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

\+ C.A.(COMM.IPD-TM) 166/2021

STATE STREET CORPORATION ..... Appellant

Through: Mr. Omesh Puri, Ms. Aparajita Nigam, Ms. Swati Mittal, Mr. Gautam Kumar, Ms. Sanobar Faisal and Mr. Dhruv Tandan, Advocates.

versus

THE REGISTRAR OF TRADE MARK ..... 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

% 27.04.2023

1. The present appeal concerns refusal of Trade Mark Application No. 2548103 for the device mark ‘ IFS | INTERNATIONAL FUND SERVICES A State Street Company ’ under Class-35 for services “*Administration and management services rendered to financial service providers, namely, record keeping services, fund accounting services, regulatory reporting of information relating to hedge funds, electronic processing of orders for others and providing assistance in management of business activities relating to alternative investments*” [hereinafter “*subject mark*”].

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2. Registration for the subject mark stands refused *vide* order dated 15th October, 2019, supported by the statement of grounds of reasons dated 03rd January, 2020 [hereinafter separately "*Refusal Order*" and "*Statement of Grounds*", respectively and collectively "*Impugned Orders*"]. Reasons disclosed in Statement of Grounds are culled out hereinbelow:

> "The Trademark application is refused on account of following grounds: Section 9(1)(a):- The trade mark is 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.
>
> The Trademark "IFS INTERNATIONAL FUND SERVICES" is devoid of any distinctive character. The mark is a combination of non-distinctive words which are commonly in use. The Present case also does not fall in category of "proviso" to Section 9(1) as the said mark is filed on proposed to be used basis.
>
> Proposed to be used: The Trademark filed on proposed to be used basis. Written submission filed by applicant perused. However It is the matter of record that the applicant mark is registered in various countries, but the applicant has failed to establish the distinctiveness by filing of supporting documents.
>
> The objections raised in the Examination Report under section 9(1)(a) of the Trade Marks Act, 1999 cannot be waived. After perusal of records and submissions by the attorney. In this regard, the registration of the mark is objectionable under section 9(1)(a) of the trademarks act, 1999." [sic.]
>
> [Underscoring supplied]

3. The Senior Examiner has held that the subject mark is objectionable under Section 9(1)(*a*) of the Trade Marks Act, 1999 [hereinafter "*the Act*"] as it is an acronym of the services applied for by the proprietor/ Appellant.

4. The Court has heard the counsel for the parties. The subject mark has to be seen as a whole. The same comprises of three elements: (i) a combination of atypical letters/ acronym "IFS", (ii) the words "International Fund Services", and (iii) the words "A State Street Company" [hereinafter

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separately "*first element*", "*second element*" and "*third element*", respectively and collectively "*elements*"]. All of these elements are placed in a specific representation with the first element featuring on the left side; second element and third element written on the right side, one above the other.

4.1. *Re: first element ('IFS')* – The subject mark is a combination of atypical letters which, by itself, have no meaning whatsoever. It is derived from Appellant's alternative investment solution division which reinforces the exclusive association of the subject mark with the Appellant.

4.2. *Re: second element ('International Fund Services')* – Appellant asserts that it is a financial holding company which provides 'International Fund Services' through acquisitions as part of its investment-related services. Even if the second element of the mark is indicative of the services rendered by the Appellant falling under Class-35, however, the device mark has to be seen as a whole and cannot be viewed independently/ dissected so as to deny registration of the same. Moreover, Appellant has not claimed any exclusivity over the second element.

4.3. *Re: third element ('A State Street Company')* – The said mark is the trading name of the Appellant-corporation and is arbitrary in nature having no nexus of the goods or services rendered by the Appellant. Moreover, Appellant has the following marks registered in its favour: (i) word mark 'STATE STREET', which forms part of the third element of subject mark and also the name of the Appellant-corporation, which has been granted registration under Classes-36 under Trade Mark No. 1456330; (ii) word mark 'STATE STREET PRIVATE EQUITY INDEX' under Trade Mark No. 1625854 under Class-35; (iii) device mark

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‘ STATE STREET GLOBAL ADVISORS ’ under Trade Mark No. 1730305 under Class-36.

5. Considering the above, since the subject mark is distinctive, Senior Examiner’s reliance placed on the proviso to Section 9(1) of the Act, cited in the Statement of Grounds is misconceived. The subject mark is capable of distinguishing its services from another and thus, the objection under Section 9(1)(*a*) of the Act cannot be sustained.

6. For the foregoing reasons, the present appeal is allowed with the following directions:

(i) Impugned Orders are set-aside.

(ii) Trade Marks Registry is directed to process the registration application for the subject mark.

(iii) Subject mark be advertised within a period of three months from today.

(iv) If there is any opposition, the same shall be decided on its own merits, uninfluenced by observations made hereinabove.

(v) The rights in subject mark shall be restricted to combination of words comprising the mark.

(vi) It is clarified the subject mark shall not grant any exclusive rights in the words ‘International’ or ‘Fund’ or ‘Services’, separately or individually. This disclaimer/ condition and limitation shall be reflected in the Trade Marks Journal at the time of advertisement if the subject mark ultimately proceeds for registration.

7. With the above directions, the appeal is disposed of along with pending application(s), if any.

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8. Registry is directed to supply a copy of the present order to the Trade Marks Registry at llc-ipo@gov.in for compliance.

SANJEEV NARULA, J

APRIL 27, 2023
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(Corrected and released on: 08th May, 2023)

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