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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 30.08.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/150/2023
(OA/29/2019/TM/CH)

Frenway Products Inc.,
6F-6, No.130, Sec-2,
Chung Hsiao R.Rd,
Taipei City,
Taiwan - 10053.

... Appellant

-VS-

The Assistant Registrar of Trademarks,
Trademarks Registry,
IP Building, GST Road, Guindy,
Chennai - 600 032.
Respondent

...

PRAYER: Transfer Civil Miscellaneous Appeal (Trademarks) filed under Section 91 of the Trademarks Act, 1999, prays that the impugned order dated 12.02.2018 in Trademark Application No.2453461 refusing the application may be quashed and set aside.



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For Appellant : Mr. John Mathew
for M/s. John Mathew and Associates

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

JUDGMENT

The appellant applied for registration of the following device mark



under Application No. 2453461 in class 8 in relation to handtools. At the time of application, the appellant had not used the mark in relation to handtools in India, but had used the mark outside India. In response to the application, the respondent provided the examination report dated 08.01.2014 raising 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 lacks distinctive character. The objection under Section 11 was made by citing the mark





which was registered in the name of Emjas Trust under Application No.1631517 in class 8. In response to the examination report, by communication dated 23.12.2013, the appellant asserted that the mark is distinctive.

2. After hearing, the impugned order dated 12.02.2018 was issued and, upon request, the grounds of decision were provided on 12.11.2018. The present appeal is filed in the said facts and circumstances.

3. Learned counsel for the appellant invited my attention to the application, the examination report, the reply thereto and the impugned order. With reference to the mark cited in the examination report, learned counsel submitted that the mark was last renewed up to 17.12.2017. The status of registration of the first cited mark was specifically placed for consideration.

4. Learned counsel also invited my attention to the registration



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of identical device marks by the appellant in classes 11 and 7. He also pointed out that identical device marks were registered in multiple jurisdictions outside India, such as Canada, Taiwan, China, Japan, UAE and the United States of America.

5. Mr.P.G.Santhosh Kumar, learned SPC, submits that the impugned order was issued in view of the existence of a conflicting mark on the register. He also pointed out that such conflicting mark is also in class 8 and in relation to similar goods.

6. The objection under Section 9 is clearly untenable because the device mark of the appellant is neither generic nor descriptive of the goods in relation to which it is proposed to be applied. The appellant has placed on record evidence that the last registration of the mark cited in the examination report was not renewed after 17.12.2017. There are registrations of the identical device mark by the appellant in other classes in India and in multiple jurisdictions overseas.



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7. The operative part of the impugned order is as under:

1. *Shri MANIKANDAN applicant / Advocate / Agent appeared before me and made his submissions. I have heard arguments, gone through the records and passed the following Order.*

2. *The trade mark applied for is objectionable under Section 9/11 of the Act. The application is accordingly refused."*

8. Neither the impugned order nor the grounds of decision contain any reasons in support of the conclusions recorded therein. Therefore, the impugned order and the grounds of decision are unsustainable and are, hereby, set aside. By taking into consideration the factors set out in paragraph 6, this is a fit case to proceed to advertisement. It is, however, made clear that this decision would not be binding on opponents, if any. There shall be no order as to costs.



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Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes/ No

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