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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 11.09.2023

CORAM:

THE HON'BLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

(T) CMA (TM) No.146 of 2023
(OA/23/2019/TM/CHN)

Board of Regents,
The University of Texas System
201 West 7th Street,
Austin, Texas 78701,
USA

... Appellant

Vs.

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

... Respondent

PRAYER : This Civil Miscellaneous Appeal filed under Section 91 of the Trademark Act, 1999, prays that the order issued by the respondent dated 05.10.2018 and received by us on 10.10.2018 be set aside and the Application No.2416154 for the trademark '**cancer and Slash Design**' in classes 35,36,41,44 be allowed to proceed to registration.



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For Appellant : Ms.Shweta Sree Majumder
for M/s. M.S.Bharath

For Respondent : Mr.S.Diwakar, SPC

JUDGMENT

The appellant challenges the grounds of decision dated 05.10.2018 issued in relation to the order dated 26.09.2018 by which Application No.2416154 for the registration of the following device mark was refused:



2. The appellant is the Board of Regents, The University of Texas System, Texas, USA, which runs the M.D.Anderson Cancer Center. The above mentioned application was submitted on 22.10.2012 in classes 35, 36, 41 and 44 on a “proposed to be used” basis. By examination report dated 04.02.2014, the Registrar of Trade Marks raised objections both under Sections 9 and 11 of



the Trade Marks Act, 1999 (the Act). The objection under Section 9 was on the ground of lack of distinctive character and the objection under Section 11 was raised by citing multiple marks. The appellant replied on 17.03.2014 and pointed out that the mark is distinctive because it is written in a stylized form and is a device mark which combines the word 'Cancer' and a slash which runs through the words. As regards the cited marks, the appellant pointed out that apart from the word 'Cancer', there is no commonality between the marks. Thereafter, the appellant filed Form TM-M and sought to amend the “proposed to be used” basis of the application as used since 14.05.2007. In support thereof, a declaration of acquired distinctiveness was filed in the form of a user affidavit dated 09.02.2018. After a hearing on 12.06.2018, by the order dated 26.09.2018, the application was refused by citing Sections 9/11 of the Act. The grounds of decision dated 05.10.2018, however, makes reference only to Section 9. The present appeal was filed in these facts and circumstances.



3. After inviting my attention to the documents referred to above, learned counsel for the appellant submitted that the impugned order is liable to be set aside for the following reasons:

(i) the impugned order is unreasoned and merely draws reference to Section 9 and records the conclusion that the mark is highly descriptive.

(ii) the application is in respect of a device mark consisting of the word 'cancer' written in a stylized manner and a slash that runs through the word 'Cancer'.

(iii) the Registrar of Trade Marks completely disregarded the subsequent Form TM-M and the evidence of use annexed thereto.

(iv) The Registrar of Trade Marks also disregarded the multiple registrations obtained by the appellant for an identical device mark in several overseas jurisdictions including the Kingdom of South Arabia, Japan, the United Arab



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Emirates, the United States of America, Mexico, etc.

(v) The appellant entered into collaborations with the Delhi Cancer Institute, the Tata Memorial Center and the like and conducted seminars/symposiums in India, and the mark was used in relation thereto.

4. In response to these submissions, Mr.S.Diwakar, learned SPC, submitted that the impugned order does not call for interference for the following reasons:

(i) the mark is clearly descriptive of the nature of services provided by the appellant.

(ii) Unlike earlier registrations of the appellant, this mark consists of only the word 'Cancer' and the slash.

5. The impugned order is typically bereft of reasons. Even the grounds of decision merely record conclusions and no effort



was made by the officer to deal with the evidence of use adduced by the appellant after filing Form TM-M. On the limited ground of being unreasoned, the impugned order is unsustainable.

6. The appellant is a reputed University which runs the M.D.Anderson Cancer Center. The appellant has placed on record evidence of the registration of an identical device mark in multiple jurisdictions overseas. The mark is a device mark which consists of the word 'Cancer' and a slash which runs through the word. The appellant has placed on record evidence of partnerships /collaborations with reputed institutes such as the Tata Memorial Center and the Delhi Cancer Institute.

7. By taking into account all of the aforesaid, this is a fit case to proceed to advertisement albeit subject to the incorporation of the limitation that the appellant shall not claim exclusive use of the word 'Cancer'.



8. For reasons set out above, (T)CMA(TM) No.146 of 2023

is allowed and the impugned order is set aside and the application is accepted for advertisement subject to the terms indicated above. However, it is clarified that this order will not be binding on opponents, if any. There shall be no order as to costs.

11.09.2023

Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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SENTHILKUMAR RAMAMOORTHY, J.

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