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

\+ C.A.(COMM.IPD-TM) 111/2022

INFORMATION TV PVT LTD. ..... Appellant
Through: Ms. Shweta Pandey, Advocate

versus

REGISTRAR OF TRADE MARKS ..... Respondent
Through: Mr. Harish Vaidyanathan Shankar, CGSC, Mr. Srish Mishra, Mr. Sriram and Mr. Paikaday, Advs.

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

JUDGMENT (ORAL)

% 07.08.2023

1. On 30 April 2013, the appellant applied under Section 18(1)[1] of the Trade Marks Act, 1999 for registration of the device mark  in Class 41 of the NICE classification in respect of Production of radio and television programmes, television entertainment and programmes included in class 41.

2. The Trade Marks Registry, *vide* First Examination Report (FER) dated 16 May 2014, objected to the application on three grounds; firstly, that the mark was descriptive, as it designated the kind, quality, quantity, intended purpose, values, geographical origin or time of production of the goods or rendering of the service in

[1] **18. Application for registration**.—(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark.

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respect of which registration was sought, which was not registrable under Section 9(1)(b)[2] of the Trade Marks Act; secondly, that the registration of the proposed mark was prohibited under the emblems and names (Prevention of Improper Use) Act, 1950 and, thirdly, that the mark was similar to earlier trademarks.

3. The appellant responded to the FER *vide* communication dated 27 July 2016, contesting all the three grounds on which the registration was proposed to be refused.

4. By order dated 24 September 2018, the senior examiner of trademarks rejected the petitioner's application under Sections 9 and 11 of the Trade Marks Act. The appellant sought the reasons for the decision. The senior examiner, thereupon, issued the following "Statement of Grounds of decision", as envisaged by Rule 36(1) of the Trade Marks Rules, 2017, on 2 November 2018:

> "Gentleman/Madam,
>
> With reference to the above and request on Form TM-M dated 30/10/2018. It has been decided by the Registrar of Trade Marks to inform you that hearing in respect of above application was held on 11/09/2018 and the said application is refused on the following Grounds:
>
> * Advocate appeared. Matter argued. The Trade Mark is not distinctive and descriptive to the goods applied. So obj. u/s 9

[2] **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;
(*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*) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade,
shall not be registered

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cannot be waived Hence Refused

* 9-Absolute grounds for refusal of registration.
* 9(1)(a) The trade mark 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:
* 9(1)(b) The Trade Mark consist exclusively of marks or indications which 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 services.
* 9(2)(d) - The trade mark: ---its use is prohibited under the Emblems and Name(Prevention of Improper Use)Act, 1950 (12 of 1950)

Yours Faithfully,

DINESH KHURANA
(SENIOR EXAMINER)"

5. Thereby, the appellant appealed to the learned Intellectual Property Appellate Board (IPAB) under Section 91 of the Trade Marks Act, *vide* the present appeal which, subsequently, was transferred to this Court consequent to the abolition of the IPAB.

6. During the pendency of these proceedings, it appears that the appellant has been granted registration of the word mark "India News" in class 38 and 41 as well as for the device mark  in class 38.

7. The present case only deals with the entitlement of the appellant to registration of the device mark  in class 41.

8. Having agreed to register the word mark "India News" in

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favour of the appellant in class 41, it goes without saying that the respondent cannot possibly object to registering the device mark  in the same class.

9. Given this situation Mr. Harish Vaidyanathan, learned CGSC appearing for the Registrar of Trade Marks leaves the matter to the Court.

10. In the aforesaid facts and circumstances, no occasion arises for this Court to enter into the merits of the controversy. The Court is informed that the registration for the word mark "India News" has been granted to the appellant in classes 38 and 41 without any accompanying disclaimer. If that be so, the appellant would also be entitled to registration of the device mark  in class 41 without any accompanying disclaimer.

11. Solely on this ground, and without entering into the aspect of whether the mark "India News" was otherwise registrable under Section 9 of the Trade Marks Act, this appeal is allowed. The impugned order is quashed and set aside.

12. The Registrar is directed to accord registration to the appellant of its device mark  in class 41 as sought by it. Application No. 2522479 filed by the appellant accordingly stands allowed.

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13. Mr. Vaidyanathan undertakes to transmit a copy of this order to the Registrar of Trademarks for necessary compliance.

C.HARI SHANKAR, J

AUGUST 7, 2023
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