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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : **05.12.2024**

CORAM

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

(T) CMA (TM) No.206 of 2023

In the matter of Trade Mark application
No.1062994 in class 1 in the name of
Fashion Chemicals GmbH & Co.KG,
(A Company organized under the Laws
of Germany) Am Trippelsberg 92,
40589, Dusseldorf,
Germany. .. Appellant

-vs-

1.Registrar of Trade Marks,
Trade Marks Registry,
Boudhik Sampada Bhavan,
S.M. Road, Antop Hill,
Mumbai - 400 037.

2. Assistant Registrar of Trade Marks,
Trade Marks Registry,
Intellectual Property Building,
G.S.T. Road, Guindly,
Chennai - 600 032. .. Respondents

Prayer: Appeal filed under Section 91 of the Trade Marks Act, 1999 against an order dated 19.12.2014 passed by the Assistant Registrar of Trade Marks, Chennai received on 02.01.2015 in the matter of trade mark Application No.1062994 in class 1.

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For appellant : Mr.Yatin Khochare along with
Mr.Jay Shah for
Ms.K. Swetha

For respondents : Mr.C. Samivel
SPCGSC

JUDGMENT

This appeal has been filed, aggrieved by the impugned order dated 19.12.2014, refusing to grant Trade Mark registration for the appellant's Trade Mark "REPELLAN" on the ground that the appellant's mark is deceptively similar to that of the cited mark "REPELLIN" under Application No.466663 and also the cited mark is much prior than the appellant's mark for the similar goods, thereby causing confusion in the minds of the public.

2. The impugned order has been passed refusing to register the appellant's Trade Mark "REPELLAN" under Sections 9 and 11 of the Trade Marks Act. The appellant has challenged the impugned order on the ground that the impugned order is a non speaking order and it is an order passed in violation of principles of natural justice.

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3. Admittedly, the appellant had raised objections through a detailed reply dated 25.07.2003 for the objections raised by the respondents for refusing the registration of appellant's Trade Mark "REPELLAN". As seen from the reply dated 25.07.2003 sent by the appellant to the respondent, the appellant had submitted the following:

a) The mark "REPELLAN" of the appellant does not deceive or cause confusion among the consumers viz-a-viz., the cited mark "REPELLIN" as the channels of trade in the two marks are different;

b) "REPELLAN" the appellant's mark is used as a finishing product in the textile industry, whereas the cited mark "REPELLIN" is used in building construction industry;

c) The appellant's mark "REPELLAN" is used in industrial segments, which are different from the usage of the cited mark "REPELLIN";

d) The appellant had also cited a Judgment of the Delhi High Court in the case of ***Essco vs. Mascot*** reported in ***AIR 1982 Del 308*** to support their contention that the class of customers, the nature of goods, the similarity, character and purposes of goods and the other surrounding circumstances are four important factors that are cardinal in applying the test of deceptive similarity of two Trade Marks.

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4. According to the appellant, if the said test was employed, the mark "REPELLAN" of the appellant cannot be held to be deceptively similar to the cited mark "REPELLIN" as the cited mark is being used in respect of different goods and for different classes of customers.

5. Eventhough, the aforesaid objections were raised, the same has not been considered, as seen from the impugned order dated 19.12.2014 passed by the second respondent. Being a cryptic and non speaking order without giving reasons as to why the objection raised by the appellant in their reply dated 25.07.2003 are not acceptable, the respondent has refused to register the appellant's Trade Mark "REPELLAN" under Sections 9 and 11 of the Trade Marks Act, by stating that the cited mark under Application No.466663 "REPELLIN" is deceptively similar to the appellant's mark and also the cited mark is much prior than the appellant's mark for the similar goods, which may cause confusion in the minds of public.

6. Before this Court, the appellant has placed *prima facie* evidence to show that the cited mark "REPELLIN" under application No.466663 and the Trade Mark "REPELLAN" of the appellant are dealing with different

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goods. The appellant has categorically claimed that they have applied for registration of the mark "REPELLAN" on "propose to use" basis in the chemical industry whereas the cited mark "REPELLIN" under application No.466663 is being used in the construction industry and it will not cause confusion in the minds of the public as claimed under the impugned order.

7. The second respondent has refused the trademark application of the appellant at the threshold itself through a cryptic and non speaking order by not adhering to the principles of natural justice. The second respondent ought to have published the appellant's Trade Mark in the Trade Mark journal to enable any third party to raise any objection by filing an opposition petition, opposing the Trade Mark registration sought for by the appellant for its Trade Mark "REPELLAN". Instead of following that procedure, the second respondent by a cryptic and non speaking order by violating the principles of natural justice has rejected the appellant's Trade Mark application at the threshold itself.

8. Necessarily, the impugned order has to be quashed and the second respondent should be directed to publish the Trade Mark "REPELLAN" of

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the appellant in the Trade Marks Journal to enable any third party who have objection with regard to the said registration to file opposition petition.

9. Accordingly, the impugned order dated 19.12.2014 passed by the second respondent is hereby quashed and this appeal is allowed by directing the second respondent to publish the appellant's Trade Mark "REPELLAN" in the Trade Marks Journal within a period of eight weeks from the date of receipt of a copy of this order to enable third parties to raise objections if any with regard to the request for Trade Mark registration sought for by the appellant for its Trade Mark "REPELLAN". No Costs.

05.12.2024

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Index: Yes/No
Speaking/Non Speaking Order
Neutral Citation Case: Yes/No

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To

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ABDUL QUDDHOSE,J.

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