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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **C.A.(COMM.IPD-TM) 10/2023**

ABU DHABI GLOBAL MARKET Appellant
Through: Mr. Arjun Khurana and
Lalltaksh Joshi, Advs.

versus

THE REGISTRAR OF
TRADEMARKS, DELHI Respondent
Through: Mr. Harish Vaidyanathan
Shankar, CGSC, Mr. Srish Kumar Mishra,
Mr. Sagar Mehlawat and Mr. Alexander
Mathai Paikaday, Ad vs.

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

JUDGMENT (ORAL)

% **18.05.2023**

C.A.(COMM.IPD-TM) 10/2023, I.A. 5131/2023 (Order XLI Rule 5 of the CPC) and I.A. 5177/2023 (for placing additional documents on record)

1. This appeal assails order dated 9th December 2022, passed by the Assistant Registrar in the Registry of Trademarks, whereby Application No. 3184380, filed by the appellant, seeking registration

of the device mark  has been rejected. The impugned order reads thus:

“With reference to the above and request on Form TM-M dated 17/05/2021. It has been decided by the Registrar of Trade Marks to inform you that hearing in respect of above application was held on 15/04/2021 and the said application is refused on the following Grounds:

* 9(1)(a)-The attorney failed to establish the Identity of the mark in applied class. Neither the mark appears to be coined or invented.

* 9(1)(a)-The applicant failed to establish the distinctiveness by filing of evidence of use by way of affidavit. ABU DHABI is geographical name (the capital of the United Arab Emirates) and mark as a whole is non-distinctive which cannot be monopolized. Objections raised in examination report sustain accordingly.”

2. Assailing the aforesaid order, Mr. Arjun Khurana, learned Counsel for the appellant, submits that neither of the grounds, on which the Assistant Registrar has deemed it appropriate to reject the appellant’s application, can sustain on facts or in law.

3. Apropos the finding that the  mark is not distinctive, Mr. Khurana submits that the finding is completely unsupported by any reason and, even otherwise has, on facts, no legs to stand on. He submits that the  mark already stands registered in favour of the appellant. As such, there is recognition, on the part of the office of the Registrar of Trademarks, that the device mark  mark is distinctive and does not infract any of the inhabiting factors envisaged by Section 9 of the Trademarks Act 1999, as would bar registration of the mark. He submits that, if the  mark is distinctive, the mark cannot lose its distinctiveness by the addition, below it, of the words “ABU DHABI GLOBAL MARKET”.

4. With respect to the finding that the mark is not coined or invented, Mr. Khurana has pointed out that the trading name ABU DHABI GLOBAL MARKET of the appellant has been adopted by the appellant under the Federal Laws of United Arab Emirates (UAE), specifically Federal Decree No. 15 of 2013 dated 11th February 2013, issued in the name of the President of the UAE, which states thus:

“A Financial free zone shall be established under the name
“Abu Dhabi Global Market”.”

5. Mr. Khurana has also drawn my attention to the actual Federal Decree No. 15/2013, which has been placed on record with the present appeal.

6. With respect to the finding that the mark could not be registered as Abu Dhabi is the name of a place and is, therefore, in the nature of a geographical indicator, Mr. Khurana submits that there is no proscription in the Trademarks Act, to registration of a composite mark, a part of which is the name of a place.

7. Apropos the allegation that the application of the appellant was not accompanied by any affidavit of use, Mr. Khurana submits that, where the application is filed on proposed to be used basis, there is no statutory requirement of filing of any affidavit of use.

8. Mr. Srish Kumar Mishra, learned Standing Counsel, appearing for the Registrar, has essentially restricted his submission to the objections relating to Abu Dhabi being the name of a place/geographical indicator and to the finding that the mark is lacking in distinctiveness.

9. Mr. Mishra submits that, as Abu Dhabi is the name of a place and constitutes the most prominent part of the  mark which was sought to be registered, the learned Assistant Registrar has correctly refused to register the mark in view of the absolute

proscription against such registration contained in Section 9(1)(b)¹ of the Trademarks Act. For the same reason, he submits that the



mark, which was being sought to be registered, was also lacking in distinctiveness.

10. I have heard learned Counsel for both sides and applied myself to the record and the facts and applicable law.

11. The impugned order has rejected the appellant's application on the following grounds:

(i) The mark , which was being sought to be registered, was neither coined nor invented.

(ii) The appellant had failed to establish distinctiveness by filing an affidavit of evidence of use.

(iii) Abu Dhabi is a geographical name and the capital of the UAE.

12. Before examining these issues, I may observe that the first

¹ 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:

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.

sentence of the impugned order reads thus:

“9(1)(a)-The attorney failed to establish the Identity of the mark in applied class.”

13. I confess that I have no idea as to what this sentence is intended to convey. I have requested for the assistance of Mr. Srish Kumar Mishra in that regard and, apart from stating that the mark is not invented or distinctive, Mr. Mishra is also not able to explain the opening sentence in the impugned order.

14. As the sentence is incomprehensible, it cannot obviously serve as a ground to reject the appellant's application.

15. Proceeding to the more comprehensible part of the impugned order, I am of the opinion that none of the grounds, on which the Assistant Registrar has deemed it appropriate to reject the appellant's application, can sustain either on facts or in law.

16. The first ground cited by the Assistant Registrar is that the mark is neither coined nor invented. Section 9(1)(a) of the Trade Marks Act has been invoked in this context.

17. The grounds on which registration of a trade mark can be refused are contained in Sections 9 and 11 of the Trade Marks Act, which are comprehensive and exhaustive in that regard. I do not find, in the said provisions, any requirement of a mark being “coined” or “inventive” for it to be eligible for registration. Distinctiveness is, undoubtedly, a pre-requisite for registration of a mark, but inventiveness is not. Inventiveness is required for registration of a design or a patent, under the Designs Act, 2000 and the Patents Act, 1970, respectively. There is no corresponding provision in the Trade

Marks Act.

18. The Assistant Registrar could not, therefore, have refused to register the  mark on the ground that it is not “coined” or “inventive”.

19. That apart, even on facts, the objection appears to be unjustified. Mr. Khurana has pointed out that the mark was adopted in terms of Federal Decree No. 15/2013 dated 11th February 2013, issued in the name of the President of UAE, which specifically required establishment of a financial free zone under the name “ABU DHABI GLOBAL MARKET”. This specific ground was canvassed by the appellant, by way of reply dated 25th April 2017 to the First Examination Report (FER) dated 16th September 2016. The impugned order makes no reference thereto.

20. The said explanation, it is clear, answers, even on facts, the allegation that the  mark, of which registration was sought, was neither coined nor invented.

21. The second ground on which the Assistant Registrar has rejected the impugned mark is that the appellant had failed to establish distinctiveness by filing an affidavit of evidence of use of the mark.

22. I am unable to understand the link that the Assistant Registrar seeks to forge, between distinctiveness and evidence of use. Indeed, the finding is in the teeth of Section 9(1)(a) of the Trade Marks Act, which *defines* “distinctiveness” as capability “of distinguishing the goods and services of one person from those of another person”.

There is no observation, much less any finding, in the impugned order, that the  mark was incapable of distinguishing the goods and services of one person from those of another. Instead, the Assistant Registrar seems to have confused distinctiveness with actual user of the mark, with no basis, whatsoever, in law, therefor.

23. Evidence of user of the mark is *not* required to establish distinctiveness. If such an interpretation were to be accepted, marks could never be registered on “proposed to be used” basis – as was sought in the present case. The finding of the Assistant Registrar is not only contrary to the statute, but displays complete non-application of mind.

24. There is, in fact, no reason to hold that the  mark is not distinctive. The mark consists of the  symbol, below which is printed “ABU DHABI GLOBAL MARKET”. The logo  already stands registered, in the appellant’s favour, with the Registrar of Trademarks, indicating that the distinctiveness of the  logo stands recognized. Mr. Khurana is correct in his submission that by adding the words “ABU DHABI GLOBAL MARKET” below the logo, the mark cannot lose distinctiveness.

25. A finding of lack of distinctiveness must be preceded, in view of Section 9(1)(a), by a finding that the mark in question is incapable of distinguishing the goods or services, in respect of which it is registered, from goods or services of another. One may envisage, for example, marks which consist solely of common English words with

no distinctive character, as falling within this category (though even such marks would be entitled to registration if the proviso to Section 9(1) applies to them). Otherwise, quite frankly, capability to act as a marker to distinguish the goods and services of one from another being the sole criterion which is, statutorily, to be taken into consideration while assessing “distinctiveness”, it is difficult to conceive of *any* mark, which is not in common use by others, as being found to lack in distinctiveness. Albeit in the context of Section 9(3)² of the Trade & Merchandise Marks Act, 1958, this Court, in ***Mohd Rafiq v. Modi Sugar Mills***³, held that “the most imperative requisite of the word ‘distinctive’ when used in relation to the goods in respect of which a trade mark is registered, is that the trade mark should be adopted to distinguish the goods of the proprietor from the goods of the other persons”.

26. So long as others do not use the mark, or any similar mark, I am of the opinion that a finding of non-distinctiveness can ordinarily not be returned as, howsoever innocuous a mark may appear to be, if it is used only by one person, it would, in plain etymological terms, be distinctive. If, for example, one were to use the simple ! exclamation mark as a trade mark, could it be said that it lacks in distinctiveness? If no one else is using such a mark, I fail to see how it can be found not to be distinctive, as, whenever one refers to the ! mark in respect of that category of goods, the sole registrant of the mark would invariably come to mind.

27. In any event, in the present case, there being no finding that the

² (3) For the purpose of this Act, the expression “distinctive” in relation to the goods in respect of which a trade mark is proposed to be registered, means adapted to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

³ AIR 1972 Delhi 46



mark is used by anyone else, and the mark itself consisting of a combination of the  motif and the words "ABU DHABI GLOBAL MARKET" below it, I am unable, even on facts, to endorse the finding of the Assistant Registrar that the  mark is not distinctive.

28. The third ground of refusal to register the  mark is that Abu Dhabi is a geographical name, being the name of the capital of the UAE and is, therefore, non-registrable under Section 9(1)(b) of the Trade Marks Act.

29. Section 9(1)(b) of the Trademarks Act, in its clear and explicit terms, proscribes registration only of trade marks "which consist *exclusively* of mark or indications, which may serve in trade to designate the ... geographical origin... of the goods or services". 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.

31. The  mark, which was sought to be registered in the present case, does not consist exclusively of marks or indications

which designates the geographical origin of the goods or services sought to be covered thereby. The mark is a composite mark, which couples the words “ABU DHABI GLOBAL MARKET” with the logo . Section 9(1)(b) cannot, on its terms, apply to such a mark.

32. Mr. Mishra sought to contend that “ABU DHABI” forms the dominant part of the  mark and that, therefore, the Assistant Registrar is correct in the view she has taken.

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*⁴, 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.

34. Besides, even on facts, it is highly arguable as to whether in a

⁴ 2015 (61) PTC 231 (SC)
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composite mark, combining  alongwith “ABU DHABI GLOBAL MARKET”, “ABU DHABI” alone can be treated as the dominant, or prominent, part.

35. The third ground of rejection, in the impugned order, too, therefore, cannot sustain.

36. The impugned order cannot, therefore, sustain.

37. Before concluding, this Court is constrained yet again to express its unhappiness at the manner in which the Assistant Examiner has discharged her duties in the present case. Consequent to the FER dated 16th September 2016, a detailed reply, running into 11 pages and 23 paragraphs, which, combined with the documents filed therewith, runs into over 100 pages, was filed by the appellant.

38. The impugned order clearly indicates that the Assistant Registrar, who has passed it, has apparently not even condescended to see, much less apply her mind, to the reply, or its contents.

39. Persons who apply for registration of trademarks, do not file detailed replies to FERs, for the sake of fun. These replies are drafted with application of mind, to answer the objections which have been raised. The least that the officer adjudicating the application can do is to read the reply and at least extend, to it, the bare courtesy of application of mind.

40. There is complete abdication, by the Assistant Registrar in the present case, of the quasi-judicial functions vested in her by the Trade

Marks Act and the Trade Marks Rules. The impugned order reduces Section 18(5) of the Trade Marks Act to a redundancy.

Conclusion

41. The impugned order dated 9th December 2022 is, therefore, quashed and set aside.

42. Application No 3184380 dated 11th February 2016, is remanded to the office of the Registrar of Trademarks for advertisement and proceedings thereafter in accordance with law and the procedure envisaged in the Trade Marks Act and the Trade Marks Rules.

43. Let a copy of this order be marked to the Registrar of Trade Marks, for due notice and appropriate action as he deems fit.

44. The appeal stands allowed in the aforesaid terms.

45. Miscellaneous applications do not survive for consideration and stand disposed of.

C.HARI SHANKAR, J

MAY 18, 2023

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