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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

\+ C.A.(COMM.IPD-TM) 2/2023

MANKIND PHARMA LIMITED ..... Appellant

Through: Ms. Saumya Bajpai, Advocate.

versus

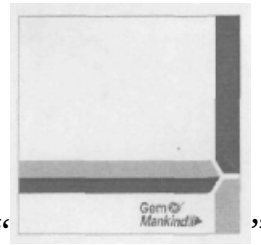
REGISTRAR OF TRADE MARKS ..... Respondent

Through: None.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 06.02.2023

1. The present appeal under Section 91 of the Trade Marks Act, 1999 [hereinafter, "***the Act***"] is directed against the order dated 16th August, 2019, read along with Statement of Grounds of Decision dated 06th September, 2019, both issued by Senior Examiner of Trade Marks, whereby Appellant's application no. 3032470 dated 14th August, 2015 [hereinafter "***the application***"] for registration of device mark "

" in Class 1 [hereinafter "***subject mark***"] was refused.

2. The relevant portion of the Statement of Grounds of Decision reads as follows: -

"With reference to the above and request on Form TM-M dated

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30/08/2019. It has been decided by the Registrar of Trade Marks to inform you that hearing in respect of above application was held on 11/07/2019 and the said application is refused on the following Grounds;

**11(1)(a) Relative grounds for refusal of registration.- The said trade Mark is refused for registration because of its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or*

11(1)(b) Relative grounds for refusal of registration. The said trade Mark is refused for registration because of its similarity to earlier trade mark and identity or similarity of the goods or services covered by the trade mark there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

Identical/Similar, valid marks with same classification vide application no. 1075520 is already on record. Likelihood of confusion. The applicant claimed to be user from 2015 but failed to establish the user by filing of evidence of use by way of affidavit and sufficient supporting documents. Objection under Section (11) sustained. Trademark application is accordingly refused under Section 18(4) of the Trade Marks Act, 1999."

3. The Examiner has rejected the subject trademark as per Section 11 (1)(a) and (b) of the Act, citing similarities between the subject trademark and previously registered and other cited trademarks. The Examiner believes that such similarities have the potential to confuse the general public.

4. The three cited similar marks are as follows: -

Sl. No.	**Mark**
1.	"G E M" (Word) Application No. 307633
2.	"GEM" (Word) Application No. 1075520
3.	" GEM " (Device) Application No. 1946717

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5. Ms. Saumya Bajpai, counsel for Appellant, states that first cited mark no. 307633, is likely to be removed from the register on account of non-filing of renewal request; second mark no. 1075520, is for a different category of goods; and third cited mark no. 1946717 has been abandoned. That apart, subject mark is a device mark comprising of artistic work of stripes and words "GEM MANKIND" in stylised font. The commonality between the subject mark and cited marks only extends to use of generic word "GEM". Accordingly, in the *prima facie* opinion of the Court, subject mark does not attract Section 11(1) (a) and (b) of the Act.

6. Moreover, identical mark has already been registered in favour of the Appellant in other classes i.e., Class 3 – TM application no. 3032471; Class 5 – *vide* application no. 3032472; Class 10 – TM application no. 3032473; Class 30 – TM application no. 3032474; Class 31 –TM application no. 3032475; Class 32 – TM application no. 3032476; Class 35 – TM application no. 3032477, which are currently valid.

7. In view of the above, the present appeal is allowed with following directions:

(a) The impugned order dated 16th August, 2019 and Statement of Grounds of Decision dated 06th September, 2019 are set aside.

(b) Trademark Registry is directed to proceed for advertisement of application no. 3032470 for subject mark, within a period of three months from today.

(c) If there is any opposition, the same shall be decided on its own merits, uninfluenced by observations made hereinabove.

(d) It is clarified that subject mark shall not grant any exclusive rights in the word "GEM". This disclaimer shall be reflected in the trade marks

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journal at the time of advertisement and also if the subject mark ultimately proceeds for registration.

8. With the above directions, the appeal is disposed of.

9. Registry is directed to supply a copy of the present order to the Trademark Registry at llc-ipo@gov.in for compliance.

SANJEEV NARULA, J

FEBRUARY 6, 2023
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