



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 07-08-2025

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THE HON'BLE MR JUSTICE SENTHILKUMAR RAMAMOORTHY

CMA(TM) No. 5 of 2025

Sidharth Jindal
120/A, 201, Ravi Colony, Trimulgherry
Secunderabad, Hyderabad-500015,
Telangana, India.

..Appellant

Vs

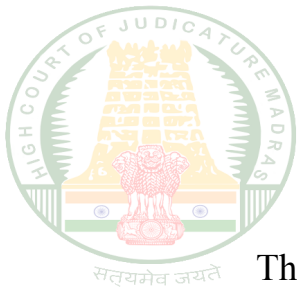
The Registrar of Trade Marks
Trade Marks Registry,
Intellectual Property Building,
GST Road, Guindy, Chennai-600032.

..Respondent

Prayer: Civil Miscellaneous Appeal (Trade Mark) is filed under Section 91 of the Trade Marks Act, 1999 to call for the papers and proceedings of the Trade Mark Application No.5881755 filed by the appellant and after examining the legality thereof, quash and/or set aside the impugned order passed by the respondent and after examining the legality of the trade mark application filed thereof, direct the respondent to grant the trade mark in favour of the appellant and for costs.

For Appellant: Mr.Kaustubh Shakkarwar
for Ms.S.Akila

For Respondent: Mr.Rajesh Vivekananthan, DSG



JUDGMENT

This appeal is directed against order dated 04.11.2024 rejecting Trade Mark Application No.5881755 for registration of the word mark BANGTAN BOYS BTS. The appellant had applied for registration of the above mentioned trade mark on 04.04.2023 on a 'proposed-to-be-used' basis. Examination report dated 05.12.2023 was issued in respect thereof raising objections both under Sections 9 and 11 of the Trade Marks Act, 1999 (the TM Act). The appellant responded thereto on 27.12.2023. The order impugned herein was issued in the above facts and circumstances.

2. Learned counsel for the appellant invited my attention to the application and the examination report. He pointed out that the search report annexed to the examination report cites three allegedly conflicting marks. As regards the first cited mark, he submits that the mark is BTS and is applied in relation to goods such as pumps. As regards the second cited mark, he submits that the mark is BTS BIOGAS SRL/GMBH (BTS BIOGAS) and is applied in relation to biogas installations. With regard to the third cited mark, learned counsel submits that the mark is BTS GROUP AB and appears to be applied in relation to advice and consultancy services.



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3. Learned counsel next submitted that by reply dated 27.12.2023, the objections raised in the examination report were dealt with in detail by also citing precedents in support of the contentions of the appellant. He also pointed out that the appellant had applied for and obtained registration of the mark BTS BANGTAN BOYS in Class 9 and had also applied for registration of the mark BANGTAN BOYS BTS in Class 16, and that the said application was accepted for advertisement. By turning to the impugned order, learned counsel submits that the said order refers to the South Korean boy band although no reference was made thereto in the examination report. He also points out that the respondent has recorded that the application is being rejected because it was filed on a proposed-to-be-used basis. Learned counsel contends that such conclusion is in the teeth of Section 18 of the TM Act. Learned counsel also relied upon the earlier order of this Court in *M/s. EFFRA LIFE SCIENCE, Represented by its Proprietor S.Kannan v. The Registrar of Trade Marks, judgment dated 11.03.2025 in CMA(TM)No.3 of 2025*.

4. In response to these contentions, learned counsel for the respondent submits that the application was rejected in view of deceptively similar marks being present on the register.



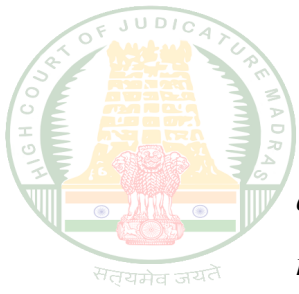
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5. On perusal of the examination report and the search report annexed thereto, it appears that three allegedly rival marks were cited. The first of these marks is BTS and this mark appears to be applied to a range of goods, including centrifugal pumps, submersible pumps and the like. The goods to which the said mark is applied appear to be dissimilar to the goods, i.e. stationery products, in relation to which the appellant's mark is applied. Similarly, as regards the second cited mark, namely, BTS BIOGAS, the said mark is applied in relation to biogas installations. Therefore, the relevant products appear to be completely dissimilar. The third cited mark is BTS GROUP AB and this mark is applied in relation to consultancy, business management and the like. In addition, it is trite that a comparison should be made between the marks as a whole. If the cited marks were to be compared as a whole with the mark applied for by the appellant, it cannot be concluded that the marks are deceptively similar.

6. The operative portion of the impugned order reads as under:

“The mark applied for registration is objectionable under S 9(2) of the Trade Marks Act, 1999, as it is likely to deceive the public or cause confusion in the mind of public;

The mark applied for registration is identical with/similar to earlier trade marks on record, as mentioned in the Examination report and by similarity of marks as well



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as similarity of goods and services covered under such marks, there exists a likelihood of confusion in the mind of public. As such the registration of the mark is objectionable under Section 11(1) of the Trade Marks Act, 1999.

Advocate appeared, Heard learned advocate. The objection of Section 9(2)(a) of the Trade Marks Act, 1999 as the mark is likely to deceive the public or cause confusion is proper and justified. The mark is a combination of non-distinctive words. BTS, also known as the Bangtan Boys, is a South Korean boy band formed in 2010 which clearly indicates that the public will associates the mark and there will be confusion therefore objection under Section (9) sustained. Identical/similar, valid marks with similar classification of goods/services vide application no.2988537 is already on record. Likelihood of confusion. Application is filed on proposed to be used basis and mark has not been in the market objection under Section (11) also sustained. Trademark application is accordingly refused under Section 18(4) of the Trade Marks Act, 1999.”

7. As regards the conclusion regarding Section 9, it is unclear as to how such conclusion was recorded given the fact that the mark is BANGTAN BOYS BTS, which appears to be an unusual juxtaposition of words. As regards the conclusions under Section 11, the said conclusions are unsustainable in light of the discussion on the examination report. The conclusion with regard to



the application being rejected because it was made on a 'proposed-to-be-used' basis is *ex facie* erroneous and in contravention of the prescription under Section 18 of the TM Act. Thus, the impugned order is unsustainable.

8. Therefore, impugned order dated 04.11.2024 is set aside and it is directed that Trade Mark Application No.5881755 shall proceed for advertisement. It is, however, clarified that this order will not be binding on opponents, if any. This appeal is allowed on the above terms. There shall be no order as to costs.

07-08-2025

Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes / No

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To

The Registrar of Trade Marks
Trade Marks Registry,
Intellectual Property Building,
GST Road, Guindy, Chennai-600032.



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SENTHILKUMAR RAMAMOORTHY, J.

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