

22nd August 2020

Mumbai

To,
The Registry of Trademark,
Boudhik Sampada Bhavan,
Antop Hill, S.M. Road, Mumbai-400037

Subject: Reply to the Examination Report Dated 16/08/2020 for Application NTMC2020017
in Class 12 in the name of M/S. SANIKA SURVE.

Dear Sir/Madam,

This is in furtherance to the Examination Report dated 16th August,2020 regarding the trademark "TOPAZE" which has been filed for registration through Trademark Application No. **NTMC2020017** in class **12** in the name of M/S. Sanika Surve. The concerned Application has been refused on the grounds of Section 11(1) of the Trademarks Act 1999. I would like to humbly submit the following response:

- 1) The mark "TOPAZE" is a **coined** and a **distinct** word mark. The mark does not hold any meaning in the English dictionary thereby making it highly distinctive in nature. The applied mark is therefore not deceptively similar to the earlier marks registered in the same class with similar description of goods.
- 2) The mark "TOPAZE" is a proposed to be used mark under class 12 dealing with motors and engines for land vehicles, air cushion vehicles, all automobiles on land included in class 12, parts and fittings of motor land vehicles, couplings and transmission components for land vehicles. The mark "TOPAZE" is a **fanciful** mark and has no relation to the description of the goods traded by the Proprietor of the mark. Thus, the mark is distinct from the earlier marks and does not confuse with earlier marks.
- 3) It is humbly submitted that the applied mark does not violate the provisions of Section 11(1) of the Trademarks Act as pointed out by the Examiner. The applied mark is unsimilar and distinct to the mark cited as conflicting by the Examiner since the marks are visually, orally, structurally and phonetically dissimilar to each other.

- 4) The cited mark “TOPAZ” seeks protection for limited goods as described in Class 12 whereas the applied mark “TOPAZE” seeks protection for wide range of goods which are distinct from the cited mark that are included in class 12. It has been held by Bombay High Court that there is no law that says that a solitary test of pronunciation will suffice to defeat all else that weighs against or the visual, structural similarity, attendant circumstances, lack of meaningful reputation or goodwill.¹
- 5) The Apex Court has provided for the registration of the mark in the same class for different business, which are claimed to be deceptively similar.² Thus, although the Registry has cited the mark “TOPAZ” under Application No. 289203 as deceptively similar on the grounds of section 12, there is no reason as to why the Applied mark should not be granted registration as a trademark as the precedent by the Supreme Court provides for such registration.
- 6) It is humbly submitted that there are wide range of dissimilarities between the mark “TOPAZ” and “TOPAZE” and would like to mention the same.

Sr.No	DISSIMILARITIES	“TOPAZ”	“TOPAZE”
1.	Businesses	Proprietor of this mark has protection only for parts of motor land vehicles and fittings thereof in class 12	Applicant of this mark seeks protection of various goods under class 12. The same includes all kinds of motors and engines for land vehicles, remote control vehicles, parts of vehicles, couplings and transmission components for land vehicles, accessories of motor land vehicles.

¹ *International Foodstuffs Co LLC v. Parle Products Private Limited and Anr*, Notice of Motion No. 2624 of 2012 in Suit No 2497 of 2012.

² *M/s Nandhini Deluxe vs. M/s Karnataka Co-operative Milk 2018 (9) SCALE 202*

2	Structure	The mark "TOPAZ" is made of 5 alphabets	The mark "TOPAZE" is made up of 6 alphabets with a letter 'E' in the last which is responsible for making the mark distinct from the cited mark.
3	Meaning	The word "TOPAZ" is a name of the gem and finds its meaning in the English dictionary.	The word "TOPAZE" has no meaning in the English dictionary and is a coined and a fanciful mark. Thus, the Applied mark is highly distinctive in nature.
4	Pronunciation	The mark "TOPAZ" is pronounced according to the standard pronunciation of the gem TOPAZ since its spelled the same.	The mark "TOPAZE" is not pronounced the same as the cited mark. It differs in the pronunciation due to the last alphabet "E", thus not making it deceptively similar to any earlier marks.

- 7) Apart from dissimilarities between the two marks, it is humbly submitted that the cited mark does not have a user detail and as per current status is on the verge of expiry. This shows that the Proprietor of the mark is uninterested to renew his mark and thus provides a room for the registration of the applied mark. The Trademark status of this Application is attached and named as **Annexure "A"**.
- 8) In addition to the above submissions, I would also like to bring attention to Application No. **1299262** which has been registered for the mark "TOPAZ". This mark has been registered by the Proprietor Manish Gupta who is not the same Proprietor as of the cited

mark. The trademark status and Examination report of this Application has been attached and named as **Annexure “B”** and **“C”** respectively. Application No. **1299262** was objected with the same cited mark (TOPAZ for Application no. **289203**) as it is the objecting mark for the current trademark application. The application no. **1299262** was filed under class 12 for businesses of bicycles, parts and fittings included therein, but was objected with the application no. **289203** which is filed for the protection for parts and fittings of motor land vehicles. However, the mark was later granted registration despite the initial refusal under section 11(1). The Registration Certificate of this trademark has been attached and named as **Annexure “D”**.

- 9) Thus, in the light of the above responses, it is humbly submitted that the refusal under Section 11(1) of the Trademark Act 1999 be withdrawn and the mark be accepted and advertised in the Trademark journal to proceed in furtherance to the registration of the same.

Thank You,

Adv. Richa Sharma

Annexure A

19/08/2020

E-Register - Main Page

(NOT FOR LEGAL USE)

As on Date : 19/08/2020

Status : Registered

[View TM Application](#) | [View Additional Representation Sheet](#)

Alert : Trade mark is likely to be removed due to non filing of Renewal request within prescribed time limit In case of any discrepancy contact respective TM Registry.

TM Application No.	289203
Class	12
Date of Application	05/07/1973
Appropriate Office	DELHI
State	CHANDIGARH
Country	India
Filing Mode	Branch Office
TM Applied For	TOPAZ
TM Category	TRADE MARK
Trade Mark Type	WORD
User Detail	Proposed to be used
Certificate Detail	Certificate No. 113766 Dated : 16/10/1974
Valid upto/ Renewed upto	05/07/1980
Proprietor name	(1) JASBIR SINGH. Trading As : KARTAR AUTO INDUSTRIES. Single Firm
Proprietor Address	1/526, GANDA NALA BAZAR, KASHMERE GATE, DELHI -6.
Email Id	
Goods & Service Details	[CLASS : 12] PARTS OF MOTOR LAND VEHICLES AND FITTINGS THEREFOR INCLUDED IN CLASS 12.
Publication Details	Published in Journal No. : 595-0 Dated : 16/03/1974

Trade Mark Image : (1)

TOPAZ

[PRINT](#)

[PR Details](#)

[Correspondence & Notices](#)

[Uploaded Documents](#)

[EXIT](#)

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Annexure B

22/08/2020

E-Register - Main Page

(NOT FOR LEGAL USE)

As on Date : 22/08/2020

Status : Registered

[View Registration Certificate](#)

[View TM Application](#) | [View Additional Representation Sheet](#)

Alert : Trade mark is likely to be removed due to non filing of Renewal request within prescribed time limit In case of any discrepancy contact respective TM Registry.

TM Application No.	1299262
Class	12
Date of Application	29/07/2004
Appropriate Office	DELHI
State	PUNJAB
Country	India
Filing Mode	Branch Office
TM Applied For	TOPAZ
TM Category	TRADE MARK
Trade Mark Type	WORD
User Detail	01/04/2001
Certificate Detail	Certificate No. 502283 Dated : 30/12/2005
Valid upto/ Renewed upto	29/07/2014
Proprietor name	(1) MANISH GUPTA Trading As : BRAND TECH BIKES Partnership Firm Details : CHHITIJ RAJ
Proprietor Address	D-85, PHASE-V, FOCAL POINT, LUDHIANA, (PB).
Email Id	
Agent name	MAHTTA & CO.[252]
Agent Address	43 - B/3, MAHTTA HOUSE,UDHAM SINGH NAGAR, LUDHIANA - 141 001, (PUNJAB).
Goods & Service Details	[CLASS : 12] BICYCLES, PARTS AND FITTINGS INCLUDED IN CLASS 12.
Publication Details	Published in Journal No. : 1327-4 Dated : 24/01/2005

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Annexure C

GOVT. OF INDIA
TRADE MARKS REGISTRY
OKHLA INDUSTRIAL ESTATE, NEW DELHI -110020

Date :

11/52
31/8

From : The Registrar of Trade Marks, New Delhi.

To,

Machills & Co.
Ludhiana

EXAMINATION REPORT

Application No. 1239262 in Class/Classes 12

In the name of istand Tech Bikes
Gentlemen/Madam

APPLICATION EXAMINED: With reference to the application numbered as above, I have to invite your attention to paragraph ticked (-/) below and request you to comply with the requirements thereof at an early date. Please respond to all matters raised in this report.

1. **ABSOLUTE GROUNDS FOR REFUSAL (SECTION 9)**

- Trade Mark is not capable of- distinguishing because : The mark submitted for registration is open to objection under paragraph (a), (b) & (c) of section 9(1) of Trade Marks Act, 1999. The objection arises because:

- The mark submitted for registration is open to objection under section 9(2) & 9(3) because.

2. **RELATIVE GROUNDS FOR REFUSAL (Section 11)**

- The mark submitted for registration is identical with or deceptively similar to the registered trade mark(s) and/or prior pending trade mark(s) application. Search Report is enclosed herewith.

3. **PROHIBITION UNDER SECTION 13**

- The mark submitted for registration is prohibited being a name of a chemical element or international non-proprietary name

4. **PROHIBITION UNDER SECTION 80**

- The trade mark applied for registration is open to objection under section 80 of the Act because.

5. **CONDITIONS / ASSOCIATION**

- The following conditions/association should be agreed to

6. **ADVERTISEMENT BEFORE ACCEPTANCE / ADVERTISEMENT AS ACCEPTED**

- The application will be advertised as accepted/before acceptance for registration in the Trade Marks Journal, subject to compliance with other conditions indicated in this Report.

REPLYING TO THIS REPORT: If you wish to pursue this application, you may choose to :

- Reply in writing to the grounds of objection raised in this report or provide any additional information you feel may be helpful, or provide evidence of appreciable use of the mark in respect of the goods or services specified in the application by way of an affidavit supported by documentary proof. The Registrar will re-consider the registrability of your trademark in the light of all such submissions.

- **HEARING:** ** Your hearing in this matter is fixed on 22/9 2004. You have the right to be heard at the Office of the Trade Marks Registry before the undersigned officer where the application was filed & your case may be argued there.

- **REQUEST AN INTERVIEW:** Where an advocate/agent has 100+ pending cases awaiting resolution, he may request an interview with a Deputy Registrar/ Asstt. Registrar to discuss and resolve those matters. This service is being provided by the Trade Marks Registry in addition to your right to be heard, listed above, to provide improved speed and customer service.

TIME ALLOWED FOR RESPONSE :

- It is in your interest to reply as soon as possible The Trade Marks Rules, 2002 specifies a period of one month from the date of this communication for you to reply to this report, or to request a hearing [vide R.38(5)]. In the absence of such response, your application shall be deemed to have been abandoned.

FORMALITY CHECK:

- As well as overcoming the above grounds for objection, you also need to meet the requirements of formality check reports annexed herewith. **You should address all correspondence with HEARING DATE to the undersigned for quick disposal.**

वई दिवकी
I. S. JUNBIA
Sr. Examiner of Trade Marks
New Delhi
for Registrar of Trade Marks

Yours faithfully,

Annexure D

प्ररूप ओ - 2
FORM O-2



भारत सरकार

GOVERNMENT OF INDIA

व्यापार चिन्ह रजिस्ट्री
TRADE MARKS REGISTRY

क्रमांक
No.

502283

व्यापार चिन्ह अधिनियम, 1999
TRADE MARKS ACT, 1999

व्यापार चिन्ह के रजिस्ट्रीकरण का प्रमाणपत्र, धारा 23 (2) नियम 62 (I)
Certificate of Registration of Trade Mark, Section 23 (2), Rule 62 (I)

व्यापार चिन्ह संख्या/ Trade Mark No. 1299262 दिनांक/ Date 29-07-2004 ज.संख्या/ J.No. 1327(S-IV)

यह प्रमाणित किया जाता है कि जिस प्रकार चिन्ह की सभाकृति इसके साथ संलग्न है, वह
के बारे में दिनांक नाम से रजिस्ट्रीकृत हो चुका है।

Certified that the Trade Mark / a representation is annexed hereto, has been registered in the name(s) of

MANISH GUPTA CHHITRAJ, TRADING AS BRAND-TECH BIKES, D-85, PHASE V, FOCAL POINT, LUDHIANA, (P)B,
MERCHANTS & MANUFACTURERS.

In Class 12 Under No. 1299262 as of the Date 29-Jul-2004 in respect of
BICYCLES, PARTS AND FITTINGS INCLUDED IN CLASS 12.



TOPAZ

मेरे निदेश पर आज के मास के वे दिन को इस पर मुद्रा लगायी गई।

Scaled at my direction, this December 30, day of 2005

व्यापार चिन्ह रजिस्ट्री, मुम्बई ।
Trade Marks Registry, Mumbai

व्यापार चिन्ह रजिस्ट्रार
Registrar of Trade Marks

रजिस्ट्रीकरण आवेदन की तारीख से 10 वर्ष के लिए है और वदुपसना वह 10 वर्ष को काताधि के लिए और प्रत्येक 10 वर्ष की काताधि के अवसान पर ही नवीनीकृत किया जा सकता है।
Registration is for 10 years from the date of application and may then be renewed for a period of 10 years and also at the expiration of each period of 10 years.
यह प्रमाणपत्र सिर्फ कर्तव्यसिद्धियों में प्रयोग के लिये या विदेश में रजिस्ट्रीकरण अधिप्राप्त करने के लिये नहीं है।
This certificate is not for use in Legal proceedings or for obtaining Registration abroad.
टिप्पणी - इस व्यापार चिन्ह के स्वामित्व में कोई परिवर्तन होने पर, इस आवेदन के मुद्रा लगाने के पते में या भारत में जहाँ के लिये पते में परिवर्तन होने पर परिवर्तन के लिये आवेदन पुराने चिन्ह जन्म बाधित।
Note: Upon any change of ownership of this Trade Mark, or change in address, of the principal place of business or address for service in India a request should AT ONCE be made to register the change.