2023:MHC:4335

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED **: 21.09.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/108/2023
(OA/6/2021/TM/CHN)

The Ryzman Family Partnership,
2220, Gaspar Avenue, Los Angeles,
CA 90040, USA. ... 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 04 December 2020 and received by the Appellant only on 08 December 2020 be set aside and the mark "SURGI WAX" vide application No.3947193 in class 03 in the name of THE RYZMAN FAMILY PARTNERSHIP 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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ORDER

The appellant assails the grounds of decision dated 04.12.2020 in support of the order dated 23.09.2019 by which Application No.3947193 for registration of the mark "SURGI WAX" was refused. The appellant applied for registration of the above mentioned word mark on 17.09.2018 in Class 3 on a "proposed to be used" basis. The mark was proposed to be applied in relation to non-medicated skin care preparations, such as moisturizing lotions, cleaning lotions, etc. By examination report dated 22.10.2018, the Registrar of Trade Marks raised objections under Section 11(1) of the Trade Marks Act, 1999 (the Trade Marks Act) by citing the mark SURGI - STAIN. The said mark was registered in relation to a product used for removal of stains from stainless steel surgical instruments in class 3. By reply dated 20.12.2018, the appellant stated that the appellant's mark and

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the cited mark should be compared as a whole and not by splitting such marks into the respective constituents. The appellant further stated that the goods to which the appellant's mark is applied and the goods to which the cited mark is applied are dissimilar. After a hearing on 23.07.2019, by order dated 23.09.2019, the application was rejected by citing both Section 9 and Section 11(1)(a) of the Trade Marks Act. The grounds of decision were issued on 04.12.2020. The present appeal was filed in the said facts and circumstances.

2. By inviting my attention to the appellant's mark, learned counsel for the appellant submitted that the mark was proposed to be applied in relation to skin care preparations. By contrast, he pointed out that the cited mark SURGI - STAIN is applied to a product used for the removal of stains from stainless steel surgical instruments. Therefore, he submitted that the goods of the appellant and the goods of the proprietor of the cited mark are completely different. Learned counsel pointed out that these aspects were dealt with in the

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reply dated 20.12.2018. By turning to the impugned order, learned counsel pointed out that the said order refers to the absolute grounds of refusal under Section 9 of the Trade Marks Act although such grounds were not raised in the examination report. By drawing reference to the grounds of decision, he pointed out that the grounds of decision referred to Section 11(1)(b) of the Trade Marks Act, whereas the order dated 23.09.2019 referred to Section 11(1)(a) of the Trade Marks Act. For all these reasons, learned counsel submitted that the impugned order is unsustainable.

3. In response, Mr.S.Diwakar, learned SPC, contended that the appellant's mark SURGI WAX is clearly descriptive of the intended purpose and kind of goods to which the mark was proposed to be applied. In addition, he submitted that the marks SURGI WAX and SURGI-STAIN are deceptively similar and such marks are applied to the same class of goods (class 3). Hence, he submitted that no interference is warranted with the impugned order.

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4. The application reveals that the mark SURGI WAX was proposed to be used in relation to skin care preparations. By contrast, the registered trade mark SURGI - STAIN is used in relation to a rust and stain remover from stainless steel surgical instruments. Section 11(1) of the Trade Marks Act becomes applicable when the mark for which an application is filed is identical or similar to an earlier trade mark and the goods or services concerned are either identical or similar. In this case, there is some similarity between the marks but the goods are certainly not identical. The question as to whether the goods are similar or not cannot be decided merely by reference to the class in which the application is filed. Put differently, goods falling within the same class may be different whereas goods falling in different classes may be similar. The determination as to whether goods are similar or dissimilar is required to be made by taking into account multiple factors such as whether the goods concerned can be used as substitutes, and whether the goods concerned are directly complementary. The

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origin of the goods and the intended purpose also play a role. Reference may be made to the judgment in *Hatsun Agro Products Limited -vs- Arokiya Foods, MANU/TN/6029/2022*, where I discussed the law on the subject extensively.

5. As discussed earlier, the cited registered mark is applied in relation to a rust and stain remover for use in relation to stainless steel surgical instruments. By taking into consideration the range of factors discussed in the preceding paragraph, it appears that the goods are not similar goods. If the goods are not similar, Section 11(1) of the Trade Marks Act is inapplicable. Consequently, unless the registered proprietor of the earlier mark is able to establish that such mark is a well known mark and that the requirements of Section 11(2) are satisfied, the registration cannot be refused on that ground.

6. As regards the absolute grounds of refusal, such grounds were not raised in the examination report. The impugned order

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becomes unsustainable on that ground. In addition, as stated by the appellant in the reply to the examination report, the mark should be compared as a whole and not by splitting a mark into components.

7. For all these reasons, the impugned order cannot be sustained and is hereby set aside. By taking the facts and circumstances into account, this is an appropriate case for the application to be accepted for advertisement subject to the limitation that the appellant shall not claim exclusive use of the words SURGI or WAX, when used separately. This order shall not be binding on opponents, if any. The appeal stands disposed of on the above terms.

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rna/gvn
Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes/No

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