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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 18.10.2023

CORAM

THE HONOURABLE MR.**JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T) CMA (TM)/58/2023
(OA/6/2016/TM/CHN)

Samskruti Builders Private Ltd.,
(Registered under the Indian Companies Act, 1956)
Rep., by its Director Mr.Venkat Chalasani,
M/s.Samskruti Builders Pvt., Ltd., 12, RR Heights, 3rd Floor,
Next to Shoppers Stop., N S Palaya, Bannergatta Road,
Bangalore – 560 076. ... Appellant

-vs

1. The Trade Marks Registry,
   IP Office Building, G.S.T.Road, Guindy,
   Chennai.

2. The Deputy Registrar of Trade Marks
   Trade Mark Registry,
   IP Office Building, GST Road, Guindy,
   Chennai – 600 032. ... Respondent

PRAYER: Transfer Miscellaneous Appeal (Trade Marks) is filed under Section 91 of the Trade Marks Act, 1999, praying to set aside the impugned order of the respondent made in Order No.TLA/671/2306/2015, dated 23rd June 2015 and received by them on 10th July 2015.

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

For Respondent 1 : Mr.K.Subbu Ranga Bharathi, CGSC

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JUDGMENT

The appellant challenges an order dated 22.06.2015 (wrongly mentioned as order dated 23.06.2015 in the prayer) by which Application No.1971509 for registration of the trade mark "BUILDING SMART COMMUNITIES" was refused. The appellant applied for registration of the above mentioned trade mark on 26.05.2010 by asserting use since 01.10.2006. By examination report dated 16.12.2010, the Registrar of Trade Marks raised objections under Section 11 of the Trade Marks Act, 1999 (the Trade Marks Act), by citing three similar marks. The appellant replied to the examination report and pointed out that the appellant's mark should be looked at as a whole and that each cited mark contains only one word from the appellant's trade mark. The appellant also produced evidence of use of the trade mark in the form of brochures, invoices and a screenshot of the appellant's website. Eventually, by order dated 22.06.2015, the application was rejected by merely referring to Sections 9

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and 11 of the Trade Marks Act. The present appeal arises in the above facts and circumstances.

2. Learned counsel for the appellant submitted that the application was filed by asserting and providing evidence of use from 01.10.2006. As regards the examination report, learned counsel pointed out that the Registrar of Trade Marks cited three marks by combining one word from each of the three cited marks in order to object to the appellant's mark, which is a combination of three words. According to learned counsel, such fusion of one element from each cited mark to object to the appellant's mark is unknown to Trade Mark law. He next submitted that the impugned order does not consider the appellant's assertion of acquired distinctiveness through use or the evidence produced in support thereof. Therefore, learned counsel submits that the impugned order is unsustainable.

3. In response, Mr.Subbu Ranga Bharathi, learned Central Government Standing Counsel, submits that the appellant did not provide any evidence of use of the trade mark "BUILDING SMART COMMUNITIES" on a stand-alone basis and only provided evidence of

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use as a tag line to the primary trade mark. In spite of not using the trade mark on a stand-alone basis, he submits that an application has been filed for registration of the trade mark on a stand-alone basis. Learned counsel justifies the impugned order on that basis.

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

> *"2.The trade mark applied for is objectionable under Section 9/11 of the Act. The application is accordingly refused."*

5. The above extract reveals that the order is completely devoid of reasons. Especially in the context of the appellant applying for registration by asserting use from 01.10.2006 and submitting evidence of such use, the impugned order is clearly unsustainable.

6. By taking into consideration the evidence of use provided by the appellant and the fact that each cited mark contains not more than one of the three words constituting the appellant's trade mark, the application shall proceed to advertisement subject to the condition that the appellant shall not claim exclusive right over the words "BUILDING", "SMART" or

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"COMMUNITIES", when used separately. It is made clear, however, that this order will not be binding on opponents, if any.

7. (T)CMA(TM)/58/2023 is allowed on the above terms without any order as to costs.

18.10.2023

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

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