2023:MHC:3926

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **28.08.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/142/2023
(OA/19/2019/TM/CHN)

British Engines (UK) Limited
11 Glasshouse Street, St Peters,
Newcastle upon Tyne,
Tyne and Wear, NE6 1BS,
United Kingdom ... Appellant

-vs-

The Assistant Registrar of Trade Marks
Trade Mark Registry Chennai,
Boudhik Sampada Bhawan,
G.S.T.Road, Guindy,
Chennai 600 032. ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Trademarks) filed under Section 91 of the Trademarks Act, 1999, prays that the order issued by the respondent dated 05 October 2018 received by us on 10th October 2018 be set aside and the Application No.2769368 for the trademark

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in Classes 6,7,41 and 42 be allowed to proceed to registration.

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

For Respondent : Mr.S.Diwakar, SPC

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JUDGMENT

The appellant is a company incorporated in the United Kingdom. It was incorporated under the corporate name BRITISH ENGINES (UK) LIMITED. An application was filed by the appellant on 07.07.2014 for registration of the following mark



in classes 6, 7, 41 and 42.

2. Upon examination, objections were raised under Sections 9 and 11 of the Trade Marks Act, 1999, (the Trade Marks Act) on 17.11.2015. In response to the examination report, the appellant submitted a response on 21.04.2016. After hearing, by order dated

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20.07.2018, the application was rejected under Sections 9 and 11 of the Trade Marks Act. The appellant requested for the grounds of decision under Rule 36(1) of the Trade Marks Rules, 2017, and the grounds of decision were provided on 05.10.2018. This appeal is presented under the above facts and circumstances.

3. Learned counsel for the appellant invited my attention to the application for registration and pointed out the following: first, that the trade mark is a device mark which traces its origin from the corporate name of the appellant; and secondly, that the mark is not applied to engines and, consequently, cannot be characterized as descriptive of the goods or the nature, features or characteristics thereof. He next placed for consideration the registrations obtained in respect of an identical mark in multiple jurisdictions outside India.

4. By drawing reference to the reply to the examination report, learned counsel pointed out that the Section 9 objection was responded to by stating that the trade mark is a device mark consisting of the words 'BRITISH ENGINES', written in a stylized manner, along with a logo. In addition, he pointed out that the

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appellant had also stated that the trademark has no reference to the character or quality of the goods/services.

5. As regards the objection under Section 11, learned counsel submitted that the appellant stated in the reply that the marks cited in the examination report do not fall within the classes 6, 7 and 42. Even as regards the marks in class 41, the appellant stated that TM No.1255318 and 1268041 were not renewed. Moreover, it was stated that only the prefix 'BRITISH' is common to the appellant's mark and the cited marks. Since the comparison should be between the marks as a whole, learned counsel contended that the objections are untenable.

6. In support of these contentions, learned counsel for the appellant referred to and relied on the following precedents:

(i) *Dubai Islamic Bank v. Union of India, dated 04.12.2019 in W.P.(C).No.12749 of 2019,* particularly paragraphs 8 to 11 thereof.

(ii) *Abu Dhabi Global Market v. Registrar of Trademarks, Delhi, 2023 SCC OnLine Del 2947,* particularly paragraphs 24 and 25 thereof.

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(iii) *Godfrey Philips India Ltd. v. Girnar Food & Beverages (P) Ltd, (2004) 5 SCC 257,* particularly paragraph 4 thereof.

7. In response, Mr.S.Diwakar, learned SPC, submitted that the mark consists of two descriptive words. The first word 'BRITISH' indicates geographical origin and the second word 'ENGINES' indicates the nature of goods. Secondly, he submitted that multiple conflicting marks were cited in the examination report. Therefore, he concluded that the impugned order does not call for interference.

8. The operative portion of the impugned order is as under:

> *1. Shri Ravindran applicant/Advocate/Agent appeared before me and made his submissions. I have heard arguments, gone through the records and passed the following Order.*
>
> *2. The trade mark applied for is objectionable under Section 9/11 of the Act. The application is accordingly refused."*

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9. It would be an understatement to say that the impugned order is completely bereft of reasons. On requesting for grounds of decision, such grounds of decision were provided. In relevant part, the grounds of decision are as under:

> *"* Counsel appeared and req for acceptance, documents are perused. The mark itself highly descriptive and also indicates the intended purpose of the goods and services which are sought for registration. There is no use of the mark in India prior to the filing of the application. In view of the grounds, the mark is refused U/s 9 of this act.*
>
> *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 and services."*

10. Apart from recording conclusions that the mark is highly descriptive and that it indicates the intended purpose of the goods and services, no effort has been made to deal with the explanation

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provided by the appellant, in reply dated 21.04.2016, either with regard to the objections under Sections 9 or 11. Solely on the ground of lack of reasons, the impugned order, including the grounds of decision, is unsustainable.

11. The appellant has stated categorically in paragraph 4.1.11 of the appeal that the mark is not applied to engines. It is evident from the application that the mark is derived from the corporate name of the appellant. There is evidence that multiple registrations were obtained overseas for the identical mark.

12. By taking into account the aforesaid factors, this is an appropriate case to proceed to advertisement albeit subject to the limitation that the appellant shall not claim exclusive rights over the words “British” or “Engines”, when used separately.

13. For reasons set out above, (T)CMA(TM)/142/2023 is allowed without any order as to costs by setting aside the impugned order. Consequently, the application shall proceed to advertisement subject to the limitation that the appellant shall not claim exclusive

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right to use, separately, either the word "British" or the word "Engines". It is made clear that this order will not be binding on opponents, if any.

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Index : Yes/No

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SENTHILKUMAR RAMAMOORTHY, J

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