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

COMMERCIAL MISCELLANEOUS PETITION NO. 650 OF 2022

Yamaha Hatsudoki Kabushiki Kaisha ... Petitioner
Versus
The Registrar of Trade Marks ... Respondent

Adv. Darius Dalal a/w Ms. Disha Mehta i/by Jehangir Gulabbhai & Bilimoria & Daruwalla for the Petitioner.

Mr. Abhishek Bhadang a/w Ms. Gauri Raghuwanshi for the Respondent.

Ms. Pranjal Sharma, Examiner of Trade Marks G I & Copyright-present.

**CORAM: MANISH PITALE, J.
RESERVED ON : 28th APRIL 2025
PRONOUNCED ON : 13th JUNE 2025**

ORDER :

. The petitioner, in short referred to as Yamaha in this petition, has challenged order dated 20th May 2021 passed by the respondent-Registrar/Examiner of Trade Marks, whereby an application moved by the petitioner for registration of trade mark 'WR' was refused. The respondent found that there was likelihood of confusion in the mind of public between the trade mark of the petitioner, of which registration was sought, and similar trade marks already on the register. In this context, Section 11(1) of the Trade Marks Act, 1999, was invoked by the respondent.

2. Before referring to the submissions made on behalf of the

petitioner and the respondent, it would be appropriate that the facts leading to the filing of the present petition are taken into account.

3. As per the petitioner, Yamaha Company was founded on 1st July 1955 in Japan and that with time it has achieved the status of being a leading manufacturer of motorcycles and marine products as also All-Terrain Vehicles (ATVs) and other such products. The petitioner has stated that it is the second largest in motorcycle sales in the world and that it is a world leader in water vehicles sales.

4. Yamaha Motors India Private Limited is a wholly owned Indian subsidiary of the petitioner with headquarters at Chennai and manufacturing facilities at various places in India. The petitioner Yamaha has already introduced and sold various products, including motorcycles in India. In that light, it has achieved distinctiveness globally in its name and brand Yamaha.

5. The petitioner has coined and adopted various distinctive trade marks from time to time and one such trade mark is WR. The petitioner states that it adopted the said trade mark WR in August 1990, in respect of two wheeler and three wheeler products, parts and accessories and that it has sold its products bearing the trade mark WR in 131 countries since 1999 and presently, it is selling the same in at least 62 countries.

6. It is stated that a particular variant of the petitioner's motorcycle bearing the trade mark WR received a Red Dot Design Award in 2013 and that the reach of the said trade mark WR has been global from the time of its inception in the year 1990. It is further stated that since the petitioner intends to launch its WR range of motorcycles in India, information regarding the same is made available in the social media and on the internet on various web-sites, including indianautosblog.com, zigwheels.com, bikedekho.com, gaadi.com, etc. It is in this backdrop that, on 5th November 2018, the petitioner filed its application for registration of the trade mark WR with the respondent in class 12, which pertains to motorcycles, motor scooters, mopeds, etc. On 28th November 2018, the Trade Marks Registry sent an email of First Examination Report (FER) citing the mark of Honda Motor Company Ltd. i.e. WR-V registered in class 12 itself as a conflicting mark and gave opportunity to the petitioner to respond to the same.

7. The petitioner submitted initial response to the FER on 26th December 2018 and subsequently a detailed response was submitted on 8th July 2020, for consideration before the respondent-Registrar. Hearing was fixed for 20th May 2021. By the impugned order dated 20th May 2021, the respondent refused to accept the application for registration of the trade mark WR of the petitioner by invoking Section 11(1) of the Trade Marks Act. Aggrieved by the same, the petitioner has filed the present

petition. Upon notice being issued, the respondent filed reply affidavit supporting the impugned order, reiterating that the petitioner's mark WR is not distinguishable from the cited mark WR-V and there is likelihood of confusion in the mind of the public. The petitioner filed rejoinder affidavit refusing the claims of the respondent, reiterating the grounds raised in the petition.

8. Mr. Darius Dalal, learned counsel appearing for the petitioner, submitted that the elaborate material placed on record of the respondent in the initial, as also the detailed response to the FER, was ignored by the respondent while passing the cryptic impugned order. It was submitted that the impugned order does refer to some of the precedents cited on behalf of the petitioner, but there is no discussion with regard to the same and the impugned order can be said to be devoid of any reasons. It was submitted that Section 11(1) of the Trade Marks Act was mechanically referred to and the impugned order was passed, refusing to accept the application of the petitioner.

9. Thereupon, the learned counsel appearing for the petitioner invited attention of this Court to the documentary material placed on record before the respondent, including the detailed response to the FER, as also the affidavit of user along with exhibits placed before the respondent. It was emphasized that the petitioner has obtained registration for the said trade mark WR in a number of international jurisdictions, including United States, European Union, Australia, New Zealand and Japan. Yet, the respondent did

not refer to the same while passing the impugned order. It is further submitted that sufficient material was placed on record to show that the trade mark WR has been used by the petitioner Yamaha in the context of its motorcycles from August 1990 onwards and that its presence on the social media, including *YouTube*, for a number of years demonstrates that the consumers in India are also familiar with the product of the petitioner bearing the trade mark WR. It was submitted that therefore, the respondent could not have brushed aside such material on the basis of single sentence reasoning while passing the impugned order.

10. Reliance was placed on the judgment of the Supreme Court in the case of *Milment Oftho Industries & Ors. v/s. Allergan Inc., (2004) 12 SCC 624*, to contend that when transborder reputation of a trade mark extends to India, the said factor cannot be ignored while considering the claim of the petitioner for grant of registration of its trade mark. On this basis, it was submitted that the impugned order ought to be set side and this Court may direct further steps to be taken by the respondent upon acceptance of the application of the petitioner.

11. On the other hand, Mr. Abhishek Bhadang, learned counsel appearing for the respondent, submitted that the impugned order correctly refers to Section 11(1) of the Trade Marks Act and in the light of the material on record, there can be no doubt about the applicability of the said provision. It was submitted that the order

passed by the respondent appears to be brief, but relevant reasoning has been recorded in the light of material placed before the respondent. It is specifically recorded that there is likelihood of confusion in the mind of the public between the trade mark of the petitioner and the cited mark, apart from other similar marks on the register and therefore, the impugned order cannot be found fault with.

12. As regards the claim of the petitioner in respect of transborder reputation extending to India, reference was made to judgment of the Supreme Court in the case of *Toyota Jidosha Kabushiki Kaisha v/s. Prius Auto Industries Limited & Ors., (2018) 2 SCC 1*, to contend that the Supreme Court has acknowledged the applicability of the principle of territoriality and in that context, it would be necessary for the petitioner to demonstrate spillover of the reputation and goodwill of its mark in India. It was submitted that hardly any material to support the same was placed on record and therefore, the impugned order does not deserve interference. It was submitted that the petition deserves to be dismissed.

13. This Court has considered the rival submissions in the light of the documentary material on record. A perusal of the FER shows that the respondent specifically raised an objection with regard to similarity of marks on the register, while citing the registered trade mark WR-V of Honda Motor Company Limited. In response, the petitioner placed on record an initial reply and

then a detailed reply along with documentary material to claim that the two marks could not be said to be similar and that in any case, the aforesaid trade mark WR in the context of the motorcycle of the petitioner Yamaha, had been in use from August 1990. It was also claimed during the course of arguments that on the basis of the material on record, it could be demonstrated that the trade mark WR of the petitioner in the context of its motorcycle and the trade mark WR-V of the Honda Motor Company Limited in the context of its car, have concurrently existed over various international jurisdictions. Much emphasis was placed on behalf of the petitioner on the fact that it has registration for its trade mark WR in a number of international jurisdictions and that goodwill and reputation associated with WR has reached India over a period of time.

14. This Court has considered the material on record to examine the said claims made on behalf of the petitioner. On a bare perusal of the two marks i.e. WR of the petitioner and WR-V i.e. the cited mark, this Court is unable to accept the contention raised on behalf of the petitioner that there is no possibility of confusion in the mind of the public between the two marks. It is to be noted that the cited mark WR-V is registered in the same class i.e. class 12, which includes motorcycles. Therefore, invoking Section 11(1) of the Trade Marks Act, on the part of the respondent, cannot be said to be misplaced. The petitioner has not been able to demonstrate why Section 11(1)(b) of the Trade Marks

Act, which pertains to similarity to a particular trade mark leading to likelihood of the confusion in the mind of the public, cannot be invoked in the facts and circumstances of the present case.

15. But, considering the elaborate material placed on record by the petitioner in response to the FER, it was incumbent upon the respondent to have at least considered the same. Such material does indicate the petitioner's claim of prior use of the trade mark WR in the context of motorcycles in international jurisdictions from August 1990 onwards. The petitioner also placed on record material to demonstrate registration of the trade mark WR in aforementioned international jurisdictions. The sales figures pertaining to its motorcycles bearing the trade mark WR in such international jurisdictions were also placed on record. It was also claimed by the petitioner that its mark has been in the international markets concurrently with the cited mark for a long period of time. This could be a situation creating special circumstances in favour of the petitioner.

16. Yet, at this stage itself, it would not be appropriate for this Court to reach findings in favour of the petitioner merely because the respondent failed to take into consideration the aforementioned material despite applicability of Section 11(1) of the Trade Marks Act. This Court also cannot ignore the position of law indicated by the Supreme Court in the case of *London Rubber Co. Ltd. v/s. Durex Products Incorporated & Anr.*, AIR 1963 SC 1882 when the Court took into consideration special

circumstances for invoking Section 12 of the Trade Marks Act, despite the subject trade marks being absolutely identical. Although, the said judgment is in the context of the Court considering the applicability of Section 12 of the Trade Marks Act, it is not an unknown phenomenon that even identical or similar trade marks can exist on the register. The claim of international reputation of the petitioner spilling over to India would also need to be considered. These aspects were completely ignored by the respondent while proceeding to refuse the application filed by the petitioner by a cryptic order.

17. In fact, this Court finds substance in the contention raised on behalf of the petitioner that the respondent could have passed a detailed and well reasoned order, particularly in the light of the elaborate material placed on record by the petitioner in response to the FER. Such a detailed reasoned order could also have assisted this Court in appreciating the material in a comprehensive manner. The petitioner also stood deprived of an opportunity to raise specific grounds to challenge the reasons that could have been given by the respondent. Be that as it may, the impugned order does show that Section 11(1) of the Trade Marks Act was invoked. As noted hereinabove, this Court is also of the opinion that Section 11(1) of the Trade Marks Act could be invoked by the respondent. But, the exercise to be carried out by the respondent ought not to have stopped at that stage.

18. Section 20 of the Trade Marks Act indicates that the options

available to the Registrar, when an application for registration is filed. In this context, the proviso to sub-Section (1) of Section 20 of the Trade Marks Act assumes significance, which the respondent in the present case has completely ignored. In fact, neither counsel invited attention of this Court to the said provision.

19. This Court also finds that the scope of Section 20 of the Trade Marks Act came up for consideration before the Delhi High Court in the case of *Jai Bhagwan Gupta v/s. Registrar of Trade Marks & Ors., 2020 SCC OnLine Del 2634*. Although, it came up in the context of the propensity of the office of the Registrar of Trade Marks of advertising all applications filed for registration of trade marks, even before considering as to whether such applications could be accepted or refused, in the said judgment Section 20 of the Trade Marks Act was considered and certain observations were made, which are found to be relevant for the present case.

20. Section 20 of the Trade Marks Act reads as follows :

“Section 20 - Advertisement of application.-(1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted together with the conditions or limitations, if any, subject to which it has been accepted, to be advertised in the prescribed manner:

Provided that the Registrar may cause the application to be advertised before acceptance if it relates to a trade mark to which sub-section (1) of section 9 and sub-sections (1) and (2) of

section 11 apply, or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do.

(2) Where —

(a) an application has been advertised before acceptance under sub-section (1); or

(b) after advertisement of an application,—

(i) an error in the application has been corrected; or

(ii) the application has been permitted to be amended under section 22, the Registrar may in his discretion cause the application to be advertised again or in any case falling under clause (b) may, instead of causing the application to be advertised again, notify in the prescribed manner the correction or amendment made in the application.”

21. In the context of the above quoted provision in the said judgment of the Delhi High Court in the case of ***Jai Bhagwan Gupta v/s. Registrar of Trade Marks & Ors.*** (supra), it was observed as follows :

“6. A perusal of the above provision shows that under Sec. 20(1), the mark can be advertised after acceptance or subject to conditions and limitations. Historically, the Registrar of Trademarks used to pass a specific order under Section 20(1) either accepting the mark or in some cases, direct advertisement of the mark before acceptance. Marks were advertised before acceptance only, in exceptional circumstances, when the examiner has a doubt as to whether the marks ought to be accepted for registration or not. This is because if a mark is advertised before acceptance and thereafter during opposition or further proceedings, the mark is either amended or corrected, it would require re-advertisement of the mark. This is in line with the settled legal position as succinctly captured in Narayanan on Trade Marks and Passing Off, [Narayanan, P. (2004). Law of

Trade Marks and Passing Off (6th ed.). Kolkata : Eastern Law House]. The Id. Author observes as under:

“5.24 Advertisement of application - s. 20 and Rules 43-46

If the applicant satisfactorily meets all the objections raised by the office, the application will be advertised in the Trade Marks Journal either as accepted or before acceptance (s.20), on the applicant furnishing a printing block, where necessary. An application may be advertised before acceptance if it relates to a trade mark to which s. 9(1) and s. 11(1) and (2) applies or in any other case where it appears that it is expedient by reason of any exceptional circumstances so to do. Where the application has been advertised before acceptance under the proviso to s. 20(1), the Registrar may in his discretion cause the application to be advertised again. Re-advertisement of the application may also be ordered where an error in the application has been corrected or where the application has been amended under s. 22 after its advertisement. In the alternative, the correction or the amendment made in the application may be notified in the Trade Marks Journal in the prescribed manner.”

7. *A similar view is expressed in Halsbury's Laws of India, Vol. 20(1), which opines as under:*

“[185.834] Advertisement of application after acceptance

When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar will, as soon as may be after acceptance, cause the application as accepted together with the conditions or limitations, if any, subject to which it has been accepted, to be advertised in the prescribed manner.”

8. *Thus, it is not in every case that a trade mark is advertised before acceptance. The said course of action ought to be the exception and not the rule. If upon examination of a trade mark application, the Registrar is of the view that the mark cannot proceed for registration, then not every mark needs to be advertised. A mechanical advertisement of marks even when it is clear that the same ought not to proceed for registration, is contrary to the maintenance of the purity of the Register. Thus, upon examination of a trade mark, as per the various applicable provisions of the Act and the Rules, the Registrar of Trade Marks, inter alia, has the following options:*

i. Accept the mark unconditionally and direct advertisement in the Trade Marks Journal;

ii. Accept the mark subject to a condition and direct advertisement in the Trade Marks Journal;

iii. Accept the mark subject to a limitation and direct advertisement in the Trade Marks Journal;

iv. Direct the advertisement of the mark in the Trade Marks Journal, before acceptance, if Section 9 or Section 11 is attracted or if exceptional circumstances exist or if it is considered expedient to do so;

v. Reject the application at that stage itself if the Registrar is of the opinion that the same ought not to proceed for registration due to any of the absolute prohibitions etc.,

9. In recent times it is noticed, that almost all the trademarks are being advertised before acceptance under the Proviso to Section 20(1) of the Act. Such a procedure would be contrary to the Act, inasmuch as there is application of mind which is required to be exercised by the Registrar of Trademarks, prior to the mark being advertised. Under Section 20(1), there has to be a reason why the Registrar of Trademarks is directing 'advertisement before acceptance' and the same cannot be a ministerial act or a mere formality. The application of mind, prior to acceptance or advertisement before acceptance, has to be deliberate and conscious and the provisions of the Act would have to be considered by the Registrar in a conscious manner. Marks that do not deserve advertisement ought not to be advertised before acceptance. The automatic or indiscriminate advertisement of trade mark applications tends to increase the burden upon the applicants to keep a watch on the Trade Marks Journal and also to oppose, leading to heavy costs to maintain trademark rights which are granted under the Act. Thus, it is not proper and is impermissible for the Registrar of Trademarks to direct advertisement of a majority of marks, before acceptance, under the proviso to Section 20(1) of the Act. A specific order would have to be passed as to the reason why the mark is being advertised after acceptance or the reason why the mark is being advertised before acceptance. The order need not be detailed but ought to exist on file, even if, very brief. The burden of the Registrar of Trademarks to examine marks as per the provisions of the Act and Rules, cannot be completely shifted upon the applicants/proprietors/owners of the trademarks. Such a procedure would result in completely ignoring the provisions of Act itself, which is impermissible. The Registrar has to maintain the purity of the Register."

22. This Court is in agreement with the above mentioned observations, which indicate that the Registrar is required to pass a reasoned order as to why a mark is being advertised after acceptance and also a reasoned order as to why a mark is being advertised before acceptance. In fact, the Registrar has the option of directing advertisement of a mark before acceptance under proviso to sub-Section (1) of Section 20 of the Trade Marks Act. It is correctly observed in the aforementioned judgment of the Delhi High Court that every application filed before the Registrar ought not to be advertised before acceptance, as it is not a ministerial act or a mere formality, but when there are reasons for advertisement before acceptance, the Registrar can certainly do so. It would depend upon the facts and circumstances of the individual case.

23. In the present matter, it is crucial to note that the Registrar came to the conclusion that Section 11(1) of the Trade Marks Act applied. But, as noted hereinabove, the petitioner had placed on record elaborate material regarding prior use in international jurisdictions, the registration obtained for the subject mark WR in such international jurisdictions, the fact that motorcycles of the petitioner bearing the trade mark WR were being sold in a number of foreign countries, also providing sales figures for the same. The petitioner specifically claims that said mark WR and the cited mark WR-V were being used concurrently in international jurisdictions. It also claimed spill over reputation in India. These factors certainly satisfy the requirements of the proviso to sub-

Section (1) of the Section 20 of the Trade Marks Act for the Registrar to direct advertisement before acceptance. The proviso not only indicates that such a step can be undertaken by the Registrar when it is found that Section 11(1) of the Trade Marks Act applies, but it also considers a situation where the Registrar finds it expedient by reason of any exceptional circumstances, so to do.

24. This Court is of the opinion that the petitioner has made out a case under proviso to sub-Section (1) of Section 20 of the Trade Marks Act and therefore, the Registrar could not have refused to accept the application of the petitioner and a direction ought to have been issued for advertisement before acceptance, in the facts and circumstances of the present case. The Registrar was required to record reasons as to why such an option was being exercised, but the impugned order being cryptic in nature, shows no consideration of any of these aspects and the application of the petitioner has been refused directly upon reference to Section 11(1) of the Trade Marks Act. In the facts and circumstances of the present case, it cannot be said that the application of the petitioner could have been refused without first advertising it and hence, the petition filed by the petitioner deserves to be allowed to that extent.

25. In view of the above, the petition is allowed. The impugned order is set aside. The respondent is directed to advertise the application of the petitioner before acceptance in terms of proviso

to Section 20(1) of the Trade Marks Act. Thereafter, the respondent shall proceed further in accordance with law.

26. The respondent is directed to take appropriate action in terms of the directions given hereinabove, within two weeks of this order being produced before it.

27. The petition is disposed of in above terms. Pending applications, if any, also stand disposed of.

MANISH PITALE, J.