

SHRIKANT
SHRINIVAS
MALANI

Digitally signed
by SHRIKANT
SHRINIVAS
MALANI
Date: 2023.03.21
17:23:15 +0530

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION**

COMMERCIAL MISCELLANEOUS PETITION NO. 1279 OF 2022

Amica Financial Technologies Pvt. Ltd.

...Petitioner

Versus

The Registrar of Trade Mark

...Respondent

- Mr. Nitin Masilamani, Ms. Simran Jalan i/by Jerone Merchant & Partners, for Petitioner.

CORAM : MANISH PITALE, J

DATE : 20th MARCH, 2023.

P. C. :

1. Heard, Mr. Masilamani, learned Counsel appearing for the Petitioner.

2. By this petition, the Petitioner has challenged the order dated 20th January, 2022, passed by the Respondent – Registrar of Trade Marks, whereby an application for registration of trademark of the Petitioner has been refused under Section 11(1) of the Trade Marks Act, 1999. On 18th November, 2022, this Court issued notice for final disposal to the Respondent. Despite service, the Respondent has chosen not to appear before this Court. Accordingly, the learned Counsel for the Petitioner is heard for finally disposing of the present petition.

3. It is brought to the notice of this Court that the Petitioner applied for registration of its trademark “JUPITER” under Class 36

for specific services as mentioned in the said application, including Electronic Funds Transfer, Clearing and Reconciling Financial Transactions etc. The Petitioner has candidly referred to an apparently similar registered trademark, but it is specifically pleaded that such registered trademark pertains to distinct services within the same class. It is the case of the Plaintiff that the said aspect of the matter was placed before the Respondent and yet the impugned order records as follows:

“The mark applied for registration is proposed to be used mark similar to earlier trademark application no. 1608245 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.”

4. The learned Counsel for the Petitioner submits that the observation made by the Respondent that not only is there similarity in marks, but also similarity of goods and services, demonstrates non application of mind on the part of Respondent.

5. In this context, the learned Counsel for the Petitioner has invited attention of this Court to an affidavit filed in the present petition. Along with the said affidavit the petitioner has annexed its

response dated 21st December, 2019, to the Examination report, wherein the distinction was highlighted between the services provided by the entity with the conflicting registered mark and the services provided by the Petitioner within the same class. The learned Counsel for the Petitioner had relied upon series of judgments in support of its contention that in such a situation, Section 11(1) of the aforesaid Act could not have been invoked to refuse registration for the trademark of the Petitioner.

6. As noted above, the Respondent has chosen not to appear before this Court, despite service. The material on record also shows that detailed material was indeed placed on record before the Respondent to support the contention of the Petitioner that in the light of the services being distinct, the Registrar ought to have considered whether Section 11(1) of the Act, could have been invoked in such circumstances. A perusal of the impugned order shows that there is no application of mind by the Respondent on this aspect of the matter at all.

7. Apart from that, the learned Counsel for the Petitioner invited attention of this Court to paragraph no. 31 of the petition, wherein it is stated that the Petitioner had filed a request under Rule 36 of the Trade Marks Rules, 2017, requesting for a reasoned statement for the impugned decision of the Respondent. The said

request was filed on 05th April, 2022. It is specifically stated that till date, there is no response from the Respondent as regards the aforesaid request made under the relevant Rules.

8. This Court is convinced that the Respondent erred in not considering the said aspect of the matter, pertaining to the claim of the Petitioner that the services provided by the entity having registration for an identical mark, are distinct from the services provided by the Petitioner under the same class. This aspect finds no mention in the impugned order and in fact an emphatic finding is recorded that there is similarity of services. Instead of this Court applying its mind for the first time on the said aspect of the matter, the Respondent being the original authority ought take a decision in the matter. The Petitioner has already placed on record material in its response to the examination report, which can be taken into consideration by the Respondent. Additionally, the Petitioner can be permitted to place on record written submissions and relevant material, so that the Respondent can decide the matter with a detailed reasoned order, at the earliest.

9. In view of the above, the petition is partly allowed. The impugned order dated 20th January, 2022, is quashed and set aside. The matter is remanded to the Respondent for reconsideration.

10. The Respondent is specifically directed to consider the material already placed on record by the Petitioner in support of its contentions. Additionally, the Petitioner is permitted to place on record written submissions with the relevant material before the Respondent within two weeks of appearance. The Respondent – Registrar of Trade Marks is expected to take a final decision in the matter within four weeks thereafter.

11. In view of the above, the Petitioner shall appear before the Respondent – Registrar of Trade Marks on 10th April, 2023.

12. The written submissions along with relevant material, if any, shall be placed on record before the Respondent within a period of two weeks of 10th April, 2023.

13. The Respondent shall pass final order in the matter within a period of six weeks of 10th April, 2023. The Respondent is expected to pass a detailed order, considering the issues raised by the Petitioner in support of its application.

14. The petition stands disposed of.

(MANISH PITALE, J.)