2023:MHC:5376

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **13.12.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/194/2023
(OA/SR.217/2020/TM/CHN)
&
(T)CMP(TM)/6/2023

Contitech USA Inc,
703 S Cleveland, Massillion Road,
Fairlawn, Ohio-44333, USA. ... Appellant

-vs-

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

PRAYER: Transfer Civil Miscellaneous Appeal (Trade Marks) filed under Section 91 of the Trade Marks Act, 1999, prays to (i) Quash/set aside the impugned order dated 21.01.2020 passed by the Respondent in Trademark application of Appellant for Trademark TORQFLEX under No.2763546 in class 07; (ii) Restore the Trademark application of Appellant for Trademark TORQFLEX under No.2763546 in class 07 to proceed for registration in accordance with the law; and Summon the records in respect of trademark

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application Trademark application of Appellant for Trademark TORQFLEX under No.2763546 in class 07 from the office of the Respondent.

For Appellant : Mr.Shravan Kumar Bansal
Mr.Somnath De for
M/s.K.G.Bansal and Company

For Respondent : Mr.S.Janarthanam, SPC

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JUDGMENT

The appellant assails the statement of grounds of decision dated 21.01.2020 issued pursuant to the refusal order dated 11.03.2019 by which Application No.2763546 for registration of the word mark "TORQFLEX" was refused.

2. The above mentioned application was filed by the appellant on 27.06.2014 by asserting continuous use since 23.06.2014 in respect of power transmission belts for machines, motors and engines used in industrial applications. By examination report dated 04.11.2015, the respondent raised objections under Section 11 of the Trade Marks

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Act, 1999 (the Trade Marks Act) by citing four allegedly conflicting marks. The appellant responded to the examination report and stated that the appellant's mark has been adopted and used since 23.06.2014 and that the said mark is neither identical nor deceptively similar to the cited marks. Eventually, after a hearing on 11.03.2019, the refusal order was issued on 11.03.2019. Subsequently, the statement of grounds of decision was issued on 21.01.2020. The present appeal arises in the above facts and circumstances.

3. Learned counsel for the appellant invited my attention to the application and pointed out that the appellant's mark has been used since 23.06.2014. He also pointed out in this connection that this mark along with connected trade marks were assigned to the appellant by its predecessor-in-interest, Veyance Rubber India Pvt. Ltd. He also pointed out that the mark is applied in relation to the specific goods mentioned in the application. By turning to the examination report, learned counsel pointed out that the second cited mark, TORSIFLEX, is used in relation to couplings being parts of machines. On that

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basis, learned counsel submitted that the goods to which the appellant applies the mark are not similar to the goods to which the second cited mark is applied. He also pointed out that the identical mark was registered both under Class 17 and Class 35. In support of the submission that the registration of a mark in a particular class does not provide protection to the registered proprietor in respect of all the goods in that class, he relied on the judgment of the Hon'ble Supreme Court in *Vishnudas, Trading as Vishnudas Kishendas v. Vazir Sultan Tobacco Co. Ltd., Hyderabad and Another, (1997) 4 SCC 201.*

4. In response to these submissions, Mr.Janarthanam, learned SPC, submitted that the grounds of decision in respect of the refusal order contain detailed reasons for refusal of the application. In particular, learned counsel submits that by referring to the second cited mark, TORSIFLEX, it was concluded that there is a strong likelihood of confusion on the part of the public, including by way of association, on account of the similarities between the second cited mark and the appellant's mark, the similarity of goods, etc. He also

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pointed out that the judgment of the Hon'ble Supreme Court in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals, AIR 2001 SC 1952,* was referred to extensively in the statement of grounds of decision. Therefore, learned counsel submits that the impugned order does not call for interference.

5. From the application filed by the appellant before the Registrar of Trade Marks, it is evident that the application was filed by asserting use since 23.06.2014. The assignment deed executed by the predecessor-in-interest of the appellant, Veyance Rubber India Pvt. Ltd., has also been placed on record. The examination report discloses that four marks were cited as conflicting marks. Out of these four marks, only the second cited mark, TORSIFLEX, is referred to in the statement of grounds of decision. The said mark is clearly not identical to the mark of the appellant. The search report indicates that the mark is applied in respect of couplings being parts of machines. The appellant contends that the goods to which the cited mark is applied are different from the goods in relation to which the

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appellant's mark is applied. Given the specific description of goods in respect of which the respective marks are applied, there is an arguable case to contend that the goods are not similar. It should also be taken note of that the appellant has applied for and obtained registrations for the identical mark in classes 17 and 35.

6. The registered proprietor of a trade mark is only entitled to seek protection if an identical or similar mark is used in relation to identical or similar goods. Since there is an arguable case to contend that the goods to which the appellant applies its mark are not similar to the goods to which the cited mark is applied, the rejection of the application at the pre-advertisement stage was not justified.

7. Especially by taking into account the registration of the identical mark in classes 17 and 35 and the facts and circumstances set out above, (T)CMA(TM) No.194 of 2023 is allowed, the impugned order is set aside and it is directed that the application be

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accepted for advertisement. However, it is made clear that the order will not be binding on opponents, if any. There shall be no order as to costs. Consequently, the connected miscellaneous petition is closed.

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Index : Yes/ No

Internet : Yes/No

Neutral Citation: Yes/No

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SENTHILKUMAR RAMAMOORTHY J.

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