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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 14.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

CMA(TM) No.13 of 2023

Ramesh Bishnoi ... Appellant

Vs.

The Registrar of Trade Marks,
Office of the Trade marks Registry
Intellectual Property Building
G.S.T. Road, Guindy
Chennai - 600 032 ... Respondent

Prayer : Civil Miscellaneous Appeal filed under Section 91 of the Trade Marks Act, 1999 to allow the appeal against the order of the respondent dated 14.09.2023 and set aside the same and accept the Trade Mark Application No.4869008 filed on 18.02.2021 and advertise in the Trade Marks Journal.

For Appellant : Ms.Gladys Daniel

For Respondent : Mr.R.Prasath
Addl. Central Govt. Standing Counsel

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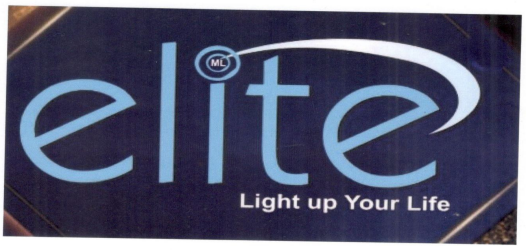
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JUDGMENT

This appeal is directed against the order of the respondent dated 14.09.2023, by which the respondent had refused to entertain appellant's application for registering its mark.

2. The facts are :

(a) Claiming user of a word mark 'ELITE' from April, 2009, on 18.02.2021, the appellant had applied for registering that mark with the device mark with a colour scheme under class 11, which is as below:



(b) The respondent had made a search and had found atleast six other registered marks in the same class which substantially use the word 'ELITE'.

(c) The Registrar raised a preliminary objection to appellant's registration

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of mark, and it was to the effect that it bears striking resemblance to one of the marks which she got to know from the search report.

(d) The appellant had responded to the said objection, following which the appellant was invited for a hearing by the respondent. In the course of hearing, the appellant tried to establish that he has been using the mark since 2009, that he had granted licence to another sister entity namely 'MICROLIGHTS' to use the same mark, and also produced several documentary evidence to show the bonafide of appellant's claim vis-a-vis the user of its mark.

(e) So far as the objection on merit as pertaining to the alleged similarity which the appellant's mark is stated to be bearing with another mark owned by certain Mrs.Saroj Sharma is concerned, the appellant had already moved the IPAB with a petition under Sec.57 of the Act, seeking rectification of the mark, and to have the mark registered as 3557784 in the name Mrs.Saroj Sharma, cancelled. After the abolition of IPAB, the matter has moved to Gujarat High Court, and it is now pending consideration in R.A.No.42 of 2002

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3. Ms.Gladys Daniel, the learned counsel for the appellant proceeded to submit that the respondent herein (a) had disbelieved or at least was inadequately convinced about the pendency of the rectification petition before the Gujarat High Court; (b) disbelieved the user status of the appellant's mark. She added, in fitness of things, the Registrar should have waited till at least the mark is advertised in the Trade Mark journal. After all, that would pave the way for informing those who are likely to be affected by the registration of the appellant's mark and would be the occasion when the appellant should establish the user status, for the user status will be relevant only when there is an opposition to the registration of the mark. The learned counsel for the appellant further submitted that the hearing had happened on-line and possibly the respondent might not have been able to appreciate the entire arguments.

4. The learned Additional Central Government Standing Counsel appearing for the respondent submitted that earlier the appellant had filed an application for registration of its trade mark in A. No.3224642. That application came to be rejected and the appellant has now filed a second application in A. No.4869008 for an identical purpose. In other words, what the appellant now attempts is a

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virtual action replay of what had already been done.

5. The learned counsel for the appellant would now submit that the earlier application in A. No.3224642 came to be rejected on the ground that the appellant had not responded to the examination report and consequently, the Registrar had held that the appellant had abandoned its earlier application. She submitted further that the Trade Mark Registry had not applied its mind to the merit of the first application, and hence, the appellant had chosen to file the second application for which there is no statutory prohibition under the scheme of the Trade Marks Act.

6. Rival submissions are carefully weighed. If the quintessence of the order is carefully weighted, it discloses in effect the twin submissions which the learned counsel for the appellant had made. Primarily, the Registrar is essentially required to evaluate the merit of the application for registration of the trade mark either under Sec.9 or under Sec.11(1) of the Act. That a petition for rectification is pending elsewhere between the appellant and the rival claimant need not *per se* bother the Registrar of Trade Marks, while considering an application for registration. Though nothing prevents the respondent from

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considering its pendency, what is contextually significant here is that the respondent has cited its inability to ascertain about the pendency of a rectification petition which is said to have been filed by the appellant (which is now stated to be pending before the Gujarat High Court) as a ground. That by itself is not an adequate ground that may prompt the respondent to refuse registration. After all, if the Registrar wants certain particulars about it, he/she could have asked the appellant to provide the information.

7. Turning to the second objection of the respondent vis-a-vis the user status, the learned counsel submits that the appellant had produced a copy of the licence document under which the appellant has permitted M/s.Microlights to use its trade mark. If that is so, blindly the Registrar of Trade Marks had overlooked the said material.

8.To conclude, this matter has to be re-appreciated by the respondent and hence this court deems it appropriate to remand the matter back to the respondent.

9. In conclusion, this appeal is allowed and the impugned order is set aside. The matter is remanded back to the Trade Mark Registry, who shall now provide an

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opportunity to the appellant to explain his objections. To save embarrassment to the Controller/Ecxaminer who had earlier passed the order, this court now requires that the appellant's application be considered by some other Controller/Examiner. No costs.

14.03.2024

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

To

The Registrar of Trade Marks,
Office of the Trade marks Registry
Intellectual Property Building
G.S.T. Road, Guindy
Chennai - 600 032

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N. SESHASAYEE, J.

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