

ORDER SHEET

TMA 4 of 2023
IN THE HIGH COURT AT CALCUTTA
SPECIAL JURISDICTION

ORIGINAL SIDE

BIDISHA GHOSHAL

VS.

THE REGISTRAR OF TRADE MARKS.

BEFORE:

The Hon'ble JUSTICE ARINDAM MUKHERJEE

Date: 18th October, 2023.

Mr. Rishad Medora, Adv.
Mr. Sagnik Majumdar, Adv.
Ms. Arunima Lala, Adv.
Ms. Shreya Ghosh Dostidar, Adv.

Advocates for the appellant.

Mr. Sourav Kr. Mukherjee, Adv.

Advocate for the Registrar of Trade Marks.

The Court: The instant appeal under Section 91 of the Trade Marks Act, 1999 arises out of an order dated 19th December, 2022 passed by Senior Examiner of Trade Marks by which the application vide application no. 5093966 for registration of the mark "42 orchids" made by the appellant UNDER Class 16 has been rejected.

The Appellant, Bidisha Ghosal, claims to operate her business under the trade name of '42 orchids' and is engaged in the business of manufacturing and selling of quilled artwork. The Appellant says that she started this business under the trade name '42 orchids' in the year 2021. The Appellant, under the trademark "42 orchids" (hereinafter the subject trademark), has developed various types of quilled artwork. The Appellant is the founder of "42 orchids" and the chief designer there at. The Appellant manufactures and sells all her products under the said trademark. The appellant has a website under the domain name <42orchids.in> which is not yet operational, the appellant's business as of now is primarily through social media marketing, her Instagram Page and word of mouth. The Appellant has already registered the said trademark with Udyam, Government of India, Ministry of Micro, Small and Medium Enterprises and European Union Intellectual Property Office (EUIPO). The supporting documents are marked and annexed as "C" at page 35 of the appeal. Thereafter the Appellant had applied for registration of the subject trademark "42 orchids" under the subject application no. 5093966 in Class 16 of the Trade marks Act, 1999 (hereinafter referred to as the said Act). The said application is annexure "D" to this appeal at page 40 and was filed on August 18, 2021 on "proposed to be used" basis.

By an Examination Report dated August 27, 2021, the appellant was duly notified that the mark of the appellant was devoid of any distinctive character and was incapable of registration. The application has been rejected on the ground of objections to the registration of the mark under Sections 11(1) of the said Act on the premise that the mark applied for registration is identical with or similar to earlier trademarks on record, as mentioned in the Examination report and due to similarity of marks as well as similarity of goods and services covered under such marks, there exists a likelihood of confusion in the mind of public.

The Report relied on various trademark applications in support of the said ground. Thereafter, by the order dated December 19, 2022, the Learned Examiner refused the application under Section 11(1) of the Trade Marks Act, 1999.

Thus aggrieved, the Appellant has preferred the present appeal. The certified copy of the impugned order is being filed herewith. The operative part of the said order reads as follows:

"The mark applied for registration is identical with/similar to earlier trademarks on record, as mentioned in the Examination report and by similarity of marks as well as similarity of goods and services covered under such marks, there exists a likelihood of confusion in the mind of public. As such the registration of the mark is objectionable under Section 11(1) of the Trade Marks Act 1999. After perusal of all the documents on record and submission made by the applicant/ authorised agent, it is concluded that applied mark is not registrable because of the reason stated as above. Hence application no 5093966 cannot be accepted and refused accordingly."

That the copy of impugned order was received by the Appellant's Attorney through email on December 19, 2022 and therefore the deadline for filing the appeal expired on March 19, 2023 being 3 months from receipt of the order.

The Appellant prayed for an order condoning the delay of 121 days in filing the present appeal. Considering the explanation given the delay was condoned and the appeal was admitted to be heard on merits.

It is submitted by the appellant that the order impugned is devoid of reasons. The appellant says that the report of the Examiner was mechanical and also does not give a clear picture as to the reasons of objection. The appellant has cited a judgment reported in 2023 (7) SCC 282 (State Bank of India And Another Vs. Ajay Kumar Sood) to impress upon the Court that the order impugned was passed mechanically. The appellant submits that the Examination Report lacks material particulars. Some of the marks referred to in the Examination Report (the 2nd and 3rd marks at page 44, and the 2nd, 4th and 5th marks at page 46) have not been registered and consequently, have no bearing on the Appellant's application for registration. None of the marks referred to in the Examination Report contain the digits/figure "42", which is an essential and integral part and component of the mark being sought to be registered by the Appellant. The said number with its suffix creates a distinctive mark to identify appellant's goods and services. There are no same or similar marks already on the record of the register for the same or similar goods and services. The Appellant's mark is not identical with or similar or even deceptively similar to earlier marks in respect of identical or similar

description of goods and services. Hence, there exists no likelihood of confusion on the part of the public in respect of the marks referred to in the Examination Report and the trademark being sought to be registered by the Appellant. The purported objection raised by the Respondent under Section 11 (1) of the Trade Marks Act, 1999 is untenable and/or misconceived.

The proprietor in respect of most of the marks referred to in the Examination Report is one Kamat Hotels (India) Limited and it had filed all its applications for registration of its marks on 29/2/2008. It is evident from the Examination Report that certain other marks (the 1st and 3rd marks at page 46) bearing the word “orchid” were sought to be registered subsequent to 29/2/2008 and have been registered. The appellant seeks to register a word mark in respect of quilled artwork and it is evident from the examination report that there are no similar or identical trademarks with the figure 42 or relating to same line of work i.e. art work.

In support of its aforesaid submissions, the Appellant seeks to rely on the judgment reported in (2023) 7 SCC 282 as well as an order passed by this Hon’ble Court in TMA 8 of 2022 whereby this Hon’ble Court had been pleased to set aside an order passed by the Trade Marks Registry which is identical (save and except for the name of the Applicant/Appellant and the mark) to the order impugned in the instant appeal.

The respondent submits that from the description of goods and services to be traded by the appellant as provide in her application dated 18.08.2021 the

said goods and services would fall in Class 16. The said application was thoroughly examined and upon searches having been made, it was found by the office of the respondent that a Trademark, namely, 'Orchid' has already been issued in favour of one Kamat Hotels (India) Limited and Others in 2008 and even prior thereto in respect of goods and services falling in Class 16. By a detailed Search Report, it has been depicted by the office of the respondent that the products/goods for which appellant has made the said application are same and similar to the products/goods wherefor trademark, namely, Orchid had already been issued, accepted and registered. In the said report dated 27.08.2021 it has been categorically explained since trademarks for same class of goods and services is/are already on record of the said application was liable to be refused.

After the report was notified to the appellant, no justification and/or explanation to show dissimilarity of the mark applied by the appellant with the mark(s) already on record and/or registered was submitted by the appellant. The respondent also submits that following the procedure the mark applied for registration being identical with/or similar to earlier trademarks on record as mentioned by the examination report there is every likelihood of confusion in the mind of public at large to arise. Accordingly, the applied mark was held to be objectionable under Section 11 (1) of the Trade Marks Act, 1998 and the applied mark was not registrable. The application thereby was refused.

The Respondent also submits that the judgments and order submitted by the appellant is not applicable in the instant case since the said Report of the

Examiner is crystal clear and though the respondent authority is 'not a court'; the respondent has passed a considered and well-reasoned order referring to the detailed materials already on record. The respondent submits that the well-settled principle that reason is the life of law which injects soul into the judgment does not hold in present order wherein decision is found to be conclusion devoid of illegality, irrationality and arbitrariness, as reasons satisfactory to a prudent man has been cited in the impugned order. Moreover in TMA 8 of 2022 in connection whereof the order of the Coordinate Bench of this Court dated 18th January, 2023 was passed wherein the examination report was not considered, but that is not true in the present appeal.

After hearing the parties and considering the materials on record, I find that the order impugned is not only cryptic but also bereft of reasons. Although, the learned Advocate for the respondent has tried to stretch his argument as far as possible to argue that the order is a reasoned one but there is no discussion as regards the examination report in the order impugned except only a reference thereof. The similarity or deceptive similarity between the applied mark and the registered mark as submitted by the respondent is completely missing in the order impugned. The distinctive feature or the essential features of a mark can be the distinguishing feature between two marks. Only because the mark Orchid is registered it does not mean that no mark containing the word Orchid can be applied for or registered. It is to be seen whether the two marks are structurally and phonetically similar or would cause for such reason cause deception in the minds of consumers. Ocular test is also considered for the

purpose of finding out whether confusion in the mind of public at large is caused or not. There is no such discussion in the order impugned. The impugned order also does not take into consideration the scope and ambit of Section 2(m) of the said Act. It is also well-settled as held in **AIR 1974 SC 87 [Union of India vs. Mohan Lal Capoor & Ors.]** that *“reasons are the links between the materials on which certain conclusions are based and the actual conclusions. They disclose how the mind is applied to the subject matter for a decision whether it is purely administrative or quasi judicial. They should reveal a rational nexus between the facts considered and the conclusions reached.”*

In light of the discussion hereinabove based on arguments and materials on record, the order dated September 7, 2022 is set aside. The matter is remanded back to the respondent authorities to consider the application of the petitioner afresh in accordance with law and after giving right to hearing of the authorities. It is expected that the respondent authorities shall dispose of the application of the petitioner within a period of six months from the date of communication of this order.

To the aforesaid extent, TMA/4/2023 stands allowed. However, there shall be no order as to costs.

(ARINDAM MUKHERJEE, J.)