

**HIGH COURT OF DELHI**

**BENCH : JUSTICE PRATHIBA M. SINGH**

**Date of Decision: 3<sup>rd</sup> May, 2024**

W.P.(C)-IPD 54/2021

**AMIT SOOD ...PETITIONER**

**Versus**

**UNION OF INDIA AND ORS. ...RESPONDENTS**

**Legislation:**

Sections 9(2)(a), 11(3)(a), 18(1), 47, 57 of the Trade Marks Act, 1999.

**Subject:** The petition concerns the cancellation of the trade mark “ROSHAN” registered under class 42, primarily focusing on the prior use and goodwill associated with the petitioner’s family business in photographic services, and disputes over the legitimacy of the respondent’s claim to the trade mark.

**Headnotes:**

Trademark Law – Prior Use and Goodwill – Dispute over the trade mark “ROSHAN” in relation to photographic studio services – Petitioner asserts prior use and reputation dating back to 1960 under “ROSHAN STUDIO” and later “ROSHAN PORTRAITS” – Petitioner’s evidence includes documents from 1950s showing widespread recognition and usage across various states and interactions with national and international dignitaries – Respondents began using “ROSHAN PORTRAITS” in 1991 in Panchkula, a geographic area close to the petitioner’s original business locations. [Paras 1-9, 18-22]

Cancellation of Trade Mark – IPAB dismissed petitioner’s rectification application, which is challenged here – Delhi High Court finds IPAB’s analysis flawed, particularly the disregard for the petitioner’s extensive evidence of prior use and goodwill, as well as misapplication of legal standards regarding the significance of service mark registrations prior to 2003 – Court rules in favor of petitioner, emphasizing the distinctiveness acquired by “ROSHAN” associated with the petitioner’s services, over decades of use – Respondent’s

registration under “ROSHAN” deemed capable of causing confusion or deception among the public due to the similarity with petitioner’s long-established trade name. [Paras 16-28, 38]

Decision – Respondents’ trademark “ROSHAN” under class 42 ordered to be cancelled – Decision emphasizes protection of public interest in ensuring the purity of the trademark register and preventing misleading use affecting consumers. [Paras 38-39]

#### **Referred Cases:**

- Mahendra & Mahendra Paper Mills Ltd. V. Mahindra & Mahindra Ltd. (2002) 2 SCC 147
- Dr. Reddy’s Laboratories Ltd. V. Reddy Pharmaceuticals Limited MANU/DE/0658/2004
- Montari Overseas Ltd. V. Montari Industries Ltd., 1995 SCC OnLine Del 865
- Heifer Project International Ltd. V. Heifer Project India Trust, 2024:DHC:3178
- Kia Wang v. The Registrar of Trademarks & Anr., 2023:DHC:6684
- Ahmed Oomerbhoy v. Gautam Tank (2007 SCC OnLine Del 1685)

#### **Representing Advocates:**

Petitioner: Mr. Neeraj Grover, Ms. Ritu Khandelwal, Ms. Ayushi Chandra, Ms. Sunidhi Gupta

Respondents: Mr. Mohan Vidhani, Ms. Elisha Sinha, Mr. Ashish Singh, Ms. Mokshita Gautam, Mr. Harish Vaidyanathan Shankar, Mr. Srish Kumar Mishra, Mr. Alexander Mathai Paikaday, Mr. Krishnan V.

### **JUDGMENT**

#### **Prathiba M. Singh, J.**

1. This hearing has been done through hybrid mode.

#### **Facts**

2. The present petition arises out of a cancellation petition filed under Section 57 of the Trade Marks Act, 1999 (*hereinafter referred as ‘the Act’*) by the Petitioner seeking cancellation of the mark “ROSHAN” bearing no.1324435 in Class 42. The bibliographic details of the mark “ROSHAN” is set out below:

TM Application No.	1324435
Class	42
Date of Application	07/12/2004
Appropriate Office	DELHI
State	HARYANA
Country	India
Filing Mode	Branch Office
TM Applied For	ROSHAN
TM Category	TRADE MARK
Trade Mark Type	WORD
User Detail	31/12/1991
Certificate Detail	Certificate No. 460471 Dated : 10/11/2005
Valid upto/ Renewed upto	07/12/2024
Proprietor name	(1) JIT KATHURIA Trading As : ROSHAN PORTRAITS Partnership Firm Details : MRS. SHASHI KATHURIA
Proprietor Address	S.C.O. NO. 72, SECTOR - 7, URBAN ESTATE, PANCHKULA, HARYANA.
Email Id	****eting@premierip.in
Agent name	PREMIER REGISTRATION SERVICE.[260]
Agent Address	8/2, RAJINDER NAGAR, NEW DELHI - 110 060.
Goods & Service Details	[CLASS : 42] PHOTOGRAPHY SERVICES LIKE MICROFILMING, PHOTOGRAPHY, VIDEOTAPING.
Publication Details	Published in Journal No. : 1328-3 Dated : 21/02/2005

3. The provisions on the basis of which cancellation is sought are under Sections 47 and 57 of the Trade Marks Act, 1999. The case of the Petitioner is based upon the prior use of the mark as also the goodwill and reputation of the mark “ROSHAN” in respect of photo studio and other cognate and allied goods/services.

4. The facts which emerge from the record of the case is that the Petitioner, including its predecessors are engaged in the business of providing services in field of photography & ancillary activities including photocomposing, photographic film development, photographic printing *etc.*

The mark “ROSHAN STUDIO” was adopted by the Petitioner’s grandfather in the year 1960 in Simla. The studio in Simla was a partnership firm. As per the partnership deed dated 1<sup>st</sup> April, 2010, the partners in the firm were Mrs.

- Sarita Sood, (Petitioner's mother), Mr. Abhinav Sood (Petitioner's cousin) and Mr. Amit Sood (Petitioner) in equal proportions. The original partnership deed was produced before the Court and an inspection was given of the same.
5. Thereafter, the family set up ROSHAN STUDIO in Panchkula in the year 1992, initially as ROSHAN PORTRAITS, managed by Shri Akshay Sood, father of the Petitioner herein. After the death of Shri Akshay Sood, another branch of ROSHAN STUDIO was opened in Panchkula which was looked after by the Petitioner and the Simla branch was looked after by the Petitioner's mother- Smt. Sarita Sood. The branch in Chandigarh was managed by one of Petitioner's cousin-Shri Abhinav Sood. The Petitioner also operates a website with the domain name www.roshanstudiods.com.
  6. On the other hand, it is averred that the Respondents' studio was also started in Panchkula in the year 1990 under the name "ROSHAN PORTRAITS". The Respondents filed a suit against the Petitioner in the year 2005 before the ADJ, Panchkula. In the said suit, the Petitioner herein filed a counter-claim. It is further averred that during the pendency of the suit the Petitioner became aware of the fact that the Respondents No.2 has obtained a registration for the mark "ROSHAN" under class 42. Vide final order dated 4<sup>th</sup> September, 2008, the suit filed by the Respondents has been dismissed and the counter claim filed by the Petitioner was decreed. The operative portion of the said order reads as under:

*"12. Resultantly it was to be held that in the instant case the defendants claims stands at a higher side from that of the plaintiffs case and as such the defendant becomes entitled to secure the relief of injunction against the plaintiffs. This court is supported in its aforesaid view from a ratio of law laid down in a number of citations i.e. Mis Heinz Italian and another Vs M/s Dabur India Ltd. 2007 (3) RCR (Criminal) Page 290 Supreme Court of India contury continuous stationary Pvt. Ltd Vs Radhav Shyam Gups 1999 (Suppl.) Arb LR 188 (P&H) Rajindera Sahoo Vs Ganeswar Swain AIR 1987 Orissa 156 National Garments, Kaloor Cochin Vs National Apparels Ernakulam Cochin AIR 1990 Kerala 119 Smt. Vinay Chawla Vs M/S Chandamand Tovtronix Pvt Ltd. AIR 1997 Delhi Page 234, Parkash Industries Ltd Vs Rajan Enterprises 1993 (2) Arbitration Law Reporter Page 382 N R Donarm Vs Whirlpool Corp. 1996 DTC (16) Page 476 Ramesh Chandra Saha Vs Prakash Chandra Das and another 2000 (2) Arbitration Law*

*Reporter Page 316 and Shalimar Chemical Works Limited Vs Surrender Oil and Dal Mills (Refineries) & Qrs. 2000 (1) Civil Court Cases 665 (A.P.)*

*Accordingly both these issues are hereby decided against the plaintiff and in favour of the defendant.*

**ISSUE NO 3**

13. *Keeping in view my aforesaid bindings on the aforesaid issues this issue is also hereby decided in favour of the defendant and against the plaintiffs.*

**ISSUE NO 4 (RELIEF)**

14. **Keeping in view my findings on the aforesaid issues the suit of the plaintiffs suits and the same is hereby dismissed with costs whereas the counter claim of the defendant succeeds and the same is hereby accepted with costs.**

Accordingly decree for injunction restraining the plaintiffs from the using trade mark/name Roshan for provide any service or goods in the field of photography anywhere in India from passing off their services and goods over that of the defendant from using the word Roshan in packaging packing maternal vouchers bills and other stationary etc. from using any other similar or deceptive name in the field business of photography is hereby passed against the plaintiffs and in favour of the defendant.

*However for removal of duties it is made clear that this injunction order shall be applicable only till the case of passing off exists in between the contesting parties and in case any of the party after institution of the suit if gets itself registered with Trade mark Registry Govt of India under the Trade Marks Act 1999 with respect to the present Trade Mark Roshan then the said party would be at liberty if it so desires to take legal recourse available with it, with respect to the right of impingement in accordance with law. I order accordingly. Decree suit be drawn file be consigned to the record confirm after due connivance. Pronounced 3.9.2008”*



7. An **RFA No. 4661 of 2008(O&M)** against this order is pending before the Punjab and Haryana High Court wherein, the High Court on 1<sup>st</sup> July, 2009 observed as under:

*“On consideration of the matter, I do not find merit in the contention, that merely because the registration of trade mark relates back to the date of application, a prima facie case was made out in favour of the plaintiffs/applicant, as word "Roshan" was being used by the defendant Respondents prior in time. Once the business was being run in the name of "Roshan Studio" at Simla and Chandigarh since the year 1960, the plaintiff/ applicant cannot claim that prima facie case is made out in his favour merely because of registration of the trade mark. Even otherwise no irreparable loss is likely to be caused to the plaintiff / applicants. As the lapse can be compensated in terms of money, which does not entitle the plaintiff/applicants to seek injunction. Consequently, the CM is dismissed. However, keeping in view the controversy the main appeal is ordered to be fixed for final bearing on 16.12.2009”*

8. As per the above stated order the Court observed that merely because a trade mark registration dates back to date of application, a case cannot be made in favour of such Plaintiffs/applicant. Thus, as on date, an injunction has been granted against the Respondents.

9. During the pendency of the suit before the ADJ Panchkula, on 16<sup>th</sup> May, 2008, the Petitioner filed a rectification application before the IPAB under Sections 47 and 57 of the Act. It was alleged that the registration of the trade mark is contrary to Sections 9(2)(a), 11(3)(a) and 18(1) of the Act before the Registrar of Trade Marks for rectification/removal of the mark “ROSHAN”. Vide order dated 24<sup>th</sup> August, 2012, IPAB dismissed the Petitioner’s rectification application in the following terms:

*“13. We are afraid the applicant have not developed their claim in their evidence to succeed under Section 11(3) (a) of the Act. The affidavit of Amit Sood in support of application under Section 47 &57 for rectification/ removal of the registered trade mark 1324435 in Class 42 is accompanied by many Exhibit inter-alia Certificate issued by HP Government; HP Official Photographer of Lt.*

*Governor; credential as messages and good wishes from Vice-President; Chief Minister; several noted International organization; sample photographs taken with visiting dignitaries; unsolicited press coverage; copies of import of latest photographic equipments; copies of letter of appreciation received from eminent dignitaries etc. A copy of the order of Additional District Judge, Panchkula dated 03.0.2008 has been filed in which the Suit for injunction filed by the Respondents was dismissed and the counter claim of the applicant was decreed restraining Respondents from using the trade mark. This order has been appealed against. The Court, however, made it clear that if the marks are registered then the legal recourse available under the TM Act could be resorted to. Sample copies of Studio Register detailing the name of parties; number of photos, bill number and amount from 1971 onwards as Exhibit have also been furnished.*

14. ....

15. *'ROSHAN' is an ordinary proper noun. It denotes Light. Perhaps, that is the reason both the applicant and Respondents who are in the business of photography had chosen the name. The applicant has not produced any evidence to show that his fame spread beyond the cities at Simla and Chandigarh so as to make a case for dishonest adoption. The Respondents have been carrying on business at least from 1995. It appears that it is the applicant who had recently moved to Panchkula. If so, there is no justification for removal of Respondents' mark who has been in existence for over 15 years. The third party affidavit mentioned shows that they are well known in the area. The power to remove trade mark on rectification application is purely discretionary. In this case, we do not think the circumstances warrant the removal of the mark.*

16. ....

17. *Finally, the applicant have sought statutory recognition as a well-known mark under Section 11 (10) (i). None of the parameters to make a determination to that effect including extent and geographical area of use, record of successful enforcement, evidence of consumer survey, opinion poll etc. has been furnished. So such a recognition cannot be granted. There is nothing to show that the mere mention of the words 'ROSHAN STUDIO' will indicate a trade mark connection with the applicant or his services.*

18. *In the result, ORA/08/2009/TM/DEL is dismissed for the foregoing reasons. The applicant are directed to pay a sum of Rs. 5000/- as costs to the Respondents.”*
10. The grounds raised in the cancellation petition are :-
- that the Petitioner is the owner of the name ROSHAN STUDIO as also ROSHAN PORTRAITS and the use of the word/mark “ROSHAN” for studios and other related services is only associated with the Petitioner and not the Respondents.
  - that the goodwill in the mark “ROSHAN” qua studio, photo and other services vests in the Petitioner.
  - that the mark is distinctive of the Petitioner’s business.
  - that the Respondent is a subsequent adopter of the mark.
11. Before the IPAB, initially, a challenge was raised by the Respondents that the cancellation petition is not maintainable at the behest of three individuals i.e., Mrs. Sarita Sood, Mr. Abhinav Sood and Mr. Amit Sood. Vide order dated 12<sup>th</sup> December, 2008 the IPAB directed the Petitioner to file an amended petition. After the said direction, the petition was filed by Mr. Amit Sood as a partner of M/s ROSHAN STUDIOS. The relevant portion of the said order dated 12<sup>th</sup> December 2008, of the IPAB is extracted below:
- “6. We are of the view that the question of multiplicity of proceeding does not arise. The applicants have not explained as to how the other applicants are necessary and proper party to the proceedings. The applicants are said to be carrying on business under one trading style at different places by some common / mutual arrangement. One can establish his user by adducing cogent evidence in relation to use of the mark which can be substantiated by the other party even without being impleaded as a party.*
- 8. The objection of the Registry is upheld. The applicant is therefore at liberty to file amended application with statement of case duly amending the same. The applicants are granted 30 days time from the date of communication of the order to carry out the said amendment failing which, the Registry to strike out the names of the 2nd &3rd applicant and process the application if in order in accordance to law.”*



12. The IPAB finally dismissed the Rectification petition by the impugned order dated 24<sup>th</sup> August, 2012 which is challenged in the present petition.

**Submissions**

13. Notice was issued in this petition on 3rd December, 2012. The petition has been pending since then. On 28<sup>th</sup> October, 2022, when the matter was listed, this Court heard the Id. Counsel for the Petitioner in length. Mr. Neeraj Grover, Id. Counsel appearing for the Petitioner made the following submissions:

- i. That there is sufficient documentary evidence on record to show prior adoption, good-will and reputation of the Petitioner's Simla business by the name "ROSHAN STUDIOS". Reliance is placed on the following pages 51 to 53, 56, 59, 61, 63, 64, 69. Reliance is also placed upon documents filed with the written submissions - pages 80 to 86 and pages 107 to 122 contains invoices.
- ii. Ld. Counsel submits that the name "ROSHAN STUDIOS" was derived from the name of the founder Mr. Roshan Lal Sood and the Respondents No.2 is using ROSHAN PORTRAITS for an identical business in Panchkula which is geographically located close to Simla. In the suit which was filed by the Respondents-ROSHAN PORTRAITS against the Petitioner a counter-claim was filed by the Petitioner seeking a decree of permanent injunction on the ground of prior user. Vide final judgment dated 4th September, 2008, Id. ADJ dismissed the suit of the Respondents No.2 and decreed the counterclaim. However, the said injunction granted in favour of the Petitioner is to come into effect only after the rectification petition is decided.
- iii. The said order is stated to have been challenged by both the parties before the Punjab and Haryana High Court and the appeal is stated to be pending. Mr. Grover, Id. Counsel submits that in view of the order passed by the Trial Court, the question as to whether the Respondents No.2 is to be permanently enjoined or not now hinges on the decision in this rectification petition.
- iv. Ld. Counsel submits that the impugned order proceeds on a completely wrong premise. There is complete non-application of the correct principles of law. In fact wrong principles have been applied by the IPAB. Reference is made to paragraph 7 of the order to argue that the IPAB holds that the user prior to 2003 cannot be taken into consideration as service mark registrations were permitted only with effect from 2003. This is a completely incorrect principle as the goodwill which has enured in favour of the Petitioner cannot be ignored in this manner.

- v. It is submitted that the judgment of ***Pernod Ricard S.A. V. Rhizome Distilleries Pvt. Ltd. & Ors., 2015 SCC OnLine Mad 11996*** which was passed by the Madras High Court relied upon by the IPAB was stayed by the Supreme Court and was, thereafter, set aside by the Supreme Court. The said judgment incorrectly held that objections under Section 9 and 11 cannot be considered in cancellation petitions. Ld. Counsel submits that if a mark is not liable to remain on the register for any grounds contained in Section 9 and 11, the same can be considered and canvassed in a rectification petition.
- vi. The third ground for rectification of the petition is that “ROSHAN” is a common name. This ground was not even taken by the Respondents No.2 in the counter statement and has been used against the Petitioner. He submits that the name of the Respondents No.2 is Mr. Jit Kathuria and, thus, there is no justification for adopting the name “ROSHAN”.
- vii. The IPAB also holds that the Petitioner did not prove mala fide adoption of the Respondents. It is a settled position in law that intention is irrelevant in such a matter. This is also a wrong principle of law laid down by IPAB. The IPAB fails to take into consideration the findings of the Id. ADJ which clearly come to the conclusion that the use of the mark “ROSHAN PORTRAITS” by the Respondents No.2 would result in passing off under Section 11(3)(a) of the Act. The mere fact that the order is being appealed against does not mean that the said finding could have been ignored by the IPAB. The benefit of the said judgment ought to have been given to the Petitioner.
- viii. Mr. Grover further argued, on behalf of the Petitioner highlighting two issues, firstly, relationship between Mr. Amit Sood and the other family members of Mr. Roshan Lal Sood. Ld. Counsel submits that Mr. Amit Sood is the son of Mr. Akshay Sood and Mr. Amit Sood’s mother *i.e.*, Mrs. Sarita Sood is partner with Mr. Amit Sood in the Simla studio today. He, thus, submits that there can be no challenge to the fact that the Simla studio was the flagship studio of the Petitioner and all other branches have originated from the said Simla studio. He, further, urges that insofar as the other branches of the family is concerned *i.e.*, Mr. Abhay Sood (uncle of the Petitioner) and Mr. Abhinav Sood (cousin of the Petitioner) they operate their studio in Chandigarh and there is no dispute between the two branches of the family.
- ix. The declarations which were drafted and given by Mr. Akshay Sood was for the purposes of income tax and other taxation issues to keep the firms separate so that they can be assessed separately. He finally urges that the inauguration of the Panchkula branch when it was reported in the newspaper

itself clearly stated that the famous Roshan Studio at Mall Road Simla had opened a branch in Panchkula. These facts would establish that the Petitioner is the genuine original adopter of the mark "ROSHAN STUDIO" and "ROSHAN PORTRAITS" and use of the said name for identical service would result in passing off and would be contrary in law.

14. On behalf of the Respondents the following submissions were made by Ms. Elisha Sinha, Id. counsel:

- i. That the studio in Panchkula was opened in the year 1991. It was opened by Mr. Jeet Kathuria. She relies upon the affidavit of Mr. Balakrishan Sharma who was the landlord of the first outlet in Panchkula wherein he clearly states that the studio was opened in 1991 at House No.537, Sector 7, Panchkula which was later shifted to SCO No.72, Sector 7, Panchkula. The said affidavit of the landlord reads as under:

*"1. That the deponent is the G.P.A. holder of SCO No. 72, Sec-7, Panchkula.*

*2. That the deponent knows M/s. Roshan Portraits and its partners namely Shri Jit Kathuria and Smt. Shashi Kathuria. Shri Jit Kathuria started the business of Photography in Sector-7, Panchkula in the year 1991 under the Firm Name of M/s. Roshan Studio at House No. 537, Sector-7, Panchkula and later on he shifted his business to SCO No.72, Sector-7, Panchkula in the name and style of "Roshan Studio/Portraits". In the year 1994, he formed the partnership firm with his wife in the name and style of M/s Roshan Portraits.*

*3. That the said M/s. Roshan Studio/Portraits has been running the business of Photography in SCO No.72, Sector-7, Panchkula since the year 1992 to till date regularly and without any interruption.*

*4. That the said M/s. Roshan Portraits command a very good reputation for its best photography services in the city of Panchkula and its nearby surrounding areas. Windows They are the first and prior user of the Trade Mark/Name "Roshan" in the city of Panchkula and its nearby surrounding areas. The said trade mark/name is known is to be belonging to M/s. Roshan Portraits in the entire city of Panchkula and its nearby surrounding areas.*

*5. That M/s. Roshan Portraits is using the trade mark/name "Roshan" in the city of Panchkula and its nearby surrounding areas since the year 1992 regularly and without any interruption or*

*objection from an quarter. The said concern is well known amongst the general public of the city of Panchkula and its nearby surrounding areas for its best photography service by the name of Roshan Portraits. 6. That none else was/is using the said Trade Name/Mark in the city of Panchkula and its nearby surrounding areas since such a long time.”*

- ii. Ld. Counsel submits that the said affidavit would show that even an independent third party had confirmed that the Respondents are the prior user of the mark “ROSHAN PORTRAITS” in Panchkula. iii. Ld. Counsel further, challenges the right of the Petitioner in the mark “ROSHAN STUDIO” by stating that earlier the name of the Petitioner’s studio was Photo Studios and not Roshan Studio. Reliance is placed on page 61 of Pleadings Vol-1. It was called Photo Studios (The Petitioner’s case is that the name Roshan Studio was adopted in the year 1960 and not before that) (reliance is placed on page 107 of Vol.1 of the Pleadings, which shows the register of the studio with the name ROSHAN STUDIOS from the 1970s in Simla). iv. It is argued by the Id. Counsel that since the Respondents are the prior user since 1991 in Panchkula, the rights deserve to be protected as the Petitioner never objected to the Respondents’ use of the mark. In addition, reliance is also placed upon two declarations given by Mr. Akshay Sood wherein he claims exclusive rights in the mark “Roshan Portraits”. Ld. Counsel submits that these affidavits are contrary to the case which is being set up in the present petition. There is also no pleading that the Petitioner has inherited the business of the studio located in Simla as there is no goodwill which has flown from the said Simla Studio to the Petitioner’s.
- v. Finally, she urges that even in the press clippings which announce the inauguration of the Panchkula studio, there is no date and since the Respondents are prior and an open extensive user, the Respondents were entitled to register the mark in their favour, thus, the IPAB order deserves to be upheld.
- vi. After having seen the partnership deed Id. Counsel has two objections. Firstly, that there is no witnesses to the partnership deed and, secondly, there are no recitals confirming that the name “ROSHAN STUDIO” was being run since 1960s.

15. Mr. Grover, Id. Counsel submits that the Respondents does not dispute that the Petitioner is the family member of Mr. Roshan Sood and that

the Respondents are not relatives or family members of Mr. Roshan Sood. The Respondents' stand is that there is continuous use of the mark and the use is also by different family members at different points of time and hence the same would not connect to the original user. The Petitioner has always been aware of the Respondents' studio which is being running for several years.

### **Analysis & Conclusions**

#### **Impugned findings of the IPAB**

16. The IPAB vide the impugned order dated 24<sup>th</sup> August, 2012, has, considered objections under Section 9 and 11, and has given the following findings:

I. **On Section 9(2)(a)** - The IPAB holds that the present case is one of triple identity but since "ROSHAN" is a common name and the adoption of the mark being *non-est* and the registration having gone through the process of intense scrutiny, the mark would not be liable to be rectified. In fact, the IPAB holds that the Petitioner had to show that the adoption of the mark was *mala fide*, that the Respondents had knowledge of the Applicant's mark and that it wanted to encash upon it. None of these conditions is satisfied as per the IPAB.

II. **Objection under Section 11(3)(a)** – As per this provision, the mark would not be entitled to registration if the use of the mark is liable to be prevented by virtue of the law of passing off. On this issue, the IPAB has held that the documents of use, provided by the Petitioner are not sufficient and that the Petitioner had not shown that the Respondents had knowledge of the Petitioner's mark and wanted to encash on it. As per the IPAB the Petitioner also failed to show that there is goodwill attached to the mark. The setting up of the studio in Panchkula is not established but the Respondents were able to show existence of the studio since 1995, and other invoices showing purchase of machineries for the said studio in Panchkula. Since "ROSHAN" is a word which denotes light and the Petitioner has not been able to show its fame beyond Simla, the allegation that the Respondents cannot be the proprietor of the mark under Section 11(3)(a) of the Act is rejected by the IPAB.

III. Finally, the IPAB holds that the mark of the Petitioner does not deserve to be declared as a well-known mark.

17. The first finding of the IPAB is that since the registration relates to services, any use of the mark prior to 15<sup>th</sup> September, 2003 is not protected



by statute. This is clearly an incorrect and untenable finding inasmuch as registration of the mark is merely a recognition of the goodwill and the use of the mark by the Applicant. Even though, service mark registrations have been permitted in India, only from 15<sup>th</sup> September, 2003, use prior to the said date would definitely deserve to get recognition in order to establish rights in the mark. Thus, the non-recognition of the use of the Petitioner prior to 15<sup>th</sup> September, 2003 is a wrong approach of the IPAB.

18. The next question, that arises is whether the mark of the Respondents is liable to be rectified under Sections 9, 11 and 18. In order to decide this issue, the evidence which has been placed by the Petitioner deserves to be considered. The documents of the Petitioner filed on record for the purpose of establishing prior adoption & use, extensive goodwill and reputation *inter alia* include:

- a) October, 1961 document issued from Raj Niwas, Simla by the Lieutenant Governor appointing ROSHAN STUDIOS as the official photographer.
- b) Registration with the Punjab Photographers' Association for the year 1968-69.
- c) Sales tax registration of ROSHAN STUDIOS in Chandigarh dated 3<sup>rd</sup> April, 1970.
- d) Sales tax registration under the East Punjab Act, 1948 dated 10<sup>th</sup> February, 1970.
- e) Central sales tax registration for the year 1960.
- f) Various testimonials issued by Government authorities such as Chief Commissioner of Himachal Pradesh, World Health Organization, United Nations, Youth Welfare, Raj Bhawan, Chief Secretary of Government of Himachal Pradesh to Mr. Roshan Lal Sood dating back to 1951 and 1952.
- g) Appreciation letters issued by Secretary of the Lieutenant Governor dated 16<sup>th</sup> October, 1954, Indian Roads Congress dated 26<sup>th</sup> November, 1969, Ministry of Defence dated 25<sup>th</sup> March, 1957, Jesus and Merry dated 3<sup>rd</sup> October, 1957, India Red Cross Society in 1951, Lieutenant Governor of the Western Command dated 7<sup>th</sup> May, 1955, American Agricultural Extension Advisor, USA dated 1954 and All India Radio in 1951.
- h) Studio's registers dating back to 1972 showing photographs being clicked and payments being made by clients.
- i) Income tax returns under the name ROSHAN STUDIOS and ROSHAN PORTRAITS.

- j) Various customs and port trust related documents showing import and export of machineries for the studios in 1970s and 1980s.
- k) Copies of various bills of ROSHAN PORTRAITS Panchkula of the Petitioner.
- l) Recognition issued by Kodak Studios.
- m) Photograph with the then Prime Minister of India Pandit Jawahar Lal Nehru dated 15<sup>th</sup> July, 1950.
- n) The letter of 25<sup>th</sup> September, 1992 issued by an advocate practicing in the Calcutta High Court confirming that the firm's name "ROSHAN PORTRAITS" has been registered in some Government office.
- o) An affidavit filed of user dated 23<sup>rd</sup> October, 1992.
- p) An import/export Code certificate issued by the Ministry of Commerce on 10<sup>th</sup> November, 2004.
- q) Various press clippings showing establishment of the studio in Panchkula in the year 1992 and thereafter.
- r) One press clipping dated 16<sup>th</sup> April, 2005 specifically states that the Panchkula studio was inaugurated by the deputy Chief minister and is a branch of Simla studio.

19. On the other hand, the earliest use by the Respondents is of 1995. The Respondents claims to have adopted the mark "ROSHAN STUDIOS" in 1991 and changed to "ROSHAN PORTRAITS" thereafter. The earliest sales tax registration is of 1995 and trademark applications were also filed on 7<sup>th</sup> December, 2004, and were granted registration in the year 2005. The user claim in the trade mark application is from 31<sup>st</sup> December 1991. The Respondents argue that the Petitioner's studio in Panchkula was established only in 2004 and not before and, therefore, in Panchkula, the Respondents were a prior user.

20. The analysis of the evidence as discussed above reveals one clear fact that the Petitioner and his predecessor had adopted the mark "ROSHAN" which was derived from the name of Mr. Roshan Lal Sood who is the founder of ROSHAN STUDIOS. The said founder, on the basis of the evidence on record enjoyed immense goodwill and reputation in Himachal Pradesh and was also a member of the Punjab Photographs' Association. The use was extensive and clearly spread beyond Simla or Himachal Pradesh as is evident from various organisations, authorities, press clippings which have been placed on record.

21. The goodwill and reputation of such a studio of which the business commenced in 1950s and the name ROSHAN STUDIOS was itself used in

1960 is much beyond the geographical boundaries of a particular State. The areas of Chandigarh, Panchkula and Mohali, *etc.*, are so geographically proximate to the first studio in Simla set up by the Petitioner that it would be unimaginable that the reputation and goodwill of the ROSHAN STUDIOS, did not spread in these areas in Punjab and Haryana. The word “ROSHAN” by itself may have a reference to light - however, due to long and widespread use of the name ROSHAN STUDIOS derived from the Petitioner’s grandfather’s name has clearly acquired distinctiveness over more than five decades prior to adoption by the Respondents.

22. The IPAB’s finding that “ROSHAN” is a common name and can, therefore, be used by the Respondents and is, therefore, a bona fide adoption by the Respondents is in fact not borne out from the record. ROSHAN STUDIOS not only has acquired national fame but also fame with various international organisations spread across various US agencies, agencies of the UN, Red Cross Society and such other bodies. The letters and testimonials on record are effusive in the praise of the Petitioner and its business since 1950s. The name and style of ROSHAN STUDIOS may be in use since 1960, however, the document show that Mr. Roshan Lal Sood was, in fact, known for running a studio. The national and international goodwill of the name ROSHAN STUDIOS is, in fact, decipherable from the various documents which are placed on record including from high ranking public persons such as the Prime Minister of India, the Lieutenant Governor, *etc.*

23 . It is also a matter of common knowledge that during the colonial times and even thereafter Simla had prime importance in the Northern Indian region being the summer capital during the British time. The general trend for people used to be to travel to Simla during summers. Thus, ROSHAN STUDIOS which was located in the Mall Road in Simla obviously enjoyed not merely fame and renown but an iconic status, as is evident from the documents placed on record. The word light in Hindi can be used in different terminologies such as ROSHNI, PRAKASH *etc.*, but the adoption of the name “ROSHAN” specifically for setting up of a studio that too in Panchkula which is so closely located to Simla cannot by any stretch of imagination be described as an honest or bona fide adoption. The family of the Petitioner has been in the studio business for almost 75 years now and such long use of a particular mark or name cannot be simply wished away by holding that the Respondents’ adoption is honest and concurrent. Such a finding has to be on the basis of the evidence on record. The affidavit which have been placed clearly show that the name ROSHAN STUDIOS irrespective of

whether it is registered or not, is associated exclusively with the Petitioner and not with the Respondents at all. Moreover, prior user is not to be adjudged city-wise or colony-wise in a restricted manner. Use may be from a particular physical location but would not be restricted to such a physical location. Use is a dynamic concept and its effect spreads like air, beyond geographical confines.

24. The findings of the District Court in the suit filed by the Respondents against the Petitioner further reaffirm this position. In the said suit, the Id. Trial Court records clearly that the Respondents' founder was Mr. Kathuria who had obtained the registration for the trademark. The said Mr. Kathuria had pleaded ignorance of a studio under the name "ROSHAN STUDIOS" being run in Chandigarh since 1936 by the Petitioner's family. This pleading of ignorance by the Respondents, in fact, lead to an adverse inference being taken by the Trial Court that the Petitioner had established the studio in 1960 in Simla and at Chandigarh since 1969 and again in the year 1991 in Panchkula. The Trial Court came to the conclusion that the Petitioner's studio had a higher standing than that of the Respondents. These findings in a post-trial civil suit by the Id. ADJ, Panchkula cannot be ignored.

25. Moreover, under Section 11 of the Trademarks Act, 1999, any mark that would result in passing off of the business of the applicant of the mark would not be liable to be registered. The mark of the Respondents is not distinctive of its business. The use of the name ROSHAN STUDIOS clearly connotes and denotes the Petitioner. The finding of the IPAB to the contrary is thus not tenable. Under Sections 9 and 11 if the registration of a mark is likely to deceive the public or cause confusion it is not liable to be registered.

26. Under similar circumstances, the Supreme Court in ***Laxmikant V. Patel v. Chetanbhai Shah and Ors.*** was dealing with a case involving a studio under the name Muktajivan, and the setting up of another studio with identical name a few kilometres away. The Supreme Court held in categorical terms that such setting up of a studio under an identical name would be liable to cause confusion. The fact that it is geographically located a little far off would in fact lead to an inference that the Defendant's business could be confused as being a branch or affiliated business. The relevant portions from ***Laxmikant (supra)*** are set out below:

*"14. In the present case the plaintiff claims to have been running his business in the name and style of Muktajivan Colour Lab and Studio since 1982. He has produced material enabling a finding*

being arrived at in that regard. However, the trial court has found him using Muktajivan as part of his business name at least since 1995. The plaintiff is expanding his business and exploiting the reputation and goodwill associated with Muktajivan in the business of colour lab and photo by expanding the business through his wife and brother-in-law. On or about the date of the institution of the suit the defendant was about to commence or had just commenced an identical business by adopting the word Muktajivan as a part of his business name although till then his business was being run in the name and style of Gokul Studio. The intention of the defendant to make use of the business name of the plaintiff so as to divert his business or customers to himself is apparent. It is not the case of the defendant that he was not aware of the word Muktajivan being the property of the plaintiff or the plaintiff running his business in that name, though such a plea could only have indicated the innocence of the defendant and yet no difference would have resulted in the matter of grant of relief to the plaintiff because the likelihood of injury to the plaintiff was writ large. **It is difficult to subscribe to the logic adopted by the trial court, as also the High Court, behind reasoning that the defendants' business was situated at a distance of 4 or 5 km from the plaintiff's business and therefore the plaintiff could not have sought for an injunction. In a city a difference of 4 or 5 km does not matter much. In the event of the plaintiff having acquired a goodwill as to the quality of services being rendered by him, a resident of Ahmedabad city would not mind travelling a distance of a few kilometres for the purpose of availing a better quality of services. Once a case of passing-off is made out the practice is generally to grant a prompt ex parte injunction followed by appointment of Local Commissioner, if necessary.** In our opinion the trial court was fully justified in granting the ex parte injunction to the plaintiff based on the material made available by him to the court. The trial court fell in error in vacating the injunction and similar error has crept in the order of the High Court. The reasons assigned by the trial court as also by the High Court for refusing the relief of injunction to the plaintiff are wholly unsustainable.”



27. In ***Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd. (2002) 2 SCC 147*** the Court also observed that when a word has been in use for a long time, the name acquires distinctiveness and secondary meaning in the business or trade circle. The relevant portion of the said judgment has been extracted below:

*“24. Judging the case in hand on the touchstone of the principles laid down in the aforementioned decided cases, it is clear that the plaintiff has been using the words “Mahindra” and “Mahindra & Mahindra” in its companies/business concerns for a long span of time extending over five decades. The name has acquired a distinctiveness and a secondary meaning in the business or trade circles. People have come to associate the name “Mahindra” with a certain standard of goods and services. Any attempt by another person to use the name in business and trade circles is likely to and in probability will create an impression of a connection with the plaintiffs' Group of Companies. Such user may also affect the plaintiff prejudicially in its business and trading activities. Undoubtedly, the question whether the plaintiffs' claim of “passing-off action” against the defendant will be accepted or not has to be decided by the Court after evidence is led in the suit. Even so for the limited purpose of considering the prayer for interlocutory injunction which is intended for maintenance of status quo, the trial court rightly held that the plaintiff has established a prima facie case and irreparable prejudice in its favour which calls for passing an order of interim injunction restraining the defendant Company which is yet to commence its business from utilising the name of “Mahendra” or “Mahendra & Mahendra” for the purpose of its trade and business. Therefore, the Division Bench of the High Court cannot be faulted for confirming the order of injunction passed by the learned Single Judge.”*

28. Common words or names which may be used for long periods are entitled to registration under the law and are also entitled to protection. In ***Dr. Reddy's Laboratories Ltd. v. Reddy Pharmaceuticals Limited MANU/DE/0658/2004*** the Court was dealing with a common surname such as Reddy but still held that it was exclusively associated with the Plaintiff and hence protectable. The relevant portion of ***Dr Reddy's Laboratories (supra)*** is set out below:

*“13. Thus, it prima facie stands established on record that the defendant is endeavouring to pass off its products under the trade mark “Reddy” with a view to confuse and mislead the customers by making them believe that the products are manufactured by the plaintiff company. Even now, the defendant appears to be having no manufacturing unit for manufacturing pharmaceutical preparations and it is only putting the name “Reddy” on the pharmaceutical preparations manufactured by others. The absence of the registration of the trade mark in favour of the plaintiff and the pendency of the application in this regard is of no consequence for the reason that the defendant’s impugned action is squarely covered within the definition of “passing off”. The Apex Court in the case of Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd., 2002 (24) PTC 121 (SO, had examined a similar controversy. The name “Mahindra & Mahindra Ltd.” was held to have acquired a distinctiveness and secondary meaning in the trade circle and people had come to associate this name with a certain standard of goods and services. The effort of the defendant/Mahendra & Mahendra Paper Mills Ltd., to use the said name was held to be capable of creating an impression of a connection with the plaintiffs group of Companies and it was held that such user may affect the plaintiff prejudicially in the business and trading activities. The plaintiffs plea for ad interim injunction was found justified.*

**14. The plea raised by the defendant that it has a bona fide statutory right to use the trade name “Reddy” as its Managing Director is Mr. Reddy is also liable to be rejected for the reason that the trade mark “Dr. Reddy” in spite of not bring registered has acquired considerable trade reputation and goodwill in the community dealing with drugs and pharmaceutical not only in India but abroad also. This trade mark is now distinctively associated with the plaintiffs company. Its long and continuous user by the plaintiff is prima facie established. The use of trade name/mark “Reddy” by the defendant is capable of causing confusion and deception resulting in injury to the goodwill and reputation of the plaintiff company. No other “Reddy” has a right to start a rival business by using the same trade name on the plea that it is**

**his surname. This would encourage deception.** *If such a plea is allowed, rivals in trade would be encouraged to associate in their business ventures persons having similar surnames with a view to encash upon the trade reputation and goodwill acquired by others over a period of time. In Bajaj Electrical Limited, Bombay v. Metals & Allied Products, Bombay and another, AIR 1988 Bombay 167, the user of a family name by the defendants was held to be an act of passing off the goods and it was observed that the use of such family name as a trade mark was not permissible. The plea of the defendants that the surname of the partners of its firm could be used to carry on trade in their own name was rejected. It was held that prima facie the defendants were intentionally and dishonestly trying to pass off their goods by use of name “Bajaj” and as such the plaintiff had made out a case for grant of injunction.”*

29. After having perused that the name adopted by the Respondents is identical to that of the Petitioner’s and considering the fact that this is a case where services are similar and are in the same geographical area *i.e.*, Panchkula, the trade channel and the target audience will automatically be similar. This makes it a case of **‘TRIPLE IDENTITY’**.
30. In ***Ahmed Oomerbhoy v. Gautam Tank (2007 SCC OnLine Del 1685)***, the word ‘Postman’ as well as the device mark ‘Postman’ was registered and in that context, this Court held that since the impugned mark ‘Super Postman’ was similar, goods were the same and the area in trade is also common, test of **“triple identity”** was satisfied, and a case for infringement and passing off were made out. This Court observed as follows:

*“25. The mark used by the defendants is similar, the goods are the same and the area of trade is also common. **If these three factors are same or quite similar, then the second manufacturer should not be allowed to sell its product under the same name. This principle which is also termed as triple identity principle has been invoked in a number of cases.** A Single Judge of this Court in *Lal Sons Machines v. Sachar E & M Stores 1986 Raj LR 165* had held that in case of triple identity where the mark used by defendant is the same, the goods are the same and also the trade area it is the duty of the Court to protect the registered trademark. Another Single Judge of Calcutta High Court in *Kalyani Breweries Ltd v. Khoday**

*Brewing and Distilleries Industries Ltd. had invoked the triple identity rule. It was explained that where after marks were identified, the goods were identified and the areas over which the goods are going to be sold are identified, a second manufacturer can not be allowed to sell its product under the same trade name. Comparison of two marks, prima facie, show that the essential features of the trademark of the plaintiffs have been adopted by the defendant nos. 1 & 2. In these circumstances the minor differences in the getup, packaging and other writings on the goods or on the packets in which the goods are sold by the defendants indicating clearly the different trade origin different from the registered proprietor of the mark of the plaintiff would not be very material. The added matter, prima facie, will not be sufficient to avoid any confusion or deception. The alleged superior quality of goods of the defendants also does not entitle the defendants to any such rights as has been claimed by the defendants. [...]*

*The defendants can not claim any rights, prima facie as they had given an undertaking contending categorically that they will withdraw their application for registration of the name 'Super Postman', if the plaintiffs will raise any objection or opposition in future against the applied trade mark of the defendants. [...]"*

31. Recently in ***Heifer Project International Ltd. v. Heifer Project India Trust, 2024:DHC:3178***, the Court observed that identical and deceptively similar marks are likely to create confusion and deception amongst the general public when the mark, area of operation and segment of target is same. The operative portion of the said judgment is extracted hereinbelow:
- "30. Indeed, the present case is a classic instance of 'triple identity.' The Impugned trademarks are nearly identical, as are the areas of operation, and the segments of the public they target. Therefore, the Defendants' use of these nearly identical and deceptively similar marks is certain to cause deception and confusion among the general public. Besides, the Defendants have persistently engaged in activities that unlawfully exploit Plaintiff's reputation and goodwill. Even after the termination of their contractual relationship and the explicit*

*withdrawal of rights to use the Plaintiff's trademarks and logos, Defendants have unauthorisedly continued use of their deceptively similar marks. This defiance not only violates the agreement but also misleads the public and the relevant stakeholders regarding the nature of Defendants' affiliation with Plaintiff. Defendants have further compounded their infringement by falsely representing their relationship with Plaintiff. They have insinuated to the public and stakeholders that they remain affiliated or integrally connected with Plaintiff, thereby undermining Plaintiff's brand/ trademark integrity and causing confusion about its unique identity in the marketplace. Defendants lack any legal right or justification to the use of contested marks, or applying for their registration of identical marks for conducting any business activities."*

32. Considering the above stated position in the judgment **Ahmed Oomerbhoy (Supra)** and **Heifer Project International Ltd. (Supra)**, it is clear that in the present case also the Respondents have adopted an identical name/mark "ROSHAN" and are providing their identical services in the same geographical location which means that the target audience and the trade channel is also same.
33. This is also a case where the concept of triple identity has been further narrowed down as not only the trade name, trade area, trade channel is same but also the geographical area in which both the studios are located *i.e.*, Panchkula which makes it even more difficult for the Petitioners to prove its authenticity to its target audience that the Respondents are not affiliated to them rather it's a separate photo studio. Importance should be given to the public who are likely to be misled by the Respondents use of ROSHAN STUDIOS as there is a high possibility that they infer that the source of both the studios is the same. The Petitioner has been building his reputation and goodwill for a long time and the same has been proved by the evidence led. Clearly the Respondents are aware of the same and are encashing on the Petitioner's goodwill.
34. In **Montari Overseas Ltd. V. Montari Industries Ltd., 1995 SCC OnLine Del 865**, the Court observed the true measure of deception lies in the likelihood of misleading an ordinary person on the street. This issue should be examined from their perspective as imitating a trade name is equivalent to providing false information to the public, and they need to be shielded from



such misleading practices. The relevant portion of the said judgment is extracted below:

11. *It is well settled that an individual can trade under his own name as he is doing no more than making a truthful statement of the fact which he has a legitimate interest in making. But while adopting his name as the trade name for his business he is required to act honestly & bonafidely and not with a view to cash upon the goodwill & reputation of another. An individual has the latitude of trading under his own name is in recognition of the fact that he does not have choice of name which is given to him. However, in the case of a Corporation the position is different. Unlike an individual who has no say in the matter of his name, a company can give itself a name. Normally a company cannot adopt a name which is being used by another previously established company, as such a name would be undesirable in view of the confusion which it may cause or is likely to cause in the minds of the public. Use of a name by a company can be prohibited if it has adopted the name of another company. It is well settled that no company is entitled to carry on business in a manner so as to generate a belief that it is connected with the business of another company, firm or an individual. The same principle of law which applies to an action for passing off of a trade mark will apply more strongly to the passing off of a trade or corporate name of one for the other. **Likelihood of deception of an unwary and ordinary person in the street is the real test and the matter must be considered from the point of view of that person. Copying of a trade name amounts to making a false representation to the public from which they have to be protected.** Besides the name of the company acquires reputation and; goodwill, and the company has a right too to protect the same. **A competitor cannot usurp the goodwill and reputation of another. One of the pernicious effects of adopting the corporate name of another is that it can injure the reputation & business of that person.***

12. ....

*It is also not a case where the appellant had no knowledge of the corporate name of the respondent. Rather the stand of the appellant is that in the prospectus and press reports of the*

company, it was pointed out that the appellant had nothing to do with the respondent. In the circumstances it appears to us that the adoption of the corporate name by the appellant with the word "MONTARI" figuring in it, was not innocent. **When a defendant does business under a name which is sufficiently close to the name under which the plaintiff is trading and that name has acquired reputation and the public at large is likely to be misled that the defendant's business is the business of the plaintiff, or is a branch or department of the plaintiff, the defendant is liable for an action in passing off.** Even if the word "MONTARI" as part of the corporate name of the appellant was derived from the names of the father and father-in-law of the M.D. of the appellant company it would still be liable for an action in passing off as **the use of the word "MONTARI" in its corporate name is likely to cause confusion and injure the goodwill and reputation of the respondent, in the sense that this is a reasonable and foreseeable consequence of the appellant's action.** We find from the record of the trial court, which contains the Memorandum of Association of six Montari group of companies and annual reports of Montari Industries Ltd., that Montari group of industries have large operations and some of them have been in business for a long time. **The members of the public are likely to mistakenly infer from the appellant's use of the name which is sufficiently close to the respondent's name that the business of the appellant's company is from the same source, or the two companies are connected together.**

35. The Id. Counsel for the Petitioner has also pointed out that the judgment relied upon by the IPAB in ***Pernod Ricord (supra)*** has been set aside by Supreme Court. The proposition, therefore, that objections under sections 9, 11 cannot be considered in cancellation petitions is no longer good law. The adoption of the mark/name "ROSHAN STUDIOS" or "ROSHAN PORTRAITS" is not honest. In any event the intention of the party even if innocent but is resulting in passing off, the mark would not be liable to be continued on register. The Respondents have given no plausible justification for using the impugned name/mark. The Respondents claim that it is the owner of the mark is itself flawed as the goodwill in the name does not belong to the Respondents but to the Petitioner. Moreover, the Court also has a duty in cancellation petitions

to ensure that the purity of register is clearly maintained. This has been repeatedly reaffirmed in several decisions of this Court as also the Supreme Court. In ***Khoday Distillers Limited v. Scotch Whisky Association and Others, (2008) 10 SCC 723***, the Supreme Court has highlighted the need for maintaining purity of the Register of Trade Marks and that it is in public interest to even consider applications for registration. Recently, in ***Mr. Sanjay Chadha trading as Eveready Tools Emporium and Anr. v. Union of India and Anr., 2022:DHC:614*** a coordinate bench of this Court has accentuated the need for maintaining the purity of the Trade Mark Register and that the same is in public interest. The relevant extract of the said judgement is extracted as under:

*“15.3 With regard to the submissions of the petitioners that order of the IPAB is based on surmises and conjectures and not on the evidence on record, it may be necessary to point out here, that in terms of Section 92 of the Trade Marks Act, the IPAB was not bound by the procedure under the CPC but was guided by principles of natural justice. **While considering any application for rectification of a mark, the IPAB/Court has to take into account public interest. It is in the interest of the public that the purity of trade mark Register, has to be maintained.** As far back as in *Hindustan Pencils (P) Ltd. Vs. India Stationery Products Co., AIR 1990 Del 19*, it was held that though in an action for infringement of trade mark if the interim injunction is not granted, the plaintiff when ultimately succeeds can always be compensated by awarding damages for the loss suffered but during the period the defendant is allowed to continue to infringe the trade mark, it is the consumer or the purchaser who alone suffers and who ultimately cannot be compensated; therefore, in order to curb the menace of manufacture, production and sale of spurious goods and the blatant violation of intellectual property, it will be proper for the Court to take into consideration the interest of the general public.”*

36. The same has been reaffirmed in the judgment of ***Kia Wang v. The Registrar of Trademarks & Anr., 2023:DHC:6684*** wherein the Court also highlighted the importance of maintaining purity of register for other traders, wholesalers and retailers in the following manner:

*21. Removal of the impugned trademark from the Register of Trade Marks is also essential to maintain the purity of the Register.*

*In Paine and Co.'s Trade Marks (L. R. (1893) 2 Ch. 567 at page 584 = 10 RPC 217 at page 232), it was observed that "**The purity of the Register of Trade Marks is of much importance to trade in general, quite apart from the merits or demerits of particular litigants, 'and it is the duty of the tribunal to see that no word not 'adapted to distinguish' shall be put on the Register in the interest of other traders, wholesale and retail, and of the public.** If this were not so, the C.O. (COMM.IPDTM) 2/2021 Page 19 of 22 large and wealthy firms with whom the smaller folk are unwilling to litigate, could by a system of log-rolling --...-- divide amongst themselves all the ordinary words of description and laudation in the English language."*

37. In this background, the clear conclusions that emerge are that the Petitioner is the prior adopter of the mark/name since 1950s and the actual name was used since 1960. The Petitioner has acquired extensive and widespread goodwill. The geographical proximity of the Petitioner's and the Respondents' establishment clearly shows that the Respondents' adoption was with complete knowledge of the Petitioner's name. The explanation that Respondents was the first to establish in Panchkula is bereft of merit as prior user cannot be judged city wise or colony-wise. This is well settled in ***Laxmikant Patel (Supra)***. The registration of the Respondents mark would be contrary to the statutory mandate as encompassed in Sections 9 and 11. The mere fact that the Petitioner may have missed opposing the mark does not mean that the cancellation cannot be sought.
38. In these facts and circumstances the impugned order of the IPAB dated 24<sup>th</sup> August, 2012, deserves to be set aside. The Respondents' trademark 1324435 in Class 42 for the mark "ROSHAN" is liable to be cancelled under section 57 of the Act. Ordered accordingly.
39. The office of the CGPDTM shall give effect to this judgment and remove the mark of the Respondents from the register of trademarks within 30 days. Copy of this order be emailed to the Office of the CGPTDM at [e-mail-llc-ipo@gov.in](mailto:e-mail-llc-ipo@gov.in) for compliance of this order.
40. The petition is disposed of. All pending applications are disposed of.

© All Rights Reserved @ LAWYER E NEWS

\*Disclaimer: Always compare with the original copy of judgment from the official website.

