2023:MHC:5230

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **29.11.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/208/2023
(OA/SR.102/2020/TM/CHN)

M/s.K and K Promotions SA
(K and K Promotions Ltd.,)
Rue De Veyrot 10, 1217, Meyrin,
Switzerland. ... 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 to set aside the order dated 20th March 2020 of the Respondent in respect of Trade Mark Application No.4239877 for the mark CHATEAU MONESTIER LA TOUR in class 33.

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For Appellant : Mr.R.Rajesh
for M/s.De Penning and De Penning

For Respondent : Mr.A.R.Sakthivel, SPC

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JUDGMENT

The appellant challenges the statement of grounds of decision dated 20.03.2020 issued pursuant to order dated 05.03.2020 rejecting Application No.4239877 for registration of the word mark "CHATEAU MONESTIER LA TOUR" in Class 33.

2. The above mentioned application was filed on 19.07.2019 on a "proposed to be used" basis. By examination report dated 21.08.2019, 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. The appellant responded thereto by stating that

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the only commonality between the mark applied for and the cited marks is the word "CHATEAU". The appellant further submitted that the mark should be viewed and compared in entirety and, if this is done, the mark applied for qualifies as distinctive and capable of distinguishing the goods of the appellant from those of others. After a hearing on 05.03.2020, the application was rejected. The present appeal arises in the said facts and circumstances.

3. Learned counsel for the appellant invited my attention to the application and pointed out that the word mark is distinctive when viewed as a whole. By referring to pages 42 to 52 of the typed set of papers, learned counsel submitted that the World Intellectual Property Organization (WIPO) issued a statement of grant of protection in respect of the relevant mark. Learned counsel also pointed out that there are a large number of marks registered by the respondent that contain the word "CHATEAU" as one element of the mark.

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4. In response to these contentions, Mr.A.R.Sakthivel, learned SPC, submits that the mark is required to be looked at as a whole and that the element "CHATEAU" cannot be overlooked while carrying out this exercise. He further submits that the Registrar of Trade Marks is obligated to consider the likelihood of confusion and that such likelihood exists in view of the common element.

5. The French word "CHATEAU" means, in substance, a large country house or castle. Since wines are produced by particular estates, judicial notice may be taken of the fact that the element CHATEAU is commonly contained in the marks associated with the wine business. This is corroborated by the search report placed on record by the appellant showing a large number of registered marks containing the word "CHATEAU" as an element. There can be no demur to the general proposition advanced by learned SPC to the effect that the Registrar is under an obligation to examine if there is any likelihood of confusion. Such likelihood of confusion should,

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however, be examined by reckoning the class of consumers consuming the relevant goods. In the context of wines, the class of consumers is limited, likely to be discerning and aware of the usage of the element "CHATEAU" in most wine related marks.

6. Therefore, the rejection of the application is untenable and the order of refusal and the statement of grounds are, hereby, set aside. By taking into account the fact that the appellant's mark has been granted a statement of protection by the WIPO, and by comparing the appellant's mark and the cited marks as a whole, the application shall proceed to advertisement. It is made clear, however, that this order will not be binding on opponents, if any. (T)CMA(TM)/208/2023 is allowed on the above terms without any order as to costs.

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

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