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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **24.09.2024**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(TM)/6/2024

KX TECHNOLOGIES LLC
55 Railroad Avenue,
West Haven, CT 06516,
U.S.A. Through Power Agent
R.R.Nair, S/o.Mr.P.Raghavan,
aged 68 years, working at
De Penning & De Penning
120, Velachery Main Road,
Guindy, Chennai-600 032. ... Appellant

-vs-

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

PRAYER: Civil Miscellaneous Appeal (Trademarks) filed under Section 91 of the Trademarks Act, 1999, to set aside the impugned order dated 10.01.2024 of the respondent and consequently direct the respondent to permit the petitioner's Trade Mark Application No.2700393 to proceed to advertisement in the Trademarks journal.

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For Appellant : Mr.Dwarakesh Prabhakaran

For Respondent : Mr.S.Janarthanam, SPC

JUDGMENT

An order dated 10.01.2024 rejecting Application No.2700393 for registration of the word mark FACT is the subject matter of this appeal. The appellant applied for registration of the above mentioned word mark on 17.03.2014 on a "proposed to be used" basis. Such application was made for use of the mark in relation to filters used for purification of air and drinking water. The examination report dated 02.04.2014 was issued by the respondent raising objections both under Sections 9 & 11 of the Trade Marks Act, 1999. The objection under Section 9 was raised on the ground that the trade mark is devoid of distinctive character. As regards Section 11, three conflicting marks were cited. All the cited marks were registered trade marks of the Fertilisers & Chemicals Travancore Limited. By reply dated 08.05.2014, the appellant asserted that the trade mark was coined by the appellant and that it is not used to refer to the

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goods in respect of which the application was filed. As regards the objections on relative grounds, the appellant stated that it proposed to use the marks in relation to filters used for the purification of air and water, whereas, the cited marks are used in relation to products used in the fertilizer sector. Eventually, by the impugned order, the application was rejected by referring to the cited marks and to the fact that the appellant's trade mark had not acquired distinctiveness.

2. Learned counsel for the appellant referred to the application and pointed out that it is clear from the application that the appellant proposed to use the trade mark in relation to filters for purification of air and drinking water. He further submits that an application was filed in Form TM-M for amending the application by removing the words "namely chemical and mineral treatment of fiber pulp" so as to make it clear that the appellant does not intend to use the trade mark in relation to general chemical products. By referring to the search report annexed to the examination report, learned counsel further

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submitted that all the three cited marks are in relation to products used for the chemical and fertilizer sectors.

3. In reply to these contentions, Mr.S.Janarthanam, learned SPC, relies upon the examination report and the impugned order to contend that the cited marks were registered with effect from March 1963. Since the appellant applied on a "proposed to be used" basis in 2014, which is much later than the use of the earlier marks, he submits that the use of the appellant's trade mark is likely to cause confusion and deception.

4. The use and registration of a trade mark confer rights only in respect of identical or similar goods or services unless the relevant trade mark is declared to be a well known trade mark. On scrutiny of the search report annexed to the examination report, it is clear that all the three cited marks are owned by the Fertilisers & Chemicals Travancore Limited. From the description provided in relation to

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each mark, it is also evident that such mark is being applied to chemical products especially those used in the fertilizer sector. By contrast, on examining the appellant's trade mark application and the literature placed on record by the appellant, it appears that the appellant's trade mark is used in relation to products used for air and water purification.

5. In the appeal, the appellant has also stated that the word mark FACT is an acronym of "**F**ibrillated **A**dsorbent **C**ellulose **T**echnology". It is pertinent to notice that the appellant had applied for an amendment of the application so as to delete the words "namely chemical and mineral treatment of fiber pulp" from such application. If the appellant were to use the trade mark in relation to products used in the fertilizer industry, it is likely that it would result in confusion or deception among the public. On the other hand, if such use is confined to filters and other products used in the purification of air, water and fluids, such confusion or deception

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appears unlikely.

6. For reasons aforesaid, impugned order dated 10.01.2024 is set aside and it is directed that Application No.2700393 shall proceed to advertisement subject to the appellant providing a disclaimer that the trade mark shall be applied only in relation to products used for purification of air, water or fluids. It is made clear, however, that this order will not be binding on opponents, if any.

7. CMA(TM)No.6 of 2024 is disposed of on the above terms without any order as to costs.

24.09.2024

Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No
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SENTHILKUMAR RAMAMOORTHY,J.

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