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(T)CMA(TM)/102/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 27.09.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/102/2023
(OA/42/2020/TM/CHN)

Mrs.Madhu Devi
Trading As: M/s.Hanuman Trading Company,
No.76/2, Narayana Mudali Street,
3rd Floor, Chennai - 600 079.

... Appellant

-vs-

The Registrar of Trade Marks,
Trade Marks Registry,
Chennai.

... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Trade Marks) filed under Sections 91, 92 of the Trade Marks Act, 1999, praying that an order setting aside the impugned dated 30th July 2019 passed by the Respondent of Trade Marks and to accept the mark for registration.



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For Appellant : Mr.N.C.Vishal
for M/s.Anand and Anand

For Respondent : Mr.N.Ramesh, SPC

ORDER

The appellant assails an order dated 30.07.2019 by which Application No.3247349 for registration of the following device mark



was refused.

2. The appellant states that it applied for registration of the device mark extracted above on 27.04.2016 by asserting continuous use since 01.05.2008 in relation to hand saws. By examination report dated 25.10.2016, the Registrar of Trade Marks raised objections under Section 11(1) of the Trade Marks Act, 1999 (the Trade Marks Act) by citing two marks. The appellant responded to the examination report on 27.01.2017 and pointed out that the goods to which the cited marks are applied are not similar. The appellant



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further submitted that the cited marks are phonetically, visually and structurally different from its marks. After a hearing on 15.04.2019, the impugned order was issued on 30.07.2019. Upon application, the grounds of decision were issued on 03.12.2020. Hence this appeal.

3. Learned counsel for the appellant submitted that the mark has been used by the appellant in relation to hand saws from 01.05.2008. In support of this contention, he places reliance on invoices issued by Royal International, the predecessor-in-interest of the appellant, from 31.10.2008 onwards. The relevant deed of assignment was also referred to. The next submission of learned counsel was that the impugned order is completely unreasoned and that it draws reference to both Sections 9 and 11 of the Trade Marks Act, whereas the examination report referred only to Section 11. He further submits that the grounds of decision were issued about 18 months later on 03.12.2020. With reference to the grounds of decision, he submits that the Registrar of Trade Marks recorded the



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patently erroneous conclusion that the appellant and the proprietors of the cited marks used the respective marks in respect of identical goods. He further submitted that the Registrar of Trade Marks recorded the conclusion that the adoption of the mark by the appellant is patently *mala fide* without any basis for such conclusion. He also pointed out that a substantially similar mark of the appellant was accepted for advertisement recently. Hence, he submits that the impugned order is liable to be set aside.

4. In response, Mr.N.Ramesh, learned SPC, submits that the application was rejected on account of the existence of prior marks in relation to goods under class 7. He further submits that the cited marks and the mark of the appellant are deceptively similar and that the rejection of the application is justified.

5. On examining the mark of the appellant, it is evident that it is a device mark. The said mark has been applied in relation to hand



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saws and the mark is not descriptive of the goods. The first cited mark is also a device mark. The said mark has been registered in relation to sewing machines and machines used in the garment industry. *Prima facie*, it appears that the goods to which the appellant applies its mark and the goods to which the proprietor of the first cited mark applies its mark are not identical or similar. Likewise, the second cited mark appears to be a word mark used in relation to soldering and casting machines. These goods also appear to be neither identical nor similar to the appellant's goods.

6. The appellant has placed on record evidence of use of the mark by its predecessor-in-interest from October 2008. The deed of assignment under which the mark was assigned to the appellant is on record. As is typical with orders of the Registrar of Trade Marks, the impugned order is completely unreasoned. It draws reference to Sections 9 and 11 of the Trade Marks Act although Section 9 was not referred to in the examination report. The grounds of decision were



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issued about 18 months after the impugned order was issued. Even without taking into account any other grounds, the impugned order calls for interference on this ground.

7. The grounds of decision, in relevant part, are as under:

"The entire documents are appreciated. From analyzing facts of the case, Counsel has not explained the genuine reasons for adopting the particular word as the trade mark by the applicant. The Tribunal is concluded that the applicant has failed to prove the continuous usage of the impugned trade mark from the date of adoption to 2019 by way of documentary evidences. Further, the impugned trade mark is phonetically and visually identical to the conflicting marks which is mentioned in the search report and also they are well in prior use in respect of the identical goods which sought by the applicant. The applicant is the well subsequent user among the conflicting marks user period. In view of these grounds, the Tribunal has opined that the applicant has deliberately chosen the



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subject mark in an effort to ride upon the goodwill and reputation of the conflicting marks. Applicant has no bona fide adoption of the subject mark in respect of the applied goods. Further, the allowance of the subject mark is patently mala fide since the mark has been dishonestly adopted by the applicant hence the applicant cannot claim to be the proprietor of the subject mark under Section 18(1) of the Act. Allowance of the subject mark is adversely affecting the interest of the public, it would lead to confusion as it is more than likely, due to imperfect recollection that the average buyer may confuse the applicant's mark 'GLOBAL' as the conflicting owners' goods under 'GLOBAL'. In view of such similarities between the nature of the marks and their goods, the applicant's trade channel and counters, there exists a strong likelihood of confusions on the part of the consuming public, including an association, as they are likely to assume and confuse that the applicant's goods are connected or otherwise associated with the conflicting marks goods, when no such connection exists.



Consequently, the members of the trade would no doubt, be under the mistaken belief that the applicant's goods originate from the conflicting marks or that they have some trade connection or affiliation thereby causing irreparable loss and damage not only to the conflicting marks trade and business but also suiting erosion of distinctiveness hard earned by the conflicting marks."

8. As is evident from the above, the following three conclusions were recorded and I also deal with the sustainability thereof:

(i) the goods to which the appellant applied its mark are identical to the goods to which the cited marks were applied. For reasons set out earlier, this conclusion is erroneous.

(ii) the adoption of the mark is patently *mala fide*. There is no basis whatsoever for entering such conclusion against the appellant.

(iii) the subject mark is not being accepted for general publication to avoid opposition to the registration and passing off action. These are clearly not relevant considerations while deciding



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an application for registration, which is required to be decided by applying Sections 9 and / or 11, as the case may be.

9. Therefore, the impugned order and the grounds of decision are set aside. By taking into account the following: the appellant's mark is used in relation to goods which do not appear to be similar to the goods to which the cited marks are applied; the appellant has provided evidence of use from October 2008 in the form of invoices; and a substantially similar mark of the appellant was accepted for advertisement recently, the application shall be accepted for advertisement. The appeal stands disposed of on the above terms by making it clear that the order shall not be binding on opponents, if any.

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SENTHILKUMAR RAMAMOORTHY,J

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