

**THE TRADE MARKS ACT, 1999
(Before the Deputy Registrar of Trade Marks)**

IN THE MATTER OF Registered Trade Mark Application No.1109980 in Class 3 in the name of M/s Oriental Extractions Pvt. Ltd..

Registered Proprietor/Respondents

And

IN THE MATTER OF Rectification No.259345 in Class 3 in the name of Mr. S. Siva Subramaniyan, Polaythodu, Mundakkal, Kollam - 691 001.

Applicants for Rectification/Petitioner

And

IN THE MATTER OF Interlocutory Petition dated 13.10.2008 filed by the Registered Proprietor.

Present: **Mr. John Mathew, Advocate and Mr. S. Sivasubramaniyan, Proprietor of M/s Divine Pharmaceuticals, Kollam for the Applicants for Rectification.**

None for the Registered Proprietor.

ORDER

This order will dispose of Interlocutory Petition filed by Registered Proprietor and the main case.

The Trade Mark MANJAL was sought for registration in Class-3 by M/s Oriental Extractions Pvt. Ltd. bearing No.1109980 in Class-3. After some preliminary objection, the mark was ordered to be advertised in the Trade Marks Journal and accordingly it was published in the Trade Marks Journal No. 1103 (Supplement), 21.9.2003. Since there is no opposition to the said application within the statutory period, the mark got registered.

The applicants for rectification have filed Form TM-26 for removing the mark from the Register by Mr. S. Siva Subramaniyan, Polaythodu, Mundakkal, Kollam - 691 001 mainly on the following reasons:

The trade mark "MANJAL" registered in Class-3 for goods "ayurvedic bath soap" is descriptive as the mark MANJAL is:

- the name of the essential ingredient of the goods registered
- direct reference to the characteristics of the goods
- describes the kind, quality, value and intended purpose of the goods

The trade mark "MANJAL" is a transliteration of a descriptive and commonly used word in Malayalam and Tamil national languages and

the translation of the same in English Language is TURMERIC and in Hindi it is called "HALDI".

Therefore, the mark is registered contrary Sections 9 (1) (b) and the main purpose of the Trade Marks Act, 1999 and is remaining in the Register unlawfully, and as such it is to be expunged from the Register under Section 57(2) of the Trade Marks Act, 1999.

Further, a suit for permanent injunction to restrain the applicant from using the Malayalam word MANJAL is pending before the High Court of Delhi vide case No.OS (CS) 550 of 2008.

The Registered Proprietor have filed counter statement along with Interlocutory Petition on 13.10.2008 for the reason that the rectification application filed before the Hon'ble Tribunal to be returned to the applicant as it is the humble submission of the registered proprietor that the Trade Marks Registry, Chennai has no jurisdiction to adjudicate over the said rectification application. Further it has been stated that the registered proprietor hereby calls forth the provisions of Section 125(1) of the Trade Marks Act, 1999 which is enumerated as follows:-

- i) where in a suit for infringement of a registered proprietor of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under Section 30(2)(e) and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register and, notwithstanding anything contained in Section 47 or Section 57, such application shall be made to the Appellate Board and not to the Registrar.

The applicants for rectification have filed evidence in support of rectification by way of an affidavit of Mr. S. Siva Subramaniam along with Exhibits A1-12. The Registered Proprietor has filed evidence in support of registration by way of an affidavit of Ms. Vijayalakshmy Malkani along with annexures A-F - as per details contained therein. A hearing was fixed to decide the Interlocutory Petition filed by the Registered Proprietor and the main case. Mr. John Mathew, Advocate appeared for the applicants for rectification and none appeared for the Registered Proprietor but filed TM-56 to adjourn the hearing on the hearing date without fee and have not informed to the Applicant for rectification's counsel. The counsel for the applicant for the rectification has come all the way from Ernakulam.

The counsel for the applicant for rectification has argued the case on merits and also submitted the written arguments. In the written submission filed by the counsel for applicants for rectification stated that as follows:-

1. The Registrar of Trademarks has the jurisdiction to entertain and dispose of the Trademarks Act has no application in the facts and circumstances of the case as the plaintiff's trade mark is not questioned by the defendant. The suit pending before the Hon'ble Delhi High Court as O.S. 550/2008 is between Marico Limited and Divine Pharmaceuticals whereas the rectification application is between the proprietor of Divine Pharmaceuticals Mr. S. Siva Subramaniam and one Oriental Extractions Private Limited the registered proprietor of trade mark No.1109980. Marico is not a party to the

rectification nor Oriental a party to the suit. If Oriental was the plaintiff there must have some merits in the arguments of the respondent. The plaintiff in the suit Marico Limited is not a registered proprietor of the trade mark MANJAL and as such it has no locus standi to represent as the registered proprietor.

2. The trade mark MANJAL is incapable of distinguishing the goods of one person from the other and hence it cannot be a trade mark. Since it is a word in the current language it is in public domain and no one can acquire a monopoly or exclusive right on MANJAL.

3. The mark MANJAL is generic and descriptive. No amount of use will confer on it a secondary meaning especially the use is in relation to a soap where the main ingredient is Manjal.

Once it is proved that the word is generic designation of a class of goods, no amount of evidence of purported secondary meaning can give legal protection to that generic name" 188 US PQ 612 [2nd Cir. 1975] quoted at page 256, Law of Trademarks and Passing Off by P. Narayanan VI Edition.

In the case of a word which has a direct reference to the character or quality of the goods or services, it may be very difficult to establish that it has lost its primary signification and acquired a distinctive character i.e., capable of distinguishing". 1929 46 RPC 99. quoted at page 257, Law of Trademarks and Passing Off by P. Narayanan VI Edition.

4. The person who have chosen such a descriptive name as MANJAL for a Manjal soap has done so at their peril. Such persons can never become a proprietor of such a mark so as to apply for registration of the mark. The proprietary rights in relation to a generic name vest in the public. So the claim made by the registrant as proprietor was a fraudulent claim with the aim of usurping a public right, and the acceptance of the application by the Trademarks Registry was in error and the officers of the Registry became the victims of fraud committed by the registrant.

5. The very object of the Trademarks Act is the prevention of use of fraudulent marks. Every unfair means used to obtain an unconscionable advantage over another is said to be fraud. By registering the mark MANJAL to the exclusion of others, the registrant has committed a fraud to the whole society.

6. An error happened while registering the mark MANJAL can be corrected by the Trademarks Registrar at any time. So also a fraudulent registration can be expunged from the Registrar at any time. Thus the Registrar of Trademarks is bound to cancel the registration granted to the mark MANJAL under No.1109980 at the earliest as it is wrongly remaining in the Register.

7. The purity of the Register is a concern of public interest and to maintain the purity of the Register and upholding the public interest is the primary duty of the Registrar. Hence the registration granted to the mark MANJAL is liable to be expunged from the Register and the applicant humbly requests to exercise the powers conferred on the Registrar by Section 57 of the Trade Marks Act by expunging the wrongful entry.

8. The applicant herein is a person aggrieved, as the applicants also had a trade mark having MANJAL as a part together with many other traders. The applicant never claimed a monopoly over MANJAL but only wanted a co-

existence with other traders who are legitimately using MANJAL as a part of their trademarks. The act of claiming exclusive use of MANJAL by the registrant prejudiced the applicant and as such very much aggrieved by its existence in the Register".

I have considered the submissions of the counsel for applicants for rectification and have gone through the records of this case.

At the first instance, I disallow the Interlocutory Petition filed by the registered proprietor since the Registrar of Trademarks has the jurisdiction to entertain and dispose of the present rectification application.

Section 9(1)(b) applies in this case.

Section 9(1)(b) of Trade Marks Act, 1999 states that:-

Section 9 – Absolute grounds for refusal of registration - (1) The trade marks – (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;

shall not be registered:

The trade mark MANJAL is registered under No.1109980 in Class-3. The trade mark MANJAL is a transliteration of a descriptive and commonly used word in Malayalam and Tamil national languages and the translation of the same in English Language is TURMERIC and in Hindi it is called HALDI.

In the instant case the mark MANJAL is Registered under No. 1109980 in Class-3 in respect of "bathing soap" have also got direct reference to the character and quality of the goods and it is highly descriptive in respect of the goods are concerned. It has been held in 1982 PTC 523 M/s Godfrey Philips India Ltd. Vs. M/s Girnar Food Beverages Pvt. Ltd. that the mark is highly descriptive and not adapted to distinguish the goods of the Registered Proprietor in this case.

The Registered trade mark MANJAL as indicating the goods since it has very direct and close resemblance to the character and quality of the goods thus, the mark contains laudatory apathetic and it is not adapted to distinguish the goods and therefore, even the long user cannot help the registration within the meaning of Section 9(1)(a) of the Act. The mark applied for is inherently incapable of distinguishing the goods within the provisions of Section 9(1)(a) of the Act also. As a result of which no particular proprietor can claim an exclusive right to use them as a trade mark since these words are considered common to the particular trade or publici juris. Therefore, the question of acquiring distinctiveness does not arise, hence, the trade mark MANJAL is inherently incapable of distinguish the goods within the meaning of Section 9(1)(a) and extensive use and huge advertisement cannot make the said trade mark registrable.

"As pointed out that the word MANJAL cannot be considered suitable for distinguishing the goods of one trade from those of another, if it is apt to describe the goods of "A", it is also apt to describe the goods of "B". A common

word having reference to the character or quality of the goods in connection with which it is used, and having no reference to anything else cannot be an apt, or appropriate instrument for distinguishing the goods of one trader from those of another. If any authority is required for this proposition it may be found in Standard Ideal Co. Vs. Standard Sanitary Mfg. Co. (1910) 27 RPC 789 (P.C.) at P. 796) it was held by the Judicial Committee of the P.C. that the word "Standard", though registered was not a valid trade mark; and that the word had not been proved to have acquired a secondary signification by the Plaintiff Co. and that the trade designation adopted by the Defendant Co. was not calculated to deceive or to lead the customers to believe that in buying Defendant Co's goods they were buying goods of the Plaintiff Co. and that the charge of passing off was established. The appeal was allowed and the action dismissed with costs.

As regards the extent of distinctiveness acquired by virtue of user or of the other also cannot be taken into consideration.

It was held in Liverpool Electric Cable Company Ltd. Application (1929) 46 RPC page 29 – the word LIVERPOOL for cables bricks for powder use as a boiler (water purifier), which was use in the form of bricks were held to be inherently not capable of distinguishing the goods. In SBC Ltd. Vs. Himalaya Drugs Company 1997 (PTC) page 540 – nobody can claim exclusive right to use any word or abbreviation or acronym which has become as publici juris in the trade of drugs, it is common practice to name of drug by the name of the organ or ailment which it treats or the main ingredients of the drugs such as acronym ailments or ingredients being publici juris or generic cannot be owned by any one for use as trade mark.

As pointed out that there are two rectifications filed against the said registration under Nos.259225 & 259345 and therefore the requisite changes in the proprietorship cannot be allowed because in the deed of Assignment dated 3.1.2005, in para 5.2 it has been stated as the mark MANJAL is not distinctive under Section 9 of the Trade Marks Act, 1999, the Assignor has agreed the same while entering into Agreement with Assignee as per Para 5.2 as stated below:

"The Assignor represents that the IPR sought to be assigned to the Assignee under this agreement are free from any infirmities in their respective registrations wherever already registered or in the applications or the process for registration, wherever the registration is yet to be received, on any ground, including but not limited to an argument that the terms Manjal, Pasupu, Arishina, Haldi, Holudh and Haldar" are descriptive of the products in which the Assignor currently carries on any Business or that they have a generic meaning associated with them in one or more Indian languages".

On the basis of the submissions made by the Applicants for Rectification, the mark Manjal is a generic name and cannot be registered under Section 9 of the Act.

Further, the Registrar of Trade Marks is the custodian of the Register and purity of the same and in the interests of the public at large he can rectify the Register to support this statement, I am relying on the judgement reported in (1909) 26 RPC 837 at 861 – Farewell L.J. in the perfection case, which reads as under:-

"The purity of the Register of Trade Marks is of much importance to trade in general quite apart from the merits or demerits of particular litigants, and it is the duty of the Tribunal to see that no word not 'adapted to distinguish' shall be put on the Register in the interest of other traders, wholesale and retail, and of the public. If this were not so, the large and wealthy firms with whom the smaller folk are unwilling to litigate, could be a system of log rolling... divide amongst themselves all the ordinary words of description and laudation in the English language".

Under these circumstances, the Registered Trade Mark No. 1109980 in Class-3 are hereby removed from the Register in the interest of public and purity of Register, which is wrongly remaining on the Register, under Section 57(4) of Trade Marks Act, 1999.

Signed and Sealed at Trade Marks Registry, Chennai, this the 21st day of January, 2011.



N. D. Kasturi
(N.D. KASTURI)
DEPUTY REGISTRAR OF TRADE MARKS