



WEB COPY



(T) OP (TM) No.542 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 20.06.2024

Pronounced on: 28.06.2024

CORAM:

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

(T) OP (TM) No.542 of 2023

M/s.Prakash Pipes Limited,
KH No.75/19/26/4/20/32 Srivan,
Najafgarh Road, Bijwasan,
New Delhi – 100 015.

.. Petitioner

..Vs.

1.A.K.Rama Rao

2.The Registrar of Trademarks,
Trade Marks Registry,
Intellectual Property Appellate Rights Building,
G.S.T.Road, Guindy, Chennai 600 032.

.. Respondents

Prayer: This Petition came to be numbered by transfer of O.R.A.SR.No.43/2020/TM/CH from the file of the Intellectual Property Appellate Board, Chennai and praying that the impugned Trade Mark No.125103 in Class-17 be removed/rectified/expunged/cancelled from the Register of Trade Marks.

For Petitioner : Mr.Sahil Gupta

For Respondents : No Appearance for R1
Mr.A.R.Sakthivel
SPCGSC, for R2



(T) OP (TM) No.542 of 2018

ORDER

WEB COPY

The above Original Petition is filed seeking rectification by way of cancellation of registered Trademark "*PRAKASH*" in Trademark No.1251013 under Class 17 in favour of the first respondent.

2. Despite service of notice on the first respondent, there is no appearance on behalf of the first respondent. I have heard Mr.Sahil Gupta, learned counsel for the petitioner and Mr.A.R.Sakthivel, learned Senior Panel Central Government Standing Counsel for the respondent.

3. The learned counsel for the petitioner would take me through the typedset of papers and also the Rectification Petition to fortify his contentions that the petitioner has been using "*PRAKASH*" right from 1980 onwards and has registration under Classes 9, 17 & 20. The first respondent has adopted an identical trademark "*PRAKASH*" and has obtained Registration under Classes 9 and 17. The learned counsel for the petitioner further submits that the petitioner came to know about the use of



(T) OP (TM) No.542 of 2020

name "*PRAKASH*" by the first respondent only in 2020 and the Rectification Petition has been filed on the ground of non use of the trademark under Section 47 of the Trademarks Act, 1999.

4. The learned counsel for the petitioner would further submit that for the past five years and more, the first respondent has not been using the trademark "*PRAKASH*" and therefore on the ground of non user especially after having obtained Registration in the year 2006, the first respondent is not entitled to retain Registration in his favour.

5. I have heard the learned counsel for the petitioner and the learned counsel for the second respondent. I have also gone through the connected records including the averments and allegations made in the Rectification Petition.

6. I can see that though the respondent has Registration of "*PRAKASH*" in his favour, that too for same class of goods especially Classes 9 and 17, for which the petitioner has a prior Registration and has



WEB COPY

(T) OP (TM) No.542 of 2013



also shown use right from 1980, the first respondent has not been using the trademark for over 5 years now. It is also seen that the first respondent is also engaged in similar business as that of the petitioner dealing with PVC Pipes, switches etc. The petitioner has further stated that the first respondent has not used the impugned trademark "*PRAKASH*" and has claimed a false user since 4th January 1993 which in any event is much later than, the use of the trademark "*PRAKASH*" by the petitioner.

7. From the records, it is seen that the petitioner has earned enormous goodwill by using the trademark "*PRAKASH*" and the first respondent by adopting the identical trademark "*PRAKASH*" of the petitioner, has done so with malafide intention to make unlawful enrichment, by passing off the first respondent goods as those of the petitioner.

8. I also find that the petitioner is a registered owner and proprietor of the artistic work "*PRAKASH PVC PIPES*", which is also registered under the Copy Right Act, 1957. The petitioner also has registered several trademarks using "*PRAKASH*" under Classes 9, 17 as well as 20. The



petitioner has shown that their sales over the past several years is only on the rise from time to time, indicating the popularity and success of the petitioner's trademark.

9. The petitioner has also filed several suits against various other infringers of the trademark "*PRAKASH*", with or without suffix and prefix and had successfully obtained interim orders against such infringers of trademark "*PRAKASH*". I also find from the Registration Certificate issued to the first respondent that he had claimed user from 04.01.1993 and he has been granted Registration under Classes 9 and 17 which were valid until 21.11.2023 only.

10. It is the specific case of the learned counsel for the petitioner that the first respondent has not been using the trademark "*PRAKASH*" for over five years. The first respondent has not appeared to contradict the stand of the petitioner in this regard as well.

11. In any event, I find that the petitioner is the prior user and both



(T) OP (TM) No.542 of 2024

the petitioner and the first respondent are dealing with the same goods.

There is every likelihood of deception caused by the first respondent using the registered trademark "*PRAKASH*" which is exclusively belonging to the petitioner and in such process, make illegal gain at the expense of the petitioner. Thus, I find that the petitioner has made out a case for rectification by way of cancellation of the registered trademarks No.1251013 in Classes 9 & 17.

12. In fine, this Original Petition is allowed and the registration of the 1st respondent's Trade Mark No.125103 registered under Class-17 is hereby cancelled. No costs.

28.06.2024

Index : Yes/No

Speaking/Non-speaking order

rkp

To

The Registrar of Trademarks,

Trade Marks Registry,

Intellectual Property Appellate Rights Building,

G.S.T.Road, Guindy, Chennai 600 032.



WEB COPY



(T) OP (TM) No.542 of 2023

P.B.BALAJI,J.

rkp

(T) OP (TM) No.542 of 2023

28.06.2024