



**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
COMMERCIAL MISCELLANEOUS PETITION (LODGING) NO. 31636 OF 2023**

Khadi and Village Industries Commission ... Petitioner
vs.
The Registrar of Trade Marks ... Respondent

Ms. Shwetasree Majumder a/w. Mr. Bimal Rajasekhar, Ms. Aishwarya Ambadekar and Ms. Vanshika Jain for petitioner.

Mr. Yashodeep Deshmukh for respondent.

CORAM : MANISH PITALE, J.

DATE : 29th JANUARY, 2025

P.C. :

. By this petition, the petitioner has challenged the order dated 17.08.2023 passed by the respondent i.e. the Registrar of Trade Marks, whereby the application filed by the petitioner for registration





of its device mark in Class 2, has been refused registration under Section 9(1)(b) of the Trade Marks Act, 1999.


2. The petitioner i.e. Khadi and Village Industries Commission is a statutory body established by an Act of Parliament and it is an apex organization under the Ministry of Micro, Small and Medium Enterprises, engaged in promotion of Khadi and village industries in rural areas. The petitioner has been using its name “KHADI” on various products for a long period of time and it has spent considerable amount towards advertisement and promotional activities associated with such products. The trade mark “KHADI” of the petitioner has been declared as a well-known trade mark by the Delhi High Court and it is also included in the list of well-known trade marks by the Trade Mark Registry in the year 2022.

3. On 17.12.2020, the petitioner announced the launch of its anti-fungal, anti-bacterial paints, the main component of which is cow dung, under the brand and trade mark “VEDIC PAINT”. These paints were developed and invented by an autonomous research and development body viz. Kumarappa National Handmade Paper Institute, that has also applied for patent titled “Paint Comprising Cow Dung”, which is pending registration.



4. It is the case of the petitioner that it re-branded the said

product as  on 12.01.2021 and that it was launched by the concerned Minister, which generated interest in the media and the public. The aforesaid products were said to have been placed on the official media pages of the petitioner with the brand name

 on social media such as Facebook, Instagram and X. On this basis, the petitioner claims that its aforesaid products under

the trade mark  gathered a lot of attention and viewership in a short span of time. It is further brought to the notice of this Court that the petitioner was granted registration on 11.02.2021 for its word mark “KHADI PRAKRITIK PAINT” in Class 2 in respect of paints, varnishes, distempers, emulsion paints, etc. The user was claimed since 12.01.2021.


5. It is in this backdrop that the petitioner filed an application on

 On 04.03.2021 in Class 2 for the subject mark i.e. . On 17.03.2021, the petitioner filed an affidavit of use, with user documents in support of the aforesaid application before the

Registrar. On 19.03.2021, the Registrar raised two objections in respect of the said application, one under Section 9(1)(b) of the aforesaid Act, stating that the mark consists exclusively of words which designate the kind and intended purpose of the goods or rendering of service or other characteristics. The other objection was under Section 11(1) of the aforesaid Act, on the basis that a similar mark in respect of identical/similar goods existed and conflicting

mark i.e.  being cited.

6. On 31.03.2021, the petitioner gave a detailed response to the examination report, requesting waiver of the objections and in support thereof, the petitioner placed reasons on record. Thereafter, show cause notice was issued to the petitioner and hearing was conducted. The petitioner, *inter alia*, relied upon an order passed by the Delhi High Court in the case of *Khadi and Village Industries Commission vs. M/s. JBMR Enterprises (order dated 04.06.2021 passed in a civil suit bearing No. CS(COMM) 284 of 2021)*, wherein injunction was granted in favour of the petitioner in the context of

the mark . The petitioner also relied upon an award dated 03.06.2022 passed by the World Intellectual Property Organization (WIPO), wherein the offending party was directed to transfer the mark in favour of the petitioner.

7. During the course of hearing, the petitioner relied upon various judgments passed in the context of device marks. But, by the impugned order dated 17.08.2023, the respondent refused registration under Section 9(1)(b) of the Trade Marks Act. The objection under Section 11(1)(a) of the aforesaid Act, initially raised in the examination report, was waived in the impugned order.

Therefore, the present petition concerns refusal of registration under Section 9(1)(b) of the aforesaid Act.

8. Ms. Majumder, the learned counsel appearing for the petitioner submitted that the impugned order deserves to be set aside and a direction deserves to be issued to the respondent to proceed for registration of the subject mark, for the reason that the grounds on which the respondent has refused registration, are wholly untenable. It was emphasized that the application of the petitioner pertains to a device mark, which necessarily has to be appreciated as a whole, without breaking it down into its constituents, which the respondent failed to appreciate, while passing the impugned order. It was submitted that registration of such device mark could not have been refused on the ground that the constituent parts of the mark i.e. the words contained therein, would not be independently registrable. According to the petitioner, the respondent fell in error in failing to look at the device mark as a whole, while applying Section 9(1)(b) of the aforesaid Act. In this regard, specific reliance was placed on the judgment of the Supreme Court in the case of *Registrar of Trade Marks vs. Ashok Chandra Rakhit Ltd.* (AIR 1955 SCC 558). It was submitted that the said position of law has been followed till date, wherein it is clarified that registration of device mark or a label mark gives exclusive statutory right to the proprietor of such mark as a whole and such a proprietor cannot claim exclusive right in respect of any particular word or name contained within such a mark. It was submitted that in the face of the said position of law, the impugned order passed by the Registrar, is wholly unsustainable.


9. The learned counsel for the petitioner further referred to Section 17 of the Trade Marks Act, to submit that the statutory

provision itself takes care of the situation and hence, the respondent could not have refused registration under Section 9(1)(b) of the aforesaid Act, in the facts and circumstances of the present case. It was further submitted that the respondent also wrongly ignored the aforesaid judgment of the Delhi High Court in the case of **Khadi and Village Industries Commission vs. M/s. JBMR Enterprises** (*supra*) as also the award dated 03.06.2022 passed by the WIPO, holding in favour of the petitioner.

10. The learned counsel appearing for the petitioner also relied upon the judgments of the Delhi High Court in the cases of *Abu Dhabi Global Market vs. Registrar of Trade Marks, Delhi* (2023 SCC OnLine Del 2947) and *Ishi Khosla vs. Anil Aggarwal and others* [2007 (34) PTC 370 (Del)]. Reliance was also placed on the order passed by the Madras High Court in the case of *Jawan Guarding Services Private Limited vs. Senior Examiner of Trade Marks* [order dated 11.09.2023 passed in (T)CMA(TM) Nos.159 & 179 of 2023].

11. It was further submitted that the respondent wrongly recorded that the petitioner had not filed affidavit of user, for the reason that such an affidavit was very much on record. It was submitted that the respondent could not have insisted upon invoices being filed by the petitioner because use of the subject mark would include its use in the public domain in the form of publicity, for which sufficient material was placed on record. It was submitted that this Court had specifically held that use of a mark can be gauged from the intention to adopt and to use the same. Reliance was placed on the judgment of this Court in the case of *Consolidated Foods Corporation vs. Brandon and Company Private Limited* (AIR 1965 Bom 35).

12. The learned counsel for the petitioner also relied upon the fact that registration had been granted to the petitioner, not only for its mark “KHADI PRAKRITIK PAINT” with effect from 11.02.2021, but it

was further granted for the device mark , which is also a device mark. In the face of such registrations granted by the very same authority, denial of registration of the subject mark is wholly unsustainable.

13. On the other hand, Mr. Deshmukh, the learned counsel appearing for the respondent-Registrar of Trade Marks defended the impugned order and he submitted that sufficient reasons have been recorded in the said order for refusing registration of the petitioner’s mark. It was submitted that the mark of the petitioner consists of the individual words “PRAKRITIK” and “paint” written in Devnagari with the words “भारत का पहला गाय के गोबर से विकसित पेंट”, also in Devnagari at the bottom of the mark. A head of a cow is depicted on the right top corner of the mark. It is submitted that the individual words ‘Prakritik’ meaning natural and “paint” are such that the petitioner cannot claim exclusivity in the same. It is further submitted that the aforementioned words written at the bottom of the mark, give details of the kind and origin of the goods, on which the mark is being applied. On this basis, it is submitted that Section 9(1)(b) of the aforesaid Act was correctly invoked by the Registrar to refuse registration of the petitioner’s mark.

14. It was submitted that as per Section 17 of the aforesaid Act, when the mark consists of several matters, registration of the same does not confer exclusive right in the proprietor, as regards any part thereof, which is not separately registered as a trade mark and which

contains any matter common to trade or is otherwise of a non-distinctive character. It was submitted that the words 'Prakritik' meaning natural and 'paint', are such that the petitioner would never be able to claim exclusive rights, thereby indicating that when the petitioner cannot claim exclusive rights in the individual parts of the mark, there is no question of granting registration for the mark as a whole. The judgments upon which the petitioner placed reliance were sought to be distinguished. It was submitted that the statutory provisions were clearly applied in the proper perspective by the respondent, while passing the impugned order.

15. This Court has considered the rival submissions. It is to be kept in mind that the subject mark in the present case, is a device mark consisting of various components. The settled position of law in this regard is that when a device mark comes up for registration and even when proprietary right is asserted upon registration in any proceeding before a Court, such a device mark has to be considered as a whole. This is further evident from the words used in Section 17 of the aforesaid Act, which pertains to registration of a trade mark consisting of several matters. It is specifically provided therein that when a trade mark consists of several matters, its registration confers on the proprietor exclusive right to use such a trade mark taken as a whole. The words "taken as a whole" in the aforesaid provision assume great significance. It is further elaborated in the aforesaid provision that the registration of such a trade mark does not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered. Thus, there is a statutory mechanism in Section 17 of the aforesaid Act itself which answers the contention raised on behalf of the Registrar. The enquiry into the question as to whether individual parts of such a device mark or trade mark

consisting of several matters, can be registrable, itself is misplaced. By registration being conferred on such a device mark or trade mark consisting of several matters, as per sub-section (2) of Section 17 of the aforesaid Act itself, the person holding such registration cannot claim any exclusive right in the matter forming only a part of the whole of the trade mark. This is abundantly clear from the observations of the Supreme Court in the case of **Registrar of Trade Marks vs. Ashok Chandra Rakhit Ltd.** (*supra*). In the said case, the Supreme Court was considering a label mark, being a trade mark consisting of several matters. In the said judgment, it was held as follows:

“14. It is true that where a distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole. As said by Lord Esher in - 'Pinto v. Badman', 1891-8 RPC 181 at p. 191 (J):

"The truth is that the label does not consist of each particular part of it, but consists of the combination of them all".

Observations to the same effect will be found also in - 'In re Apollinaris Company's Trade Marks', 1891-2 Ch 186 (K), - In re Smokeless- Powder Co. (F) (*supra*), - 'In re Clement and Cie Trade Mark', 1900-1 Ch 114 (L) and -'In re Albert Baker and Company (B) (*supra*) and finally in the Tudor case (H), referred to above which was decided by Sargant, J. This circumstance, however, does not necessarily mean that in such a case disclaimer will always be unnecessary. It is significant that one of the facts which give rise to the jurisdiction of the tribunal to impose disclaimer is that the trade mark contains parts which are not separately registered. It is, therefore, clear that the section itself contemplates that there may be a disclaimer in respect of parts contained in trade mark registered as a whole

although the registration of the mark as a whole does not confer any statutory right with respect to that part.”

16. As regards the contention raised on behalf of the Registrar that the words at the bottom of the subject mark indicate the kind and origin of the goods, this Court finds that the said contention is based on an erroneous application of Section 9(1)(b) of the aforesaid Act to a device mark or a composite mark i.e. a mark which consists of several matters. In the case of **Abu Dhabi Global Market vs. Registrar of Trade Marks, Delhi** (*supra*), the Delhi High Court considered the applicability of Section 9(1)(b) in such cases. In the said case, the subject mark consisted of a logo and the words “Abu Dhabi Global Market” written at the bottom thereof. The relevant portion of the said judgment reads as follows:

“29. Section 9(1)(b) of the Trademarks Act, in its clear and explicit terms, proscribes registration only of trademarks “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, trademarks, 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 consists of marks of indications which serve, in trade, to designate the geographical origin of the goods or services in respect of which the mark is registered.”

17. In the present case, this Court is unable to understand how an argument on origin is made on behalf of the Registrar because the words written at the bottom of the subject mark do not indicate any geographical origin, as contemplated under Section 9(1)(b) of the

aforesaid Act. In any case, this Court agrees that the above-quoted reasoning in the Delhi High Court judgment, wherein it is recorded that such composite marks stand excluded from the scope of Section 9(1)(b) of the aforesaid Act. Thus, the very basis of the objection raised on behalf of the Registrar, is taken away.

18. It is relevant to note that in the very same judgment of the Delhi High Court, in the case of **Abu Dhabi Global Market vs. Registrar of Trade Marks, Delhi** (*supra*), it was further elucidated that “dominant part” principle is also alien to Section 9(1)(b) of the aforesaid Act because in the proceedings before the Registrar, the question of infringement, as it arises in a suit before the Court, does not arise. It is only when a party knocks the door of the Court in an infringement suit, that the question of similarity between the dominant parts of such rival composite or device marks, would arise. This Court agrees with the said observation made in the judgment of the Delhi High Court. If the entire mark, being a device mark or a composite mark or a trade mark consisting of several matters, in its entirety and as a whole falls within any of the categories contemplated under Section 9(1)(b) of the aforesaid Act, the Registrar may refuse registration. But, in the present case, the Registrar has not refused registration on the said basis and instead, refusal is sought to be justified on the ground that individual parts or matters of the subject device mark are not registrable. The approach of the Registrar is in the teeth of the provisions of the aforesaid Act and the position of law laid down in that regard.

19. There is substance in the contention raised on behalf of the petitioner with regard to the question of user of the mark. In the first place, the observation made in the impugned order that affidavit of


user was not filed by the petitioner, is factually incorrect. The learned counsel for the Registrar sought to indicate that the observation was made in the context of the failure on the part of the petitioner to file such an affidavit alongwith the invoices or sales bills. This Court finds that there was sufficient material placed on record by the petitioner before the Registrar to show that the petitioner was openly using the subject device mark in the context of its goods in the public domain. Documents were placed on record to show as to the manner in which wide publicity was given to the use of such device mark, particularly because the petitioner intended to promote the same. These documents were completely ignored by the Registrar, while passing the impugned order. Reliance placed on the judgment of this Court in the case of **Consolidated Foods Corporation vs. Brandon and Company Private Limited** (*supra*) is justified because it is laid down therein that a single actual use with an intent to continue such use, confers the right on such mark as a trade mark. The Delhi High Court in the case of **Ishi Khosla vs. Anil Aggarwal and others** (*supra*) has also held that a new idea can be fascinating and it can become a hit overnight and further that it is not necessary to show that the trade mark has been used for a considerable length of time. Even a single actual use with an intent to continue such use, is enough. This Court is of the opinion that applying the said position of law to the facts of the present case, particularly in the light of the documents placed by the petitioner before the Registrar, the said authority could not have drawn an adverse inference against the petitioner, while refusing registration of the subject mark.

20. There is also no reference to the order passed by the Delhi High Court in favour of the petitioner in the case of **Khadi and Village Industries Commission vs. M/s. JBMR Enterprises** (*supra*). It

is relevant to note that in the body of the order, a specific reference was made to the subject device mark also. This could not have been ignored by the Registrar, while passing the impugned order. The award passed by WIPO in favour of the petitioner, was also completely ignored, demonstrating that the Registrar did not consider the entire material available before it, while passing the impugned order.

21. The effect of registration of the trade mark “KHADI PRAKRITIK PAINT” in favour of the petitioner was also ignored. It is to be noted that the very Registry has granted registration to the petitioner for its

device mark . The components of the said device mark are the words “PRAKRITIK PAINT” with the image of the head of a cow and the aforementioned words “KHADI INDIA” written at the top. Having granted registration to the said device mark of the petitioner i.e. , it was not appropriate for the Registrar

to refuse registration for the subject device mark i.e. .

22. In view of the above, the petition is allowed in terms of prayer clause (a). Consequently, the impugned order is set aside and it is directed that the application of the petitioner for registration of the subject device mark shall now be allowed to proceed for registration. The Registrar shall take further steps in terms of provisions of the aforesaid Act, including advertisement etc.

23. The petition stands disposed of.

24. Pending applications, if any, also stand disposed of.

(MANISH PITALE, J)