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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 15.09.2023

CORAM:

THE HON'BLE MR. **JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(TM) No. 2 of 2023
&
CMP. No. 15970 of 2023

M/S.CHU CHU TV STUDIOS LLP
TVH Beliciaa Towers, Tower 1,
1st Floor, No.94,
MRC Nagar, Chennai 600 028. ... Appellant

Vs.

THE REGISTRAR OF TRADEMARKS
The Trademarks Registry, IP Building,
GST Road, Guindy,
Chennai 600 032 ... Respondent

PRAYER : This Civil Miscellaneous Appeal filed under Section 104 and Order XLIII Rule 1 of CPC read with Section 91 of the Trademark Act, 1999, prays to set aside the order dated 14.09.2021, passed by the Respondent herein, refusing the application for registration of the trademark under No.4377556 in Class 28 and consequently proceed with the application in the manner known to law.

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For Appellant : Mr.S.Diwakar
for M/s.Rajesh Ramanthan

For Respondent : Mr.K.Subbu Ranga Bharathi,
Central Govt. Standing Counsel

JUDGMENT

The appellant challenges an order dated 14.09.2021 by which Application No.4377556 for registration of the following device mark was rejected:



2. The appellant submitted that the above mentioned application was made on 13.12.2019 by asserting use from 27.09.2019. The application was in class 28 in relation to games, sporting articles and the like. By examination report dated 08.01.2020, the Registrar of Trade Marks raised objections under Section 11(1) of the Trade Marks Act, 1999 (the Trade Marks Act) by citing one mark. The status of the cited mark is shown as

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'objected' in the search report annexed to the examination report. By reply dated 01.02.2020, the appellant referred to registrations obtained previously in classes 38 and 41 for the mark CHUCHU TV and its formative marks. The appellant stated that the cited mark was adopted subsequent to adoption by the appellant and that this is evident from the fact that the application was filed in September 2019 on a 'proposed to be used' basis. In support of the application, the appellant had also filed evidence of use, including in the form of online material and invoices. By order dated 14.09.2021, the application was rejected on multiple grounds. The present appeal is filed in these facts and circumstances.

3. Learned counsel for the appellant invited my attention to the application for registration of the device mark. He also pointed out that the appellant had obtained registrations for the device mark CHU CHU TV both in classes 38 and 41 with effect from 01.07.2013. He also referred to an article published in the online version of the Business Standard with regard to the operations of CHU CHU TV as an online channel for pre-school

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kids. By inviting my attention to invoices issued on 24.08.2019 and 30.08.2019, he pointed out that these invoices relate to goods in class 28 in respect of which the present application was filed. In spite of providing such evidence to the Registrar of Trade Marks, learned counsel contended that the impugned order was issued on entirely untenable grounds. With reference to the conclusion in the impugned order that a certificate under Section 65B of the Indian Evidence Act, 1872 (the Evidence Act) should have been submitted, learned counsel contended that such certificate is not required in relation to content posted online by a third party. He also placed reliance on the judgment of the Delhi High Court in *Excitel Private Limited v. The Registrar of Trade Marks*, 2022:DHC:2681, where, at paragraph 14, the Court concluded that evidence provided by an applicant for registration of the Trade Mark should not be rejected by citing Section 65B and that, at best, the examiner may call for an affidavit under Section 65B.

4. With regard to the conclusion in the order that mere combination of two known words would not qualify as an

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invented word, learned counsel submitted that such conclusion was reached by relying on Section 9 of the Trade Marks Act, which was not referred to in the examination report. Even otherwise, learned counsel submitted that the said conclusion cannot be countenanced in relation to the device mark.

5. In response to these contentions, Mr.K.Subbu Ranga Bharathi, learned Central Government Standing Counsel, submitted that the application was rejected on account of the existence of one prior application in class 28 and also because a certificate under Section 65B was not provided.

6. The operative part of the impugned order is set out below:

> *"Attorney Reshma submitted that the subject mark i.e. CHUCHU TV is not descriptive it is distinctive applied mark is a label mark which is coined and invented conflicting mark cited in the examination report is visually and phonetically different and have different nature of goods Ld. Attorney further submitted*

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that principal of entirety of trademark must be considered Heard examine the application documents and reply to examination report Reply not satisfactory neither user documents filed to substantiate the user claimed continuously and extensively in the application since 2019 that the subject mark has been in the market nor disclose in the user affidavit the turnover under the subject mark nor the advertisement and promotional expenditure nor share value of the mark yearwise, territory of the use of mark in order to acquire distinctiveness moreover visually phonetically conceptually (i.e. Similarity in ideas) identical and deceptively similar marks are on record with same goods, trade channel and consumers are also same vide application no.4281624 i.e. CHU CHU which is valid and subsisting Conflicting mark is prior user than applicant there is likelihood to deceive or cause confusion regarding the origin of goods which includes the likelihood of association with the earlier trade mark in the mind of public Furthermore this is settled law that mere combination of two known words or abbreviation thereof, would not be an invented word even though the combination may not have been in use before if to the eye or ear the same idea would be conveyed as by the word in its ordinary form

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Furthermore Supreme Court in the case of Anwar PV v PK Basheer and Others held conclusively that documentary evidence in the form of an electronic record can be proved only in accordance with the procedure set out under Section 65B of the Evidence act hence objection maintained application refused under section 11(1) of the Trade Marks Acts 1999."

7. From the impugned order, it appears that the Registrar of Trade Marks rejected the application on the following grounds:

(i) the applicant/appellant did not disclose the turnover from use of the relevant mark, the advertisement and promotional expenditure, the share value of the mark, etc.

(ii) a conflicting mark under Application No.4281624 is valid and subsisting and the user of such conflicting mark is the prior user.

(iii) a mere combination of two known words or an abbreviation thereof would not qualify as an invented word.

(iv) electronic record should be proved by filing a certificate under Section 65B of the Evidence Act.

Each of these grounds warrant a brief discussion.

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8. The appellant had produced invoices and materials available online in the public domain as evidence of use of the mark. In addition, the appellant had produced registration certificates in respect of the mark 'CHUCHU TV' in other classes. In view of the availability of such evidence, the rejection of the application on the ground that the turnover and advertising expenditure was not provided cannot be countenanced.

9. As regards the cited mark, the search report annexed to the examination report indicates that the status of the mark was 'objected'. Therefore, the conclusion that the mark is valid and subsisting and that the use of the said mark preceded use by the appellant is untenable. In this regard, it is pertinent to point out that Application No.4281624 does not disclose the date of use and appears to be on a 'proposed to be used' basis. In fact, learned counsel for the appellant points out that the status of the said mark continues to be the same and that objection was raised under Section 9 in respect thereof.

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10. The conclusion that two known words or an abbreviation thereof would not qualify as an invented word is correct but entirely inapplicable to the device mark for which the registration has been applied for. As regards the conclusion that evidence cannot be accepted in the absence of a certificate under Section 65B of the Evidence Act, such certificate is required to be produced when an electronic record, which is within the possession, control or custody of the person producing such electronic record, is sought to be introduced as evidence. In the case at hand, the documents placed on record by the appellant are articles available online and posted by third parties/news agencies. Since the appellant is not the person within whose power, possession or control the said material is, the appellant is not in a position to and cannot produce a Section 65B certificate in respect thereof. Besides, as concluded by the Delhi High Court, it is always possible for the authority to access and examine the said content and, thereby, verify its genuineness. Therefore, the impugned order is unsustainable.

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11. For reasons set out above, CMA(TM) No..2 of 2023 is allowed and the impugned order is, hereby, set aside. By taking into account the previous registrations obtained by the appellant for the mark "CHU CHU TV", the evidence of use in the form of invoices and online content, the application is directed to be accepted for advertisement. This order will not, however, be binding on opponents, if any. There shall be no order as to costs. Consequently, connected miscellaneous petition is closed.

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Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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