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(T) CMA (TM) No.204 of 2023



IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 03.06.2024

Pronounced on: 14.06.2024

CORAM:

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

(T) CMA (TM) No.204 of 2023

ITW India Limited,
(formerly, ITW Signode India Limited)
Level 1, Lotus Plaza,
732/1, Mehrauli Gurgaon Road,
Sector -14, Gurgaon 122 001,
Haryana.

.. Appellant

..Vs.

1.Deputy Registrar of Trade Marks,
Trade Marks Registry,
I.P. Building, Guindy,
Chennai 600 032.

2.Metalguard Private Limited,
C/o. Rao and Rao,
12-10-651/3, Road No.2,
Indira Nagar, Warsiguda,
Secunderabad – 500 061,
Andhra Pradesh.

.. Respondents

Prayer: This appeal came to be numbered by transfer of IPAB Case SR. No.441/2010/TM/CHN from the file of the Intellectual Property Appellate Board, Chennai praying this Court to call for records, quash and set aside the



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order of the first respondent dated 6th August 2010 and the application be restored to file and proceeded as per Rules and pass appropriate orders as deemed fit according to law and award costs of proceedings to the Appellant.

For Appellant : Mr.R.Rajesh,
for M/s.Depenning and Depenning

For Respondents : Mr.M.Karthikeyan for R1
Mr.K.Mohankumar for
M/s.Rao and Rao for R2

J U D G M E N T

The present Appeal is challenging the impugned order dated 06.08.2010, passed by the first respondent rejecting the Registration of the appellant based on the second respondent's objections.

2. I have heard Mr.R.Rajesh, for M/s.Depenning and Depenning learned counsel for the Appellant and Mr.M.Karthikeyan, learned counsel for the first respondent and Mr.K.Mohan Kumar, for M/s.Rao and Rao, learned counsel for the second respondent.

3. According to the learned counsel for the Appellant, the appellant



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has coined and invented the word "MET L GARD" and they had applied for registration under Class-2. The Appellant commenced the commercial use of the said trademark from 21st June 1995 and the learned counsel for the appellant would invite my attention to the invoice dated 15.07.1996, to show that the Appellant has been using "MET L GARD", right from 1996 and they have acquired distinctiveness from day one. He would also submit that the Company was founded way back in 1979 and it is also fairly pointed out by Mr.Rajesh, learned counsel for the appellant that at the time of making Application on 06.04.2005, it was wrongly mentioned as “proposed to be used” in the user details, instead of mentioning as 21st June 1995. He would contend that since the error has anyway been corrected, the original Application cannot be relied and harped on by the respondents.

4. He would also contend that the trademark is not identical and further the second respondent has obtained Registration only under Class-1 and not under Class-2 and therefore, the first respondent ought not to have rejected the Registration accorded to the appellant based on relevant factors which had no nexus whatsoever to the issue in question.



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5. Per contra, the learned counsel for the second respondent would first and foremost submit that the invoices which are relied on by the appellant have been introduced for the first time in this Appeal and they were not placed before the first respondent. According to the learned counsel for the second respondent, these invoices are fabricated only for the purposes of the present Appeal and hence they cannot be relied upon.

6. The learned counsel would also submit that both the appellant and the second respondent are in the same line of the business and phonetically "MET L GARD" and "METALGUARD" are the same and it is only a clever and deceptive adaptation made by the appellant in order to cause confusion amongst the public and at the same time, make unlawful enrichment at the cost of the second respondent.

7. I have considered the rival submissions advanced by the learned counsel on either side. I have also gone through the impugned order passed by the first respondent.

8. Admittedly, I do not find any reference to the invoices now filed



along with the Appeal papers to have been placed before the first respondent. If really the first respondent claims to have been using "MET L GARD" right from 2005, then certainly, these invoices would have been placed before the first respondent at the time of the hearing. In this context, the Application filed by the appellant also becomes relevant and assume significance. At the first instance, the appellant has only stated that the trademark "MET L GARD" is proposed to be used. However, as an afterthought, eight years down the line, the same is sought to be corrected as if it was an inadvertent error and that the user details should be "21st June 1995" and not "proposed to be used".

9. That apart, though the appellant came to be in business right from 1995 onwards, the invoices produced before the first respondent are only from the year 2004 onwards and not for any period prior to it. On the contrary, the second respondent has provided their sales turnover right from 1995-96 onwards and also the factum of user of "METALGUARD" right from 1995 onwards. Thus it is a clear mischievous attempt on the part of the appellant to make inroads into the business of the second respondent by using their registered trademark "MET L GARD", however, by splitting up



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METAL viz., MET L and mentioning GARD as guard. Phonetically, both the words "MET L GARD" and "METALGUARD" are pronounced the same and therefore, there is every likelihood that the customers would be deceived into buying the products of the appellant, as if they are the products of the second respondent. The Registration sought under Class-2 is also found to be mischievous as Class-2 deals with rust preventive oils and Class 1 deals with metal treatment chemicals. Admittedly, both the appellant and second respondent are in the same field of business and therefore, the Registration sought for by the appellant under Class-2 is clearly only to get over the rights of the second respondent.

10. I do not find any infirmity in the findings arrived at by the first respondent. The first respondent has found, on the available documents, that the appellant is not entitled to Registration under Class-2 and consequently, in my considered opinion, rightly allowed the opposition of the second respondent. Hence, I do not find any justifiable grounds for interference under Section 91 of the Trademarks Act, 1999. Consequently, the Civil Miscellaneous Appeal is dismissed. No costs.



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14.06.2024

Index : Yes/No
Speaking/Non-speaking order
rkp
To
Deputy Registrar of Trade Marks,
Trade Marks Registry,
I.P. Building, Guindy,
Chennai 600 032.

P.B.BALAJI,J.
rkp



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