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

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Date of decision: 3rd February, 2025

+ C.O. (COMM.IPD-TM) 121/2024 with I.A. 34109/2024 &
I.A. 34110/2024

ORACLE AMERICA, INC..... Petitioner

Through: Ms. Priya Adlakha, Ms. Sucharu Garg
and Ms. Shilpi Sinha, Advocates

versus

MR. SANDEEP KHANDELWAL AND ANR Respondents

Through: Ms. Nidhi Raman, CGSC with
Mr. Zubin Singh, Advocate for R-2

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present rectification petition has been filed under Sections 47 and 57 of the Trade Marks Act, 1999 (hereinafter 'the Act') seeking cancellation of the registration of the trade mark **javatpoint** bearing registration no. 5420304 in Class 41 in the name of the respondent no.1 (hereinafter 'impugned mark'), who filed the application for registration on 22nd April, 2022 and was granted registration on 10th July, 2023.

2. Notice in the application for *ad interim* stay on the operation of the impugned registration was issued and was accepted on behalf of the respondents in court on 1st August, 2024.

3. *Vide* the order dated 1st August, 2024, when the respondent no.1 was present through counsel, the court also directed that a *status quo* be maintained *qua* the impugned mark and the respondent no.1 was granted four weeks to file a reply to the aforesaid application, which expired on 29th August, 2024. No reply to the present petition or the aforesaid application on behalf of the respondent no.1 has been filed till date.

4. There was no appearance on behalf of the respondent no.1 on the previous date of hearing and none appears on his behalf even today.

BRIEF FACTS

5. Brief facts relevant for adjudicating the present petition are set out below:

5.1. The petitioner, a corporation incorporated and existing under the laws of California, United States of America, is a subsidiary of Oracle Corporation. Oracle Corporation operates in India through its other subsidiary, Oracle India Private Limited, which has its registered address in New Delhi. The aforesaid entities are hereinafter collectively referred to as the 'Petitioner Group'.

5.2. The petitioner group operates in over 175 countries and is a leading developer of enterprise and internet-based products and technologies including computer hardware, software and other related products and its customers include the Fortune 100 companies. The petitioner's parent company Oracle Corporation is an approximately USD 50 billion software and technology concern.

5.3. The petitioner group, through its predecessor Sun Microsystems, Inc., adopted and commenced using JAVA as a trade mark in connection with computer software and related services in 1996. The mark JAVA is

used by the petitioner group both on a standalone basis or in a combined manner with other prefix/ suffix including the mark JAVASCRIPT in India.

5.4. The petitioner group currently offers some of the most widely sold software products and services for application development and deployment under the mark JAVA. Among its many JAVA-branded offerings, the petitioner group provides a series of JAVA training and certification courses around the world including online courses accessible by users in India. After completion of the requisite courses, users are able to become Oracle-certified JAVA developers.

5.5. The products and services of the petitioner group under the JAVA marks enjoy a global reputation and are available across the world including in India with sales running into several millions of dollars annually.

5.6. The petitioner's parent company also owns and maintains a dedicated website, accessible at www.java.com, which domain was registered on 6th June 1996. The aforesaid website can be accessed from across the world including in India at <https://www.oracle.com/in/java/>.

5.7. The petitioner's JAVA marks have been used in India since the 1990s, originally through its aforesaid predecessor. Therefore, the relevant class of consumers and members of trade in India are extremely familiar with the JAVA marks and the petitioner groups' products and services thereunder.

5.8. The petitioner is the registered proprietor of the mark JAVA and other JAVA-formative marks, including the mark JAVASCRIPT, in India, a list of which has been provided in paragraph no. 11.12 of the petition.

5.9. The petitioner owns registrations for the JAVA marks in various classes in several other countries including but not limited to the USA, Canada, Mexico, Spain, Thailand, the European Union, Japan, China, Vietnam, Taiwan and South Korea.

5.10. The petitioner filed notices of opposition against the respondent no.1's trade mark application nos. 5420305 for the mark **javatpoint** in Class 42 and 6165135 for the mark **java T point** in Class 41.

5.11. Thereafter, upon a public search on the website of the Trade Marks registry, the petitioner's counsel learnt about the impugned registration in favour of the respondent no.1.

GROUND FOR CANCELLATION

6. The impugned mark is registered without sufficient cause and its registration is liable to be revoked under Section 57 of the Act on the following grounds:

6.1. The impugned mark subsumes the petitioner's prior adopted, used and registered trade mark JAVA entirely in respect of identical services, *i.e., 'Education; Providing of training; Entertainment; Sporting and cultural activities under class 41'.*

6.2. The impugned mark is devoid of any distinctive character and is likely to deceive the public and cause confusion among the members of trade and public.

6.3. The adoption of the impugned mark by the respondent no.1 is *mala fide* and dishonest and by virtue of the law of passing off in India, its registration is in violation of the provisions of Section 11(3)(a) of the Act.

6.4. Given the prior registration for the JAVA marks in favour of the petitioner, the registration of the impugned mark is contrary to the provisions contained in Section 11(1) of the Act. Reliance is placed on the order dated 12th February, 2024 in ***Oracle America v. Sonoo Jaiswal***, CS(COMM) 2/2024.

6.5. The respondent no.2 has failed to discharge its duty of examining the impugned mark under Sections 9, 11, and 18 of the Act as well as Rule 33 of the Trade Marks Rules, 2017 by not citing the petitioner's earlier registered JAVA marks in the examination report issued for the impugned mark. Reliance is placed on ***Jahangir Biri Factory v. Mohd. Dildar Hossain***, 2018 SCC OnLine IPAB 122 and ***Enagic HK v. Enagic International***, MANU/IC/0016/2021.

6.6. The respondent no.1 has no *bona fide* interest or claim in the impugned mark as the same has been abandoned by him with regard to services falling in Class 42.

7. There has been no *bona fide* use of the impugned mark by the respondent no.1 in respect of any services in Class 41 for the time being upto three months prior to the filing of the present petition on 23rd July, 2024. Therefore, the impugned mark is liable to be removed under the provisions of Section 47(1)(a) of the Act.

ANALYSIS AND FINDINGS

8. I have heard the counsel for the petitioner and perused the record of the case.

9. The respondent no.1 has not filed his reply to the present petition, which indicates that he has nothing substantial to put forth on merits by way of a response to the averments made in the petition. In view of the

above, the averments made in the petition are deemed to be admitted.

10. Firstly, it is imperative to refer to the decision of the Intellectual Property Appellate Board, Chennai in *Enagic HK* (supra), the relevant portion of which is extracted below:

“8.3. The fact of non-citing of registration of the applicant is [sic] the examiner report has not been denied by the Respondent No. 1. It appears to us that it may more happened due to an error while examining the said impugned trademark of the Respondent No. 1. The Office of the Respondent No. 2 had tailed [sic] to cite the earlier identical trademark of the Applicant registered in respect of identical/similar goods, thereby making the said examination is violative of the provisions of Section 11 of the Trade Marks Act, 1999 read with the provisions of Rule 33 of the Trade Marks Rules, 2017.

8.4. It is admitted position that it is the duty of the Respondent No. 2 to thoroughly examine the application and make a search of earlier Registered and pending trademarks which are identical with or similar to the mark being examined and shall prepare his consolidated examination report to cite all similar/identical registrations and other pending marks. However the Applicant's Registered mark is not cited as relevant marks by the Respondent No. 2 and has accepted without proper examination.


8.5. It is a settled principle of law that under the provisions of Rule 33 of the Trade Marks Rules, 2017 read with Section 11 of the Trade Marks Act, 1999 the Office of the Respondent No. 2 is obliged to cause a search to be made amongst the registered/pending trademarks for the purpose of ascertaining whether there exist on record any earlier identical/similar trademarks to the mark sought to be registered in respect of identical/similar goods and that where the subsequent mark is registered in contravention to the said provisions then the effect of such registrations are liable to be stayed. [Zee Telefilms Ltd. and Anr. Vs. Asia Today Ltd. And Ors. MANU/DE/7487/2007 : 2007 (34) PTC 467 (Del)] [Gulf Gate Hair Care Hair Fixing Pvt. Ltd. Vs. M/s. Brothers Gulf Gate Hair Care Centre ORA/194/2010/TM/CH] [Sriram Arya HUF Vs. Dinesh Shah ORA/298/2014/TM/DEL]”

(emphasis supplied)

11. A perusal of the record in the present case shows that the petitioner is the prior adopter, user and the registered proprietor of the JAVA marks and its earliest registration in India dates back to 30th March, 1995 for the mark JAVA and 6th February 1996 for the mark JAVASCRIPT in Class 9 with

respect to ‘computer software, hardware & peripherals & catalogues sold as a unit computer software’. Further, the petitioner is also the registered proprietor of the mark JAVA in Class 41 for identical services, i.e., ‘education; providing of training; entertainment; sporting and cultural activities’ with effect from 27th September 2006. Per contra, the respondent no.1 obtained registration for the impugned mark in Class 41 on a ‘proposed to be used’ basis with effect from 22nd April, 2022.

12. A comparison of the impugned mark with some of the petitioner’s JAVA marks is set out below:

Petitioner’s Marks	Impugned Mark
JAVA JAVASCRIPT JAVAONE JAVAOS GO JAVA	

13. This Court in the case of *Greaves Cotton Limited v. Mohammad Rafi and Ors.*, 2011 SCC OnLine Del 2596, has held as follows:

“16. It is not necessary that in order to constitute infringement, the impugned trademark should be an absolute replica of the registered trademark of the plaintiff. When the mark of the defendant is not identical to the mark of the plaintiff, it would be necessary for the plaintiff to establish that the mark being used by the defendant resembles his mark to such an extent that it is likely to deceive or cause confusion and that the user of the impugned trademark is in relation to the goods in respect of which the plaintiff has obtained registration in his favour. It will be sufficient if the plaintiff is able to show that the trademark adopted by the defendant resembles its trademark in a substantial degree, on account of extensive use of the main features found in his trademark. In fact, any intelligent person, seeking to encash upon the goodwill and


reputation of a well-established trademark, would make some minor changes here and there so as to claim in the event of a suit or other proceeding, being initiated against him that the trademark being used by him, does not constitute infringement of the trademark, ownership of which vests in some other person. But, such rather minor variations or distinguishing features would not deprive the plaintiff of injunction in case resemblance in the two trademarks is found to be substantial, to the extent that the impugned trademark is found to be similar to the registered trademark of the plaintiff. But, such malpractices are not acceptable and such a use cannot be permitted since this is actuated by a dishonest intention to take pecuniary advantage of the goodwill and brand image which the registered mark enjoys, it is also likely to create at least initial confusion in the mind of a consumer with average intelligence and imperfect recollection. It may also result in giving an unfair advantage to the infringer by creating an initial interest in the customer, who on account of such deceptive use of the registered trademark may end up buying the product of the infringer, though after knowing, either on account of difference in packaging etc. or on account of use of prefixes or suffixes that the product which he is buying is not the product of the plaintiff, but is the product of the defendant.”


(emphasis supplied)

14. As may be seen from the side-by-side comparison of the marks set out in the table above, the impugned mark subsumes the petitioner's mark JAVA in its entirety and is almost identical with its mark JAVASCRIPT. The minor difference/ addition in the impugned mark does not render it different from the petitioner's prior and reputed JAVA marks when considered in totality. It is therefore evident that the impugned mark is deceptively similar to the petitioner's JAVA marks. This Court further notes that the petitioner also provides series of JAVA training and certification courses around the world including online courses accessible by users in India. Therefore, the target consumers of the rival parties are identical and overlapping.

15. Further, this court, *vide* order dated 12th February 2024 in **Oracle**


America v. Sonoo Jaiswal, CS(COMM) 2/2024, had observed that the

impugned mark JAVA T POINT/  incorporates the plaintiff's mark JAVA entirely and mere addition of the word TPOINT as a suffix to the plaintiff's mark JAVA does not take away from the fact that JAVA is the prominent part of the impugned mark. Accordingly, an *ad interim* injunction was granted in favor of the petitioner herein.

16. The observations of the aforesaid judgment are fully applicable in the present case as in the present case also, the impugned mark is the same, *i.e.* JAVATPOINT/ .

17. Considering the aforesaid, I am of the view that the impugned mark is likely to cause confusion and deception among the consumers who associate the mark JAVA with the petitioner only and none else, especially as the petitioner has been using the JAVA marks since the 1990s in India and has acquired immense goodwill and reputation thereunder.

18. In view of the above, it is clear that the impugned mark has been adopted by the respondent no.1 dishonestly to ride over the goodwill and reputation of the petitioner under the JAVA marks and to associate himself and his services with the petitioner. Therefore, the continuation of the registration of the impugned mark in the name of the respondent no.1 in the Register of Trade Marks is in contravention of the provisions of Sections 9, 11 and 18 of the Act and is liable to be cancelled under the provisions of Section 57 of the Act.

19. Accordingly, the present petition is allowed and the Trade Marks Registry is directed to remove the impugned mark .

bearing the registration no. 5420304 in Class 41 in the name of the respondent no.1 from the Register of Trade Marks.

20. The Registry is directed to supply a copy of the present order to the Trade Marks Registry, at e-mail: llc-ipo@gov.in, for compliance.

21. The pending applications stand disposed of.

AMIT BANSAL, J

FEBRUARY 3, 2025

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