2024:MHC:3925

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : **19.11.2024**

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THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

CMA (TM) No.12 of 2024 and CMP No.13363 of 2024

Ricaria Support Services Private Limited,
rep. by its Director Samarth Sindhi .. Appellant

-vs-

The Registrar of Trade Marks,
Trade Marks Registry, Chennai,
Intellectual Property Office Building,
G.S.T.Road, Guindy,
Chennai - 600 032. .. Respondent

Prayer: This Civil Miscellaneous Appeal filed under Section 91 of the Trade Marks Act, 1999 to allow the appeal and set aside the order dated 07.02.2024 in Trade Mark Application No.4769799 for the Trade Mark 'MARS BY GHC' in class 05.

For appellant : Mr.P.Wilson,
Senior Counsel for
Mr.Richardson Wilson

For respondent : Mr.M.Karthikeyan,
SPC

JUDGMENT

This appeal has been filed, challenging the order dated 07.02.2024

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passed by the respondent under Section 11 of the Trade Marks Act, refusing to register the appellant's Trade Mark "MARS BY GHC" applied under class 5, i.e., Pharmaceuticals, Medical and Veterinary preparations etc.,.

2.According to the appellant, by total non application of mind to the appellant's Trade Mark "MARS BY GHC" and the cited Trade Mark "MARS", the respondent has, at the threshold itself, refused to consider the application of the appellant by rejecting the same under Section 11 of the Trade Marks Act.

3.The learned Senior Counsel appearing for the appellant would submit that the cited Trade Mark under the impugned order involves a manufacturer, who is dealing exclusively in pharmaceutical items and does not have any relevance with regard to the appellant's Trade Mark "MARS" even though the cited Trade Mark is also registered under class 5 of the Trade Marks Act. He would submit that since the cited Trade Mark "MARS" involves a manufacturer of pharmaceutical items and the drugs sold by the said manufacturer are schedule-H drugs, the same cannot be compared with that of the appellant, who are selling life style products. According to the

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learned Senior counsel for the appellant, there is no deceptive similarity between the appellant's Trade Mark as well as the cited Trade Mark as it will not cause any confusion in the minds of the public. He drew the attention of this Court to the impugned order and would submit that the reasons given by the respondent registry under the impugned order are arbitrary and the same has been given by total non application of mind to the fact that the appellant's mark "MARS BY GHC" and the cited mark viz., "MARS", whose manufacturer sells different products, will not cause confusion in the minds of the public. Therefore, according to him, erroneously, the impugned order has been passed, refusing to register the appellant's Trade Mark under Section 11 of the Trade Marks Act, 1999.

4.Learned Senior Counsel for the appellant also drew the attention of this Court to the additional affidavit filed by the appellant dated 05.10.2024 before this Court pursuant to directions given by this Court on 26.09.2024. As seen from the additional affidavit, the appellant has stated that it is willing to modify its applied mark "MARS BY GHC" by changing the word 'BY GHC' to show the origin of goods and to enhance the dis-similarity with any other existing mark containing the word 'MARS' if the respondent is

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willing to accept the said modification for allowing registration of the appellant's Trade Mark.

5.When the appellant has produced documents before this Court to show that the appellant's mark viz., "MARS BY GHC" is intended for broader spectrum of products, including pharmaceuticals, medical and veterinary preparations, sanitary preparations for medical purposes, dietetic food and substances adapted for medical or veterinary use, among others, whereas the cited mark under the impugned order viz., "MARS" involves pharmaceuticals and medicinal preparations. According to the appellant, their products under the Trade Mark "MARS BY GHC" can be purchased directly from the shelf without any confusion. Whereas, the products sold under the Trade Mark "MARS", which is the cited Trade Mark for refusing registration of the appellant's Trade Mark, cannot be purchased from the shelf as a medical prescription from a Doctor is required.

6.Section 11 of the Trade Marks Act stipulates certain related grounds to refuse registration of Trade Marks. When the appellant has placed documents before this Court to show that the Trade Mark of the appellant

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"MARS BY GHC" cannot be treated to be deceptively similar to that of the cited mark, the respondent ought not to have dismissed the appellant's application at the threshold itself under Section 11 of the Trade Mark Act, 1999.

7.The respondent has also not disclosed in the impugned order as to which category the appellant's application falls, as Section 11 discloses various categories (Grounds) for refusing to register any Trade Mark. If the appellant was allowed to publish its Trade Mark in the Trade Mark Journal, any third party objecting to the registration of the applied Trade Mark in favour of the appellant has got the legal right to oppose the registration of the appellant's Trade Mark by filing an Opposition Petition. Instead of following the said exercise, the respondent, through a non speaking order with regard to the category under which the appellant falls under Section 11 of the Trade Mark Act, 1999, has rejected the appellant's application at the threshold itself by applying Section 11 of the Trade Mark Act, 1999. The appellant has also agreed to modify its applied Trade Mark "MARS BY GHC" by which the size of the word GHC to show the origin of goods and to enhance the dis-similarity with any other existing mark containing the

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common word 'MARS', if the respondent is willing to allow the said modification for allowing registration of the appellant's mark as seen from the affidavit filed by the appellant dated 05.10.2024 before this Court pursuant to the direction given by this Court on 26.09.2024.

8.After giving due consideration to the aforementioned factors, necessarily, this appeal will have to be allowed by setting aside the impugned order and by permitting the appellant to publish its Trade Mark in the Trade Marks Journal to enable any third party to oppose the appellant's registration by filing an appropriate petition in accordance with the provisions of the Trade Marks Act, 1999.

9.It is also to be noted that prior to the filing of the application for registration of the appellant's Trade Mark, the appellant has pleaded that they did not receive any cease and desist notice from any contesting party.

10.In the result, the impugned order dated 07.02.2024 passed by the respondent, is hereby quashed and the appeal is allowed by permitting the appellant to publish its Trade Mark "MARS BY GHC" or its modified Trade

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Mark to suit the requirements of the respondent in the Trade Marks Journal by inviting opposition petitions if any from any third party to enable the third party to file Opposition Petition opposing the registration of the appellant's Trade Mark and as and when such an Opposition Petitions are filed, the respondent will have to consider the same, on merits and in accordance with law and pass final orders after affording a fair hearing to all the parties. No costs. Consequently, connected petition is closed.

19.11.2024

ab
Index: Yes/No
Speaking/Non Speaking Order
Neutral Citation Case: Yes/No

To

The Registrar of Trade Marks,
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ABDUL QUDDHOSE,J.

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