

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 24.08.2017

Pronounced on : 06.09.2017

Coram

THE HONOURABLE Mr. JUSTICE M.VENUGOPAL
AND
THE HONOURABLE Mr. JUSTICE P.D.AUDIKEVALU

W.P.No.11884 of 2012 and
M.P.No.1 of 2012

Wealth Advisors (India) Pvt. Ltd.,
Lemuir House, Ground Floor,
10, G.N.Chetty Road,
T.Nagar, Chennai – 600 017.

.. Petitioner

Vs.

1.Citibank, N.A./Citigroup Inc.,
399, Park Avenue,
New York 10043,
United States of America.

2.The Intellectual Property Appellate Board,
Annex I, 2nd Floor,
Guna Complex, 443, Anna Salai,
Teynampet, Chennai – 600 018.

3.The Registrar of Trade Marks,
Trade Marks Registry,
Intellectual Property Office Building,
G.S.T. Road, Guindy,
Chennai – 600 032.

..Respondents

Prayer: Writ Petition filed under Article 226 of the Constitution of India praying for issuance of Writ of Certiorarified Mandamus,

calling for the records pertaining to the order of the 2nd respondent dated 09.03.2012 made in ORA.7/2010/TM/CH and to quash the same and to direct the 3rd respondent not to cancel/re-enter trademark registration No.1317858 in Class 36 for the trademark/label WAI WEALTHADVISORS from/in the Register of Trade Marks.

For Petitioner : M/s.S.Suba Shiny

for M/s.Brinda Mohan

For RR 1 : Mr.Rajesh Ramanathan

For RR 2 & 3 : M/s.D.Simon, CGSC

ORDER

M.VENUGOPAL, J.

The Petitioner has preferred the instant Writ Petition praying for passing of an order by this Court in calling for the records relating to the order of the 2nd Respondent/Appellate Board dated 09.03.2012 in ORA/7/2010/TM/CH and to quash the same. Further, the Petitioner has also sought for passing of an order by this Court in directing the 3rd Respondent/Registrar of Trade Marks not to cancel/Re-enter Trade Mark Registration No.1317858 in Class 36 for the trade mark/label WAI WEALTHADVISORS from/in the Register of Trade Marks.

Summation of Facts:

2. According to the Petitioner, it is an Independent Investment Advisory Firm promoted by JV Gokal Group [a leading export house in India] founded in the year 1952, with an annual turnover of Rs.1000 Crores and net worth of Rs.300 Crores. As a matter of fact, the Petitioner is promoted by a team of professionals with more than two decades of experience in the Financial Services Industry. Moreover, the Petitioner's products and service lines include (i) Mutual Funds, (ii) Insurance, (iii) Equity, (iv) Fixed Income, (v) Investment Tax Advisory, and (vi) Will & Trust services.

3. The stand of the Petitioner is that it had honestly adopted the mark "WEALTHADVISORS" and "Logo" for its financial services in May 2004 and had continuously, widely and extensively used the mark in respect of the said services and had earned extensive reputation and goodwill among the trade and public. That apart, it had extensively and widely advertised the products and services under the mark "WEALTHADVISORS" and "Logo" throughout India on print and electronic media. The said Petitioner's mark and Logo has become distinctive and capable of differentiating the services rendered by it.

4.It is the plea of the Petitioner that the 1st Respondent had filed a Rectification Petition in the year 2009 before the 2nd Respondent for removal of the Petitioner's registered mark as "WEALTHADVISORS" (Logo) bearing No.1317858 in Class 36 and in fact, the said petition was filed only to harass it. Also, it is the stand of the Petitioner that there was no proper explanation on the part of the 1st Respondent in not taking timely action to file any opposition when the stage was set open for the very same purpose.

5.Moreover, it is projected on the side of the Petitioner that the 1st Respondent was well aware of the Petitioner's trade mark and its widespread use of the same and only in a deliberate manner, the 1st Respondent had filed the Rectification Application after the Petitioner had built a good and profitable business over the years.

Petitioner's Contentions:

6.The Learned Counsel for the Petitioner takes a plea that the Petitioner is a prior and a *bona fide* user of the registered trade mark, using it from the year 2004 for its services. Further, the 1st

Respondent had adopted the mark 'CITI WEALTH ADVISORS' as a subsequent user which was admitted by the 1st Respondent in its pleadings before the 2nd Respondent/Intellectual Property Appellate Board to the effect that 'CITI WEALTH ADVISORS (CWA) had recently launched its 'Business' in India.

7.The Learned Counsel for the Petitioner projects an argument that the Petitioner is using the registered trade mark 'WEALTHADVISORS' for over eight years and as such, the mark had acquired distinctiveness and secondary meaning among the trade and public.

8.The Learned Counsel for the Petitioner strenuously contends that the Petitioner has not received a certificate of registration for trademark 'WEALTHADVISORS' under No.1317858 in Class 36 and in the instant case, there was no contravention or failure to observe any condition entered on the Register. In reality, it is represented on behalf of the Petitioner that Section 57(2) of the Trade Marks Act, 1999 can be pressed into service by an aggrieved person on the ground of absence or omission from the Register of any entry or by any entry in the 'Register' without sufficient cause or by an entry

wrongly remaining in the 'Register' or by any error or defect in any entry in the Register.

9.The Learned Counsel for the Petitioner emphatically submits that the Petitioner's mark applied for under No.1317858 in Class 36 is for WAI Logo with WEALTHADVISORS label as a whole and not 'WEALTHADVISORS' *per se*. Moreover, the 1st Respondent/Bank is not the registered Proprietor of the service mark 'CITI WEALTH ADVISORS'.

10.The Learned Counsel for the Petitioner draws the attention of this Court that the Petitioner had filed its 'Income Tax Returns' showing the 'Business Turn Over' carried on under the mark 'WEALTHADVISORS' since the year 2004 and also it had filed the turnover figures. Besides this, the Learned Counsel for the Petitioner points out that the 2nd Respondent/Appellate Board considered the use of mark 'WEALTHADVISORS' by the Petitioner only for a period of five months prior to the date of filing of Application No.1317858 in Class 36.

11.The Learned Counsel for the Petitioner submits that the ingredients of Section 9 of the Trade Marks Act, 1999 cannot be pressed into service in a 'Rectification Petition' and in fact, Section 9 of the Act can only be invoked in an opposition proceedings filed before the 3rd Respondent/Registrar of Trade Marks. Added further, in the present case, the 1st Respondent had not filed any opposition proceedings against the Petitioner's Application No.1317858 in Class 36.

12.In this connection, to lend support to the said contention, the Learned Counsel for the Petitioner relies on the decision of this Court in ***Rhizome Distilleries Pvt. Ltd., V. Union of India and others reported in 2012-2-L.W.-204 at special page 215***, wherein at paragraph 23, it is, inter alia, observed as under:

"23. Further, in our considered opinion, the grounds embodied under Sections 9 and 11 are available to the persons only at the time when they raise objection for registering the trademark. The said principles cannot be applied for rectification of the registration, particularly considering the factum

that the Liquor India Private Limited has withdrawn their objections before the Commissioner on 14.03.2016 and allowed the petitioner to carry on the business under the name of RHIZOME IMPERIAL GOLD."

13.The Learned Counsel for the Petitioner points out that the 2nd Respondent/Appellate Board came to the conclusion that the Petitioner's mark 'WEALTHADVISORS' is not distinctive under Section 9 of the Trade Marks Act, 1999.

14.The Learned Counsel for the Petitioner submits that the 2nd Respondent had not considered the ingredients of Section 32 under the caption '*Protection of Registration of ground of distinctive in certain cases*'. Also that, it is the plea of the Petitioner that the words 'WEALTHADVISORS' are suggestive and in any event, 'WEALTHADVISORS' is not directly distinctive of the services rendered by the Petitioner.

15.The Learned Counsel for the Petitioner contends that in Law, the mark should identify the source and distinguished the

same from others and to avoid distribution and confusion in the minds of Trade and Public.

16.The core contention advanced on behalf of the Petitioner is that in the absence of any petition being filed by the 1st Respondent as an 'Aggrieved Person', the 2nd Respondent has no power to allow the Rectification Petition as per Section 57(2) of the Act.

17.The Learned Counsel for the Petitioner contends that the Petitioner's registered mark 'WEALTHADVISORS' with effect from 28.04.2004 is *prima facie* a valid mark within the meaning of Section 31 of the Act and that the registration is valid [including under Section 57 of the Act] and therefore, the impugned order passed by the 2nd Respondent/Appellate Board dated 09.03.2012 is contrary to Law.

18.The Learned Counsel for the Petitioner submits that the Petitioner had generated high income and had filed Huge Returns and that the 2nd Respondent/Appellate Board had committed an error in holding that the same were irrelevant. Per contra, it is the stand of the Petitioner that the 2nd Respondent/Appellate Board

should have held that by virtue of the high income and huge returns filed, the Petitioner had established the distinctiveness of its mark 'WEALTHADVISORS'.

19. The Learned Counsel for the Petitioner takes a plea that the 2nd Respondent had failed to consider that the mark 'WEALTHADVISORS' can, by no stretch of imagination, be called as a distinctive word. Moreover, the mark has to be considered as a whole and that the impugned mark is a 'Label Mark' and not 'WEALTHADVISORS' *per se*.

20. The Learned Counsel for the Petitioner submits that by the continuous use, the mark 'WEALTHADVISORS' and the Logo WAI with the distinctive, unique colour scheme had attained distinctiveness as the trading public associate the mark and the logo with colour scheme only with the services rendered by the Petitioner alone and none else.

21. It is the submission of the Learned Counsel for the Petitioner that the principle in regard to 'Prior User' and 'Actual and bona fide use of a mark' were not appreciated by the 2nd Respondent/Appellate Board in a proper and real perspective.

22.The Learned Counsel for the Petitioner submits that the Petitioner's Company's name was changed from 'WEALTHADVISORS (INDIA) PVT. LTD.' to that of 'WEALTHADVISORS (INDIA) PRIVATE LIMITED' and to that effect, a fresh certificate of incorporation (pursuant to change of name) was issued by the Assistant Registrar of Companies, Tamil Nadu, Chennai on 14.06.2004. Furthermore, it is represented on behalf of the Petitioner that the words 'WEALTHADVISORS (INDIA) PVT. LTD.' are not word *per se* and it is a composite mark.

23.The Learned Counsel for the Petitioner refers to Section 17 of the Trade Marks Act, 1999 which speaks of 'Effect of Registration of Parts of a Mark'. The Learned Counsel for the Petitioner takes a stand that the Company's use the WEALTHADVISORS and the Logo WAI had attained distinctiveness. That apart, WAI had attained distinctiveness and that Petitioner is using from the year 2004. Moreover, it is the plea of the Petitioner that the Petitioner is the first person to use the 'WEALTHADVISORS' and the 'Logo WAI' and in fact, nobody uses the word 'WEALTHADVISORS' and the 1st Respondent had filed a Rectification Petition before the authority and the 1st Respondent/Bank gives solution on Bank Management.

24.The Learned Counsel for the Petitioner refers to the application for removal of trade mark 'WEALTHADVISORS' Logo bearing No.1317858 in Class 36 in the name of 'WEALTHADVISORS (INDIA) PVT. LTD.' from the Register or Rectification of Register under Section 57 of the Trade Marks Act, 1999 filed by the 1st Respondent before the 2nd Respondent/Appellate Board. In this connection, the Learned Counsel for the Petitioner refers to Section 9 of the Trade Marks Act are deals with 'Absolute grounds for refusal of Registration'.

25.The Learned Counsel for the Petitioner contends that even if the mark 'WEALTHADVISORS' with WAI Logo is descriptive, still the said mark in Law shall not be invalid. Also, the Learned Counsel for the Petitioner points out that the 2nd Respondent/Appellate Board has completely lost sight of the ingredients of Section 32 of the Trade Marks Act, 1999.

26.The Learned Counsel for the Petitioner submits that the 2nd Respondent/Appellate Board had considered only five months use of the mark in question and it had not considered the subsequent use by the Petitioner.

27.Finally, the Learned Counsel for the Petitioner strenuously points out that under Section 31(2) of the Trade Marks Act, 1999, Section 9 of the Act can be pressed into service only if the Petitioner can prove that it had used the mark prior to the date of registration of an impugned mark. Further, the 1st Respondent/Bank had not filed any document before 28th October 2004 to the effect that they had used the mark 'CITI WEALTH ADVISORS' or 'WEALTHADVISORS' *per se* anywhere in India. Therefore, it is the plea of the Petitioner that the ingredients of Section 9 of the Act cannot be invoked by the 1st Respondent/Bank.

28.Petitioner's Decisions:

(i) The Learned Counsel for the Petitioner cites the decision in ***Sunil Mittal and others V. Darzi on Call reported in MANU/DE/1028/2017***, wherein at paragraph 37, it is observed as under:

"37.The plaintiffs thus have made out a prima facie case. The balance of convenience also is in favour of the plaintiffs and against the defendant in as much as use by the plaintiffs of the trademark according to the defendant also is for at least 20 years prior to

that by the defendant. The defendant already since the last about six months has been using a different trademark and I am of the view that the prejudice from the interim injunction to the defendant will be negligible in comparison to that to the plaintiffs from non- grant thereof. Needless to state that a prima facie case having been found in favour of the plaintiffs, the plaintiffs will suffer irreparable injury from continued use by the defendant of the mark. A customer of a tailor, once lost, is unlikely to come back."

(ii) The Learned Counsel for the Petitioner refers to the decision in ***Ishi Khosla V. Anil Aggarwal and another reported in 2007 (34) PTC 370 (Del.)*** wherein at paragraph 26 & 27, it is held as follows:

"26. In view of the aforesaid discussion, I do not accept the contention of the defendants that the ingredients of passing off action are not established in the instant case. The

plaintiff has been able to show, prima facie, prior use, distinctiveness as well as reputation which the plaintiff's trademark 'Whole Foods' has acquired. Judgment of the Supreme Court in the case of American Home Products Corporation v. Mac Laboratories Pvt. Ltd. would, therefore, be of no assistance to the defendants wherein the Court held that before grant of injunction aforesaid requisites are to be established. Learned Counsel for the defendants had also cited the judgment in the case of Jabbar Ahmed v. Prince Industries and Anr. 2003 (26) PTC 576 (Del) and made the submission that as in the absence of any advertisement of the product it could not be said that the plaintiff was using the said product or had acquired distinctiveness. In that case the plaintiff had filed certain assessment orders on the basis of which it had claimed use of trademark 'BELL' during the said period. The Court observed that there was nothing in

these assessment orders which can even remotely indicate that the plaintiff had been manufacturing scissors/nail clippers under the said trademark. However, in the instant case the plaintiff has produced sufficient material which would show user of trade name 'Whole Foods' in respect of her goods.

*27. Many judgments including the case of **Vijay Kumar Ahuja v. Lalita Ahuja** 2002 (24) PTC 141 (Del) were cited by learned Counsel for the defendants in support of the plea that when the Trademark is an English language word nobody can claim proprietary rights over the same unless there is acquired secondary signification. There is no quarrel about the proposition of law. However, my discussion above shows that the plaintiff has been able to, prima facie, show that 'Whole Food' is associated with her products in the instant case. In the facts of this case, therefore, the judgment of Supreme Court in the case of **Kaviraj Pandit Durga Dutt Sharma v.***

Navaratna Pharmaceutical Laboratories and the case of Johnson and Johnson and Anr. v. Christine Hoden India (P) Ltd. and Anr. 1988 PTC 39 cited by the defendants would have no application."

(iii) The Learned Counsel for the Petitioner seeks in aid of the decision of the Hon'ble Supreme Court in ***Satyam Infoway Ltd., V. Siffynet Solutions (P) Ltd. Reported in (2004) 6 Supreme Court Cases 145 & 146***, it is held as follows:

"A trademark is protected by the laws of a country where such trademark may be registered. Consequently, a trade mark may have multiple registration in many countries throughout the world. On the other hand, since the internet allows for access without any geographical limitation, a domain name is potentially accessible irrespective of the geographical location of the consumers. The outcome of this potential for universal connectivity is not only that a domain name would

require world wide exclusivity but also that national laws might be inadequate to effectively protect a domain name."

(iv) Also, in the aforesaid decision at page 147, it is observed and held as under:

"The doubtful explanation given by the respondent for the choice of the word "Sify" coupled with the reputation of the appellant can rationally lead us to the conclusion that the respondent was seeking to cash in on the appellant's reputation as a provider of service on the internet. In view of our findings albeit prima facie on the dishonest adoption of the appellant's tradename by the respondent, the investments made by the appellant in connection with the trade name, and the public association of the tradename Sify with the appellant, the appellant is entitled to the relief it claims. "

(v) The Learned Counsel for the Petitioner refers to the decision of the Hon'ble Supreme Court of India, in ***Godfrey Philips***

India Ltd. V. Girnar Food & Beverages (P) Ltd. reported in **2005 (30) PTC 1 (SC)**, wherein at paragraph 4, it is, *inter alia*, observed as follows:

"4. Without going into the question whether the conclusion arrived at by the Division Bench that the trade mark is descriptive is correct or not, it appears to us, and as is conceded by both parties before us, that the enunciation of the principle in law with regard to the protection available even in respect of the descriptive trade mark was wrong. A descriptive trade mark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source."

(vi) The Learned Counsel for the Petitioner cites the decision of **House of Lords [between Reddaway V. Banham]** in **'Reports of Patent, Design' of Trade Mark Cases [Vol. XIII, No. 15]** at page 218 at special page 219, wherein it is held as follows:

"... that when words which are descriptive of an article have come to denote the goods of a particular manufacturer, he is entitled to restrain others from using them so as to deceive purchasers, notwithstanding that the words are a description of the goods: that the findings of the jury were warranted by the evidence; that the Plaintiff's were entitled to an injunction in the form granted by the Judge; and that the Orders of the Court of Appeal should be reversed."

Pleas of the 1st Respondent:

29. Conversely, it is the submission of the Learned Counsel for the 1st Respondent that the Petitioner cannot claim 'Exclusivity' in respect of the commonly used term 'WEALTHADVISORS' for financial services. That apart, it is the stand of the 1st Respondent that no one party should be allowed to claim exclusivity over the mark in question and added further, the mark 'WEALTH ADVISORS' is commonly used in the trade by financial institutions to describe the wealth advisory services provided by them.

30.The Learned Counsel for the 1st Respondent contends that permitting the Petitioner's Registration for 'WEALTHADVISORS' and Logo bearing No.1317858 in Class 36 to subsist on the Register of Trade Marks, shall deprive all wealth management or banking consultancies from using WEALTH ADVISORS under the fear of an infringement action by the Petitioner.

31.The Learned Counsel for the 1st Respondent submits that the Petitioner had admitted that from the year 2004, it has made bona fide use of the mark 'WEALTH ADVISORS' and Logo and hence, it had acquired no distinctiveness on the date of application. Besides this, it is the stand of the 1st Respondent that a descriptive mark like 'WEALTH ADVISORS' could not possibly have acquired distinctiveness so as to differentiate and identify the Petitioner's services within the short span of a few months or with any extent of use as the case may be.

32.The Learned Counsel for the 1st Respondent contends that the words 'WEALTH ADVISORS' have become *public juris* and that no one party should be given 'Exclusivity' in such a mark.

33.The Learned Counsel for the 1st Respondent submits that the words 'WEALTH' and 'ADVISORS' are commonly used dictionary words and the combination of the said words connotes the services provided by the Petitioner and therefore, the said registration of the mark was rightly held by the 2nd Respondent/Appellate Board to be quite contrary to the provisions of Section 9 of the Trade Marks Act, 1999.

34.The Learned Counsel for the 1st Respondent submits that the 2nd Respondent/Appellate Board had rendered a finding that notwithstanding the evidence of user furnished by the Petitioner in as much as the mark WEALTH ADVISORS and Logo is purely descriptive, any amount of use could not turn the said words into a trade mark.

35.The Learned Counsel for the 1st Respondent brings it to the notice of this Court that the 1st Respondent has not claiming monopoly in respect of 'WEALTHADVISORS'. Furthermore, it is represented on behalf of the 1st Respondent that the Law provides for cancellation of a registration, because of the reason that the

grant of a registration certificate is only a *prima facie* evidence of its validity.

36.The Learned Counsel for the 1st Respondent takes a plea that just because the Petitioner had adopted two different dictionary words in *juxtaposition*, it cannot be said that the same amounts to a coined one.

37.The Learned Counsel for the 1st Respondent submits that there is no requirement before conducting a search to show that the applicant of the search intends to apply or register the mark. Also that, the 1st Respondent denies that a Form-TM-54 is only filed when an answering Respondent intends to file an application with regard to the mark for which a search is made with a view to find out whether the said mark is registrable or already registered by a third party.

38.The Learned Counsel for the 1st Respondent contends that the 1st Respondent/Bank is using the words 'CITI WEALTH ADVISORS' and further, in respect of the words 'WEALTHADVISORS', no one can claim monopoly for use of the

same.

39.The Learned Counsel for the 1st Respondent refers to Section 28 of the Trade Marks Act which deal with 'Rights conferred by Registration'. Also, a reference is made on behalf of the 1st Respondent to Section 29 of the Trade Marks Act, 1999 which speaks of 'Infringement of registered Trade Marks'. As a matter of fact, the Learned Counsel for the 1st Respondent adverts to the ingredients of Section 29(9) of the Act, 1999 which enjoins that ***"Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly."***

40.The Learned Counsel for the 1st Respondent refers to Section 32 of the Trade Marks Act, 1999 which enjoins that 'Protection of Registration on the ground of distinctiveness in certain cases'. That apart, the Learned Counsel for the 1st Respondent also refers to Section 47 of the Act which deals with 'Removal from

register and imposition of limitations on the grounds of non-use'.

41.An Appraisal:

41.1. It is to be noted that a 'Trader' acquires a right of property, in distinctive mark as per Section 2(1)(m) of the Trade Marks Act, 1999 merely by using it upon or in relation to his goods, irrespective of the length of such user and the extent of his Trade.

41.2. It is to be pointed out that Section 2(1)(Zb) of the Trade Marks Act, 1999 defines 'Trade Mark'. As a matter of fact, the inherent requirement of 'Trade Mark' is that it ought to be descriptive so as to point out a nexus between 'Goods' and 'Mark Only'. In reality, if a mark is not a unique one and does not show any connection with the concerned person/party, then, it is not a brand name. Also that, the registration of a Trade Mark as per Section 2(1)(w) of the Act does not affect the Common Law rights.

41.3. Indeed, in the area of 'Trade Marks', registration of a Trade Mark within the meaning of Section 23 of the Trade Marks Act, 1999 only recognise the rights which are in existence in

Common Law and does not create any rights. A Plaintiff is to establish that a product represented by him/it had earned a reputation in the market and that the reputation was sought to be breached by the other side before appropriation of use, of a particular mark within the meaning of proviso of Section 2(1)(m) of the Act 1999.

41.4. To put it precisely, the function of a Trade Mark is to give an indication as regards the source of the goods. In this connection, this Court aptly points out the observations made in **Re Powell's Trade Mark [1893] 10 RPC at 200** which runs as under:

"The Function of a Trade Mark is to give an indication to the purchaser or possible purchaser, as to the manufacture or quality of the goods, to give an indication to his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market. It tells the person who is about to buy, or considering whether he shall buy, that what is presented to

him is either what he has known before under similar name as coming from a source with which he is acquainted or that it is what he has heard of before as coming from that similar source."

41.5. It cannot be forgotten that a distinctive Trade Mark is entitled to protection if it had assumed a secondary meaning with a certain product or with being a particular source. It is to be borne in mind that a Trade Mark's distinctiveness is to be gauged with reference to (i) the goods are services in regard to which the registration is applied for; (ii) the participation of the consumers of the goods are services of that category.

41.6. Really speaking, the representation of a trade mark for Goods or Services must be in a manner that can be put on the register. The essence of a trade mark is that it must be of distinctive character which points out that the goods of a particular person. Indeed, the Trade Mark signals to the mind, the identity or the source of the manufacturer/producer of a certain product. The aim of protection of 'Fair Trade' is meant to enable a trader who

had established that the mark, devise are the like really points out his 'Goods' only, to register his title and to prevent the necessity of establishing it against the opposite party.

41.7. At this stage, it is not out of place for this Court to make a significant mention that even a prior user of the name by the Plaintiff in the name of institute viz., 'Skyline Education Institute (Pvt) Limited' would not confer upon it an exclusive right to use the name to the exclusion of others and the pendency of applications for registration of name under Section 18 of the Act, 1999 is inconsequential, as per decision ***Skyline Education Institute (Pvt.) Ltd., Vs. S.L.Vaswani and another, AIR 2010 Supreme Court 3221.***

41.8. Furthermore, in the aforesaid decision, at special page 3224, at paragraph 8, the Hon'ble Supreme Court had, among other things, observed as under:

".... While rejecting the argument that use of the word 'Skyline' by the respondents for the Institute of Engineering and Technology established by them will create confusion in the mind of the general

public and the prospective students who want to pursue their studies in the field of engineering and technology, the learned Single Judge observed:

"In the opinion of this Court, merely by the use of the word "Skyline" as a prefix in the name of the two institutions, there is no likelihood of such a confusion because the full name of the plaintiff institute is "Skyline Education Institute (India) Pvt. Ltd." while that of the defendant is "Skyline Institute of Engineering and Technology" used in defendant's name are sufficient to indicate to all concerned that the defendant is not the same institute as the plaintiff. In any case, care can be taken to clarify such a confusion, even if there is any likelihood of such a confusion."

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41.9. There is no two opinion of a vital fact that there is no exclusive ownership of the symbols which constitute a trade mark besides the use or application of them. However, the term 'Trade Mark' is a designation of these marks or symbols as and when

applied to a particular product/vendible commodity and the exclusive right to make such utilization or application is described as 'property'.

41.10. It is to be mentioned that the 'Trade Mark' concerns the goods themselves, whereas a 'Property Mark' relates to the Proprietor. Indeed, the property mark denotes the ownership in it. However, a 'Property Mark' under Section 479 of the Indian Penal Code means a mark for pointing out that a movable property belongs to a certain person. A property mark attached to the movable property of a *Homo-Sapien* remains even if part of such property passes out of his hands and ceases to be his.

41.11. In fact, there can be no right of Exclusive Ownership of any symbols or marks universally abstract, as per decision **Hall V. Barrows 4 De G J & S 150, Page 158 [LORD WESTBURY]**. Also, it has never been the Law that the mark must be universally recognised as 'Distinctive'. What is to be seen in the teeth of the words of the Act is that the word or mark must 'Distinguish the goods or services of one undertaking from that of other undertakings' with a view to 'guarantee the trade mark as an indication of origin'.

41.12. It is to be remembered that for registrability of a 'Trade Mark', the same ought to be capable of being represented graphically and, also capable of distinguishing the goods or services of one individual from that of others. Suffice it for this Court to point out that the trade mark to be registered mark used or proposed to be used with reference to the goods or services for the purpose of indicating or to so as communication as connection in the course of trade between the goods or services and some person have in the right to use the mark with or without the identity of that person. If a person chooses the trade under a name, which is highly non-specific, which consists of simple words in common use in the general language of the people, then, he is to reap the consequences as per decision **Randall Limited V. Bradley & Son, (1907) 24 RPC 773 (CA)**.

41.13. It is to be noted that under Section 9(1)(a) of the Trade Marks Act, 1999, a trade mark, which is not capable of distinguishing the goods or services of one individual and that of another person, cannot be registered. In fact, Section 9(1) of the Act would enable the marks to be accepted, if prior to the date of

application/petition, it is exhibited to have acquired a distinctive character as a result of the use made of it or it is a well known mark. Generally, by establishing the acquisition of distinctiveness over a longer period of use and also by restricting the specification of goods or services, the objection specified in the proviso to Section 9 can be got over. Also, the relevant yardstick for trade mark protection is whether what is claim as a trade mark really identifies and distinguishes the claimants Goods/Products from that of others.

41.14. Coming with the ingredients of Section 17 of the Trade Marks Act, 1999, it is to be relevantly pointed out that the trade mark must be considered in entirety and the absence of a disclaimer meant that the registration gave no separate rights in matter which only formed part of the trade mark. To put it succinctly, the rights of the registered Proprietor are clearly defined in Section 17(1) of the Act, 1999 which expressly state that the exclusive right is in respect of the use of the trade mark should be taken as a whole. If the Proprietor is desires a statutory protection to the exclusive right of any part of the 'trade mark', he has to apply to register the whole and each such part as separate trade

marks.

41.15. It may not be out of place for this Court to make a significant mention that the ingredients of Section 32 of the Trade Marks Act, 1999 clearly envisages that distinctiveness acquire from the date of registration would be taken into account if the validity is contested at a later point of time. More importantly, the new Law has merged Part A and Part B of the register into a single register, possessing the same distinctiveness requirements and legal rights.

41.16. At this juncture, this Court aptly points out the decision of the Hon'ble Supreme Court in ***National Bell Co. V. Metal Goods Mfg. Co.(P) Ltd., and another*** reported in ***AIR 1971 Supreme Court 898*** wherein it is observed as under:

"While Clause (b) of Section 32 of the Trade and Merchandise Marks Act (1958) relates to facts existing at the time of and after registration Clause (c) relates to facts which are post-registration facts, existing at the date of the commencement of rectification

proceedings. If the trade mark at such date is not distinctive in relation to the goods of the registered proprietor, the rule as to conclusiveness enunciated in Section 32 would not apply. Therefore, a person can apply for cancellation on the ground that the trade mark in question was not at the date of the commencement of the rectification proceedings distinctive in the sense of Section 9(3). The burden of proof, however, in such a case is on the applicant applying under Section 56."

Also, in the aforesaid decision, at page 899, it is laid down as follows:

"The principle underlying Cl(c) of Section 32 of the Trade and Merchandise Marks Act (1958) is that the property in a trade mark exists so long as it continues to be distinctive of the goods of the registered proprietor in the eyes of the public or a section of the public. If the proprietor is not in a position to use the mark to distinguish abandoned it or the mark has become

so common in the market that it has ceased to connect him with his goods, there remains no justification in retaining it on the register. The distinctiveness of the trade mark in relation to the goods of a registered proprietor of such a trade mark may be lost in a variety of ways, e.g., by the goods not being capable of being distinguished as the goods of such a proprietor or by extensive piracy so that the marks become publici juris."

41.17. It is to be remembered that Section 57 of the Trade Marks Act, 1999 confers powers on the Appellate Board or the Registrar to dispose of the application for rectification on the grounds specified thereunder. It is only an option for an Applicant to file a Rectification Application before the Registrar or Appellate Board. However, where in a suit for breach of a registered trade mark, when the validity of registration is in dispute, the issue as to validity can only be decided on an application for rectification filed before the Appellate Board as per Section 125 of the Trade Marks Act, 1999. Under those circumstances, an Application for

rectification is to be presented only before an Appellate Board.

41.18. It is to be borne in mind that as regards the onus of proof under Section 57 of the Act, it is for the Applicant seeking rectification to exhibit that when the name was registered, it had not acquired distinctiveness or at the time of the commencement of the proceedings, it had ceased to be distinctive of the goods of the registered Proprietor. Just because, an Applicant for rectification had not opposed the 'Trade Mark' when it was advertised in the 'Trade Mark Journal' cannot be a reasonable/ justifiable ground for rejecting the application. However, if the grounds adumbrated in Section 57 of the Act, 1999 for rectification were not established by the concerned Applicant, then, his Application fails, as opined by this Court.

41.19. It is to be pointed out that as per Section 92 of the Trade Marks Act, an Appellate Board shall not be bound by the procedure of the Civil Procedure Code, but shall be guided by the ingredients of Natural Justice. Moreover, an Appellate Board is enjoined with the necessary powers to regulate its own procedure(s). In reality, Rules 92 to 101 of the Trade Marks Rules,

2002 specifies the procedure to be adhered to, before the Registrar. Even in a case where the registered Proprietor does not contest the rectification application by filing counter, yet, the applicant is to establish an *ex facie* case in its favour by keeping in mind of the principle that the registration of a trade mark is a requisite factor of its validity in the legal proceedings as per Section 31 of the Trade Marks Act, 1999.

Disposition:

42. As far as the present case is concerned, the Writ Petitioner /Respondent on 28th October, 2004 had applied for its adopted mark 'WEALTHADVISORS' and Logo for staking a 'User Claim' for its financial services from 20th May 2004 on the ground that it is a prior adopter and user of the said Mark and Logo in respect of various financial services and products. It's categorical plea is that the mark 'WEALTHADVISORS' WAI Logo Label is to be considered in entirety and not 'WEALTH ADVISORS' *per se*. However, it is the stand of the 1st Respondent/Bank that 'WEALTH ADVISORS' is only descriptive in character and therefore, it is against public interest to grant Monopoly to a Solo Trader/User to the term/word 'WEALTH ADVISORS' concerning services in Class 36. Besides that, it is the

plea of the 1st Respondent that the said term 'WEALTH ADVISORS' has become *public juris* and therefore, they had sought for rectification.

43. Be that as it may, on a careful consideration of respective contentions, in the light of detailed discussions and also this Court, on an overall assessment of the attendant facts and circumstances of the present case which float on the surface, comes to an irresistible conclusion that the Writ Petitioner's mark 'WEALTHADVISORS' and Logo had not acquired any distinctiveness on the date of application and furthermore, the words 'WEALTH ADVISORS' have become 'publicly juris'. Looking at from this angle, it is held by this Court that the Petitioner cannot claim 'Exclusivity' or 'Monopoly' over the same. That apart, 'WEALTH' and 'ADVISORS' are commonly used descriptive words and they do find a place in the 'Dictionary'. To put it pin pointedly, the words 'WEALTH ADVISORS' are not only suggestive, but, they are descriptive in nature, in the considered opinion of this Court. As such, no one can claim 'Exclusivity' over its use. Viewed in that perspective, the impugned order of the 2nd Respondent/Appellate Board in ORA/7/2010/TM/CH dated 09.03.2012 in allowing the application

for removal of the mark 'WEALTHADVISORS' Logo bearing No.1317858 is flawless one. Resultantly, the Writ Petition fails.

44.In fine, the Writ Petition is dismissed for the reasons assigned by this Court in this Writ Petition. No costs. Consequently, connected Miscellaneous Petition is closed.

(M.V., J.) (P.D.A., J.)

06.09.2017

Speaking Order

Index :Yes

Internet :Yes

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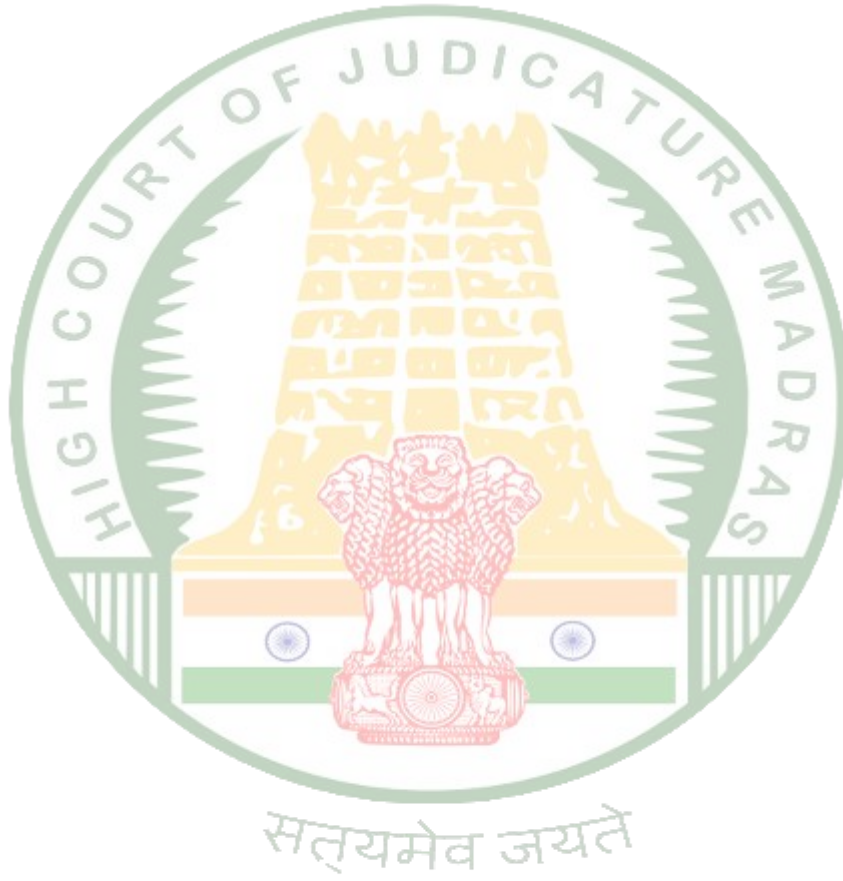
To

1.Citibank, N.A./Citigroup Inc.,
399, Park Avenue,
New York 10043,
United States of America.

2.The Intellectual Property Appellate Board,
Annex I, 2nd Floor,
Guna Complex, 443, Anna Salai,
Teynampet, Chennai – 600 018.

3.The Registrar of Trade Marks,
Trade Marks Registry,
Intellectual Property Office Building,

G.S.T. Road, Guindy,
Chennai – 600 032.



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