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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

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Date of Decision : 3rd May, 2023

+ C.A.(COMM.IPD-TM) 97/2021

ARVIND MEDICARE PVT LTD. Appellant
Through: Mr.Abhiraj Jayant, Advocates.

versus

REGISTRAR TRADE MARKS Respondent
Through: Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar Mishra,
Mr. Sagar Mehlawat and
Mr.Alexander Mathai Paikaday,
Advocates.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present appeal has been filed impugning the order dated 14th March, 2018 passed by the Senior Examiner of Trade Marks in respect of

Application No. 2361804 for the device mark  in class 44.

2. Brief facts necessary for adjudication of the present appeal are as under:

2.1. The appellant is a company that has been engaged in the business of offering medical, hospital and allied services under the device mark

 since 2012.

2.2. On 11th July, 2012, the appellant applied for registration of the device

mark  under class 44 vide Application No. 2361804.

2.3. Vide Examination Report dated 17th July, 2013, the Trade Marks

Registry objected to the registration of the device mark  under class 44, citing prior subsisting registrations of marks which were similar to the mark of the appellant.

2.4. In response to the Examination Report, the appellant stated that the device mark of the appellant should be registered since it is distinctive in nature. Further, it was stated that since such distinctive device mark had been continuously used by the appellant since 2012, the customers of the appellant were easily able to differentiate between products of the appellant and those of others, thereby eliminating any possibility of confusion in the market.

2.5. However, the trademark application of the appellant, seeking

registration of the device mark  under class 44, was subsequently rejected by the Trade Marks Registry vide the impugned order.

2.6. Consequently, the appellant filed a request on Form TM-M under Rules 36(1) of the Trade Marks Rules, 2017 for obtaining from the Registrar the grounds taken in rejecting the Trade Mark Application of the appellant.

2.7. On 21st June, 2018, the appellant was issued the Statement of Grounds of Decision, which cited Sections 9(1)(a), 9(1)(b), 11(1)(a) and 11(1)(b) of the Trade Marks Act, 1999 as the grounds for refusal of the registration application of the appellant.

2.8. Accordingly, the appellant has been constrained to file the present appeal.

3. At the outset, reference may be made to the relevant extract of the Statement of Grounds of Decision dated 21st June, 2018, which is as under:

“ With reference to the above and request on Form TM-M dated 06/04/2018. It has been decided by the Registrar of Trade Marks to inform you that hearing in respect of above application was held on 14/03/2018 and the said application is refused on the following Grounds;

** application refused in light of passed order by Hon'ble Delhi High Court in case of Sap Se v/s Sap Edge; Icon Health and Fitness v/s Sheriff Usman; Verizon Trademark Services LLC v/s. Vijay Patel and Hon'ble Kolkata High Court in case of Skipper Limited v/s Akash Bansal (Bansal Skipper v/s Bansal Aster).*

** 9 - Absolute grounds for refusal of registration.*

** 9(1)(b) - The Trade Mark consist exclusively of marks or indications which serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or services.*

** 11(1)(a) - Relative grounds for refusal of registration.- The said trade Mark is refused for registration because of its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or*

** 11(1)(b) - Relative grounds for refusal of registration. The said trade Mark is refused for registration because*

of its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

** 11(2)(a) -The trade mark with- it is identical with or similar to an earlier trade mark; and*

Since the objection raised in the Examination Report under section 9 & 11 of the Trade Marks Act, 1999 as mentioned above cannot be waived and Ld. Counsel failed to convince at the time of hearing in proving his/her case in the light of order passed by Hon'ble Delhi High Court in case of Sap Se v/s Sap Edge; Icon Health and Fitness v/s Sheriff Usman; Verizon Trademark Services LLC v/s. Vijay Patel and Hon'ble Kolkata High Court in case of Skipper Limited v/s Akash Bansal (Bansal Skipper v/s Bansal Aster), the above mentioned application is refused. ”

4. A copy of a trademark search report for the word “miracles” has also been handed over to the Court, which reflects that the mark



, bearing Application No.2193061, which was cited by the Registry in the Examination Report, is now registered.

5. Counsel for the appellant submits that since the appellant has been



continuously using the device mark since 2012, owing to which the appellant has also built a valuable name in the Indian market, it should be afforded the benefit of the proviso to Section 9(1) of the Trade Marks Act, 1999. He further submits that in relation to the ground of

rejection under Section 11, the objection raised by the Registry was only on



the basis of one prior mark, bearing Registration No.2193061, which is neither identical nor similar to the



device mark of the appellant.

6. It cannot be lost sight that the appellant's device mark uses a prominent portion of the earlier registered device mark i.e., the word "miracles" and both device marks fall under class 44. However, from a comparison of the two device marks, this Court is of the view that the only common element between the earlier registered mark and the device mark of the appellant is the word "miracles". The earlier registration has been granted for the device mark "Dr. Yogesh Kadam's Miracles Health Clinic". Further, the font, colour of the text as well as the stylization of the alphabets "a" and "M" in the word "miracles" is different in both the device marks.

7. From a reading of the Statement of Grounds of Decision dated 21st June, 2018, it appears that no reasons have been given as to how the word mark of the appellant is not distinctive or that it is descriptive of the goods/services offered by the appellant under the word mark. What weighs with the Court is also the submission of the counsel for the appellant that the



appellant has been using the device mark since 2012 and having gained reputation and goodwill over the past decade, as demonstrated through the various documents placed on record by the appellant, the said trademark has acquired distinctiveness.

8. Further, the appellant has filed two more trademark registration applications, being TM Application Nos.2784553 and 2784554, before the Trade Marks Registry under class 44. The status of the aforesaid applications is shown as “opposed” by Dr. Yogesh Kadam, the registered



proprietor of the earlier registered mark . In this view of the matter, it is deemed appropriate that the present appeal is allowed and the present trademark application also proceeds to the stage of advertisement as per the proviso to Section 20 of the Trade Marks Act, 1999.

9. I have also perused the various orders referred to in the impugned order. None of the aforesaid orders have any correlation to the rejection of the present trademark application.

10. Accordingly, the appeal is allowed and the impugned order dated 14th March, 2018 is set aside.

11. The Trade Marks Registry is directed to proceed with the advertisement of the subject trademark application as per the proviso to Section 20 of the Trade Marks Act, 1999. Let the same be done within a period of three months.

12. Upon the mark being advertised in the Trade Marks Journal, the Trade Marks Registry shall send an intimation to registered proprietors of the cited marks which are currently valid.

13. If there is any opposition to the said application, the same shall be decided on its own merits without being affected by the observations made hereinabove.

14. The Registry is directed to supply a copy of the present order to the Trade Marks Registry at llc-ipo@gov.in for compliance.

AMIT BANSAL, J

MAY 3, 2023

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