



2026:DHC:5074



* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% Judgment reserved on: 10.04.2026
Judgment delivered on: 05.06.2026

+ C.O. (COMM.IPD-TM) 171/2025, I.A. 18595/2025 & I.A. 18596/2025

PANASONIC HOLDINGS CORPORATION & ANR.Petitioners

versus

SIDDHARTH VIJ & ANR.Respondents

+ C.O. (COMM.IPD-TM) 172/2025, I.A. 18603/2025 & I.A. 18604/2025

PANASONIC HOLDINGS CORPORATION & ANR.Petitioners

versus

SIDDHARTH VIJ & ANR.Respondents

Advocates who appeared in this case:

For the Petitioners : Mr. Afzal B. Khan, Mr. Debjyoti Sarkar, Mr. Manosij Mukherjee, Mr. Sharad Besoya, Ms. Manaya Jain and Mr. Balkrishan Singh, Advocates.

For the Respondents : Mr. Mohan Vidhani, Mr. Dhruv Sikka, Ms. Mokshita Gautam and Ms. Urvashi Arora, Advocates for R-1.
Ms. Nidhi Raman, CGSC with Mr. Om Ram and Ms. Nikita Singh, Advocates for R-2.

CORAM:
HON'BLE MR. JUSTICE TUSHAR RAO GEDELA



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J U D G M E N T

TUSHAR RAO GEDELA, J.

1. Present petitions have been filed under Sections 47 and 57 of the Trade Marks Act, 1999 seeking removal/cancellation of the entry in Trade Marks Register with respect to the word mark 'PONTA' bearing trademark registration no.4134589 [in C.O. (COMM.IPD-TM) 172/2025] and device mark ‘

bearing trademark registration no.4885149 in Class-9 [in CO(COMM.IPD-TM) 171/2025], registered in the name of respondent no.1.

2. With the consent of the parties, both the above petitions are being disposed of *vide* this common judgment.

3. The petitioner no.1 is a company incorporated under the laws of Japan in the year 1918 and claims to be engaged in manufacture, marketing and sale of electrical products and operates across multiple business segments.

4. The petitioner claims to have entered in India in the year 1972 and by virtue of certain relaxations in the Foreign Direct Investment by the Government of India the petitioner no.1 through its subsidiaries and associated companies started actively expanding its business operations in India.

5. It is stated that in order to expand its presence in India, the petitioner no.1 acquired the business of the 'SHAH Family Group' together with the goodwill which included the trademarks such as 'ANCHOR', 'PENTA' and 'ROMA' amongst others, in the year 2007 for a consideration of 110 Crores.

6. The trademark application bearing no.516905 in Class-09 for the word mark 'PENTA', which is the subject matter of the present petition, was filed by



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the predecessor-in-title on 18.09.1989. The petitioner claims using the said mark continuously since then till date in respect of electrical switches, sockets, regulators etc.

7. Petitioner claims that the trademark 'PENTA' has grown by leaps and bounds since the time of acquisition and the petitioner no.2 has consistently posted enormous sales figures for its business under the said mark. The petitioner has furnished its sales turnover for the FY 2013-14 at approximately Rs.3,26,02,33,791.19/- which grew to Rs.6,31,60,38,458.87/- in the year 2024 up till November, 2024. Petitioner claims that it has a countrywide network of authorized distributors, stockists, dealers and retailers who extend to various States like Maharashtra, Gujarat, Rajasthan etc.

8. Petitioner stated that its products bearing the trademark 'PENTA' are also available on various e-commerce platforms such as Flipkart, Amazon etc. Petitioner also asserts that it spent a large amount of finances, resources and efforts in marketing and popularizing its products. The promotions are also carried out through websites, third-party online platforms, in print (both national and regional) as well as on television throughout the country. Apart from the offline presence, the petitioner also asserts significant presence online through various social media platforms like Facebook, YouTube, Instagram, X (formerly Twitter).

9. On the basis of the aforesaid, petitioner claims to enjoy substantial goodwill and immense reputation in India. It also asserts that the high sales turnover, extensive promotional activities, both offline and online, and the high quality products manufactured by the petitioner cumulatively have associated the



mark 'PENTA' with the products manufactured by the petitioner in the mind of the general public as also trade circles.

10. Petitioner alleged that the respondent no.1 filed for the impugned registration of the impugned mark 'PONTA' on 30.03.2019 in respect of electric sockets, electric plugs, electric switches, multi-plugs etc. in Class-09. It is stated by the petitioner that the application was wrongly granted registration on 22.02.2021. It is further stated that the application for registration of the impugned mark was filed on a 'proposed to be used' basis and has never been used in connection with the goods for which it stands registered.

11. It is stated that the Trade Marks Office issued an Examination Report dated 21.05.2019 raising objections under Section 11 of the Trade Marks Act, 1999 (hereinafter referred to as "*the Act*") citing the petitioner's trademark 'PENTA' bearing no.516905 and 1054399. Petitioner stated that despite the citation of the petitioner's trademark, the respondent no.1's application seeking registration of the impugned mark 'PONTA' culminated into registration dated 22.02.2021.

12. Aggrieved by the said registration, the petitioner has filed the present petitions under Sections 47 and 57 of the Act.

CONTENTIONS OF THE PETITIONER:-

13. Mr. Khan, learned counsel for the petitioner, argued as under:-

13.1. Learned counsel submitted that the petitioners are undisputedly the prior adopters and users of the trademark 'PENTA' in India. In that, the mark 'PENTA' was applied for registration on 18.09.1989 in Class-09. Apart from that, the petitioner also holds multiple registrations for the mark 'PENTA' and



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its variants. It is contended that since the impugned registration is itself applied for on 30.03.2019 on a 'proposed to be used' basis, the said registration cannot withstand the scrutiny of law and has to be cancelled/removed from the Register of Trade Marks under the provisions of Section 57 of the Act.

13.2. Apart from the above, it was argued that the Examination Report dated 21.05.2019 was issued by the Trade Marks Registry raising an objection under Section 11 and the trademark 'PENTA' of the petitioner was cited as an objection. While referring to the response dated 21.05.2019, learned counsel for the petitioner submitted that the respondent no.1 furnished a bald statement that the marks 'PENTA' and 'PONTA' are different and, therefore, there would be no question of any deceptive similarity, which may lead to confusion or deception in the minds of the general public.

13.3. Dilating on the aforesaid stand taken by the respondent, learned counsel for the petitioner contended that this Court is only to consider the deceptive similarity and decide as to whether to continue to retain the trademark 'PONTA' of the respondent no.1 in the Register of Trade Marks. It was forcefully contended that the mark 'PONTA' is visually, structurally and phonetically similar/deceptively similar to the mark 'PENTA' of the petitioner. It was stoutly argued that mere replacement of the letter "E" with the letter "O" would really not create any substantial distinction between the two marks as to not confuse or deceive the general public. Learned counsel contended that the goods being identical, the trade circles, distribution channels and retailers ordinarily would be common. According to him, the triple identity test stands satisfied and an average consumer is likely to get confused or deceived while purchasing the goods of the respondent no.1, believing them to be those of the petitioner or



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associated with it. In that context, learned counsel relied upon the judgments of the Bombay High Court in *Kamani Oil Industries Pvt. Ltd. vs. Bhuwaneshwar Refineries Pvt. Ltd.*:2014 SCC OnLine Bom 595, *Aktiebolaget Volvo of Sweden vs. Volvo Steels Ltd. of Gujarat (India)*: 1997 SCC OnLine Bom 578, *Federal Express Corporation vs. Fedex Securities Pvt. Ltd. & Ors.*: 2025 SCC OnLine Bom 5056 and Delhi High Court in *Mallcom (India) Ltd. vs. Shanti Udyog Weldsafe Pvt. Ltd. & Ors.*: 2024 SCC OnLine Del 2751 and *Mallcom (India) Ltd. & Anr. vs. Rakesh Kumar & Ors.*: 2019 SCC OnLine 7646.

13.4. During the arguments, learned counsel for the petitioner had also handed over a convenience compilation of documents relating to both the parties containing various trademark registrations, the Chartered Accountant's certificate, the brochures of the products manufactured by the petitioner under the mark 'PENTA', Invoices of sales under the said mark, advertisements in various newspapers etc., commencing from the year 2002 onwards and the Legal Proceedings Certificates of the respondent no.1 alongwith the Memorandum of Understanding executed in favour of the respondent no.1.

13.5. Learned counsel contended that the respondent no.1 has dishonestly adopted the mark 'PONTA' as the petitioner's mark 'PENTA', by the time respondent commenced its business, had already garnered substantial goodwill and reputation in the market. In any case, he would contend that the petitioner was the prior adopter and registrant of the mark 'PENTA' for identical goods. He would contend that the respondent no.1 had clear knowledge of the petitioner's massive presence and popularity of the mark 'PENTA'. Thus, the respondent has no justification or explanation for having adopted and used the



mark 'PONTA' which is deceptively similar to the registered mark 'PENTA' of the petitioner.

13.6. Learned counsel also contended that the dishonesty of the respondent is established by the fact that even in the Examination Report, the mark 'PENTA' of the petitioner was cited as an objection and yet, the respondent, without any justification or explanation, pursued its application and got its mark 'PONTA' registered.

13.7. Learned counsel has also urged that the version of the respondent no.1 of being inspired by the name "PAONTA SAHIB" from the famous Gurudwara is also false for the reason that the revered Gurudwara is historically and universally spelt as "PAONTA SAHIB" and not "PONTA". According to him, even if this version were to be accepted, the same would be liable for cancellation under Section 9(2)(b) of the Act. According to learned counsel, the deliberate misspelling by removing the letter 'A' to morph "PAONTA" into 'PONTA' is a calculated maneuver to structurally mimic the petitioner's mark 'PENTA'.

13.8. So far as the reliance on various native languages and expressions of other countries is concerned, learned counsel would contend that while the respondent no.1 has filed and referred to the meaning of the word "PONTA" in different languages in the world, for the first time in its reply to the present petition, the reply dated 25.05.2019 to the Examination Report dated 21.05.2019 was conspicuous by the absence of reference to any such explanation regarding language or meaning. Learned counsel would forcefully contend that the response to the Examination Report is bereft of any reasons whatsoever and has only two paragraphs. He would contend that in such a situation, this Court may



not permit respondent no.1 from relying on such extraneous materials which were not brought before the Registrar of Trade Marks to overcome the objections under Section 11 of the Act. Learned counsel contended that these submissions demonstrate the inconsistent and vacillating explanations for the adoption of the trademark 'PONTA' and clearly demonstrates that the adoption is dishonest and *mala fide*.

13.9. Lastly, learned counsel argued that while the trademark 'PENTA' of the petitioner was explicitly cited in the Examination Report, however, overlooking the objection raised by the Trade Marks Registry itself, in the absence of any valid justification or explanation, the registration of the mark 'PONTA' is a clear procedural deficiency and error on the part of respondent no.2 and thus, the grant of registration of such mark itself ought to be construed as erroneous.

13.10. On the basis of the aforesaid documents and submissions, learned counsel insisted that the respondent no.1's registered mark 'PONTA' cannot continue to remain on the Register of Trade Marks. Predicated on the above, learned counsel would contend that the mark 'PONTA' of the respondent no.1 ought to be removed from the Register of Trade Marks for contravention of Sections 11(3)(a) and 11(10)(ii) read with Sections 9 and 18 of the Act.

CONTENTIONS OF THE RESPONDENT NO.1:-

14. Appearing for the respondent, Mr. Vidhani, learned counsel vehemently refuted the contentions of the petitioner and argued as under:

14.1. Learned counsel would contend that the respondent no.1 had applied for registration of the word mark 'PONTA' on 30.03.2019 for manufacture of goods in Class-9 in relation to electric sockets, electric plugs, electric switches etc. The



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respondent no.1 has also executed a Memorandum of Understanding (hereinafter referred to as “MoU”) dated 10.08.2020 and 03.03.2021 licensing the trademark

PONTA

‘PONTA’, both word and device mark, in Class-9 in favour of his mother - Ms. Karishma Vig, proprietor of M/s. India Electrical Industries for the purpose of manufacturing, marketing and selling goods under the said mark.

14.2. Mr. Vidhani contended that the respondent no.1 and his family members are devout followers of Sikh faith and deeply rooted in tradition. According to him, given the background and the faith of respondent no.1 in the Sikh faith, *bonafidely* and honestly adopted the trademark ‘PONTA’ by deriving inspiration from the sacred and revered Gurudwara Shri Paonta Sahib. Thus, the adoption of the mark ‘PONTA’ is genuine and a sincere expression of faith and reverence intrinsically linked to the spiritual heritage.

14.3. Predicated on the aforesaid genuineness in adoption of the mark ‘PONTA’, the respondent no.1 claims protection under Section 12 of the Trade Marks Act, being honest, *bona fide* and in good faith. Learned counsel vehemently disputed the submission of the petitioner that only with an intention to ride on the goodwill and reputation of the petitioner in the mark ‘PONTA’, that the respondent no.1 has dishonestly adopted the mark ‘PONTA’. He would contend that once the respondent no.1 has offered a genuine and *bona fide* reason for adoption of the said mark, the petitioner cannot dispute the version of the respondent no.1.



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14.4. Learned counsel contended that though the respondent no.1 had applied for registration of the mark 'PONTA' on 30.03.2019 in Class-9 on a 'proposed to be used' basis, the first commercial sale under the said mark took place on 14.08.2020 and since then, the respondent no.1 too has garnered substantial goodwill and market recognition. In order to substantiate the contention, learned counsel would refer to the annual turnover which was recorded at Rs.87,08,350/- for FY 2020-21 and reached a turnover of Rs.3,06,56,040/- for FY 2024-25.

14.5. Other than that, learned counsel would also state that the respondent no.1 has, in the meanwhile, obtained BSI certifications, registration under the MSME Ministry etc., to contend that the respondent no.1 is not a fly by night operator and is an entity of repute and standing with turnover running into crores within a short span of six years. Learned counsel also referred to the extensive promotions and advertisements that the respondent has conducted to popularize its high class products under the mark 'PONTA'.

14.6. So far as the contention of the petitioner in respect of similarity/deceptive similarity is concerned, Mr. Vidhani, learned counsel vehemently contended that both the marks are phonetically, visually and structurally distinct. It was contended that while the respondent no.1's mark is derived from a sacred Sikh institution, the expression "PENTA" of the petitioner is generic and commonly used in trade. It was further contended that the substitution of the letter 'E' with the letter 'O' does not render the marks identical nor would it create any likelihood of confusion, association or deception among the relevant class of consumers. As per the respondent no.1, the petitioner being a large and dominant player in the industry is attempting to harass, intimidate and hinder small business proprietors through unfounded and frivolous claims. It is contended that



the petitioner has not placed on record a single shred of evidence to demonstrate any evidence of consumer confusion or damage to its goodwill.

14.7. Lastly, learned counsel for the respondent no.1 copiously referred to a number of paragraphs in the reply to the present petition, wherein diverse meaning of the expression 'PONTA' in different jurisdictions and languages was expressed.

14.8. Predicated on the above, learned counsel for the respondent no.1 prays that the petitions be dismissed.

ANALYSIS & CONCLUSION:-

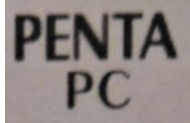
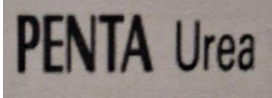
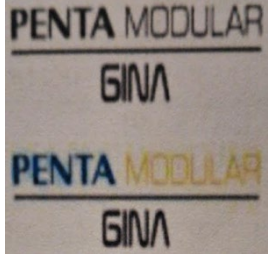
15. This Court has heard the arguments of Mr. Khan, learned counsel for the petitioner and Mr. Vidhani, learned counsel for the respondent no.1. The documents on record have also been examined.

16. At the outset, it is relevant to note that the petitioner had obtained registration of its mark 'PENTA' in the year 1989 in relation to the products under Class-9 for electric fittings for fluorescent lamps, electric bells, buzzers, transformers, chokes, switches, cutout plugs, sockets, connectors, connection and electric contact devices, electric switch holders, starters, irons, wires, cables, extension card boxes, adopters, lighting fixtures, PVC conduit pipe, kit-kats, radios, transistors, speakers, amplifiers, loudspeakers etc., and thereafter, has registered its variants. The registrations are still valid. Some of the registrations are detailed in the following table:-



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S. No.	Registration No.	Application Date	Trade Mark	Renewed up to
1.	516905	18/09/1989	PENTA	18/09/2026
2.	1054399	25/10/2001	PENTA	25/10/2031
3.	2471917	04/02/2013		04/02/2033
4.	2471919	04/02/2013		04/02/2033
5.	3399302	27/10/2016		27/10/2026
6.	3510934	20/03/2017		20/03/2027

17. In order to demonstrate and establish substantial goodwill and reputation, the petitioner has filed the CA Certificate in respect of the sales turnover for the products manufactured under 'PENTA' and 'PENTA MODULAR' trademarks from FY 2013-14 to FY 2024-25 (upto November 2024). The table is extracted hereunder:-



Financial Year	Sales Turnover (In INR)
2013 -14	3,26,02,33,791.19
2014 -15	3,29,99,43,919.83
2015 -16	3,20,93,35,286.59
2016 - 17	3,75,66,44,945.24
2017 -18	4,21,10,23,349.86
2018-19	7,98,12,99,396.09
2019-20	7,88,18,59,410.85
2020-21	9,63,06,47,317.00
2021-22	9,93,92,83,486.81
2022-23	9,78,86,87,297.41
2023-24	9,13,64,34,836.27
2024 - Nov24	6,31,60,38,458.87

18. To corroborate the assertion of having garnered substantial goodwill and reputation, the petitioner has also placed on record the Brochures and Price Lists of the year 2008 to demonstrate the products were offered for sale under the trademark 'PENTA'; Invoices commencing from the year 2005 onwards to establish actual sales of products bearing the trademark 'PENTA'; and copies of newspapers and other forms/modes of advertisements in respect of the mark 'PENTA' from the year 2002 onwards as also promotions in online mode. Considered cumulatively, the petitioner has been able to evidence not only the registration of its trademark 'PENTA' in Class-9, but manufacture and sale of products under the said Class-9 under the said mark. The extensive sales and promotions have been clearly demonstrated by documentary evidence which propels this Court to conclude that petitioner has indeed garnered substantial



goodwill and immense reputation in respect of the products manufactured and offered for sale in Class-9 under the trademark 'PENTA'.

19. At this juncture and before this Court considers the contentions on behalf of the respondent no.1, it may be pertinent to juxtapose the status of the respondent no.1 in the context of the status of the petitioner when it commenced operations in the year 2019-20. It may be noted that in FY 2019-20, the petitioner had achieved a turnover of Rs.7,88,18,59,411/- cumulatively in respect of the sales for the products under the marks 'PENTA' and 'PENTA MODULAR'. Thus, by the time the respondent no.1 commenced its business, the petitioner had already garnered substantial goodwill and reputation in the market in relation to the products under Class-9, which is common to both parties. This would surely provide a good reason for the respondent no.1 to adopt a mark similar to the mark 'PENTA' registered in the name of the petitioner.

20. It is also significant to appreciate that the respondent no.1 had applied for registration of the word mark 'PONTA' on 30.03.2019 on a "proposed to be used" basis. Similarly, the respondent no.1 had also applied for registration of

PONTA

the device mark 'PONTA' in relation to products under Class-9 on the same date on a "proposed to be used" basis. Thus, there can be no claim of use prior to the date of application for registration of the said marks.

21. The Trade Marks Registry had issued an Examination Report dated 21.05.2019 raising objections under Section 11(1) of the Act on the basis of the cited mark 'PENTA' of the petitioner. It would be appropriate to extract the said Examination Report hereunder:-



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**INTELLECTUAL
PROPERTY INDIA**

एकसत्र / PATENTS / अधिकार्य / DESIGNS]

व्यापार चिन्ह / TRADE MARKS

भौगोलिक चिह्नदर्शन / GEOGRAPHICAL INDICATIONS

फोन : 28082915, 28082916, 28082917

सत्यमेव जयते
भारत सरकार
GOVERNMENT OF INDIAभारत सरकार
व्यापार चिन्ह रजिस्ट्री
बौद्धिक सम्पदा भवन
कॉर्ट संख्या 32, सेक्टर 14, द्वारका,
नई दिल्ली - 110078GOVERNMENT OF INDIA
TRADE MARKS REGISTRY
Intellectual Property Bhavan,
Plot No - 32, Sector 14, Dwarka,
New Delhi - 110078
Tel : 28082915, 28082916, 28082917

No: TMR/DELHI/EXM/2025/

From : The Registrar of Trade Marks, DELHI

Date: 21/05/2019 15:45:51

To,
ACTIVE REGISTRATION SERVICE,
12/ 23, 2ND FLOOR, WEST PATEL NAGAR, NEW DELHI- 110 008.

Application No: 4134589 in Class/Classes : 9

In the name of M/s: SIDDHARTH VJ

Gentlemen/Madam,

The above mentioned application has been examined under the provisions of Trade Mark Act,1999 and Trade Mark Rules,2002 and the trade mark applied for is open to objection under the following sections :

1. The Trade Mark application is open to objection on relative grounds of refusal under Section 11 of the Act because the same/similar trade mark(s) is/are already on record of the register for the same or similar goods/services.The detail of same/similar trade marks is enclosed herewith

The objection is raised under S 11 (1) of the Trade Marks Act, 1999, as the mark is identical with or similar to earlier marks in respect of identical or similar description of services and because of such identity or similarity there exists a likelihood of confusion on the part of the public.

Hence, the above application is liable to be refused. Accordingly, you are requested to submit your response/submissions, if any, along-with supporting documents, with in One Month from the date of receipt of this Examination Report or you may apply for a hearing.

Please Note that if no reply is received or a request for a hearing is applied for within the above mentioned stipulated time, the said application shall be treated to have been abandoned for lack of prosecution under Section 132 of the Trade Marks Act,1999 and there after the status of application in the computer database shall reflect the factual position

Note:The reply should be submitted online through Comprehensive eFiling services or through email at parm.tmr@nic.in. With the subject as REPLY TO EXAMINATION REPORT.

Yours faithfully,
SEVANAND UPADHYAY
For Registrar of Trade Marks



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GOVERNMENT OF INDIA
TRADE MARKS REGISTRY



LOCATION:
SECTION: EXM
REPORT: EXM007

PHONETIC SEARCH REPORT
APPLICATION NUMBER: 4134589
Class : ---
TRADEMARK: 'PONTA'

USER : SIU
PAGE:1
DATE: 04/05/2019

APPL NO	CLASS	CONFLICTING MARK	JOURNAL No	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	TM IMAGE
GOODS SERVICES							

516905	9	PENTA	1064	PANASONIC CORPORATION	1006, OAZA KADOMA, KADOMA-SHI, OSAKA 571-8501, JAPAN.	Registered	
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APPLICATION DATE 18/09/1989

GOODS/SERVICE ELECTRIC FITTINGS FOR FLOURESCENT LAMPS, ELECTRIC BELLS, BUZZERS, TRANSFORMERS, CHOCKES, SWITCHES, CUTOUT PLUGS, SOCKETS, CONNECTORS, CONNECTION AND ELECTRIC CONTACT DEVICES, ELECTRIC SWITCH HOLDERS, STARTERS, IRONS, WIRES, CABLES, EXTENSION CARD BOXES, ADOPTERS, LIGHTING FIXTURES, PVC CONDUIT PIPE, KIT-KATS, RADIOS, TRANSISTORS, SPEAKERS, AMPLIFIERS, LOUDSPEAKERS, VCR/VCP, TELEVISION SETS, AUDIO AND VIDEO TAPE RECORDERS, CASSETTES, BATTERIES, INCLUDED IN CLASS 9.

1054399	9	PENTA		PANASONIC CORPORATION	1006, Oaza Kadoma, Kadoma-Shi, Osaka 571-8501, Japan	Opposed	
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APPLICATION DATE 25/10/2001 11:26:00

GOODS/SERVICE COMPUTERS, INTERFACES, CABLES, COMPUTER SOFTWARES, HARDWARE AND ACCESSORIES THEREOF, COMPUTER PERIPHERALS AND TERMINALS, DISK DRIVES, PRINTERS, MODEMS, HARD AND FLOPPY DISCS, DISKETTE HOLDERS, MONITORS, ELECTRONIC DATA PROCESSING APPARATUS AND PARTS THEREOF AND ACCESSORIES THEREFOR, ELECTRIC AND ELECTRONIC GOODS, PARTS FITTINGS AND COMPONENTS OF ELECTRICAL AND ELECTRONIC GOODS, ELECTRONIC GAMES, INTEGRATED CIRCUITS, PRINTED CIRCUIT BOARD AUDIO AND VIDEO TAPES, CARDS, SHEETS FOR SOUND, VISUAL AND DATA RECORDING, ELECTRONIC TYPEWRITERS/TELEPRINTERS, AUDIO, VIDEO AND MAGNETIC RECORDING AND REPRODUCING SYSTEMS, PROCESS CONTAINERS, VOLTAGE STABILISERS, REGULATORS, TRANSFORMERS OF ALL TYPES, INVERTERS, UNINTERUPLIBLE, POWER SUPPLIERS, CONSTANT FREQUENCY SOURCES, DC TO DC CONVERTERS, COMPUTER TERMINALS SERVO CONTROLLED EQUIPMENTS, DEVICES FOR MAGNETIC, AUDIO AND VIDEO SIGNALS AND TRANSMISSION THEREOF, DISC DRIVERS, CASSETTES, DATA STORAGE AND RETRIEVAL SYSTEMS, ISOLATORS, PROGRAMMERS, TELEVISION RECEIVERS SWITCHES, SWITCH HOLDER, SWITCH GEARS, IRON BELLS, BUZZERS, TRANSFORMERS, STARTERS, PLUGS, SOCKETS, EXTENSION, CARD BOXES, ADOPTERS, LIGHTING FIXTURES, PVC CONDUITS PIPE AND ELECTRICAL ACCESSORIES INCLUDED IN CLASS 09.

SEVANAND UPADHYAY
For REGISTRAR OF TRADE MARKS

Exit Print

22. In response to the said Examination Report, the respondent no.1 submitted its reply *vide* the communication dated 25.05.2019 baldly stating that both marks are dissimilar. Other than that, the respondent no.1 offered no reason, explanation or justification as to how and why the mark 'PONTA', it proposes registration of, is not similar or deceptively similar to the mark 'PENTA' and why it would not cause any confusion in the minds of the public. In order to appreciate this controversy, it would be important to reproduce the said reply hereunder:-



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“To,
The Registrar of Trademark,
Trademark Registry, DELHI

Date: 31/05/2019

Sub: REPLY TO EXAMINATION REPORT(MIS-R) Dated on: 04/05/2019
14:40:48

Ref: Application Number: 4134589

In case of hearing, your preferred mode of attending the hearing is: PHYSICAL

Sir,

With reference to the above application, the point wise reply is as under:-

FN/3004/

Date 25.5.2019

AGENT CODE NO.471

The Registrar of Trade Marks
Trade Marks Registry
New Delhi

REPLY TO EXAMINATION REPORT

Dear Sir,

Reg: Application No. 4134589 in Class 9 Trade Mark PONTA in the
name of SIDDHARTH VIJ.

Reference to the Examination Report dated 21/5/2019, which is appearing on
website but has not been received by us yet, we have to respectfully submit as
under:

REPLY TO PARA NO. 1

1. That the cited marks under nos.516905(PENTA) and 1054399 (PENTA) are
different from applicant mark PONTA. Kindly accept the application and waive
the objection under Section 11.

2. We rely upon the judgment namely CADILA PHARMACEUTICALS LTD. Vs.
The Registrar of Trade Marks, passed by the Hon'ble High Court at Ahmedabad
(Reported in PTC2002 page 308). In view of submissions, we request your
goodself that appropriate order be passed in the application for advertisement
in the trademarks journal.

3. In case, if the Ld. Registrar is still not satisfied with the above submissions,
kindly give us the reason for communication to the applicant and matter be
directed for hearing for final disposal.

ACTIVE REGISTRATION SERVICE.

Agent [471]”



23. From a perusal of the aforesaid reply, clearly, the respondent no.1 has not provided any satisfactory or plausible reason for adopting the mark 'PONTA', nor is this Court able to discern the same from a plain reading. It is indeed intriguing to note as to how the Trade Marks Registry, despite raising valid objections and citing the relevant mark of the petitioner, proceeded to register the mark 'PONTA', without any sufficient reason or justification in the reply dated 25.05.2019. It is significant to note that both the parties manufacture products which are identical and fall in the same class of goods.

24. To the aforesaid issue, the respondent had, for the first time, in the present proceedings, tendered a brilliant and most innovative storyline in the reply/counter. One, that the respondent no.1 is a deeply religious person and ardent follower of Sikh religion and traditions and in the course of such deeply entrenched thoughts, was motivated and borrowed the name 'PONTA' from the religious shrine Gurudwara 'SHRI PAONTA SAHIB'. The only thing respondent no.1 did was to delete/omit the letter 'A' from the name of the shrine and coin the word "PONTA". Two, that the word 'PONTA' is available in many languages over the world carrying varied meanings and thus, the word 'PONTA' as adopted is arbitrary as it has no relation to the products manufactured.

25. In the context of the aforesaid innovative storyline and explanation brought out by the respondent no.1 for the first time before this Court, which though seems attractive, but is unpersuasive and unmerited. This is for the reason that no such explanation or justification was tendered to the Trade Marks Registry while submitting its response and therefore, there was no occasion for the Registry to have considered or appreciated any such explanation before it registered the mark 'PONTA' of the respondent no.1. Thus, this Court cannot



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and will not consider any justification being tendered now for the first time. Moreover, the respondent has extensively relied upon the meaning and references to the word 'PONTA' based on research generated by Artificial Intelligence Tools, without any authentication or corroborative evidence of existence of such word in foreign languages. This Court cannot surely rely upon such unauthenticated and unverified material.


26. So far as the reliance placed on the name of a religious shrine being the motivator for adoption of the mark 'PONTA' is concerned, it appears to be very convenient. Had there been a shred of genuineness in such submissions, there was no reason why this was not mentioned by the respondent no.1 in the reply dated 25.05.2019 submitted in response to the Examination Report of the Trade Marks Registry. It appears to this Court that the respondent no.1 has now cooked up a story to align with the *malafide* adoption of its mark.

27. For the aforesaid reasons too, the argument in respect of the protection afforded by the provisions of Section 12 of the Act would not enure to the benefit of the respondent no.1. The adoption cannot fall within the ambit of "honest or concurrent user" as the trademark of the petitioner was cited in the Search Report and an objection to that effect was raised in the Examination Report however, there was no justification provided at all by the respondent no.1 against the same and yet the respondent no.1 pursued its application for registration of 'PONTA' and was ultimately registered. Equally, there is no concurrent use inasmuch as, (i) the respondent no.1 had applied for registration of its mark on a "proposed to be used" basis; and (ii) by the time the respondent no.1 commenced its business for manufacture of identical products in Class-9



under the said mark, the petitioner was already a popular and established entity with substantial goodwill and reputation in its mark 'PENTA'.


28. It would also be relevant to examine both the rival marks, i.e., word and device as well. The table of comparison is as under:-

PETITIONER	RESPONDENT NO.1
PENTA	PONTA 

29. What strikes the eye at the first glance is the glaring similarity, rather identicalness, in both the marks. Merely by replacing 'E' with the letter 'O' does not create any distinction at all. Moreover, if one were to carefully observe the device mark of respondent no.1, the design built into the letter 'O' actually gives an impression as if it is 'E' and not 'O'. In the opinion of this Court, the mark 'PONTA' of the respondent no.1 is visually, structurally and conceptually, if not identical, clearly deceptively similar. It also gives an impression, given the background facts that the trademark of the petitioner was indeed cited in the Examination Report, that the respondent no.1 has created a facade to establish distinction, however, it is not so. This Court does not find any dissimilarity at all. Thus, the mark 'PONTA' of the respondent no.1 is deceptively similar to the mark 'PENTA' of the petitioner. The marks being deceptively similar, products being identical, trade circles and distribution channels and retailers being common, an unwary consumer with average intelligence and imperfect



recollection is likely to get confused or deceived into purchasing the goods of the respondent no.1 believing them to be those of the petitioner or associated with it. It also cannot be lost sight of that the kind of consumers who would purchase the products would be electricians, petty contractors and general public who may really not inquire or attempt to find out as to whether the goods manufactured by the respondent no.1 and purchased are those manufactured by the petitioner or associated with it. In fact, the device used in the letter 'O' in the device mark

PONTA/  actually gives an impression that the letter is 'E' instead of 'O'.

30. That said, the petitioner has relied upon the provisions of Section 47 of the Act to challenge the registered mark of the respondent no.1 and sought its cancellation/removal from the Register of Trade Marks. To the mind of this Court, the said section is not applicable to the facts of this case. Section 47(1) (a) of the Act provides twin conditions to be satisfied. One, that the mark was registered without any "*bonafide intention*" for use in relation to the goods or services provided; and two, the need to prove the fact that there has been no "*bonafide use*" of the said mark in relation to those goods or services by any proprietor to date three months before the date of application. The respondent no.1 had admittedly applied on a "proposed to be used" basis, thus *bonafide use* three months before the date of application would not be applicable. Since the respondent no.1 has placed certain invoices showing sales of products manufactured by it and sold under the mark 'PONTA', the question as to the "*bonafide intention*" may also not be applicable in the present case.



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31. However, the petitioner has also relied upon Section 57 of the Act to seek cancellation/removal of the mark 'PONTA' from the Register of Trade Marks.

32. Section 57 of the Act provides for cancellation or variation and expunging of registration of a mark for varied reasons. Sub-section (2) of section 57 of the Act provides that a person aggrieved by the entry made without sufficient cause, or by any entry wrongly remaining on the Register or by any error or defect in any entry may apply for expunging or varying the said registered mark.

33. In the opinion of this Court, it would be the provisions of Section 57(2) of the Act that would be applicable to the facts of this case. Having regard to the analysis in the preceding paragraphs, in the opinion of this Court, the registration of the mark 'PONTA' in favor of the respondent no.1 is without any sufficient cause and thus, it would be incorrect to let the same remain in the Register of Trade Marks. As analysed and observed above, the registration of the mark of the respondent no.1 for 'PONTA', particularly when the mark 'PENTA' of the petitioner was cited in the Examination Report and there being no justification or reasons for adoption of the said mark by the respondent no.1, the mark could not have been registered. The deceptive similarity of the trademarks, the manufacture of identical products, the identical trade circles, identical distribution channels and retailers is bound to create confusion and deception in the mind of the general public. The issue of triple identity also is satisfied.

34. *Ergo*, the respondent no.2/Registrar of Trade Marks is directed to remove the registered mark 'PONTA' (word mark) bearing application no. 4134589

registered on 22.02.2021, and the device mark

bearing



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application no. 4885149 in Class-9 registered on 09.08.2021 in the name of respondent no.1, shall be removed and rectified in the Register of Trade Marks. The exercise shall be carried out within four weeks from the date of receipt of this order.

35. No costs.

36. The petitions, alongwith pending applications, stand disposed of in above terms.

**TUSHAR RAO GEDELA
(JUDGE)**

JUNE 05, 2026/yrj/anj/rl