



(T)OP(TM)No.48 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 27.03.2025

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CORAM:

THE HONOURABLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)No.48 of 2023
(ORA/240/2012/TM/CHN)

Heritage Foods (India) Limited

6-3-541/C, Panjagutta

Hyderabad-500 082 (A.P)

Represented by its President

M.Sambasiva Rao, son of Ram Koti

Aged : 55 yrs, r/o Hyderabad (A.P)

.. Petitioner

Vs.

1. Good Health Agrotech Pvt. Ltd.

1-8-663, Azamabad Industrial Area

Azamabad, Hyderabad-500 020 (A.P.)

2. The Registrar of Trade Marks

Trade Marks Registry

Chennai.

.. Respondents

Prayer: This Original Petition (Trademarks) filed under Sections 57 & 125 of the Trademarks Act, 1999, praying to pass order for removing the impugned mark from the Register and grant reliefs as prayed for.

For Petitioner :Mr.Venkata Ramana for
M/s.Rao and Rao



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For Respondents : Ms.S.Bala Janaki for R1

Mr.J.Madagagopal Rao, SPC for R2

ORDER

By this petition, the petitioner seeks rectification of the register of trade marks by expunging the entry relating to trade mark No.1250040.

2. The petitioner states that it is a listed company engaged in manufacturing and marketing a range of dairy and food products. It is further stated that the sales turnover of the petitioner by sale of products bearing the trade mark 'HERITAGE' is substantial and was about Rs.900.38 crores for financial year 2009-10. Likewise, it is stated that the advertising expenditure in relation to such products for financial year 2009-10 was Rs.1,41,83,027/-. The petitioner relies on multiple registration certificates pertaining to marks containing the word 'HERITAGE', which registrations were in Class 29 in relation to a range of dairy and food products.

3. The petitioner asserts that the mark 'HERITAGE', which forms a part of the corporate name of the petitioner, has been used since 1993. As



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evidence of use, purchase orders issued by the petitioner and invoices raised on the petitioner in respect of the issuance of advertisements on behalf of the petitioner have been placed on record. The petitioner has further placed on record wrappers for a range of dairy and food products manufactured and marketed by the petitioner under the trade mark 'HERITAGE'. Upon noticing the impugned trade mark, it is stated that the petitioner instituted a civil suit, O.S.No.510 of 2011, before the City Civil Court at Hyderabad and also filed opposition proceedings in respect of several applications filed by the first respondent for registration of trade marks. The present rectification petition was filed in these facts and circumstances.

4. Learned counsel for the petitioner referred to the above mentioned facts and sequence of events. In particular, he emphasizes that the petitioner's sales turnover is substantial and was Rs.900.38 crore in financial year 2009-10. He also states that the aggregate sales turnover between 1993-94 and 2009-2010 was about Rs.4269.04 crore. By referring to the registration certificates, he points out that the registration for trade mark No.597152 covers edible oils and fats. He further submits that such registration was with effect from 14.05.1993. By referring to



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purchase orders placed on suppliers by the petitioner, learned counsel points out that the first purchase order on record was issued on or about 26.06.1992. As regards invoices issued by advertising agencies, he points out that invoices issued from 1999 have been placed on record. By referring to the wrapper relating to the sale of cow ghee under the trade mark 'HERITAGE', learned counsel submits that both cow ghee and the edible oils marketed by the first respondent are cognate goods. He also points out that the petitioner is operating multiple retail units across the country under the name and style of Heritage Fresh and relies upon invoices issued by such units.

5. On the strength of the above documents, learned counsel contends that the petitioner has established long and prior use resulting in the acquisition of significant reputation. Therefore, it is submitted that the use of the deceptively similar mark 'HERITAGE' by the first respondent in relation to edible oils, which are cognate goods, is likely to cause deception and confusion among the public. By further submitting that other applications for registration of trade marks by the first respondent were opposed by the petitioner, learned counsel submits that this application had missed the attention of the petitioner. Since the entry



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relating thereto was made without sufficient cause, learned counsel

contends that the entry is liable to be expunged from the register.

6. These contentions were refuted by learned counsel for the first respondent. Her first submission was that the first respondent had originally applied for registration of the trade mark 'HERITAGE' before the Registrar of Trade Marks, Chennai, on 15.09.1994 claiming user from 01.04.1991. After the said application was deemed abandoned, she states that a subsequent application was filed on 17.11.2003 by erroneously claiming user from 17.11.2003. Upon realizing this error, she states that an application for correcting the user date was lodged on 10.10.2011 and that the said application is still pending. She points out that the first respondent has placed on record evidence of use of the mark 'HERITAGE' in relation to edible oils in the form of an application for certificate of authorization dated 01.04.1994 and by way of multiple invoices. According to her, the earliest invoice is dated 03.04.1995 and that invoices issued between April, 1995 and the date of filing of the rectification application have been placed on record. Therefore, she submits that the first respondent is an honest and concurrent user and that use by the first respondent over this extended period of time has not caused any deception or confusion among the public.



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7. In support of the contention that the first respondent is an honest and concurrent user, learned counsel referred to and relied upon the judgment of a Division Bench of the Delhi High Court in *Goenka Institute of Education v. Anjani Kumar Goenka & another*, AIR 2009 Delhi 139, particularly paragraph 12 thereof. She also relied upon the judgment of the Hon'ble Supreme Court in *Renaissance Hotel Holdings Inc. v. B.Vijaya Sai*, judgment dated 19.01.2022 in Civil Appeal No.404 of 2022, especially paragraph 59 thereof.

8. Her next contention is that the petitioner is not entitled to the relief of rectification on the ground of laches and acquiescence. In support of this contention, learned counsel points out that opposition proceedings were initiated by the petitioner in relation to other applications filed by the first respondent in the year 2008, whereas the rectification petition was lodged only in May 2012. As regards the civil suit filed by the petitioner, she submits that such civil suit was dismissed for non-prosecution and that no steps were taken by the petitioner in relation thereto.



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WEB COPY 9. Upon taking stock of the rival contentions, the first question that

falls for consideration is the evidence adduced by the contesting parties with regard to use of the identical trade mark 'HERITAGE' by each party.

In this regard, the petitioner has placed on record certificate of incorporation dated 05.06.1992, which shows the incorporation of the petitioner under the name and style of 'HERITAGE FOODS (INDIA) LIMITED'. Several registration certificates for registration of word and device marks containing the element 'HERITAGE' have also been placed on record by the petitioner. The earliest certificate relates to trade mark No.597152 for a device mark containing the element 'HERITAGE'. The registration is with effect from 14.05.1993 and appears to be on 'proposed-to-be-used' basis. This registration is in Class 29 covering a range of dairy and food products, including edible oils and fats. Other registrations in Classes 28, 29, 31 and 32 have also been placed on record.

10. By way of evidence of use, the petitioner has relied on several purchase orders issued by the petitioner for purchase of items like milk cards. These purchase orders were issued under the corporate name of



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the petitioner, which, as noticed earlier, contains the element 'HERITAGE'. The earliest of these purchase orders was issued in the year 1992. Invoices relating to advertising expenditure are also on record. As regards direct evidence of use in relation to specific goods, wrappers have been placed on record. These wrappers indicate use in relation to dairy products such as milk, ghee and ice cream; and food products such as turmeric powder, coriander powder, khatta-meetha and nuts. Material evincing retail sales by Heritage shops, both through physical stores and online, of a range of consumer staple and personal care products bearing different trade marks, and invoices issued by retail outlets under the name 'Heritage Fresh' are also on record. It should be noticed, in this regard, that the petitioner has not placed on record any evidence of use of the trade mark in relation to edible oils.

11. The first respondent, on the other hand, asserts use since 01.04.1991. Such assertion is contained in Form TM-26 pertaining to the application to rectify the user date in trade mark No.1250040. Trade mark No.1250040, which is the impugned trade mark, was issued with effect from 17.11.2003. By way of evidence of use, as discussed earlier, the first respondent has relied on the application for grant of certificate of



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authorization to grade and mark vegetable oils under *inter alia* the 'HERITAGE' brand. This application is dated 01.04.1994. The applicant has also placed on record communications from the Deputy Agricultural Marketing Adviser granting permission for printing pouches for vegetable oils. A letter dated 28.09.1994 from Sri Satya Sai Laboratories enclosing a demand draft towards revenue charges for 15 kgs. of groundnut oil under the trade mark 'HERITAGE' has also been enclosed in the volume of documents.

12. Apart from these documents, the first respondent has also placed on record invoices relating to sale of products bearing the trade mark 'HERITAGE'. The earliest of these invoices is dated 03.04.1995. Multiple invoices issued between 03.04.2008 and about 2008 by the first respondent for sale of edible oil have also been filed by the first respondent. If the above documents are compared with documents produced by the petitioner, the evidence leads to the conclusion that the petitioner has used the corporate name containing the word 'HERITAGE' from about 1992, i.e. after incorporation. With regard to sales, it is unclear from the documents on record as to the date of first commercial sale of the petitioner's products. The turnover details set out in the



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petition provide such data from financial year 1993-94 onwards. Both the provision of such data only from financial year 1993-94 and the low turnover of about Rs.4.38 crore in that year indicate that the said year was the first year of commercial sale. While the first respondent contended that it commenced use in 1991, there is no evidence of use from 1991. Nonetheless, the documents on record lead to the conclusion that the first respondent commenced using the impugned trade mark latest by early 1995. The documents on record also clearly disclose that the petitioner has not applied the mark in relation to edible oils, although the registration certificate for trade mark No.597152 also covers edible oils and fats.

13. Apart from the above, an affidavit filed by the first respondent in support of its trade mark application before the Registrar of Trade Marks is also on record. In paragraph 15 thereof, the first respondent has set out details of its sales turnover and the promotional expenses from financial year 1995-96 to financial year 2007-2008. This leads to the question whether the first respondent would qualify for protection under Section 12 of the Trade Marks Act, 1999 (the TM Act).



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14. Section 12 is as under:

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*“12. Registration in the case of honest concurrent use, etc.—In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, **subject to such conditions and limitations, if any, as the Registrar may think fit to impose.**”(emphasis added)*

As is evident from the text of Section 12, it is applicable if there is honest concurrent use or other special circumstances which permits the registration by more than one proprietor of trade marks which are identical or similar. Such registration may be permitted subject to such conditions and limitations as the Registrar may impose.

15. Whether this issue may be considered in a rectification petition warrants brief consideration. Section 57 is as under:

57. Power to cancel or vary registration and to rectify the register.—(1) On application made in the prescribed manner to the [High Court] or to the Registrar by any person aggrieved,



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the [Registrar or the High Court, as the case may be,] may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the [High Court] or to the Registrar, and the [Registrar or the High Court, as the case may be,] may make such order for making, expunging or varying the entry as it may think fit.

(3) The [Registrar or the High Court, as the case may be,] may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(4) The [Registrar or the High Court, as the case may be,] of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an



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*opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).
(5) Any order of the [High Court] rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.*

From the language of Section 57, it is pertinent to notice that the power of rectification embraces the power to expunge, modify, make or vary entries in the register of trade marks. Under sub-section (3), this Court may decide any question that it is necessary or expedient to decide in connection with such rectification, and this would encompass the power to decide whether the benefit of Section 12 should be extended and, if so, on what conditions.

16. In the case at hand, the first respondent is applying the trade mark 'HERITAGE' only to edible oils. There is no evidence of the use of the trade mark 'HERITAGE' by the petitioner in relation to edible oils. As discussed above, the first respondent has placed on record evidence of adoption of the trade mark 'HERITAGE' in relation to edible oil in early 1994 and commercial sale from early 1995. The evidence on record leads



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to the inference that such adoption and use was both honest and *bona*

fide. The petitioner has not placed any evidence to the contrary. The petitioner had filed O.S.No.510 of 2011 seeking relief in respect of alleged infringement and passing off. Admittedly, the suit was dismissed for non-prosecution and no action has been taken thereafter to restore the suit. In the cause of action paragraph of the suit, the petitioner states that it became aware of applications by the first respondent for registration of multiple trade marks on 16.02.2008. It is also stated that opposition proceedings were initiated on 15.04.2008. However, the petitioner lodged the rectification petition only in 2012. Therefore, there has been considerable delay on the part of the petitioner in filing the rectification petition.

17. In these circumstances, there are special circumstances justifying the retention of the entry relating to the first respondent's trade mark by extending the benefit of Section 12 of the TM Act to the first respondent subject to the condition that the Registrar of Trade Marks shall incorporate a limitation that the first respondent's use of the impugned mark shall be limited to edible oils. In view of this conclusion, it is unnecessary to examine whether the petitioner acquiesced in the use of the impugned trade mark by the first respondent.



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WEB COPY 18. For reasons aforesaid, (T)OP(TM) No.48 of 2023 is disposed of by declining to expunge the entry from the register of trade marks but by directing the Registrar of Trade Marks to incorporate a condition in the entry relating to the first respondent's trade mark in the register of trade marks that the first respondent shall not apply the mark to any products other than edible oils. There shall be no order as to costs.

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Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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To

The Registrar of Trade Marks

Trade Marks Registry

Chennai.



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SENTHILKUMAR RAMAMOORTHY J.

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