2023:MHC:4366

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED **: 25.09.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/158/2023
(OA/26/2020/TM/CHN)

Heraeus Electro-Nite International N.V.
Centrum Zuid 1105,
Houthalen 3530,
Belgium. ... Appellant

-vs-

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

PRAYER: Transfer Civil Miscellaneous Appeal (Trade Marks) filed under Section 91 of the Trade Marks Act, 1999, praying that the impugned order issued by the Respondent dated 22 January 2020 and received by the Appellant on 23 January 2020 be set aside and the mark QuiK-Tap vide Application No.2637548 in class 9 in the

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name of Heraeus Electro-Nite International N.V. be allowed to proceed to registration.

For Appellant : Mr.Dwarakesh Prabhakaran
for M/s.De Penning and De Penning

For Respondent : Mr.P.G.Santhosh Kumar, SPC

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ORDER

The appellant assails the grounds of decision dated 21.01.2020 (wrongly mentioned as 22.01.2020 in the appeal) in support of the refusal order dated 09.02.2019 by which Trade Mark Application No.2637548 for registration of the word mark QuiK-Tap was refused.

2. The appellant applied for registration of the mark referred to above on 04.12.2013 in class 9 in relation to a device for insertion into steel to measure temperature. The application was filed by asserting use since 06.10.2010. By examination report dated 11.12.2013, the Registrar of Trade Marks raised objections both under Section 9 and

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11 of the Trade Marks Act, 1999 (the Act). The objection under Section 11 was raised by citing six marks. By reply dated 03.02.2014, the appellant responded to the objections under Section 9 by stating that the trade mark is a combination of two unique words, QUIK and TAP. The appellant further submitted that the said words are not commonly used in the trade to refer to the goods specified in the application. Consequently, it was stated that the trade mark is distinctive and eligible for registration. The cited marks were distinguished by stating that when the trade mark of the appellant is compared with the cited marks as a whole, the marks are distinguishable. After a hearing on 15.11.2018, by order dated 09.02.2019, the application was refused. The grounds of decision were provided about one year later on 21.01.2020. The present appeal was filed in the above facts and circumstances.

3. Learned counsel for the appellant invited my attention to the search report annexed to the examination report. He pointed out that

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the first cited mark Tap Dance was removed on account of non renewal. The second cited mark, QuiK Play, is in force but is clearly distinguishable according to learned counsel. As regards the third cited mark, Quik-Tap, learned counsel submitted that the present status is refused. He placed reliance on the document at page 26 of the additional paper book in such regard. As regards the fourth cited mark, Tap Tap, he submitted that the status is refused. As regards the fifth and sixth cited marks, he stated that these are marks of the appellant. In fact, he pointed out that the mark QuiK-Cup stands registered in favour of the appellant currently.

4. The next contention of learned counsel for the appellant was that the applicant for the third cited mark, QuiK-Tap, was a distributor of the appellant and that he was expressly restrained under the distribution agreement from using the mark QuiK-Tap. In support of the assertion regarding the use of the mark, learned counsel relied upon the user affidavit of Mireille Maenhoudt and the

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invoices enclosed in the original paper book. Therefore, learned counsel contended that the impugned order is unsustainable.

5. In response, Mr.P.G.Santhosh Kumar, learned SPC, submitted that the trade mark QuiK-Tap is descriptive of the intended purpose and characteristic of the goods to which such mark is applied. He also submitted that the evidence of use produced by the appellant is insufficient for establishing acquired distinctiveness.

6. The application discloses that the appellant had used the mark from 06.10.2010. In support of such use, the appellant filed the user affidavit dated 14.01.2014 and also enclosed invoices. The first invoice placed on record by the appellant was dated 06.10.2010. There are invoices from the year 2011, 2012 and 2013. Undoubtedly, therefore, the appellant did place evidence of use of the trade mark. Turning to the order of refusal, such order is bereft of reasons. The order draws reference both to Sections 9 and 11 of the Act. The

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grounds of decision were issued about one year later on 21.01.2020. Unlike the order of refusal, the grounds of decision only refer to Section 9(1) of the Trade Marks Act. As discussed earlier, the appellant placed on record evidence of use from the year 2010. Upon consideration thereof, in relevant part, the grounds of decision record the following findings:

> "*In this case the impugned trade mark has not acquired distinctive character before the date of filing of the application as mentioned in the proviso of Section 9 based upon the produced documentary evidences to substantiate the user claim. Hence, the impugned trade mark is descriptive for the applied goods which cannot be function as a trade mark and as such is not to be allowed for registration.*
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> *In my opinion the impugned trade mark comes under the category of incapable of registration as the same has described the intended purpose and quality of the applied goods. It is apparent that there are some words like*

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'QUIK-TAP' which are so apt for normal description that no amount of trade mark use can render such words "capable of distinguishing" the applicants' goods or services to justify exclusive appropriation. Therefore, Proviso to Section 9(1) does not come to rescue of applicants.

In view of these above mentioned case laws, impugned trade mark has neither acquired a distinctive character in the trade nor a capable of distinguishing the goods of a particular trader. In this position, I would like to enlighten the object of the Trade Marks Act, 1999. The said object is to provide for registration and better protection of trade marks for goods and services. If the trademark is allowed for registration, the object of the Trade Marks Act, 1999 would be jeopardised and the purity of the Register will be affected."

7. The first of the above extracts, merely records the conclusion that the trade mark has not acquired distinctive character in terms of the proviso to Section 9 based upon the produced documentary

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evidence. Conspicuous by its absence, are any reasons in support of the conclusion. The second extract, set out above, records the conclusion that the trade mark is descriptive and that no amount of trade use can render such words capable of distinguishing the goods of the appellant from those of others. This conclusion is also not preceded by reasoning. In this connection, it should be noticed that the appellant asserted in reply to the examination report that the words forming the trade mark bear no relation to the goods in relation to which the mark is applied. This contention was not considered and dealt with in the grounds of decision.

8. Learned counsel for the appellant also pointed out that the mark, QuiK-Cup, was registered in favour of the appellant after similar objections were raised previously. He placed on record proof of such registration (page 31 of the additional typed set of papers).

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9. In the above facts and circumstances, the order of refusal and the grounds of decision are unsustainable and are, hereby, set aside. By taking into consideration the evidence of use placed on record by the appellant, the fact that the cited mark was subsequently refused registration, the application shall be accepted for advertisement. The appeal stands disposed of on the above terms subject to the limitation that this order will not be binding on opponents, if any.

25.09.2023

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Index : Yes / No
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Neutral Citation: Yes/No

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