

# Chambers



GLOBAL PRACTICE GUIDES

---

Definitive global law guides offering  
comparative analysis from top-ranked lawyers

# Trade Marks

**India**

Manisha Singh and Omesh Puri

LexOrbis

[practiceguides.chambers.com](https://practiceguides.chambers.com)

# 2021

## Trends and Developments

*Contributed by:*

*Manisha Singh and Omesh Puri*

*LexOrbis see p.5*



### Trends in Trade Mark Appeal Cases before the Intellectual Property Appellate Board against Refusal of Trade Mark Applications by the Registrar of Trade Marks

In recent years, there have been a number of appeals decided by Intellectual Property Appellate Board (IPAB) against the refusal orders passed by Registrar of Trade Marks. This article will try to capture the trends of such appeal cases.

#### *Examining trade mark applications*

In India, the trade mark application is examined both on absolute and relative grounds of refusal. As per the procedure, if objections are raised by the Registrar of Trade Marks (“Registrar”), a response must be filed within one month from the date of receipt of the examination report. After reviewing the response, if the Registrar continues to maintain the objection(s), a hearing is scheduled. Alternatively, if the Registrar is satisfied with the response, the mark is accepted and advertised in the Trade Marks Journal inviting oppositions. However, if the trade mark application is refused after the hearing, the applicant needs to file an official request asking the Registrar to provide the grounds of and the materials used by them in arriving at their decision and, once the detailed grounds of refusal is issued, the applicant can file an appeal before the IPAB within three months of the receipt of grounds of refusal.

The Delhi High Court in *Intellectual Property Attorneys Association v The Controller General Of Patents Designs & Trade Marks & Anr.* vide its decision dated 16 October 2019 observed that “... the Registrar of Trade Marks is directed to strictly implement Section 18(5) of the Trade Marks Act by recording in writing grounds for refusal/conditional acceptance and the order containing the grounds of refusal/conditional acceptance be sent to the applicant within two weeks of the passing of the order.”

The Supreme Court of India in *Siemens Engineering and Manufacturing Co. of India Ltd. v Union of India* [1976 AIR SC 1785], also observed that “... It is now settled law that where an authority makes an order in exercise of a quasi judicial function it must record its reasons in support of the order it makes. Every quasi-judicial order must be supported by reasons...”

Based on these judgments, it is settled principle that the orders refusing the trade mark application are required to be reasoned and they must outline the grounds for refusal and/or materials used in refusing the application in support of the order. If the refusal orders do not provide any grounds for refusal, then it will be held in contravention of Section 18(5) of the Trade Marks Act and the above judgments. Below are summarised some of the recent appeals decided by IPAB.

#### **GRADUATE MANAGEMENT ADMISSION COUNCIL**

In an appeal against the refusal of the trade mark application for GRADUATE MANAGEMENT ADMISSION COUNCIL in class 41 on the ground of devoid of distinctive character and descriptiveness, the appellant argued that it had been using the trade mark and tradename GRADUATE MANAGEMENT ADMISSION COUNCIL since 1976. It was submitted by the appellant that it has been granted registration for the trade mark GRADUATE MANAGEMENT ADMISSION COUNCIL for class 16 goods. The acceptance was given on the condition that the mark is used as a whole.

Based on this, the appellant argued that the impugned order is inconsistent in light of the acceptance granted in class 16. The appellant has also been granted registration for the trade mark GRADUATE MANAGEMENT ADMISSION TEST in class 41 itself. It argued that it sought no exclusive proprietorship in individual terms in the trade mark, but the exclusive right is claimed on the composite mark as a whole and the trade mark applied for is a combination of the terms “GRADUATE”, “MANAGEMENT”, “ADMISSION”, and “COUNCIL”. Such combination is exclusively associated with the appellant only.

It was noted by the IPAB that the refusal order makes no reference to and has failed to consider the response to examination report filed by the appellant and the supporting documents discussing the use and adoption of the trade mark GRADUATE MANAGEMENT ADMISSION COUNCIL. Accordingly, the IPAB vide order dated 18 June 2020 allowed the appeal subject to the disclaimer on individual terms in the mark.

# INDIA TRENDS AND DEVELOPMENTS

Contributed by: Manisha Singh and Omesh Puri, LexOrbis

## *iTherm*

In an appeal against the refusal of the mark *iTherm* for class 9 goods (devices for measuring temperature, temperature sensors, temperature head transmitters, transmitter head for measuring temperature all the above excluding temperature controlling apparatus) on the ground of being identical to an earlier mark I-THERM, the IPAB allowed the appeal vide order dated 2 December 2020, as the goods for which the earlier mark was applied for were found to be different.

It was observed by the IPAB that appellant is the manufacture of thermometer for direct installation in various industrial applications whereas the proprietor of the cited mark manufactures goods related to temperature controlling apparatus in India. The IPAB held that both sets of goods are different, the consumers of both the category of goods are different and both of the categories of goods are sold through different trading channels. It was held that there does not exist any scope for the likelihood of confusion amongst the consumers and members of trade.

The IPAB relied upon the established principle of Trade Marks law that a single party cannot be allowed to claim a monopoly on the whole class of goods/services when it actually does not intend on using the mark for the whole specification of goods/services falling under the particular class. It was also observed that the Registrar did not take into consideration that the appellant has been using the mark *iTherm* in India since 2014, and internationally since 2010, and there have been no reported instances of confusion or deception in the market, nor that the mark *iTherm* is also registered in various foreign jurisdictions.

## **GREAT AMERICAN COOKIES**

The trade mark for GREAT AMERICAN COOKIES (stylised representation), in class 43 for the services “retail bakery store services, restaurant services, services providing food and drink”, was refused by the Registrar on the ground of devoid of distinctive character and descriptiveness. In an appeal before the IPAB, the appellant submitted that the GREAT AMERICAN COOKIES (stylised representation) trade mark is inherently distinctive as it is a unique logo and is presented in a distinctive manner and visual representation and it has also acquired distinctiveness by way of use and that said trade mark has acquired registration in various major jurisdictions of the world.

It was also submitted that appellant’s predecessor honestly adopted the trade mark GREAT AMERICAN COOKIES in the year 1994. Thereafter, the appellant continued to extensively use the said name and also continued to evolve the GREAT AMERICAN COOKIES brand. It was in 1997 that the appellant adopted the GREAT AMERICAN COOKIES (stylised representation) trade mark as an extension of the GREAT AMERICAN COOK-

IES brand in order to distinguish its goods and services in the market from those of others.

The appeal was allowed by the IPAB, holding that the same mark was registered in many overseas countries and since it is a logo mark, the absolute ground objection was waived. The trade mark was ordered to be advertised subject to the condition that the appellant shall have the exclusive rights only in respect of the mark applied for with a disclaimer to the word Cookies. It was also held that third party would be entitled to use the word “American” in a different form for which the appellant shall have no exclusive rights and that would have only right to protect the same if someone used the same or deceptively similar logo.

## **TRUE SCOTCH**

The mark TRUE SCOTCH for class 33 goods (alcoholic beverages (except beers); the goods of Scottish origin) was refused registration on the ground that mark is devoid of distinctive character and descriptive in nature.

In an appeal proceeding, the appellant argued that the mark is an arbitrary combination of words TRUE and SCOTCH which was adopted in 2012 to distinguish the goods of the appellant from those of other manufacturers and that there is no possible apparent connection or the meaning of the goods sought for registration with the subject mark TRUE SCOTCH and thus it is distinctive and not descriptive. The appellant also relied upon the fact that the mark has been accepted by many trade mark offices worldwide.

The IPAB vide order dated 13 January 2020 allowed the appeal and the appellant agreed to disclaim the word “Scotch” in the registration.

## **New procedures**

Under Indian trade mark laws, a new procedure was introduced in 2017 whereby a trade mark owner can apply to the Indian Trade Marks Registry to seek determination of its mark as a “well-known trade mark”. The IPAB, in an appeal against the refusal of well known trade mark application for the mark YONEX, held that a mark can be considered as well known in India if it has attained recognition in the minds of relevant section of public rather than substantial segment of public.

## **Conclusion**

It is evident from the above that the Trade Marks Registry, in order to expedite the processing of trade mark applications, have refused number of applications which cannot be called reasoned and speaking orders. All such refusals are being challenged before the IPAB and appropriate reliefs are being provided to all the right holders by the IPAB.

Due to the COVID-19 pandemic, the hearings before the IPAB are being conducted through videoconferencing. The Supreme Court of India, on 6 April 2020, issued a number of directions to Courts across the country to facilitate hearing of cases through the videoconferencing mode. Though COVID-19 numbers are decreasing in India, hearings before the IPAB are expected to continue through videoconferencing mode in coming months.

# INDIA TRENDS AND DEVELOPMENTS

---

Contributed by: Manisha Singh and Omesh Puri, LexOrbis

LexOrbis is one of the premier and amongst the fastest-growing IP firms in India, with offices at three strategic locations, Delhi, Mumbai and Bengaluru. With a team of over 90 highly reputed lawyers, engineers and scientists, it acts as a one-stop shop and provides practical solutions and services on all intellectual property and legal issues faced by technology companies, research institutions, universities, broadcasters, content developers and brand owners. Services include Indian and global IP portfolio development and management, advisory

and documentation services on IP transactions/technology-content transfers and IP enforcement and dispute resolutions at all forums across India. The firm has a global reach, with trusted partners and associate firms. The firm's team of highly accomplished legal professionals is adept at handling all business needs and addressing complex legal and techno-legal issues, and employ cutting-edge technology systems to improve its processes and efficiency.

## Authors



**Manisha Singh** is a founder and managing partner of LexOrbis. She oversees and supervises all practice groups at the firm. She has played an important and crucial role in developing Indian IP policy and law makers on global standards associated with IP administrative and enforcement

systems. Manisha is known for her expertise in prosecution and enforcement of all forms of IP rights and for strategising and managing global patents, trade marks and design portfolios of large global and domestic companies. Her keen interest in the latest technology tools and processes has helped the firm develop efficient IP service delivery models and services. She has been involved in various IP infringement and passing off cases.



**Omesh Puri** is a partner with LexOrbis and head of the firm's trade mark, design, and copyright practice, with over 12 years' experience. He has undertaken a wide array of assignments in prosecution and enforcement of IP rights and routinely advises on complex commercial and IP

transactions. His current focus, along with IP prosecution and contentious matters, is providing advisory services to the technology and media and entertainment sectors. He is responsible for developing large IP portfolios from various industries, including pharmaceuticals, food and beverages, computer software, fashion, sports and automobiles. Omesh is actively involved in IP awareness campaigns with several government organisations. He is widely published.

---

## LexOrbis

709-710 Tolstoy House  
15-17 Tolstoy Marg  
New Delhi - 110001  
India

Tel: +91 11 23716565  
Fax: +91 11 23716556  
Email: [manisha@lexorbis.com](mailto:manisha@lexorbis.com)  
Web: [www.lexorbis.com](http://www.lexorbis.com)

