
(2011) 09 IPAB CK 0003

In the Intellectual Property Appellate Board

Case No : M.P. Nos. 118/2007, 134 And 135/2011 In ORA/170/2007/TM/KOL

Jagpin Breweries Limited

APPELLANT

Vs

Shaw Wallace And Company Limited

RESPONDENT

Date of Decision : 14-09-2011

Acts Referred:

Code Of Civil Procedure, 1908 — Order 39.Rule 1
Trade And Merchandise Act, 1958 — Section 2(zb), 6, 9(1)(e), 11(7), 11(8), 17, 18,
32(c), 38, 39, 40, 144
Trade Marks Act, 1940 — Section 13

Citation : (2011) 3 MIPR 317

Hon'ble Judges : Prabha Sridevan, J;S. Usha, J

Bench : Division Bench

Final Decision : Dismissed/Disposed Of

Judgement

Prabha Sridevan, J

1 . Haywards 5000 is the trademark that is in controversy. The applicant seeks rectification of the trademark No. 436744 in class 32 in the name of

Shaw Wallace and company Ltd or for a disclaimer on the numeral 5000. Shaw Wallace was the original respondent in the rectification petition.

2 . The Applicant manufactures and markets beer, ale and porter. In 2003 the applicant devised a trademark ""Cox"". The number 5000 was added to

indicate potency. Since then the applicant was using the said trademark ""Cox 5000"" until it was restrained by an order of injunction by the Bombay

High Court. The Applicant has applied for registration of the said trademark and the applications are pending. There is a copyright registration of the

artistic work. The applicant has been using the mark openly, continuously and extensively. The mark has been associated with the goods of the

applicant alone. The Respondent (SKOL Breweries Ltd) filed Suit No. 2510 of

2006 in the Bombay High Court. According to the suit averments

Shaw Wallace had assigned the Trademark rights to the Respondent under a deed, and TM 24 was pending. The Registrar granted registration with

the disclaimer of all descriptive matters for this mark which contained the words ""Haywards 5000 Super Strong Beer"" The number 5000 shall be

disclaimed as per Section 17 of the Trade and Merchandise Act 1958 (The Act). Therefore clearly the disclaimer included 5000. In the original

Respondent's application No. 94088 in class 32, the disclaimer had been imposed and it had been agreed to. No one can claim a monopoly over a

number. The mark is not distinctive. The Registered Proprietor was never the proprietor of the trade mark ""Haywards"" or ""Haywards 5000"" The beer

is drunk by young people and the number denotes the strength. The assignment deed shows that proper stamp duty was not been paid. There is no

similarity between the Applicant's trademark and the Respondent's trade mark. The number 5000 is a laudatory word. The Respondent must prove

user. Numerals are common to the trade, as the search reports would reveal. The Registrar must be consistent in his stand regarding imposition of

disclaimers. Applicant is a person aggrieved. The applicant prayed for rectification on the basis of the above averments.

3. The Respondent in its counter statement denied all the averments. The Respondent is engaged in the manufacture of Alcoholic beverages. It had

acquired several trademarks including ""Haywards lager beer"", ""Haywards Diet"", ""Haywards 2000"", ""Haywards 5000"" and Ors. from Shaw Wallace

under the assignment deed dated 27-5-2005. This has been recorded by the Registrar and also notified in the Journal 1384 dated 16.1.2008. The

Respondent (which term includes Shaw Wallace and Company Ltd) had adopted the trademark ""Haywards 5000"" in 1983, and ""Haywards 2000"" in

1980. The earliest application for ""Haywards 2000"" was filed on 18.4.1980 in No. 360850 in class 32. It was registered and has been renewed. The

earliest application for ""Haywards 5000"" was filed on 19.4.1985. It was registered and has been renewed till 19.4.2016. The artistic work of the

Haywards 5000"" label has been granted a copyright under No A-430438/83. The launch of this product was an instant success. It is one of the

largest selling beers in the Strong Beer segment. The sales have crossed several crores of rupees. The Respondents have been using the series of

trademark incorporating the word ""Haywards"" and the numeral 5000, where the emphasis was given to the numeral. There has been extensive

promotion and advertisement of the product and consequently the sales figures are also huge. The mark 5000 has been associated only with the

Respondent's goods. Apart from the common law rights, the Respondent has also secured statutory rights in respect of several marks in several

classes. They have protected their rights by issuing cease and desist notices against third parties who were misusing the marks ""Haywards 5000"", or

Haywards"" or ""5000"", these actions have been initiated either by the Respondent or its predecessor in interest. This includes the suit filed against the

applicant. The Respondent had specifically objected to the disclaimer of the numeral ""5000"". Despite this objection, the Registrar had notified the trade

mark with the said condition. The mark is distinctive. There was no fraud, no irregularity in obtaining the registration. All the allegations are baseless.

4. To this a reply was filed. According to this reply, the counter statement shall not be taken on record, since it has not been signed by the party but by

one SKOL Breweries Ltd. The TM 23 order is vitiated because no notice was given to the Applicant for the said proceedings. The numeral 5000 is a

descriptive term, and no length of user can convert it to a distinctive one. Since the counter statement specifically states that the goods sold under the

trade mark is mainly beer, other goods included in the registration are liable to be deleted. Numerals denote strength. Haywards 5000 contains 7%

alcohol while Haywards 10000 contains 8% alcohol. The Respondent cannot carve out monopoly in the said numeral. The Respondent has no

bonafide intention to use the mark, it has no sale in the country. Therefore, the rectification must be allowed.

5. On 23.6.2011, this Board directed the Respondent to produce the assignment deed by which the rights were transferred to the Respondent. A copy

was produced and the same was taken on file on 9th August 2011. The counsel for the Respondent raised an objection that the assignment deed was

not duly stamped and cannot be looked into. The counsel for the Respondent then produced the original document and we have seen it and find that it

is duly stamped.

6 . The Learned Counsel for the Applicant submitted that the words disclaiming all descriptive words meant not only the words ""super"" and ""strong

but also the numeral "5000" since the number denotes strength. All the judgments that are referred to in the evidence are cases that arose under Order 39.Rule.1, and do not really deal with the issue of disclaimer. If the label is looked at, it would be clear that originally the label did not have 5000 as the main feature, but now the dimensions of the numerals is gradually increased. The Respondent is thus appropriating to itself an unhealthy monopoly in a number which it is not entitled to. Section 144 of the Act requires that trade usage be taken into consideration. Annexure C is the advertisement of the mark 360850 "Haywards 2000 lager beer extra strong" and it says that the registration shall give no right to the exclusive use of 2000 and words extra strong. He referred to annexure A filed along with M.P. No. 135/2011 which is an extract from a beginners guide to alcoholic strength. According to him this would show that the numerals are added to denote strength. According to the Respondent Haywards 5000 contains 7% alcohol and Haywards 10000 contains 8% alcohol. He denied the user of Haywards 2000 and Haywards 5000 from 1980 and 1983 respectively. According to him Cox 5000 was adopted only to show potency. The Search report would show that there are so many marks registered with the numerals 5000, 2000 etc. The registrar had imposed the disclaimer on the number 2000 and the Respondent had accepted it. So now it cannot take a contrary stand. No notice was given when TM 24 was taken on file. There was failure of the principles of natural justice and on this ground the proceedings have to be set aside. In our day to day life we convert everything to numerals in order to assess the strength or potency etc. He compared the Section 17 of Trade and Merchandise Marks Act and Section 18 of the Trade Marks Act. He submitted that the registrar must have realized that the disclaimer may be ambiguous and that is why the disclaimer is explicitly stated in 2000.

7 . The Learned Counsel for Respondent submitted that the Respondent had never acquiesced to the disclaimer. He submitted that there was nothing to show that 5000 was a descriptive word. He referred to instances where the registrar had disclaimed the descriptive words and also the numerals which only meant that the numeral was not a descriptive word. The Learned Counsel submitted that the Respondent had been vigilant in protecting the mark Haywards 5000 as a whole on numerous occasions and produced the Court orders and the compromises arrived at. He submitted that there was

no doubt that Haywards 5000 had acquired a distinctive character because of the reputation. The learned counsel submitted that the Respondent can

only prove the sales effected by the Respondent, but since in our country advertisement of liquor was not permitted it was not possible to show that

they had marketed their products as HAYWARDS 5000. The Learned Counsel submitted that the rectification must be disallowed.

8. We have considered the submissions.

9. The Learned Counsel for the applicant objected to the reception of the additional documents on the ground that they were all in the possession of

the Respondent even when they originally filed their evidence in the counterstatement. It is relevant to note that a rectification petition is not an appeal

but an original proceeding, and therefore the criterion for reception of additional evidence in Order 47 will not apply. But we have examined the matter

on the principles of natural justice and we see no reason why we cannot look at public documents like trademark journals or the orders and judgments

of the trademark registry or the High Courts respectively. They are public documents too.

10. The request on TM 23 was made and the entries made in the registry on 27.12.2007(Annexure B to M.P. No. 134/2011). The Journal

notification recording the Respondent as the subsequent proprietor for the impugned mark among others was made on 16.1.2008 (Annexure in above).

In the order dated 17.10.2006 the mark ""Haywards 5000"" in application No. 941704 proceeded to registration and the applicant's opposition was

disallowed. It is important to note that the Registrar has recorded that they had ""agreed to disclaim the numeral 5000"" (annexure C1 in above).

Another opposition to the same application filed by the proprietors of Superior 5000 was also disallowed on 19.1.2007(Annexure C2). Against this an

OA/18/2007/TM/KOL was filed and this was dismissed. In this case there was an objection to the assignment deed as in the case on hand and this

Board held that the assignment cannot be disputed by a third party. Therefore this ground of opposition is rejected. Even if the Registrar had not given

notice in the TM 23 proceedings, it cannot vitiate the entire proceedings. So this same objection had earlier been raised and rejected too.

11. Annexure D is a register maintained by the registry of well-known trademarks defined in Section 2 (zb) and as per Section 11 (8). Section 11 (8)

reads as follows:

Where a trade mark has been determined to be well-known in at least one relevant section of the public in India by any court or Registrar, the

Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.

12 . I n 2003 (27) PTC 63 Shaw Wallace and Company Ltd. and Anr. v. Superior Industries Ltd., the Hon'ble Delhi High Court has recognized this as

a well-known mark. The Court held that the material on record shows that numerical 5000 has been used in connection with their super strong beer

and the said numeral has resulted in the generation of reputation in respect of the beer and is identified in the minds of consumers with their trade.

13. The Learned Counsel for applicant wondered what sanctity such a list can have and that there are glaring omissions. We have no comments to

offer on the list, but the Act clearly says that if a trade mark has been considered as well-known by a considerable section of society, the Registrar

shall consider it as such. In this regard Section 11(7) says how it shall be determined.

14. Annexure E consists of the list of opposition filed by the Respondent and there are 90 oppositions, including the applicant herein. There are

documents to show that applications opposed by the Respondent have abated, or persons receiving notices of opposition have agreed not to use the

numerals in connection with goods in Class 32 and 33. Such marks are ""Smile 2000"" (Sundaram Clayton) ""Russel 2000"" (Frank Russel Ltd USA).

15. Then we have a series of judgments of the High Court. One such is the order in Notice of Motion No. 1259 of 1994 in Suit 2037 of 1994 on June

20 1996. This answers many of the issues raised here. It relates to a suit filed by Shaw Wallace the predecessor in interest of the Respondent herein

to restrain the use of ""Castle 2000"". It was held that there is no evidence to show that the numeral indicates potency and that ""That there could be an

arcane connection between the numeral used and the potency of the beer or its alcohol contents, which perhaps is known only to its manufacturer, is

insufficient to change the numeral from a fancy number to descriptive one so as to take it out of its realm of exclusiveness"".

16. In Annexure I the Bombay High Court protected the right of the proprietor of Haywrds 5000 (Application No. 463744) from being infringed by the

proprietors of ""Prestige 5000"" or ""Four Square 5000"" and observed ""Thus wherever there is a disclaimer in respect of a numeral the reference is

specifically made. In the instant case i.e. the mark which is registered, there is no such disclaimer in respect of the numeral 5000 and the disclaimer is

for descriptive word which obviously are strong beer."" The judgment has also noted the objection of the Respondent to the disclaimer in Application

No. 940878.

17. Annexure L1 is a suit between the parties herein where interim order against the applicant was confirmed it is dated 8-3-2011.

-Annexure L2 is a decree against the mark of Dansberg 5000 dated 1st October 2008.

-Annexure L4 is against the mark ""Holyward"", ""Holyward 5000"", ""Harvard 5000"" and ""Valley 5000"".

-Annexure L5 is a decree against the mark Mount's 5000.

-Annexure L6 is a decree against the mark Maikal 5000.

18. It is not necessary to enumerate and mention each document, it is amply evident that the courts have held that the Respondent is entitled to a

protection against use of 5000 for goods in this class and the parties who have used it have withdrawn their applications or subjected to consent

decrees.

19. In Annexure F filed along with the Petition we find the search report of marks containing 2000. In page 1 there are 4 registrations of the

Respondent/ Maqua 20000 and Castle 2000 are abandoned. The only other mark is Berlin 2000. In page 2 there are 2 marks belonging to the

Respondent on the register, then Expo 2000,(2) are withdrawn, Miraj 2000 is opposed and aqua 2000 examination report issued, In page 3, the marks

belonging to others containing 2000 are abandoned or withdrawn, one is opposed, and four marks are subject to examination report, in page 4 the

marks belonging to Respondent are registered, the only other mark belonging to the Respondent that is registered is MARWAR 2000, the rest are

either opposed, withdrawn or not registered. The search report with regard to 2000 or 10000 are really not very relevant. Therefore by and large the

live marks on the Register containing the numerals, belong to the Respondent really.

20. Now with regard to search report relating to 5000 the case is the same as in

2000. The majority of the marks containing the numeral which are registered are the Respondents or Shaw Wallace, the marks belonging to others are opposed, withdrawn, abandoned or still at the stage of examination report. There are only a few containing the mark and belonging to others which are registered.

21 . The search report to the extent of its reliability only speaks of a history of successful assertion of the right to use the numeral by the Respondent and resistance to others using it.

22. Now we come to Annexure G.

23. These are extracts from the Trademark journal.

1) August 1, 1984. Haywards 2000 lager Beer-Disclaimer of numeral 2000 and words "" extra strong

2) September 16, 1984. Brihans No:1 disclaimer of the device of grapes and the expression No. 1

3) March 16, 1988 Brihans 555 XXX Rum disclaimer of the numeral 555 and letters XXX

4) November 16, 1988 McDowell's brandy disclaimer of McD and No1

5) He man 3000 No right to exclusive use of 3000

6) Haywards 2000 extra strong no right to exclusive use of numeral 2000 and words "" extra strong

7) August 1, 2001 Hi Noon 10000. No right to exclusive use of the numeral 10000

8) August 25, 2003 Berlin 2000. No right to exclusive use of numeral 2000

9) August 15, 2005 extra strong London 5001 plus super strong beer: no right to exclusive use of all other descriptive matter.

10) March 30, 2005 Tomo hawk 9000. No right to the non-exclusive number

11) March 30, 2005 Mast 5000. No right to the exclusive number 5000.

24. The above list shows that the Registrar had specified in certain cases when the mark was accepted with the disclaimer of the numeral. There is a

specific warning that the registration does not grant an exclusive right to the numeral. In some cases where the mark contained a number the registrar had merely disclaimed all descriptive matter.

25. In these circumstances it will not be correct to assume that the words ""all other descriptive matter"" will include the numeral. In view of this, we do

not think it is necessary to deal with the difference between Section 17 of the old Act and Section

18 of the present Act.

26. Another factor, which is in favour of the Respondent, is the lack of any evidence to show that the numeral is descriptive of the potency of the

beer. The mere statement to that effect in the affidavit without any corroborative matter cannot be accepted as proof. As regards the Trade usage,

Section 144 clearly refers to evidence with regards to trade usage. So unless there is acceptable evidence that there is trade usage, it can not be held

that there is a trade usage and that in this trade, there is usage of numbers in connection with the goods concerned to describe the strength of the

goods.

27. Further, the applicant has not adduced any evidence that in the trade or in goods in class 32 and 33, to show that numerals are introduced to

indicate potency.

28. If it were proved that the numeral is an indicator of potency then we must accept the case of the applicant that the numeral is descriptive and the

Respondent can not claim exclusivity. In the absence of any such evidence we cannot read the words ""all other descriptive matter"" to include the

numeral. So it is clear that the Registrar did not intend to disclaim the numeral while registering the impugned trademark. We are re-inforced in our

view because the trademark journal shows that there is specific exclusion of numerals if that is intended.

29. Now let us look at the judgements.

30. In AIR 1979 Cal 280 Chandra Bhan Agarwal and Anr. v. Arjundas Agarwal and Ors. it was held ""20. ... It is thus obvious that the Registrar did

not take into consideration the import, significance or meaning of the word as a common word in use in India's national language as evident from the

dictionaries produced before us.

31. In AIR 1998 Delhi 126 S.B.L. Limited v. Himalaya Drug Company S.B.L. Ltd. v. Himalaya Drug Company, it was held ""26. Reverting back to

the facts of the case, from the documentary evidence filed we are satisfied that here are about 100 drugs in the market using the abbreviation 'Liv'

made out of the word Liver an organ of the human body, as a constituent of names of medicinal/pharmaceutical preparations with some prefix or

suffix-mostly suffixes meant for treatment of ailments or diseases associated with liver. Liv has thus become a generic term and publici juris. It is descriptive in nature and common in usage. Nobody can claim an exclusive right to the use of 'Liv' as a constituent of any trade mark. The class of customers dealing with medicines would distinguish the names of the medicines by ignoring 'LIV' and by assigning weight to the prefix or suffix so as to associate the name with the manufacturer. The possibility of deception or confusion is reduced practically to nil in view of the fact that the medicine will be sold on medical prescription and by licensed dealers well versed in the field and having knowledge of medicines. The two rival marks Liv 52 and LIV-T contain a common feature Liv which is not only descriptive but also publici juris; a customer will tend to ignore the common feature and will pay more attention to uncommon features i.e. 52 and T. The two do not have such phonetic similarity as to make it objectionable." In the present case we cannot conclude that 5000 has become a generic word. The Respondent has been successfully asserting that they alone have the right to use it in this class of goods.

3 2 . 1992 PTC 73 Golden Tobacco Company Limited Bombay v. I.T.C. Limited, Calcutta it was held

33 Whether a matter is or is not common to the trade is a question of fact. A feature which is common to one trade may not be so to a different trade.

Similarly a mark may continue to be trade mark in some countries and publici juris in others (National Starch v. Munn's Patent Maisona (1894) 11

RPC 261). A mark which was common to the trade at one time may in course of time become distinctive and vice versa. A word or words used by a

number of firms as part of their designation may be considered as words in common use (Great Tower Street v. Smith (1889) 6 RPC 165).

3 5 . To establish common use, the use by other persons should be substantial (National Bell v. Metal Goods AIR 1971 SC 898 at 908). The owner of

an otherwise undisputed old trade mark, if of a simple form, is not to be held, of necessity, to have had his trade mark made common to the trade

because subsequent traders have, for the same class of goods, used without being stopped a complicated trade mark or complicated trade marks,

containing as one of their elements a copy of the old simple mark. The question ought to be, in each case, when considering two old marks, is the one

substantially the same as the other for the purpose of a trade mark, so that the two marks, regarded as trade marks, are substantially indistinguishable

in the trade (see Base's case (1902) 19 RPC 529 at 539 (CA).

33. The question whether a mark is common to the trade being a question of fact, the onus of proof is on the part alleging this fact. The more

presence of a number of trademarks containing a common feature on the register in the name of different persons is not proof that the feature is

common to the trade. The presence of a mark on the register does not prove its user (See Corn Products v. Shangrila AIR 1960 SC 142 at 146-147;

see also Willesdon Varnish v. Young (1922) 39 RPC 285 at 289; and Beck Keller's Appln. (1947) 64 RPC 76).

40 . Initial onus lies on the opponents to prove by cogent and sufficient evidence that the words ""Glod Flake"" have become common to the trade. To

succeed in such an allegation, a case of substantial and extensive user by a large number of manufacturers or traders have to be established with total

inaction by the proprietors of ""Gold Flake"" mark against the infringers. Even some stray use by the infringers is not enough (AIR 1971 S.C. 898 at

page 908).

50 . A mark is not prevented from being a distinctive mark under Section 9(1)(e) because it includes amongst its integers an integer which in itself is

not separately registrable (Arthur Fairest's Appln. (1951) 68 RPC 197 at 2060.) Where there is at least one integer which by itself is distinctive and

which is sufficiently prominent on the mark so as to attract the attention of the customers and fix itself in their minds, the mark as a whole may be

considered distinctive. It may however be necessary to consider the what non-distinctive features, if any, should be disclaimed by the applicant for the

purpose of defining his rights under the registration. Cases may arise where none of the component part of the mark taken by itself is distinctive. In

judging whether such a combination mark is distinctive or not, it is wrong to dissect the mark, and to show that each of its component parts is not

distinctive in itself, and then conclude that the mark as a whole is not distinctive.

This is entirely in favour of the Respondent. The onus of proof that it is common to trade must be proved by the applicant. It has not been done. There

is no proof of substantial user of 5000 by a large number of manufacturers. On the contrary wherever there has been such use, the Respondent has

successfully resisted it. Further a mark cannot be held to be non-distinctive only because it includes an integer.

33. In 1999 (19) PTC 476 P.L. Lamba and Ors. v. Avtar Kishan Ghai and Ors., it was held ""6. In so far as the question of rectification proceedings is

concerned filing of the rectification proceedings itself does not debar the filing or pursuing with the suit. However, in so far as the objection relating to

trafficking in the trademark by assignment is concerned, in the light of the provisions of Sections 38, 39, and 40 of the Act, it would be appropriate that

these objections should be allowed to be raised by the Defendants after substitution of M/s Digital Securities Pvt. Ltd"".

34. In AIR 1955 SC 558 Registrar of trade marks, v. Ashok Chandra Rakhit Ltd., it was held ""10. Keeping, then, in view the meaning and scope of

Section 13 of our trade Marks Act, 1940 and its underlying purpose as discussed above we proceed to consider whether in the circumstances of the

present case the Registrar had exercised his discretion properly in inserting in the register a disclaimer of the word ""Shree"". It has not been disputed

that the Respondent company's registered trade mark No. 3815 is a distinctive device properly registrable under Section 6 of the Act. It is also a fact

that it contains, as its prominent part, the word ""Shree"" which is not separately registered as a trade mark in the name of the Respondent company,

and, -indeed, no application had been made by it for the separate registration of that word. There can, therefore, be no doubt as to the existence of the

jurisdictional fact referred to in Clause (a) of that section.

Further, the Registrar found as a fact, for reasons stated by him, that the word ""Shree"" was not adapted to distinguish, which means that it did not pass

the test for registrability laid down in Section 6 and in particular in Sub-section (3) thereof. The High Court also unequivocally took the view that

Shree"" is a word which had numerous meanings and that it would be impossible for any trader to contend that he had an exclusive right to the use of

such a word. It, therefore, follows that the Respondent company's trade mark was concurrently held to have contained matters of a non-distinctive

character and consequently the second jurisdictional fact was also present in this case.

It, nevertheless, appeared to the High Court that there was no ground whatsoever for the order made by the Registrar. The High Court read the

decision of the Registrar as proceeding only on what was described as an inflexible practice established in the Registry whereby the word "Shree was either refused registration as a trade mark or a disclaimer was enforced it was a part of a trade mark and in this view the case appeared to the High Court to be indistinguishable from the case of - "n re Cadbury Brothers' Application'. 1915-2 Ch 307 (H)." There is no such inflexible practice here. We have already seen in the paras supra that the Registrar had specifically disclaimed the numeral when it was intended to be disclaimed so the words "descriptive matter" cannot be proved to be descriptive.

35. 2010 (42) PTC 806 Del (DB) Rhizome Distilleries P. Ltd and Ors. v. Pernod Ricard S.A. France and Ors., was relied on wherein it was held

23...We are not a little surprised that no disclaimer was recorded by the Registrar for IMPERIAL, which would have resulted in both parties adding something more to this word so as to create distinction...

24. It is our analysis that no exclusive or proprietary rights can be claimed by either of the parties before us in respect of the word IMPERIAL which is not only in common parlance to be found in every dictionary, but also is laudatory in nature as it alludes to royalty or grandeur. With respect, we are not convinced that IMPERIAL refers only to royalty, empowering only such persons to take litigative umbrage. Illusions of royalty and grandeur are one of the sentiments resulting from imbibing spirits, and, therefore, IMPERIAL may justifiably be seen as descriptive.

...

26. We are of the prima facie opinion that the Plaintiffs/Respondents had adequate knowledge much prior to the filing of the suit of the resolve of the Defendants to use the trademark RHIZOME Imperial Gold firstly because the Defendants had made its intent clear before the Excise Department, Hyderabad and the Defendants had applied for registration of the trademark in 2002 and secondly because Plaintiffs' bottler had withdrawn its objection before the Excise Department, Hyderabad. The Plaintiffs idly stood by and watched the Defendants sales increase manifold. In this period the Appellants/Defendants had cornered a substantial part of the market. Delay and acquiescence has thus stepped in to defeat the Plaintiffs claim for an ad interim injunction." In this case there is no evidence to show that 5000 is a laudatory word.

36. 2010 (44) PTC 736 Del (DB) Marico Limited v. Agro Tech Foods Limited
"Courts should ordinarily lean against holding distinctiveness of a

descriptive trademark unless the user of such trademark is over such a long period of time of many many years that even a descriptive word mark is

unmistakably and only and only relatable to one and only source i.e. the same has acquired a secondary meaning". In this case there is no evidence

that 5000 is a descriptive term.

37 . PTC (Supp) (1) 13 SC Corn Products Refining Company, v. Shangrila Food Products Ltd., "17. The series of marks containing the common

element or elements therefore only assist the applicant when those marks are in extensive use in the market. The onus of proving such user is of

course on the applicant, who wants to rely on those marks. Now in the present case the applicant, the Respondent before us, led no evidence as to the

user of marks with the common element. What had happened was that Deputy Registrar looked into his register and found there a large number of

marks which had either 'Gluko' or 'Vita' as prefix or suffix in it. Now of course the presence of a mark in the register does not prove its user all. It is

possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the

marks on the register." This does not help the applicant.

3 8 . MANU/SC/0369/1970 National Bell Company and Anr. v. Metal Goods Mfg. Company (P) Ltd. and Anr. "6... The Division Bench held that

though there was some evidence of the use of the numeral '50' by certain other concerns after 1953, no importance could be attached to such

breaches as there, was hardly any evidence as to when the infringers started manufacturing and the extent of their manufacture and sales, and that

the correct principle applicable in such cases was that a few unchallenged, scattered infringements by a number of traders did not render a registered

trade mark common. As regards the earlier use of the word 'Fifty' and the numeral '50' by Lucas and other foreign concerns, the Division Bench held

that they were not the registered trade marks of those companies and that those concerns had used those marks as merely type marks. ...Lastly, it

held that the statements of sales produced by the Respondent-company demonstrated that its sales had been steadily increasing and that some

concerns, finding the use by the Respondent-company of its marks '50' and 'Fifty'

highly successful, had sought in recent years to take advantage of

am popularity of the cycle bells of Respondent-company by imitating its marks...

17. There then remains the question whether Clause (c) of Section 32 applies, i.e., that the trade marks were not at the commencement of the

proceedings distinctive of the goods of the Respondent company. The distinctiveness of the trade mark in relation to the goods of a registered

proprietor of such a trade mark may be lost in a variety of ways, e.g., by the goods not being capable of being distinguished as the goods of such a

proprietor or by extensive piracy so that the marks become publici juris...

The indication, on the contrary, is that they were distinctive. That is to be found from the zeal with which the Respondent company tried to maintain its

right in them...This evidence negatives any abandonment of trade marks or letting infringements go unchallenged or misleading the other

manufacturers that the Respondent company would not interfere if they were to use the same marks.

39. To conclude,

a) the assignment deed cannot be assailed. It has earlier been accepted by the Board in proceedings inter-parties;

b) the words 'all descriptive matter' cannot include '5000' because there is no evidence that it describes potency and also the Registrar has on many

instances separately disclaimed the descriptive words and numerals;

c) there is no evidence that there is trade usage to use numerals;

d) the Respondents' use of the mark is shown by the successful resistance to all infringement and the sales statistics.

In view of the above, the rectification application is dismissed. M.P. Nos. 118/2007, 134 & 135/2011 stand disposed of. No order as to costs.