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IN THE HIGH COURT OF DELHI AT NEW DELHI*Date of decision: 18th May, 2022*

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C.A.(COMM.IPD-TM) 52/2022**MANKIND PHARMA LIMITED**

..... Appellant

Through: Mr. Hemant Daswani, Ms. Bhawani
Singh, Advocates (M:8233686869)

versus

THE REGISTRAR OF TRADE MARKS

..... Respondent

Through: Mr. Harish V. Shankar, CGSC, Ms. S.
Bushra Kazim, Mr. Srish Kumar
Mishra, Mr. Sagar Mehlawat,
Advocates (M:9810788606)**CORAM:****JUSTICE PRATHIBA M. SINGH****Prathiba M. Singh, J.(Oral)**

1. This hearing has been done through hybrid mode.
2. The present appeal was filed before the IPAB and has been received by this Court, pursuant to the Tribunals Reforms Act, 2021.
3. The Appellant has filed the present appeal challenging the impugned order dated 2nd August, 2019 passed by the Senior Examiner of Trade Marks by which the review petition filed by the Appellant has been dismissed. The said petition was filed by the Appellant seeking review of order dated 20th December, 2018 vide which the trade mark application of the Appellant bearing no. 2457850 for registering the word mark "DON'T WORRY" in Class- 3 had been rejected. The said application is in respect of the goods and services including:

'Bleaching Preparations and Other Substances for Laundry Use; Cleaning, Polishing, Scouring and Abrasive Preparations; Soaps; Perfumery, Deodorants, Essential Oils, Cosmetics, Hair Lotions; Dentifrices.'



4. The reasoning given for the rejection of the mark in the order dated 20th December, 2018 is as under:

“The trade mark applied for is objectionable under Section 9/11 of the Act. The application is accordingly refused.”

5. A review petition was preferred against the said order by the Appellant. The review petition was dismissed by the Senior Examiner of Trade Marks on 2nd August 2019, in the following terms:

“The present petition on form TM-M has been filed for review of the order dated 20 December 2018. None appeared. No relevant facts are established for the acceptance of trade mark application in the review petition. Application is devoid of any distinctive character. The mark is a combination of non-distinctive words. The mark is descriptive in nature and shows the intended purpose. Refusal order is sustained. Review application is disallowed on merit. The request on form TM-M is accordingly Refused.”

6. The statement of grounds of decision under Rule 36 (1) of the Trade Marks Rules, 2017 has been provided to the Appellant which states as under:

“Application was examined and objections were raised under section 9 of Trade Marks Act, 1999. The Trademark “DON’T WORRY” is devoid of any distinctive character. The mark is descriptive in nature and shows the intended purpose of the applied goods. Reply filed, perused but found not satisfactory. Application proceeded for show cause hearing. The refusal order was passed on 20/12/2018 by the hearing officer.



On 21/01/2019 the review petition was filed for review the refusal order. None appeared on behalf of the Applicant. The materials available on record till the date of hearing was considered. The available records of the subject application shows that the application has been filed on propose to be used basis.

The applicant stated in para 6 of the affidavit that the applicant had filed the documents for user claim and voluminous sales of the mark “Don’t worry” but the available documents and material provided by the application shows that the applicant is using the said mark in class 5 Sanitary Napkin.

The applicant adopted the mark “DON’T WORRY” in 2013 as per the applicant claim but the applicant filed the mark in class 3 on proposed to be used basis.”

7. A perusal of the reasoning given by the Senior Examiner would show that the ground for rejection of the application is that the mark “DON’T WORRY” is devoid of any distinctive character and is descriptive in nature. The Senior Examiner also notes that the mark “DON’T WORRY” is being used by the Appellant for Sanitary Napkins in Class-5.
8. The submission of Id. Counsel for the Appellant is that the Appellant has various registrations for the mark “DON’T WORRY” with or without the prefix “Mankind’s” in Classes - 1,5,31,32,35,44. He further submits that there is no reason which has been given by the Senior Examiner of Trade Marks for the rejection of Appellant’s application. Accordingly, the mark ought to be permitted to proceed for registration.
9. A perusal of record shows that the Appellant has the following registrations for marks consisting of the words “DON’T WORRY”:



MARK	CLASS	APPL. NO.	STATUS
MANKIND'S DON'T WORRY	01	2520512	Registered
MANKIND'S DON'T WORRY	05	2332721	Registered
DON'T WORRY	05	2332722	Registered
DON'T WORRY	31	2457857	Registered
DON'T WORRY	32	2457860	Registered
DON'T WORRY	35	2457863	Registered
DON'T WORRY	44	2457866	Registered

10. On a query by the Court to the counsel, it is submitted that the mark is being used by the Appellant in respect of sanitary napkins and therefore the present application is a *bona fide* application by the Appellant. The words “DON'T WORRY” being the registered trademark of the Appellant in other classes, there can be no reason for refusing the application in question, even though it is on a ‘proposed to be used’ basis.

11. In the opinion of the Court, the application on ‘proposed to be used’ basis in Class-3 cannot be rejected merely on the ground that words “DON'T WORRY” are devoid of distinctive character. The said mark would be an arbitrary or a suggestive mark in respect of goods falling in Class-3. Accordingly, this Court is of the view that the application ought to be permitted to proceed for advertisement before acceptance on the following terms and conditions:

- i. The application shall be associated with the trademarks of the Appellant “MANKIND'S DON'T WORRY” registered in



Class-1 and Class-5 bearing nos. 2520512 and 2332721 respectively.

- ii. The use of the mark in Class-3, if any, shall be with the word 'MANKIND'S' and the registration shall not grant any exclusive rights in the words 'DON'T' and 'WORRY' separately or conjointly in respect of unrelated products and/or services.

12. The application of the Appellant shall be advertised before acceptance in the Trade Mark Journal within a period of four months.

13. The observations in this order shall not in any manner prejudice any opposition proceedings, if commenced against the application.

14. The appeal is allowed in the above terms.

15. The present order shall be communicated to the Registrar of Trade Marks for compliance by Mr. Harish Vaidyanathan, Id. CGSC.

PRATHIBA M. SINGH
JUDGE

MAY 18, 2022/aman/SK