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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **C.A.(COMM.IPD-TM) 20/2023**

MUNEER AHMAD Appellant

Through: Mr. C.M. Lall, Sr. Adv. With
Mr. A. Naqvee, Mr. Iman Naqvi, Mr. Saurav
Choudhary, Ms. Yashi Agrawal and Mr.
Abhinav Bhalla, Advs.

versus

REGISTRAR OF TRADE MARKS Respondent

Through: Mr. Harish Vaidyanathan
Shankar, CGSC with Mr. Srish Kumar
Mishra, Mr. Alexander Mathai Paikaday,
Mr. Krishnan V., Advs.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR


ORDER

17.11.2023

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C.A.(COMM.IPD-TM) 20/2023

1. The order dated 12 May 2023, passed by the Senior Examiner of Trademarks and impugned in the present appeal under Section 91 of the Trade Marks Act, 1999, rejects Application No. 4136359, filed

by the appellant seeking registration of the device mark  in Class 16 for "Painting Brushes, Artistic Brushes, Roller Brushes".

2. The paragraphs from the impugned order which set out the grounds for rejecting the appellant's application, read as under:

"Following objections were raised:



Section 9 (1) (a):- The mark applied for registration is objectionable under Section 9(1)(a) of the Trade Marks Act 1999, as it is devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person.

Section 9(1) (b) - The mark applied for registration is objectionable under S 9(1)(b) of the Trade Marks Act 1999, as it consists of which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service.

The reply to examination report and materials available on record till the date of hearing were considered.

The applied trademark “BHARAT with the device of brush” is devoid of any distinctive character. The applied trademark is a combination of very common words and cannot be monopolized by individual. The applied trademark is non-distinctive trademark. After considering the reply to examination report, material available on record it was observed that the subject mark is not distinctive and also any valid grounds and reasons based on which objection raised under section 9(1)(a) of the The Trade Marks Act,1999 is not maintainable to the present case.

Also the applied trademark “BHARAT with the device of brush” for the applied specification “Painting Brushes, Artistic brushes, roller brushes” is highly descriptive in nature and may serve in trade to designate quality of the applied specification. The device of brush used in the applied trademark indicate the intended purpose of the specification, as applied mark is for the brushes only. The applied trademark for the applied specification, per se not registrable.

User claimed: The application has been filed on 03/04/2019 and applicant has claimed the user since 27/01/1977. The available evidence in support of application for registration is not sufficient to prove the acquired distinctiveness of the trademark.

The objections raised in the Examination Report under section 9(1) (a) and (b) of the Trade Marks Act, 1999 cannot be waived. After perusal of records and submissions by the attorney in this regard, the registration of the mark is objectionable under section 9(1) (a) and (b) of the trademarks act, 1999”

3. I have heard Mr. Lall, learned Senior Counsel for the appellant




and Mr. Vaidyanathan, learned Counsel for the respondent.

4. Mr. Lall submits, *inter alia*, that there are several registrations granted to the word BHARAT and that, therefore, it cannot be contended that the word BHARAT is *publici juris* or devoid of any distinctive character and, therefore, ineligible for registration under Section 9(1)(a)¹ or 9(1)(b) of the Trade Marks Act for lacking in distinctiveness.

5. Mr. Vaidyanathan, learned Counsel, reiterates the impugned order.

6. Section 9(1)(a) of the Trade Marks Act proscribes registration of trademarks which are devoid of any distinctive character. The expression “devoid of any distinctive character” is explained in the same provision as “not capable of distinguishing the goods or services of one person from those of another person”.

7. The mark of which the appellant sought registration is a not a

word mark, but the device mark . It is well settled that, whether considering the eligibility of a mark for registration, or


¹ 9. **Absolute grounds for refusal of registration.** –

- (1) The trade marks –
- (a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;
 - (b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;
 - (c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade,
- shall not be registered:



examining the mark in the context of a claim of infringement or passing off, the mark has to be seen as a whole. It cannot be vivisected into its individual parts.

8. For Section 9(1)(a) to apply, therefore, learned Senior Examiner

would have had to hold that the device mark , seen as a whole, was lacking in distinctive character.

9. There is no reference, in the impugned order, to any other device mark which is similar to the device mark of which the appellant sought registration. The lack of distinctive character, as per Section 9(1)(a), *to render the mark in question incapable of distinguishing the goods or services of the applicant who seek its registration from those of others*. In my opinion, such cases can fall into two categories. There may be marks which so inherently lacking in distinctiveness as to *ipso facto* be incapable of being used to distinguish the goods or service with respect to which they are used. One may readily envisage, in this category, commonly used words, such as “and”, “the”, “it”, or the like. The second category of marks which are “lacking in distinctiveness” would be those which are so commonly found or used, in connection with goods or services, as to be incapable to acting as source identifiers. For that, there must be specific reference, in the order of the Registrar, identifying the mark which is thus “common to the trade”.

10. The impugned order does not make reference to any such mark.



11. Even otherwise, *prima facie*, the device mark of which the appellant sought registration, seen as a whole, is clearly distinctive inasmuch it incorporates the word BHARAT, written in a distinctive style, with a zig-zag swirl over the upper left edge of the “B” and the figure of a slanted paint brush.

12. The mark cannot, therefore, be said to be lacking in distinctiveness. The invocation of Section 9(1)(a) as a ground for rejecting the appellant’s application is, therefore, *ex facie*, misconceived.


13. Adverting, now, to Section 9(1)(b), the impugned order holds that the mark, of which the appellant sought registration, is descriptive in nature.

14. Here, again, the Senior Examiner appears to have examined the mark solely with respect to the paint brush, which is only part of the whole device mark of which registration was sought. Such an approach would, again, be misguided, as it would amount to viewing the mark in part. The device mark of which the appellant sought registration, seen as a whole, cannot be said to be descriptive in nature merely because a paint brush happens to be part of the mark. When the brush is seen in conjunction with the word BHARAT, written in a distinctive style, and with the zig-zag swirl on the left upper edge of the mark, the mark cannot, seen as a whole, be said to be descriptive of the product in respect of which its registration was sought. The word “BHARAT”, moreover, constitutes the most prominent feature of the mark, and cannot, by any stretch of imagination, be regarded as





descriptive of the goods in respect of which the mark is used.

15. In invoking each of the clauses of Section 9(1), therefore, the Senior Examiner has erred in viewing merely individual parts of the mark, ignoring others. *In examining the registrability of the mark, whether under Section 9 or Section 11, the mark has to be viewed as a whole.*

16. I am of the opinion, therefore, that the registration of the  device mark could not have been refused either under Section 9(1)(a) or under Section 9(1)(b) of the Trade Marks Act.

17. It does not, however, appear that the aspect of the date from which the claim of user of the appellant, could be accepted, has been clearly examined by the Senior Examiner.

18. As such, while holding the appellant's mark  to be entitled to registration as a trademark, and, therefore, setting aside the impugned order, the matter is remanded to the Senior Examiner solely to decide the date from which the claim of the appellant to user of the

 mark should be accepted.

19. As Mr. Vaidyanathan has raised an objection that most of the documents on the basis of which the appellant was seeking to substantiate its claim of user are illegible, the appellant would be at



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liberty to file a fresh affidavit of user along with documents in support thereof. Said affidavit is directed to be filed within two weeks from today.

20. After considering the said affidavit and other material on record, the Registrar would proceed, to issue the certificate of registration, incorporating the date of user of the mark by the appellant, within a period of four weeks from today.

C.HARI SHANKAR, J

NOVEMBER 17, 2023

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Click here to check corrigendum, if any