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(T)CMA(TM)/95/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 01.11.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/95/2023
(OA/24/2020/TM/CHN)

Smt.Shyla,
Trading as M/s.Mysore Bags & Tarpaulins,
No.84, Devaraj Urs Road,
Mysore - 570 001.

... Appellant

-vs-

The Registrar of Trade Marks,
The Trade Marks Registry,
Intellectual Property Building,
G.S.T.Road, Guindy,
Chennai - 600 032.

... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Trade Marks) filed under Section 91 of the Trade Marks Act, 1999, praying to set aside the order of refusal dated 02.04.2019 issued by the respondent in Application No.2781085 in Class 18 and consequently proceed with the application in the manner known to law.



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For Appellant : Mr.S.Diwakar
for M/s.Factum Law

For Respondent : Mr.N.Ramesh, SPC

ORDER

The appellant challenges an order dated 02.04.2019 by which Application No.2781085 for registration of the following device mark was refused.



2. The appellant applied for registration of the device mark extracted above on 25.07.2014 by asserting use since 26.05.2014. By examination report dated 29.02.2016, the Registrar of Trade Marks raised objections both under Sections 9 and 11 of the Trade Marks Act, 1999 (the Trade Marks Act). The objection under Section 9 was on the ground that the mark is a common surname / personal name



2. Learned counsel for the appellant invited my attention to the appellant's device mark and pointed out that the application was pursuant to order dated 16.04.2013 in Cont.P.Nos.366 and 367 of 2009. With reference to the said order, learned counsel pointed out that the contempt petition was disposed of by permitting the



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appellant herein to use the word "Mysore" at the bottom of the word "Sri Tarpaulins" provided the font size of "Mysore" is smaller than the word "Sri Tarpaulins". By turning to the mark cited in the search report annexed to the examination report, learned counsel pointed out that the cited mark is the mark of the contempt petitioner. He further pointed out that the civil suit, out of which the contempt petition arose, was subsequently dismissed as withdrawn on 04.10.2019.

3. Learned counsel further submitted that evidence of use was provided to the Registrar of Trade Marks along with the affidavit dated 01.12.2018, and that such evidence included registration certificates and invoices dating from 18.05.2015. For all these reasons, learned counsel submitted that the entirely unreasoned interim order warrants interference.

4. In response to these contentions, Mr.N.Ramesh, learned SPC, referred to the examination report and the impugned order and



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submitted that the impugned order does not call for interference because of the existence of a deceptively similar prior mark on the register in respect of nearly identical goods.

5. On examination, it is evident that the appellant's mark is a device mark. The said device mark consists of three elements: the first being the word "Sri Tarpaulins"; the second being the word "Mysore"; and the third being the pictorial depiction of a boy carrying a bag. For purposes of deciding distinctiveness, the mark is required to be examined as a whole. When so examined, the objection raised by the Registrar of Trade Marks under Section 9 is untenable. Turning to the objection under Section 11, such objection was made by citing one mark, which is in the Kannada language.

The proprietor of the said mark had filed C.S.No.379 of 2008 against the appellant before this Court. In the contempt proceedings arising therefrom, the appellant was permitted to use the mark consisting of the words "Sri Tarpaulins", with the word "Mysore" written in a



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smaller font. The civil suit was dismissed as withdrawn subsequently on 04.10.2019. In these circumstances, the objection under Section 11 on the basis of the cited mark is not justified. The impugned order and the statement of grounds of decision are both unreasoned and merely record conclusions. Therefore, they are unsustainable and are, hereby, set aside.

6. By taking into consideration the above facts and circumstances, including the evidence of use submitted by the appellant, the application shall be accepted for advertisement.

7. The impugned order is set aside and (T)CMA(TM)/95/2023 is allowed on the above terms by making it clear that this order will not be binding on opponents, if any. There shall be no order as to costs.

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