



(T) OP (TM) Nos.319 & 320 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 28.06.2024

Pronounced on:06.09.2024

CORAM:

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

(T) OP (TM) Nos.319 & 320 of 2023

M/s.GM Modular Private Limited,
405, Shalimar Morya Park,
New Link Road, Opp. Infinity Mall,
Andheri (W), Mumbai – 400 053

... Petitioner in the above OPs

..Vs.

1.K.Dalpat Singh,
No.148-150, K.K. Lane No.1,
Avinashi Road, Coimbatore – 641 018,
Tamil Nadu.

..1st respondent in (T) OP (TM) No.319 of 2023

1.D.Pepi Devi
No.148-150, K.K. Lane No.1,
Avinashi Road, Coimbatore – 641 018,
Tamil Nadu.

..1st respondent in (T) OP (TM) No.320 of 2023

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

.. 2nd Respondent in the above OPs



(T) OP (TM) Nos.319 & 320 of 2023

Common Prayer: This Petition came to be numbered by transfer of O.R.A.Nos.37 & 38/2019/TM/CHN, from the file of the Intellectual Property Appellate Board, Chennai to remove/rectify/expunge the entry pertaining to impugned trademarks 'Gm Pipe' registered under No.2826667 in Class No.19 and 'Gmware' registered under No.2945975 in Class 11, from the Register.

For Petitioner : Mr.Shravankumar Bansal and
Mr.Somnath De.

For Respondents : Mr.S.Diwakar and
Ms.Antara Balaji for R1
Mr.K.Subbu Ranga Bharathi,
Senior Panel Central Government
Standing Counsel for R2

COMMON ORDER

The present Original Petitions have been filed seeking removal of the impugned trademark 'GM Pipe' registered under No.2826667 in Class 19 and 'GMware' registered under No.2945975 in Class 11 in favour of the respective 1st Respondent in each of the petitions.

2. I have heard, learned counsel Mr.Shravankumar Bansal & Mr.Somnath De for the Petitioners in both the OPs and Mr.S.Diwakar &



Ms. Antara Balaji, learned counsel for the 1st Respondent and Mr. K. Subbu Ranga Bharathi, learned Senior Panel Central Government Standing Counsel for the 2nd Respondent.

3. The learned counsel for the Petitioner would submit that the Petitioner has been having the benefit of various registered trademark, word per se 'GM' right from 1999 onwards. The trademark 'GM' is also being used in a distinctive and artistic manner and the trade name of the Petitioner is also 'GM Modular Pvt. Ltd.' The Petitioner also has registration of copyright of its GM label. The Petitioner has built a valuable trade under its trademarks/labels and have also achieved phenomenal sales figures over the years and acquired an enviable goodwill and reputation in the market.

4. The 1st Respondent, in bad faith has applied for registration under Class 19 on 14.10.2014, knowing fully well and that it would lie only under Class 17. He would also submit that the Delhi High Court has granted an injunction against the 1st Respondent and the said order is in force and the 2nd Respondent ought not to have granted registration to the 1st Respondent.



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5. The learned counsel for the Petitioner would submit that the impugned mark of the 1st Respondent is similar and identical with the Petitioner's mark/label and in the interest of purity of the Register the 1st Respondent's mark is liable to be removed from the Register. The learned counsel for the Petitioner would also contend that the 1st Respondent has not shown any use and what all is shown are only self-serving documents and created invoices for the purposes of the case. His further submission is that for an action of passing off, there is no requirement for the goods to be similar or same. He would point out the change in position post 1999 amendment to the Act.

6. Insofar OP No.320 of 2023, the learned counsel for the Petitioner would submit that the 1st Respondent is the wife of the 1st Respondent in OP No.319 of 2023 and in this case the impugned mark is 'GMware'. The 1st Respondent, claiming user from 2013 has obtained the registration in Class 11. He would further rely on the invoices filed by the 1st Respondent showing sales in 2018 and would vehemently contend that the same is in gross violation and contempt of the injunction order passed by the Delhi High Court in 2018. He would therefore state that the 1st Respondent's



conduct is mala fide.

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7. The learned Counsel for the Petitioner would rely on the following decisions:

i) *American Home Products Corporation v. Mac Laboratories Private Limited*, reported in *AIR 1986 SC 137*;

ii) *Midas Hygiene Industries Private Limited. v. Sudhir Bhatia*, reported in *2004 (73) DRJ 647 (SC)*;

iii) *Anchor Health & Beauty Care Private Limited. v. Shivam Hygienes India Private Limited*, reported in *2013 (56) PTC 441 (Del)*;

iv) *Borosil Glass Works Limited v. V.O.P. Batra and another*, reported in *1995 PTC (16) (Del)*;

v) *Pfizer Enterprises Sarl v. Cipla Limited*, reported in *2009 (39) PTC 358(Del)(DB)*;

vi) *Laxmikant V. Patel v. Chetanbhai Shah and another*, reported in *(2002) 3 SCC 65*;

vii) *Vguard Industries Limited v. Crompton Greaves Consumer Electricals Limited* in *CS (Comm) 92/2022 dated 12.05.2022*;

viii) *Pidilite Industries Pvt. Limited v. Jubilant Agri & Consumer Products*, reported in *2014(57) PTC 617 (Bom)*; and



ix) *Mahendra & Mahendra paper Mills Ltd. v. Mahindra & Mahindra Limited*, reported in (2002) 2 SCC 147.

8. The learned counsel for the Petitioner would therefore pray for the Petitions being ordered as prayed for.

9. Per contra, Mr.S.Diwakar, learned counsel for the 1st Respondent would submit that in terms of WIPO NICE classification, the goods fall only under Class 19, being rigid pipes, not of metal and hence the 1st Respondent was right in applying under Class 19 and there was nothing mala fide or dishonest about it.

10. The next submission urged by Mr.Diwakar, learned counsel for the 1st Respondent is that the Petitioner ought to have obtained leave under Section 124, since admittedly the Petitioner had filed the suit earlier in point of time. In this regard he would take me through the decision of the Apex Court in *Patel Field Marshal Agencies and others v. P.M.Diesels Limited and others*, reported in *AIR 2017 SC 5619* and submit that the rectification petitions filed directly before the IPAB without getting leave under Section



124 of the Trademarks Act, 1999 (in short 'Act') were not maintainable.

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11. The next submission raised by the learned counsel for the 1st Respondent is that the deponent who has sworn to the papers before the IPAB and now transferred to this Court was not authorised to represent the Petitioner company and the board resolution passed by the Petitioner was only to file a civil suit. In this context, he would place reliance on *Nibro Limited. vs. National insurance Co. Ltd.*, reported in *AIR 1991 Del 25*.

12. The Counsel for the 1st Respondent would also contend that both Classes 17 & 19 deal with PVC but Class 19 was relevant since it dealt with rigid PVC and the Petitioner, even according to their own admissions, never had a Class 19 registration in their favour and that implies that the Petitioner does not sell goods falling under Class 19. Under Section 17 of the Act, the Petitioner cannot claim any monopoly and cut across classes and prevent the 1st Respondent from doing business in totally different goods which are used only in construction of buildings whereas the Petitioner deals only with electrical goods.

13. According to the learned counsel for the 1st Respondent, the ratio



laid down in *Vishnudas Trading as Vishnudas Kishandas v. Vazir Sultan Tobacco Co. Limited, Hyderabad and others*, reported in *AIR 1996 SC 2275*, would squarely apply to the facts of the present case. He would further submit that the Petitioner has no declaration of a well-known mark in its favour and therefore, it is for the Petitioner to prove reputation in 2013, when the 1st Respondent adopted the impugned mark.

14. Placing reliance on the ratio laid down in *Associated Electronic & Electrical Industries (Bangalore) Pvt. Limited v. Sharp Tools*, reported in *AIR 1991 Kar 406*, he would submit that only visual similarity was relevant in so far as copyright registration is concerned and there is no violation of the device mark registered in favour of the Petitioner.

15. In so far OP No.320 of 2023, the learned Counsel for the 1st Respondent would submit that the 1st Respondent's goods are only apparatus for water supply which has nothing to do with the Petitioner's registration. He would rely on *Vazir Sultan's* case (referred herein supra) and submit that both marks can co-exist and there is no possibility of confusion. In so far as the order of the Delhi High Court, the learned



counsel for the 1st Respondent would contend that only GM Pipes was covered and GMware was not covered.

16. I have carefully considered the rival submissions advanced by the learned counsel on either side. I have gone through the pleadings as well as the decisions on which reliance is placed on by the learned counsel for the parties.

17. This Court on 21.02.2024, framed the following common issues in the above petitions:

“1. Whether the impugned trademark 'Gmware' is contrary to the provisions of Trade Marks Act, 1999?

2. Whether the impugned trademark 'Gmware' is liable to be rectified as per the petition and documents of the petitioner?

3. Whether the impugned mark is liable to be rectified from the register of Trademarks by expunging the respondent No.1's Trademark Registration under No.2945975 in Class 11? OPP

4. Whether the impugned trademark 'GM PIPE' is contrary to the Provisions of Trade Marks Act, 1999?

5. Whether the impugned trademark 'GM PIPE' is liable to be rectified as per the petition and documents of the petitioner?

6. Whether the impugned mark is liable to be rectified from the register of Trademarks by expunging the respondent No.1's Trademark Registration under No.2826667 in Class



19?OPP

7. To what other reliefs is the petitioner entitled?"

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18. All the issues are taken up together since the arguments advanced by the learned counsel on either side has touched upon all the issues in common.

19. I will first take up the objection regarding leave not being obtained under Section 124 of the Act. The learned counsel for the Petitioner would contend that the plea of Section 124 leave not being obtained has not been taken by the 1st Respondent earlier and for the first time, it is raised during the course of arguments and he would therefore submit that this issue cannot be considered at all.

20. I do not find this objection taken in the counter affidavits filed by the 1st Respondent and consequently, no issue has also been framed by this Court as well. Though the learned counsel has also cited a few judgments on this aspect to fortify his contentions, I do not see any of those judgments applying to the facts of the present case. It is no doubt, settled law that new or additional pleas cannot be taken during arguments and only aspects that



have been leaded should be considered. However, in a case of this nature, where a pure legal question is raised, there is no impediment for the Court to ignore it on the ground that the said legal issue has not been pleaded. The Courts are well within their right to consider legal questions, though not forming part of the pleadings. However, in order to apply the said legal question raised, if it is necessary the relevant material should be available or placed on record before the Court for it to decide whether the said legal plea would apply to the facts of the present case.

21. Section 124 of the Trade Marks Act, 1999 is extracted hereunder:

“1)Where in any suit for infringement of a trade mark—

(a)the defendant pleads that registration of the plaintiff’s trade mark is invalid; or

(b)the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff pleads the invalidity of registration of the defendant’s trade mark, the court trying the suit (hereinafter referred to as the court), shall,

(i)if any proceedings for rectification of the register in relation to the plaintiff’s or defendant’s trade mark are pending before the Registrar or the Appellate Board, stay the suit pending the final disposal of such proceedings;

(ii)if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff’s or defendant’s trade mark is prima facie tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the Appellate Board for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b) (ii) of sub-section (1) within the time specified therein or within such extended time as the court may for



sufficient cause allow, the trial of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction, directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit. ”

22. In the present case, admittedly, the suit was filed earlier. In this context, Section 124(1)(b)(ii) of the Act would apply and in such a case, if the Court is satisfied about the plea of invalidity of the registration of either of the marks, is prima facie tenable, it should raise an issue in that regard and adjourn the case for a period of 3 months from the date on which the issue is framed to enable the party concerned to apply for rectification of the register.

23. Section 124(3) mandates that when no such application has been made within the time prescribed or as extended by the Court, the issue



regarding validity of the registration of the trademark concerned shall be deemed to have been abandoned.

24. On a careful reading of the above Section, it is clear that mere pendency of a suit is not a requirement for a party to seek leave and approach the High Court for rectification of the impugned mark. It is only when the plea of invalidity of registration is raised and the Court trying the suit is prima facie satisfied that such a plea is tenable, the Court shall frame an issue in this regard to enable the party to seek rectification. In this backdrop, the 1st Respondent has neither filed the copy of the written statement filed in the suit before the Delhi High Court nor the issues framed to establish that the mandate of Section 124(3) would kick in to hold that the plea of invalidity of the impugned mark is deemed to be abandoned.

25. In *Patel Filed Marshal's* case, (referred herein supra) the Hon'ble Supreme Court held that all questions with regard to the validity of the trademark are required to be decided only by the Registrar or IPAB or the High Court and not by the Civil Court. It further held that where a suit is pending, whether instituted before or after the filing of the rectification



petition, the exercise of jurisdiction by the prescribed statutory authority is contingent on a finding of the Civil Court as regards prima facie tenability of the plea of invalidity. It further held that the Tribunal will however come into seisin of the matter only if the Civil Court is satisfied that an issue with regard to invalidity ought to be framed in the suit and once an issue is framed, the matter will have to go to the Tribunal and the decision of the Tribunal will thereafter bind the Civil Court. Only where, despite the order of the Civil court, the parties do not approach the Tribunal for rectification, the plea with regard to rectification will no longer survive.

26. Therefore, even applying the ratio of the Apex Court in the above case, it is pre-requisite for the Civil Court to satisfy itself regarding the issue of invalidity and further frame an issue in that regard to enable filing of a rectification petition. The 1st Respondent has not filed any material before the Court as to whether the Delhi High Court, where the suit is pending, has satisfied itself prima facie and whether any issue has been framed in that regard. In the absence of such vital particulars, it is not possible for this Court to hold that the plea of invalidity has been abandoned by the Petitioner.



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27. As regards the next preliminary contention that the person who has filed the petitions is not duly authorised, the learned counsel for the 1st Respondent has placed reliance on *Nibro's* case, (referred herein surpa). In the said case, the Court held that authority to institute a suit on behalf of a company is not a technical matter and it has far-reaching effects and only by passing a resolution, power can be conferred.

28. The learned counsel for the Petitioner, per contra, would cite the decision of the Apex Court in *United Bank of India v. Naresh Kumar and others*, reported in (1996) 6 SCC 660, where it has been held that substantive rights should not be allowed to defeat on technical grounds of procedural irregularity so as to ensure that no injustice is done to any party. It further held that the Court can even render a finding regarding ratification based on evidence on record. Ratification by the company, expressly or impliedly is permissible in law.

29. In the present case, a Board Resolution has been passed on 14.02.2018, authorising Mr.Divyang Jain, Depot Manager to sign, verify,



institute the suit on behalf of the company against both the Respondents in the two rectification petitions. No doubt there is reference only to 'the suit' which refers to the suit already instituted before the Delhi High Court based on this resolution. However, I find that two fresh Board Resolutions dated 13.06.2024 have been passed, ratifying the actions taken by Mr.Divyang Jain in connection with these proceedings. In view of the same, I do not find it necessary to dwell further with regard to the issue of maintainability of the petitions on the ground of they being initiated by a person not duly authorised to do so. In fact, the learned counsel for the respondent also fairly conceded to this on being brought to notice about the new resolutions.

30. Now, coming to the merits of the claims in these rectification petitions, the Petitioner admittedly has a registration of its trademark GM under Class 17. The registration which is impugned in the present proceedings is under Class 19. It is also the specific case of the 1st respondent that the Petitioner does not deal with the class of goods dealt with by the 1st Respondent under Class 19 and therefore, there is no question of cancellation or removal of the marks of the Respondent.



31. Class 17 to the Fourth Schedule to the Trade Marks Rules, 2002 deals with ‘rubber, gutta percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.’

32. Class 19 of the same Schedule deal with ‘Building materials, (non-metallic), non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

33. The bone of contention of the learned counsel on either side actually boils down to whether the 1st respondent who has applied and obtained a registration for ‘non-metallic building material, non-metallic rigid pipes for building, raw material for non-metallic rigid pipes, rigid PVC tubes and pipes and accessories, PVC pipes for flow of liquid’ was entitled to make an Application under Class 19 or as to whether the proper Class under which he ought to have applied is Class 17 only.

34. Interestingly, the 1st Respondent has also made an Application for



registration under Class 17 on the very same day. i.e. 14.10.2014 for 'Plastics flexible pipes not of metal- PVC tubes and pipes and accessories'.

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The Petitioner has opposed the said Application on 12.12.2018 and the issue is not yet decided and the same is still pending.

35. Interestingly, the 1st Respondent has issued a notice on 06.04.2018 to the Petitioner wherein it is contended that the Petitioner has unlawfully used the 1st Respondent's mark, 'Gm Pipe'. The 1st Respondent has chosen to differentiate Classes 17 and 19 and stated that the Petitioner's permissible product was flexible pipes and not rigid pipes. The 1st Respondent has further accused the Petitioner's goods to be deceptively similar to the goods of the 1st Respondent and that it is likely to lead to confusion in the market. Therefore, it does not lie in the mouth of the 1st Respondent to contend that the 1st Respondent's mark is not deceptively similar to the Petitioner's mark.

36. In fact, the argument of the learned counsel for the 1st Respondent, is that the Petitioner does not have a registration under Class 19 and therefore, the 1st respondent's registration cannot be cancelled and



countenanced. Though he would also place reliance on WIPO NICE Classification to attempt and impress upon the Court that the goods are very different and the registration is also in different classes, I do not see any merit in such a contention. The classification of goods is only for the purposes of registration at the time of application being made to the Registrar and more for the convenience of the Registrar. If in a given case, it is shown that the goods or marks are identical or deceptively similar, there is no fetter on the Court to grant relief by way of rectification or cancellation and the mere fact that the goods are registered under different Classes will not come in the way.

37. The orders of the Delhi High Court also assume significance. Insofar as the Respondents herein, the learned Additional District Judge-01, New Delhi, on 09.05.2018, in TM No.54/18, has found a prima facie case being made out by the Petitioner and granted an interim order restraining the Respondents from using GMagic, GMGMAGIC, GmG Magic, G Magic, GmG MAGIC Pipe, Gm Bath, Gm Pipe etc. as well as trade name GM, formative GM marks/labels, GMAGIC, GMAGIC MINI MODULAR SERIES in relation to their impugned goods and business of electrical pipes,



accessories and fittings and other allied/related and cognate products and from doing any other acts or deeds amounting to likely to infringe the Petitioner's registered trademark/labels GM etc. The said order admittedly is in force even as on date. The order is a very sweeping order and the Respondents are bound by the same. Even if it is contended that it is only an interim order, it does not give any liberty to the Respondents to violate the same and in defeasance use the Petitioner's marks as it would only amount to committing disobedience/contempt of the order of the Court.

38. Similarly, in TM No.42 of 2017, by order dated 25.04.2017, the Petitioner has obtained an order of interim injunction against the 1st Respondent, restraining use of trademark/label, GM & GMAGIC and/or any other trade word/mark/label/device which may be identical with and/or GM and GMAGIC in relation to manufacturing and marketing of C.P. Bath fitting and sanitary apparatus and installations relating thereto and other allied and cognate goods, till further orders.

39. The 1st Respondent in OP No.320 of 2023 has filed a typed set of papers to evidence use of GMWARE. Invoices of the year 2017 onwards



and in fact up to March 2023 have been filed. In the teeth of the order of the Delhi High Court, the 1st Respondent in OP No.320 of 2023 has clearly disobeyed the interim order which is admittedly in force. Further, the invoices that have been filed have no GST numbers, all of them are hand written and appear to be self-serving and created for the purposes of showing use. The said invoices do not appear to be credible documents even on the face and hence even from this angle, the 1st Respondent is either guilty of violation of the interim order of the Delhi High Court or having projected fabricated documents to evidence use of Gmware. Therefore, I do not find any bona fides in the actions of the 1st Respondent in OP No.320 of 2023.

40. Even in respect of OP No.319 of 2023, the 1st Respondent even on the date of his Application for registration under Class 19, was not only aware but also conscious of the fact that the Petitioner had a registration under Class 17 and in fact the 1st Respondent's Application was also opposed by the Petitioner. Therefore, the very argument of the 1st Respondent that the registration of the Petitioner is under a totally different Class, viz. Class 17 and therefore, there can be no rectification of the 1st



Respondent's registration under Class 19 is clearly fallacious and totally unacceptable, especially factoring the conduct of the 1st Respondent in applying for registration under Class 19 after having made an application for registration only under Class 17.

41. Now turning to the next and most important, rather crucial aspect that needs to be seen, whether the 1st Respondent's mark is hit by the provisions of Section 11(1) of the Trademarks Act, 1999. The point to be determined here is as to whether there is any similarity of the marks of the 1st Respondent and the Petitioner and as to whether there exists a likelihood of confusion on the part of the public.

42. The Petitioner has certainly established by overwhelming documentary evidence that the Petitioner has been extensively using its mark GM and various other marks right from the inception, viz. 1999 when it got registration of its marks. The 1st Respondent admittedly got a registration under Class 19 only in the year 2014, with a user claim from 2013. Petitioner has shown by filing several invoices that they have been using their marks even from 1993 onwards. Therefore, it is crystal clear that



the Petitioner is a prior user of the mark GM and other related marks. The case of the Respondent is that their goods are entirely different and is dealing only in PVC pipes and not electrical goods, which is the mainstay of the Petitioner. It is not the case of the 1st Respondent that the 1st Respondent is a prior user or that there has been an honest and concurrent use and therefore the 1st Respondent is entitled to protection.

43. As already seen, the 1st Respondent himself chose to register his mark under Class 17 only and the same was promptly opposed and simultaneously the 1st Respondent has also made an Application under Class 19 and got it successfully registered. The attempt on the part of the 1st Respondent is clearly mischievous and only to hoodwink the Petitioner into not opposing the Application made under Class 19. Admittedly both the parties deal with pipes. The case of the 1st Respondent is that the Petitioner deal only with electricity related goods whereas the 1st Respondent is dealing with pipes used in the construction industry. It cannot be said that the field or sphere of business of the parties is so distinct that there is no possibility of any confusion, considering the fact that both of them supply to the construction industry. Therefore, there is a likelihood of the customers



getting an impression that the goods of the 1st Respondent are actually goods of the Petitioner who has shown a good reputation of its marks. In such case, the 1st Respondent will make unlawful enrichment, riding on the goodwill and reputation of the Petitioner.

44. In fact, the 1st Respondent himself has issued a notice to the Petitioner claiming that there is similarity in the marks and therefore, there is no better evidence in the present case. As already discussed, the classification is only for the convenience of the Registrar and has no more significance and the argument of the 1st Respondent that the Petitioner is trying to cut across Classes cannot be countenanced. If the Court is satisfied that there is a violation of any of the limbs of Section 11, then suitable orders can be passed and there is no impediment arising merely because the marks are registered under different classes.

45. In fact, in *Laxmikant Patel's* case, (referred herein supra), the Apex Court held that the Court will have to have regard to the way in which business may be carried on in the future and not just to the way it is being carried on at the date of the proceedings. Therefore, it cannot be said that



the Petitioner may not foray into the field of pipes used in the construction industry at a later date.

46. In *American Home Products*, (referred herein supra), the Hon'ble Supreme Court held that registration of the mark gives the registered owner valuable rights to use of the trademark and if there is any invasion of his right by any other person using a mark, which is the same or deceptively similar to his mark, he can protect his mark.

47. In *Midas's* case, (referred herein supra), the Hon'ble Supreme Court held that in cases of infringement either of Trademark or of Copyright, an injunction must follow and grant of injunction becomes necessary, if it is prima facie clear that the adoption of the Mark was itself dishonest. In the case on hand, the competent Court in Delhi has found such prima facie case made out by the Petitioner, in fact, as against the 1st Respondent in these cases and granted an interim injunction which continues till date.

48. In *Anchor Health's* case, (referred herein supra), the Delhi High



Court held that when the logo of the Defendant is not identical but is misleading to the consumer, then there is great room for deception and it would come under 'confusingly and deceptively similar' and even if use of the Defendant is in respect of cognate goods, an injunction would follow.

49. In *Borosil's* case, (referred herein supra), the Delhi High Court held that trade mark law is not intended to protect a person who deliberately sets out to take the benefit of somebody else's reputation with reference to goods.

50. In *Pfizer's* case, (referred herein supra), the Hon'ble Division Bench of the Delhi High Court held that judicial admission made by parties at or before the hearing of the case, stand on a higher footing than even evidentiary admissions and would fully be binding on the party that makes them and constitute a waiver of proof. Thus, applying this ratio, when the 1st Respondent himself had issued a notice complaining of the Petitioner causing deception, it does not lie in the mouth of the 1st Respondent to now state that they deal with entirely different goods and therefore, there is no cause for any confusion.



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51. In *Larsen & Toubro Limited v. Lachmi Narain Trades & others*, reported in 2008 (36) PTC 223(Del) (DB), the Delhi High Court held that the test of ‘field of activity’ is no more valid and the question is really one of likelihood of confusion or deception among customers and the resultant damage to the Plaintiff.

52. The IPAB in *Eveready Industries India Limited v. Kamlesh Chadha*, reported in MANU/IC/0045/2020, held that even when the goods of the rival parties are different, if a trademark is a famous trademark, the same can still be protected. In the present case, not only has the Petitioner satisfied this Court that they have been doing successfully in business right from the late 1990s’ but also have been diligent enough in protecting their registered marks by taking prompt action against infringers who attempt to ride on their reputation. Therefore, I am unable to countenance the submissions of the 1st Respondent that the field of business being different, there can be no relief or protection for the Petitioner.

53. The 1st Respondent relied on the famous *Charminar*’s case as



well as *Nandhini Deluxe v. Karnataka Cooperative Milk Producers Federation Limited*, reported in (2018) 9 SCC 183.

54. In the *Charminar*'s case, the decision was based on facts which were decided on the unamended provisions of the Trademark Act. Post 2003 Amendment to Section 11, passing off also being statutorily recognised, the ratio laid down by the Apex Court may not be strictly applicable to the case on hand. Moreover, in that case the Respondent had challenged the Petitioner's registration, which is not the case on hand. Also, in that case the plea of honest and concurrent use was also taken, which admittedly is not the plea in the present cases.

55. In *Nandhini Deluxe*'s case, (referred herein supra), what ultimately weighed in the mind of the Apex Court was long use. However, in the present case, the use of the 1st Respondent is only 2013 onwards even according to them and therefore, I am unable to apply the ratio laid down by the Apex Court in favour of the 1st respondent.

56. To sum up and conclude, in view of the findings arrived at



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hereinabove, the Petitioner has made out a case for rectification of the marks of the 1st Respondent in both the cases and the adoption of GM by the 1st respondent is not justified or bona fide and also remains unexplained. It is clearly adopted with an ulterior motive of riding on the goodwill and reputation of the Petitioner. All the issues are answered accordingly. Hence, for all the above reasons, the Petitioner is entitled to succeed.

57. In fine, both the Original Petitions are allowed, with costs. The entry pertaining to impugned trademarks 'Gm Pipe' registered under No.2826667 in Class No.19 and 'Gmware' registered under No.2945975 in Class 11 are directed to be removed from the Registry of the Trade Marks.

06.09.2024

Index : Yes/No
Speaking/Non-speaking order
rkp
To
The Registrar of Trademarks,
Trademarks Registry,
Boudhik Sampada Bhavan, G.S.T.Road,
Guindy, Chennai – 600 032, Tamil Nadu.



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P.B.BALAJI,J.

rkp

**Pre-delivery Common Order in
(T) OP (TM) Nos.319 & 320 of 2023**

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