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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
Date of Decision: 3rd November, 2022

+ **C.A.(COMM.IPD-TM) 51/2021**

M/S. JINDAL INDUSTRIES PRIVATE LIMITED..... Appellant

Through: Mr. Rishabh Srivastava, Ms. Shreeya Rastogi & Ms. Sunita, Advocates.
 (M:9737708556)

versus

THE REGISTRAR OF TRADE MARK Respondent

Through: Mr. Harish V. Shankar, CGSC, Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat, Mr. Alexander Mathai Paikaday, Advs. (M:9810788606)

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J.(Oral)

1. This hearing has been done through hybrid mode.
2. This is an appeal under Section 91 of the Trade Marks Act, 1999 (*hereinafter 'Act'*) challenging the order dated 28th May, 2019 passed by the Trade Marks Registry read along with statement of grounds dated 11th October, 2019. Vide the said order, the trademark application of the Appellant/Applicant (*hereinafter 'Applicant'*) has been rejected. The details of the Applicant's trade mark application are as under:

Mark	Application No.	Application Date	Class	Applicant
	1787422	19 th February, 2009	35	M/s Jindal Industries Pvt. Ltd.

3. The said mark has been rejected by the Trade Mark Registry under Sections 9 and 11 of the Act as also the Emblems and Name (Prevention of Improper Use) Act, 1950. The relevant portion of the impugned order reads as under:

“9(2)(d) - The trade mark;—Its use is prohibited under the Emblems and Name(Prevention of Improper Use)Act,1950 (12 of 1950)

11(1)(b) - Relative grounds for refusal of registration. The said trade Mark is refused for registration because of its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

4. It is the case of the Applicant that it has been using similar marks since 1961 and holds registration in respect of them under various classes including Classes 6, 17, 11. Ld. Counsel for the Applicant further relies upon the judgment of this Court in ***C.A.(COMM.IPD-TM) 99/2021*** titled ***M/s Jindal Industries Pvt. Ltd. v. The Registrar of Trade Mark*** as also in ***C.A. (COMM.IPD-TM) 99/2021*** titled ***M/s Jindal Industries Pvt. Ltd. v. The Registrar of Trade Mark*** to argue that the Emblems and Names (Prevention of Improper Use) Act, 1950 does not prevent the use of outline of the map of India as a trade mark.

5. Heard and perused the record. The order under challenge in the present appeal does not consider the fact that similar trademarks have already been registered by the Appellant in several Classes. The reasoning for rejecting the application in question in the Statement of Grounds of Decision under Rule 36(1) of the Trade Marks Rules, 2017 is as under:

“With reference to the above and request on Form TM-M dated 10/09/2019 . It has been decided by the Registrar of Trade Marks to inform you that hearing in respect of above application was held on 18/04/2019 and the said application is refused on the following Grounds;

ADV. APOORVA, APPEARED, ARGUED, HEARD, CHECKED, IT APPEARED THAT, DECEPTIVELY SIMILAR REG. MARK WITH SAME SERVICES ARE ON RECORD, USER CLAIMED SINCE 1961 AND FILED USER OF GOODS AND NOT SERVICES ALONG WITH MARK APPLIED, MOREOVER USE OF THE MAP ALONG WITH MARK IS NOT INHERENTLY DISTINCTIVE ALSO NOT GAVE MONOPOLY RIGHT, BENEFIT OF PROVISIO SEC. 9 AND SEC.12 ALSO NOT PROVIDED, HENCE REFUSED.”

6. The order is completely silent on other registrations which have been granted in favour of the Applicant for identical/ similar marks in other classes. Further the Trade Mark Registrar did not take into consideration the no objection given by the Survey of India in favour of the Applicant in respect of the mark in question.

7. This Court had the occasion to consider a similar matter in **C.A.(COMM.IPD-TM) 99/2021** where the application was filed by this very Applicant for an identical mark as in the present matter in Class 17 which was rejected by the Trade Mark registry on identical grounds. The Court had observed therein as under:

“13. A perusal of the record shows that the Schedule to The Emblems and Names (Prevention of Improper Use) Act, 1950 does not, prevent the use of the outline of the map of India. Moreover, vide letter dated 8th February, 1994, as extracted hereinabove, the Survey of India has already given a ‘No

Objection’ to the Appellant-M/s. Jindal Industries Pvt. Ltd., for use of the impugned mark ‘JINDAL’ with the outline of the map of India, as set out above. Various other registrations which have been granted in favour of the Appellant also show that there are several marks wherein the outline of India has been depicted. Thus, the reasoning given by the Registrar of Trademarks is completely unsustainable. Moreover, the use of the outline of India signifies that the product originates from India, and thus, the use of the same cannot be held to be violative of Section 9 of the Trade Marks Act, 1999, or The Emblems and Names (Prevention of Improper Use) Act, 1950.

14. Accordingly, the impugned orders are set aside. The Registrar of Trademarks is directed to proceed for registration of the impugned mark. Let the impugned mark be advertised within a period of 3 months. If there is any opposition in respect to the impugned mark, the same shall be decided by the Registrar of Trademarks, in accordance with law, without being affected by the observations in the present order”

8. This order has been affirmed and relied upon by the Id. Single judge in *C.A.(COMM.IPD-TM) 34/2021* wherein the Court, again dealing with an identical mark as in the present appeal under Class 6, vide its order dated 28th July, 2022, held as under:

“9. The impugned order does not reflect the consideration of the Examiner of Trade Marks on the issue that the appellant is a registered proprietor of the mark “JINDAL” in various variants and for various classes, including Class 6. Some of the cited marks were that of the appellant itself. Therefore, rejection of the application of the appellant on this ground cannot be sustained.

10. As far as the outline of the map of India is

concerned, again the appellant is the registered proprietor of similar marks for other classes of goods, as had been contended by the appellant in its appeal. Even otherwise, a Co-ordinate Bench of this Court has considered this aspect as held as under:-

“13. A perusal of the record shows that the Schedule to The Emblems and Names (Prevention of Improper Use) Act, 1950 does not, prevent the use of the outline of the map of India. Moreover, vide letter dated 8th February, 1994, as extracted hereinabove, the Survey of India has already given a ‘No-Objection’ to the Appellant-M/s. Jindal Industries Pvt. Ltd., for use of the impugned mark ‘JINDAL’ with the outline of the map of India, as set out above. Various other registrations which have been granted in favour of the Appellant also show that there are several marks wherein the outline of India has been depicted. Thus, the reasoning given by the Registrar of Trademarks is completely unsustainable. Moreover, the use of the outline of India signifies that the product originates from India, and thus, the use of the same cannot be held to be violative of Section 9 of the Trade Marks Act, 1999, or The Emblems and Names (Prevention of Improper Use) Act, 1950.”

11. On ground (c), the rejection of the application of the appellant on the ground of it being unable to substantiate the user claim since 01.04.1961, also cannot be sustained. **The Registrar of Trade Marks has not stated that no user of the mark was proven in the present case or that the mark was not distinctive for the appellant. In absence thereof, the rejection of the mark was not proper.**

12. In view of the above, the impugned order is set aside. The Registrar of Trade Marks is directed to proceed with the registration of the impugned mark.

Let the impugned mark be advertised within a period of three months. If there is any opposition in respect of the impugned mark, the same shall be decided by the Registrar of Trade Marks in accordance with law, remaining unaffected from any observation made in the present order.”

9. The rationale and reasoning of the above two orders are completely applicable *mutatis mutandis* to the present appeal as well. In the opinion of the Court, the impugned order is thus completely unsustainable and is accordingly set aside.
10. The Registrar of Trade Marks is accordingly directed to proceed for registration of the application. Let the same be advertised within a period of three months.
11. If there is any opposition to the said application, the same shall be decided on its own merits without being affected by the observations made herein.
12. With these observations the appeal is disposed of. All pending applications are also disposed of.
13. Registry to supply a copy of the present order to Trade Mark Registry at llc-ipo@gov.in for compliance.

PRATHIBA M. SINGH
JUDGE

NOVEMBER 3, 2022
dj/sk