off action. The case of the first respondent does not fall under any of those categories, which enables the petitioner to sue the first respondent for passing off.



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55. The contention of the learned counsel for the petitioner that without there being a plea of inordinate delay and acquiescence in the counter affidavit filed by the first respondent, this Court cannot decide this new defence raised by the first respondent in this rectification petition, has to be rejected for the following reasons:-

(a) This Court has discretion to take notice of the legal issue as well as the relevant laws, even if it is not pleaded by the parties.

(b) This Court is empowered to take notice of the legal issue to prevent miscarriage of justice.

(c) The Court must also grant an opportunity to the parties to respond to the legal issue, for which a specific plea has not been taken in the pleadings of the parties who claim benefit under the said legal issue.

(d) While deciding a legal issue for which a plea has not been taken, this Court has to decide whether the said legal issue is relevant and material to the case on hand.

56. Section 114 of the Indian Evidence Act also empowers this Court to take notice of any relevant fact or provision of law even if it is not pleaded by the parties. Order VI Rule 13 of CPC also permits the Court to consider any legal



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issue that arises during the proceedings even if it is not pleaded by the parties.

Section 33 of the Act provides for a statutory bar for filing a trademark infringement/passing off suit in case the petitioner is guilty of acquiescence. The first respondent, as observed earlier, has satisfied the test for acquiescence as stipulated under Section 33 of the Act. By the long usage and inordinate delay in filing this rectification petition as the same has been filed after a lapse of 14 long years from the date when the first respondent obtained its registration, judicial notice as per Section 114 of the Indian Evidence Act can be taken for the purpose of holding that the rectification petition filed by the petitioner is not maintainable on the ground of delay and laches. It is not a case where this Court before passing an order had put the petitioner by surprise with regard to legal issues of 'acquiescence' and 'delay and laches'. The said legal issues were also argued by the learned counsels for the petitioner as well as the first respondent during the course of their respective submissions. Only after hearing them, this Court has now come to the conclusion that this rectification petition filed by the petitioner does not deserve merit on account of 'acquiescence' and 'delay and laches'. Therefore, the contention of the learned counsel for the petitioner that without there being any plea with regard to 'acquiescence' and 'delay and laches', this Court cannot decide the said legal issue in this rectification petition, has to fail.



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57. One of the contentions of the learned counsel for the petitioner is that the first respondent has taken inconsistent stand, one before the trademark registry and the other before this Court as claimed by the petitioner. On perusal of the pleadings and other materials available on record, in the considered view of this Court, the first respondent has not taken any inconsistent stand, and all along, a consistent stand has been taken by the first respondent that they are the exclusive owner of the trademark 'DOLOBENE' and the usage of the said trademark will not cause confusion in the minds of the consumers. In fact, it is to be noted that the first respondent has also filed an opposition petition opposing the fresh request for registration of the trademark 'DOLOBAN' by the petitioner in the year 2007. Therefore, the contention of the petitioner that the first respondent has taken inconsistent stand cannot be sustained.

58. Since it has been held that the petitioner has lost the right to claim prior user of the mark 'DOLOBAN', there is no necessity for this Court to decide as to whether 'DOLOBENE', the trademark of the first respondent; and 'DOLOBAN', the trademark of the petitioner, are deceptively similar marks. The petitioner has voluntarily not let in oral evidence for the purpose of proving 'DOLOBAN' and 'DOLOBENE' are deceptively similar marks. The petitioner has not proved



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through the available materials that the trademark registration obtained by the first respondent for its trademark 'DOLOBENE' has to be cancelled. Since the petitioner has also lost its right to claim prior user and has also not been able to prove through oral and documentary evidence that 'DOLOBAN' and 'DOLOBENE' are deceptively similar marks, the question of granting the relief of infringement/passing off against the first respondent in respect of its trademark 'DOLOBENE' does not arise. For the reasons stated above, the issues framed by this Court on 03.04.2024 are answered in favour of the first respondent and against the petitioner.

59. In the result, this Court is not inclined to entertain this petition on the ground of inordinate delay for filing this petition for rectification and on the ground of acquiescence falling under Section 33 of the Act. Accordingly, this petition is dismissed as devoid of any merit. No Costs.

28.11.2024

rkm

Index:yes

Neutral citation: yes



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To

The Registrar of Trade Marks,
Trade Marks Registry,
Chennai.



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ABDUL QUDDHOSE,J.

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