

# **Notable Delhi HC IP Division decisions pertaining to** **Section 9 of the Trade Marks Act, 1999**

## Relevant Legal Provisions

### ❖ Section 9, The Trade Marks Act, 1999

*“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;*

*...*

*shall not be registered:*

*Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.”*

## Relevant Legal Provisions (Contd.)

### ❖ Section 9, The Trade Marks Act, 1999

*“(2) A mark shall not be registered as a trade mark if—*

*(a) it is of such nature as to deceive the public or cause confusion;*

*...*

*(d) its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950)”*

## Relevant Judicial Decisions

### ❖ **Ticona Polymers, Inc. v. Registrar of Trade Marks [C.A.(COMM.IPD-TM) 89/2022]**

- The appellant applied for registration of the mark **COOLPOLY** in **Class 1** in respect of plastic and carbon moulding materials for use in the manufacture of moulded plastic articles and in **Class 9** in respect of moulded heat sinks for use in computers and parts and components thereof and moulded electrical conductors.
- “11. ...*Section 17(1) of the Trademarks Act statutory embodies this anti-dissection principle in the context of infringement proceedings, the principle would apply, mutatis mutandis, even at the stage when the mark is examined for its entitlement for registration...*” (Emphasis supplied)
- “12. ...*Senior Examiner...clearly erroneously, conflated the concept of lack of distinctiveness, addressed by Section 9(1)(a), and descriptiveness, addressed by Section 9(1)(b), and confused the two.*”
- “13. *Section 9(1)(a) would apply only where a mark was so common and so lacking in distinction as would make it impossible...to distinguish between the goods of one person and goods of another.*” (Emphasis supplied)

## Relevant Judicial Decisions (Contd.)

- ❖ **Seal For Life Industries US LLC v. The Registrar of Trade Marks [C.A.(COMM.IPD-TM) 120/2022]**
  - The appellant applied for registration of the mark **ANODEFLEX** in **Class 9** in respect of electric apparatus and instruments, not included in other classes, electric cables and wires, insulated; non-metallic sheaths for electric cables and wires; electric element coils, etc.
  - “8...it cannot be said that a mark can be straightway rejected only because it appears to be descriptive in character. The Senior Examiner would be required to examine **whether the mark has acquired distinctiveness, by scrutinizing its extent and length of user, registrations, if any, in other jurisdictions etc. ...**”
  - “10. ...**Distinctive nature of a mark can be established based on character of the mark, extent of use of the mark, global priority in adoption, well-known status, advertising and promotional investment, etc...**” (Emphasis supplied)

## Relevant Judicial Decisions (Contd.)

### ❖ Kohler Co v. Registrar of Trade Marks [C.A.(COMM.IPD-TM) 34/2022]

- The appellant applied for registration of the mark **BELIEVING IN BETTER** in **Class 35** in respect of services relating to promoting public interest and awareness in the field of kitchen and bath products, furniture and home interior products, engines and generators etc.
- “5. ...slogans or taglines are treated like word marks while processing for registration. **Several generic common English words which constitute taglines have been afforded protection under the Act. Although a tagline conveys a simple message, it can also be abstract to the extent it indicates commercial origin of the goods or services.**” (Emphasis supplied)

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## Relevant Judicial Decisions (Contd.)

### ❖ **A Dot Limited v. Registrar of Trade Marks [C.A.(COMM.IPD-TM) 25/2021]**

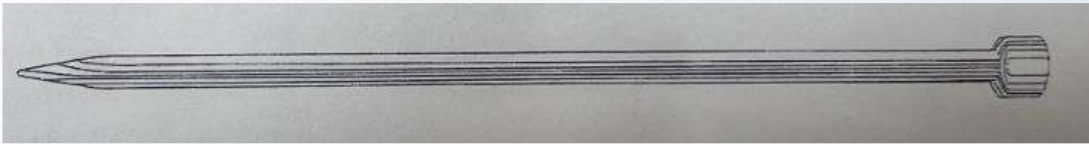
- The appellant applied for registration of the mark **WHAT DO YOU SEE?** in **Classes 16, 25, 26, 41 and 45.**
- *“3....combination of words can function as a source identifier as long as the expression does not describe or relate to the features of the products and services.”*
- *“4. This Court...has already observed that **slogans or taglines are treated like word marks while processing a Trade Mark Application for registration.**”* (Emphasis supplied)

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## Relevant Judicial Decisions (Contd.)

❖ **Knitpro International v. Examiner of Trade Marks through Registrar of Trade Marks [C.A. (COMM.IPD-TM) 110/2022]**

- The appellant applied for the **shape of a knitting needle** in **Class 26** in respect of knitting needles and crochet hooks. The image of the knitting needle sought to be registered is extracted below:



- The appellant, later, withdrew the appeal. Thus, on facts, the appeal was dismissed as withdrawn.
- *“13. ...in order for a shape trademark to be registered, it has to be shown that the said shape is not the generic shape of the product. It has to be a distinctive shape that associates the mark with the source by itself without anything further like a name or logo appended on it. The shape must have lost its inherent or generic meaning and ought to have acquired a secondary connotation. The standard of distinctiveness required to be acquired would be quite high.”* (Emphasis supplied)




## Relevant Judicial Decisions (Contd.)

- ❖ **Disruptive Health Solutions Private Limited v. Registrar of Trade Marks [C.A. (COMM. IPD-TM) 133/2022]**
  - The appellant applied for registration of the mark **HEALTHSKOOL in Class 10** in respect of bandages, condoms and other cognate and allied products in the surgical medical field.
  - *“10. ...just because some portion of the mark may have some reference or indication as to the products or services intended for, the same may not be liable to be rejected straightaway. ...the merits of the marks would have to be considered along with the extent of usage. Other registrations of the applicant would also have a bearing on the capability of the mark obtaining registration. ...”* (Emphasis supplied)
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  - *11. The spectrum of distinctiveness has to be considered while examining the applications which come up for registration before the Trade Mark Registry.”* (Emphasis supplied)

## Relevant Judicial Decisions (Contd.)

### ❖ **Abu Dhabi Global Market v. The Registrar of Trademarks, Delhi [C.A.(COMM.IPD-TM) 10/2023]**




- The appellant applied for registration of the mark  in **Classes 16, 35, 36, 41 and 45.**
- “17. ...*Distinctiveness is ...a pre-requisite for registration of a mark, but inventiveness is not. ...*”
- “23. *Evidence of user of the mark is not required to establish distinctiveness. If such an interpretation were to be accepted, marks could never be registered on “proposed to be used” basis...*”
- “30. *Composite marks...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.*”
- “33. *The “dominant part” principle is alien to Section 9(1)(b). ...use of the word “exclusively” completely forecloses any argument predicated on the “dominant part” principle. ...*”

## Relevant Judicial Decisions (Contd.)

### ❖ **Navaid Khan v. Registrar of Trademarks Office [C.A. (Comm. IPD-TM) 8/2023]**




- The appellant applied for registration of the mark  in **Class 4** in respect of lubricants, lubricants in the nature of oils, industrial oils and greases, etc.
- “8. *The mark having a combination of words and devices has to be considered as a whole for the purposes of grant of registration.*”
- “10. *...this Court in...Abu Dhabi Global Market v. The Registrar of Trademarks...interpreted Section 9(1)(b)...*”

## Relevant Judicial Decisions (Contd.)

### ❖ NRI Taxi Service Pvt. Ltd. v. Registrar of Trade Marks [C.A. (COMM. IPD-TM) 114/2022]




- The appellant applied for registration of the mark  in **Class 39** in respect of taxi services.
- “9. Counsel for the appellant has correctly placed reliance on the judgment in *Mohd. Rafiq (supra)*, the relevant observations of which are set out below:  
*...The reference to the character and quality, in our opinion, should be direct and plain and not remote and far-fetched. Likewise, the word, which is sought to be construed as laudatory, should have obvious significant of praise, and not one out of which an inference of praise has to be spelt out by a laboured process. ...*” (Emphasis supplied)

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## Relevant Judicial Decisions (Contd.)

### ❖ **Armasuisse v. The Trade Mark Registry & Anr. [C.A.(COMM.IPD-TM) 158/2022]**



- Respondent 2 applied for registration of the mark  in **Class 25** in respect of textile items.
- “103. ...*The impression of the mark on the consumer, or any other third person, is irrelevant, where Section 9(1)(b) is concerned. ...only concerned with what the mark serves to designate in trade...*”
- 104. ...*The word “geographical origin”, finding place in the company of the words “kind”, “quality”, “quantity”...to be interpreted noscitur a sociis and ejusdem generis with the said expressions. ...a mark can be said to “designate the geographical origin” of the goods only where it unequivocally does so. Section 9(2)(a), would stand attracted even in a situation in which the mark, though it does not unequivocally indicate the geographical origin of the goods, may confuse the public into assuming or believing such an origin....*” (Emphasis supplied)

## Relevant Judicial Decisions (Contd.)

### ❖ M/S Jindal Industries Private Limited v. The Registrar of Trade Mark [C.A.(COMM.IPD-TM) 99/2021]



- The appellant applied for registration of the mark & fittings, PVC flexible pipes, acrylic sheet, etc. in **Class 17** in respect of PVC pipes
- “13. *A perusal of the record shows that the Schedule to The Emblems and Names (Prevention of Improper Use) Act, 1950 does not, prevent the use of the outline of the map of India. ...the use of the outline of India signifies that the product originates from India, and thus, the use of the same cannot be held to be violative of Section 9 of the Trade Marks Act, 1999, or The Emblems and Names (Prevention of Improper Use) Act, 1950.*”

## Conclusion

- ❖ Refusal orders under Section 9 often suffer from non-application of mind, if not wholly unreasoned, with the Examiners conflating and confusing the concept of lack of distinctiveness with descriptiveness.
- ❖ The Delhi HC IPD has repeatedly come down on the Registrar/Examiner for passing orders that do not take into consideration well-established principles that guide the interpretation of provisions of Section 9 of the Trade Marks Act, 1999.
- ❖ The decisions of the Delhi HC IPD in respect of Section 9 are coherent and consistent with recurring themes of consideration of marks as a whole, the spectrum of distinctiveness of marks, relevant factors to ascertain acquired distinctiveness, geographical names in marks, taglines as marks, etc.

**Thank you!**  
**Questions?**

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