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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)/151/2023
(OA/30/2019/TM/CH)

World Animal Protection
(Formerly) World Society For The Protection of Animals,
222 Grays Inn Road,
London, WC1X 8HB,
United Kingdom.

... Appellant

-vs-

The Examiner of Trade Marks,
Trademarks Registry,
IP Building, GST Road, Guindy,
Chennai - 600 032.
Respondent

...

PRAYER: Transfer Civil Miscellaneous Appeal (Trademarks) filed under Section 91(1) of the Trademarks Act, 1999, prays that the impugned order dated 27.07.2018 in Trademark Application No.2590702 may be reversed and the trademark application No.2590702 be allowed.

For Appellant : Mr.John Mathew



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for M/s.John Mathew and Associates

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

JUDGMENT

The appellant assails an order dated 27.07.2018 by which Application No.2590702 for registration of the following device mark



in classes 36, 41, 44 was rejected.

2. The appellant is an entity carrying on not-for-profit activities in relation to the protection of animals. It was registered in the United Kingdom. On 03.09.2013, the application for registration of the device mark extracted above was filed in classes 36, 41 and 44. By examination report dated 07.09.2015, the Registrar of Trademarks raised an objection under Section 9 on the ground that the trademark is devoid of distinctive character. A reply dated 17.02.2016 was filed by the appellant stating that the mark is distinctive and does not



WEB COURT

indicate the kind, quality or quantity of the goods or services. The appellant also referred to the manner of establishment of the society, its evolution and the registrations obtained in jurisdictions such as the United States, Philippines, Mexico and the United Kingdom. Eventually, by order dated 27.07.2018, the application for registration of the trademark was refused both under Sections 9 and 11. In the grounds of decision issued subsequently on 05.10.2018, the Registrar of Trademarks has referred to the lack of distinctive character and justified the refusal under Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act, 1999 (the Trade Marks Act).

3. Learned counsel for the appellant invited my attention to the device mark and submitted that the application was in relation to a composite mark consisting of a circular device with the words "WORLD ANIMAL PROTECTION" found inside the said circle. He also pointed out that the appellant obtained registration in respect of a near identical device mark with effect from 02.05.2014 under Application No.2729699. In addition, he referred to documents



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under which registrations were granted in multiple jurisdictions outside India.

4. While admitting that the individual words "WORLD ANIMAL PROTECTION" are descriptive words, he contended that the composite mark is distinctive and deserving of protection.

5. In response, Mr.P.G.Santhosh Kumar, learned SPC contended that all the three words that form the mark are descriptive of the activities, and devoid of distinctive character. He also raises the objection that the application has been filed in multiple classes. Therefore, he concluded that the impugned order is not liable to be interfered with.

6. On considering the above submissions, the conclusion that the mark is devoid of distinctive character cannot be disregarded



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entirely. The individual words "WORLD ANIMAL PROTECTION" are common descriptive words and in view of the nature of activities in relation to which the mark is applied, the words cannot be provided protection. However, Section 17 of the Trade Marks Act mandates that a mark should be considered as a whole. If so considered, it is clear that the application is in respect of a device mark and not a word mark. The appellant has placed on record evidence of registration of a near identical device mark



in classes 35 and 39 under Trademark no.2729699. The appellant has also placed on record evidence of registration of identical device marks in multiple jurisdictions overseas. The words in the mark are drawn from the name of the appellant. The contention of Mr.P.G.Santhosh Kumar, learned SPC, that the application should not be made under multiple classes is untenable since the Trade Marks Act under Section 18(2) allows a party to file an application in more than one class.



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7. The only reason recorded in the impugned order and the grounds of decision are with reference to the absence of distinctive character in the impugned mark. Although reference is made to Section 11 of the Trade Marks Act, no allegedly conflicting marks are cited.

8. For reasons set out above, in the light of evidence produced by the appellant, the device mark is sufficiently distinctive to overcome the conclusions recorded in the impugned order subject to the caveat that no exclusive right over the words "WORLD ANIMAL PROTECTION" shall be claimed by the appellant. Subject to the incorporation of such limitation, the application shall proceed to advertisement. The impugned order is set aside and the appeal is allowed on the above terms by making it clear that the order will not be binding on opponents, if any. There shall be no order as to costs.

30.08.2023

Index : Yes / No

6/8



Internet : Yes / No

Neutral Citation: Yes/ No

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