



WEB COPY



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 26.06.2024

Pronounced on:30.08.2024

CORAM:

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

(T) OP (TM) Nos.337, 344, 345, 346, 413 & 470 of 2023

GOTO Technologies USA, Inc,
represented by its Authorized Representative,
Mr.Harshit Gupta, Having office at,
333 Summer Street, Boston,
Massachusetts 02210,
United States of America.

(Amendment has been carried out
vide order dated 28.11.2023)

... Petitioner in all the OPs

..Vs.

1.Sanikommu Venkata Ramalinga Reddy,
Having address at, Flat No.221, Block F,
Shanthi Gardens Apartment,
Radgavendra Nagar Nacharam,
Hyderabad -500 076, Telangana.

2.The Registrar of Trademarks,
Trademarks Registry,
Boudhik Sampada Bhavan,
G.S.T.Road, Guindy,
Chennai – 600 032, Tamil Nadu.
OPs

.. Respondents in all the



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

Prayer in (T) OP (TM) No.337 of 2023: This Petition came to be numbered by transfer of O.R.A.No.20/2020/TM/CHN, from the file of the Intellectual Property Appellate Board, Chennai to allow the Application for removal/rectification of Registration No.2863058 for the trade marks GOTO LEARNING (Device) in Class 42 and the Registration Nos.2863058 for the trademarks GOTO LEARNING (Device) in Class 42, be cancelled and the entry relating thereto may be altogether removed from the Register.

Prayer in (T) OP (TM) No.344 of 2023: This Petition came to be numbered by transfer of O.R.A.No.19/2020/TM/CHN from the file of the Intellectual Property Appellate Board, Chennai to allow the Application for removal/rectification of Registration No. 2863056, for the trade mark GOTO LEARNING in Class 45 and the Registration Nos.2863056 for the trademark GOTO LEARNING in Class 45, be cancelled and the entry relating thereto may be altogether removed from the Register.

Prayer in (T) OP (TM) No.345 of 2023: This Petition came to be numbered by transfer of O.R.A.No.21/2020/TM/CHN from the file of the Intellectual Property Appellate Board, Chennai to allow the Application for removal/rectification of Registration No. 2863059, for the trade mark GOTO LEARNING (Device) in Class 45 and the Registration Nos.2863059 for the trademark GOTO LEARNING (Device) in Class 45, be cancelled and the entry relating thereto may be altogether removed from the Register.

Prayer in (T) OP (TM) No.346 of 2023: This Petition came to be numbered by transfer of O.R.A.No.24/2020/TM/CHN from the file of the Intellectual Property Appellate Board, Chennai to allow the Application for



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

removal/rectification of Registration No. 2863054, for the trade mark GOTO LEARNING in Class 41 and the Registration Nos.2863054 for the trademark GOTO LEARNING in Class 41, be cancelled and the entry relating thereto may be altogether removed from the Register.

Prayer in (T) OP (TM) No.413 of 2023: This Petition came to be numbered by transfer of O.R.A.No.23/2020/TM/CHN from the file of the Intellectual Property Appellate Board, Chennai to allow the Application for removal/rectification of Registration No. 2863055, for the trade mark GOTO LEARNING in Class 42 and the Registration Nos.2863055 for the trademark GOTO LEARNING in Class 42, be cancelled and the entry relating thereto may be altogether removed from the Register.

Prayer in (T) OP (TM) No.470 of 2023: This Petition came to be numbered by transfer of O.R.A.No.22/2020/TM/CHN from the file of the Intellectual Property Appellate Board, Chennai to allow the Application for removal/rectification of Registration No. 2863057, for the trade mark GOTO LEARNING (Device) in Class 41 and the Registration Nos.2863057 for the trademark GOTO LEARNING (Device) in Class 41, be cancelled and the entry relating thereto may be altogether removed from the Register.

For Petitioner : Mr.M.S.Bharath
and Ms.Jayabharathi.TS
for M/s.Kria Law in all OPs
For Respondents : Mr.Pranshul Dube for R1 in all OPs
Mr.K.Subbu Ranga Bharathi,
Central Government Standing Counsel
for R2



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

in (T) OP (TM) Nos.337 & 346 of 2023
Mr.S.Janarthanam,
Senior Panel Counsel for R2
in (T) OP (TM) Nos.344 & 345 of 2023
Mr.Rajesh Vivekananthan,
Deputy Solicitor General for R2
in (T) OP (TM) No.413 of 2023
Mr.A.R.Sakthivel,
Senior Panel Counsel for R2
in (T) OP (TM) No.470 of 2023

COMMON ORDER

These batch of Original Petitions are taken up together in view of the commonality involved, viz., registration of GOTOLEARNING mark of the first respondent being challenged by the Petitioner in relation to its various marks with the prefix GOTO.

2. The Registrar of Trademarks has been arrayed as the Second Respondent and is only a formal party. All references to Respondent, occurring hereafter in this order shall mean only the 1st Respondent.

3. The details of the cases are as hereunder:

<i>OP. Nos.</i>	<i>Registration Sought to be removed</i>	<i>Class registered in</i>
337 of 2023	2863058	Class 42



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

<i>OP. Nos.</i>	<i>Registration Sought to be removed</i>	<i>Class registered in</i>
344 of 2023	2863056	Class 45
345 of 2023	2863059	Class 45
346 of 2023	2863054	Class 41
413 of 2023	2863055	Class 42
470 of 2023	2863057	Class 41

4. I have heard Mr.M.S.Bharath, learned counsel for the Petitioner in all these OPs and Mr.Pranshul Dube, learned counsel for the Respondent in all these OPs.

5. The learned counsel for the Petitioner would contend that M/s.Citrix originally started GoTo family, GetGo, LogMeIn, offering various services like GoToMeeting, GoToWebinar, GoToTraining, GoToMyPC, GoToAssist in the year 2001. On 31.03.2016, GetGo, Inc. was incorporated and later LogMeIn merged with Citrix in the year 2016. He would also refer to Assignment Deeds 16.04.2019 between GetGo, Inc. and LogMeIn assigning Trade Mark Nos.1993333, 1993334 & 2030708, pertaining to GoToAssist, GoToMeeting & GoToManage.



WEB COPY

6. The learned counsel for the petitioner would further contend that LogMeIn was named Leader & Challenger in 2018 & 2019 and was also awarded American Business Award and SIIA CODiE awards in 2019. He would add that GoToMyPC also featured in CNN.com, Los Angeles Times & New York Times even as early as in 2001. The learned counsel would further refer to the sales turnover of Citirx, Annual Reports for the years 2010, 2011 2012, 2013, 2014, 2015 & 2018 to show steady rise and growth and also advertisement expenses (Exhibit 6)

7. The learned counsel for the petitioner would further refer to Exhibit 8 to show the respective creation dates, 25.06.2003-(GoToAssist), 20.01.2010-(GoToManage), 26.06.2003-(GoToMeeting), 11.01.2001-(Domain - LogMeIn), 25.03.1999- (GoToTraining) and 26.06.2003-(GoToWebinar). He would invite my specific attention to Exhibit 9 to evidence operations in India in August, 2019 and Exhibit 10, for having effected sales in India, Purchase Order dated 19.06.2019 as well as Order Form – Quote dated 28.03.2018.



8. The learned counsel for the petitioner would also strongly rely on Exhibits 14 & 17 in proof of adverse orders suffered by the respondent before the WIPO Arbitration and Mediation Center in 2012. Finally, contending that the respondent has applied for registrations only in 2014 and therefore, there is likelihood of confusion or deception between the rival marks. He would further submit that the Respondent's documents also do not disclose any use of his mark, i.e. showing any prior use and therefore, the Petitioner was entitled to succeed in the rectification petitions.

9. The learned counsel for the respondent would first and foremost submit that right from 2014, when the respondent got a registration, no suit has been filed by the petitioner and only in 2019, the rectification petitions came to be filed. He would also contend that the petitioner has also not shown how he became the owner of the trademarks and the respondent is the prior user/adaptor as well as the one to get the Registration before the petitioner. Further, he would add, the petitioner has not been using the marks under Classes 41 and 45 and there is no proof filed to establish use in India prior to the Registration in favour of the respondent.



10. In respect of Class 42, the learned Counsel for the respondent would state that even though the registration of the Petitioner is prior in point of time, no use has been shown, much less extensive use in India.

11. In so far as Class 41, he would contend that it relates to education and training for which petitioner has no Registration in India. Moreover, according to the learned counsel for the respondent, no user has also been shown in India and mere Registrations obtained abroad will be of no avail.

12. In so far as Class 45-Registration, the learned counsel for the respondent would state that the petitioner has not shown to be in the service of training and his arguments in respect of Class 41 would equally apply to this Class as well.

13. As regards Class 42, the learned counsel for the respondent would argue that admittedly, the petitioner has entered the Indian fray, 10 years after the respondent, and had no presence in India and only in December 2019, which is after the respondent obtained a registration in 2014, the



petitioner has been able to show some evidence. The learned counsel would therefore conclude stating that no rectification is warranted as prayed for by the Petitioner.

14. In reply, Mr.M.S.Bharath, learned counsel for the petitioner would invite my attention to Explanation to Section 11 of the Trade Marks Act, and state that it does not contemplate use in India. Referring to Exhibit 13, he would state that it evidences that the Application was made even in 2010. Moreover, according to him, the marks need not be identical and even when similarity is shown and it is likely to cause confusion, it is enough to bring it within the mischief of the Section. Also, he would draw a distinction and state that Section 11(3)(a) relating to passing off is not synonymous with Section 11(1)(b).

15. The learned Counsel for the petitioner would place reliance on the decision in, *South India Beverages Pvt. Limited. v. General Mills Marketing Inc. & another*, reported in 2014 SCC OnLine Del 1953, where, discussing the Rule of Anti-Dissection, the Court whilst dealing with cases



of trademark infringement involving composite marks, held, must consider the composite marks in their entirety as an indivisible whole rather than truncating or dissecting them into component parts and make a comparison with the corresponding parts of arrival mark to determine the likelihood of confusion. In so far as identification of dominant Mark, it held, while a mark has to be considered in entirety, it is permissible to accord more or less importance or 'dominance' to a particular portion or element of a mark in cases of composite marks. The Court also extracted *McCarthy on Trademarks and Unfair Competition*, where the author has observed that the principle of anti-dissection does not impose an absolute embargo upon the consideration of the constituent elements of a composite mark and the said elements may be viewed as a preliminary step on the way to an ultimate determination of probable consumer reaction to the conflicting composites as a whole. The principles of anti-dissection and dominant mark compliment each other and are not antithetical to one another.

16. In *M/s.Kirorimal Kashiram Marketing & Agencies Pvt Ltd. v. M/s.Shree Sita Chawal Udyog Mill*, reported in 2010 SCC OnLine Del



2933, when the Appellant/Plaintiff was found to be the prior and registered user and the adoption by the respondent/defendant was not honest and it not being permissible to copy a prominent part of the mark and finding that the mark is arbitrarily adopted, it was held that then the balance of convenience was in favour of the Appellant/Plaintiff.

17. The learned counsel for the respondent relied on the decision in *Toyota Jidosha Kabushiki Kaisha v. Tech Square Engineering Pvt. Ltd. and others*, reported in *AIR 2023 Del 49*, where the Court held that the Explanation to Section 11 of the Act makes it clear that for the purposes of Section 11, the phrase 'earlier trade mark' would apply only in respect of a registered trade mark. It was held, when the petitioner in this case was not registered in India at the time when registration was granted in favour of the respondent, the petitioner cannot take benefit of sub-sections (1) and (2) of Section 11 of the Act.

18. *Hypnos Limited v. Hosur Coir Foam Pvt. Ltd.*, reported in 2015 (62) PTC 374 (IPAB) was also relied on by the learned counsel for the



respondent to state that the Applicant has to show strong ground to dislodge already registered trademark.

19. Though the learned counsel on either side had suggested draft issues, issues have not been framed till date. Considering the draft issues suggested by the learned counsel on either side, I frame the following issues:

- a) Whether the Petitioner can claim exclusivity over the mark GOTO?*
- b) Whether the registration obtained by the 1st Respondent violative of Sections 11 and 18?*
- c) Whether the marks registered by the 1st Respondent deceptively similar to the Petitioner's marks?*
- d) Whether the Petitioner has shown use of the mark GOTO since 2001?*
- e) Whether the adoption of the marks by the 1st Respondent bona fide?*
- f) Whether the registration of the marks, in favour of the 1st Respondent liable to be cancelled and entries removed from register under Section 57 of the Act?*

20. I have carefully considered the rival submissions advanced by the



learned counsel on either side. The issues are all taken up together for consideration since the factual matrix involved in deciding the issues are all common and connected /intertwined.

21. The petitioner hold a valid registration of the GOTO mark in Registration No.4129668. The respondent has GOTOLEARNING mark registered in his favour.

22. The petitioner, admittedly has global registrations of GOTO marks which have been filed before this Court. The Indian registrations are marked as Exhibit 13. It can be seen that the petitioner applied for the following marks and obtained valid registrations under various Classes, which are set out hereunder for ease of reference:

(i) GOTOASSIST – applied on 14.07.2010 and registration granted by Trade Mark Registry under Class 9, 42 in 1993333 on 04.04.2016

(ii) GOTOMANAGE – applied on 29.09.2010 and registration granted on 19.08.2013, under Class 42, in 2030708

(iii) GOTOMEETING – applied on 14.07.2010 and registration



WEB COPY



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

granted in 1993334 under Classes 9, 38 & 42 on 04.04.2016

(iv) GOTOMYPC – applied on 31.01.2011 and registration granted in 2091681 under Class 9 on 05.05.2018

(v) GOTOTRAINING - applied on 31.01.2011 and registration granted in 2091680 under Classes 9, 38 & 42 on 04.07.2017

(vi) GOTOWEBINAR – applied on 31.01.2011 and registration granted in 2091682 under Classes 9, 38 & 42 on 22.06.2017.

23. The respondent, admittedly applied for registration of its GOTOLEARNING mark, under various Classes on 16.12.2014 and registrations were also granted, as hereunder (Exhibit 15):

23 (i). The impugned registration under Class 41 was obtained by the respondent on 23.10.2017. The respondent had applied for GOTOLEARNING on 16.12.2014 in Application No.2863054. The user detail provided by the Respondent is 06.11.2014.

23 (ii). The impugned registration under Class 42 was obtained by the respondent on 02.01.2019. The respondent had applied for



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

GOTOLEARNING on 16.12.2014 in Application No.2863055. The user detail provided by the Respondent is 06.11.2014.

23 (iii). The impugned registration under Class 45 was obtained by the respondent on 21.10.2017. The respondent had applied for GOTOLEARNING on 16.12.2014 in Application No.2863056. The user detail provided by the Respondent is 06.11.2014.

23 (iv). The impugned registration under Class 41 was obtained by the respondent on 02.01.2019. The respondent had applied for GOTOLEARNING only on 16.12.2014 in Application No.2863057. The user detail provided by the Respondent is 06.11.2014.

23 (v). The impugned registration under Class 42 was obtained by the respondent on 02.01.2019. The respondent had applied for GOTOLEARNING only on 16.12.2014 in Application No.2863058. The user detail provided by the respondent is 06.11.2014.

23 (vi). The impugned registration under Class 45 was obtained by



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

the respondent on 26.09.2016. The respondent had applied for GOTOLEARNING only on 16.12.2014 in Application No.2863059. The user detail provided by the Respondent is 06.11.2014.

24. Exhibits 14 & 17 are very material and vital documents. A case was filed by *Citrix* against the respondent herein before the WIPO Arbitration and Mediation Center, and in and by order dated 17.08.2012, WIPO Arbitration and Mediation Center found that the respondent does not have right or legitimate interest in the disputed domain name, <gototraining.net> and that Citrix's Application was 16 months prior to the respondent acquiring the disputed domain name and that the respondent had registered and used the disputed domain name in bad faith. Similar findings of bad faith were rendered on 10.01.2012 (gotoassist) & 11.04.2018 (gotomeeting).

25. In Exhibit 16, the petitioner had issued a notice alleging unauthorized adoption of the mark GOTOLEARNING marks and to cease and desist from using the GOTOLEARNING marks or any other deceptively



similar marks. Admittedly, the Respondent did not issue a reply to the said notice.

26. The petitioner, admittedly has the benefit of registration of GOTO per se. As rightly contended by the learned counsel for the petitioner, Explanation to Section 11 does not suggest that there has to be use shown in India. It is in this backdrop that Exhibits 14 and 17 assume significance. As already discussed, the respondent attempted to use 'gototraining' and suffered an order even as early as in August, 2012. Therefore, the respondent cannot be allowed to contend that he was not aware of 'GOTO' when he applied for a registration in 2014. More so, when the petitioner has registration of the word mark GOTO in its favour, the respondent's attempt and even successful in a way, to get his mark, GOTOLEARNING registered is clearly malafide.

27. The respondent feebly attempts to question the ownership of the marks at the hands of the petitioner. However, the stand of the respondent does not merit acceptance since the petitioner has satisfactorily shown that



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

the GOTO marks that were originally owned by M/s.Citrix and have duly and validly been assigned in favour of LogMeIn in 2016 and later the registrations have all been effected in the name of the petitioner Company only and the domain name has also been transferred in favour of the petitioner which also went unchallenged. In fact, this Court, by order dated 28.11.2023 also permitted the present petitioner Company to be substituted as petitioner and when the said order has also become final, it does not lie in the mouth of the respondent to contend that the petitioner has not shown as to how it owns the various registered marks.

28. Insofar as use, the argument of the learned counsel for the respondent that the petitioner has not shown use in India, Exhibit 10 clearly negates such a contention. Insofar as prior use, the petitioner admittedly has made an Application in India in 2010 itself and the respondent though, obtained Registration of his mark in 2014, has himself set out user only from 06.11.2014 which is much after the Application of the Petitioner and far more importantly, after suffering an order before the WIPO Arbitration and Mediation Center in 2012 itself and knowing fully well about the



Registration of GOTO marks. In fact, insofar as Class 42, the petitioner's Registration is even admittedly prior in point of time. Insofar as Class 41 and 45, the argument of the respondent that the petitioner is not in training service/sector and since there is no user presence in India, I am unable to countenance the same for the reason that in the Explanation to Section 11, earlier trade mark has been explained to mean a registered trade mark or an Application under Section 18 bearing an earlier date of filing or an international Registration referred to in Section 36-E. In this case, the petitioner's Application is certainly earlier, having been made even in 2010, earlier than the respondent's Application and Registration.

29. I have already found that even after suffering an adverse order in 2012, the respondent applied and got a Registration of GOTOLEARNING in 2014 and even insofar as use, excepting for LinkedIn presence and a couple of self-serving e-mails, the respondent has not been able to show any use of his mark, despite obtaining a Registration in 2014. However, even otherwise, when his adaptation of the mark itself is *mala fide* and motivated and having been applied for after suffering an order in August 2012, the



Respondent cannot feign ignorance of the earlier Registration of GOTO marks in favour of M/s.Citrix, the predecessor-in-interest of the Petitioner.

30. The next and most crucial aspect is whether the mark of the respondent is similar or deceptively similar in as much as it is likely to cause confusion, the respondent, first and foremost has not been able to satisfy as to how he coined GOTO. It is settled law that under Section 11(1)(b), it is enough to show similarity and there is no requirement or mandate that the marks should be identical. The petitioner has several registrations incorporating the GOTO mark and therefore every chance of confusion arising in the minds of the public and likelihood of confusion is writ large on the face of the respondent's mark in as much as it is very likely to deceive the public that the respondent's mark is that of the petitioner's, especially considering the similarity of services rendered by the petitioner and the respondent.

31. One another argument that was put forth by the learned counsel



for the respondent is that the petitioner has made separate Applications for various marks with GOTO in it and therefore, it shows that the respondent's GOTOLEARNING mark is also different and therefore petitioner cannot attack the same. In this context, the law is settled that the marks should be considered as a whole and even otherwise the dominant part of the mark being GOTO, owned and registered in favour of the petitioner, the respondent cannot attack the several Registrations in favour of the petitioner and try to use it against the petitioner and in favour of the respondent. The ratio laid down in *South India Beverages's* case and discussed herein supra, would squarely apply to the facts of the present case.

32. Even the ratio laid down in *M/s.Kirorimal Kashiram Marketing & Agencies's* (referred herein supra) would apply to the facts of this case because the respondent without justification has adopted the prominent GOTO part of the petitioner's mark.

33. Though the learned counsel for the respondent, applying the ratio laid down in *Toyota Jidosha Kabushiki Kaisha's* case, (referred herein



supra) contended that on the date of the Registration in favour of the respondent, the petitioner did not have a registered mark and hence the Explanation to Section 11 would not apply, given the fact that in the present case, the petitioner had applied for registration in 2010, much prior to the Application and Registration in favour of the respondent and Explanation clearly including even an Application under Section 18 bearing an earlier date, I am unable to countenance the argument of the learned counsel for the respondent in this regard.

34. I also do not see any merit in the argument of the respondent's counsel that the petitioner took no action for almost 10 years and hence on the ground of delay the petitioner has to be non-suited. The respondent's Registration was granted only in 2019 and the Rectification Petition was filed by the petitioner before the IPAB in 2019 itself, just after a lapse of few months and therefore by no stretch of imagination, it can be said that the petitioner has acquiesced itself of the impugned Registration in favour of the respondent.



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

35. For all the above reasons, the petitioner is entitled to succeed. All the issues are answered in favour of the petitioner and against the respondent.

36. In fine, the Original Petitions are allowed with costs to be paid by the first respondent and the impugned Registrations in favour of the 1st respondent are cancelled.

30.08.2024

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.



WEB COPY



(T) OP (TM) Nos.337, 344 to 346, 413, 470 of 2023

P.B.BALAJI,J.

rkp

**Pre-delivery Orders in
(T) OP (TM) Nos.337, 344, 345, 346, 413 & 470 of 2023**

30.08.2024