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

Date of Decision: 4th December, 2019

\+ **W.P. (C) 12749/2019**

DUBAI ISLAMIC BANK ..... Petitioner

Through: Mr. Pravin Anand, Mr. Shrawan Chopra and Mr. Sidhant Chamola, Advocates. (M: 8373944051)

versus

UNION OF INDIA & ORS. ..... Respondents

Through: Mr. Rohan Anand, Advocate for Mr. Kirtiman Singh, CGSC for UOI. (M: 9968791199)

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

CM APPL. 52101/2019 (exemption)

1. Allowed, subject to all just exceptions. Application is disposed of.

W.P.(C) 12749/2019 & CM APPL. 52100/2019 (stay)

2. The present writ petition has been filed challenging the refusal of registration of the trade mark '*DUBAI ISLAMIC BANK - THE BETTER WAY TO BANK*'. A perusal of the impugned order dated 26th March, 2019, shows that the refusal has been effected under Section 9 of the Trade Marks Act, 1999, on the ground that the mark, consisting of the word 'Dubai' and 'Bank', is indicative of the geographical origin and is purely descriptive in nature.

3. Ld. counsel for the Petitioner relies upon a list of banks, whose trademarks are stated to be registered in India, and which contain the geographical origin. It is submitted that usually, banks have their

geographical origin as part of their trade mark, in order to signify the origin of the banks, however, that by itself does not mean that the name of these banks cannot be registered. Ld. counsel relies upon the following list of names of banks and their slogans to illustrate this position:

Indian Bank Slogans:

Bank Name	***Bank Slogan***
Allahabad Bank	*A tradition of trust*
Andhra Bank	*Much more to so. With YOU in focus*
Axis Bank	*Badhti ka Naam Zindgi*
Bank of Baroda	*India's International Bank*
Bank of India	*Relationships beyond Banking*
Bank of Maharashtra	*One Family One Bank*
Bank of Rajasthan	*Together we Prosper*
Bandhan Bank	*Aapka Bhala, Sabki Bhalai*
Canara Bank	*It's easy to change for those who you love, Together we Can*
Central Bank	*Build A Better Life Around Us, Central to you since 1911*
Corporation Bank	*Prosperity for all*
City Union Bank	*Trust and Excellence since 1904*
Dhanlaxmi Bank	*Tann Mann Dhann*
Federal Bank	*Your Perfect Banking Partner*
HDFC Bank	*We Understand Your World*
HSBC	*World's Local Bank*
ICICI Bank	*"Hum Hai na ..."*
IDBI Bank	*Bank for all; "Aao Sochein Bada"*
IDFC Bank	*Banking Hatke*
Indian Bank	*Taking Banking Technology to Common Man, Your Tech-friendly bank*
Indian Overseas Bank	*Good people to grow with*
Indusland Bank	*We care Dil se; we make you feel Richer*
J & K Bank	*Serving to Empower*
Karur Vyasya Bank	*Smart way to Bank*

Karnataka Bank	*Your family bank, Across India*
Kotak Mahindra Bank	*Lets make money simple*
Lakshmi Vilas Bank	*The Changing Face of Prosperity*
Oriental Bank of Commerce	*Where every individual is committed*
Punjab and Sindh Bank	*Where series is a way of life*
Punjab National Bank	*The Name you can Bank Upon*
RBL Bank	*Apno ka bank*
State Bank of India	*The Nation banks on us; Pure Banking Nothing Else; With you all the way; A bank of the common man; The banker to every Indian*
South Indian Bank	*Experience Next Generation Banking*
Syndicate Bank	*Your Faithful And Friendly Financial Partner*
UCO Bank	*Honors Your Trust*
Union Bank of India	*Good people to bank with*
United Bank of India	*The Bank that begins with "U"*
Yes Bank	*Experience our expertise*

Multinational Bank Slogans:

Name of the Bank	***Punch line***
CITI Bank	*Let's get it done*
Standard Chartered Bank	*Your Right Partner*
HSBC Bank	*The World's Local Bank*
Royal Bank of Scotland	*Make it happen*
BNP Paribas	*The bank for a changing world*
JP Morgan Chase Bank	*The right relationship is everything*
Deutsche Bank	*A passion to perform*
Scotia Bank	*You're richer than you think*
American Express Bank	*Do more*
Barclays Bank	*Fluent in finance*
DBS Bank	*Living, Breathing Asia*

4. It is further submitted that the registration of the mark has been refused without considering that the mark is registered in a large number of countries.

5. Ld. Counsel appearing for the Respondent seeks time to take instructions. This court is of the opinion that the impugned order is self-explanatory and has to stand on its own legs.

6. It is clear from a perusal of the impugned order that the Senior Examiner of Trade Marks has simply applied the judgment of ***British Sugar Plc. v. James Robertson & Sons Ltd., (1996) RPC 281***, which is a judgment from the UK, without considering the settled legal position in India.

7. Section 9 of the Trade Marks Act, 1999, provides for absolute grounds for refusal of registration of a mark. If a mark is *"devoid of any distinctive character"*, it would not be entitled for registration. The said section reads as under:

> *"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.

(2) A mark shall not be registered as a trade mark if—

(a) it is of such nature as to deceive the public or cause confusion;

(b) it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;

(c) it comprises or contains scandalous or obscene matter;

(d) its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950).

(3) A mark shall not be registered as a trade mark if it consists exclusively of—

(a) the shape of goods which results from the nature of the goods themselves; or

(b) the shape of goods which is necessary to obtain a technical result; or

(c) the shape which gives substantial value to the goods.

Explanation.— For the purposes of this section, the nature of goods or services in relation to which the trade mark is used or proposed to be used shall not be a ground for refusal of registration."

8. A perusal of the above provision shows that there can be various grounds on which a mark can be refused registration. The term *"distinctive character"* is expansive in nature and not restricted. A mark may lack distinctiveness if it is descriptive or generic in nature or if it contains the geographical origin. It could also lack distinctiveness if it consists of any customary terminology. The various provisions of Section 9 contain illustrative reasons as to when a mark could be considered as lacking distinctiveness. While some of the conditions could be an absolute bar for

registration, for example, the use of an emblem, the others are subjective in nature. Each of the factors mentioned in Section 9(1)(b), 9(1)(c), 9(2) or 9(3) is a subjective standard and not an objective, mathematical standard. For example:

a) If the mark is descriptive but secondary meaning is established, it can be granted registration;

b) If the mark has a geographical name, it is not automatically disqualified for registration and distinctiveness can be established;

c) If the mark has acquired a well-known status prior to the date of application, it would be considered distinctive;

d) The scandalous or obscene nature of the mark is subject to review from time to time, as *"scandalous or obscene matter"* by itself is not a frozen concept;

e) The shape of goods can be registered as a trademark, if secondary meaning is established.

9. Usually, the distinctive nature of a mark can be established based on the character of the mark, the extent of use of the mark, the global priority in adoption of the mark, the well-known status of the mark, the advertising and promotional investment in the mark, judicial decisions upholding the distinctiveness of the mark and the localized reputation of the mark. Sometimes, the composite nature of the mark and the customer base for the mark would play an important role in granting registration. Thus, the Registrar would have to consider all these factors before rejecting a mark. In the present case, the impugned order records the reasons as under:

> *"The impugned mark is not only purely descriptive in nature but also clearly indicative of kind, quality,*

intended purpose, values, geographical origin of the goods for which the registration is being sought under the mark. The mark is not inherently distinctive and can only be registered if it has acquired reputation by virtue of long use and/or acquired the status of the well known mark prior to the filing of the application as per the proviso of Section 9. Which is not a situation as the present application is concern, admittedly the present mark has been claimed to be used only Proposed to be used, therefore is of no help to the applicant to overcome the objection under Section 9 (1)(a) & (b) as such.

The law was clearly laid down in British Sugar Plc v. James Robertson & Sons Ltd. (1996) RPC 281 at 302, in a passage cited by MR JAMES, JACOB J. stated: "I have already described the evidence used to support the original registration. You have really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that use equals distinctiveness. The illogicality can be seen from an example. No matter how much a manufacturer made use of the word 'Soap' as a purported trade mark for Soap the word would not be distinctive of the goods. He could use fancy lettering as much he liked, whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a product and be able to show massive use by him alone of that word for the product. Nevertheless, the word is apt to be the name of the product not a mark." Also, In Paine & Co.'s Trade Marks, (1893) 10 RPC 217 at p. 232, it was observed that "The purity of Register of Trade Marks is of much importance to trade in general, quite apart from the merits or demerits of particular litigants, and it is duty of the tribunal to see that no word not 'adopted to distinguish' shall be put on the Register in the interest of other traders, wholesale and retail, and of the public. If this were not so, the large and wealthy firms

> *with whom the smaller folk are unwilling to litigate, could by a system of log-rolling ... divide among themselves all the ordinary words of description and laudation in the English language." In view of the foregoing discussion, I find the impugned mark taken as a whole is clearly non-distinct, purely descriptive and nothing but a common words which can't be subject matter of exclusive monopoly of any person.*
>
> *Also, the mark cannot be allowed in the interest of purity of register. As such the Application no- 2883415 is hit by objections under Section 9(1)(a) & (b) of the Act and, therefore, application is refused for registration"*

10. A perusal of the above shows that the Senior Examiner of Trade Marks has basically quoted sub-section 9(1) (b) of the Trade Marks Act, 1999 and held that the mark is not registrable, as the mark is proposed to be used in India. The order is quite general in nature and does not consider the composite nature of the mark and various other elements of the mark, including the fact that there is a slogan.

11. The mark - '*DUBAI ISLAMIC BANK - THE BETTER WAY TO BANK*' is clearly a composite mark, which does not just have the words 'Dubai' and 'Bank', but also has a slogan. Such a mark should not have been refused simply on the basis of the fact that there is an indication of the geographical origin i.e., the word DUBAI. Obviously, when a bank seeks a trade mark registration, the word 'Bank' usually appears in the mark. The appearance of the said word would not by itself make the mark inherently descriptive or make it lack distinctiveness. A perusal of the illustrative list above shows that the names of most banks use a geographical name, the word 'Bank', as also a slogan.

12. Accordingly, the impugned order is set aside. The matter is remanded back to the Registrar of Trade Marks for consideration of the matter afresh. While deciding on registrability, the list of banks which are already stated to be registered in India, whose names contain the word 'bank' as well as their geographical location, as also the global registrations of the Petitioner shall be considered. The settled legal position that slogans and taglines are also registrable as trade marks shall also be considered.

13. Thereafter, the Registrar of Trade Marks shall proceed with the application, in accordance with law. The Petitioner shall be afforded a hearing before the Registrar of Trade Marks, in order to place the said material and any judicial precedent the Petitioner intends to rely upon.

14. The writ petition, is accordingly, allowed and the matter is remanded back to the Registrar of Trade Marks. All pending applications are also disposed of. No orders as to costs.

PRATHIBA M. SINGH
JUDGE

DECEMBER 04, 2019
dk/dj

corrected & released on 23rd December, 2019