IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

IN ITS COMMERCIAL DIVISION

COMMERCIAL MISCELLANEOUS PETITION NO. 20 OF 2026
AND
COMMERCIAL MISCELLANEOUS PETITION (L) NO. 10288 OF 2026

Graviss Foods Private Limited ...Petitioner

Versus

The Registrar of Trade Marks ...Respondent

Mr. Anand Mohan *a/w Mr. Kaivalya Shetye & Ms. Kalyani Paunikar, i/b Mr. Mahesh Mahadgut Advocates, for Petitioner.*

Mr. Yashodeep Deshmukh *a/w Mr. Ashutosh Misra, Ms. Vaideshi Deshmukh, Mr. Rutvik Rao & Ms. Pratisha Shukla, for Respondent No.1.*

ASHWINI JANARDAN VALLAKATI Digitally signed by ASHWINI JANARDAN VALLAKATI Date: 2026.09.16 16:39:38 +0530

CORAM: SOMASEKHAR SUNDARESAN, J.

DATE: SEPTEMBER 16, 2026

JUDGEMENT :

Context and Factual Background:

1. Commercial Miscellaneous Petition (L) No. 10288 of 2026 ("***Petition 10288***") and Commercial Miscellaneous Petition No. 20 of 2026 ("***Petition 20***") challenge the rejection of two applications for registration of a trade mark

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ICE CREAM ROCKS[1] ("***Subject Mark***"), a mark attested to have been in use from June 10, 2023, made by Graviss Foods Pvt. Ltd. ("***Petitioner***"). The product in relation to which the mark is actually used is described as a 'bite-sized, coated ice cream treat with a flavoured ice cream centre in a choco-dip with brownie crumbles, hazelnut pieces or rice crispies, sold in flavours such as Mississippi Mud, Caramel Biscuit and Hazelnut'.

2. Both applications were made on January 17, 2024. The Registrar of Trade Marks ("***Registrar***") refused each application for registration in separate orders passed on December 23, 2025 (collectively, "***Impugned Orders***").

3. The Examination Report in the Class 29 Application raised two objections: *first*, under Section 9(1)(a) of the Trade Marks Act, 1999 ("***the Act***") that the Subject Mark, 'ICE CREAM ROCKS' is devoid of any distinctive character; and *second*, under Section 11(1) of the Act, citing 'ICE CREAM WORKS'[2] ("***Existing Marks***") that had four registrations, all standing in the name of a single proprietor, Prince Creamery Private Limited. The Examination Report in the Class 35 Application raised objections under

1 Application No. 6263527 is for registration in Class 29 for, among others, milk and milk products, dairy-based desserts, meat, fish, poultry and game, and vegetables, jellies, jams, and edible oils. Application No. 6263529 is for registration in Class 35 for services of marketing, sales promotion, wholesaling, retailing and distribution services of the aforesaid goods.

2 The existing registered marks bear numbers 2043077, 3616359, 3988910 and 6189813

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Sections 9(1)(a) and 9(1)(b) of the Act, with no registered mark being cited against it.

4. The Impugned Order passed in the Class 29 Application, after reciting the facts of filing, examination and hearings conducted, holds in a single operative paragraph that: -

A] The Subject Mark is not inherently distinctive, as it comprises laudatory and descriptive terms for the applied goods;

B] The Subject Mark has a direct reference to the character, quality and intended purpose of the applied goods, and is therefore incapable of distinguishing the goods of one person from those of another;

C] No exclusive right can be claimed in laudatory and descriptive terms unless distinctiveness has been acquired before the date of application by long, continuous and extensive commercial use – the Subject Mark not having had long and continuous use, the question of acquired distinctiveness does not arise;

D] The Subject Mark is phonetically, visually and structurally similar to the Existing Marks registered under the four cited numbers in Class 29, giving rise to a likelihood of confusion and a likelihood of association, and the Existing Marks are prior in adoption and

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registration;

E] The Petitioner has failed to show any plausible reason for the adoption of the Subject Mark;

F] Therefore, registration is objectionable under Section 9(1) and Section 11(1) of the Act.

5. The Impugned Order rejecting the Class 35 Application is in the same form and holds that:

A] The Subject Mark is not inherently distinctive, being generic, common to trade, laudatory and descriptive, and has direct reference to the character, quality and intended purpose of the services applied for, and that acquired distinctiveness is not established for want of long, continuous, uninterrupted and extensive use supported by clear and cogent evidence;

B] A mere combination of two known words is not an invented word where the same idea is conveyed to the eye or the ear as by those words in their ordinary form;

C] The Subject Mark would be seen in the relevant market sector as *an advertising expression or purely informational statement*;

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D] The relevant public would perceive in it no indication of commercial origin beyond the promotional information it conveys;

E] The objection raised under Section 9(1)(a) and Section 9(1)(b) of the Act is held to be maintainable and in the interest of purity of the Register, the application deserves to be rejected.

6. The Impugned Orders reject both the applications without the Registrar exercising the discretion to advertise them.

Contentions of Parties:

7. By consent of the parties, both Petitions were taken up for final hearing. I have heard Mr. Anand Mohan, Learned Advocate on behalf of the Petitioner, and Mr. Yashodeep Deshmukh, Learned Advocate on behalf of the Registrar. With their assistance, I have examined the material on record. The Learned Advocates agreed that a decision in Petition 10288 would, for all practical purposes be dispositive of the issues arising in Petition 20 as well, since the application in Class 29 was for goods while the application in Class 35 was for services related and incidental to such goods.

8. Mr. Mohan's challenge to the Impugned Orders is principally on the ground that they contain conclusions but no reasons. He would submit that the whole of the findings under Section 9 are contained in two sentences

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which do no more than recite the language of the statute. The Impugned Orders do not say what the mark is said to describe, or which characteristic, quality, or intended purpose of these goods and services it is said to refer to. They do not so much as identify the goods and services, which alone would have supplied the context in which the Subject Mark is to be judged.

9. Mr. Mohan would rely on ***Gurdial Singh***[3] and on ***Kranti Associates***[4] for the settled position that the recording of reasons is a facet of natural justice and one cannot conflate conclusions with reasons. He would cite ***Huhtamaki Oyj***[5] for the standard of assessment expected of authorities; and ***Bidisha Ghoshal***[6] to submit that a refusal couched in the very same boilerplate, including the identical concluding formula, must be set aside as cryptic and bereft of reasons.

10. Mr. Mohan would submit that the Impugned Orders do not contain the basis on which the Registrar has drawn the conclusions made in them, and therefore are devoid of reasons. He would also submit that at the least, the applications ought to have been advertised, instead of the Registrar himself speaking for the Existing Marks without having even considered if the registrant of the Existing Marks, or anyone else in the market, truly had any

3 Gurdial Singh Fijji v. State of Punjab, (1979) 2 SCC 368
4 Kranti Associates Pvt. Ltd. and Anr. v. Masood Ahmed Khan and Ors, (2010) 9 SCC 496
5 Huhtamaki Oyj and Anr. v. Controller of Patents, 2023 (96) PTC 198
6 Bidisha Ghoshal v. Registrar of Trade Marks, TMA No. 4 of 2023, decided by the Calcutta High Court on October 18, 2023

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objection to the registration. Such an approach would have enabled validation of the concerns expressed upon examination, which has been avoided by not advertising the applications.

11. In contrast, Mr. Deshmukh would submit that the Impugned Orders indeed contain reasons adequate enough to deal with the *ex-facie* untenable applications, which in his view, are evidently for words that are not amenable to registration as trade marks. According to Mr. Deshmukh, the Impugned Orders identify the statutory objections, the nature of the Subject Mark, the reasons why inherent distinctiveness is lacking, the reasons for rejecting the plea of acquired distinctiveness and the basis upon which registration stands refused. Therefore, he would submit that the decision demonstrates due application of mind to the material placed before the Registrar and cannot be characterised as arbitrary merely because the reasoning is concise.

12. Mr. Deshmukh would submit that the appellate jurisdiction under Section 91 is not intended to substitute the opinion of the Court merely because another view is possible, interference being unwarranted unless the exercise of statutory discretion is shown to be arbitrary, perverse or contrary to law.

13. He would submit that remand would serve no useful purpose since on the face of the record, the Subject Mark is not amenable to registration, being

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barred by Section 9, which has been noticed in the examination and put to the Petitioner, and dealt with in the Impugned Orders.

Analysis and Findings:

14. The Petitioner is essentially a licensee of the "Baskin Robbins" ice-cream brand and variously describes itself as a licensee and as the owner (in the SAARC region) of the "Baskin Robbins" brand. The Petitioner is said to operate India's largest ice-cream store chain, with over 800 parlours across 230 cities and over 5000 retail units, and has coined and invented various trade marks which are the names of the flavours and products of ice cream used as sub-brands sold under the umbrella house mark "Baskin Robbins".

15. However, the Subject Mark has no reference to "Baskin Robbins" or "BR" in it. The actual use of the Subject Mark in the market, as is seen from the material brought on record by the Petitioner is "BR Ice Cream Rocks" but what is sought to be registered to get a monopoly over, is the phrase "ICE CREAM ROCKS" as a word mark.

16. It is true that neither Impugned Order cites any dictionary, lexicon or trade publication to support the finding that the mark is merely descriptive or laudatory. They hold that the usage of the Subject Mark has not been for long enough to give it an aura of acquired distinctiveness. It is also contended that the Affidavit of User filed by Mr. Mohit Khattar dated January 16, 2024

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("***Affidavit of User***") on behalf of the Petitioner has not been squarely addressed in the Impugned Orders. These submissions make the Impugned Orders appear vulnerable when seen from the perspective of the prayer for a remand with a direction to advertise the applications, however, considering the nature of the Subject Mark (a simple combination of generic words i.e. "ICE CREAM ROCKS") and considering that the appellate jurisdiction under Section 91 of the Act is co-extensive with the powers of the Registrar, it is felt appropriate to assess if the observations in the Examination Report and the submissions of the Petitioner in that regard, make out a case for remanding the applications to the Registrar as prayed.

17. Therefore, the provisions of law cited by the Registrar to resist processing the applications any further, are extracted below and the submissions of the parties are dealt with.

Section 9:

Section 9 of the Act reads thus:

> *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**;*

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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;*

(c) *****

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****.*

[Emphasis Supplied]

18. Section 9(1)(a) of the Act sets out a positive statutory prohibition on registering any trade mark that is devoid of any distinctive character. The features of such a mark are articulated in the provision itself as a mark not capable of distinguishing the goods or services of one person from the goods or services of another. Section 9(1)(b) of the Act sets out a positive statutory prohibition on the registration of any trade mark which consists exclusively of indications that may serve in trade to designate the kind, quality, purpose or other characteristics of the goods or services.

19. Mr. Deshmukh is right in his submission that Sections 9(1)(a) and 9(1)(b) embody the legislative policy that expressions incapable of distinguishing one trader's goods or services from those of another, and expressions which designate the nature, quality, or intended purpose of goods

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or services, must remain available for *bona fide* use by all traders, without allowing anyone to monopolise them. What is sought to be registered by the Petitioner is the expression "ICE CREAM ROCKS" and not something like "BR ICE CREAM ROCKS" or "BASKIN ROBBINS ICE CREAM ROCKS". With that handicap in the Subject Mark, one has to examine whether the Subject Mark is capable of distinguishing the goods of the Petitioner from the goods of another.

20. Indeed, the Petitioner has relied on about 130 instances of registered marks with "ICE CREAM" in them, but almost all of them have as their primary element, the brand name of ice cream – for example "Amul" or "Arun" as a prefix or fuller names such as "METRO THE DAIRY ICECREAM" or "HOKEY POKEY ICE CREAM PARLOUR". There is also a registration of "ICE CREAM WORKS", which is an ice cream parlour in Mumbai and that is discussed when dealing with Section 11 of the Act later in this judgement.

21. The Senior Examiner has recorded a categorical finding that 'ICE CREAM ROCKS' is descriptive, common to trade and laudatory in relation to the goods and services for which registration has been applied, and is therefore incapable of functioning as a legitimate mark. These views are upheld in the Impugned Orders.

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22. Mr. Mohan would submit that no monopoly can be, or is being claimed on "ICE CREAM", which by itself is a matter of public right. The real differentiator, he would submit is in the addition of "ROCKS" which makes the Subject Mark distinctive. He would contend that the Subject Mark is neither descriptive nor laudatory of the goods. The expression has no dictionary meaning and is not a phrase known to the language, to the trade, or to the consumer. He would contend that the Subject Mark is an ungrammatical combination of words put together to invent a new expression, and it must be judged as a whole, without being dissected. 'ROCKS' bears no meaning in relation to these goods. Mr. Mohan would submit that the meanings it bears i.e. a stone or minerals forming the earth's crust, to shake or move back and forth, and, colloquially, to be excellent or to perform very well, is suggestive at the highest, and the consumer would need a mental leap to associate it with a dairy product. Therefore, it is not, on the face of it, incapable of registration. Rocks having no fixed shape, size, colour or composition, the word cannot describe the shape or appearance of anything.

23. Indeed, neither the phrase 'ICE CREAM' nor the word 'ROCKS' by itself would be capable of acquiring a distinguishing feature making them amenable to registration, and indeed, one cannot dissect a mark into its parts to examine their merits for registration. Whether in the combination used, the mark taken as a whole becomes ineligible for registration owing to the prohibition

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under Section 9 is the issue to be examined. Having contended that the phrase must be seen as a whole, and having disclaimed any monopoly of 'ICE CREAM' the Petitioner's submission boils down to analysing the meaning of 'ROCKS' and argumentation on what that particular word could mean – ranging from a piece of earth (as a noun) to excelling in performance (as a verb). In my view, seen in a combined fashion, it is difficult to see how the Subject Mark is capable of distinguishing the goods of the Petitioner from the goods of others in the market.

24. It must be remembered that heavy reliance is placed on the "Baskin Robbins" lineage and umbrella in the pleadings but the Subject Mark sought to be registered in order to claim a monopoly against the world at large has no whisper of this lineage to seek distinguishment from others. The Subject Mark speaks for itself (*res ipsa loquitur*) in how it is indistinctive to differentiate between the goods or services of the Petitioner from the goods or services of any other person. This is not a case of "Baskin Robbins Ice Cream Rocks" as would be the case with, for example, 'METRO THE DAIRY ICE CREAM'. Merely adding 'ROCKS' to 'ICE CREAM' does not turn the needle in favour of making the Subject Mark capable of acquiring a distinctive character enabling grant of a monopoly to the Petitioner.

25. In this sense, Mr. Deshmukh is right in contending that merely because no one else has used a coinage that is incapable of overcoming the bar under

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Section 9, it would not follow that the first person to use such an unregistrable coinage can get registration. Indeed, the actual usage by the Petitioner is of "BR ICE CREAM ROCKS" with the "Baskin Robbins" prefix, which is what provides the distinguishment in the actual usage in the real market. However, what is sought to be done in the applications is to take over a statutory monopoly over a part of what is actually being used, which part, on the face of it contains nothing distinctive about it within the meaning of Section 9(1)(a) of the Act.

26. As regards Section 9(1)(b), the Subject Mark, even taken as a whole (in itself, a part of the real whole actually put to use in the market) comprises exclusively of marks or indications to designate the kind of goods (ice cream) or the quality or other characteristics of the goods ('ROCKS' as in shape or 'ROCKS' as an adjective for quality and excellence). Therefore, on the face of it, even under Section 9(1)(b) of the Act, there is an evident lack of anything beyond the generic and bare description of the product or its quality. Indeed, the contentions by the Petitioner call for an etymological comparative analysis of 'ROCKS' and 'WORKS', particularly in the context of Section 11 in view of the Existing Mark cited in the Impugned Order. While Section 11 is discussed separately below, the mere addition of 'ROCKS' to 'ICE CREAM' does not result in the ingredients of Section 9(1)(b) of the Act being overcome. The Subject Mark ('ICE CREAM ROCKS') still comprises exclusively the kind of

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goods and the projected quality of the goods with no other element brought to bear, to take it out of the prohibitive jurisdiction of Section 9(1)(b) of the Act. The goods in question are essentially ice-cream encapsulated in forms that are intended to suggest they are rocks. This is merely an indication of the characteristic of shape of the goods and does not overcome Section 9(1)(b) of the Act.

27. Generic, descriptive or laudatory terms, particularly those commonly used in a given trade, cannot be monopolised and the protection by registration does not extend to such elements *per se* unless it is affirmatively shown that they have acquired secondary meaning or distinctiveness. Mr. Deshmukh's reliance on ***Pernod Ricard***[7] is appropriate in this context. The following extract is noteworthy:

> *34.* ***It is a well-established principle of trademark law that generic, descriptive, or laudatory terms – particularly those commonly used in a given trade – cannot be monopolized*** *by any one proprietor.* ***Even where such terms form part of a registered trademark, protection does not extend to those elements per se*** *unless it is affirmatively shown that they have acquired secondary meaning – i.e., that* ***the term has come to be exclusively and distinctively associated with the plaintiff's goods in the perception of the consuming public****.*
>
> ***[Emphasis Supplied]***

28. The *proviso* to Section 9 too does not assist the Petitioner. Whether at the time of the application for registration, the Subject Mark had acquired a

7 Pernod Ricard India Pvt. Ltd. & Anr. v. Karanveer Singh Chhabra, ***2025 INSC 981***

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distinctive character as a result of use is the question to be asked. The Affidavit of User claims acquisition of such distinctive character since June 10, 2023, relying on an online-aggregator invoice dated 10/06/2023 (Exhibit "C"). The applications were made on January 17, 2024 – a mere seven months since the attested commencement of use, and on the very same day as the registration of the Affidavit of User. I have already set out that the actual use is not of just the Subject Mark but the wider mark that includes the differentiator Baskin Robbins. What is sought in the applications is to take a part of it comprising generic and non-distinctive and descriptive elements and secure a monopoly over them. When assessing the Impugned Orders, one must examine the factual position obtaining at the time of the application, and use of a wider mark over such a short period of time would not confer distinctiveness over a part of the wider mark that is sought to be registered.

29. The result of such use and whether it has led to acquisition of distinctiveness is a question of fact. Since a grievance is made about the Affidavit of User not having been dealt with, I have examined the same. The affidavit is simply an attempt to demonstrate the use, which is but of a seven-month period. It is the annexures to the affidavit that show the use of the Subject Mark. Indeed, the Petitioner claims that such use, and that too with the 'BR' or 'Baskin Robbins' differentiator gives distinctiveness, but what is sought to be registered is only 'ICE CREAM ROCKS'. Indeed, the numerous

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registrations pressed into service by Mr. Mohan entail registrations that include a differentiator umbrella element such as “Amul”, “Arun” etc.

30. Mr. Mohan would submit that the two limbs of the findings cannot stand together, since if ‘ROCKS’ is read in the sense of a stone, the mark is not laudatory, and if it is read in the colloquial sense, the Subject Mark is not descriptive of the character, quality or intended purpose of dairy goods. The Impugned Orders, not having disclosed which of the two they base the rejection on, it cannot be said that the preliminary and minimal threshold under Section 9 is adequate to reject the applications. This is why the material on record has been examined in the co-extensive appellate jurisdiction and the submissions of both parties on the merits have been heard. Having examined the material on record and the affidavit of the Petitioner, I am afraid, for the reasons set out above, the bar under Section 9 cannot be overcome by the Subject Mark.

31. The contention that Google search results throw up only the Petitioner’s product too does not turn the needle for acquisition of distinctiveness. It is true that there is no specific metric for efflux of time for distinctiveness to have been obtained, but there is nothing to show that the Subject Mark is a household name or that it is associated so distinctively with the Petitioner, and that too in the manner sought to be registered without the brand distinction of Baskin Robbins. Thus, in my view, such grant of registration would militate

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against the wider legislative objective of not permitting a registrant to squat over generic non-distinctive words through a registration.

32. It is correct to state that the burden of proving acquisition of distinctiveness is to be shouldered by the Petitioner and all that is available on record is assertions of reputation, internet search results and evidence contained in the Affidavit of User. Accepting the date of acquisition of distinctive character claimed in the Affidavit of User, I am afraid no reasonable case is made out from the material on record to demonstrate that usage has led to the public recognising and associating the Subject Mark exclusively with the Petitioner.

Section 11(1):

Section 11 of the Act, reads thus:

> *11. Relative grounds for refusal of registration.—*
>
> *(1) Save as provided in section 12, a trade mark shall not be registered if, because of—*
>
> > *(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or*
> >
> > *(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,*
>
> *there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.*

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[Emphasis Supplied]

33. While the prohibition on registration under Section 9 of the Act is absolute, the restrictions under Section 11 are relative to marks registered earlier. If the mark sought to be registered is identical to a mark already registered and the goods and services covered by the mark are similar with those covered by such mark, it must not be registered. Likewise, if there is a likelihood of confusion on the part of the public because of the similarity of the mark for which registration is sought with an earlier mark, the goods or services covered being identical or similar, such mark must not be registered.

34. Section 11(1) has found mention on the part of the Registrar only in the rejection that is covered by Petition 10288. Mr. Mohan would assail the finding of likelihood of confusion being contained in a single sentence and contend that similarity is asserted and nowhere shown, and that the order describes no feature of the applied mark or of any cited mark and does not identify what is said to be similar to what. Mr. Mohan would submit that the Existing Marks being 'ICE CREAM WORKS', would indicate that the only common element is 'ICE CREAM', which is the name of the goods themselves and over which monopoly has been expressly disclaimed by the Petitioner. Therefore, he would submit, the real comparison is between 'ROCKS' and 'WORKS', words different in sound, in appearance and in idea, which could

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lead to no confusion.

35. The Existing Marks are used as a trading style or signage for ice cream parlours, while the Petitioner's mark is used upon the product itself and that too beneath the umbrella house mark BASKIN ROBBINS. The Impugned Order, in any case, does not say anything about the goods, trade, customers or channels of trade relating to the Existing Marks. Further, Mr. Mohan would submit that the Registrar himself has permitted the four Existing Marks, and upwards of 130 further marks incorporating the expression 'ICE CREAM', to be registered, and that too in Class 29. Therefore, it is submitted that this was a fit case to exercise the power to advertise the applications, so that the proprietor of the Existing Marks or indeed any other proprietor of any other mark with 'ICE CREAM' in it could have made their opposition known. Reliance was placed on the decision of this Court in ***Kleo Consumer***[8].

36. Mr. Deshmukh would submit that every application must be examined independently on its own merits and the registration of another mark neither creates a precedent nor confers a right upon a later applicant to demand similar treatment. He would also point to the jurisdiction to pursue rectification after registration to contend that registration does not constitute an inexorable conclusive legitimacy of the monopoly conferred. However, he

8 Kleo Consumer Brands Private Limited v. Jeevan Kumar, Senior Examiner of Trade Marks and Anr., ***COMMP No. 39 of 2025***

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would also candidly submit that while the Petitioner may indeed have a point to make in relation to the invocation of Section 11 of the Act by the Registrar, that would be rendered irrelevant since the Subject Mark simply cannot be registered by reason of Section 9 of the Act. In this context he would submit that even if after advertisement and opposition, an opponent and the Petitioner were to settle their differences under Section 11, it would still not be open to the Registrar to register the Subject Mark in view of the clear prohibition under Section 9 of the Act.

37. In my opinion, there is far greater subjectivity in the element of Section 11 of the Act and its application to the facts of the case. It is not clear how the Registrar cites the Existing Marks and Section 11 because there is no analysis benchmarking the Subject Mark with the Existing Marks in terms of the goods and services covered by them respectively, and the similarity or identity between them within the mischief of Section 11 of the Act. However, analysis of the invocation of Section 11 and the infirmity of the Impugned Order that deals with Section 11 is moot inasmuch as, for the reasons set out above, in my opinion, the Subject Mark is not amenable to registration as applied for, in view of Section 9 of the Act. Therefore, in the interest of avoiding prolixity, I am not analysing or commenting further on this facet of the case.

Summary of Conclusions

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To summarise my findings and conclusions:

A] The Impugned Orders are indeed not articulately reasoned and come close to being vulnerable on this count. However, the scope of this Court's appellate jurisdiction is co-extensive with the scope of jurisdiction of the Registrar. It is appropriate for the Section 91 Court to examine if the core and substance of the Registrar's reasoning under Section 9 passes muster, and whether based on the same material as was available before the Registrar, the same outcome is reached with obvious reasons. Upon such examination, if it is found that there is no basis to permit registration under Section 9 of the Act, there is little point in directing a remand with a direction to advertise the applications;

B] The Registrar was not wrong in rejecting the registration of the Subject Mark under Section 9 of the Act for lack of distinctiveness, whether inherent or acquired. A prohibition on registration under Section 9 has to be adjudicated on the facts of the case. No degree of ventilation in opposition proceedings or even the complete lack of opposition from any member of society, can overcome what is clearly prohibited from registration under Section 9 of the Act;

C] Going by the plain English meaning of the Subject Mark, which

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too is only a part of the mark actually used, in my view, compels the conclusion that registering the Subject Mark would result in very generic and descriptive words being monopolised, when even commercially, the Petitioner uses the Subject Mark along with 'Baskin Robbins' or 'BR' to establish distinctiveness. Registering just 'ICE CREAM ROCKS' would give the Petitioner a wider protection for just the integers of the Subject Mark, which by themselves only describe the products and their characteristics – be it of *shape* (ice cream embedded in rock-like structure), or of *quality* ('ROCKS' as an indicator of excellence in performance);

D] The Subject Mark is hit not only by Section 9(1)(a) of the Act but also by Section 9(1)(b). Taken as a whole, it consists exclusively of indications which serve in trade to designate the kind of goods (ice cream) and their quality or other characteristics – whether the shape in which the goods are presented, or the excellence conveyed by 'ROCKS' read as a verb. There is no further element in the Subject Mark to take it outside that prohibition;

E] The reliance placed on about 130 registrations containing 'ICE CREAM' does not assist the Petitioner. Almost every one of them carries the distinguishing element of a brand name (such as 'Amul' or 'Arun'), which is precisely the element that the Subject Mark, as applied

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for, lacks. In any event, the registration of another mark neither creates a precedent nor confers a right upon a later applicant to demand similar treatment;

F] The length of usage of the Subject Mark at the time of the applications does not inspire confidence in the claim of acquired distinctiveness. The applications have been filed within seven months of the commencement of claimed usage. The proviso to Section 9 is not attracted in the facts of the case, to warrant registration. The Subject Mark cannot claim to be a household name, and no inference on the ground of the Subject Mark having acquired distinctiveness is warranted;

G] Since the Subject Mark trips on the hurdle of Section 9, whether it successfully crosses the hurdle under Section 11 is irrelevant. Reliance on Section 11 by the Registrar, and the manner in which the Registrar has dealt with Section 11 and its ingredients, does not turn the needle either way in the peculiar circumstances of the case. It is true that the Impugned Order in Petition 10288 records no analysis benchmarking the Subject Mark and the goods it covers against the Existing Marks and the goods they cover, but that infirmity stands rendered academic by the conclusion under Section 9. The fact that Subject Mark is not registrable by reason of Section 9 would render the invocation of Section 11 and

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further examination of reactions from society to the perceived objections under Section 11 irrelevant;

H] The reasoning set out above governs both Petitions. The application in Class 35 is for services relating to the very goods covered by the application in Class 29, and thus the Subject Mark falls foul of Section 9 in relation to those services in the same manner and for the same reasons. It is therefore unnecessary to examine separately the additional findings in the Impugned Order rejecting the Class 35 Application.

38. For the aforesaid reasons, the Petitions do not inspire any appellate intervention and they are ***finally disposed of*** without any interference with the Impugned Orders.

39. Before parting with the matter, it would be appropriate to direct a serious consideration on the quality of the articulation in orders passed by the Registrar and indeed other similarly-placed authorities administering intellectual property laws. Orders impugned in statutory appeals are often found to have been passed without even proper formatting, paragraph-numbering and without readable standard font sizes. It is often a challenge to decipher the orders impugned. In statutory appeals involving cases where the matter has turned on the basis of the conflict between private parties and one

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does not even have to hear the Registrar, whose orders must speak for themselves. The lack of precision, at the least in the form in which the decisions are presented, poses a serious challenge to the administration of the appellate review. Advocates for the Registrar are requested to have these views placed before the leadership involved in governance of the Registrar's offices to ensure that these shortcomings are addressed.

40. All actions required to be taken pursuant to this order shall be taken upon receipt of a downloaded copy as available on this Court's website.

[SOMASEKHAR SUNDARESAN, J.]

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