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

\+ C.A.(COMM.IPD-TM) 150/2021

XIAOMI INC ..... Appellant

Through: Mr. Prithvi Singh and Mr. Vardaan Anand, Advocates.

versus

THE REGISTRAR OF TRADE MARKS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advocates.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 21.02.2023

1. Appellant impugns the Statement of Grounds of decision dated 02nd November, 2018 [hereinafter "*impugned decision*"] whereby its Trade Mark Application No. 2719192 for registration of the mark 'MI WIFI' [hereinafter "*subject mark*"] under Class-09, was refused.

2. Mr. Prithvi Singh, counsel for Appellant contends that the objection in the Examination Report dated 09th September, 2015, pertained to only Section 9(1)(*a*) and 11 of the Trade Marks Act, 1999 [hereinafter "*the Act*"]; however, the impugned decision rejects the application instead under Section 9(1)(*b*) in addition to Section 11 of the Act. Thus, he states that Appellant was never afforded any opportunity to meet the objection under Section 9(1)(*b*).

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3. Relevant portion of the Examination Report and the Impugned Decision are extracted hereinbelow for quick reference:

Examination Report

> *"The above mentioned application has been examined under the provisions of Trade Mark Act, 1999 and Trade Mark Rules,2002 and the trade mark applied for is open to objection under the following sections:*
> *1. The trade marks-which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or serves of one person from those of another person;*
> *2. The Trade Mark application is open to objection on relative grounds of refusal under Section 11 of the Act because the same/similar trade mark(s) is/are already on record of the register for the same or similar goods/services. The detail of same/similar trade marks is enclosed herewith.*
> *Save as provided in Sec.12, a trade mark shall not be registered if, because of-its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark.*"

Impugned Decision

> "*Adv. Aastha APPEARED ____* [sic] *AND REPLY IS ALSO NOT SATISFACTORY TO EXAMINATION REPORT ,MARK IS NOT DISTINCTIVE* ***BUT DESCRIPTIVE IN NATURE SO OBJ U/S 9 SUSTAIN MOREVER IT IS PROPOSED TO BE USED SO BENEFIT OF PROVISO OF SEC.9 IS NOT PROVIDED, HENCE REFUSED.*** [sic]
>
> **9- Absolute grounds for refusal of registration.*
> *****9(1)(b)*** [sic]*- The trade mark is devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person form those of another person:*
> **11(1)(a)- Relative grounds for refusal of registration. - The said trade Mark is refused for registration because of its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or*"
>
> [Emphasis supplied]

4. Considering the above, instead of remanding the matter back for fresh consideration, the court has given full opportunity to Appellant's counsel to

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make good the objection under Section 9(1)(*b*) of the Act. Mr. Singh argues that the subject mark is not descriptive in nature, it is inherently distinctive and capable of registration. He clarifies that no exclusivity is being claimed over the word 'WIFI'. He further submits that 'MI' is Appellant's house mark and has been registered in several classes, enumerated in page No. 8 of the appeal paper book. The trademark 'MI' is arbitrary for the class of goods for which it is applied for and is therefore, distinctive, and capable for functioning as a trademark. Additionally, it is contended that the said mark, on account of long and continuous use has acquired distinctiveness in respect of Appellant's goods and services and has become a renowned and established mark amongst public and trade alike. It thus serves as a source identifier to distinguish the goods and business of the Appellant from those of others.

5. Heard. The subject mark comprises of two words 'MI' and 'WIFI'. The word 'MI' is Appellant's house mark, which also forms part of Appellant's logo and is registered under several classes. As per information displayed on Appellant's website, 'MI' is an abbreviation for "Mobile Internet".[1] While the word 'MI' has no meaning in English language (although, is used as an abbreviation for "mile"), it does have meaning in Spanish and Chinese languages. However, the meaning ascribed in those foreign languages has no connection with the class of goods applied for and is thus, inherently distinctive. The crux of the matter is the suffix 'WIFI' for which, Appellant is not claiming any exclusive rights, but desires to be included as an integral part of the subject mark.

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6. While conducting an online search of the term 'WIFI' (sometimes used interchangeably with 'Wi-Fi'), one can see that it is identified as both a proper noun and a trademark. As a proper noun it means "*a wireless networking technology that allows communication between computers and other devices*".[2] As a trademark, 'Wi-Fi' serves as a certification mark used to certify "*interoperability of wireless computer devices*".[3] The intention of a certification mark is to demonstrate that goods or services connected with the mark satisfy certain prescribed criterion/ qualifications. Wi-Fi™ Alliance is the entity that provides certification marks *inter alia* 'Wi-Fi®' and 'Wi-Fi CERTIFIED™' to its "*Members and Registered Affiliate Members*" by way of a Certification Mark License Agreement. 'Wi-Fi CERTIFIED™' Logo is an internationally recognized seal of approval for products indicating that they have met industry-agreed standards for interoperability, security, and a range of application specific protocols.[4] Furthermore, Wi-Fi™ Alliance has been granted a certification mark registration in India for its device mark - Wi Fi CERTIFIED , which is valid and subsisting.[5]

7. Appellant's application under Class-09 is broad-based and exhaustive covering all kinds of computers and computer-related hardware, including

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[1] *Refer*: https://www.mi.com/global/about#:~:text=OUR%20LOGO,defy%20in%20our%20early%20days.
[2] *Refer*: Collins Dictionary: https://www.collinsdictionary.com/dictionary/english/wi-fi
[3] *Refer*: Merriam Webster Dictionary: https://www.merriam-webster.com/dictionary/Wi-Fi
[4] *Refer*: Wi-Fi™ Alliance, June 2019, https://www.wi-fi.org/downloads-public/Wi-Fi_Alliance_Brand_Style_Guide_202006.pdf/7717, Additional Requirements for Certification Marks in Logo Form, page No. 7.
[5] *Vide* Trade Mark Application No. 1096259 under Class-09.

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computer networks, transmitters of electronic signals, etc., which is described in application as under:

> *"'MI WIFI" under application no. 2719192 in class 09 in respect of "Computer hardware, computer software and computer peripherals for communication between multiple computers and between computers and local and global computer networks; network routers; wireless routers; computer network hubs, switches, adapters and routers; connection cables, servers and routers; modems and modem cables; computer hardware and software for use in connecting computers with televisions, projectors, monitors or other display devices over electronic, optical, or wireless communications networks; computer storage device for back-up, storage and access of electronic data through local and remote computer networks; transponders: transmitters of electronic signals.*"

8. The use of the word 'WIFI', a slight alteration of the certification mark 'Wi-Fi', as part of a trademark on any product can lead to confusion in the minds of the purchasing public identifying the same to be certified by Wi-Fi™ Alliance or other such organisation. As the Appellant intends to use the subject mark for a host of products described above such as routers, range extenders, etc. the use of the certification mark can be misleading and would constitute as false advertisement if the product otherwise does not meet the standards set up for certification, particularly since the word 'WIFI' is identified in the minds of purchasing public to be common for goods/ technology, rather than a particular brand. Relevant purchasing public would understand 'WIFI' indicative of the genus of goods relating to wireless networking technologies. Thus, objection raised by Respondent under Section 9(1)(*b*) of the Act is sustained.

9. Now we proceed to deal with objection under Section 11 of the Act. The word mark 'M.I' is presently registered under Trade Mark Application

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No. 1363513, against which Appellant has filed its opposition and has initiated rectification proceedings. In order to overcome the said objection, Appellant asserts that the subject mark is distinguishable and the two marks should be compared as a whole. It is highlighted that the subject mark is 'MI WIFI', is dissimilar to 'MI'. In the opinion of the Court, when Appellant is not claiming any exclusivity over the word 'WIFI', the addition thereof to the house mark 'MI' appears to be to only prevail over the cited registered word mark *i.e.*, 'M.I' (*vide* Trade Mark Application No. 1363513). At first blush, Appellant's argument about dissimilarity may seem plausible, but upon closer examination, it becomes clear that it is without merit. As 'WIFI', has acquired generic meaning and 'Wi-Fi' is a certification mark, it can also be utilised by the registered owner of conflicting mark descriptively or as certification mark. In such an event, the perceived dissimilarity would become non-existent. Therefore, 'WIFI' cannot serve as a distinguishing feature. Even if a disclaimer or a condition is put on the word 'WIFI', in the opinion of the Court, it would not resolve the issue. Firstly, disclaimers are never communicated to the public at large, and secondly, the word 'WIFI' is also used as a generic term common to trade. The comparison has to be of the distinctive elements in the subject mark, on which exclusivity is being claimed rather than the generic word. Thus, the objection under Section 11 of the Act, of prior registered mark, is also sustained.

10. It must also be noted that the Appellant has not argued that it has taken the permission and/ or consent for use a certification mark from any organisation/ entity to be incorporated as part of its subject mark.

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11. For the fore-going reasons, the Court is not inclined to interfere with the impugned decision.

12. Dismissed.

SANJEEV NARULA, J

FEBRUARY 21, 2023
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(Corrected and released on: 06th March, 2023)

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