

MANU/IC/0034/2008

**Equivalent Citation:** 2008(37)PTC696(IPAB)

**INTELLECTUAL PROPERTY APPELLATE BOARD, CHENNAI  
CIRCUIT BENCH AT MUMBAI**

ORA/74 and 75/2006/TMMUM

Decided On: 23.05.2008

Appellants: **Karamchand Appliances Private Ltd.**

**Vs.**

Respondent: **Godrej Sara Lee Limited**

**Hon'ble Judges/Coram:**

Z.S. Negi, Chairman and S. Usha, Member (T)

**Counsels:**

For Appellant/Petitioner/Plaintiff: Shyam Sunder Iyer, Adv.

For Respondents/Defendant: T.N. Daruwalla, Adv.

**Subject: Intellectual Property Rights**

**Acts/Rules/Orders:**

Trade Marks Act, 1999 - Sections 9, 9(1), 11, 31, 36, 36(1), 36(2), 47, 57, 57(2) and 125

**Cases Referred:**

Roshan Lal Oil Mills Ltd. v. Assam Company Ltd. 1996 PTC 699 Del.; Competition Review Ltd. v. N.N. Ohja 1996 PTC 124; J.R. Kapoor v. Micronix India 1994 PTC 260 (SC); Gillete v. A.K. Stationary 2001 PTC 513 (Delhi); The Bada Co. v. Montgomery Ward and Co. 165 USPQ 483; Teofani v. Teofani (1913) 30 RPC 446 (CA); Corn Products Refining Co. v. Shangrila Food Products Ltd. AIR 1960; Central Camera Company Pvt. Ltd. v. The Registrar of Trade Marks IPLR Volume 5 1980; J.L. Mehta v. The Registrar of Trade Marks AIR 1962 Bombay 82; In Re: Powell's Tm. (1894) 11 R.P.C. 4, HL

**Disposition:**

Application dismissed

**ORDER**

**Z.S. Negi, Chairman**

1. The applicant has filed two similar applications for removal of two identical Trade Marks 'JUMBO GOLD' registered in the name of the respondent under Nos. 1241924 in class 5 and 1241927 in class 9, respectively, from the register or rectification of the register under Section 47/ 57/ 125 of the Trade Marks Act, 1999 (hereinafter referred to as the Act).

2. Before enumerating facts leading to the filing of the present applications, it would be appropriate to clarify at the outset that since the contentions in both the applications are broadly on the same lines and both the parties are also same, both the applications were, with the concurrence of both the learned Counsel, heard together; for the sake of convenience we shall deal with the dispute arising out of ORA/74 /2006/TMMUM and apply the findings therein on ORA/75/2006/TMMUM.

3. It is stated that the respondent herein filed an application No. 693150B on 12.1.1996 for registration of trade mark 'JUMBO', which was opposed by the applicant herein on the grounds, inter alia, that the applicant manufactures and markets a range of household insecticides/mosquito repellents in various forms including coils, mats and liquid vapourisers apparatus and liquid vapourise refills under its well known trade mark 'ALL OUT'; that it is one of the largest companies in mosquito repellents in market in India with an overall market share of more than 22%; that it uses the word JUMBO to signify bigger size or coil lasting for a longer duration for its ALL OUT coil which lasts for longer hours than the regular coil; that the word JUMBO is an ordinary word which means big and used by almost all the manufacturers of fast moving consumer goods to distinguish between small, medium and big size and as such no body can have monopoly over the word JUMBO and that the word is generic, incapable of becoming a trade mark and the registration of JUMBO as the trade mark would be contrary to the provisions of the Act.

4. It is further stated that the respondent has instituted a suit being CS (OS) No. 1230 of 2002 for infringement

manupatra and passing off against the applicant and also in the suit the respondent has filed an application for an interim injunction before the High Court of Delhi. The suit is pending and the interim injunction sought for has not been granted till today. Thereafter, the respondent issued a caution notice in the newspaper dated 3.9.2003 claiming that the respondent is the proprietor of the trade mark JUMBO and only the respondent was entitled to use the trade marks including GOODNIGHT JUMBO, JET JUMBO and JUMBO and thereupon, the applicant obtained an injunction on 1.10.2003 from the High Court of Delhi against issuing such caution notices by the respondent claiming ownership of trade mark JUMBO. The respondent, despite its earlier application for trade mark JUMBO pending, filed two applications, on proposed to be used basis, on 8.10.2003 for registration of JUMBO GOLD trade marks and obtained registration of trade marks under Nos. 1241924 and 1241927 both as of 8.10.2003. Averment has been made that the applicant is the person aggrieved under Section 57 of the Act and this application, without prejudice to the rights and contentions of the applicant in the suit pending before the High Court of Delhi, is filed for the purpose of maintaining the purity of the register.

5. The applicant, claiming to be the person aggrieved, has sought removal of the respondent's trade mark from the register or rectification of the register on various grounds, inter alia, that the impugned mark JUMBO GOLD cannot be registered under Section 9(1) of the Act; that the impugned mark is covered by proviso (a) to Sub-section (1) of Section 36 of the Act; that the impugned registration has been made without sufficient cause and that for maintaining the purity of register and, having regard to the malafide conduct of the respondent before the Registrar of Trade Marks in not disclosing the fact of suit pending in the High Court of Delhi and registration of trade mark JUMBO on its earlier application has not been granted, the impugned marks should be expunged from the register. The respondent has filed its counter-statement on 5th January, 2007 denying the material averments made in the application and claiming that the trade mark JUMBO was originally conceived and honestly adopted by the respondent in the year 1996 and applied for registration on 2.1.1996 but the registration certificate has not been received and also no notice of opposition has been received by it or its attorneys till date. It is further claimed that the respondent on or about 9.9.1999 began using the trade mark JUMBO in conjunction with its well-established and reputed trade marks JET and GOOD KNIGHT and in October, 2003 the respondent conceived and adopted the trade mark JUMBO GOLD, applied for registration and obtained registration without any oppositions to the applications for registration.

6. The applications came up before us for hearing on 2.4.2008 at the Circuit Bench sitting at Mumbai, when Shri Shyam Sunder Iyer, Advocate appeared on behalf of the applicant and Shri T.N. Daruwalla, Advocate appeared on behalf of the respondent.

7. Shri Shyam Sunder Iyer, learned Counsel for the applicant, contended that the applicant is the person aggrieved within the meaning of Section 57 of the Act as the respondent has filed a suit for infringement and passing off against the applicant; it is a bonafide user of the mark JUMBO in respect its products; it has been using the trade mark JUMBO to indicate the applicant's larger sized coils and the registration of the respondent's mark would adversely affect the rights of the applicant.

8. Shri Iyer contended that the impugned mark cannot be registered as a trade mark, in view of application of provisions of absolute grounds of refusal under Clauses (a) and (b) of Sub-section (1) of Section 9 of the Act. The word JUMBO is a generic term with respect to coils to indicate the larger size or big which can never acquire a secondary meaning. The word or term is not only used for coils and mosquito repellants but also used to signify larger size by various manufactures in relation to pens, envelopes, kitchen appliances, household items, toiletries and various other products. He pointed out that the respondent has itself stated in the counter-statement that there are many others whose registered mark contain the word JUMBO as detailed in under para 9(d) thereof, therefore it is completely established that the impugned mark JUMBO GOLD is devoid of any distinctive character, that is to say, not capable of distinguishing the goods of one person from those of another person. The word is an ordinary dictionary word which means big. In the Roshan Lal Oil Mills Ltd. v. Assam Company Ltd. 1996 PTC 699 Del, the Court held that the idea of using the word JUMBO by the plaintiff and defendant is to convey superpower or strength in edible oils and tea respectively. The word JUMBO is indicative of the characteristic of a product i.e. the size of a particular product and as such is also hit by Section 9(1)(b) of the Act. In the case of Competition Review Ltd. v. N.N. Ohja 1996 PTC 124, the High Court of Delhi refused injunction to plaintiff holding that the plaintiff cannot claim exclusive right of the word COMPETITION which was a descriptive word. The learned Counsel relied upon the decisions in J.R. Kapoor v. Micronix India 1994 PTC 260 (SC) and Gillete v. A.K. Stationary 2001 PTC 513 (Delhi) wherein the Supreme Court in relation to Microtel and Micronix held that the word MICRO is a common or general name descriptive of the micro technology used for the electronic goods which come daily to the market and no one can claim monopoly over the use of the said word and in relation to LUXOR PAPERMATE FLEXGRIP and EKCO FLEXGRIP the High Court of Delhi held that the words FLEXGRIP are descriptive because the use of the word GRIP that too used in relation to pens and other writing instruments. He relied on a US judgment in The Bada Co. v. Montgomery Ward and Co. 165 USPQ 483 to say that JUMBO appears in dictionaries and in common usage in a combining form or singly meaning large or big and the respondent's mark, therefore, is exactly analogous to other marks relating to the size of goods which have been held merely descriptive. It was further contended that the word JUMBO is not only descriptive or indicative of size but also has become customary in the customary language and bonafide practice of the trade. As such its registration is prohibited under Clause (c) of Sub-section (1) of Section 9 of the Act and also such a word falls within the exception carved out by proviso (a) to Sub-section (1) of Section 36 of the Act. The assertion of the learned Counsel was that the word JUMBO is not only purely descriptive, describing the size of the

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respondent's product, but is used for various other goods and registration of such word would give monopoly of use to the registered proprietor in violation of the provisions of Section 36 of the Act.

9. Shri Iyer next contended that as the impugned registration has been made in violation of the provisions of Sections 9 and 36 of the Act, such entry in the register is made without sufficient cause within the meaning of Sub-section (2) of Section 57 of the Act and, therefore, the impugned entry is liable to be expunged from the register.

10. Shri Iyer submitted that the conduct of respondent has not been bonafide as it did not disclose the fact of the pending Suit No. 1230 of 2002 against it before the High Court of Delhi which relates to the mark JUMBO and the fact that the trade mark JUMBO applied by it earlier on 2.1.1996 for registration has not till then been allowed by the Registrar. Since non disclosure of these material facts amount to concealment of material facts and the impugned registration has been obtained on concealment of material facts, hence the impugned registration deserves to be removed from the register on this ground alone.

11. Shri T.N. Daruwala, learned Counsel for the respondent, submitted that the applicant is not the person aggrieved within the meaning of Section 57 of the Act as the suit filed by the respondent is a passing off suit based on its trade mark JUMBO which was and still is unregistered trade mark. The trade mark JUMBO GOLD was not at all mentioned in the said suit and the application of the respondent seeking amendment of plaint to add trade mark JUMBO GOLD was refused by the High Court of Delhi mainly on the ground that JUMBO GOLD is altogether a new trade mark and the plaintiff has not sought amendment in the body of the plaint to the effect that JUMBO and JUMBO GOLD are one and the same. The application for registration of trade mark JUMBO GOLD was made after filing of the suit and the dispute here is only about the word JUMBO. The applicant in paragraphs 14 and 15 of the application has alleged to be person aggrieved due to registration of trade mark JUMBO and not the trade mark JUMBO GOLD which is the subject matter of registered trade mark No. 1241924 in class 5. There is nothing brought out in the application to show as to why the registered trade mark JUMBO GOLD should be expunged. He further submitted that the entire Form I has been drafted in a vague manner and nothing is shown as to how the applicant is the person aggrieved within the meaning of Section 57 of the Act.

12. Shri Daruwala submitted that the grounds taken by applicant for rectification under Sections 9(1) and 36(1) is misconceived. The registered trade mark must be considered as a whole and the registered trade mark is JUMBO GOLD and not JUMBO per se. It is false and absurd for the applicant to contend without any basis that JUMBO GOLD is indicative of the size of the mark or it is customary. The allegation of the applicant that the impugned mark is descriptive of the size of the mark and as such covered by Section 9(1)(b) of the Act does not on the face of it make sense and no evidence has been led to show that JUMBO GOLD has become customary in the current language or in the bonafide established practices of the trade. Relying on the decision in *Teofani v. Teofani* (1913) 30 RPC 446 (CA), the learned Counsel submitted that it is important to note that the burden of proof is always on the applicant who seeks to rectify or vary the register. Placing reliance upon the decision in *Corn Products Refining Co. v. Shangrila Food Products Ltd.* MANU/SC/0115/1959, learned Counsel argued that in the matters for rectification and in the present mark and/or part of the mark being common element to trade, the onus to prove the common element to trade lies on the party so pleading. He asserted that it has been consistently held that the mark comprising the common element shall be in fairly and extensive use and the use should be use in the market in which the marks under consideration are being or will be used. The objection raised under Section 36 of the Act does not apply to the facts of the present case without establishing that the trade mark JUMBO GOLD is the name or descriptive of the article or substance. The applicant has deliberately omitted to refer to Sub-section (2) of Section 36 of the Act. In the case on hand the trade mark does not consist solely of JUMBO but consist of JUMBO GOLD. The applicant has utterly failed to prove that there is a well-known and established use of the word JUMBO or JUMBO GOLD. The learned Counsel relied upon the decision of the Bombay High Court in the *Central Camera Company Pvt. Ltd. v. The Registrar of Trade Marks* reported as IPLR Volume 5 1980 page 1 and in *J.L. Mehta v. The Registrar of Trade Marks* MANU/MH/0144/1962 in support of his submissions that JUMBO GOLD has no direct reference to the character or quality of the goods of the respondent and that JUMBO GOLD is not descriptive of goods manufactured by the respondent.

13. After carefully hearing the arguments of both the parties, the first question that need to be considered is whether the applicant is the 'person aggrieved' to file the present rectification application. The expression 'aggrieved person' has received liberal construction from the courts and includes rivals in the same trade who are aggrieved by the entry of rival's mark in the register of trade marks or persons who are in some way or the other substantially interested in having the mark removed from the register or persons who would be substantially damaged if the mark remained on the register. **In re Powell's Tm.** (1894) 11 R.P.C. 4, HL at p. 4 Lord Herschell said: "The first question raised is whether the Respondents were 'Persons aggrieved'.... My Lords, I should be very unwilling unduly to limit the construction to be placed upon these words; because, although they were no doubt interested to prevent officious interference by those who had no interest at all in the Register being correct, and to exclude a mere common informer, it is undoubtedly of common interest that they should not be unduly limited, in as much as it is a public mischief that there should remain upon the Register a mark which ought not to be there; and by which many persons may be affected, who, nevertheless, would not be willing to enter upon the risk and expense of litigation. Wherever it can be shown, as here, that the Applicant is in the same trade as the person who has registered the Trade Mark, and

manupatra wherever the Trade Mark, if remaining on the Register, would, limit the legal rights of the Applicant, so that by reason of the existence of the entry on the Register he could which, but for the existence of the mark upon the Register, he could lawfully do, it appears to me he has a *locus standi* to be heard as a person aggrieved." In the present case, though not pleaded, it appears from the facts and records that the applicant and the respondent are in the same trade and as such are trade rivals. The applicant has made specific averment in the application that the registration of the mark JUMBO would adversely affect the rights of the applicant. A suit for infringement and passing off has been instituted by the respondent against the applicant. Having regard to the fact that the applicant for rectification being from the same trade as from that of the registered proprietor and as the existence of registered trade mark would limit its legal rights to carry on business under the trade mark JUMBO, the applicant *prime facie* appears to be the person aggrieved and as such is entitled to file the present rectification application under Section 57 of the Act.

14. The next issue is JUMBO is an ordinary word to signify large size, generic, common to trade and incapable of being a trade mark or attaining trade mark signification and as such prohibited to be registered as a trade mark under Section 9 of the Act. Section 9 of the Act which provide for absolute grounds for refusal of registration reads as under:

9. (1) The trade marks-

(a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;

(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;

(c) which consist exclusively of marks or indications which have become customary in the current language or in the *bona fide* and established practices of the trade,

shall not be registered:

Provided that....

15. After extracting the relevant provision of law we would see on whom the onus to prove lies that the impugned registration is in contravention of the above extracted provision. Having regard to the provision in Section 31 of the Act which provide that in all legal proceedings the registration is *prima facie* evidence of validity thereof, the burden of proof in rectification proceedings for cancellation or variation of the registration, is on the applicant seeking rectification to show that the mark is wrongly registered or wrongly remaining on the register. The onus of proof is on the applicant to show that the trade mark was registered in contravention of the provisions of Section 9 or Section 11 or both. We would refer to *Formica case* (1971) 75 CWN 663 wherein Justice B. Mukherjee of Calcutta High Court observed thus: "Mark on the register you want to take off the Register? The onus is then upon you to prove that the mark deserves to be taken of so. This is plain common sense too. I am on the register. Sure enough, it is not for me to prove that I should be where I am and that the entry in my favour is valid. Were I to prove so, why register? Registration becomes valueless."

16. There is no dispute that the word jumbo is an ordinary dictionary word. According to *The Chambers Dictionary* (New Edition) the word 'Jumbo' in means anything very big of its kind; an elephant (after a famous large one so named); a jumbo jet;- adj huge; colossal; extra-large. The application on hand is in relation to removal of trade mark JUMBO GOLD from the register or rectification of register, therefore the issue to be considered is in relation to the words JUMBO GOLD and not JUMBO *per se*. The above mentioned meaning of jumbo cannot apply to the words jumbo gold. The words JUMBO GOLD has been registered as a trade mark we have to take into consideration of the trade mark as a whole. The mark JUMBO GOLD taken as a whole is not directly descriptive of the character or quality of the concerned goods as the concerned goods is mosquito mat or coil and not gold and as such we do not see any ground of absolute refusal enumerated in any of the clauses of Sub-section (1) of Section 9 of the Act. There is no evidence available on record to show that the mark jumbo gold consist exclusively of indications which have become customary in the current language or in the *bonafide* and established practices of the trade. Regarding the contention of the applicant that the registration of JUMBO GOLD is also covered under the proviso (a) to Sub-section (1) of Section 36 of the Act, such contention is sustainable where it is proved that there is a well known and established use of the word jumbo gold as the name or description of the article or by the other traders then the provisions of Sub-section (2) of Section 36 of the Act will apply. In the present case the same has not been proved and the list of goods where the word used is JUMBO not the JUMBO GOLD and the extent of such use is not indicated. Similarly the respondent has under para 7 (d) has given a list of more than seventy registered trade marks consisting of word JUMBO singly or in combination with word JUMBO to show that such word is in wide use by others and the applicant cannot claim monopoly over that word. However, in the absence of any evidence of user the same cannot be given credence as mere registration of trade mark is no proof of its use in trade. The case law cited by the applicant in support of its contention will be not much helpful as they are distinguishable to the facts of the case on hand. Having regard to the above discussion, it

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is difficult to sustain the grounds given under Section 9(1) and proviso (a) to Sub-section (1) of Section 36 of the Act.

17. We have already stated that it is difficult to sustain the grounds given under Section 9(1) and proviso (a) to Sub-section (1) of Section 36 of the Act, the objection that the mark is registered without sufficient cause also fails.

18. The last contention of the applicant that the respondent has concealed material facts, that it's earlier application for registration of trade mark JUMBO is pending and that a suit for infringement and passing off is also pending before the Delhi High Court, before the Registrar of Trade Marks for obtaining registration of trade mark JUMBO GOLD. Concealment in law means the intentional suppression of truth or fact known, to injure or prejudice another. The applicant has not explained in the application or at the time of arguments as to how the applicant is injured or prejudiced by not disclosing the alleged facts to the Registrar of Trade Marks and also not adduced any evidence to prove that these facts were not factually disclosed and that the impugned registration was obtained by virtue of concealment of the alleged facts.

19. In view of the above, we can unhesitatingly hold that the applicant has miserably failed to discharge its onus and as such the application must fail.

20. Accordingly, the application ORA/74/2006/TM/MUM is dismissed. By applying the findings in the application mentioned here before, the ORA/75/2006/TMMUM is also dismissed. There shall be no order as to costs.

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