

(2013) 06 IPAB CK 0004

In the Intellectual Property Appellate Board

Case No : ORA/51 And 52/2005/TM/KOL And M.P. No. 392/2012 In
ORA/51/2005/TM/KOL

M/s. Gillette India Limited

APPELLANT

Vs

M/s. Harbans Lal Malhotra & Sons Pvt. Ltd. And The Registrar

RESPONDENT

Date of Decision : 21-06-2013

Acts Referred:

Trade Marks Act, 1999 — Section 9, 9(1), 9(1)(a), 9(1)(b), 9(5), 9(5)(a), 11, 47(1)(a), 47(1)(b), 57
Evidence Act, 1872 — Section 3
Code Of Civil Procedure, 1908 — Order 13 Rule 2, Order 41 Rule 27, Order 39 Rule 1, Order 39 Rule 2

Citation : (2013) 3 MIPR 103

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

Bench : Division Bench

Advocate : Hemant Singh, Debnath Ghosh

Judgement

.....

V. Ravi, Technical Member",.....

COMMON ORDER No. 131/2013,.....

1. The applicant herein which is an Indian subsidiary of a US Company are seeking the removal of the following two trade marks CHAMPION from,.....

the Register:.....

a) trade mark registration No. 223840 in Class 8 for ""razor blades for export""." ,.....

b) trade mark registration No. 244109 also in Class 8 be removed and cancelled or in the alternative the description ""safety razors"" be deleted from the" ,.....

description goods that the trade mark is registered for;.....

The substantial grounds for removal of the above two trade marks are more or less same and therefore both the matters are disposed of by this,,,,,

common order.,,,,,,

2. The respondent had applied for registration for the trade mark CHAMPION under no. 223840 in class 8 for ""razor blades for export"" as of 18th,,,,,

August, 1964. This mark is liable to be removed under Section 47(1)(b) as no such razor blades have been exported for a continuous period of five",,,,,

years from the date on which the trade mark CHAMPION was actually entered into register upto 3 months before the date of filing of this petition on,,,,,

1st August, 2005. Similarly, the other application under no. 244109 in respect of ""safety razor blades and safety razors"" is liable to be removed under",,,,,

Section 47(1)(a) as there has been allegedly no bonafide use thereof upto a date of three months before the date of filing of the present petition on 8th,,,,,

August, 2005. Further, registered trade mark 244109 is also liable to be removed from the register under Section 47(1)(b) since upto a date of three",,,,,

months before the filing of this petition a continuous period of five years from the date on which the trade mark CHAMPION was actually entered in,,,,,

the register and longer has lapsed during which there has been no bonafide use thereof in relation to safety razors by the respondent registered,,,,,

proprietor.,,,,,,

3. It is alleged that CHAMPION is a laudatory epithet exclusively consisting of a mark which may serve in the trade to designate the kind, quality and",,,,,

value of the goods produced. The OXFORD English dictionary defines it "" as a person or thing that has defeated and surpassed all rivals"". WEBSTER",,,,,

dictionary state it means ""anything that takes first place in competition and who defeated in a competition or a series of competition so as to hold his",,,,,

place"". Therefore, the impugned mark is an appropriate word that signifies the quality and value in relation to which is used. It aptly conveys the",,,,,

message that a manufacturer wants to put across and cannot be allowed to be monopolized by a single manufacturer. As such the impugned marks is,,,,,

incapable of acquiring any distinctiveness and hence it ought not to have been registered in the first place. The registration is in violation and in,,,,,

contravention of Section 9(1)(a) & (b) of the Act and is therefore, liable to be revoked. The impugned mark is commonly used by the members of the",,,,,

trade in relation to their goods. The mark is also hit by Section 9 as it consists

exclusively of a mark that has become customary in the current,,,,,

language and or bonafide and established trade practice to be used as ""brand imagery"" to puff or allow the quality of the product marketed.",,,,,

4. The impugned registration is invalid as it is in contravention of Section 9(1)(a) (b) and (c) as also Section 47(1)(a) & 47(1)(b) of the Act.,,,,,

Accordingly, the entries made in the register in respect of the above two impugned marks are without sufficient cause and liable to be expunged.",,,,,

5. In the detailed Statement of Case accompanying the petition seeking the removal of the above two impugned marks, the applicant have expanded",,,,,

on the grounds for removal exhaustively. In brief, the applicant state that that the trade mark GILLETTE is a household international brand and some",,,,,

of its products carries it supplementary brand like MACH 3 and MACH 3 TURBO in relation to safety razors that enjoys formidable goodwill and,,,,,

reputation being technically the most advanced safety razor available in the market. CHAMPION was adopted by the GILLETTE Co., USA which is",,,,,

the licensor and parent company of the applicant in September, 2003. It is used as a laudatory term for brand imagery and used extensively as such in",,,,,

TV commercials worldwide. The TV advertisements use latest model of fast Sports Car to highlight the unsurpassed engineering, unparalleled",,,,,

technology and appealing look which are the hallmark of the CHAMPION. The advertisement ends by inviting consumers to ""Test Drive the",,,,,

Champion"". So, the name CHAMPION captures the essence of the high performance car. Thus, the mark CHAMPION used upon packaging of the",,,,,

applicant is merely to indicate a co-relation between the product and the TV commercials for brand imagery. The said product and TV Commercial,,,,,

was launched in India in May, 2005 promoting the trade mark GILLETTE MAC 3 Turbo. In short, the word CHAMPION is public juris.",,,,,

6. The applicant has been served with a Legal Notice on 14.06.2005 by the respondent for the alleged infringement of its registered trade mark,,,,,

CHAMPION. The applicants are therefore 'persons aggrieved' by the continuation of both the impugned marks in the register. The applicant,,,,,

therefore, pray for the removal of both the impugned marks.",,,,,

7. The case of the respondent/registered proprietor is as follows:,,,,,

a. The respondent is the first user and adopter of the mark CHAMPION in relation to goods falling Class 8. It was registered way back in 1964 and,,,,,

has been continuously and extensively used since then. The mark has been duly renewed from time to time and is valid upto date. The respondent are,,,,,

well known manufacturers of razor, safety razor blade etc. in India since long. In fact, according to A C Nielsen Retail Audit Data in 2005 in respect",,,,,

of safety razors and razor blades, the respondents are the market leaders with a volume share of 46% and valued at 38.7% compared to Gillette's",,,,,

market volume of 9.7% and a market share of 18%. The present rectification proceeding is a counter blast to the registered proprietors refusal to the,,,,,

unreasonable and malafide offer of the applicant to take over the business of the respondent. The applicant initially sought to enter the Indian market,,,,,

by way of a proposed foreign collaboration which ultimately did not materialize. Therefore, GILLETTE USA, floated its own Indian subsidiary to",,,,,

capture the Indian market. In fact, by a letter dated 18.08.1993, the GILLETTE USA addressed a letter to the Chairman, FIPB acknowledging that",,,,,

the respondent are the market leader in India in the manufacture of razor blades.,,,,,

b. The respondent have traced from old records, export invoices relating to goods exported to various foreign countries under the trade mark",,,,,

CHAMPION from 1965 upto 5th April, 2012. Significantly, payments in relation thereto have been received by the registered proprietors through",,,,,

bank. Due to the continuous use of the impugned mark CHAMPION since 1964 it has acquired secondary significance and distinguishes of the goods,,,,,

of the respondent. Further, due to lack of interest of the respondent's earlier counsel engaged by them namely M/s. Daswani & Daswani they were",,,,,

forced to engage M/s. Khaitan & Company, Kolkata at the last minute who on the advice of the Senior Counsel who argued their case have filed a",,,,,

miscellaneous petition to take on record the additional documents/evidences for effective and proper adjudication of the dispute which could not be,,,,,

tendered on time due to the mishandling of the case by the previous counsel on record. The respondents state that there was no willful delay or laches,,,,,

on their part and the miscellaneous petition to take additional evidence on record should be allowed in the interest of justice.,,,,,

8. The matter came up before us on 6th December, 2012 which was adjourned to 7th on the following day when both counsel were present. We have",,,,,

heard the detailed arguments of Shri Hemant Singh, learned counsel for the applicant. The respondent's counsel sought time to file written submission",,,,,

which was permitted by the Board. It was required to be filed on or before 18th, December, 2012 serving a copy to the other side. The written",,,,,

submissions of the respondent was received by the Registry on 17th December, 2012 and the comments thereon of the applicant on 8th January, 2013.",,,,,

We have perused all the documents and material on record.,,,,,

9. In the written submission the respondents state that the principal grievance of the applicant is that the mark CHAMPION registered in its favour is,,,,,

an English word and has laudatory significance and no monopoly or exclusivity can be claimed by anyone and so the mark is incapable being,,,,,

registered under Section 9 of the Act and therefore both the impugned marks are liable to be removed from the register. The two impugned marks,,,,,

have been registered in favour of the respondents as of 18th August, 1964 and 7th September 1967 in relation to razor blades and safety razor",,,,,

respectively. The present rectification proceeding has been initiated by the applicant in 2005 after 40 years. In such circumstances, the respondents",,,,,

are protected by the provisions of the Section 32 of the Act reproduced below:,,,,,

32. Protection of registration on ground of distinctiveness in certain cases. - Where a trade mark is registered in breach of sub-Section (1) of section,,,,,

9, it shall not be declared invalid if, in consequence of the use which has been made of its, it has after registration and before commencement of any",,,,,

legal proceedings challenging the validity of such registration, acquired a distinctive character in relation to the goods or services for which it is",,,,,

registered.,,,,,

10. The respondents state that a trade mark Search Report indicates that they were the first to register CHAMPION as a trade mark in respect of,,,,,

razors and razor blades since 1964. Other entities have also registered CHAMPION in relation to diverse goods for distinguishing their products and,,,,,

various registration are still valid and subsisting.,,,,,

11. In their written submission the respondents have relied on a number of case laws in support of the registration which are briefly indicated below:,,,,,

i) Apple Computer Incorporation MANU/DE/0919/1991 : 1992 ALR (1) 93 - Held use of apple as a trade mark is a distinctive identity in respect of,,,,,

computers and the mark Apple was protected and an injunction was passed restraining the defendants Apple Leasing and Industries from using the,,,,,

word Apple.,,,,,

ii) Trade mark SUPER CUP-[1997 (2) ALR (2) 559] - Courts have protected SUPER CUP"" and passed orders restraining the use of SUPER CUP" ,,,,,

tea in relation to tea. An injunction was passed despite the word ""SUPER CUP"" being was a laudatory epithet and not capable of distinguishing the" ,,,,,

goods of the plaintiff in the said suit and no monopoly or exclusivity can be claimed over the said mark.,,,,,

iii) MANU/DE/1198/2003 : 2004 (28) PTC 300 The word 'SOLO' meaning singular was also protected by the Hon'ble Delhi High Court and an ,,,,,

injunction had been passed restraining the defendant from using the said mark. Such injunction has been granted by the Hon'ble Delhi High Court ,,,,,

despite allegation by the defendant in the said suit that the word ""SOLO"" is not an invented word but a common dictionary word and the plaintiff" ,,,,,

cannot claim proprietary right or exclusive right to the use of the word Solo. The Hon'ble Court rejected the contention of the defendant and held that ,,,,,

it cannot be denied that a common English word like 'SOLO' may also become a trade mark giving exclusive right to its adopter on account of long ,,,,,

user and the extensive publicity and the reputation created among the consumers and traders, who may buy the goods by mere look or hearing of the" ,,,,,

word and will associate the product with a particular manufacturer or trader (para 26),,,,,

iv) AIR 86 DEL 245- Similar protection in relation to common English word like SUPER FLAME has been granted by the Hon'ble Delhi High Court.,,,,,

There, it has been specifically held that a common language word that has a meaning can be exclusively appropriated only upon it being established" ,,,,,

that the word has acquired secondary significance i.e. to say a different meaning other than the primary meaning in the language; it is only to be seen ,,,,,

whether the registered proprietor has applied his skill and expended labour upon its creation/adoption . It was further held that very little amount of skill ,,,,,

and very little amount of labour is sufficient for this purpose.,,,,,

v) Rhizome; Distilleries Private limited vs. Union of India & Ors. (see para 23) The objection under Section 9 so raised by the applicant is not ,,,,,

available to the applicant for rectification as the grounds embodied therein are available only at the time when objection raised in regarding registering ,,,,,

a mark. The objections as enumerated under Section 9 and Section 11 cannot be applied in a case rectification of a registered trade mark. In the said ,,,,,

case the order rectifying the mark RHIZOME IMPERIAL GOLD was set aside by the Hon'ble Division Bench on this ground.,,,,,

vi) It is of much significance to note that the applicant had themselves showed interest in holding stake in the registered proprietor way back in 1996.,,,,,

and hold 49% of the paid up capital therein. Accordingly, the applicant is estopped from contending that the mark 'CHAMPION' is hit by Section 9 of the said Act and inherently not capable of distinguishing the product of any trade.,,,,,

12. The applicant have filed a rejoinder to the written submissions made by the respondent. In it, the applicant state that respondent themselves had",,,,,

acknowledged and admitted that the word CHAMPION is commonly used by various traders and manufacturers in relation to variety of goods and",,,,,

not exclusively used by the respondents.,,,,,

13. The Hon'ble High Court of Delhi in the judgment reported as "Marico Ltd., Vs. Agrotech - MANU/DE/3131/2010 : 2010 (44) PTC 736 (Del)",,,,,

(DB) (para 8)" has clearly held that:",,,,,

(i) acquired distinctiveness under Section 9 is equivalent to being mark "well known". Therefore, the evidence of use and reputation of the mark should",,,,,

be such that it should become a well-known trade mark in order to overcome the bar to registration under Section 9 of The Trade Marks Act, 1999.",,,,,

There is no such evidence produced by respondent in the present case;,,,,,

(ii) it is essential for a mark to have been used exclusively by one person during a long period of time without anyone else attempting to use said trade",,,,,

mark, in order to infer acquired distinctiveness/secondary meaning. Once others claim a right to a descriptive trade mark before end of a long period",,,,,

which is essential for descriptive mark to become distinctive then the original user of descriptive mark cannot ordinarily distinguish its mark and the",,,,,

mark can never acquire a status of a "distinctive mark";",,,,,

The pleading and evidence produced by the applicant that CHAMPION is a word commonly used by several others in the trade is sufficient to reject",,,,,

the claim of acquired distinctiveness by respondent. Neither there is any exclusive use of the mark CHAMPION nor there is any evidence of use",,,,,

over long period of time of the mark CHAMPION by the respondent. Hence, the registration is in breach of Section 9 and ought to be cancelled.",,,,,

14. The Hon'ble Calcutta High Court (DB) vide judgment reported as

""Chandrabhan Vs Arjun Das -MANU/WB/0068/1979 : AIR 1979 Cal 280",,,,,

(Para 12, 17, 18 & 20) has categorically held that descriptive marks may acquire distinctiveness but nobody should be permitted to monopolize",,,,,

laudatory mark"". CHAMPION undisputedly is a laudatory mark.",,,,,

15. The Hon'ble Division Bench of Calcutta High Court in judgment reported as ""Imperial Tobacco Vs. Registrar of Trade Marks -",,,,,

MANU/WB/0109/1977 : AIR 1977 Cal 413"", upholding the Learned Single Judge judgment reported in ""MANU/WB/0105/1968 : AIR 1968 Cal 582",,,,,

(para 24, 51, 55 & 56)"" has held that mere evidence of use is not sufficient to establish acquired distinctiveness. The evidence of use must be",,,,,

critically examined"" to draw such inference. Mere sale and advertisement figures are not sufficient. The evidence of use must be such that it leads no",,,,,

doubt in mind of the court that the mark has become as indicative of source of one manufacturer alone, when used in the trade and has lost its",,,,,

laudatory or descriptive connotation. Such evidence has not been produced by the respondent herein.,,,,,

16. The Hon'ble Division Bench of Delhi High Court in the judgment reported as ""Bhole Baba Vs. Parul Foods"" - MANU/DE/4050/2011 : 2011 (48)",,,,,

PTC 235 (Del) DB (paragraph 2, 3, 5, 12 & 13) has held that the volume of sale has to be considered with reference to the spectrum of consumers",,,,,

keeping in view the market span of the goods in question in order to determine the secondary meaning and distinctive character acquired by the mark,,,,,

in question.,,,,,

17. The goods in question are safety razors and safety blades. It is commonly known that these are used on day to day basis by millions of people. The,,,,,

goods in question, therefore, are of the characteristic which are used by every man and in a country like India the evidence of use of such goods must",,,,,

be of exceptionally high volume for the court to draw an inference of acquired distinctiveness. No such evidence has been produced by respondent in,,,,,

the present case.,,,,,

18. The Chancery Division in the judgment reported as ""British Sons Vs. James Robert - 1996 (RPC) 281 (page 305-306), while examining the issue",,,,,

of acquired distinctiveness of a descriptive trade mark ""TREAT"" has held that mere extensive use is not enough. It must be shown that the mark has",,,,,

really become accepted by a substantial majority of persons as trade mark and

has become a household word. Even if 60% of the purchasing public,,,,,, recognize the word as a trade mark, that is not sufficient. Such recognition must be amongst at least 90% of the purchasing segment of public. The",,,,, respondent has miserably failed to produce on record any such evidence.,,,,,

19. There is nil evidence produced by respondent along with their pleadings. The only evidence produced was a bald statement of sale and export (Ex.,,,,, -B to affidavit dated 22.03.2006 of Mr. Kishori Lal Sawhney). The said statement of sale is not even signed or certified by any Chartered Accountant,,,,, or auditor and is not supported by any supporting or corroborative evidence.,,,,,

20. As mentioned earlier, the respondents had filed a miscellaneous petition (MP) to take on record the additional documents/evidence in support of",,,,, the registration which was vigorously opposed by the applicant. The respondents have provided written materials why the MP. should be taken on,,,,, record. They state that no prejudice would be caused to the applicant by admitting the said MP and there is no element of surprise. The very same,,,,, document tendered have been relied upon in earlier proceedings in Courts where the applicants have been the party. Therefore, the admission of these",,,,, documents is extremely important. Further, the applicant is not an aggrieved party and no injunction is operating against them. As mentioned at the",,,,, hearing, the respondents case has been mishandled by their erstwhile attorneys and there has been no wilful delay on the part of the respondent. All",,,,, the objections raised by the applicant are technical in nature and should not stand in the way of adjudication on merits. Else the respondents will be,,,,, severely prejudiced. Reference was made to ""State of Punjab Vs. Shamlal Murarilal MANU/SC/0494/1975 : (1976) 1 SCC 719 (Para 8).",,,,,

21. Further, our attention was drawn to another judgment of the Supreme Court in ""Eastern Equipment and Sales Ltd. V. Ing Yash Kumar Khanna",,,,, MANU/SC/7556/2008 : (2008) 12 SCC 739 (Para 5 & 7) "" -where it was held that even at the appeal stage, an application under Order 41 Rule 27 of",,,,, the Civil Procedure Code along with the application for additional evidence ought to have been taken on record by the Appellate Court.,,,,,

22. In another Supreme Court Judgment - North Eastern Railway Administration, Gorakhpur Vs, Bhagwan Das (D) by Lrs. -MANU/SC/7481/2008 :",,,,, (2008) 8 SCC 511 (Paras - 13, 13, 20). - The Hon'ble Supreme Court has held inter-alia that - evidence may be admitted by an appellate authority if it",,,,,

' requires' to enable it to pronounce judgment 'or for any other substantial cause.',,,,,

23. The Respondent further submit that in Billa Jagan Mohan Vs. Billa Sanjeeva Reddy MANU/SC/0748/1994 : (1994) 4 SCC 659 (Para 4) - it was,,,,,

observed that - it is settled law that if the documents are found to be relevant to decide the real issue in the controversy and when the Court felt that,,,,,

interest of justice requires that the documents may be received, it exercised the power under Order 41, Rule 27 C.P.C. holding that the appellate court",,,,,,

would receive the documents and consider their effect thereof.,,,,,,

24. Further, in Glyder Bush V. Glyco Metal Works - (1984 PTC 277) (Pg 279) - it was observed that the discretion of granting leave to file further",,,,,,

evidence is to be exercised if a good cause is shown and that discretions is to be exercised to further justice and that too technical a view should not,,,,,

be taken.,,,,,,

25. In their rejoinder to the written submissions of the respondent, the applicant have questioned the legality of the impugned Miscellaneous Petition on",,,,,,

the following grounds:,,,,,

(i) During the hearing, the respondent has sought to place on record the Miscellaneous Petition presented before the Hon'ble Board on 06.12.2012",,,,,,

whereas the pleading in the present petition was concluded on 22.06.2006 when the applicant filed rejoinder affidavit. The Miscellaneous Petition,,,,,

sought to be placed on record as additional documents are enlisted in paragraph 24 of Miscellaneous Petition. The only ground given for not filing,,,,,

these documents is that the erstwhile attorney never advised filing of these documents. This can never be considered as a permissible or reasonable,,,,,

ground for permitting such late filing of evidence. Admittedly the documents were in power and position of the respondent at the time of filing of,,,,,

affidavit of Mr. Sawhney dated 22.03.2006. This Miscellaneous Petition must be rejected being without sufficiency of cause.,,,,,,

(ii) Reliance is placed by applicant/ petitioner on judgment of Delhi High Court reported as:,,,,,

D. Lonic India Vs. Bhardwaj Engineering - MANU/DE/0532/1997 : 70 (1997) DL T 781 (para 5). The Hon'ble Delhi High Court rejected the prayer,,,,,

for belated filing of documents on the ground that the documents admittedly were in power and possession of the applicant.,,,,,,

(iii) The documents referred to in paragraph 24 of Miscellaneous Petition are not supported by any affidavit-in-evidence and hence are not admissible,,,,,

by virtue of Rule 8 of IP AB (Procedural) Rules 2003.,,,,,

(iv) Reliance is placed on the judgment of this Hon'ble Board titled ""Manikchand & Sons Vs. Rasik Lal Manikchand - Manu/IC/0049/2012 (para 7)" ,,,,,

(v) The documents even otherwise as produced do not substantiate the plea of respondent that the mark has acquired distinctive character in India.,,,,,

The only relevant documents are bills and invoices marked ""H"" & ""T"". The documents marked ""H"" are export invoices which are only for the period" ,,,,,

1965-66 and thereafter for the year 2004. There are no invoices for the period 1966 to 2004. Further, these are not the invoices issued by the" ,,,,,

respondent and there is no license agreement produced between the respondent and the consignor. Respondent therefore cannot take advantage of ,,,,,

use of the mark by-consignee for export under the Trade Marks Act. Apart from that, these invoices are not for sale in India and do not therefore" ,,,,,

establish use of the mark in India for purposes of overcoming Section 9 prohibition. As far as invoices marked ""I"" are concerned, they are for the" ,,,,,

period after 2007 and cannot be looked at as not relevant being subsequent of filing the present rectification petition. The acquired distinctiveness must ,,,,,

be established by respondent on the date of institution of the present cancellation petition which was in the year 2005. Hence, even additional evidence" ,,,,,

produced by the respondent do not establish use of the mark between 1965 to 2005 so as to justify an inference of acquired distinctiveness.,,,,,

(vi) In absence of any cogent evidence of acquired distinctiveness and the mark CHAMPION being a laudatory word, the registration granted was in" ,,,,,

breach of Section 9 and continues to wrongly remain on register. The registrations are therefore liable to be cancelled under Section 57 read with ,,,,,

Section 9 of the Act. At the hearing the learned counsel for the applicant relied on the following authorities: ,,,,,

1. ""Chandra Bhan AGarwal and another Vs. Arjundas AGarwal and others"" - MANU/WB/0068/1979 : AIR 1979 CAL. 280) -" ,,,,,

Apart from the conditions referred to In Section 9, the Courts have uniformly and consistently imposed a further condition before a trade mark is" ,,,,,

granted registration. No trade mark shall be allowed to be registered which may hamper or embarrass the traders or the trade now or in future in ,,,,,

respect of the place or country in which it is proposed to be registered.,,,,,,

2. ""Marico Limited Vs. Agro Tech Foods Limited "" - MANU/DE/3131/2010 : 2010 (44) PTC 736 (Del.) (DB)",,,,,,

Section 30 - Civil Procedure Code, 1908 - Order 39 Rules 1 & 2 Registration of trade mark 'Low-Absorb' and 'Lo-sorb' for edible oils - The",,,,,,

expression 'Low Absorb' is clearly descriptive expression which cannot be appropriated by plaintiff - Both using different packaging though for similar,,,,,

product i.e. vegetable oil - User of about 7 years is not sufficient to establish distinctiveness so as to make out a case of passing off - Interim,,,,,

injunction, rightly refused by learned single Judge - Impugned order, affirmed.",,,,,,

3. ""MANU/WB/0109/1977 : AIR 1977 Cal. 413 - The Imperial Tobacco Co. of India Ltd. Vs. The Registrar of Trade Marks and another""",,,,,,

To be distinctive (which means adapted to distinguish) or capable of distinguishing the goods as aforesaid, there may be some inherent qualities or",,,,,,

distinguishing characteristics in the mark itself which may make it so distinctive or capable of distinguishing the goods of the applicant from others.,,,,,,

The degree or extent of such inherent quality that may satisfy the requisite qualification for registration is left to the discretion of the Tribunal to,,,,,

determine, with his expert knowledge as the extent of quality is always variable from mark to mark.",,,,,,

All these are subject to the condition that where inherent unsuitability is so strong no degree of distinctiveness in fact can counterbalance its, so that",,,,,,

some marks are totally unregistrable. This is for the reason that if any mark for example violates the requirements of the sub-cl. (d) of sub-s. (1) of S.,,,,,,

9 such mark because of inherent infirmity can never be distinctive or capable of distinguishing the goods of the applicants sought to be registered from,,,,,

others goods either inherently or by reason of use of the mark or other circumstances.,,,,,,

4. MANU/WB/0109/1977 : AIR 1977 Cal. 413- The Imperial Tobacco Co. of India Ltd. Vs. The Registrar of Trade Marks and another.,,,,,,

Distinctiveness in trade has to be established. It is a notion by itself. It may be result of the sales or of the advertisements, but that result has to be",,,,,,

proved. Sales and advertisements may be the means to lead to distinctiveness but they themselves are neither necessarily so nor conclusive.,,,,,,

Distinctiveness of goods in a trade by its association with a particular name requires normally a hard, laborious and time-consuming process in",,,,,

business. There can be no hard and fast rule for any particular minimum period of time required to acquire distinctiveness. In some cases the time to,,,,,

acquire distinctiveness may be larger than in others. But in this there is a limit. No doubt what that limit is, will depend on the facts of each case. But",,,,,

then the important point is that it must be a reasonable time which can make it reasonably possible for one to acquire distinctiveness in the ordinary,,,,,

world of business. There are certain guides laid down by Section 9(5) of the Trade Marks Act to show when a trade mark is distinctive or it capable,,,,,

of distinguishing. I do not consider Section 9(5) of the Act is exhaustive. It is illustrative to indicate the features which the Tribunal ""may"" regard in",,,,,

determining whether a trade mark is distinctive or is capable of distinguishing. The first consideration under Section 9(5)(a) is when a trade mark is,,,,,

inherently distinctive or is inherently capable of distinguishing The second feature which the Tribunal may regard under Section 9(5)(a) of the Act is,,,,,

where by a reason of the use of the trade mark or of any other circumstances, the trade mark is in fact so adapted to distinguish or is in fact capable",,,,,

of distinguishing, as aforesaid. Held on facts that user of three years was not conclusive.",,,,,

5. ""British Sugar PLC Vs. James Robertson & Sons Ltd.""-1996 R.P.C.",,,,,

6. ""Bhole Baba Milk Food Industries Ltd. Vs. Parul Food Specialities Pvt. Ltd."" _ MANU/DE/4050/2011 : 2011(48) PTC 235 (Del.) (DB)",,,,,

Trade Mark,,,,,

Descriptive Mark _ ""KRISHNA"" in Class 29 for Dairy Products _ The Registration of the appellant is not per-se to the word KRISHNA but to the",,,,,

word KRISHNA written in a distinctive form: akin to a label _ Held, we are in agreement with the view taken by the Learned Single Judge not only",,,,,

for the reasons given by but the additional reason as in the instant case, a deity may be associated with a particular kind of goods. _ It is common",,,,,

knowledge that Lord Krishna as a child, was known for his love of milk & butter and thus Lord Krishna is closely linked with milk & butter and this",,,,,

would certainly dilute a proprietary claim projected by any person in relation to KRISHNA with Dairy Products _ Mere voluminous sales would not,,,,,

transcend a highly descriptive mark like KRISHNA into a distinctive mark.

Appellant can lay claim to what it has got registered as a whole and such,,,,,
registration cannot possibly give an exclusive statutory right to the appellant qua
a particular word of common origin.,,,,,

7. ""Manikchand & Sons (J) Pvt. Ltd. Vs. Rasiklal Manikchand Dharwal"" - IPAB
Order No. 94/2012",,,,,

In the present case, the respondent has raised a valid objection regarding the
documents filed along with the application. Rule 8 clearly provides that",,,,,

evidence shall be in the form of an affidavit. In any event documents can only be
proved by affidavit and even the Civil Procedure Code provides for,,,,,

evidence to be proved by affidavit. The documents can be marked only through a
witness and the affidavits filed are in lieu of the witness getting into,,,,,

the box. The documents in connection with the statement of case cannot be
marked in evidence since they have not been proved in accordance with,,,,,

law.,,,,,

8. ""D. Lonic India Pvt. Ltd. Vs. Bhardwaj Engineering"" -MANU/DE/0532/1997
-"",,,,,

Coming to the second application moved by the petitioner under Order XIII Rule
2 of the Code of Civil Procedure, the contention of the petitioner is",,,,,

that the Trial Court has declined the same only on the ground of delay and shut
out the evidence despite petitioner's assertion that on account of bona,,,,,

fide reasons and sufficient cause, the same could not be produced. I am not
persuaded to accept the submission of learned Counsel for the petitioner",,,,,

for the reasons given, viz. that petitioner bona fide believed that the documents
had been filed and only at the time of change of Counsel when the",,,,,

FINANCIAL

YEAR",PRODUCTION,SALE,"CONSIGNMENT

SALE", "TOTAL

SALE",EXPORT

1964 - 65,16.776,"Opening

balance",,"Closing

balance",136.068

1965 - 66,370.328,251.018,-----,251.018,248.051

1966 - 67,139.862,77.49,"6,000",77.149,40.146

1967 - 68,174.566,93.775,-----,93.775,47.950
 1968 - 69,227.439,196.165,"50,000",246.165,39.000
 1969 -70,47.253,27.876,"12,250",40.126,17.500
 1970 - 71,22.657,16.911,-----,16.911,"7,000
 1971 - 72,27.865,"12,474",-----,"12,474","17,500
 1972 -73,96.751,72.025,-----,72.025,-----
 2003 - 04,841.666,447.165,"275,340.50","722,505.50",-----
 2004-05,"3,225,700.50","1,774,013","1,298,208.00","3,072,221.00","6,000
 2005-06,"2,457,103.00","1,347,301","1,000,024.00","2,347,325.00",-----

30. The applicants themselves have admitted to have attempted buy out of the respondent company in 1996 which ultimately failed. The respondent,,,,,

are the largest manufacturers of blade in India. In these circumstances it would not lie on the mouth of the applicant to say that the respondent cannot,,,,,

be proprietor of the impugned marks CHAMPION. Everything points to the fact that the applicant had foreknowledge of the respondent's mark. The,,,,,

parent company of the applicant decided to promote the word 'CHAMPION' as brand imagery only in 2003 and also started its Indian campaign in,,,,,

2005. Business ethics have both formative and descriptive dimensions. The conduct of the applicant to oust an Indian trade mark owner in this,,,,,

particular instant is not in conformity with international commercial behaviour. The expression 'CHAMPION' may prima facie be a laudatory,,,,,

expression but can qualify for registration, if and when, it acquires secondary meaning. Here we find through a process of electronic and TV blitz and",,,,,,

related information protocols, an established mark is sought to be booted out of the register. We also note the studied silence of the applicant on the",,,,,,

protection afforded by statute by virtue of Section 32 of the Act. In the instant case the applicant are lacking in commercial scruples and are,,,,,

attempting to crush a relatively small time Indian player from playing its rightful role in the Indian market. The 'TREAT' case relied on by the applicant,,,,,

is misplaced. Firstly, it is an English case which ruled 'mere extensive use is not enough'. In that case it was held that it must be further shown that the",,,,,,

mark has really become accepted by a substantial majority of person as a trade mark and has in fact become household. Such recognition must be,,,,,

amongst at least 90% of the purchasing segment of the public. We respectfully

differ from this finding and in our judgment that it is not good law in,,,,,
India. It may be used as a mark for determination of a well-known mark in India
but not oust a mark 40 years or longer on the register. The same,,,,,
English courts have also ruled that even a solitary use is adequate to save a
mark under attack in rectification proceeding. Facts differ from case to,,,,,
case and we are not unduly impressed by these arguments. Considering the
totality of the case, we find that there are no serious grounds to remove",,,,,,
both the impugned trade marks from the register. In the result, ORA 51 &
52/2005/TM/KOL is dismissed. There is no order as to costs. M.P. No.",,,,,
392/2012 is closed.,,,,,,