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

+ **C.A.(COMM.IPD-TM) 89/2022**

TICONA POLYMERS, INC.

..... Appellant

Through: Ms. Aamna Hasan, Mr.
Vaibhav Vutts and Mr. Devadathan
Jayachandran, Advs.

versus

REGISTRAR OF TRADE MARKS

..... Respondent

Through: Mr. Harish Vaidyanathan,
CGSC with Mr. Srish Kumar Mishra, Mr
Sagar Mehlawat, Mr. Alexander Mathai
Paikaday, Advs.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

JUDGMENT (ORAL)

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28.02.2023

1. This appeal, under Section 91 of the Trade Marks Act, 1999, assails order dated 26th October 2020 passed by the Senior Examiner in the office of the Registrar of Trade Marks, whereby Application No. 2847019, filed by the appellant for registration of the word mark "COOLPOLY", in (i) Class 1 in respect of plastic and carbon moulding materials for use in the manufacture of moulded plastic articles and (ii) Class 9 in respect of moulded heat sinks for use in computers and parts and components thereof and moulded electrical conductors, was rejected.

2. Application No. 2847019 was filed by the appellant on 19th November 2014. Consequent to a preliminary scrutiny, First Examination Report (FER) dated 13th January 2016 was issued by the

Registrar, objecting to the registration of the aforesaid mark COOLPOLY under Sections 9(1)(a)¹ and 11(1) (though not expressly quoted) of the Trade Marks Act. The objections in the FER read thus:

“1. The trade marks 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;

2. The Trade Mark application is open to objection on relative grounds of refusal under Section 11 of the Act because the same/similar trade mark(s) is/are already on record of the register for the same or similar goods/services. The detail of same/similar trade marks is enclosed herewith

Save as provided in Sec. 12, a trade mark shall not be registered if, because of-its identity with an earlier trade mark and similarity of goods or services covered by; the trade mark; or its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,”

3. Additionally, the FER required the appellant to file the duly stamped TM-48 which, Ms. Aamna Hasan submits, was filed.

4. Of the aforesaid two objections raised in the FER, the impugned order has dropped the objections predicated on Sections 11 and 12. The Senior Examiner proceeds, thereafter, to reject the appellant's application on the ground that

- (i) COOLPOLY was merely a combination of the two English words COOL and POLY,
- (ii) COOLPOLY, as a whole, was not inherently distinctive,
- (iii) the mark was, on the other hand, descriptive of the goods in respect of which its registration was sought, and

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;

shall not be registered.

(iv) as registration was sought on a “proposed to be used” basis, it had not acquired any secondary meaning.

(It is not clear from the impugned order, which is extremely clumsily written and worded, whether the Senior Examiner finds COOLPOLY as a whole to be descriptive or whether she finds COOL and POLY individually to be descriptive.)

5. The following passage from the impugned order contains what may be called the reasoning of the Senior Examiner:

“Adv. Aamna Hasan appeared and argued and submitted that. Goods have no reference to mark, and the mark is registered in various jurisdictions so consider as a distinctive. Thirdly sec. 11 is not applicable, heard, and checked the details of application, it appears that, total five opportunities of hearing given. As per details on record and submission made by advocate it appears that, the cited marks are visually, phonetically, and conceptually different, so obj. u/s 11 waived, moreover obj. u/s 9 is sustain because mark as a whole is not inherently distinctive, it is a mere combination of an English word "coolpoly" which is not distinctive and descriptive to applied goods of "[CLASS-1] Plastic and carbon molding materials for use in the manufacture of molded plastic articles.[CLASS-9] Molded heat sinks for use in computers and parts and components therefore and molded electrical conductors." .the mark is mere combination of word "cool" and "poly" hence it is not inherently distinctive, so no one can claim any exclusive right over the descriptive word, until and unless the mark has acquired distinctiveness by long and continuous commercial use and Mark is descriptive in nature and has direct reference to goods applied, it has describes quality and intended purpose, further more it is a proposed to be used mark, so not having user so no acquired secondary meaning. The adv. Also submitted that, the mark is registered in various jurisdiction so consider as distinctive, whereas trans-border reputation or goodwill is not recognized by the Hon. Supreme court in landmark judgment of PRIUS. Furthermore, it is a well settled law that, mere combination of two known word or abbreviation thereof would not be an invented word, even though the combination may not have been in use before, if to the eyes or ear the same idea would be conveyed as by the words in its ordinary form, as decided in the cases of "E.

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.

Griffiths Hughes Ltd. vs Vick Chemical Co. AND A.R. Khaleel And Sons vs Registrar of Trade Marks In India", so upon considering the material on record, and submission made by the advocate, the applicant and adv. is fail to prove the justification for waving off obj. raised under sec.9 (1)(a) trade Mark Act 1999."

6. Aggrieved, the appellant has appealed to this Court.

7. I have heard Ms. Aamna Hasan, learned Counsel for the appellant and Mr. Harish Vaidyanathan, learned Counsel for the respondent.

8. None of the considerations on which the Senior Examiner has rejected the appellant's application commend themselves to acceptance.

9. In the first place, the learned Senior Examiner was required to examine the entitlement to registration, of the COOLPOLY mark as a whole, and not by breaking it into COOL and POLY.

10. The Senior Examiner has, in rejecting the appellant's application for registration of the COOLPOLY mark, proceeded on the reasoning that COOLPOLY was a mere portmanteau of the words COOL and POLY, each of which was descriptive of the nature of the goods in respect of which registration of the mark was sought. As such, the Senior Examiner holds that the mark was not inherently distinctive as required by Section 9(1)(a) of the Trademarks Act.

11. It is well settled that a mark cannot be dissected into its individual parts while examining its entitlement to registration.

Though Section 17(1)² of the Trademarks Act statutory embodies this anti-dissection principle in the context of infringement proceedings, the principle would apply, *mutatis mutandis*, even at the stage when the mark is examined for its entitlement for registration as it is only the factum of registration which brings, in its wake, the privileges that follow, including protection against infringement.

12. Seen as a whole, it cannot be said that the word COOLPOLY has any etymological meaning or significance in the English language. It is not a word of common – or, for that manner, even uncommon – usage, as would render it incapable of distinguishing goods of one person from those of another if used as a trade mark. Indeed, the impugned order is silent as to why the mark is not distinctive. Rather, the Senior Examiner appears to have, clearly erroneously, conflated the concept of lack of distinctiveness, addressed by Section 9(1)(a), and descriptiveness, addressed by Section 9(1)(b), and confused the two.

13. Section 9(1)(a) would apply only where a mark was so common and so lacking in distinction as would make it impossible, on the basis of that mark, to distinguish between the goods of one person and goods of another. Common English words and phrases of everyday usage would fall within this category. Such common English words cannot be registered as marks, unless they enjoy the benefit of the

² 17. **Effect of registration of parts of a mark. –**

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark—

(a) contains any part –

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,

the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

proviso to Section 9(1), which would apply where the mark, before the date of registration, has acquired distinctiveness –in trade mark terminology, a “secondary meaning” – by dint of long or continuous use, or is a “well known trade mark” within the meaning of Section 2(1)(zg)³ of the Trade Marks Act.

14. The impugned order does not hold that COOLPOLY is a word of common English usage. Indeed, as already noted, COOLPOLY has no meaning. The impugned order does not cite any other mark of any other person, similar to “COOLPOLY” or provide any reason as to why the use of the mark “COOLPOLY” in respect of goods for which registration was sought by the appellant would make it impossible to distinguish between the said goods or any other goods available in the market.

15. Adverting, next, to the aspect of descriptiveness, COOLPOLY, being a word with no meaning, can obviously not be regarded as descriptive of the goods in respect of which registration was sought by the appellant. For that matter, it cannot be said that either of the parts of the mark “COOL” or “POLY”, even seen individually, is descriptive of the nature of the goods in respect of which registration was sought. Registration of the mark “COOLPOLY” was sought in respect of plastic and carbon moulding materials used in the manufacture of moulded plastic articles and moulded heat sinks for use in computers and parts and components thereof and moulded electrical conductors. The impugned order is silent as to how the words “COOL” and “POLY” even if seen individually, are descriptive

³ (zg) “well-known trade mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person during the mark in relation to the first-mentioned goods or services.

of the products in respect of which registration was sought or were wanting any distinctive character.

16. The basic prerequisites of Section 9(1)(a) do not appear to be addressed in the impugned order. In a sense, the impugned order is unreasoned, as it merely holds, as the mere *ipse dixit* of the Senior Examiner, that the expression “COOL” and “POLY” were descriptive of the products in respect of which registration was sought.

17. This Court is not inclined to agree with the said reasoning or conclusion. In the opinion of the Court,

- (i) COOLPOLY cannot, for examining distinctiveness, be vivisected into COOL and POLY,
- (ii) COOLPOLY is not a word of common English usage,
- (iii) COOLPOLY, if used as a mark by one person is, therefore, perfectly capable of distinguishing the goods or services of that person, in respect of which the mark is used, from the goods and services of others,
- (iv) the proscription against registration contained in Section 9(1)(a) would not, therefore, apply,
- (v) neither COOLPOLY, nor COOL and POLY individually seen, are descriptive of the goods in respect of which the appellant sought registration of the COOLPOLY mark and
- (vi) the proscription against registration contained in Section 9(1)(b) would also, therefore, not apply.

18. As such, the impugned order, which is unsustainable in law or on facts, is quashed and set aside.

19. As the application of the appellant has yet to be advertised, the application is remanded to the Registrar to advertise the mark and proceed thereafter in accordance with the provisions of the Trademarks Act and the Trademarks Rule.

20. The appeal stands allowed accordingly with no orders as to costs.

21. Ms. Hasan prays that a direction for a time bound decision may be passed. This Court is hesitant to do so as this Court is not aware of the amount of work which is pending before the Registrar. However, Mr. Vaidyanathan very fairly undertakes to ensure that there would be no delay in the matter.

22. Let this order be uploaded on the website of this Court within 24 hours.

C.HARI SHANKAR, J

FEBRUARY 28, 2023

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