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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **05.09.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/140/2023
(OA/16/2019/TM/CH)

Sundaram Industries Limited,
180, Anna Salai, Chennai 600 006
India. ... Appellant

-vs-

The Registrar of Trade Marks,
Trade Marks Registry,
Chennai. ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Trademarks) filed under Sections 91 of the Trademarks Act, 1999, prays that the order dated 05 October 2018 issued by the respondent refusing the mark TRISTAR vide Application No.2790337 in class 12 be set aside and the subject mark in the name of SUNDARAM INDUSTRIES LIMITED be allowed to proceed to registration.

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For Appellant : Mr.R.Rajesh
for M/s. De Penning and De Penning

For Respondent : Mr.S.Diwakar, SPC

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JUDGMENT

The appellant assails the grounds of decision dated 05.10.2018 in support of order dated 20.07.2018 by which its application for registration of the word mark TRISTAR was refused. The appellant applied for registration of the above mentioned mark under Application No.2790337 dated 12.08.2014. Such application was in class 12 in relation to solid industrial tyres. In the examination report dated 08.12.2015, the application was objected to both under Sections 9 and 11 of the Trade Marks Act, 1999 (the Trade Marks Act). As regards the objection under Section 9, the Registrar of Trade Marks stated that the mark was devoid of distinctive character. As regards the objection under Section 11, four marks were cited. In response to the examination report, by communication dated 01.08.2016, the

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appellant stated that the mark does not describe the goods listed in the application and does not refer to the character or quality thereof. With regard to the cited marks, the appellant stated that the goods in relation to which the mark is proposed to be applied are solid industrial tyres, which are clearly different from the goods in relation to which the cited marks are applied. After providing a hearing on 12.06.2018, by order dated 20.07.2018, the application was rejected. Upon application, the grounds of decision were provided on 05.10.2018. The present appeal is filed in the above facts and circumstances.

2. Learned counsel for the appellant placed for consideration the application for registration, the examination report, the reply thereto, and the impugned order. With reference to the examination report, learned counsel submitted that the objection that the mark is generic or descriptive of the goods is untenable. As regards the cited marks, he submitted that the fourth cited mark was subsequently

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abandoned. With regard to the second and third cited marks, he submitted that the said marks are clearly distinguishable. Turning to the first cited mark, learned counsel submitted that the said mark consists of the words TRI and STAR written separately. Moreover, he submitted that the mark is applied in relation to tyres and tubes for motor land vehicles. By contrast, he pointed out that the appellant's mark is used only in relation to solid industrial tyres. By inviting my attention to Section 11(1) of the Trade Marks Act, he submitted that there would be no likelihood of confusion on the part of the public because the consumers of solid industrial tyres and tyres and tubes for motor land vehicles are different.

3. In response, Mr.S.Diwakar, learned SPC, submitted that the mark TRISTAR and the first cited mark in the examination report are identical. He further submitted that the goods are nearly identical. He placed for consideration the current status of TM No.308929 (i.e., the first cited mark) and pointed out that the registration is valid up

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to 01.10.2033. In these circumstances, learned counsel concluded his submissions by submitting that there is no infirmity in the impugned order and that no interference is warranted.

4. As is typical with orders of the Registrar of Trade Marks, the impugned order is cryptic and contains no reasons. While it is stated in the grounds of decision that deceptively similar marks are already on record and that the appellant did not show use of the mark in India prior to filing the application, the grounds of decision also do not satisfy the requirement that a quasi-judicial authority should engage with the submissions of the applicant and provide reasons for rejecting such submissions. Nonetheless, in view of the first cited mark being used in relation to similar goods and the marks being near identical, no purpose would be served in interfering with the impugned order entirely on the ground that it is not supported by reasons. Therefore, the merits are examined.

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5. On examining the application of the appellant, it is evident that the application was made on a "proposed to be used" basis. The application is in respect of the word mark TRISTAR. Learned counsel for the appellant is correct in contending that the mark is neither generic or descriptive when used in relation to solid industrial tyres. This leads to the objection under Section 11. Such objection was raised by citing four conflicting marks. The first cited mark relates to TM No.308929, which is in respect of the mark TRISTAR under class 12; the registration was obtained with effect from 01.10.1975; and is currently valid up to 01.10.2033. The said mark is used in relation to tyres and tubes for motor land vehicles. In my view, solid industrial tyres and tyres and tubes for motor land vehicles are clearly similar if not identical goods.

6. Section 11(1) of the Trade Marks Act is as under:

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> "***11. Relative grounds for refusal of registration.*** *- (1) Save as provided in section 12, a trade mark shall not be registered if, because of -*
>
> *(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or*
>
> *(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,*
>
> *there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.*"

7. From the text of Section 11(1), it is evident that trade mark protection would apply to cases where the later mark is identical or deceptively similar to the earlier mark and the goods or services in question are either identical or similar. An additional requirement is that such similarity in marks and goods / services should create likelihood of confusion on the part of the public. By taking into

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account the fact that the marks are near identical and the goods are similar, I am of the view that there would be likelihood of confusion on the part of the public or, at a minimum, the likelihood of association with the earlier mark.

8. For the reasons set out above, (T)CMA(TM)/140/2023 is dismissed without any order as to costs.

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Internet : Yes / No

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