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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **10.11.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/143/2023
(OA/20/2019/TM/CHN)

Cabot Corporation
a Delaware Corporation
Two Seaport Lane, Suite 1300
Boston, Massachusetts, 02210
United States of America. ... Appellant

-vs-

The Registrar of Trade Marks
Trade Marks Registry
Chennai. ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Trademarks) filed under Section 91 of the Trade Marks Act, 1999, to allow the present appeal and set aside the order dated 07.12.2018 issued by the respondent refusing the mark 'PROPEL' vide application No.2917721 in Class 1 and to allow the mark PROPEL to proceed to registration.

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For Appellant : Mr.Dwarakesh Prabhakaran
for M/s.De Penning and De Penning

For Respondent : Mr.S.Diwakar, SPC

JUDGMENT

The appellant challenges the grounds of decision issued on 07.12.2018 in support of the order dated 16.10.2018 by which Application No.2917721 for registration of the word mark "PROPEL" in Class 1 was refused.

2. The appellant submitted the application referred to above on 05.03.2015 in relation to carbon black materials. By examination report dated 08.09.2016, an objection was raised under Section 11(1) of the Trade Marks Act, 1999 (the Trade Marks Act), by citing two marks. The appellant replied thereto on 08.03.2017 by stating that both the cited marks are distinguishable. By order dated 16.10.2018, the application was rejected by referring to Sections 9 & 11 of the Trade Marks Act. The statement of grounds of decision was issued on 07.12.2018. In the statement of grounds of decision, the two marks

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cited in the examination report were referred to as the reason for refusal. The present appeal arises in the above facts and circumstances.

3. Learned counsel for the appellant invited my attention to the search report annexed to the examination report. With reference to the first cited mark (Trade Mark Application No.1712697), he submitted that the proprietor of the relevant trademark consented to the registration of the mark "PROPEL" by the appellant under the communication of 24.01.2019. As regards the second cited mark (Trade Mark Application No.1944912), he submitted that such registration is in respect of a composite device mark comprising three elements. In this connection, he also referred to the prosecution history of the said mark. With specific reference to the reply issued by the Indian Oil Corporation Limited (Indian Oil) to the examination report, he pointed out that Indian Oil distinguished its mark from the label mark "PROPEL", by relying on the three

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elements of Indian Oil's label mark. For all these reasons, learned counsel submitted that the impugned order is unsustainable.

4. In response to these contentions, Mr.S.Diwakar, learned SPC, submitted that the application of the appellant was rejected on account of the presence of the two cited marks on the Register of Trademarks. He further submitted that both the cited marks are deceptively similar and that both the marks were registered in Class 1 in relation to similar goods. Therefore, learned SPC submitted that the impugned order does not call for interference.

5. On examining the application of the appellant, it is clear that the mark “PROPEL” is intended to be applied to carbon black materials, which are chemicals used in tyres and as an insulating agent in other applications. The search report annexed to the examination report discloses that the first cited mark, namely, “PROPELL” is registered in Class 1 and applied to chemicals for use

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in purification through displacement chromatography. The proprietor of this mark has, *albeit* subsequent to the impugned order, consented to the registration of the appellant's trademark. While the consent of the proprietor of the cited mark is not sufficient by itself to preclude an objection by the Registrar of Trademarks, when considered in the context of the fact that the appellant uses the mark in relation to carbon black materials, whereas the first cited mark is used in relation to chemicals used for purification in displacement chromatography, the objection on the basis of the first cited mark is no longer sustainable in view of the consent.

6. Turning to the second cited mark, it is undoubtedly a composite label mark comprising at least three elements. Section 17(1) of the Trade Marks Act makes it abundantly clear that the registration of a composite mark consisting of more than one element provides protection to the mark as a whole. Sub-Section 2 thereof, which opens with a non obstante clause, makes it abundantly clear

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that protection will not be provided to the individual elements of such composite mark unless the proprietor applies for and obtains a registration separately for such individual elements. It is not the case of the Registrar of Trademarks that Indian Oil has a registration for the element "PROPEL" in the composite mark. In those circumstances, the objection on the basis of the second cited mark is also not tenable.

7. For the reasons set out above, the impugned order is set aside and it is directed that the application shall proceed to advertisement. It is, however, made clear that this order will not be binding on opponents, if any. (T)CMA(TM)/143/2023 is allowed on the above terms, without any order as to costs.

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Index : Yes / No
Internet : Yes / No
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