

(2012) 07 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : M.P. No. 297/2010 & M.P. No. 76/2012 In ORA/28/2008/TM/AMD And ORA/28/2008/TM/AMD

General Mills Inc., Number One General Mills Boulevard
Minneapolis Minnesota 55426 USA

APPELLANT

Vs

Kaira District Cooperative Milk, Producers Union Ltd.
Federation, Amul Dairy Road, Anand 388001, Gujarat And
The Registrar Of Trade Marks Office Of The Trade Marks
Registry Baudhik Sampada Bhawan, Near Antop Hill Post
Office, Antop Hill, Mumbai-400037

RESPONDENT

Date of Decision : 16-07-2012

Acts Referred:

Trade Marks Act, 1999 — Section 9, 11, 21, 33, 33(1), 47, 57, 125

Citation : (2012) 07 IPAB CK 0001

Hon'ble Judges : S. Usha, J;V. Ravi, Technical Member

Bench : Division Bench

Final Decision : Allowed/Disposed Of

Judgement

S. Usha, J

1. Application for removal of the trade mark "TRIX" registered under No. 330224 in class 30 under Section 47/57/125 of the Trade Marks Act, 1999 (in short 'the Act'). The applicant is engaged in the business of manufacturing and marketing a wide range of food items like baking products, cereals, organic foods, snacks, desserts, mixes etc. The applicant is a food products manufacturing company. They sell their products in more than 100 countries. The applicant traces its history to the year 1928 when James Ford Bell, President of Washburn Crosby led a mega-merger of milling companies across the United States to create General Mills. The new Company included some of the most respected names in flour and the applicant became the largest flour milling company in the world. The applicant's international business accounts for more than \$ 1.8 billion in annual sales including the food service segment.

2 . The applicant carries on business by itself and through joint ventures. The applicant has formed a joint venture company called Cereal Partner worldwide which markets ready-to-eat cereal brands in more than 130 international markets. The applicant carries on its business General Mills India Private Limited which is a subsidiary of the applicant company. The Indian subsidiary was formed in the year 1995. Its emphasis is on global brands and technology and adopting these to local market requirements. The applicant's Indian brand portfolio includes Pillsbury Chakki fresh atta, Pillsbury non-sticky semiya etc. and was introduced as early as 1998 in India.

3 . The applicant's predecessor M/s. Trix Food Products Inc. adopted and used the trade mark "TRIX" as early as 29 July, 1910 which was assigned to the applicant company in 1953. The applicant launched its first TRIX cereal under the brand in the year 1954. The goods bearing the brand "TRIX" were an instant hit due to their superior quality. On 21st November, 1989 the applicant and Societe des Produits Nestle, S.A. entered into a joint venture agreement for marketing of ready-to-eat breakfast cereal outside the United States, Canada and Iceland. The joint venture company is called Cereal Partners Worldwide and uses several applicant's brands to market breakfast cereal including "TRIX" brand.

4. In some countries for ease of management, if TRIX breakfast cereal is not sold in such countries the applicant retains all rights and registers the brand in its own name. Currently in India, Cereal Partners Worldwide is not selling breakfast cereal. So the present applicant currently for all purposes is pursuing registration and protection of the brand "TRIX" for its products. The applicant's consolidated worldwide net sales of various products for the years 2002 to 2007 are US \$ 1,400,0000,000. The advertisement expenses of various products are US \$ 244,000,000. The mark was advertised in the year 1959. The applicant has constantly changed the packaging and given different prizes to popularize the brand.

5 . The applicant owns registrations in various countries. The mark had been used since 1910 in the USA and it launched its products in India under the brand name "TRIX" in the year 2005. The mark "TRIX" has been advertised through various media like newspapers, television etc.

6. In order to gain statutory protection, the applicant herein filed an application for registration of the mark "TRIX" for goods falling in classes 29 and 30. The application was numbered as 1347981. The Registrar of Trade Marks rejected the said application on the ground that the trade mark "TRIX" was already on the register and that the applicant's trade mark was "proposed to be used" against which an appeal has been preferred and the same is pending.

7. The applicant through an advertisement on the internet in the DNA Daily News on 26. 11.2007 became aware of the first respondent's trade mark "TRIX" which was to be launched in December, 2007. The applicant immediately filed a Civil Suit in the High Court of Delhi restraining the respondent from launching its

product under the trade mark and passing off of its goods as that of the applicant. The Hon'ble High Court of Delhi restrained the first respondent from launching the goods bearing the trade mark.

8 . The applicant's representative found that though the mark is registered in favour of the respondent it was not put to use. Since no use was found no legal action was initiated till filing of the Civil Suit. The impugned trade mark was filed as early as 28.10.1977 on "proposed to be used" basis. The respondent has till date not used the impugned trade mark. It was in November 2007 that the respondent was to launch its products in December, 2007. The Delhi High Court had restrained the respondent from launching its products by order dated 12th December 2007. The impugned trade mark is liable to be removed for not using the mark continuously for a period of 5 years and 3 months and on the ground that the mark is registered without sufficient cause and is wrongly remaining on the register. The mark is registered without any bonafide intention to use. The impugned trade mark has been wrongly registered as the respondent is not the proprietor of the impugned trade mark. The impugned trade mark is identical to the applicant's trade mark. The registration has been obtained with malafide intention. It has been registered for the purpose of harassing the applicant and to prevent the applicant from registering the trade mark. Therefore, the applicant prays that the impugned trade mark be rectified.

9. The respondent herein filed their counter statement stating that they are carrying on business of marketing milk and milk products. The respondent is a cooperative society established with the object to carry out certain activities for the welfare and economic development of the dairy farmers in organizing and marketing milk and other dairy products.

10. The respondent is involved in the business inter alia milk and milk products such as Amul Spray, Amul Butter, Amul Milk powder, chocolate etc. They are the registered proprietor of the reputed and well known trade mark and many of its variants. In the year 1977, the respondent coined the word from the dictionary word "TRICKS". The application for registration of the mark "TRIX" was filed on 28.10.1977. The respondent had started using the trade mark in chocolate, Amul food. The respondent started selling "AMUL TRIX" since 1986. It has also advertised its products through various media. It is clear that the registered trade mark "TRIX" is openly in use in India. The respondent further states that the applicant is doing business in India through its associates in the same line of business. Therefore, it is submitted that under Section 33(1) of the Trade Marks Act, 1999 assuming the applicant claims to be the proprietor of the trade mark which is denied by the respondent and the applicant seems to have acquiesced for a continuous period of 5 years and is no longer entitled to apply for a declaration for the registration which is invalid. This acquiescence is clear from the fact that the applicant through its associates and the respondent were doing business in the same line and in the same area. In support of this, the respondent has filed two affidavits of wholesale dealers distributing the products

of the respondent who reaffirm the fact that Nestle was aware of the respondent's products and therefore under Section 33 of the Act, the application is not maintainable. The rest of the averments made in the application were denied by the respondent.

11 . We have heard Shri N. Mahabir, Counsel for the applicant and Shri Pranit K. Nanavati, Counsel for the respondent.

12 . The learned Counsel for the applicant submitted that the application for registration of the impugned trade mark was filed on 28.10.1977 as "proposed to be used" by the respondent. The applicant adopted the trade mark "TRIX" as early as 29.07.1910 by its predecessor and in 1953 by the applicants. The first products was launched in 1954.

13. The respondent had not used the trade mark on their goods even though they had applied for and obtained registration as early as 1977. In December, 2007 when the respondent had advertised about their launch, the applicant filed the Civil Suit and obtained injunction. The mark is not put to use and therefore the mark is wrongly remaining on the register.

14. The applicant adopted and used the trade mark since the year 1910 outside India and in India since 2005. The applicant therefore applied for registration of the trade mark "TRIX" on 30.03.2005 under No. 1347981. On 26.11.2007, the applicant became aware of the respondent's launch of the product bearing the trade mark "TRIX" through an advertisement on the internet in the DNA Daily News & Analysis. The Counsel submitted that a Civil Suit was thereafter filed. The Counsel then pointed out the averments made in the Counter Statement and submitted that the respondents themselves have admitted that they are selling their nougat bar since 1986. The respondents have also admitted that in 1986 they launched chocolate under the trade mark "AMUL TRIX" throughout India. In 2005-2006 after a market search and survey they launched chocolate wafer in May 2007.

15. The Counsel further submitted that they had been using the trade mark "TRIX" extensively since adoption outside India. The respondents are not using the trade mark and therefore ought to be removed on the ground of non user. The Counsel then relied on a few judgments:

(i). 2004 (28) PTC 585 (SC) - Milment Ortho Industries & Ors., Appellants Vs. Allergan Inc., Respondent was relied on to state that they were first in the world market and the respondent's mark which was subsequent ought not to continue on the register.

(ii) . 1996 PTC (16) 476 - N.R. Dongre, Petitioner Vs. Whirlpool Corp., Respondents - The magazine "Life" had circulation in India was observed in that judgment. The applicant's mark was advertised in the said magazine "Life" as early as 1953 and so the magazine "life" had circulation in India can be relied on to prove their use in India.

(iii) . 2006 (32) PTC 133 (Del) - Austin Nichols & Co. & Anr., Plaintiffs Vs. Arvind Behl & Anr., Defendants - Merely being first past the post in India is not enough.

(iv). 1998 (PTC) 18(DB) 288 - Centron Industrial Alliance Ltd., Petitioner vs. Gillette U.K. Ltd., Respondents - Foreign magazine advertisements which are circulated in India are freely imported and presumably read.

(v). 2001 PTC 889 (Del) DB - Veerumal Praveen Kumar, Petitioner Vs. Needle Industries (India) Ltd. & Anr., Respondents - If there is non user for a long period of time then mere registration will not entitle that person to obtain injunction.

(vi) . 2005 (30) PTC 358 (Del-DB) - Fedders Lloyd Corporation Ltd. & Anr., Petitioners Vs. Fedders Corporation, Respondents - It is the duty of the respondent to show their intention to use the trade mark.

16 . The applicant prayed that the application be allowed and the trade mark be removed from the register.

17. The learned Counsel for the respondent in reply contended that the applicant had not satisfied the provisions of Section 47 and as such no ground is made out for removal of the trade mark. The applicant is not a person aggrieved. The Counsel submitted that they had sale during the year 1985-86. In the year 2005, they had sale for a different product. For sale in the year 1986 they relied on few invoices filed along with the reply to the Miscellaneous Petition filed by the applicant to receive additional documents.

18 . The Counsel then relied on the judgment reported in MANU/SC/0932/2010 - Infosys Technologies Ltd., Appellants Vs. Jupiter Infosys Ltd. and Another, Respondents and submitted that the phrase "aggrieved person" is differently construed in the case of Section 47 and it not the same as in the case of removal under Section 57. The Counsel produced a computer generated search report and stated that there were several people using the trade mark "TRIX".

19 . The other contention was that the applicants were aware of the respondent's registration as early as 2005 when they received the examination report for their application for registration. Having been aware of this mark on the register, the applicant has acquiesced the respondent's use. The Counsel then relied on the judgment - Madras High Court W.P. No. 8681 of 2011 - Rhizome Distilleries Pvt. Ltd., Vs. Union of India decided by the Division Bench of the Madras High Court and submitted that this Board had no powers to decide the rectification under Sections 9 and 11 of the Act.

20. As regards "aggrieved person" the respondent relied on these judgments -

(i). AIR 2003 SC 3377 - Hardie Trading Ltd., and another, Appellants Vs. Addisons Paint and Chemicals Ltd., Respondent

(ii). AIR 1969 Cal 43 (V.56 C 9) - Aktiebolaget Jonkoping Vulcan, Appellant Vs. V.S.V. Palanichamy Nadar and others, Respondents

(iii). ORA/89/2007/TM/CH(IPAB) - Elbaik Food Systems Co.S.A., Applicant Vs. Mr M Moideen Kutty, Respondent

(iv). ORA/38/2007/TM/MUM (IPAB) - M/s. Mashreq International (L.L.C.), Applicant Vs. Tuff Stuff Watches Pvt. Ltd., Respondent

The advertisements in foreign magazines will not prove use unless it is openly available in the market - ORA/13/2004/TM/KOL (IPAB) - Nabisco Inc., Applicant Vs Royal Snacks Food Products & Another, Respondents and TA/286/2004/TM/AMD (IPAB) - M/s.The Wellcome Foundation Limited, Appellant Vs. M/s. Reliance Formulations Private Ltd., & Another, Respondents were relied on.

21. In rejoinder the Counsel for the applicant submitted that the various trade marks which are pending before the Registrar (the list produced by the respondent) have been opposed by the applicant. The issue of acquiescence does not arise as the applicant had conducted a market survey and found that the goods bearing the trade mark "TRIX" was not available till the date of this rectification application.

22. We have heard and considered the arguments of both the sides and have gone through the pleadings and documents.

23. The application for rectification in this case is mainly based on the ground of non user. As had been held in the Hardie's case (supra) if the ground is merely of non user it is not on account of public interest. It gives a right to a person whose interest is affected to apply for its removal whereas the non user does not by itself render the entry incorrect. The test here would be to see if the applicant is really a person aggrieved and has the right to file an application for rectification.

24. The settled principle is that only an aggrieved person can file an application for rectification and not any person as provided under Section 21 of the Act. Romer. J. held in Wright Crossley, Tm : (1898) 15 RPC 131 that -

...in some possible way he may be damaged or injured if the Trade Mark is allowed to stand; and by "possible" I mean possible in a practical sense, and not merely in a fantastic view..... All cases of this kind, where the original registration is not illegal or improper, ought to be considered as questions of common sense, to a certain extent at any rate; and I think the applicants ought to show something approaching a sufficient or proper reason for applying to have the Trade Mark expunged. It certainly is not sufficient reason that they are at loggerheads with the respondents or desire in some way to injure them.

25. In the case on hand, the applicants are injured in some way. The applicants have applied for registration and were not successful in their application as the impugned trade mark was already on the register. The impugned trade mark was not put to use and was therefore wrongly remaining on the register without sufficient cause. The applicant is therefore a person affected and can be said to be a person aggrieved.

26. The other issue is regarding non user of the registered impugned trade mark. The documents produced by the respondents are only for the year 1986 only. There are few bills which is for the mark "AMUL TRIX". There is one advertisement of the year 1986. The other documents filed by the respondent are few invoices of the year 2007 which were filed along with the reply to the Miscellaneous Petition No. 297/2010. The invoices of the year 2007 bear the trade mark "TRIX" mentioned. So there has been sporadic intermittent use of the trade mark which shall not be accepted. The mark on the register without use prevents others from using the mark who really have intention to use the trade mark. The other documents filed by the respondent are two affidavits. The deponents in those affidavits have stated that they have been assigned the wholesale dealership of "AMUL" from the year 1977. There is no proof for the same. They have stated about the advertisement cutting filed by the respondent. This is only of the year 1986. There is nothing on record to prove that the mark was in use extensively and continuously since 1986.

27. The Apex Court has held in *Milment Ortho Industries & Ors.*, (cited supra) that the mere fact that the party has not used the mark in India would be irrelevant if they were first in the world market. The applicants have used the trade mark outside India and have proved their intention to use in India by filing an application for registration. The applicant's use outside India is not in dispute. Considering all the above, the application for rectification ORA/28/2008/TM/AMD is allowed with a direction to the Registrar of Trade Marks to cancel the trade mark registered under No. 330224 in Class 30. There shall be no order as to costs. M.P. No. 297/2010 and M.P. No. 76/2012 are disposed of.