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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 05.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

CMA(TM) No.7 of 2023

HMD GLOBAL OY
Bertel Jungin aukio 9 FI-02600
Espoo, Finland
having its address for service in India at
32A, Krishna Street, T.Nagar
Chennai - 600 017 ... Appellant

Vs.

The Registrar of Trade Marks,
Office of the Trademark Registry
Intellectual Property Bhavan
Besides Antop Hill Post Office
S.M.Road, Antop Hill, Mumbai 400 037
and having its branch at
Intellectual Property Office Building
GST Road, Guindy, Chennai - 600 032 ... Respondent

Prayer : Civil Miscellaneous Appeal filed under Section 91 of the Trade Marks Act, 1999 to set aside the order dated 13.01.2023 passed by the respondent, refusing the application for registration of the trade mark under No.4110705 in Class 09 and consequently direct the respondent to advertise the application in Trade Marks Journal.

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For Appellant : Ms.Antara Balaji
for Mr.Rajesh Ramanathan

For Respondent : Mr.A.R.Sakthivel
Senior Panel Counsel

JUDGMENT

This appeal is directed against the order of the respondent dated 13.01.2023, rejecting appellant's application for registering its word mark "PureDisplay' under Section 9(1)(a) of the Trade Marks Act, 1999. The solitary ground on which the respondent has rejected is that the word mark of the appellant lacks distinctiveness.

2. The learned counsel for the appellant submitted that the trade mark is owned by a Finnish Corporation, Finland which has registration across the globe and it applied for registering its mark under class 9, more particularly for the following goods 'Mobile phones, smart phones, tablet computers, handheld media players, displays for smart phones, displays for mobile phones, displays for tablet computers, displays for handheld media players, touch displays, light emitting diode (LED) displays, apparatus for recording, transmission or

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reproduction of sound or images'. She added that the appellant has not applied for two separate words 'Pure' and 'Display', but it is for 'PureDisplay' as a composite word which the respondent has ignored. Secondly, it has also ignored the evidence filed by the appellant showing that the said mark has been registered in various countries. Thirdly, the appellant has also been using the said mark since 2018 and the respondent has ignored the user evidence filed by the appellant.

3. On scrutinising the application of the appellant, the Trade Marks Registry has raised a preliminary objection under Section 9(1)(a) on the ground that appellant's mark lacks distinctive character. The appellant had responded to the same and this was followed by the first set of three hearing notices from the Trade Marks Registry, whose details are as below:

Hearing	***Date of Notice***	***Date of hearing***
I hearing notice	24.02.2020	08.04.2020
II hearing notice	11.10.2021	09.11.2021
III hearing notice	01.08.2022	28.09.2022

4. On each of the occasions, the appellant had appeared before the Registrar of

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Trade Marks and made his submissions.

5. In the meantime, the appellant had also applied for registering its mark in various other jurisdictions. Between the second hearing and the third hearing, the appellant had its mark registered in few other jurisdictions. Under these circumstances, the appellant had brought them to the notice of the respondent during his submissions made in the third hearing notice. It is after the third hearing, the Registrar has chosen to reject the application vide his impugned order.

6. Heard both sides and perused the materials available on record in the form of typed set of papers.

7. The learned counsel for the appellant submitted that while the preliminary objection of the Registry to register appellant's mark was raised under Section 9(1)(a) and when appellant has also made his submissions to each of the hearing notices, only for 9(1)(a), the respondent had refused registration under Section 9(1)(b). Learned counsel added that Section 9(1)(a) and 9(1)(b) are not overlapping provisions, but have their distinctive area of operation, and when the appellant was put on notice only vis-a-vis the objection under Section

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9(1)(a), to pass an order under Section 9(1)(b), without giving the appellant an opportunity of being heard in the matter, involves gross violation of principles of natural justice.

8. If the doctrine *'res ipsa loquitur'* can be applied, then nothing more needs to be added to the submissions of the counsel for the appellant. The facts being what they are, this court has little hesitation in holding that the impugned order of the respondent cannot be sustained.

9. In conclusion, this court sets aside the order of the respondent dated 13.01.2023 made in application No.4110705 and remands the matter back to the respondent, who is now required to continue to process appellant's application from the stage where it was left. The respondent is also required to take its final decision in the matter, as expeditiously as possible, at any rate, not later than six months from the date of receipt of a copy of this order.

05.03.2024

Asr
Index: Yes/No
Speaking Order / Non-Speaking Order

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Neutral Citation: Yes / No

To

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N. SESHASAYEE, J.

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