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

% *Date of Decision : 3rd May, 2023*

\+ C.A.(COMM.IPD-TM) 112/2021

ARVIND MEDICARE PVT. LTD. ..... Appellant
Through: Mr.Abhiraj Jayant, Advocates.

versus

THE REGISTRAR OF TRADE MARKS, DELHI ..... Respondent
Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr.Alexander Mathai Paikaday, Advocates.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present appeal has been filed impugning the order dated 29th May, 2018 passed by the Senior Examiner of Trade Marks in respect of Application No. 2420117 for the word mark "MIRACLES" in class 44.

2. Brief facts necessary for adjudication of the present appeal are as under:

2.1. The appellant is a company engaged in the business of offering medical, hospital and allied services under the word mark "MIRACLES" since 2012.

2.2. On 31st October, 2012, the appellant applied for registration of the word

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mark "MIRACLES" under class 44 vide Application No. 2420117.

2.3. Vide Examination Report dated 2nd September, 2013, the Trade Marks Registry objected to the registration of the word mark "MIRACLES" under class 44, citing prior subsisting registrations of trademarks which were similar to the mark of the appellant.

2.4. In response to the Examination Report, the appellant stated that the word mark of the appellant should be registered since it is distinctive in nature. Further, it was stated that since the mark had been continuously used by the appellant since 2012, the customers of the appellant were easily able to differentiate between products of the appellant and those of others, thereby eliminating any possibility of confusion in the market.

2.5. However, the trademark application of the appellant, seeking registration of the word mark "MIRACLES" under class 44, was subsequently rejected by the Trade Marks Registry vide the impugned order.

2.6. Consequently, the appellant filed a request on Form TM-M under Rules 36(1) of the Trade Marks Rules, 2017 for obtaining from the Registrar the grounds taken in rejecting the Trade Mark Application of the appellant.

2.7. On 29th June, 2018, the appellant was issued the Statement of Grounds of decision, which cited Sections 9(1)(a), 9(1)(b), 11(1)(a) and 11(1)(b) of the Trade Marks Act, 1999 as the grounds for refusal of the registration application of the appellant.

2.8. Accordingly, the appellant has been constrained to file the present appeal.

3. At the outset, reference may be made to the relevant extract of the Statement of Grounds of Decision dated 29th June, 2018, which is as under:

> " *With reference to the above and request on Form TM-*

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M dated 25/06/2018. It has been decided by the Registrar of Trade Marks to inform you that hearing in respect of above application was held on 16/05/2018 and the said application is refused on the following Grounds;

** 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.*
** 9(1)(b) - The Trade Mark consist exclusively of marks or indications which serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or services.*
** 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 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.*

Application was examined and objections were raised under section 11 of Trade Marks Act, 1999. Reply filed, perused but found not satisfactory. Application proceeded for show cause hearing. Supporting documents in support of the claim of user did not filed by the applicant. Other similar valid marks are already on record. The objections raised in the Examination Report under sectio11 of the Trade Marks Act, 1999 cannot be waived. After perusal of records and submissions by the attorney in this regard, the application for registration of Trade Mark is refused on merit."

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4. In relation to the earlier registered marks, the Examination Report dated 2nd September, 2013 cited two marks, which although objected to at the time, were subsequently granted registrations. The details of the said marks are as under:

S. No.	Application No.	Class	Proprietor Name	Status	Mark
1.	2021074	44	Mr. Rahul	Registered	MIRACLE CREATIONS
2.	2193061	44	Dr.Yogesh Kadam	Registered	Dr. Yogesh Kadam's Miracles HEALTH CLINIC

5. The mark shown at serial no.1 above was, however, only valid/renewed up to 9th September, 2020.

6. Counsel for the appellant submits that since the appellant has been continuously using the word mark "MIRACLES" since 2012, owing to which the appellant has also built a valuable name in the Indian market, it should be afforded the benefit of the proviso to Section 9(1) of the Trade Marks Act, 1999. He further submits that in relation to the ground of rejection under Section 11, the device mark Dr. Yogesh Kadam's Miracles HEALTH CLINIC is neither identical nor similar, phonetically or visually, to the word mark of the appellant.

7. A perusal of the documents on record would also show that the registration of the word mark "MIRACLES" has been objected to and

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subsequently rejected by citing the two aforesaid device marks that feature the word “miracle”/ “miracles”. However, from a reading of the Statement of Grounds of Decision dated 29th June, 2018, it appears that no reasons have been given as to how the word mark of the appellant is not distinctive or that it is descriptive of the goods/services offered by the appellant under the word mark. Therefore, without going into the merits of the matter, what weighs with the Court is the submission advanced by the counsel for the appellant that the appellant has been using the word mark “MIRACLES” for almost a decade now and having gained reputation and goodwill on account of the said mark, as demonstrated through the various documents placed on record by the appellant, the said trademark has acquired distinctiveness.

8. Further, the appellant has filed two more trademark registration applications, being TM Application Nos.2784553 and 2784554, before the Trade Marks Registry under class 44. The status of the aforesaid applications is shown as “opposed” by Dr. Yogesh Kadam, the registered proprietor of the earlier registered mark . In this view of the matter, it is deemed appropriate that the present appeal is allowed and the subject trademark application also proceeds to the stage of advertisement as per the proviso to Section 20 of the Trade Marks Act, 1999.

9. Accordingly, the appeal is allowed and the impugned order dated 29th May, 2018 is set aside.

10. The Trade Marks Registry is directed to proceed with the advertisement of the subject trademark application as per the proviso to Section 20 of the Trade Marks Act, 1999. Let the same be done within a period of three months.

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11. Upon the mark being advertised in the Trade Marks Journal, the Trade Marks Registry shall send an intimation to registered proprietors of the cited marks which are currently valid.

12. If there is any opposition to the said application, the same shall be decided on its own merits without being affected by the observations made hereinabove.

13. The Registry is directed to supply a copy of the present order to the Trade Marks Registry at llc-ipo@gov.in for compliance.

AMIT BANSAL, J

MAY 3, 2023
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