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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)/160/2023
(OA/31/2020/TM/CH)

Insta Rooms Private Limited
504A, Brooklyn Apartments,
Jai Bharat Nagar,
Bangalore - 560 033, Karnataka.

... Appellant

-vs-

The Senior Examiner of Trade Marks,
Intellectual Property Office,
Intellectual Property Office Building,
GST Road, Guindy, Chennai - 600 032,
Tamil Nadu, India.
Respondent

...

PRAYER: Transfer Civil Miscellaneous Appeal (Trademarks) filed under Section 91 of the Trademarks Act, 1999, praying that the order dated 6th March 2019 of the Hon'ble Senior Examiner of Trade Marks in Application Number 3541418 in Class 43 be set aside and the subject trade mark be allowed to proceed to registration.



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For Appellant : Mr.B.Karthik

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

JUDGMENT

The appellant assails an order dated 06.03.2019 by which the application for registration of the following device mark



in relation to food, drink and temporary accommodation services was rejected.

2. The appellant is a private limited company incorporated in the name and style of Insta Rooms Private Limited. It filed Application no.3541418 on 03.05.2017 for registration of the device mark extracted above in class 43. In the application, the appellant asserted that the mark was in use in relation to the relevant services from 09.06.2016. By examination report dated 23.06.2017, the Registrar of Trademarks raised an objection under Section 9(1)(b) of



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the Trade Marks Act, 1999 (the Trade Marks Act), on the ground that the mark consists exclusively of words designating the intended purpose of the services. By reply dated 13.09.2017, the appellant asserted both inherent and acquired distinctiveness of the mark. As regards inherent distinctiveness, the appellant asserted that the mark "Insta Rooms" is a coined or invented mark and that it has no obvious meaning. Without prejudice, the appellant asserted that the mark had acquired distinctiveness through use. Eventually, by order dated 06.03.2019, the application for registration was refused. On request, the grounds of decision were communicated on 22.01.2010. The present appeal is filed in these facts and circumstances.

3. Learned counsel for the appellant drew reference to the mark, the application in respect thereof, the examination report, the reply thereto and the impugned order. He pointed out that the application itself indicates use from 09.06.2016. As evidence of use, learned counsel adverted to invoices issued between May 2019 and February 2020. He also referred to advertisements posted online.



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4. Mr.P.G.Santhosh Kumar, learned SPC, contended that the word "Insta" is an abbreviation of the word Instant and the word "rooms" is a common descriptive word. Consequently, he contended that the impugned order is fully justified and that the mark is incapable of registration under Section 9 of the Trade Marks Act.

5. The said device mark consists of an outline of a bed, a lamp and the words "insta rooms Book instantly". Therefore, it is required to be considered as a whole and not by dissecting it into its elements. It is also pertinent to notice that the corporate name of the appellant is Insta Rooms Private Limited. There is evidence of use of the mark in the form of invoices. The master data indicates that the appellant was incorporated under the name referred to above on 09.06.2016. The acknowledgment relating to the income tax returns of the appellant, which were filed under the corporate name, with regard to assessment years 2017 - 2018 and 2019 - 2020, are on record.



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6. The impugned order reads, in relevant part, as under:

*"*KARTHICK applicant / Advocate / Agent appeared before me and made his submissions. I have heard arguments, gone through the records and passed the following order.*

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

7. As is evident from the above extract, apart from the reference to Sections 9/11 of the Act, the impugned order contains no reasons. The grounds of decision, in relevant part, and as under:

"The entire documents are appreciated. From analyzing facts of the case, Counsel has not explained the genuine reasons for adopting the particular words as the trade mark by the applicant. The impugned trade mark is in direct relationship, highly descriptive nature with the



services. Since the impugned trademark is indicated the character and intended purpose of the services the impugned trademark is not capable of distinguishing the services of one person from those of another person. Counsel has failed to prove that the impugned trade mark has not acquired distinctive character as a result of the use before the date of filing of the application as defined under proviso of Section 9(1) of the Trade Marks Act, 1999.

After scrutinizing all the facts as mentioned in the trademark application as well as the material evidence in support of the said facts which are available in the file I decided that there is no doubt that the impugned trademark has neither acquired distinctive character before the date of filing of the application nor the well-known trade mark as defined under proviso of Section 9(1) of the Trade Marks Act, 1999."

8. The grounds of decision indicate that the application for registration was refused on the grounds that the appellant had not



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explained the genuine reasons for adopting the words forming the trademark and on the ground that there is a direct relationship between the mark and the nature of services provided by the appellant. As regards the reason for adoption of the particular words, a mere glance at the corporate name of the appellant explains the reasons for adoption of the mark. The conclusion that the mark is descriptive of the services of the appellant cannot, however, be brushed aside. Nonetheless, the mark is required to be looked at as a whole. As discussed earlier, the mark is a device mark consisting of an outline of a bed, a lamp and the words "insta rooms book instantly". When so considered, the mark is sufficiently distinctive to overcome the objections under Section 9. This is, however, subject to the caveat that a limitation shall be incorporated to the effect that the appellant is not entitled to claim exclusive use or rights over the words insta, including variations thereof, or rooms, when used separately.

9. For reasons set out above, the impugned order is set aside



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and the respondent is directed to advertise Trademark Application No.3541418. It is made clear that this order will not be binding on opponents, if any. There shall be no order as to costs.

30.08.2023

Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes/ No

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