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

\+ C.A.(COMM.IPD-TM) 142/2021 & I.A. 1466/2023

CEAT LIMITED ..... Appellant

Through: Mr. Nishad Nadkarni, Advocate (through VC).

versus

THE REGISTRAR OF TRADE MARKS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Alexander Mathai Paikaday and Mr. Krishnan V., Advocates.

CORAM:
HON'BLE MR. JUSTICE ANISH DAYAL

O R D E R

% 20.03.2024

1. This appeal has been filed under Section 91 of the Trade Marks Act, 1999 ("**the Act**") read with Rule 125 of the Trade Marks Rules, 2017, ("**the Trade Marks Rules**") assailing the order dated 30th August, 2019 ("**impugned order**") passed by the Registrar of Trade Marks rejecting Trademark Application No. 3324395 in Class 12 for the mark "FARMAX" filed by the appellant.

2. Mr. Nadkarni, counsel for appellant, has pointed out that the application was made in Class 12 by the appellant for agricultural vehicles, automobiles tyres; retreaded tyres; vehicle tyres; tyres for the wheels of forestry vehicles; tyres for land vehicles; parts and fittings for the aforesaid goods etc., in the name of CEAT Specialty Tyres Ltd. The original applicant was initially a subsidiary of the current appellant but was merged with the appellant in

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March, 2020.

3. The application was filed in December, 2014 to amend the name of the applicant before the Registrar of Trade Marks. Further, he has pointed out to the Examination Report dated 09th November, 2016 which states two conflicting marks against the appellant's mark being "FARMOX" in Class 12, for use of scooters, motorcycles, tractors and motor like vehicles and "FORMAX" in Class 12 for parts and fittings for use in motor land vehicles and tractors.

4. A response was filed on 12th January, 2017 stating that *firstly*, for assessing similarity, the marks have to be compared as a whole and the cited marks were structurally, visually and phonetically different from the subject marks; *secondly*, that the goods offered in the cited marks were different from that of the appellant; *thirdly*, the very fact that the two cited marks co-exist on the Trade Marks Register for similar category of goods ought not to prevent the registration of the appellant's marks, which was in the same class but for a different nature of goods i.e. tyres.

5. In this regard, he relies upon the decisions, *inter-alia*, in ***Nandhini Deluxe vs. Karnataka Cooperative Milk Producers Federation Limited***, 2018 (9) SCC 183.

6. Refuting the submissions of the appellant, Mr. Harish Vaidyanathan, CGSC, states that the appeal should be dismissed at the very threshold on account of delay in filing the same. He points out to the application for condonation of delay filed by the appellant which states that there has been a delay of 425 days in filing the appeal before the Intellectual Property Appellant Board ("**IPAB**"). The IPAB was abolished in 2021 and the matter was transferred to this Court.

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7. The condonation of delay application states that the appellant came to know of the impugned order in May, 2020, though it was passed in August, 2019, pursuant to internal due diligence. Mr. Harish Vaidyanathan, CGSC, submits that the erstwhile attorney of the appellant was Khaitan & Company and no circumstance or fact has been stated in the said application as to why the appellant was not informed about the impugned order by their trademark's attorney, which is a firm of some repute. Further, even if the appellant came to know of the said order in May, 2020, no reason has been given as to why the appeal was filed in February, 2021, despite the fact that only ninety days are provided for filing an appeal under Section 91 of the Act.

8. Also, internal due diligence, as claimed by the appellant, was conducted around May, 2020 which was the peak of the COVID-19 pandemic and appellant's plea, therefore, seems untenable in these circumstances.

9. On the merits of the matter, he points out that the cited marks belong to the same set of goods, and products for which the appellant seeks registration, as it relates to vehicles and tractors.

10. He has further pointed out that Form TM-M was filed on 12th February, 2021 by the appellant under Rule 37 of the Trademark Rules seeking correction of an alleged "clerical error" from "*proposed to be used*" to "*prior use from 31st December, 2013*". This, he states, evidences appellant's *mala fide* in this regard, considering that such a substantial change cannot be made under the cover of a clerical error and that form TM-M as per Rule 37 can be filed only when a registration application is pending and not when it is refused.

11. Having heard the parties and perused the documents on record, the Court is of the opinion that the appeal filed by the appellant was grossly

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delayed and the explanation offered in the condonation of delay application is specious, cursory and flimsy, and does not find favour of the Court. The reasons submitted in the condonation of delay do not provide any details and do not explain why the said appeal could not be filed even after May, 2020 when, as per the appellant, they found out about the impugned order.

12. Be that as it may, even the plea of the appellant on merits of the matter does not find favour of the Court, considering that the cited marks are structurally and phonetically similar to appellant's mark "FARMAX" and are also registered in similar category of goods. To drive distinction between vehicles' tyres, for which the appellant seeks registration and automobiles, for which the cited marks had been registered, would be too tenuous, particularly, when there is strong likelihood of confusion between appellant's marks "FARMAX" and cited marks "FORMAX" and "FARMOX".

13. The fact that the two cited marks existed on the register does not give an excuse for the appellant's mark to also be registered, considering the above facts and circumstances.

14. The decision in ***Nandhini Deluxe*** (*supra*) by the Hon'ble Supreme Court, as cited by the counsel for appellant, may not come to appellant's assistance since the nature and style of business of the appellant and the respondent therein were altogether different, in that, the appellant was running restaurants and the respondent was a Cooperative Federation of Milk Producers of Karnataka and selling milk, as also *Nandini*/*Nandhini* was stated to be a generic mark being the name of a God and a cow in mythology, which is different from this case where the marks in question are coined marks. Also, the marks in comparison in ***Nandhini Deluxe*** (*supra*) were device marks held to be structurally and visually very different, whereas the appellant's mark

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and cited marks are word marks.

15. Accordingly, the appeal is dismissed.

16. Pending applications, if any, are disposed as infructuous.

17. Order be uploaded on the website of this Court.

ANISH DAYAL, J

MARCH 20, 2024/kct

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