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(T) OP (TM) No.165 of 2



IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 25.07.2024

Pronounced on:27.09.2024

CORAM:

THE HON'BLE MR.JUSTICE P.B.BALAJI

(T) OP (TM) No.165 of 2023

1.V.Lakshminarayanassamy

2.Suguna Lakshminarayanassamy,
No.160, Linghi Chetti Street,
Chennai 600 001.

... Petitioners

..Vs.

1.Siva Bhaskaren
No.510, SKC Road,
Surampatti Nall Road,
Erode – 638 009.

2.The Deputy Registrar of Trademarks,
Trademark Registry,
G.S.T. Road, Guindy,
Chennai – 600 032.

.. Respondents

Prayer: This Petition came to be numbered by transfer of O.R.A.No.66/2015/TM/CHN, from the file of the Intellectual Property Appellate Board, Chennai, the petitioner prays that this Original Rectification Application may be allowed and the Trademark Registration



No.1171847 in Class 7 for the goods of wet grinders, mixer grinders and washing machines registered in the name of Siva Bhaskaren, the 1st respondent herein may be removed/expunged/revoked/cancelled as the case may be and the Register of Trademarks rectified accordingly.

For Petitioner : Mr.G.K.Muthukumar for
M/s.GMS Law Associates

For Respondents : Mr.RTL.Chandar for
Mr.A.M.Amutha Ganesh for
M/s.Le Intelligensia for R1
Mr.K.Subbu Ranga Bharathi,
Central Government Standing Counsel
for R2

ORDER

This Original Petition has been filed for removal/rectification of the Trademark of the Respondent under Section 57 of the Trade Marks Act, 1999 (in short 'Act').

2. The case of the Petitioner:

The Petitioner is the prior registered proprietor of 'SUGUNA' and "SI" monogram in Class 7 and has been using it for a variety of goods and ever since 1959, the Petitioner has been using the mark 'SUGUNA' for



motors, fans, ceiling as well as exhaust etc.

3. The Petitioner mark's essential feature is 'SUGUNA' and they are the prior users of the same. The Petitioner has acquired substantial goodwill and reputation over the mark, 'SUGUNA' and while so, the 1st Respondent, dishonestly and with malafide intention in order to sail on the Petitioner's mark has adopted 'SUGUNA' and the same is also deceptive and likely to cause confusion. The goods as well as trade channels are similar and class of customers is also identical and hence, the 1st Respondent's mark is liable to be removed.

4. The claims of user with respect to wet grinders, mixer grinders and washing machines by the 1st Respondent are false and motivated. The 1st Respondent has obtained registration of an identical mark to that of the Petitioner.

5. The case of the 1st Respondent:

The 1st Respondent has been in the business for over 24 years using



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the brand name, 'SUGUNA' and launched its products in 1994 and is the prior user of the mark and has acquired immense reputation and goodwill and is well recognized in India. The use of the mark by the Respondent is extensive, continuous and successful. The mark 'SUGUNA' identifies the 1st Respondent's business, products and services and distinguishes it from competitors. The 1st Respondent is a bona fide user of the mark and it is in respect of an entirely different product altogether and the fact that the 1st Respondent was granted registration itself disproves the claims of the Petitioner. The mark is uniquely designed logo mark and dissimilar to the Petitioner's mark and the bar under Section 9(1)(a) of the Act does not operate.

6. The marks have to be compared as a whole and there is no chance of any confusion or deception as claimed by the Petitioner. There is no contravention of Section 9(2)(a) of the Act also. Even visually as well as structurally the marks are entirely different and hence even Sections 11(1)(a) and 11(1)(b) would not apply. The 1st Respondent's mark is also not in contravention of Section 11(2) of the Act. The allegation of infringement



also does not arise. The 1st Respondent is the prior user of a uniquely designed logo mark. In any event, the 1st Respondent is an honest and concurrent user of the impugned mark and lawful registered proprietor and hence the registration in favour of the 1st Respondent is not contrary to Section 18 also. The 1st Respondent therefore sought for dismissal of the petition.

7. On 29.04.2024, both the learned counsel informed this Court that their respective parties do not wish to adduce any oral evidence and would straightaway argue the Original Petition.

8. I have heard Mr.G.K.Muthukumar, for M/s.GMS Law Associates, learned counsel for the Petitioner, Mr.RTL.Chandar, learned counsel for 1st Respondent and Mr.K.Subbu Ranga Bharathi, learned Central Government Standing Counsel for the 2nd Respondent.

9. The learned counsel for the Petitioner, Mr.G.K.Muthukumar would



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contend that the Petitioner is admittedly the prior user of the mark ‘SUGUNA’ and is using the mark right from the year 1959 onwards. He would take me through the documents to evidence registration of the marks, word as well as Monogram. The Petitioner enjoys a registration in Class 7, right from 1964 and the registration is valid as on date. He would take me through the several invoices that have been filed right from 1989 onwards to show extensive as well continuous use across several major towns and cities and by relying on the voluminous documents, he would state that the Petitioner has acquired distinctiveness. He would also contend that the 1st Respondent has not shown to have been using the mark from 14.11.1994 as claimed and all the documents filed by the 1st Respondent are only after 2012.

10. He would also invite my attention to the registration in Class 11, in favour of the 1st Respondent for ‘home appliances’ which has lapsed and only wet grinders survived. According to the learned counsel, there is no reason for the 1st Respondent to adopt ‘SUGUNA’ and further the mark



being deceptively similar, the 1st Respondent was dishonestly trying to ride on the good will and reputation of the Petitioner. He would further submit that even the plea of honest and concurrent use has not been established by letting in adequate evidence.

11. He would rely on the following decisions:

i) *T.V.Venugopal v. Ushodaya Enterprises Limited and others*, reported in (2011) 4 SCC 85;

ii) *Parle Products (P) Limited v. J.P. and Company, Mysore*, reported in (1972) 1 SCC 618;

iii) *A.Sirkar & Co.(Jewellers) Private Limited Vs. B.Sirkar Jahuree Private Limited*, reported in MANU/OT/0018/2021;

iv) *Laxmikant V. Patel v. Chetanbhat Shah and others*, reported in (2002) 3 SCC 65;

v) *Johnson & Johnson v. Lupin Limited and others*, reported in MANU/DE/0624/2015;

vi) *Mr.Sanjay Chadha Trading as Eveready Tools Emporium & others v. Union of India and others*, reported in MANU/DE/0553/2022;



vii) *Lal Babu Priyadarshi v. Amritpal Singh*, reported in (2015) 16 SCC 795;

viii) *Ruston & Hornsby Limited v. The Zamindara Engineering Company*, reported in (1969) 2 SCC 727; and

ix) *Sun Pharma Laboratories Ltd. v. Cian Healthcare Limited and others*, reported in MANU/DE/2914/2023.

12. Per contra, Mr.RTL.Chandar, learned counsel for the 1st Respondent would emphasize on the point that the Petitioner is into pumps whereas, the 1st Respondent is only into wet grinders, being home appliances and therefore, the products were entirely different and as long as the Petitioner was not declared as a 'well known mark', the Petitioner cannot claim any monopoly over mixed grinders when admittedly the Petitioner deals only with motor pumps. He would further state that the Petitioner is not the original proprietor and he got the right only under a Will and that was only after 2005, by which time the 1st Respondent had started using the mark and the Petitioner could claim right only after the death of the original proprietor on 20.06.2009. He would further submit that even the



logos and styles were totally different and there was no likelihood of any confusion or deception. Further, when the original proprietor never challenged the mark until his demise, the Petitioner was not entitled to do so, after a lapse of 7 years. Lastly, he would submit that the 1st Respondent was entitled to be protected under Section 12 of the Act.

13. He would rely on the following decisions:

a) *M/s.Nandhini Deluxe v. M/s.Karnataka Co-operative Milk Producers Federation Limited*, reported in (2018) 9 SCC 183;

b) *Nestle India Limited v. Mood Hospitality Private Limited*, dated 10.02.2010 by the Delhi High Court in FAO(OS) 255/2009;

c) *Vishnudas Trading as Vishnudas Kishendas Vs. Vazir Sultan Tobacco Limited, Hyderabad and another*, reported in (1997) 4 SCC 201;
and

d) *National Sewing Thread Company Limited v. James Chadwick and Brothers Limited*, reported in (1953) 1 SCC 794.

14. I have carefully considered the submissions advanced on either



side. I have also gone through the pleadings, documents placed on record by way of typed sets and also the decisions on which the learned counsel on either side have placed reliance on.

15. The following issues are to be determined in the given facts and circumstances:

- a) Whether the Petitioner or the 1st Respondent is the prior user of the mark 'SUGUNA'?
- b) Whether the impugned mark of the 1st Respondent is deceptively similar to the Petitioner's mark, in so much as to cause confusion?
- c) Whether the adoption of the 1st Respondent's mark is honest and concurrent?
- d) Whether the Petitioner is entitled to rectification on the grounds of violation of Section 9, 11 and 18 of the Act?

16. The issues are taken up together since the facts of the case as may be necessary to decide all the above issues in fact overlap.

17. The Petitioner has been enjoying a registration in Class 7 for the last several decades. The earliest use of the "SUGUNA" mark by the Petitioner has been shown to be 1959. The first registration of the mark was



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granted on 13.08.1964 and the Petitioner has been periodically renewing the same. It is also seen from the registrations that the goods have been described as Motors (not for land vehicles), grinding machines including flexible shaft machines. The word and device mark registered in favour of the Petitioner is:



18. It is also seen from the said certificate in Annexure-A that the present Petitioners were brought on record as subsequent Proprietors in respect of the said registered trade mark on 07.01.2010 by virtue of TM-24 dated 14.12.2009 pursuant to death of one, G.Ramaswamy on 20.06.2009 and his Will dated 18.12.2006. Relying on the same, the learned counsel for the 1st Respondent would contend that the Petitioner is not the original registered proprietor and therefore, he cannot claim any user prior to the death of Mr.G.Ramaswamy on 20.06.2009 and therefore, the 1st



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Respondent has shown prior use of the 'SUGUNA' mark. I am unable to countenance the said submission. The Trade Mark Registry has recognised the rights of the said G.Ramaswamy and also acknowledged the fact that the Petitioner, as beneficiary under the Will of the said G.Ramaswamy has become entitled to registration in the name of the Petitioner, that too way back in 2009. The rights held by the said G.Ramaswamy, including the right over the trademark and its registrations would certainly enure to the benefit of the Petitioner who has only stepped into the shoes of the original proprietor and therefore, it cannot be contended that the Petitioner can claim actual use only from the date on which the registration was transferred in the name of the Petitioner. The Will of the said G.Ramaswamy is also filed in Annexure-B. It is in fact a registered Will. The bequest in favour of the daughter and son-in-law of G.Ramaswamy and includes all movables, business assets and property of every description. Therefore, it cannot be construed that the trade mark registrations held by the said G.Ramaswamy would not pass on to the said beneficiaries. The Petitioner only steps into the shoes of the registered proprietor and would take the benefit of all rights and interests held/owned by him.



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19. Now, with regard to the rival claims of both the Petitioner and the 1st Respondent, regarding prior use, I proceed to examine the documents filed on either side.

20. In Annexure-E, the Petitioner has filed certificates of a Chartered Accountant, Mr.M.Sundaram (dated 14.05.2009) annexing sales turn over and advertisement expenses right from the year 1960 onwards, by 'Suguna Industries', in respect of their mark, SUGUNA', Chartered Accountants, N.C.Rajan & Company, dated 25.2.2011, certifying sales and advertisement expenses for the mark, 'Susi Suguna', from 1990-91 to 2009-10.

21. In Annexure-F, the Petitioner has filed invoices to evidence sales and use of their registered mark, both word as well as device, as early as from 05.09.1989 and thereafter.

22. In contrast, examining the documents filed on the side of the 1st Respondent, it is seen that their claim of first use is in 1994. The invoices



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filed by the 1st Respondent in R14 are found to be only from 2001 onwards.

VAT returns and certifications are only in 2016-17. The claim of the 1st Respondent that the impugned mark has been used by them from the year 1994 onwards has not been established and from the documents filed by the 1st Respondent, use is established only from the year 2001 onwards. Therefore, from the available documentary evidence, I reject the claim of user by the 1st Respondent to be November, 1994 and also hold that the Petitioner is the prior user of the 'SUGUNA' mark. The issue is answered accordingly.

23. Next, moving on to whether the use of the impugned mark, violates Section 9, 11 and 18 of the Act, first and foremost, the rival marks of the parties is to be seen. The Petitioner's mark has already been reproduced hereinabove. The 1st Respondent's mark is reproduced hereunder:



24. On comparing both the rival marks, in line with the settled legal principles enunciated by the Hon'ble Apex Court as well as other High Courts, the rival marks may not be identical. However, the marks are certainly very similar and there is likelihood of the consumer mistaking the mark of the 1st Respondent as that of the Petitioner. 'SUGUNA' is common in both and it being a common name/word, the logo in both the marks would alone survive for real test and the 'S' in artistic form in the 1st Respondent's is certainly deceptive and similar to the artistic 'S' in the Petitioner's mark, though the logos are different. The 1st Respondent has to show by adducing sufficient as well as satisfactory evidence that the 1st Respondent's mark has acquired a distinctiveness. But, in the present case, I do not find any such evidence forthcoming from the side of the 1st Respondent. Thus, clearly, the



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1st Respondent has not made out a case that its mark is capable of being distinguished vis-a-vis the Petitioner's mark and therefore, under Section 9(1)(a), I find there existing an absolute ground for refusal of the 1st Respondent's mark.

25. If a trade mark's use in India is liable to be prevented by virtue of the law of passing off, then a trade mark shall not be registered. Therefore, even though the argument of the learned counsel for the 1st Respondent that the products dealt with by both the Petitioner and the 1st Respondent are very different, there is a likelihood of the consumers believing that the goods of the 1st Respondent to be that of the Petitioner. In fact, the argument advanced by the learned counsel for the 1st Respondent that the trade channels are different and there is no chance of any confusion does not merit acceptance. The Petitioner is dealing with motor and pump sets and also holds valid registration for grinding machines and the 1st Respondent is into wet grinders and the chances or likelihood of confusion or deception cannot



be ruled out just because the goods of the 1st Respondent are sold in a different sector as on date as there are high chances of the 1st Respondent's mark being associated with the Petitioner's mark.

26. In fact, after the amendment to the Act, there is a substantial change in the law. The Explanation (a) to Section 11 states that a registered trade mark or an application under Section 18 bearing an earlier date of filing than the trade mark in question, would mean an 'earlier trade mark'. Explanation (b) also states that such an earlier trade mark would be entitled to protection as a well-known trade mark if it was claiming priority over the mark in question. Therefore, even in the absence of being declared as a well-known mark, the Petitioner, having down to be the prior user, is entitled to protection.

27. Moreover, the adoption of the mark by the Respondent is without cause. The 1st Respondent has not adduced any reasons for adopting the 'SUGUNA' mark and when the 1st Respondent has started using not only the trade mark but also the name, 'SUGUNA' without offering any



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explanation, then the 1st Respondent cannot seek protection under Section 12 stating that the use of the mark is honest and concurrent. The Petitioner has shown to have grown over the past several decades and has earned a great amount of goodwill and reputation built for its mark and the 1st Respondent's adoption of the same clearly evidences mala fides and dishonesty, with an ulterior motive on sailing or riding on the Petitioner's reputation and good will.

28. Turning to the case law, the 1st Respondent placed strong reliance on *M/s.Nandhini Deluxe*'s case, (referred herein supra). The Apex Court held that the word 'Nandhini' was not coined or invented and was only generic, being a name of a Hindu goddess and when the nature of business of the rival parties was different, there could not be any justification to hold that the mark impugned in the said case would cause confusion.

29. The Apex Court relied on Section 12 and found that there was long use shown in that case and the same was also honest. However, here, I have already found that the 1st Respondent has not been able to show either



honest or concurrent use and therefore, what weighed in the case of *M/s.Nandhini Deluxe's* case (referred herein supra) cannot be applied to the facts of this case.

30. In *Nestle India Limited's* case (referred herein supra), the Delhi High Court was deciding an infringement action and in that context, compared the claims under Section 29 of the Act and came to a conclusion that in the facts of the case, the mark was not used as a trade mark and further its use was likely to be taken as being used a trade mark and further held the marks, viewed as a whole were neither similar nor identical.

31. In *Vishnudas Trading's* case (referred herein supra), the Apex Court decided the issue in the pre-amendment position when passing off was not relevant. However, as already discussed, post amendment to the Act, passing off also becomes a relevant factor while deciding entitlement of a mark to registration. Similarly, in *National Sewing's* case (referred herein supra) as well, the decision was only based on the fact that considerations relevant for passing off are different than what is relevant for an application



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for registration of a mark under the Trade Marks Act. However, post-amendment, there is a change in the legal position and therefore, this decision also does not help the 1st Respondent.

32. In *Parle Products'* case, (referred herein supra) the Hon'ble Supreme Court held that the broad and essential features of the two marks are to be considered and the real test is not to place them side by side and find out differences. I have already undertaken this exercise and found that the broad and essential features of the rival marks have to be considered even if the marks are not identical and if there is an overall similarity which is likely to mislead a person to accept the impugned mark as that of the other, then it would be deceptively similar.

33. In *A.Sirkar's* case, (referred herein supra) the Court held, relying on the decision of the Apex Court in *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceuticals Laboratories*, MANU/SC/0197/1964, held that if the essential features of the trade mark of the Plaintiff have been adopted by the Defendant, the fact that the get up, packing and other writings or



marks on the goods or on the packets in which the goods are offered show marked differences, it would be immaterial.

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34. In *Laxmikant Patel*'s case, (referred herein supra) the Apex Court held that the law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the good belonging to someone else, are his or are associated therewith.

35. In *Lal Babu*'s case, (referred herein supra) the Apex Court ruled that unless a mark has acquired a distinctive character as a result of use before the date of application, it shall not be registered. In the present case, there is not a shred of evidence to even suggest that the 1st Respondent had acquired such distinctiveness, by use of the mark 'SUGUNA' even before the date of his Application.

36. In *Sanjay Chadha*' case, (referred herein supra) the Court held that even if the trade mark is not a well-known trade mark and business activities are different, still it can be protected because of long user,



proprietorship right and nature of mark in question. The ratio laid down in this case would apply in all force, to the present case.

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37. Even testing the rival marks in the light of the well settled principles of law enunciated by the Courts, I am unable to sustain the impugned registration in favour of the 1st Respondent. For all the above reasons, the Petitioner is entitled to succeed in respect of all the issues framed.

38. In fine, the petition is allowed and the Trademark



Registration No.1171847 in Class 7 is directed to be removed from the Register. However, there shall be no order as to costs.



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27.09.2024

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Index : Yes/No

Speaking/Non-speaking order

rkp

To

The Deputy Registrar of Trademarks,
G.S.T. Road, Guindy, Chennai – 600 032.

P.B.BALAJI,J.

rkp

**Pre-delivery Orders in
(T) OP (TM) No.165 of 2023**



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27.09.2024

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED:12.12.2024

CORAM:

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Prayer: This Petition came to be numbered by transfer of O.R.A.No.66/2015/TM/CHN, from the file of the Intellectual Property Appellate Board, Chennai, the petitioner prays that this Original Rectification Application may be allowed and the Trademark Registration No.1171847 in Class 7 for the goods of wet grinders, mixer grinders and washing machines registered in the name of Siva Bhaskaren, the 1st respondent herein may be removed/expunged/revoked/cancelled as the case may be and the Register of Trademarks rectified accordingly.

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Mr.A.M.Amutha Ganesh for
M/s.Le Intelligensia for R1
Mr.K.Subbu Ranga Bharathi,
Central Government Standing Counsel
for R2

ORDER

Today, this matter is listed under the caption 'for being mentioned' at the instance of the learned counsel for the petitioners.

2. Heard Mr.G.K.Muthukumar, learned counsel for the petitioners and the learned counsel for the first respondent.



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3. The learned counsel for the petitioners would submit that since Section 11 has several sub sections, order dated 27.09.2024, may incorporate Sub Section 4, at line 2 of the 26th paragraph and also incorporate the following line viz., '*was entitled to protection as a well known mark*' at the same paragraph i.e., 7th line of 26th paragraph, after the word *question*, to give more clarity and avoid any confusion.

4. The learned counsel for the respondent has no objection to the said changes to be effected to the order dated 27.09.2024. However he would contend that a limitation would run from the date of the modification order being passed, i.e., today (12.12.2024).

5. Recording the same, the Registry is directed to issue a fresh copy of the order after incorporating necessary corrections. It is made clear that in view of the above correction and a fresh copy being issued, limitation would be reckoned from today.

6. Except the aforesaid modification, order dated 27.09.2024, remains unaltered in all other respects.

12.12.2024

To

26/28



The Deputy Registrar of Trademarks,
G.S.T. Road, Guindy, Chennai – 600 032.

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12.12.2024