2023:MHC:3818

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **18.08.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/88/2023
(OA/16/2020/TM/CH)

American Heart Association, INC,
7272 Greenville Ave., Dallas,
Texas 75231, US ... Appellant

-vs-

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

PRAYER: Transfer Civil Miscellaneous Appeal (Trademarks) filed under Sections 91 of the Trademarks Act, 1999, praying that the order issued by the Respondent dated 24 September 2019 and received by us on 03 October 2019 be set aside and the Application No.3970773 for the Trademark



in classes 35, 36 and 41 be allowed to proceed to registration.

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For Appellant : Mr.R.Rajesh
for M/s.De Penning and De Penning

For Respondent : Mr.A.R.Sakthivel, SPC

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JUDGMENT

The appellant assails an order dated 24.09.2019 by which Application No.3970773 for registration of the device mark



was refused by citing Section 9(1)(a) of the Trade Marks Act, 1999 (the Trade Marks Act).

2. The appellant is a company incorporated in Texas, United States of America, under the name and style of American Heart Association, Inc. The appellant filed an application on 11.10.2018 for registration of the device mark extracted above in classes 35, 36 and

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41 by way of a multi-class application. Upon examination, by communication dated 16.11.2018, the Registrar of Trade Marks raised an objection under Section 9(1)(a) of the Trade Marks Act on the ground that the mark is non distinctive and, consequently, incapable of distinguishing the services of the appellant from those of others. In response thereto, the appellant submitted a reply dated 14.01.2019. In relevant part, the reply is as under:

> "*With regard to the **objection under Section 9**: it is submitted that the subject trademark is represented in a stylized and composite form (along with a logo), hence on the whole inherently distinctive. The nature of services is highly specific to the field of Cardiology and with public interest as the core objective. The main activity under the said trade mark is to launch a movement to train the general public on first aid and CPR and to sensitize the need to act quickly on a person suffering from cardiac arrest. The source of the services offered will be well explained and known to the stake holders and the general public. Hence, the subject trade mark will not be perceived to be descriptive or non distinctive. Further, the said applicant is already active in India offering the relevant service under the subject trade mark, a snap shot from the website www.heartandstroke.in is enclosed herewith for your reference.*"

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3. Pursuant to a personal hearing, the order dated 23.07.2019 was issued. In relevant part, the order reads as under:

> "*sonu Applicant/Advocate/Agent appeared before me and made his submissions. I have heard arguments, gone through the records and passed the following Order.
>
> *9 - Absolute grounds for refusal of registration.
>
> *9(1)(a) - The trade mark is devoid of any distinctive character, that is to say, not capable of Distinguishing the goods or services of one person from those of another person."

4. Since no reasons were discernible from the order, the appellant requested for the grounds of decision as per Rule 36(1) of the Trade Marks Rules, 2017. In response, by communication dated 24.09.2019, the purported grounds of decision were provided. In relevant part, the grounds of decision are as under:

> "*Adv. sonu appeared and submitted that mark is distinct and not descriptive heard, examine the application mark has direct reference to the quality and characteristics of the goods or

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services mark is highly descriptive for the applied goods hence not distinctive reply is not satisfactory hence application is refused under Section 9(1)(a) of the act."

5. Learned counsel for the appellant provided an overview of the facts by taking me through the documents adverted to above. He also placed for consideration the registrations obtained in respect of near-identical device marks in various jurisdictions. He further pointed out that the appellant obtained registration for a composite mark comprising an identical device albeit with the words 'American Heart Association' instead of Heart and Stroke Foundation India a subsidiary of American Heart Association. Learned counsel further contended that the explanation of the appellant with regard to the distinctive nature of the composite mark was not taken into consideration while passing the impugned order. For all these reasons, he contends that the impugned order is liable to be set aside and that directions be issued for the advertisement of the mark.

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6. In response to these contentions, Mr.A.R.Sakthivel, learned counsel, submits that the composite mark consist of the words 'Heart and Stroke Foundation', which are not only descriptive but specifically descriptive of the nature of services provided by the appellant. He submits that the appellant cannot be permitted to appropriate these words and prevent other stake holders in the medical sector from using these words. Therefore, he submits that the impugned order does not call for interference.

7. On examining the impugned mark, it is evident that it is a composite mark with a prominent device. The said device consists of a heart in black colour, a flaming torch in white colour with a small flame in white colour enclosed by a larger flame in black colour. The words “Heart and Stroke Foundation India a subsidiary of American Heart Association” are used along with this device. At the time of application, the composite mark was proposed to be used in India.

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However, while responding to the examination report, the appellant has stated that the mark is being used in India in relation to services provided by the appellant. The contention that the appellant has obtained a composite mark registration containing an identical device, albeit with the words 'American Heart Association' is not denied by the respondent. The registrations obtained by the appellant for near identical marks in multiple jurisdictions are on record and learned counsel for the appellant cited the decision in ***Dubai Islamic Bank v. Union of India, order dated 04.12.2019 in W.P.No.12749 of 2019***, particularly paragraph 12 thereof, to substantiate the contention that registrations obtained overseas may be taken into consideration by the Registrar of Trade Marks.

8. In respect of the concern voiced by Mr.A.R.Sakthivel, with regard to the descriptive nature of the words 'Heart and Stroke Foundation', it is pertinent to draw reference to Sub-Section 4 of Section 18 of the Trade Marks Act, which is as under:

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> *"4. Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit."*

In view of sub section 4, it is always possible for the Registrar of Trade Marks to impose conditions or limitations, wherever appropriate.

9. The order dated 23.07.2019 is entirely bereft of reasons. As a quasi-judicial authority, notwithstanding Rule 36(1) of the Trade Marks Rules, it is incumbent upon the Registrar of Trade Marks to engage with the submissions of the applicant and specify reasons for not agreeing with such submissions. It is wholly insufficient to merely record conclusions *ipse dixit*. Even the purported grounds of decision merely recorded conclusions and did not set out reasons for rejecting the response of the appellant to the examination report. Therefore, the order dated 23.07.2019 and the grounds of decision are clearly unsustainable.

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10. By taking into account the nature of the composite mark; the fact that the appellant obtained registration for a composite mark comprising an identical device; and the fact that registrations were obtained in multiple jurisdictions outside India, this is a fit case to proceed with advertisement. Therefore, (T)CMA(TM)/88/2023 is allowed, the orders dated 23.07.2019 and 24.07.2019 are set aside and the respondent is directed to advertise the mark and, thereafter, proceed in accordance with the Trade Marks Act and the rules framed thereunder. There shall be no order as to costs

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Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes/ No

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