

(2012) 11 GUJ CK 0013

In the Gujarat High Court

Case No : Special Civil Application No. 13455 of 2012

Karia District Co-Operative Milk Producers Union Ltd.

APPELLANT

Vs

General Mills Inc.

RESPONDENT

Date of Decision : 08-11-2012

Acts Referred:

Constitution of India, 1950 — Article 226

Trade and Merchandise Marks Act, 1958 — Section 46, 46(1)

Trade Marks Act, 1999 — Section 12, 2(2)(b), 46, 46(1), 46(1)(a)

Citation : (2013) 1 GLR 799

Hon'ble Judges : Bhaskar Bhattacharya, C.J.; J.B. Pardiwala, J

Bench : Division Bench

Advocate : K.S. Nanavati, for Nanavati Associates, for the Appellant; S.N. Soparkar, with Akshay A. Vakil, for the Respondent

Final Decision : Dismissed

Judgement

J.B. Pardiwala, J.—By way of this petition under Art. 226 of the Constitution of India, the writ-petitioner, one of the member-Unions of Gujarat Co-operative Milk Federation Ltd. seeks to challenge the order dated July 16, 2012 passed by the Intellectual Property Appellate Board, Circuit Bench, Ahmedabad (hereinafter referred to as "the Board"), pursuant to the respondent's rectification application dated December 14, 2007 bearing No. ORA/28/2008/TM/AMD, against the trade mark "TRIX" bearing No. 330224 registered in favour of the petitioner in Class 30 since October 28, 1977, and thereby, praying before the Registrar of Trade Marks to cancel the registration of the said trade mark. The case made out by the petitioner in this petition may be summarised as under:

1.1. The writ-petitioner is the registered proprietor of trade mark "AMUL" and its numerous variants.

1.2. The writ-petitioner is one of the member-Unions of Gujarat Cooperative Milk Marketing Federation Ltd. that under a licence from the petitioner markets milk and milk products under the trade mark AMUL and its numerous variants.

1.3. The respondent claims to be a U.S. Food giant company and claims to be registered proprietor of trade mark "TRIX" in several countries.

1.4. The writ-petitioner's trade mark "AMUL" is one of the leading brands across all sectors in India and is the leading dairy brand in Asia.

1.5. In the year 1977, the writ-petitioner with a bonafide intention to use honestly adopted the trade mark "TRIX", coined from the word "TRICKS" from the concept of appearing and disappearing tricks being shown in a magic show. The writ-petitioner vide application bearing No. 330224 dated October 28, 1977 had applied in Class 30 for registration of trade mark "TRIX" in respect of "FOOD BEVERAGES AND PREPARATIONS FOR MAKING FOOD BEVERAGES INCLUDED IN CLASS 30; CEREALS AND PREPARATIONS MADE FROM CEREALS FOR FOOD FOR HUMAN CONSUMPTIONS CHOCOLATES, NON-MEDICATED CONFECTIONERY FROZEN CONFECTIONS AND MIXTURES."

1.6. According to the writ-petitioner, the said application bearing No. 330224 was advertised in Trade Marks Journal No. 736 dated February 1, 1980 and since there was no opposition, even by the respondent herein, it was registered in due course and the Trade Marks Registry was pleased to issue a Certificate bearing No. 135332 dated July 26, 1980.

1.7. It is the case of the writ-petitioner that the respondent claiming to be the proprietor of trade mark "TRIX" from a time much earlier than the said publication date of July 26, 1980 of the said Trade Marks Journal, could have filed opposition to the said application of the writ-petitioner, but did not do so.

1.8. It is also the case of the writ-petitioner that in the year 1986, the writ-petitioner launched "Chocolate Covered Nougat Bars" under the trade mark "TRIX" together with its well-known house mark AMUL. To highlight the concept of tricks, advertisements were released through various media, based on the appearance and disappearance tricks i.e. the chocolate bars disappear/melt in the mouth quickly. The said concept and advertisement were developed focusing on the consumer group of children.

1.9. According to the writ-petitioner, the writ-petitioner had spent Rs. 6 lakh in the year 1985-1986 to promote its AMUL "TRIX" brand and had effected significant sales during the period from February, 1987 to May, 1987.

1.10. It is the case of the writ-petitioner that in the year 1995, the General Mills India Pvt. Ltd. came into existence as a subsidiary of the respondent.

1.11. It is also the case of the writ-petitioner that on March 30, 2005 the respondent filed a "proposed to be used" application in Classes 29 and 30, for registration of trade mark "TRIX" vide No. 1347981, which was duly examined by the Trade Mark Registry and the Examination Report dated July 26, 2006 issued by the Trade Mark Registry disclosed the registration of the writ-petitioner's trade mark "TRIX" under Trade Mark No. 330224 in Class 30.

1.12. According to the writ-petitioner, the respondent's application under Class 30 for registration of trade mark "TRIX" was not allowed in view of the writ-petitioner's said registration since October 28, 1977 and an order dated November 20, 2007 was passed refusing the said application No. 1347981 of the respondent.

1.13. It is the case of the writ-petitioner that the respondent, though claiming to be one of the largest food companies in the world, and proprietor of trade mark "TRIX" in several jurisdictions, did not take any action to oppose the petitioner's trade mark "TRIX" when it was first published in the Trade Marks Journal dated July 26, 1980 and also did not take any action when its application No. 137481 was examined citing the writ-petitioner's said trade mark "TRIX". The respondent, thereby, has clearly acquiesced by its aforementioned actions.

1.14. It is also the case of the writ-petitioner that the respondent in December, 2005, forayed into the Indian market by introducing through General Mills India Pvt. Ltd., a snack under the trade mark "DIP-TRIX". Before December, 2005, the respondent had not used in India the trade mark "TRIX", a trade mark with or without any other word forming part of its trade mark.

1.15. According to the writ-petitioner, for strategic commercial reasons, the writ-petitioner had temporarily discontinued use of its registered trade mark "TRIX" after May, 1987 though the writ-petitioner kept the said trade mark registered in the name by filing timely renewal applications.

1.16. It is the case of the writ-petitioner that they started activities in December, 2005 for re-launch of its products under its registered trade mark "TRIX". The products that were to be launched were wafer chocolates under the trade mark "TRIX".

1.17. It is also the case of the writ-petitioner that sales of its wafer chocolates under trade mark "TRIX" started in May, 2007 in early May. After the use of its registered trade mark "TRIX" in the years 1985-1986 and 1986-1987, the writ-petitioner started use of the said trade mark in December, 2005 as aforesaid leading to start of sales in May, 2007.

1.18. According to the writ-petitioner, making a news Article dated November 24, 2007 published in the daily newspaper "DNA", a cause of action, the respondent, before the Hon"ble High Court of Delhi, instituted a Civil Suit bearing C.S. (OS) No. 2438 of 2007 for passing off and succeeded in obtaining an ex-parte injunction order dated December 12, 2007 restraining the writ-petitioner from using its trade mark "TRIX" which on the said date stood registered in the name of the writ-petitioner past 30 years. The said Civil Suit is still pending before the Hon"ble High Court of Delhi.

1.19. It is the case of the writ-petitioner, that immediately thereafter, the respondent filed a Rectification Application dated December 14, 2007 bearing No. ORA/28/2008/TM/AMD before the Board, which came to be finally heard and

decided by the Board on July 16, 2012.

1.20. It is also the case of the writ-petitioner that the writ-petitioner filed a counter-statement together with documents in due time against the said Rectification Application.

1.21. According to the writ-petitioner, the respondent filed a rejoinder to the said counter-statement.

1.22. It is the case of the petitioner that the respondent filed Miscellaneous Petition (M.P.) No. 76 of 2011 dated November 3, 2011 to place on record bulky documents inter alia to try to establish trans-border reputation in India.

1.23. It is also the case of the petitioner that the main ground in the said Rectification Application was that the writ-petitioner had not used its registered trade mark "TRIX" for a period of five years and three months before December 14, 2007, i.e. the date of the said Rectification Application.

1.24. According to the writ-petitioner, the writ-petitioner began activities for launch of its wafer chocolates under its trade mark "TRIX" in December, 2005, leading to sales in May, 2007. After the first use of its registered trade mark "TRIX" in the year 1985-1986, its use was restarted in December, 2005 leading to sales in May, 2007. The said use in December, 2005 and May, 2007 clearly fall within the statutorily stipulated period of five years and three months before December 14, 2007, i.e. the date of the said Rectification Application. It is, therefore, the case of the writ-petitioner that on this ground alone, the Rectification Application ought to have been rejected.

1.25. It is the case of the writ-petitioner that the product "DIP-TRIX" of the respondent was short-lived as the respondent decided to withdraw the said DIP-TRIX product from the market and the said fact appeared in a news report dated November 27, 2009 by Business Line, a business daily from Hindu Group of publications. With the said withdrawal, the respondent had no product available in India under the trade mark "TRIX" with or without any other word forming part of its trade mark. For the said reason, the respondent could not be treated as an aggrieved person on July 16, 2012, the date on which the Board finally decided the Rectification Application bearing No. ORA/28/2008/TM/AMD.

1.26. It is also the case of the writ-petitioner that the respondent had clearly acquiesced and could not be said to be an aggrieved person on the date of the final decision of the Rectification Application and the statutory requirement of non-use period of five years and three months though not complied with, the Board cancelled the 30 years old registration of trade mark "TRIX" of the petitioner.

Stance of the Respondent:

2. It is the case of the respondent that the trade mark "TRIX" was adopted and is in use since 1910 in different parts of the world including U.S.A. and Canada,

registered in various countries of the world. The trade mark is advertised on a large-scale in different international magazines, newspapers and electronic medium including in LIFE magazine of 1956 and Archie comics. These are all circulated and available in India. Hence, the respondent's trade mark "TRIX" had trans-border reputation in India since 1950's itself. The trade mark "TRIX" was directly launched in India in December, 2005. The respondent had more than 1,90,000 retail units selling its products in 2008 with annual sale of more than 7.50 crore. The trade mark "TRIX" was distinctive of the respondent's products.

2.1. According to the respondent, the writ-petitioner's adoption of the mark in 1977 is dishonest. It claims to have adopted the trade mark "TRIX" from TRICKS as its chocolate disappears on putting in the mouth. The writ-petitioner, as per its own admission, had used the trade mark for the first time in the year 1986 for a brief period of 10 months only. Therefore, it could not have coined the trade mark in the year 1977 based on the effect of a product which came into existence in the year 1986 i.e. 10 years later. The explanation for adoption, is therefore, far-fetched.

2.2. It is also the case of the respondent that the writ-petitioner has not made commercial use of the trade mark "TRIX" during the relevant period, and therefore, the Appellate Board rightly cancelled under Sec. 47 of the Trade Marks Act, 1999 (hereinafter referred to as "the Act"). Even during 1986, it claims to have used "AMUL TRIX" only for ten months and not the trade mark "TRIX" per se.

2.3. It is the case of the respondent that non-use of the trade mark by the writ-petitioner leads to abandonment. The writ-petitioner admittedly has not used the trade mark commercially any time other than 10 months during the year 1986. It has not given any reason for its non-use for a period of 20 years, until its proposed launch in December, 2007. The writ-petitioner had, thus, abandoned the trade mark and it was open for any person to use it during this period.

2.4. According to the respondent, the writ-petitioner's registration is an entry made in the register without sufficient cause and as the respondent's trade mark is first in the world market, having trans-border reputation in India since the year 1950, the writ-petitioner's registration/use is likely to result in passing off. The registration was, thus, wrongly granted and entered under Sec. 57(2) of the Act.

2.5. It is the case of the respondent that on account of the blameworthy conduct of the writ-petitioner, the trade mark "TRIX" was an entry wrongly remaining on the register under Sec. 57(2) of the Act. On account of large-scale sale and advertisement by the respondent under "TRIX" globally since the year 1910 and since the year 2005 in India, the trade mark has become distinctive of the respondent's goods and associated by the consumers with the respondent. The writ-petitioner has not taken any steps to stop the respondent from use of the trade mark "TRIX" since the year 2005 in India. The writ-petitioner has not

denied that it was very much aware of the respondent's use of the trade mark "TRIX" in India. Use of the mark now by the writ-petitioner will result in deception and confusion.

2.6. It is also the case of the respondent that it had not acquiesced in the registration of writ-petitioner. The respondent's application was filed in India in March 30, 2005 under No. 1347981. The examination report was issued on July 26, 2006 when it became aware of writ-petitioner's registration for the first time. However, there were no goods of sale under the trade mark "TRIX". Hence, there is no acquiescence.

2.7. According to the respondent, the respondent has not abandoned the trade mark "TRIX" and continues to be a person aggrieved for the following reasons:

(i) The respondent is selling products under the trade mark "TRIX" globally even today. Such use is not denied by the writ-petitioner.

(ii) The report dated November 26, 2009 states that the respondent had to suspend sales due to "Distribution woes-Distribution was a challenge for the brand and they needed a far broader distribution for an impulse....."

(iii) It is a temporary suspension and not termination of the product. The respondent had to withdraw for marketing reasons and will launch again.

(iv) Even assuming that the respondent was not using its trade mark in India on account of its trans-border reputation, it could have maintained the present action.

Submissions on behalf of the Writ-petitioner:

3. Mr. K.S. Nanavati, the learned Senior Counsel appearing for the writ-petitioner, vehemently submitted that the Rectification Application dated December 14, 2007 could not have been allowed as indisputably there was use of its registered trade mark "TRIX" in December, 2005 by the writ-petitioner leading to sale in May, 2007 i.e. during the statutorily required period of non-use for a period of five years and three months before the date of Rectification Application as provided for in Sec. 47(1) of the Act, 1999. Mr. Nanavati submitted, that the Board despite taking on record and recognising invoices of the year 2007 of the writ-petitioner for the sale of wafer chocolates under its registered trade mark "TRIX", clearly erred in allowing the said Rectification Application violating Sec. 47(1) of the Act.

3.1. Mr. Nanavati also submitted that the respondent had clearly acquiesced by not taking action until December, 2007 despite prior knowledge of the writ-petitioner's registration. According to Mr. Nanavati, the Board erred in not taking into account the acquiescence on the part of the respondent, and thereby, erred in allowing the said Rectification Application. Mr. Nanavati also submitted that the respondent could never be said to be an aggrieved person to begin with and in view of the pull back of its product "DIP-TRIX" years before the Rectification

Application was finally heard and decided in the year 2012, the respondent was certainly not an aggrieved person on the date of the final decision of the said Rectification Application. Mr. Nanavati placed reliance on the decision of the Supreme Court in the case of Hardie Trading Ltd. and Another Vs. Addisons Paint and Chemicals Ltd., . Mr. Nanavati placed reliance on the observations passed in Paragraphs 36, 37, 38, 39 and 40 of the cited decision. It will be profitable to reproduce the said paragraphs as under:

36. The last submission does not appear to be correct. The Division Bench had addressed itself to the question and as far as the intent to use the existing trade mark was concerned it was said that there was -

.....an onerous duty cast onto the registered proprietor not only to show that there is no intentional abandonment or intent to use the trade mark, in relation to the goods, but there must exist a definite intent to use the mark and a continuation of the same throughout the entire period as envisaged in the Statute but all his efforts were rendered fruitless by reason of the statutory ban on imports. The affidavit of Buttress, however, negates such a situation and as such the issue under Sec. 46(3) being answered in favour of the appellant does not and cannot arise.

37. In any event the contention has been expressly raised in the SLP and argued extensively by Counsel for the appellants. Submissions have been equally extensively made both in the counter-affidavit and by Addison's Counsel in the course of arguments before us. In the circumstance, we do not think that it would at all be proper not to decide the issue.

38. The Joint Registrar construed the word "use" in Sec. 46(1)(b) to mean use of the trade mark on the goods in respect of which the trade mark is registered. He relied upon letter written by Hansa's lawyers to Addisons dated 25th December, 1977 in which it was stated that Hansa had not manufactured or sold any goods under the trade marks, to hold - first, that neither Hansa nor Hardie had sold any goods during the relevant period, and second, that therefore, there was no use of the registered trade marks. Both the Single Judge and the Division Bench appear to have proceeded on the same basis.

39. The question, therefore is - Is the word "use" in Sec. 46(1) so limited? The phrase used in Sec. 46 is "bona fide use thereof in relation to those goods". The phrase has been defined in Sec. 2(2)(b) of the Act as:

to the use of a mark in relation to goods shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation - whatsoever, to such goods.

40. This shows that the use may be other than physical. It may be in any other relation to the goods. Given this statutory meaning, we see no reason to limit the user to use on the goods or to sale of goods bearing the trade mark.

Mr. Nanavati, therefore, urged to admit the writ-application and grant the interim

relief as prayed for in the writ-application.

Submissions on behalf of the Respondent:

4. On the other hand, Mr. S.N. Soparkar, the learned Senior Counsel appearing with Mr. A.A. Vakil for the respondent, on Caveat opposed the admission of the petition submitting that the Board committed no error in passing the impugned order and no interference is warranted in the present writ-application. Mr. Soparkar submitted that the petitioner had not used the trade mark commercially at any point of time other than 10 months during the year 1986. There is no explanation worth the name assigning any sufficient cause for its non-use for a period of 20 years until it proposed to launch "AMUL TRDC" in December, 2007. The petitioner had, thus, abandoned the trade mark and it was open for any person to use it during that period. Mr. Soparkar submitted that the intention to use the trade mark sought to be registered must be genuine and real. The concerned person, therefore, who does not have any bonafide intention to use the trade mark is not expected to get his product registered so as to prevent any other person from using the same. Mr. Soparkar invited our attention at page 224 of the paper-book and pointed out that for the first time on November 24, 2007, it was declared by the writ-petitioner that they propose to unveil the trade mark "TRIX" by December. Mr. Soparkar also invited our attention to pages 434 and 435 of the paper-book which are retail invoices suggesting that the sale shown in the retail invoice dated May 7, 2007 was of Rs. 1,642/- and in the same manner, in the retail invoice dated May 8, 2007, the sale is shown to be of Rs. 1,642/-. According to Mr. Soparkar, this by itself is suggestive of the fact that the writ-petitioner has no bona fide intention to use the trade mark. Mr. Soparkar, therefore, urged that there being no merit in this writ-application, the same be dismissed.

5. Having heard the learned Counsel for the respective parties and having gone through the materials on record, the only question that falls for our consideration in this writ-application is as to whether the Board was justified in allowing the Rectification Application preferred by the respondent, and thereby, directing the Registrar of Trade Marks to cancel the trade mark of the writ-petitioner registered vide No. 330224 in Class 30.

6. Before advertng to the rival submissions of the parties, it will be profitable to look into the provisions of Sec. 47 of the Act, which is as under:

Section 47: Removal from register and imposition of limitations on ground of non-use:- (1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the Appellate Board by any person aggrieved on the ground either -

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of Sec. 46 apply,

by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time-being up to a date three months before the date of the application; or

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time-being:

Provided that except where the applicant has been permitted under Sec. 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the Tribunal of trade mark, the Tribunal may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, of opinion that he might properly be permitted so to register such a bona fide use of the trade mark by any proprietor thereof for the time-being in relation to -

(i) goods or services of the same description; or

(ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.

(2) Where in relation to any goods or services in respect of which a trade mark is registered -

(a) the circumstances referred to in clause (b) of sub-sec. (1) are shown to exist so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in a particular place in India (otherwise than for export from India), or in relation to goods to be exported to a particular market outside India; or in relation to services for use or available for acceptance in a particular place in India or for use in a particular market outside India; and

(b) a person has been permitted under Sec. 12 to register an identical or nearly resembling trade mark in respect of those goods, under a registration extending to use in relation to goods to be so sold, or otherwise traded in, or in relation to good to be so exported, or in relation to services for use or available for acceptance in that place or for use in that country, or the Tribunal is of opinion that he might properly be permitted so to register such a trade mark,--

on application by that person in the prescribed manner to the Appellate Board or to the Registrar, the Tribunal may impose on the registration of the first-mentioned trade mark such limitations as it thinks proper for securing that registration shall cease to extend to such use.

(3) An applicant shall not be entitled to rely for the purpose of clause (b) of sub-

sec. (1) or for the purposes of sub-sec. (2) on any non-use of a trade mark which is shown to have been due to special circumstances in the trade, which includes restrictions on the use of the trade mark in India imposed by any law or regulation and not to any intention to abandon or not to use the trade mark in relation to the goods or services to which the application relates.

7. At this stage, it will also be profitable to look into the decision of the Supreme Court in the case of *Kabushiki Kaisha Toshiba Vs. TOSIBA Appliances Co. and Others*, . In the said decision, the Supreme Court interpreted clauses (a) and (b) of sub-sec. (1) of Sec. 46 of the Trade and Merchandise Marks Act, 1958, which is para materia to Sec. 47 of the Act, 1999. It will be profitable to quote the relevant observations of the Supreme Court, which are as under:

31. In the aforementioned backdrop of the statutory provisions, we are called upon to interpret clauses (a) and (b) of sub-sec. (1) of Sec. 46 of the Act. It is beyond any doubt or dispute that sub-sec. (1) of Sec. 46 confers a discretionary jurisdiction on the Registrar. The jurisdiction may be exercised if any application is filed by a person aggrieved. The said application has to be filed in the manner prescribed therefor. Whence it is found that the application is filed by a person aggrieved in the prescribed manner, the grounds which would be available to the Registrar for exercise of its discretionary jurisdiction are stated in clauses (a) and (b) of sub-sec. (1) of Sec. 46. We may, at the outset, notice that clauses (a) and (b) are disjunctive and not cumulative. Recourse may be taken to either of them or both of them. A combined application even under Secs. 46 and 56 of the Act is permissible in law.

32. Whereas clause (a) refers to bona fide use of the trade mark; clause (b) stipulates the period upto a date of one month before the date of application, a continuous period of five years or longer elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time-being. Sub-section (3) postulates an exclusion clause as regards application of clause (b) of sub-sec. (1) of Sec. 46 if any non-use of a trade mark which is shown to have been due to special circumstances in the trade or not to any intention to abandon or not to use the trade mark in relation to the goods to which the application relates.

33. No doubt, a Statute is required to be read as a whole, Chapter by chapter, section by section and clause by clause. However, the purpose for which clauses (a) and (b) of sub-sec. (1) of Sec. 46 on the one hand and sub-sec. (3) thereof, vis-a-vis Sec. 56 of the Act on the other have been enacted require consideration. They appeared to have been enacted for different purposes.

Analysis:

34. We may now consider the three-fold submission of Mr. Nariman that:

- (i) the Registrar has not exercised its jurisdiction under Sec. 56 of the Act;
- (ii) the learned Single Judge while exercising its appellate jurisdiction has found

that no case has been made out for invoking clause (b) of sub-sec. (1) of Sec. 46; and

(iii) the trade mark consists of an invented word and is very well-known in the international market. The basis of the said submission, thus, appear to be two-fold:

(1) As there is no evidence that the appellant had any intention to abandon the use of the said trade mark, as a logical corollary thereof, the High Court ought to have held that the appellant had the intention of bona fide use of the trade mark not only at a point of time when an application for registration was filed but also continuously thereafter;

(2) The provisions of clauses (a) and (b), if read in the aforementioned context, sub-sec. (3) of Sec. 46 would also come into play particularly when the words "non-use" therein and clause (a) of sub-sec. (1) are identical, namely "not to have any intention to abandon or not to use the trade mark in relation to the goods to which the application relates" and save and except in clause (a), the word "bonafide" has been added.

35. We do not find any force in the aforementioned submission. Clauses (a) and (b) operate in different fields. Sub-section (3) covers a case falling within clause (b) and not the clause (a) thereof. Had the intention of the Parliament been that sub-sec. (3) covers cases falling both under clause (b) and clause (a), having regard to the similarity of the expressions used, there was no reason as to why it could not be stated so explicitly.

36. If the submission of Mr. Nariman is to be accepted, the result thereof would be that for all intent and purport, no distinction would exist in the situations covered by clause (b) and clause (a) except that whereas in the former no period is mentioned, in the latter a specific period is provided.

37. There may be a case where owing to certain special circumstances, a continuous use is not possible. The trade mark for which registration is obtained is used intermittently. Such non-user for a temporary period may be due to any exigency including a bar under a statute, or a policy decision of the Government or any action taken against the registrant.

38. Moreover, in cases of intermittent use, clause (b) shall not apply. [See *Namdeo Sakham Meshram Vs. Motilal Udaichand Jain*, ; *Express Bottlers Services Private Ltd. Vs. Pepsico Inc. and Others*, ; *Bali Trade Mark (Rectification Ch.D.)*, 1966 (16) RPC 387; *Bali Trade Mark (Rectification C.A.)*, 1968 (14) RPC 426; and *"BULOVA" Trade Mark (Rectification Ch.D.)*, 1967 (9) RPC 229].

39. Clause (a) of sub-sec. (1) of Sec. 46 takes within its sweep a situation where registration has been obtained without any bona fide intention on the part of the registrant that it should be used in relation to those goods by him and that there has, in fact, been no bonafide use. Clause (a), therefore, provides for more than one contingency. Both the pre-conditions laid down therein are required to be

fulfilled and not the contingency which is contemplated by clause (1). Furthermore, it is not a case where the appellant had taken recourse to Sec. 47 of the Act.

40. In American Home Products Corporation Vs. Mac Laboratories Pvt. Ltd. and Another, , this Court categorically noticed the aforementioned distinction, stating;

32. Clause (b) of Sec. 46(1) applies where for a continuous period of five years or longer from the date of the registration of the trade mark, there has been no bona fide use thereof in relation to those goods in respect of which it is registered by any proprietor thereof for the time-being. An exception to Clause (b) is created by Sec. 46(3). Under Sec. 46(3), the non-use of a trade mark, which is shown to have been due to special circumstances in the trade and not to any intention to abandon or not to use the trade mark in relation to the goods to which the application under Sec. 46(1) relates, will not amount to non-use for the purpose of Clause (b).

33. The distinction between Clause (a) and Clause (b) is that if the period specified in Clause (b) has elapsed and during that period there has been no bonafide use of the trade mark, the fact that the registered proprietor had a bona fide intention to use the trade mark, at the date of the application for registration becomes immaterial and the trade mark is liable to be removed from the Register unless his case falls under Sec. 46(3), while under Clause (a) where there had been a bonafide intention to use the trade mark in respect of which registration was sought, merely because the trade mark had not been used for a period shorter than five years from the date of its registration will not entitle any person to have that trade mark taken off the Register.

41. The intention to use a trade mark sought to be registered must be genuine and real. When a trade mark is registered, it confers a valuable right. It seeks to prevent trafficking in trade marks. It seeks to distinguish the goods made by one person from those made by another. The person, therefore, who does not have any bonafide intention to use the trade mark, is not expected to get his product registered so as to prevent any other person from using the same. In that way trafficking in trade mark is sought to be restricted.

Person Aggrieved:

42. The concept of the term "person aggrieved" is different in the context of Secs. 46 and 56, Section 46 speaks of a private interest while Sec. 56 speaks of a public interest. Respondent filed a composite application. Registrar did not think it fit to consider the case from the point of view of public interest and confined the case to Sec. 56 of the Act, as would appear from the fact that while sustaining the respondent's objection under Secs. 46(1) and (b) on the ground that the same had not been used by the appellant for the last twenty years, it was observed:

Having held that Sec. 46(1)(a) is a bar to the continuation of the impugned mark

on the Register as above, I hold that the entry in respect of those goods for which the Registered Proprietors could not prove their user of the Registered Trade Mark 273758 was wrongly made in the Register and is wrongly remaining on the Register under Sec. 56(2) of the Act.

43. Reference to Sec. 56(2) of the Act at that place appears to be a typographical mistake. It is palpably wrong. No deliberation was made on the said question. No fact or contention has been taken note of. There are no discussions; no findings.

44. The learned Single Judge found that the respondent No. 1 had never manufactured or sold washing machine and spin dryers at all. They did not have even any plan for commencing the manufacture or sale thereof. It, in that backdrop, was observed:

If that statement was made before the Deputy Registrar, then that was a mis-statement.

45. Respondent, however, was found to be a person aggrieved upon taking into consideration a large number of decisions. It was held:

The respondent is anything but a common informer or an officious person. It deals in articles of Class 11 and it uses the mark TOSHIBA. If it were to go into the trade of washing machines or spin dryers, and if the mark TOSHIBA were to remain on the Register, with the appellant as its proprietor, the respondent could not in that event, use its mark for washing machines and spin dryer too. This is enough, I think, to come to the conclusion without any hesitation that the respondent had a sufficient and impeachable locus standi to maintain the rectification application in the Registry.

46. The learned Single Judge as also the Division Bench referred to a large number of decisions to hold that the respondent was the person aggrieved within the meaning of Secs. 46 and 56 of the Act. It is beyond any doubt that the question has authentically been answered by a Division Bench of this Court in *Hardie Trading Ltd. and Another Vs. Addisons Paint and Chemicals Ltd.*, , holding:

30. The phrase "person aggrieved" is a common enough statutory precondition for a valid complaint or appeal. The phrase has been variously construed depending on the context in which it occurs. Three Sections viz., Secs. 46, 56 and 69 of the Act contain the phrase. Section 46 deals with the removal of a registered trade mark from the Register on the ground of non-use. This Section presupposes that the registration which was validly made is liable to be taken off by subsequent non-user. Section 56 on the other hand deals with situations where the initial registration should not have been or was incorrectly made. The situations covered by this Section include:- (a) the contravention or failure to observe a condition for registration; (b) the absence of an entry; (c) an entry made without sufficient cause; (d) a wrong entry; and (e) any error or defect in the entry. Such type of actions are commenced for the "purity of the Register"

which it is in public interest to maintain. Applications under Secs. 46 and 56 may be made to the Registrar who is competent to grant the relief. "Person aggrieved" may also apply for cancellation or varying an entry in the Register relating to a certification trade mark to the Central Government in certain circumstances. Since, we are not concerned with a certification trade mark, the process for registration of which is entirely different, we may exclude the interpretation of the phrase "person aggrieved" occurring in Sec. 69 from consideration for the purposes of this judgment.

31. In our opinion, the phrase "person aggrieved" for the purposes of removal on the ground of non-use under Sec. 46 has a different connotation from the phrase used in Sec. 56 for cancelling or expunging or varying an entry wrongly made or remaining in the Register.

32. In the latter case, the locus standi would be ascertained liberally, since it would not only be against the interest of other persons carrying on the same trade but also in the interest of the public to have such wrongful entry removed.

8. The principles discernible from the aforesaid decision of the Supreme Court may be summarised thus:

(i) Clauses (a) and (b) of sub-sec. (1) of Sec. 47 of the Act, 1999, operate in different fields.

(ii) In a given case, due to certain special circumstances, a continuous use of the trade mark may not be possible and the trade mark for which the registration is obtained may be used intermittently.

(iii) Such non-user for a temporary period could be due to any exigency which may include a statutory bar or a policy decision of the Government or any other legal action taken against the registrant.

(iv) In the cases of intermittent use of the trade mark, Clause (b) of sub-sec. (1) of Sec. 47 of the Act shall not apply.

(v) Clause (a) of sub-sec. (1) of Sec. 47 of the Act takes within its sweep a situation where registration is obtained without any bona fide intention on the part of the registrant that it should be used in relation to those goods by him and that there has, in fact, been no bona fide use. Clause (a), therefore, provides for more than one contingency. Both the pre-conditions laid down therein are required to be fulfilled and not the contingency which is contemplated by clause (1).

(vi) The distinction between Clause (a) and Clause (b) is that if the period specified in Clause (b) has elapsed and during that period there has been no bona fide use of the trade mark, the fact that registered proprietor had a bona fide intention to use the trade mark, at the date of the application for registration becomes immaterial and the trade mark is liable to be removed from the Register unless his case falls under Sec. 46(3), while under Clause (a) where

there had been a bona fide intention to use the trade mark in respect of which registration was sought, merely because the trade mark had not been used for a period shorter than five years from the date of its registration, will not entitle any person to have that trade mark taken off from the Register.

9. The picture that emerges from the record of the case, is that the application for registration of the trade mark "TRIX" was filed by the writ-petitioner on March 28, 1977. On the other hand, the respondent adopted the trade mark "TRIX" as early as on July 29, 1910 through its predecessor and in 1953 by the respondents. The writ-petitioner failed to use the trade mark on their goods even though they had applied for and obtained the registration way back in the year 1977. It also appears that in December, 2007 when the writ-petitioner advertised for the first time about their launching of the product, a civil suit against the use of the trade mark, was filed by the respondent in the High Court of Delhi and the High Court granted injunction against the petitioner as prayed for by the respondent and since then the trade mark has not been put to use. We are not impressed by the submission of Mr. Nanavati that due to injunction operating against them, they were unable to use the trade mark. The injunction was granted against the writ-petitioner on December 12, 2007. The writ-petitioner, indisputably, had not used the trade mark commercially at any point of time other than 10 months in the year 1986 and so far as the period of five years is concerned as contemplated under Sec. 47 of the Act from September 15, 2002 to September 14, 2007. As held by the Supreme Court in *Kabushiki Kaisha Toshiba Vs. TOSIBA Appliances Co. and Others*, , the intention to use a trade mark sought to be registered must be genuine and real. When a trade mark is registered, it confers a valuable right. It seeks to distinguish the goods made by one person to those made by any other. A person, therefore, who does not have any bona fide intention to use the trade mark is not expected to get his product registered so as to prevent any other person from using the same. In our opinion, taking into consideration, the materials on record, more particularly pages 434 and 435 of the paper-book, the invoices-cum-chalan showing sale of the product to the tune of Rs. 1,642/-, it could easily be said that both the conditions as provided in clauses (1)(a) and (1)(b) of Sec. 47 of the Act are fulfilled.

10. The decision of the Supreme Court in the case of *Hardie Trading Ltd. and Another Vs. Addisons Paint and Chemicals Ltd.*, relied upon by the learned Senior Counsel appearing for the writ-petitioner would not be of any help to the writ-petitioner since the only principle that could be culled out from the judgment is that the use of the trade mark could be other than physical. In our view, the subsequent decision of the Supreme Court in the case of *Kabushiki Kaisha Toshiba Vs. TOSIBA Appliances Co. and Others*, would apply with all force in the present case.

11. We are of the view that no error, much less an error of law, could be said to have been committed by the Board in passing the impugned order. For the

foregoing reasons, we do not find any merits in this petition and the same is, accordingly, dismissed.