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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED **: 05.10.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/98/2023
(OA/29/2020/TM/CHN)

Lenord, Bauer & Co. GmbH
Trading As: Lenord, Bauer & Co. GmbH
Dohlenstr: 32, 46145 Oberhausen
Germany. ... Appellant

-vs-

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

PRAYER: Transfer Civil Miscellaneous Appeal (Trade Marks) filed under Section 91 of the Trade Marks Act, 1999, praying that the order issued by the respondent dated 29 January 2020 and received by us on 30 January 2020 be set aside and the Application No.3325258 for the trade mark



in classes 7, 9 and 43 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.N.Ramesh, SPC

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ORDER

The appellant assails the grounds of decision dated 23.01.2020 (wrongly mentioned as 29.01.2020 in the prayer), pursuant to the order dated 27.02.2019 by which Application No.3325258 for the registration of the following device mark



was refused.

2. The appellant applied for registration of the device mark extracted above on 01.08.2016 under classes 7, 9 and 42 on a "proposed to be used" basis. By examination report dated 30.11.2016,

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the Registrar of Trade Marks raised objections under Section 11(1) of the Trade Marks Act, 1999 (the Trade Marks Act) by citing three marks. By reply dated 31.12.2016, the appellant contended that this mark is invented and is not similar to the marks cited in the examination report. After a hearing on 20.11.2018, the order dated 27.02.2019 was issued refusing the application for registration and the grounds of decision were issued about one year later on 23.01.2020. The present appeal was filed in the above facts and circumstances.

3. By inviting my attention to the appellant's device mark, learned counsel for the appellant submitted that the said device mark is not deceptively similar to any of the three cited marks. He also pointed out that the appellant is a company incorporated in Germany and that the device mark is evidently traceable to the corporate name of the appellant. Turning to the refusal order, learned counsel submitted that it is completely unreasoned and merely draws

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reference to Sections 9 and 11. As regards the grounds of decision, learned counsel submitted that the conclusions therein are untenable because the appellant's mark is clearly distinguishable from the cited marks and the said mark was adopted honestly by drawing on the corporate name of the appellant.

4. In response to the submissions, Mr.N.Ramesh, learned SPC, submitted that the application was rejected in view of the existence of deceptively similar marks on the register. He further submitted that the said marks were used in relation to similar goods from dates substantially prior to the application of the appellant.

5. On examining the appellant's mark, it is evident that it is a device mark. The said mark consists of two words joined by a plus mark. Placed by the side of the two words is a device consisting of two elements. When viewed as a whole, the appellant's device mark is distinguishable from the three cited marks. The first cited mark is

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a word mark which consists of only one of the words in the appellant's device mark. Similarly, the second and third cited marks, which are device marks, also contain only one of the words in the appellant's mark.

6. The order of refusal dated 27.02.2019 is completely unreasoned and appears to be a copy and paste job. As regards the grounds of decision, it was issued almost one year after the order of refusal. In relevant part, the grounds of decision are as under:

> *"The entire documents are appreciated. From analyzing facts of the case, the impugned trade mark is phonetically and visually identical to the conflicting marks which is mentioned in the search report and also they are well in prior use which sought by the applicant. The applicant is the well subsequent user among the conflicting mark user period. In view of these grounds, the Tribunal has opined that the applicant has deliberately chosen the subject mark in an effort to ride upon the goodwill and reputation of the conflicting*

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marks. Applicant has no bona fide adoption of the subject mark in respect of the applied goods. Further, the allowance of the subject mark is patently mala fide since the mark has been dishonestly adopted by the applicant hence the applicant cannot claim to be the proprietor of the subject mark under Section 18(1) of the Act. Allowance of the subject mark is adversely affecting the interest of the public; it would lead to confusion as it is more than likely, due to imperfect recollection that the average buyer may confuse the applicant's mark 'LENORD+BAUER as the conflicting owners sold their products under the name of 'BAUER'."

7. From the above extract, it is clear that the application was refused for two reasons, both of which are untenable, for reasons set out below:

(i) The appellant's trade mark and the cited marks are phonetically and visually identical. For reasons set out earlier, this conclusion is incorrect.

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(ii) The appellant dishonestly adopted the mark. No reasons precede the said conclusion except for the fact that the appellant's mark is subsequent to the cited marks. A mere perusal of the corporate name of the appellant indicates the reason for adoption of the appellant's mark. Therefore, this conclusion is also untenable.

8. By taking into account the fact that the appellant's mark is a device mark, which appears to be distinguishable from the cited marks, the application is liable to be accepted for advertisement. Consequently, (T)CMA(TM)/98/2023 is allowed by setting aside the grounds of decision dated 23.01.2020 and the order of refusal dated 27.02.2019 on the terms indicated above. It is needless to say that this order will not be binding on opponents, if any.

05.10.2023

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

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