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OP(TM) No.61 of 2024

IN THE HIGH COURT OF JUDICATUE AT MADRAS

DATED: 03.12.2024

CORAM

THE HONOURABLE **MR. JUSTICE ABDUL QUDDHOSE**

OP(TM) No.61 of 2024

LENOVO (Singapore) Pte. Ltd.,
Rep. By its authorized representative
Ms.Becky A.Williams,
Singapore.

.. Petitioner

Vs

1.RPD Workstations Private Limited,
Banjara Hills, Hyderabad – 500 034.
Telangana.

2.The Registrar of Trademarks,
Office of the Trade Mark Registry,
The Intellectual Property Building,
Guindy, Chennai – 600 032.

.. Respondents

Prayer: This appeal is filed under Section 57 of the Trade Marks Act, 1999, seeking to rectify, cancel and remove the entry relating to the impugned mark 'THINBOOK' bearing number 3306407 in Class 9 made in the name of the first respondent, from the Register of Trademarks; and award costs of the proceedings to the petitioner.



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For Petitioner : Mr.Ramesh Ganapathy
For R2 : Mr.S.Janarthanam, SPCGSC
For R1 : No Appearance

JUDGMENT

This petition has been filed under Section 57 of the Trade Marks Act, 1999 (in short 'the Act') seeking for cancellation and removal of the first respondent's trademark 'THINBOOK' bearing No. 3306407 in Class 9 from the Register of Trademarks.

2. The petitioner has challenged the impugned trademark registration on the following grounds:-

(a) The petitioner is the originator, prior adopter, prior user and prior registered proprietor of the THINK Family of Marks including THINKPAD and THINKBOOK for a varied range of goods and services, including those falling under Classes 09, 16, 35 and 42.

(b) The petitioner has been using THINK Family of Marks since 1992 for a wide variety of goods and through such use, the said trademarks have been associated exclusively with the petitioner.

(c) The petitioner's THINK Family of Marks enjoy a high degree



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of goodwill and reputation.

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(d) The petitioner's THINKPAD and THINKBOOK are entitled to be protected as a well-known trademark within the meaning of Section 2(1)(zg) of the Act.

(e) The impugned trademark covered under the impugned registration is structurally, visually, phonetically and conceptually similar to the petitioner's THINK Family of Marks, in particular, the marks 'THINKBOOK' and 'THINKPAD'. According to the petitioner, since THINK Family of Marks belong to the petitioner, the public at large is likely to think that the impugned mark is another addition or extension to THINK Family of Marks of the petitioner.

(f) The impugned mark gives rise to a strong risk of consumer getting confusion due to the first respondent's apparent association with the THINK Family of Marks of the petitioner, as the consumer would believe that the impugned mark is merely an extension/new service/product offered under the petitioner's THINK Family of Marks.

(g) The malafide and deceitful intention of the first respondent to copy the petitioner's earlier and famous THINK Family of Marks is evident from the fact that the first respondent is well aware that the petitioner adopted a unique font style in respect of its trademarks with 2



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letters in capital, i.e., ThinkPad, ThinkStack, ThinkCenter, ThinkMate, ThinkVantage, to distinguish THINK as the dominant portion of the trademark and therefore, the first respondent has deliberately copied and picked up the said concept of the petitioner to come as close as possible to the petitioner's THINK Family of Marks.

(h) The goods and services covered under the impugned registration are highly similar/nearly identical to the goods and services offered by the petitioner in connection with its THINK Family of Marks, for which, the petitioner has prior rights under Class 09. The similarities between the goods and services offered by the petitioner and the first respondent will only cause further confusion in the minds of the general public.

(i) The registration of the impugned mark by the Trademark Registry is contrary to the provisions of Section 9(1)(a) and Section 9(2)(a) of the Act. Instead of refusing to register the first respondent's trademark under those provisions, the Trademark Registry has erroneously by total non-application of mind to the fact that the very same trademark is being adopted and used for a very long years by the petitioner, registered the mark 'THINBOOK' in favour of the first respondent.



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(j) The registration of the impugned mark also runs contrary to the provisions of Section 11(1) of the Act. According to the petitioner, even on relative grounds for refusal of registration as provided under Section 11(1) of the Act, the Trademark Registry ought not to have registered the impugned trademark in favour of the first respondent. The petitioner has acquired distinctiveness for its THINK Family of Marks by its long and continuous usage and the impugned mark will certainly cause confusion in the minds of the general public as to whom the impugned mark belongs. According to the petitioner, by the long and continuous usage, THINK Family of Marks have been associated only with the petitioner and no one else.

3. The first respondent has been duly served with notice in this petition. However, till date, they have not entered appearance despite due service. Therefore, the first respondent is set exparte by this Court.

4. The second respondent is represented by its standing counsel. He reiterates that only by following due procedure contemplated under the Trade Marks Act, the trademark, which is impugned in this petition, was granted in favour of the first respondent.



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5. This Court has given due consideration to the credentials of the petitioner as highlighted in this petition. Judicial notice can also be taken note of the said fact. Admittedly, the petitioner is one of the leading Laptop manufacturers in the world. The credentials of the petitioner as pleaded in this petition are undisputed. The petitioner's THINK Family of Marks are for their Laptops, Notebooks, Ipads, etc. and they are exclusively associated only with the petitioner and no one else. It is surprising as to how the second respondent has granted registration under Class 9 bearing No. 3306407 in favour of the first respondent for its mark 'THINBOOK', which is also used by the first respondent for the sale of their Laptops. A series of trademarks have been registered in favour of the petitioner for their THINK Family of Marks as revealed in this petition. They have been using THINK Family of Marks from 1992 onwards in India and internationally from 1920 onwards. They have also obtained registration for their THINK Family of Marks in India, which is also disclosed in the petition, and supporting documents have also been filed along with this petition.

6. This Court has carefully examined and perused the same. On



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careful examination and perusal, this Court is of the considered view that as pleaded in this petition, the petitioner has obtained several trademark registrations under various Classes in respect of their THINK Family of Marks. The petitioner has gained reputation of its own in India and Abroad in respect of their products, viz., Laptops, Notebooks, Ipad, etc., by using THINK Family of Marks.

7. The first respondent has also attempted to obtain the trademark registration by using the mark THINBOOK-2, for which, the petitioner had also filed a petition for opposition before the Trademark Registry and the said opposition petition is still pending. However, according to the petitioner, without their knowledge, the first respondent has obtained trademark registration for their mark 'THINBOOK' bearing No. 3306407 under Class 9, which is impugned in this petition. The first respondent has been using the said mark only for the manufacture and sale of Laptops. The products of the petitioner have gained reputation both in India and Abroad under their THINK Family of Marks. Therefore, certainly, the use of the mark 'THINBOOK' by the first respondent will cause confusion in the minds of the general public as to the origin of the same. The public would certainly think that since the mark 'THINBOOK'



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is phonetically similar to the petitioner's THINK Family of Marks, the said mark 'THINBOOK' also belongs to the petitioner. Therefore, on account of causing confusion, this Court cannot allow the mark 'THINBOOK' to remain as an registered mark in the Register of Trademarks. By misrepresentation, the first respondent has been able to convince the Trademark Registry and obtained registration of its mark 'THINBOOK' bearing No. 3306407 under Class 9 and the second respondent also by total non-application of mind to the fact that the petitioner is the registered proprietor of THINK Family of Marks has permitted registration of the mark 'THINBOOK' in favour of the first respondent.

8. The petitioner has satisfied the requirements of Section 57 of the Act for cancelling the first respondent's trademark 'THINBOOK'. The petitioner is certainly an aggrieved party, since the usage of the mark 'THINBOOK' by the first respondent, which is deceptively and phonetically similar to that of the petitioner's THINK Family of Marks, will cause disrepute to the petitioner in the Indian and International market pertaining to the manufacture and sale of Laptops, Notebook,



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Ipad, etc.

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9. Admittedly, the petitioner is a major player insofar as the products manufactured by them are concerned. Being a global leader in the manufacture and sale of Laptops, Notebook, Ipad, etc., their reputation should not be tarnished by a small time player, namely, the first respondent, who has copied the petitioner's trademark by using the mark 'THINBOOK', which is certainly deceptive and phonetically similar to that of the petitioner's THINK Family of Marks. It is also undisputed fact that THINK Family of Marks are being used by the petitioner in India since 1992 and in Abroad since 1920.

10. Since this Court has come to the conclusion that the petitioner is the exclusive proprietor of THINK Family of Marks, for which, trademark registrations have already been obtained both in India as well as in Abroad; that the petitioner has acquired distinctiveness for its THINK Family of Marks by its long and continuous usage; and that the first respondent's mark 'THINBOOK' is deceptively and phonetically similar to that of the petitioner's THINK Family of Marks, this Court will have to allow this petition under Section 57 of this Court. Accordingly,



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for the reasons stated above, the second respondent is directed to cancel the impugned mark 'THINBOOK' bearing No. 3306407 in Class 9 made in the name of the first respondent and remove the said mark from the Register of Trademarks, within a period of four weeks from the date of receipt of a copy of this order. In the result, this petition is allowed. No Costs.

03.12.2024

rkm
Index:yes/no
Neutral citation: yes/no

To

The Registrar of Trademarks,
Office of the Trade Mark Registry,
The Intellectual Property Building,
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ABDUL QUDDHOSE,J.

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