

jsn

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

COMM MISCELLANEOUS PETITION NO.19 OF 2023

Mitsubishi Materials Corporation

...Petitioner

Versus

The Senior Examiner of Trade Marks

...Respondent

Aditya Mahadevia with Karan Khiani i/b. Rashmi Singh for the
Petitioner.

Pranav Thakur for the Respondent.

CORAM : R.I. CHAGLA J

DATE : 14 JUNE 2023

ORDER :

1. By this Commercial Miscellaneous Petition the Petitioner is seeking quashing and setting aside of the Respondent's Order dated 2nd September, 2021 which holds that the applied mark is not registrable.

2. The learned Counsel appearing for the Petitioner has submitted that the impugned Order refers to Section 9(1) (a) and

9(1) (b) of the Trade Marks Act, 1999 and holds that the mark applied for registration is objectionable under these provisions. However, no opportunity was granted to the Petitioner to make submissions on the objection under Section 9(1) (b) as this objection was never raised prior to the passing of the impugned Order. This is evident from the Notification of Provisional Refusal of Protection of an International Registration Designating India under Rule 17(1) of the Common Regulations issued by the Trade Marks Registry, where objection in relation to the applied mark was raised only under Section 9(1) (a) of the Trade Marks Act, 1999. He has submitted that in view of the no opportunity being granted to the Petitioner to meet the objection under Section 9(1) (b) of the Trade Marks Act, 1999, the impugned order be set aside. He has further submitted that the impugned order is a non reasoned order as it fails to consider submissions of the Petitioner under Section 9(a) (a) of the Trade Marks Act, 1999.

3. The learned Counsel appearing for the Respondent – Trade Marks has placed reliance upon the impugned Order and submitted that in view of the objections raised by the Respondent under Section 9(1) (a) and 9(1) (b) of the Trade Marks Act, which

was after perusal of documents on record and submission made, the finding was arrived at that the applied mark was not registerable due to these objections. Hence, the application of the Petitioner was not accepted.

4. Having considered the submissions, I am of the view that the impugned order fails to make reference to the submissions of the Petitioner and / or authorities relied upon. Thus, there is no consideration of the submissions and / or independent application of mind on the part of the Senior Examiner of Trade Marks other than by referring to Sections 9(1) (a) and 9(1) (b) of the Trade Marks Act, 1999. Further, there is no opportunity given to the Petitioner to deal with the objection under Section 9(1) (b) of the Act as this objection was not raised in the aforementioned Notification of Provisional Refusal of Protection of an International Registration pertaining to the applied for mark. The Senior Examiner of Trade Marks has for the first time in the impugned order referred to the objection under Section 9(1) (b) of the Trade Marks Act. Accordingly, in my view, there has been non-conformity with the principal of natural justice and in view of which apart from the aforementioned findings, the impugned order requires to be set aside.

5. In view thereof, the following order is passed :-

(i) The impugned order dated 2nd September, 2021 is set aside and remanded back to the Respondent for fresh consideration of the submissions and / or material relied upon by the Petitioner as well as giving the Petitioner an opportunity to deal with the objection under Section 9(1) (b) of the Trade Marks Act, 1999 and thereafter a reasoned order. This exercise shall be completed within a period of eight weeks from the date of this Order.

6. The Commercial Miscellaneous Petition is accordingly disposed of.

[R.I. CHAGLA J.]