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

Date of Decision: 09.11.2022

+ **C.A.(COMM.IPD-TM) 84/2021**

LICENSING IP INTERNATIONAL S.AR.L.

..... Appellant

Through: Mr.Peeyosh Kalra, Ms.V.
Mohini & Mr.Udayvir Rano,
Advs.

versus

SENIOR EXAMINER TRADE MARKS

..... Respondent

Through: Mr.Harish Vaidyanathan
Shankar, CGSC with Mr.Srish
Kumar Mishra, Mr.Sagar
Mehlawat & Mr.Alexander
Mathai Paikaday, Advs.

CORAM:

HON'BLE MR. JUSTICE NAVIN CHAWLA

NAVIN CHAWLA, J. (Oral)

1. This appeal has been filed by the appellant challenging the order dated 02.04.2019 passed by the Senior Examiner of Trade Marks, rejecting the application no. 2640851 of the appellant seeking registration of its mark "BRAZZERS" in Class 35.
2. The appellant had filed the above application seeking registration of the trade mark "BRAZZERS" in Class 35 in respect of "on-line retail store services featuring clothing, mobile phone cases, golf balls, key chains, and mugs". The Registrar of Trade Marks issued an Examination Report dated 25.02.2015 raising an objection

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under Section 11 of the Trade Marks Act, 1999 (hereinafter referred to as the 'Act') on ground of similar trade marks being already on record in the Register for the same or similar goods or services. The marks cited against the appellant were as under:-

7/7/2019 Examination Report

GOVERNMENT OF INDIA
TRADE MARKS REGISTRY

INTELLECTUAL PROPERTY INDIA
REGISTRATION OF TRADE MARKS

LOCATION: SECTION: EXM REPORT: EXM007
PHONETIC SEARCH REPORT APPLICATION NUMBER: 2846851 Class: --- TRADEMARK: 'BREEZERS'
USER: SUH PAGE: 1 DATE: 18/12/2014

APPL. NO	CLASS	CONFLICTING MARK	JOURNAL No	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	TM IMAGE
GOODS SERVICES							
2312824	9	BRESSER	1608	RAJU PATEL	4TH FLOOR, 10/12, DR. WILSON STREET, OFF. VITHALBHAI PATEL ROAD, MUMBAI-400004	Registered	
APPLICATION DATE 10/04/2012 GOODS/SERVICE OPTICAL APPARATUS AND INSTRUMENTS; ASTRONOMY APPARATUS AND INSTRUMENTS; MICROSCOPES; SPOTTING SCOPES; MOUNT FOR TELESCOPES OR MICROSCOPES; TRIPOD FOR TELESCOPES; EYEPIECES; DIAGONALS; FINDER SCOPES; CONTROLLER FOR TELESCOPES MOUNT (ELECTRONICS); REMOTE CONTROL APPARATUS FOR TELESCOPES MOUNT (ELECTRONICS); BINOCULARS.							
297759	25	BREEZER	636	BISHAMBHAR DASS	122/885, SHASTRI NAGAR, KANPUR, UTTAR PRADESH	Registered	
APPLICATION DATE 18/07/1974 GOODS/SERVICE VEST, UNDERWEAR (HOSIERY), GANJL							
867475	25	BREEZERS	9999	LAKHANI INDIA LIMITED	PLOT NO. 131, SECTOR 24, FARIDABAD, HARYANA.	Registered	
APPLICATION DATE 22/07/1999 15:41:53 GOODS/SERVICE FOOTWEAR OF ALL KIND INCLUDED IN CLASS 25.							
1111281	25	BREEZERS	9999	ASHWANI KUMAR GOEL	265/24, ST. NO. 2, MAHARAJA RANJIT SINGH PARK, BEHIND SHINGAR CINEMA, LUDHIANA (PB.).	Registered	
APPLICATION DATE 13/06/2002 10:33:51 GOODS/SERVICE HOSIERY GOODS INCLUDING UNDER GARMENTS.							
1171073	25	BREEZER	1328	BACARDI & COMPANY LTD.	AEULESTRASSE 5, FL- 9490 VADUZ, LIECHTENSTEIN.	Registered	
APPLICATION DATE 24/01/2003 15:40:00 GOODS/SERVICE CLOTHING, FOOTWEAR AND HEADGEAR INCLUDING IN CLASS 25.							
2123322	25	BREEZERS WITH DEVICE		LAKSONS FOOTWEAR PVT LTD	PLOTNO 131, SECTOR 24, FARIDABAD-05, HARYANA	Objected	
APPLICATION DATE 30/03/2011 GOODS/SERVICE CLOTHING, FOOTWEAR AND HEADGEAR, INCLUDED IN CLASS 25.							
2312625	35	BRESSER		RAJU PATEL	4TH FLOOR, 10/12, DR. WILSON STREET, OFF. VITHALBHAI PATEL ROAD, MUMBAI-400004	Objected	
APPLICATION DATE 10/04/2012 GOODS/SERVICE ADVERTISING, BUSINESS MANAGEMENT, BUSINESS ADMINISTRATION, OFFICE FUNCTIONS.							

SUHAS SURESH AMDOSKAR
For REGISTRAR OF TRADE MARKS

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https://ipdionline.gov.in/register/examreport.aspx?APPLICATION_NUMBER=WfRaW1x0KS0rJy8eKFhZW1cXQ==

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3. The appellant filed a reply to the Examination Report under cover of its letter dated 30.01.2016.
4. The application of the appellant was, however rejected vide an order dated 02.04.2019 passed by the Senior Examiner of Trade Marks, holding the mark applied to be objectionable under Section 9/11 of the Act.
5. The appellant applied for Statement of Grounds of Decision under Rule 36(1) of the Trade Marks Rules, 2017, which were provided to it vide order dated 01.05.2019, stating as under: -

“The application for the registration of the mark had been filed on 11/12/2013, claiming user of the same since 11/08/2012. The fact that the impugned mark is being filed with the use since the year 2012 is of no help to the applicant in this case whereas the user document filed alongwith the affidavit does not validate the claimed user show from the goods of year 2012 as claimed in the application and not compliance of Rule 25.

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Identical and/or similar prior trade mark no. 1111261, 1171073, 2123322 & 2312625 is already on Register of Trade Marks. As such the Application no- 2640851 in class 35 is hit by objections under Section 11 (1) of the Act and, therefore, application is refused for registration. Reliance in this concern is placed upon the judgment of Hon'ble Delhi High Court reported at

2012 (50) PTC 433 (Del.) (DB), wherein in paragraph 26, it was held that once a mark is registered a label mark then it cannot be said that work contain therein is not registered. Therefore, identical and/or similar of the earlier mark registered under no. 1111261 1171073, 2123322 & 2312625, is worthy of protection even if the manner is somewhat different.”

6. The learned counsel for the appellant submits that the Senior Examiner of Trade Marks has erred in law in dismissing the application of the appellant on account of the appellant not being able to prove its user of the mark since 2012. He submits that, in case the Senior Examiner of Trade Marks was of such a view, it should have granted to the appellant an opportunity to amend the user as “proposed to be used” or of any other date, however, the application should not have been rejected on this ground.

7. As far as the cited marks are concerned, the learned counsel for the appellant submits that the cited marks under application nos. 1111261, 1171073 and 2123322 were for different Class of goods and, therefore, not relevant to the application of the appellant. As far as the cited mark under application no. 2312625 is concerned, though the same was for the same Class as the one applied for by the appellant, the services covered therein were different. He submits that, on enquiry, it was found that the applicant therein was, in fact, engaged in the business of manufacturing precision astronomical telescopes.

8. He further submits that the appellant is also the registered proprietor of its mark in various countries across the world, details whereof are given by the appellant in paragraph 4(vii) of the appeal. He submits that the said mark is also registered in India for other classes, namely, Class 9, 38, 41 and 42.

9. On the other hand, the learned counsel for the respondent submits that the cited marks are deceptively similar to the mark applied for by the appellant. He further submits that even the goods and services for atleast the cited marks under application no. 1111261, 1171073 and 2123322 are similar to that of the appellant, being clothing and undergarments.

10. I have considered the submissions made by the learned counsels for the parties. As is evident from the examination report, the cited marks under application nos. 1111261, 1171073 and 2123322 are in different Class of goods. Further, the application of the appellant was for an “*online retail store services*”; it was not for the goods *per se*. Therefore, in my opinion, and subject to any opposition being filed by the applicants of these marks at a later stage, the Senior Examiner of Trade Marks could not have refused the application of the appellant at this stage citing the said marks.

11. As far as the cited marks under application no. 2312625 is concerned, again, the services for which the said mark has been registered are as under:-

*“GOODS/SERIVCE ADVERTISING,
BUSINESS MANAGEMENT,
BUSINESS ADMINISTRATION,
OFFICE FUNCTIONS.”*

12. The same is different from the services for which the appellant applied for registration of its mark.

13. The learned counsel for the appellant submits that even before the Registrar of Trade Marks, a submission was made that the applicants in application no. 2312625 are engaged in the business of manufacturing precision astronomical telescopes, which is totally distinct from that of the appellant. This submission does not find mention in the Impugned Order, leave alone being answered. Be that as it may, the effect of this submission can be noticed once the objections against the registration of the impugned mark, if any, are filed by the applicant in application no. 2312625 on advertisement of appellant's mark. The present was not the stage for the consideration of the same.

14. On the objection of the user of the mark being not proved, in my opinion, the Senior Examiner of Trade Marks could have granted an opportunity to the appellant to change the user detail in its application. As stated by the learned counsel for the appellant, the user detail would be changed to 'proposed to be used'.

15. In view of the above, the Impugned Order dated 02.04.2019 and the Statement of Grounds of Decision dated 01.05.2019 are set aside. It is directed that the application of the appellant be proceeded for advertisement on the claim of the mark being 'proposed to be used'. It is, however, made clear that any objection filed to the application of the appellant seeking registration of its mark shall be considered by

the Registrar of Trade Marks remaining uninfluenced by any observation made in the present order.

16. The appeal is allowed in the above terms.

NAVIN CHAWLA, J

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