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(T)CMA(TM) No.52 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 07.03.2024

CORAM :JUSTICE N.SESHASAYEE

(T)CMA(TM) No.52 of 2023

OA/26/2015/TM/CHN

Prem Biyani
Prop. Trading Uttaransha International
7-24/10/8, Shivaji Nagar, Attapur
Hyderabad – 500 064.

... Appellant

Vs.

- 1.Zee Entertainment Enterprises Ltd.,
135, Continental Building
Dr.Annie Besant Road
Worli, Mumbai – 400 018.
- 2.The Deputy Registrar of Trade Marks
Trade Marks Registry at Chennai
Chennai.

... Respondents

PRAYER: Transferred Civil Miscellaneous Appeal (Trade Mark) filed under Trade Marks Act, praying to (a) set aside the impugned order dated 19.04.2012; (b) to direct the second respondent to proceed further with application No.960905 in Class 05 in accordance with the law; and (c) to award costs of the proceedings.



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For Appellant : Mr.P.Venkataramani
For Respondent : Mr.C.Kulanthaivel
Central Govt. Standing Counsel for R2
R1 - No Appearance

JUDGMENT

This appeal is directed against the order of the Deputy Registrar of Trade Marks dated 19.04.2012, by which he had rejected the appellant's application for registering its word mark 'ZEE' under class 5, following an opposition from the first respondent for the registration of the same.

2. The brief facts are as below :

- a) The appellant introduces itself as a manufacturer and marketer of insecticides, that it is using the work 'ZEE' since 1998 for marketing its product, and on 04.10.2000, it moved the Trade Mark Registry with its application for registering the mark under class 5.
- b) It sailed through the preliminary procedures and it came to be published in the Trade Mark journal.
- c) No sooner, the first respondent came out with its opposition alleging that it has been using the word 'Z' or 'ZEE' along with other



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combination words, and has atleast 14 registrations. The details are as below :

<i>S.No.</i>	<i>Application No.</i>	<i>Class</i>	<i>Mark</i>
1	1263421	35	ZEE NETWORK
2	1263422	38	ZEE NETWORK
3	1263423	41	ZEE NETWORK
4	1246684	35	Z ENGLISH
5	1246672	41	Z NEWS
6	1246670	35	Z NEWS
7	1246622	35	Z ZEE
8	1246629	38	Z ZEE
9	1081810	9	ZEE CINE RATING
10	1081811	16	ZEE CINE RATING
11	1246642	41	Z RECORDS
12	1246663	41	Z CINEMA
13	789417	16	Z CINE AWARDS
14	789416	9	Z CINE AWARDS

d) Before the Trade Mark Registry, the appellant claims to have produced its evidence, but the Deputy Registrar had held that the said documents are confusing and proceeded to hold that the appellant's mark is deceptively similar to the first respondent's mark and proceeded to reject the appellant's application for registration.

This is now under challenge.



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3. The first respondent was served with a notice, and it did not choose to appear. Heard the learned counsel for the appellant as well the second respondent.

4. The learned counsel for the appellant made the following submissions :

- (a) None of the marks of the first respondent were registered under class- 5; and
- (b) Today, the first respondent's mark may have been considered as a well-know mark, but not in 1997, for the concept of well-know mark was statutorily not recognised under the Trade Marks Act, 1958, which was then in vogue. However, the Registrar has invoked the well-known mark concept for deciding the present issue. Indeed, the Registrar has taken twelve long years to take a decision on the application filed in 2000.

5. The learned counsel for the second respondent submitted that:

- (a) In the various invoices produced by the appellant, the work 'ZEE' was found missing; and
- (b) In the records of the Trade Mark Registry, the mark of the first



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respondent is notified as a well-known mark.

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6. The submissions on either side is carefully weighed. There are two facts that requires to be considered :

- (a) that the first respondent mark does not appear in isolation, but in combination with other words, and at any rate it was not registered under class-5;
- (b) even if it is a well-known mark, it is not that such well known mark should prevail over any other similar or identical marks, since under Sec.12 of the Trade Marks Act, the Registrar can still impose certain conditions. Indeed, the legislative intent is far too evident in that, it has made Sec.11 subject to Sec.12. Therefore, in all such situations, it may be appropriate for the Registrar to consider any application where the mark is similar or identical to any other mark, more so, when they belong to different classes and apply his mind to ascertain if both the marks can be allowed to be used, subject to certain conditions under Sec.12. This apparently has not been done in this case.



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7. In view of the same, this Court deems it appropriate to allow this appeal, and remands the matter back to the Trade Mark Registry, for it to consider the application of the appellant in the light of what this Court has hereinabove observed. No costs.

07.03.2024

ds

Index : Yes / No

Speaking order/ Non-speaking order

To:

The Deputy Controller of Patents & Design
Patent Office Intellectual Property Building
GST Road, Guindy
Chennai - 600 032



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N.SESHASAYEE, J.

ds

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