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**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
COMMERCIAL APPEAL (L) NO. 18137 OF 2021
AND
COMMERCIAL APPEAL (L) NO. 18138 OF 2021**

Metso Outotec Corporation ...Appellants
Versus
Registrar of Trade Marks ...Respondent

Mr Hiren Kamod, *with Kunal Kanungo, Himanshu Deora & Rahul Punjabi, i/b S Venkateshwar & Himanshu Deora, for the Appellants.*
Mr RS Apte, *Senior Advocate, i/b Mayuresh S Lagu, for the Respondent.*

CORAM: G.S. PATEL, J
DATED: 6th October 2021

PC:-

1. These are two Appeals or Petitions under Section 91 of the Trade Marks Act 1999 and the Trade Marks Rules 2017. They assail separate orders of 22nd May 2021 passed by the Registrar of Trade Marks, Mumbai. The Appeals now lie to this Court in view of the abolition of the Appellate Board under the Trade Marks Act.

2. The mark in question is **SISUPER**. The Appellants sought registration of both the word mark and a device mark. For the device mark, the name is depicted in a stylized fashion, possibly unique. The Petitioner/Appellant submitted before the Registrar that an international application for this mark dated 28th October 2019 designated India through the Madrid Protocol route under international registration No. 1512932. The IRDI number allotted to the mark was IRDI-4435364. On 2nd March 2020, the Petitioner received a provisional refusal, a copy of which is at page 40. This cited one reason in column (VI). The objection was under Section 9(1)(a) of the Trade Marks Act 1999.

3. The impugned order in the first matter is at page 28, Exhibit 'A'. It reads thus:

“ORDER

Above application has been filed for registration of the trade mark SISUPER on 28/10/2019 which was examined on 18/02.2020 and examination report was communicated to the applicant at his address for service. A reply to the office objection(s) had been filed on behalf of the applicant but the same was not found satisfactory and the application was set down for hearing and eventually hearing took place before me on 19/05/2021.

Adv. Arohan Bansal Attorney appeared before me and made his/her submissions. I have heard arguments and gone through the records.

The mark applied for registration is objectionable under S 9(1)(a) of the Trade Marks Act 1999, as it is devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person.

The mark applied for registration is objectionable under S 9(1)(b) of the Trade Marks Act 1999, as it consists of his may serve in trade to designate quality, intended purpose of the goods or service.

The mark ha been considered as descriptive as it refers to the quality of goods/ services.

After perusal of all the documents on record and submission made by the applicant / authorised agent it is concluded that applied mark is not registrable because of the reason stated as above. Hence application no. 4435364 cannot be accepted and refused accordingly.

Dated: 22 May 2021.”

4. On the face of it this order contains no reasons. It merely recites a Section.

5. Even that recitation is inaccurate. Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act 1999 read:

“9. Absolute grounds for refusal of registration

(1) The trade marks—

- (a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;
- (b) which consist exclusively of marks or indications 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.”

6. The order in question purports to invoke the objection under Section 9(1)(a) but actually invokes the provisions of Section 9(1)(b).

7. The Petitioner had submitted detailed submissions and representations. None of these have received any consideration at all in the order, which is entirely too cryptic. Mr Kamod for the Petitioner / Appellant says there are several authorities in support of his application. He makes it clear that his client claims no exclusivity over the word **SUPER** *per se*. He accepts that this is a common English word and speaks to the quality of the goods. There is, however, in his submission an explanation both on facts and in law. On facts, he is in a position to demonstrate how the mark **SISUPER** was coined and adopted — it has, he says, nothing to do with SUPER. A mark can split in different ways, and therefore the law requires that the mark be taken as a whole. One splitting could be SI and SUPER. Another could be SISU and PER. It is not only the former that is rigidly fixed. The latter, if accepted, would fall under neither Section 9(1)(a) nor (b). That is why such a carving up is impermissible.

8. On law, he submits that there is sufficient authority that a mark cannot be dissected and on the basis that one dissected component is a common word or is descriptive, the application for registration of the mark, read as a whole, cannot be rejected.

9. In essence, his submission is that the mark **SISUPER** is not and cannot be treated as a mark “SUPER” simpliciter. He also

submits that the Registrar could well have entered a disclaimer disallowing the Petitioner from claiming exclusivity over the word SUPER *per se*. Even this has not been done, although in his submission such a dissection is not permissible in law.

10. He makes these submissions on a without prejudice basis.

11. The real difficulty in my assessing this order is that it contains no reasons at all. None of these submissions are considered at all. The order only says that the Registrar has heard an Advocate who appeared and has gone through the records. But that process of analysis must surely reflect in the order itself. It is not permissible for the authority to merely note that submissions have been made and directly arrive at a conclusion with no findings or consideration of the submissions at all.

12. In any case, the form of this order, i.e. the total elision of all reasons, is contrary to the statutory mandate of Section 18(5) in Chapter III of the Trade Marks Act 1999. That Section requires written reasons if an application is rejected or only conditionally accepted. The grounds for the refusal or conditional acceptance and also, importantly for our purposes, the materials used by the Registrar must be reflected in the order.

13. The Appeals succeed. The orders of 22nd May 2021 are quashed and set aside.

14. The application will be heard by the Registrar afresh at his earliest convenience without being influenced by the impugned order.

15. Both Appeals are disposed of in these terms. No costs.

16. Mr Apte seeks to appear for the Registrar. I have not permitted this. The Registrar is the authority that issued the order under appeal. He is not a party to any lis. He can no more enter the arena to 'defend' his order any more than an arbitrator can appear before a Section 34 challenge court or a judge before an appellate court. The order must speak for itself.

17. All concerned will act on production of a digitally signed copy of this order.

(G. S. PATEL, J)