WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 05.03.2024

CORAM :JUSTICE N.SESHASAYEE

(T)CMA.(TM) No.171 of 2023
(OA/SR.201/2020/TM/CHN)

Civic India Housing & Infrastructure Pvt Ltd.
A Company incorporated under
The (Indian) Companies Act, 1956
#44/1, Fair Field Layout, Race Course Road
Bangalore – 560 001.
By its Director. ... Appellant

Vs

The Registrar of Trade Marks
Office of the Trade Marks Registry
Intellectual Property Building
G.S.T. Road, Guindy
Chennai – 600 032. ... Respondent

PRAYER: This Civil Miscellaneous Appeal (Trade Marks) came to be filed by transfer of OA/SR.No.201/2020/TM/CHN from the file of Intellectual Property Appellate Board, Chennai, praying this Court (a) to set aside / quash the order dated 30.01.2020 of the learned Examiner of Trade Marks, Chennai, refusing Trade Mark Application No.2982167, to proceed to registration; (b) to allow Trade Mark Application No.2982167, to proceed to registration; and (c) pass such further or other orders as may be just and necessary under the facts and circumstances of the case.

https://www.mhc.tn.gov.in/judis

WEB COPY

For Appellant : Mr.J.Vijay Raghavan
for M/s.Attul and Associates

For Respondent : Mr.A.R.Sakthivel
Senior Panel Counsel

JUDGMENT

The present appeal is filed to set aside the order of the learned Examiner of Trade Marks dated 30.01.2020, refusing the registration of the appellant's mark, and to direct the Examiner of Trade Marks to register the mark of the appellant.

2.1 The facts that lead to the present appeal are:

a) The appellant, Civic India Housing and Infrastructure Pvt. Ltd. is a company incorporated in 2007 under the Companies Act, 1956.

b) The appellant's mark is a label mark bearing the words "CIVIC INDIA HOUSING & INFRASTRUCTURE"and a distinctive logo consisting of the devices: a free-hand representation of the Indian map juxtaposed on a globe along with the devices of human figures with raised hands underneath the globe with a colour scheme, and a tagline "Thinking beyond business". It is reproduced as below:

https://www.mhc.tn.gov.in/judis

WEB COPY

CIVIC INDIA
HOUSING & INFRASTRUCTURE
Thinking beyond business

c) The term "CIVIC INDIA" was coined and was used for the first time by the appellant in building and construction business. On 11.06.2015, the appellant, claiming user since 06.06.2007, submitted an application bearing number 2982167 to the Trade Mark Registry to register its mark in Class 37.

d) Upon receipt of the application, the Examiner sent his Examination Report raising objections under Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act, 1999. A written response was submitted by the appellant to get over the objections. An additional objection was raised by the Examiner regarding the free-hand representation of the India map and this was raised orally.

e) Subsequently on 17.09.2018, a hearing was held at the Trade Marks Registry, pursuant to which the appellant filed an affidavit along with additional documents on 20.09.2018 and 30.01.2019 to substantiate its user claim from 2007.

https://www.mhc.tn.gov.in/judis

WEB COPY

2.2 Finally, the final hearing took place on 30.01.2020, and on the said date, the Examiner chose to refuse registration of the appellant's mark and rejected its application. His line of reasoning is:

a) The mark cannot be registered for it is not distinct and hence is not registrable in terms of Section 9(1)(a) of the Trade Marks Act.

b) Secondly, the mark in question cannot also be registered under Sec.9(1)(b) of the Act, for it has direct reference to the quality and characteristics of the service for which it is applied.

c) No relevant supporting documents were filed to substantiate the user claimed.

d) The applicant had cited the registration of an identical mark under class 35 in order to press the registration of the impugned mark under class 37. However, as per Section 31 of the Act, it has been made adequately clear that the registration certificate only proves the validity of the registration and the same cannot be relied on to prove acquired distinctiveness.

e) The mark contains the map of India whose use is prohibited under Section 2(d) of the Emblems Act, 1950.

https://www.mhc.tn.gov.in/judis

WEB COPY

This is now under challenge in this appeal.

3. Heard both sides. The learned counsel for the appellant submitted that not one of the objections raised by the respondent is sustainable on facts. Firstly, the mark of the appellant is neither 'CIVIC' nor 'INDIA' but a combination of two words 'CIVIC INDIA' and is accompanied by labelled logo and tagline plus a colour scheme. The Examiner appears to have pre-decided the issue to reject the registration and has chosen to pick only just two words from a group of distinctive features that forms its trade mark. Turning to the second objection that the trade mark has a reference to the quality and characteristics of service, it baffles as to how the word 'CIVIC' or 'INDIA' describes the quality or characteristics of any business. The third objection is that merely because the mark was registered under Class 35, it does not merit consideration. Insofar as the certificate of registration of mark only proves quality of the registration and not its distinctiveness is concerned, the respondent has got his understanding of the law on Trade Mark entirely wrong. The certificate of registration serves two purposes : (a) that it proves the validity of registration; and (b) it evidences ownership over

WEB COPY

the registration and confers certain specific statutory rights on the owner of the trade mark.

4. This Court is in absolute agreement with the submissions of the counsel for the appellant. It is mind baffling that the respondent should consider that the trade mark of the petitioner which is reproduced in the earlier paragraph with the colour scheme forms one single mark and it cannot be dissected by the Registry at its own will. The Registry is here to examine the mark as is produced by the applicant and to treat the mark so produced in its wholesomeness, if so seen that the mark of the applicant does show its own distinctiveness. Turning to the other ground of objection of the respondent under Sec.9(1)(b) of the Act, it is amazing how two words 'CIVIC' and 'INDIA' either read as two words or read as a single phrase connotes the quality and characteristics of the service which the appellant provides. The respondent displays amazing skills in reading something in these two words which no ordinary person with some degree of perception can ever decipher. The law has to be administered not by those who walk with laser-scanner, but by one who has a strong understanding how a common man with ordinary prudence who goes to the market to procure any goods or services, perceives

https://www.mhc.tn.gov.in/judis

WEB COPY

the mark. And to the last ground founded under Sec.2(d) of Emblems Act, 1950, it only says that no emblem can be inappropriately used. It is not known how displaying a free hand drawing of Indian map, offends the emblem. Indeed, the same Trade Mark Registry has registered the appellant's mark under Class 35 as it is presented.

5. This Court very strongly suspects that the respondent with a motive, rejected the appellant's mark. Its action in rejecting the registration appears malafide.

6. To conclude, the appeal is allowed. This Court now directs the respondent to take the application of the appellant back on its record and register the Trade Mark of the appellant in Class 37, after satisfying itself on aspects other than those which are already raised by it and rejected by this Court vide this order. No costs.

05.03.2024

Index : Yes / No
Speaking order/ Non-speaking order
ds

https://www.mhc.tn.gov.in/judis

WEB COPY

N.SESHASAYEE, J.

ds

To:
The Registrar of Trade Marks
Office of the Trade Marks Registry
Intellectual Property Building
G.S.T. Road, Guindy
Chennai – 600 032.

(T)CMA.(TM) No.171 of 2023

05.03.2024