



IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

COMMERCIAL MISC. PETITION NO. 2 OF 2024

Wacom Co. Ltd.

...Petitioner.

Versus

The Registrar of Trade Marks.

...Respondent.

*Ms. Janhvi Chadha, Mr. Atif Sayyed i/b Krishna & Saurastri Associates LLP for
the Petitioner.*

Mainak Adhikary for the Respondent.

Coram : Sharmila U. Deshmukh, J.

Date : June 10, 2025.

P. C. :

1. Petition has been preferred challenging the order dated 5th August 2021 refusing registration of trade mark "Lifelong Ink" in classes 9, 35 and 41 in the name of Petitioner.

2. The Petitioner is a technology leadership company providing unique and innovative digital tools, software and solutions to its customers. On 8th July 2020, an international application seek registration of trade mark "Lifelong Ink" was filed with the Respondent inter alia in respect of Input devices for computers, graphics, tables etc., for retail or wholesale services for electric and electronic machinery etc., and education and training services etc., in

class 9, 35 and 41 respectively. The Application was examined by the Respondent in accordance with the procedure prescribed under the Trade Marks Rules, 2017 and the Trade Marks Act, 1999 and the provisional refusal containing objections to the acceptance of trade mark was issued by the Respondent which was duly replied by the Petitioner by letter dated 8th January 2021 along with substantiating annexures to demonstrate that the trade mark is fanciful combination mark which has been coined by the Petitioner and is being used by the Petitioner in various countries. The objection in respect of Section 11(1) of the Trade Marks Act was also responded to show that there was no likelihood of confusion or deception in the minds of trade and public and there was no conflicting mark. Despite the submissions and documents produced by the Petitioner, vide order dated 5th August 2021, the Application came to be rejected.

3. Learned Counsel appearing for the Petitioner has taken this Court in detail through the provisional refusal, response to the examination report filed by the Petitioner and the impugned order. She would submit that the basic flaw in the impugned order is that as the objections were on the ground of Section 9(1)(a) and 11(1) of the Trade Marks Act, 1999 whereas the refusal of registration by the impugned order is based on Section 9(1)(a) and 9(1)(b) of the Trade Marks Act, 1999. She would submit that the order holding registration

objectionable on the ground of being descriptive is unsustainable drawing support from the decisions of ***Central Camera Co. Pvt. Ltd v. The Registrar of Trade Marks***¹ and ***Bata India Ltd v. Chawla Boot House***². She would submit that there is no question of any direct reference to the character or quality of goods in which registration was sought as the mark is “Lifelong Ink” which demonstrates that there is no reference muchless direct reference to the character and quality of goods.

4. Learned Counsel appearing for the Respondent submits that the matter be remanded back for consideration afresh. He would submit that in similar cases where the order was non reasoned, non speaking order, this Court has adopted the course of remanding the matter for consideration afresh which can be adopted in the present case also.

5. I have considered the submissions and perused the record.

6. The provisional refusal of international registration was based on Section 9(1)(a) and 11(a) of the Trade Marks Act, 1999. The refusal was in respect of classes 9 and 41 whereas the registration was sought in respect of classes 9, 35 and 41. The impugned order makes no reference as to why registration was refused in Class 35. Though a detailed response was filed to the Examination Report, perusal of the impugned order does not indicate consideration of the submissions

1 1980 SCC OnLine Bom 18.

2 2019 SCC OnLine Del 8147.

raised by the Petitioner. In a cryptic one paragraph, the Respondent has held that the applied trade mark is not registrable upon perusal of the documents. It is necessary for a detailed reasoned order to be passed to indicate application of mind. The fact that provisional refusal was on the ground of Section 9(1)(a) and Section 11(1) of the Trade Marks Act, 1999 whereas the refusal of registration is on the grounds under Section 9(1)(a) and (b) of the Trade Marks Act, 1999 itself demonstrates total non application of mind.

7. Though it is sought to be submitted by learned Counsel appearing for the Petitioner that registration be permitted in the instant proceedings before this Court, the same requires a detailed examination which is best conducted by the Respondent. It is expected by this Court that upon remand, there would be appropriate application of mind by the Respondent and not an empty formality in consideration of Application. It is expected that a detailed reasoned and speaking order is passed which will indicate application of mind by the Respondent.

8. In the light of above, impugned order dated 5th August 2021 is hereby quashed and set aside. Application No. 4745732 is remanded to the Respondent to be considered afresh after hearing the Petitioner. It is expected that Respondent will complete the hearing and pass appropriate order within a period of two months from date

of this order. The Respondent is directed to list the Application for consideration on 18th June 2025.

9. The Petition is allowed in above terms.

[Sharmila U. Deshmukh, J.]