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THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 05.11.2024

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

CMA(TM) No.14 of 2024

BEERCO LTD.,
Rep. by its Authorised Signatory,
Ms.Saranya Chakrapani .... Plaintiff

vs

The Registrar of Trademarks
Trademark Registry,
Intellectual Property Building,
G.S.T. Road,
Guindy,
Chennai – 600 032. ... Respondent

Prayer : **CIVIL MISCELLANEOUS APPEAL (TRADE MARK)** filed under Section 91 of the Trademarks Act, 1999 to set aside the order, dated 21.12.2021 pertaining to Application bearing No.4649793 passed by the respondent refusing the application bearing No.4649793 filed by the appellant seeking to register its trademark **BeerCo** under 'class 32' and order the same be proceeded for registration by publication in the Trademarks Journal.

For Appellant : Mr.S. Aravindan
For Respondent : Mr.K.Ramanamoorthy
CGSC

JUDGEMENT

This appeal has been filed challenging the order, dated 21.12.2021 passed by the respondent refusing to register the trademark of the

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appellant **BeerCo** under Section 9(1)(b) of the Trademarks Act, 1999.

2. Under the impugned order, the respondent had observed that the mark applied for registration by the appellant is objectionable under Section 9(1)(b) of the Trade Marks Act, 1999 as it consists of a mark which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service.

3. The appellant has challenged the impugned order on the following grounds :

(a) It is a non-speaking order with regard to the contentions of the appellant raised before the respondent.

(b) The appellant had obtained several registrations earlier which includes the word **BeerCo** and having obtained those trademark registrations, the respondent ought not to have refused to register the appellant's trademark **"BeerCo"** under class 32.

4. The learned counsel for the appellant drew the attention of this Court to the various registrations obtained by the appellant by using the word **Beer** under various classes and would submit that having obtained

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the same, by total non application of mind, the respondent under the impugned order has refused to register the trademark of the appellant **BeerCo** under class 32.

5. The learned counsel for the appellant would also submit that only when the appellant is allowed to publish its trademark **BeerCo** in the trademark's journal, there will be an opportunity for any third party to raise objections with regard to the appellant's request for registration of its trademark **BeerCo**. He would submit that instead of allowing the appellant to publish its trademark in the trademark's journal, the respondent under the impugned non speaking order has by total non application of mind to the earlier registration obtained by the appellant has refused to register the appellant's trademark **BeerCo** at the threshold itself.

6. On the other hand, the learned Central Government Standing Counsel appearing for the respondent would reiterate the contents of the impugned order and would submit that the mark of the appellant is derived from the trading style of the appellant and is highly descriptive of the goods applied for and therefore, such a mark cannot be registered under Section 9 of the Trade Marks Act, 1999. It is also submitted that

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the respondent is also not informed as to whether the foreign application numbers uploaded by the appellant pertaining to other marks of the appellant has been registered or not, since the said applications are still active.

7. The appellant had earlier obtained trademark registrations by using the very same word **BeerCo,** which are detailed hereunder :-

SN	Country	Trademark	Number	Class	Status
1	India	**BeerCo**	4649794	35	Registered
2	Cambodia	**BeerCo**	KH/93741/20	16	Registered
3			KH/93744/20	36	Registered
4			KH/93742/20	32	Registered
5			KH/93743/20	35	Registered
6	Philippines	**BeerCo**	42020510546	16	Registered
7			42020510548	32	Registered
			42020510552	35	Registered
9			42020510553	36	Registered
10	Malaysia	**BeerCo**	TM2020016861	16	Registered
11	Malaysia		TM2020016864	36	Registered
12	Singapore	**BeerCo**	40202014175Y	36	Registered
13	Singapore		40202014172Q	32	Registered
14	Singapore		40202014174U	35	Registered
15	Singapore		40202014170P	16	Registered

8. When the appellant had earlier obtained registration of a similar trade mark **BeerCo,** though under class 35, the respondent ought to have

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permitted the appellant to publish its trademark in the Trade Marks journal so that third parties if they have any objection can file opposition petition.

9. The appellant has categorically contended that they have bonafidely and with an honest intention has adopted an inherently distinctive mark that is entitled to be registered under the provisions of the Trade Marks Act and its Rules. The appellant has also contended that even though the very same contentions were raised before the respondent, the respondent under the impugned order has failed to consider the same, through a speaking order. The appellant has contended that by a non-speaking order, the respondent has refused to register the appellant's trademark **BeerCo** under class 32 by erroneously applying Section 9(1)(b) of the Trade Marks Act, 1999. When the same materials which includes the registrations obtained by the appellant for its trademark **BeerCo** under class 35 were produced before the respondent by the appellant, the respondent ought to have taken note of the same and ought to have permitted the appellant to publish the trademark **BeerCo** in the trademark's journal for the purpose of receiving objections from any third party. The said exercise was erroneously not

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done, but instead the respondent has at the threshold itself refused to register the appellant's trademark by applying Section 9(1)(b) of the Trade Marks Act, 1999.

10. For the foregoing reasons, this Court is of the considered view that the impugned order passed by the respondent has to be quashed and this appeal will have to be allowed. Accordingly, the impugned order, dated 21.12.2021 passed by the respondent is hereby quashed by directing the respondent to permit the appellant's trademark **BeerCo** which is sought to be registered under class 32 to be published in the trademark's journal and the respondent thereafter on receipt of the publication is directed to decide the appellant's trademark application in accordance with law after giving due consideration to opposition petiiton, if any filed by third parties.

11. In the result, this Civil Miscellaneous Appeal is allowed with the aforesaid directions. No costs.

05.11.2024

Index: Yes/ No
Speaking order / Non speaking order
Neutral citation : Yes / No
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