2023:MHC:4109

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 11.09.2023

CORAM:

THE HON'BLE MR. **JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T) CMA (TM) No.144 of 2023
(OA/21/2019/TM/CHN)

M/s. TIL Healthcare Private Limited
Having its office at No.72,
Marshalls Road, Egmore,
Chennai 600008 ... Appellant

Vs.

The Registrar of Trade Marks
Trade Mark Registry, Boudhik Sampada Bhawan,
G.S.T.Road, Guindy,
Chennai 600032 ... Respondent

PRAYER : This Civil Miscellaneous Appeal filed under Section 91 of the Trademark Act, 1999, prays (a) order dated 07.12.2018 passed by the learned Examiner be set aside in Application No.2479146 pertaining to the mark "URELOG"; (b) this Appeal be allowed and registration of the Trade Mark URELOG be granted to the Appellant based on Application No.2479146; (c) the learned Tribunal may be pleased to direct the Registrar of Trade Marks, Chennai to revert and/or change the status of the Trade Mark

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"URELOG" bearing Application No.2479146 in Class 5 to its Original position and (d) costs of these proceedings be awarded to the Appellant.

For Appellant : Mr.M.S.Bharath
for M/s. Kria Law

For Respondent : Mr.S.Diwakar, SPC

JUDGMENT

The appellant challenges the grounds of decision dated 07.12.2018 issued in relation to order dated 16.02.2018, by which Application No.2479146 for the registration of the mark "URELOG" was refused.

2. The appellant applied for registration of the word mark set out above on 15.02.2013 on a "proposed to be used" basis. By examination report dated 20.02.2014, the Registrar of Trademarks raised objections under Section 11 of the Trade Marks Act, 1999 (the Trade Marks Act) by citing three similar marks.

3. In response, by communication dated 16.03.2016, the appellant stated that the mark "URELOG" is distinctive and was

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coined honestly by drawing on the element 'URE' which is related to the kidney and the element “LOG” which is derived from “KETOANALOGUE”, which is a kidney-related supplement. After a hearing on 22.01.2018, the refused order was issued. The impugned grounds of decision were provided subsequently on 07.12.2018. The present appeal was filed in these facts and circumstances.

4. Learned counsel for the appellant referred to the application for registration, the examination report, the response thereto, the impugned order and the grounds of decision. In addition, learned counsel referred to an affidavit dated 05.09.2023, and, in particular, to the statement therein that there are 87 marks with “URE” as the first three alphabets in class 5 and that 32 of such marks were registered. Likewise, learned counsel pointed out the statement therein that there are 5735 marks containing the element “LAC” and that 2675 of those marks were registered. He also invited my attention to the search report in order to substantiate the statement.

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5. Learned counsel also relied upon the following judgments:

1.F.Hoffman La Roche and Company Ltd. v. The Sanitex Chemical Industries Ltd., 1962 SCC Online Bom 110, particularly paragraph 14 thereof;

2. Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories, 1964 SCC OnLine SC 14, particularly paragraph 30 thereof; and

3. Mount Mettur Pharmaceuticals (P) Ltd. v. Dr.Wander, 1976 SCC OnLine Mad 147, particularly paragraph 8 thereof.

6. In response to these contentions, Mr.S.Diwakar, learned SPC, invited my attention to the grounds of decision and pointed out that the application for registration was rejected primarily on account of the existence of the mark "URELAC", which was registered with effect from 15.09.1993. Mr.Diwakar further submitted that the marks are applied to nearly identical

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products and that the marks are both phonetically and visually similar. Therefore, learned counsel concluded his submissions by submitting that the impugned order does not call for interference.

7. From the materials placed on record by the appellant, it appears that the element "URE" is derived from the words "urea" or "urine". Similarly, the element "LOG" appears to have been derived from "KETOANALOGUE", which are broken down forms of amino acids, from which nitrogen is excluded. It is used as a supplement to improve renal function.

8. The appellant has also placed for consideration the number of marks registered with the element "URE" and the element "LAC". The reason for adoption of the mark was duly explained in the response dated 16.03.2016. As compared to an arbitrary or fanciful mark, ordinarily, the degree of protection extended to a mark consisting of derived elements such as "URE" and "LAC" is lower.

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9. By taking into account the explanation with regard to the reason for adoption of the mark, the existence of multiple marks containing the element "URE" and the fact that "URELOG" is not a self evident fusion of urea/urine and ketoanalogue, the impugned order is liable to be set aside and the application accepted for advertisement.

10. Accordingly, (T)CMA(TM) No.144 of 2023 is allowed, the impugned order is, hereby, set aside and the respondent is directed to accept the application for advertisement. This order will not, however, be binding on opponents, if any. 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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