

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

COMMERCIAL MISCELLANEOUS PETITION NO. 1244 OF 2022

Arjo IP Holdings AB

...Petitioner

Versus

The Registrar of Trade Marks

...Respondent

* * *

- Mr. Nitin Masilamni, for Petitioner.
- Mr. R.V. Govilkar and Ms. Shaba N. Khan, for Respondent.

* * *

CORAM : MANISH PITALE, J

DATE : 09th JANUARY, 2023.

P. C. :

1. Heard, learned Counsel for the parties.

2. By this petition the Petitioner has challenged order dated 21st September, 2021, passed by the Respondent Authority, whereby application for registration of Trade Mark "ARJO-GUARD" has not been accepted and it has been refused by invoking Section 11(1) of the Trade Marks Act, 1999.

3. Mr. Nitin Masilamni, learned Counsel appearing for the Petitioner vehemently submitted that the impugned order is unsustainable, for the reason that in the light of the settled position of law and failure on the part of the Respondent to consider the mark in respect of which the application was made, as a whole, that invoking of Section 11(1) and the refusal of the application is rendered unsustainable. It is submitted that the Respondent was not justified

in referring to applications made in respect of the trademark ARJOI and holding that there was likelihood of confusion amongst the public /probable consumers.

4. The learned Counsel for the Petitioner specifically relied upon detailed submissions dated 26th February, 2021, placed on record before the Respondent, in support of the application, which emphasized upon necessity to consider the proposed mark as a whole and reliance was placed on case law and precedents. It was submitted that the detailed submissions were not taken into consideration by the Respondent while passing the impugned order.

5. Attention of this Court was also invited to the contents of the present petition, wherein reference is made to the registrations already obtained by the Petitioner in respect of the said mark in various countries.

6. On the other hand Mr. Govilkar, learned Counsel appearing for the Respondent submitted that if this Court was of the opinion that the impugned order was cryptic and a detailed order ought to be passed, this Court may issue appropriate directions. None the less it was submitted that in the facts of the present case, Section 11(1) was correctly invoked by the Respondent while refusing the application submitted on behalf of the Petitioner.

7. This Court has considered the impugned order. A perusal of the same shows that the application for registration of the trademark ARJO-GUARD filed on behalf of the Petitioner has been refused by invoking Section 11(1) of the said Act. The reasoning of the Respondent in the impugned order is as follows :

“The mark applied for registration is identical with/ similar to earlier trademarks on records, 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.

Ld. Advocate referred NOC dated 09.02.2021 from the proprietor of cited mark 3630086 in provisional refusal. However, the other cited marks 4601765, 4601767 are considered as considered as identical/similar having similar goods. The same are likely to cause confusion among public / probable consumers.”

8. A perusal of the above quoted portion of the impugned order shows that the Respondent appears to have virtually quoted the statutory provision while refusing the application filed on behalf of the Petitioner. There is no further reasoning, much less consideration of the detailed submissions dated 26th February, 2021, submitted on behalf of the Petitioner, wherein reliance was also placed on case law.

9. This Court is of the opinion that the specific contentions raised on behalf of the Petitioner in the submissions dated 26th February, 2021, including the necessity of consideration of the mark as a whole, along with case law relied upon by the Petitioner ought to have been considered in detail and a proper reasoned order ought to have been passed by the Respondent, in the facts and circumstances of the present case.

10. This Court is of the opinion that the impugned order is cryptic and without detailed reasons, although the contention raised on behalf of the petitioner warranted a reasoned order, upon consideration of various contentions raised on behalf of the Petitioner on merits.

11. Therefore, this Court is convinced that the impugned order cannot be sustained and that at the same time the matter deserves to be remanded to the Respondent for proper consideration and disposal in accordance with law.

12. In view of the above, impugned order is set aside. The matter is remanded to the Respondent i.e. Registrar of Trade Marks to be decided afresh. The Petitioner shall appear before the Respondent i.e. Registrar of Trade Marks on 27th January, 2023. The Petitioner would be at liberty to file additional submissions and case

laws upon which the Petitioner may rely, within two weeks of appearance before the Respondent.

13. The Respondent is directed to consider the contentions raised on behalf of the Petitioner in the light of the aforementioned submissions dated 26th February, 2021, already filed on behalf of the Petitioner and further submissions along with case laws that the Petitioner may submit before the Respondent. The Respondent shall consider the aforesaid material and pass a detailed order with reasons, within six weeks of the appearance of the Petitioner before the said Respondent i.e. within six weeks of 27th January, 2023.

14. In view of the fact that this Court has directed the Petitioner to appear before the Respondent on 27th January, 2023, the necessity of issuing notice for hearing is dispensed with.

15. It is made clear that this Court has not expressed any opinion on the merits of the matter.

16. The petition stands disposed of in above terms.

(MANISH PITALE, J.)