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

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Date of Decision: 21.02.2024

+ **LPA 88/2024 & CM Appls.5961-65/2024****MEHBOOB AHMAD**

..... Appellant

Through: Mr. J.Sai Deepak, Mr. Ajay Amitabh Suman, Mr. Ajay Amitabh Suman and Mr. Luv Virmani, Advs.

versus

MUNEER AHMAD & ANR.

..... Respondents

Through: Mr. Chander Mohan Lall, Sr. Advocate with Mr. Alishan Naqvee, Mr. Rupal Bhatia, Mr. Iman Naqui, Mr. Saurav Chaudhary, Ms. Yashi Agrewal and Mr. Abhinav Bhalla, Advs. for R-1.

Mr. Harish Vaidhyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Alexander Mathai Paikaday and Mr. Krishnan V., Advs. for R-2.

CORAM:**HON'BLE MR. JUSTICE VIBHU BAKHRU****HON'BLE MS. JUSTICE TARA VITASTA GANJU****VIBHU BAKHRU, J.****CM APPL. 10714/2024**

1. Respondent no. 1 has filed the present application, *inter alia*, praying as under:

“A. Pass an order clarifying paras 19 and 20 of the order dated 17.11.2023 in C.A.(COMM.IPD-TM) 20 of 2023 thereby directing the Respondent No. 2 to immediately advertise and take all necessary steps under the Trade Marks Act, 1999 to grant a certificate of registration to the Respondent No. 1 in Application No. 4136359; and”



2. The clarification sought for essentially relates to the merits of the appeal, therefore, we do not consider it apposite to consider this prayer separately.

3. The application is accordingly disposed of.

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4. With the consent of the learned counsel for the parties, the appeal is taken up for hearing.

5. The appellant has filed the present appeal impugning an order dated 17.11.2023 (hereafter '*the impugned order*') passed by the learned Single Judge of this Court in an appeal under Section 91 of the Trade Marks Act, 1999 (hereafter '*Trade Marks Act*') being CA (COMM-IPD-TM) 20 of 2023. By the impugned order, the learned Single Judge had allowed the respondent no. 1's appeal impugning an order dated 12.05.2023 passed by the Senior Examiner of Trademarks (hereafter '*the Examiner*') whereby the respondent no.1's application (application no. 4136359) for registration of



the device mark  in Class 16 for "Painting Brushes, Artistic Brushes, Roller Brushes", was rejected.

6. The Examiner had rejected the respondent no.1's application on the ground that it was devoid of any distinctive character and, therefore, is not registrable under Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act. The learned Single Judge had examined the said contention and faulted the decision of the Examiner. The learned Single Judge had noted that respondent no.1 had sought the registration of a device mark and not a word mark and the same was required to be considered as a whole. The learned



Single Judge has also held that the device mark could not be vivisected into individual parts for considering whether any part of it lacks a distinctive character.

7. There is no cavil as to the decision of the learned Single Judge in regard to whether the registration of the device mark could be refused under Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act. The controversy raised in the present appeal, essentially, relates to the operative part of the impugned order whereby, the learned Single Judge had directed the Registrar of Trademarks to proceed and issue a Certificate of Registration incorporating the date of use of the mark by the appellant within a period of four weeks from the date of the said order.

8. An application for clarification was filed by the appellant, *inter alia*, praying that the paragraphs 19 and 20 of the impugned order – which is the operative part – be clarified. However, the said application was rejected by an order dated 22.12.2023 as there was no ambiguity in the directions issued by the learned Single Judge.

9. The Examiner had issued a notice dated 23.05.2019, noting that there were objections to respondent no.1's application for registration of the mark in question under Sections 9(1)(a), 9(1)(b) and 11(1) of the Trade Marks Act. The respondent no.1 was called upon to response to the said notice.

10. Respondent no.1 had replied to the said notice and, thereafter, the Examiner passed the order dated 12.05.2023, whereby respondent no.1's application was rejected by referring to the provisions of Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act. The Examiner held that the device mark was devoid of any distinctive character. However, the ground under Section 11(1) of the Trade Marks Act – objection regarding similarity with an earlier



trademark in respect of similar or identical goods – was not mentioned.

11. Since, the learned Single Judge had found that the respondent no.1's trade mark could not be rejected, as devoid of any distinctive character under Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act, it would follow that respondent no.1's application was required to be accepted and, thereafter, advertised. However, it is pointed out by the appellant, that the Examiner of the Trademarks has not referred to Section 11(1) of the Trade Marks Act, although the same was expressly mentioned in the notice dated 23.05.2019.

12. In order to obviate any further challenge, we consider it apposite to dispose of the said appeal by remitting the matter to the Examiner. The Examiner shall consider whether to issue an advertisement in terms of proviso to Section 20(1) of the Trade Marks Act. However, we clarify that the same would be only in respect of the objection under Section 11(1) of the Trade Marks Act and in the context of the notice dated 23.05.2019 issued by the Examiner. It is clarified that the no objection under Sections 9(1)(a) and 9(1)(b) of the Trade Marks Act survives. The Registrar may also advertise the mark under Section 20(1) of the Trade Marks Act. The application for registration of the Trade Mark shall proceed in accordance with law from the aforesaid stage.

13. All contentions and rights of the parties are left open in this regard. Since, considerable time has already elapsed, we request the Examiner to process the respondent no.1's application as expeditiously as possible.

14. The appeal is disposed of in the aforesaid terms. All pending applications are disposed of as well.



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15. The hearing scheduled for 18.03.2024 stands cancelled.

VIBHU BAKHRU, J

TARA VITASTA GANJU, J

FEBRUARY 21, 2024/r

Click here to check corrigendum, if any