

(T)OP(TM) Nos.368 to 370, 460, 461 & 464/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

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Order reserved on	21.04.2025
Order pronounced on	26.06.2025

CORAM:

THE HON'BLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP (TM) Nos. 368 to 370, 460, 461 & 464 of 2023**In all OPs:**

M/s Media Monks Multimedia Holding B.V.,
Schapenkamp 2 NL- 1211 PA Hilversum,
The Netherlands

...Petitioner

vs

1. M/s Pachala Murali Krishna,
First Floor, 3-6-892, Street No. 16,
Himayathnagar, Hyderabad- 500 029,
Andhra Pradesh

2. The Registrar of Trademarks,
Intellectual Property Rights Building,
Industrial Estate, SIDCO RMD,
G.S.T. Road, Guindy,
Chennai- 600 032

...Respondents



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Prayer in T (OP) (TM) No. 368/2023: Removal of trademark “MEDIA MONK LABEL” registered under no. 1846458 in class 16 in favour of M/s Pachala Murali Krishna, First Floor, 3-6-892, Street No. 16, Himayathnagar, Hyderabad- 500 029, Andhra Pradesh from the register or rectification of the register under Section 47/57/125 of the Trade Marks Act, 1999.

Prayer in T(OP) (TM) No. 369/2023: Removal of trademark “MEDIA MONK” registered under no. 1846457 in class 16 in favour of M/s Pachala Murali Krishna, First Floor, 3-6-892, Street No. 16, Himayathnagar, Hyderabad- 500 029, Andhra Pradesh from the register or rectification of the register under Section 47/57/125 of the Trade Marks Act, 1999.

Prayer in T(OP) (TM) No. 370/2023: Removal of trademark “MEDIA MONK LABEL” registered under no. 1846460 in class 35 in favour of M/s Pachala Murali Krishna, First Floor, 3-6-892, Street No. 16, Himayathnagar, Hyderabad- 500 029, Andhra Pradesh from the register or rectification of the register under Section 47/57/125 of the Trade Marks Act, 1999.

Prayer in T(OP) (TM) No. 460/2023: Removal of trademark “MEDIA MONK” registered under no. 1846459 in class 35 in favour of M/s Pachala Murali Krishna, First Floor, 3-6-892, Street



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No. 16, Himayathnagar, Hyderabad- 500 029, Andhra Pradesh from the register or rectification of the register under Section 47/57/125 of the Trade Marks Act, 1999.

Prayer in T(OP) (TM) No. 461/2023: Removal of trademark “MEDIA MONK LABEL” registered under no. 1846456 in class 09 in favour of M/s Pachala Murali Krishna, First Floor, 3-6-892, Street No. 16, Himayathnagar, Hyderabad- 500 029, Andhra Pradesh from the register or rectification of the register under Section 47/57/125 of the Trade Marks Act, 1999.

Prayer in T(OP) (TM) No. 464/2023: Removal of trademark “MEDIA MONK' registered under no. 1846455 in class 09 in favour of M/s Pachala Murali Krishna, First Floor, 3-6-892, Street No. 16, Himayathnagar, Hyderabad- 500 029, Andhra Pradesh from the register or rectification of the register under Section 47/57/125 of the Trade Marks Act, 1999.

In all OPs

For Petitioner : Mr. Sudharshan Kumar Bansal
Ms. Ancy George
for M/s. K.G.Bansal and Company

For 1st Respondent : Mr.P.Satheesh Kumar
Ms.Vidya R.

For 2nd Respondent : Mr.A.R.Sakthivel, SPC



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COMMON ORDER

Background

By way of these rectification petitions, the petitioner seeks to rectify the word mark 'MEDIA MONK' and the device mark 'MEDIA MONK' with a frog label ('impugned marks') registered under classes 16, 35 and 09 in favour of the first respondent. The petitioner entity is a digital, unitary operating company, engaged in the business of *inter alia* offering advertising and marketing communication services including consultancy in the field of advertising and digital productions and marketing.

2. The petitioner asserts that it started using its mark 'MEDIAMONKS' globally since its inception in 2001 as a trade name and domain name and that it has secured registration in the Netherlands under Nos. 0801864 and 0898259 dated 12.09.2005 and 24.03.2011, respectively, and has routed its application in other countries viz., European Union, United States, China, Australia, Switzerland, Norway, Russia, Singapore, and Turkey through the Madrid Protocol. In India, the petitioner commenced



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its business in the year 2015, applied on 24.10.2015 for registration of the word mark 'MEDIAMONKS' under classes 35, 41 and 42 on a 'proposed-to-be-used' basis and was granted registration on 23.01.2025 with effect from the date of application.

3. In its rectification petition, the petitioner avers that it has an online presence and created its domain name www.mediamonks.com on 19.01.2001 which is accessible to the Indian audience. It also enlists its advertising projects done for several multi-national companies, international awards won since 2001 and media coverage vis-à-vis its projects to assert that it possesses trans-border reputation and its mark qualifies as a 'well-known' mark within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999 ('TM Act').

4. The first respondent individual, engaged in the business of advertising, registered the impugned marks bearing registration nos. 1846460, 1846458, 1846457, 1846455, 1846456, and 1846459 with effect from 03.08.2009 under classes 09, 16, and 35 in respect



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of advertising and marketing by inter alia electronic media. The first respondent asserts that he coined and honestly adopted the impugned word marks in January, 2009 drawing inspiration from his monicker 'MEDIA MONK', by which his friends, family and clients called him, as he is a self-taught, self-made 'MEDIA MONK' trying to make a big leap like a little frog as a small player among giants in the industry. Asserting that he is the prior user and registrant of the impugned marks, the respondent avers that he commenced the usage thereof in January 2009 preceding the petitioner's usage and first application in India in 2015.

5. Taking into account the pleadings and draft issues, the Court, on 08.12.2023, framed the following issues in the rectification petitions relating to the word marks:

1. *Whether the petitioner is a person aggrieved for purposes of prosecuting the present petition?*
2. *Whether the petitioner is entitled to prosecute the petition in India under applicable provisions of the Trade Marks Act, 1999?*



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3. *Whether the petitioner acquiesced in the use of the trade mark MEDIA MONK by the first respondent or is guilty of laches, and not entitled to maintain this petition for any of the above reasons?*
4. *Whether the petitioner adopted and used the trade mark MEDIAMONKS as per the Trade Marks Act, 1999 before the first respondent adopted and used the trade mark MEDIA MONK?*
5. *Whether the first respondent's trade mark is deceptively similar to the petitioner's trade mark?*
6. *Whether the adoption and registration of the impugned mark was in bad faith or with mala fide intention?*
7. *Whether the entry relating to the impugned mark was made in contravention of applicable provisions of the Trade Marks Act, 1999?*
8. *Whether the impugned trade mark*



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was entered on the register without sufficient cause or whether it is wrongly remaining on the register?

9. *Whether the petitioner is entitled to the relief claimed?*

10. *Whether the parties are entitled to any other relief?*

Identical issues in respect of the registration of the device mark 'MEDIA MONK' label were framed in the rectification petitions challenging those registrations under classes 09, 16 and 35.

6. Evidence was recorded in common in all the rectification petitions. The rectification petitioner adduced evidence by examining Mr. Kanan Rele, authorized signatory of the petitioner company as P.W.1. During his examination-in-chief, 26 documents were exhibited as Exs.P1 to P26. Thereafter, P.W.1 was cross-examined by learned counsel for the first respondent. The first respondent adduced evidence by examining himself as R.W.1. . In course of his examination-in-chief, 12 documents were exhibited as Exs.R1 to R12. R.W.1 was later cross-examined by learned counsel



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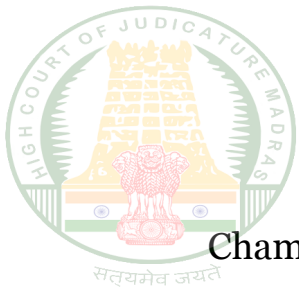
for the petitioner.

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Counsel and their contentions:

7. Oral arguments on behalf of the petitioner were advanced by Mr. Sudharshan Kumar Bansal, learned counsel, assisted by Ms. Ancy George, learned counsel. On behalf of the contesting respondent, learned counsel, Mr. P. Satheesh Kumar, advanced oral arguments, assisted by Ms. R. Vidya, learned counsel.

8. Learned Counsel for the petitioner opened his submissions by referring to Ex.P6 which is the 'WHOis report' evincing the domain name registration “mediamonks.com” and Ex.P7, the website downloads from the petitioner's website indicating the establishment of the petitioner company in its trade name 'MediaMonks' in the year 2001 which is much prior to the respondent's use of the impugned marks in India in 2009. Thereafter, he drew my attention to Exs. P4 and P5 which are the petitioner's trademark registrations and applications in other jurisdictions and the copy of the extract from the Netherlands'



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Chamber of Commerce's Commercial Register corresponding to the petitioner's commencement of business as 20.04.2005 respectively.

9. Learned counsel referred to and relied upon the judgment in *Milmet Oftho Industries and Ors. v. Allergan Inc. (2004) 12 SCC 624*, specifically paragraphs 2 to 4 and 8 to 10 thereof, wherein the Supreme Court observed that the party which uses the mark first in the world market, albeit not in the Indian market, is entitled to protection as the prior user. He further relied on *Hardie Trading Ltd. and another v. Addisons Paint & Chemicals Ltd., (2003) 11 SCC 92*, particularly paragraphs 72 and 85 thereof, to contend that the petitioner's application for registration on a 'proposed-to-be used' basis is positive proof of its intention to use the mark in India and as the prior user, the petitioner is entitled to claim proprietary rights over its mark. Referring to the copies of the sale invoices for the period 2019- 2023 (Ex. P14) at pages 232-249 of the typed set, documents in relation to publicity expenses for the period 2020- 2023 (Ex. P15), documents showing revenue



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generated during the period 2019-2023 (Ex. P16), learned counsel submitted that they are dispositive of the use of the mark in India.

10. By referring to R.W.1's answers to question nos. 1, 2, 4, 6, and 14-22 in his cross-examination wherein the respondent admitted that he uses the Internet for his work in digital productions; and paragraph 6 of R.W.1's proof affidavit and answers to question Nos. 27 to 29 in R.W.1's cross-examination wherein the first respondent admitted that he worked as an Executive Director and Managing Director of various media companies, learned counsel contended that the respondent, being in the same business as that of the petitioner, ought to have been aware of the petitioner and its mark which is inventive in nature comprising the unusual juxtaposition of the words 'media' and 'monks'. For this purpose, he also relied on answers to question Nos. 35 to 37 in R.W.1's cross-examination corresponding to the respondent's knowledge of other big companies in the business of media and digital production; and the answers to question Nos. 60-62 in relation to the respondent's knowledge about the



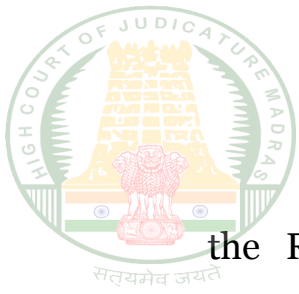
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petitioner's Noida office in India.

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11. Learned counsel made reference to *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd. (2004) 6 Supreme Court Cases 145 ('Satyam Infoway')*, particularly paragraphs 30 and 31 thereof, wherein the Court held that the respondent's choice of its word 'SIFY' was not original but inspired by the appellant's domain name 'SIFY' and, therefore, the appellant, as the prior user, has the right to debar the respondent from eating into its goodwill. Relying on Exs P8, P9, P10 and P11, which are the transcripts of interviews of the petitioner company's officials from the year 2002, copies of press releases in Asia, and list of awards and citations won by the petitioner since 2001, learned counsel contended that they establish the petitioner's trans-border reputation.

12. He further submitted that since the first respondent had knowledge of the petitioner's mark, his applications for registration of the impugned marks were made fraudulently and in bad faith and therefore the impugned marks are liable to be expunged from



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the Register. Learned Counsel relied on an excerpt from *P.*

Narayanan, Law of Trade Marks and Passing Off (6th Ed., 2017)

p.900, for this purpose.

13. Learned counsel for the petitioner also relied on the following cases to canvass his case:

(i) *Laxmikant V Patel v. Chetanbhat Shah & Anr.* [(2002) 24 PTC 1 (SC)]

(ii) *M/s Power Control Appliances and Ors. v. Sumeet Machines Pvt. Ltd.* [(1994) 2 Supreme Court Cases 448]

(iii) *B.S. Ramappa v. B. Monappa and Anr.* [1956 SCC OnLine Mad 188]

(iv) *B. Monappa v. R.S. Ramappa and Anr.* [1954 SCC OnLine Mad 377]

(v) *Ciba Ltd. Basle Switzerland v. M. Ramalingam and S. Subramaniam trading in the name of South Indian Manufacturing Co., Madura and Anr.* [1957 SCC OnLine Bom 45]

(vi) *East End Hosiery Mills Private Ltd. v. M/s Agarwal Textiles Mills*, [1970 SCC OnLine Cal 57]



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- (vii) *M/s Hindustan Pencils Pvt. Ltd. v. M/s India Stationery Products Co. and Anr*, [AIR 1990 DELHI 19]
- (viii) *Jolen Inc. v. Shobanlal Jain and Ors.*, [2004 SCC OnLine Mad 883]
- (ix) *Austin Nichols & Co. v. Arvind Behl* [2005 SCC OnLine Del 1276]
- (x) *Pfizer Products Inc. v. Renovision Exports Pvt. Ltd. and Anr* [2024 SCC OnLine Del 3140]
- (xi) *Choice Hotels International Inc. v. M. Sanjay Kumar and Anr.* 2015 SCC OnLine Del 7407]
- (xii) *Pepsico Inc & Ors. v. M/s Pure Water Beverages & Ors.* [2011 SCC OnLine Del 2605]
- (xiii) *Rolex SA v. Alex Jewellery Pvt. Ltd. & Ors.* [2014 SCC OnLine Del 1619]
- (xiv) *Telecare Network India Pvt. Ltd. v. Asus Technology Pvt. Ltd. And Ors.* [2019 SCC OnLine Del 8739]

14. In response, learned counsel for the first respondent argued that the first respondent coined and adopted the impugned marks 'Media Monk' honestly in India in the year 2009 much prior



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to the petitioner company, which commenced its business in India

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in 2015. By referring to the answers to question Nos.25 to 27 in

P.W.1's cross-examination and Ex. P3, learned counsel submitted that the petitioner made its application for registration of the mark

'MEDIAMONKS' on a 'proposed-be-used' basis in the year 2015.

He also referred to Ex. R1 which relates to the petitioner's second application dated 08.01.2022 and P.W.1's Answers to question

Nos. 61-63 in his cross-examination to contend that the petitioner's

second application for registration was also made on a 'proposed-to-be-used' basis in India in the year 2022. Drawing reference to

the letter dated 12.10.2009 (Ex. R7), which mentions the

advertisement campaign carried by the first respondent for his client, corresponding cheques at pages 37 and 39 of the first

respondent's typed set and the invoice dated 24.03.2010 raised by

the first respondent in respect of the campaign made for a client

bearing the impugned word mark (Ex R.8), learned counsel

submitted that the documentary and oral evidence show that the

first respondent, having commenced its business in 2009, is the

prior user and honest adopter of the impugned marks.



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15. Learned counsel also drew my attention to P.W.1's answers to question Nos. 89-94 in his cross-examination and submitted that the petitioner company, in other countries, uses names other than 'MEDIAMONKS' such as 'PONTO. MONKS' and 'FLUX.MONKS' and, therefore, the spill-over of the reputation of its mark 'MEDIAMONKS' into India, by way of its usage in other jurisdictions, is not well-founded. To refute the petitioner's assertion that the petitioner's mark has acquired trans-border reputation prior to its usage in India, learned counsel relied heavily of the judgment of the Supreme Court in *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Limited and Ors.* (2018) 2 SCC 1 ('*Toyato*'), particularly paragraphs 7, 17, 24 & 40 thereof, wherein the Supreme Court had applied the territoriality principle and concluded that advertisements in magazines, information on the Internet, news articles relating to the product launch in Japan do not qualify as positive evidence of spillover of reputation and goodwill of the plaintiff's mark 'PRIUS' to the Indian market prior to April 2001, when the defendant started using its mark 'PRIUS' in the Indian territory. Learned counsel also



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relied on *Chanda Softy Ice Cream & Ors. v. 'MARS' Incorporated*
and *Anr. [2006 SCC OnLine Mad 1240]* and argued that

documentary evidence evincing actual sales, turn over, and advertisements from the relevant period are required to prove that the petitioner's mark has acquired trans-border reputation in India prior to the first respondent's adoption of the impugned marks in the year 2009.

16. Learned counsel for the petitioner made further submissions by way of rejoinder. By referring to the answer to question No.1 in R.W.1's cross-examination, learned counsel for the petitioner reasserted that the first respondent, engaged in the same line of business as that of the petitioner, and in knowledge of the petitioner's marks, fraudulently adopted the impugned marks in bad faith. He further relied on answers to question Nos. 76-81 in P.W.1's cross-examination in relation to the inception of the petitioner's business unit in India in support of the petitioner's usage of the mark in India.



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Discussion, Analysis and Conclusion:

Issue Nos. 1 and 2:

17. Issue Nos.1 and 2 relate to whether the petitioner is a 'person aggrieved' under the TM Act and is entitled to prosecute these petitions. The petitioner has instituted the present rectification petitions primarily on grounds that the impugned marks are nearly identical to the petitioner's earlier marks and that they were adopted and applied *mala fide*. Consequently, the petitioner asserts that the entries relating thereto were made without sufficient cause. This ground falls under Section 57(2) of the TM Act. In *Hardie Trading Ltd v. Addisons Paint & Chemicals Ltd, (2003) 11 SCC 92*, the Supreme Court held that unlike a petition under Section 47 of the TM Act on the ground of non-use which requires the petitioner to show that it will possibly suffer if the impugned entry is allowed to subsist, the *locus standi* under Section 57 should be construed liberally to correct a public mischief in the interest of maintaining the purity of the register.



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18. In any case, the rectification petitioner is in the same line

of business of digital media productions as the first respondent and has a reasonable basis to complain of being aggrieved by the impugned entries. Taking into account this factual scenario, I conclude that the petitioner is a 'person aggrieved' and therefore entitled to prosecute the current rectification petitions.

Issue No. 5:

19. Issue No.5 is in relation to whether the impugned marks are deceptively similar to the petitioner's mark. The petitioner's mark is an unusual and unique juxtaposition of the words 'MEDIA' and 'MONKS'. Bearing in mind such unique juxtaposition, it is inherently distinctive.

20. Comparison between the rival marks to determine whether the marks are deceptively similar has to be done from the perspective of a consumer of average intelligence and imperfect recollection. The petitioner's mark is 'MEDIAMONKS'. The impugned word mark is 'MEDIA MONK' which is nearly identical



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to the petitioner's mark except for the removal of 'S' and the addition of space between the words 'MEDIA' and 'MONK'. Despite the impugned device mark containing the depiction of a leaping frog, 'MEDIA MONK' is the prominent feature therein. Taking into account the essential feature of the impugned marks, the arbitrary juxtaposition of words of the petitioner's mark and that the petitioner and the respondent are in the same line of business, I conclude that the impugned marks are deceptively similar to the petitioner's mark 'MEDIAMONKS'. An important issue, however, remains: is the petitioner entitled to be treated as the proprietor of the earlier mark? I turn to this aspect next.

Issue No. 4:

21. Issue No. 4 pertains to whether the petitioner is the prior adopter and prior user of the mark 'MEDIAMONKS'. As evidence of global registrations and applications, adoption and use outside India and in India, the petitioner relied on several documents. Trade mark registrations or applications for registration of the trade mark 'MEDIAMONKS' in countries/territories such as the



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Netherlands, Argentina, Special Administrative Region Hong

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Kong, United Arab Emirates, Australia, United States of America

are exhibited collectively as Ex.P4. Illustratively, the registration in

the Netherlands appears to be from 12.09.2005 and the Madrid

Protocol registration on 19.12.2012. Ex. P6 is the online print out of

the 'WHOis Report' containing the registration details of the

petitioner's domain name www.mediamonks.com on 19.01.2001.

Ex.P5 is the copy of the extract from the Netherlands' Chamber of

Commerce's Commercial Register which indicates that the

petitioner commenced operations under the name

'MEDIAMONKS' on 20.04.2005. Evidence of use outside India has

been adduced in the form of online printouts of works and projects,

interviews, press releases and awards (Exs. P7-P11). The earliest

use appears to be from 2001, as per these documents. As evidence

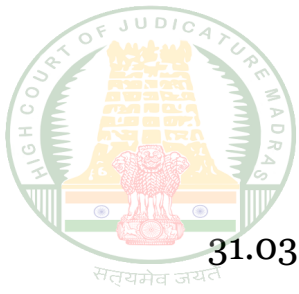
of use of the petitioner's trade mark in India, invoices issued by the

Petitioner's group entity in India, M-Monks Digital Media Pvt.

Ltd., were exhibited collectively as Ex.P12. Each of these is an

export invoice for the provision of media services to a foreign third

party entity by the Indian entity. The earliest of these is dated



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31.03.2020.

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22. As regards the first respondent, six certificates of registration, each dated 03.08.2009, were exhibited as Ex. R1. The certificate of incorporation (Ex.R4) of Media Monk Private Limited/ the first respondent shows that it was incorporated on 07.08.2009. Evidence of use of the impugned trade marks has been adduced *inter alia* in the form of an approved estimate dated 12.10.2009 for an outdoor ad campaign for Bharathi Cement Corporation Limited (Bharathi Cement), the invoice issued in respect thereof and the cheque from Bharathi Cement as proof of payment for services. These documents are filed collectively as Ex.R7. Further evidence of use of the impugned trade marks in the form of print outs and invoices have been filed as Exs.R8-R11. The earliest invoice out of these is dated 24.03.2010. Thus, there is evidence of use, albeit sporadic. On appraisal of evidence, it is clear that the petitioner is the prior adopter and user of its mark 'MEDIAMONKS' globally. However, in India, the first respondent is the prior user. Given this conclusion, a critical issue arises: can



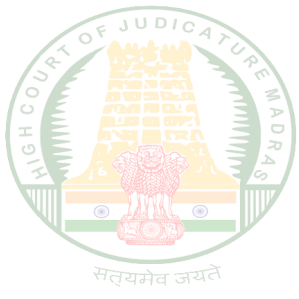
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the petitioner rely on its prior use outside India to support these petitions? This question calls for consideration after first examining whether the adoption and use by the first respondent was in bad faith.

Issue No.6:

23. Issue No.6 is whether the applications for the registration of the impugned marks were made in bad faith. The term 'bad faith', which has not been defined in the TM Act, connotes a mental state of dishonesty, moral obliquity, and conduct exhibiting commercial behaviour which does not behave reasonable and experienced men in the relevant field. There is no defined yardstick to gauge 'bad faith' and it must be gleaned from the conduct of the party. The oral evidence of R.W.1 regarding his use of the Internet for his work, knowledge of the principal players in the digital media business and the like become crucial in this evaluation.

24. R.W.1's answers to question Nos.1 & 2 and 14-19 in his cross-examination are pertinent in this regard:



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Q1: Is it true that in relation to your business activities in relation to digital productions, designing, creative inputs, passwords creations, branding solution and the alike, you use the Internet, e-systems, digital platforms, online platforms and technologies?

A: Yes, we use Internet for my works but E-System I am not clear what is meant by. I need elaboration.

Q2: E-System means electronic platforms and digital technologies.

A: Currently I do not directly use but my clients use electronic platforms and digital technologies mentioned above, for the works I create. I help in creating. In some places I give consultations.

Q14: Are you aware of WHOIS App where particular domain names will be displayed in this app?

A: Yes.

Q15: Ex.P6 is shown to the witness. Is this the WHOIS report?

A.Yes.



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Q16: What is the domain name mentioned in the report?

A: MEDIAMONKS.COM.

*Q17: What is the year of creation of this domain **MEDIAMONKS.COM** as mentioned in Ex.P6?*

A: 19th January 2001.

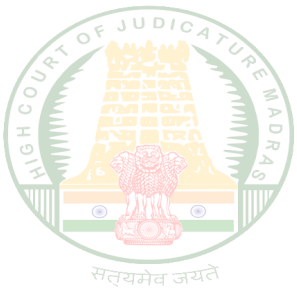
Q18: Is this domain name mentioned in Ex.P6 yours?

A: No.

Q19: Ex.P6 is shown to the witness. Who is the Registrant Organization of the domain name mentioned in Ex.P6?

A: MEDIAMONKS Multimedia Holding B.V.

The above oral evidence shows that the respondent has been using the Internet for his work in relation to digital productions, branding solutions and advertisements and is also aware of the WHOis app and acknowledges Ex.P6 evincing the petitioner as the owner of the domain name www.mediamonks.com. The WHOis domain database contains information such as the registration of a domain name, details of its ownership etc.



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WEB COPY 25. R.W.1's answers to question Nos. 27 to 29 & 36 and 37 in

his cross-examination are of further relevance:

Q27: Please see the Counter Affidavit filed by you wherein you have stated that you have worked as a Group Account Director being a Managing Director as well as the CEO for a OUTDOOR MEDIA OWNERSHIP COMPANY?

A: OUTDOOR MEDIA OWNERSHIP COMPANY is not the Company Name. It is the nature of Business in Advertising wherein my Company ATTITUDE MAXIMUS INDIA PRIVATE LIMITED and BRAND BOUTIQUE MEDIA INDIA PVT LIMITED are

OUTDOOR MEDIA OWNERSHIP COMPANIES which own OUTDOOR MEDIA and here I worked in the above capacities.

Q28: Please name the company covered by OUTDOOR MEDIA OWNERSHIP COMPANY and the name of the Company



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in which you have worked as an Executive Director as mentioned in your Counter Affidavit?

A: The Companies covered under OUTDOOR MEDIA OWNERSHIP COMPANY are ATTITUDE MAXIMUS INDIA PRIVATE LIMITED and BRAND BOUTIQUE MEDIA INDIA PVT LIMITED and the Companies covered under MEDIA PLANNING COMPANY are MEDIAMONK PRIVATE LIMITED, ATTITUDE MAXIMUS INDIA PRIVATE LIMITED and BRAND BOUTIQUE MEDIA INDIA PVT LIMITED. ATTITUDE MAXIMUS INDIA PRIVATE LIMITED and BRAND BOUTIQUE MEDIA INDIA PVT LIMITED also do media planning using their existing media for their clients.

Q29: In which year had you worked as a Group Account Director, Managing Director, CEO for the above mentioned companies?

A: As a Group Account Director in 2009, Managing Director from 2009 to till now. CEO from 2009 to 2010 or 2011 (I am not



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sure about year).

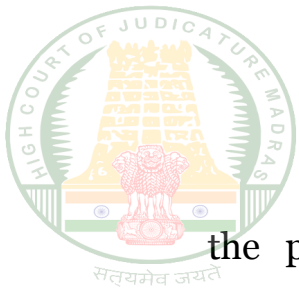
Q36: Being in the media and digital production field please name some big overseas companies in this area of business?

A: OGILVY, WARNER MUSIC, THE MEDIA GROUP.

Q37: Is the petitioner also one such big Company?

A: Only as per the documents submitted by the Petitioner in this Case I came to know that it is a Company which is big because they exhibited their financial in their papers submitted.

The above oral evidence from R.W.1's cross-examination indubitably shows that the first respondent has been in the business of media for several years, has held senior managerial positions in various companies and is aware of several multinational companies in the field. The documentary evidence submitted by the petitioner, including Ex P.10 in relation to the award won by the petitioner in 2005 in the e-business category of the europrix.nl multimedia competition, overwhelmingly supports



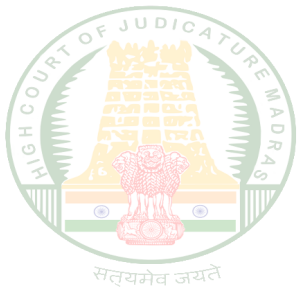
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the petitioner's case that the petitioner company was widely acclaimed for its work and received extensive media coverage much prior to the respondent's user claim in January 2009. I find it implausible that the respondent, having been in the same line of business as that of the petitioner for several years, holding senior managerial positions, and being aware of other big multinationals in the field, was ignorant of the petitioner company and its trade name at the time of filing his application for the registration of his impugned marks.

26. In addition, as noticed earlier, the petitioner's trade mark consists of an unusual juxtaposition of two English words. R.W.1, in his answer to question no.47, in the course of cross-examination provided the following explanation for the adoption of the impugned word mark:

Q47: Why did you chose the word MONK with the media when there are other words like GURU, ENLIGHTENED or the like which also signify the learned person?

A: As I mentioned above I am a self made



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and self learned creative person who uses various media in my works and hence my family and friends used to call me MR.MEDIA MONK and the word MONK is very much related to the Country I live.

Considering that the petitioner company is the prior adopter of the mark 'MEDIAMONKS' and that the first respondent had been operating in the field of digital media for several years at the time of application for registration of the deceptively similar impugned marks, I find the first respondent's explanation for adoption, as owing to his moniker, is unconvincing and appears to be post-rationalisation (*See Satyam Infoway*). Because of these reasons, I find that the impugned marks were adopted and applied in bad faith and dishonestly. Against this backdrop, I revert to the issue of the petitioner's entitlement to rely on prior use outside India.

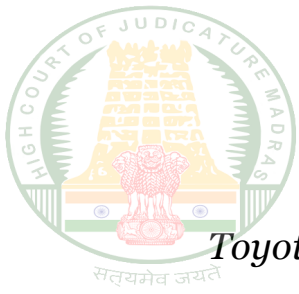
27. The first respondent relied on the judgment of the Supreme Court in *Toyota* to contend that in view of the territoriality principle, the documentary evidence submitted by the petitioner, including the interviews and awards won abroad, is



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insufficient to support its assertion that there is spill-over of reputation. It is noteworthy that the Supreme Court in *Toyota* assessed trans-border reputation by taking stock of the limited sale of *Prius* cars by Toyota in India, the lack of advertisements prior to the respondent's first use in 2001 and held that it indicates absence of goodwill and reputation among the target population in India. The Supreme Court further held that a news article in relation to the launch of the product in Japan cannot be sufficient basis for spill-over of reputation into the target population.

28. In the present case, the petitioner is in the business of digital production and multimedia advertisements for companies, including multinationals, which form the petitioner's consumer base and target audience. In light of the extensive recognition and acclaim of the petitioner among the addressable market, as evinced by Exs.P10 and P11, it cannot be said that the target population in India, i.e. companies using digital media services and operating across jurisdictions, would be unaware of the petitioner and its business activities. Therefore, the first respondent's reliance on



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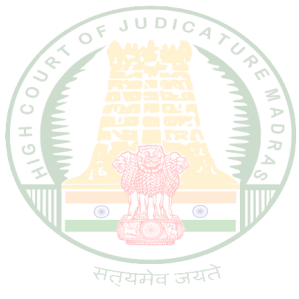
Toyota does not pass muster and the documentary evidence submitted by the petitioner leads to the conclusion that there is spill-over of reputation of the petitioner's eponymous trade mark into the Indian territory amongst its target consumer base prior to the first respondent's first use of the impugned marks in 2009. Issue No.6 is disposed of on these terms.

Issue No. 3:

29. Issue No.3 relates to the maintainability of the rectification petition, i.e. whether the petitioner acquiesced in the use of the impugned marks by the respondent and whether the petition suffers from delay or laches. Section 33, dealing with acquiescence, reads as under:

33. Effect of acquiescence

*(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, **being aware of that use**, he shall no longer be entitled on the basis of that earlier trade mark—*



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(a) to apply for a declaration that the registration of the later trade mark is invalid, or

*(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark **was not applied in good faith.***

(2) Where sub-section (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark, or as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark may no longer be invoked against his later trade mark.

(emphasis added)

Section 33 of the TM Act provides that a challenge to a registered trade mark cannot be made after the person intending to challenge the registration has acquiesced in the use of the later mark for a continuous period of five years after being aware of such use.

30. In his chief-examination, P.W.1 adduced evidence that the petitioner was not aware of the impugned registrations until it



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filed the rectification petitions. When an application for registration is made, publication in the trade mark journal is effected to put the public on notice and invite objections thereto. The impugned marks were registered with effect from 03.08.2009. The documents on record reveal that publications in trademark journal nos. 1445-0 in respect of impugned Trade Mark nos. 1846457 and 184658 were effected on 01.08.2010 in order to put the public on notice thereon. Details as regards publication of other trade mark applications are not on record. All the rectification petitions were filed on 06.08.2016. Other than relying on the advertisements in the trade mark journals, the first respondent has not adduced any evidence of the petitioner's knowledge of the registrations. Given the express requirement in Section 33 that the proprietor of the earlier mark should be aware of use by the later user for a continuous period of five years, a mere constructive notice of registration is insufficient to sustain this defence. Therefore, a case of acquiescence is not made out.

31. In any case, Section 33 provides that a challenge to the registration of the later trade mark is valid beyond the stipulated



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five year period if the later mark was not applied in good faith. In

light of the finding that the applications for the impugned marks were not made in good faith under issue no.6, the statutory bar under Section 33 of the TM is not attracted in this case.

32. As for delay and laches, it is a settled principle of law that delay *per se* in the absence of acquiescence cannot defeat an action for rectification of the register, as it is in the interest of the public to preserve its purity.

Issue Nos.7-10

33. Issue Nos.7-10 relate to whether the entries in respect of the impugned marks were made in the register in contravention of the applicable provisions of the TM Act and without sufficient cause, and whether they are therefore liable to be removed from the register. In light of the finding in Issue No.4 that the rival marks are deceptively similar; the findings in Issue Nos.5 and 6 that the petitioner acquired goodwill and reputation in India prior to the first respondent's first use in 2009 and that the adoption and use by the first respondent was not in good faith, it is concluded



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that the entries in relation to the impugned marks were made on the register without sufficient cause. Issue Nos.7 and 8 are decided on these terms.

34. On account of the above findings, the petitioners are entitled to the relief claimed i.e., removal of the impugned registrations from the register. Issue Nos. 9 and 10 are disposed of on these terms.

35. As a result, (T)OP(TM) Nos.368 to 370/2023 and 460, 461, 464/2023 are allowed by directing the Registrar of Trade Marks to cancel the entries relating to Trade Mark Nos. 1846458, 1846457, 1846460, 1846459, 1846456 and 1846455. This action shall be completed within 60 days from the date the web copy of this order is uploaded. There will be no order as to costs.

26.06.2025

Index : Yes/No
Internet : Yes/No
Speaking /Non-Speaking order : Yes/No



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Neutral Citation

: Yes/No

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Plaintiff's Witness: PW1: Ms. Kanan Rele

Documents Exhibited by the Plaintiff

Exhibits	Documents
Ex. P1	Online copy of the Impugned Registered Trademarks under No. 1846460, 1846458, 1846459, 1846455, 1846456 and 1846457 under classes 35, 16, 35, 9, 9 and 16 respectively of the Respondent No. 1 (Certificate u/s 65-B of I.E. Act Produced).
Ex. P2	Photocopy of the Representation of the Trademark/Label/Tradename/Domain Name of the petitioner.
Ex. P3	Online status of the petitioner's trademark application for registration of its trademark MEDIAMONKS in India under Application No. 3085371 in classes 35, 41, 42. (Certificate u/s 65-B of I.E. Act produced). (The learned counsel for the defendant objects to mark the same as it is mentioned as 'Not for Legal Use').
Ex. P4	Online copies of the petitioner's trademark registrations and applications for its trademark MEDIAMONKS in Netherlands, Argentina, Hong Kong, United Arab Emirates, and International Basic Applications (under the Madrid Protocol) for Australia, Switzerland, China, European Union, Norway, Russia, Singapore, Turkey and United States. (Certificate u/s 65-B of I.E. Act produced).
Ex. P5	Online extract from the Netherlands Chamber of Commerce, Commercial Register corresponding to the petitioner's registration therewith in 08.08.2005. (Certificate u/s 65-B of I.E. Act produced).



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Exhibits	Documents
Ex. P6	Online print out of the 'Whois Report' depicting the Domain Registrant/Registrar/Registration details of petitioner's domain name www.mediamonks.com created on 19th January 2001. (Certificate u/s 65-B of I.E.Act Produced).
Ex. P7	Online printouts from the website www.mediamonks.com of the petitioner regarding its works, projects, culture, interviews. (Certificate u/s 65-B of I.E.Act Produced).
Ex. P8	Online printouts of the transcripts of some old interview of the officials of the petitioner dating back to 2002. (Certificate u/s 65-B of I.E.Act Produced).
Ex. P9	Copies/web-print-outs of few of the press releases in the Asian region illustrating the wide reputation and goodwill of the Petitioner. (Certificate u/s 65-B of I.E.Act Produced).
Ex. P10	Photocopy of the Tabulated list of about over 1,000 awards won by the petitioners since the year 2001 along with the name of the brand/title of the work, the agency or the client for whom the work was done and the weblink on which the same was published.
Ex. P11	Online print-outs of numerous awards/ citations won by the petitioner since the year 2001, downloaded from various websites on which the same were published. (Certificate u/s 65-B of I.E.Act Produced).
Ex. P12	Photocopy of the ex-parte order dated 14.07.2016 passed by Shri.S.S.Rathi, ADJ Patiala House Court, New Delhi in Civil Suit No. TM No.541 of 2016 titled as M/s.MediaMonks Multimedia Holdings B.V. & Anr.vs.M/s/Media Monks & Ors.
Ex. P13	Photocopy of the Resolution-cum-authority letter in favour of Mrs. Meena Bansal.



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Exhibits	Documents
Ex. P14	Photocopy of the Sales Invoices for the period of 2019-2023.
Ex. P15	Photocopy of the Documents showing publicity expenses for the period of 2020-2023.
Ex. P16	Photocopy of the Documents showing Revenue generated during 2019-2023.
Ex. P17	Photocopy of the Annual Reports and Accounts of the Petitioner's Parent Company pertaining to the year 2022.
Ex. P18	Details of the Company "M-Monks Digital Media Private Limited" as downloaded from the official website of Ministry of Corporate Affairs (MCA Portal). (Certificate u/s 65-B of I.E.Act Produced).
Ex. P19	WHOIS details of Official Website www.media.monks.com of the Petitioner Company showing existence of the Website since 1994. (Certificate u/s 65-B of I.E.Act Produced).
Ex. P20	Documents showing Official Website www.media.monks.com of the Petitioner company with new interface along with its social media presence on third party e-commerce platforms like LinkedIn, Instagram, Facebook, YouTube, etc., showing their latest interfaces in the year 2023-2024. (Certificate u/s 65-B of I.E.Act Produced).
Ex. P21	Printouts of various e-commerce news, channels. Forums and third-party websites who have posted articles/ news about MEDIAMONKS for the period 2021-2023. (Certificate u/s 65-B of I.E.Act Produced).
Ex. P22	Printouts of various awards and recognitions received by MEDIAMONKS in the year 2023. (Certificate u/s 65-B of I.E.Act Produced).
Ex. P23	Printouts of Media coverage reports by MEDIAMONKS. (Certificate u/s 65-B of I.E.Act Produced).



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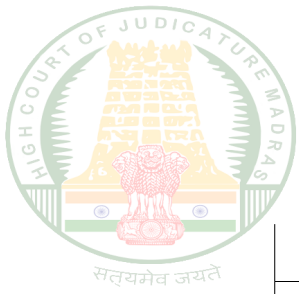
Exhibits	Documents
Ex. P24	Online copy of the Trademark Registration of the Petitioner in USPTO. (Certificate u/s 65-B of I.E.Act Produced).
Ex. P25	Photocopy of the Resolution-Cum-Authority in favour of Mrs.Sangita Bansal. (The learned counsel for the first respondent objects to mark the same on the ground that the Board Resolution in whose favour passed is not a deponent before this Court).
Ex. P26	Power of Attorney dated 15.05.2024 in favour of Mrs.Kanan Rele.

First Respondent's Witness:

RW1: Mr. Pachala Murali Krishna

Documents Exhibited by the Respondent:

Exhibits	Description
Ex. R1	The Global Application dated 08.01.2022.
Ex. R2	Photocopy of the registration certificates issued for the above 3 classes (6 Nos.) in respect of word mark and device mark "MEDIA MONK". (Original seen and returned. The learned counsel for the first Respondent undertakes to produce the Original Document before the Court.)
Ex. R3	Photocopy of the DIN (Director Identification Number) allotted. (Original seen and returned. The learned counsel for the first Respondent undertakes to produce the

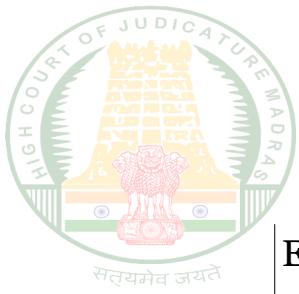


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	Original Document before the Court.)
Ex. R4	Photocopy of the certificate of Incorporation of the above Company. (Original seen and returned. The learned counsel for the first Respondent undertakes to produce the Original Document before the Court.)
Ex. R5	Photocopy of the PAN card of the above Company. (Original seen and returned. The learned counsel for the first Respondent undertakes to produce the Original Document before the Court.)
Ex. R6	Online copy of the list of Directors of the Company. (Certificate u/s 65-B of I.E.Act produced).
Ex. R7	(Series) photocopies of the proof for the work done by the first Respondent in the name of trademark Media Monk for Bharathi Cements Corporation with the receipt of payment from the said Company. (Original seen and returned. The learned counsel for the first Respondent undertakes to produce the Original Document before the Court.)
Ex. R8	Photocopy of the invoice raise by me and the cheque received. (Original seen and returned. The learned counsel for the Respondent undertakes to produce the Original Document before the Court.)
Ex. R9	Print out of the work done for GREYHOUNDS. (Certificate u/s 65-B of I.E.Act produced).
Ex. R10	Printout of the work done by the Respondent for TELANGANA STATE CYBER SECURITY BUREAU (TCSB). (Certificate u/s 65-B of I.E.Act produced).



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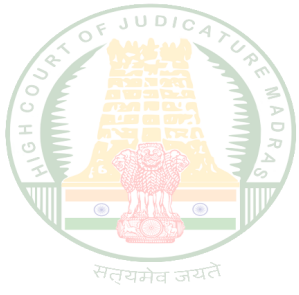


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Ex. R11	Printout of the work done by me for TELANGANA DHASAPTHI UTSAVALU. (Certificate u/s 65-B of I.E.Act produced).
Ex. R12	Some of the private works done by the first Respondent along with the photocopy of the Invoices. (Original seen and returned. The learned counsel for the Respondent undertakes to produce the Original Document before the Court.)

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26.06.2025

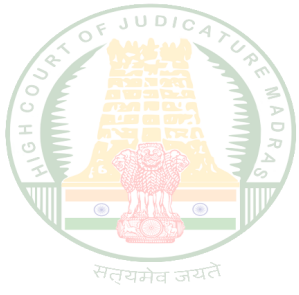


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To

The Registrar of Trademarks,
Intellectual Property Rights Building,
Industrial Estate, SIDCO RMD,
G.S.T. Road, Guindy,
Chennai- 600 032



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SENTHILKUMAR RAMAMOORTHY J.

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Pre-delivery common order made in
(T) OP (TM) Nos. 368 to 370,
460, 461 & 464 of 2023

26.06.2025

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