



IPAB Intellectual Property Appellate Board

Delhi Registry –Cum-Bench

G-62 to 67 & 196 to 204, August Kranti Bhawan, Bhikaji Cama Place,
New Delhi – 110 066

Tele No: 011-26180613/14 Email: delhiregistryipab@gmail.com Website: <http://www.ipab.gov.in>

MP.NO.143/2020

IN

ORA/171/2020/TM/DEL

FRIDAY, THIS THE 4TH DAY OF DECEMBER, 2020

**HON'BLE SHRI JUSTICE MANMOHAN SINGH
HON'BLE MS.LAKSHMIDEVI SOMANATH
HON'BLE MR. MAKYAM VIJAY KUMAR**

**CHAIRMAN
TECHNICAL MEMBER (TRADEMARKS)
TECHNICAL MEMBER (TRADEMARKS)**

SASSOON FAB INTERNATIONAL PVT. LTD.
NO.2, UPPER GROUND FLOOR,
GUJRANWALA PART-2, DELHI -110009

: PETITIONER

(Represented by Mr. Neeraj Grover)

Versus

SANJAY GARG
804-A, MANJUSHA BUILDING,
57 NEHRU PLACE,
NEW DELHI-110019

REGISTRAR OF TRADE MARKS
BAUDHIK Sampada Bhavan
PLOT NO. 32, SECTOR-14,
DWARKA,
NEW DELHI-110078

: RESPONDENTS

(Represented by None)

ORDER

HON'BLE SHRI JUSTICE MANMOHAN SINGH, CHAIRMAN

1. The Rectification Application is filed under Section 57 of Trademark Act, 1999 for Removal of the "N95" label under Reg. No. 4487559 in class 10 registered in favor of Respondent No.1. Along with main Rectification Application the present Miscellaneous Petition vide M.P.No.143 of 2020 for Stay of operation of Registration of Respondent No.1 for the above impugned mark pending disposal for the main Rectification Application has been filed.

2. In the main petition, two months' time is granted to the Respondent No. 1 to file the counter statement with an advance copy to the learned counsel for the applicant who may file the response within one month thereafter and main petition is listed for hearing

on 05/03/2021.

3. The present Miscellaneous Petition has been filed seeking stay of operation of Registration until the Rectification Application finally decided. Learned Counsel for the Applicant Mr. Neeraj Grover has submitted that he has served copies of the Present petition along with main Rectification to the Respondent No.1 and his counsels and made his submissions.

4. As counsel for the Petitioner is pressing the interim orders, we propose to consider the said request. There is no representation on behalf of Respondent No 1 despite of service. We are of the view that given the present urgency, the said request is accepted. The order is passed by taking prima facie view which shall have no bearing when the matter will be decided on merit after filing of the counter statement by the Respondents and completion of pleadings in the matter.

5. It is a matter of fact that the mark applied is based on proposed to be used. The mark prime facie offends under Section 9 of the Act as it is descriptive of the goods.

6. N 95 is prima facie generic term that is used to provide the quality of the masks hence it is hit by Section 9 of the Act. The history of the concept of N 95 which is available in public domain is reproduced here under:

The Concept of face masks is very old. People have been using different kind of masks throughout history. One of the masks that people has been using for decades is the N95 mask. The Covid-19 pandemic has led to an high increase in the demand for the N95 Mask. It's ability of easily covering the face and reducing particles from entering the mouth has made this mask extremely suitable for fighting the virus.

The U.S based company 3M developed this N95 mask in 1972. Now, let's look at the story on how face masks first began in short.

The longer you wear an N95 respirator, the more efficient it becomes at filtering out particles. More particles just help filter more particles. But breathing becomes more difficult over time as those gaping holes between the fibers get clogged up with particles, which is why an N95 respirator can't be worn for more than about eight hours at a time in a very dusty environment. It doesn't stop filtering; it just prevents you from breathing comfortably.

How the Model of the Mask N95 was developed?

Sara Little Turnbull, who spent a lot of time visiting sick family members in hospitals. She lost three loved ones in quick succession. And out of that grief came a new invention: A "bubble" surgical mask that 3M released in 1961.

In 1958, she gave a presentation titled Why?—in front of a room of only men—where she presented her many ideas. Her pitch of a new product application using this new material gauged the interest of 3M. Turnbull was given the green light to create a modelled bra cup.

She thought about her bra design, and how a cupped facial covering like that could be better for medical professionals — reiterating the foundations she had laid out in her article years before: corporations need to be designing products for end users (doctors and nurses), not distributors (the hospital). 3M liked her idea and in 1961 its first lightweight medical mask based on Turnbull's molded bra cup design was released.

By the 1970s, the Bureau of Mines and the National Institute for Occupational Safety and Health teamed up on creating the first criteria for what they called "single use respirators." The first single-use N95 "dust" respirator as we know it was developed by 3M, and approved on May 25, 1972 which we still use today.

The N95 respirator of course isn't perfect. It can get uncomfortable when worn for long hours, and sometimes become difficult to breathe in. But while some [scientists have been working to improve](#) the respirator, Turnbull's prototype lives on. What started as an idea to offer women extra comfort during their day-to-day activities prospered into a lifesaving device that still holds up almost five decades later.

Initially it was intended to be used for industrial work. But after the spread of tuberculosis in the 1990s, to stop airborne spread, N95 standards were updated for the healthcare settings, and doctors began wearing them when helping tuberculosis patients. It is recommended for serious communicable diseases such as tuberculosis, SARS, and influenza. The "N" stands for "Not resistant to oil," and it has the capability of filtering out 95% of airborne particles.

At the present day (May 2020), due to the corona pandemic, everyone starting from doctors to common citizens are using this mask to reduce the chances of getting infected.

7. The Petitioner submitted that it is a company incorporated under the Indian Companies Act, 1913, incorporated in the year 2004 and has been engaged in the business of manufacture and sale of a variety of goods including towels, bath linen, bed sheets, carpets, etc. ever since then under its well-known and well established trade mark SASSOON which was earlier adopted by Mr. Surinder Prakash Gupta, earlier in 1998 for the said business under his proprietorship firm M/s Prakash & Sons.

8. The Petitioner submitted that in the month of May, 2020, it expanded its business and started using its well-known trade mark SASSOON in relation to "protective masks, masks for protection against dust, anti-pollution masks for respiratory protection, infra-red thermometers, cleanroom face masks, surgical masks, respiratory masks for medical use, sanitary masks for germ and virus isolation purpose, protective face mask for medical use, masks for use by medical personnel, PPE kits for use by medical personnel, digital thermometer for medical use, medical devices and instruments". That for effective marketing of its respiratory marks, the petitioner bonafidely started to describe its respiratory marks with the established term to describe such marks i.e. N95 masks by mentioning the same on its packaging and the product for denoting the genus, and/or type of the products.

9. The Petitioner submitted that the said generic term N95 has been since then been used extensively and continuously by the Petitioner in relation to its respiratory mask under the trade mark SASSOON. The Petitioner also registered itself as a seller on e-commerce platform i.e. www.amazon.in and had been inter alia selling its products including N95 masks from the said platform. In this background, on 20-11-2020, the petitioner received an email from www.amazon.in informing that the petitioner's listing of its N95 masks under ASIN No. B0898N72RN had been removed by the platform apparently on the complaint filed on behalf of Respondent No.1. The contents of the complaint were not made available to the petitioner but the e-mail dated 20-11-2020 did mention the trade mark no. 4487559 as the trade mark claimed to be infringed. A screen shot of the removed listing from the website www.amazon.in was placed before us.

10. The petitioner submitted that on enquiry it found that the Respondent No.1 had frivolously and fraudulently obtained an unlawful registration of the generic term N95 in

class 10. The Application for the said registration was filed on 14-4-2020 on a “proposed to be used basis” in respect of Surgical, medical, dental and veterinary apparatus and instruments; Artificial limbs, eyes and teeth; Orthopedic articles; Suture materials; Therapeutic and assistive devices adapted for persons with disabilities; Massage apparatus; Apparatus, devices and articles for nursing infants; Sexual activity apparatus, devices and articles and the same was registered by Respondent No.2 on 11-11-2020.

11. The Petitioner submitted that it checked through the Respondent No.1 's website www.maya123.com and it found that the Respondent No.1 was running a business of various Audio & Video accessories like cables, connectors, smart watches, speakers etc. On being contacted Respondent No.1 claimed that he shall only allow those business houses to use N95 as a term on their products who share their profits with him. He further claimed that he was in the process to totally block the business of the Petitioner and other manufacturers/traders and threatened the petitioner's representatives that they should advise the directors of the petitioner to contact him for a “business deal” within 2 days, else he will totally destroy the business of the petitioner.

12. The petitioner submitted that on 21-11-2020 they instituted a suit under Section 142 of the Trade Marks Act, 1999 before the Ld. ADJ, Saket Courts, New Delhi which suit being CS no. DJ/2468/2020 was listed on 25/11/2020 and short notice of 2 days was issued. The Respondent No.1 was served and has entered appearance in the said suit on 28/11/2020 and the Respondent No.1 has been directed to file its Written Statement to the Suit and reply to the injunction application on or before 2-12-2020 and the matter has been posted on 4-12-2020 for arguments on the Petitioner's application for interim relief.

13. The Petitioner submitted that on 25-11-2020, they received a message from the Respondent No.1 on the amazon seller platform as an “Enquiry from amazon customer Sanjay Garg”. The said message reads as “We are trademark holder for word mark N95. We request you to alter your product image/product title/or take Brand Licensing. Our Brand Licensing starts from 10K per month only. Kindly look into it and help us.” Screenshot of the said message was placed before us.

14. We have heard the learned counsel for the Petitioner. We have also gone through the pleadings as well as the material placed on records before us. It is the established principle that a generic expression can never be granted registration and/or protection as a trade mark under the trade mark laws. In **Nestle'S Products (India) Ltd. vs P. Thankaraja And Anr., AIR 1978 Mad 336**, it was opined by the Hon'ble Madras High Court that “...**'INSTEA'** has the tendency to monopolise all manufactured tea which goes by the generic description of **'instant tea'** or **'instantaneous tea'**. To grant registration to this word-mark, would therefore make its owner a monopolist of a part of the ordinary vocabulary in which traders transact business with themselves and their customers.” Further in **Cadilla Healthcare Ltd.v/s.Gujarat Co-operative Milk Marketing Federation Ltd. and Ors, 2009 (41) PTC 336 (Del.) (DB)** it was discussed that generic term is only entitled to protection on the ground that it

had acquired a distinctive character in the minds of customers and had acquired a well known status, same will be depending upon case to case. And thus in general the generic mark is not entitled to protection. In **Jain Riceland Pvt. Ltd. v/s. Sagar Overseas, CS(COMM) 796/2016**, the Hon'ble Delhi High Court was clear when laying down the dictum that that the generic word cannot acquire distinctiveness. Further in the case of **ITC Ltd v. Nestle India Limited C.S.No.231 of 2013, 2020 SCC Online Mad 1158 decided on 10.06.2020** by High Court of Madras which stated that the mark 'Magic Masala' was not a descriptor of the product but rather a laudatory expression, and the same cannot be given monopoly or protection. Further, the Court held that the terms '**Magic**' and '**Masala**' are commonly used terms by different manufacturers in the packaged food industry and it would be unfair to confer monopoly over the same expression. Because the term N95 is a generic term in the mask industry, the same is not capable of being neither registered or protected as trade mark nor the same can be appropriated by any one entity. The term N95 is in use world over ever since early 1970 have to refer to single respirator face masks which were designed to filter 95% of dust particles to enter the nose or mouth and was initially designed by famous 3M Company for industrial uses and announced the same as an industry standard. The same is on the face of record a generic and/or a descriptive mark which is used extensively not only by members of the trade but by various government authorities, institutions to refer to a particular type of the respiratory mask, which are in huge demands by hospital authorities, healthcare workers, and even general public due to ongoing COVID-19 pandemic and due to government mandate to especially the mark are related to Healthcare. The term N95 further serves as an indicator in the trade to designate the kind, quality, intended purpose and other characteristics of the particular product which is nonproprietary in nature. The registration of the impugned mark was thus barred under the absolute grounds of refusal under Section 9 (1) (b) of the Trade Marks Act, 1999.

15. The **Delhi High Court** *in its judgment dated January 3, 2013, in the case of M/S Three- N-Products Pvt. Ltd. vs M/S Kairali Exports and Anr., noted that protection of a generic word as a trademark requires a greater degree of proof and a lot more effort from the person claiming trademark rights over the mark.* The Court opined that it is not that a generic or descriptive mark will never have any legal protectability but the burden of proof on the person claiming distinctness in favor of a generic or descriptive mark is much higher. The Plaintiff would have to show that the mark adopted by the Plaintiff, because of its extensive use has acquired distinctness and is identifiable only with the goods of the Plaintiff. The same are lacking in the present case as it has been filed as proposed to be used and the same even as on the date of the present petition are not been marketed by the Respondent No.1.

16. In this case, the wording N95 in the registered mark is descriptive of a characteristic of the masks, specifically that they filter at least 95% of airborne particles and are not strongly resistant to oil is a standard and is a class of respiratory devices and thus is a

generic term . A generic term is one that refers to the genus of which the particular product is a species. Thus, N95 is an industry standard, due to the renown of the certifying standard named in the generic mark N95, the Respondent No.1 cannot monopolize the said N95 mark in commerce.

17. Generic terms cannot be registered under trademark law and no protection to proprietor is provided. If any word is to be adopted as a trademark it cannot be a term that is primarily understood by people as referring to a 'product category'. The governing principle in cancellation/Rectification of registration Applications, “**what is the primary significance of the registered mark to the relevant public**” shall be the test for determining whether the registered mark has become the generic name of goods or services and in the present case not just the relevant public but various government authorities and institutions to refer to a particular type/standard of the respiratory mask as N95 and thus it is generic to the goods. Further from the record placed before us it is clear that the relevant public also does not identify the goods as emanating just from Respondent No.1.

18. It is clear to us that the Respondent No.1 is a squatter and has got registered the generic term N95 as a trade mark to blackmail the bonafide users of the said term and to extract illegal monies. From the documents placed before us, it is shown that the Respondent is not even using the said term nor is it dealing in the masks or for that matter in any goods for which it applied the said mark under impugned application no. 4487559 in class 10. It appears that the Respondent does not have any bona fide intent to lawfully use the applied-for mark in commerce. During the Pandemic COVID-19 crisis the shameless acts of the Respondent No.1 in restricting the sales of the N95 Standard masks based on the Registration obtained by him would deprive the general public from accessing the N95 Masks that are declared as essential commodity by the Government. In light of the COVID-19 global pandemic and the harm that could occur should fraudulent acts of the Respondent No.1 are allowed to restrict the sales of masks would impair general public and consumers from purchasing the said protective N95 masks in the market.

19. Therefore, given current public sentiment during this global public health crisis and since the dishonesty factor holds the cardinal principle until the Rectification Petition is finally decided the operation of the registration No. 4487559 in class 10 Registered under Certificate No. 1633656 shall remain stayed. No costs.

20. List the main matter on 05/03/2021.

-Sd/-

-Sd/-

-Sd/-

(MS. LAKSHMIDEVI SOMANATH)
TECHNICAL MEMBER (TM)

(MR. MAKYAM VIJAY KUMAR)
TECHNICAL MEMBER (TM)

(JUSTICE MANMOHAN SINGH)
CHAIRMAN

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