



**IPAB Intellectual Property Appellate Board**

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**OA/16/2020/TM/MUM**  
**FRIDAY, THIS THE 21<sup>st</sup> DAY OF AUGUST, 2020**

**HON'BLE SHRI JUSTICE MANMOHAN SINGH**  
**HON'BLE DR. ONKAR NATH SINGH**

**CHAIRMAN**  
**TECHNICAL MEMBER (PVPAT)**

**1. ALIBABA GROUP HOLDING LIMITED**

FOURTH FLOOR, ONE CAPITAL PLACE,  
P.O. BOX 847, GEORGE TOWN,  
GRAND CAYMAN, CAYMAN ISLANDS

...APPLICANT/APPELLANT

(Represented by: Mr. Naqeeb Nawab)

Versus

**THE REGISTRAR OF TRADEMARK**  
TRADE MARKS REGISTRY  
BOUDHIK SAMPADA BHAWAN,  
ANTOP HILL S.M. ROAD, MUMBAI – 400 037

...RESPONDENT

(Represented by – None)

**ORDER**

**HON'BLE SHRI JUSTICE MANMOHAN SINGH, CHAIRMAN**

1. The appellant has filed the present Appeal under Section 91 of the Trademarks Act, 1999 arising out of the Order dated 22<sup>nd</sup> February, 2019 passed by Registrar of Trade Marks, Trade Marks Registry, Mumbai, thereby refusing the registration of trade mark Application No. 1997944 "ALIBABA.COM" in classes 35, 36, 38, 39, 41 & 42)

**FACTS OF THE CASE**

2. The application was filed by the Appellant on 23rd July, 2010 before the Registrar of Trade Marks, Mumbai. The Application was examined and objections were raised as follows :

*Relative Grounds under Section 11 (1). The objection is raised that “the same/similar trade mark(s) is/ are already on records of the register for the same or similar goods/ services”;*

*Other objection/requirement/condition/restrictions (1) be Associated with 1615741,1615741,1615741 (2) You are require to amend Country to Iceland by way of filing TM-M with fees*

- 2.1 The Appellant had responded to the above objections by way of a response filed on 13<sup>th</sup> December, 2017. The Appellant had also filed documents to support the registrability of the Application along with the formal response which have been digitized and reflect in the online records of the Application.
3. Show-cause hearing was appointed for the Subject Application. The counsel for the Appellant had appeared before hearing officer at the Trade Marks Registry, Mumbai. The counsel made submissions and produced evidence which the Appellant relied on which was also duly digitized and uploaded in the online records of the Subject Application prior to the date of the hearing. However, the Hearing Officer refused the Application.
4. Aggrieved by the said order, the Appellant filed a request to obtain the detailed grounds of refusal as mandated under Rule 36 (1) of the Trademarks Rules, 2017 on 23<sup>rd</sup> July, 2018 with a view to getting clarity on the interpretations of the provisions of law that the Ld. Hearing Officer has applied to reach on the decision of refusal. In response to this request, the impugned order dated 22<sup>nd</sup> February, 2019 appears to have been issued and uploaded in the online records but was not communicated to the Appellant till date.
5. No counter affidavit has been filed by the respondent despite of service. No one appeared when the matter was taken on behalf of respondent.
6. ABOUT THE APPELLANT

The Appellant is an exempted company incorporated in the Cayman Islands with limited liability, whose registered address is Fourth Floor, One Capital Place, P.O. Box 847, George Town, Grand Cayman, Cayman Islands. The Appellant and its affiliates

(hereinafter collectively referred to as “Alibaba Group”) are a family of Internet-based businesses whose mission is to make it easy for anyone to buy and sell online anywhere in the world, including in India.

6.1. The Appellant was established in 1999 by eighteen people led by Mr. Jack Ma, a former English teacher from Hangzhou, China, who aspired to help make the Internet accessible, trustworthy and beneficial for everyone. The founders of the Appellant believed that the Internet would level the playing field by enabling small enterprises to leverage innovation and technology to grow and compete more effectively in the domestic and global economies.

6.2. Since 1999, the Appellant has established a premier online marketplace for businesses and consumers, and Alibaba Group and its related companies have developed leading businesses in e-commerce, online payment services and cloud computing etc., reaching Internet users worldwide. Details of Alibaba Group as well as its businesses and activities are publicly available from its website [www.alibabagroup.com](http://www.alibabagroup.com). A list of the major businesses under Alibaba Group can be found at <http://www.alibabagroup.com/en/about/businesses>. It is submitted that all subsidiaries and consolidated entities of the Alibaba Group outside China are 100% owned directly and indirectly by the Appellant. The Appellant became a public company in September 2014, when its shares began trading on the New York Stock Exchange in the largest initial public offering worldwide.

6.3. The brand “ALIBABA”/ “阿里巴巴” (i.e. the corresponding Chinese mark for “ALIBABA”) was chosen by Alibaba Group’s founders, including Mr. Jack Ma, prior to its establishment in 1999. “ALIBABA” / “阿里巴巴” is the core and distinctive element of the company name of Alibaba Group and also its house mark

under which its business activities including its various online platforms are promoted.

### Businesses under Alibaba Group

7. Alibaba Group's businesses are comprised of core commerce, cloud computing, digital media and entertainment, and other innovation initiatives. The Appellant's core commerce is comprised of marketplaces operating in retail commerce, wholesale commerce, logistic services and consumer services, including:-

Wholesale commerce -

Alibaba.com – the wholesale marketplace for global trade (“Alibaba.com Platform”)

1688.com – China domestic wholesale marketplace (“1688.com”)

Retail commerce -

Taobao Marketplace – the China online commerce destination (“Taobao Marketplace”)

Tmall – the China third-party platform for brands and retailers (“Tmall Platform”)

Lazada – the e-commerce platform across Southeast Asia (“Lazada”)

AliExpress – the global marketplace enabling consumers from around the world to directly buy from manufacturers and distributors primarily in China (“AliExpress”)

Logistics Services

Cainiao Network – the logistics data platform and nationwide fulfillment network (“Cainiao Network”)

Consumer Services -

Fliggy – the online travel platform in China providing comprehensive reservation services for airline tickets, accommodation, train tickets, car rental, package tour and destination attraction (“Fliggy”)

Ele.me – the on-demand delivery and local services platform in China enabling consumers to order meals, snacks and beverages online (“Ele.me”)

7.1 Alibaba Group’s e-commerce customers include both buyers and sellers who discover, select and transact with each other on our global online marketplace platforms. Buyers from around the world, access the Appellant’s marketplaces free of charge and they include consumers who come to their retail marketplaces to shop for anything, anytime, anywhere, as well as businesses from around the world, which use the wholesale marketplaces to source products for use in their own businesses and/or for resale. Sellers, including brand owners, retailers, wholesalers and manufacturers from around the world, use Alibaba Group’s websites to establish a presence on the Internet and market products and services to hundreds of millions of consumers and other businesses.

7.2. The approximate total annual revenues generated by Alibaba Group for all its goods and services sold from January 2008 to March 2018 are set out as follows:

Time Period	Revenue (USD millions)
Jan 2008 – Dec 2008	451.5
Jan 2009 – Dec 2009	582.4
Jan 2010 – Dec 2010	835.3
Jan 2010 – Mar 2010	Not available
Apr 2010 – Mar 2011	1,800
Apr 2011 – Mar 2012	3,030
Apr 2012 – Mar 2013	5,223

Time Period	Revenue (USD millions)
Apr 2013 – Mar 2014	7,944
Apr 2014 – Mar 2015	12,293
Apr 2015 – Mar 2016	15,686
Apr 2016 – Mar 2017	22,994
Apr 2017 – Mar 2018	39, 898

7.3. Alibaba Group has incurred the following approximate worldwide marketing expenditures from January 2008 to March 2018:-

Time Period	Revenue (USD millions)
Jan 2008 – Dec 2008	166.5
Jan 2009 – Dec 2009	244
Jan 2010 – Dec 2010	308.1
Jan 2010 – Mar 2010	Not available
Apr 2010 – Mar 2011	477
Apr 2011 – Mar 2012	463
Apr 2012 – Mar 2013	547
Apr 2013 – Mar 2014	688
Apr 2014 – Mar 2015	1,373
Apr 2015 – Mar 2016	1,753
Apr 2016 – Mar 2017	2,370
Apr 2017 – Mar 2018	4,352

The figures set out in Paragraphs 14 and 15 have been extracted from the 2009 to 2011 Annual Reports, and the Announcement of Financial Results for the quarter ended 31 March 2012 for Alibaba.com Limited (a company under Alibaba Group), as well as the Annual Reports for the Appellant.

The ALIBABA trade mark

8. The Appellant has adopted and used its trade mark ALIBABA in connection with its goods and services since at least 1999. The Appellant authorizes the use of its trade marks including the trade mark ALIBABA per se, marks containing the word ALIBABA such as ALIBABA.COM and marks with the prefix ALI (hereinafter collectively referred to as the “Appellant’s Trade Marks”).
  
9. It has come on record that Alibaba Group operates an online business-to-business (“B2B”) marketplace at [www.alibaba.com](http://www.alibaba.com) (herein referred to as the “Alibaba.com Platform”) which is a global trade marketplace for importers and exporters under the Appellant’s Trade Marks.

Alibaba.com Platform is a leading English-language wholesale marketplace for global trade that connects buyers located in over 190 countries and sellers located around the world, including India. Sellers include wholesale distributors, re-sellers, and/or manufacturers of a wide variety of products and services. Buyers include trade agents, wholesalers, retailers, manufacturers and small and medium sized enterprises engaged in the import and export businesses.

Sellers and buyers of the Alibaba.com Platform are able to directly communicate with each other by using the messaging services provided by the Alibaba.com Platform.

Further, seller on the Alibaba.com Platform may purchase an annual Gold Supplier membership to reach customers, provide quotations and transact on the marketplace. They may also purchase an upgraded membership package to receive value-added services

such as upgraded storefront management tools. Country-specific versions of the Alibaba.com Platform are available.

10. The Alibaba.com Platform connects millions of buyers and sellers of all kinds of products from around the world, including India. The table below sets out the approximate worldwide numbers of registered users (buyers), paying members (sellers who pay membership fees to use Alibaba.com), and storefronts from December 2006 to March 2012:-

Time period	No. of registered users (buyer) (millions)	No. of paying members (seller) (thousands)	No. of storefronts (thousands)
Dec 2006	3.115	29.525	514.89
Dec 2007	4.406	39.536	697.56
Dec 2008	7.915	59.164	965.75
Dec 2009	11.578	113.90	1400.33
Dec 2010	18.025	131.71	1696.91
Dec 2011	25.517	105.56	2235.42
Mar 2012	27.342	95.185	2354.76

11. It is stated by the counsel for the appellant that the above figures were extracted from Annual Reports for Alibaba.com Limited in 2009 and 2011 while the 2012 figure was extracted from the Announcement of Financial Results for the quarter ended 31 March 2012 for Alibaba.com Limited. While the numbers of registered users since March 2012, and the number of paying members from March 2012-2018 are confidential and not publically available, it is stated that the numbers of registered users, paying members, and storefronts have generally grown in connection with the increasing revenues earned through Alibaba.com. As of March



31, 2018, as shown in Appellant’s Annual Report, the Alibaba.com Platform had over 164,000 paying members.

The approximate total annual revenues generated by Alibaba Group through the Alibaba.com Platform from April 2012 to March 2018 are set out as follows:

Time Period	Revenue (RMB millions)	Approximate Revenue (USD millions) [Exchange rate: RMB6.27=USD1]
Apr 2012 – Mar 2013	3,768	600.96
Apr 2013 – Mar 2014	3,913	624.08
Apr 2014 – Mar 2015	4,718	752.47
Apr 2015 – Mar 2016	5,425	865.23
Apr 2016 – Mar 2017	6,001	957.10
Apr 2017 – Mar 2018	6,625	1,056.62

The figures from April 2012 to March 2018 were extracted from the Appellant’s Annual Reports of 2015 to 2018. According to the Appellant’s Annual Reports of 2015 and 2016, more than 136,000 and 137,000 worldwide paying members were registered through the Alibaba.com Platform as of March 2015 and March 2016 respectively.


## 12. Trade Mark Rights and Protection for the Appellant’s Trade Marks

It is a matter of fact that the Appellant applied for and registered the Appellant’s Trade Marks worldwide including but not limited to China, Bangladesh, Cambodia, Hong Kong, India, Indonesia, Japan, Macau, Malaysia, Mongolia, Myanmar, Philippines,

Singapore, South Korea, Sri Lanka, Taiwan, Thailand, Australia, New Zealand, the E.U., the U.S., Canada, OAPI, etc.

Table below are the registration for some of the Appellant's Trade Marks in India:-

Trade Mark	Class	Appl./ Reg. No.	Date of Application	Date of Registration	Status
Alibaba.Com	9	885829	1999.11.08	1999.11.08	Registered
Alibaba.Com	16	885827	1999.11.08	1999.11.08	Registered
ALIBABA	18	947361	2000.11.08	2000.11.08	Registered
ALIBABA TRADE MANAGER	35, 38, 42	1400591	2005.11.21	2005.11.21	Registered
Ali-ADvance	9, 35, 38, 42	1793275	2009.03.06	2009.03.06	Registered
Ali-AD-Vance	9, 35, 38, 42	1793274	2009.03.06	2009.03.06	Registered
ALIAVILA	9, 14, 28, 35, 37, 38, 42	3022094	2015.07.31	2015.07.31	Registered
ALICLOUD	9, 35, 36, 38, 39, 41, 42	3066429	2015.09.24	2015.09.24	Registered
AliCloud MAP Marketplace Alliance Program	35, 38, 41, 42	3066428	2015.09.24	2015.09.24	Registered

Trade Mark	Class	Appl./ Reg. No.	Date of Application	Date of Registration	Status
ALIEXPRESS	38	1903087	2009.12.30	2009.12.30	Registered
ALIFINANCE	9, 35, 36, 38, 39, 42	1651641	2008.02.08	2008.02.08	Registered
ALIMEBOT	9, 35, 38, 41, 42, 45	3537128	2017.04.28	2017.04.28	Registered
ALIOS	9, 35, 38, 41, 42	3642933	2017.09.25	2017.09.25	Registered
Alisoft	9, 35, 36, 38, 39, 41, 42	1606261	2007.09.27	2007.09.27	Registered
 Alisoft.com	9, 35, 36, 38, 39, 41, 42	1606787	2007.09.28	2007.09.28	Registered
ALISPORTS	9, 28, 35, 38, 41, 42, 45	3615609	2017.08.18	2017.08.18	Registered

13. Use of the Appellant's Trade Marks including the ALIBABA.COM platform in India

It is submitted that the Appellant has actively promoted and operated its businesses in India. The significant success in the marketing and operation of the Alibaba.com Platform in India has resulted in the establishment of a dedicated website for India at <https://india.alibaba.com/>, which facilitates membership subscription, browsing of the product listings as well as B2B trade focused in India and offers a comprehensive information section for doing business in India.

The Alibaba.com Platform is also available in Hindi at <http://hindi.alibaba.com/> which enables buyers and potential buyers from India to source products from suppliers around the world.

The number of registered users in India for the calendar years 2009 to 2011 are set out below:-

Year	Number of Registered Users	Percentage of Total Registered Users
2009	1,274,305	11%
2010	1,866,244	10.4%
2011	2,573,350	10.1%

The above figures are obtained from the Annual Reports of Alibaba.com Limited from 2009 to 2011.

Apart from these websites, the Appellant's Alibaba.com Platform can also be accessed via mobile apps which can be downloaded by users in India. The Appellant is offering goods and services under the Appellant's Trade Marks in mobile apps. These mobile apps are available in both iOS platform and Android platform wherein the Appellant's Trade Marks are prominently used.

## Advertising and Promotion

14. It is also submitted that Alibaba Group has expended significant time and effort to extensively promote the Appellant's Trade Marks, and the goods and services available through the Alibaba.com Platform for several years via the Internet and through publicity and advertising in trade press and other print media.

Alibaba Group extensively advertises and promotes its goods and services by way of a variety of advertising and promotional materials, including in association with the Appellant's Trade Marks. The said trade marks have earned recognition and goodwill by way of news articles and other promotions as can be viewed at various web links on the internet. The growth of Alibaba Group, and the success of the Alibaba.com Platform as well as other services offered by Alibaba Group, have garnered a significant amount of media attention and resulted in a high public profile for Alibaba Group and the Appellant's Trade Marks globally.

The following are the articles/materials showing use of the Appellant's Trade Marks that are circulated in India:

*India Marketing Updates issued in May 2010, June 2010, July 2010, August 2010 and October 2010;*

*A booklet titled "India Success Stories";*

*An article titled "Empowering Women Entrepreneurs in India through E Commerce;*

*Copies of customer feedback forms and contracts/ application forms for Gold Suppliers and TrustPass; and*

*Copies of brochures for Alibaba.com.*

The Appellant extensively advertises its goods and services by way of publishing videos at YouTube, all of which are accessible to users in India as well. Such videos provide information relating to general information of the goods and services available

through the Alibaba.com Platform. Some of the videos mentioned above, within which the Appellant's Trade Marks are prominently featured, can be found via the links below:-

*"Alibaba.com", published on January 5, 2015, available at:*  
<<https://www.youtube.com/watch?v=X9eTogxqz7Y>>

*"Alibaba presents the World's largest shopping day", published on 8 November 2017, available at*  
<https://www.youtube.com/watch?v=FGZrzM-JAnn> (3,206 views as at 8 February 2019).

The Appellant also has a considerable online social media presence in relation to the Appellant's Trade Marks, including Facebook pages at <https://www.facebook.com/alibabagroupofficial/>, <https://www.facebook.com/AlibabaGroupCorporate/>, <https://www.facebook.com/AlibabaGGS>, Twitter accounts at <https://twitter.com/AlibabaGroup>, [https://twitter.com/Alibaba\\_GGS](https://twitter.com/Alibaba_GGS) and LinkedIn pages at <https://www.linkedin.com/company/alibaba-group/>, <https://www.linkedin.com/company/alibaba-com/>. All the above stated social media accounts are accessible to users in India. Such social media presence has generated sizeable fame and reputation among users worldwide.

### Brand Recognition

15. It has come on record that by virtue of the extensive use and registrations, the Appellant's Trade Marks are well-recognized and highly valued internationally. BrandZ, a leading brand valuator, valued the Appellant's ALIBABA brand at:-

Year	Brand Value
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2015	US\$66.4 billion	The world's most valuable retail brand
2016	US\$49.3 billion	The world's second most valuable retail brand, ahead of The Home Depot, Walmart, IKEA, Costco, and others.
2017	US\$59.1 billion	The world's second most valuable retail brand
2018	US\$113.4 billion	The world's second most valuable retail brand

Brand Finance, another leading brand valuator, recently valued the Appellant's ALIBABA brand at:-

Year	Brand Value	Ranking amongst the Top 100 Most Valuable Global Brands
2016	US\$17.968 billion	62nd
2017	US\$34.9 billion	22nd
2018	US\$54.9 billion	12th

Alibaba Group has been consistently recognized for their achievement around the globe and across their businesses. Alibaba Group has received numerous awards and accolades for the quality and standards maintained in respect of the goods and services provided, including but not limited those provided under the Appellant's Trade Marks. By virtue of such awards and accolades, an immense goodwill and reputation has accrued upon Alibaba Group and the Appellant's Trade Marks, which are associated exclusively with the Appellant. Examples of the awards/recognitions that the Appellant has received in India and elsewhere include the following:

*Named one of the 27 Great Brands of Tomorrow by Credit Suisse Research;*

*Ranked among the Forbes Global 2000 by the Forbes Magazine;*

*Asia's Best Managed Companies in China by Finance Asia Magazine;*

*Most Trusted Export Service Provider in China 2010 by the Imp-Exp Executive magazine (China);*

*Named one of the Top 10 Best Employers in the University Students' Best Employer Survey by ChinaHR.com;*

*Top 100 Chinese E-commerce Enterprises: Integrated B2B E-commerce Enterprise Award by China Electronic Commerce Association;*

*Most Admired Chinese Company 2010 by Fortune magazine Chinese edition and Hay Group;*

*Asia 200 2010: Named one of China's Top 10 by The Wall Street Journal;*

*Ranked in Asia's Heroes of Philanthropy list by Forbes magazine Asia edition;*

*Named one of the 50 Smartest People in Tech by Fortune Magazine;*

*Asian Business Leaders Award by Asia House (U.K.);*

*Inducted into the 2011 World Retail Hall of Fame by World Retail Congress;*

*Named one of the Chinese Businesspeople of the Year 2010 by Forbes magazine Chinese edition;*

*Ranked in the 2010 Power 50 list by Counselor magazine;*

*Asia's Best Managed Companies – China: Best CFO (No. 1) by Finance Asia magazine*

*Ranked 5<sup>th</sup> in the 2018 Change the World list by Fortune*

16. By virtue of an extensive, continuous and exclusive use of the Appellant's Trade Marks by the Alibaba Group, the Appellant's Trade Marks have acquired a high level of distinctiveness and the Appellant enjoys an immense goodwill and reputation from the use of the Appellant's Trade Marks in India. A significant level of goodwill and reputation has also been spilled over into India through the extensive use of the Appellant's Trade Marks around the world (including in countries and regions in proximity to India).




17. Thus, it is evident that the trade mark “ALIBABA.COM” filed under the Subject Application had already acquired distinctiveness as on the filing date. The Appellant being the proprietor of the trade mark ALIBABA.COM under Section 18 of the Trade Marks Act, 1999 is entitled to the statutory protection of the same under various provisions of the Act.


18. The Respondent has not considered the evidence, documents and submissions tendered in support of the subject mark, and there is no application of mind on part of the Respondent.

19. The Impugned Order has been passed in a most casual manner without looking into the true facts..



19. The trade mark  under Application No. 1500048 as cited to be similar to the Subject Application currently stands opposed by the Appellant itself on the grounds of its similarity with the Appellant’s Trade Marks. The Appellant herein has filed extensive documentary evidence in support of its opposition against Application No. 1500048, whereas, the owner of the cited mark has failed to file any evidence.



20. The trade mark  under Registration No. 1812224 is not similar to the Application.. Appellant has sought to register the Subject Application for services in classes 35, 36, 38, 39 and 42 which are different to the services covered by Registration No. 1812224.

21. Further, the appellant has produced the evidence in order to establish concurrent registration if the marks cited are similar. The respondent has failed to consider any aspect of the matter. The order has been passed in mechanical manner and without application of mind. Hence, the order of the respondent is set-aside.
22. The appeal is allowed. The application is accepted and shall proceed further for advertisement in Trade Mark Journal.
23. No. costs.

-Sd/-

**(Dr. Onkar Nath Singh)**  
Technical Member (PVPAT)

-Sd/-

**(Justice Manmohan Singh)**  
Chairman

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