2023:MHC:3879

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 22.08.2023

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/81/2023

(OA/9/2020/TM/CHN)

BEST Sport & Freizeit GmbH
Mittelwendung 22
D-28844 Weyhe
ALEMANIA ... Appellant

-vs-

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

PRAYER: Transfer Civil Miscellaneous Appeal (Trademarks) filed under Section 91 of the Trademarks Act, 1999, that the impugned order issued by the Respondent dated 05 April 2019 and received by the Appellant on 11 April 2019 be set aside and the mark



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vide application No.2834287 in class 28 in the name of BEST Sport & Freizeit GmbH be allowed to proceed to registration.

For Appellant : Mr.R.Rajesh
for M/s.DEPENNING AND DEPENNING

For Respondent : Mr.R.Rajesh Vivekananthan,
Deputy Solicitor General

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JUDGMENT

The appellant assails an order dated 05.04.2019 by which application No.2834287 in Class 28 in respect of the following device mark



was rejected.

2. The appellant is a German company under the corporate name "BEST Sport & Freizeit GmbH". It is engaged in the business of dealing with sports goods and equipments. An application for registration of the above extracted device mark was made by the

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appellant on 29.10.2014. The said application was made in Class 28. Upon examination, by communication dated 04.02.2016, the Registrar of Trade Marks raised objections both under Section 9(1)(b) and 11(1) of the Trade Marks Act 1999 (the Trade Marks Act). The objection under Section 9(1)(b) was on the ground that the mark consists of words which designate the kind, quality, intended purpose or other characteristics of the goods. The objection under Section 11(1) was by citing two rival marks under Class 28. In response thereto, the appellant stated, by communication dated 12.04.2016, that the trademark of the appellant is in a stylized form (along with logo) and that the trademark has no reference to the character or quality of the goods in respect of which it is proposed to be registered. The cited marks were differentiated by pointing out that the comparison should be between the marks as a whole and not by splitting up the marks into its constituents. After receiving the response, a hearing was held and the order dated 27.02.2019 was issued refusing the application under Section 9 of the Trade Marks Act. On request, the

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grounds of decision were provided under Rule 36(1) of the Trade Marks Rules 2017. In the grounds of decision, it is stated that the mark is highly descriptive with respect to the quality of the goods.

3. Learned counsel for the appellant invited my attention to documents relating to the application and the refusal thereof. In addition, he placed for consideration registration certificates issued in several jurisdictions overseas in respect of the identical mark. He also pointed out that the corporate name of the appellant contains the words 'BEST SPORT'. He further pointed out that the mark is a device mark and that the words ''BEST SPORTING' cannot be looked at in isolation. On instructions, he submits that the appellant is willing to accept a limitation or condition that no exclusive right would be claimed as regards the words 'BEST' or 'SPORTING' when used individually but that exclusivity is asserted to the words 'BEST SPORTING' when used in combination.

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4. In response to these contentions, Mr.Rajesh Vivekananthan, learned Deputy Solicitor General, submits that the words "BEST SPORTING" are undoubtedly descriptive of the quality of sporting goods. By taking into account the nature of the goods in relation to which the mark is applied, he contends that the conclusion arrived at in the impugned order is unexceptionable. In order to substantiate these contentions, he relies upon the following judgments:

(i)*NRI Taxi Service Pvt. Ltd. vs Registrar Of Trade Marks, Delhi [2023 SCC Online Delhi 356]*, particularly paragraphs 11 to 14 thereof, wherein the Court directed the advertisement of the device mark 'NRI' and 'TAXI' subject to a disclaimer.

(ii) *Red Bull AG vs Pepsico India Holdings Pvt. Ltd. [2022 SCC Online Delhi 969]*, particularly paragraphs 25 to 27 thereof, whereby the Delhi High Court refused to grant an

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injunction restraining the use of the tagline "Stimulates Mind. Energises Body" by the defendants therein.

(iii) *Geep Flashlight Industries Ltd. vs. The Registrar of Trade Marks, New Delhi [1971 SCC Online Del 340]*, particularly paragraphs 15 to 17 thereof, whereby the Delhi High Court affirmed the order of the Assistant Registrar rejecting the application for registration of the Trademark 'Janta' in respect of electric torches.

5. Upon taking stock of the rival contentions, at the outset, it is pertinent to notice that the corporate name of the appellant contains the words 'BEST SPORT'. The appellant is a company incorporated in Germany. The appellant has placed on record evidence of registrations granted in respect of the identical device mark in multiple jurisdictions.

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6. The mark is a composite device mark which uses the colours – blue, yellow and white. At the corner, against a yellow background, it contains the stylized letter 'B'. The words BEST SPORTING are used as part of this composite device mark. The settled legal position is that such composite mark should be examined as a whole and not by splitting up the mark into its constituent elements. It should also not be lost sight of that Section 18(4) of the Trade Marks Act enables the Registrar of Trademarks to impose conditions or limitations while accepting an application for registration. In the case at hand, on instructions, learned counsel for the appellant submits that the appellant is ready to accept conditions or limitations with regard to not exercising any exclusive rights over the words 'BEST' or 'SPORTING' when used individually.

7. By taking into account all the aforesaid facts and circumstances, the impugned order and the grounds of the decision are liable to be interfered with. The said impugned order and the

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grounds of decision are set aside. The evidence on record justifies the application proceeding to advertisement, albeit subject to the incorporation of a condition or limitation not permitting any exclusive right over the individual words 'BEST' or 'SPORTING'. This order will not, however, be binding on opponents, if any, pursuant to advertisement of the mark.

8. (T)CMA(TM)/81/2023 is disposed of on the terms indicated above without any order as to costs.

22.08.2023

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