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C.M.A(TM)/3/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 08.09.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

CMA(TM)/3/2023

CCL Product (India) Ltd.,
Duggirala,
Guntur - 522 330,
Andhra Pradesh.

... Appellant

-VS-

The Registrar of Trade Marks,
Trade Mark Registry,
Anna Salai, Guindy Industrial Estate,
SIDCO Industrial Estate,
Guindy, Chennai,
Tamil Nadu - 600 032.

... Respondent

PRAYER: Civil Miscellaneous Appeal (Trademarks) filed under Sections 91 of the Trade Marks Act, 1999, praying to set aside the impugned order dated 10.02.2022 passed by the Ld. Registrar, the Trade Marks Registry, Chennai, refusing the registration of the device mark (CONTINENTAL WRITTEN WITH TWO COFFEE



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BEANS AT THE TOP), bearing trademark application number 4416029 in the name of CCL Products (India) Ltd., and direct the respondent to accept the trademark Application No.4416029 for the device mark (CONTINENTAL WRITTEN WITH TWO COFFEE BEANS AT THE TOP)



and advertise the same for classes 11 and 30 in the Trade Marks Journal and proceed thereafter in accordance with law.

For Appellant : Mr.R.Parthasarathy
for Mr.Adarsh Ramanujan

For Respondent : Mr.K.Subbu Ranga Bharathi, CGSC



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JUDGMENT

The appellant assails an order dated 10.02.2022 by which Application No.4416029 for registration of the following device mark



was refused. The appellant applied for registration of the device mark extracted above on 21.01.2020 under classes 11 and 30. The application under class 30 was in relation to beverages such as coffee, tea, cocoa and the like and the application under class 11 was in respect of electrical appliances, including coffee machines. By examination report dated 13.02.2020, the Registrar of Trade Marks raised objections under Section 11 of the Trade Marks Act, 1999 (the Trade Marks Act) by citing two marks. The examination report was responded to on 13.03.2020. In such reply, the appellant, *inter alia*, referred to the 43 trade mark registrations previously obtained by it both in respect of word and device marks. The appellant



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emphasized that all the registrations contained the word CONTINENTAL. As regards the cited marks, the appellant stated that the first cited mark is also a device mark. The said mark contains the galloping horse symbol and is distinguishable from the appellant's mark. The appellant further stated that the cited mark is used in relation to apparatus for heating, lighting and steam generations, whereas the appellant's mark is used in relation to electrical appliances, including coffee machines. As regards the second cited mark, the appellant stated that the said mark is used in relation to apparatus for heating, lighting, steam generations, which are different from the goods in relation to which the appellant uses the mark. After a hearing on 10.02.2022, the impugned order was issued. The present appeal is filed in the said facts and circumstances.

2. Learned counsel for the appellant invited my attention to the trade mark application, the examination report, the response thereto,



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the impugned order, the invoices relating to use of the device mark and registrations obtained previously by the appellant.

3. With specific reference to the first cited mark, learned counsel submitted that the said mark is a device mark bearing the device of a galloping horse. The mark is used by a German Company engaged in the production of tyres. When compared as a whole, he submitted that the appellant's mark and the first cited mark are distinguishable. Additionally, they are applied in relation to dissimilar goods. As regards the second cited mark, apart from pointing out that the said mark is also in relation to dissimilar goods, he pointed out that the status of the said mark is opposed and not registered.

4. With reference to the impugned order, learned counsel pointed out that the impugned order does not take into consideration the fact that the application was both under class 11 and class 30. In



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particular, he submitted that the impugned order contains no reference to class 30 and to the fact that the appellant had obtained multiple registrations for the mark CONTINENTAL and other formative marks.

5. I had asked learned counsel to obtain instructions as to whether the appellant would be willing to accept a limitation with regard to use of the device mark in class 11 only in relation to coffee machines. Upon obtaining instructions, learned counsel submitted that the appellant is willing to accept a limitation provided the appellant is permitted to apply the mark to all coffee, tea, cocoa and other beverage vending, dispensing and making machines.

6. Mr.K.Subbu Ranga Bharathi, learned Central Government Standing Counsel, made submissions in response. He pointed out that the application for registration was declined primarily by taking



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into account the first cited mark and by noticing that the said mark was registered in 2013.

7. The application discloses that it is in relation to a device mark. The device mark contains the word CONTINENTAL and two coffee beans are placed above the said word. The appellant has placed on record invoices containing the mark with the word CONTINENTAL. The appellant has also placed on record details of several registrations obtained in class 30 of marks containing the word CONTINENTAL and associated formative marks.

8. On examining the first cited mark, it is evident that the said mark is also a device mark containing the image of a galloping horse. The said mark was registered in class 11 in relation to apparatuses for lighting, heating and the like. The second cited mark was not registered and the status is indicated as opposed. It should also be



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noticed that the impugned order only refers to the first cited and not the second cited mark.

9. While the impugned order cannot be said to be devoid of reasons, the said order makes no reference to the application under class 30 or to the evidence of prior registrations and use of the mark. Therefore, the impugned order calls for interference. Even as regards the first cited mark, as discussed earlier, the said mark is also a device mark and there is a clear distinguishing feature. In addition, the said mark is used in respect of goods which *prima facie* appear to be neither identical nor similar.

10. In the above circumstances, the impugned order dated 10.02.2022 is set aside. Subject to the incorporation of a limitation to the effect that, in class 11, the mark of the appellant will be applied only in relation to or in connection with all types of coffee, tea, cocoa and other beverage vending, dispensing and making machines, the



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application shall proceed to advertisement. It is made clear,
however, that this order will not be binding on opponents, if any.

There shall be no order as to costs.

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