



2026:DHC:2292



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

% Judgment delivered on: 17.03.2026

+ C.A.(COMM.IPD-TM) 53/2025 & I.A. 21010/2025

MAJOR LEAGUE BASEBALL PROPERTIES INCAppellant

versus

REGISTRAR OF TRADE MARKSRespondent

Advocates who appeared in this case:

For the Appellant : Mr. Mr. Urfee Roomi, Mr. Jaskaran Singh, Ms. Janaki Arun and Ms. Adhya S., Advocates.

For the Respondent : Ms. Nidhi Raman, CGSC with Mr. Om Ram and Ms. Nikita Singh, Advocates.

CORAM:

HON'BLE MR. JUSTICE TUSHAR RAO GEDELA

J U D G M E N T

TUSHAR RAO GEDELA, J. (ORAL)

1. This is an appeal under Section 91 of the Trade Marks Act, 1999, (hereinafter referred to as "*the Act*") challenging the order dated 22.05.2026 passed by the learned Assistant Registrar of Trade Marks cancelling Registration No. 5245655 for the mark "CHICAGO" device, in Class 41, in the name of the appellant.

2. The appellant had filed for the registration of the device mark "CHICAGO" in a distinctive style on 13.12.2021 in Class 41 i.e.- "education; providing of training; entertainment; sporting and cultural activities, education services; education information; organization of educational competitions, organization of exhibitions for cultural, educational; organization of sports competitions; entertainment services; providing sports facilities; entertainment



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information; providing information relating to sports; presentation of live performances, sports camp services, instruction and coaching (training) services; preparation of entertainment programmes for broadcasting; organization of live shows; conducting of live sports events; production and rental of video tapes and DVDs featuring recorded baseball programs; recording, production and distribution of films, video and audio recordings, radio and television programs; providing on-line electronic publications; online game services; providing online newsletters in the fields of sports entertainment." The said mark is being extracted hereunder:



3. The Trade Marks Registry had issued an examination report on 22.01.2022 raising the following objections under Sections 9(1)(a) and 11(1) of the Act:

"a. That the Appellant's CHICAGO Mark is a geographical name and, as per Section 9(1)(a) of the Act, is not capable of distinguishing the goods or services of one person from those of others; and

b. That the Appellant's CHICAGO Mark is identical/similar to one (1) prior mark already existing on the Register of Trade Marks (hereinafter the "Register") for same/similar goods, due to which, there existed a likelihood of confusion on the part of the public under Section 11 (1) of the Act."

4. The appellant filed a response thereof on 20.05.2022 in respect of both the objections. So far as the objection under Section 11(1) of the Act is concerned, the appellant had stated that the cited mark of the NBA Properties Inc. cannot bar the registration of the appellant mark, as the said NBA Properties Inc. had consented to registration of the appellant's mark and in



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support, thereof, furnished a copy of the order of consent signed by the NBA in the appellant's favour. So far as the objection in respect of Section 9(1)(a) of the Act is concerned, the appellant had submitted that its mark is inherently distinctive on account of unique stylization of the word CHICAGO in a distinctive bold font depicted in a radial arch. In addition thereto, the appellant had also brought to the learned Assistant Registrar's notice that it already owned registration for a few other marks consisting solely of names of cities/states/geographical locations in the United States of America, depicted in stylized manners, covering services in Class 41. Those marks were also registered by the very same Trade Marks Registry. Thus, the appellant stated that the objection under Section 9(1)(a) of the Act could not be maintained against the appellant.

5. Subsequently, the show cause notice for hearing dated 10.01.2024 and 19.02.2024 were issued, where the appellant was heard by the Registry.

6. Consequent upon the hearing, the Trade Mark Registry accepted the trade mark application on 24.02.2024. As a result thereof, on 19.07.2024 a registration certificate too was issued in favour of the appellant for the device mark "CHICAGO", which is the subject matter of the present appeal.

7. After almost about six months, on 06.12.2024, the Registrar issued a retraction notice under Section 57(4) of the Act, ostensibly under the provisions of Section 9(1)(a) of the Act, though such reference to the exact provision was not mentioned.

8. In order to appreciate the controversy, it would be appropriate to extract the said retraction notice hereunder:



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दिनांक/Date: 06/12/2024

सेवा प्राप्त,
SUSANTA CHANDHRI IP ATTORNEYS
2106 Express Trade Towers 2, First Floor, B-26, Sector 122, Expressway,
NOIDA 201301, Uttar Pradesh, India

विषय : नोटिस : 41 में साधारण चिह्न आवेदन संख्या 524555 के संबंध में धारा 57(4) के अधीन नोटिस
Subject : Notice U/s 57(4) in respect of Application No. 524555 in Class/Classes : 41

पंजीकृत स्वाम्यारी का नाम/Name of the Registered Proprietor: Major League Baseball Properties, Inc.

सद्विषय : सद्विषय,
Sir/Madam,

उपरोक्त विषय के संबंध में, साधारण चिह्न अधिनियम, 1999 की धारा 57(4) के प्रावधानों के अधीन आपका नोटिस जारी किया जाता है। रजिस्ट्रार निम्नलिखित कारणों के कारण नोटिस में परिचालन करने का प्रस्ताव करता है।
With reference to the above subject, Notice under the provisions of Section 57(4) of Trade Marks Act, 1999 is, hereby, issued to you. The Registrar proposes to rectify the register due to the following reason(s):

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.

इसलिए, आपसे अपेक्षित है कि आप अपना प्रत्युत्तर/प्रस्तुति, यदि कोई हो, सहसम्बद्ध दस्तावेजों के साथ, इस नोटिस की प्रतिलिपि शिथि से एक माह के भीतर प्रस्तुत करें, अन्यथा आप चुनवाई के लिए आवेदन कर सकते हैं।

You are, therefore, required to submit your response/submissions, if any, along with supporting documents, within ONE MONTH from the date of receipt of this Notice or you may apply for a hearing.

कृपया ध्यान दें कि यदि उपरोक्त निर्धारित समय के भीतर कोई उत्तर प्रस्तुत नहीं होता है या चुनवाई के लिए अनुरोध नहीं किया जाता है, तो वह माना जाएगा कि पंजीकृत स्वाम्यारी कर्तव्यवादी से धारा लेने का इच्छुक नहीं है और मामला साधारण चिह्न विषय, 2017 के नियम 100 (2) के प्रावधानों के अनुसार निपटार के लिए जारी रहेगा।

Please note that if no reply is received or a request for a hearing is not applied for, within the above mentioned stipulated time, it will be treated that the registered proprietor is not desirous to take part in the proceedings and the matter shall proceed for disposal as per provisions of the Rule 100(2) of the Trade Marks Rules, 2017.

कृपया ध्यान दें कि उत्तर ऑनलाइन ई-फाइलिंग सर्विसेज के माध्यम से विभागे निपटार निपटार = निपटार ई नोटिस U/s 57(4) के नियम से धारा 57(4) के अधीन नोटिस का उत्तर विषय के साथ ऑनलाइन प्रस्तुत किया जाना चाहिए।

Note: The reply should be submitted online via Comprehensive eFiling Services through Miscellaneous Reply = Reply to Notice U/s 57(4) with the subject as 'REPLY TO NOTICE U/s 57(4)'.

भवदीय/Yours faithfully,
Abhishek Rai
ASST. REGISTRAR

साधारण चिह्न रजिस्ट्रार के लिए
For Registrar of Trade Marks

यह प्रतिक्रिया कंप्यूटर प्रणाली द्वारा इलेक्ट्रॉनिक रूप से तैयार किया गया है।
इसलिए किसी हस्ताक्षर की आवश्यकता नहीं है।
This is an electronically generated email by the authorized computer
hence, no signature is required.

[Emphasis supplied]

9. It is stated that on 23.12.2024, the appellant had filed its detailed reply to the said retraction notice, giving the references to previously registered marks in the names of cities and geographical places existing in the United States of America. That apart, certain more registrations of cities in United States of America in favour of the appellant itself, in Class 25 and 41 too, were referred

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and specifically mentioned in the said reply. Various third party city names registered in Class 41 in India also were referred to by the appellant in its aforesaid reply.

10. After having afforded an opportunity to the appellant to make appropriate submissions in respect of the retraction notice, by the impugned order dated 22.05.2025, the learned Assistant Registrar rejected the said submissions and passed the impugned order retracting the registration certificate granted to the appellant. In view thereof, the present appeal was preferred.

11. This Court has heard Mr. Urfee Roomi, learned counsel appearing on behalf of the appellant as also Ms. Nidhi Raman, learned CGSC for the respondent and perused the documents on record.

12. Without entering into the merits of the case, this Court is of the considered opinion that the appeal can be allowed on a preliminary issue as to whether any order by a *quasi* judicial authority can include within its ambit issues which were not subject matter of the show cause notice which was issued to the appellant, to essentially base the reasoning behind such impugned order. The law in respect of aforesaid is well-settled and no more *res integra*. The learned Single Judge of the High Court of Gujarat in the case of **Pradeep Kumar Thakur vs. State Bank of India & Ors.: 2024 SCC OnLine Guj 905** in the context of the aforesaid issue, had examined the ratio laid down in various judgments of the High Court as referred to in para 14 of the said judgment (**Janardan Jaishankar Jokharkar vs. State of Gujarat : 2008 SCC OnLine Guj 5** and **Vijaykumar Muljibhai Jasani vs. Gujarat State Road Transport Corporation Rajkot: (1987) IGLH 195**). The ratio which can be culled out from conjoint reading of the said judgments is that an authority while passing an order of adjudication cannot take into account the grounds or circumstances



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which are not alleged in the notice or in respect of which the individual is not put to notice. It was observed that in the absence of such procedure the purpose of issuing notice and inviting response would itself be frustrated apart from it constituting violation of principles of natural justice. It is trite that orders passed by quasi judicial authorities can clearly not contain extraneous considerations which are beyond the show cause notice. As a corollary, it mandates that every show cause notice needs to clearly specify the objection sought to be responded to in clear terms failure whereof, would disentitle the quasi judicial authorities from passing orders on considerations which are extraneous to the objections or charges raised in the show cause notice. This action, if undertaken, would render such an order liable for interference and consequent setting aside.

13. It is clear that while the show cause notice is being issued, the mandate of the authority issuing such show cause notice is to put the exact charges which are being levied or raised against the noticee. Unless such notice consists of the exact charge, it is not expected that the noticee would have any reason to give explanations in respect of an issue which was not raised therein. In the present case, it is clear that in the notice issued under Section 57(4) of the Act, dated 06.12.2024, the only objection appears to have been raised is in respect of Section 9(1)(a) of the Act, though there is no specific mention of the said Section therein. However, the language employed is very clear by itself. It would be appropriate to extract the said para hereunder:

“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.”

14. In order to conclude that the notice under Section 57(4) of the Act proceeded only under Section 9(1)(a) of the Act, it would be apposite to juxtapose the language used above in the said notice, with that of the language



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employed in Section 9(1)(a) which is 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;”

15. As is evident from the above, the language employed in Section 9(1)(a) of the Act and the language used in the notice under Section 57(4) of the Act issued to the appellant is identical. In other words, undoubtedly, the notice of retraction under Section 57(4) of the Act, restricts its objections to the provisions of Section 9(1)(a) of the Act. Thus, the impugned order proceeding on the presumption that an objection under Section 9(1)(b) of the Act has been raised against the appellant, is completely erroneous and cannot be countenanced.

16. It appears that after the registration was granted on 19.07.2024 consequent upon the objections under Sections 11(1) and 9(1)(a) of the Act having been overcome by the appellant, the only issue again raised by the Trade Marks Registry was in respect of Section 9(1)(a) of the Act. Whether this objection was still available to the respondent to initiate the retraction process or not, is not being considered by this Court at this stage.

17. However, what is required for consideration is as to whether once the Trade Mark Registry issues a notice under Section 57(4) of the Act on an objection premised on the provisions of Section 9(1)(a) of the Act, whether the order passed by the Registrar dated 22.05.2025 could be based on any ground other than Section 9(1)(a) of the Act. A perusal of the impugned order clearly bring to fore that the learned Registrar has engaged himself with the objections in respect of ‘geographical location’ and predicated his reasoning purely on the aforesaid aspect. His conclusion that the said mark “CHICAGO” is not distinctive is not premised on the provision of Section 9(1)(a) but Section



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9(1)(b) of the Act involving “geographical origin” of the said mark. This objection having not been raised in the notice under Section 57(4) of the Act, could not have been made the subject matter for the basis of the reasoning contained in the impugned order.

18. Having regard to the fact that no specific charge or specific objection under Section 9(1)(b) of the Act was raised in the notice under Section 57(4) of the Act, the said notice suffers from legal defect and lacuna which cannot be covered by any explanation or submissions offered by learned counsel for the respondent. Consequently, the impugned order also suffers from same vice.

19. In that view of the matter, without passing any observations or comments on the merits of the matter, this Court is of the considered opinion that the impugned order having been based on the objections which were not put to the appellant in the notice dated 06.12.2024 under Section 57(4) of the Act, is unsustainable and liable to be set aside.

20. *Ergo*, the appeal is allowed. The impugned order dated 22.05.2025 passed by the learned Assistant Registrar of Trade Marks is set aside.

21. However, the authority is at liberty to re-issue any notice, if warranted under law, on the clearly set out and specified grounds of objection, which the appellant would be entitled to answer.

22. As a consequence, the registration no. 5245655 is restored to its original status of having been registered in the Register of Trade Marks.

23. It is informed that the re-entry of the aforesaid registration has already been complied with under the interim order dated 27.08.2025.

24. Be that as it may, the aforesaid appeal is allowed in the aforesaid terms with no order as to costs.

TUSHAR RAO GEDELA, J

MARCH 17, 2026/anj

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