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Order QR

(T)OP(TM) No. 482 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON
02.06.2026

PRONOUNCED ON
28.09.2026

CORAM

THE HON'BLE MR.JUSTICE K.KUMARESH BABU

(T)OP(TM) No. 482 of 2023

RPG Enterprises Limited
having its registered office at RPG House, 463,
Dr.Annie Besant Road, Worli, Mumbai 40030

..Petitioner(s)

Vs

1. The Registrar of Trademarks
Office of the Trade Marks Registry,
Chennai 110075
2. RPG Marble Pvt Ltd
No.11/3, Bannerghatta Road,
Bangalore 560030
3. Giriraj Ladha
RPG Marble Pvt. Ltd,
No.11/3, Bannerghatta Road, Bangalore 560030
4. Rajkumar Ladha
RPG Marble Pvt. Ltd, No.11/3,
Bannerghatta Road, Bangalore 560030
5. Pawan Kumar Gupta
RPG Marble Pvt. Ltd, No.11/3, Bannerghatta
Road, Bangalore 560030
6. Omprakash Mantry
RPG Marble Pvt. Ltd, No.11/3,
Bannerghatta Road, Bangalore 560030

..Respondent(s)



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For Petitioner

: Ms.V.Aswini Anjana

For Respondent

: Mr.A.R.Sakthivel SPC – CGSC for R1

Mr.Ramesh Ganapathy for RR2 to R6

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The present petition has been filed under Section 57 of the Trade Marks Act, 1999 (hereinafter referred to as “Act”), by the petitioner contending that it has been aggrieved by the registration of the second respondent’s trademark “RPG MARBLE PVT. LTD.” (Device) registered by the first respondent bearing Registration No.1474334 dated 28.07.2006 in Class 42 standing in the name of the second Respondent and the respondents 3 to 6 are the directors of the second respondent

2. The case of the petitioner is that it is the proprietor and registered owner of the trademark “RPG”, which has been continuously, extensively and uninterruptedly used since the year 1979 in respect of a wide range of goods and services. Hence by the virtue of long-standing use, extensive promotion, advertisement and commercial success, the trademark “RPG” has acquired immense goodwill, reputation and has become exclusively associated with the petitioner and its group companies in the minds of the trade and public. The petitioner further claims to be the registered proprietor of several trademarks containing the expression “RPG”, the owner of copyright in the RPG Enterprises Logo and the proprietor of domain names incorporating the mark “RPG”. It is the specific case of the Petitioner that the mark



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“RPG” has attained the status of a well-known trademark and enjoys substantial reputation and recognition both in India and abroad.

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3. The petitioner avers that the impugned mark wholly incorporates and reproduces its well-known trademark “RPG”, which constitutes as the most dominant, essential and distinctive feature of the impugned mark. The Petitioner asserts that the Respondent has copied the petitioner’s trademark in its entirety and that the impugned mark is visually, phonetically identical and deceptively similar to the petitioner’s mark. Consequently, the registration and use of the impugned mark are likely to cause confusion and deception amongst consumers, members of the trade and the general public at large who may erroneously believe that the second Respondent’s business, goods or services are either associated with or originate from the petitioner.

4. The Petitioner contends that the goodwill and reputation built around the trademark “RPG” over several decades are being adversely affected by the continued registration and use of the impugned mark. It is contended that the use of the trademark “RPG MARBLE PVT. LTD.” by the second Respondent dilutes the distinctive character and exclusivity attached to the petitioner’s trademark and erodes the valuable reputation acquired by the Petitioner through long and extensive use. It is further contended that the continued presence of the impugned mark on the Trade



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Mark Register of the first respondent is likely to create an impression of a trade connection, association or affiliation between the Petitioner and the Respondent and thereby causes substantial prejudice to the petitioner's proprietary and commercial interests. It is contended that the continued existence of the offending mark of the respondent under the Registration No.1474334 in Class 42 on the Register would cause a confusion and deception among the trade and public, enabling the Respondents to take unfair advantage of the goodwill and reputation associated with the Petitioner's trademark and result in dilution of the distinctive character of the Petitioner's well-known mark. The Petitioner therefore asserts that the impugned trademark is wrongly remaining on the Register, having been registered without sufficient cause and in contravention of the provisions of the Act. Therefore the Petitioner has filed the present seeking rectification of the registered trade mark RPG MARBLE PVT. LTD (device) of the respondents 2 to 6 under the Registration number 1474334 in class 42 in the Trade Marks Register of the first defendant.

5. Heard learned counsel Ms.V.Aswini Anjana appearing on behalf of the petitioner and Mr.Ramesh Ganapathy appearing on behalf of the respondents 2 to 6 and Mr.A.R.Sathivel Special CGSC appearing on behalf of 1st respondent.

6. The learned counsel appearing for the petitioner submitted that the present rectification petition has been instituted under Section 57 of the Act seeking removal



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of Trade Mark Registration No.1474334 in respect of the mark "RPG Marble Pvt. Ltd." registered in Class 42 in favour of the respondents, on the ground that the impugned registration has been wrongly entered and continues to remain on the Register of Trade Marks.

7. Assailing the registration of the impugned mark of the respondent on the ground of deceptive similarity, the learned counsel submits that the dominant, essential and memorable feature of the impugned mark is the expression "RPG", which constitutes the petitioner's well-known trademark. It was contended that the expression "RPG" is prominently displayed in the impugned mark and is likely to leave a lasting impression upon the consumers and public in general with average intelligence and imperfect recollection. She submits that the remaining elements of the impugned mark are insufficient to distinguish it from the petitioner's mark. Reliance was placed upon the judgment in *South India Beverages Pvt. Ltd. v. General Mills Marketing Inc.* to contend that while comparing rival marks, greater significance must be accorded to their prominent and distinctive features.

8. The learned counsel vehemently contends that the impugned registration suffers from a fundamental defect insofar as the business activities claimed under the Class 42 therein pertains to manufacture and sale of marbles, granites and allied products, which properly fall under Class 19 of the NICE Classification and not



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under Class 42. She submits that the learned Examiner of Trade Mark had also raised an objection with regard to *supra* in the examination Report of the Impugned Registration. She further contends that the mention of wrong class of Goods/Service tantamounts to a wrong entry in the register and the erroneous entry in the Register is liable to be removed under Section 57(2) of the Act. It is contended that the alteration of Class of Goods/Service amounts to 'material alteration' and the same cannot be permitted at any time after the stage of registration and reliance was placed upon the decisions in ***Gopal Krishan v. Mex Switchgear (P) Ltd.*** and ***Pakku Devi v. Metro Enterprises*** in support of the said contention.

9. The learned counsel submits that though respondents in their counter affidavit had pleaded that the impugned trademark have been adopted from the first letters of the names of senior directors impleaded as the respondents 3 to 6 herein, it is averred that it is apparent that the respondent chose to adopt the impugned trade mark in the particular combination and sequence of the letters in such a way that it is deceptively similar to that of the petitioner's trademark "RPG". The learned counsel further contends that the petitioner's trade mark is already a well known mark which has already been in continuous and extensive use for over two decades even by 2000, therefore the 2nd respondent without any room for doubts would have been aware of the petitioner's prior rights in the trademark "RPG". Reliance has been placed upon judgments made in the case of ***Soicete Des Produits Nestle Vs Swaraj Industrial and***



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Domestic Appliances Pvt. Ltd. And Ors., in support of his contention. Hence it is submitted that the second respondent has failed on his part to give a *bona-fide* explanation with regard to the adoption of the mark “RPG”, thus the impugned registration of the respondents mark is liable to be cancelled for the violation of the provisions of Section 11(10) of the Act.

10. The learned counsel vehemently contends that the defense under the section 35 of the Act, is applicable only if the use of the Trademark is *bona fide*. It is submitted that the second respondent herein did not derive the trademark from the single name rather, had fraudulently adopted the trademark from the first letters of the names of three different names of its directors, which are arranged in a particular sequence “RPG” instead of any combination or sequence as stated *supra*. She submits that the second respondent cannot use the initial letters’ or first letters of collection of names in a sequence identically similar to an existing well known mark and then claim it a tradition of naming business. It is submitted that the defense under Section 35 is only applicable to a natural person and not applicable to a body incorporate or company and a reliance has been placed upon the judgment made in the case of ***Kirloskar Diesel Recon Pvt. Ltd. And Ano.V.Kirloskar Proprietary Ltd., and others*** reported in ***AIR 1996 BOMBAY 149***. Further the use of name as laid in the section 35 of the Act only refers to the full name and not short forms/ combination of letters from names as held in the case of ***RPG Enterprises Limited Vs RijuGhoshal***



Trading As RPG Opticals And RPG Pharmacy reported in **2022(90) PTC**

11. It is submitted that there is an inconsistency in the use of the impugned Trademark by the respondents, though the second respondent claims that the impugned mark has been in the use from the date of 07.04.2000, there has been no substantial proofs produced on behalf of the respondents 2 to 6 to prove the same, on contrary the invoices of the 2nd respondent from the year of 2013 does not reflect the impugned trademark. She highlights that the second respondent has claimed the rights in “RPG” only in this present proceedings but had disowned its rights with respect to the impugned trademark in many other places. Therefore the learned counsel contends that the respondent cannot approbate and reprobate at the same, a reliance has been placed upon the judgment in the case of ***Peps Industries Private Ltd. Vs Kurlon Ltd.***, reported in **2023 (93) PTC (Del)**.

12. The learned counsel further submits that the petitioner has established its proprietary rights over the trademark “RPG” and that the said mark also forms an integral part of its trade name and corporate name, thereby rendering it entitled to be protected under law. It is further contended that the continued use of the impugned mark or any other similar mark by the respondents would create an association to the petitioner’s well established reputation and goodwill, therefore diluting the



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distinctiveness and reputation of the petitioner. In support of the aforesaid contention, the reliance is been placed upon the Hon'ble Apex Court's judgement in the case of

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Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd.

13. The learned counsel asserts the fact that the mark "RPG" enjoys the status of a well-known trademark. In this regard, reliance was placed upon various judicial pronouncements including the judgement made by this court in C.S(Comm) No.21 of 2018. It was further submitted that during the pendency of the present proceedings, the Trade Marks Registry, by notification published in Trade Marks Journal No.2106 dated 29.05.2023, declared the petitioner's mark "RPG" as a well-known trademark and included the same in the list of well-known marks maintained by the Registrar of Trade Marks.

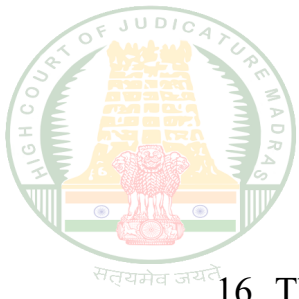
14. The learned counsel further contends that the petitioner is a multi-industrial conglomerate, which has active business activities and interests spanning across several trademark classes, whereas the second respondent engaged in the business with regard to marble, granite and stones. It is submitted that the petitioner has business subsidiaries operating in the field of infrastructure and development, wherein the materials such as those dealt with by the second company are extensively used as the raw materials therein. Consequently the business carried out in the second respondent company becomes a cognate and/or allied to the petitioner's diverse range



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of businesses. She submits that in any case of known marks such as the petitioner's "RPG" the law extends protection not merely against use in relation to identical or similar goods, but also against use in respect of dissimilar goods and in this regard the reliance is placed upon the judgement made in the case of *Daimler Benz Aktiegesellschaft v. Hybo Hindustan* reported as *AIR 1994 Delhi 239*. She further avers that the impugned registration without due cause, takes unfair advantage of and is detrimental to the distinctive character of the petitioner's earlier and well known RPG marks. Hence the impugned registration is liable to be cancelled as per the sections 11(1) and 11(2) of the Act.

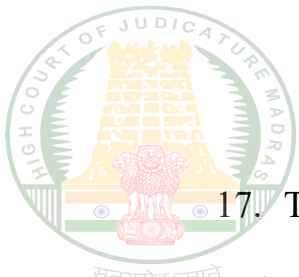
15. The learned counsel further contends that the second respondent has not furnished any justification for adopting the trademark "RPG" and has been carrying on business under different trademark. Therefore, no prejudice would be caused to the second respondent if the offending mark is removed or rectified from the Register under Section 57 of the Act. It is further submitted that, on the date of adoption and registration of the impugned mark, the petitioner's trademark had already acquired the status of a well-known mark and enjoyed widespread recognition. Reliance is placed on the judgment of this Court in *M/s. Godfrey Philips India Ltd Vs Khoday India Ltd., & Another* wherein it was held that the reputation and well-known character of an earlier mark must be assessed as on the date of the application for registration of the subsequent mark.



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16. The learned counsel submits that though the second respondent claims to have replied to the legal notice in 2002, it has failed to produce the same before this court. It is submitted that even assuming that the legal notice was issued by the petitioner in 2002 and that the second respondent had suitably replied to the same, still the second respondent had gone ahead with filing the trademark application in 2006 with dishonest intention of taking undue advantage of the petitioner's well known registered Trademark "RPG". It is contended that the second respondent's defence of laches, acquiescence and delay only based on the 2002 legal notice which has been specifically denied by the petitioner to have been sent. The petitioner's actual knowledge about the second respondent was only on 2017 and has taken immediate action to send legal notice. Further in cases of the dishonest adoption, delay does not affect the rights of the proprietor of the trademark, reliance has been placed upon the judgments made in the cases of *Hindustan Pencils Pvt. Ltd. Vs. India Stationary Products Co.*, reported in *AIR 1990 Delhi 19*, *The Timken Company Vs Timken Services Pvt. Ltd.*, reported in *2013(55) PTC 568 (Del)*, etc. She submits that there is no period of limitation prescribed in respect of initiating the rectification proceedings and reliance has been placed upon the judgment made in the case of *Mr.Sanjay Chadha Trading as Eveready Tools emporium & Anr. Vs Union of India & Anr* made in W.P.(C)-IPD No.12 of 2021.



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17. The learned counsel also submits that the impugned trademark was registered without any due cause and is a wrong entry within the scope of Section 57(2) of the Act and is liable to be expunged from the register of the Trademarks. The classification of the second respondent's goods were also incorrectly made and the objection raised in the examination report pursuant to the aforesaid mistake was also not complied with. She further highlights that the impugned trademark not only affects the proprietary rights of the petitioner but also the purity of the Register which it is in Public interest to maintain. Therefore in light of the above the facts the learned counsel seeks rectification of the first respondent's Trademark Register by removal of the impugned registration standing in the name of the second respondent.

18. *Per Contra*, countering the above arguments the Learned counsel appearing for Respondents Nos. 2 to 5 submits that the present Rectification Petition is wholly devoid of merits and is liable to be dismissed, as the impugned registration bearing Application No. 1474334 in respect of the trademark "RPG Marble Pvt. Ltd." does not constitute an erroneous entry on the Register nor is it liable to be removed under Section 57 of the Act. He submits that the 2nd Respondent Company has been carrying on business under the corporate name "RPG Marble Pvt. Ltd." since the year 2000 and has been engaged in the manufacture and sale of marbles, granite, stones and allied products. He vehemently contends that the expression "RPG" was coined from the initials of the names of the Directors of the Company, namely Rajkumar



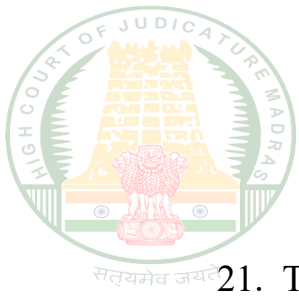
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Laddha, Pawan Kumar Gupta and Giriraj Ladha, who are also the respondents herein and thereby the adoption of the trade name and trademark was entirely honest, *bona fide* and was coined independently without any reference to any of the Petitioner's business.

19. He submits that the Respondents commenced use of the impugned mark with effect from 07.04.2000 and thereafter filed Application No. 1474334 on 28.07.2006 for registration of the trademark "RPG Marble Pvt. Ltd." in Class 42. It was contended that the Respondents have continuously and extensively used the impugned mark in the course of trade for more than two decades and have thereby acquired substantial goodwill and reputation independent of the Petitioner. It was further submitted that the Respondents' mark is designed to be a distinctive mark, which incorporates a uniquely stylised letter "R" with a distinctive artistic representation and colour combination of blue and beige, and the same mark is been registered.

20. Learned counsel contended that the Petitioner's registrations admittedly subsist only in Classes 5, 9, 12, 16 and 30, whereas the Respondents' registration stands in Class 42. It was submitted that the businesses carried on by the respondents are entirely distinct and unrelated to



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21. The learned counsel further contends that the present Rectification Petition is barred by the principles of waiver, delay, laches and acquiescence, as embodied under Section 33 of the Act. It was submitted that the dispute between the parties is not of recent origin, but traces back to the year 2002, when the Petitioner, through its then counsel M/s. Mulla & Mulla and Craige, Blunt & Caroe law firm, issued a legal notice to the Respondents in respect of the impugned mark. Despite possessing knowledge of the Respondents' adoption and continuous use of the impugned mark since the year 2002, the Petitioner remained inactive for nearly fifteen years and instituted the Rectification Petition only in the year 2017. Therefore the present proceedings is squarely hit by the section 33 of the Act. In support of the aforesaid contention, reliance was placed upon *Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel*, reported in (2006) 8 SCC 726; *Khoday Distilleries Ltd. v. Scotch Whisky Association* reported in (2008) 10 SCC 723; and *Power Control Appliances v. Sumeet Machines Pvt. Ltd.*, reported in (1994) 2 SCC 448.

22. It was further submitted that the Petitioner has approached this Court with unclean hands, without making a full and frank disclosure of all material facts. It is submitted that the Petitioner during the course of chief had denied, the issuance of the legal notice in the year 2002 and also professed ignorance with regarding the law firm which had issued the notice. Whereas the learned counsel submits that the



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Petitioner's own Annual Report for the year 2016–2017 discloses the names of the same law firm and counsel through whom the petitioner sent the legal notice in 2002 as stated *supra*. Accordingly it is submitted that the Petitioner already had knowledge about the use of the impugned trademark in year 2002 itself. Therefore it is submitted that the present petition deserves to be dismissed on the ground that the Petitioner has not approached the Court with clean hands.

23. The learned counsel vehemently contends that the Petitioner's subsequent recognition as the proprietor of a well-known trademark cannot retrospectively invalidate the Respondents' registration or divest the rights lawfully acquired by the Respondents much prior to such declaration. He further submits that the Petitioner's mark had not been declared to be a well-known trademark, when the respondents had started using the impugned mark in year 2000 or had filed for the registration of the same in 2006. Further the respondent's impugned mark is with regard manufacture and sale of the marbles, granite and stones which are different to the petitioner's business, hence there is no likelihood of confusion, misrepresentation or harm to the petitioner's business even before the well known status was granted to the petitioner. He further contends that rights or protections extended to a well known mark only apply prospectively from the date of recognition and cannot be used to penalise past actions. The Reliance in this regard was placed upon the judgment of the Delhi High Court in ***Vans Inc. USA v. FCB Garment Tex India (P) Ltd.***, wherein it was held that



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declaration of a trademark as a well-known mark does not automatically entitle the proprietor to seek rectification of all prior registrations subsisting in different classes.

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Therefore it is submitted that the well known trademark cannot have a retrospective effect by cutting across all classes where the goods are different, where the adoption of respondent's mark is honest and *bona fide*.

24. He further contends that petitioner have registered their trademark in different classes whereas the second respondent company is registered proprietor and long-term user under class 42. It is further submitted that the second respondent mark is not just "RPG" whereas it is "RPG Marble Pvt. Ltd." services. It was submitted that the Respondents' mark is to be considered as a whole, namely "RPG Marble Pvt. Ltd.", which is easily distinguishable from the mark of petitioner. In support of the said submissions, reliance was placed upon *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*, *Nandhini Deluxe v. Karnataka Cooperative Milk Producers Federation Ltd.*, and *Rana Steels v. Ran India Steels Pvt. Ltd.*, to contend that registration of a trademark does not confer monopoly over an entire class or over unrelated goods and services.

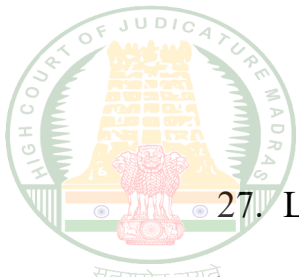


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26. Learned counsel further submitted that the Petitioner has failed to establish that the mark "RPG" had acquired such reputation, distinctiveness or public recognition as on the date when the Respondents adopted the impugned mark in the year 2000. It was pointed out that the Petitioner's earliest registration under Application No. 850255 in Class 12 had been filed only on a proposed-to-be-used basis on 08.04.1999, and that the Petitioner's mark had neither acquired the status of a well-known trademark nor achieved such extensive public recognition at the time when the Respondents honestly adopted the impugned mark. It was therefore submitted that the Respondents' adoption was independent, honest and bona fide.



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27. Learned counsel lastly submitted that the Petitioner had instituted O.S. No. 805 of 2018 before the competent Civil Court at Bengaluru on 30.01.2018 seeking a decree of permanent injunction against the Respondents in respect of the mark "RPG". It was submitted that the said suit came to be dismissed for non-prosecution and that a petition seeking restoration of the suit is presently pending. According to the Respondents, the Petitioner's conduct in the connected proceedings further demonstrates the absence of diligence and militates against the grant of any discretionary or equitable relief in the present rectification proceedings.

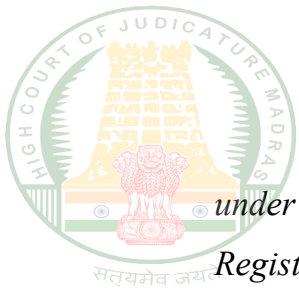
28. In view of the aforesaid submissions, learned counsel submits that the Petitioner is not entitled to rely on Section 57 of the Act, for removal of the impugned registration from the Register. Therefore he seeks that the present Rectification Petition is liable to be dismissed with costs, holding that the impugned registration is valid and does not warrant interference in the exercise of this Court's rectification jurisdiction.

29. It can be seen that this court vide its order dated 26.04.2024 had framed the following issues for determination:-

(i) *Whether the Respondent No.2's trademark registration bearing no. 1474334 under Class 42 for the mark “  “ is*

RPG Marble Pvt. Ltd.

liable to be rectified/ cancelled and removed from the Trade Marks Register



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under Section 57 of the Trade Marks Act, for being wrongly remaining on the Register of Trade Marks?

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(ii) Whether the Respondent No.2 has fraudulently and dishonestly adopted the trademark "  " that which is similar/identical to the prior

RPG Marble Pvt. Ltd.

used trademarks of the Petitioner; inter alia, 'RPG' and '  ' ?

(iii) Whether the Petitioner's trademarks, inter alia, 'RPG' and  were known to public and prevalent at the time of the subsequent adoption of the trademark "  " by the Respondent No.2 and

RPG Marble Pvt. Ltd.

whether the Respondent No. 2 is justified in adopting the identical/similar trademark to that of the Petitioner's trademark?

(iv) Whether the Petitioner is a '**Person Aggrieved**' within the meaning of the provisions of Section 57 of the Trade Marks Act, 1999?

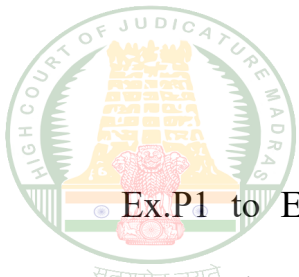
(v) Whether the instant Petition is hit by the Doctrine of Waiver, Delay and Laches and Acquiescence?

(vi) Whether the Well-Known status of the petitioner's Trade mark has retrospective effect on the Respondent No.2's trade mark?

(vii) Whether the Petitioner herein is entitled to the relief as sought for in this petition?

(viii) Whether the Petitioner here is entitled to any other relief?

30. On the Petitioner's side the authorised signatory of the petitioner Mr.R.Natarajan has been examined as PW1 and he has marked the 18 documents,



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Ex.P1 to Ex.P18 as evidence. Through the cross examination of the PW1, the Respondent side evidence Ex.R1 to Ex.R3 has been marked.

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31. I have heard the arguments and submissions made by both sides and have perused the materials available on record.

32. It is pertinent to note that, among the issues framed, an issue relating to the provision of Section 33 of the Trademarks Act has also been framed and in that regard it would only be apropos to deal with the said issue before taking up the other issues

“(v) Whether the instant Petition is hit by the Doctrine of Waiver, Delay and Laches and Acquiescence?”

33. The primordial contention of the learned counsel appearing on behalf of the respondents 2 to 5, is that the present Rectification petition is squarely hit by the principles of the waiver, delay, laches and acquiescence, as embodied under section 33 of the Act. The submission of the learned counsel is that the Petitioner was very much aware of the respondents’ adoption of the impugned Trademark as early as in the year of 2002, which can be substantiated through the legal notice dated 13.02.2002, sent by petitioner through its counsel M/s.Mulla & Mulla and Craige, Blunt & Caroe law firm. It is his contention that the despite such knowledge, the



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petitioner had instituted the present rectification petition only in the year of 2017, after been inactive for nearly 15 years. It is therefore contended that the present petition squarely falls within the ambit of Section 33 of the Trademarks Act, 1999. In support of his contention the learned counsel had placed his reliance upon various Hon'ble Apex Court Judgements reported in **(2006) 8 SCC 726**, **(2008) 10 SCC 723** and **(1994) 2 SCC 448**

34. Whereas countering the aforesaid contentions the learned counsel appearing on behalf of the petitioner maintained that the petitioner's actual knowledge of the second respondent's infringement of the trademark was only in 2017 and forthwith, the petitioner had issued a legal notice and took necessary action. Therefore there is no delay on the part of the petitioner in taking the necessary action against the respondent which can be construed as Acquiescence on the part of the petitioner. He further contends that mere delay does not defeat the rights of the proprietor of a Trademark and that no period of limitation is prescribed for initiating rectification proceedings. In support of his submissions, the learned counsel places reliance upon the various judgments referred to *supra*.

35. Insofar as Issue No.(v) is concerned, it is pertinent to note that, though PW1, during his cross-examination had feigned ignorance of the legal notice allegedly sent in the year 2002 and of the law firm through which the same was



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issued, he admitted that Ex.R2 is the Annual Report of the petitioner's subsidiary company in the year 2016–2017, wherein the name of the law firm, namely M/s.Mulla & Mulla and Craige, Blunt & Caroe, through which the Petitioner had issued notice to the Respondent in 2002, is mentioned as the legal Advisor. When confronted with the same, PW1 did not categorically deny that the name of the law firm mentioned therein, but merely stated that it “might be right”, which is inconsistent with his earlier testimony wherein he had feigned ignorance of the said law firm. Such evasive response, read with Ex.R2 and the contradiction during cross-examination, lends support to the Respondents' contention that the Petitioner had prior knowledge of the second Respondent's adoption of the impugned Trademark. Therefore, this Court is inclined to accept the contention of the learned counsel for the Respondents, as well as the reliance placed by him upon the judgments of the Hon'ble Apex Court in this regard.

36. The Hon'ble Apex Court in its judgment made in the case of *Union of India and Others Vs N.Murugesan and others* reported in (2022) 2 SCC 25, wherein the Hon'ble Apex Court has lucidly delineated the distinction and inter-relationship between the concepts of acquiescence, delay and laches. The Hon'ble Apex Court, in the aforesaid judgment, has observed that acquiescence indicates tacit or passive acceptance, or an implied or reluctant consent to a particular act, decision or state of affairs, which may be inferred from the knowledge possessed by a party with regard



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to the relevant circumstances, combined with its conduct or failure to raise an objection within a reasonable period. The aforesaid principle is relevant in determining whether a party, having knowledge of the act, had acquiesced to the same by its subsequent conduct or inaction. For a better appreciation the relevant portion of the Hon'ble Apex Court's judgment *supra* is extracted hereunder:-

“.....

Acquiescence

24. We have already discussed the relationship between acquiescence on the one hand and delay and laches on the other.

25. Acquiescence would mean a tacit or passive acceptance. It is implied and reluctant consent to an act. In other words, such an action would qualify a passive assent. Thus, when acquiescence takes place, it presupposes knowledge against a particular act. From the knowledge comes passive acceptance, therefore instead of taking any action against any alleged refusal to perform the original contract, despite adequate knowledge of its terms, and instead being allowed to continue by consciously ignoring it and thereafter proceeding further, acquiescence does take place. As a consequence, it reintroduces a new implied agreement between the parties. Once such a situation arises, it is not open to the party that acquiesced itself to insist upon the compliance of the original terms. Hence, what is essential, is the conduct of the parties. We only dealt with the distinction involving a mere acquiescence. When acquiescence is followed by delay, it may become laches. Here again, we are inclined to hold that the concept of acquiescence is to be seen on a case-to-case basis.

.....”

37. Applying the ratio laid down by the Hon'ble Apex Court with regard to the doctrine of acquiescence, as extracted *supra*, to the facts of the present case, this



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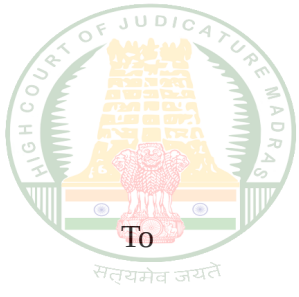
court is of the view that it is evident that the Petitioner had prior knowledge of the adoption and use of the impugned Trademark by the second Respondent as early as in the year 2002. However, the Petitioner instituted the present Rectification Petition only in the year 2017, nearly fifteen years after acquiring knowledge of the alleged infringement. Such a prolonged inaction, despite knowledge of the use of the impugned Trademark, constitutes acquiescence on the part of the Petitioner. Accordingly, the instant Petition is squarely hit by the principles of acquiescence, thereby falling within the ambit of Section 33 of the Trade Marks Act, 1999. Consequently, Issue No.(v) is answered against the Petitioner.

38. In view of the finding rendered on the aforesaid issue, this court is of the view that the remaining issues need not be deliberated upon in detail.

40. Accordingly the Transfer Original Petition stands dismissed. Consequently connected Miscellaneous Application is also closed. No costs.

28-09-2026

Index: Yes/No
Speaking/Non-speaking order
Neutral Citation: Yes/No
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K.KUMARESH BABU, J.

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