

Delhi High Court

Navaid Khan vs Registrar Of Trademarks Office on 30 May, 2023

* IN THE HIGH COURT OF DELHI AT NEW DELHI

% Date of decision: 30th May, 2023

+ C.A.(COMM.IPD-TM) 8/2023 and I.A. 4692/2023 (for stay)

NAVAID KHAN

..... Appellant

Through:

Ms.Kangan Roda and Mr.Sharad
Besoya, Advocates.

versus

REGISTRAR OF TRADEMARKS OFFICE Respondent

Through: Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar Mishra,
Mr. Sagar Mehlawat and
Mr.Alexander Mathai Paikaday,
Advocates.

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

ORDER

AMIT BANSAL, J. (Oral) C.A.(COMM.IPD-TM) 8/2023

1. The present appeal under Section 91 of the Trade Marks Act, 1999 impugns the order dated 12th January, 2023 (hereinafter 'impugned order') passed by the Registrar of Trade Marks, refusing the registration of the appellant's device mark 'CruzOil'/ (hereinafter 'subject mark'), bearing application number 4449921 (hereinafter 'subject application') in class 04.

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2. The relevant portion of the impugned order is set out below:

"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, intended purpose of the goods or other characteristics of the goods. The applied mark is highly descriptive as it designate the kind and intended purpose of the goods applied for registration. It clearly indicates that the oil is used in Cruz or for Cruz. It is the name of the product. It is not coined nor invented. It cannot be monopolized."

3. Brief facts leading to the filing of the present appeal are set out below:

3.1. On 21st February, 2020, the appellant filed the subject application for registration of the subject mark in class 04.

3.2. On 4th May, 2020, examination report was issued by the Registrar of Trade Marks raising objection under Section 9(1)(b) of the Trade Marks Act, 1999 on the ground that the mark consists exclusively of words that may serve in the trade to designate the intended purpose of the goods.

3.3. On 29th May, 2020, reply to the examination report was filed on behalf of the appellant stating that the subject mark, when considered as a whole, has no dictionary meaning nor is it used in common parlance.

3.4. A hearing notice was issued to the appellant pursuant to which representative of the appellant appeared before the respondent and made his submissions.

3.5. The impugned order dated 12th January, 2023 was passed refusing the subject application of the appellant.

Signature Not Verified Digitally Signed By:AMIT BANSAL 3.6. Accordingly, the appellant has been constrained to file the present appeal.

4. Counsel for the appellant submits that:

4.1. The subject mark is completely arbitrary and does not relate to the goods i.e., industrial lubricants. Therefore, the same is arbitrary and distinctive.

4.2. The word 'CruzOil' does not have any dictionary meaning.

4.3. A device mark having combination of words and devices has to be considered as a whole for registration.

4.4. In its trademark application, the appellant has made a disclaimer with regard to the exclusive right to use the word 'Oil'.

5. Per contra, counsel for the respondent opposes the present appeal and supports the impugned order passed by the Registrar of Trade Marks. He submits that the grounds for refusal under Section 9(1)(b) of the Trade Marks Act, 1999 are absolute and since the mark is descriptive and designates the kind and intended purpose of the goods, the Registrar has rightly refused the application.

6. I have considered the rival submissions.

7. It is important to bear in mind that the appellant has applied for registration of a composite device mark, which contains the word 'CruzOil', along with other elements. However, the impugned order proceeds on the Signature Not Verified Digitally Signed By:AMIT BANSAL basis that the subject mark is a word mark, 'CruzOil' and therefore, treats it as such.

8. The mark having a combination of words and devices has to be considered as a whole for the purposes of grant of registration. The subject mark is a device mark which consists of various unique and arbitrary elements, such as a tagline 'Lifeline for Engines', yellow background with two purple rings, unique pattern of semi circles with images of 4 stars on alternative sides with a pattern of slanting parallel lines.

9. At this stage, a reference may be made to Section 9(1)(b) of the Trade Marks Act, 1999, which is set out below:

"9. Absolute grounds for refusal of registration.--(1) The trade marks--

.....

(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;"

10. A Co-ordinate Bench of this Court in its judgment dated 18th May, 2023 in C.A.(COMM.IPD-TM) 10/2023 titled Abu Dhabi Global Market v. The Registrar of Trademarks, Delhi, has interpreted Section 9(1)(b) of the Trade Marks Act, 1999 in respect of composite marks in the following manner:

"29. Section 9(1)(b) of the Trademarks Act, in its clear and explicit terms, prescribes registration only of trade marks "which consist exclusively of mark or indications, which may serve in trade to designate the ... geographical origin... of the Signature Not Verified Digitally Signed By:AMIT BANSAL goods or services". It is only, therefore, trade marks, which consist exclusively of marks or indications which designate the geographical origin of the goods, which cannot be registered.

30. Composite marks, therefore, stand ipso facto excluded from the scope of Section 9(1)(b), even if part of such marks consist of marks or indications which serve, in trade, to designate the geographical origin of the goods or services in respect of which the mark is registered.

XXX XXX XXX

33. The "dominant part" principle is alien to Section 9(1)(b). It cannot co-exist with the "exclusivity" principle which finds statutory place in the provision. We are not concerned, here, with an infringement suit, in which similarity between dominant parts of rival marks can constitute a ground to return a finding of infringement, following the law laid down in South India Beverages Pvt Ltd v. General Mills Marketing, despite Section 17 of the Trade Marks Act which forbears claiming of exclusivity in respect only of part of a registered trade mark. We are concerned with the entitlement of the mark to registration under Section 9(1)(b). Section 9(1)(b) uses the word "exclusively". The use of the word "exclusively" completely forecloses any argument predicated on the "dominant part" principle. It is only if the entire mark exclusively falls within one of the excepted categories envisaged by Section 9(1)(b) that the registration of the mark can be treated as statutorily proscribed."

11. Therefore, in my considered view, the Registrar erred in dissecting the subject mark into its individual parts while considering registration.

12. It is relevant to note here that there were other composite marks containing the word 'Cruz' that have been registered under Class 04, details of which are given in paragraph 15 of the Memorandum of Appeal. It is also Signature Not Verified Digitally Signed By:AMIT BANSAL relevant to note that the appellant has given a disclaimer with regard to exclusive right to use the word 'Oil'.

13. In view of the above need is not felt to go into other grounds raised by the plaintiff in the present appeal.

14. Accordingly, the present appeal is allowed and the impugned order dated 12th January, 2023 is set aside.

15. The Trade Marks Registry is directed to proceed with the advertisement of the subject application as per the proviso to Section 20 of the Trade Marks Act, 1999. Let the same be done within a period of three months from today.

16. If there is any opposition to the said application, the same shall be decided on its own merits without being affected by the observations made hereinabove.

17. The Registry is directed to supply a copy of the present order to the Trade Marks Registry at llc-ipo@gov.in for compliance.

AMIT BANSAL, J.

MAY 30, 2023 sr Signature Not Verified Digitally Signed By:AMIT BANSAL