

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
COMMERCIAL MISCELLANEOUS PETITION NO. 10 OF 2022**

BB IPR Limited	...	Petitioner
vs.		
The Registrar of Trademarks	...	Respondent

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

Mr. Abhishek Bhadang, i/by. Anusha P. Amin for respondent.

**CORAM : MANISH PITALE, J
DATE : 30th MARCH, 2023**

P.C. :

. Heard learned counsel for the parties.

2. By the impugned order dated 22nd December, 2020, the respondent i.e. Registrar of Trademarks at Mumbai, has refused the application for registration of trade mark VITAL BABY, filed by the petitioner for registration of its trade mark in class 5 on proposed to be used basis.

3. The application was filed on 9th August, 2019. The material on record shows that as per the examination report, it was found that the said trade mark was open for objection, for the reason that there were a number of identical/similar earlier marks found on the Register. Reference was made to some such identical/similar marks.

4. In response to the examination report dated 6th September, 2019, the petitioner filed a detailed objection, giving a list of number of registered trade marks. A reference was also made to case law to support the case of

the petitioner. It was specifically submitted on behalf of the petitioner that in light of the said material brought to the notice of the respondent, objection raised under Section 11(1) of the said Act ought not to be a ground for refusal to register the said trade mark.

5. Considering the detailed material placed on record, the respondent was expected to discuss/deliberate and render findings on the specific contentions on facts and law raised on behalf of the petitioner.

6. But, a perusal of the impugned order shows that it is cryptic and the application of the petitioner has been refused in one short paragraph, which reads as follows:

‘The mark applied for registration is identical with/similar to earlier trademarks 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.’

7. This Court had issued notice for final disposal of the present petition. The respondent has appeared through counsel.

8. The learned counsel for the respondent sought to justify the impugned order passed by the respondent, by stating that the examination report sufficiently demonstrates that there are already identical/similar trade marks on the Register and that there is every likelihood of confusion being caused in the mind of consumers. It was sought to be emphasized that since the trade mark is applied for under class 5, pertaining to pharmaceutical and medicinal preparation, any such confusion in the mind of consumers can

have drastic consequences.

9. This Court has considered the contentions raised on behalf of the petitioner as well as respondent. The impugned order is not just cryptic, but wholly unsatisfactory, as regards dealing with the grounds raised by the petitioner. A perusal of the response/objection dated 6th September, 2019, placed on record on behalf of the petitioner before the respondent, would show that detailed material was placed on record, to indicate that there was no question of refusal of the registration of the trade mark of the petitioner, only because the word 'Vital' was an integral part of other trade marks. It was placed on record before the respondent that a number of registered trade marks had different words prefixed and suffixed to the word 'Vital' and use of the word 'Vital' as a part of the trade mark of the petitioner could not, in itself, be a ground for refusal.

10. This Court is of the opinion that when the petitioner had placed on record such material and also referred to case law in support of its contentions, the least that was expected from the respondent was to discuss, deliberate and render specific findings on the contentions raised on behalf of the petitioner. The impugned order shows that no such exercise was undertaken on behalf of the respondent. On this ground itself, the impugned order deserves to be set aside. It would be appropriate if the respondent appreciates the material on record and renders specific findings after considering the material placed on record on behalf of the petitioner.

11. In view of the above, the petition is partly allowed. The impugned order is quashed and set aside. The matter is remanded back to the respondent for deciding afresh.

12. Issuance of fresh notice is dispensed with and the petitioner is directed to appear before the respondent on 12th April, 2023.

13. The petitioner is at liberty to place on record further material to support its contentions. Such material shall be placed before the respondent within two weeks from 12th April, 2023.

14. The respondent shall decide the application of the petitioner within six weeks from 12th April, 2023.

15. The petition stands disposed of.

(MANISH PITALE, J)

Priya Kambli

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