

Delhi High Court

Agatha Christie Limited vs Registrar Of Trade Marks on 8 December, 2021

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* IN THE HIGH COURT OF DELHI AT NEW DELHI

+ C.A.(COMM.IPD-TM) 10/2021 & I.A.14878/2021, I.A.14879/2021, I.A.14880/2021, I.A.14881/2021,

AGATHA CHRISTIE LIMITEDAppellant
Through: Ms. Aamna Hasan, Mr.
Vaibhav Vutts and Ms. Shrutika Misra,
Adv.

versus

REGISTRAR OF TRADE MARKS Respondent
Through: Mr. Harish Vaidyanathan
Shankar, CGSC with Ms. Bushra Kazim and
Mr. Karan Chhibber, Adv.

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR
J U D G E M E N T (O R A L)

% 08.12.2021

1. At the outset of proceedings, I queried of Mr. Vaidyanathan, learned Counsel for the respondent, as to whether he had any objection to my hearing this matter as I am an avowed aficionado and, indeed, admirer of Agatha Christie. He answers emphatically in the negative, asserting, in fact, that he, too, is one.

2. Agatha Christie (1890-1976), fondly known as the "Queen of Crime", needs no introduction. She is, arguably, the greatest writer of books in the murder mystery genre, ever. She is, unarguably, the best-selling fiction writer of all times as per the Guinness Book of World Records. Hercule Poirot and Miss Marple, her detective creations, Signature Not Verified By: SUNIL SINGH NEGI Signing Date: 13.12.2021 10:23:17 share the same exalted space, in the detective firmament, as Sherlock Holmes. For her contribution to literature, Agatha Christie was made a Dame Commander of the British Empire (DBE) in 1971.

3. The most famous work of Agatha Christie and one of the top selling books of all time is "And Then There Were None", originally published on 6th November, 1939 as "Ten Little Niggers". It was described, by Agatha Christie herself, as the book she found most difficult to write, and is widely regarded as a classic by enthusiasts of the genre.

4. Agatha Christie Ltd., the appellant before me, is a Company established in 1955 by Agatha Christie herself. It is presently chaired and managed by Mr. James Prichard, her great grandson.

5. The appellant, on 5th December, 2017, filed an application for registration of the trademark "AND THEN THERE WERE NONE", under Classes 9, 16 and 41 of the Schedule to the Trademarks Rules,

2017, which read thus:

"Class 9: Pre-recorded magnetic, digital and optical recording media and data carriers, including audio and video cassettes, digital audio tapes, video tapes, vinyl records, compact discs (CDs), audio digital discs, magnetic discs, optical discs, floppy discs, holographic discs, DVDs, cartridges for computer and video games, magnetic or digital cards, cards bearing electronically recorded data, smart cards, flash memory cards, portable flash memory devices, USB flash drives; cinematographic films; television films; slide films; slide film mounts; photographic films; computer software; computer application software for mobile devices; downloadable software via the internet and wireless devices;

Signature Not Verified By:SUNIL SINGH NEGI Signing Date:13.12.2021 10:23:17 downloadable software in the nature of a mobile application; video and computer games in the form of computer programs recorded on data carriers or downloaded via the internet; electronic publications; nonprinted publications; printed publications in electronically, magnetically or optically recorded and readable forms; multimedia entertainment goods recorded in electronic, magnetic, digital or optical forms or downloaded via the internet; downloadable digital media and recordings containing sound, images, text, information, signals or software; downloadable video and audio recordings provided via the internet and mobile devices; downloadable video, video recordings, animation films and programs provided via a video on demand service; audio books, electronic books, digital books, podcasts, webcasts, ringtones, wallpapers, screensavers, icons, images, all the aforementioned recorded or downloaded via the internet; digital book readers; electronic memo books; digital tablets; mobile telephones, parts, fittings and accessories therefor; computer mouse mats and computer wrist mats; parts and fittings for all the aforesaid goods."

"Class 16: Printed matter; books; artwork publications; newspapers, periodicals and magazines; advertising publications; educational publications; promotional publications; booklets; booklets relating to games; pamphlets; event programs; computer software in printed form; instruction manuals relating to computer software; computer game instruction manuals; strategy guide books for games; strategy guide magazines for games; writing or drawing books; goods made of paper and cardboard; collectable cards; bookmarks; covering materials for books; covers for books; paper for wrapping books; protective covers for books; photographs; photo stands; photograph albums; scrapbooks; stationery; notepaper; envelopes; notebooks; address books; visitors books; writing instruments; pens; pencils; adhesive materials for stationery use; artists' materials; paint brushes; office requisites; desk sets, blotters, book ends; instructional and teaching material; calendars, diaries, personal organisers; greetings cards; posters; postcards; wrapping paper; gift tags."

Signature Not Verified By:SUNIL SINGH NEGI Signing Date:13.12.2021 10:23:17 "Class 41: Education; providing of training; entertainment; cultural activities; provision of entertainment services through the media of publications; publishing services (including electronic publishing services); publishing and editing of printed matter and printed publications; on-line publishing of electronic books, audio books, journals, newsletters, digests, reports, newspapers and magazines (non-downloadable); music publishing and music recording services; provision of entertainment

services; entertainment by means of theatre productions, music performances, roadshows, radio, television, film and internet; entertainment services in the form of television and radio shows, programs, films and series, theater and stage productions, cabaret, live musical performances, concert performances, sound recordings, cinema performances, films and multimedia entertainment production; entertainment services in the form of electronic, computer and video games provided by means of the internet and other remote communications device; planning, organizing, directing, production, performance and presentation of theatre performances and shows, stage performances and shows, plays, musical performances and shows, dramas, live comedy shows and live performances, cinematographic films, video films, animated films and cartoons; production of pre-recorded video, television and cinema films; video-tape film production, television programs, television series, live television programs, radio programs, radio broadcasts, musical programs, musical shows, live musical performances, concerts; television, radio, film and show production; on-line entertainment material, including non-downloadable webcam recordings, blogs, podcasts and multimedia entertainment production; recorded audio-visual presentations; production of entertainment in the form of video tapes; video game entertainment services; electronic games services provided from a computer database or by means of the internet; electronic game services and competitions provided by means of the internet; electronic games services, including provision of computer games on line or by means of a global computer network; providing interactive multi-player computer games via the internet and electronic communication networks; providing internet games (non-downloadable); provision of games by means of a Signature Not Verified By: SUNIL SINGH NEGI Signing Date: 13.12.2021 10:23:17 computer based system; cinema theaters; motion picture theaters; movie theatres; production of musical recordings and musical videos; recording, film, video and television studio services; amusement park services; theme park services; entertainment and educational services in the nature of lectures and performances provided on cruises, tours, excursions, exhibitions, and private events; entertainment services in the nature of interactive shows, plays, performances and dinner parties featuring adaptations of scripts of mystery novels and fictional characters and involving participation of the audience; arranging of competitions for education or entertainment; entertainment information; entertainment information services, information services relating to books, films, movies, shows, plays, theatre performances, music, television and radio programs and series computer and video games; ticket information services for entertainment events; providing entertainment information via a website; arranging and conducting conferences, conventions, congresses and exhibitions; audiovisual display presentation services for entertainment purposes; production, arranging and conducting of presentations for cultural, entertainment and educational purposes; organisation of events for entertainment and cultural purposes; museum services and provision of museum facilities for presentations and exhibitions; gallery services; courses of instruction in history and literature; exhibition of cine films, video films and video film sound tracks; movie theatre presentations; organisation of entertainment and cultural events; arranging of festivals for cultural, educational and entertainment purposes; audio, film, video and television recording and production services; production of sound and image recordings on sound and image carriers; production of entertainment in the form of video and audio recordings; dissemination of entertainment material; rental of audio books and electronic books; rental and hire of pre-recorded media, DVDs, video and audio cassettes and tapes; rental of cinematographic films, motion picture films and television programs; rental of computer game programs; film and television program distribution (other than

transportation); providing educational and entertainment services relating to Signature Not Verified By:SUNIL SINGH NEGI Signing Date:13.12.2021 10:23:17 uploading, exchanging and sharing photos and videos via a website; orchestra services."

6. The appeal avers that, on the date when the application was filed, no mark even remotely similar to "AND THEN THERE WERE NONE" was in use, in relation to the goods and services in respect of which registration was sought by the appellant, or, for that matter, in respect of any other goods or services.

7. A show cause notice, proposing rejection of the mark was served on the appellant, who responded thereto. The appellant was, thereafter, heard and the impugned order came to be passed on 14th January, 2021, rejecting the application. The order reads thus:

"In the matter of Application No. 3695699 for registration of a trade mark AND THEN THERE WERE NONE Filed by AGATHA CHRISTIE LIMITED ORDER Above application has been filed for registration of the trademark AND THEN THERE WERE NONE on 05/12/2017 which was examined on 04/01/2018 and examination report was communicated to the applicant at his address for service. A reply to the office objection(s) had been filed on behalf of the applicant but the same was not found satisfactory and the application was set down for hearing and eventually hearing took place before me on 11/01/2021.

Vaibhav Vutts Attorney appeared before me and made his/her submissions. I have heard arguments and gone through the records.

Office objection u/Sec. 9 (1) (a).

Signature Not Verified By:SUNIL SINGH NEGI Signing Date:13.12.2021 10:23:17 Ld. Counsel himself submits that the applied mark is the name of a novel by the writer Agatha Christie.

Applied mark is AND THEN THERE WERE NONE.

To my mind, applied mark is a kind of mark where one needs to educate the people that its not just any phrase but a trademark and is intended to be so used. Applied mark is only proposed to be used. There is no substantive evidence that the applied mark has been used as a trademark ever. Applied mark lacks distinctiveness.

Objection sustained.

Refused.

After perusal of all the documents on record and submission made by the applicant/authorised agent it is concluded that applied mark is not registrable because of the reason stated as above. Hence application no. 3695699 cannot be accepted and refused accordingly.

Dated: 14 January, 2021."

8. Mr. Vaidyanathan, learned Counsel for the respondent has, with customary candour, left the matter to the Court.

9. Ex facie, the impugned order cannot sustain either on facts or in law. The only ground on which the impugned order refuses registration of the appellant's mark is that it is not distinctive. I fail, completely, to understand why "AND THEN THERE WERE NONE" is, by any reckoning, not a distinctive mark, when seen vis-a-vis the categories of services in respect of which its registration was being sought. The impugned order does not allege that the mark, or any mark deceptively similar thereto, was ever registered, or even in use in Signature Not Verified By:SUNIL SINGH NEGI Signing Date:13.12.2021 10:23:17 respect of goods or services identical or similar to the marks in respect of which registration was sought by the appellant. Nor could it be alleged that the mark "AND THEN THERE WERE NONE" was descriptive of the services in respect of which its registration was sought by the appellant.

10. The Trade Marks Act, 1999, confers, as a matter of right, the right to register a trademark which does not suffer from any of the infirmities which the Act contemplates.

11. The grounds on which registration of a mark used, or proposed to be used, as a trademark, may be refused, are contained in Sections 9, 11 and 13 of the Act. They permit refusal of registration if

(i) the mark is devoid of any distinctive character, meaning that it is not capable of distinguishing the goods or services of one person from those of another [Section 9(1)(a)],

(ii) the mark consists 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 [Section 9(1)(b)],

(iii) the mark consists exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade [Section 9(1)(c)],

(iv) the mark is of such a nature as to deceive the public or cause confusion [Section 9(2)(a)],
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(v) the mark contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India [Section 9(2)(b)],

(vi) the mark comprises or contains scandalous or obscene matter [Section 9(2)(c)],

(vii) the use of the mark is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950) [Section 9(2)(d)],

(viii) the mark consists exclusively of the shape of goods which results from the nature of the goods themselves [Section 9(3)(a)],

(ix) the mark consists exclusively of the shape of goods which is necessary to obtain a technical result [Section 9(3)(b)],

(x) the mark consists exclusively of the shape which gives substantial value to the goods [Section 9(3)(c)],

(xi) the mark is such that, because of its identity or similarity with an earlier trademark and the goods or services covered by such earlier mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark. [Section 11(1)],

(xii) the mark is identical or similar to an earlier trademark, but is to be registered into goods or services which are not similar to the goods or services for which the earlier trademark is registered, if the earlier trademark is a well-known trademark in India within the meaning of Section 2(1)(zg), and the use of the mark of which registration is sought would take unfair Signature Not Verified By:SUNIL SINGH NEGI Signing Date:13.12.2021 10:23:17 advantage of, or be detrimental to, the distinctive character or repute of the earlier trademark [Section 11(2)],

(xiii) the use of the mark in India is liable to be prevented by virtue of any law, in particular the law of passing off protecting an unregistered trade mark used in the course of trade, or by virtue of copyright law [Section 11(3)],

(xiv) the mark is the commonly used and accepted name of a single chemical element or a single chemical compound in respect of a chemical substance of preparation [Section 13(a)], or

(xv) the mark is declared by the World Health Organisation, as an international non-proprietary name, or is deceptively similar to an international non-proprietary name granted by the WHO.

12. The circumstances in which registration of a mark can be refused, being specifically statutorily delineated in the Trade Marks Act, have to be regarded as exhaustive. Absent any of these circumstances, therefore, a request for registration of a trademark cannot be refused.

13. "Trade mark" and "mark", are defined in Clauses (zb) and (m) of Section 2(1) of the Trademarks Act, 1999, thus:

"2. Definitions and interpretation -

(1) In this Act, unless the context otherwise requires, ***** Signature Not Verified By:SUNIL SINGH NEGI Signing Date:13.12.2021 10:23:17

(m) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any

combination thereof;

***** (zb) "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;"

Names, words and combinations or names/words are, therefore, "marks", within the meaning of the Trade Marks Act, 1999. The only other criteria of a "trade mark", is that it must be capable of being represented graphically and must be capable of distinguishing the goods of one person from those of others.

14. There is no finding or observation, by the author of the impugned order, that the name "AND THEN THERE WERE NONE" is not capable of being represented graphically or is incapable of distinguishing the services being provided, or intended to be provided, by the appellant, from those provided or intended to be provided by others.

15. In fact, the name being the title of the most well-known work of fiction written by Agatha Christie, it is also capable, prima facie, of creating an association between the name and the appellant, which is a company established by Agatha Christie herself. It can, therefore, legitimately be used in the context of services which the said company provides or intends to provide.

16. There is no obligation, in law, requiring, mandatorily, the name or other insignia, whereunder goods or services are provided, to be registered under the Trade Marks Act, 1999. Registration of a trademark, however, permits transparency in trade and is also in the interests of the consuming public who would, then be able to identify and distinguish goods and services being provided by one entity from those provided by another. As such, if the trademark is not one, the registration of which is inhibited by any of the provisions of the Trade Marks Act, its registration must be allowed.

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17. Essentially, if the mark is distinctive, and is not identical or confusingly or deceptively similar to any earlier mark which is registered or in use from a prior date in respect of similar goods or services, or which results in the passing off, by the applicant, of its goods or services as those of another, registration of the mark is a matter of right.

18. The impugned order denies, without due justification, to the appellant, this right.

19. The impugned order is also liable to be set aside, in my view, as being unreasoned. The right to register a mark under which one intends to provide good or services is a valuable right, partaking of the character of Article 19(1)(g) of the Constitution of India. Any decision not to allow registration of a mark has, therefore, to be informed by reasons which should be apparent on the face of the decision. The impugned order, in my view, is bereft of sufficient reasons to justify the decision taken therein.

20. Absent any other infirmities or shortcomings, the appellant's mark would be entitled to registration as sought in respect of the services under Classes 9, 16 and 41.

21. As such, the impugned order is quashed and set aside. The matter is remitted to the office of the Registrar of Trade Marks with the direction that, if the application of the appellant does not suffer from any other fatal infirmity, the mark "AND THEN THERE WERE Signature Not Verified By:SUNIL SINGH NEGI Signing Date:13.12.2021 10:23:17 NONE", as sought by the appellant, be registered under Classes 9, 16 and 41.

22. The appeal is allowed accordingly, with no order as to costs.

C. HARI SHANKAR, J DECEMBER 8, 2021 kr/ SS Signature Not Verified By:SUNIL SINGH NEGI Signing Date:13.12.2021 10:23:17