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

\+ C.A.(COMM.IPD-TM) 108/2021

SURENDER KUMAR ..... Appellant

Through: Mr. M.K. Miglani, Advocate.

versus

REGISTRAR TRADE MARKS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, Central Government Standing Counsel with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advocates.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 17.02.2023

1. The present appeal under Section 91 of the Trademarks Act, 1999 arises from order dated 04th October, 2019 passed by the Senior Examiner [*hereinafter*, "***impugned order***"], refusing registration for Appellant's mark "CANON" under application No. 2879533 in class 11 for Sanitary Wares (non-ceramic) [*hereinafter*, "***subject mark***"].

2. The reasons disclosed in the impugned order are as follows:

> "** Sh. Sunil Kumar Applicant/Advocate/Agent appeared before me and made his submissions. I have heard arguments, gone through the records and passed the following Order.*
>
> ** 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 an earlier trade mark and the*

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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."

3. The Senior Examiner has objected to registration of the subject mark under Section 11(1)(a) and (b) of the Trademarks Act in view of conflicting mark cited in the examination report, extracted hereunder:

LOCATION:
SECTION: EXM
REPORT: EXM007

WORD MARK SEARCH REPORT
APPLICATION NUMBER: 2879533
Class : ---
TRADEMARK: 'CANON'

USER : SHP
PAGE:1
DATE: 23/01/2016

APPL NO	CLASS	CONFLICTING MARK	JOURNAL No	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	TM IMAG
GOODS SERVICES							
401567	11	CANON	974	CANON KABUSHIKI KAISHA	30 - 2, SHIMOMARUKO 3 - CHOME, OHTA - KU, TOKYO, JAPAN.	Registered	

APPLICATION DATE 17/02/1983

GOODS/SERVICE INSTALLATIONS FOR LIGHTING, HEATING, STEAM GENERATING, COOKING, REFRIGERATING, DRYING, VENTILATING, WATER SUPPLY AND SANITARY PURPOSES.

4. The afore-said conflicting mark "CANON" was registered *w.e.f.* 17th February, 1983. However, it emerges that in an earlier litigation between Appellant and the registered proprietor of the cited mark, a settlement came about, basis whereof on a joint application of parties under Order XXIII Rule 3 of the CPC, the suit was decreed by this Court on 08th July, 2014.[1] The copies of the application as well as the decree binding the parties to settlement terms have been placed on record. The agreed terms are as under:

"*2. The Plaintiffs and the Defendant No. 2 & 3 have agreed to settle their disputes arising in the present suit and are entering into a settlement on terms set hereinafter.*

a. Subject to sub clause (b) and (c), the Defendant No. 2 & 3 would limit and restrict the use and registration of the mark "CANON", to the following goods, within the territory of India: "nuts, bolts, rivets, screws, fasteners, washers, railing, false ceiling & flooring, pipes & tubes (metallic), hand tools sanitary wares (non ceramic), building materials viz. tiles, flooring and ceiling and services of repair arid maintenance and contracts in relation to the aforesaid goods.

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[1] In CS(OS) 82/2007.

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5. Thus, under the settlement between the parties, Canon Kabushiki Kaisha (proprietor of cited mark) consented to Appellant's use and registration of the subject mark for certain goods, which includes sanitary wares (non-ceramic) falling in class 11, in respect whereof application No. 2879533 has been filed. The Appellant, in its reply to the examination report dated 18th March, 2016 had brought the above-noted to the notice of the Senior Examiner, but same has been overlooked and subject mark was denied registration.

6. Since there was a binding agreement between the parties which forms the basis for a court decree, reasons disclosed in the impugned order are not sustainable. Accordingly, the present appeal is allowed with the following directions:

(i) Impugned order dated 04th October, 2019 is set aside.

(ii) Trade Marks Registry is directed to process the registration of application No. 2879533 for the mark "CANON" in class 11.

(iii) Subject mark be advertised within a period of three months from today.

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

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

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

SANJEEV NARULA, J

FEBRUARY 17, 2023/as

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