

Trademark | Case Law Update

Bombay High Court pulls up the Trade Marks Registry for non-speaking orders

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Section 18(5) of the Trade Marks Act, 1999 (the TM Act) mandates that when a trademark application is refused or conditionally accepted, the Registrar must record in writing the grounds for such refusal or conditional acceptance and the materials relied on in arriving at the decision. In June this year, the Bombay High Court set aside two orders of issued by the Senior Examiner of Trade Marks (Senior Examiner) that lacked any reasoning and remanded the cases to the Senior Examiner for detailed reconsideration.

In *I Am The Ocean, LLC v Registrar of Trade Marks*, the Examiner refused the trademark application of I Am the Ocean ("Ocean"), a luxury retail brand, under section 11(1) of the TM Act. Despite detailed submissions and reliance on legal precedents by Ocean, the order did not offer any specific reasons for refusal. The Court noted that the least that is expected of the adjudicating officer is the bare courtesy of application of mind and that there is a complete abdication by the officer of the quasi-judicial functions vested in them by the TM Act. The Court noted that the impugned order reduced section 18(5) of the TM Act to a redundancy.

In the case of *Acutronic Holding AG v The Senior Examiner of Trade Marks*, yet again the Court set



aside the order as it was passed by the Senior Examiner without providing proper reasoning and without consideration of the submissions made by the applicant Acutronic Holding AG. This case was also remanded by the Court to the Senior Examiner for reconsideration.

It is hoped that the above precedents will persuade the hearing officers of the Trade Marks Registry to consider applicants' submissions in detail with due application of mind and refrain from refusing applications without providing cogent reasoning.