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(T) OP (TM) No.532 of 2023
and OP (TM) No.59 of 2024

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 20.02.2025

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T) OP (TM) No.532 of 2023

and

OP (TM) No.59 of 2024

(T) OP (TM) No.532 of 2023

Solidaire Digital Electronics Private Limited,
H-306, TNHB Colony, Ellis Nagar,
Madurai – 625 016, Tamil Nadu, India.

... Petitioner

Vs.

1. Salahudeen Abdhullatheef,
M/s.Sagar Enterprises Punalur,
Kollam District – 691 305.

2. The Registrar of Trade Marks,
Intellectual Property Building,
GST Road, Guindy,
Chennai – 600 032.

... Respondents

Prayer: Original Petition has been filed under Sections 47, 57 and 125 of the Trade Marks Act, 1999, pleaded to rectify the impugned mark vide TM.No.3882705 in Class 9 of the registered proprietor ought to be expunged from the register of trademarks.



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OP (TM) No.59 of 2024

Salahudeen Abdhullatheef,
Trading As: M/s. Sagar Enterprises Punalur,
Kollam District – 691 305, Kerala, India.

... Petitioner

Vs.

1. Solidaire Digital Electronics Private Limited,
H – 306, TNHB Colony,
Ellis Nagar, Madurai – 625 016,
Tamil Nadu, India.

2. The Registrar of Trademarks,
The Office of Trademarks Registry,
The Intellectual Property Building,
GST Road, Guindy, Chennai – 600 032.

... Respondents

Prayer: Original Petition has been filed under Sections 47 and 57 of the Trade Marks Act, 1999, pleased to remove the registered trademark **Solidaire** of the petitioner having Registration No.1574746 under Class.

For Petitioner : Mr.R.Sathishkumar
for M/s.G.Ramji
in (T) OP (TM) No.532 of 2023

Mr.Ramesh Ganapathy
in OP (TM) No.59 of 2024

For 1st Respondent : Mr.Ramesh Ganapathy
in (T) OP (TM) No.532 of 2023

Mr.R.Sathish Kumar
in OP (TM) No.59 of 2024



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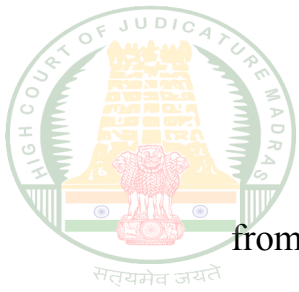
For 2nd Respondent : Mr.S.Janarthanam,
in both petitions Senior Panel Counsel

COMMON ORDER

(T) OP (TM) No.532 of 2023 has been filed by the Solidaire Digital Electronics Private Limited (Solidaire Private Limited) to rectify the register of trade marks with regard to the trademark , which was registered under TM No.3882705 in Class 9 in relation to inter alia Compact Discs, DVDs and other digital recording media.

2. OP (TM) No.59 of 2024 was filed by Salahudeen Abdhullatheef (Abdhullatheef) to rectify the register of trade marks in respect of the trademark , which was registered under TM No.1574746 in Class 9 in respect of all types of electronics and communication equipments and wireless equipments and domestic equipments, DTH and DTS systems, VHF and UHF, FM antennas.

3. The registration of Solidaire Private Limited was with effect



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from 02.07.2007 claiming user from 05.06.2007. The registration of Abdhullatheef is with effect from 09.07.2018. Such registration was obtained on a “proposed to be used” basis.

4. Learned counsel for Solidaire Private Limited, Mr.R.Sathishkumar, submits that the registration was obtained by asserting use from 05.06.2007. As evidence of use, he relies upon a series of invoices, the first of which is invoice dated 07.06.2007. He also relies upon the documents issued by various Government authorities, such as the acknowledgement dated 02.06.2009 from the Department of Industries and Commerce, Government of Tamil Nadu. He points out that the predecessor in interest of Solidaire Private Limited was a proprietary concern under the trade name 'SOLIDAIRE', which was established by the sole proprietor, S.Rajan.

5. By contrast, learned counsel submits that Abdhullatheef registered a deceptively similar trademark with effect from 09.07.2018 on a “proposed to be used” basis. As regards evidence of use, by referring to



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invoice dated 14.05.2020, learned counsel submits that the said invoice is the first invoice in chronology. Thus, learned counsel submits that Solidaire Private Limited is both the prior user and prior registrant of the trademark **Solidaire**.

6. As regards the defence raised by Abdhullatheef, learned counsel submits that the earlier registration of the trademark “SOLIDAIRE” was removed from the Register of Trademarks some time in the year 2006. He also submits that the status continues without change and that no steps were taken for the restoration of the trademark. He further submits that there is no evidence of use of trademark “SOLIDAIRE” by the proprietor Hi-Beam Electronics Private Limited (Hi-Beam) or any successor in interest. In any event, learned counsel contends that the earlier registration by Hi-Beam cannot be raised as a defence by Abdhullatheef. Even if such defence were to be raised by Hi-Beam, in the factual context of discontinuation of use of the said mark, he contends that a petition by Hi-Beam would be liable to be rejected. *A fortiori*, he submits that the petition by Abdhullatheef is clearly not sustainable.



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7. In response to these contentions, Mr.Ramesh Ganapathy submits that the adoption and use by Solidaire Private Limited is not honest. The said entity has blatantly copied the trademark of Hi-Beam. Consequently, he submits that Solidaire Private Limited is not entitled to seek the relief of rectification. The next contention of learned counsel is that the trademark of Abdhullatheef is not deceptively similar. The trademark is derived from the latin expression for a small piece of money. In contrast, he submits that the trademark of Solidaire Private Limited is derived from the word 'Solidarity'.

8. In support of his contentions, learned counsel for Abdhullatheef referred to the following judgments for the principles set out below:

(i) J.K.Sons -vs- Parksons Games & Sports, (2011) SCC

OnLine Bom 397, particularly paragraph 13, for the principle that no action is sustainable if tainted by

Ex turpi causa;



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(ii) Official Liquidator of M/s Ideal Jawa (India) Limited

(In liquidation) -vs- Registrar of Trademarks, C.A.No.71 of 2018, for the proposition that a company does not lose the ability to monetise its trademark either on account of such company being wound up or on account of ceasing to use the relevant trademark;

(iii) R.R.Oomerbhoy Pvt Ltd. -vs- Court Receiver, High

Court, Bombay, (2003) SCC OnLine Bom 718, especially paragraph 32, for the principle that the goodwill of a firm and the property in trademark does not get destroyed by mere cessation of business;

(iv) Hardie Trading Ltd. -vs- Addisons Paint &

Chemicals Ltd., (2003) 11 SCC 92, particularly paragraphs 26, 27 and 49 with regard to the interpretation of the expression “aggrieved person” in Sections 47 and 57 of the Trademarks Act;

(v) Ramjas Foundation -vs- Union of India, (2010) 14

SCC 38, particularly paragraph 21, for the proposition that a person approaching court with unclean hands is



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not entitled to equitable relief; and

(vi) *Sun Pharma Laboratories Ltd. -vs- Finecure Pharmaceuticals Ltd., 2023 SCC OnLine Del 4932,* particularly paragraph 63 thereof, for the principle that infringement is a statutory tort and that the entitlement to remedy depends on the existence of a right in the person seeking such remedy.

9. The essential facts are largely undisputed. Solidaire Private Limited has placed on record evidence of use of its trademark from 07.06.2007. Abdhullatheef has placed on record evidence of use from 14.05.2020. Therefore, without doubt, Solidaire Private Limited is the prior user. The registration certificates also disclose that the registration of Solidaire Private Limited is with effect from 02.07.2007, whereas the registration of Abdhullatheef is with effect from 09.07.2018.

10. The next aspect to be examined is whether the two trademarks are deceptively similar. The two marks are set out below in



order to examine whether the marks are deceptively similar:

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11. It is noticeable from the above depictions that both marks are labelled as device marks. Notwithstanding such label, the prominent feature of Abdhullatheef's mark is the word "SOLIDARE". The almost exclusive feature of Solidaire Private Limited's mark is the word "SOLIDAIRE". Except for the placement of the alphabet "i" between the letters "a" and "r" in the mark of Solidaire Private Limited, there is no difference at all. From a phonetic stand point, it is difficult to distinguish between the two marks. If viewed from the perspective of a consumer of average intelligence and imperfect recollection, there is no doubt that the two marks are deceptively similar.

12. The next aspect to be considered is whether the marks are used in relation to similar or cognate goods. By examining the respective



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registration certificate and invoices, it appears that the trademark of Solidaire Private Limited is being used in relation to equipments, such as DTH systems, FM antenna and the like. If the documents of Abdhullatheef are subjected to similar scrutiny, it appears that the mark is being used in relation to electronic goods, such as televisions. Since both the parties deal with electronics and communication equipments, it cannot be said that the goods to which the respective marks are applied are not similar. Abdhullatheef has not pleaded acquiescence. The documents on record do not leave room to plead or establish prior use or even honest and concurrent use. All that remains is to consider the defence based on the prior registration by Hi-Beam.

13. Hi-Beam had registered the mark “SOLIDAIRE” in relation to Television receiving sets, sound recording equipments and the like. Such registration was with effect from 20.03.1978. In the written arguments filed by the first respondent, it is stated that the trademark of Hi-Beam is shown as removed in the records of the Registrar of Trade Marks. There is no evidence of the restoration of the said trademark as on date,



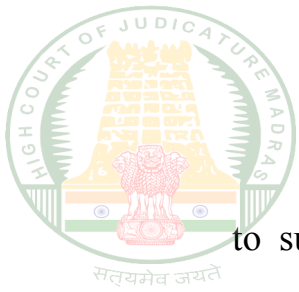
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and the long-stop date for restoration has lapsed. There is no evidence of use of the trademark “SOLIDAIRE” by Hi-Beam as on date.

14. When an application for registration of a trademark is received, it is tested both on absolute and relative grounds. The test on relative grounds under Section 11 of the Trade Marks Act, 1999 (the TM Act) is undertaken to examine whether any deceptively similar mark in relation to similar goods or services exists on the Register of Trademarks. The obvious purpose of the exercise is to maintain the purity of the register and, more importantly, ensure that public interest is safeguarded by not permitting the registration of a later mark, which is deceptively similar to an earlier mark on the register. In the case at hand, the earlier mark not only does not exist on the register, but there is no evidence of use of such earlier mark.

15. Under Section 57 of the TM Act, the rectification of a register is warranted if a mark is erroneously entered on the register or remains thereon erroneously or if there are omissions or errors in relation



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to such entries. As regards the trademark of Solidaire Private Limited, Abdhullatheef has been unable to show the existence of any prior mark on the register when Solidaire Private Limited's mark was entered on the register. Merely because Hi-Beam had once registered the trade mark, SOLIDAIRE, which admittedly does not exist any longer on the register, rectification of the entry relating to the mark of Solidaire Private Limited is not warranted. This conclusion is fortified by the fact that there is no evidence of Hi-Beam's product with the trademark SOLIDAIRE being available in the market.

16. As regards the mark of Abdhullatheef, on the other hand, the documents on records evince that the mark of Solidaire Private Limited is prior thereto both in terms of use and registration. As concluded earlier, the marks are clearly deceptively similar. Therefore, Solidaire Private Limited is entitled to the relief claimed, whereas Abdhullatheef is not so entitled.

17. For the reasons aforesaid, the following orders are issued:

(i) (T) OP (TM) No.532 of 2023 is allowed by directing the



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Registrar of Trademarks to rectify the register by

expunging the trademark  bearing TM

No.3882705 in Class 9 from the Register of Trademarks.

This action shall be completed within four weeks from
the date of receipt of a copy of this order;

(ii) OP (TM) No.59 of 2024 is dismissed without any order
as to costs. No costs.

20.02.2025

skr

Index : Yes

Speaking order

Neutral Citation : Yes

To

1. The Registrar of Trade Marks, Intellectual Property Building,
GST Road, Guindy, Chennai – 600 032.
2. Solidaire Digital Electronics Private Limited, H – 306, TNHB Colony,
Ellis Nagar, Madurai – 625 016, Tamil Nadu, India.
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