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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 03.12.2024

Pronounced on : 09.12.2024

CORAM

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

(T) OP (TM) No.180 of 2023

Hatsun Agro Product Limited,
Karapakkam, Chennai - 600 097,
Chennai - 600 040.

.. Petitioner

-VS-

1.V.Shanmugam and S.Murugesan,
Trading as Arokiya Foods,
89, Semadampalayam Road,
Vellakovil - 638 111,
Erode District, Tamil Nadu.

2.Registrar of Trade Mark,
Office of the Trademarks Registry,
G.S.T.Road, Guindy,
Chennai - 600 032.

.. Respondents

Prayer: This petition filed under Sections 47 and 57 of the Trade Marks Act may be pleased to rectify the register by removing or cancelling the first respondent's trademark AROKIYA label registered under No.1299314 in Class 30.



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For petitioner : Mr.Surya Senthil for
M/s.Surana and Surana

For respondents : Mr.R.Sathish Kumar for
Mr.A.K.Rajaraman for R1

Mr.J.Madanagopal Rao,
SPLCGSC for R2

ORDER

This petition has been filed under Sections 47 and 57 of the Trade Marks Act seeking for cancellation of the first respondent's trade mark registration in respect of the Mark 'AROKIYA' obtained through Application No.1299314 in Class 30 in respect of 'INSTANT IDLI DOSA WET BATTER'.

2.Though the petitioner has filed this petition both under Sections 47 and 57 of the Trade Marks Act, learned counsel for the petitioner, at the outset would submit that the petitioner is seeking for cancellation of the trade mark registration obtained by the first respondent for the trade mark 'AROKIYA' in Class 30 in respect of 'INSTANT IDLI DOSA WET BATTER' only under Section 47 of the Trade Marks Act on the ground of non-usage of the said trade mark for more than five years.



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3. According to the petitioner, since the first respondent has not been using the trade mark 'AROKIYA' as per the trade mark registration obtained by them through Application No.1299314 in Class 30 for more than five years as they have substantially altered the trade mark subsequently without seeking permission of the Trade Marks Registry as per the provisions of Section 59 of the Trade Marks Act 1999, the trade mark registration obtained by the first respondent through Application No.1299314 for the trade mark 'AROKIYA' under class 30 has to be cancelled and removed from the Register of trade marks.

4. The petitioner also claims that since they have obtained trade mark registration for the trade mark 'AROKYA' under various classes and that they have been in usage of the said trade mark for the products manufactured by them for a very long time and the said trade mark having acquired distinctiveness and being associated only with them, they are aggrieved by the usage of a similar trade mark 'AROKIYA' by the first respondent and therefore, as an aggrieved party, they are legally entitled to seek for cancellation of the first respondent's trade mark registration for the very same mark 'AROKIYA' as per the provisions of Section 47 of the



Trade Marks Act on account of non-usage of the registered trade mark obtained by the first respondent for more than five years.

5. On the other hand, the first respondent has categorically contended as follows:

a) The infringement suit filed by the petitioner in C.S. No.34 of 2015 against the first respondent in respect of the very same trade mark 'AROKIYA' was dismissed by this Court through its judgment dated 11.08.2022 by a well reasoned judgment after a full trial and arguments made by both the parties. Hence, this petition is not maintainable as the issues, which are the subject matter of consideration in this petition, were also the subject matter of consideration in the suit filed by the petitioner and since the issues have been answered against the petitioner, the question of re-agitating the same through this rectification petition does not arise;

b) As early as on 04.08.2009 itself, the petitioner was informed by the first respondent through its reply to the cease and desist notice dated 28.07.2009 sent by the petitioner that the first respondent is a bonafide user of the trade mark 'AROKIYA' having obtained trade mark registration in



class 30 in respect of 'INSTANT IDLI DOSA WET BATTER'. However, according to the first respondent, belatedly only in the year 2015, the petitioner had filed the application seeking for cancellation of registration of the first respondent's trade mark 'AROKIYA' under Section 47 of the Trade Marks Act on the alleged ground of non-usage of the trade mark 'AROKIYA' by the first respondent for more than five years;

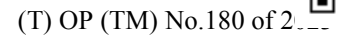
c)According to the first respondent, as per Section 33 of the Trade Marks Act 1999, on the ground of acquiescence for more than five years by the petitioner and the first respondent being an honest and bonafide user of the trade mark 'AROKIYA' pursuant to the trade mark registration obtained by them, the question of seeking the relief of cancellation of the first respondent's trade mark registration in respect of the trade mark 'AROKIYA' under Section 47 of the Trade Marks Act does not arise;

d)The goods manufactured and sold by the petitioner under the trade mark 'AROKYA' are dairy products, whereas the goods manufactured and sold by the first respondent under the trade mark 'AROKIYA' are 'INSTANT IDLI DOSA WET BATTER' which is different. Therefore,



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having acquiesced to the usage of the trade mark 'AROKIYA' by the first respondent in respect of 'INSTANT IDLI DOSA WET BATTER' for more than five years and the first respondent, having trade mark registration for 'AROKIYA', the instant petition filed under Section 47 of the Trade Marks Act, 1999 is not maintainable. The first respondent has been continuously using the trade mark 'AROKIYA' even prior to the date of the trade mark registration obtained by them for the trade mark 'AROKIYA' in respect of 'INSTANT IDLI DOSA WET BATTER' under class 30. Out of necessity, the first respondent altered its trade mark by removing the device mark 'ROSE' alone from the trade mark registration obtained by them. However, according to them, in all other respects, the trade mark 'AROKIYA' used by them, remained unaltered. According to the first respondent, only when the trade mark has been substantially altered by the first respondent affecting the first respondent's identity over the trade mark 'AROKIYA', there may be a requirement for the first respondent to seek for approval of the altered trade mark from the trade mark registry under Section 59 of the Trade Marks Act;



f) Since Section 59 of the Trade Marks Act, which enables the proprietor of the registered trade mark to seek permission for alteration of registered trade mark, is not mandatory and is only directory, the first respondent cannot be compelled to approach the Registrar of trade mark for seeking permission to alter its registered trade mark. According to the first



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respondent, if Section 59 of the Trade Marks Act, 1999 is mandatory,

Section 55 of the Trade Marks Act would be rendered otiose and hence,

such an argument ought to be rejected.

g)The petitioner cannot be allowed to blow hot and cold. The principle of approbate and reprobate is applicable to the case on hand. On the one hand, the petitioner filed a suit against the use of the term 'AROKIYA' by the first respondent and on the other hand, the very same petitioner has invoked the provision of Section 47 of the Trade Marks Act that the Trade Mark is not in use for the past five years and the same has to be rectified/cancelled.

6.Learned counsel for the petitioner reiterated the contents of the T(OP) as stated supra.

7.Similarly, the learned counsel for the first respondent reiterated the contents of the counter affidavit filed by the first respondent before this court, as summarised supra.



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8.Learned Standing Counsel appearing for the second respondent/Trade Marks Registry would submit that the second respondent would abide by any orders passed by this Court in this rectification petition filed under Sections 47 and 57 of the Trade Marks Act.

9.Learned counsel for the petitioner in support of the petitioner's contention relied upon the following authorities :

a)A.K.Al Muhaidib & Sons v. Chaman Lal Sachdeva reported in 2011 (1) SCC 125;

b)Khoday Distilleries Ltd. v. Scotch Whisky Association reported in 2008 (10) SCC 723; and

c)Sanjay Chadha v. Union of India reported in 2022 SCC Online Del. 509.

10.In support of the first respondent's contention, learned counsel for the first respondent drew the attention of this Court to Khoday Distilleries Ltd. v. Scotch Whisky Association reported in 2008 (10) SCC 723.



Discussion:

11.The following are the undisputed facts:

a)The trade mark infringement and passing of suit filed by the petitioner before this Court pertaining to the use of the very same trade mark 'AROKIYA' by the first respondent, has been dismissed by this Court on 11.08.2022 in C.S. No.34 of 2015 by a reasoned judgment after full trial and after hearing the arguments of both the parties.

b)As early as on 04.08.2009 itself, the petitioner was informed by the first respondent through its reply to the cease and desist notice dated 28.07.2009 sent by the petitioner that the first respondent is a bonafide user of the trade mark 'AROKIYA' having obtained trade mark registration in class 30 in respect of 'INSTANT IDLI DOSA WET BATTER';

c)The rectification application was filed both under Sections 47 and 57 of the Trade Marks Act by the petitioner only in the year 2015 after a lapse of almost six years, after the petitioner was put on notice in writing by the first respondent that the first respondent is a bonafide user of the trade



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mark 'AROKIYA' pursuant to a trade mark registration obtained by them in class 30 in respect of 'INSTANT IDLI DOSA WET BATTER'. The only alteration made by the first respondent to the trade mark registration obtained by them in respect of the trade mark 'AROKIYA' is the removal of



the device mark 'ROSE'.

Apart from the same, no other alteration has been made. However, they claim that removal of the 'ROSE'



would also amount to substantial alteration, which requires permission from the Trade Mark Registry as per the provisions of Section 59 of the Trade Marks Act;

12. Having recorded the undisputed facts, this Court will now consider as to whether there is any merit in this rectification petition filed under Sections 47 and 57 of the Trade Marks Act on the alleged ground of non usage of the registered trade mark obtained by the first respondent for



more than five years. For deciding the same, the primary issue that has to be considered by this Court is whether the removal of the device mark 'ROSE'



by the first respondent will amount to 'substantial alteration' made to its registered trade mark and whether the said alteration made by the first respondent would amount to abandoning the registered trade mark for more than five years enabling the petitioner to file an application under Section 47 of the Trade Marks Act seeking for cancellation of the trade mark registration obtained by the first respondent in respect of the trade mark 'AROKIYA' on the ground of non-usage for more than five years;

13. Admittedly, the petitioner had earlier filed a suit before this Court in C.S. No.34 of 2015 and it was an infringement and passing off suit in respect of the very same trade mark 'AROKIYA' used by the first respondent. The first respondent in the said suit had also raised the same defences, which are raised in this petition. By a reasoned judgment, after a full fledged trial, a learned Single Judge of this Court dismissed the said suit filed by the petitioner against the first respondent by a judgment dated



11.08.2022 passed in C.S. No.34 of 2015. In the said suit, it was contended by the petitioner that the first respondent has adopted a completely different trade mark by using 'AROKIYA' in a straight line and has removed the 'ROSE' device, which would amount to substantial alteration and the same is not permissible without the permission of the Trade Mark Registry under Section 59 of the Trade Marks Act.

14. In the plaint filed in C.S. No.34 of 2015, the petitioner had also pleaded that no action was taken against the first respondent subsequent to the cease and desist notice dated 28.07.2009 sent by the petitioner only due to the reason they were persuading the first respondent not to use the trade mark 'AROKIYA'. The petitioner's witness in the suit, however, contradicted the plaint averments as seen from the deposition of the petitioner's witness. In paragraph 30 of the plaint filed in C.S. No.34 of 2015, the petitioner herein has stated that they will invoke rectification proceedings against the first respondent. In the evidence rendered by the legal officer of the petitioner before this Court, he has admitted that no action was taken against the first respondent between the period from 2009 to 2015. Section 33 of the Trade Marks Act, 1999, which deals with acquiescence, is extracted hereunder:



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'33. Effect of acquiescence.—(1) *Where the proprietor of an earlier trade mark has acquiesced for a continuous 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.

(2) Where sub-section (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark, or as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark may no longer be invoked against his later trade mark'

15. Admittedly, in the case on hand, the petitioner was made aware about the details of the first respondent's trade mark registration in respect of its Trade Mark 'AROKIYA' in the year 2009 itself through the reply notice sent by the first respondent dated 04.08.2009 to the cease and desist notice sent by the petitioner dated 28.07.2009. However, the petitioner did not proceed against the first respondent in respect of the alleged



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infringement and passing off within a period of five years from the date of knowledge of the infringement/passing off. Admittedly, the product for which the trade mark 'AROKIYA' being used by the first respondent is 'INSTANT IDLI DOSA WET BATTER', having obtained trade mark registration in class 30, whereas the petitioner is having trade mark registration only in respect of dairy products and not in respect of 'INSTANT IDLI DOSA WET BATTER'. The evidence available on record also does not disprove the first respondent's contention that the adoption of the mark 'AROKIYA' by them is honest and bonafide. Being an honest and a bonafide user of the trade mark 'AROKIYA', the defence of acquiescence as per the provisions of Section 33 of the Trade Marks Act comes to the aid of the first respondent. If the petitioner was really aggrieved by the trade mark registration obtained by the first respondent in respect of the trade mark 'AROKIYA' under class 30, they ought to have filed this petition within five years from the date when they were informed by the first respondent about the details of the trade mark registration obtained by the first respondent in respect of the trade mark 'AROKYA' i.e. in the year 2009 itself.



16. Having slept over their rights for more than six years, it is not legally permissible for the petitioner to invoke either Section 57 or Section 47 of the Trade Marks Act seeking for cancellation of the trade mark registration obtained by the first respondent for the trade mark 'AROKIYA' under Class 30. In the decision of the Hon'ble Supreme Court in the case of **Khoday Distilleries Ltd. v. Scotch Whisky Association reported in 2008 (10) SCC 723**, it has been made clear that the principle of acquiescence is applicable even to the rectification proceedings. The relevant paragraph of the judgment is extracted hereunder:

'31. The power of the Registrar in terms of Section 56 of the Act is wide. Sub-section (2) of Section 56 of the Act used the word "may" at two places. It enables a person aggrieved to file an application. It enables the Tribunal to make such order as it may think fit. It may not, therefore, be correct to contend that the delay or acquiescence or waiver or any other principle analogous thereto would apply under no circumstances. Purity of register as also the public interest would indisputably be relevant considerations. But, when a discretionary jurisdiction has been conferred on a statutory authority, the same although would be required to be considered on objective criteria but as a legal principle it cannot be said that the delay leading to acquiescence or waiver or abandonment will have no role to



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play (See Ciba Ltd v. M Ramalingam) In determining the said question, therefore, conduct of the person aggrieved in filing the application for rectification would be relevant. For the aforementioned purpose, whether it is a class or group action or a private action although would be relevant but may not be decisive. It is one thing to say that class or group action will receive special attention of the statutory authority vis-à-vis a private action. But, in both types of cases, public interest should remain uppermost in the mind of the authority. The question which is required to be posed therefore would be as to whether the public in general or the class of buyers would be deceived or be confused if the existing mark is allowed to remain on the register. Thus, deceptive similarity or confusion is the principal criterion for determining applications both for registration as also for rectification.'

17.This Court will now discuss the primary question that arises for consideration as to whether the trade mark used by the first respondent is altered as per Section 59 of the Trade Marks Act or is it substantially identical to satisfy the requirements of Section 55 of the Trade Marks Act. Section 55 of the Trade Marks Act is reproduced hereunder:

'55. Use of one of associated or substantially identical trade marks equivalent to use of another.—(1) Where under the



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provisions of this Act, use of a registered trade mark is required to be proved for any purpose, the [Registrar or the High Court, as the case may be] may, if and, so far as it shall think right, accept use of a registered associated trade mark or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall, for the purpose of this Act, be deemed to be also use of any trade mark being a part thereof and registered in accordance with sub-section (1) of section 15 in the name of the same proprietor.

(3) Notwithstanding anything in section 32, the use of part of the registered trade mark in sub-section (2) shall not be conclusive as to its evidence of distinctiveness for any purpose under this Act.'

18.As seen from Section 55, the trade mark with additions or alterations not substantially affecting its identity is legally permissible. In the instant case, both in the registered trade mark and in the presently used mark, the first respondent uses the word mark 'AROKIYA'. The only difference in the presently used mark is the removal of the device mark 'ROSE'



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The provisions of Section 59 of the Trade Marks Act will get attracted only if the registered proprietor makes a substantial change or alteration to the registered trade mark and only then at the option of the registered proprietor, permission can be sought for from the Trade Mark Registry in respect of the substantial change or alteration made to the registered trade mark. As seen from the presently used trade mark by the first respondent, excepting for the removal of the ROSE,



the prominent features of the registered trade mark 'AROKIYA' as obtained by the first respondent in Class 30 in respect of 'INSTANT IDLI DOSA WET BATTER', has not been altered by the first respondent. The identity of the trade mark 'AROKIYA' as per the trade mark registration obtained by the first respondent is in no way substantially altered and hence, the use of the trade mark in the present form by the first respondent will fall under the provisions of Section 55 of the Trade Marks Act as re-produced supra and therefore, the alteration would not amount to substantially affecting the



identity of the first respondent's trade mark 'AROKIYA' registration obtained under Class 30 for 'INSTANT IDLI DOSA WET BATTER'.

19. Section 59 of the Trade Marks Act, which the learned counsel for the petitioner had relied upon, does not apply to the case of the first respondent. Section 59 of the Trade Marks Act is re-produced hereunder:

'59. Alteration of registered trade marks.—(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) Where leave is granted under this section, the trade mark as altered shall be advertised in the prescribed manner,



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unless the application has already been advertised under sub-section (2)'.

20.As seen from the above Section, it is not mandatory and only directory. As rightly contended by the learned counsel for the first respondent, the first respondent cannot be compelled to approach the Registrar of Trade Marks seeking permission for alteration of its registered trade mark. Having satisfied the requirements of Section 55 of the Trade Marks Act as the alteration made by the first respondent to its trade mark 'AROKIYA' will not amount to altering the prominent feature of the registered trade mark 'AROKIYA' obtained by the first respondent as the said alteration does not substantially affect the first respondent's identity in respect of its trade mark 'AROKIYA', there is no legal necessity for the first respondent to seek permission for alteration of their trade mark under Section 59 of the Trade Marks Act. Having failed to succeed in the infringement and passing off suit and that too when the alteration made by the first respondent to its registered trade mark 'AROKIYA' does not amount to substantial alteration, the question of entertaining this rectification petition under Sections 47 and 57 of the Trade Marks Act does



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not arise. The trade mark presently used by the first respondent is equivalent to the trade mark registration obtained by the first respondent in respect of its trade mark 'AROKIYA' in Class 30 in respect of 'INSTANT IDLI DOSA WET BATTER' even though they have made a minor alteration by removing the device mark ROSE,



however, retaining the mark 'AROKIYA'.

21.It is also to be noted that the goods under which the mark 'AROKIYA' is being used by the first respondent is in respect of 'INSTANT IDLI DOSA WET BATTER' and the said goods are totally different from the products used by the petitioner, which are basically dairy products.

22.Though the first respondent in its counter had raised defences that the petitioner is not an aggrieved party to enable the petitioner to file a petition under Section 47 of the Trade Marks Act, the said defence was not argued during the course of his arguments.

23.This Court is also of the view that the petitioner claiming to be an



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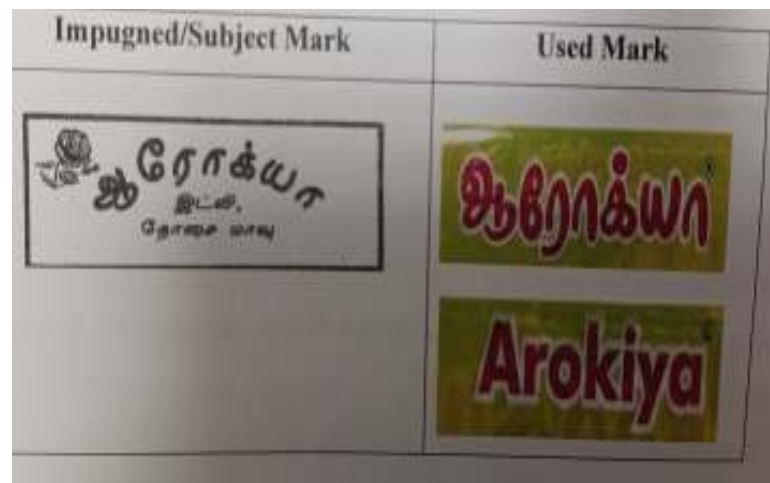
affected party has to be treated as an aggrieved party. Since the first respondent's counsel has not emphasised the said defence during the course of his arguments and in view of the fact that sufficient pleadings are placed on record by the petitioner, this Court is of the considered view that the petitioner can be treated as an aggrieved party. However, due to the reasons stated supra, even on merits, this petition is not maintainable. Therefore, the decision relied upon by the learned counsel for the petitioner in the case of **A.K.Al Muhaidib & Sons v. Chaman Lal Sachdeva reported in 2011 (1) SCC 125** with regard to the "aggrieved party" is concerned, no elaborate discussion is required from this Court since the petitioner is treated as an aggrieved party by this Court.

24.Insofar as the judgment relied upon by the learned counsel for the petitioner in the case of **Sanjay Chadha v. Union of India reported in 2022 SCC Online Del 509** is concerned, the said judgment is not applicable to the facts of the instant case since the petitioner has failed to establish the non-usage of the trade mark 'AROKIYA' by the first respondent for more than five years as this Court has categorically held that the alteration made by the first respondent to its registered trade mark 'AROKIYA' is not a



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substantial alteration which alters its prominent features but is a minor alteration which does not take away its identity as per the registered trade mark and squarely falls under Section 55 of the Trade Marks Act i.e. the trade mark presently used by the first respondent is equivalent to the registered trade mark obtained by the first respondent for the trade mark 'AROKIYA' in Class 30. The registered trade mark obtained by the first respondent for the trade mark 'AROKIYA' and the presently used trade mark by the first respondent is re-produced hereunder:



As seen from the above, it is clear that the trade mark 'AROKIYA' has been retained and only the device mark 'ROSE'



has been removed by the first respondent which would not amount to



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substantial alteration.

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25. For the foregoing reasons, this Court does not find any merit in this petition. Accordingly, this petition is dismissed. No costs.

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Index: Yes/ No

Speaking order / Non speaking order

Neutral citation : Yes / No

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Pre-delivery order in
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