



(T)OP(TM) No.171 of 2023  
(ORA/125/2013/TM/CHN)

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**IN THE HIGH COURT OF JUDICATURE AT MADRAS**

DATED: 20.03.2024

CORAM

**MR.JUSTICE N.SESHASAYEE**

(T)OP(TM) No.171 of 2023  
(ORA/125/2013/TM/CHN)

Erode No.1 Mangaiyar Choice  
(A Partnership firm duly represented  
by its Partner)  
A.Karpagam @ Vijaya  
No.747-B, Netaji Street  
Erode - 1

... Petitioner

Vs.

1.Mangai Agencies  
Rep. by its Partner V.M.A. Gunasekaran  
No.325, Katcheri Road  
Erode - 638 001

2.V.M.A.Gunasekaran

3.G.Thamaraiselvi

4.The Registrar of Trade Marks  
Trade Mark Registry  
Chennai

... Respondents



(T)OP(TM) No.171 of 2023  
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Prayer: Original Petition filed under Sections 57 and 125 of the Trade Marks Act, 1999 to rectify /remove/cancel/expunge/vary in the larger public interest and also to maintain the purity of the Register, so as to prevent the respondents from monopolising on the word 'MANGAI' which is a descriptive dictionary word of common public and trade use and describing services pertaining to women.

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

For Respondents : Mr.N.Alagu R.Narayanan for R1 to R3  
Mr.C.Kulanthaivel, SPC for R4

### **ORDER**

The petitioner herein seeks a rectification of the registration vis-a-vis the label mark '**Mangai Agencies**' with a Saluting Lady as the device which the 1st respondent had registered. The petitioner's mark was "**Erode No.1 Mangaiyar Choice**" without any lady device. The exception is to the use of the word Mangai by the 1st respondent.



(T)OP(TM) No.171 of 2023  
(ORA/125/2013/TM/CHN)

WEB COPY

2.The learned counsel for the petitioner submitted that the 1st respondent's label mark 'Mangai Agencies' with the aforesaid device, contains multiple information including the phone numbers. The learned counsel submitted:

(a) that the word 'Mangai' is a descriptive word and a common word in Tamil, meaning 'a young lady' or 'a young girl'. While it is permissible for any proprietor of a trademark to have a label with descriptive word registered as a trademark, yet the same is subjected to Section 17(2) of the Trade Marks Act, 1999. If the 1st respondent needs to get over Section 17(2) of the Act, then it ought to have registered even the part of the mark under Section 15(1) of the Act. However, under Section 9(1)(a) of the Act, the word 'Mangai' *per se* cannot have a distinctive character. Therefore, if the 1st respondent had gone for registration of the word 'Mangai' in his label separately under Section 15(1), then, he necessarily may have to negotiate Section 9(1)(a).

(b) The 1st respondent has not obtained a registration exclusively for the word 'Mangai' in its trade mark 'Mangai Agencies' under Section 15 of the Act and therefore it cannot claim any exclusivity for the use of the word 'Mangai'.



(T)OP(TM) No.171 of 2023  
(ORA/125/2013/TM/CHN)

WEB COPY

(c) Since the Registrar had registered the entire label and not part of the mark of the 1st respondent, the situation did not arise for the Registrar to resist registration of the 1st respondent's mark under Section 9(1)(a).

(d) The learned counsel submitted that the petitioner has lost both the suit for infringement of trademark and also the first appeal, essentially because the 1st respondent's label was registered and that in terms of Section 13(1) of the Act, every registered trademark carries with itself a presumption of its validity, and in any suit founded on a registered trademark, Sec.9 cannot be a ground of defence. It is hence, the petitioner, notwithstanding the fact that it could not succeed in the suit, is constrained to pursue this petition. Even in the judgment of the Appellate Court in A.S.No.1072/2012, this Court has underscored that the decree that it had passed in the first appeal would be subject to the outcome of the present petition.

(e) In fitness of things, the 4<sup>th</sup> respondent, the Registrar of Trademarks ought to have restricted the use of label or parts thereof by the 1<sup>st</sup> respondent in order that the descriptive name 'Mangai' is available for



(T)OP(TM) No.171 of 2023  
(ORA/125/2013/TM/CHN)

WEB COPY

everyone's use, and should have imposed a condition under Section 18(4) which he has not done.

5. The learned counsel for the respondents 1 to 3 submitted that these respondents have not obtained registration for any word mark for '**Mangai Agencies**' but have obtained a registration for a label mark with multiple information. These respondents also do not claim any exclusive right to the use of the word '**Mangai**' vis-a-vis the certificate of registration they have obtained for the word '**Mangai Agencies**'. The issue, however, is not about the petitioner using the word 'Mangaiyar' but it is all about how he presents its trade name in public here, argued the counsel. It is pertinent to state that the petitioner was running its business initially under the trade name Saravana Stores and later he changed it to "**Erode No.1 Mangaiyar Choice**" and he has his business in a building adjacent to that of the respondent. Therefore, the issue here is not about the right of the petitioner to use the word 'Mangai' but whether he presents it in a way that may confuse a gullible consumer into believing that his business has something to do with the business of the respondents 1 to 3. That precisely is why these



(T)OP(TM) No.171 of 2023  
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WEB COPY

respondents were constrained to institute a suit for passing off which this court has now decreed. He also added that the petitioner has since changed the name of its business as Gangai Agencies.

6. The learned counsel for the petitioner would now submit that the respondents 1 to 3 takes a strong exception to the use of the word 'Mangai' as a descriptive word in its advertisement or other material.

7. The short question which is raised before the Court was all about the alleged exclusivity which the respondents 1 to 3 have claimed vis-a-vis the use of the word 'Mangai' in its Trade Mark 'Mangai Agencies'. Now that the learned counsel for the respondents 1 to 3 has made known to this court that they do not claim any exclusivity over the word 'Mangai', this Court may not have a role to play vis-a-vis the present petition for rectification. This however, does not imply that the petitioner may engage in any activity, which may border on passing off the goods of the respondents 1 to 3 as its own goods. That is a different issue that falls outside the purview of Section 57 of the Act. Therefore, the petitioner is free to use the word 'Mangaiyar' in



(T)OP(TM) No.171 of 2023  
(ORA/125/2013/TM/CHN)

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the manner of its choice, but is also cautioned that it may not use the word in a manner that may constitute passing off.

8. With the above observation, this petition is disposed of. No costs.

20.03.2024

Asr  
Index: Yes/No  
Speaking Order / Non-Speaking Order  
Neutral Citation: Yes / No

To  
The Registrar of Trade Marks  
Trade Mark Registry  
Chennai



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(T)OP(TM) No.171 of 2023  
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N. SESHASAYEE, J.

Asr

(T)OP(TM) No.171 of 2023  
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