

MANU/IC/5000/2007

Equivalent Citation: MIPR2007(3)260, 2007(35)PTC915(IPAB)

INTELLECTUAL PROPERTY APPELLATE BOARD, CHENNAI

ORA/86/2006/TM/CH

Decided On: 28.08.2007

Appellants: **Computer Sciences Corporation**
Vs.

Respondent: **Mr. R. Thangaraj, CSC Computer Education**

Hon'ble Judges/Coram:

M.H.S. Ansari, J. (Chairman) and S. Usha, Member (T)

Counsels:

For Appellant/Petitioner/Plaintiff: Prathiba M. Singh, Adv.

For Respondents/Defendant: None

Subject: Intellectual Property Rights

Acts/Rules/Orders:

Trade Marks Act, 1999 - Sections 9(1), 11, 11(1), 11(2), 11(3), 11(6), 12 and 18

Cases Referred:

Austin Nichols & Co. v. Arvind Behl and Anr. 2006 (32) PTC 133 (Del); Milment Oftho Industries and Ors. v. Allergan Inc. 2004 (28) PTC 585 (SC)

Disposition:

Application allowed

Citing Reference:

Discussed 2

Case Note:

Intellectual Property Rights - Trademarks - Prior user of trademark - Section 18 of Trade Marks Act - Applicant-company, registered proprietor of the trademark CSC in India and worldwide, filed application for cancellation of Respondent-company's trademark "CSC Computer Education" on the ground of prior user of a registered similar trade mark with respect to similar business - Held, the Applicant-company has established that it is the prior adopter and user of the trade mark 'CSC', worldwide, and therefore, the proprietor - Hence, a similar trade mark by the Respondent ought to be refused registration under Section 18 of the Act - Application allowed

Intellectual Property Rights - Trade marks - Distinctive character of a trademark - Refusal of registration in the absence of distinctive character for a trade mark - Section 9(1) (a) of Trade mark Act - Applicant-company filed application for cancellation of trade mark of Respondent-company on ground that the mark in question, 'CSC Computer Education', was devoid of any distinctive character that could distinguish the goods or services of the Respondent from those of the Applicant-company - Held, the word 'CSC' could only have acquired distinctive character as a result of use made of it or if it was already a well known mark - With regard to the date of user of the mark by the Respondent it had stated in its application for registration as 'proposed to be used' - Therefore, question of the mark acquiring distinctiveness by use by the date of application does not arise - It should have, therefore, been refused registration under the absolute grounds for refusal under Section 9(1) (a) of the Act - Application allowed

Intellectual Property Rights - Trademarks - Deceptively similar trade mark and likelihood of confusion - Refusal of registration - Applicant-company contended that the trade mark of Respondent was deceptively similar to its trade mark and therefore there was likelihood of confusion and the same ought to be cancelled on above grounds - Held, because of the similarity between the rival marks and the services covered by the two marks there exists, undoubtedly, a likelihood of confusion on the part of public and, therefore, falls foul of Section 11(1)(a) of the Act -

Ratio Decidendi:

“Registration of a trade mark has to be refused under Section 18 of Trade mark Act, if a party establishes that it is the prior adopter and user of a similar trademark.”

“Registration of a trade mark has to be refused under Section 9(1) (a) of Trade mark Act if the trade mark in question has not acquired a distinctive character of its own. “

“Registration of a trademark can be cancelled if said trade mark is deceptively similar to another trade mark and there is likelihood of confusion among the public about the same.”

ORDER

M.H.S. Ansari, J. (Chairman)

1. Instant application is filed for cancellation/expunging from the Register of Trade Marks the trade mark 'CSC Computer Education' bearing registration No. 796910 in class 16 in respect of "paper and paper articles, cardboard and cardboard articles, printed matter, newspapers and periodicals books, book-binding material, photographs, stationery, adhesive materials (stationer); artists materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than apparatus); playing cards; (printers) type and cliches (stereotypes", registered in the name of Mr. R. Thangaraj trading as 'CSC Computer Education'.

2. Notice in Form-C was issued to the respondent by the Registry of this Board on 19.9.2006 by way of registered post/parcel. But as neither the acknowledgement card nor the cover was returned unserved the post office was requested to confirm service upon the respondent and applicant was also directed to send the rectification application along with the enclosures as filed before the IPAB and furnish proof of service. The postal authorities by their letter dated 1.5.2007 informed the Registry that the registered parcel was delivered on 24.9.2006. Learned Counsel for the applicant also served the entire set vide their letter dated 24.4.2007 and filed the courier receipt. Despite the same none has appeared on behalf of the respondent.

3. We heard Ms. Prathiba M. Singh assisted by Shri Sudeep Chatterjee learned Counsel for the applicant at Chennai on 20.8.2007.

4. It is the case of the applicant company that it is a globally recognised company in the field of information technology, having its head quarters in the USA, it being the third largest IT services company in the world having global presence in more than 80 countries. The applicant company (Computer Sciences Corporation) was found in the year 1959 in the USA and claims to have the distinction of having developed more systems software than any other computer services company in the industry. The achievements of CSC included a contract to support NASA Jet Propulsion Laboratory's Flight Operation Facility in 1961 and also claims to be the first software company to be listed on the US Stock Exchange in 1963. The applicant company and its group of companies today employ around 78,000 people worldwide in approximately 80 countries. In the late 1980s the applicant company started to expand its business in various countries outside the USA. In the year 2000 it acquired Policy Management Systems Corporation, a group company of Mynd Corporation. The acquisition of the said company in India was completed in the year 2001 and subsequently its name was changed to Computer Sciences Corporation India Pvt. Limited in 2001 (See Exhibit B). It is the case of the applicant company that its operations in India is the third largest location of CSC worldwide. It is also one of the applicant company's World Sourcing centers. In India it operates across four locations, namely Noida, Indore, Hyderabad and Chennai. The applicant company has been using the trade mark/corporate name since its inception and by its continuous and extensive use and advertising the mark 'CSC' has become distinctive to the applicants all over the world including India. The applicant company is the registered proprietor of the mark CSC in India and also in a large number of countries worldwide. The list of worldwide registration of the mark 'CSC' of the applicants are exhibited and marked as exhibit D collectively. In India the mark 'CSC' has been registered in class 9,16,36,38 and 42 on 14.12.2004. The applicant company is the proprietor under the Trade marks Act, 1999 (hereinafter referred to as the Act) in respect of trade mark 'CSC' abbreviated form or its full name 'Computer Sciences Corporation' in India and several of its applications for registration of the trade mark are pending, list whereof has been furnished in para 19 of the affidavit of evidence in support of rectification. The applicant company, by virtue of its trade mark claimed exclusive right to use the registered trade mark/name 'CSC', which it claims has acquired distinctive name within the computer industry, all across the world, including India. The goodwill and reputation vested in the mark has made it distinctive to the applicant company. The applicant claims that its trade mark is a well known mark. It satisfies all tests of a 'well known mark". The mark 'CSC' is completely within the knowledge of and is recognised by the relevant section of the public who are dealing in computer and IT industry.

5. The grievance of the applicant company is that the respondent has obtained registration for the trade mark 'CSC Computer Education' in his name under registration No. 796910 in class 16 vide certificate No. 314237 dated 8.2.2005. The application for registration of the trade mark was filed by the respondent on 30.3.1998 as 'proposed to be used'. The respondent through its company CSC Computer Education are not only using the mark which is deceptively similar to the applicant's mark but are also claiming to be providing computer

manupatra services to the public by using the identical corporate name of the applicant company. It is stated that respondent is obviously aware of the global reputation of the applicant company and is trying to build up its business by using the mark of the applicant company. The respondent's mark 'CSC' is identical to that of the applicant company. It is obviously being used to create confusion. In fact confusion has been caused in one instance wherein some persons who may have seen the respondent's advertisement have directed e-mail through the applicant company believing them to be same.

6. Learned Counsel for the applicant Ms. Prathiba Singh contended that the predominant feature of respondent's mark CSC is identical to that of the applicant's registered mark and, therefore, it was not entitled to registration under Sections 9(1) (a), 11, 12 and 18 of the Act. It was further contended that the respondent cannot have any proprietary rights in the trade mark CSC in any form by merely adding prefix or suffix in the applicant's registered trade mark. Applicant's registered trade mark being a well known mark satisfying the tests laid down in Section 11(6) of the Act is entitled to be protected under the Act. It was stressed by the learned Counsel for the applicant that the applicant company was incorporated in 1959 in the USA and since then it has grown to be the third largest IT services company in the world having global presence in more than 80 countries. The applicant company's activities in the field of information technology have been covered by a large number of national daily newspapers. The learned Counsel drew our attention to exhibit 'C' (pages 35 to 75). She also drew our attention to the registrations obtained by the applicant company in respect of its trade mark 'CSC' both in India and worldwide, some of which have been filed as exhibits to the affidavit.

7. Learned Counsel Ms. Prathiba Singh referring to a judgment of the learned single Judge of Delhi High Court in **Austin Nichols & Co. v. Arvind Behl and Anr.** 2006 (32) PTC 133 (Del) drew our attention to the following observations:

I am of the view that the decision of the Supreme Court in Milmet is fully applicable to the facts of the present case and merely being first past the post in India is not enough. The plaintiffs were first past the post worldwide and this is of crucial importance.

8. Learned Counsel submitted that the Supreme Court in **Milment Oftho Industries and Ors. v. Allergan Inc.** 2004 (28) PTC 585 (SC) held that "the ultimate test should be who is first in the market". It was, therefore, contended that even if it is assumed without admitting and for the sake of argument that respondent was earlier in point of time in obtaining registration of its mark in India, then on the authority of the above two judgments cited applicant company is entitled to the protection of its registered trade mark as it was first in the world market and also because applicant's mark is a well known mark it is entitled to protection under Section 11 of the Act. The applicant company is first in the global market to have invented, adopted and used the mark 'CSC' which is also the trade name of the company.

9. Learned Counsel has taken us through the evidence in support of the rectification application, namely the affidavit and exhibits thereto. The trade mark of the applicant company 'CSC' is registered in class 16 on 14.12.2004 as can be seen from para 19 of the affidavit. This is apart from the fact that the applicant company's trade mark 'CSC' and 'Computer Sciences Corporation' which is also the trading name was already registered worldwide (see pages 76 to 83 Exhibit D) and certain other applications in respect thereof in other classes are pending registration. Respondent's trade mark is 'CSC Computer Education'. The distinguishing feature between the rival marks is the suffix "Computer Education" in the respondent's registered mark. The predominant feature of the rival marks, however, is CSC which is identical in both marks. The two marks are registered in the same class and therefore, the only question is whether the applicant is the first user and adopter of the mark. It cannot be denied, more particularly from the un rebutted and unchallenged affidavit of Sudar Viswanathan and the exhibits A to H proved on record as evidence by the applicant company that it has a global presence, starting in 1959 in USA when it was incorporated and in 1960s it became a premier developer of custom software and by the late 1980s its business expanded to various countries outside the USA. It has received numerous awards for achievements in business and technology (see page 74). Its global commercial revenue is in the region of \$ 2 billion (see page 71) It acquired an Indian company in India whose name was later changed to Computer Sciences Corporation India Pvt. Limited in 2001. Today the applicant company employees more than 8000 IT professionals in India alone operating from four well known locations in India. Its trade mark and trade name is associated with the business of the applicant in computer and information technology. It is the registered proprietor of the mark 'CSC' as also Computer Sciences Corporation in India and also in a large number of countries worldwide. Apposite in this connection are the observations in **Austin Nichols & Co. v. Arvind Behl and Anr.** (cited supra) which are to the following effect:

...because of huge advances made in information and communication technology over the years, I think it is too late for the defendants to seriously urge that the regular sale of a product in one or more foreign countries would be unknown to persons living in India. I would, therefore, hold that the plaintiffs having come out with 'Blenders Pride' whisky first in the international market were first past the post; even though the defendants were the first to do so in India.

10. As other judgments relied upon by the learned Counsel for the applicant company have been referred to in

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the judgment of the Delhi High Court in Austin Nichols case (supra) therefore, we do not wish to cite them here once again. Also as none has appeared on behalf of the respondent we are not inclined to go into the question as to whether the applicant company's trade mark is a "well known mark", that question is left open. Suffice it to state here that the applicant company has established before us that it is the prior adopter and user of the trade mark 'CSC', worldwide, and therefore, the proprietor; similar trade mark by respondent ought to have been refused registration under Section 18 of the Act. We also uphold the contention of learned Counsel for the applicant Ms. Prathiba Singh that the mark 'CSC Computer Education' was devoid of any distinctive character i.e. to say it is not capable of distinguishing the goods or services of the respondent from those of the applicant company as on the date of application. The word 'CSC' could only have acquired distinctive character as a result of use made of it or if it was already a well known mark. With regard to the date of user of the mark by the respondent it had stated in its application for registration as 'proposed to be used'. Therefore, the question of the mark acquiring distinctiveness by use by the date of application does not arise. It should have, therefore, been refused registration under the absolute grounds for refusal under Section 9(1) (a) of the Act.

11. Because of the similarity between the rival marks and the services covered by the two marks there exists, undoubtedly, a likelihood of confusion on the part of public and, therefore, falls foul of Section 11(1)(a) of the Act.

12. As already stated we are not going into the question as to whether the trade mark of the applicant is a well known mark and therefore, the objections under Section 11(2) and (3) are not being considered and are left open.

13. For the reasons aforesaid the rectification application is accordingly allowed. It is directed that the trade mark 'CSC Computer Education' bearing registration No. 796910 in class 16 registered in the name of Mr. R. Thangaraj trading as 'CSC Computer Education', respondent herein be removed from the Register of Trade Marks. However, in the facts and circumstances of the case there shall be no order as to costs. A copy of this order be also sent to the Registrar of Trade Marks.