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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 09.07.2024	Pronounced on : 19.07.2024

CORAM:

THE HON`BLE MR.JUSTICE P.B.BALAJI

CMA (TM) No.5 of 2024

Just Lime My Child Foundation,
2675 San Clemente Terrace,
San Deigo, CA 92122,
having its address for service in India at
Ground Floor, No.48, Eldams Road,
Alwarpet, Chennai – 600 018. .. Appellant

.Vs.

The Registrar of Trade Marks,
Office of the Trade Mark Registry,
Intellectual Property Office Building,
GST Road, Guindy,
Chennai - 600 032. .. Respondent

Prayer: This Civil Miscellaneous Appeal filed under Section 91 of the Trade Marks Act, 1999, praying to set aside the order dated 08.02.2024, passed by the respondent, refusing the application for registration of trademark under No.4824864 in Class 41 and consequently, direct the respondent to advertise the application in Trademarks Journal.

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For Appellant : Ms.Antara Balaji
for Mr.S.Rajesh Ramanathan

For Respondent : Mr.S.Janarthanam
Senior Panel Central
Government Standing Counsel

J U D G M E N T

The Trademark Appeal has been preferred by the appellant, aggrieved by the order dated 08.02.2024 passed by the respondent, refusing registration of the word mark “GIRL POWER PROJECT” in Class 41.

2.I have heard Ms.Antara Balaji, for Mr.S.Rajesh Ramanathan, learned counsel for the appellant and Mr.S.Janarthanam, learned Senior Panel Central Government Standing Counsel for the respondent. I have also gone through the records.

3.The primary submission of Mr.Antara Balaji, the learned counsel for the appellant is that though the appellant had made an application for registration of a composite word mark “GIRL POWER PROJECT, the respondent has dissected the composite word mark and has erroneously held

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that the word mark is descriptive of the services in Class 41 and therefore, it cannot be registered. The learned counsel for the appellant would further submit that the same word mark has been registered abroad, especially in the United States of America and in Uganda and despite being put on notice about the same, the respondent has failed to consider the registrations in favour of the appellant for the very same word mark. The learned counsel for the appellant would further submit that the word mark was clearly not descriptive of girl empowerment alone and she would therefore pray for the appeal being allowed and a direction to be issued for advertising the word mark and for further process towards registration of the word mark.

4.The learned counsel for the appellant also placed reliance on the decision of the learned Single Judge of the High Court of Delhi in ***Skechers, Usa Inc li Vs. Union of India and Others*** reported in ***2022 (92) PTC 212 (Del)***, where the High Court of Delhi held that the examiner has to specifically consider the composite nature of the mark and various other elements of the mark and not in a general fashion. She would also place reliance on the order dated ***20.09.2001*** passed in ***Procter & Gamble Company Vs. Office for Harmonisation in the Internal Market***, where the

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European Court of justice held that a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

5.The Court further held that with regard to word marks composed of words, descriptiveness shall be determined not only in relation to each work taken separately but also in relation to the whole which they form and any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class or consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark. In order to testing the word BABY-DRY, the Court held that the said combination cannot be regarded as exhibiting as a whole, descriptive character and therefore, cannot be refused registration.

6.In reply, Mr.S.Janarthanam, learned Senior Panel Central

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Government Standing Counsel for the respondent would submit that under Section 9(1)(b) of the Trade Marks Act, absolute grounds for refusal are available to the respondent and invoking the same, the respondent has rightly rejected the request for registration. He would further submit that ample opportunities were also given to the appellant and the appellant also participated in the hearing notice. He would further submit that the object of the act is not to create confusion and therefore, the respondent had rightly refused registration since the word mark "GIRL POWER PROJECT" was clearly descriptive of girl empowerment and therefore, could not have been registered under Class 41.

7.The learned Standing Counsel would also place reliance on the judgment passed by the High Court of New Delhi in ***C.A(Comm.IPD-TM) No.158 of 2022*** dated ***04.01.2023*** in the case of in ***Armasuisse Vs. The Trade Mark Registry and Another,*** where the Court held that SWISS MILITARY logo designated geographical origin of the goods as being Switzerland and the possibility of the mark confusing or deceiving the public into believing that the goods are of Swiss original when, in fact, they are not, would fatally imperil the entitlement of the mark to registration. He would therefore, seeks

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dismissal of the appeal.

8.The appellant is a non profit Company formed with laudable objectives of improving health care, personal care, education and micro enterprises among women and girl children globally. The appellant has shown that they have launched operations in the name and style of GIRL POWER PROJECT in the year 2014 which was aimed at empowering girls around the world to meet challenges of adolescence and to lead them good life of early marriage, pregnancy and disease or a life of education and economic independence. In the year 2020, the appellant has started their project in India with similar objectives. Admittedly, the registration of the mark GIRL POWER PROJECT has been accorded in United States of America and Uganda. No doubt, in India, the appellant sought for registration of the mark as proposed to be used, in Class 41. At the First Examination Report, the respondent raised the objection under Section 9(1)(b) of the Trade Marks Act alone. In response to the same, the appellant gave its reply on 16.02.2021, explaining that the appellant's mark was composite and distinctive in nature and thereafter, after personal hearing, the impugned order came to be passed.

9.It is the grievance of the learned counsel for the appellant that the

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impugned order does not even refer to the arguments placed by the learned counsel for the appellant at the time of personal hearing and there has been total non application of mind.

10.I have gone through the impugned order. The only ground on which the application has been rejected is that the "GIRL POWER PROJECT" is descriptive and/or common to trade. However, I do not find any discussion on the said conclusion arrived at by the respondent. The respondent has indeed dissected the composite word mark "GIRL POWER PROJECT" by independently examining the word mark GIRL POWER PROJECT. The respondent has also failed to see that the GIRL POWER PROJECT has been favourably considered for registration in United States of America as well as in Uganda.

11.The impugned order does not even specify as to why the composite word mark is hit by Section 9(1)(b) of the Trade Marks Act. The objects with which the project has been launched clearly make it distinguishable from the services envisaged in Class 41 and therefore, I am unable to sustain the findings of the respondent in this regard. As rightly held by the learned Single

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Judge of the High Court of Delhi in ***Skecher's*** case, even while testing the word mark under Section 9(1)(b) of the Trade Marks Act, the mark has to be considered as a composite one. However, in the instant case, the respondent has not adopted the said approach and instead, has sought to compartmentalize the word mark GIRL POWER PROJECT in order to refuse registration. Moreover, the respondent has also not considered the registrations granted in the United States of America and Uganda which have also been brought to his notice.

12.In ***Armasuisse's*** case before the High Court of Delhi, the facts were entirely different and it was a case of opposition to the registration of the mark and not refusal to register and on the facts of the said case, it was held that the trade mark, of which registration was sought, consisted exclusively of marks or indications which are intended to identify the geographical origin of the goods in trade and hence the mark became non-registrable under Section 9(1)(b) of the Trade Marks Act. Hence, I do not find the said decision in any way helping the case of the respondent.

13.I am unable to sustain the impugned order and the finding that the

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word mark GIRL POWER PROJECT shows intended purpose of services applied is clearly unsustainable. As I have already found that GIRL POWER PROJECT is a distinctive mark and is clearly capable of distinguishing services of the appellant from those of others. The services of the appellant are diverse and by no stretch of imagination limited to the class of services set out in the Class 41. The finding of the respondent that the mark has a direct relation with the services applied in Class 41 and that it is completely descriptive is therefore unsustainable.

14.For all the above reasons, the appeal is allowed and the impugned order passed by the respondent is set aside and the respondent is hereby directed to process the application of the appellant for registration and take such steps in accordance with law and shall complete the said process, within a period of three months from the date of receipt of a copy of this order. There shall be no order as to costs.

19.07.2024

Index : Yes/No
Speaking/Non-speaking order
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P.B.BALAJI,J.

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To

The Registrar of Trade Marks,
Office of the Trade Mark Registry,
Intellectual Property Office Building,
GST Road, Guindy,
Chennai - 600 032.

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