



(T)CMA(TM) Nos.13,14,15, 111 & 116 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 26.03.2024

CORAM :JUSTICE N.SESHASAYEE

(T)CMA(TM) Nos.13,14,15, 111 & 116 of 2023
(OA Nos.39, 40, 43, 40 & 42 /2011/TM/CHN)

Karnataka Cooperative Milk Producers
Federation Limited

KMF Complex

Hosur Road

Bangalore – 560 029.

... Appellant in all cases

Vs

1.N.Ananda

Trading as M/s.Nandhini

No.114/2, Lalbagh Fort Road

Minerva Circle

Bangalore – 560 004.

2.The Deputy Registrar of Trade Marks

Office of the Trade Marks Registry

I P Building, GST Road

Guindy, Chennai – 600 032.

... Respondents 1 &2 in all cases

PRAYER in (T)CMA(TM) No.13 of 2023: The appeal came to be filed by transfer of IPAB case in SR.No.381/2009/TM/IPAB from the file of Intellectual Property Appellate Board, Chennai in OA/39/2011/TM/CHN praying for the following reliefs:

(a) call for the records, quash and set aside the order of the Hon'ble Deputy Registrar / 2nd respondent herein dated 17.04.2009 in



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Opposition No. MAS – 256162 to Application No.1360905 in Class 42 and consequently disallow and dismiss the Application No.1360905 in Class 42;

- (b) costs of the opposition proceedings and the instant appeal proceedings to the appellant
- (c) such other or other relief as this Court may deem fit and proper in the circumstances of the case.

PRAYER in (T)CMA(TM) No.14 of 2023: The appeal came to be filed by transfer of IPAB case in SR.No.327/2010/TM/IPAB from the file of Intellectual Property Appellate Board, Chennai in OA/41/2011/TM/CHN praying for the following reliefs:

- a) call for the records, quash and set aside the order of the Hon'ble Deputy Registrar / 2nd respondent herein dated 12.04.2010 in Opposition No. MAS – 732170 to Application No.982280 in Class 33 and consequently disallow and dismiss the Application No. 982280 in Class 33;
- b) costs of the opposition proceedings and the instant appeal proceedings to the appellant
- c) such other or other relief as this Court may deem fit and proper in the circumstances of the case.

PRAYER in (T)CMA(TM) No.15 of 2023: The appeal came to be filed by transfer of IPAB case in SR.No.330/2010/TM/IPAB from the file of Intellectual Property Appellate Board, Chennai in OA/43/2011/TM/CHN praying for the following reliefs:



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- a) call for the records, quash and set aside the order of the Hon'ble Deputy Registrar / 2nd respondent herein dated 12.04.2010 in Opposition No. MAS – 732171 to Application No.982283 in Class 32 and consequently disallow and dismiss the Application No. 982283 in Class 32;
- b) costs of the opposition proceedings and the instant appeal proceedings to the appellant
- c) such other or other relief as this Court may deem fit and proper in the circumstances of the case.

PRAYER in (T)CMA(TM) No.111 of 2023: The appeal came to be filed by transfer of IPAB case in SR.No.325/2010/TM/IPAB from the file of Intellectual Property Appellate Board, Chennai in OA/40/2011/TM/CHN praying for the following reliefs:

- a) call for the records, quash and set aside the order of the Hon'ble Deputy Registrar / 2nd respondent herein dated 12.04.2010 in Opposition No. MAS – 721033 to Application No.1294121 in Class 42 and consequently disallow and dismiss the Application No. 1294121 in Class 42;
- b) costs of the opposition proceedings and the instant appeal proceedings to the appellant
- c) such other or other relief as this Court may deem fit and proper in the circumstances of the case.

PRAYER in (T)CMA(TM) No.116 of 2023: The appeal came to be filed by transfer of IPAB case in SR.No.329/2010/TM/IPAB from the file of



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Intellectual Property Appellate Board, Chennai in OA/42/2011/TM/CHN
praying for the following reliefs:

- d) call for the records, quash and set aside the order of the Hon'ble Deputy Registrar / 2nd respondent herein dated 12.04.2010 in Opposition No. MAS – 722405 to Application No.982282 in Class 16 and consequently disallow and dismiss the Application No. 982282 in Class 16;
- e) costs of the opposition proceedings and the instant appeal proceedings to the appellant
- f) such other or other relief as this Court may deem fit and proper in the circumstances of the case.

For Appellant : Mr.S.Ravi, Senior Counsel
Assisted by Ms.Indumathi Ravi

For Respondent : Mr.J.Madanagopal Rao
Senior Panel Counsel for R2

R1 – No Appearance

COMMON JUDGMENT

This batch of appeals are directed against a set of Orders passed by the Trademark Registry dismissing the appellant's opposition to the registration of the mark of the first respondent.

Facts



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2. The case of the appellant is as below :

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- a) The Appellant's trademark NANDINI is in use from 1983 and is also a well-Known trademark within the meaning of section 11(2) of the Trade Marks Act, 1999 and its mark is recognized all over India and enjoys tremendous reputation and good will. The appellant has several registrations in Classes 29, 30, 31 and 32.
- b) Much reputation and valuable goodwill have occurred to appellant's well known NANDINI marks by reason of long continuous use, advertisement, publicity and sales promotion work, and also by reason of the superior quality of the goods sold or services rendered under its said mark through multiple channels of trade.

2.2 The first respondent has adopted a trademark NANDHINI for its vegetarian and non-vegetarian restaurant, and has applied for registering its mark in classes 29,30,32,33 and 34. As the mark of the appellant is strikingly and deceptively similar to the trademark of the appellant has filed its opposition before the Trademark Registry.

2.3 Before the second respondent, the first respondent had filed its counter wherein it contended that its mark NANDHINI has a particular artistic design



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and get-up for running vegetarian and non-vegetarian Andra style Restaurant in the year 1989. and they have opened 7 branches all over Bangalore under its trade name NANDHINI since 1989 and that its mark is distinguishable from the mark of the appellant.

3. The appellant have filled their evidence in support of opposition under Rule 50 & 51 on different dates i.e., 30.10.2007, 02.03.2009, 25.06.2008, 03.04.2009 & 08.08.2008 respectively and the matter came to be heard by the second respondent who eventually chose to dismiss all the oppositions of the appellant on the ground that the appellant's trade name is a generic name of Goddess Lakshmi (which is the opinion of the Hon'ble Supreme Court in *Nandhini Deluxe Vs Karnataka Cooperative Milk Producers Federation Limited*, (2018) 9 SCC 183) and that appellant's mark is not a well known mark.

4. Challenging the above orders of the second respondent, this batch of appeals are filed. Notice of the appeals are served on the first respondent, but it chose not to contest these appeals.

5. Heard the learned counsel for the appellant and the second respondent.



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This Court carefully perused the records, and found that only in three out of five cases, the petitioner has made available the exact marks of the appellant and the first respondent. While they are presented to the Court in black and white, this Court through internet-verification found that there is colour scheme and other design attached to the them.

6. Turning to the line of reasoning of the second respondent in the order now impugned in this appeal, this Court is in partial agreement with it. Where this Court differs is that, when there is clash between two registered owners of the same mark, it is imperative, that the Registrar exercises his powers under Sec.12 of the Act, and may impose such conditions as may let both the owners of the same mark co-exist in their respective businesses using their respective marks. Milk and butter which the appellant sells cannot be equated to running a restaurant, a business which the first respondent is engaged in. However, each of these owners must have peaceful co-existence, and hence balancing their respective interests over their respective intellectual property through appropriate conditions is mandatory. Here, the second respondent has missed a point.



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7. This Court therefore, deems it appropriate to allow these appeals, set aside the orders of the second respondent impugned herein, and remands the opposition of the appellant back to the second respondent with a direction to exercise his powers under Sec.12 of the Act to order commercial and proprietary interests of both the appellant and the first respondent are protected. No costs.

26.03.2024

Index : Yes / No

Neutral Citation : Yes / No

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To:

The Deputy Registrar of Trade Marks

Office of the Trade Marks Registry

I P Building, GST Road

Guindy, Chennai – 600 032.



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N.SESHASAYEE, J.

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