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

\+ C.A.(COMM.IPD-TM) 88/2022

SHIVANI VIG KAPOOR AND RUSHI TIWARI MAKKER H.NO. 136, NATIONAL MEDIA CENTRE NATHUPUR, GURGAON, HARYANA ..... Appellant

Through: Mr. Vaibhav Vutts, Ms. Anupriya Shyam, Ms. Aamna Hasan and Ms. Yushika Dalmia, Advs.

versus

REGISTRAR OF TRADEMARKS, BAUDHIK SAMPADA BHAVAN, PLOT NO. 32, SECTOR-14, DWARKA, NEW DELHI ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Alexander Mathai Paikaday and Mr. Krishnan V, Advs.

CORAM:
HON'BLE MR. JUSTICE C.HARI SHANKAR

O R D E R (O R A L)

% 12.12.2023

1. The appellant applied on 28 January 2013 for registration of the word mark "WONDERFUL WORLD" in Class 39 in respect of "transport; packaging and storage of goods; travel arrangements, tourism, arranging for travel tours".

2. The application was rejected by the Senior Examiner of Trade marks *vide* order 1 May 2018, which reads thus:

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"ORDER

A Hearing in respect of the above matter came up before me on 23/04/2018 and the following is to be communicated to the applicant/agent:

1. Shri Mr. Shreyas Rastogi applicant/Advocate/Agent appeared before me and made his submissions. I have heard arguments, gone through the records and passed the following Order.

2. The trade mark applied for is objectionable under Section 9/11 of the Act. The application is accordingly refused.

Attention is invited under Rule 36(1) of the Trade Marks Rules,2017 whore the application is refused a request may be made in form no TM-M along with the prescribed fee to communicate in writing the grounds of decision and materials used by the Registrar in arriving at his decision to refuse the said application. The said request on form TM-M should be tendered within 30 days of receipt of the order of refusal.

Dated: 01 May 2018

(BIRENDRA JAISWAL)
SENIOR EXAMINER OF TRADE MARKS
(Authorized under 3(2) of the Act)"

3. As advised in the concluding paragraph of the aforesaid order dated 1 May 2018, the appellant applied on 4 June 2018, seeking the reasons for rejecting the appellant's application.

4. I may note that the practice of passing an unreasoned order rejecting an application for registration of a trademark and, thereafter, requiring the applicant to apply for obtaining the reasons for rejection against payment of a fee is a clearly an unwholesome practice though

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it has legislative sanction in the form of Rule 36(1)[1] of the Trade Marks Rules. Mr. Mishra informs me that the said practice is no longer being followed. This is undoubtedly a welcome development.

5. That apart, this Court has been seeing, in case after case, during the regime when Rule 36(1) was being followed in text and spirit, that the subsequent order, which was supposed to contain the reasons for rejection of the applicant's application for registration of a trademark, was as unreasoned as the original order of rejection, as it merely set out the text of the relevant provisions. Instead of taking the trouble of typing out the text of the provisions, the rejecting authority might just as well have directed the applicant to study the provisions of the Trade Marks Act and discern for himself as to why his application was rejected. Mere reproduction of the text of the provisions, in response to a request by the applicant under Rule 36(1) seeking reasons for rejection, does complete disservice to the requirement of providing reasons.

6. Be that as it may, as this practice is no longer being followed, I refrain from making any further comments on it.

7. I do not see any purpose in remanding this matter to the respondent to give detailed reasons for rejection, as the impugned order was passed in 2018, and five years have passed since then,

[1] **36. Decision of Registrar**. — (1) The decision of the Registrar under Rules 33, 34 or 41 shall be communicated to the applicant in writing at his address of service and if the applicant intends to appeal from such decision, he may within thirty days from the date of such communication apply in Form TM-M to the Registrar requiring him to state in writing the grounds of, and the materials used by him in arriving at, his decision.

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during which COVID-19 pandemic has come and, hopefully, gone.

8. I, therefore, queried of Mr. Mishra, who appears on behalf of the Registrar of Trademarks as to the justification for invoking Sections 9(1)(a)[2] and Section 9(1)(b)[3] of the Trade Marks Act as grounds to reject the petitioner's application. The mark which was sought to be registered was the wordmark "WONDERFUL WORLD" which is clearly descriptive of the services which are intended to be covered by the mark. As such, he submits that the Senior Examiner was correct in rejecting the petitioner's application and that the decision does not call for any interference by this Court.

9. I am unable to agree that submission made by Mr. Mishra can, in any case not justify rejection of the petitioner's application under Section 9(1)(a).

10. Section 9(1)(a) permits rejection of an application which seeks registration of a mark which is lacking in distinctiveness. The provision does not leave the concept of lack of distinctiveness nebulous, but explains that lack of distinctiveness implies that the

[2] **9. Absolute grounds for refusal of registration**. — (1) The trademarks—

(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;

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.

[3] **9. Absolute grounds for refusal of registration**. — (1) The trademarks—

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(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;

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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mark is not such as would enable the goods or services of the applicant to be distinguished from the goods or services of others.

11. I do not see how it can be contended, in the absence of any evidence to that effect, that the mark WONDERFUL WORLD, if granted to the applicant, is not such as would serve to distinguish the services provided by the applicant from the services of others. It is not as though the words WONDERFUL WORLD, when used as a phrase, are so common place that they are inherently lacking in distinctiveness and, therefore, ineligible for registration. The Senior Examiner has not made reference to any other person who holds a trademark registration for the expression WONDERFUL WORLD or any other similar expression. He could not therefore have rejected request for registration of the mark on the ground that the mark was lacking in distinctiveness as it could not distinguish the services provided by the appellant from the services provided by others.

12. Section 9(1)(a), therefore, clearly cannot be pressed into service as a ground to reject the mark. Indeed, Mr. Mishra, too, did not base his submission on Section 9(1)(a).

13. Mr. Mishra, however, submits that the mark is descriptive of the nature of goods and services provided thereunder.

14. There is a difference between marks which are descriptive and marks which are suggestive. Section 9(1)(b) proscribes registration of marks which indicate, or which may serve in trade to designate, the

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kind, quality, quantity, intended purpose, value, geographical origin or production of the goods or rendering of the services or other characteristic of goods or services. This provision has been understood, by judicial decisions as prohibiting the registration of what are known as "descriptive". Marks which describe the goods or services which they seek to cover are not entitled for registration. There is, however, a distinction between descriptive marks and suggestive marks. Unlike descriptive marks, suggestive marks are entitled to registration.

15. The mark "WONDERFUL WORLD" cannot be treated as descriptive of the services provided by the appellant. The mere fact that the appellant was seeking registration of the mark in respect of tour and travel services, which might have involved, possibly, travels to various places, can hardly be a ground to treat the mark "WONDERFUL WORLD" as descriptive of travel services.

16. One may recollect that one of the most celebrated vocal renditions of celebrated Saxophonist, Louis Armstrong is "It's a Wonderful World", and that the maestro, while rendering the number, was certainly not referring to travel services of any kind.

17. At the highest, therefore, the words "WONDERFUL WORLD" may be suggestive, if at all, of travel services. Section 9 (1)(b) cannot be used as a ground to refuse registration to any word mark which may have some relationship, howsoever distant, with the goods or services in respect of which registration of the mark has been sought.

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I am, therefore, unable to concur with Mr. Mishra's submission that the wordmark "WONDERFUL WORLD" was rightly refused registration under Section 9(1)(b).

18. As I do not find either Section 9(1)(a) or Section 9(1)(b) to be justifiable as a ground on which to refuse registration to the mark "WONDERFUL WORLD", as sought by the appellant, the impugned order dated 1 May 2018 as well as the subsequent communication dated 21 June 2018 which purportedly set out the grounds for rejection are both quashed and set aside.

19. The mark has yet to be advertised, as it was rejected at a preliminary stage. As such, the petitioner's application no. 2467381 for seeking registration of the wordmark WONDERFUL WORLD is remitted to the Trademarks Registry so that it could be advertised and further proceedings in that regard may be taken.

20. The appeal stands allowed in the aforesaid terms.

C.HARI SHANKAR, J

DECEMBER 12, 2023
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Click here to check corrigendum, if any

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