

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

COMMERCIAL MISCELLANEOUS PETITION NO. 3 OF 2021

HDFC Bank Limited

...Petitioner

Versus

The Registrar of Trad Marks

...Respondent

- Mr. Rohan Savant and Mr. Kaivalya Shetye i/by Mahesh Mahadgut, for Petitioner.

CORAM : MANISH PITALE, J

DATE : 27th MARCH, 2023.

P. C. :

1. Heard, learned Counsel for the Petitioner.
2. By this petition, the Petitioner has challenged order dated 04th June, 2021, passed by the Respondent i.e. the Registrar of Trade Marks, Mumbai, whereby an application for registration of the trademark (device mark) of the Petitioner "MILLENNIA" was refused under Section 11 of the Trade Marks Act, 1999.
3. It is the specific case of the Petitioner that the reason recorded in the impugned order while refusing the registration to the trademark of the Petitioner is not borne out by the material on record and that the Respondent failed to appreciate the material relied upon by the Petitioner.
4. On 20th February, 2023, this Court issued notice for final

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disposal. The service report shows that the Respondent has been served. There is no appearance on behalf of the Respondent.

5. The learned Counsel for the Petitioner submitted that in the present case, the only reason for refusing registration of the trademark of the Petitioner was that according to the Respondent, the trademark of the Petitioner was found to be similar to a trademark registered earlier for similar services, thereby leading to the conclusion that there was likelihood of confusion in the public if the application of the petitioner was to be granted.

6. It was submitted that the said reason was not justified. The learned Counsel for the Petitioner placed emphasis on the facts placed before the Respondent, while it was considering the application of the Petitioner and passed the impugned order, on 23rd May, 2019. The Petitioner had sought correction/amendment of its application, specifically seeking deletion of services pertaining to insurance and financial affairs, monetary affairs etc. and the Petitioner had specified the services, post such amendment, for which it was seeking registration of the said trademark.

7. The learned Counsel for the Petitioner submitted that the Respondent failed to appreciate the said aspect of the matter, while wrongly holding that the services in respect of which the Petitioner

was seeking registration of the trademark were similar to the services rendered by the entity using the earlier registered trademark "MILLENNIA". Apart from this, it was submitted that the two marks being device marks, the Registrar could not have reached the conclusion that there was similarity between the two marks. It was emphasized that the earlier registered trademark was a device mark accompanied with a logo and it was clearly distinguishable from the trademark in respect of which the Petitioner was seeking registration. On this basis, it was submitted that the impugned order deserved to be set aside.

8. The learned Counsel for the Petitioner further placed reliance on judgment of this Court, in the case of *Central Camera Co. Private Ltd. Vs. The Registrar of Trade Marks*¹, to contend that this Court had found it desirable that the mark is advertised and opposition is invited so that multiplicity of litigation could be avoided and by relying upon the said judgment, the learned Counsel for the Petitioner submitted that this Court may consider directing the Respondent to first accept the mark and proceed to advertise the same.

9. The learned Counsel for the petitioner also relied upon judgment of this Court in the case of *M/s. R.T. Engineering and*

¹ 1980 SCC OnLine Bom 18

*Electronics Co.*², to contend that this Court may consider directing the Respondent to advertise the mark and call for opposition even before accepting the application for registration submitted by the Petitioner.

10. This Court has considered the aforementioned judgments upon which the learned Counsel for the Petitioner has placed reliance, but it would be appropriate to consider the contents of the impugned order, in order to examine as to the manner in which the present petition can be disposed of and the nature of directions that can be issued to the Respondent.

11. A perusal of the impugned order shows that the Respondent has refused the registration of the trademark (device mark) of the Petitioner “MILLENNIA”, primarily on the ground that it is likely to lead to confusion, due to the fact that there is already a trademark (device mark) “MILLENNIA” registered in respect of insurance services and financial monetary affairs.

12. This Court has considered the registered trademark, which has been referred to by the Respondent. Although, both the trademarks in question in the present case are device marks, this Court is not inclined to accept the contention raised by the Petitioner that the two marks being device marks are so distinct and distinguishable that the Registrar could not have indicated that there

² 1970 SCC OnLine Bom 48

was similarity between the two marks. This Court is not inclined to say anything further on that aspect of the matter,

13. But, nonetheless, the Registrar appears to have fallen in error in completely ignoring the fact that the Petitioner itself had applied for correction/amendment of its application for registration of the said trademark by specifically deleting certain services, including insurance and financial affairs, monetary affairs etc. In fact, the request made on behalf of the Petitioner in the application moved before the Respondent on 23rd May, 2019, reads as follows :

Request	CORRECTION OF CLERICAL ERROR; OR FOR AMENDMENT U/R 37
Details of corrections	Hereby request to delete “Insurance; financial affairs; monetary affairs; real estate affairs; banking; exchanging money; financial management and consultancy; providing financial affairs; banking affairs, monetary affairs including through telecommunication networks namely wireless, satellite, cable, internet; mobile phone banking services; insurance consultancy; insurance information; financial analysis; financial consultancy; financial evaluation; brokerage; electronic funds transfer; loans; mortgage banking; mutual funds; safe deposit services; securities brokerage; stocks and bonds brokerage; money exchange; from the specification of services, as directed by the Examiner of Trade Marks. After the said amendment, the specification of services will be as follows : “payment gateway services; financial transfers, transactions and payment services including through telecommunication networks, namely wireless, satellite,

	cable, internet; electronic funds transfer; online banking; processing of credit and debit card payments; banking services including through electronic devices, channels and modes including television, telephones, mobile phones and/or electronic devices, apparatus, instruments; credit and services; debit card services.” We also enclose herewith a copy of the General Power of Attorney as executed by the Applicant in our favour.
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14. A perusal of the above quoted portion shows that, not only did the Petitioner seek deletion of specified services from its application, but it also specified services for which it was seeking registration of the said trademark. The said services, *inter alia*, include payment gateway services, financial services, transaction and payment services etc.

15. The said request made on behalf of the Petitioner clearly demonstrated its intention to seek registration for specified services and that the Respondent was expected to examine the application of the petitioner in the light of such a specific request placed on record. The Registrar was expected to pass a reasoned order as to why the application of the Petitioner could be rejected, even though it had now limited its application for registration for specified services. The Respondent was expected to compare such services with the services offered by the entity holding the earlier registration and then come to a reasoned conclusion either way in the matter. No such exercise

appears to have been carried out in the impugned order dated 14th June, 2022. Apart from this, there is no application of mind on the part of the Respondent, on the aspect as to whether the two marks could be said to be similar, considering the fact that both the marks are device marks.

16. It is further relevant that the Petitioner had submitted reply to the examination report before the Respondent, in support of its application for registration of the said trademark. But, there is no reference to the contentions raised therein while passing the impugned order. This further indicates that the Respondent appears to have passed the impugned in a mechanical manner, without proper application of mind.

17. As regards reliance placed on the aforementioned judgments in the case of *M/s. R.T. Engineering and Electronics Co. (supra)* and *Central Camera Co. Private Ltd. Vs. The Registrar of Trade Marks (supra)*, in the facts of the present case, this Court is of the opinion that although the impugned order deserves to be set aside, the course of action to be followed by the Registrar can be left open i.e. as to whether the mark has to be accepted and advertised or advertised even before accepting the same. It would be appropriate that the matter is remanded to the Respondent for properly considering the aforesaid aspects of the matter, particularly the

services to which the Petitioner restricted its application seeking registration in respect of the said trademark. It would be appropriate that the Petitioner is granted further opportunity to place on record material to support its contention that, notwithstanding the existence of the said registered trademark (device mark), its application deserves to be granted.

18. In the light of the above, the impugned order dated 04th June, 2021, passed by the Respondent is quashed and set aside. The present petition is partly allowed to that extent. The matter is now remanded to the Respondent for consideration afresh.

19. The Petitioner shall appear before the Respondent on 10th April, 2023. Issuance of notice by the Respondent is dispensed with. The Petitioner is granted liberty to place a copy of the order passed by this Court before the Respondent for further action in the matter. The Petitioner is granted permission to place on record before the Respondent an additional affidavit along with relevant documents, to support its application for registration of the said trademark, within two weeks of 10th April, 2023. The Registrar is directed to dispose of the said application of the Petitioner, within six weeks from 10th April, 2023.

(MANISH PITALE, J.)