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(T)CMA(TM)/182/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 21.11.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/182/2023
(OA/SR.63/2020/TM/CHN)

Anuj Kumar Gupta, Trading as ATC Tools,
Industrial Estate, 19-2-239/1/A,
Chandulal Baradari, Bahadurpura,
Hyderabad, Telangana 500064, India.

... Appellant

-vs-

The Deputy Registrar of Trade Marks,
Intellectual Property Office,
Intellectual Property Office Building,
G.S.T.Road, Guindy, Chennai 600 032,
Tamil Nadu, India.

... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Trade Marks) filed under Section 91 of the Trade Marks Act, 1999, praying that the order dated 20th February 2020 of the Hon'ble Deputy Registrar of Trade Marks in Application Number 4082478 in Class 08 be dismissed and the Subject Trade Mark be allowed to proceed to registration.



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For Appellant : Mr.B.Karthik

For Respondent : Mr.M.Karthikeyan, SPC

JUDGMENT

The appellant challenges an order dated 20.02.2020 by which Application No.4082478 for registration of the following device mark was rejected:



2. The appellant applied for registration of the device mark extracted above on 09.02.2019 by asserting use since 17.10.2013 in relation to hand tools and power tools. By examination report dated 01.03.2019, the Registrar of Trade Marks raised objections under Section 11 of the Trade Marks Act, 1999 (the Trade Marks Act) by



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citing two marks. The appellant responded thereto on 16.03.2019 and stated that the cited marks are distinguishable. After a hearing on 20.02.2020, the application was rejected by the impugned order.

3. Learned counsel for the appellant invited my attention to the application and pointed out that the application was in respect of a device mark, which has been used by the appellant since 17.10.2013. In order to substantiate use of the mark, learned counsel referred to invoices issued by the appellant from 17.10.2013. With regard to the marks cited in the examination report, learned counsel submitted that the first cited mark is also a device mark in use since 30.09.2011. Apart from the distinctions between the two device marks, learned counsel contended that the appellant qualifies as an honest and concurrent user in terms of Section 12 of the Trade Marks Act. He also submitted that the device mark was adopted in good faith and that it is derived from the trading name, Anuj Trading Company, of the appellant.



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4. Learned counsel referred to the certificate of the Chartered Accountant with regard to the turnover of the appellant from the financial year 2012-13 to the financial year 2018-19. He also pointed out that applications for registration in classes 7 and 35 in respect of the identical device mark were accepted for advertisement.

5. In response to these contentions, Mr.M.Karthikeyan, learned SPC, submitted that the application was rejected on account of the existence of two prior marks on the register, which are visually and phonetically similar. He also submitted that the use of the abbreviation "ATC" as a trade mark is rampant in the hand and power tools industry and that there is likelihood of confusion among the public as a result thereof.

6. The examination report cites two marks. The second cited mark is used in relation to hand tools and hand operated implements



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for spraying insecticide. Therefore, the goods to which the appellant uses the trade mark and the goods to which the second cited mark is used do not appear to be similar. Turning to the first cited mark, it is also a device mark containing the element "ATC". The mark is registered and learned counsel for the appellant admits that the mark is in use since 30.09.2011. The mark is applied in relation to tools including hand tools and power tools. Given the fact that the goods are similar and the marks are also similar, the conclusion in the impugned order that the prior marks are phonetically and visually similar is not devoid of merit.

7. However, it should be noticed that the trading name of the appellant is Anuj Trading Company and this is borne out from the certificate issued by the Commercial Taxes Department, Government of Andhra Pradesh and by the invoices issued by the appellant. It is also noticeable from the invoices issued from 25.09.2018 that the trading name has been changed to ATC Tools. Thus, the adoption of



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the element “ATC” in the device mark appears to be in good faith.

As stated earlier, evidence of use in the form of invoices is available from 17.10.2013 to 17.03.2020. The appellant has also placed on record the fact that applications for registration relating to the identical device mark were accepted for advertisement in allied classes.

8. Based on the foregoing evidence, the appellant has made out an arguable case with regard to the contention that it is an honest and concurrent user of the device mark. By taking into consideration all the factors set out above, the impugned order calls for interference. In this regard, it should be noticed that the impugned order also refers to the meaning of the cited mark being the same as that of the mark applied for, and the said conclusion is untenable.

9. Therefore, the impugned order is set aside and Application No.4082478 shall proceed to advertisement. It is made clear,



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however, that this order will not be binding on opponents, if any,
including the proprietors of the cited marks. There shall be no order
as to costs.

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