

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
COMMERCIAL MISCELLANEOUS PETITION NO. 204 OF 2022**

HDFC Bank Limited	...	Petitioner
vs.		
The Registrar of Trade Marks	...	Respondent

Mr. Rohan Savant, Ms. Poonam Teddu and Mr. Kaivalya M. Shetye, i/by. Mahesh Mahadgut for petitioner.

Mr. Ashutosh Misra, i/by. A. A. Ansari for respondent.

**CORAM : MANISH PITALE, J
DATE : 13th APRIL, 2023**

P.C. :

1. Heard learned counsel for the petitioner. By this petition, the petitioner has challenged order dated 30th March, 2021, passed by the respondent-Registrar of Trade Marks, whereby an application for registration of trade mark SMART ACCOUNT of the petitioner was refused by invoking Section 9(1)(b) of the Trade Marks Act, 1999.

2. The sole respondent was served and has appeared through counsel.

3. The learned counsel appearing for the petitioner invited attention to the impugned order dated 30th March, 2021 and submitted that the order does not divulge any reasons for refusing the application, other than quoting the language of the relevant statutory provision i.e. Section 9(1)(b) of the aforesaid Act, which pertains to one of the absolute grounds for refusal. According to the petitioner, in the light of the material placed on record on behalf of the petitioner and the response to the examination report, the

respondent was expected to pass a detailed order, while disposing of the application for registration filed on behalf of the petitioner.

4. It was submitted that the respondent failed to appreciate the entirety of the mark for which, the petitioner was seeking registration. It was emphasized that apart from the words SMART ACCOUNT, the proposed mark included a logo for which, the petitioner has separate registration. It is further submitted that on earlier occasions, the Registrar of Trade Marks had granted registrations to certain marks of the petitioner, which included the word SMART, in conjunction with other words. On this basis, it is submitted that the respondent could not have invoked Section 9(1)(b) of the said Act, which pertains to an absolute ground for refusal of registration of trade mark, which consists exclusively of marks or indications, that may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics thereof. It was submitted that therefore, the impugned order deserves to be set aside.

5. The learned counsel for the respondent submitted that the respondent passed the impugned order after taking into consideration, the material on record and invoking the appropriate provision of the said Act and therefore, interference is not warranted.

6. This Court has perused the impugned order and the material placed on record, in the backdrop of the submissions made on behalf of the rival parties.

7. The material on record shows that in the examination report, the respondent had indicated that the application for registration of trade mark SMART ACCOUNT filed on behalf of the petitioner, was liable to be refused on the basis of objections pertaining to Section 9(1)(b) and 11(1) of the said Act. It is submitted that the petitioner had filed reply to the examination report, dealing with the objections pertaining to the said provisions. It appears that the respondent accepted the contentions of the petitioner, insofar as the objection pertaining to Section 11(1) of the said Act is concerned, but the contention pertaining to Section 9(1)(b) of the said Act appears to have been rejected, leading to refusal of the application.

8. This Court is of the opinion that the respondent was expected to pass a reasoned order, indicating the grounds, on which the objections under Section 9(1)(b) of the said Act could be sustained, particularly in the light of the specific explanation and contentions raised on behalf of the petitioner in that regard.

9. This Court finds that the petitioner indeed has registration independently, for the logo, which is used in conjunction with the words SMART ACCOUNT in the trade mark, of which the registration is sought in the present case. The material placed on record also indicates that on earlier occasions, registrations have been granted to the petitioner, in the context of trade marks like SMART BUY, SMART HUB, in conjunction with the said logo, for which the petitioner has registrations. These aspects ought to have been considered and discussed by the respondent, before disposing of the application filed by the petitioner.

10. The impugned order shows that no such exercise was undertaken and a cryptic order was passed, eventually refusing the application under the provisions of the Act, indicating non-application of mind on the part of the respondent.

11. In view of the above, the impugned order cannot be sustained. Accordingly, the petition is partly allowed and the impugned order is quashed and set aside. The respondent is directed to consider the application filed by the petitioner for the trade mark SMART ACCOUNT afresh.

12. Accordingly, the petitioner shall appear before the respondent on 27th April, 2023. The petitioner may file further material before the respondent to support its application, within two weeks from 27th April, 2023. The respondent shall dispose of the application of the petitioner within six weeks from 27th April, 2023.

13. The respondent is expected to pass a detailed well-reasoned order, while dealing with the contentions raised on behalf of the petitioner. Needless to say, this Court has not expressed any opinion on the merits of the matter.

(MANISH PITALE, J)

Priya Kambl

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