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

% *Date of Decision: 14th October, 2022*

+ C.A.(COMM.IPD-TM) 13/2022

ENTREPRENEUR MEDIA, INC Appellant
Through: Mr. Peeyoosh Kalra and Ms. Aarti
Aggarwal, Advocates.

versus

THE SENIOR EXAMINER OF TRADE
MARKS DELHI Respondent
Through: Ms. Kunjala Bhardwaj, Ms. Vidhi
Jain and Mr. Madhav Bajaj, Advocates for
Mr. Kirtiman Singh, Central Government Standing
Counsel.

CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH

JUDGEMENT

JYOTI SINGH, J. (ORAL)

1. Present appeal has been preferred under Section 91 of the Trade Marks Act, 1999 (hereinafter referred to as the 'Act') seeking setting aside of the order dated 21.07.2020, passed by the Respondent as well as for a direction to the Registrar to proceed with registration of the trademark 'ENTREPRENEUR' under TM application No. 3233928.

2. The brief and relevant facts necessary for the disposal of the present appeal, as culled out from the averments in the appeal, are that Appellant is a company that publishes the renowned 'ENTREPRENEUR' magazine, with its headquarters in USA. The magazine, first published in the year 1977, publishes 8 issues annually and is published under license, internationally in countries such as Hungary, India, Mexico, Philippines, Russia, South Africa, etc.

3. For nearly 40 years, the magazine has been a definitive guide to all the diverse challenges of business ownership and is available both in print, online and as a mobile application. Appellant offers its website www.entrepreneur.com in many geographical editions, such as India, USA, Europe, South Africa etc.

4. In India, the magazine was first published in September, 2009. Appellant uses the mark 'ENTREPRENEUR' with its variations and has secured registrations internationally for the said mark in jurisdictions, such as United States of America, Canada, Mexico, etc. The mark 'ENTREPRENEUR' is registered in Class 16 in India in respect of "*paper goods and printed matter, namely, magazines, books and published reports pertaining to business opportunities*" under Application No. 1035820, dating back to 10.08.2001. The earliest registration obtained in respect of the mark internationally, goes back to 23.06.1983, in Canada in Class 16 in respect of "*paper and printed goods*".

5. It is the case of the Appellant that in India, Appellant filed an application in Form TM-52 under No. 3233928, dated 13.04.2016, for registration of the trademark 'ENTREPRENEUR' in classes 09, 38 and 41 in respect of various pre-recorded audio and audio-visual programs concerning strategies etc. as mentioned in para 2 (v) of the appeal on 'proposed to be used basis'.

6. Registrar of Trade Marks scrutinized the Application No. 3233928 and issued an Examination Report dated 15.10.2016, raising the following objections: -

"The Trade Mark application is open to objection on relative grounds of refusal under Section 11 of the Act because the

same/similar trade mark(s) is/are already on record of the register for the same or similar goods/services. The detail of same/similar trademarks is enclosed herewith.

The objection is raised under Section 11(1) of the Trade Marks Act, 1999, as the mark is identical with or similar to earlier marks in respect of identical or similar description of goods or services and because of such identity or similarity there exists a likelihood of confusion on the part of the public”

7. Appellant filed a request on Form TM-M dated 17.04.2017 seeking extension of time in filing reply to the Examination Report and finally on 16.05.2017, the Appellant filed its reply, responding to the objections raised in the Examination Report and to ensure that the mark ‘ENTREPRENEUR’ is accepted and proceeds for advertisement in the Trade Marks Journal. Appellant also filed Evidence Affidavit dated 11.10.2017, in support of use of the subject Trade Mark, along with a Letter of Consent dated 05.09.2017, issued by Mr. Gaurav Marya, Proprietor of one of the cited marks from the Examination Report, consenting to the use and registration of the Appellant’s trademark ‘ENTREPRENEUR’.

8. On 16.07.2019, hearing was accorded to the Appellant by the Registrar of Trade Marks. Counsel appearing for the Appellant attended the hearing and advanced submissions for acceptance of the mark ‘ENTREPRENEUR’ for advertisement, on the ground that one of the cited mark was ‘refused’, the second stood abandoned and the third and fourth were applied for in respect of completely different businesses/products.

9. Respondent declined acceptance of the mark *vide* impugned order dated 21.07.2020, invoking Section 11(1) of the Act, on the ground that the mark applied for is identical with/similar to earlier trademarks on record and

on account of similarity of marks and goods and services covered under the marks, there exists a likelihood of confusion in the mind of public.

10. Mr. Peeyoosh Kalra, learned counsel appearing on behalf of the Appellant submits that Registrar of Trade Marks has completely erred in disallowing the mark 'ENTREPRENEUR' to proceed for advertisement in the Trade Marks Journal. The mark ENTREPRENEUR is an English word which has been adopted by the Appellant to identify and demarcate its goods from the others. The mark has been adopted from the name of the Appellant's company i.e. Entrepreneur Media, Inc. and the obvious association between the two lends greater exclusivity and distinctiveness to the mark in public perception. Respondent failed to appreciate that the mark stands registered in the name of the Appellant in several jurisdictions, world-over including Canada, Mexico, Singapore, USA etc., with the earliest registrations dating back to 23.06.1983 in Canada. The mark has been used by the Appellant in India since 2009 and has acquired distinctiveness in the local trade circles.

11. Drawing the attention of the Court to Documents on record, it is submitted that four marks were cited by the Respondent in the Examination Report to deny the acceptance and advertisement of Appellant's mark ENTREPRENEUR, as follows:-

- (a) Trademark 'ENTREPRENEUR GROW YOUR BUSINESS INDIA' (device), Application No. 2099934, registered under class 41, in the name of Mr. Gaurav Marya;
- (b) Trademark 'ENTREPRENEUR OF THE YEAR', *vide* Application No. 2407129, registered in classes 16, 35 and 41;

(c) Trademark 'Entrepreneurship Development Institute of India', under application No. 2577800, filed on August 08, 2013 in the name of Entrepreneurship Development Institute of India;



(d) Trade Mark under No. 3054976, filed on September 14, 2015, in the name of Center for Social Integration And Borderless World, in Class 41 in respect of 'arranging and conducting of networking seminars' with use claimed since November 30, 2014.

12. It is submitted by Mr. Kalra, that insofar as the cited mark (a) is concerned, firstly, the status of the mark is 'refused' and secondly, Mr. Gaurav Marya, in whose favour the mark was registered has given a consent letter in favour of the Appellant, to use and register the mark. The Letter was placed before the Respondent but has been totally overlooked. Insofar as trademark (b) is concerned *vide* letter dated 14.04.2018 the application has been withdrawn, as the Applicant did not wish to prosecute the application further.

13. With respect to trademarks (c) and (d) aforementioned, it is submitted that the said marks are in respect of goods/services which are wholly different from the Appellant's and therefore, rejection under Section 11(1) of the Act that there is likelihood of confusion is erroneous.

14. In order to substantiate and support the contention with respect to marks (c) and (d), learned counsel has relied on the judgments of the Supreme Court in *Nandhini Deluxe v. Karnataka Cooperative Milk*

Producers Federation Limited, (2018) 9 SCC 183 and Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd., (1997) 4 SCC 201.

15. Learned counsel submits that in *Nandhini Deluxe (supra)*, more particularly para 33 thereof, Supreme Court has held that a proprietor of a trademark cannot enjoy monopoly over the entire class of goods. The Supreme Court placed reliance on the earlier judgment of the Supreme Court in *Vishnudas Trading (supra)*, where it was held that:-

“47. The respondent Company got registration of its brand name “Charminar” under the broad classification “manufactured tobacco”. So long such registration remains operative, the respondent Company is entitled to claim exclusive use of the said brand name in respect of articles made of tobacco coming under the said broad classification “manufactured tobacco”. Precisely for the said reason, when the appellant made application for registration of quiwam and zarda under the same brand name “Charminar”, such prayer for registration was not allowed. The appellant, therefore, made application for rectification of the registration made in favour of the respondent Company so that the said registration is limited only in respect of the articles being manufactured and marketed by the respondent Company, namely, cigarettes. In our view, if a trader or manufacturer actually trades in or manufactures only one or some of the articles coming under a broad classification and such trader or manufacturer has no bona fide intention to trade in or manufacture other goods or articles which also fall under the said broad classification, such trader or manufacturer should not be permitted to enjoy monopoly in respect of all the articles which may come under such broad classification and by that process preclude the other traders or manufacturers from getting registration of separate and distinct goods which may also be grouped under the broad classification. If registration has been given generally in respect of all the articles coming under the broad classification and if it is established that the trader or

manufacturer who got such registration had not intended to use any other article except the articles being used by such trader or manufacturer, the registration of such trader is liable to be rectified by limiting the ambit of registration and confining such registration to the specific article or articles which really concern the trader or manufacturer enjoying the registration made in his favour. In our view, if rectification in such circumstances is not allowed, the trader or manufacturer by virtue of earlier registration will be permitted to enjoy the mischief of trafficking in trade mark. Looking to the scheme of the registration of trade mark as envisaged in the Trade Marks Act and the Rules framed thereunder, it appears to us that registration of a trade mark cannot be held to be absolute, perpetual and invariable under all circumstances. Section 12 of the Trade Marks Act prohibits registration of identical or deceptively similar trade marks in respect of goods and description of goods which is identical or deceptively similar to the trade mark already registered. For prohibiting registration under Section 12(1), goods in respect of which subsequent registration is sought for, must be (i) in respect of goods or description of goods being same or similar and covered by earlier registration and (ii) trade mark claimed for such goods must be same or deceptively similar to the trade mark already registered. It may be noted here that under sub-section (3) of Section 12 of the Trade Marks Act, in an appropriate case of honest concurrent use and/or of other special circumstances, same and deceptively similar trade marks may be permitted to another by the Registrar, subject to such conditions as may deem just and proper to the Registrar. It is also to be noted that the expression “goods” and “description of goods” appearing in Section 12(1) of the Trade Marks Act indicate that registration may be made in respect of one or more goods or of all goods conforming a general description. The Trade Marks Act has noted distinction between description of goods forming a genus and separate and distinctly identifiable goods under the genus in various other sections e.g. goods of same description in Section 46, Sections 12 and 34 and class of goods in Section 18, Rules 12 and 26 read with Fourth

Schedule to the Rules framed under the Act.

(emphasis supplied)

48. *The “class” mentioned in the Fourth Schedule may subsume or comprise a number of goods or articles which are separately identifiable and vendible and which are not goods of the same description as commonly understood in trade or in common parlance. Manufactured tobacco is a class mentioned in Class 34 of Fourth Schedule of the Rules but within the said class, there are a number of distinctly identifiable goods which are marketed separately and also used differently. In our view, it is not only permissible but it will be only just and proper to register one or more articles under a class or genus if in reality registration only in respect of such articles is intended, by specifically mentioning the names of such articles and by indicating the class under which such article or articles are to be comprised. It is, therefore, permissible to register only cigarette or some other specific products made of “manufactured tobacco” as mentioned in Class 34 of Fourth Schedule of the Rules. In our view, the contention of Mr Vaidyanathan that in view of change in the language of Section 8 of the Trade Marks Act as compared to Section 5 of the Trade Marks Act, 1940, registration of trade mark is to be made only in respect of class or genus and not in respect of articles of different species under the genus is based on incorrect appreciation of Section 8 of the Trade Marks Act and Fourth Schedule of the Rules.”*

16. Learned counsel appearing on behalf of Respondent, fairly and candidly submits that in view of the judgements in *Nandhini Deluxe (supra)* and *Vishnudas Trading (supra)*, she has written instructions not to contest the matter.

17. Having heard the learned counsel for Appellant and on perusal of the impugned order, this Court is of the view that Respondent has failed to accord consideration to the submissions made and documents filed by the

Appellant. The matter, therefore, deserves to be remanded back to the Registrar for consideration of the following points, *inter alia*:

A. Documents in respect of trademark (a) indicating: (i) status of the mark as 'refused'; and (b) consent letter issued by Mr. Gaurav Marya on 05.09.2017, whereby he has written to the Registrar of Trade Marks, consenting to the use and registration of the mark by the Appellant.

B. Withdrawal of application in respect of trademark (b) by the Applicant therein *vide* letter dated 14.04.2014, copy of which has been filed in this Court.

C. Contention of the Appellant with respect to Trademarks (c) and (d) that the goods and services under the cited allegedly conflicting marks are dissimilar.

18. Accordingly, the impugned order dated 21.07.2020 is set aside. Respondent is directed to reconsider the matter and take a decision afresh, in accordance with law.

19. Needless to state that the decision shall be taken by the Respondent uninfluenced by any observations in the present order, as this Court has not expressed any opinion on the merits of the case.

20. Appeal is allowed and disposed of in the aforesaid terms.

JYOTI SINGH, J

OCTOBER 14, 2022/sn/shivam