

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

COMMERCIAL MISCELLANEOUS PETITION NO. 1246 OF 2022

Methodical Mind LLC

...Petitioner

Versus

The Registrar of Trade Marks & Anr.

...Respondents

- Mr. Amit Jamsandekar and Ms. Archita Gharat i/by Sunil N. Nair, for the Petitioner.
- Mr. Advait M. Sethna, Ashutosh Mishra and Rangan Majumdar i/by A.A. Ansari, for the Respondents.

CORAM : MANISH PITALE, J

DATE : 11th APRIL, 2023.

P. C. :

1. Heard, learned Counsel for the parties.
2. The present petition challenges order dated 23rd July, 2021, passed by the Respondent No. 1 – Registrar of Trade Marks, whereby registration of the trademark of the Petitioner “ProductLink” has been refused by invoking Section 9(1)(a) and (b) of the Trade Marks Act, 1999.
3. Since the Respondents were served by way of private service, they have appeared through Counsel and the petition is taken up for hearing.
4. The learned Counsel appearing for the Petitioner submits that in the present case the application for registration of trademark

SHRIKANT
SHRINIVAS
MALANI

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SHRIKANT
SHRINIVAS MALANI
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“ProductLink” of the Petitioner was placed for consideration before the Respondents under the Madrid Protocol. It is submitted that the said trademark enjoys protection in international jurisdictions, including Australia, Canada, China, European Union, Great Britain etc. It is submitted that the aforesaid material was placed before the Respondents, in order to support the application for grant of registration of the said trademark in the context of goods under class 9 and Services under class 42.

5. It is brought to the notice of this Court that the Respondents prepared an examination report, indicating that the application of the Petitioner was liable to be refused under Section 9(1)(a) of the said Act, for being non distinctive and not being capable of distinguishing the goods and services of one person from those of the others.

6. The Petitioner responded to the aforesaid examination report and asserted its claim by relying upon case laws, to claim that the objection under Section 9 (1) (a) of the said Act, ought to be waived. Thereupon, the impugned order came to be passed on 23rd July, 2021, refusing the application submitted on behalf of the Petitioner.

7. The learned Counsel for the Petitioner submitted that a

bare perusal of the impugned order would show that it contains no reasons and mechanically reproduces the statutory provision. It is further submitted that while the examination report indicated that the application for registration of the Petitioner was liable to be refused under Section 9(1)(a) of the said Act, in the impugned order, Section 9(1)(b) was invoked without any opportunity to the Petitioner to respond to such objection. It was submitted that since the Petitioner enjoys registration and protection in various international jurisdictions, the said factor ought to have been at least considered and discussed by the Respondents before passing the impugned order. On this basis, it was submitted that the impugned order deserves to be set aside.

8. On the other hand, learned Counsel appearing for the Respondents submitted that when the material available on record indicated that Section 9(1) (a) and (b) could be invoked for refusal of the application for registration of trademark, the Respondents were well within their authority to pass the impugned order.

9. This Court has considered the material on record. In paragraph no. 5 of the petition, the Petitioner has specifically pleaded as follows :

“5. The Petitioner has applied for registration for the trademark “ProductLink” in a number of countries.

In this respect, the trademark was first filed in the country of origin namely, in USA under No. 88743220 on December 31, 2019. Thereafter, the Petitioner filed the subject International Registration through the Madrid Protocol, in which India was one of the designated countries. The International registration for the trademark subsists under registration no. 1563357 in classes 9 and 42 designating countries - Australia, Canada, China, European Union, Japan, Great Britain, India, Switzerland. Hereto annexed and marked as **EXHIBIT "B"** are the extracts from WIPO, USPTO, EU, Australia, Japan and Canada. The mark has been granted protection in EU and the United Kingdom and published in Australia and United States of America."

10. The said assertion is supported by documents placed at Exhibit "B". Apart from this, the material on record also indicates that the Petitioner, on 08th February, 2021, placed its detail response to the examination report before the Respondents. This included reference to case laws in support of its claim. A perusal of the examination report also shows that only section 9(1)(a) was invoked as a ground for possible refusal of the application filed by the Petitioner. There was no reference to the Section 9(1)(b) of the said Act.

11. But, a perusal of the impugned order shows that, firstly,

there are absolutely no reasons contained in the same and the statutory provision i.e. Section 9(1)(a) and (b) appear to be mechanically reproduced, while refusing the application of the Petitioner. In fact, Section 9(1)(b) has not even been properly reproduced in the impugned order. This shows non application of the mind on the part of the Respondents.

12. Apart from this, the aspect of the Petitioner having registration of the said trademark in various international jurisdictions has not been considered in the impugned order. There is no reference to the said material. The Respondent has also not discussed the case laws upon which the Petitioner had placed reliance. The least that was expected from the Respondents was consideration, discussion and proper disposal of the claims made on behalf of the Petitioner in the application for registration of the trademark "ProductLink".

13. It is also interesting to note that the very same authority has accepted an application of the Petitioner for registration of its mark "Instrumental Link". This indicates that in the present case the Respondents have failed to undertake proper exercise of considering the material on record before recording findings on the claims made on behalf of the Petitioner. The impugned order is found to be unsustainable.

14. In view of the above, the petition is partly allowed. The impugned order dated 23rd July, 2021, is quashed and set aside. The matter is remanded to the Respondent No. 1 for consideration afresh. The Petitioner is directed to remain present before the Respondent No. 1 on 25th April, 2023. Issuance of fresh notice by Respondent No. 1 is dispensed with.

15. The Petitioner is granted liberty to place fresh material, if any, before the Respondent No. 1, within two weeks from 25th April, 2023. The Respondent No. 1 is directed to pass final order, pursuant to remand, within six weeks from 25th April, 2023. It is expected that Respondent No. 1 will deal with the material and contentions placed on record on behalf of the Petitioner and to pass a well reasoned order, while deciding the application for registration filed on behalf of the Petitioner.

16. The petition stand disposed of in above terms.

(MANISH PITALE, J.)