



(T) OP (TM) No.350 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 03.07.2024

Pronounced on: 20.09.2024

CORAM:

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

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V.Rangasamy Naidu Educational Trust,
(a trust registered under the Indian Trust Act,
1882) Rep. by its Managing Trustee,
Dr.S.R.K.Prasad.

... Petitioner

..Vs.

1.Parthasarathy Seniammal Educational Trust,
Rep. by its Managing Trustee,
HIG -34, Raja Munnar Street,
3rd Main, Nulambur, Chennai – 600 037.

2.The Registrar of Trade Marks,
Trade Marks Registry,
IPO Building, Guindy,
Chennai -32.

.. Respondents

Prayer: This Petition came to be numbered by transfer of O.R.A.No.44/2020/TM/CHN, from the file of the Intellectual Property Appellate Board, Chennai, to allow the rectification Application and the Trademark registration No.2855463 registered in Class 41 in the name of



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P.SRIRAM, P.JANAKIRAM, S.SRIDEVI trading as PARTHASARTHY SEENIAMMAL EDUCATIONAL TRUST, herein may be removed/expunged/revoked/cancelled and to direct the Registrar of Trade Marks to rectify/remove from the Register of Trade Marks by expunging/removing the trademark registration under No.2855463 in Class 41 in the name of P.SRIRAM, P.JANAKIRAM, S.SRIDEVI.

For Petitioner : Mr.G.K.Muthukumar for
M/s.GMS Law Associates.

For Respondents : Dr.M.Sathyakumar for R1
Mr.M.Karthikeyan,
Senior Panel Counsel for R2

ORDER

This Rectification Petition has been filed under Sections 57 and 125 of the Trade Marks Act, 1999 (in short 'Act'), for removal of the registration of Trademark registration No.2855463 in Class 41 in favour of the Respondents.

2. Respondents occurring hereafter shall refer only to the contesting Respondent No.1.

3. Case of the Petitioner:



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The Petitioner Trust was formed in 1956 with special emphasis on industrial training in the fields of science, engineering and technology. The Coimbatore Institute of Technology (CIT) was established in 1956 and ‘CIT’ was coined and adopted simultaneously as the abbreviation of the name of their college and the same has become very popular and reputed in as much as students, staff, alumni and also the public have started referring to the Petitioner by the abbreviated form alone. The Petitioner was affiliated to Madras University from 1956 to 1980 and later from 1980 to 2001 to Bharathiar University and from 2001, to Anna University. Over the years, the Petitioner has earned enormous reputation and goodwill. As early as 1961, the Petitioner also established a Polytechnic by name CIT Sandwich Polytechnic and over the past several decades, the Petitioner’s mark has acquired distinction and even a secondary meaning as a mark of the Petitioner and none else. ‘CIT’ is prominently used at workshops, seminars, events as well as conferences. Even their website is www.cit.edu.in.

4. The Respondents started using ‘CIT’ prominently in their Institute building, Application Form, Prospectus, Stationary, Buses and also in their



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domain name, www.citchennai.edu.in. The Respondents being in the same service of education have dishonestly adopted the mark, knowing fully well the reputation and goodwill of the Petitioner's mark 'CIT'. The Respondents have suppressed and played fraud by not revealing the pendency of the Civil Suit while obtaining registration. The Petitioner had already filed a suit for the reliefs of infringement and passing off and even obtained an interim order against the Respondents. The impugned mark of the Respondents is neither distinct nor capable of distinguishing its services from that of the Petitioner. The Petitioner is therefore entitled to relief as prayed for.

5. Case of the Respondents:

The Respondents have made honest and concurrent use of the impugned mark as envisaged under Section 12 of the Act. The suit has been filed in 2017 itself, though the registration of the Petitioner's mark was only in 2018. The rectification petition is an afterthought. The Respondent's mark has to be conceived as a whole and a part of a word does not constitute a separate trademark and both the Petitioner and Respondents being unknown to each other and also unaware of the mark used by the other, the adoption is

innocent and the Registrar's discretion in granting the benefit of 'honest and concurrent user' by the Respondents cannot be called in question. The Respondents therefore prayed for dismissal of the Original Petition.

6. Issues framed:

Taking into account the pleadings of the parties, the following issues are framed:

1. Whether the Respondent's mark is liable to be removed as prayed for?

2. Whether non adherence to Section 124 of the Act renders the OP not maintainable?

3. Whether the Respondent's use of the impugned mark is honest and concurrent?

7. Both the learned counsel reported to this Court that they do not intend to go for trial and the learned counsel would only advance submissions based on the materials on record.

8. I have heard Mr.G.K.Muthukumar for M/s.GMS Law Associates, learned counsel for the Petitioner and Dr.M.Sathyakumar, learned counsel for 1st respondent and Mr.M.Karthikeyan, learned Senior Panel Counsel for the 2nd Respondent.



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9. The learned counsel for the Petitioner would contend that the Petitioner Trust was formed even as early as in the year 1956 and a polytechnic college was started in the year 1961 and ever since, the Petitioner has been using CIT which is denoting Coimbatore Institute of Technology. The Petitioner, according to the learned counsel for the Petitioner, has earned enormous good will and reputation and also got its registration under Class 41 on 25.05.2011. The Respondents got a registration of their mark only in 2014, claiming a user from 2013 and their registration was also under Class 41. The learned counsel would emphasise that both the Petitioner and the Respondents are in the same field, viz., education and there is every likelihood of confusion arising and being a prior user, the Petitioner would be entitled to claim protection of its registered mark.

10. The learned counsel would also take me to the rival marks and contend that the CIT has been prominently depicted in the Respondent's mark and even though they claim it to be a composite mark, the tag line is nearly invisible and the conduct of the Respondents clearly smacks of



malafide. He would further submit that the Respondents, even according to their claim, have been using their mark only for 14 months and hence there is no question of acquiring any distinctiveness on the date of their Application. He would state that it was a classic case of, not only confusion but also deception and therefore, the Petitioner was entitled to relief as prayed for.

11. The learned counsel for the Petitioner placed reliance on the following decisions:

i) *Patel Field Marshal Agencies and Another v. P.M.Diesels Limited and others*, reported in (2018) 2 SCC 112

ii) *Parle Products (P) Ltd v. J.P. and Co., Mysore*, reported in MANU/SC/0412/1972

iii) *Sun Pharma Laboratories Ltd. v. Cian Healthcare Ltd. &ors*, reported in MANU/DE/2914/2023

iv) *Ruston & Hornsby Ltd. v. The Zamindara Engineering Co.*, reported in MANU/SC/0304/1969

v) *Gangotree Sweets and Snacks Pvt. Ltd. v. Shree Gangotree Sweets*,



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Snacks and Savouries, reported in *MANU/TN/2389/2005*

vi) *T.V.Venugopal v. Ushodaya Enterprises Ltd. & others*, reported in
MANU/SC/0169/2011

vii) *Laxmikant V. Patel v. Chetanbhat Shah & others*, reported in
MANU/SC/0763/2001

12. Per contra, the learned counsel for the contesting 1st respondent would submit that first and foremost, the suit was admittedly pending on the date of the Petitioner filing the rectification petition and therefore, the Petitioner, as mandated under Section 124 of the Act ought to have approached the Civil Court and sought for leave to file the above petition and consequently the Original Petition was liable to be dismissed.

13. As this issue of maintainability was taken by the Respondents for the first time in the course of arguments, the learned counsel for the Petitioner was given an opportunity to meet the same. I will deal with this Issue, framed as Issue No.2 separately.



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14. The learned Counsel for the Respondents would submit that the use of the impugned mark by the Respondents is honest and bona fide and the mark has to be seen as a whole and viewed thus, there is no likelihood of any confusion as claimed by the Petitioner. He would further contend that the Respondent's mark is a composite mark and the butterfly and the tagline are the dominant part of the registered mark. He would further state that the end users are students and they being educated would easily distinguish between the two marks and what would ultimately weigh in their minds is the quality of education. The contention regarding dishonest use, according to the learned counsel for the Respondents, was not sustainable since the mark was only an abbreviation of their name, Chennai Institute of Technology and therefore, adoption of the mark was out and out honest and there was a reason for the same as well.

15. He would further submit that the Petitioner has also not disclosed the pendency of the suit while filing the above Original Petition and hence, is guilty of suppression of material facts and does not therefore, deserve relief from this Court.



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16. The learned counsel for the Respondents would place reliance on the following decision:

Astrazeneca UK Limited and another v. Orchid Chemicals & Pharmaceuticals Ltd., reported in *ILR (2007) 1 Delhi 874*

17. I shall first deal with the question of maintainability raised by the learned counsel for the Respondents.

18. The learned counsel for the Respondents would refer to the ratio laid down in *M/s.Astrazeneca UK Limited* (referred herein supra) and contend that the rectification petition was liable to be dismissed at the threshold for not getting the leave of the Civil Court where the suit filed by the Petitioner was pending and he would refer to Section 124 of the Act. The Hon'ble Division Bench of the Delhi High Court held that a petition for rectification cannot be filed without showing, establishing and obtaining prima facie satisfaction of the Court that they have sufficient material to be able to invalidate the registration of the mark of the Respondents.



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19. Countering the said submissions, the learned counsel for the Petitioner would first and foremost contend that, the Petitioner cannot be taken by surprise at the stage of arguments without taking the plea of maintainability in the counter. On merits, he would contend that the argument is misconceived as Section 124(1)(b)(ii) of the Act would apply to the facts of the present case, especially since on the date of the filing of the suit there was no registration in favour of the Respondents and hence, the question of applying Section 124 of the Act itself did not arise for the Petitioner.

20. Section 124 of the Act runs thus:

“Section 124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc.

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. "

21. The Hon'ble Supreme Court in *Patel Field Marshal's* case (referred herein supra) has also held that in a situation where a suit is pending and irrespective of the same being filed before or after the filing of the rectification petition, the exercise of jurisdiction by the prescribed statutory authority would be contingent on a finding of the Civil Court regarding the prima facie tenability of the plea of invalidity raised before the Civil Court.



22. Section 124 of the Act contemplates a situation where a suit for infringement of trademark is filed and the Defendant takes a plea that the Plaintiff's registration itself is invalid or where the Defendant raises a defence that there is no infringement by reason of use of a registered trade mark in favour of the Defendant, though the marks may be identical or nearly resembling each other [Section 30(2)(e)] and in such event, the Plaintiff pleads invalidity of the registration in favour of the Defendant.

23. Examining the said provision, in the light of the facts of the present case, the suit in CS No.344 of 2017 was filed sometime in April, 2017. The rectification Original Petition was filed initially before the Intellectual Property Appellate Board (IPAB) on 30.08.2019 on which date admittedly, the suit was pending. It is admitted by both parties that the Petitioner was granted an interim relief in the suit and the same was also extended until further orders and the same is in force as on date.

24. The Petitioner was granted a registration under Class 41 with effect from 25.05.2011. The Respondent's registration is on 04.12.2014,



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admittedly with a user claim of 12.10.2013 only.

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25. The next limb that requires to be considered is whether the Plaintiff has challenged the invalidity of the Defendant's mark or vice-versa. Admittedly, till date, the Respondents, the Defendants in the suit have not challenged the registration in favour of the Petitioner. The issues were framed in the suit only on 06.02.2023 by which time the Rectification OP had been already filed and was pending before the IPAB. Therefore, there was no occasion of issues being framed by the Civil Court on the date when the Petitioner filed the above Rectification Petition. As rightly contended by the learned counsel for the Petitioner, the facts of the present case would warrant Application of Section 124(1)(b)(ii) only. However, when the rectification petition was filed much before the issues being framed in the suit on 06.02.2023, there is no question of granting a stay of the proceedings as contemplated under Section 124 in the first place and consequently, the deeming provision under Section 124(3) that the issue of validity of the registration of the trade mark concerned being abandoned also does not arise. Even otherwise, when the Civil Court trying the infringement suit has



not chosen to stay the trial of the suit and wait for the result of the rectification proceedings, it cannot be contended that the rectification proceedings itself is liable to be dismissed.

26. Moreover, even in *Patel Field Marshal's* case, (referred herein supra), the Apex Court ruled that all issues relating to and connected with the validity of the registration has to be dealt with only by the prescribed Authority under the Act and not the Civil Court. Further, Section 124 of the Act as it stands today also does not contemplate a party to obtain leave from the Civil Court before filing a rectification petition.

27. For all the above reasons, I answer Issue No.2 in favour of the Petitioner, holding that the above OP is maintainable.

28. Issue Nos.1 and 3:

Coming to the merits of the contentions of the parties, the main ground of attack of the Petitioner is that the Respondents have adopted the impugned mark with mala fide intentions and only in order to take undue and unfair advantage of the reputation and good will enjoyed by the



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Petitioner. On the contrary, the Respondents' defence is that the use of their mark is honest and concurrent.

29. It is not in dispute that both the Petitioner and the Respondents are in the same service industry of Education. The Respondents may have a justification for contending that they being Chennai Institute of Technology, there is nothing wrong in their using CIT.

30. Under Section 9(1)(a) of the Act, if the trade mark of the Respondents is devoid of any distinctive character and not capable of distinguishing the services of the Respondents from that of the Petitioner, then there is an absolute ground for refusal of the registration of the trademark of the Respondents. Under Section 9(2) of the Act, the mark of the Respondents shall not be registered, if it is of such a nature as to deceive the public or cause confusion.

31. The only defence actually taken by the Respondents even in the counter statement is that their use of the impugned mark is honest and



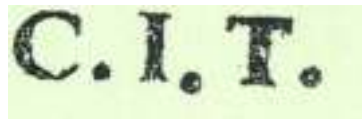
concurrent. That being the case, there is actually no difficulty in holding that the Respondents admit that there is actually no distinctiveness.

32. Though it was contended by the Respondents that when their mark is viewed as a whole, the same would clearly set them apart from the Petitioner's mark. The butterfly and the tag line along with CIT, according to the Respondents would distinguish their mark from that of the Petitioner.

33. The law on this aspect is fairly well settled by the Hon'ble Supreme Court in *Parle Products'* case (referred herein supra) that in order to come to a conclusion whether one mark is deceptively similar to another, the broad and essential features of the two marks are to be considered.

34. The two rival marks are reproduced hereunder:

Petitioner's mark:



Respondent's mark:



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35. On comparing both the marks, it is clear that the Respondents' mark bears an overall similarity to the Petitioner's mark and there is a likelihood of a person being misled to accept the Respondents' mark as that of the Petitioner. Though the Respondents contend that their butterfly and tag line clearly distinguish their mark, I am unable to countenance the said contention since the broad and essential feature is only CIT and not the tagline or even the butterfly around CIT. Therefore, there is every chance of the end customer being misled into thinking that the Respondents' mark is that of the Petitioner, more reason, both the Petitioner and the Respondents being in the Education Sector. I am unable to countenance the argument of the Counsel for the Respondents that since the users are only students, they will be able to make an intelligible differentiation and hence there is no cause of confusion. As I have already found from the comparison of the two rival marks, 'CIT' is the prominent part of the mark of the Respondents and



the butterfly and even the tagline, do not over shadow 'CIT' adopted by the Respondents and therefore even to students there is a likelihood of confusion arising and as held by the Hon'ble Supreme Court in *Parle Products'* case (referred herein supra), the consumer is not gifted with the powers of observation of a Sherlock Holmes!

36. As held in *Laxmikant V. Patel's* case, (referred herein supra), the law does not permit any one to carry on a business in such a way so as to persuade customers in believing that their goods either belong to someone else or is associated therewith; The mark of the Respondents is likely to make the customer think that the Respondents are either associated with the Petitioner, or even worse, the Respondents are also the Petitioner only. This ratio was followed by our Court in *Gangotree Sweets* case (referred herein supra).

37. In *T.V.Venugopal's* case, (referred herein supra) the Apex Court, quoted with approval, the ratio laid down by the Supreme Court earlier, in *Ramdev Food Products (P) Limited v. Arvindbhai Rambhai Patel and*



others, reported in (2006) 8 SCC 726 that there can be only one mark, one source or one proprietor and registration of trademarks is envisaged to remove any confusion in the minds of the customers. In this case, there is cause for confusion amongst the students as to the source and therefore, the Petitioner's registration is entitled to protection.

38. In *Ruston's* case (referred herein supra), the Apex Court held that the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions and even adding the word India to the mark would not be of any consequence and the Respondent's mark would still be deceptively similar. This would apply to the facts of the present case where the Respondents rely heavily on the butterfly and tagline to distinguish their mark from that of the Petitioner.

39. In *Sun Pharma's* case, (referred herein supra) the Delhi High Court held that when the Petitioner asserts that the registration obtained by the Respondent was on a false statement and the Respondent does not produce any evidence in support of its user, then the Respondent cannot



claim to be a proprietor of the impugned mark within the meaning of Section 18(1) of the Act. Here also, the Respondents have not been able to substantiate their user claim from 2013 and on this ground also their registration is liable to be cancelled.

40. There is no quarrel over the fact that the Petitioner's use is much prior, even from 1956 onwards, to the adoption of the mark by the Respondents only in the year 2013. As rightly contended by the learned counsel for the Petitioner, the Respondents, even according to their own case, had only a usage of about 14 months on the date of their Application and therefore clearly, there cannot be any distinctiveness shown in such a short span of time. In any event, there is absolutely no evidence to establish any such distinctiveness.

41. As regards honest and concurrent use, there is no merit in the said defence raised by the Respondents. In fact, on the date of registration being granted to the Respondents' there was an interim order of restraint of use of the mark by a competent Civil Court and the claim of user itself falls flat.



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Even otherwise, there is absolutely no material placed on the side of the Respondents to substantiate their plea of 'honest and concurrent user'.

42. Further, the Respondents are also guilty of suppressing the interim order granted, before the Registrar as when their Application was pending before the Authority, the Civil Court granted an interim injunction restraining use of the impugned mark and the Respondents ought to have brought it to the notice of the Authority, who may have, in all probability, on coming to know of the restraint order, would have refused registration in the first place. This also reflects poorly on the defence of 'honest use' claimed by the Respondents.

43. For all the foregoing reasons the Issues 1 and 3 are also answered in favour of the Petitioner.

44. In fine, the Original Petition is allowed and the impugned trademark is liable to be removed and the second Respondent





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shall take steps to remove the impugned mark

under

Application No.2855463 in Class 41 from the register. However, there shall

be no order as to costs.

20.09.2024

Index : Yes/No

Speaking/Non-speaking order
rkp

To

The Registrar of Trade Marks,
Intellectual Property Office,
IPO Building, Guindy,
Chennai -32.

P.B.BALAJI,J.

rkp



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Pre-delivery Order in
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(1/2)

20.09.2024