



2025:DHC:10350



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

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Judgment delivered on: 24/11/2025

+ **C.A.(COMM.IPD-TM) 48/2025, IA Nos.19973/2025, 19974/2025
& 19975/2025**

ASHIM KUMAR GHOSH

.....Appellant

Versus

THE REGISTRAR OF TRADE MARKSRespondent

Advocates who appeared in this case

For the Appellant : Mr. Sudarshan Kumar Bansal & Mr. Shivendra Pratap Singh, Advocates.

For the Respondent : Mr. Piyush Beriwal, Mr. Vedansh Anand, Ms. Ruchita Srivastava & Ms. Jyotsana Vyas, Advocates.

CORAM:

HON'BLE MR. JUSTICE TEJAS KARIA

JUDGMENT

TEJAS KARIA, J

1. The present Appeal has been filed by the Appellant under Section 91 of the Trade Marks Act, 1999 (“Act”) against the order dated 20.05.2025 (“**Impugned Order**”) passed by the Respondent in Trade Mark Application No. 5799569 in Class 16 for the Trade Mark ‘SoEasy’ (“**Appellant’s Mark**”) filed by the Appellant.



FACTUAL BACKGROUND:

2. The Appellant had filed the Trade Mark Application bearing No. 5799569 in Class 16 for the goods - instructional and teaching material (except apparatus), printed matter and book binding material. The said Application was filed before the Respondent on 02.02.2023 on a 'proposed-to-be-used' basis.

3. This Application was duly examined by the Registrar, who issued an Examination Report dated 15.06.2023. Contesting the same, the Appellant filed its Reply dated 01.07.2023 to the Examination Report. Thereafter, *vide* order dated 10.04.2024, the Appellant's Application was accepted under Section 20(1) of the Act subject to the condition that the Appellant's Mark shall be used as a whole.

4. Thereafter, the Registrar published the Appellant's Mark in the official Trade Mark Journal No. 2153 dated 22.04.2024. On 16.12.2024, the Respondent issued a notice dated 16.12.2024 under Section 19 of the Act ("Notice") seeking to withdraw the order of acceptance of the Appellant's Application for the registration of the Appellant's Mark on the ground that the Appellant's Mark had been erroneously accepted as it was devoid of distinctiveness and not capable of distinguishing the Appellant's goods from those of others. The Appellant was also called upon to submit its response with documents, failing which the acceptance of the said Application shall be deemed to be withdrawn. The Appellant contested the Notice by filing its Reply dated 21.12.2024, wherein it was submitted that the Notice was not



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maintainable and that it was a review and / or appeal in guise and was unsubstantiated.

5. Subsequently, the Respondent scheduled a hearing, which was held on 20.02.2025. On 19.05.2025, the Respondent issued a fresh Examination Report and, thereafter, *vide* the Impugned Order, the Respondent refused the Appellant's Application for the registration of the Appellant's Mark.

6. Being aggrieved by the Impugned Order, the Appellant has preferred the present Appeal before this Court.

SUBMISSIONS ON BEHALF OF THE APPELLANT:

7. The learned Counsel for the Appellant submitted that the power to withdraw the acceptance of a Trade Mark application conferred upon the Registrar under Section 19 of the Act is discretionary in nature and not absolute. It is further submitted that this discretion must be exercised on just grounds and not in an arbitrary manner as Section 19 of the Act does not confer unfettered powers on the Registrar to withdraw acceptance in a whimsical manner.

8. The learned Counsel for the Appellant submitted that the Appellant was entitled to the Registration Certificate and Section 19 of the Act cannot be interpreted in a manner so as to curtail the said right accrued to the Appellant as pursuant to the acceptance and publication of the Appellant's Mark, no opposition was received within the statutory time period.

9. The learned Counsel for the Appellant submitted that the First Examination Report dated 15.06.2023 issued against the Appellant's Mark raised an objection under Section 9 of the Act, which was successfully responded by the Appellant, pursuant to which the Appellant's Mark was accepted for registration *vide* order dated 10.04.2024 and published in the



Trade Marks Journal No. 2153 dated 22.04.2024. It was further submitted that the adjudication regarding the objection raised under Section 9 of the Act had attained finality and proceedings under Section 19 could not have been initiated on the very same grounds.

10. The learned Counsel for the Appellant submitted that it is evident from a plain reading of Section 19 of the Act that the Respondent can only withdraw the acceptance and not dismiss or refuse the Application itself. Therefore, the Respondent committed an error in rejecting the Appellant's Application.

11. The learned Counsel for the Appellant submitted that the Respondent issued the Notice only on limited grounds under Section 19(a) of the Act and, therefore, the proceedings could not be adjudicated under any other provision. It is further submitted by the learned Counsel for the Appellant that the "error" contemplated in Section 19(a) of the Act can only be interpreted to mean those errors, which are occasioned by mistakes or oversight or at most the errors, which are basic and fundamental in nature, not requiring any judicial application of mind as judicial errors can only be corrected in appeal or review.

12. The learned Counsel for the Appellant submitted that even though the Appellant's Mark is a combination of two ordinary dictionary words, it is an invented and arbitrary Trade Mark. It is further submitted that the Appellant's Mark consists of an unusual combination and juxtaposition of two independent English words consequently making it a coined Trade Mark. Therefore, the Appellant's Mark is inherently distinctive in nature and should be protected even without any secondary significance of the Appellant's Mark. It is also submitted that the Appellant's Mark does not



name or describe the goods in Class 16 and the said Mark is suggestive in nature as it requires imagination, thought and perception to reach a conclusion regarding the nature of the goods.

13. In view of the foregoing submissions, it is prayed that the present Appeal be allowed, thereby setting aside the Impugned Order.

SUBMISSIONS ON BEHALF OF THE RESPONDENT:

14. The learned Counsel for the Respondent submitted that the Notice was issued by the Respondent under Section 19 of the Act entirely as the Notice does not specify any particular sub-section of the said provision.

15. The learned Counsel for the Respondent submitted that under Section 19 of the Act, if the Registrar is satisfied that a particular Trade Mark should not be registered, the Registrar may withdraw the acceptance after hearing the applicant, if he so desires. It is further submitted by the learned Counsel for the Respondent that in the present case, the Impugned Order was passed by the Respondent after giving an opportunity of hearing to the Appellant in accordance with Section 19 of the Act.

16. The learned Counsel for the Respondent relied upon Section 23 of Act and submitted that under the said provision, the registration of a Trade Mark, despite non-opposition, is subject to the provisions of Section 19 of the Act.

17. The learned Counsel for the Respondent submitted that the Appellant's Mark is a laudatory word indicating that a task is accomplished with minimal effort or challenge. It is further submitted that the Appellant's Mark is a combination of generic words having a dictionary meaning and is neither coined nor invented and, therefore, it is neither a unique nor a distinctive combination of words, thus, falling under the purview of Section 9(1) of the Act.



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18. In view of the foregoing submissions, it is prayed that the present Appeal be dismissed.

ANALYSIS AND FINDINGS:

19. Heard the learned Counsel for the Parties and perused the material placed on record.

20. This Appeal raises following issues for determination:

- i. Whether the Respondent's refusal of the Appellant's Application for the registration of the Appellant's Mark is in accordance with the provisions of Section 19 of the Act?
- ii. Whether the Impugned Order erred in ruling that the Appellant's Mark is non-distinctive in nature?

21. The Impugned Order dated 20.05.2025 passed by the Respondent reads as under:

"An application No. 5799569 in class/es 16 was filed on 08/02/2023 for registration of trade mark SoEasy (Device/Word Mark) in the name of ASHIM KUMAR GHOSH, G-1326, 3rd Floor, Chittaranjan Park, New Delhi -110019 as mentioned above. The application was examined and was accepted and advertised in the Trade Marks Journal No. 2153 dated 22/04/2024.

Thereafter, it has come to the notice of the Registrar of Trade Marks that the impugned trade mark was erroneously accepted and the Registrar proposed to withdraw the acceptance due to the following reasons:

- *The impugned mark is devoid of distinctiveness and hence not capable of distinguishing the goods and services of the applicant from those of others. Therefore an opportunity to be heard may be given to the party.*



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In view of the above, hearing was conducted on 20-02-2025 and was attended by Adv. Arpit Dudeja.

• *Adv. Arpit Dudeja appeared and submitted that the applied trademark 'SoEasy' is a combination of unique, novel and inherently distinctive elements, and the subject mark bears no significance to its usual individual dictionary meaning in relation to the claimed specification of the goods. Heard and perused the documents on record. Objections have been raised under Sections 9(1)(a) and 9(1)(b) of the Trademarks Act. It has been mentioned in the reply to the examination report that the trademark applied for is an arbitrary, unique, rare and/or coined trademark in relation to the goods involved and has no attribute in relation thereto. The impugned mark 'So Easy' indicates that a task is accomplished with minimal effort or challenge. It suggests that the action is uncomplicated, direct, and requires little to no exertion, which is in direct reference to the applied specification. The impugned mark is a laudatory word, and the laudatory words are not subject matter of registration. The impugned mark is a generic word and is neither coined nor invented, having a dictionary meaning. Hence, it is neither a unique nor a distinctive combination of words; thus, it falls under the purview of 9(1)(b). Further, the present mark also does not fall in the category of "proviso" to Section 9(1), and the case of any acquired distinctiveness is not proved by satisfactory evidence because the mark was filed on a proposed-to-be-used basis. Hence, objections raised under Section 9 (1) (a) and 9(1)(b) are maintained, and accordingly, the application is refused.*

Hence, it is hereby ordered that the subject Trade Mark Application No. 5799569 in class/es 16 is refused and the status of the Trade Mark shall be updated accordingly."

22. Section 19 of the Act reads as under:

19. Withdrawal of acceptance.—Where, after the acceptance of an application for registration of a trade mark but before its registration, the Registrar is satisfied—



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- (a) that the application has been accepted in error; or*
- (b) that in the circumstances of the case the trade mark should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted,*

the Registrar may, after hearing the applicant if he so desires, withdraw the acceptance and proceed as if the application had not been accepted.

23. Section 23 of the Act reads as under:

23. Registration.—(1) *Subject to the provisions of section 19, when an application for registration of a trade mark has been accepted and either—*

- (a) the application has not been opposed and the time for notice of opposition has expired; or*
- (b) the application has been opposed and the opposition has been decided in favour of the applicant,*

the Registrar shall, unless the Central Government otherwise directs, register the said trade mark [within eighteen months of the filing of the application] and the trade mark when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of section 154, be deemed to be the date of registration.

(2) On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof, sealed with the seal of the Trade Marks Registry.

(3) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

(4) The Registrar may amend the register or a certificate of registration for the purpose of correcting a clerical error or an obvious mistake.



24. It is the Appellant's case that the Appellant was entitled to the Registration Certificate, when no objection was received against the Appellant's Mark within the statutory time-limit for notice of objection.

25. However, Section 23(1) of the Act provides that the registration of a Trade Mark that has been accepted and not been opposed within the statutory time-limit for notice of objection, is subject to the provisions of Section 19 of the Act. In other words, even if a Trade Mark has been accepted and advertised and, thereafter, no objection has been filed against the same, Section 19 of the Act empowers the Registrar to withdraw the acceptance given to the said Mark before its registration.

26. Hence, the scheme of the Act is very clear that the Respondent has the power under Section 19 of the Act to withdraw acceptance at any stage before issuing the Registration Certificate and there is no vested right of the Appellant to demand the Registration Certificate on the basis of absence of any opposition.

27. The Appellant contended that the Notice was issued by the Respondent only on limited grounds under Section 19(a) of the Act and therefore, the proceedings could not be adjudicated under any other provision. However, the Notice did not specify Section 19(a) of the Act and mentioned that:

"With reference to the above subject, Notice under the provisions of Section 19 of Trade Marks Act, 1999 is, hereby, issued to you. The above mentioned application has been accepted through an error and the Registrar proposes to withdraw the acceptance due to the following reason(s) :



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The Impugned mark is devoid of distinctiveness and hence not capable of distinguishing the goods and services of the applicant from those of others. Therefore an opportunity to be heard may be given to the party.”

28. Hence, the Notice was under Section 19 of the Act entirely and not restricted to Section 19(a) of the Act alone.

29. The Appellant further contended that the objection under Section 9 of the Act had already been raised in the Examination Report and adjudicated upon by the Respondent. Pursuant to satisfactory response by the Appellant, the acceptance to the Appellant's Mark was granted and, therefore, the adjudication regarding the objection raised under Section 9 of the Act had attained finality and proceedings under Section 19 of the Act could not be initiated by the Respondent on the very same grounds.

30. Section 19 of the Act envisages prevention of the registration of Trade Marks that do not satisfy the requirements for registration under the Act in order to maintain the purity of the Register of Trade Marks. However, the scheme of the Act does not give unfettered powers to the Registrar and confines it to the limits of revisiting and withdrawing the acceptance given to only those Marks that are accepted but are not yet registered, on the grounds provided for under Clauses (a) and (b) of Section 19 of the Act.

31. In the present case, as the Appellant's Mark was not registered, the Respondent was well within its powers to exercise jurisdiction under Section 19 of the Act to revisit the acceptance granted earlier to the Appellant's Mark and withdraw the same after giving a hearing to the Appellant.

32. Section 19 of the Act does not impose any bar on the Registrar to revisit and examine the acceptance even though the same grounds have been adjudicated upon previously while granting acceptance. The intent of



Section 19 of the Act is to maintain the purity of the Register of Trade Marks and weed out any error that might have crept in while giving acceptance to a Trade Mark that should not be registered or should only be registered subject to specific conditions or limitations.

33. Therefore, in the present case, the Respondent's withdrawal of acceptance given earlier to the Appellant's Mark before its registration was procedurally correct as per the provisions of the Act.

34. As regards the issue on the Impugned Order deciding that the Appellant's Mark is non-distinctive in nature as per Section 9(1) of the Act, it is the Appellant's case that the Appellant's Mark is inherently distinctive in nature and should be granted protection under the Act even if no secondary significance is attributed to the Appellant's Mark.

35. Section 9(1) of the Act reads as under:

"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:

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."



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36. Accordingly, if any Trade Mark is devoid of any distinctive character, or may serve to designate the kind, quality, quantity, intended purpose, values, geographical origin, time of production of goods / rendering of service, or other characteristics of the goods or service, such a Trade Mark cannot be registered except in accordance with the proviso to the aforesaid provision.

37. Therefore, in order to determine this issue, it is to be adjudicated whether the Appellant's Mark is distinctive in nature so as to distinguish the goods of the Appellant from those of others.

38. In *Teleecare Network (India) (P) Ltd. v. Asus Technology (P) Ltd.*, 2019 SCC OnLine Del 8739, this Court explained different categories of Trade Marks. The relevant extract from the said decision is reproduced as under:

“22. There are various types of trademarks. Initially four categories of trademarks i.e. (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful were set out in Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2nd Cir. 1976). Subsequently in Two Pesos, Inc. v. Taco Cabana, Inc., 505 US 763 (1992), it was held that there are five categories of trademarks. The relevant portion of the said judgment is reproduced hereinbelow:—

“... Marks are often classified in categories of generally increasing distinctiveness; following the classic formulation set out by Judge Friendly, they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. ...The latter three categories of marks, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection. In contrast, generic marks—those that “refe[r] to the genus of which the particular product is a species,” Park N Fly, Inc. v. Dollar Park & Fly, Inc., 469 US 189 (1985),



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citing Abercrombie & Fitch, supra, at 9-are not registrable as trademarks. Park 'N Fly, supra, at 194.

Marks which are merely descriptive of a product are not inherently distinctive. When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected. However, descriptive marks may acquire the distinctiveness which will allow them to be protected under the Act. Section 2 of the Lanham Act provides that a descriptive mark that otherwise could not be registered under the Act may be registered if it “has become distinctive of the applicant's goods in commerce.”. ...

The general rule regarding distinctiveness is clear : An identifying mark is distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning. ...”

23. The said categorisation of trademarks has been accepted by a Coordinate Bench of this Court in Evergreen Sweet House v. Ever Green, (2008) 38 PTC 325 (Del) (paragraph 14), wherein it was held that the mark ‘Evergreen’ in its application to sweets and confections is an arbitrary one and accordingly is entitled to protection.

24. The term ‘generic’ refers to the ‘genus’ to which a particular product or service is a species of.

25. The term ‘descriptive’ refers to a word/mark which describes an article/service, its qualities, ingredients or characteristics.

26. However, often the lines differentiating different categories of marks are blurred. Often, distinctions between suggestive, fanciful and arbitrary marks may seem artificial.

27. For instance, in Abercrombie & Fitch Co. (supra) it was explained that “Deep Bowl” when used for an article which is a deep bowl, does not only describe the article, but also identifies it. Therefore, “Deep Bowl” is generic when used for a deep bowl. Similarly the term “spoon” is not merely descriptive of the article i.e. spoon, but identifies the article and therefore, is generic.



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28. However, the mark “Deep Bowl Spoon” for a spoon merely describes the significant characteristic of being able to reach deep in a bowl. It is not descriptive of the article i.e. spoon, since the article is not a deep bowl, but a spoon.

29. In common law, neither the generic nor merely descriptive terms are valid trademarks and the exclusive use of such terms is not entitled to legal protection. However, protection is awarded to descriptive marks which have acquired secondary significance.

30. The category of suggestive marks refers to those marks which are neither exactly descriptive on the one hand, nor truly fanciful on the other. A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. If a term is suggestive, it is entitled to registration without proof of secondary meaning. For instance, as pointed out in *Abercrombie & Fitch Co. (supra)* the word “Ideal” when used for hair brushes, is in no sense indicative or descriptive of the qualities or characteristics or merits of a brush. It is therefore not descriptive. However, the word “Ideal” for hairbrushes does suggest that the product meets the very highest ideal mental conception of what a hair brush should be and is therefore suggestive.

31. The term ‘fanciful’ refers to a mark which is an invented word solely for use as trademarks. When a common word is applied in an unfamiliar way, it is called an ‘arbitrary’ mark. For instance, “Ivory” would be generic when used to describe a product made from the tusks of elephants but would be arbitrary when applied to a soap.

32. Fanciful and arbitrary terms enjoy all rights accorded to suggestive marks and are also entitled to registration without proof of secondary meanings.”

39. The Application for the registration of the Appellant’s Mark was filed under Class 16, which includes instructional and teaching material (except apparatus), printed matter and bookbinding material. The documents placed on record suggest that the Appellant’s Mark is being used in relation to its



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platform, which provides instructional and teaching material for learning, teaching and testing Hindi language.

40. It is the Appellant's case that the Appellant's Mark is not descriptive, but suggestive in nature. In *Teleecare (supra)*, this Court explained that a Trade Mark is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods. It was further observed that a suggestive Mark is neither exactly descriptive nor fanciful in nature.

41. Simply put, in order for a Mark to be suggestive, the consumers must take a mental leap to understand the relationship between the suggestive Mark and the product sold under it. A suggestive Mark would neither fall into the category of descriptive Marks nor can it be said to be arbitrary or fanciful.

42. In the present case, the Appellant's Mark 'SoEasy' used for the Appellant's Hindi language learning, teaching and testing platform suggests that the learning, teaching and testing of Hindi language would be made easy and uncomplicated or would require minimal effort, on the Appellant's platform and, therefore, it is suggestive in nature as it would require the consumers' imagination, thought and perception to reach a conclusion regarding the nature of the Appellant's product on offer. In other words, the consumers would require a mental leap to draw a connection between the Appellant's Mark and the product sold or services provided under the said Mark as the words 'So' and 'Easy' juxtaposed together to formulate the Appellant's Mark would not immediately be reminiscent of the Appellant's product or service without consumers' additional imagination, thought and perception regarding the same.



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43. Hence, the Appellant's Mark is not descriptive of the qualities, ingredients or characteristics of the Appellant's product. It is well-settled that suggestive Trade Marks are liable to be protected under the Act, while descriptive Trade Marks are not entitled to protection. As the Appellant's Mark is suggestive in nature, it is entitled to protection under the Act.

44. In view of the above, even though there is no procedural infirmity with the Impugned Order, interference is required on merits of the decision of the Respondent. Accordingly, the present Appeal is hereby allowed and the Impugned Order passed by the Respondent in Trade Mark Application No. 5799569 in Class 16 for the Mark 'SoEasy' is set aside.

45. The Respondent is directed to proceed with Appellant's Application No. 5799569 in Class 16 for the registration of the Appellant's Mark 'SoEasy' in accordance with the provisions of the Act and the Trade Marks Rules, 2017.

46. For compliance, the Registry is directed to supply a copy of the present Order to the Trade Marks Registry through email at llc-ipo@gov.in as well as through the learned Counsel appearing for the Respondent.

47. Pending Applications also stand disposed.

TEJAS KARIA, J

NOVEMBER 24, 2025

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