

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)

IPDATM/1/2023

MONDAL BROTHERS ENTERPRISES PRIVATE LIMITED
VS
THE REGISTRAR OF TRADE MARKS AND ORS.

Before:

The Hon'ble Justice RAVI KRISHAN KAPUR

Date: 6th March 2025

Appearance:
Mr. Sayantan Basu, Sr. Adv.
Mr. Tanmoy Roy, Adv.
Mr. Koushik Mukherjee, Adv.
...for applicant.

Mr. Nandalal Singhania, Adv.
Ms. Rini Bhattacharyya, Adv.
...for controller.

The Court: This is an application for rectification and cancellation under sections 47, 57 and 125 of the Trademarks Act, 1999.

The petitioner is a company involved in the business of manufacturing and trading in wide range of goods including tarpaulin, vermi bed, wagon covers, sack, bags and other similar goods. By a Deed of Assignment dated 1 September 2020, the petitioner had been assigned the absolute and exclusive rights of all the marks and copyrights in the mark 'TARPEX' under the Trade Marks Act 1999 and the Copyright Act 1957 respectively.

Briefly, the petitioner challenges the registration of the impugned mark TARFLEX Tarp (T Logo)(Device of Stars) being application number 3117287, filed on 7 December 2015 in class 22 for the goods tarpaulin registered in favour of the respondent no.3.

The above application was duly examined, accepted and advertised on 8 August 2016. Subsequently, the registration was granted in favour of the private

respondent no. 3, bearing registration certificate number 1430127, dated 30 December 2016.

The original owner of the mark 'TARPEX' was the East Hooghly Poly Plast Private Limited who were also involved in the same business as that of the petitioner and the respondent no.2. By a Deed of Assignment dated 1 September 2020, all rights in the said mark were assigned by the original owner to the petitioner. It is submitted on behalf of the petitioner that the impugned mark TARFLEX is deceptively and strikingly similar to the petitioner's mark TARPEX.

The respondent Controller does not oppose the submissions made on behalf of the petitioner and makes no submissions insofar as the merits of the case are concerned. Despite repeated service, the private respondent no. 3 remains unrepresented.

It appears from the records that originally one Hooghly Polyplast Private Limited, duly incorporated under the Companies Act, 1956 was inter alia, engaged in carrying on business of manufacturing and marketing of tarpaulin, HDPE Covers, Vermi Bed, Wagon Covers LDPE Covers, Sacks and Bags and other allied products. In the usual course of business, the company had on 15th November 2010 adopted and conceived of the mark TARPEX to be used in respect of the above products. The sale figures of the above products also demonstrates that the petitioner has a sizable volume of sales. By virtue of a Deed of Assignment dated 1st September 2020, the company assigned all its rights in respect of the said mark

TARPEX along with the goodwill, reputation and assets of the company to the petitioner. As a consequence, the petitioner became the proprietor of all the trademarks and copyrights pertaining to the mark TARPEX both under the Trademarks Act 1999 and under the Copyright Act, 1957. The petitioner thereby has been using the above mark continuously and uninterruptedly since 2010. The mark TARPEX of the petitioner has also been represented in a particular artistic manner which is completely unique and innovative. The petitioner has also spent sizable amounts on advertisements and sales promotion. With the passage of time, the petitioner has earned immense reputation and goodwill in respect of the above mark. Sometime in May 2022, while causing searches, the petitioner came to learn of the impugned mark TARFLEX registered in favour of the respondent no. 3 bearing trademark number 3117287 in class 22. In this background, the petitioner has filed this application for rectification and cancellation of the registration in favour of the impugned mark. During the pendency of this proceeding, the petitioner has also obtained registration in the category of multi class (class 99) which has been registered in favour of the petitioner on 17 May, 2023.

Admittedly, the petitioner is the prior adopter and user of the mark TARPEX. The respondent no. 3 has been unable to show that they have not been using the impugned mark. In any event, the impugned mark is phonetically and structurally similar to the petitioner's mark 'TARPEX'. There is every likelihood of confusion and deception as to the source and origin of the two products. The respondent no.

3 has also been unable to furnish any reason for adopting a mark which is deceptively similar to the mark of the petitioner. There is no *bonafides* which the respondent no.3 has been able to demonstrate.

In such circumstances, it is clear that the respondents being in the same business as that of the petitioner are attempting to ride on the goodwill and reputation of the petitioner. The impugned mark is devoid of any distinctive character and violates the mandate of section 9(2) of the Act and is *per se* deceptive. The impugned mark erodes the exclusivity or distinctive character of the earlier trademark. The goods of the respondent being similar to that of the petitioner will inevitably lead in dilution of the goodwill of the mark of the petitioner. As such, the impugned mark has been registered in violation of the provisions of the Act.

In view of the above, the petitioner has been able to demonstrate a strong *prima facie* case on merits. The balance of convenience and irreparable injury are also in favour of orders being passed. In such circumstances, there shall be an order in terms of prayers (a) to (f) of the Notice of Motion.

With the above directions, IPDATM/1/2023 stands allowed.

(RAVI KRISHAN KAPUR, J.)