

(2004) 06 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : T.R.A. No. 23/2003/TM/CH (Order No. 60 Of 2004)

Shalimar Agarbatti Company

APPELLANT

Vs

N. Ranga Rao And Sons

RESPONDENT

Date of Decision : 03-06-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11, 18, 56, 108

Citation : (2004) 29 PTC 247 (IPAB)

Hon'ble Judges : S. Jagadeesan, J;Raghubir Singh, J

Bench : Division Bench

Advocate : M.K. Rao, V. Veeraraghavan

Final Decision : Dismissed

Judgement

S. Jagadeesan, J

1. The applicant filed this application for rectification of the register or removal of trade mark of the first respondent from the Register under Sections

9, 11, 18 and 56 read with Section 108 of the Trade and Merchandise Marks Act, 1958.

2. The case of the Applicant is that he is a manufacturer and trader in Agarbathis. For a considerable long period, the applicant is using various trade

marks for their Agarbathis containing the words ""THREE IN ONE and FOUR IN ONE"" such as ""SHALIMAR THREE IN ONE, KUNAL THREE

IN ONE, SHALIMAR 100 THREE IN ONE"" among others. The use of the expression THREE IN ONE and FOUR IN ONE and other words

referring to the numerical is intended to inform the purchaser that the cartons of agarbathis bearing such expression contain, the agarbathis of three

different fragrances or four different fragrances as the case may be. Hence, such expressions are purely descriptive in nature, having a direct

reference to the goods, indicating the number of fragrances each carton contains. While so, the first respondent has secured a registration of a trade mark THREE IN ONE in No. 426521 for agarbathis in Class 3 under the Trade and Merchandise Marks Act, 1958 and thereby the first respondent is in a position to claim exclusive right to use of the said expression in respect of Agarbathis and to prevent others from using the said expression in respect of each goods. The applicant apprehends legal action against them by the first respondent for infringement of the trade mark for use of such descriptive expression THREE IN ONE. When the impugned mark was advertised in the Trade Mark Journal dated 16.11.1989, there was an explicit disclaimer entered in the application to the effect that the first respondent cannot claim any exclusive rights to the expression THREE IN ONE. Subsequently, a notification appeared in a latter issue of the Journal dated 16.1.1990 under the heading CORRIGENDA wherein the disclaimer in respect of the description had been withdrawn. The first respondent also filed another application No. 544494 in Class 3 for registration of a trade mark containing the expression THREE IN ONE which has been advertised in the Trade Mark Journal dated 1.5.1997. The same is pending under opposition by the applicant. The first respondent, since already obtained a registration in respect of the impugned mark containing the expression, the applicant has filed this application.

3. The first respondent filed counter contending that they are engaged in the manufacture and sale of incense sticks, i.e., Agarbathis for several years.

During the course of the trade, the first respondent firm adopted the trade mark THREE IN ONE and started using it from the year 1981. It is further

the case of the first respondent that ever since 1981, the aforesaid THREE IN ONE is being used continuously and extensively and has become

distinctive of the first respondent's goods. The first respondent has also furnished the sales turn-over from 1981 to 2000. The registration was made by

the Registrar only after careful consideration of the particulars furnished by the first respondent in the application for registration. The first respondent

further registered the impugned trade mark in the United Arab Emirates; Kingdom of Saudi Arabia; Ethiopia, Brunei Darussalam. The first respondent

also denied the use of the expression THREE IN ONE and FOUR IN ONE by the applicant. At any rate, the registration granted to the first

respondent is not in contravention of the provisions of Section 9 of the said Act. By virtue of long, continuous and extensive usage, the first respondent has established a distinctiveness of their goods. The words THREE IN ONE in the carton of the first respondent would prove that the character and quality of the goods are separately mentioned in the carton for which the Registrar of Trade Marks had imposed disclaimer. The applicant is not an aggrieved person and as such, the application is not maintainable and accordingly the same is liable to be dismissed.

4. The learned counsel for the applicant, Shri M.K. Rao, fairly represented that the first respondent's trade mark as per the Certificate is CYCLE

brand Agarbathis under the registration of Trade Mark No. 426521, dated 14.9.1990. Subsequently, the same has been periodically renewed. The

applicant has no objection for the registered Cycle brand. The only objection of the learned counsel is in respect of the words THREE IN ONE in the

cartons of the first respondent on the ground that the first respondent got them registered and thereby the first respondent gets an absolute right in

respect of those words as a registered mark and is entitled to prevent the other manufacturers from using such words. When the words THREE IN

ONE or FOUR IN ONE are common in nature, cannot be registered in anyone's favour, because it reflects the descriptive expression of the different

fragrances of Agarbathis in the carton. Every manufacturer is entitled to use such descriptive expression in their respective cartons and no one can

claim any exclusive ownership or right in respect of the said impugned registered mark. When the disclaimer in respect of the word THREE IN ONE

of the first respondent registered trade mark was published on 16.11.1989, marked as DOCUMENT No. 2 it is not clear as to the basis on which the

corrigenda was published in the manual marked as DOCUMENT No. 4.

5. The learned counsel for the applicant also contended that the applicant using the words THREE IN ONE, FOUR IN ONE in respect of their

Agarbathis and other manufacturers of Agarbathis are also using the words THREE IN ONE, TWO IN ONE of similar nature by way of descriptive

expression to identify the different fragrances in the carton. Hence, the first respondent cannot claim exclusive ownership in respect of the words

THREE IN ONE and consequently the register of the Registrar of Trade Marks has to be modified by making the disclaimer in respect of those

words by the first respondent.

6. On the other hand, the learned counsel for the first respondent Shri V. Veeraraghavan, contended that the first respondent has been using the impugned trade mark right from 3.7.1981. The first respondent has also registered the said trade mark in several other foreign countries. The applicant is challenging the registration unduly delayed and as such on the ground of laches, the application is liable to be dismissed. Except the applicant, no other trade or manufacturer who use the words TWO IN ONE, THREE IN ONE or such words in their cartons have challenged the registration of the first respondent's trade mark. When the registration of the first respondent's mark was done after due process, the present application by the applicant cannot be maintained. At times, the descriptive words may become distinctive and as such the words THREE IN ONE used by the first respondent had acquired a distinctiveness in respect of the goods of the first respondent. The corrigenda was issued by the Registrar on his satisfaction that the words THREE IN ONE do not refer to different fragrances because the names of three different fragrances have been separately mentioned in the carton.

7. It is the further contention of the learned counsel for the first respondent that no legal action can be initiated for use of the words THREE IN ONE or identical. Legal action can be taken only if the colour scheme with the registered trade mark is copied or infringed alongwith other words contained in the carton. The applicant has filed the present application only on the mere apprehension that the first respondent may initiate legal action and as such there is no cause of action for the maintainability of the application. Hence, the application is liable to be dismissed.

8. On the above arguments, the issue arising for consideration is: Whether the registered trade mark of the first respondent Cycle brand Agarbathis

Three in One requires any modification or removal from the Register?

9. Before entering into a discussion of the rival contentions of the counsel, it is better to have a look at the certificates of the Trade Mark Registry.

The Document No. 1 at page No. 1 of the type set filed by the first respondent reveals that the first respondent had registered under the Trade Mark

No. 426521, through application dated 31.8.1984, the ""CYCLE BRAND AGARBATHIES"" in Class 3 of the Trade and Merchandise Marks Act, in

respect of Agarbathis. The Document at page 2, the carton contains the Cycle brand with the device and also the words "Three in One". The three fragrances mentioned are Lily, Fancy and Intimate. This registration was renewed periodically. Under the Copyrights Act also, the first respondent had registered their mark in Registration No. A 50888/91. The document at page 5 is the extract from the Registry of the Copyrights furnishing the particulars. In Clause 5, it is stated "Cycle Brand Three in One" carton. The document at page 7 is the carton registered under the Copyrights Act. The documents at pages 9, 11, 13, 15 and 17 are all different types of cartons used by the first respondent. The document at page 22, the registration of Trade Mark certificate of the first respondent in the State of Kuwait, the trade mark is "CYCLE BRAND THREE IN ONE". The document at page 24, is the carton used by the first respondent. The first respondent also produced several registered certificates from various foreign countries where they have registered their trade mark "CYCLE BRAND THREE IN ONE" and specified that their origin is at India. Of-course, we are not concerned with the trade marks registered in foreign countries and we have to confine in this order, only with regard to the trade mark of the first respondent having its trade in India.

10. Now, we take up the matter for discussion. The prime grievance of the applicant for filing the application for registration is that the words "THREE IN ONE" have been registered alongwith the "Cycle Brand" trade mark of the first respondent and consequently, the first respondent may claim the exclusive right over the words "THREE IN ONE". When similar words of the nature "TWO IN ONE, THREE IN ONE, FOUR IN ONE, FIVE IN ONE", are being regularly used in the trade of Agarbathis, incense sticks by various manufacturers, the Registrar ought not to have granted the registration of the words "THREE IN ONE" in favour of the first respondent. The applicant seems to have entertained the apprehension that the first respondent may put forth exclusive claim with the words THREE IN ONE on the basis of the disclaimer published in the Journal dated 16.11.1989, in respect of the first respondent's trade mark was withdrawn by way of corrigenda. The disclaimer published originally is as follows which is marked as document No. 2 and available at page 27 of the document set filed by the applicant.

The Non-Roman Characters appearing on the mark represent the word ""Cycle Brand"" of descriptive matters.

426.521:- August 31, 1984, R. GURU, R.N. MURTHY, R.V. VASU, R. KRISHN, R. VENKATESH, R. SRIDHAR and R. MOHAN, trading as N.

RANG RAO & SONS and also as VASU & CYCLE BRAND, AGARBATHI WORKS, 100 Feet Rod, Post Box No. 52, Mysore-570 004,

Manufacturers and Merchants. To be associated with No. 191,076(263) iii & others User claimed since 3-7-1981, (MADRAS).

Agarbathies.

Registration of this Trade Mark shall give no right to the exclusive use of the device of the Word & World ""vrabd"" AND ""Three in One"".

11. Subsequently, the corrigenda was published in a later journal which is available at page 29 of the same set filed by the applicant which is as

follows:

2. 426,521(971) iii : The Disclaimer is corrected to read as Registration of this Trade Mark shall give no right to the exclusive use of the ""Lily, Fancy, intimate and other descriptive matters except three in one"".

12. When we look at the cartons used by the first respondent and also the particulars furnished before the Registrar of Copy Rights, it is clear that the

registration of the first respondent's trade mark is made as ""CYCLE BRAND THREE IN ONE"". Even in foreign countries, the first respondent had

registered its trade mark only as ""CYCLE BRAND THREE IN ONE"". The learned counsel for the first respondent also contended that neither the

applicant nor any other trader had been cautioned so far by the first respondent in respect of the use of the words ""THREE IN ONE"". The first

respondent has been using the said trade mark ""CYCLE BRAND THREE IN ONE"" for nearly two decades without asserting any exclusive rights in

respect of the words ""THREE IN ONE"". Even as per the statement of the learned counsel for the applicant, other several manufacturers are using

the identical words or the numerical words 2 in 1, 3 in 1, 4 in 1, etc. and except the applicant, no one else has come to the Court. When the applicant is

not facing any legal threat and in the absence of any material on record either before the Registrar of Trade Marks or before us that the persons

similarly placed like that of the applicant in the same trade are facing any threat from the first respondent, we are of the view that there is absolutely

no cause of action for filing the application for rectification.

13. The learned counsel for the applicant has relied upon the following passage from the Trade and Merchandise Act by Shri Narayanan-4th Edition

at page 355, paragraph 21.19:

21.19 Persons whose interests are affected. An application for rectification can only be made by a person aggrieved. The expression ""persons

aggrieved"" has been construed liberally by English Courts while dealing with the corresponding provisions, under the English Acts. Thus persons who

are aggrieved are persons who are in some way or other substantially interested in having the mark removed from the register, or persons who would

be substantially damaged if the mark remained. Whenever it can be shown that the applicant is in the same trade as the person who has registered the

trade mark, and wherever the trade mark, if remaining on the register, would, or might, limit the legal rights of the applicant, so that by reason of the

existence of the entry on the register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, he

has a locus standi to be heard as a person aggrieved. Any trader is, in the sense of the Statute, 'aggrieved whenever the registration of a particular

trade mark operates in restraint of what would otherwise have been his legal rights.

14. Relying upon the above passage, the learned counsel for the applicant contended that by remaining the words ""THREE IN ONE"" on the register,

the same would, or might limit the legal rights of the applicant from using the same words and as such, the applicant has a locus standi to be heard as a

person aggrieved.

15. When we consider the submissions made by the learned counsel for the first respondent that the first respondent has been in the trade for more

than two decades using the same registered mark ""CYCLE BRAND THREE IN ONE"" and the applicant and also the other manufacturers did not

face any exclusive claim by the first respondent, we are of the view that the applicant cannot be considered to be an aggrieved person at this stage

when his rights has not been affected so far. Further, it is clear that the registered trade mark of the first respondent is ""CYCLE BRAND THREE IN

ONE"". As rightly pointed out by the learned counsel for the first respondent, the first respondent is entitled to safeguard his registered trade mark in a

combined colour scheme, the device used on the carton alongwith the device and the mark. When that be so, there is absolutely no merit in the present application.

16. The learned counsel for the first respondent further contended that after the publication of the corrigenda referred to above withdrawing the disclaimer in respect of the words ""THREE IN ONE"", the applicant filed a Review Petition before the Registrar of Trade Marks and the same was dismissed. Having allowed the order to stand which became final, it is not open to the applicant to file a separate application for rectification. On this ground also, this application is not maintainable. The learned counsel for the first respondent pleaded ignorance of the same and in spite of one opportunity, the learned counsel for the applicant could not get instructions from his client regarding the review application. The learned counsel for the first respondent also did not place any record before this Board about the Review application filed by the applicant and the orders thereon. In the absence of any record, we are of the view that it may not be proper for us to entertain the plea and discuss the same. Hence, we are not inclined to traverse this issue for want of material.

17. For the reasons stated above, the application is dismissed. However, there will be no order as to costs.