

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

COMMERCIAL MISCELLANEOUS PETITION NO. 23 OF 2023

Volocopter GMBH ... Petitioner

Versus

The Senior Examiner of Trade Marks, Mumbai ... Respondent

Mr. Karan Khiani a/w Aditya Mahadevia i/b Rashmi Singh for the Petitioner.

A.M. Sethana a/w Pranil Sonawane a/w Siddhantrao Molankar for the Respondent.

CORAM : R.I. CHAGLA, J.

DATED : 21st JUNE, 2023.

ORDER :

1 By this Commercial Miscellaneous Petition the Petitioner is seeking setting aside of the order dated 18.09.2021 passed by the Respondent.

2 Mr. Karan Khiani, the learned Counsel for the Petitioner has submitted that the impugned order fails to consider the submissions and/or material furnished by the Petitioner in their response dated 19.10.2020. The impugned order merely refers to cited marks 3786222, 4086568, 4309445 and has held that cited marks in provisional refusal

are considered as identical/similar having similar goods/services and the same are likely to cause confusion among public/probable consumers.

3 Mr. Khiani has submitted that the Petitioner in their response had submitted that the applied for mark VOLOCITY is an extremely innovative and creative coinage, which is novel to the Applicants and hence to be considered distinctively. Another submission made in the response is that out of the cited marks relied upon by the Respondent, two of the cited marks namely 3786222 and 4309445 are still under opposition. The third cited mark 4086568 registered is for motor vehicles namely automobiles and their structural parts whereas the applied for mark is in respect of completely specific goods of evidently different nature than those covered under cited marks. The applied for mark of the Petitioner are for goods, namely Aerodynamic fairings for aircraft; aerodynamic attachments for vehicle aircraft bodies; aerodynamic wings for airplanes; aerofoils for air vehicles; aeronautical apparatus, machines and appliances etc. as mentioned in the application for registration at Exhibit-C to the Petition.

4 Thus, the applied for mark is for goods though falling under class 12 as in the case of the cited mark 4086568, they are for specific goods as aforementioned. He has submitted that this should have been

considered by the Respondent while arriving at the finding that the registration of the applied mark is objectionable under Section 11(1) of the Trade Marks Act, 1999.

5 Mr. Sethana, learned Counsel appearing for the Respondent has supported the impugned order. He has submitted that there are reasons given in the impugned order for arriving at the finding that the applied mark is not registerable. He has referred to Section 11(1) of the Trade Marks Act, 1999 which provides for ground of registration and where registration will be refused particularly where the identity of the trade mark is for similar goods or services as that of an earlier trade mark. He has submitted that the finding arrived at by the Respondent is justifiable in view of the cited marks being for being for similar goods/services and where the mark is “VELOCITY” which is deceptively similar to ‘VOLOCITY’ i.e. the applied mark. Hence, the same is likely to cause confusion amongst public/consumers and thus not registerable.

6 Mr. Sethana has referred to a decision of the Delhi High Court in *Imagine Marketing Pvt. Ltd. vs. Exotic Mile* (MANU/DE/0162/2020 which has referred to *Encore Electronics Limited vs. Anchor Electronics and Electricals Private Limited* wherein the Delhi High Court had found phonetic similarity between ‘Anchor’ on the one hand and

‘Encore’ on the other, and held that the two marks are phonetically, visually and structurally similar. The said decision held that the Court must assess the make up of an Indian consumer and, associated with that, the cultural traits that underlie the spelling and pronunciation of words. One must not look at the manner in which these words are pronounced by an Englishman or Frenchman. The Court must consider the usage of words in India and the manner in which the words would be written in Indian languages and last but not least, the similarity of pronunciation if the rival marks were to be pronounced in languages prevalent in the Country where the marks are used. He has submitted that in the present case there is no manner of doubt that the applied for mark “VOLOCITY” is phonetically, visually and structurally similar to the cited marks “VELOCITY”. Thus, the reason given by the Respondent for finding that the applied mark is not registerable in view of the applied mark likely to cause confusion amongst public/consumers is a proper reason and the impugned order is required to be upheld.

7 Having considered the rival submissions, in my view the Respondent was required to consider the submissions of the Petitioner as to the Petitioner’s adoption of the applied for mark “VOLOCITY” and that whether the applied for mark is not an ordinary mark but an innovative and creative coinage, which is arbitrary and novel to the Applicants and

hence to be considered distinctive. Further, the Respondent was excepted to consider that two of the three cited marks were under opposition and one of the cited marks which had been registered was for motor vehicles namely automobiles and their structural parts which was different for the goods of the Petitioner in respect of which the mark was applied for. Another factor which was required to be considered by the Respondent is that one of the cited marks namely 3786222 being the mark 'VELOCITY' had been accepted and advertised and only thereafter there was opposition to the mark. This required relevant consideration as said cited mark fell within Class 12 for locomotion by land, air or water. Thus, there was similarity of goods viz. for air as that of the Petitioner's goods for which the mark is applied for. Similar treatment may have been required to be given to the Petitioner's applied for mark.

8 Having perused the impugned order, it does appear that the reasons are insufficient and there should have been a more elaborate consideration of the submissions of the Petitioner and findings on the submissions which have been referred to herein above. The Senior Examiner of Trade Marks should have applied his independent mind to these submissions which were in the response dated 19.10.2020. Having failed to do so, the impugned order is unsustainable.

9 The provision of Section 11(1) of the Trade Marks Act, 1999 was not merely to be cited by the Senior Examiner of Trade Marks in the impugned order but there should have been consideration of this provision in light of the submissions of the Petitioner. The Petitioner had applied for their mark in respect of goods which were very specific in Class 12 and thus required to be considered in light of the cited marks, two out of three were of completely different nature and in respect of one, the cited mark had been accepted and advertised and then there was opposition.

10 In view thereof, the impugned order is set aside and the matter is remanded back to the Respondent for fresh consideration and hearing of the Petitioner as well as considering the submission and material on record which consideration should form part of the fresh order. This exercise shall be carried out within a period of 12 weeks from the date of this order.

11 The Commercial Miscellaneous Petition is accordingly disposed of.

(R.I. CHAGLA, J.)