2023:MHC:4270

WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 20.09.2023

CORAM:

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/92/2023
(OA/20/2020/TM/CHN)

FC Madras Trust
Rep. by its Trustee K.Ananth
A-7, Terraspace Blooming Dale,
Plot No.107, Jeyachandran Nagar,
Medavakkam, Chennai – 600 100. ...Appellant

-vs-

1.The Registrar of Trade Marks,
The Trade Marks Registry,
IP Office Building, G.S.T. Road,
Guindy, Chennai – 600 032.

2.The Senior Examiner of Trade Marks,
The Trade Marks Registry,
IP Office Building,
G.S.T. Road, Guindy,
Chennai – 600 032. ...Respondents

PRAYER: Transfer Civil Miscellaneous Appeal (Trademarks) filed under Section 91 of the Trade Marks Act, 1999, praying to set aside the impugned order of the respondent passed on 27th August, 2019 and statement of

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

WEB COPY

grounds of decision of the same received by us on 3rd October, 2019 in correspondence No.TLA/200/27/09/2019 against registration of the Trademark 'FC Madras' with Application No.3821512 in Class 16.

For Appellant : Mr.R.Sathish Kumar
for M/s.Altacit Global

For Respondents : Mr.P.G.Santhosh Kumar
Senior Panel Counsel

JUDGMENT

The appellant assails an order dated 27.08.2019 by which Application No.3821512 for registration of word mark "FC MADRAS" was refused. The appellant applied for registration of the mark extracted above on 02.05.2018 in Class 16 pertaining to printed publications, books, newspapers, periodicals and journals. By examination report dated 07.06.2018, the Registrar of Trade Marks raised an objection under Section 9(1)(a) of the Trade Marks Act, 1999 (the Trade Marks Act), on the ground that the mark is a geographical name and, as such, incapable of distinguishing the goods of one person from those of others. The appellant replied to the examination report and pointed out that the mark adopted by the appellant has no connection with the geographical origin of the goods

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

WEB COPY

and that such mark is coined and capable of distinguishing the goods of the appellant from those of others. After a hearing on 20.06.2019, the application was rejected on 27.08.2019 by drawing reference to Section 9(1)(a) of the Trade Marks Act. The grounds of decision were provided on 24.09.2019. In the grounds of decision, it was reiterated that the mark is a common geographical name which is incapable of distinguishing the goods of one person from those of others. Hence, this appeal.

2. Learned counsel for the appellant invited my attention to the certificates of registration obtained by the appellant for the identical mark "FC MADRAS" in Classes 35, 36 and 41. He also pointed out that the mark was used extensively by drawing reference to invoices issued by the appellant. By further submitting that the appellant is a football club, he contended that the mark is not descriptive of the goods in respect of which registration was applied for. By inviting my attention to the Manual of Trade Marks, Practice and Procedure, published on 10.03.2015, learned counsel submitted that geographical names, which are not likely to be taken as indicating the origin of the goods, may be accepted. For the above

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

WEB COPY

reasons, he concluded his submissions by stating that the impugned order is unsustainable.

3. In response to these contentions, Mr.P.G.Santhosh Kumar, learned Senior Panel Counsel, submitted that the mark contains the word 'Madras', which is a common geographical name. According to him, such geographical name cannot be registered as a trade mark under Section 9(1)(a) of the Trade Marks Act.

4. The impugned order merely draws reference to Section 9(1)(a) of the Trade Marks Act as the reason for refusal of the application. The grounds of decision also do not contain any reasons apart from the conclusion that the mark is a common geographical name and is consequently incapable of distinguishing the goods of one person from those of others.

5. From the application of the applicant, it is evident that the application was for registration of the word mark "FC MADRAS". The

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

WEB COPY

mark should be considered as a whole and not by splitting it into its constituents. Under Section 9(1)(a) of the Trade Marks Act, a mark is liable to be refused registration if it is found devoid of distinctive character. The appellant seeks registration of the above mentioned mark in Class 16 in relation to printed publications, books, newsletters and the like. The appellant's mark, when viewed as a whole, is certainly not descriptive of the goods in relation to which the mark is applied. As pointed out by learned counsel for the appellant, even the Manual of Trade Marks, Practice and Procedure, does not state that geographical names cannot be registered. The guidance provided therein appears to be that such names cannot be registered if they are descriptive of the goods or services in relation to which such marks are applied.

6. The appellant has also provided evidence of the registration of the identical mark in about 3 classes. When the mark was not considered to be descriptive of the goods covered by the said registrations, the same mark cannot be considered to be descriptive of the goods covered by the present application. Therefore, the objection under Section 9(1)(a) of the Trade

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

WEB COPY

Marks Act is untenable. Because the order contains no reason for rejection of the application, other than the reference to Section 9(1)(a), the order is set aside. In the facts and circumstances outlined above, the application is liable to be accepted for advertisement subject to the condition that no exclusive right can be claimed over the word 'Madras' when used separately.

7. For the above reasons, the appeal is allowed on the terms indicated above by setting aside the impugned order. It is made clear, however, that this order will not be binding on opponents, if any.

20.09.2023

Index:Yes
Speaking Order
Neutral Citation:Yes
hvk

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

WEB COPY

To

1.The Registrar of Trade Marks,
The Trade Marks Registry,
IP Office Building, G.S.T. Road,
Guindy, Chennai – 600 032.

2.The Senior Examiner of Trade Marks,
The Trade Marks Registry,
IP Office Building,
G.S.T. Road, Guindy,
Chennai – 600 032.

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

WEB COPY

SENTHILKUMAR RAMAMOORTHY,J.

hvk

(T)CMA(TM)/92/2023
(OA/20/2020/TM/CHN)

20.09.2023

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