



IN THE HIGH COURT OF JUDICATURE AT MADRAS

Judgment reserved on	12.12.2023
Judgment pronounced on	24.01.2024

CORAM

The Hon'ble Mr. Justice **SENTHILKUMAR RAMAMOORTHY**

(T) OP (TM) No.255 of 2023
(ORA/9/2018/TM/CHN)

Kaleesuwari Refinery Pvt. Ltd.
 #53, Rajasekaran Street,
 Opp. Kalyani Hospital,
 Dr.Radhakrishnan Salai
 Chennai-600 004.

... Petitioner

-vs-

1.Rathinasamy Gomathy, Ravindran Vijayalakshmi
 and Surendran Amsadevi, trading as SNR Dhall Mill,
 2/4, Vaidyanatha Mudali Street,
 Tondiarpet, Chennai-600 081.

2.Registrar of Trade Marks at Chennai
 Boudhik Sampada Bhawan,
 G.S.T.Road, Guindy, Chennai-600 032.

... Respondents

PRAYER: Transfer Original Petition (Trademarks) filed under Sections 47 and 57 of the Trade Marks Act, 1999, prays to order the removal of the impugned Trade Mark No.1232740 in Class 30 from



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the register and award costs and exemplary costs of the proceedings.

For Petitioner

: Mr.N.Surya Senthil,
Ms.Aiswarya for
M/s.Surana and Surana

For Respondents

: Mr.Ramesh Ganapathy
for M/s.Mission Legal for R1
Mr.M.Karthikeyan, SPC for R2

ORDER

Background

By this petition, the petitioner seeks rectification by way of removal of the following device mark from the register of trade marks :



2. The first respondent applied for registration of the device



mark extracted above on 05.09.2003 by asserting use since 01.06.1999.

The application was filed in class 30 in relation to toor dal, dal varieties and other goods in class 30. The registration certificate was issued on 19.09.2005 with the limitation that the registration shall not give an exclusive right to use the device of the man and other descriptive matters appearing in the label. A rectification petition was filed by the petitioner earlier in 2006 in respect of the same trade mark and withdrawn in 2013. The present rectification petition was filed in January 2018 before the Intellectual Property Appellate Board (IPAB) and subsequently came to be transferred to this Court.

Counsel and their contentions

3. Oral arguments on behalf of the petitioner were addressed by Mr.Surya Senthil, learned counsel of M/s.Surana & Surana, and by Mr.Ramesh Ganapathy, learned counsel of M/s.Mission Legal for the first respondent. Mr.M.Karthikeyan, learned SPC, appeared on behalf of the second respondent.



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4. Learned counsel for the petitioner submitted that the petitioner has used the trade mark 'GOLD WINNER' in relation to edible oil since 1999. Upon noticing the adoption and use of a device mark with a deceptively similar element, GOLD WINNER, he submitted that a rectification petition was filed by the petitioner before the Registrar of Trade Marks in the year 2006. He further submitted that the said rectification petition was withdrawn because the first respondent was not using the impugned trade mark at the time of withdrawal. Learned counsel submitted that the first respondent filed a suit (C.S.No.164 of 2017) before this Court thereafter alleging that the petitioner had infringed the first respondent's trade mark by adopting a deceptively similar trade mark and also sought to restrain the petitioner from passing off its products as those of the first respondent herein. By referring to the judgment and decree of this Court in C.S.No.164 of 2017, learned



counsel contended that the Court concluded that the element 'GOLD WINNER' was not an essential feature of the trade mark of the first respondent. When the matter was carried in appeal by the first respondent herein, he submitted that the Division Bench affirmed the judgment of the Single Judge. In particular, learned counsel referred to paragraphs 46, 47 and 60 of the judgment of the learned Single Judge and paragraphs 10,12,14 and 15 of the judgment of the Division Bench.

5. Learned counsel next contended that Section 124 of the Trade Marks Act, 1999 (the Trade Marks Act) is not applicable because the petitioner is not challenging the validity of registration of the first respondent's trade mark. Consequently, although this Court did not frame an issue regarding the validity of the trade mark while deciding C.S.No.164 of 2017, he submitted that the present petition is maintainable.



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6. As regards the withdrawal of the earlier rectification petition, learned counsel contended that the present petition is maintainable notwithstanding such withdrawal. According to learned counsel, a petition under Section 47 of the Trade Marks Act is maintainable after withdrawal of an earlier petition for rectification provided the petitioner satisfies the Court that there was non-use and that such non-use falls within the scope of Section 47.

7. By referring to the judgment of the Division Bench of this Court in *Haw Par Bros. International Ltd. v. Tiger Balm Co. (P) Ltd. & Others*, 1995 SCC OnLine Mad 189, learned counsel submitted that the Division Bench recognized the distinction between goodwill and reputation. While goodwill is restricted to a specific class of customers of particular goods/services bearing the relevant trade mark, he submitted that reputation extends beyond the specific class of goods. As a result of large scale sale and expenditure incurred



towards advertisements, he submitted that the petitioner has a reputation that extends beyond the specific goods in relation to which its trade mark is used, and is entitled to seek rectification if a deceptively trade mark is used. He also relied upon the judgment of this Court in *Godfrey Phillips India Limited v. Khoday India Limited and Ors*, MANU/TN/6291/2023.

8. In response to these contentions, Mr.Ramesh Ganapathy, learned counsel, opened his submissions by pointing out that the first respondent's trade mark was registered with effect from 05.09.2003 based on assertion of use from 01.06.1999. He next submitted that the petitioner filed a rectification petition before the Registrar of Trade Marks on 25.02.2006 both under Sections 47 and 57 of the Trade Marks Act. Learned counsel pointed out that the said petition was withdrawn by the petitioner in 2013 without obtaining leave to re-apply for rectification later. As a consequence of such withdrawal, learned counsel submitted that the present petition is not



maintainable. By referring to the present rectification petition, which was filed in September 2017, learned counsel pointed out that this petition was also filed both under Sections 47 and 57 of the Trade Marks Act. Since both the rectification petitions were filed under the same provisions of law, learned counsel submitted that the contention of learned counsel for the petitioner that this petition is maintainable under Section 47 cannot be countenanced.

9. By referring to paragraphs 35 to 38 of the judgment of the Hon'ble Supreme Court in *Patel Field Marshal Agencies v. P.M. Diesels Limited and Others(Patel Field Marshal)*, (2018) 2 SCC 112, learned counsel submitted that a person loses his right to subsequently apply for rectification of a trade mark if such person failed to challenge the validity of registration in a civil suit instituted earlier by the counter party. Since the petitioner did not challenge the validity of registration of the first respondent's trade mark in the civil suit filed by the first respondent earlier, he contended that the petitioner



relinquished the right to sue for rectification. Learned counsel also submitted that this petition is not founded on a cause of action that arose after withdrawal of the earlier petition and, indeed, is based on the identical cause of action. Consequently, he contended that this petition is not maintainable. He concluded his submissions by referring to and relying upon the judgment of the Hon'ble Supreme Court in *Hardie Trading Ltd. and another v. Addisons Paint & Chemicals Ltd.* (*Hardie Trading*), (2003) 11 SCC 92, particularly paragraphs 25,26,33,41 to 45 thereof for the proposition that only a person with genuine private interest would qualify as a person aggrieved for purposes of Section 47 of the Trade Marks Act. Learned counsel submitted that the petitioner does not qualify as a person aggrieved and that, therefore, the petition is liable to be dismissed.

10. By way of rejoinder, learned counsel for the petitioner submitted that the first respondent filed a suit against the petitioner alleging infringement. Moreover, the first respondent currently uses



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the deceptively similar trade mark 'GOLD WINNER', albeit on a substantially modified label. Consequently, as the prior adopter and user of the trade mark 'GOLD WINNER', he submitted that the petitioner fulfils the requirements for a person aggrieved under Section 47 of the Trade Marks Act as per the judgment of the Hon'ble Supreme Court in *Hardie Trading*. By referring to paragraph 15 of the judgment of the Division Bench in the appeal filed by the first respondent against the judgment and decree in C.S.No.164 of 2017, learned counsel reiterated that the Division Bench affirmed the findings of the learned Single Judge that the element GOLD WINNER is not an essential feature of the first respondent's trade mark. In order to substantiate the contention that the first respondent used a substantially altered trade mark, he relied on the depiction of the registered trade mark and the trade mark, as used, at pages 420 and 421 of volume No.2 of the documents filed by the first respondent. As a result of such substantial alteration, learned counsel also contended that rectification of the register will not



affect the first respondent.

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Discussion, analysis and conclusions

10. The first question that falls for consideration on the basis of the rival contentions is whether the petitioner qualifies as a person aggrieved. The first respondent relied on *Hardie Trading* to contend that the bar is set higher for a petition under Section 47 as compared to a petition under Section 57. The Supreme Court held, in *Hardie Trading*, that a petition under Section 57 may be prosecuted even in public interest because the continuance of a trade mark, which was entered on the register, or remains therein, without sufficient cause is against public interest. By contrast, it was held that removal for non-use can only be at the instance of a person who is directly affected, such as a competitor carrying on a similar business and using a similar mark in relation thereto. The first aspect to be noticed, in this regard, is that this petition was filed both under Sections 47 and 57.



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Even otherwise, both the petitioner and the first respondent carry on broadly similar businesses and apply a similar mark in relation thereto. In addition, the first respondent sued the petitioner for infringement on the strength of the mark sought to be rectified herein. When these facts and circumstances are considered cumulatively, the petitioner meets the threshold set in *Hardie Trading* by qualifying as a person aggrieved even if this were a standalone petition under Section 47.

11. The next question to be examined is whether the petition is maintainable. The admitted factual position is that the first respondent applied for registration of the device mark extracted in paragraph 2 on 05.09.2013. The said application was filed by asserting use since 01.06.1999 in relation to toor dal , dal varieties and other goods, and the registration was granted with effect from the date of application.



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12. The petitioner herein first applied for rectification before the Registrar of Trade Marks by filing Form TM-26 in February 2006. In the said rectification petition, the petitioner alleged that it noticed that the first respondent had registered a deceptively similar trade mark with the intention of capitalizing on the petitioner's reputation. The first respondent herein filed a counter to the said petition in November 2007. In the said counter, the first respondent asserted use of the trade mark in relation to toor dal and other dal varieties, rice, flour and spices since 1999. The first respondent also asserted that the petitioner was not manufacturing or marketing dal, rice and flour under the trade mark 'GOLD WINNER'. The first respondent further asserted that the petitioner's registration was in class 29, whereas the first respondent's registration was in class 30. About 7 years after the petition was filed, on 30.01.2013, the petitioner withdrew the rectification petition.



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13. The order passed by the Deputy Registrar of Trade Marks, in relation to such withdrawal, is set out below:

*“Proceedings having been taken under Section 57 of the Trade Marks Act, 1999 by the above named Applicants for Rectification to rectify the Register of Trade Marks by removing the above mentioned Registered Trade Mark **GOLD WINNER (label)** and whereas the above named Applicants for Rectification having desired to withdraw the Application for Rectification vide their counsel's letter dated 29th January, 2013;*

IT IS HEREBY ORDERED THAT Application for Rectification No.215502 is treated as withdrawn;

IT IS HEREBY FURTHER ORDERED THAT there shall be no order as costs of these proceedings.

Signed and Sealed at Chennai this the 30th day of January, 2013.”

It is significant to notice that the order of withdrawal does not refer to the reason for withdrawal or, more importantly, grant leave to the petitioner to re-apply for rectification.



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14. Notwithstanding such withdrawal, learned counsel for the petitioner submitted that this rectification petition is maintainable because the petition is founded on the ground of non-use. The said submission warrants close examination. The present rectification petition was filed in January 2018. As in the case of the earlier petition, it was filed both under Sections 47 and 57 of the Trade Marks Act. An explanation was provided for the withdrawal of the earlier rectification petition in paragraph 9(f) of the petition, which is set out below:

“9(f). It is pertinent to note that the present Petitioner had earlier filed a rectification against the impugned application. However the said proceedings went on for several years and as such in due course the Petitioner came to know that the respondent was not manufacturing and marketing dhall under the trademark “Gold Winner”, but instead was selling their product in loose/generic packaging including under the brand name “Wheel”. Therefore the Petitioner, believing that there was no infringement of their registered trademark by the respondent, and owing to the fact that the proceeding had been



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dragging on for several years, based on the advice received, did not pursue the rectification petition. Hence, though the Respondent allegedly registered the said mark "GOLD WINNER" in respect of dhalls in class 30, the Petitioner could not find even an iota of evidence regarding use of the alleged trademark by the Respondent. Notwithstanding the above, the respondent has now challenged the very bona fide use of the mark Gold Winner by the petitioner. As said above, "GOLD WINNER" and its variants are distinctive and are associated only with the Petitioner and its goods. Therefore, the impugned mark of the Respondent is wrongly registered and wrongly remains in the register as per Section 47 of the Trade Marks Act, 1999 ("Act") for no bona fide use of the mark."

Prior to the filing of this petition, the first respondent herein filed C.S.No.164 of 2017 against the petitioner alleging infringement and claiming relief in respect thereof. In the written statement of the petitioner herein in C.S.No.164 of 2017, the previous rectification petition was referred to and the same reasons were provided for withdrawal of such petition. Before examining the implications of the explanation of the petitioner for the withdrawal of the earlier



rectification petition, it is instructive to consider the statutory prescription on rectification for non-use.

15. The failure by the registered proprietor to use the trade mark provides a cause of action to a person aggrieved to apply for rectification under Section 47 of the Trade Marks Act. Section 47, in relevant part, is as under:

“47. Removal from register and imposition of limitations on ground of non-use.

(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the [High Court] by any person aggrieved on the ground either--

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or



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(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

As is evident from the text of Section 47(1), rectification may be requested under this provision either if the registered proprietor obtained the registration without the *bona fide* intention of using the registered trade mark and proceeded to not use such trade mark or where the registered proprietor failed to use the trade mark in relation to the relevant goods or services for a continuous period of not less than five years ending three months prior to the institution of the rectification petition.

16. Reverting to the explanation for withdrawal, two reasons are set out: (a) the proceedings being pending for several years; and



(b) no evidence of use of the trade mark in relation to goods. The first reason is undoubtedly no justification for withdrawing a petition and thereafter re-prosecuting for the same relief. Moving to the second reason, lack of evidence of use, while it may have served as justification for not suing for infringement, it strengthens the case for rectification under Section 47. Consequently, said reason justifies continued prosecution for rectification on the ground of non-use and not withdrawal. Hence, the only ground on which the present petition would be maintainable is if the cause of action arose after the earlier petition was withdrawn. Whether the petitioner established a fresh cause of action after such withdrawal is examined next.

17. I first examine whether a fresh cause of action arose under clause (a) of sub-section (1) after withdrawal of the earlier petition. In order to maintain a petition under this clause, the petitioner should establish that there was no *bona fide* intention to use the trade mark even at the time of registration. Assuming that to be the case, it



would be the same cause of action as the earlier withdrawn petition and this second rectification petition cannot be maintained under clause (a) of sub-section (1) of Section 47.

18. Turning to clause (b) of sub-section (1) of Section 47, the time limit prescribed therein with regard to non-use is a continuous period of five years ending three months prior to the filing of the petition. Especially in view of the reasons for withdrawal, this period cannot be calculated from a date prior to the withdrawal of the earlier rectification petition because non-use, if any, prior to such date would have either formed the cause of action for the earlier petition or, at a minimum, would have constituted a compelling reason to continue to prosecute and not withdraw the petition for rectification. The only basis, therefore, on which this petition would be maintainable despite the withdrawal of the earlier petition is if a fresh cause of action accrued to the petitioner on account of non-use of the trade mark for not less than the length of time prescribed in



Section 47(1)(b) after the withdrawal of the earlier petition. The earlier petition was withdrawn on 30.01.2013. If the five year period were to be calculated from such date, it would end on or about end January 2018 and, if three months are added thereto, it would mean that this petition could not have been filed before May 2018, whereas the petition was filed in January 2018. Thus, this petition is not maintainable either under clause (a) or (b) of sub-section (1) of Section 47.

19. The maintainability of this petition was also sought to be defended on the ground of use by the first respondent of a substantially altered trade mark. Effectively, the contention is that the use of a substantially altered trade mark is tantamount to non-use of the registered trade mark. Before considering the merits of this contention, it is pertinent to notice that the record shows that the first respondent uses the following trade mark in relation to dal :



In support of the contention that the trade mark is substantially different from the registered trade mark, learned counsel for the petitioner relied upon the findings of the learned Single Judge and the Division Bench. The finding of the learned Single Judge and the Division Bench is to the effect that the first respondent herein had not proved the use of the registered label mark, and that the first respondent used a modified version of the trade mark.

20. In view of the above findings being recorded in connected civil proceedings, for the purpose of determining the question of maintainability, I proceed on the basis that the first respondent used



a modified version of the registered trade mark. Even so, the petitioner fails to surmount two hurdles. First, in the preceding paragraph, I concluded that the non-use period prescribed in Section 47(1)(b) did not lapse after withdrawal of the earlier rectification petition. Assuming that the first respondent started using the modified label after the withdrawal of the earlier rectification petition, the prescribed period has certainly not lapsed to maintain the petition under Section 47(1)(b). Secondly, as regards Section 47(1)(a), the lack of *bona fide* intention to use the mark should be established as of the date of registration. As stated earlier in the context of non-use, any allegation as of the date of registration would be the same cause of action as the earlier withdrawn petition and this second rectification petition cannot *a fortiori* be maintained under clause (a) of sub-section (1) of Section 47 on the ground of use of a modified label when it is not maintainable for complete non-use.



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21. Both on the ground that the cause of the action for this petition was not different from the earlier petition and because the prescribed non-use period had not lapsed, I conclude that this rectification petition is not maintainable and is liable to be rejected on this preliminary issue. In view of the conclusion that the petition is not maintainable, it is unnecessary to deal with the other contentions.

22. Therefore, (T)OP(TM)/255/2023 is dismissed as not maintainable without any order as to costs.

24.01.2024

Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No
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To

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1.Rathinasamy Gomathy, Ravindran Vijayalakshmi
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SENTHILKUMAR RAMAMOORTHY J.



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Pre-deliver order made in
(T) OP (TM) No.255 of 2023
(ORA/9/2018/TM/CHN)

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