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

% Judgment delivered on: 09.01.2026

\+ **C.A.(COMM.IPD-TM) 15/2025**

KAPIL GOYAL .....Appellant

Versus

THE REGISTRAR OF TRADE MARKS .....Respondent

Advocates who appeared in this case

For the Appellant : Mr. Sandeep Narula, Mr. Rehan Narula & Mr. Deepanshu Singh, Advocates.

For the Respondent : Ms. Nidhi Raman, Mr. Arnav Mittal, Mr. Mayank Sansanwal & Mr. Om Ram, Advocates.

CORAM:
HON'BLE MR. JUSTICE TEJAS KARIA

JUDGMENT

TEJAS KARIA, J

1. This is an Appeal filed by the Appellant under Section 91 of the Trade Marks Act, 1999 ("**Act**") and Rule 156 of the Trade Marks Rules, 2017 ("**Rules**") read with the Delhi High Court Intellectual Property Rights Division Rules, 2022, seeking setting aside of the order dated 24.01.2025 ("**Impugned Order**") passed by the learned Senior Examiner of Trade Marks refusing registration of the Trade Mark "DOUBLE-CHOICE" ("**Appellant's Mark**") bearing Application No. 5987240 in Class 30.

FACTUAL BACKGROUND:

2. The Appellant is engaged in the business of trading of rice, flour and preparations made from cereals. On 20.06.2023, the Appellant filed an Application bearing No. 5987240 for the registration of the Appellant's Mark on a proposed-to-be-used basis in Class 30.

3. *Vide* Examination Report dated 06.11.2023, objections were raised under Section 9(1)(a) of the Act claiming that the Appellant's Mark is devoid of distinctive character, in addition to Section 9(1)(b) of the Act claiming that the Appellant's Mark consists exclusively of words or indications which may serve in trade to designate the characteristics of the goods.

4. In response to the said Examination Report, the Appellant filed its detailed reply dated 12.11.2023 addressing the objections raised in the examination report. Thereafter, the matter was heard on 12.11.2024 and *vide* the Impugned Order, the Appellant's application for the registration of the Appellant's Mark was refused.

5. Aggrieved by the Impugned Order, the present Appeal has been filed by the Appellant.

SUBMISSIONS ON BEHALF OF THE APPELLANT:

6. The learned Counsel for the Appellant submitted that the Respondent rejected the application for the registration of the Appellant's Mark on the ground that it was non-distinctive in nature without providing any reasoning for the said finding. It is further submitted that the Impugned Order merely states the conclusion that the Appellant's Mark is non-distinctive without explaining why it cannot distinguish the Appellant's goods from those of

others. Therefore, the Impugned Order is in violation of principles of natural justice.

7. The learned Counsel for the Appellant relied upon this Court's decision in ***Abu Dhabi Global Market v. Registrar of Trademarks***, 2023 SCC OnLine Del 2947 to submit that an order refusing registration on the ground of lack of distinctiveness must contain reasoned finding demonstrating why the mark is incapable of distinguishing goods / services for which it is used.

8. The learned Counsel for the Appellant submits that the Respondent erroneously demanded proof of 'acquired distinctiveness' and 'secondary meaning' for the Appellant's application for the registration of the Appellant's Mark even when it was explicitly filed on a proposed-to-be-used basis, which is a paradoxical requirement. The learned Counsel for the Appellant relied upon this Court's decision in ***Abu Dhabi Global Market*** (supra) to further submit that for an application filed on a proposed-to-be-used basis, evidence of acquired distinctiveness or secondary meaning cannot be demanded as the statutory recognition of proposed-to-be-used applications under Section 18(1) of the Act would be rendered meaningless if the evidence of market use is required.

9. The learned Counsel for the Appellant submitted that the Respondent erroneously held that the Appellant's Mark is descriptive of rice and cereals. The learned Counsel for the Appellant further submitted that direct and immediate descriptiveness is required under law, and not remote connections, to render a mark descriptive. It is also submitted that the Appellant's Mark would require multiple mental steps and imagination to

draw a connection between the Appellant's Mark and the rice products of the Appellant, rendering the Appellant's Mark suggestive in nature.

10. The learned Counsel for the Appellant submitted that the Impugned Order incorrectly assumes that having a dictionary meaning automatically renders a Mark descriptive. It is further submitted that in order to be descriptive in nature, a Mark should directly describe characteristics of specific goods and not merely possess some general meaning.

11. The learned Counsel for the Appellant relied upon the decision in ***Mohd. Rafiq v. Modi Sugar Mills Ltd.,*** 1971 SCC OnLine Del 190, to submit that for a Mark to be considered descriptive, the reference to character or quality must be direct, plain and immediately apparent, and should not be remote or require multiple steps of reasoning.

12. In view of the foregoing submissions, it is prayed that the present Appeal be allowed.

SUBMISSIONS ON BEHALF OF THE RESPONDENT:

13. The learned Counsel for the Respondent submitted that the Appellant's Mark is devoid of any distinctive character and is a combination of non-distinctive words, i.e. 'DOUBLE' and 'CHOICE'.

14. The learned Counsel for the Respondent submitted that the Appellant's Mark is descriptive in nature and indicates the intended purpose in relation to the goods for which it is applied. It is further submitted that the meaning of the Appellant's Mark denotes a situation where there are two options to choose from, and that it signifies the variety of the goods that are to be sold under the said Mark and there is a choice available to the consumers with respect to the said variety of the Appellant's goods.

15. In view of the foregoing submissions, the learned Counsel for the Respondent prayed that the present Appeal be dismissed.

ANALYSIS AND FINDINGS:

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

17. For ease of reference, the Impugned Order passed by the Respondent is set out as under:

> *"Above application has been filed for registration of the trademark DOUBLE-CHOICE on 20/06/2023 which was examined on 06/11/2023 and examination report was communicated to the applicant at his address for service. A reply to the office objection(s) had been filed on behalf of the applicant but the same was not found satisfactory and the application was set down for hearing and eventually hearing took place before me on 12/11/2024.*
>
> *Rehan Narula Attorney appeared before me and made his/her submissions. I have heard arguments and gone through the records.*
>
> *The mark applied for registration is objectionable under S 9(1)(a) of the Trade Marks Act 1999, as it is 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 because it is a common surname/personal name/…*
>
> *The mark applied for registration is objectionable under S 9(1)(b) of the Trade Marks Act 1999, as it consists of 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.*
>
> *Heard learned advocate, Reply perused and same is not found satisfactory. Objection of section 9(1)(a) and (b) is raised. The application is devoid of any distinctive character. The mark is a combination of non-distinctive words. The mark is descriptive in nature and shows the Kind and intended purpose in relation to the goods applied. The mark "DOUBLE-CHOICE" for the goods "rice, flour and preparations made from cereals" is highly descriptive. Meaning of "DOUBLE-CHOICE" is "A double choice is a situation*

where there are two options to choose from". The mark filed on proposed to be used basis and for the same reason it is not fit within the proviso attached with section 9. Mark has not acquired secondary meaning as well due to none use of the mark in the market. Application lags on all count therefore objection under Section (9) (1)(a) and (b) sustained. Trademark application is accordingly refused under Section 18(4) of the Trade Marks Act, 1999.

After perusal of all the documents on record and submission made by the applicant / authorised agent, it is concluded that applied mark is not registrable because of the reason stated as above. Hence application no 5987240 cannot be accepted and refused accordingly."

18. Perusal of the Impugned Order makes it clear that the Appellant's application for the registration of the Appellant's Mark was refused on the ground that the Appellant's Mark being a combination of non-distinctive words, is devoid of any distinctive character.

19. It was further held in the Impugned Order that the Appellant's Mark is highly descriptive for the goods in respect of which its registration was sought, i.e., rice, flour and preparations made from cereals. Additionally, it was held that the Appellant's Mark was sought to be registered on a proposed-to-be-used basis and, therefore, the Appellant's Mark had not acquired any secondary meaning due to non-use of the said Mark in the market.

20. At the outset, the factum of non-use of a Mark that is sought to be registered on a proposed-to-be-used basis is irrelevant in determining whether such Mark can be granted registration. As such Mark has not been used, there is no question of it acquiring secondary meaning.

21. As regards the distinctiveness of the Appellant's Mark, the Impugned Order holds that the Appellant's Mark is non-distinctive since it is a combination of non-distinctive words. Accordingly, it was held that the

Appellant's Mark was not distinctive as required by Section 9(1)(a) of the Act.

22. It is well-settled that a Mark cannot be dissected into its individual parts while examining its entitlement to registration. Section 9(1)(a) of the Act applies only when a Mark is so common and lacking in distinction that it would not be possible to distinguish the goods of the person using such a Mark with the goods of others. Words and phrases used in common parlance would fall within the fold of this category and cannot be registered as Marks, unless they are covered by the proviso to Section 9(1) of the Act.

23. In the present case, there is no cavil that the Appellant's Mark consists of two commonly used words 'DOUBLE' and 'CHOICE', which are used in conjunction with each other to formulate the Appellant's Mark. However, when the Appellant's Mark "DOUBLE-CHOICE" is considered as a whole, it cannot be said to be a word or phrase of such common usage that is so lacking in distinction, although it has some etymological significance in English language when both the words formulating the Appellant's Mark are used together, so as to render it incapable of distinguishing the goods of the Appellant with those of others, when it is used as a Trade Mark. Further, the Impugned Order does not cite any other Mark which is either identical or similar to the Appellant's Mark and fails to provide any reason as to why the use of the Appellant's Mark would make it impossible to distinguish the goods of the Appellant from those of others.

24. The Impugned Order held that the Appellant's Mark is descriptive in nature and shows the kind and intended purpose of the goods for which it is applied. It was further held that the meaning of the Appellant's Mark envisages a situation where there are two options to choose from. It is the

Respondent's case that the Appellant's Mark signifies the variety of the Appellant's goods that are to be sold under the same, and that there is a choice with respect to the same.

25. However, this argument of the Respondent is not convincing. It is not clarified in the Impugned Order as to which of the products the consumers are required to choose from. There is no basis to arrive at a conclusion that the Appellant's Mark denotes the variety of the goods sold under it and that there is a choice that the consumers enjoy with respect to the said goods in absence of factual material available before the Respondent. Hence, such findings are imaginary and based on conjecture. There are no two varieties of products from which the consumers can choose from while purchasing the Appellant's goods. Hence, the reasoning of the Impugned Order cannot be sustained.

26. In any event, the Application for the registration of the Appellant's Mark has been filed by the Appellant on a proposed-to-be-used basis and, therefore, there was no prior use to arrive at a conclusion about the options available to the consumers when there were no products that were sold under the Appellant's Mark. Given that the Appellant's Application for the registration of the Appellant's Mark was filed on a proposed-to-be-used basis, it cannot be said that the Appellant had two varieties of goods offered under the Appellant's Mark. The Impugned Order is completely silent on this aspect and the conclusion reached based on this reasoning is unfounded. Therefore, Impugned Order has erred in holding that the Appellant's Mark is descriptive in nature.

27. In view of the above analysis, the present Appeal is allowed and the Impugned Order dated 24.01.2025 refusing registration of the Appellant's Mark bearing Application No. 5987240 in Class 30, is set aside.

28. The Respondent is directed to advertise the Appellant's Mark "DOUBLE-CHOICE", and, thereafter, proceed with the Appellant's Application No. 5987240 in Class 30, in accordance with the provisions of the Trade Marks Act, 1999 and the Trade Marks Rules, 2017.

29. Let a copy of this Order be sent to the Office of the Controller General of Patents, Designs and Trade Marks at the email address llc-ipo@gov.in, for compliance.

30. In terms of the above directions, the present Appeal stands disposed of.

TEJAS KARIA, J

JANUARY 9, 2026
st