$~4 (09.03.2023)

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

\+ C.A.(COMM.IPD-TM) 133/2021

CASTROL LIMITED ..... Appellant

Through: Mr. Peeyoosh Kalra, Ms. V. Mohini, Mr. Udayvir Rana and Mr. Rohan J. Kapoor, Advocates.

versus

THE REGISTRAR OF TRADEMARKS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat, Mr. Alexander Mathai Paikaday, Advocates.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 10.03.2023

The Matter has been taken up today as 09th March, 2023 was declared as a holiday of the Court pursuant to an Office Order bearing No. 767/I-G-4/Genl.I/DHC dated 07th March, 2023.

1. The present appeal under Section 91 of the Trade Marks Act, 1999 [hereinafter "*the Act*"] impugns order dated 17th January, 2019 read along with Statement of Grounds of decision dated 08th March, 2019 [hereinafter collectively "*impugned order*"], both passed by Senior Examiner, whereby Appellant's Trade Mark Application No. 2867612 for word mark 'DURATEC' under Class-04 for "*industrial lubricants for use in gas-fired power generation units*" [hereinafter "*subject mark*"], has been refused under Section 9 and 11(1)(*a*) of the Act. Relevant portion of the Statement

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of Grounds for decision, are extracted hereinbelow:

> "** 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*"

2. From the above, it is noticed that while order dated 17th January, 2019 records an objection under Section 9 and 11 of the Act, however, the only ground for refusal, featured in the Statement of Grounds of decision dated 08th March, 2019, is that of Section 11(1)(*a*) of the Act, which arose in light of conflicting cited marks *bearing* Trade Mark Application Nos. 2270270 and 2270271 [hereinafter "*cited marks*"], mentioned in the 'Phonetic Search Report' accompanied with the Examination Report dated 18th January, 2016 (annexed at page No. 41 of the appeal paper book).

3. Mr. Peeyoosh Kalra, counsel for Appellant, has drawn this Court's attention to communication dated 04th March, 2015, whereby trademark agent of the Applicant of cited marks wrote to the Trade Marks Registry conveying his instructions to withdraw the above two cited marks.

4. Mr. Kalra further brings to Court's notice that despite the above request for withdrawal, the cited marks were subsequently granted registration. He states there is no explanation forthcoming from the Trade Marks Registry as to why the same had been done. Nonetheless, Mr. Kalra further points out that goods described in the cited marks have been revised and are narrowed down as follows:

> "*Class 4:*
> *Industrial Oils, not being for use upon automotive goods and not in connection with motor vehicle or parts.*"

5. Additionally, he also hands over a printout of a device mark registration (Trade Mark Application No. 3008035) in the name of the

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Applicant of the cited marks under Class-05, which indicates the following logo:



6. On the basis of the aforesaid, it is argued that Appellant's mark is associated with entirely different goods which are "*industrial lubricants for use in gas-fired power generation units*".

7. Considering the above, in the opinion of the Court, above aspects should be examined by the Trade Marks Registry. Accordingly, the present appeal is disposed of with following directions:

a) Impugned order is set-aside.

b) This matter is remanded back to the Trade Marks Registry for fresh consideration of Appellant's Trade Mark Application (No. 2867612) in light of the facts noted above. Appellant shall be afforded an opportunity of personal hearing.

c) Appellant is granted liberty to file additional documents, if any, in support of their application within three weeks from release of this order.

d) All rights and contentions of the parties are left open.

8. With the above directions, the present appeal is disposed of.

SANJEEV NARULA, J

MARCH 10, 2023*nk*
(Corrected and released on: 17th March, 2023)

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