



IN THE HIGH COURT OF JUDICATURE AT BOMBAY  
ORDINARY ORIGINAL CIVIL JURISDICTION  
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (L) NO.4264 OF 2023  
IN  
COMM MISCELLANEOUS PETITION (L) NO.3899 OF 2023

I Am The Ocean, LLC

...Applicant /  
Petitioner

*Versus*

Registrar of Trade Marks

...Respondent

Hiren Kamod, Kunal Kanungo, Tanushree S. and Atishay Jain i/b. S. Venkateshwar for the Applicant / Petitioner.

Shreyas Deshpande and Sandeep Ramon h/f. A.M. Sethna for the Respondent.

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CORAM : R.I. CHAGLA J.  
DATE : 14 JUNE 2023.

ORDER :

1. By this Commercial Miscellaneous Petition, the Petitioner is seeking to set aside the Order dated 23rd August, 2021 passed by the Examiner of Trade Marks, Trade Marks Registry, Mumbai.
2. Mr. Hiren Kamod learned Counsel for the Petitioner has referred to the impugned Order and has submitted that there was initially an order passed on 23rd August, 2021. The Petitioner had

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upon receiving the said Order called upon the Senior Examiner of Trade Marks to furnish reasons as the said Order was an un-reasoned order. The said Order had only referred to the provision Viz. Section 11(1) of the Trade Marks Act, 1999 and had further referred to cited marks in Provisional Refusal which were considered to be identical or similar having similar goods / services. The same was held likely to cause confusion among public / probable consumers. The applied mark for registration was accordingly not accepted and refused.

3. Mr. Kamod has thereafter referred to the impugned order dated 9th November, 2022 passed by Senior Examiner of Trade Marks which is nothing but a replica of the said order dated 23rd August, 2021. The same observations are recorded in the impugned order for arriving at the conclusion that the subject mark applied for is not registrable. He has submitted that there were detailed submissions made by the Petitioner and from which it is apparent that the Petitioner had made out a case as to the subject mark having distinctiveness. Further, several authorities were relied upon in support of the Petitioner's case, including the fact that the subject mark had been granted registration in the European Union and New-Zealand. The Petitioner had also dealt with the fact that the subject

mark could not be compared with the cited marks relied upon in the impugned order. There were submissions that a comparison of the subject mark with the cited marks would make it apparent that the subject mark is unique and coined device and not merely a use of the words “I AM” as in the cited marks. The subject mark is completely different in all respects i.e. phonetically, visually and structurally from the cited mark when viewed in its entirety. It was submitted that the subject mark comprising of the words “I AM” is surrounded by a cursive letter “O” which is part of the stylized word “OCEAN” and where the word “N” in “OCEAN” has a stroke extending to the right that ends with two wave crests, that has been put forward after much thought and deliberation. The subject mark produces a net impression of a distinctive mark.

4. Mr. Kamod has further referred to the authorities relied upon in the Reply of the Petitioner which hold that in comparison of marks, the marks have to be considered as a whole. This includes the decisions of the Supreme Court in *Corn Products Vs. Shangri-La Food Products Ltd.*<sup>1</sup> and *Amritdhara Pharmacy V. Satyadeo Gupta*<sup>2</sup>. He has submitted that these authorities have not even been dealt with and /

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<sup>1</sup> AIR 1960 SC 142.

<sup>2</sup> (1963) 2 SCR 484.

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or considered whilst holding that the subject mark is not registrable. He has accordingly submitted that the impugned order be set aside and the matter be remanded back for consideration.

5. Mr. Shreyas Deshpande, the learned Counsel appearing for the Respondent has submitted that there are reasons in the impugned order that the cited marks are identical / similar having similar goods / services and the same are likely to cause confusion among public / probable consumers to support the finding that the applied mark is not registrable. He has submitted that the Petitioner is also using the word “I AM” in the subject mark which is also used in the cited marks and thus this would cause confusion in the minds of the public. He has submitted that the impugned order does not merely refer to Section 11(a) of the Trade Marks Act but is a reasoned order. He has accordingly supported the impugned order dated 9th November, 2022.

6. Having considered the submissions, I find much merit in the contentions on behalf of the Petitioners. There are detailed submissions which have been placed on record in support of the Petitioner’s case. Further, the subject mark has been registered in the European Union and New Zealand. There are submissions on the

subject mark being required to be viewed in its entirety and for which the aforementioned decisions have been relied upon by the Petitioner. There are submissions that the subject mark is unique and coined device. The words “I AM” is surrounded by a cursive letter “O” which has a stroke extending to the right that ends with two wave crests. This appears to have been put forward after much thought and deliberation by the Petitioner and which produces the impression of a distinctive trade mark. There are submissions that the cited mark “I AM” is completely different in all respects i.e. phonetically, visually and structurally from the subject mark when viewed its entirety.

7. The impugned order has made no reference to the submissions and / or the authorities relied upon by the Petitioner. Thus, these submissions and authorities have not been considered in holding that the cited marks are identical / similar having similar goods / services. There is no independent application of mind on the part of the Senior Examiner of Trade Marks to the Reply submissions canvassed by the Petitioner and thus the impugned order cannot be stated to be a reasoned order as contended on behalf of the Respondent. The finding of the subject mark not being registered should have been supported by cogent reasons which the impugned

order lacks.

8. It has been observed by this Court in a series of matters which have come up that although there have been submissions and documents in support of the Petitioner's case for registration of the Trade Marks in the replies which have been filed before the Registrar of Trade Marks, these are not being considered. The replies are drafted with application of mind. The least expected of the Officer adjudicating the application is to peruse the reply and extend to it the bare courtesy of application of mind. There is complete abdication by the Registrar of Trade Marks / Senior Examiner of Trade Marks in quasi judicial functions vested in them by the Trade Marks Act and Trade Marks Rules. The impugned order reduces Section 18(5) of the Trade Marks Act to a redundancy.

9. Accordingly, impugned order dated 9th November, 2022 passed by the Respondent / Senior Examiner of Trade Marks is set aside and the matter remanded back to consider the submissions and the material on record in support of the Petitioners case in the Reply and thereafter give a reasoned order. This exercise shall be carried out by the Respondent / Senior Examiner of Trade Marks within a period of eight weeks from the date of this Order.

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10. The Commercial Miscellaneous Petition is disposed of in above terms. There shall be no order as to costs.

[ R.I. CHAGLA J. ]