



## Intellectual Property Appellate Board

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**TP/14/2020/CR/SZ**

**WEDNESDAY, THIS THE 30<sup>TH</sup> DAY OF DECEMBER, 2020**

**Hon'ble Shri Justice Manmohan Singh**  
**Hon'ble Shri. N. Surya Senthil**  
**Hon'ble Shri. SP. Chockalingam**

...Chairman  
...Technical Member (CR)  
...Technical Member (CR)

1. M/S. HIRUSHA COSMETICS PVT. LTD.  
No. 85, P.S.K. STREET,  
KANCHIPURAM – 631 501

2. Mr. V.M. GANU SAH  
PROPRITOR, M/S. GANUS ENTERPRISES  
No. 58 (55-B), SHEICKPET SOUTH STREET  
KANCHIPURAM – 631 501

.....Appellants

(Represented by Ms. Devi. N)

**Vs.**

N. SUMESH  
PROPRIETOR, M/S. LAVANYA COSMETICS,  
NENMANI HOUSE,  
D. No. 2/250, VATTAKANDI POIL,  
PANANGAND, BALUSSERY,  
KOZHIKODE DISTRICT  
KERALA

.....Respondent

(Represented by – None)

### **ORDER**

#### **Hon'ble Shri SP. Chockalingam, Technical Member (Copyright)**

It is the case of the Petitioners that the 1<sup>st</sup> Petitioner is the original adopter and user of the trademark 'LAVANYA' in respect of goods covered under Class 3. The 1<sup>st</sup> Petitioner has assigned the trademark in favour of the 2<sup>nd</sup> Petitioner vide Assignment Deed dated 11/12/2003. The Petitioners are the manufacturers of Talcum Powder and Collar Perfume in powder form for application on fabrics. The trademark LAVANYA is being used continuously since the year 1977.

2. During the second week of February 2001, the 1<sup>st</sup> Petitioner came to know that the Respondent along with his father N. Surendran is marketing duplicate products under the trademark LAVANYA. The 1<sup>st</sup> Petitioner had filed a Civil Suit, CS No. 603 of 2003 against the Respondent, on the file of the Hon'ble Madras High Court, seeking, *inter alia*, a permanent injunction restraining the Respondent herein from infringing the registered trademark and copyright of the 1<sup>st</sup> Petitioner. The said Civil Suit was decreed in

favour of the Petitioner by the Hon'ble Madras High Court on 27/08/2009. The Respondent herein had not preferred any appeal against the judgment and decree of the Hon'ble Madras High Court.

3. During the pendency of the said Civil Suit, the Petitioner came to know that the Respondent had registered the impugned artistic work under the provisions of the Copyright Act, 1957, and the relevant registration number being A-65648/2003.

4. The Respondent's registered artistic work is an exact and slavish imitation of the Petitioner's registered trademark LAVANYA. The Respondent had once worked as an agent/dealer for the Petitioner.

5. The Certificate of Registration issued by the Copyright Office clearly mentions that the copy of the work annexed thereto is not to be used to any goods. However, the Respondent had violated the said condition, and is using the artistic work in respect of his goods.

6. The Respondent has approached the Copyright Office with unclean hands, suppressing material facts and has misrepresented and got the Certificate of Registration in an illegal manner. With the wrongly obtained registration, the Respondent is creating havoc in the trade and is causing irreparable loss and hardship to the Petitioner. The copyright registration of the Respondent is wrongly entered, and in order to maintain the purity of the register, the impugned registration should be rectified.

7. The Respondent had filed his written statement. Notice of hearing was issued to the Respondent, however he had refused to receive the notice. The learned counsel for the Petitioner represented the matter. The Respondent failed to turn up for the hearing.

8. As culled out from the records, the case of the Respondent is that the Petitioners do not possess any copyright hence they are not entitled to file the instant petition. The said contention of the Respondent is fallacious. It is not necessary under the provisions of the Copyright Act, 1957 that to seek for rectification of a registered artistic work, the Petitioner need to be a copyright owner himself. It is sufficient that if he satisfies he is aggrieved by the registration of the impugned artistic work. The case of the Petitioners is that the impugned artistic work of the Respondent is the slavish imitation of the Petitioners' trademark. Further, the Petitioners had contended that the Copyright Office while granting registration to the Respondent had clearly mentioned in the registered certificate that the "Work not to be used in relation to any goods". However, the Respondent is using the artistic work in respect of goods. Both the Petitioners as well as the Respondent are carrying on business in respect of identical goods, which fall under Class 3 to the IV<sup>th</sup> Schedule of the Trade Marks Act, 1999. Both the parties are the registered proprietors of the mark LAVANYA under the provisions of the Trade Marks Act, 1999. However, the Respondent contends that the Petitioners have no registration in respect of perfume in

powder form to be used in collar and fabrics. Initially, the Petitioners did not have registration for the said description of goods, however, subsequently they have applied for the registration of the mark LAVANYA in respect of the said goods. Thus, the Petitioners are the aggrieved persons and they are entitled to seek cancellation of the impugned copyright registration.

9. The Respondent's contention is that the 1<sup>st</sup> Petitioner is a private limited company; whereas the 2<sup>nd</sup> Petitioner is a proprietorship concern, and therefore a joint petition filed by them is bad in law on account of misjoinder of parties. Further it is the contention of the Respondent that upon assignment, the assignor (1<sup>st</sup> Petitioner) loses all his rights in the trademark and the 1<sup>st</sup> Petitioner cannot in law claim title or interest over the trademark. The said contention of the Respondent is untenable for the reason that in the petition it has been clearly mentioned that the 1<sup>st</sup> Petitioner has assigned his right in the trademark in favour of the 2<sup>nd</sup> Petitioner. By way of abundant caution, the 2<sup>nd</sup> Petitioner would have arrayed M/s. Hirusha Cosmetics Private Limited as the 1<sup>st</sup> Petitioner in the petition. There is nothing wrong about it. After all, under Order 1 Rule 9 of CPC 1908, "No suit shall be defeated by reason of the misjoinder or non-joinder of parties, and the Court may in every Suit deal with the matter in controversy so far as regards the rights and interests of the parties actually before it." Further, as per Section 61 of the Copyright Act, 1957, in every Civil Suit or other proceeding regarding infringement of copyright, instituted by a licensee, the owner of the copyright shall be made as a Defendant. Though the instant proceeding is not a proceeding for infringement, and one for a rectification under Section 50 of the Copyright Act, 1957, still we can draw parallels between these two provisions, though not on the legal sense, and in any event we do not find any infirmity in the assigner being added as a party to the proceeding; ergo the Respondent cannot take any leverage out of it.

10. The next contention of the Respondent is that since the 1<sup>st</sup> Petitioner has assigned the trademark in favour of the 2<sup>nd</sup> Petitioner and thereby had lost right, title and interest in the trademark, and therefore he cannot be a party to the proceeding. This issue has been addressed in the preceding paragraph and therefore we hold that the said contention of the Respondent is untenable in law.

11. The further contention of the Respondent is that the Petitioners have not obtained registration for the trademark LAVANYA in respect of goods - perfume in powder form to be used in Collar and Fabrics, and that the Respondent has got exclusive right in respect of the said trademark and against the said goods. The said issue is untenable for the present proceeding, as the proceeding is one under the provisions of the Copyright Act, 1957 and not under the Trade Marks Act, 1999. The issue that has to be decided is whether the Petitioners are aggrieved by the registration of the impugned artistic work by the Respondent. In such a scenario, the issue of rival marks being the same, and the goods are different,

which are trite to Trade Mark law has no bearing in the proceeding under Section 50 of the Copyright Act, 1957.

12. The Respondent has contended that no one can claim exclusive right over the mark LAVANYA, as it is a personal name and is of common usage in India. The said issue is also totally irrelevant to the present proceeding as the IPAB is now concerned with the artistic work under the provisions of the Copyright Act, 1957 and is not trammled by the basics of “personal name” or “*publici iuris*”, which are all essential features that need to be looked into for consideration in a proceeding related to a trademark or trade name.

13. The Respondent had stated that the Petitioners have ceased to manufacture, distribute and sell the products under the trademark LAVANYA. The Respondent had not substantiated the said statement and therefore his statement smacks merits. The Respondent had stated that he had filed a Civil Suit, OS No. 3 of 2011 on the file of the District Court, Kozhikode, and had obtained an order of interim injunction against the 2<sup>nd</sup> Petitioner herein, [*sic.*] restraining him from manufacturing the perfume in powder form to be used in collar and fabrics. On the contrary, the Petitioners had submitted that they have obtained a decree for permanent injunction against the Respondent herein from the Hon’ble Madras High Court in CS No. 603 of 2003, restraining him from infringing the registered trademark – LAVANYA, and the copyright of the Petitioners. It is noteworthy that the Respondent has not preferred any appeal against the said order. Further, the 2<sup>nd</sup> Petitioner had filed ORA/24/2011/TM/CH before IPAB for the rectification of the Respondent’s mark. In the said rectification application, this Hon’ble Board, vide its order, dated 12/10/2012 had cancelled the registration of the Respondent’s mark and has allowed the rectification application. The Respondent has not challenged the said order of IPAB. Thus, the Petitioners’ right in respect of their trademark and copyright has been protected.

14. However, the Respondent’s registration of the artistic work under the Copyright Act, 1957 is creating havoc in the trade and is causing irreparable loss and hardship to the Petitioners, and that said registration is questioned before us. Hence the present petition has to be decided upon its own merits. It is apposite that the provisions of the Copyright Act, 1957 and that of the Trade Marks Act, 1999 are not *in pari materia*.

15. *Prima facie* it could be seen that the Respondent had violated the conditions of registration. The Registration Certificate of the Respondent’s artistic work clearly mentions that the registered artistic work should not be used in relation to any goods. However, the Respondent in flagrant violation of the said condition has used the said artistic work. This is evidenced by Respondent’s trademark registration, *vide* No. 1004039 in respect of goods covered under Class 3. As per the relevant registration Certificate the

Respondent has been using mark (artistic work) since 18/04/2001. Further, the Respondent's use of the artistic work is accentuated in the pleadings of the Respondent. The Respondent in his written statement in paragraph No. 32, in page No. 24 admits that he has obtained license in doing business of manufacture, sale and distribution of cosmetics *i.e.* perfume in powder form to be used in collar and fabrics after obtaining license from the Balussery Grama Panchayath. The license was being renewed every year. That the Respondent concern is registered with Department of Commercial Taxes, State of Kerala and the registration was being renewed for the period 2011-2012. The said facts enure that the Respondent had not only registered the impugned artistic work as his trademark, he had also used it in the course of trade. This shows the Respondent has flouted the condition of registration imposed on him by the Registrar of Copyrights.

16. The Hon'ble Copyright Board in the case of Federation of Industries of India Vs. G. Kesavalu Naidu, reported in MANU/CP/0013/2008, which has identical facts as that of this case, had held that *'Respondent made applications for registration of artistic works in relation to drawings titled "The new invented Mild Steel Tube 175 mm Outer Dia" and "The new invented Mild Steel Tube 180 mm Outer Dia". Column 8—Remarks of both the certificates carry a note "Work not to be used in relation to any goods". Format of the Certificate is almost reproduction of the Form IV to be filled in by the applicants in pursuance of rule 16 of the Copyright Rules, 1958. Registrar has included these exclusionary remarks in pursuance of the submissions made in the respective applications. Thus it is apparent that there was an understanding both with the applicant and the Registrar that the drawings are meant for a purpose which is not in relation to goods. .... We find it clearly in violation of the condition imposed by the Registrar in column 8 of both the certificates. .... Thus we hold that the registrations are in violation of the specific and unambiguous statutory provision under proviso to sub-section (1) of section 45.'*

17. In the case on hand also, the Respondent has violated the condition of registration, thereby violating the statutory provision of Section 45(1) of the Copyright Act, 1957. Thus, the registration of the impugned artistic work has to be expunged. Hence we order accordingly. The petition is allowed without costs.

-Sd/-

-Sd/-

-Sd/-

Hon'ble Shri N. Surya Senthil  
Technical Member (CR))

Hon'ble Shri SP. Chockalingam  
Technical Member (CR)

Hon'ble Shri Justice Manmohan Singh  
Chairman.

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