2023:MHC:3903

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 24.08.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM).No.148 of 2023
(OA/25/2019/TM/CH)

Prakash Ferrous Industries Private Limited,
Registered Office:
Survey No.27/, Urandur Village,
Sri Kalahasti Mandal, Pin - 517644,
Andhra Pradesh, India.

and

Administrative Office:
47/07, 1st Floor, Prestige Point,
Haddows Road, Nungambakkam,
Chennai - 600006, Tamil Nadu. ...Appellant

Vs.

The Registrar of Trade Marks,
Intellectual Property Buildings,
GST Road, Guindy,
Chennai – 600 032. ...Respondent

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Prayer: Transfer Civil Miscellaneous Appeal (Trade Mark) filed under Section 91 of the Trade Marks Act, 1999, praying to set aside the impugned order passed on 09.11.2016 vide Ref No-TLA/373, dated 28.11.2016 against the appellant's Trade Mark Application No.2080181 in Class 6 and direct the Registry to register the mark thereof.

For Appellant : Ms.Scarlet Danielle Grey
for M/s.Anand and Anand

For Respondent : Mr.P.G.Santhosh Kumar

JUDGMENT

The appellant applied for registration of the Trade Mark "TIRUMALA" as a word mark in Class 6 under Application No.2080181. Upon examination, by communication dated 25.11.2013, the Registrar of Trade Marks raised objections both under Sections 9 and 11 of the Trade Marks Act, 1999. As regards the objections under Section 11, four marks were cited. The appellant filed a reply to the examination report on 31.08.2015. Pursuant thereto, a personal hearing was held and the impugned order was pronounced on 09.11.2016. Hence, this appeal.

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2. Learned counsel for the appellant submitted that the mark TIRUMALA has been used by the appellant since 26.12.2007 in relation to TMT steel rods. By taking into account the goods in relation to which the mark is applied, learned counsel contends that the objection under Section 9 is completely untenable. As regard the objection under Section 11, learned counsel points out that the first cited mark TIRU was not renewed after 29.08.2011; the second cited mark TIRUS is clearly distinguishable; the third cited mark TIRUMALA under Application No.1887225 was abandoned on 25.09.2023 pursuant to opposition by the appellant; and the fourth cited mark is the appellant's mark. Therefore, learned counsel contends that the impugned order is liable to be set aside.

3. In response, Mr.P.G.Santhosh Kumar submits that the impugned order was issued on account of the existence of the cited conflicting marks. He further submits that the appellant failed to provide evidence in support of use of the mark TIRUMALA.

4. The impugned order is typically cryptic. The operative portion thereof is as under:-

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"1. The trade mark applied for is objectionable under Section 9/11 of the Act. The application is accordingly refused.

Attention is invited under Rule 40(1) of the Trade Marks Rules, 2002 where the application is refused a request may be made in form no TM-15 along with the prescribed fee of Rs.1000/- to communicate in writing the grounds of decision and materials used by the Registrar in arriving at his decision to refuse the said application. The said request on form TM-15 should be tendered within 30 days of receipt of the order of refusal."

5. Notwithstanding Rule 40(1) of the Trade Marks Rules, 2002 or the currently applicable Rule 36(1) of the Trade Marks Rules, 2017, a quasi judicial authority cannot fight shy of providing reasons for its decision. On that short ground, the impugned order is unsustainable and is hereby set aside. Given the fact that the evidence of user does not appear to have been placed before the authority, I am not inclined to directly order that the application proceed to advertisement. Instead, the matter is remanded for reconsideration and the appellant is permitted to place evidence of use before the authority.

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After providing a reasonable opportunity to the appellant, a reasoned decision shall be provided within a period of three months from the date of receipt of a copy of this order. The appeal is disposed of on the above terms.

24.08.2023

Index:No
Speaking order
Neutral Citation:Yes
hvk

To

The Registrar of Trade Marks,
Intellectual Property Buildings,
GST Road, Guindy,
Chennai – 600 032.

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SENTHILKUMAR RAMAMOORTHY,J.

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