2023:MHC:4230

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 19.09.2023

CORAM:

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/149/2023
(OA/27/2019/TM/CH)

Laticrete International, Inc.
One Laticrete Park North,
Bethany, CT 06524-3423
U.S.A. ...Appellant

-vs-

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

PRAYER: Transfer Civil Miscellaneous Appeal (Trademarks) filed under Section 91 of the Trade Marks Act, 1999, praying that the order issued by the respondent dated 04th March 2019 issued under No.TLA/199 dated 05th March 2019 and received by us on 14th March 2019 be set aside and the Application No.3216123 for the trademark



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in Classes 1, 2, 3,17 & 18 in the name of LATICRETE INTERNATIONAL, INC. be allowed to proceed to registration.

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

For Respondent : Mr.P.G.Santhosh Kumar
Senior Panel Counsel

JUDGMENT

The appellant assails the grounds of decision dated 04.03.2019 issued in relation to the refusal order dated 04.02.2019, by which Application No.3216123 for registration of the following device mark was refused:



2. The appellant is a company incorporated in Bethany, United States of America. The appellant applied for registration of the mark set out above on a "proposed to be used" basis on 21.03.2016. Such application was in Classes 1, 2, 3, 17 and 19. In the application, the appellant is described as a

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manufacturer and merchant. By examination report dated 19.09.2016, the Registrar of Trade Marks raised objections under Section 11(1) of the Trade Marks Act, 1999 (the Trade Marks Act) by citing 5 allegedly conflicting marks. The appellant replied to the examination report on 19.10.2016 and contended that the appellant's mark and the cited marks are distinguishable; the class of consumers of goods manufactured by the entities concerned are different; and the trade channels are different. The impugned order was issued after a hearing on 04.02.2019 and, upon request, the grounds of decision were provided on 04.03.2019.

3. Learned counsel for the appellant invited my attention to the examination report and, in particular, to the status report annexed thereto. With reference to the cited marks, learned counsel pointed out that the first cited mark under Application No.2114041 in Class 1 was abandoned, as evidenced by the document at page 29 of the paper book. Likewise, he submitted that the second cited mark under Application No.2114042 in Class 2 was also abandoned. A document in support of such contention was provided. As regards the 3rd, 4th and 5th cited marks, learned counsel

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provided the current status and pointed out that the status of these marks continues to be "opposed".

4. The last contention of learned counsel was that the explanation of the appellant in response to the examination report was not taken into consideration while issuing the refusal order, and that the refusal order is unsustainable.

5. In response to these submissions, Mr.P.G.Santhosh Kumar, learned Senior Panel Counsel, submitted that the application was rejected because of the existence of the cited marks which are deceptively similar and the application dates of the cited marks precede the date of application of the appellant.

6. The impugned order is completely unreasoned and appears to be a copy and paste job. The grounds of decision contain conclusions that the mark applied for and the cited marks are identical; that they relate to similar goods/services; and that the applicant of the cited marks is the prior user.

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Once again, no effort was made to consider the response of the appellant to the examination report and to record reasons for not accepting such explanation. The refusal order and grounds of decision are clearly unsustainable for such reason.

7. Learned counsel for the appellant has placed on record evidence that the 1st and 2nd cited marks were abandoned and that the remaining 3 cited marks continue to be in the "opposed" stage. In these circumstances, the appellant's application is entitled to be accepted for advertisement.

8. In the result, (T)CMA(TM) No.149 of 2023 is allowed by setting aside the refusal order dated 04.02.2019 and grounds of decision dated 04.03.2019 and directing that Application No.3216123 be advertised. It is made clear, however, that this order will not be binding on opponents, if any.

19.09.2023

Index:No
Speaking Order
Neutral Citation:Yes
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SENTHILKUMAR RAMAMOORTHY,J.

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To

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

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