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

% *Date of decision: 10th December, 2024*

\+ C.A.(COMM.IPD-TM) 26/2024 with I.A. 9555/2024

SOCIETE DES PRODUITS NESTLE S A .....Appellant
Through: Ms. Akansha Singh, Advocate.

versus

THE REGISTRAR OF TRADE MARKS .....Respondent
Through: Mr. Arnav Kumar, CGSC with Mr. Priyam Gandhi and Mr. Devraj, Advocates.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present appeal has been filed under Section 91 of the Trade Marks Act, 1999 (*hereinafter 'the Act'*) read with Rule 156 of the Trade Marks Rules, 2017 impugning the order dated 25th January, 2024 (*hereinafter 'the impugned order'*) passed by the Senior Examiner of Trade Marks refusing the trademark registration bearing application number 4990611 under Classes 05 and 29.

BRIEF FACTS

2. The case set up by the Petitioner is as follows:

2.1 On 1st June, 2021, the appellant filed a multiclass trade mark application for the series mark  bearing

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number 4990611 with user claim of 31st January, 2019 in Class 5 *i.e.*, for food and food substances for babies, infant formula, lacteal flour for babies, *etc* and Class 29 *i.e.*, for milk and milk products; powdered milk.

2.2 On 25th June, 2021, the respondent issued an Examination Report under the subject trade mark application raising objections under Sections 9(1)(b) and 11(1) of the Act.

2.3 On 22nd July, 2021, the appellant submitted its reply to the Examination Report stating that the subject mark is distinctive and also filed evidence of use of the subject mark prior to the date of application i.e. 1st June, 2021.

2.4 *Vide* the impugned order dated 25th January, 2024, the Senior Examiner of Trade Marks refused the application of the appellant under Section 9(1)(b) of the Act.

3. Aggrieved by the aforesaid, the present appeal came to be filed.

PROCEEDINGS IN THE PRESENT APPEAL

4. Notice was issued by this Court in the present appeal *vide* order dated 30th April 2024.

5. To be noted, the order passed by the Predecessor Bench on 31st July, 2024, recorded that the counsel for the respondent did not wish to file any reply.

6. Today, Ms. Akansha Singh, counsel appearing on behalf of the appellant submits that the word 'EGG' was used in the application only so as to describe the device mark. However, the registration was only in respect of a device mark and the word 'EGG' does not find a mention there.

6.1 It is further submitted that the device marks

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are used in the packaging of the appellant's product 'NAN', which does not contain any egg. Therefore, the mark does not have any reference to the character and quality of the product.

7. Counsel appearing on behalf of the respondent submits that the subject mark 'EGG' (Device) in respect of Nutritional and Dietary Supplements has direct reference to the character and quality of the products. He also alleges that the subject mark is a common/ generic word mark used in common parlance hence not an invented word.

7.1 It is further submitted that not a single document has been produced to show either that the subject mark has been used independently to substantiate user claim of the year 2019 or to show acquired distinctiveness.

ANALYSIS AND FINDINGS

8. I have heard the parties and perused the material on record.

9. On the previous date of hearing *i.e.*, 31st July, 2024, the Predecessor Bench had asked the counsel for the appellant to take instructions whether the appellant is willing to remove reference to the word 'EGG' in its trademark application.

10. Ms. Singh has conveyed to the Court that the appellant is willing to amend the trade mark application so as to remove references to 'EGG' in the application.

11. The next ground of objection taken by the Examiner of Trade Marks is that the subject mark is descriptive of the products and is also a common/generic word in common parlance hence not an invented word.

12. In my considered view, the aforesaid objection is on an erroneous

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assumption that the impugned mark is a word mark. The impugned mark which is the subject matter of the application is an artistic impression which does not use any word at all. The word 'EGG', as noted above, occurs only in the trade mark description, which forms part of the trademark application, which the counsel for the appellant has agreed to amend.

13. The aforesaid device marks  are, in fact, used in the packaging of the appellant's product 'NAN'. The trade mark 'NAN' has been registered in favour of the appellant since 1967.

13.1 The packaging of products sold under the mark 'NAN', which carry the impugned device mark are extracted below:



14. As regards the objection taken in the impugned order with respect to the appellant not having filed any documents in support of its user claim, the counsel appearing on behalf of the appellant has drawn attention of the Court to Document A/5 filed along with the appeal *i.e.*, page 168 onwards of the appeal paper-book marked as Exhibit C wherein the appellant has filed details of its user of the impugned mark from January, 2019.

15. In view of the discussion above, the present appeal is allowed, the impugned order passed by the appellant is set aside and the trade mark application filed on behalf of the appellant is restored.

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16. The appellant shall file the appropriate form for amending the subject application within two (2) weeks from today. Thereupon, the matter will be considered afresh by the Controller in light of the observations made above.

17. All pending applications are disposed of.

18. The Registry is directed to supply a copy of the present order to the Trademark Registry, at e-mail – "llc-ipo@gov.in" for compliance.

AMIT BANSAL, J

DECEMBER 10, 2024
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