
(2002) 07 BOM CK 0059
In the Bombay High Court
Case No : Misc. Petition No. 42 of 1995

I.T.C. Limited

APPELLANT

Vs

G.T.C. Industries Ltd. and Another

RESPONDENT

Date of Decision : 05-07-2002

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 17, 9(4)

Citation : (2003) 2 BomCR 417 : (2002) 25 PTC 341

Hon'ble Judges : S.A. Bobde, J

Bench : Single Bench

Advocate : Ravi Kadam, Rahul Chitnis, Ninish Kothare, Paul P.P. and Santosh Bhide, instructed by Nanu Hormasjee and Co, for the Appellant; M.R. Nair, for the Respondent

Final Decision : Dismissed

Judgement

S.A. Bobde, J.—This petition challenges the order dated 19.12.1994 of the Asstt. Registrar of Trade Marks by which he has permitted the respondent to register the trade mark "MAGNUM" in class 34 in respect of cigarettes, bidis, safety matches, cigars, smoker's articles, etc.

2. The respondent No. 1 made an application on 23.12.1987 for registration of the trade mark "MAGNUM" for its cigarettes. Upon an advertisement for registration in part A of the register, the petitioner filed a notice of opposition on 14.5.1992. A counter was filed by the respondent No. 1 on 11.8.1992.

3. The evidence was led in the form of affidavits wherein a reference is made to the dictionary meaning of the word. A piece of evidence considered important by the petitioner was an advertisement in a Trade Mark Journal where the Registrar had while registering the label mark for CAVANDERS cigarette laid down a disclaimer for the words "MAGNUM FILTER". It is important to note that the disclaimer, as observed by the Registrar, was agreed to by Godfrey Philips.

4. The learned Registrar found that the word "MAGNUM" occurs in various

dictionaries. He, however, observed that it does not appear to have a descriptive significance as far as the goods specified in the impugned application. The learned Registrar has stated that the word "MAGNUM" is derived from a Latin word "MAGNUM" which means great. Though the Registrar found the word descriptive in the sense that it has been adapted to distinguish, he did not register the trade mark in part A of the register but allowed its registration in part B. There is no dispute about the fact that a descriptive trade mark may nonetheless be registered under part B by virtue of Section 9(4) which reads as follows:-

"9. Requisites for registration in Parts A and B of the register.

(1)

(2)

(3)

(4) A trade mark shall not be registered in Part B of the register unless the trade mark in relation to the goods in respect of which it is proposed to be registered is distinctive, or is not distinctive but is capable of distinguishing goods with which the proprietor of a trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration."

5. Mr. Kadam, learned counsel for the petitioner, submitted that the word "MAGNUM" was not capable of being adapted to distinguish goods like cigarettes, bidis, etc., since it was a common word and being part of the common of the English language, it can neither be considered as adapted to distinguish nor distinctive.

6. In order to appreciate the argument of the learned counsel, a reference may be made to the leading judgment on this concept, which words may be considered as adapted to distinguish i.e. the judgment of the Court of Appeal reported in the case of Joseph Cross field & Sons Ltd. 1909 (26) RPC 836. That was a case in which the English Court considered whether the word "Perfection" can be taken as a word which is adapted to distinguish the goods in question, in that case, soap, of the proprietor from the goods of other person. The Court observed at page 854 of the report:

"Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure." The Court further observed:-

"It is apparent that no word can be registered under this paragraph unless it is "distinctive" - that is to say, is "adapted to distinguish" the goods of the proprietor from the goods of other persons. There are some words which are incapable of being so "adapted" such as "good", "best", and "superfine". They

cannot have a secondary meaning as indicating only the goods of the applicant. There are other words which are capable of being so "adapted", and as to such words the Tribunal may be guided by evidence as to the extent to which use has rendered the word distinctive. It is easy to apply this paragraph to geographical words, and it is possible to suggest words having direct reference to character or quality which might be brought within it. But an ordinary laudatory epithet ought to be open to all the world, and is not, in my opinion, capable of being registered. It may be that within a particular area the applicant might succeed in a passing off action against a trader who used the epithet without sufficiently distinguishing his goods from the goods of the applicant. But that would not justify the Court in giving the applicant a monopoly throughout the United Kingdom in the use of a laudatory epithet."

7. Therefore, what needs to be considered is whether the word "MAGNUM" is a part of the common language used in India. There is no doubt that we are dealing with goods such as cigarettes, bidis, etc. which are capable of consumption by a cross section of Indian people.

8. On behalf of the petitioner, reliance was placed before the Registrar on the following cases where words like "PERFECTION" occur:-

"1) Joseph Crosfield & Sons Ltd. Perfection Case (1909) 26 RPC 561.

2) ALWAYS Trade Mark (1986) RPC 93.

3) HEAVENLY Trade Mark (1967) RPC 306.

4) MERIT Trade Marks (1989) RPC 687.

5) MUST Trade Mark (1976) RPC 712.

6) CHARM Trade Mark 194 RPC 1."

The question that needs to be asked is whether the word "MAGNUM" is a part of the common language, including English in India. In my view, it does not take much to answer in the negative since the word "MAGNUM" which is essentially a Latin word is little known. In the English language, it means essentially a large bottle for wine or spirits, containing about 50 ounces, as would be apparent from the meaning of the word in the Concise Oxford Dictionary, Random House Dictionary and the Chambers English Dictionary. There would be few who would know, in India, that it means great.

9. I have no doubt that a person of good education and proficient in the English language would know that it connotes something large or great. That is not the correct test to apply. Whether the word is well-known or little known must not be considered from the stand point of the educated man or the Lexicographer, but must be considered from the stand point of the common man or the man of average intelligence and knowledge. As is well-settled, "the mark or the word of which it is constituted, must be given not only its ordinary popular meaning but must also be considered from the point of view of the reaction to such a mark of

word of the proverbial common man with average intelligence and imperfect recollection and not how a lexicographic (sic) or a highly educated person would understand or react to it" vide V.K. Industries v. V.H. Mehta 1998 (18) PTC 526 (Del). Applying this test, I am of the view that "MAGNUM" is not part of the common language in India and must be taken to be word which is adapted to distinguish or capable of distinguishing of goods of its proprietor from the goods of another. A Court must, undoubtedly guard against attempt of well-known traders to enclose part of the common language and to exclude the general public of the present day and of the future from access to enclosure. The guard would go up only when in the first place, the word in question is a word which is a part of the common language in India. In my view, it is not so in this case.

10. The Supreme Court in Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd., , has, although in another context unequivocally held that the setting in which the effect of trade mark must be considered is in India. In para 33, the Supreme Court has observed as follows:-

"While examining such cases in India, what has to be kept in mind is the purchaser of such goods in India who may have absolutely no knowledge of English language or of the language in which the trade mark is written and to whom different words with slight difference in spellings may sound phonetically the same. While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors. What is likely to cause confusion would vary from case to case."

Earlier in the judgment, their Lordships have observed as follows:-

"The products will be purchased by both villagers and townsfolk, literate as well as illiterate and the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. A trade may relate to goods largely sold to illiterate or badly educated persons. The purchaser in India cannot be equated with a purchaser of goods in England."

I am, therefore, clearly of the view that the word "MAGNUM" in India can be considered to be a word which is adapted to distinguish and, in any case, capable of distinguishing the goods of the proprietor from the goods of another.

11. Mr. Kadam then contended that the Registrar's order must be set aside on the ground of arbitrariness since the Registrar has, while registering the label mark for CAVANDERS, cigarette asked its proprietor Godfrey Philips to disclaim the following sets of words:-

"Magnum Filter, Extra thickness, Extra taste, 10, Filter cigarettes. Made in India Number 10 and letter C."

The argument is that the Registrar has blown hot and cold in respect of the same

word "MAGNUM" by asking the proprietor to disclaim it, presumably on the ground that it is not distinctive and allowing another to use it on the ground that it is distinctive.

12. Mr. Nair, learned counsel for the respondent No. 1, submitted that whatever the Registrar may have done in the case of CAVANDERS in relation to the proprietor Godfrey Philips cannot bind the respondent. I am of view that Mr. Nair is right in making this submission. If the contrary were true, it would mean that all proprietors in future who propose to use the words disclaimed by Godfrey Philips in their trade mark would be prevented from applying for registration of those words as part of their trade mark. This cannot be.

13. Moreover, it is apparent from the order of the Registrar in the present case that the disclaimer by Godfrey Philips was to the words "MAGNUM FILTER" and not "MAGNUM" per se. In the area where trade marks are important, it makes a difference. Moreover, it is clear from the order that Godfrey Philips themselves agreed to disclaim the words "MAGNUM FILTER". It, therefore, cannot be said that the disclaimer of the words "MAGNUM FILTER" would disclaim another proprietor from applying for registration of a trade mark containing the word "MAGNUM".

14. At this point, it may be relevant to consider the effect of disclaimer u/s 17. Section 17 reads as follows:-

"17. Registration of trade marks subject to disclaimer:-

If a trade mark-

(a) contains any part-

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character;

the tribunal, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register, that the proprietor shall either disclaim any right to the exclusive use of such part or of all or any portion of such matter, as the case may be, to the exclusive use of which the tribunal holds him not to be entitled, or make such other disclaimer as the tribunal may consider necessary for the purpose of defining the rights of the proprietor under the registration:

Provide that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made."

It is obvious from Section 17 that the Registrar can, in the cases contemplated

by (a), (b) and (c) above, require the proprietor to disclaim the right to exclusive use of such part or of "all or any portion of such matter." The section requires the Registrar to be precise. He may call for a disclaimer of the whole matter or a part of such matter. Once a disclaimer is recorded, it must follow that what is disclaimed must be taken as a whole. Thus where, the disclaimed portion is a phrase containing several words in a certain sequence the whole phrase must be taken to have been disclaimed as a whole. It would not be permissible to infer a disclaimer of a part of it or the whole of it in another sequence. From Section 17 it is clear that one of the main reasons why the Tribunal makes a disclaimer is for the purpose of defining the rights of the proprietor under the registration. I am of view that inquiry is different where an application for registration of a trade mark is being considered. Firstly, the whole of the trade mark must be considered and in a given case a part of what is disclaimed by one party may legitimately be allowed to be registered as a part of the trade mark of another party depending upon the way it is incorporated in the trade mark. There cannot be any absolute statement of law that if a part of a trade mark is disclaimed, part of what is disclaimed can never form part of another trade mark.

15. Mr. Kadam, learned counsel for the petitioner submitted that if the order of the Registrar allowing "MAGNUM" is upheld, no one will ever be allowed to use that word in respect of goods in clause 34 i.e. cigarettes, bidis, etc. Mr. Nair in reply rightly refers to Section 34 which reads as follows:-

"34. Saving for use of name, address or description of goods.

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bonafide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods."

It is clear that another person cannot be prevented from resorting to any bona fide description of the character or quality of his goods. I make it clear that this question does not arise before me for determination, but I have referred to it only in passing.

16. In the result, I see no merit in this petition which is hereby dismissed. No order as to costs.

17. At this stage, Mr. Chitnis on behalf of the petitioner states that respondent No. 1 had assured the Court that they would not collect its Certificate of Trade Mark when this petition was admitted. Mr. Nair, learned counsel for respondent no. 1, states that he would continue the assurance for a period of four weeks from today.

18. P.S. to give ordinary copy of this order to the parties concerned.