



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 22.08.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/91/2023

(OA/19/2020/TM/CH)

M/s.VP Enterprises,  
A Partnership Firm,  
Represented by its Partner Mr.Pulipati Venkatesh,  
105/71, 1<sup>st</sup> Main, 4<sup>th</sup> Cross,  
Guru Raghavendra Layout, JP Nagar, 8<sup>th</sup> Phase,  
Bangalore 560 078, Karnataka, India.

... Appellant

-VS-

Assistant Registrar of Trade Marks,  
Intellectual Property Office,  
Intellectual Property Office Building,  
G.S.T.Road, Guindy, Chennai-600 032  
Tamil Nadu, India.

... Respondent

**PRAYER:** Transfer Civil Miscellaneous Appeal (Trademarks) filed under Section 91 of the Trademarks Act, 1999, prays that (a) the order of the Senior Examiner of Trade marks be dismissed and the Subject Trade Mark under Application Number 3894824 be allowed to proceed to registration.

For Appellant : Mr.B.Karthik



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For Respondent : Mr.P.G.Santhosh Kumar, SPC

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## **JUDGMENT**

The appellant had applied for the registration of the composite mark set out below:



In the application dated 19.07.2018, the appellant had stated that the mark was being used by the appellant or its predecessor-in-title since 02.06.2018 in relation to the provision of gym services and related sporting activities. Upon examination, the Registrar of Trade Marks raised an objection under Section 11(1) of the Trade Marks Act 1999 (The Trade Marks Act) by citing conflicting marks.



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2. In response to these objections, the appellant submitted a reply dated 25.08.2018 stating that the mark is unique and distinctive and that the cited marks are completely different from the appellant's mark. A personal hearing was provided and order dated 17.09.2019 was issued, without assigning reasons, rejecting the application under Section 11(1)(a) and 11(1)(b) of the Trade Marks Act. Hence this appeal.

3. Learned counsel for the appellant pointed out that the appellant had produced evidence of use of the mark from 02.06.2018 by placing on record invoices issued by the appellant in respect of club membership subscription. He pointed out that the said invoices contain the composite mark for which the application was submitted. He also referred to the advertisements posted on Facebook. In addition, learned counsel relied on the certificate of registration granted in respect of an identical device under Trademark No.3894825 with effect from 23.07.2018.



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4. As regards the allegedly conflicting marks, learned counsel contends that the first cited mark was not renewed after 2013. TM Application No.1698350 was withdrawn and TM Application Nos.2198253, 2927706 and 2927714 were abandoned. Even as regards the other cited marks, learned counsel contends that the composite mark of the appellant is clearly distinguishable from the said marks, the said marks were applied for in relation to dissimilar services and that the same is evident from the examination report.

5. In response, learned special panel counsel submits that the impugned order was issued in view of the existence of multiple marks which are deceptively similar to the mark for which the appellant applied for registration. Therefore, he submits that the impugned order does not call for interference.

6. The composite mark for which the appellant seeks registration contains a device of a silhouette of persons swimming,



working out and playing football. The words “LOTUS FITNESS” are found along with the said device. There is evidence of use of the mark from 02.06.2018 by way of invoices issued by the appellant. The registration certificate in relation to TM No.3894825 reveals that a mark containing an identical device (without the words “LOTUS FITNESS”) was registered in relation to the same services in favour of the appellant.

7. As correctly contended by learned counsel for the appellant, the marks cited in the examination report were not used by the respective applicant in relation to fitness services. Many of the cited marks were abandoned, withdrawn or the registration in relation thereto was not renewed. Even otherwise, when looked at as a whole, the composite mark of the appellant appears to be distinctive and distinguishable from the said marks.



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8. When all these facts and circumstances are considered holistically, the impugned order is unsustainable. These facts and circumstances also justify directing that the application be directed to proceed to advertisement. Consequently, (T)CMA(TM)/91/2023 is allowed by setting aside the impugned order and directing that the appellant's application should proceed to advertisement. Thereafter, the application may be dealt with in accordance with the Trade Marks Act and the rules framed thereunder. There shall be no order as to costs.

**22.08.2023**

Index : Yes / No  
Internet : Yes / No  
Neutral Citation : Yes/No  
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**SENTHILKUMAR RAMAMOORTHY,J**  
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**(T)CMA(TM)/91/2023**  
**(OA/19/2020/TM/CH)**

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