

Michael Hill Franchise Pty Limited Vs Registrar Of Trade Marks

Court: Intellectual Property Appellate Board, Delhi Registry Cum Bench

Date of Decision: Feb. 9, 2021

Acts Referred: Trade Marks Act, 1999 " Section 9, 11, 12, 91
Code Of Civil Procedure, 1908 " Order 41 Rule 27

Hon'ble Judges: Lakshmidevi Somanath, Technical Member; Makyam Vijay Kumar, Technical Member; Manmohan Singh, J

Bench: Full Bench

Advocate: Himanshu Deora

Final Decision: Allowed

Judgement

Trademark,"Registration

No.",Class,"Date of

Application",Status

MICHAEL HILL,2868134,35,22/12/2014,Registered

Specification of Services:

Class 35: Retail and wholesale services; advertising, retail, wholesale, and distribution of jewellery, goods of precious metal and their alloys, goods in precious metals or coated therewith, precious and semi-precious stones, jewellery cases, jewellery caskets, perfume, perfume bottles, charms, bracelets, necklaces, chains, rings, trinkets, goods of shell, amber and mother-of-pearl, horological instruments, chronometric instruments, watches and clocks, and parts and accessories for each of the foregoing; marketing and advertising services; business information services; compilation and systemisation of information into databases; organisation, operation, management, and supervision of customer loyalty programmes and schemes; privileges and loyalty recognition programmes; frequent use bonus incentive schemes; schemes involving accumulation of points for redemption by customers; product promotion services including advertising; sales and promotional incentive schemes; organisation, operation and supervision of sales and promotional incentive schemes; database management; invoicing services; information, advisory and consultancy services in

relation to the aforementioned services; provision of all of the aforementioned services

electronically, including via the Internet." ,,,,

10. The Appellant submitted that it has extensive presence of the subject mark MICHAEL HILL that can also be found on third party websites ,,,,

including but not limited to the widely popular social networking websites such as Facebook, Twitter, and Instagram. The said ownership and operation" ,,,,

adds to the easy accessibility of the various goods/services and makes the same accessible to the public at large thereby creating an association of the ,,,,

subject mark MICHAEL HILL with the Appellant in minds of the purchasing public and members of the trade. ,,,,

11. The Appellant submitted that the Application No.2868132 for the registration of subject trademark MICHAEL HILL in class 14 was filed ,,,,

by the Appellant on December 22, 2014 and the subject application was objected under Sections 9 and 11 of the Trade Marks Act, 1999 along with an" ,,,,

objection to file a duly attested Power of Attorney. The Appellant filed the suitable Reply dated 16-April- 2016 the objections raised in the examination ,,,,

report. A show cause hearing was listed on 01-January- 2019 and the counsel for the Appellant made submissions and produced evidence to ,,,,

overcome the objections raised. The Hearing Office seems to have not perused the same and the Ld. Hearing Officer refused the application by ,,,,

Refusal order dated January 01, 2019. Pursuant to the request on Form TM- M, the statement of grounds of refusal dated 21st February, 2019 (with" ,,,,

the printed date of 07-Feb-2019) was received by the Appellant on 28th February, 2019. The said refusal order and the statement of grounds of" ,,,,

refusal are impugned in the present appeal. That aggrieved by the impugned order, the Appellant preferred the present appeal." ,,,,

12. The learned counsel for the Appellant Mr. Himanshu Deora submitted that the Registrar of Trade Marks had erred by completely disregarding the ,,,,

evidences and submissions put forth by the counsels for the Appellant during the hearings listed on January 01, 2019. The Appellant submitted that" ,,,,

MICHAEL HILL is a distinctive trademark and it is not a common name/ personal name in India. And that the Appellant's Application No. ,,,,

2868134 for the mark MICHAEL HILL in class 35, which was accepted & advertised at the time of issuance of the impugned order has proceeded" ,,,,

to registration. The subject trademark has been held to be distinctive and hence registrable by numerous Trade Marks Offices worldwide, including" ,,,,

but not limited to Australia, China, Canada, Hong Kong, New Zealand, Switzerland, United Kingdom, USA etc. this aspect has been completely" ,,,,

ignored by the Ld. Registrar with regards to refusal under Section 9. ,,,,

13. The Appellant further submitted that with regards to the refusal under Section 11 Respondent has cited 4 prior marks in the examination report as ,,,,

follows:,,,,

Registration No. 1240569- MICHAEL KORS,,,,

Registration No. 1515251- MICHAEL ARAM,,,,

Application No. 2820156-,,,,

Application No. 2858187-,,,,

The Appellant stated that none of the cited marks under Section 11 are sustainable as the Appellant adopted the subject mark MICHAEL HILL prior,,,,

to all the parties. Out of these four cited marks, 2 marks namely Application No. 2820156 and 2858187 have been abandoned. Application No." ,,,,,

2820156 has been abandoned pursuant to the opposition by the Appellant. Hence, these marks are not valid citations against the subject mark. As" ,,,,,

regards to other two marks i.e., MICHAEL KORS and MICHAEL ARAM, the Appellant stated that (a) Appellant is the prior adopted of the subject" ,,,,,

mark MICHAEL HILL in the year 1979 and it has been extensively used by the Appellant on worldwide basis, (b) the cited marks are not identical or" ,,,,,

similar to the subject trademark, (c) the Appellant has been co-existing with these parties in various jurisdictions." ,,,,,

12. The Appellant submitted that the Respondent erred in refusing the Appellant's mark and relied on the following decision in support of its case:,,,,

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a) Dubai Islamic Bank vs. Union of India & Ors., W.P. (C) 12749/2019- Para-8 & 9- in this case, the Hon'ble Delhi High Court observed that the" ,,,,,

Registrar would have to consider all the following factors before rejecting a mark- the character of the mark, the extent of use of the mark, the global" ,,,,,

priority in adoption of the mark, the well-known status of the mark, the advertising and promotional investment in the mark, judicial decisions upholding" ,,,,,

the distinctiveness of the mark and the localized reputation of the mark. ,,,,,

b) Louis Vuitton Malletier vs. Iqbal Singh and Ors., 2019(78)PTC 315(Del)- in this case, the Court accepted the rights of the Plaintiff, inter alia, in the" ,,,,,

trademark LOUIS VUITTON derived from the name of its founder Mr. Louis Vuitton and not only issued permanent injunction in favour of the ,,,,,

Plaintiff, but also declared that it is a well-known trademark." ,,,,,

c) S. Oliver Bernd Freier Gmbh & Co. Kg. Vs. Rasul Exports and Ors., 2014(58)PTC 630(Del)- Para- 21, - in this case, the Plaintiff was the owner of" ,,,,,

the trademark "S. Oliver" derived from the name of its founder. Plaintiff was engaged in the business of manufacture and trade of a wide range of ,,,,,

fashion and lifestyle products and the Defendant was using OLIVE in relation to the readymade garments. The Court accepted the Plaintiff's ,,,,,

rights in the mark "S. Oliver" and granted injunction in favour of the Plaintiff. ,,,,,

d) Tata Sons Limited and Ors. Vs. Aniket Singh, 2016(65)PTC 337(Del)- Para- 36- in this case, the Court accepted the Plaintiff's rights in the",,,,

name Mr. Cyrus Pallonji Mistry and granted permanent injunction in favour of the Plaintiff, directing the Defendants to the domain names-",,,,

www.cyrusmistry.co.uk and www.cyrusmistry.co to the Plaintiff.,,,,

13. The Appellant also submitted that pursuant to earlier direction on 12th January 2021 of this Board it had filed an Amendment Application to amend,,,

the user from "Proposed to be used" to "19th July 2007" and submitted the Invoice copy of JeweleX India Private Limited who exported the,,,

jewellery to the Appellant and thus involved into the business activity in India. The Appellant claims that though internationally the mark is used since,,,

1979 and it has cross-border reputation in India its actual commercial transactions have started since 19th July 2007 which is almost seven years ago,,,

the date of the Trademark Application.,,,,

14. The Appellant also relied on judgment of Hon'ble High Court of Bombay in the case of Agar Distributors and Ors. Vs. Intellectual Property,,,

Appellate Board and Ors. (29.04.2011) (2011(4)ALLMR403), in which it was held that Hon'ble Appellate Board is empowered to take additional",,,,

documents on record as contemplated under Order 41 Rule 27 of the Code of Civil Procedure, 1908. Accordingly, the Appellant's registration for",,,,

the trademark MICHAEL HILL and some other documents filed herewith may be taken on record and considered by this Hon'ble Tribunal.,,,,

15. We have examined the Registrar's impugned order 01-Jan-2019 and the statement of grounds of refusal dated 21st February, 2019 and",,,,

reviewed the submissions of the Appellant. It is evident that the Respondent orders are non-speaking orders in that no proper reasons were given in,,,

impugned orders nor the evidence produced was discussed. The Respondent would have to consider all these factors before rejecting a mark. The,,,

Respondent would have considered the mark as distinctive owing to International Registrations for the similar mark as well as Statutory protection,,,

accorded in India to the mark in class 35.,,,,

16. The mark is filed as proposed to be used and as narrated by the Appellant the two cited mark were abandoned. The Respondent stated that,,,

the Appellant's Trademark is proposed to be used on the date of the application and thus they are not entitled to take shelter even under Section 12,,,

of the Trademark Act, 1999 to claim right over the trademark applied for; however the Appellant presently filed an amendment to the user and",,,,

claiming user since 19/07/2007 and thus the benefit of Section 12 of the Trademark Act, 1999 can be accorded to the Appellant based on the usage.",,,,

The Appellant had submitted voluminous documents that prove the usage of the mark beyond any reasonable doubts and hence the TM-M,,,,

Amendment application required to be allowed and benefit under Section 12 needs to be accorded to the Appellant's Application.,,,,

17. The Appellant submission that it had obtained Registrations in various foreign jurisdictions for the mark MICHAEL HILL and had filing of the,,,,

copies of the said Registration Certificates, further since no litigation on the subject mark is pending and since it is bonafide usage of the personal" ,,,,

name of the Appellant's founder to his entity, allowing the application will not prejudice anyone." ,,,,

18. This Board in its various orders from time to time directed the Respondent to pass speaking Orders by narrating as to why the arguments,,,,,

advanced by the Applicant's Counsel and Document relied by them does not establish their case while refusing the Registrations. However the,,,,,

Respondent time and again failed to oblige the said orders of this Board. It is pertinent for this Board to mention here the judgment of Honourable,,,,,

Madras High Court by HONOURABLE MR.JUSTICE S.MANIKUMARin the case of The Collector vs K. Krishnaveni on 3 September, 2019 in" ,,,,

W.A.No.1995 of 2018 - Where it has observed the Hon'ble Supreme Court Decision - In M/s. Steel Authority of India Ltd., v. STO, Rourkela-I" ,,,,

Circle &Ors. reported in 2008 (5) Supreme 281, the Hon'ble Supreme Court testing the correctness of an order passed by the Assistant Commissioner" ,,,,

of Sales Tax against the assessment, at Paragraph 10, held as follows ""10. REASON IS THE HEARTBEAT OF EVERY CONCLUSION. IT" ,,,,

INTRODUCES CLARITY IN AN ORDER AND WITHOUT THE SAME IT BECOMES LIFELESS.""and emphasized the importance of speaking" ,,,,

orders and reasons to be provided for the decisions made. It had further discussed elaborately various case citations and law lay down by various,,,,,

courts and summarized the discussion at paragraph 47 as follows: - "47. Summarising the above discussion, this Court holds:" ,,,,

(a) In India the judicial trend has always been to record reasons, even in administrative decisions, if such decisions affect anyone prejudicially." ,,,,

(b) A quasi-judicial authority must record reasons in support of its conclusions.,,,,

(c) Insistence on recording of reasons is meant to serve the wider principle of justice that justice must not only be done it must also appear to be done,,,,,

as well.,,,,

(d) Recording of reasons also operates as a valid restraint on any possible arbitrary exercise of judicial and quasi-judicial or even administrative power.,,,,

(e) Reasons reassure that discretion has been exercised by the decision- maker on relevant grounds and by disregarding extraneous considerations.,,,,

(f) Reasons have virtually become as indispensable a component of a decision-making process as observing principles of natural justice by judicial," ,,,,

quasi-judicial and even by administrative bodies.,,,,

(g) Reasons facilitate the process of judicial review by superior courts.,,,,

(h) The on-going judicial trend in all countries committed to rule of law and constitutional governance is in favour of reasoned decisions based on.,,,,

relevant facts. This is virtually the lifeblood of judicial decision-making justifying the principle that reason is the soul of justice.,,,,

(i) Judicial or even quasi-judicial opinions these days can be as different as the judges and authorities who deliver them. All these decisions serve one.,,,,

common purpose which is to demonstrate by reason that the relevant factors have been objectively considered. This is important for sustaining the.,,,,

litigants' faith in the justice delivery system.,,,,

(j) Insistence on reason is a requirement for both judicial accountability and transparency.,,,,

(k) If a judge or a quasi-judicial authority is not candid enough about his/her decision-making process then it is impossible to know whether the person.,,,,

deciding is faithful to the doctrine of precedent or to principles of incrementalism.,,,,

(l) Reasons in support of decisions must be cogent, clear and succinct. A pretence of reasons or rubber-stamp reasons is not to be equated with a valid" ,,,,

decision-making process.,,,,

(m) It cannot be doubted that transparency is the sine qua non of restraint on abuse of judicial powers. Transparency in decision-making not only.,,,,

makes the judges and decision-makers less prone to errors but also makes them subject to broader scrutiny. (See David Shapiro in Defence of Judicial.,,,,

Candor.),,,,

(n) Since the requirement to record reasons emanates from the broad doctrine of fairness in decision-making, the said requirement is now virtually a" ,,,,

component of human rights and was considered part of Strasbourg Jurisprudence. See Ruiz Torija v. Spain EHRR, at 562 para 29 and Anya v." ,,,,

University of Oxford, wherein the Court referred to Article 6 of the European Convention of Human Rights which requires, adequate and intelligent" ,,,,

reasons must be given for judicial decisions.,,,,

(o) In all common law jurisdictions judgments play a vital role in setting up precedents for the future. Therefore, for development of law, requirement" ,,,,

of giving reasons for the decision is of the essence and is virtually a part of due process. "" ,,,,

If these principles are to be followed by the Respondent; a large percentage of its Orders/decisions cannot be appealed before us by the Applicants as.,,,,

the Applicant by reading those reasons provided would respect the decision of the Respondent.,,,,

19. In view of the above, the present appeal is allowed and impugned order of Respondent i.e., Registrar of Trade Marks, Delhi dated 01-Jan-2019 and",,,,

the statement of grounds of refusal dated 21st February, 2019 are set-aside. The Application No. 2868132 for the mark "MICHAEL HILL" in",,,,

Class 14 with amended user is directed to be accepted by the Respondent.,,,,

20. No costs. The application shall proceed further as per rules.,,,,