



WEB COPY



CMA (TM) No.2 of 2024

THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 17.12.2024

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

CMA (TM) No.2 of 2024

Disys India Private Limited
Neville Towers, Module 3 & 5,
Ramanujam IT City,
Rajiv Gandhi Salai (OMR),
Taramani, Chennai-600 113.

.... Appellant

vs

The Registrar of Trademarks,
The Office of the Trademark Registry,
Intellectual Property Building,
G.S.T. Road,
Guindy,
Chennai – 600 032.

.... Respondent

Prayer : Civil Miscellaneous Appeal filed under Section 91 of the trademarks act, 1999 for the following reliefs :-

- i) Allow the present Appeal and issue and order setting aside the Impugned Order dated 3.11.2023 for being unjust, and erroneous;
- ii) Issue direction to the Respondent to grant the trademark on the trademark application No. 5181506.

For Petitioner : Ms.R.S. Pornima

For Respondent : Mr.A.R.Sakthivel
SPCGSC



WEB COPY

JUDGMENT

This appeal has been filed challenging the impugned order dated 03.11.2023 passed by the respondent refusing to grant trademark registration for the trademark '**DISYS**' under Section 11(1) of the Trademarks Act, 1999.

2. The learned counsel for the appellant while referring to the impugned order would submit that the cited mark DISYSO has not been put to use by the Proprietor of the said mark. Further, she would submit that the said trademark is not phonetically similar to the appellant's mark '**DISYS**'.

3. The learned counsel for the appellant also drew the attention of this Court to the trademark application filed by the appellant before the respondent and would submit that as seen from the same, the appellant has been using the trademark '**DISYS**' from 2012 onwards.

4. The learned counsel for the appellant also drew the attention of this Court to the sales turnover of the appellant from 2012-13 onwards,



CMA (TM) No.2 of 2024

as seen from the Chartered Accountant's certificate, dated 13.12.2024

and would submit that by the long usage of the trademark '**DISYS**', the appellant has acquired distinctiveness for its trademark '**DISYS**'. Therefore, according to the learned counsel for the appellant by total non application of mind by referring to a cited mark DISYSO, which is not in use presently, the respondent has refused to process the trademark application submitted by the appellant for its trademark '**DISYS**'.

5. On the other hand, the learned Standing Counsel appearing for the respondent would submit that the cited trademark is DISYSO and being phonetically similar to the appellant's trademark, the respondent has rightly refused to process the appellant's trademark under the impugned order. He would also submit that excepting for filing invoices raised by the appellant on a sister concern of the appellant in U.S.A., no other documents were produced by the appellant before the respondent to prove that they have been using the trademark '**DISYS**' from 2012 onwards.

6. Admittedly, as seen from the contents of the impugned order, dated 03.11.2023 passed by the respondent refusing to grant trademark



registration for the appellant's trademark '**DISYS**', the contentions of the appellant as raised in this appeal have not been considered. Only on the ground that there exists a phonetically similar mark DISYSO in the market, the respondent has refused to grant trademark registration for the appellant's trademark '**DISYS**' under section 11(1) of the Trademarks Act, 1999, which deals with relative grounds of refusal for the grant of trademark registration. As seen from the impugned order, the alleged non usage of the cited mark as claimed by the appellant in this appeal has not been considered. The sales turnover certificate produced by the appellant before this Court also discloses that the sales turnover of the appellant from 2012-13 which has been increasing every year, has also not been considered. The appellant also claims that DISYSO, the cited mark is not phonetically similar to the appellant's trademark '**DISYS**' and therefore, it cannot be treated as a deceptively similar trademark. By a non speaking order, the impugned order, dated 03.11.2023 has been passed by the respondent. Being a non speaking order, with regard to the contentions raised by the appellant in this appeal, necessarily the impugned order has to be quashed and the matter has to be remanded back to the respondent for fresh consideration of the appellant's trademark application.



CMA (TM) No.2 of 2024

7. Accordingly, the impugned order, dated 03.11.2023 passed by the respondent is hereby quashed and this Civil Miscellaneous Appeal is disposed of by directing the respondent to reconsider the appellant's trademark application in A. No.5181506 afresh on merits and in accordance with law after affording a fair hearing to the appellant. The respondent shall pass final orders with regard to whether the appellant's trademark can be published in the trademarks journal or not within a period of eight weeks from the date of receipt of a copy of this order.

No costs.

17.12.2024

Index: Yes/ No

Speaking order / Non speaking order

Neutral citation : Yes / No

vsi2



WEB COPY



CMA (TM) No.2 of 2024

ABDUL QUDDHOSE, J.

vsi2

To :
The Registrar of Trademarks,
The Office of the Trademark Registry,
Intellectual Property Building,
G.S.T. Road,
Guindy,
Chennai – 600 032.

CMA (TM) No.2 of 2024

17.12.2024