



2023:DHC:8923



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

+ CS (COMM) 611/2023, I.A. 16738/2023 &amp; I.A. 16739/2023

INSTITUTE OF DIRECTORS ..... Plaintiff

Through: Mr. Dinesh Jotwani, Ms. Harpreet Oberoi, Mr. Sourabhpreet Singh and Ms. Shivalika Midha, Advs.

versus

WORLDDEVCORP TECHNOLOGY AND BUSINESS SOLUTIONS PVT LTD &amp; ORS. .... Defendants

Through: Mr. Yashpal Singh, Mr. Saurabh Kansal, Mr. Manish Kumar and Mr. Raghav Vig, Advs. for D-1 to 4


**CORAM:****HON'BLE MR. JUSTICE C. HARI SHANKAR****JUDGMENT (ORAL)**

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**11.12.2023****I.A. 16738/2023 [under Order XXXIX Rules 1 and 2 of the CPC]**

1. This judgment adjudicates IA 16738/2023, preferred by the plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC).


2. The following trademarks stand registered in favour of the plaintiff under the Trade Marks Act, 1999:

Trademark	Application No.	Date of filing	Class
	1180935	6 March 2003	16




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INSTITUTE OF DIRECTORS	OF	2535355	22 May 2013	16
INSTITUTE OF DIRECTORS	OF	2535356	22 May 2013	35
		2394163	11 September 2012	41

3. Classes 16, 35 and 41, in which the above marks stand registered pertain to “printed matter namely publications, books, periodicals, magazines, brochures, pamphlets, newsletters, instructional material used for training, stationary items, advertising boards”, “association services catering to management, personal development of directors, and boardroom development” and “arranging and conducting of conferences, seminars and workshops, organizing international conferences & training programs”, respectively.



4. The registration of the  device mark of the plaintiff in Class 41 was subject to a disclaimer, disentitling the plaintiff from claiming any exclusive right over the descriptive matter appearing on the label. No such disclaimer attached to the registration of the plaintiff’s marks in Classes 16 and 35.

5. The plaintiff admittedly uses the aforesaid marks for running an institute as well as for conducting events, networking and other associated activities.



6. The plaintiff is aggrieved by the use, by the defendants, of the



device mark. Defendant 1 has applied for registration of the said mark in class 41 for “education; providing of training; entertainment; sporting and cultural activities”. Mr. Jotwani, learned Counsel for the plaintiff submits that his client’s grievance is essentially against the textual component of the impugned mark, which reads “Directors’ Institute”. He submits that the use, by the defendants, of “Directors’ Institute” is bound to result in confusion in the minds of the public, when seen *vis-à-vis* the plaintiff’s mark “Institute of Directors”, especially as the marks are used for providing similar and allied services. He has invited my attention to certain pages from the internet reflecting the use, by the defendants, of the appellation “Directors’ Institute”, both as a phrase, as well as in the



form of the logos and. Mr. Jotwani has no objection to the defendants using any logo they want to, provided the logo does not contain the text “Directors’ Institute” and “Director’s Institute-World Council of Directors” and/or any other text which is deceptively similar to the plaintiff’s mark “Institute of Directors”, as is likely to create confusion in the public.

7. Mr. Jotwani has also referred to certain messages received by his client which indicate that members of the public were, in fact, being confused as a consequence of the use, by the defendants, of the appellation “Directors’ Institute” to describe themselves.



8. As such, Mr. Jotwani exhorts this Court to injunct the defendants, pending disposal of the present suit, from use of the expression “Directors’ Institute” as part of their mark or to refer to themselves as “Director’s Institute”.

9. Mr. Yashpal Singh, arguing for the defendants, submits that the prayer of the plaintiff is not sustainable as, while applying for



registration of the device mark in Class 41, the plaintiff, in response to an objection raised by the Trademark Registry under Section 9 of the Trade Marks Act, specifically responded thus:

“We humbly submit that the mark IOD INSTITUTE OF DIRECTORS BUILDING TOMORROW’S BOARDS (DEVICE) of the Applicant is in the form of a device. *It is pertinent to note that the words used in the mark are common English language words and are descriptive in nature and cannot belong to any one Proprietor.* The Applied mark should be seen as a whole. It does not have direct reference to the characteristics like kind, quality, quantity or other characteristics of services. Moreover, the mark possess all the necessary pre-requisites laid down by the law to be termed as a mark as defined in section 2(1)(m) of the Trade Marks Act, 1999.”


(Emphasis supplied)

10. Mr. Yashpal Singh submits that the plaintiff has suppressed, from this Court, the aforementioned response dated 8 December 2014 submitted to the Trademarks Registry and that, for this reason too, the plaintiff cannot be held to any equitable relief.

11. As I felt this to be a submission which, if accepted, might not require this Court to enter further into the merits of the matter, I called upon Mr. Jotwani to respond.



12. Mr. Jotwani's submission is that the afore-extracted statement from the response dated 8 December 2014, submitted by the plaintiff to the Trademarks Registry was with respect to the entire textual

matter contained in the device mark , i.e. "IOD Institute of Directors Building Tomorrow's Boards", and not with respect to any particular part thereof.

13. As such, he submits that the said statement cannot disentitle the plaintiff from claiming exclusivity in respect of the words "Institute of Directors", especially when "Institute of Directors" was itself registered in the plaintiff's favour in other classes.

14. Without prejudice, Mr. Jotwani submits that the effect of the aforementioned statement made by the plaintiff before the Trade Marks Registry can, at worst, extend to the plaintiff's right to claim exclusivity in respect of Class 41. He submits that it cannot impact the plaintiff's entitlement arising from the registration of its mark in Classes 16 and 35.

15. Mr. Jotwani has also placed reliance on para 43 of the decision of the Division Bench of this Court in *Raman Kwatra v. KEI Industries Ltd*<sup>1</sup>, which reads as under:

"43. We also find merit in the appellant's contention that a party, that has obtained the registration of a trademark on the basis of certain representation and assertions made before the Trade Marks Registry, would be disentitled for any equitable relief by pleading

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<sup>1</sup> 2023 SCC OnLine Del 38



to the contrary. The learned Single Judge had referred to the decision in the case of *Teleecare Networks India Pvt. Ltd. v. Asus Technology Pvt. Ltd.*<sup>2</sup> holding that after grant of registration neither the Examination Report nor the plaintiff's reply would be relevant. We are unable to agree with the said view. In that case, the Court had also reasoned that that there is no estoppel against statute. Clearly, there is no cavil with the said proposition; however, the said principle has no application in the facts of the present case. A party that has made an assertion that its mark is dissimilar to a cited mark and obtains a registration on the basis of that assertion, is not to be entitled to obtain an interim injunction against the proprietor of the cited mark, on the ground that the mark is deceptively similar. It is settled law that a person is not permitted to approbate and reprobate. A party making contrary assertions is not entitled to any equitable relief.”

16. Mr. Jotwani has also referred me to the decision of a learned Single Judge of this Court in *Mother Sparsh Baby Care Pvt Ltd. v. Aayush Gupta*<sup>3</sup> as well as the judgment in *Automatic Electric Limited v. R. K. Dhawan*<sup>4</sup> which was cited in *Mother Sparsh Baby Care*, to submit that, the defendants having itself applied for registration of the mark “Directors’ Institute”, cannot be heard to contend that the mark “Institute of Directors” is descriptive and, therefore, disentitled to registration.

17. I have heard learned Counsel and considered the rival submissions.

18. This Court is presently examining the matter at a *prima facie* interlocutory stage, under Order XXXIX Rules 1 and 2 of the CPC. Any admission made by either party, which is destructive of the case that it seeks to canvass has, therefore, to be taken into consideration

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<sup>2</sup> 2019 SCC OnLine Del 8739

<sup>3</sup> 2022 SCC OnLine Del 1061

<sup>4</sup> 1999 SCC OnLine Del 27



by the Court while passing orders under Order XXXIX Rules 1 and 2. It would be open to the party, during trial, to seek to escape the said admission. However, at a *prima facie* stage, the admission would operate against the party making it.

**19.** I see no real escape for the plaintiff, from the representation made by it before the Trademarks Registry in its reply dated 8 December 2014 to the FER raised by the Registry, extracted in para 9 *supra*. It is specifically stated, by the plaintiff, in the said paragraph, that “words used in the mark are common English language words and are descriptive in nature *and cannot belong to any one proprietor*”. In one breath, the plaintiff, thereby, admits the textual component of its device mark both to be descriptive as well as to be lacking in distinctive character, by stating that the textual component of the mark constituted of common English words *which could not belong to any one proprietor*.

**20.** Mr. Jotwani, no doubt, sought to read down this assertion, contained in the response dated 8 December 2014, as being applicable to the entire textual matter contained in the device mark, and not merely to the “Institute of Directors” part thereof. Alternatively, he contends that the disclaimer should be read as applying to the individual words, and not to the phrase “Institute of Directors”.

**21.** No such caveat is to be found in the afore-extracted paragraph from the response dated 8 December 2014. What is unambiguously admitted therein, is that *the words used in the marks are common English language words*, and, even more damagingly (for the



plaintiff), that no person was entitled to claim exclusive proprietary rights over the said words. Mr Jotwani's submission that this declaration would either apply to the entire textual matter "IOD Institute of Directors Building Tomorrow's Boards", and not to "Institute of Directors", is, to my mind, clearly unreasonable. If the



words used in the device mark are common English words – as, *prima facie*, they indeed are - over which no one can claim ownership, the plaintiff cannot, quite obviously, claim exclusivity over the words "Institute of Directors", or seek an injunction against the defendants using "Directors' Institute".

22. The alternative submission of Mr. Jotwani that the aforementioned statement contained in the reply dated 8 December 2014 should be restricted to Class 41 also does not, *prima facie*, commend itself to acceptance, either. Indeed, if the words "Institute of Directors" are common English words, over which no one can claim monopoly, the very validity of the remaining registrations held by the plaintiff, which are for the said words as a word mark, may itself be disputable. Words which are descriptive, or indicative of the nature of the services provided, or are lacking in distinctive character, are *ex facie* disentitled to registration under clauses (a) and (b) of Section 9(1)<sup>5</sup>

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<sup>5</sup> 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





respectively, unless the mark has, by dint of continuous user, become well known. Relief against infringement is available, under Section 28(1), only to the holder of a *valid* registration in a trade mark.

23. Though Section 31(1)<sup>6</sup>, no doubt, presumes the fact of registration to be *prima facie* evidence of the validity of the registered mark, the admission, contained in the response dated 8 December 2014 of the plaintiff to the Trade Marks Registry, that the textual part



of the mark consists of normal English words over which no one can claim monopoly seriously jeopardizes the presumption from applying in the plaintiff's favour.

24. In any event, if the words "Institute of Directors" are common English words, over which no one can claim monopoly, that disclaimer would extend to any class in which a person desires to use the said words, and cannot be read as restricted to class 41 merely because the plaintiff chose to make the said statement only in response to the FER raised by the Trademarks Registry against the plaintiff's



application for registration of the device mark in class 41.

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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.

<sup>6</sup> 31. **Registration to be prima facie evidence of validity.**—

- (1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.



25. Para 43 of the *Raman Kwatra*, on which Mr. Jotwani relies, in fact, works against him. The opening sentence of the said paragraph clearly states that “a party, that has obtained the registration of a trademark on the basis of certain representation and assertions made before the Trade Marks Registry, would be disentitled for any equitable relief by pleading to the contrary”. The plaintiff cannot, therefore, today, seek to wish away the representation made by it before the Trade Marks Authority in its reply dated 8 December 2014.

26. The reliance, by Mr. Jotwani, on the remainder of para 43 of *Raman Kwatra* is, in my considered opinion, misguided. The remainder of paragraph 43 essentially examines the aspect of relevance of the representation made by the proprietor of a registered trademark before the Registry of Trademarks while securing registration of the mark, in response to an objection premised on Section 11<sup>7</sup> of the Trade Marks Act, in which a pre-existing mark is

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<sup>7</sup> 11. **Relative grounds for refusal of registration.—**

- (1) Save as provided in Section 12, a trade mark shall not be registered if, because of—
- (a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or
  - (b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,
- there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
- (2) A trade mark which—
- (a) is identical with or similar to an earlier trade mark; and
  - (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor,
- shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.
- (3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented—
- (a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or
  - (b) by virtue of law of copyright.
- (4) Nothing in this section shall prevent the registration of a trade mark where the proprietor



put up as a rival trademark. In that context, the Division Bench has held that the representation made before the Trademarks Registry would be relevant where the rival mark of which the plaintiff seeks registration is the impugned mark of the defendant. The principle that

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of the earlier trade mark or other earlier right consents to the registration, and in such case the Registrar may register the mark under special circumstances under Section 12.

(5) A trade mark shall not be refused registration on the grounds specified in sub-sections (2) and (3), unless objection on any one or more of those grounds is raised in opposition proceedings by the proprietor of the earlier trade mark.

(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

- (i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;
- (ii) the duration, extent and geographical area of any use of that trade mark;
- (iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;
- (iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;
- (v) the record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

(7) The Registrar shall, while determining as to whether a trade mark is known or recognised in a relevant section of the public for the purposes of sub-section (6), take into account—

- (i) the number of actual or potential consumers of the goods or services;
- (ii) the number of persons involved in the channels of distribution of the goods or services;
- (iii) the business circles dealing with the goods or services,

to which that trade mark applies.

(8) Where a trade mark has been determined to be well-known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.

(9) The Registrar shall not require as a condition, for determining whether a trade mark is a well known trade mark, any of the following, namely:—

- (i) that the trade mark has been used in India;
- (ii) that the trade mark has been registered;
- (iii) that the application for registration of the trade mark has been filed in India;
- (iv) that the trade mark—
  - (a) is well-known in; or
  - (b) has been registered in; or
  - (c) in respect of which an application for registration has been filed in, any jurisdiction other than India; or
- (v) that the trade mark is well-known to the public at large in India.

(10) While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall—

- (i) protect a well-known trade mark against the identical or similar trade marks;
- (ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark.

(11) Where a trade mark has been registered in good faith disclosing the material informations to the Registrar or where right to a trade mark has been acquired through use in good faith before the commencement of this Act, then, nothing in this Act shall prejudice the validity of the registration of that trade mark or right to use that trade mark on the ground that such trade mark is identical with or similar to a well-known trade mark.



the Division Bench has laid down is that, having obtained registration by pleading that the mark asserted in the plaint is dissimilar to the defendant's mark, which was set up as a rival competing mark by the Trade Marks Registry, the plaintiff cannot use the registration to seek an injunction against the defendant in respect of the very same mark.

**27.** That principle has no application whatsoever to the present case, as the statement made by the plaintiff to the Trade Marks Registry, in its response dated 8 December 2014, is not in the context of Section 11, but in the context of Section 9 of the Trademarks Act.

**28.** It is well settled that words of ordinary English usage cannot be monopolised. Else, the entire English language would be appropriated by a few, which can obviously not be permitted. There is, therefore, in Section 9(1)(a), an absolute proscription to registration of marks which are inherently lacking in distinctiveness, in that they are incapable of distinguishing the goods or services of one person from those of another. Words of common English usage fall within this category. It is only if the mark has attained secondary significance, by dint of continuous usage and is entitled, therefore, to the benefit of proviso to Section 9(1), that such a mark can be registered. Otherwise, words of common English usage, even when put together to form a phrase of common English usage, cannot be registered. No monopoly can be claimed by the registrant of such a mark.

**29.** In the present case, the statement made by the Plaintiff before the Trade Marks Registry in its reply dated 8 December 2014, in my



considered opinion, defeats its case at least at this *prima facie* stage. Having held out, to the Trade Marks Registry, that the words used in



the device mark, were words of common English usage, which could not be said to belong to any one proprietor, the plaintiff is, *prima facie*, disentitled from seeking an injunction against the use, by the defendants, of the words “Directors’ Institute”.


**30.** The decision in *Mother Sparsh Baby Care* and other decisions cited in the said judgment, to which Mr. Jotwani drew attention, are essentially decisions which deal with descriptive marks. Though Mr. Jotwani also referred to the judgment in *Living Media India Ltd. v. Jitender V. Jain*<sup>8</sup>, which was relied upon in *Mother Sparsh Baby Care*, that decision, too, cannot really help the plaintiff. That was a case in which the Court held, while dealing with the mark “AAJ TAK” that, though, “AAJ” and “TAK”, individually seen, were words of common usage, the word “AAJ TAK”, once registered as a trade mark, was entitled to claim monopoly. That decision was rendered because of the distinctive use of the word “AAJ TAK”, which was used as a specific device mark, over the whole of which monopoly was claimed. Even otherwise, that was not a case in which there was a representation made by the plaintiff before the Trade Marks Registry to the effect that the words used in the mark were words of common usage, which did not belong to any one proprietor.

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<sup>8</sup> 2002 SCC OnLine Del 605



**31.** Trademark rights can be claimed only by the proprietor of the mark. The statement, in the response dated 8 December 2014, that the

textual components of the device mark  were English words of common usage, which could not belong to any one proprietor, *prima facie* defeats the plaintiff's right to claim exclusivity over the words "Institute of Directors". Proprietary rights are a *sine qua non* for a claim to exclusivity to be sustained. Absent proprietary rights over a mark, there can be no exclusivity.

**32.** Obtaining of a registration in respect of a mark which consists of common English words is fraught with the possibility of its own adverse sequelae. While obtaining registration of such a mark, the registrant has to be conscious that, the mark being a combination of ordinary English words, and, in fact, as in the present case, being a mark as non-distinctive as "Institute of Directors", there is every possibility of a similar mark being used by another person. Commonly used words, or a non-distinctive combination of commonly used words, cannot be monopolised by any one person, so as to disentitle the rest of the world to the use thereof.

**33.** For all these reasons, therefore, the plaintiff's claim to exclusivity over the words "Institute of Directors" and, therefore, the prayer for a restraint against the defendants' using the words "Directors Institute" cannot, *prima facie*, sustain.



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**34.** Additionally, I am in agreement with Mr. Yashpal Singh that, in keeping with the requirement of fair disclosure, which is an indispensable prerequisite to any entitlement to equitable relief, it was incumbent on the plaintiff to place the aforesaid reply dated 8 December 2014, as tendered to the Trade Marks Registry, on record. This, additionally, is a ground which operates to disentitle the plaintiff to equitable relief in the present application.

### **Conclusion**

**35.** The prayer for interim injunction is declined. IA 16738/2023 stands dismissed accordingly.

**C.HARI SHANKAR, J**

**DECEMBER 11, 2023**

ar/dsn

*Click here to check corrigendum, if any*