



\$~3

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

+ **C.A.(COMM.IPD-TM) 12/2022**

TOYOTA JIDOSHA KABUSHIKI KAISHAAppellant

Through: Mr. Peeyoosh Kalra, Mr. Gaurav Mukerjee and Mr. Suyash Malhotra, Advocates.

versus

THE SENIOR EXAMINER OF TRADE MARKSRespondent

Through: Mr. Sumit Nagpal, SPC with Mr. Tanmay Saini, Advocate.

CORAM:

HON'BLE MR. JUSTICE TUSHAR RAO GEDELA

ORDER

%

11.05.2026

1. The appellant has filed the present appeal under Section 91 of the Trade Marks Act, 1991, challenging the order dated 19.02.2021, passed by the Senior Examination of Trade Marks, Delhi whereby the appellant's application for the registration of the mark "ALPHARD" under application no.3683209, was refused.

2. Mr. Peeyoosh Kalra, learned counsel appearing for the appellant, draws attention of this Court to page 10 of the documents, filed by the appellant. The document at page 10 purports to be a Trade Mark application bearing no.3683209 dated 21.11.2017 in Class-12, applied for by the appellant for the registration of the mark "ALPHARD" as a word mark on a proposed to be used basis. The said document is extracted hereunder:

“



As on Date : 17/05/2021

Status : **Refused**

[View Examination Report](#)

TM Application No.	3683209
Class	12
Date of Application	21/11/2017
Appropriate Office	DELHI
State	HARYANA
Country	Japan
Filing Mode	e-Filing
TM Applied For	ALPHARD
TM Category	TRADE MARK
Trade Mark Type	WORD
User Detail	Proposed to be used
Certificate Detail	
Valid upto/ Renewed upto	
Proprietor name	(1) TOYOTA JIDOSHA KABUSHIKI KAISHA (ALSO TRADING AS TOYOTA MOTOR CORPORATION) Body Incorporate
Proprietor Address	1, Toyota-cho, Toyota-shi, Aichi-ken, Japan
Email Id	****a.mehra@remfry.com
Attorney name	REMFY & SAGAR[12441]
Attorney Address	REMFY HOUSE AT THE MILLENNIUM PLAZA SEC 27, GURGAON 122009, NEW DELHI NATIONAL CAPITAL REGION INDIA
Goods & Service Details	[CLASS : 12] Automobiles and structural parts thereof

”

3. The Examination Report was generated by the Trade Marks Registry vide communication dated 02.01.2018 citing the mark of one Tech Square Engineering Pvt. Ltd under application no.3093218 in Class-12, for the same mark “ALPHARD”. The said Examination Report alongwith the cited mark is extracted hereunder:

*“From: The Registrar of Trade Marks, Delhi Date:02.01.2018 15:11:30
To,
REMFY & SAGAR
REMFY HOUSE AT THE MILLENNIUM PLAZA SEC 27, GURGAON
122009, NEW DELHI NATIONAL
CAPITAL REGION INDIA*

*Application No: 3683209 in Class/Classes : 12
In the name of M/s: TOYOTA JIDOSHA KABUSHIKI KAISHA (ALSO
TRADING AS TOYOTA MOTOR CORPORATION)*

*Gentlemen/Madam,
The above mentioned application has been examined under the provisions of
Trade Mark Act, 1999 and Trade Mark Rules, 2002 and the trade mark applied
for is open to objection under the following sections :*



1. The Trade Mark application is open to objection on relative grounds of refusal under Section 11 of the Act because the same/similar trade mark(s) is/are already on record of the register for the same or similar goods/services. The detail of same/similar trade marks is enclosed herewith

The objection is raised under S 11 (1) of the Trade Marks Act, 1999, as the mark is identical with or similar to earlier marks in respect of identical or similar description of goods and because of such identity or similarity there exists a likelihood of confusion on the part of the public.

2. Other Objection/Requirement/Conditions/Restrictions.
Applicant is required to provide Duly Stamped Power Of Attorney by way of filing TM-48.

Hence, the above application is liable to be refused. Accordingly, you are requested to submit your response/submissions, if any, along-with supporting documents, within One Month from the date of receipt of this Examination Report or you may apply for a hearing.

Please Note that if no reply is received or a request for a hearing is applied for within the above mentioned stipulated time, the said application shall be treated to have been abandoned for lack of prosecution under Section 132 of the Trade Marks Act, 1999 and there after the status of application in the computer database shall reflect the factual position.

Note: The reply should be submitted online through Comprehensive eFiling services or through email at parm.tmr@nic.in. With the subject as REPLY TO EXAMINATION REPORT.

Yours faithfully,
MONICA CHAWLA
For Registrar of Trade Marks”

5/17/2021

Examination Report

GOVERNMENT OF INDIA
TRADE MARKS REGISTRY



LOCATION:
SECTION: EXM
REPORT: EXM007

WORD MARK SEARCH REPORT
APPLICATION NUMBER: 3683200
Class : ---
TRADEMARK: 'ALPHARD'

USER : MCA
PAGE:1
DATE: 21/11/2017

APPL NO	CLASS	CONFLICTING MARK	JOURNAL No	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	TM IMAGE
------------	-------	---------------------	---------------	-----------------	-----------------------	--------	----------

GOODS SERVICES

3903216 12 ALPHARD 1739 TECHSQUARE
ENGINEERING PVT.LTD. A 2025 SECOND FLOOR, Registered
JANAK PURI NEW DELHI
110058

APPLICATION DATE 09/11/2015

GOODS/SERVICE CAR COVER, VEHICLE AIR CUSHION, VEHICLE SEATS, HORNS FOR VEHICLES, COVER FOR VEHICLE STEERING WHEELS, VEHICLE MUDGUARD/MUD FLAP, SUN VISOR/ROOF VISIONRAMP VISOR, BUMPER GUARD, HOODS FOR VEHICLE, SIDE STEP, BONNET VISOR, CAR SEAT COVERS, CAR WIPER, WIND SCREEN WIPER, WINDSHIELD WIPER, REAR VIEW MIRROR, CARRIER (LUGGAGE) FOR VEHICLES, UPHOLSTERY FOR VEHICLES, AIR BAGS, REVERSING ALARM FOR VEHICLES, ANTI THEFT ALARM FOR VEHICLES, ANTI THEFT DEVICES FOR VEHICLES INCLUDED IN CLASS - 12.

MONICA CHAWLA
For REGISTRAR OF TRADE MARKS



4. Mr. Kalra also further draws attention of this Court to the impugned order dated 19.02.2021, whereby the application of the appellant was refused on the basis that it is not registrable under Section 11(1) of the Trade Marks Act, 1999. The said order is extracted hereunder:

*"IN THE MATTER OF Application No 3683209
for registration of a trade mark ALPHARD
filed by TOYOTA JIDOSHA KABUSHIKI KAISHA (ALSO TRADING AS
TOYOTA MOTOR CORPORATION).*

Above application has been filed for registration of the trademark ALPHARD on 21/11/2017 which was examined on 02/01/2018 and examination report was communicated to the applicant at his address for service. A reply to the office objection(s) had been filed on behalf of the applicant but the same was not found satisfactory and the application was set down for hearing and eventually hearing took place before me on 11/02/2021.

ADVOCATE NIPUN Attorney appeared before me and made his/her submissions. I have heard arguments and gone through the records.

The mark applied for registration is identical with /similar to earlier trademarks on record, as mentioned in the Examination report and by similarity of marks as well 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 NIPUN appeared, argued and submitted that the conflicting mark cited in the examination report is visually, phonetically, structurally and conceptually different and have different goods. furthermore The attorney is relied on the judgement of MilmetOftho Industries and Ors. vs. Allergan Inc. [(1996) 12 SCC 624] and fH&M Hennes & Mauritz AB and Ors. Vs. HM Megabrand Pvt. Ltd and Ors. [2018 (740) PTC 229 (DEL)] , as per these cases prior international user should be consider. heard, and checked the details of application, As per examination report, visually ,phonetically, conceptually and structurally Identical registered and duly renewed and valid cited mark no.3093218 with the similar goods and prior user are on record, and the applicant mark have no significance and uniqueness in the adoption of the trade mark in India. The cited mark is applied on 05/11/2015 as " ALPHARD" for the goods of " CAR COVER, VEHICLE AIR CUSHION. VEHICLE SEATS, HORNS FOR VEHICLES, COVER FOR VEHICLE STEERING WHEELS, VEHICLE MUDGUARD/MUD FLAP, SUN VISOR/DOOR VISOR/RAIN VISOR, BUMPER GUARD, HOODS FOR VEHICLE, SIDE STEP, BONNET VISOR, CAR SEAT COVERS, CAR WIPER, WIND SCREEN WIPER, WINDSHIELD WIPER. REAR VIEW MIRROR, CARRIER (LUGGAGE) FOR VEHICLES, UPHOLSTERY FOR VEHICLES, AIR BAGS, REVERSING ALARM FOR VEHICLES, ANTI THEFT ALARM FOR VEHICLES, ANTI THEFT DEVICES FOR VEHICLES INCLUDED IN CLASS - 12" which is identical to the applicant mark applied on 21/11/2017 as



"ALPHARD" and as on proposed to be used mark in India for the similar goods of "Automobiles and structural parts thereof". The applicant subject mark is "ALPHARD" so there is no difference between cited mark and the applicant's mark, since the subject mark is a common terminology hence there is phonetically and visual similarity with the cited mark. Furthermore applicant mark is applied as a proposed to be used in India, hence there is no question of acquired distinctiveness, and honest and concurrent user arise in India. The attorney of the applicant has relied on the judgement of MilmetOftho Industries and Ors. vs. Allergan Inc. [(1996) 12 SCC 624] and f H&M Hennes & Mauritz AB and Ors. Vs. HM Megabrands Pvt. Ltd and Ors. [2018 (740) PTC 229 (DEL)] which are based on trans boarder reputation however in a recent judgement of Supreme Court in the case of Toyota Jidosha Kabushiki Kaisha vs M/S Prius Auto Industries Limited on 14 December, 2017 popularly known as Prius Case upheld that trans boarder reputation is not recognized because Territoriality Principle as opposed to the Universality Doctrine which has been accepted by the courts all over the world as the correct test to determine goodwill and reputation within any particular jurisdiction. The Hon'ble Supreme Court further held that the reputation could not merely be asserted, but must be proved within the territory of India. In the present application subject mark is applied on dated 21/11/2017 as a proposed to be used basis and till date in spite of due knowledge the applicant has not taken any legal steps against the proprietor of conflicting mark on the basis on prior user and adoption in Indian Market. Applicant and conflicting mark, both applied as a proposed to be used basis but the adoption and date of application of conflicting mark is prior than the applicant and as per Section 23 (1) (b) of the trademark Act 1999 mark is registered from the date of making the application and as per section 34 of the trademark act 1999 who comes first in the market hence date of adoption of the subject mark by the proprietor of conflicting mark is prior than applicant. furthermore It is a well settled law that, "The resemblance between the two marks must be considered with reference to the ear as well as the eye". so upon considering the above mentioned facts and material on record, the objection raised under section 11 of trade Mark Act 1999 can not be waived. Hence application is refused.

After perusal of all the documents on record and submission made by the applicant / authorised agent it is concluded that applied mark is not registrable because of the reason stated as above. Hence application no 3683209 cannot be accepted and refused accordingly."

5. Learned Senior Examiner of Trade Marks had based the rejection on the premise that there is no difference between the cited mark and the applicant's mark and since the subject mark is a common terminology hence there is phonetical and visual similarity with the cited mark. The further reasoning was that the appellant's mark is applied on a proposed to be used basis in India, thus



there is no question of any acquired distinctiveness or that it is an honest and a concurrent user in India. Further and on the basis of certain judgments, the impugned order was passed.

6. Mr. Kalra, learned counsel submits that parallely, the appellant had filed a rectification petition bearing no. C.O.(COMM.IPD-TM) 298/2022 before this Court, which was refused *vide* order dated 03.02.2023. The said order was taken in an appeal by the appellant in LPA 176/2023, LPA 177/2023 and LPA 178/2023, wherein one of the appeals was in respect of the aforesaid cited mark of the Tech Square Engineering Pvt. Ltd., namely registration no.3093218 in Class-12.

7. Mr. Kalra, handed over the judgment dated 04.05.2026 of the learned Division Bench in the aforesaid batch of appeals and invited attention particularly to para 100 of the said judgment, which is the conclusion drawn by the learned Division Bench. It would be apposite to extract para 100 through till para 104 of the said judgment, hereunder:

“100. Upon a holistic consideration of the material on record, we are satisfied that:

i. The Appellant has established prior adoption of the mark ALPHARD and has established its spill-over reputation within India, supported by substantial evidence of recognition and goodwill in the Indian market.

ii. The Respondent’s adoption of the mark lacks bona fides and is not entirely innocent, given the inconsistencies in their explanation and the proximity of the mark to the Appellant’s internationally recognized brand.

iii. The impugned registrations are in contravention of the provisions of Section 11 of the Act, and the marks are “wrongly remaining on the Register” within the meaning of Section 57.

101. We are further satisfied that the mark ALPHARD was a “well known” trade mark at the time of Respondent’s application. The evidence presented by the Appellant sufficiently establishes the mark’s international reputation, which had spilled over into India, qualifying it for protection under the applicable provisions of Indian trademark law.

102. In light of the above findings, we deem it appropriate to order the



removal of the impugned registration for the mark ALPHARD in favour of the Respondent, specifically under Registration Nos.3093216, 3093218, and 3093219, in respect of Classes 9, 12, and 27, respectively, dated 17.09.2016, 17.09.2016, and 13.09.2016. These registrations are hereby declared to be invalid and are to be removed from the Register of Trade Marks.

103. Consequently, we direct that the Register of Trade Marks be rectified to reflect the removal of the impugned ALPHARD mark from the Register. The Registrar of Trade Marks is further directed to take immediate action to effect this rectification.

104. Let a copy of this judgment be forwarded to the Registrar of Trade Marks through the prescribed mode for due compliance and immediate action in accordance with the directions above.”

8. Predicated on the aforesaid conclusions reached by the learned Division Bench in the aforesaid appeal, Mr. Kalra, learned counsel states that since the said registered Trade Mark of Tech Square Engineering Pvt. Ltd. has already been directed to be removed from the Register of Trade Marks, the present appeal can be allowed to the extent that the further proceedings may commence for the purposes of consideration of the Trade Mark application of the appellant after advertisement in the Trade Marks Journal.

9. Mr. Nagpal, learned counsel appearing for the Registrar, states that since the judgment in the aforesaid appeals was rendered recently on 04.05.2026, there is every possibility that the party i.e. Tech Square Engineering Pvt. Ltd. may prefer an appeal for which the statute provides three months and thus, it may be appropriate to await the said proceedings since an order restraining the operation of the judgment dated 04.05.2026 may be passed by the Supreme Court, in the meantime.

10. Though the statement of Mr. Nagpal may be a possibility, however, even if this Court quashes the impugned order, the only fall out of the same or the consequences would be that the application of the appellant would be resurrected to the stage of consideration by the Trade Marks Registry. The party, i.e., Tech Square Engineering Pvt. Ltd. may not be prejudiced since the



right of filing opposition always remains with the said party.

11. After having considered the judgment passed by the learned Division Bench in the aforesaid appeals, it appears to this Court, at this stage, that no prejudice, *per se*, would be caused to the Tech Square Engineering Pvt. Ltd., in case the present appeal is allowed, and the impugned order is quashed.

12. Accordingly, having regard to the judgment dated 04.05.2026 of the learned Division Bench, the impugned order dated 19.02.2021 is quashed.

13. The judgment of the learned Division Bench dated 04.05.2026 is taken on record.

14. The Trade Marks Registry is directed to continue the proceedings further in accordance with law. The necessary advertisement etc. would be carried out.

15. The appeal is allowed and disposed of in the above terms.

TUSHAR RAO GEDELA, J

MAY 11, 2026

yrj