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

+ **C.A.(COMM.IPD-TM) 39/2025**

BELLATOR MEDIA PRIVATE LIMITEDAppellant

Through: Ms. Swathi Sukumar, Senior Advocate with Mr. Abhinav Bhatia, Ms. Sakshi Jain, Ms. Rishika Aggarwal, Mr. Ritik Raghuvanshi and Ms. Shrudula Murthy, Advocates.

versus

THE REGISTRAR OF TRADE MARKSRespondent

Through: Ms. Nidhi Raman, CGSC with Mr. Om Ram and Ms. Nikita Singh, Advocates.

CORAM:

HON'BLE MS. JUSTICE JYOTI SINGH

ORDER

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26.02.2026

1. This appeal is filed on behalf of Appellant under Section 91 of The Trade Marks Act, 1999 ('1999 Act') challenging the impugned order dated 28.03.2025 passed by the Respondent, whereby Trademark Application bearing No. 570022 for registration of the **FitClub** in Class 41 has been refused.

2. Appellant filed TM-A application on 28.11.2022 for registration of trademark **FitClub** in Class 41. On 14.06.2023, Examination Report was issued raising objections under Section 9(1)(b) and 11(1) of 1999 Act, to which Appellant filed a reply on 24.06.2023 with supporting documents. On 23.04.2024, trademark was accepted and the same was advertised on 06.05.2024 in Trademark Journal. However, on 22.01.2025 notice was issued under Section 19 of 1999 Act, withdrawing the acceptance of the trademark.



3. On 11.02.2025, notice of hearing was issued by the Respondent, whereafter on 20.02.2025 Appellant filed detailed written submissions and hearing was conducted on 10.03.2025, during which an objection was raised under Section 9(1)(b) of 1999 Act. On 28.03.2025, Respondent passed the impugned order refusing registration of the trademark **FitClub**, on the ground that the device mark was descriptive and any monopoly granted over it would deprive others to describe their services using these words, which would not be in the interest of traders, purchasers, consumers and/or general public and/or maintaining accuracy of the Register of Trade Marks.

4. Ms. Swathi Sukumar, learned Senior Counsel for the Appellant submits that without prejudice to the contentions on merits that: (a) term FITCLUB is not generic or commonly used expression in the fitness industry; (b) FITCLUB is a coined expression *albeit* formed by juxtaposition of two ordinary English words and is novel and distinctive and capable of functioning as source identifier, especially, as a device mark with graphical and stylized elements; (c) FITCLUB is non-descriptive and cannot be immediately associated with gym or fitness services; (d) device/composite trademarks have to be seen as a whole and when seen as a whole, FITCLUB in no way describes the intended services; (e) Appellant does not claim any right over the words FITCLUB and in fact, at the time of acceptance of the application in the first instance, the Trademark Registry had put a restriction that the mark shall be used as substantially represented with no exclusive right over any of the words separately; and (f) trademark search revealed a number of trademarks, which have been registered starting with the word 'FIT' filed on 'proposed to be used' basis in Class 41, there is a grave error in the procedure followed for determining registration of the



device mark **FitClub** .

5. It is urged that despite being a device mark, the subject mark was examined as a word mark, limiting the consideration to the words FIT and CLUB, without considering its visual characteristics and without looking at the disclaimer that no right will be claimed on the words. This procedure is contrary to the methodology of examination prescribed under Vienna Agreement establishing an International Classification of the Figurative Elements of Marks, 1973 ('Vienna Agreement'). The Vienna Agreement, amended in 1985, establishes the Vienna Classification for marks containing figurative elements and purpose of classification is to facilitate and streamline the process of examination of device marks for contracting Nations. On 07.06.2019, India officially acceded to the Vienna Agreement, thereby accepting the applicability of the Vienna Classification in respect of device marks. The SOP published on the official website of the Office of the Controller General of Patents, Designs & Trademarks, India provides a brief description of stage-wise processing of trademark applications in the Trademarks Registry. In the SOP, it is provided that if the mark consists of figurative elements, their codification is to be done as per the Vienna Agreement before the trademark proceeds for examination *albeit* detailed procedure is not mentioned in the SOP. As per current Vienna Classification in force, different figurative elements are classified in 27 categories, of which category 27 covers '*Forms of Writing, Numerals*' in which Section 27.5.1 classifies '*Letters presenting a special form of writing*', which has other associated sections such as 27.5.2; '*Letters written in double outline*' etc. Therefore, a word represented in a stylized font has to be assigned a Vienna Code and considered as a device mark for examination and



registration. No doubt, Respondent has correctly categorized the mark as falling in category 27 but has erred in examining the same as a word mark, which is evident from plain reading of the impugned order. Respondent has not carried out any anticipation search and/or followed the due procedure for examination of the mark as per the Vienna Agreement and on this ground alone the impugned order deserves to be set aside.

6. It is submitted that figurative elements, which do not possess any fanciful representation, are considered non-distinctive and incapable of being registered as trademarks in many countries, however, an assessment of an overall impression of the trademark is to be undertaken to determine its distinctiveness, which is completely lacking in the instant case. Illustratively, the Intellectual Property Handbook published on official website of WIPO provides that while letters, numerals or simple gematrical shapes cannot be considered as indicators of origin of goods by the consumers, they become registrable if applied for as a fanciful device. In fact, EUIPO publishes specific guidelines to assess the distinctiveness of simple gematric shapes as compared to geometrical signs incorporating some creative arrangement, which may add a degree of distinctive character and render them registrable. It is thus submitted that the application needs re-examination after following the due procedure laid down for examining and registering a device mark.

7. Ms. Nidhi Raman, learned CGSC defends the impugned order and submits that *albeit* earlier the application of the Appellant was accepted and published in the Trademarks Journal, however, it was withdrawn since the mark was devoid of distinctiveness and hence, was not capable of distinguishing the services of the Appellant from others. Registration has



been correctly refused under Section 9(1)(b) of 1999 Act and the order is a well-reasoned order. Section 19 of 1999 Act grants power and discretion to the Registrar to withdraw an acceptance if it is found to have been given owing to an error.

8. It is further argued that the applied mark is nothing but a stylized version of two ordinary and commonly used English words FIT and CLUB combined together, where 'FIT' is synonymous with physical strength, health and fitness and 'CLUB' signifies a place where people collect and take part in a shared activity such as training. When the two words are combined, the expression immediately relates to a fitness or gym activity and is generic and descriptive and not a coined word, as alleged by the Appellant. Furthermore, even when viewed as a whole, the applied mark directly refers to the nature and purpose of services claimed in Class 41 i.e., gymnasium, physical fitness and training services and attracts the bar of Section 9(1)(b) of 1999 Act, which proscribes registration of marks consisting exclusively of descriptive indications. It is urged that minor stylization or the nature of the mark being a device mark cannot detract from the intended purpose of the expression when it is used for services relating to fitness training and gym and moreover, even when seen as a whole, the device mark in question gives prominence to the word itself rather than the stylization. Appellant has failed to establish that the expression 'FITCLUB' has any distinctive character prior to applying for registration. Insofar as the contention that the mark was not examined as a device mark is concerned, it is submitted that contention is misconceived inasmuch as the impugned order itself indicates that the mark was examined as a device mark and not a word mark.



9. Heard learned Senior Counsel for the Appellant and learned CGSC for the Respondent.

10. Multiple contentions have been raised by the Appellant assailing the impugned order dated 28.03.2025, whereby application filed for registration of mark **FitClub** has been refused by the Respondent. However, during the course of argument, learned Senior Counsel brought forth the procedural violations in examining the applied mark for the purpose of registration. Indisputably, the mark in question is a device mark and while the impugned order reflects that the Respondent was conscious of this fact, however, learned CGSC is unable to dispute that the procedure required under the Vienna Agreement read with the SOP, above mentioned, has not been followed. *Albeit* the mark has been categorized as falling under category of 27 of Vienna Classification, there is nothing forthcoming from the impugned order, which even remotely suggests that further procedure of anticipation, search etc., was carried out as required for a device mark. As rightly pointed out by learned Senior Counsel for the Appellant, Manual of Trademarks provides a step-wise procedure for filing of trademark applications and further examination of the application for the registration. It is stipulated that at the time of making data entry in the EDP Module, device marks shall be separately scanned in original colours and uploaded in the system. After verification, if the application relates to a device mark, it proceeds for Vienna Codification as per laid down steps and thereafter, the Examiner is required to examine whether the applied trademark is capable of distinguishing goods or services of one person from those of others or liable to be refused under Section 9 of 1999 Act. The Manual also provides for conditions as to disclaimer in the case of device marks. The SOP provides



for Vienna Codification if the applied mark consists of figurative elements and only thereafter the application moves for examination. Vienna Classification provides '*Forms of writing, numerals*' in category 27, which in turn includes letters presenting a special form of writing under 27.5. In the instant case, the procedure laid down for examining a device mark has not been followed by the Respondent after the stage of codifying the device mark and therefore, in my view, the matter needs to be remanded to the Respondent for fresh consideration of the application.

11. Accordingly, this appeal is partially allowed setting aside order dated 28.03.2025 and directing the Respondent to reconsider Trademark Application bearing No. 570022 for registration of trademark **FitClub** in Class 41 after following the requisite procedure and in accordance with law. The entire exercise will be completed within four months from today after giving opportunity of hearing to the Appellant as also permitting filing of additional written submissions, if any.

12. Appeal stands disposed of in the aforesaid terms making it clear that this Court has not expressed any opinion on the merits of the case.

JYOTI SINGH, J

FEBRUARY 26, 2026/vp