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

Date of Decision: 16th August, 2023

\+ **C.A.(COMM.IPD-TM) 47/2022**

FLUKE CORPORATION, 6920 SEAWAY BOULEVARD EVERETT, WASHINGTON 98203, USA ..... Appellant

Through: Mr. Pravin Anand and Ms. Sandhya Singh, Advs. (M: 9810055641)

versus

REGISTRAR OF TRADEMARKS, BOUDHIK SAMPADA BHAVAN, PLOT NO. 32, SECSTOR-14, DWARKA, NEW DELHII ..... Respondent

Through: Mr Harish Vaidyanathan Shankar CGSC with Mr Srish Kumar Mishra Mr Sagar Mehlawat and Mr Alexander Mathai Paikaday, and Mr M Sriram, Advs. (M: 98107 88606)

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J.(Oral)

1. This hearing has been done through hybrid mode.

2. The present appeal has been filed under Section 91(1) of Trade Marks Act, 1999 by the Appellant-Fluke Corporation challenging the impugned order dated 10th December 2018 passed by the Respondent-Registrar of Trademarks.

3. Vide the impugned order, the Appellant's Trademark Application bearing no. 2354325 dated 26th June 2012 for the mark 'DATAPAQ' in Class 9 (*'the Application'*) has been rejected under Section 9(1)(b) of the Trade Marks Act, 1999 on the ground that the same is descriptive of the goods and services.

4. On 4th July, 2022, a statement was made on behalf of the Appellant

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that it is willing to restrict the mark 'DATAPAQ' *qua* certain goods for temperature systems and temperature profiling. Ld. Counsel for the Appellant was directed to place on record an amended description of goods. The same has been placed on record today. The new description of goods read as under:

> "*computer software for temperature profiling systems in the fields of heavy clay and ceramics, heat treating, electronics manufacturing and the finishing industry: temperature profiling system comprised of electronic data loggers, thermocouples, thermocouple jigs, humidity sensors, telemetry hardware, thermocouple probes, and computer software, together with thermal insulation barriers, for use to analyze, monitor, record, and log data regarding temperatures in the heat treatment industry, product finishing industry, heavy clay and ceramics industry, electronics manufacturing industry, solar cell and photovoltaic module manufacturing industry, and food industry: electronic data logger sensors: thermocouples: thermocouple jigs: humidity sensors: telemetry hardware: thermocouple probes: computer software for analyzing, monitoring, recording, and logging data for use in the heat treatment industry: computer software for analyzing, monitoring, recording, and logging data for use in the product finishing industry: computer software for analyzing, monitoring, recording, and logging data for use in the heavy clay and ceramics industry: computer software for analyzing, monitoring, recording, and logging data for use in the electronics manufacturing industry: computer software for analyzing, monitoring, recording, and logging data for use in the solar cell and photovoltaic module manufacturing industry:*

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> *computer software for analyzing, monitoring, recording, and logging data for use in the food industry: computer software to monitor and control factory manufacturing processes: and computer software for temperature profiling systems in the heat treatment industry, product finishing industry, heavy clay and ceramics industry, electronics manufacturing industry, solar cell and photovoltaic module manufacturing industry, and food industry: electrical and scientific apparatus*"

5. The Appellant has, in effect, deleted the following three descriptions.

- Electronic data logger sensors
- Thermocouple trays
- Electronic data loggers

6. A perusal of the mark would show that the Appellant is seeking registration of the mark 'DATAPAQ' as a word mark. The said mark is, according to the Appellant, being used as temperature monitoring and temperature profiling software systems. The Appellant is also using the mark such as WICKEDPAQ, MONOPAQ, etc. as a series of marks.

7. A perusal of the examination report and the search report dated 24th June 2013 on record would show that there are several other parties, having registrations in respect of the marks consisting of the word 'DATA' 'PAQ/PACK' as well.

8. Such marks include DATA I/O, PACKIT, DATA WORLD, PACK TRACK, PACKTOP, DATA, PACK1, DATA ROBOTICS, DATA XPLOD, PACK POWER, DATA FLO, PACKWIN, DATA RESOLVE TECHNOLOGIES.

9. Search report filed by the Appellant dated 9th May 2018 also reveals

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that marks similar to the Appellant's mark 'DATAPAQ' exist as words 'DATA' and 'PACK' or 'PAQ'.

10. A perusal of the impugned order would show that the only reasoning given by the Registrar is captured in a very cryptic manner, in one sentence as under:

> "* *Adv. Akanksha appeared. Matter argued. The Trade Mark is descriptive. So obj. u/s 9 maintained. Hence Refused.*"

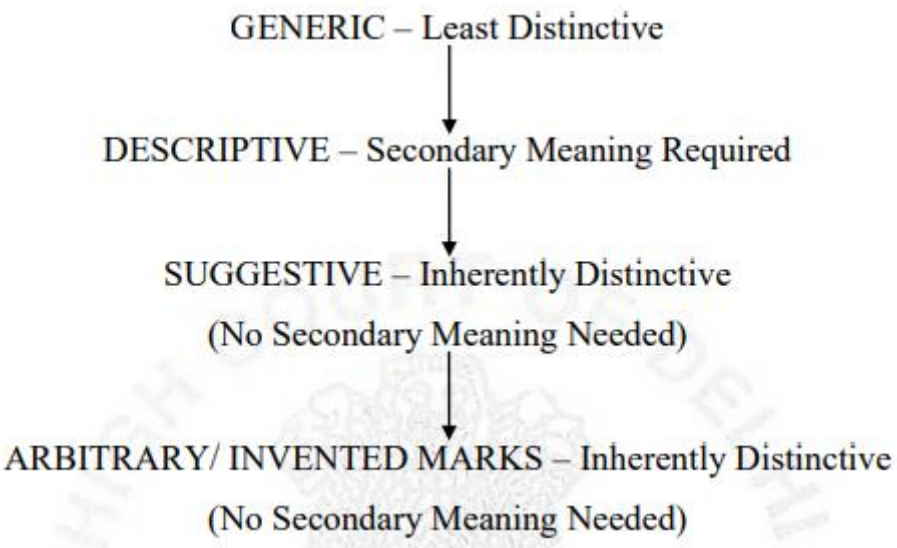
11. Heard. The Appellant, established in 1948, is stated to be a global leader in compact electronic test tools. The company, headquartered in Everett, Washington, USA, operates manufacturing centers in multiple countries and has sales and service subsidiaries across various regions. With over 100 authorized distributor and manufacturer representative channels, the Appellant employs around 2,400 people. One of its divisions, Fluke Process Instruments, specializes in designing and manufacturing infrared temperature measurement solutions for industrial applications. The division's products are claimed to be distributed globally under brands such as Raytek, Ircon, and DATAPAQ, aiming to provide crucial temperature measurement and analysis systems for manufacturing processes involving ovens, kilns, and furnaces.

12. A perusal of the above impugned order, shows that the only objection is that the trademark is descriptive. In ***Bata India Ltd. v. Chawla Boot House [CS (COMM) 110/2019, decision dated 16th April 2019]***, the Plaintiff sought protection of its mark 'POWER', against the use of the Defendant's mark 'POWER FLEX' in respect of footwear. The Court held that 'POWER' is a distinctive mark in respect of footwear, and injuncted the

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Defendant's use of the work 'POWER'. However it was made clear that use of word 'POWER' as part of the Defendant's slogan cannot be permitted to be injuncted. This Court observed as under:

> *"26. The spectrum of distinctiveness of marks clearly explains how distinctiveness of marks is to be judged. The spectrum as explained in McCarthy on 'Trade Marks and Unfair Competition', can be illustratively depicted as below:*



> *27. Even if one considers the nature of the mark 'POWER', it cannot be held to be a descriptive mark. As the well-known author Mr. J. Thomas McCarthy, in the treatise on 'Trademarks and Unfair Competition', opines, the question as to whether the mark is descriptive or suggestive, can be based on the following tests:*
>
> *a) Degree of imagination required to connect the mark with the product; and*
>
> *b) The Competitor's need to use the mark."*

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13. In ***Disruptive Health Solutions v. Registrar of Trade Marks (C.A. (COMM.IPD-TM) 133/2022, decision dated 8th July 2022)***, the main issue was whether the trade mark application for the mark 'HEALTHSKOOL' should have been rejected on the grounds that the mark is descriptive under Section 9(1)(b) of the Trade Marks Act, 1999. The Appellant therein contended that the mark was not descriptive for the specified products and highlighted their existing registrations for the same mark under different classes. The central question was whether the rejection under Section 9(1)(b) of the Trade Marks Act, 1999 was justified given the nature of the mark and the products it is intended to represent. Following the decision in ***Bata India Ltd. (supra),*** the Court observed:

> *"10. The general rule regarding distinctiveness is that* ***a mark is capable of being protected if either it is inherently distinctive or has acquired distinctiveness through secondary meaning****. In the spectrum of distinctiveness, the first category of marks is of arbitrary, fanciful and invented marks which is of absolute distinctiveness. Similarly, suggestive marks can also be registered due to their inherent distinctiveness.* ***Descriptive marks can be registered as trademarks provided secondary meaning is established. Insofar as descriptive marks are concerned, just because some portion of the mark may have some reference or indication as to the products or services intended for, the same may not be liable to be rejected straightaway****. In such a case, the merits of the marks would have to be considered along with the extent of usage. Other registrations of the applicant would also have a bearing on the capability of the mark obtaining registration. The*

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owner of a mark is always entitled to expand the goods and services, as a natural consequence in expansion of business.

11. The test which is applied by the ld. Senior Examiner in the impugned order is not in consonance with the settled legal position set out above. The spectrum of distinctiveness has to be considered while examining the applications which come up for registration before the Trade Mark Registry.

12. In the present case, the mark 'HEALTHSKOOL' has been in use by the Appellant since 2015. The same is also the subject matter of several registered marks in various classes in favour of the Appellant both in logo form and word form. The Appellant's sales are to the tune of approximately Rs.23 crores in 2020-21. The Appellant has further submitted before the Court that it does wishes to claim any exclusive rights in the word 'health' per se. ***In the opinion of the Court, at this stage, the mark is distinctive enough to proceed for advertisement****.*

13. Under these circumstances and in view of the settled legal position, the impugned order is not sustainable. The same is, accordingly, set aside. The application of the Appellant shall proceed for advertisement in the trademark journal with the condition 'No exclusive rights in the word `Health'*. ''*

14. The settled legal position is that descriptive marks can be registered, provided they acquire secondary meaning. Thus, the reasoning provided in the impugned order is itself unsustainable as there is no consideration whether the Appellant's mark has acquired secondary meaning or not.

15. Moreover, a perusal of the appeal would reveal that the Appellant is a US Corporation, and has used the mark DATAPAQ since 1985 in various

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countries. The mark DATAPAQ also has been registered in a large number of countries such as the USA. The Appellant has a number of marks ending with PAQ such as: COILPAQ, WICKETPAQ, MONOPAQ, STENTERPAQ, ROTOPAQ LITE, DATAPAQ AUTOPAQ, DATAPAQ MONOPAQ2. Thus, the mark DATAPAQ is consistent with the series marks being used by the appellant.

16. Under such circumstances, bearing in mind the current position of the other pending and registered trade marks on the Register, this Court is of the opinion that the Appellant's mark 'DATAPAQ' deserves to proceed for advertisement subject to the following conditions.

(i) No exclusivity shall vest in the word 'DATA' or 'PACK/PAQ' separately.

(ii) The trade mark registration shall be confined to the word mark DATAPAQ as a whole.

17. With these conditions, let the Appellant's mark 'DATAPAQ' be advertised in the trademark journal by the Registrar of Trademark within a period of 2 months.

18. It is made clear that the present order would not affect opposition proceedings, if any, filed against the Appellant's mark.

19. Let the present order be communicated to the Registrar of Trade Marks at llc-ipo@gov.in.

20. The appeal is disposed of in the above terms. All pending applications are disposed of.

PRATHIBA M. SINGH, J.

AUGUST 16, 2023/*dk/dn*

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