Corrigendum

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

Date of Decision: 4th August, 2023

\+ **C.A.(COMM.IPD-TM) 49/2021 and I.A. 9889/2023**

MHG IP HOLDINGS (SINGAPORE) PTE. LTD. ..... Appellant

Through: Ms. Neha Saraswat and Mr. Sumit Kumar, Advs.

versus

THE REGISTRAR OF TRADE MARKS, DELHI ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC, with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advs. (M: 9810788606)

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.

I.A. 9889/2023 (for delay)

2. This is an application for condonation of 9 days delay. For the reasons stated in the application, the delay is condoned.

3. Application is disposed of.

C.A.(COMM.IPD-TM) 49/2021

4. The present appeal under Section 91 of the Trade Marks Act, 1999 has been filed challenging the order dated 25th June, 2019 passed by the Registrar of Trade Marks by which the application of the Appellant being application no. 2835731 was refused registration.

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5. The appeal has been filed by the Appellant- M/s M & H Management Ltd., a Mauritius based company, which is in the hospitality industry. The Appellant is the wholly owned subsidiary of 'Minor International PCL' which claims to be owning and operating more than 150 hotels and resorts across various countries in the Asia Pacific, Middle East, Europe, South America, Africa and the Indian ocean region.

6. The case of the Appellant is that one of the marks adopted by it is the mark 'TIVOLI' in the year 1933 and the said mark is stated to be used by it in a large number countries across the world. The mark is also stated to be registered in several countries including in Argentina, China, Colombia, Ethiopia, France, Germany, Mexico, New Zealand, Paraguay, Spain, Sri Lanka, UAE, United Kingdom, United States of America.

7. The Appellant is also the registered proprietor of the domain name www.tivolihotels.com upon which it operates a website for promoting its various properties, resorts and hotels.

8. The Appellant filed an application bearing no. 2835731 in class 43 in 2014 for the mark details of which are as under:

Mark Applied for:	TIVOLI HOTELS & RESORTS
Trade mark number:	2835731
Class:	43

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Date of Application:	31st October, 2014
Goods and Service Details:	Hotel services; temporary accommodations; accommodation exchange service (time shares); service for providing foods and drink; restaurants; reservation services for hotel accommodation and for other accommodation; rental of conference, meeting and exhibition facilities at hotel

9. The application of the Appellant was examined by the Registrar and examination report dated 19th May, 2016 was issued citing similar marks which were already registered. In the examination report, objections under Section 11 were taken by the trademark registry.

10. The Appellant replied to the said examination report on 29th September, 2016. In its reply, the Appellant claimed world-wide reputation as well as adoption and use of the mark since 1933. According to the Appellant, the marks which were registered/applied for were not identical inasmuch as there were differences between the marks of the Appellant and the cited marks. In any event the case of the Appellant was that the mark enjoys enormous global reputation in its favour and it is, thus, liable to be registered. However, the Registrar vide its order dated 10th January, 2019 has refused registration and the review against the refusal order has also been rejected vide order dated 25th June, 2019. Hence, the present appeal.

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11. Ms. Neha Saraswat, ld. Counsel appearing for the Appellant submits that considering the global prior adoption, which is almost 90 years ago, as also the fact that the Appellant ***has more than 18*** hotels under the name 'TIVOLI', even if there are a couple of registered marks which consists of the mark 'TIVOLI', the Appellant's case deserves to be considered on trans-border reputation. She further submits that 'TIVOLI' is not a coined word and it is the name of a town in Italy. Thus, merely because 'TIVOLI' forms part of the Appellant's mark, similarity cannot be assumed.

12. Ld. Counsel for the Respondent, on the other hand, submits that considering the cited marks which are registered already in India, the Appellant is not entitled to registration.

13. Under the Trade Marks Act, 1999, an objection is raised under Section 11 whenever there are registered marks which are either identical or deceptively similar to the mark sought to be registered. In the present case, the cited marks are as under:

S. No.	**APPL. NO.**	**CLASS**	**CONFLICTING MARK**
1	1596593	42	TIVOLI HOLIDAY VILLAGE
2	1689416	42	TIVOLI CITITEL
3	2121623	43	TIVOLI

14. Out of the above three trademarks, the mark at serial no.3 has been opposed. Insofar as the registrations at serial nos. 1 and 2 are concerned the said marks are registered marks and they fall in the same class as the mark

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sought to be registered by the Appellant. However, a perusal of the said registrations would show that the same have been filed subsequent to the Appellant's adoption of the mark which dates back to 1933. The existence of registration of the domain name www.tivolihotels.com in favour of the Appellant, as also the long user and adoption, persuades this Court to take a view that this case of the Appellant could fall within the exception under Section 12 of the Act. The said section reads as under:

> ***12. Registration in the case of honest concurrent use, etc.****—In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do,* ***he may permit the registration by more than one proprietor of the trade marks which are identical or similar whether any such trade mark is already registered or not in respect of the same or similar goods or services****, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.*

15. The above section recognises honest and concurrent use. As per the said provision, two parties can register identical or similar marks if there is honest and concurrent use.

16. In the opinion of the Court, this aspect deserves to be considered by the Registrar of Trademarks in view of the overwhelming evidence which has been placed on record by the Appellant in respect of its adoption and global use of the mark in question.

17. Under these circumstances, the impugned order is set aside, the matter is remanded to the Registrar of Trademarks to take a re-look, bearing in mind the prior adoption and global use of the Appellant as also on the question of honest and concurrent user by the Appellant. The Registrar

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would evaluate the evidence and then take a decision on whether the mark of the Appellant may deserve to proceed as *`Advertised before acceptance'*, in the unique facts of this case.

18. The observations made in the present order by the Court shall not prejudice any further proceedings before the Registrar, especially, opposition proceedings, if any filed.

19. Let the present order be communicated to the Registrar of Trade Marks for necessary compliance on the email llc-ipo@gov.in.

20. The present appeal is accordingly disposed of in these terms. All pending applications are also disposed of.

PRATHIBA M. SINGH
JUDGE

AUGUST 4, 2023
dj/sk

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

\+ **C.A.(COMM.IPD-TM) 49/2021 and I.A. 14367/2023**

MHG IP HOLDINGS (SINGAPORE) PTE. LTD. ..... Appellant

Through: Ms. Neha Saraswat and Mr. Sumit Kumar, Advocates.

versus

THE REGISTRAR OF TRADE MARKS, DELHI ..... Respondent

Through: None.

CORAM:
JUSTICE PRATHIBA M. SINGH

O R D E R

% 04.08.2023

1. This hearing has been done by hybrid mode.

I.A. 14367/2023 (for correction) in C.A.(COMM.IPD-TM)-49/2021

2. This is an application seeking correction of certain clerical errors in the judgment dated 18th July 2023.

3. Ld. Counsel for the Appellant submits that in paragraph 11, the number of hotels under the name 'TIVOLI' should be read as 18 and not 150. Said para 11 of the judgment reads as follows:

> *"11. Ms. Neha Saraswat, ld. Counsel appearing for the Appellant subm"its that considering the global prior adoption, which is almost 90 years ago, as also the fact that the Appellant* ***has more than 150*** *hotels under the name 'TIVOLI', even if there are a couple of registered marks which consists of the mark 'TIVOLI', the Appellant's case deserves to be considered on trans-border reputation. She further submits that 'TIVOLI' is not a coined word and it is the name of a*

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town in Italy. Thus, merely because 'TIVOLI' forms part of the Appellant's mark, similarity cannot be assumed."

4. For the reasons stated in the application, para 11 shall now be read as follows:

> "*11. Ms. Neha Saraswat, ld. Counsel appearing for the Appellant subm"its that considering the global prior adoption, which is almost 90 years ago, as also the fact that the Appellant* ***has more than 18*** *hotels under the name 'TIVOLI', even if there are a couple of registered marks which consists of the mark 'TIVOLI', the Appellant's case deserves to be considered on trans-border reputation. She further submits that 'TIVOLI' is not a coined word and it is the name of a town in Italy. Thus, merely because 'TIVOLI' forms part of the Appellant's mark, similarity cannot be assumed."*

5. Clarified accordingly.

6. The present order shall be uploaded as a corrigendum to the judgment dated 18th July, 2023.

7. Application is disposed of.

PRATHIBA M. SINGH, J

AUGUST 4, 2023
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