
(2011) 09 IPAB CK 0018

In the Intellectual Property Appellate Board

Case No : M.P. Nos. 146 And 147/2011 In TRA/25-27/2003/TM/CH

Jupiter Infosys Ltd

APPELLANT

Vs

Infosys Technologies Ltd. And The Registrar Of Trade Marks

RESPONDENT

Date of Decision : 19-09-2011

Acts Referred:

Constitution Of India, 1950 — Article 137

Trade And Merchandise Marks Act, 1958 — Section, 2(2), 2(2)(b), 2(g), 9, 16, 18, 31, 32, 46, 46(1), 56

Trade Marks Act, 1999 — Section 2(2)(b), 2(1)(zg), 10, 11, 11(e), 11(6), 11(7), 11(8), 11(9), 11(10), 46, 46(1), 46(1)(a), 46(1)(b), 56, 56(2)

Citation : (2012) 49 PTC 383 (IPAB)

Hon'ble Judges : Prabha Sridevan, J; S. Usha, J

Bench : Division Bench

Final Decision : Disposed Of

Judgement

Prabha Sridevan, J

1 . In 2011 (1) SCC 125 Infosys Technologies Limited v. Jupiter Infosys Limited and another (ITL v. JIL in short), the Hon'ble Supreme Court set

aside the order of the Intellectual Property Appellate Board (IPAB) dated 09.09.2004 by which the impugned marks were directed to be removed and

sent them back to us for reconsideration.

2 . Pending the proceedings, a very important event had taken place which was recorded by the Hon'ble Supreme Court:

35... In the affidavit filed by the first Respondent on 14.07.2004 before the Court of the Additional District Judge, Delhi an unequivocal and categorical

statement has been made that now there is no dispute between the Plaintiff (the Appellant herein) and the Defendant (the first Respondent herein)

under the trade mark and that the Defendant has already changed the trade

mark, namely, ""Jupiter International Ltd.,"" in place of ""Jupiter Infosys Ltd.

We do not know why this was not brought to the notice of this Board when the matter was heard earlier.

3. The Hon'ble Supreme Court held that in terms of Section 46(1) of the Trade and Merchandise Marks Act, 1958 (in short the Old Act) the applicant

who invokes it has not only to show that their grievance existed on the date of making the application but that it continued to exist. The Hon'ble

Supreme Court observed that though the first Respondent had not filed any appeal against the order of the IPAB nor challenged the non-consideration

of Section 56, it did have a grievance, and directed the IPAB to hear it afresh in accordance with law. In ITL v. JIL, the Hon'ble Supreme Court

marked the difference between Section 46 which is based on private interest and Section 56 which is based on public interest and how the concept of

persons aggrieved"" must be decided with regard to each of the sections.

4 . Before the arguments began, we specifically asked Mr. Gaggar, the Learned Counsel for the applicant, how the applicant was aggrieved when it

had admittedly changed its name to Jupiter International and the same had also been recorded in the Register of the Registrar of Companies. The

answer was that this change was necessitated only because of the interim orders of the Hon'ble Madras High Court. We again asked the counsel

whether there was any likelihood of the applicant reverting to its original name Jupiter Infosys. The answer was that they might do so in the event of

succeeding in these proceedings. Nearly a decade has gone by since the change and we do not know when the litigation will reach its finality. So we

were really not convinced that there was any likelihood of reversion to the original name. We will be making our observations in this regard later.

5 . The Learned Counsel asserted that even if the pre-requisite for invocation of Section 46 is not satisfied, the Hon'ble Supreme Court had explained

how the locus-stand is wider for invoking Section 56. The Hon'ble Supreme Court had indeed referred to Hardies Trading Limited (2003) 11 SCC 92

and Kabushiki Kaisha 2008 (10) SCC 766 and also to Powel's Trade Mark in Re (1894) RPC 8. They speak of public mischief. Any how the locus-

stand of a person aggrieved with regard to Section 56 cannot be wider than the locus-stand of a litigant who moves a PIL. The Hon'ble Supreme

Court has also repeatedly stressed that a PIL cannot be Private Interest

Litigation. We will be considering this aspect of public interest also.

6 . These rectification petitions have been filed in respect of the following trade marks:

a) Trade Mark INFOSYS bearing registration No. 484837 in class 07; applied on 27th January 1988; registered on 15th September 1993 in respect of

MACHINES and MACHINE TOOLS and MOTORS (NOT FOR LAND VEHICLES) INCLUDED IN CLASS 07.

b) Trade Mark INFOSYS bearing registration No. 475267 in class 09; applied on 15th July 1987; registered on 15th November 1995 in respect of

COMPUTER HARDWARE, COMPUTER INTERFACE, COMPUTER PERIPHERALS, ELECTRONIC TELEX INTERFACE, and ALL

GOODS COVERED IN CLASS 09.

c) Trade Mark INFOSYS bearing registration No. 475269 in class 16; applied on 15th July 1987; registered on 13th July 1993 in respect of

COMPUTER STATIONERY, COMPUTER MANUALS, PRINTED MATTER FOR COMPUTERS, and INSTRUCTIONAL and TEACHING

MATERIALS ETC.

7 . The applicant was incorporated in 1978 as a Private Limited Company under the name Jupiter Agencies Private Limited. In 1990 they diversified

their activities to importation and distribution of various items of computer hardware and peripherals. According to the applicant they traded in these

goods under the family name and in 1995 they changed their name to Jupiter Infosys Private Limited.

8 . The Respondent filed Civil Suit No. 319/1996 before the Hon'ble Calcutta High Court for perpetual injunction against the applicant. The order

passed by the Single Judge of the Hon'ble Calcutta High Court restricted the order of injunction to the applicant herein using the name INFOSYS in

connection with the goods, but it did not restrict their use of the corporate name Jupiter Infosys. This was confirmed by the Division Bench and the

Hon'ble Supreme Court. The Hon'ble Madras High Court by an order dated 01.02.2001 restrained the applicant from issuing shares under the name

Jupiter Infosys, so they changed their name in order to go ahead with the public issue. This change of name has been made in accordance with law.

The applicant is ""aggrieved"" by these orders and has therefore moved the rectification application.

9. Arguments were advanced at length on behalf of both the sides and they also filed written submissions.

10. The Learned Counsel appearing for the applicant submitted that the registration itself has been obtained by fraud, by mis-declaration. The mark

Infosys is a descriptive one and not a coined one and assuming without admitting that the word is distinctive, it had ceased to be so at the time of

registration. There is no bonafide intention to use this mark for any of the goods under the relevant class for which it was registered. Therefore, there

can be no protection under Section 11(e). The mark is also liable to be rectified on the ground of non-user. Under Section 2 (g) of the 1958 Act, the

goods for which the trade mark is applied for must be the subject of trade or manufacture and that requirement is not satisfied in this case. The

Learned Counsel insisted that above all, the Registrar has a duty to maintain the purity of the Register. The Learned Counsel submitted that the name

of the Respondent had undergone several changes. It was originally Infosys Consultants Private Limited. They were only consultants and they were

only rendering service. There was no intention to trade in the goods for which the registrations were sought for. The Learned Counsel also submitted

that the fact that the Respondent is now a formidable name to be reckoned with shall not deter the Board from applying the correct law. The

impugned marks must not remain in the Register.

11. The learned Senior Counsel appearing for the Respondent submitted that there was no fraud. All the requirements for registration had been

satisfied. There was neither deceit nor injury to any person. The software has to be embedded in the hardware and therefore it is not correct to state

that there was neither trading nor manufacture. He submitted that the Respondent's name has been declared as a well known-mark and, therefore,

that is a factor which the Registrar was bound to take into reckoning even from the angle of purity of the Register. If a large section of the people

would identify the mark only with the Respondent then the registration in favour of the Respondent cannot affect the purity of the Register. On the

contrary, removal of the mark would affect the purity. The learned senior counsel also referred to the Notification issued to the Registrar of

Companies that there shall be no registration of companies which carry the name Infosys under the Name Availability Guidelines.

12. After we had reserved orders, the applicant filed a miscellaneous petition to place on record certified copies of trade mark applications filed by the

Respondent. The Registry had found that there were some defects which had to be rectified since the affidavit was not stamped. But, however, since

we had listed these matters for pronouncement of orders they placed the M.P. before us.

13. Now we will refer to the submissions in detail. According to the applicant, the mark was obtained by fraud since the claim is that the Respondents

have been using the trade mark on all the goods since 1981. The clear representation is that they were manufacturing and trading in all the goods.

According to the applicant, from the pleadings filed in the Civil Suits, it is seen they were only providing software services and it is only in Civil Suit

No. 71/2001 that they stated that they had 'also' engaged in hardware and nothing on their documents show that they had ever been manufacturers or

merchants. Out of the three impugned trade marks, two are made in the name of Infosys Consultants Pvt. Ltd., and one in the name of Infosys

Technologies Pvt. Ltd., though as a matter of fact the name of the Company changed on 21.04.1992 only. The Respondent's claim that they are

manufacturers and merchants of goods under classes 7, 9 and 16 is false. According to the applicants, the Respondents had obtained injunction orders

dishonestly without obtaining registration certificates. According to the applicant, the Respondent's claim that software was 'goods' and their

submission that since software could not be permitted to be registered under 1958 Act they had to obtain registration under Section 9, 11 and 16 could

not be accepted since what cannot be done directly cannot be done indirectly. It was submitted on behalf of the applicant that the registration

certificate clearly show that the words 'proposed to be used' have been struck off and therefore they cannot now take that stand. The registration of

trade mark for goods for which the Respondent never intended to use the mark is for the purpose of squatting and trafficking in the trademark. It is

submitted on behalf of the applicant that the present case is governed by the old Act and the concept of well-known mark is not known under the old

Act. It was submitted that since fraud avoids all actions, anything that flows out of fraud would be non est. in the eye of law. It is submitted that the

word INFOSYS is not an invented or coined word. It is only an abbreviation, the combination of the words 'information' and 'systems' like INSTEA,

which was held to be not an invented word in AIR 1978 Madras 336 Nestle Products Ltd., v. P. Thankaraja. In any event, the word INFOSYS has lost its distinctiveness.

14. There is a contravention of Section 18. There is no bonafide intention to use. Reference was made to (1997) 4 SCC 201 Vishnudas v., Vazir

Sultan and (1898) 15 RPC 534 Batts. Trade Mark and also in 1898 RPC 262 In re Carters Trade Mark to show that a person who has no bonafide

intention to trade or deal in goods for which he has obtained the registration exposes him to the risk of having the mark expunged or varied. He

submitted that the words ""in the course of their trade"" should not be given a wider meaning than intended by the legislature and if the Respondent's

stand is accepted that the requirement of the Act would be satisfied so long as the mark is used for the same purpose, in the course of the same

business activity it would be a wholly incorrect interpretation of the concept of trade mark. Infosys has ceased to be distinctive. It is used by numerous

business establishments as seen from the materials downloaded from the website. The law of limitation does not bar the applicant from moving this

Board for rectification. It was vehemently stressed that at all costs public interest and purity of the Register must be maintained.

15 . In the oral and written submissions made by the Respondent, the following points were urged: The present rectification applications were barred

by limitation. They have been filed four years after the knowledge of the Respondent's registration. The applicant is not a person aggrieved. The

learned Senior Counsel submitted that the applicant had never intended to trade in the goods in the particular class and they have now changed their

name; they cannot be considered to be person aggrieved. The applicant in any event cannot revert to the earlier name because the Registrar of

Companies has been restrained from registering any company with the name INFOSYS. The name Infosys is associated with only the Respondent

company and none other. Therefore, it would only be in public interest to retain the entry in the Register.

16. Section 56 of the Act does not apply. None of the conditions mentioned in that section arise in this case. It was submitted that in fact confusion

would arise only if the Respondent's mark was removed thereby allowing others to use the word Infosys. The burden of proof is heavily on the

persons seeking the rectification to show that the mark shall not remain in the Register. Sections 31 and 32 were relied on to show that the registration

is prima facie evidence than evidence of validity.

17. The Respondents are manufacturers and traders and cannot be restricted to service industry since software and hardware cannot be separated

from each other. He submitted that all software companies register their goods in class 7, 9, and 15 not only in India but also in Common Law

Countries and reference was made to Tata Consultancy Service's case.

18. The word Infosys is a coined mark and deserves the highest level of protection. This name is associated with the Respondent since 1981.

Reference was made to the judgment of Hon'ble Delhi High Court where the learned Judge had dealt with the word Infosys. It was submitted that

software and hardware are goods of the same description. It was also submitted that the Respondents have and continue to have bonafide intention to

use the mark Infosys and they have in fact used the mark. So their mark is not ""a proposed to be used mark"".

19. The learned Senior Counsel submitted that the applicant was not even in existence in 1981 and there must be an acceptable explanation for

adopting the name Jupiter Infosys and when fraud is alleged particularly by a person whose bonafide itself is in question, the burden of proving fraud is

heavy. He submitted that allegations of fraud must be strictly proved. He also urged that to say that Infosys is not a coined word is incorrect. The

names downloaded by the applicant from the website showing the word Infosys would prove that most of the hits are that of the domain names of the

Respondent.

20. Reference was made to Section 2 (2) and in particular to the words ""or in any other relation whatsoever"" and reference to Hardie's Trading was

made to show that a wider meaning should be given which can encompass action other than actual sale and therefore, any positive step towards

manufacture is 'use' under Section 2 (2) (b) of the Act. The allegation of trafficking was denied and it was prayed that the rectification petition shall

be dismissed.

21. The following documents were filed by the applicant:

i) Document A-1 - Certification of Registration in respect of Trade Mark No. 475269;

- ii) Document A-2 - Certificate of Registration in respect of Trade Mark No. 475267;
- iii) Document A-3 - Certification of registration in respect of Trade Mark No. 484037;
- iv) Document No. A-4 - Complaint in Suit No. 319/1996 (High Court at Calcutta);
- v) Document No. A-5 - Complaint in Suit No. C.S.71/2001 (Madras High Court);
- vi) Document No. A-6 - Download from Yahoo Website of Infosys Company;
- vii) Document No. A-7 - Download from google website of Infosys Company;
- viii) Document No. A-8 - Name Availability Guidelines under the Companies Act;
- ix) Document No. A-9 - Changes in Name Availability Guidelines under the Companies Act.

22. The Respondent on its side has produced newspaper, Annual reports, list of court proceedings against infringers, trade mark caution notices and judicial orders in their favour; Central Sales Tax Registration, Agreement of sale, Certificate of Interface approval etc.

23. The M.P. that was filed was to show that the Respondent cannot contend that the marks were ""proposed to be used"". But the learned senior counsel Mr. P.S. Raman for the Respondent submitted that it was not their case that the mark was ""proposed to be used: In that event the M.P. is unnecessary.

24. Limitation:

In 2008 (10) SCC 723 Khoday Distilleries Limited (now known as Khoday India Limited) v. Scotch Whisky Association and Ors., the Hon'ble

Supreme Court held that Article 137 would not apply to the rectification proceedings since the Trade Mark Registry is not a Court. But in this case

these rectification petitions were filed before the Hon'ble High Court. Therefore the above decision may not apply. If the petitions were time barred

when they were originally filed before the Hon'ble Madras High Court, we are not sure if that defect can be 'washed away'. But however, the issue

of limitation had been decided against the Respondent herein by the IPAB earlier. In ITL v. JIL the only question which was argued was whether or

not the applicant herein/the Respondent before the Hon'ble Supreme Court is an aggrieved person and the IPAB was directed to consider it afresh in

accordance with law and the observations made therein. Therefore, we have to

strictly restrict ourselves to considering whether the applicant is an aggrieved person.

25. Is the applicant a person aggrieved under Section 46?

We will be dealing with this matter in accordance with the Trade and Merchandise Marks Act, 1958 (old Act in short). Section 46 of the Old Act

deals with removal of the mark from the Register on several grounds. They refer to the ""bonafide intention to use"" and ""bonafide use"". In para 28 of

the in ITL v. JIL, it is held that to be an aggrieved person under Section 46, he must be one whose interest is affected in some possible way. It must

not be a fanciful suggestion of grievance. The Hon'ble Supreme Court held that:

28. The position that emerges from the above provision is this. Whether the application is under Section 46 or under Section 56 or a composite

application under both sections, it is a prerequisite that the applicant must be a person aggrieved. Section 46 (1) of the 1958 Act enables any person

aggrieved to apply for removal registered trade mark from the register on the ground of non-use as stated in Clause (a) and/or Clause (b). To be an

aggrieved person under Section 46, he must be one whose interest is affected in some possible way; it must not be a fanciful suggestion of grievance.

A likelihood of some injury or damage to the applicant by such trade mark remaining on the register may meet the test of locus stand.

It indicates that even the possibility of some injury may meet the test of locus-stand, not necessarily present injury.

26 . (2003) 11 SCC 92 Hardies Trading Ltd., and Anr. v. Addisons Paint & Chemicals Ltd., is the case that the Hon'ble Supreme Court referred in

ITL v. JIL. Here Hardies and the Respondent had a collaboration agreement which envisaged the Respondent being the registered user of the trade

mark during the period of agreement. The Hon'ble Supreme Court dealt with the issue of non-user under Section 46 and held that under Section 46 the

ground of non-user is not on account of any public mischief by way of indirect entry. The non-user by itself does not render the entry incorrect but it

should give the person whose interest is affected the right to apply for its removal and the Hon'ble Supreme Court in Hardie's case quoted from

Powel's Trade Mark. The judgment in ITL v. JIL quotes several paragraphs from Powell's Trade Mark but the following para which is extracted in

Hardie's case is relevant:

Whenever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the register, would, or might, limit the legal rights of the applicant, so that by reason of the existence of the entry on the register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me he has a locus stand to be heard as a person aggrieved.

27. Therefore, it would appear that when an applicant seeks rectification under Section 46 he should show that since he is in the same trade as the person who has obtained registration, the continuance of the trade mark would or might limit the legal rights of the applicant. The words 'might' here would show that even a likelihood of injury is sufficient. The above paragraph also shows that because of the registration and the continuance of the mark on the Register, the applicant must be prevented from doing that act which he could lawfully do otherwise but for the existence of the mark on the Register. Today the applicant has changed the trade name to Jupiter International Limited. This is not disputed. The reason for the change is not relevant for us. For the purpose of Section 46, the applicant cannot today say that Jupiter International being in the same trade as the Respondent is prevented from doing something that it could have lawfully done but is prevented from doing because the mark "INFOSYS" appears on the Register. To accept that, if and when the applicant succeeds in removing the mark from the Register, the applicant would or might revert to its name of Jupiter Infosys and really nothing can stop them, would be stretching the injury beyond the realm of likelihood, and even beyond fanciful suggestion into the realm of undiluted imagination.

28. The Hon'ble Supreme Court in para 37 and 38 of ITL v. JIL had concurred with Apollinaire's Company's Trade Marks In re (1891) 8 RPC 137 at 163 and held that for an applicant to invoke Section 46, the grievance must not only exist at the time of application but must continue to exist on the date of adjudication. The applicant's grievance does not exist today. The Learned Counsel for the applicant also submitted that Vishni Malik, in whose name the affidavit was filed before the Delhi Court that there is no dispute between the applicant and the Respondent because of the name change, did not have the authority to do so and there are other litigations pending

between the parties. We cannot inquire into whether a particular employee had authority to make an unequivocal submission before a Court that there is no dispute between the parties. As and when such a dispute is raised before the appropriate forum, we are sure that it will be decided in accordance with law. A statement was made on behalf of the applicant before a Court, who had jurisdiction that there was no dispute between the parties. This was recorded in ITL v. JIL. It remains before us until it is undone in a manner known to law. The fact that the name is changed is also a matter of indisputable fact. The Hon'ble Supreme Court has also held that the grievance must exist on the date of the adjudication. The applicant is not an aggrieved person, for the purpose of invoking Section 46. If Section 46 cannot be invoked the issue of non-user anyway will not arise.

29. The next question which we will decide is whether the word Infosys is a coined word or whether it is merely descriptive. According to the applicant the word Infosys is the abbreviation and combination of the words 'Information' and 'Systems' and cannot be called an invented word and that various companies within India prior to the incorporation of the Respondent had used the word Infosys and as an example referred to a German company in the name of CE Infosys. The counsel produced a document across the Bar which was not received by us. The Respondent was established in 1981. According to the applicant since Infosys is not an invented or coined word, the Respondent cannot have a monopoly over the said word, but the Respondent had virtually terrorized their opponents by obtaining injunction not only against the applicant, but other business establishments. It was also submitted that the adoption of the word Infosys was itself based on fraud and the Respondent had registered themselves for goods which they evidently never traded in or manufactured. According to the applicant, the Respondent's own documents would show that there are many other companies bearing the name Infosys. The applicant referred to the judgment of the Hon'ble Madras High Court in AIR 1978 Madras 336 (supra). That was a case where the impugned word was INSTEA. The learned judge held that it is clearly indicative of instant tea and there is no mistaking about the character of the goods. ""To be held an invented word an expression must not give any inkling as to the type of goods to which the word relates, whether apparently or in a disguised form. The invention may be in

the adoption of a foreign word; it may consist in an abbreviation; it may be an anagram; it may be formed out of a combination of two or more words, as they are, or in any clipped or altered form; it may introduce one or two meaningless syllables or letters in between words. Whatever is the mode of contrivance, if to the eye or to the ear the resultant expression conveys the same idea as would be conveyed by any recognizable expression in the common vocabulary, then the word would not be regarded by the trade mark law as an invented word. In short, an invented word must be different from any word in common speech, and the difference must be substantial and not skin-deep merely. In judging whether a word is invented or not in the sense aforesaid the Registrar and the Court must take in the word as a whole in order to form a totality of impression both of sight and of sound.

30. They referred to para 8.37 of P. Narayanan - Law of Trade Marks & Passing Off (6th Edition) which is extracted below:

8.37 Words held to be not invented

1 . WASHERINE for a liquid preparation for laundry purposes. A descriptive term being the ordinary word "'Wash' with a very ordinary termination

added to it. Burland v. Broxburn (1889) 6 RPC 482.

2 . ROMALIN for a substance containing formaldehyde (name of a patented article). Formalin's Appln. (1900) 17 RPC 486.

3 . UNEEDA for articles of food. Misspelling of "'You need a'". National Biscuit's Appln. (1910) 18 RPC 170.

4 . PANORAM for photographic cameras and films. Kodak v. London Stereoscopic (1903) 20 RPC 337 (rectification).

5. ABSORBINE for a liquid veterinary preparation coined from 'Absorb' with a common termination 'ine'. It is a mere variation of the word 'Absorb'

or a misspelling of "'Absorbing' and used in the same sense. Christy v. Tipper (1904) 21 RPC 97, 755 (CA).

6 . BIOSCOPE for cinematographic apparatus. Word descriptive and found in dictionaries and printed books. Warwick v. Urban (1904) 21 RPC 240.

7 . HAEMATOGEN for a proprietary medicine. Use of "'Dr. Hommel's Haematogen'" considered as evidence that the word had not acquired a

secondary meaning. Hommel v. Bauer (1904) 21 RPC 576; (1905) 22 RPC 43 (rectification).

8 . CYCLOSTYLE for stationery and apparatus for producing facsimile copies of writings and design. Descriptive word. A patent for a wheel-

pointed pen was spoken of as 'Cyclostyle'. Word also used for pen, ink, paper and other articles of duplicating apparatus. Gestetner's Tm. (1908) 25

RPC 156 (rectification).

9. DIABOLO for tops. An old Italian variant for 'diavolo' meaning devil. Word suggesting the devil or something in which the devil plays a part and

selected with the object of making that suggestion. Philippart v. William Whiteley (1908) 25 RPC 565 (rectification).

10 . ORLWOOLA for woolen goods. 'All wool' misspell with a meaningless suffix. Orlwoola Tm. (1909) 26 RPC 681, 850 (rectification).

11. ARSENOID for chemical substances. Word has same sound as 'Arsenide', a compound of Arsenic. 'Oid' a suffix meaning 'in the likeness of or

'like' as for example 'Alkaloid'. Yalding's Appln. (1916) 33 RPC 285.

1 2 . CHOCAROONS for sweetmeat derived from chocolate and Macaroons. Word used as the name of a new sweetmeat. William's Appln. (1917)

34 RPC 1, 197.

1 3 . EANCO being phonetically similar to "'E and Company'" Eisman & Company's Appln. (1920) 37 RPC 134.

14. ALUMINOX for paints, dry colors, distempers, enamels etc. word directly conveying the meaning of Aluminum Oxide. Salter's Appln. (1923) 40

RPC 402.

15. FANFOLD being a combination of two ordinary English words. Fanfold's Appln. (1928) 45 RPC 199, 325 (CA).

16. CONFOLETTE for gramophones, 'Console' used in the gramophone trade to indicate a design with particular characteristics. 'Consulate' indicates

a console machine of diminished size. SMT Gramophone's v. Itonia (1931) 48 RPC 309.

17. LIVRON for tonic preparations. Coined from the words 'Liver' and 'Iron'. Geographical name being the name of a place in France where similar

goods were made. Mark expunged from register. Boot's TM 1937 54 ROC 327 (CA).

18. DEX for bolts and screws. Phonetically equivalent to 'Decks'. National Machinery's Appln. (1941) 58 RPC 128.

19. TRAKGRIP for rubber tyres for vehicle wheels. Coined word unknown to the

English language. Evidence of user. Registration granted. Dunlop's

Appln. (1942) 59 RPC 134.

2 0 . OOMPHIES, otherwise distinctive. Registration granted. La marquise Footwear's Appln. (1947) 64 RPC 27.

2 1 . SCOTCHLITE, equivalent to "'Scotch Light.'" Goods non-metallic sheet with light reflecting surfaces. Minnesota's Appln. (1948) 65 RPC 229.

22. CHEMICO for pharmaceutical products. Word found in dictionaries as a combining form. County Chemical's Appln. (1949) 66 RPC 268.

23. VAPORUB for medicines. Word derived from "'Vapor Rub'", descriptive. De Cordova v. Vic (1951) 68 RPC 103 (PC).

24 . MICRONIC for oil filters for internal combustion engines. Registration granted in Part B. Automotive Product's Appln. (1953) 70 RPC 224.

25. PUSSIKIN for cats' food being an appropriate name to apply to a small cat. Henry Quennel's Appln. (1955) 72 RPC 36.

26. SMITSVONK for electric spark apparatus. "'Smit's a surname and 'Vonk' meaning 'spark' in Dutch. Smitsvonk's Appln. (1955) 72 RPC 117.

2 7 . MINIGROOVE for sound records 'Mini' and 'Groove' both descriptive.

Philips' Appln. (1955) 72 RPC 183.

2 8 . SIMPLUG for repair plugs for tyres. 'Sim', a surname and 'Plug' descriptive. Goodyear's Appln. (1957) RPC 173.

2 9 . BEEDKETYFT fir juttet gilds bad carets, 'Needle' and 'Tuft' ordinary English words. Cabin Crafts' Appln. (1955) 72 RPC 333.

30. EARTHMASTER for mechanical shovels etc. Chase side's Appln.(1956) RPC 73.

31. MAGNETOPHON for sound reproducing and sound recording apparatus. Word found in reference books as the name of a phonograph operated

by magnetic electricity and is a generic term for tape-recorders. Allege mine's Appln. (1957) RPC 127.

32. PATENTEX being too close to 'Patented'. Refused registration in spite of some user. Anneliese Heckman v. Registrar (1961) 63 Bom LR 650:

AIR 1962 Bom 88.

3 3 . TARZAN, being a word which had acquired a definite meaning and referred to a well known fictitious character. Tarzan Tm. (1969) rpc 301;

(1970) rpc 450 (ca).

3 4 . instead COINED FROM 'Instant tea'. Merely a condensation of the

expression 'instant tea'. Application refused. *Nestle's v. Thankaraja* (1978) 1 MLJ 417: AIR 1978 Mad 336.

3 5 . SLOPHYLLIN for pharmaceutical preparation containing the drug theophylline. To doctors the word indicated a "slow release aminophylline or theophylline. "Slophyllin Tm." (1984) RPC 39.

3 6 . YOURT in respect of yoghurt being too near to the dictionary word YOGHURT, YOGURT and YAOURT use interchangeably, and not distinctive or capable of distinguishing. YOURT Tm. (1985) RPC 363.

31. It was also submitted that it is not distinctive since distinctiveness is judged in relation to the goods with respect to which the mark is registered.

According to the applicant, since the Respondent is primarily a service industry and not trading in the goods in respect of which it is registered, the

mark cannot be said to be distinctive of its goods. In this connection, we may also refer to the objections raised by the applicant regarding the

reference to the mark being a "well known mark". According to the applicant the provisions relating to well-known marks was introduced only in the

new Act whereas the present proceedings are governed by the old Act which does not have any such reference.

32. The applicant referred to the Notification issued under the Companies Act with regard to the Name Availability Guidelines where the following

para is relevant:

4.1 In recent times it appears that quite a few companies whose principal object was computer software and who had actually been involved in

financing activities have changed their names to indicate as if they were in the business of computer software. For this purpose they have included

words like - "Infosys; Software: systems: Info system, Computers, Cyber: Cyberspace etc" in their names.

4.2 In order that investors are not misled by the strategy adopted by a few companies, ROCs are hereby advised that in future they should allow

change of name to companies to reflect the business of software only of a substantial portion of their income) as reflected from their audited accounts

or accounts certified by a Chartered Accountant) is derived from software business. If this is not proved then such change of name should not be

allowed.

33. It was submitted that this would show that many companies had changed their names to include words like the Respondent's name to indicate that they were in the business of computer software and the Registrar of Companies were advised that changes of names should not be allowed unless a certificate is given by the Chartered Accountant to the effect that a substantial portion of their income was borne from software business. According to the applicant Infosys has therefore become a descriptive word in the business of Information Technology in India and it is no longer a distinctive trade mark.

34. The learned Senior Counsel appearing for the Respondents submitted that the word Infosys was coined by them and that it has no dictionary meaning and that it had been the essential and prominent part of their corporate and trade name since 1981. He referred to the judgment of the Hon'ble Delhi High Court where it was held that Infosys is a well-known trade mark as defined under Section 2 (1) (zg) of the 1999 Act. The learned Senior Counsel also produced a list of what is stated to be well-known trade marks as per the Trade Marks Registry.

35 . The learned Senior Counsel appearing for the Respondent submitted that the Respondent had filed a writ petition before the Hon'ble Calcutta High Court to restrain the Registrar of Companies from registering names which include Infosys by other companies. It was also submitted that while assessing whether Infosys was coined word, we should really put oneself back in time to 1981 when the Respondent started the business.

36. It is indisputable that the provision relating to the well-known trade mark was introduced only in the 1999 Act. Section 2 (zg) defines what is a well-known trade mark. It is a mark of certain goods or services which has become so well-known to a large number of people with the result that the use of such a mark in relation to some other goods or services would be taken as an indicator of the link between these goods or services and the goods or services first mentioned. Section 11 (6) (7) (8) (9) and (10) deal with well-known trademarks. Now why was it necessary to introduce the concept of well-known trade mark? The basis for introducing the concept of well-known trade mark is inextricably linked with maintaining the purity of the Register. Purity of Register is based on public interest. When the mark is well known it is as if the public gets a warranty

of quality relating to the goods for which the mark was originally used/registered and by virtue of the quality or satisfaction or assurance, the public assumes that if the same mark is used in relation to other goods, there is a link between the first mentioned goods and the subsequent goods warranting the same quality or satisfaction or assurance. S.11 (10) of the new Act bars the Registrar from registering any mark which is identical to a well known mark. This is to prevent anyone attempting to deceive or confuse the public by adopting a well-known mark so that they can ride on their goodwill. Even without the introduction of Section 2(zg), these principles must guide while considering a mark that is identical or deceptively similar to a mark which has acquired a strong reputation. The concept of well-known trade mark has undoubtedly been introduced in the Act only now. But the principles underlying this have definitely existed right from the days when the Trade Mark Protection was given statutory recognition. We have the case of Daimler Benz Aktiengesellschaft v. Hybo Hindustan (AIR 1994 Del 239), Sunder Parmanand Lalwani and Ors. v. Caltex (AIR 1969 Bom 24) where the protection was given to trade marks which were so entrenched in the minds of the people that the Courts restrained others from using the trade mark albeit for a totally different class of goods because the Courts were of the opinion that to use the trade mark which had acquired a certain degree of reputation by someone totally unconnected would not be in the interest of the public nor would it add to the purity of the Register. Therefore, the introduction of the concept of well-known trade mark is only one facet of maintaining the purity of the Register and safeguarding public interest. The law makers obviously felt that it should be clarified and given a statutory form so that such well-known trade marks are not used/abused by others who have no connection with the original users/owners of such well-known marks so as to gain an advantage which they are not entitled to nor to mislead the public into believing there was a business connection. Therefore, while we accept the legal point raised by the applicant that the concept of well-known trade mark was not in the Statute book before the new Act came, undoubtedly and indisputably there were marks which were considered well-known even earlier. Now Section 11 (8) of the new Act provides that if any Court determines that the mark is well-known among at least one relevant section of the public the Registrar shall

consider it as a well-known trademark. In the present case, though we cannot hold that the impugned mark shall be recognized as a well known mark

under the Act, we are bound to refer to those High Court judgments where the mark is referred to as a well-known mark by the Court as well as the

right of the Respondent to the mark and the manner in which it was coined. In the decision referred to by the Respondent, this is what the Learned

Judge of the Hon'ble Delhi High Court had to say about the mark (in the Case No. CS (OS) 1407/2004:

...The Plaintiff has coined and adopted the expression ""Infosys"" in the year 1981 and has extensively used the said expression since its inception. The

Plaintiff is listed with the leading stock exchanges of the country as well as the NASDAQ. Further the Plaintiff's trademark/service mark is proved to

have been registered by the Plaintiff in various classes in over 20 countries; it is also a well-known trade mark as defined under Section 2 (1) (zg) of

the 1999, Act. In India, the trade mark has been registered towards various categories of goods since 15th July, 1987. The copies of trade mark

registration certificates in the Plaintiff's favour are collectively exhibited as Ex. PW-1/2. The Plaintiff has also proved the validity of the registrations

which are stated to have been renewed from time to time and are subsisting and in force in favour of the Plaintiff even at present...

37. We do not think anyone disputes that the Respondent came into existence in 1981 and adopted the word INFOSYS in connection with its business

though not in the manner that it now carries its name, but as Infosys Consultants Private Limited. Undoubtedly it has undergone two changes (the

current one is the third change) but the term Infosys was undoubtedly an important feature of their name.

38. In Halsbury's Laws of England (4th Edition Vol.48) several tests are given for an invented word. Among them are, it must have been substantially

new on the date of registration, substantially new at the time of first user. It may be an invented word even though it conveys a meaning to the reader

and can even contain a covert and skillful allusion to the character or quality of the goods. But it must not convey any obvious meaning to the ordinary

English speaking person. Telescoping of two dictionary words which are descriptive can produce an invented word. But it is really a question of fact

depending on the circumstances of each case and the guiding principle in the case of invented words is ""that no such registration must be allowed that

would monopolize part of the general vocabulary of the trade or restrict the use of words that a trader would be likely to need to describe his goods.

So even though this provides guidance and we may refer to any number of judgments, ultimately we should decide this question on the facts of the

case. Halsbury's also gives examples of invented words which include Chocaroon for "chocolate and macaroni", whisker for "whiskey and liquor", and examples of words which were held not to be invented were "Track grip", for Tyres "Mangrove" for sound records, "Rotorake" for horticultural machinery.

39. Now we should transport ourselves to 1981 to test whether Infosys was a coined word or a descriptive word or a distinctive word. In 1981, in

India at least, computer, email, computer technology was not known and the Respondent joined at random two words - 'Information' and 'System'.

Then Infosys could not have meant anything to an ordinary English knowing person. It is not obvious as in the case of Instead or Track grip or any of

the other words referred to in para 23 supra. The word INFOSYS today brings to our mind computer technology and other allied matters but would it

have done so in 1981? We think not. It is only because this mark has become so well known today that the immediate mental link is made. This is not

a part of the general vocabulary of the trade. Therefore, the mere allowing of registration of the name would not create such a monopoly of the trade

vocabulary as to restrict the right of others in the trade to choose a name for their trade nor would it be correct to state that it would restrict a trader's

right to describe his goods if he needed to. INFOSYS is not like INSTEAD. In fact in the same Volume of Halsbury's Laws of England we find that

one of the factors for proving deception by the Defendant is the nature and extent of the reputation relied upon. In other words the Plaintiff will have

to show that the mark is well known. Therefore, we, like the Hon'ble Delhi High Court hold that the Respondent has coined the word INFOSYS in

1981 and the word had been so extensively and openly used as to become distinctive of the Respondent in the eyes of the consumers. While it is true

that the Hon'ble Delhi High Court is an ex-parte judgment we agree with the views expressed there in. In fact, the notification of the Registrar of

Companies is actually a factor in favour of the Respondent. The words there are Infosys Software Systems, Info system, Computers, Cyber,

Cyberspace etc. Except for the word Infosys none of the other is a trade mark. The word Infosys had become so distinctive of the Respondent that

even the Registrar of Companies had thought it fit to give guidelines regarding future changes in company names which would include the word

Infosys. Therefore, this to our mind appears more to indicate that it has become distinctive of the Respondent's than otherwise. In fact, the applicant

has not placed any reason before us for suddenly adding the word Infosys to its original trading name of Jupiter. Was it by chance or by design? Be

that as it may, the Respondent clearly coined the word Infosys in 1981. We, therefore hold that the word Infosys is a coined word, it is distinctive as

the Respondents mark and not descriptive of the business of Respondent, and is deserving of the strongest protection.

Public Interest

40. We have referred to the submissions made on behalf of the applicant that there was fraud in adoption of the name. It is not sufficient to allege

fraud. It has to be proved. We do not see how there was an element of fraud in the adoption of name INFOSYS in the year 1981. The applicant must

show intention to deceive, to create confusion regarding source of goods, or to indicate that the source of goods is something other than it really is.

41. It is true that several decisions were cited, but the applicant should make out a case of fraud and prove it by evidence. There is no evidence of

fraud and mere allegation is of no avail. The question of public interest was raised and to support their submissions it was urged that Section 56 has

been given a very wide connotation by the Hon'ble Supreme Court and it has to be construed very liberally to include "public interest". It was also

submitted and reference was made to 2003 (11) SCC 92 Hardie Trading Ltd., which dealt with the purity of the Register. It was urged on behalf of

the applicant that this duty to maintain the purity of the Register is so heavy that the law empowers the Registrar and therefore, the Board to even

take suo motu action in order to maintain purity of the Register and to protect public interest. Reference was made to 1993 PTC 322 (Del) C.R. Auluk

& Sons Ltd., v. Rita Mechanical Works] AIR 1963 Bom 246 Nehkumar v. Mohanlal and 1903 RPC 105 Addley Bourne v. Swan and Edgar. The

Learned Counsel for the applicant submitted that the question is not one between the person seeking rectification and the person in whose name the

trade mark stands, but to the proprietor of the trade mark and the public and it was also submitted that there was a duty to set right the Register for the benefit of the public.

42. According to the Respondent however, it is public interest which requires that the Respondent's mark remains in the Register for if it is removed, it would allow others to adopt the word Infosys and thereby mislead the public into thinking that their goods are somehow linked with the Respondents.

According to the learned Senior Counsel, in fact, the question of public interest swings in favour of the Respondent.

43. We will look at the decisions relied on by the applicant and see how this issue is to be decided.

Hardie Trading Ltd. case

31. In our opinion the phrase "person aggrieved" for the purposes of removal on the ground of non-use under Section 46 has a different connotation

from the phrase used in Section 56 for cancelling or expunging or varying an entry wrongly made or remaining in the Register.

32. In the latter case the locus stand would be ascertained liberally, since it would not only be against the interest of other persons carrying on the same trade but also in the interest of the public to have such wrongful entry removed. It was in this sense that the House of Lords defined "person aggrieved" in the matter of Powell's Trade Mark (1894 (11) RFC 4):

... although they were no doubt inserted to prevent officious interference by those who had no interest at all in the Register being correct, and to exclude a mere common informer, it is undoubtedly of public interest that they should not be unduly limited, inasmuch as it is a public mischief that there should remain upon the Register a Mark which ought not to be there, and by which many persons may be affected, who, nevertheless, would not be willing to enter upon the risk and expense of litigation.

Wherever it can be shown, as here, that the Applicant is in the same trade as the person who has registered the Trade Mark, and wherever the Trade

Mark, if remaining on the Register, would, or might, limit the legal rights of the Applicant, so that by reason of the existence of the entry on the

Register he could not lawfully do that which, but for the existence of the mark upon the Register, he could lawfully do, it appears to me he has a locus

stand to be heard as a person aggrieved.

(Emphasis added)

33. But if the ground for rectification is merely based on non-user i.e. under Section 46 of the Act, that is not really on account of any public mischief

by way of an incorrect entry. The non-user does not by itself render the entry incorrect but it gives a right to a person whose interest is affected to

apply for its removal. An applicant must therefore show that ""in some possible way he may be damaged or injured if the Trade Mark is allowed to

stand; and by ""possible"" I mean possible in a practical sense, and not merely in a fantastic view..... All cases of this kind, where the original

registration is not illegal or improper, ought to be considered as questions of common sense, to a certain extent, at any rate; and I think the Applicants

ought to show something approaching a sufficient or proper reason for applying to have the Trade Mark expunged. It certainly is not sufficient reason

that they are at loggerheads with the Respondents or desire in some way to injure them.

44. In (2008) 10 SCC 766 (supra) the word Person aggrieved was explained

47. The concept of the term 'person aggrieved' is different in the context of Section 46 and 56. Section 46 speaks of a private interest while Section 56

speaks of a public interest. Respondent filed a composite application. The Registrar did not think it fit to consider the case from the point of view of

public interest and confined the case to Section 56 of the Act, as would appear from the fact that while sustaining the Respondent's objection under

Section 46(1) and (b) on the ground that the same had not been used by the Appellant for the last twenty years, it was observed:

Having held that Section 46(1)(a) is a bar to the continuation of the impugned mark on the Register as above, I hold that the entry in respect of those

goods for which the Registered Proprietors could not prove their user of the Registered Trade Mark 273758 was wrongly made in the Register and is

wrongly remaining on the Register under Section 56(2) of the Act.

Reference to Section 56(2) of the Act at that place appears to be a typographical mistake. It is palpably wrong. No deliberation was made on the said

question. No fact or contention has been taken note of. There are no discussions; no findings.

45. In 1893 Powell (Trading as Goodall, Backhouse & Company, v. The Birmingham Vinegar Brewery Company, Limited we see how a person can

claim to be aggrieved.

Whenever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade

mark, if remaining on the register, would, or might, limit the legal rights of the applicant, so that by reason of the existence of the entry on the register

he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me he has a locus stand to

be heard as "" person aggrieved."" In the present case I do not think it can be doubted that the rights of any person who was in the trade and who might

desire to make use of the words ""Yorkshire Relis"" would be less if this mark were upon the register than they would be if he were only subject to the

common law liability of being restrained from making any attempt to pass off his goods as the goods of another person.

46. AIR 1963 Bom. 246 (supra) was relied on to show that the demerits of the applicant are irrelevant since the question is between the public and the

Respondent, but if the whole judgment is read we find that the learned Judge of the Bombay High Court held that it is not in all cases that the Tribunal

has jurisdiction to rectify the Register ""on any ground it pleases"" but ""it is only in cases where a mark in its very nature is incapable of registration

under the Act and it is in this connection that the demerits of the applicant are said to be irrelevant.

Now, in considering both Section 46 and Section 10, it has got to be remembered that the primary duty of the Court is towards the public and the

maintenance of purity of the register. When a case is sought to be made out that a particular trade mark is likely to deceive or cause confusion, the

contest is not so much between the parties to the litigation as it is a contest between the party defending his right to a particular trade mark and the

public, and the duty of the Court must always be to protect the public irrespective of what hardship or inconvenience it may cause to a particular party

whose trade mark is likely to deceive or cause confusion. The object of maintaining a trade mark register is that the public should know whose goods

they are buying and with whom particular goods are associated. It is, therefore, essential that the register should not contain trade marks which are

identical or which so closely resemble each other that an unwary purchaser may be likely to be deceived by thinking that he is buying the good; of a

particular person or a particular firm or a particular industry, whereas he is buying the goods of another person or firm or industry.

So this is how one tests public interest and purity of the Register.

47. In *Addley Bourne v. Swan and Edgar* (1903) 20 RPC 105:

No considerations of the rights of third persons arise except as against the person who is on the Register, because he is claiming a monopoly to the

exclusion of the public at large, and if, as the Lord Justice says, the Court finds out in the course of the case that the mark is wrongly on the Register,

however great the demerits of the Applicant, the Court are bound to set the Register right for the benefit of the public at large.

48. So what they say is that it is not necessary for the existence of actual fraud or for proof of deception but what is to be seen is the mark

.....calculated to deceive public"".

49. Now we will apply the above judgments relied on by the applicant to test whether the mark has to be rectified to maintain the purity of the

Register. In *Addley Bourne Case* the Court says that the Register must be set right if the marks will deceive the world to believe something which is

not actually true. We do not see how the continuance of the mark will deceive the public when the mark has become inextricably linked with the

Respondent even in the eyes of the Statutory Authorities.

50. The object of maintaining a trade mark is that the public should know whose goods they are buying and with whom the particular goods are

associated. If so, we must accept the Respondent's submissions that the public knows exactly what to expect when they buy the goods bearing the

mark INFOSYS. Is there any unwary purchaser as mentioned by Hon'ble Bombay High Court who is deceived into thinking that he is buying the

goods of another? We do not think there is. On the other hand many of the persons who have adopted this mark either as a suffix or prefix have faced

infringement action initiated by the Respondent. Therefore, the purity of the Register actually has to be answered in favour of the Respondent.

51. Next we take up William Powell's case. There the goods concerned a sauce known as Yorkshire Relish. Therefore, if a person appropriated the

mark 'Relishes' to himself he would be limiting the legal rights of others by the very existence of his mark. No one who manufactured Yorkshire

Relishes which was a sauce with a particular flavor would be entitled to use it

because of the registration. Therefore they felt that any person who is in the trade would have his rights curtailed if this mark remained on the Register. The House of Lords upheld the order of Chitty J rectifying the Register by expunging the trade mark 'Yorkshire Relishes'. But it would be farfetched for anyone to suggest that continuance of the mark INFOSYS on the Register will curtail the rights of anyone who wants to trade in computer software, hardware or any of the other goods mentioned in classes 7, 9, or 16. No one in the same industry can justifiably say that their legal right to adopt a mark is curtailed because the mark INFOSYS is on the Register.

52. Now we come to 2008 (10) SCC (supra) which merely states that there is public interest involved while invoking Section 56. This is well settled.

53. As regards Hardie's Trading Ltd., we have already extracted from this judgment. It clearly holds that if the ground for rectification is merely based on non-user then the non-user by itself does not render the entry incorrect. The person aggrieved has to show something more and that is that he would be in some possible way be damaged or injured if the trade mark is allowed to stand. The relevant para of the judgment of the Hon'ble Supreme Court is extracted below:

33. But if the ground for rectification is merely based on non-user i.e. under Section 46 of the Act, that is not really on account of any public mischief by way of an incorrect entry. The non-user does not by itself render the entry incorrect but it gives a right to a person whose interest is affected to apply for its removal. An applicant must therefore show that in some possible way he may be damaged or injured if the Trade Mark is allowed to stand; and by "possible" I mean possible in a practical sense, and not merely in a fantastic view..... All cases of this kind, where the original registration is not illegal or improper, ought to be considered as questions of common sense, to a certain extent, at any rate; and I think the Applicants ought to show something approaching a sufficient or proper reason for applying to have the Trade Mark expunged. It certainly is not sufficient reason that they are at loggerheads with the Respondents or desire in some way to injure them.

In fact the extract shows that where the original registration is not illegal or improper, the question that should be considered is a question of common

sense to a certain extent and the applicants must show something approaching a sufficient or proper reason. The Hon'ble Supreme Court also

observed that the fact that the parties are at logger heads with each other cannot be a reason.

54. We are afraid that the present litigation is initiated only for that reason. There is no public interest inspiring the applicant, but pure private interest

that is egging him. We are rather dismayed to hear the submissions on behalf of the applicant that the fact that the applicant had changed their name

must not weigh with us because if they succeed they may revert to Jupiter Infosys. We have to remember the circumstances under which they

changed their name. The applicant was going in for public issue. At that juncture the Hon'ble Madras High Court restrained the applicant from using

the name Infosys. They did not want to stop the public issue. Therefore, they changed their name to Jupiter International and derived the advantage of

public subscription. To put it bluntly they enriched themselves. Now they say it is to comply with the orders of the Court. Taking an advantage by

changing one's position even if it is to comply with the orders of this Court and then to say that we will go back to the status-quo ante would amount to

abusing the process of law. We cannot allow that. What happens to the public subscription, and the money that they earned by the public issue? If the

applicant had been confident of its rights it should have kept in abeyance their public issue and established its legal rights. Then they should have

royally gone public under the name Jupiter Infosys. But having derived a definite advantage and that too a financial benefit it ill-behooves the applicant

to even make such submission. In our opinion neither public interest nor the purity of the register can be answered in favour of the applicant.

55. Now the only question that remains is whether they can be said to be aggrieved under Section 56 because of (a) absence or omissions from the

Register of any entry; (b) any entry made in the Register without sufficient cause; (c) any entry wrongly remaining on the Register; (d) any error or

defect in any entry in the Register. These are the conditions to be satisfied by a person aggrieved who invokes the power under Section 56 of the old

Act. There is no case made out of absence or omission, nor of error or defect. In fact, the applicant claims to be aggrieved by the mark remaining in

the Register. We have already dealt with this from the perspective of public interest and purity of Register and found that there is no ground to hold

that the mark shall not continue in the Register.

56. The comparative strengths of the different categories of trade marks have been graded and the coined or invented word has the greatest strength

and deserves the highest protection. We have already held that the Respondent's mark is a coined word. It has been registered and therefore the

effect of registration is prima facie evidence of its validity. It is therefore incumbent on the applicant to prove that the mark must be removed and shall

not remain in the Register. The applicant's case is that because of non user the mark shall not remain in the Register. Now how is non-user proved?

57. In *Revlon Inc., USA v. Rajendra Kumar Dhawan and Anr.* Indian Penal Code (No. 2) Vol. 1 July 1995 it was held that

...The crucial question is, has the applicant initially proved the non-use of the mark for 5 years? He has stated in his judgment that the application his

affidavit, stated, that he made thorough enquiries in the market, and found that the registered proprietor have not been using marks...

Even if Revlon Inc. had not produced a single scrap of paper in support of their case, it would still be the duty of Sarita to discharge the onus by

proving non-user...

Now, in terms of law, even taking the strictest view thereof possible, Revlon are not called upon to prove use of their mark unless the applicant first

discharge the initial onus of showing non-use of the Revlon Mark for the crucial period of 5 years. On the basis of the above statements of Dhawan,

and on the basis of those alone, how can one hold that any discharge of the initial onus was made by Sarita? To hold that the cryptic statements made

by Dhawan are sufficient discharge of the initial onus, is to hold against all reason and reasonableness, not to mention the Trade Mark Law.

58. The Hon'ble Calcutta High Court in the above case, has dealt with how the onus of proving non-user shall be discharged by the party alleging non-

user. of course that case arose under Section 46(1). But, surely, the guidelines mentioned therein will guide us. In the Revlon case there were certain

affidavits alleging non-user, one of which was described by the learned Judge as a self-serving affidavit. It was observed that even if Revlon had not

produced a single scrap of paper in support of their case, it would still be the duty of Sarita to discharge the onus by proving non-user. The learned

Judge held that the affidavits were identical, they contained common address.

Nothing was proved regarding where were the enquiries about the non-user made, when were the enquiries made, who were the persons involved and what were exact replies. The learned Judge held nothing is stated.

59. Even if we do not apply those exacting standards here in this case and we are willing to be a bit lenient, we must hold that the applicant has

produced no evidence of non-user except to state that the Respondent has been only in the soft-ware business and it has nothing to show that it has

actually used the mark in connection with the goods in the class mentioned above. We cannot dislodge the registration of this mark on the basis of a

mere ipse dixit of the applicant. The Respondent on the other hand had relied on *Tata Consultancy Services v. State of Andhra Pradesh* (2001 STC

198) where sale of software on a CD etc. was held to be sale of goods and that merely because it is intellectual property what is sold cannot fully

decide whether it comes under the purview of goods. That was of course in the context of taxation. It was submitted on behalf of the Respondent that

among the many activities undertaken by the Respondent is included manufacture of computer hardware and embedded hardware systems and that

they have been granted Central Tax Registration in respect of plant and machinery, packaging of goods for sale. It was submitted that the software

can only be sold with hardware and both an inseparable unit and therefore one would be of no-use without the other and that therefore both are goods

of the same description being of the same nature having a same purpose in the same channels of trade. They also referred to the use of their mark in

relation to computer manuals, printed manuals and instruction and teaching materials. It was urged on behalf of the applicant that use of the mark

(1967 RPC p.595 *Hospital World Trade Mark*) for educational purposes and instructional purpose and advertisement purposes (1979 RPC 166 *Update*

Trade Mark) would not amount to use in trade. We have already seen that there is no evidence with regard to non-user produced by the applicant. In

those circumstances, the evidence produced by the Respondent to show that these are the goods in relation to which the mark has been used deserves

to be accepted and while use of the mark in teaching materials may or may not be relevant for the purpose of this Act, computer manuals and printed

manuals which are sold along with the goods of the Respondent would definitely amount to use in relation to trade. The ground of non-user has not

been proved. Further in American Home Products (1986 1 SCC 465) the Hon'ble Supreme Court held

A person who intends to manufacture goods or has made preparations for the manufacture of goods but the manufacture has not commenced and,

therefore, goods have not been marketed is nonetheless entitled to get the trade mark which he proposes to use in relation to those goods registered.

In the present-day world of commerce and industry, a manufacturing industry can neither be commenced nor established overnight. There are

innumerable preparatory steps required to be taken and formalities to be complied with before the manufacture of goods can start and the

manufactured goods marketed. The process must of necessity take time. If the position were that the mere non-user of a trade mark for the period

mentioned in Clause (a) of Section 46(1) would make a trade mark liable to be taken off the Register, it would result in great hardship and cause a

large number of trade marks to be removed from the Register, because the moment one month has elapsed after the registration of a trade mark has

been ordered, a trade rival can make an application on the ground set out in Clause (a) of Section 46(1) claiming there has been no bona fide use of

the trade mark up to a date one month before the date of his application.

Therefore the date of user by the Respondent must be viewed from this perspective.

As held by us earlier, the applicant has no evidence to show non-user.

60 . As regards the certificates not being in the correct name and there being difference in the names of registered proprietor, two being in the name

of Infosys Consultants and one being in the name of Infosys Technology, it was submitted by the Respondent that the name of the Respondent

company had been change din 1992 and the request on Form 16 and TM 43 had also been filed. In any event, unless it is shown that there was a

deliberate attempt to deceive in having a certificate registered in different names and such practice was followed by the Respondent, we have only to

reject this submission. In fact in Hardies Trading, the Hon'ble Supreme Court held that Section 2 (2) (b) which uses the word 'in and whatsoever'

gives a wider meaning to the concept of use of a mark.

61. The applicants relied on the following decisions:

(i) On the issue of fraud - Baker v. Rawson (1891) 8 RPC 89; Ramappa v. B.

Monappa AIR 1957 Mad 76; Dil Prasad Company v. Mercantile

essential Company 1981 PTC 99 Bom.; Meghalaya v. Narsimha Reddy (2010 8 SCC 383); India Household and Healthcare Ltd. v. LG Household

and Healthcare Ltd.: (2007) 5 SCC 510; R. Ravindra Reddy v. H Ramaiah Reddy 2010 3 SCC 214; Anand Kur. Deepak v. Haldiram (1999) PTCX

(19) 466. We have already held that there is no proof of fraud, so it is not necessary to deal with the cases individually.

(ii) On the question that INFOSYS was an invented word - Nestle Products Ltd. v. P. Thankaraja AIR 1978 Mad 336; We have already dealt with

this and hence it is not necessary to deal with the case individually.

(iii) To show how the question relating to bonafide intention to use should be decided: Batts. Trade Mark (1898) 15 RPC 534; Vishnudas Trading v.

Vazir Sultan Tobacco 1997 (4) SCC 201; In re Carters Trade Mark (1898) RPC 262; Edward v. Dennis (1885) Ch. 454. We have dealt with this point

already. So it is not necessary to deal with this judgment individually.

(iv) Trafficking - Vishnudas Trading v. Vazir Sultan Tobacco 1997 (4) SCC 201; In re Carters Trade Mark(1898) RPC 262. In view of our finding

regarding the reputation of the mark and the orders for not registering any new company with the word Infosys, this does not apply.

(v) The word trade meaning in the book - Aristoc v. Rysta (1945) 62 RPC 65; Hospital World Trade Mark (1967) 20 RPC 595; Update Trade Mark

(1979) RPC 166; Add 70 Trade Mark (1986) RPC 89 (TMR). We have dealt with this and in any event non-use is not proved.

(vi) Limitation - Khoday Distillers v. Scotch Whisky (2008 10 SCC 723); Patel Field Marshal Agencies v. P.M. Diesels Ltd. We have referred to this

earlier.

(vii) Person Aggrieved - Hardie Trading Ltd. (2003) 11 SCC 92; Kabushiki Kaisha Toshiba v. Toshiba Appliances Company 2008 (10) SCC 766;

Powells Tm(1894) RPC 8. We have already referred to this citation.

(viii) Purity of Register - Hardie Trading Ltd. (2003) 11 SCC 92; Kabushiki Kaisha Toshiba v. Toshiba Appliances Company 2008 (10) SCC 766. We

have referred to this citation earlier.

(ix) Suo Motu Action by Registrar - C.R. Auluk & Sons Ltd. v. Rita Mechanical Works (1993 PTC 322 Del); Nehkumar v. Mohanlal

MANU/MH/0055/1963 : AIR 1963 Bom 246); Addley Bourne v. Swan and Edgar (1903) 20 RPC 105. We have referred to this citation earlier.

62. To conclude:

- a) the applicant is not 'a person aggrieved' as per Section 46;
- b) the word 'Infosys' is an invented word and distinctive of the Respondent;
- c) non-user is not proved by the applicant;
- d) the question of public interest and purity of Register is answered in favour of the Respondent; and
- e) no grounds for invoking Section 56 are made out.

63. While opening the submissions on behalf of the applicant, the Learned Counsel stated that the stature of the Respondent shall not affect the final

decision. We do not know if it is really a fight between David and Goliath. But if David plays unfair, the umpire cannot rule against Goliath merely

because he is huge. In the result, the applications are dismissed. However, we will not impose costs, only because in the earlier round the applicant

had succeeded and it has come back to us by the orders of the Hon'ble Supreme Court. Miscellaneous petitions No. 146 & 147/2011 are disposed of.

No order as to costs.