

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 06.09.2017

Pronounced on :14.09.2017

Coram

THE HONOURABLE Mr. JUSTICE M.VENUGOPAL
AND
THE HONOURABLE Mr. JUSTICE P.D.AUDIKESAVALU

W.P.No.940 of 2014 and
M.P.No.1 of 2014

M/s.N.Ranga Rao & Sons,
Rep. By Partner,
Vani Vilasa Road,
Mysore : 570 004.

.. Petitioner

Vs.

1.M/s.Amrutha Aromatics,
Represented by its Partners,
Mrs.T.V.Ratna, No.38, 9th Mani Road,
Banashakari 2nd State,
Bangalore – 560 070.

2.M/s.Betco Enterprises, सत्यमेव जयते
(Regd. Patnership Firm),
Rep. By its Partner Mr.B.Krishna Kumar,
72/2, 5th Main Road, Raghavendra Colony,
Charmrajpet, Bangalore – 560 018.

3.M/s.Mahendra Perfumery Works,
(Regd.) Patnership Firm),
Rep. By its Partner Mr.B.Krishna Kumar,
72/2, 5th Main Road,
Raghavendra Colony,
Chamrajpet, Bangalore – 560 018.

4.M/s.Shalimar Agarbathi Company,
Shalimar House PB No.2114,
32& 33, 3rd Cross Sriramapuram,
Bangalore – 560 021.

5.Intellectual Property Appellate Board,
Guna Complex Annexe-I, 2nd Floor,
443, Anna Salai Teynampet,
Chennai : 600 018.

6.The Registrar of Trade Marks,
The Trade Marks Registry,
IPR Building, GST Road,
Guindy, Chennai : 600 032.

..Respondents

Prayer: Writ Petition filed under Article 226 of the Constitution of India praying for issuance of Writ of Certiorarified Mandamus, calling for the records of the Hon'ble Intellectual Property Appellate Board dated 3rd June 2013 passed in common order (No.113 and 114 of 2013) in OA/33-35/2009/TM/CH and in OA/70-82/2008/TM/CH on the file of the 5th Respondent herein and quash the same and further direct the 6th Respondent herein to proceed with the registration of the impugned Applications vide Nos.540605, 540606, 540607, 544494, 540603, 540605, 540606, 540608, 540598, 540602, 540600, 540599, 540601, 540604, 540607, 540609, 544494, 540608, 540607, 540606, 540605, 540604, 540603, 540609, 544494, 540598, 540599, 540600, 540601 and 540602 in class 03 for the trademarks "Three in one".

For Petitioner : Mr.Rajesh Ramanathan
For M/s.TMT Law Practice

For 1st Respondent : Served – No appearance

For Respondents 2 & 3 : Mr.R.Sathish Kumar

For 4th Respondent : Mr.R.Sathish Kumar
For M/s.Sumitha Vibhu

For Respondents 5 & 6 : Mr.T.V.Krishnamachari

ORDER**M.VENUGOPAL, J.**

The Petitioner has filed the present Writ Petition seeking for issuance of direction in calling for the records pertaining to the impugned common order (No.113 and 114 of 2013) dated 03.06.2013 in OA/33-35/2009/TM/CH and in OA/70-82/2008/TM/CH passed by the 5th Respondent and to quash the same. Further, the Petitioner has sought for passing of an order by this Court in directing the 6th Respondent/Registrar of Trade Marks, Chennai to proceed with the registration of the impugned Application No.540605 and other 29 applications [mentioned in the Writ Petition] in class 03 for the trademarks "THREE IN ONE".

2.Resume of Germane Writ Facts:

(i)The Petitioner is engaged in the business of manufacturing, marketing incense sticks (Agarbathi) and dhoop sticks for more than 20 years. In the course of business, it had honestly conceived and adopted the trademark 'Cycle Brand' for their products mentioned ever since their inception in the early 1950's. Also, the Petitioner have garnered immense reputation built brick by brick by their Forefathers.

(ii)The Petitioner's products are available all over India and abroad and as such, it had attained international reputation. The trade mark of 'Cycle Brand' of the Petitioner is one of the most widely recognised Trademarks in the field of Agarbathies and Dhoop sticks.

(iii)The Petitioner had honestly conceived and adopted the trademark "THREE IN ONE" and started using the same from 03.07.1981. Because of their continuous and extensive use of the trademarks 'Cycle Brand' and "THREE IN ONE" in all their products, they are exclusively associated with the Petitioner alone and no one else. Indeed, the Petitioner had applied for and registered more than 100 trademarks including 'Cycle Brand' with the device of Cycle, and 'Cycle Brand Three in One' in India and abroad. The aforesaid trademarks 'Cycle Brand' and 'Cycle Brand Three in One' were registered as an artistic work under the Copyright Act.

(iv)A substantial reputation and a valuable goodwill had accrued to the Petitioner and the Trademark has become extremely popular in the markets in India and abroad. Moreover, the consumers identify the trademark "THREE IN ONE" with the Petitioner and not with others.

(v)The Petitioner had applied for trademark "THREE IN ONE" as a Label Mark and secured Registration bearing No.426521 in respect of Agarbathis, after due advertisement in the Trademarks Journal No.971 dated 16.11.1989. The said trademark was renewed from time to time and the same is valid.

(vi)The Petitioner had applied for the impugned trademark "THREE IN ONE" per se in the following undermentioned languages:

- 1.No.540598 in Hindi
- 2.No.540599 in Assamese
- 3.No.540600 in Kannada
- 4.No.540601 in Tamil
- 5.No.540602 in Bengali
- 6.No.540603 in Urdu
- 7.No.540604 in Punjabi
- 8.No.540605 in Telugu
- 9.No.540606 in Malayalam
- 10.NO.540607 in Marathi
- 11.No.540608 in Oriya
- 12.No.540609 in Gujarathi and

13.No.544494 in English

claiming user from 01.02.1991. The Respondents 1 to 4 had opposed all the Applications and the 6th Respondent/Registrar of Trademarks, Chennai had dismissed all the Oppositions and allowed the Applications.

(vii) Being aggrieved against with the order passed by the 6th Respondent/Registrar of Trademarks, Chennai, the Respondents preferred Appeal before the 5th Respondent/Intellectual Property Appellate Board by taking a plea that the impugned mark is the descriptive of the goods in that the term 'THREE IN ONE' has been used by numerous traders in the Industry (including the Respondents) to indicate that there are three different flavours in one incense packet (Agarbathi) and that no solo trader ought to be given the monopoly over the aforesaid term.

(viii) Apart from that, the Respondents in their Appeal had also averred that in an erstwhile Application for Rectification filed by the 4th Respondent/ M/s. Shalimar Agarbathies before the 5th Respondent/Appellate Board had admitted that the Petitioner's trademark is 'Cycle Brand Three in One' and not "THREE IN ONE"

per se. In reality, the said admission was also referred to and accepted by the 5th Respondent/ Appellate Board in its order dated 03.06.2013 in T.R.A.No.23/ 2003/TM/CH (Order No.60 of 2004) **[between Shalimar Agarbatti Company V. N.Ranga Rao & Sons]** reported in **(2004) 29 PTC 247 (IPAB)**. In the said decision, it was held and observed that 'the registration is clearly for Cycle Brand Three in One which is being used since two decades without asserting any exclusive rights in respect of the words "THREE IN ONE" and that several persons using "THREE IN ONE, TWO IN ONE, FOUR IN ONE" are not facing any legal action or threat from the 1st Respondent (Writ Petitioner)'. In short, the 5th Respondent/Appellate Board had dismissed the said Rectification Application on the basis that the Applicant therein was not an "Aggrieved Person".

(ix)The Respondents preferred Appeals before the 5th Respondent/Appellate Board and the Board ultimately allowed the Appeals and quashed the order of the Learned Registrar in dismissing all the oppositions through its Common Order No.113 and 114/2013 dated 03.06.2013.

(x) Being dissatisfied with the order of the 5th Respondent/Appellate Board, the Petitioner have preferred the present Writ Petition before this Court.

The Petitioner's Pleas:

3. The Learned Counsel for the Petitioner submits that the impugned order in OA/33-35/2009/TM/CH and OA/70-82/2008/TM/CH dated 03.06.2013 passed by the 5th Respondent/Appellate Board is palpably wrong and the same being contrary to the facts and circumstances of the case and therefore, the same is liable to be quashed in the eye of Law.

4. The Learned Counsel for the Petitioner takes a plea that the 5th Respondent/Appellate Board had interpreted the impugned trademark "THREE IN ONE" as a descriptive one *per se*. In this connection, it is represented on behalf of the Petitioner that the 5th Respondent/Appellate Board had completely ignore a vital fact that the so called admission made by the Writ Petitioner before the Board in its earlier order was on a different context altogether and has nothing to do with the impugned trademark.

5.Proceeding further, it is projected on the side of the Petitioner that before the 5th Respondent/Appellate Board on earlier occasion, it only asserted that it had not threatened or initiated any legal action any opponent/party for the use of the trademark "THREE IN ONE" from inception. Furthermore, it is also projected on the side of the Petitioner that on prior occasion before the 5th Respondent/Appellate Board, the issue was in regard to the registration of the composite label mark 'Cycle Brand Three In One' along with the unique colour combination, get up and trading style bearing Registration No.426521. Apart from that, the term "THREE IN ONE" was advertised in the Trademark Journal through its Trademark Application wherein the said term "THREE IN ONE" was ordered to be "Disclaimed". But, by means of corrigendum, the said mark "THREE IN ONE" was ordered to be removed from being disclaimed and therefore had become a distinctive trademark.

6.The Learned Counsel for the Petitioner strenuously contends that the Petitioner had asserted rights in the registered trademark label 'Cycle Brand Three In One' (a Composite Label Mark inclusive of the colour combination) and the observation made by the 5th Respondent/Appellate Board about the pending Application and the

Opposition unerringly point out that the representation in earlier case was restricted to the registered trademark and that the same could not be applied to the impugned Applications.

7. Advancing his arguments, the Learned Counsel for the Petitioner submits that the 5th Respondent/Appellate Board had wrongly held that the impugned mark to be descriptive of the Goods. In this connection, the Learned Counsel for the Petitioner projects an argument that the 5th Respondent/Appellate Board had not taken into consideration that it is a Writ Petitioner who firstly conceived and adopted the trademark during the year 1982.

8. Added further, the Learned Counsel for the Petitioner emphatically points out that the Petitioner had not given up its rights over the impugned trademark and a mere statement that they had not asserted any rights in the past would not act as a deterrent in claiming statutory rights over the said Trademark.

9. The Learned Counsel for the Petitioner contends that the 5th Respondent/Board had failed to take into consideration of its observation in the earlier order, at paragraph 2, whereby and

whereunder, the Petitioner had applied for registration of the trademark 'THREE IN ONE' (vide No.544494) and the same is pending Opposition. Furthermore, it is the contention of the Petitioner that the 5th Respondent/Board should have taken note of the pending Application along with the observation that the Petitioner are not asserting any right over the impugned trademark "THREE IN ONE".

10.The Learned Counsel for the Petitioner submits that the 5th Respondent/Appellate Board should have held that as on date of the Application, the Petitioner are the Proprietors of the impugned trademark and therefore, they are entitled to get the mark registered in their name.

11.The Learned Counsel for the Petitioner refers to Section 9 of the Trade and Merchandise Marks Act, 1958 (Old Act) which deals with '*Requisites for registration in Parts A and B of the register*'. Also, he adverts to Section 11 (e) of the Act, 1958 under the caption '*Prohibition of registration of certain marks*' which runs as under:

"(e) which would otherwise be

***disentitled to protection in a court,
shall not be registered as a trade
mark."***

12. Furthermore, the Learned Counsel for the Petitioner points out that Section 12(2) and (3) of the Act, 1958 pertains to 'Prohibition of registration of identical or deceptively similar trade marks', which read as under:

"(2) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or nearly resemble each other in respect of the same goods or description of goods, the Registrar may defer the acceptance of the application or applications bearing a later date until after the determination of the proceedings in respect of the earlier application, and may dispose of such application or applications in the light of the evidence tendered in relation to earlier application and the oppositions thereto, if any.

(3) In case of honest concurrent

use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of trade marks which are identical or nearly resemble each other (whether any such trade mark is already registered or not) in respect of the same goods or description of goods, subject to such conditions and limitations, if any, as the Registrar may think fit to impose."

13. Besides these, the Learned Counsel for the Petitioner refers to Section 15 of the Act, 1958, concerning 'Registration of parts of trade marks and of trade marks as a series.'

14. The Learned Counsel for the Petitioner contends that the 5th Respondent/Board while passing the impugned order in OA/33-35/2009/TM/CH and in OA/70-82/2008/TM/CH dated 03.06.2013 had not provided an opportunity to the Petitioner to put forward its case and instead had, among other things, proceeded to observe in the impugned order that '*... After practically conceding in the other*

case, before the Board on the earlier occasion held that the respondent had no intention to use the words "Three in One" the application for registration of trademark of the words "Three in One" per se in English and other languages is a sheer abuse.'

15. Petitioner's Citations:

15.1. The Learned Counsel for the Petitioner placed reliance on the Division Bench Judgment in ***Bharatbhai Khushalbhai Patel Trading as Harikrishna Industries V. Delux Bearing Limited and others, 2013 SCC OnLine Guj. 503*** wherein, on the facts of the case, it is held that ***'the Petitioner should have been given an opportunity to prove that the Petitioner was having a distinctive character as mark of the petitioner was capable to distinguish its goods of water pump etc. falling under Ch.12 of the Act from those of any other person as there was no use of trademark of other person etc.'***

15.2. The Learned Counsel for the Petitioner cites the decision of the Hon'ble Supreme Court in ***Godfrey Philips India Limited V. Girnar Food & Beverages (P) Ltd., (2004) 5 Supreme Court Cases 257*** wherein it is held that ***'A descriptive trade***

mark is entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or being from a particular source.'

15.3. The Learned Counsel for the Petitioner brings it to the notice of this Court in ***Shalimar Agarbatti Company V. N.Ranga Rao & Sons reported in (2004) 29 PTC 247 (IPAB) : 2004 SCC OnLine IPAB 2 wherein at paragraph 14 & 15***, it is observed and held as under:

"14. 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 trade 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 along with the device and the mark. When that be so, there is absolutely no merit in the present application.

15. 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."

Contentions of Respondents 2 to 4:

16. Conversely, it is the submission of the Learned Counsel for the Respondents 2 to 4 that the Petitioner cannot have a mark for "THREE IN ONE", there are about 250 to 300 persons are

manufacturing "THREE IN ONE" Agarbathies (incense sticks) and in short, the Petitioner cannot claim 'Exclusive Right' in respect of the words "THREE IN ONE".

17. According to the Learned Counsel for the Respondents 2 to 4, the Petitioner/1st Respondent never used the words/mark 'THREE IN ONE' independently and when the 4th Respondent viz., M/s. Shalimar Agarbathi Company on an earlier occasion sought for removing the mark belonging to the Petitioner viz., "THREE IN ONE", it took a plea that it was using the said trademark for nearly twenty years, without asserting any exclusive/ solo right in respect of the words "THREE IN ONE" and in the said case reported in **(2004) 29 PTC 247 (IPAB)** wherein it was held that the 4th Respondent/M/s. Shalimar Agarbatti Company could not be considered to be an aggrieved person at this stage with its rights has not been affected so far. Moreover, after the publication of the corrigenda in regard to the withdrawal of Disclaimer in respect of the words "THREE IN ONE", the 4th Respondent/M/s. Shalimar Agarbatti Company filed a Review Petition before the Registrar of Trade Marks and the same came to be dismissed. In that context, the 5th Respondent/Appellate Board opined that having allowed the

order to stand which became final, it was not open to the 4th Respondent/M/s.Shalimar Agarbatti Company to file a separate Application for Rectification and ultimately, the Application was held to be not maintainable and the same was dismissed.

18.The Learned Counsel for the Respondents 2 to 4 refers to the observation of the 5th Respondent/Appellate Board, in the impugned order dated 03.06.2013, wherein at paragraph 7, it is, inter alia, mentioned as under:

"Therefore, the respondent had clearly convinced the Board earlier that this apprehension relating to use of the words "Three in One" was misplaced, since they had no intention of ascertaining exclusive right to those words. They had also submitted before the Board that no one else, except the appellant, who was Shalimar had objected to the registration. Now, the same appellant has filed O.A.Nos.70 to 82 of 2009 and three other parties, who are using the words "Three in One" have filed O.a.Nos.33 to 35 of 2009. It is, therefore, clear that one

cannot give the respondent exclusive right to use the words "Three in One" which are purely descriptive of agarbathis' carton containing agarbathis of three different fragrances. It would also amount to allowing the respondent to abuse the process of law. After practically conceding in the other case, before the Board on the earlier occasion held that the respondent had no intention to use the words "Three in One" the application for registration of trademark of the words "Three in One" per se in English and other languages is a sheer abuse."

and takes a plea that now it is not open to the Writ Petitioner/1st Respondent to take a contra stand which is impermissible in law, because of the reason that one cannot Approbate and Reprobate.

19.The Learned Counsel for the Respondents 2 to 4 by pointing out to page No.541 of the typed set of papers relating to the Invoice dated 12.01.2008 of the Writ Petitioner (N.Ranga Rao & Sons) [Order No.997 dated 12.01.2008] wherein it is mentioned as

under:

Sl.No.	Code	DESCRIPTION OF GOODS	QUANTITY	Rate PER	AMOUNT
1	BNSB	BANSURI INCENCE STICKS- BIG	20 Unt O Pkt	87.99 Unt of 12 Pkt	1,759.80
2	LIAA	LIA ASSORTED INCENSE STICKS- CHANDANAM, JAS, SAMTRUPTI PRIME ROSE, SEA SHORE, SPICE WORLD, RAINBOW, NATUR'S GIFT	20 Unt O Pkt	137.49 Unt of 12 Pkt	2,749.80
3	TINR	THREE IN ONE INCENSE STICKS REGULAR - LILY FANCY, INTIMATE	80 Unt O Pkt	82.88 Unt of 12 Pkt	6,630.40

Product Value 11,140.00
TRADE DISCOUNT (-)3,772% (-) 420.20

CASH DISCOUNT (-) 2% 10,719.80
(-)214.40

C.S.T.4% 4% 10,505.40
ROUND OFF 420.22
0.38

10,926.00

Rs. Ten Thousand Nine Hundred Six Only
Balance Before this Invoice Transaction in
your account Rs. 18 Dr

FREE 2 DOZ TINR, 10 PKT BNSB & 10 PKT LIAA

20.The Learned Counsel for the Respondents 2 to 4 submits that in the Invoice/Certificate of Vijay Television Limited, Chennai 34, the Cycle Brand was made mention of and in page No.604 of the typed set of papers of the Petitioner, the 1st Respondent's credit Bill mentions "3-in-1".

21.The Learned Counsel for the Respondents 2 to 4 refers to the typed set of papers of the Petitioner at page No.694, it is mentioned as 'BETCO Enterprises, Bangalore – 560 018 (India)' wherein it was described as 'Rainbow 3 in 1 AGARBATHIES' (In English).

22.The Learned Counsel for the Respondents 2 to 4 refers to page 765 of the typed set of papers which relates to 'MOKSH AGARBATTI CO.', which speaks of "Four in One" incense sticks. Also, the Learned Counsel for the Respondents 2 to 4 refers to as a sample, the 'MONISHA's Red Rose incense sticks "3-in-1" [manufactured by Morn Agarbathi Works, Bangalore – 26] and contends that there are so many persons and other Petitioner are manufacturing the "Three-in-One" incense sticks and therefore, the

Petitioner cannot claim "Exclusivity" or "Monopoly" over the trademark 'THREE IN ONE'.

23.The pith and substance of the argument advanced on behalf of the Respondents 1 to 4 is that the Petitioner cannot assert [Three fragrances – 3 different products] a right in respect of the words "Three in One" which are descriptive in nature and also they cannot be a trademark.

24.In effect, it is the core contention of the Respondents 2 to 4 that numerous persons are using the "THREE IN ONE" agarbathies. As such, the Writ Petitioner cannot claim "Exclusivity" over the said words.

Discussion:

25.It is to be borne in mind that the well enunciated principle of law in 'Trademark' is that there can be only one mark, one source and one proprietor and not two origins. An individual can carry on his business using a brand name within the meaning of provision of Section 2(1)(k) of Act, 1958 which need not be compulsorily registered. A person is to establish that the salient features of his trademark were copied. Further, as per Section

2(1)(m) of the Trade Marks Act, 1999, a 'Trader' who adopts a distinctive mark within its meaning is entitled to direct protection in respect of an article, which has presumed a vendible character and launched in the market.

26.It is to be remembered that the Petitioner's Trademark "THREE IN ONE" in the year 1997, in various languages was advertised, without any association with any other mark and staked a claim from 3rd July 1987. In fact, a month later, Trademark No.544494 was advertised in English language, in association with its former earlier mark 426521. The 1st Respondent as Appellant before the Appellate Board questioned a registration of the mark "THREE IN ONE" by raising pleas as per ingredients of the Trade and Merchandise Act, 1958.

27.It is to be pointed out that for registering in Part A, the trademark ought to contain atleast one of the salient features mentioned in clause (a) to (e) of sub-section (1) of Section 9 of the Trade and Merchandise Marks Act, 1958.

28.It cannot be gainsaid that in terms of sub-section (2) of

Section 9 of the Act, 1958, a name, signature or word, other than those coming under clause (a) to (d) is not to be registered in Part A except based on evidence of its distinctiveness. In short, the term 'Distinctive' in sub-section (2) of Section 9 of the Act, 1958 unerringly points out that the mark must be capable of proving its identity. Also that, 'special or particular' manner specified in clause (a) of Section 9(1) implies that the representation of the mark must be capable of exhibiting its novelty at the first sight.

29. It is to be noted that in regard to the registration of a trademark in Part B of the Register, it need not necessarily be distinctive. But, if it is 'capable of distinguishing the goods' of a trader from other goods, certainly, it can be entered into Part B. In regard to Section 11 of the Trade and Merchandise Marks Act, 1958 '*Prohibition of registration of certain marks*', one is to keep in mind that the burden of establishing that the mark does not come under any of the prohibitions specified in (a) to (e) of Section 11, is undoubtedly on an Applicant.

30. Coming to the aspect of '*Prohibition of Registration of identical or deceptively similar trade marks*' under Section 12 of the

Act, 1958, it is relevantly pointed out that to decide as to whether one mark is similar to another, the marks shall be compared in entirety and not in piecemeal or part. Besides this, all surrounding circumstances are to be taken into account at the time of comparing the two marks (inclusive of what would be likely to happen if they are used in an ordinary/general fashion. Moreover, the stand of all 'Honest' and concurrent user mentioned in Section 12(3) of the Act, 1958 cannot be a justifiable defence in case of violation of 'Copy Right'.

Plea of Estoppel:

31.It is to be borne in mind that 'Estoppel' pertains to 'questions of Fact' and not 'questions of Right'. It cannot be disputed that there is no general rule of Law that a person is estopped from asserting a right which he had said that he would not assert. However, it may be that a man who agrees not to assert a right may in certain circumstances be bound by his agreement, as per decision ***Nathoo and another V. Hori Lal, AIR (32) 1945 Allahabad 196.***

32.In Law, the aspect of 'Estoppel' is a Rule of 'Equity', In

fact, in India, 'Estoppels' are more often than described 'Rules of Evidence'. Moreover, 'Estoppel' is a complex legal notion involving the statement to be acted upon, action on the faith of it, and resulting detriment to the actor as per decision ***Canada and Dominion Sugar Co. Ltd., V. Canadian National (West Indies) Steamships, Ltd., AIR (34) 1947 Privy Council 40.***

33.Glance of Citations:

(i) In this connection, this Court worth recalls and recollects the decision of the Hon'ble Supreme Court in ***Delhi Cloth & General Mills Ltd., V. Union of India, AIR 1987 Supreme Court 2414, at special page 2419, at paragraph 18,*** it is observed as follows:

"18. Here the Railways Rates Tribunal apparently, appears to have gone off the track. The doctrine of promissory estoppel has not been correctly understood by the Tribunal. It is true, that is the formative period, it was generally said that the doctrine of promissory estoppel cannot be invoked by the promise unless he has suffered 'detriment' or 'prejudice'. It was often

said simply, that the party asserting the estoppel must have been induced to act to his detriment. But this has now been explained in so many decisions all over. All that is now required is that the party asserting the estoppel must have acted upon the assurance given to him. Must have relied upon the representation made to him. It means, the party has changed or altered the position by relying on the assurance or the representation. The alteration of position by the party is the only indispensable requirement of the doctrine. It is not necessary to prove further any damage, detriment or prejudice to the party asserting the estoppel. The Court, however, would compel the opposite party to adhere to the representation acted upon or abstained from acting. The entire doctrine proceeds on the promise that it is reliance based and nothing more."

(ii) Further, in the aforesaid decision at page 2421, at paragraph 27, it is laid down as under:

"27. The last and final aspect of the matter to which attention should be drawn is that for the purpose of finding whether an estoppel arises in favour of the person acting on the representation, it is necessary to look into the whole of the representation made. It is also necessary to state that the representation must be clear and unambiguous and not tentative or uncertain. In this context we may usefully refer to the following passage from Halsbury's Laws of England, Halsbury's Laws of England 4th Edn. Vol. 16 p. 1071 para 1595.

"1595. Representation must be unambiguous To found an estoppel a representation must be clear and unambiguous, not necessarily susceptible of only one interpretation, but such as will reasonably be understood by the person to whom it is made in the sense contended for, and for this purpose the whole of the representation must be looked at.

This is merely an application of the old maxim applicable to all estoppels, that

they "must be certain to every intent...."

(iii) Apart from that, this Court points out the decision ***Mt.Gaura Dei V. Mohammad Yasin Ali Khan and others, AIR 1935 Oudh 121***, wherein it is laid down that ***'In order to found an estoppel, the representation must be in respect of an existing thing and must be clear and unambiguous.'***

(iv) Furthermore, in the decision ***Nagubai Ammal and others V. B.Shama Rao and others*** reported in ***AIR 1956 S.C. at page 593 at special page 601 & 602***, wherein at paragraph 23, it is, inter alia, observed as follows:

"23.But it is argued by Sri Krishnaswami Ayyangar that as the proceedings in O. S. No. 92 of 1938-39 are relied on as barring the plea that the decree and sale in O. S. No. 100 of 1919-20 are not collusive, not on the ground of resjudicata or estoppel but on the principle that a person cannot both approbate and reprobate, it is immaterial that the present appellants

were not parties thereto, and the decision in Verschures Creameries Ltd. v. Hull and Netherlands Steamship Company Ltd.(1), and in particular, the observations of Scrutton, L.J., at page 611 were quoted in support of this position. There, the facts were that an agent delivered goods to the customer contrary to the instructions of the principal, who thereafter filed a suit against the purchaser for price of goods and obtained a decree. Not having obtained satisfaction, the principal next filed a suit against the agent for damages on the ground of negligence and breach of duty. It was held that such an action was barred. The ground of the decision is that when on the same facts, a person has the right to claim one of two reliefs and with full knowledge he elects to claim one and obtains it, it is not open to him thereafter to go back on his election and claim the alternative relief. The principle was thus stated by Bankes, L. J.:

"Having elected to treat the delivery to him as an authorised delivery they

cannot treat the same act as a misdelivery. To do so would be to approbate and reprobate the same act".

The observations of Scrutton, L. J. on which the appellants rely are as follows:

"A plaintiff is not permitted to 'approbate and reprobate'. The phrase is apparently borrowed from the Scotch law, where it is used to express the principle embodied in our doctrine of election-namely, that no party can accept and reject the same instrument: *Ker v. Wauchope* (1819) 1 *Bligh* 1 (21) (E); *Douglas-Menzies v. Umphelby* 1908 AC 224 (232) (F). The doctrine of election is not however confined to instruments. A person cannot say at one time that a transaction is valid and thereby obtain some advantage, to which he could only be entitled on the footing that it is valid, and then turn round and say it is void for the purpose of securing some other advantage. That is to approbate and reprobate the transaction."

(v) That apart, in the decision ***Dawsons Bank Ltd., V. Nippon Menkwa Kabushihi Kaish (Japan Cotton Trading Co. Ltd.)***, AIR 1935 Privy Council 79, it is held as under:

"A statement to ground an estoppel must be clear and unambiguous. Further in order that a representation

may constitute an estoppel, the representation must be of an existing fact."

34.Glimpse of Decisions:

(i) At this stage, this Court aptly points out the decision ***Mir Hussain Ali Khan V. State of Andhra Pradesh & Others, AIR 2013 Andhra Pradesh 187 at special page 190 wherein, at paragraph 11,*** it is observed and held as under:

"11.With regard to the provisions of Sections 41 to 43 and 115 of the Indian Evidence Act, 1872, I am equally at a loss to know as to how these provisions come to the rescue of the petitioner. Making an elaborate discussion of these provisions, a Division Bench of this Court in Ahmed Ali Khan Bahadur (9 supra) held that estoppel by Judgment traceable to Section 115 of the Indian Evidence Act, 1872, applies to the parties to the Judgment and not to a third party unless the Judgment is in rem. It is an admitted fact that the petitioner is a party to the Judgments in the suit and the appeal as discussed above. Hence,

being a party to the said Judgment, respondent No.6 is estopped from pleading that the said Judgment does not bind it. The said Judgment being a Judgment in personam binds both the parties to the suit including respondent No.6. Respondent No.4-Tahsildar, Malkajgiri Mandal, in his counter-affidavit, inter alia stated as under:

"I respectfully submit that as per Khasra Pahani for the year 1954-55, the land in Survey No.373/1 and 373/3 admeasuring Acs.5-13 guntas and Ac.1-15 guntas respectively stands Patta in the name of Sri Nawab Hussain Nawab Jung.. In the Sesala Pahani for the year 1955-56 to 1957-58, the name of Smt.Mahmud Uinnisa Begum is recorded as Pattedar for the same lands and same entries continued in the pahani for the year 1958-59 in the pahani for the year 1970-71 the names of Meer Ali Khan, Meer Waheed Ali Khan and Meer Hussain Ali Khan are recorded as Pattedars against the said lands by

deleting the name of Syed Askari Hussain Jafri and Smt.Khaja Begum Jafari as per the Court Decree and Judgment in OS.No.11 of 1971 in File No.A1/6831/71. As per the pahani for the year 2006- 2007, the names of Meer Asad Ali Khan, Meer Mohammed Ali Khan and Meer Hussain Ali Khan and recorded as Pattedars. On verification of Notification No.6A, Dated 09-02-1989, furnished by the Chief Executive Officer, Wakf Board, it is evident that the Survey No.373 of Malkajgiri Village is not notified as a Wakf Land."

(ii) It is useful to cite the decision of the Hon'ble Supreme Court in **National Bell Co. V. Metal Goods Mfg. Co.(P) Ltd., and another** reported in **AIR 1971 Supreme Court 898 at special page 899**, whereby and whereunder, it is laid down as follows:

"While Clause (b) of Section 32 of the Trade and Merchandise Marks Act (1958) relates to facts existing at the time of and after registration Clause (c) relates to facts which are post-

registration facts, existing at the date of the commencement of rectification proceedings. If the trade mark at such date is not distinctive in relation to the goods of the registered proprietor, the rule as to conclusiveness enunciated in Section 32 would not apply. Therefore, a person can apply for cancellation on the ground that the trade mark in question was not at the date of the commencement of the rectification proceedings distinctive in the sense of Section 9(3). The burden of proof, however, in such a case is on the applicant applying under Section 56."

"The principle underlying Cl(c) of Section 32 of the Trade and Merchandise Marks Act (1958) is that the property in a trade mark exists so long as it continues to be distinctive of the goods of the registered proprietor in the eyes of the public or a section of the public. If the proprietor is not in a position to use the mark to distinguish abandoned it or the mark has become so common in the market that it has ceased to connect him with his goods,

there remains no justification in retaining it on the register. The distinctiveness of the trade mark in relation to the goods of a registered proprietor of such a trade mark may be lost in a variety of ways, e.g., by the goods not being capable of being distinguished as the goods of such a proprietor or by extensive piracy so that the marks become publici juris."

(iii) Furthermore, this Court relevantly points out the decision of the Hon'ble Supreme Court in ***Cadila Health Care Limited V. Cadila Pharmaceuticals Ltd., (2001) 5 Supreme Court Cases 73 at special 93***, wherein at paragraph 31, it is observed as follows:

"31.Trade mark is essentially adopted to advertise ones product and to make it known to the purchaser. It attempts to portray the nature and, if possible, the quality of the product and over a period of time the mark may become popular. It is usually at that stage that other people are tempted to pass off their products as that of the

original owner of the mark. That is why it is said that in a passing-off action, the plaintiffs right is

"against the conduct of the defendant which leads to or is intended or calculated to lead to deception. Passing off is said to be a species of unfair trade competition or of actionable unfair trading by which one person, through deception, attempts to obtain an economic benefit of the reputation which other has established for himself in a particular trade or business. The action is regarded as an action for deceit." [See Wander Ltd. Vs. Antox India (P) Ltd., 1990 Supp. SCC 727, SCC p.734, para 16].

(iv) Moreover, in the decision of the Hon'ble Supreme Court in **Skyline Education Institute (Pvt.) Ltd. V. S.L.Vaswani, AIR 2010 Supreme Court 3221, at special page 3229**, wherein it is held and observed as follows:

"18. In our opinion, the findings recorded by the learned Single Judge and Division Bench on the crucial factors like prima facie case, balance

of convenience and equity are based on a correct and balanced consideration of various facets of the case and it is not possible to find any fault with the conclusions recorded by them that it is not a fit case for restraining the respondents from using the word 'Skyline' in the name of the institute established by them. It has not been disputed on behalf of the appellant that the word 'Skyline' is being used as trade name by various companies / organizations / business concerns and also for describing different types of institute/ institutions. The voluminous record produced by the respondents before this Court shows that in India as many as 117 companies including computer and software companies and institutions are operating by using word 'Skyline' as part of their name/ nomenclature. In United States of America, at least 10 educational / training institutions are operating with different names using 'Skyline' as the first word. In United Kingdom also two

such institutions are operating. In view of this, it is not possible to agree with the learned counsel for the appellant that the Skyline is not a generic word but is a specific word and his client has right to use that word to the exclusion of others."

(v) Apart from that, in the decision ***Sumat Prasad Jain V. Sheojanan Prasad, AIR 1972 Supreme Court 2488***, it is held as follows:

"The concept of Trade Mark is distinct from that of a property mark., A Trade Mark means a mark used in relation to goods for the purpose of indicating a connection in the course of trade between the goods and some person having the right as proprietor to use that mark. The function of a Trade Mark is to give an indication to the purchaser as to the manufacture or quality of the goods, to give an indication to his eye of the trade source from which the goods come or the trade hands through which they passed on their way to the

***market in In re, Powell's Trade Mark
((1893) 10 R.P.C. 200)***

***On the other hand, a property
mark, 1893 defined by S.479 of the
Penal Code, means a mark used for
denoting that a moveable property
belong to a particular person."***

Conclusion:

35. In the light of qualitative and quantitative discussions, this Court, keeping in mind a primordial fact that in an earlier Rectification Application filed by the 4th Respondent (M/s. Shalimar Agarbathi Company) had tacitly admitted its 'Trademark' as "Cycle Brand Three in One" and not "THREE IN ONE" per se which was accepted by the 5th Respondent/Appellate Board. Also that, numerous persons are using "THREE IN ONE" "FOUR IN ONE" and "TWO IN ONE" to show that no one trader ought to be given any "Exclusivity/Monopoly" over the words/term "THREE IN ONE", comes to an inescapable and irresistible conclusion that because of the Petitioner's earlier conduct before the Appellate Board that it had no intention to employ the words "THREE IN ONE" and the same being purely descriptive of 'Incense Sticks' of three different

fragrances that the Petitioner cannot claim any 'Exclusivity' or 'Monopoly' right over the words "THREE IN ONE". Looking at from any angle, the conclusions arrived at by the 5th Respondent/Appellate Board to the effect that *'the Petitioner cannot be allowed to retract the assurance that would put a premium on dishonesty and that the words "THREE IN ONE" per se cannot be granted registration'*, do not suffer from any material irregularities or patent illegalities in the eye of Law. Consequently, the Writ Petition fails.

36. In fine, the Writ Petition is dismissed. The order of the 5th Respondent/Appellate Board is affirmed by this Court for the reasons assigned in this Writ Petition. No costs. Consequently, connected Miscellaneous Petition is also dismissed.

(M.V., J.) (P.D.A., J.)

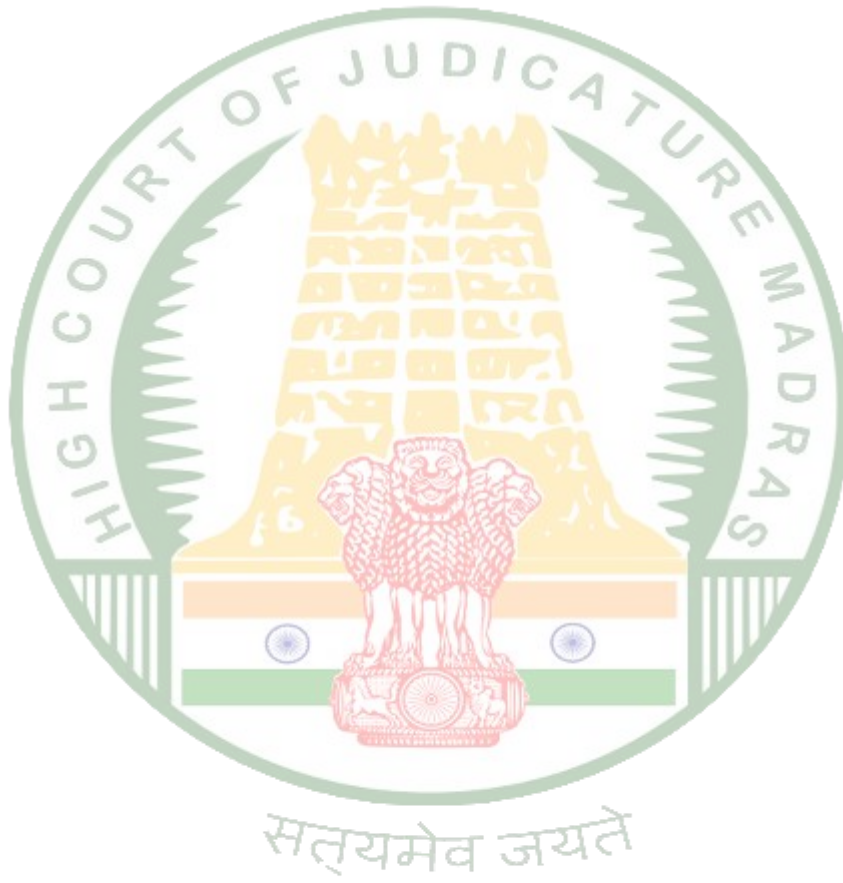
14.09.2017

Speaking Order

Index :Yes

Internet :Yes

Sgl



WEB COPY

To

- 1.M/s.Amrutha Aromatics,
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- 5.Intellectual Property Appellate Board,
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- 6.The Registrar of Trade Marks,
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