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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 19.10.2023

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/48/2023
(OA/13/2015/TM/CHN)

Ms.Craftsman Automation Pvt. Ltd.
No.1078, Senthel Towers, 4th Floor,
Avinashi Road,
Coimbatore-64118.

... Appellant

-vs-

1.The Assistant Registrar of Trade Marks,
Trade Marks Registry,
IP Building, GST Road, Guindy,
Chennai-600032.

2.Registrar of Trade Marks,
Trade Marks Registry,
IP Building, GST Road, Guindy,
Chennai-600032.

... Respondents

PRAYER: Transfer Miscellaneous Appeal (Trade Marks) is filed under Section 91 of the Trade Marks Act, 1999, praying that the present appeal be allowed and set aside the impugned order and



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order for the registration process of the said application.

For Appellant : Ms.Elizabeth Seshadri
for M/s.Iyer & Thomas

For Respondents : Mr.C.Kulandaivel,
Senior Panel Counsel

JUDGMENT

The appellant assails an order dated 12.06.2014 by which Application No.1697320 in Class 7 for registration of the internet domain name www.craftsmanautomation.com was refused.

2. The appellant applied for the registration of the above mentioned domain name in Classes 6 and 7 on 10.06.2008. The said applications were filed by asserting use since 01.01.2008 in relation to the respective goods. The affidavit was submitted on 21.07.2010 asserting that the domain name was honestly adopted on 12.03.2000 and used since then in relation to the relevant goods. The turnover of the appellant for the financial years 2008-2009 and 2009-2010 was set out in the affidavit and the appellant undertook to accept necessary



disclaimers and conditions, if imposed, in relation to its applications.

On 06.12.2012, the certificate of registration in respect of the application in Class 6 (TM No.1697319) was issued and the said domain name was registered in Class 6 with effect from 10.06.2008.

As regards the application in Class 7, pursuant to a hearing on 23.09.2013, by order dated 12.06.2014, the application was rejected by referring to Sections 9 and 11 of the Trade Marks Act, 1999 (the Trade Marks Act). The present appeal was filed in the said facts and circumstances.

3. Learned counsel for the appellant invited my attention to the applications filed in Classes 6 and 7. After pointing out that the domain name was registered in Class 6, learned counsel also pointed out that the mark 'Craftsman Automation' was registered under TM No.2040959 in Class 7 with effect from 20.10.2010. By referring to the impugned order and the grounds of decision relating thereto, learned counsel submitted that the finding entered therein that the mark is



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highly descriptive of the goods in Class 7 is completely untenable in light of the registration of the same mark in Class 6. In support of the contention that the mark does not fall within the ambit of Section 9 of the Trade Marks Act, learned counsel placed for consideration the following judgments:

(i) *Mohd. Rafiq and others vs. Modi Sugar Mills Ltd.*, AIR 1972 (Del) 46, where, at page 492 of the report, the Delhi High Court concluded that the mark "SUN", when used in respect of lanterns, cannot be construed as laudatory because the character and quality which the mark describes should be direct and plain and not an inference arrived at by a laboured process.



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(ii) *Proctor & Gamble Company v. Office for Harmonisation in the Internet Market*, 2002 RPC 369, (Proctor & Gamble), wherein at paragraphs 32, 35, 37, 40 to 43, the European Court of Justice concluded that an unusual juxtaposition of two English words, 'BABY-DRY' in that case, would satisfy the requirements of distinctiveness.

(iii) *I.T.C. Limited v. GTC Industries Ltd. and another*, (2002) SCC OnLine Bom 595, wherein at paragraph 10, the Bombay High Court concluded that the mark 'MAGNUM' satisfies the requirements of distinctiveness in the Indian context when viewed from the perspective of a person of average intelligence.



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4. In response to these contentions, Mr.C.Kulandaivel, learned Senior Panel Counsel, submitted that the appellant failed to adduce evidence of secondary meaning after asserting use from 01.01.2008. Learned counsel also submitted that each element in the mark, namely "crafts", "man" and "automation" are descriptive of the goods in Class 7. Therefore, he contended that the impugned order does not warrant interference.

5. The undisputed position is that two applications were filed on the same date for registration of an identical domain name as a trade mark in Classes 6 and 7. As regards the application in Class 6, the registration certificate was issued on 06.12.2012 with effect from 10.06.2008. Learned counsel for the appellant has also placed on record the registration certificate dated 21.03.2017 for the mark 'Craftsman Automation' in Class 7 under TM No.2040959 with effect from 20.10.2010. This case should be examined against this backdrop.



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6. The impugned order dated 12.06.2014, as is typical with orders of the Registrar of Trade Marks, is bereft of reasons and merely refers to Sections 9 and 11 of the Trade Marks Act. Turning to the grounds of decision, it contains three reasons for refusal. The first reason set out therein is that the mark consists of three words 'crafts', 'man' and 'automation', all of which are highly descriptive of the goods to which the mark is applied. The second reason cited therein is that documents in support of use since 01.01.2008 were not provided. The last reason mentioned therein is that the mark may not be descriptive as regards goods in Class 6, whereas it is highly descriptive as regards goods in Class 7.

7. I propose to examine the third reason first. The goods listed in Class 7 are common metals and their alloys; metal building materials; pipes and tubes of metals; and the like. The goods in Class 6 are machines and machine tools; motors and engines; machine coupling and transmission components; and the like. The mark is



'www.craftsmanautomation.com', which cannot be said to be descriptive of the goods in Class 7 but not descriptive of the goods in Class 6. The first reason mentioned in the grounds of decision is with regard to the descriptive character of the three elements constituting the trade mark. A trade mark is required to be examined as a whole and not by dissecting it into its constituents for purposes of deciding whether such mark is distinctive under Section 9 of the Trade Marks Act. As regards evidence of use, the corporate name of the appellant is Craftsman Automation Private Limited. In the affidavit filed by the appellant on 21.07.2010, the appellant has asserted adoption and use since 12.03.2000 in relation to the goods in Class 7. The appellant has also set out the turnover for the financial years 2008-2009 and 2009-2010. The expenditure incurred in promoting the sale of products bearing the said trade mark is set out and it is stated therein that copies of bills have also been annexed to the affidavit. In these circumstances, the conclusion recorded in the grounds of decision cannot be sustained.



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8. Section 9 of the Trade Marks Act prohibits the registration of trade marks which are devoid of distinctive character or which are used exclusively in trade to designate the kind, quality, intended purpose, geographical origin, etc., of the relevant goods or services. These requirements are also subject to the exception that distinctiveness may either be inherent or acquired. The determination of distinctiveness cannot be undertaken in a vacuum and should be undertaken with reference to the relevant goods or services. While making such determination, it should be borne in mind that the spectrum of distinctiveness is not cast-in-iron and the determination has to be made by examining the mark as a whole. In this case, the mark www.craftsmanautomation.com is applied in relation to machines and machine tools, motors and engines and related tools. The trade mark is not directly or plainly descriptive of the goods and combines the words “craftsman” and “automation” which are not typically combined. As held in *Procter & Gamble* by the European Court of Justice, even an unusual juxtaposition of



words commonly used in the English language may qualify as distinctive. In the facts and circumstances, when viewed as a whole, the mark satisfies the requirements of distinctiveness.

9. For reasons set out above, the impugned order is unsustainable and is, hereby, set aside. By taking into consideration the following : the mark originates from the corporate name of the appellant; the appellant has obtained registration of the mark 'Craftsman Automation' in Class 7 and has also obtained registration of the domain name in Class 6; other than alleged lack of distinctiveness, no other objections were raised in the examination report or the impugned order, the application shall be accepted for advertisement. Such acceptance shall, however, be subject to the condition that no exclusive use shall be claimed in respect of the words 'Craftsman' or 'Automation', when used separately. It is also made clear that this order will not be binding on opponents, if any.



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19.10.2023

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Index : Yes / No

Internet : Yes / No

Reportable : Yes / No

Neutral Citation : Yes / No



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