

Legal Issues in ‘Registrability of Composite Trademarks’

Topic: ‘Would the “Exclusivity” Principle Derived from the Absolute Grounds of Refusal of a Trademark imply Exclusion of the “Dominant Part” Principle?’

Relevant Legal Provisions

❖ Section 9(1)(b), Trade Marks Act, 1999 –

*“9. Absolute grounds for refusal of registration – (1) The trade marks - (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.” (Emphasis supplied)

Relevant Legal Provisions (Contd.)

❖ **Section 2(1)(m), Trade Marks Act, 1999 –**

“'mark' includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;” (Emphasis supplied)

Relevant Judicial Decisions

- ❖ *Nakshatra Distilleries and Breweries Ltd. v. Radico Khaitan Limited and Ors.*, ORA/271/2015/TM/MUM and ORA/227/2015/TM/MUM (Decided on November 30, 2018, by IPAB Mumbai)
- “1. The Applicant has filed the above two petitions seeking cancellation of registration of the trade mark **BRIHANS GOA labels.**” (Emphasis supplied)
- “70. (c) The impugned marks so far as it contains the expression GOA as a part of the composite mark thus attracts the provisions of section 9(1)(b) and also section 9(1)(c) as it has also become a common mark in trade of alcohol in India and internationally as well.” (Emphasis supplied).

Relevant Judicial Decisions (Contd.)

- ❖ ***Arganshe Pvt. Ltd. v. Registrar of Trade Marks, OA/62/2020/TM/DEL (Decided on November 6, 2020, by IPAB Delhi)***
- *“9. We have examined the impugned order 10th October 2019 and detailed order on 20th October 2019 passed by the Respondent and reviewed the submissions of the Appellant, The examiner report has not cited any similar applications and the **only ground on which the application is refused is that the mark is descriptive in nature.***
- *10. Further, we have recorded the submission of the Appellant that it would not use or claim exclusivity to the words "BIO" or "AYURVEDA" independently and shall always use the **mark as composite device mark as filed.***
- *11. In view of the above, the present appeal is allowed. Both orders dated 10th October 2020 and 20th October 2020 are set-aside. The application of the appellant is allowed subject to the disclaimer of the words "BIO" or "AYURVEDA" from the mark if used separately.” (Emphasis supplied)*

Relevant Judicial Decisions (Contd.)

- ❖ *Neuberg Hitech Laboratories Pvt. Ltd. and Ors. v. Ganesan's Hitech Diagnostic Centre Pvt. Ltd., Civil Suit (Comm. Div) No. 75 of 2022 (Decided on July 28, 2022, by MADHC)*
- *“33. The application for relief in respect of the device marks "Nalam Cancer Screen", "Nalam Diacheck 1.0", "Nalam Diacheck 2.0" and "Nalam MHC" remains to be considered... Significantly, the word "Nalam" means health or well being in Tamil. When used in relation to diagnostic services, it clearly refers to the intended purpose or objective of the services. Thus, they are descriptive marks.” (Emphasis supplied)*

Relevant Judicial Decisions (Contd.)

- ❖ ***Umang Dairies Limited v. Registrar Of Trade Marks, C.A.(COMM.IPD-TM) 145/2021 (Decided on February 21, 2023, by DELHC)***
- *“4. The subject mark is a composite device mark, comprising of two words ‘WHITE’ and ‘MAGIK’, along with graphic representation of milk being poured in a hot cup of tea/ coffee. In Court's opinion, while the word ‘WHITE’ may be correlated with ‘milk and milk products’, however, when paired with ‘MAGIK’, the alternative spelling of ‘MAGIC’, the resulting composite mark ‘WHITE MAGIK’ does not relate to/ describe the goods to which the subject mark is applied to. Consequently, the subject mark cannot be considered descriptive but suggestive, at best.” (Emphasis supplied)*

Relevant Judicial Decisions (Contd.)

- ❖ *Rajni Gupta Trading As Guru Kripa Chemico Industries v. The Registrar Of Trade Marks, C.A.(COMM.IPD-TM) 33/2021 (Decided on April 19, 2023, by DELHC)*
- “4. *The subject mark is a composite mark which includes two words ‘Doctor’s’ and ‘Choice’. The said mark, when viewed as a whole, is distinctive and capable of distinguishing the goods of one person from another and therefore, the objection under Section 9(1)(a) of the Act is not sustainable... Therefore, unless the products are marketed as those which are preferred or recommended by doctors, the subject mark cannot be considered descriptive; it is only suggestive and therefore, objection under Section 9(1)(b) of the Act is not be attracted.*” (Emphasis supplied)


Relevant Judicial Decisions (Contd.)

- ❖ *Abu Dhabi Global Market v. The Registrar of Trademarks, Delhi, 2023/DHC/003476 (Decided on May 18, 2023, by DELHC)*
 - “29. *It is only, therefore, trade marks, which consist **exclusively** of marks or indications which designate the geographical origin of the goods, which cannot be registered.*
 - *30. Composite marks, therefore, stand ipso facto excluded from the scope of Section 9(1)(b), even if part of such marks consist of marks or indications which serve, in trade, to designate the geographical origin of the goods or services in respect of which the mark is registered.” (Emphasis supplied)*

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Relevant Judicial Decisions (Contd.)

❖ *Abu Dhabi Global Market v. The Registrar of Trademarks, Delhi, 2023/DHC/003476 (Decided on May 18, 2023, by DELHC) (Contd.)*

- *“33. The "dominant part" principle is alien to Section 9(1)(b). It cannot co-exist with the "exclusivity" principle which finds statutory place in the provision. We are not concerned, here, with an infringement suit, in which similarity between dominant parts of rival marks can constitute a ground to return a finding of infringement, following the law laid down in South India Beverages Pvt Ltd v. General Mills Marketing, despite Section 17 of the Trade Marks Act which forbears claiming of exclusivity in respect only of part of a registered trade mark. We are concerned with the entitlement of the mark  to registration under Section 9(1)(b). Section 9(1)(b) uses the word “exclusively”. The use of the word "exclusively" completely forecloses any argument predicated on the "dominant part" principle. It is only if the entire mark exclusively falls within one of the excepted categories envisaged by Section 9(1)(b) that the registration of the mark can be treated as statutorily proscribed.”*

(Emphasis supplied)

Relevant Judicial Decisions (Contd.)

- ❖ *Navaid Khan v. Registrar of Trademarks Office, 2023/DHC/003883 (Decided on May 30, 2023, by DELHC)*
 - “7. It is important to bear in mind that the appellant has applied for registration of a **composite device mark**, which contains the word 'CruzOil', along with other elements...
 - 11. Therefore, in my considered view, **the Registrar erred in dissecting the subject mark into its individual parts while considering registration.**
 - 13. In view of the above need is not felt to go into other grounds raised by the plaintiff in the present appeal.
 - 14. Accordingly, the present appeal is allowed and the impugned order dated 12th January, 2023 is set aside.
 - 15. The Trade Marks Registry is directed to proceed with the advertisement of the subject application as per the proviso to Section 20 of the Trade Marks Act, 1999.” (Emphasis supplied)

Conclusion

- ❖ There is a divergence in practice pertaining to whether the ‘dominant part’ principle will be applied while determining the registrability of a composite device mark – or the ‘exclusivity’ principle will apply.
- ❖ Even though, Section 9(1)(b), explicitly warrants for the latter, there have been instances where the courts have adopted the former. However, it’s pertinent to note that Abu Dhabi provided a blanket statement pertaining to the ‘exclusivity’ principle being alien to the ‘dominant part’ principle; and this was followed in the Navaid Khan judgment as well.
- ❖ A specific instance that’s yet to be seen is if there is a composite device mark that is actually *exclusively* descriptive – would we then move away from the recent jurisprudence?
- ❖ Despite the recent decisions of the IP Division of the Delhi High Court – it is also yet to be seen whether the Registry has *consistently* amended its practice to ipso facto exclude composite device marks from the scope of a descriptiveness objection under Section 9(1)(b).

Thank you!
Questions?

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