

## REWRITING SPECIFICATIONS: THE POTENTIAL FOR PARTIAL REVOCATION

### CLAIMS IN INDIA BASED ON NON-USE

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#### ABSTRACT

*The norms governing the specifications of registered trade marks are crucial to achieve the balance and certainty that is sought by any trade mark regime. Proprietors of trade marks are interested in drafting specifications as widely as possible to ensure maximum protection, while the public is interested in accurately drafted specifications to ensure that monopolies are only as wide as necessary. In India, Section 47 of the Trade Marks Act, 1999 plays an important role in achieving this balance by allowing for the revocation of trade marks that are not used in relation to the goods or services for which they were registered, provided certain conditions are satisfied. In this article, the author seeks to address two questions: first, does Section 47 permit the rewriting of specifications of registered trade marks on the grounds that they have only been used for some, and not all of the goods or services that fall within its specification, and second, if Section 47 does allow for rewriting specifications on this basis, what are the principles that guide the rewriting of specifications. After an examination of Indian and comparative law on the subject, the author concludes that India does permit rewriting of specifications for partial non-use and endorses the average consumer test as applied by courts in Singapore to determine the manner in which trade mark specifications may be rewritten.*

#### I. INTRODUCTION

Section 47 of the Trade Marks Act, 1999 [hereinafter “**Trade Mark Act**”] allows for the revocation of trade marks that are not being used in relation to the goods or services for which they have been registered, provided certain conditions are satisfied.<sup>1</sup> This is because one of the principal justifications for protecting trade marks is their actual use i.e., trade marks are worth protecting only when they are used to communicate certain information to consumers in relation to the goods or services that fall within their specification.<sup>2</sup> This ensures that third parties are not unfairly restricted from using trade marks for products or services in relation to which a trade mark has

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<sup>1</sup> Trade Marks Act, 1999, §47, No. 47, Acts of Parliament, 1999 (India).

<sup>2</sup> Lionel Bently & Brad Sherman, *Intellectual Property Rights* 1029 (4<sup>th</sup> ed. 2014) [hereinafter “**Bently & Sherman**”]; David Keeling et al., *Kerly’s Law of Trade Marks and Trade Names* 121-122 (16<sup>th</sup> ed. 2017); *Invermont Trade Mark*, 114 Reports of Patent, Design and Trade Mark Cases/RPC125 (1997); *Cabanas Havana (Device) Trade Mark*, Reports of Patent, Design and Trade Mark Cases/RPC26, 34 (2000).

not been used, even if the specification of a registered trade mark includes such product or service. As a consequence, parties are prevented from engaging in opportunistic stockpiling or trafficking of desirable trade marks by registering trade marks with no intention of using them.<sup>3</sup>

In this article, the author seeks to address two questions: first, does Section 47 permit the rewriting of specifications of registered trade marks on the grounds that they have only been used for some, and not all of the goods or services that fall within its specification, and second, if Section 47 does allow for rewriting specifications on this basis, what are the principles that guide the rewriting of specifications. These questions are important because they affect the certainty of protection that a proprietor has in relation to their trade marks.<sup>4</sup> The answer to these questions will also provide guidance to proprietors on the manner in which the specification of their trade marks should be drafted when seeking registration.

The article proceeds in the following manner: in Part II, the author discusses the existing law in India on rewriting specifications due to partial non-use. In Part III, the author considers comparative jurisprudence on tests that have been used to determine how a trade mark specification should be rewritten. In Part IV, the author analyses the comparative jurisprudence to propose a test for rewriting specifications in India. In Part V, the author offers concluding remarks.

## II. NON-USE IN INDIA AND THE SCOPE FOR REWRITING SPECIFICATIONS

### A. THE STATUTORY BASIS FOR REWRITING SPECIFICATIONS

The statutory basis for revocation of trade marks on grounds of non-use is found under Section 47 of the Trade Marks Act.<sup>5</sup> It provides for two specific instances of non-use that allow for a registered trade mark to be removed from the register in respect of the goods and services for which it has been registered:

- (i) if on registration, the proprietor of a trade mark,
  - a. did not have any *bona fide* intentions to use the trade mark in relation to the goods or services for which it was registered, and
  - b. there has, in fact, been no *bona fide* use of the trade mark in respect of such goods or services for a period up to 3 months prior to an application for revocation; and

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<sup>3</sup> *Id.*

<sup>4</sup> Bently & Sherman, *supra* note 2.

<sup>5</sup> Trade Marks Act, *supra* note 1, at §47.

- (ii) if the trade mark was not used in a *bona fide* manner in relation to the goods or services for which it was registered for a continuous period of five years (up to a date three months before an application for revocation is made) from the date on which the trade mark is actually entered in the register.<sup>6</sup>

In other words, a trade mark may be revoked if it is established that there was no *bona fide* intention to use the trade mark at the time of registration or if it is established that the trade mark has not been used in a *bona fide* manner for a continuous period of 5 years from the date on which the trade mark is registered.

Unlike certain other jurisdictions, India's provision on non-use does not make it clear whether a trade mark can be revoked due to non-use in relation to a part of the specification for which the trade mark is registered.<sup>7</sup> Further, while the Supreme Court of India has relied on this provision to rewrite the specification of a trade mark due to partial non-use, a judicial body has not explicitly discussed the issue of whether rewriting specifications due to partial non-use is permitted by the Trade Marks Act. Apart from the rulings of the Madras High Court and Supreme Court in a dispute between Vishnudas Trading and Vazir Sultan Tobacco Company Limited [hereinafter "**Vazir Sultan**"],<sup>8</sup> there is no reported decision of a higher judicial body in India on the rewriting of specifications on grounds of partial non-use. This may, at least in part, be due to the fact that prior to the enactment of the Tribunal Reforms Act, 2021<sup>9</sup> (which dissolved the Intellectual Property Appellate Board [hereinafter "**IPAB**"] due to longstanding issues with its efficacy<sup>10</sup>), any attempt to revoke a trade mark was required to be brought before the Registrar of Trade Marks or the IPAB.<sup>11</sup> Courts were not permitted to adjudicate upon a claim seeking revocation in the first

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<sup>6</sup> *Id.* at §47(1).

<sup>7</sup> *See, for example*, Trade Marks Act, 1994, ch 26, §46(5), Acts of Parliament (UK), sch. 1 [hereinafter "**UK Trade Marks Act**"]; Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017, 2017 O.J. L 154/1, §58(2) (EU) [hereinafter "**EU Trade Mark Law**"]; Trade Marks Act, 1998, §22(6), Acts of Parliament (Singapore) [hereinafter "**Singapore Trade Marks Act**"].

<sup>8</sup> Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd, A.A.O. Nos. 582 and 583 of 1976, dated 11.09.1980 [hereinafter "**Charminar Case (SJ)**"]; Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd., (1990) SCC OnLine Mad 503, ¶ 18 [hereinafter "**Charminar Case (DB)**"]; and Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd., (1997) 4 SCC 201 [hereinafter "**Charminar Case (SC)**"].

<sup>9</sup> Tribunal Reforms Act, 2021, No. 33, Acts of Parliament, 2021 (India) [hereinafter "**Tribunal Reforms Act, 2021**"].

<sup>10</sup> *See* (Retd.) Prabha Sridevan, *Justice Prabha Sridevan on Govt's Proposal to Shut Down IPAB and the Way Forward*, SPICY IP, (Feb. 18, 2023), available at <https://spicyip.com/2021/02/justice-prabha-sridevan-on-proposal-to-shut-down-ipab-and-the-way-forward.html>; Prashant Reddy, *The End of the IPAB and Lessons on Concentration of Judicial Powers*, SPICY IP, (Sept. 1, 2021), available at <https://spicyip.com/2021/09/the-end-of-the-ipab-and-lessons-on-concentration-of-judicial-powers.html>; Prashant Reddy, *Justice Sridevan's report exposes the Central Govt's apathy towards the IPAB*, SPICY IP, (Sept. 27, 2011), available at <https://spicyip.com/2011/09/justice-sridevans-report-exposes.html>; Prashant Reddy, *Justice Sridevan's status report to the Madras High Court on the functioning of the IPAB*, SPICY IP, (Sept. 1, 2021), available at <https://spicyip.com/2013/05/justice-sridevans-status-report-to.html>.

<sup>11</sup> Trade Marks Act, *supra* note 1, at §57 (prior to the passage of the Tribunal Reforms Act, 2021, *supra* note 9).

instance.<sup>12</sup> Further, counter-claims of non-use could not be brought up by the defendants in infringement claims as it would undermine the efficacy of registration and the presumption of validity of registration under Section 31 of the Trade Marks Act.<sup>13</sup>

### **B. Interpreting Section 47(1) of the Trade Marks Act**

A plain reading of Section 47(1) (partially reproduced below), allows equally for an interpretation that permits rewriting of specifications and one that does not:

*“A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered [...]”<sup>14</sup>*

First, the provision may be read by including an ‘all’ in the sentence. That is, a registered trade mark may be taken off the register in respect of *all* the goods or services in respect of which it is registered. Second, it may be read by including an ‘any’ in the sentence. That is, a registered trade mark may be taken off the register in respect of *any* of the goods or services in respect of which it is registered. Neither of these interpretations is obviously right or wrong if assessed solely based on the language in Section 47. However, in cases where two interpretations are possible, the interpretation which gives meaning to the legislative intention behind including the provision should be followed. The legislative intention of the inclusion of a provision that allows for revocation of registered trade marks is to ensure that trade marks are not stockpiled through frivolous registrations or overbroad specifications.<sup>15</sup> At the same time, the legislature intended to create certainty and provide protection to proprietors of trade marks.<sup>16</sup> This balance can be achieved by reading Section 47(1) of the Trade Marks Act with the word “any”, which allows revocation on the grounds of non-use in relation to the goods or services in relation to which the mark has not been used.

### **C. The Benefits of Permitting Partial Revocation**

There are several reasons for allowing partial revocation claims in India. *First*, policy reasons for allowing partial revocation are strong as they prevent overbroad registrations and extend monopoly protection only to those trade marks that are used to communicate information to

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<sup>12</sup> *Id.*

<sup>13</sup> *New Balance Athletics v. Apex Shoe Company* 2019 SCC OnLine Del 7393, ¶ 13C; *Sun Pharmaceuticals Industries Ltd v. Cipla Ltd.*, (2009) (39) PTC 347; *H&M Hennes & Mauritz AB v. HM Megabrands Pvt. Ltd.* (2018) 251 DLT 651).

<sup>14</sup> Trade Marks Act, *supra* note 1, at §47(1).

<sup>15</sup> *Bently & Sherman*, *supra* note 2.

<sup>16</sup> *See* Trade Marks Act, *supra* note 1, at §31.

consumers.<sup>17</sup> If partial revocation claims are not allowed, then there would be an incentive for all proprietors to register their mark with the broadest possible specifications.

*Second*, allowing for partial revocation is also consistent with allowing for non-use claims generally. Non-use claims are permitted on the theoretical underpinning that stockpiling or trafficking trade marks should be discouraged.<sup>18</sup> Similarly, partial non-use claims would discourage stockpiling trade marks by registered trade marks with overbroad specifications. *Third*, comparative law in other jurisdictions such as the United Kingdom and European Union have successfully implemented laws relating to partial revocation to ensure that monopolies are enforced only to the extent that they are used, and as consequence, deserved.<sup>19</sup> For example, Section 46(5) of the UK Trade Marks Act, Section 58(2) of EU Trade Mark Law and Section 22(6) of the Singapore Trade Marks Act allow for courts and trade mark offices to partially revoke trade marks that have not been used for identified goods or services that were included in their specifications.<sup>20</sup>

#### **D. India's Case on Partial Non-Use**

In the previous sub-part, it was concluded that rewriting specifications on grounds of partial non-use is permitted under Section 47 of the Trade Marks Act. In this sub-part, the author will consider the application of this provision in the context of partial non-use in India.

The case law on the question of rewriting specifications in India emerges from a series of cases that led up to the Supreme Court, between Vishnudas Trading and Vazir Sultan. In this sub-part, the decision of each judicial body in this series of cases will be analysed to understand the application of Section 47 in the case of partial non-use.

Vazir Sultan was a company that had been manufacturing and selling cigarettes under the brand name “Charminar” (which is the name of a historic mosque located in the city of Hyderabad).<sup>21</sup> It

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<sup>17</sup> Bently & Sherman, *supra* note 2.

<sup>18</sup> *Id.*

<sup>19</sup> *See*, Thomson Holidays Ltd. v. Norwegian Cruise Line Ltd., [2003] RPC (32) (UK) 586, 597; Daimlerchrysler AG v. Alavi [2001] RPC 813 (UK); Decon Laboratories Ltd. v. Fred Baker Scientific Ltd. (2001) R.P.C. 293 (UK); Maier v. ASOS Plc [2015] EWCA Civ 220 (UK); Merck KGaA v. Merck Sharpe & Dohme Corp. [2018] E.T.M.R. 10 (UK), 266-267; Thomas Pink Ltd. v. Victoria's Secret UK Ltd. [2014] EWHC 2631 (Ch) (UK); West (T/A Eastenders) v. Fuller Smith & Turner Plc [2003] EWCA Civ 48 (UK); Reckitt Benckiser (Espana) SL v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-126/03, 2005 ECR II- 2861.

<sup>20</sup> UK Trade Marks Act, *supra* note 7, at §46(5); EU Trade Mark Law, *supra* note 7, at §58(2); Singapore Trade Marks Act *supra* note 7, at §22(6).

<sup>21</sup> Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd., (1997) 4 SCC 201, at ¶ 2.

was also the proprietor of the mark “Charminar” for “manufactured tobacco”, with a registration in Class 34 under the Trade Marks Act, 1940, and Trade Marks Act, 1958, in 1942 and 1955 respectively.<sup>22</sup>

Vishnudas Trading manufactured *quiwam* (a liquid tobacco mixture made with tobacco leaves flavoured with spices and additives) and *zarda* (a moist or dry chewing tobacco mixed with colourings, spices and perfumes) since 1973.<sup>23</sup> Vishnudas Trading used the same trade mark “Charminar” on their bottles and boxes of *quiwam* and *zarda*.<sup>24</sup> It applied for registration of the trade mark “Charminar” with the specification “manufactured tobacco” for *quiwam* and *zarda* in Class 34 under the Trade and Merchandise Act, 1958.<sup>25</sup> This application was rejected by the Joint Registrar of Trade Marks in Madras who observed that it would conflict with the existing trade mark registration in “Charminar” held by Vazir Sultan in Class 34 for “manufactured tobacco”.<sup>26</sup> The Joint Registrar of Trade Marks noted that even though the products sold by Vishnudas Trading (*quiwam* and *zarda*) were different from the product sold by Vazir Sultan (cigarettes), Vazir Sultan’s registration was for “manufactured tobacco”, which would cover *quiwam* and *zarda*.<sup>27</sup>

Subsequently, Vishnudas Trading filed an application before the Assistant Registrar of Trade Marks, Madras for rectifying Vazir Sultan’s registration, amongst other things, on account of non-use of the mark in relation to products other than cigarettes.<sup>28</sup> The Assistant Registrar of Trade Marks allowed the application for rectification, rewriting the specification of Vazir Sultan’s trade mark to “cigarettes”, noting that Vazir Sultan had never used the trade mark for any good other than cigarettes, and did not have the *bona fide* intention to put the trade mark to such use.<sup>29</sup>

Vazir Sultan subsequently filed an appeal against the decision of the Assistant Registrar of Trade Marks which was heard by a Single Judge of the Madras High Court.<sup>30</sup> The Single Judge of the Madras High Court set aside the order of the Assistant Registrar of Trade Marks.<sup>31</sup> In reaching this conclusion, the Single Judge noted that: (i) the Assistant Registrar of Trade Marks does not have

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<sup>22</sup> *Id.*

<sup>23</sup> *Id.*

<sup>24</sup> *Id.*

<sup>25</sup> Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd., (1990) SCC OnLine Mad 503, at ¶ 2.

<sup>26</sup> Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd., (1997) 4 SCC 201, at ¶ 2.

<sup>27</sup> *Id.*

<sup>28</sup> Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd., (1990) SCC OnLine Mad 503, at ¶ 3.

<sup>29</sup> Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd., (1990) SCC OnLine Mad 503, at ¶ 18.

<sup>30</sup> Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd, A.A.O. Nos. 582 and 583 of 1976, dated 11.09.1980.

<sup>31</sup> Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd., (1990) SCC OnLine Mad 503, at ¶ 4.

the authority to create a sub-classification of “manufactured tobacco” found in Class 34 (which class is for “tobacco, raw or manufactured; smokers articles; matches.”<sup>32</sup>); (ii) it is not necessary to establish use of every article within the meaning of “manufactured tobacco” to sustain Vazir Sultan’s trade mark registration; and (iii) permitting the rectification would allow Vishnudas Trading to pass off their chewing tobacco products as those of Vazir Sultan’s.<sup>33</sup>

The decision of the Single Judge was appealed before a Division Bench of the Madras High Court.<sup>34</sup> The Division Bench dismissed the appeal, agreeing with the conclusions reached by the Single Judge on non-use. The decision of the Division Bench of the Madras High Court was finally challenged before the Supreme Court.<sup>35</sup> The Supreme Court overturned the decision of the Division Bench of the Madras High Court and reinstated the decision of the Assistant Registrar of Trade Marks,<sup>36</sup> holding that Vazir Sultan’s trade mark specification was liable to be changed from “manufactured tobacco” to “cigarettes”, since Vazir Sultan had not used, and did not have any *bona fide* intention to use their trade mark for any other good.<sup>37</sup>

### C. The Decision of the Supreme Court

The Supreme Court decided the case on the basis of the Trade Marks Act, 1958, which was the applicable legislation at the time.<sup>38</sup> However, the analysis of the law in relation to non-use by the Supreme Court is also applicable to the Trade Marks Act because it has identical provisions on non-use.<sup>39</sup>

The Supreme Court held that the specification of trade marks can be rewritten under the scheme of the Trade Marks Act, 1958. It identified several reasons to allow this, including to enlarge the field of registrability.<sup>40</sup> The Supreme Court also took note of the contentions of Vishnudas Trading, which identified that the legislative intention for allowing for rectification of trade marks includes: (i) to maintain the purity and precision of the Trade Marks Register; (ii) to secure advantage to the public; (iii) to establish *bona fides* in the registration of trade marks, and (iv) to

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<sup>32</sup> Trade Marks Rules, 1959, Schedule IV (India).

<sup>33</sup> Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd., (1990) SCC OnLine Mad 503, at ¶ 4.

<sup>34</sup> *Id.*

<sup>35</sup> *Id.*

<sup>36</sup> *Id.* at ¶ 50.

<sup>37</sup> *Id.* at ¶ 47.

<sup>38</sup> *Id.* at ¶ 2.

<sup>39</sup> *Cf.* Trade Marks Act, *supra* note 1, at §47 and Trade Marks Act, 1958, §46, No. 43, Acts of Parliament, 1958 (India).

<sup>40</sup> Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd., (1997) 4 SCC 201, at ¶44.

obviate creation of monopolistic or oligopolistic trends through trade marks.<sup>41</sup> On a balance of interests, the Supreme Court held that it is desirable to rectify trade marks to limit their specifications to goods or services in relation to which the trade marks have been used, or in relation to goods or services which they have a *bona fide* intention to use the trade mark.<sup>42</sup>

Once the Supreme Court identified that trade marks should be rectified for non-use, the next task was to determine how to go about determining non-use. Vishnudas Trading argued that anything which is a subject of trade mark must be an article or thing that is distinctly complete, identifiable and vendible but not something nebulous, lacking in specificity or precise identification.<sup>43</sup> The Registrar of Trade Marks argued that allowing Vazir Sultan's registration to stand would grant them an unreasonably broad monopoly and can go against the objective of the trade mark legislation, which is to enlarge the field of registrability.<sup>44</sup>

In its decision, the Supreme Court noted that “manufactured tobacco” is a broad genus covering a large variety of goods and articles: (a) tobacco may be consumed by smoking and articles made of tobacco which are consumed by smoking comprise cigarettes, cigars, cheroots, bidis, pipe tobacco; (b) tobacco may be consumed by chewing and ingestion and this category includes *quiwam* which is in paste form and applied usually as an ingredient to pan; gutka in the form of flakes which is chewed sometimes with the addition of lime (*chuna*); and (c) tobacco consumed by inhalation – in this category, snuff which is in powder form is taken in or inhaled through the nose may be mentioned.<sup>45</sup> The Supreme Court, therefore, acknowledged that the specification is fairly broad, and covers a variety of goods that are not identical or similar to each other.

The Supreme Court noted that allowing Vazir Sultan to retain the specification of “manufactured tobacco” for a trade mark that is only used in relation to cigarettes would be unreasonable.<sup>46</sup> The Supreme Court also noted that the specification of “manufactured tobacco” includes products that are marketed and sold in different distribution channels and are used differently.<sup>47</sup>

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<sup>41</sup> *Id.* at ¶ 6.

<sup>42</sup> *Id.* at ¶ 47.

<sup>43</sup> *Id.* at ¶ 15.

<sup>44</sup> *Id.* at ¶ 43.

<sup>45</sup> *Id.* at ¶ 45.

<sup>46</sup> *Id.* at ¶ 47.

<sup>47</sup> *Id.* at ¶ 46.



Thus, even though the possibility of partial revocation was not explicitly discussed by the Supreme Court, it allowed for the rewriting of Vazir Sultan's specifications on the grounds that the actual use of the mark did not justify the breadth of the specification. The Supreme Court thus held that the actual use of the mark determined the rewriting of the specification and the fact that there was no *bona fide* intention to trade in or manufacture other goods that fall within the broad specification.<sup>48</sup> It was therefore permissible only to register the trade mark for cigarettes.<sup>49</sup>

### III. THE SWORD OF PARTIAL REVOCATION: HOW MUST ONE WIELD IT?

In the previous part, it was concluded that Section 47 permits partial revocation of trade marks on the grounds of non-use. In this part, the author will discuss how courts should determine when a trade mark specification should be rewritten. Since *Charminar Case (SC)* is the only case in which Section 47 has been relied upon to rewrite a specification in India, it is necessary to formulate a test that provides guidance in different scenarios. For instance, it is easy to determine partial non-use in cases where a mark is registered for laptops and t-shirts, and has only been used in relation to t-shirts. One simply has to strike out the registration for laptops. However, what if there is a registration for 'alcoholic drinks', but the mark has only been used in relation to whisky. Should the specification be rewritten as 'whisky'? Or malt whisky? Or Scottish single malt whisky?<sup>50</sup> To elaborate upon the test applied in India, the author will discuss jurisprudence from other jurisdictions on the subject in this part.

#### A. Partial Revocation Jurisprudence in the United Kingdom

The United Kingdom ("UK") has a rich vein of jurisprudence on the issue of partial revocation, because of an explicit provision that permits partial revocation claims in courts.<sup>51</sup> Initially, there was a division of opinion on the appropriate test to be followed when rewriting specifications, between the 'blue pencil approach' and the 'average consumer test'.

The first approach was the blue-pencil approach, followed in *Premier Brands v. Typhoon*.<sup>52</sup> This approach only checked whether the mark has been used on a good or service that fits within the meaning of the registered specification.<sup>53</sup> Therefore, if a mark was registered for alcoholic drinks, and was used in relation to whisky, the registration for alcoholic drinks could not be removed,

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<sup>48</sup> *Id.* at ¶ 46.

<sup>49</sup> *Id.*, at ¶ 49.

<sup>50</sup> Bently & Sherman, *supra* note 2.

<sup>51</sup> UK Trade Marks Act, *supra* note 7, at §46(5).

<sup>52</sup> *Premier Brands UK Ltd. v. Typhoon Europe Ltd. & Anr.*, (2000) FSR 767 (UK) [hereinafter "**Premier Brands**"].

<sup>53</sup> *Id.*; Bently & Sherman, *supra* note 2.

even if the mark was not used for any other kind of alcoholic drink. This approach defers to the choice of the proprietor to write their own specifications and does not dig deeper than the first layer.

However, the blue-pencil approach was discontinued conclusively in the UK in *Thomson Holidays v. Norwegian Cruise Line Ltd.*,<sup>54</sup> because it was thought to be inappropriate for all cases. To maintain their specification, proprietors need only use broad terminology in the specification.<sup>55</sup> For instance, even if a mark is registered for ‘beverages’ generally, and only used in relation to whisky, the specification cannot be rewritten, since whisky is also a sub-set of beverages.

The new approach relied on the perception of the average consumer based on the actual use of the mark.<sup>56</sup> In relation to the approach that courts should follow, the Court in *Thomson Holidays* stated that courts should “limit the specification so that it reflects the circumstance of the particular trade and the way the public would perceive the use.”<sup>57</sup> One must consider how the average consumer would define the range of goods or services covered by a particular mark. In *Thomson Holidays*, the Court stated that the mark “Freestyle”, which was registered for ‘arrangement and booking of travel tours and cruises’ could not be restricted to ‘land-based holidays’ or ‘holidays excluding cruises’ because consumers would not describe it as such, even though the mark was never used for cruise vacations.<sup>58</sup> The specification was ultimately rewritten to ‘package holidays’.<sup>59</sup> The average consumer test is now prevalent in the UK, with a string of other cases following this approach.<sup>60</sup>

The test adopted by the Assistant Registrar of Trade Marks and Indian Supreme Court to rewrite the specification of Vazir Sultan in some ways used the average consumer test, since it relied on the distinction in the nature and channels of distribution of cigarettes and *quiwam* and *zarda*.<sup>61</sup> The Supreme Court used this distinction to note that use of a trade mark for cigarettes would not be perceived as use of the trade mark in relation to chewing tobacco or snuff since “they are

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<sup>54</sup> *Thomson Holidays Ltd. v. Norwegian Cruise Line Ltd.*, (2003) RPC (32) (UK) 586, 597 ¶ 29 [hereinafter “**Thomson Holidays**”].

<sup>55</sup> *Thomson Holidays Ltd. v. Norwegian Cruise Line Ltd.*, (2003) RPC (32) (UK) 586, 597 ¶ 29.

<sup>56</sup> *Id.* at ¶ 31.

<sup>57</sup> *Id.* at ¶ 29.

<sup>58</sup> *Id.*

<sup>59</sup> *Id.* at ¶¶ 32-39.

<sup>60</sup> *Daimlerchrysler AG v. Alavi* [2001] RPC 813 (UK); *Decon Laboratories Ltd. v. Fred Baker Scientific Ltd.* [2001] R.P.C. 293 (UK); *Maier v ASOS Plc* [2015] EWCA Civ 220 (UK); *Merck KGaA v. Merck Sharpe & Dohme Corp.* (2018) E.T.M.R. 10 (UK), 266-267; *Thomas Pink Ltd. v. Victoria’s Secret UK Ltd.* (2014) EWHC 2631 (Ch) (UK); *West (T/A Eastenders) v. Fuller Smith & Turner Plc* (2003) EWCA Civ 48 (UK).

<sup>61</sup> *Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd.*, (1997) 4 SCC 201, at ¶46.

differently used and have their distinctive quality and separate identity”<sup>62</sup>. The Supreme Court also noted that products within the description of “manufactured tobacco” are marketed as distinct articles and used in a different manner.<sup>63</sup>

### **B. The Taxonomy Test of the European Union**

The Court of First Instance in the European Union [hereinafter “EU”] follows a different approach to rewriting specifications. In *Reckitt Benckiser*,<sup>64</sup> the mark ‘Aladin’ was registered for ‘polish for metals’, but used only in relation to ‘cotton impregnated with a polishing agent’, commonly referred to as ‘magic cotton’.<sup>65</sup> However, the court decided against rewriting the specification in this case, since ‘polish for metals’ was a ‘coherent category’ or ‘sub-category’ that could not be divided further without being arbitrary.<sup>66</sup>

When determining whether further division would be ‘arbitrary’, the court relied on the division of goods and services under the Nice Classification.<sup>67</sup> That is, if a specification is a sub-category of an existing class of goods or services in the Nice Classification, then it would be considered to be sufficiently narrow.<sup>68</sup> For instance, in *Reckitt Benckiser*, the court stated that the specification ‘polish for metals’ was “particularly precise and narrowly defined subcategory” when compared to the class under which it was registered, which included ‘cleaning, polishing, scouring and abrasive preparations’.<sup>69</sup> Further, if a mark has been used for one commercial variant in a sub-category, then it will be understood to have been used for the entire subcategory.<sup>70</sup>

In *Charminar Case (SC)*, the Indian Supreme Court did not follow the taxonomy test, since it noted that a “class” of goods may subsume or comprise a number of goods or articles which are separately identifiable and vendible and which are not goods of the same description as commonly understood in trade or in common parlance.<sup>71</sup>

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<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

<sup>64</sup> *Reckitt Benckiser (Espana) SL v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-126/03, 2005 ECR II- 2861 [hereinafter “**Reckitt Benckiser**”].

<sup>65</sup> *Id.* at ¶11.

<sup>66</sup> *Id.* at ¶46.

<sup>67</sup> *Id.* at ¶¶ 47-48; Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, September 6, 1982 (as amended on September 28, 1979) [hereinafter “**Nice Classification**”].

<sup>68</sup> *Reckitt Benckiser (Espana) SL v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-126/03, 2005 ECR II- 2861, at ¶¶47-48.

<sup>69</sup> *Id.* at ¶47.

<sup>70</sup> *Id.*

<sup>71</sup> *Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd.*, (1997) 4 SCC 201, at ¶48.

#### IV. ARRIVING AT A FAIR SPECIFICATION

In the previous part, three different approaches to determining whether a trade mark specification should be rewritten were discussed – the blue pencil approach, the average consumer test and the taxonomy test. In this part, the suitability of these approaches for India will be discussed.

##### A. Blue Pencil Approach

The blue pencil approach only considers the use of the trade mark for a particular good or service that falls within the ambit of the specification.<sup>72</sup> For example, if a trade mark is registered for vehicles and used only in relation to jet skis, a court applying the blue pencil approach would reject an application for partial revocation because the use of the mark in relation to jet skis constitutes a use in relation to vehicles. The failure to use the mark in relation to any other vehicle would not impact the registration.

The blue-pencil approach was followed in *Charminar Case* (SJ). In this case, the Madras High Court interpreted Rule 26(1) of the Trade Marks Rules, 1959,<sup>73</sup> to hold that use of the trade mark for cigarettes would constitute use of the mark in relation to all goods under Class 34 because Rule 26(1) permits registration of trade marks in relation to one whole class.<sup>74</sup> The Madras High Court further noted that since cigarettes have not been used to describe any class in Schedule IV of the Trade Marks Rules, 1959, they cannot be used as a specification for a trade mark.<sup>75</sup>

In effect, however, this approach makes the rewriting of a specification on grounds of partial non-use practically impossible, since any use of a good or service that falls within the specification is sufficient to keep the trade mark registration intact. Thus, a specification as broad as “food” could be sustained, even if the use of the trade mark was only in relation to peanut butter. This approach, thus, falls short of giving effect to the purpose of the Trade Marks Act, which is to maximise the field of registrability and prevent trade mark trafficking.

In defence of the blue-pencil approach, it may be argued that the specification registered by the proprietor must be deferred to, since business may be potentially expanded to areas beyond the current use of the trade mark. While this argument has merit (and is to an extent, given consideration in all approaches discussed), it does not justify the latitude which the blue-pencil

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<sup>72</sup> Premier Brands UK Ltd. v. Typhoon Europe Ltd. & Anr., (2000) FSR 767 (UK).

<sup>73</sup> Rule 26(1), Trade Marks Rules, 1959 (India).

<sup>74</sup> Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd., (1990) SCC OnLine Mad 503, at ¶29.

<sup>75</sup> *Id.*, at ¶4.

approach permits for the proprietor. If a proprietor intends to extend their business to an entirely new description of goods or services, then they must register the trade mark for such goods or services, just as they did for the initial registration.<sup>76</sup>

From a jurisprudential perspective, the blue pencil approach was developed under contract law as a method to save overly broad restraint of trade clauses from illegality, without rewriting the terms of the contract.<sup>77</sup> The justification for adopting such an approach was to respect the principles of party autonomy and freedom to contract.<sup>78</sup> However, such a rationale does not apply to trade mark law, which also rests significantly on public interest and policy.<sup>79</sup> As a consequence, courts, or the Registrar of Trade Marks should be entitled to intervene in a more significant manner than in the case of contracts, where they are only permitted to remove entire words or phrases.<sup>80</sup>

## B. Taxonomy Test

In this sub-part, the suitability of the taxonomy test will be considered. However, before doing so, it must be assessed whether the taxonomy test is substantively different from the average consumer test. It has been argued that the difference between the two tests is negligible,<sup>81</sup> especially in terms of the results when applying the test.<sup>82</sup> The taxonomy test is at a general or “high-level” and forms the starting point of the average consumer test,<sup>83</sup> while the perspective of the average consumer is used at a later stage to categorise goods under the taxonomy test.<sup>84</sup> On the other hand, it has been argued that the two tests are different in terms of their approach.<sup>85</sup> The average consumer test gives lesser weightage to the interests of the proprietor by relying on the perception of the average consumer,<sup>86</sup> while the taxonomy test defers to the interests of the proprietor by using the

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<sup>76</sup> See *Re Edwards v. Dennis*, (1885 E. 667.), (1884) 30 Ch.D. 454.

<sup>77</sup> *The Patisserie LLP v. Aalst Chocolate Pte Ltd*, [2019] SGIPOS 6, ¶76 [hereinafter “**Patisserie**”].

<sup>78</sup> *Id.*

<sup>79</sup> *Id.*

<sup>80</sup> *Id.*

<sup>81</sup> *Maier v. ASOS* (2015) EWCA Civ 220, ¶63.

<sup>82</sup> DAVID KEELING ET AL., *KERLY’S LAW OF TRADE MARKS AND TRADE NAMES*, ¶ 12-122 (16<sup>th</sup> ed, Sweet & Maxwell 2017); *Extreme Trade Mark, Pan World Brands Ltd v. Tripp Ltd* [2008] RPC 2, ¶ 54; *Nirvana (Trade Mark: Appointed Person)* O/262/06 (18 September 2006), ¶ 57.

<sup>83</sup> *Maier v. ASOS* (2015) EWCA Civ 220, ¶ 182 (Underhill J).

<sup>84</sup> *Capitol Records LLC v. Steven Corp Pte Ltd* (2010) SGIPOS 14, ¶¶ 42, 44 [hereinafter “**Capitol Records**”]; see also *Mundipharma AG v. OHIM* (2007) ECR II-449, ¶29.

<sup>85</sup> Paul McClelland, *Partial Non-Use Cancellation of Trade Mark Registrations*, 28 SAC LJ, ¶16 (2016); *NIRVANA (Trade Mark: Appointed Person)* O/262/06 (18 Sept., 2006), ¶ 57; see *Thomson Holidays Ltd. v. Norwegian Cruise Line Ltd.*, (2003) RPC (32) (UK) 586, 597, at ¶ 7-39.

<sup>86</sup> *Extreme Trade Mark, Pan World Brands Ltd v. Tripp Ltd* (2008) RPC 2, ¶54-55; Paul McClelland, *Partial Non-Use Cancellation of Trade Mark Registrations* 28 SAC LJ ¶ 25 (2016).

specification as the starting point of determining a fair specification.<sup>87</sup> Thus, in their approach, the average consumer test and taxonomy test are different.

The taxonomy test, by its very nature, requires reference to an authoritative reference material that provides for an indicative list of classes of goods for which a trade mark may be obtained. In *Charminar Case (SC)*, it was argued that registrars typically rely on an index to determine the class in which a particular good or service is to be registered in.<sup>88</sup> It was argued that such an approach brings rationality, objectivity and consistency to decision making and eliminates arbitrariness.<sup>89</sup> The decision in *Charminar Case (SJ)* also drew from the taxonomy test, since it held that Vazir Sultan were not required to show that the trade mark was used in respect of each article falling within its specification.<sup>90</sup> The decision also noted that since the legislature has not made any distinction between the various forms of manufactured tobacco, it may be taken to have intended that all forms of manufactured tobacco should be registered under a single entry “manufactured tobacco” in Class 34.<sup>91</sup>

The taxonomy test has been criticised because of its reliance on the Nice Classification, which is considered inappropriate because the Nice Classification is merely an aid for the administration of trade marks.<sup>92</sup> It was not meant to affect the rights of proprietors, and further, does not represent a ‘universal logic’ of classifying goods and services.<sup>93</sup> Similarly, in *Charminar Case (SC)*, Vishnudas Trading argued against the taxonomy test, noting that the classification of goods and names of the cases as set out in Schedule IV of the Trade Marks Rules, 1959, is purely for the purpose of enabling the trade marks registry to ascertain in which class specified goods or a particular article or thing falls before granting and registering a trade mark.<sup>94</sup>

The taxonomy test is not objective because there is no uniform or universal taxonomy which can be relied upon. In *Charminar Case (SC)*, the Indian Supreme Court’s attention was drawn to an index authored by Stephan P. Ladas and published by Harvard.<sup>95</sup> Since this index recognised cigarettes as a distinct item, it was argued that cigarettes are a distinct commodity that can be used

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<sup>87</sup> Reckitt Benckiser (Espana) SL v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-126/03, 2005 ECR II- 2861, at ¶ 46.

<sup>88</sup> Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd., (1997) 4 SCC 201, at ¶ 42.

<sup>89</sup> *Id.* at ¶ 4.

<sup>90</sup> *Id.*

<sup>91</sup> *Id.*

<sup>92</sup> Bently & Sherman, *supra* note 2.

<sup>93</sup> *Id.*; see also Sky Plc v. Skykick UK Ltd. [2018] EWHC 155 (Ch), ¶134.

<sup>94</sup> Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd., (1997) 4 SCC 201, at ¶16, 17.

<sup>95</sup> *Id.* at ¶42.

for the specification of a trade mark.<sup>96</sup> However, there exist multiple such indexes, such as the Nice Classification and the index referred to by the court in *Charminar Case (SC)*, with no guidance on the authoritative taxonomy to be used to determine substantive rights of proprietors.<sup>97</sup>

The reliance on taxonomies also shifts the focus from the question of whether a specification is fair, to a scramble for taxonomic arguments and authorities that support a particular argument. The decision in *Charminar Case (SJ)* highlights this absurdity.<sup>98</sup> In this case, the court noted that since the classification under Schedule IV of the Trade Marks Rules, 1959 does not mention cigarettes separately, a separate specification for “cigarettes” cannot be created.<sup>99</sup> However, the Court also notes that it would have been a different case if the specification had been rewritten to “manufactured tobacco not including chewing tobacco”.<sup>100</sup> If by this statement, the Court meant that the rewriting of the specification in this manner would have been acceptable, then the approach followed by the Court is an illustration of what following the taxonomy test can look like. It boils down to becoming a rigid adherence to words, without considering the substantive rights of trade mark proprietors and applicants. For example, in *Charminar Case (SC)*, Vazir Sultan argued that the specification for the trade mark cannot be any narrower because there is no narrower terminology in Class 34, and registration can only be in the nomenclature, terminology and phraseology used in the classification prescribed under the Trade Marks Rules, 1959.<sup>101</sup> Similarly, in *Charminar Case (SJ)*, relying on the logic of the taxonomy test, it was argued that there can be a separate registration for ‘cigarettes’, because this product was mentioned separately in the index maintained by the Registrar of Trade Marks.<sup>102</sup> However, the court in *Charminar Case (SJ)* rejected this argument because the index used by the Registrar of Trade Marks is not statutory in nature,<sup>103</sup> and rather was based on a list prepared by the Board of Trade, London.<sup>104</sup>

Thus, in isolation, the taxonomy test is not desirable. However, the element of the taxonomy test that gives weight to the proprietor by presuming that their specification is valid and consistent with the presumption of validity of the specification embodied in Section 31 of the Trade Marks

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<sup>96</sup> *Id.*

<sup>97</sup> See *id.* at ¶42; Stephen P. Ladas, *Patents, Trade Marks and Related Rights – National and International Protection*, II, Harvard University Press, 1975.

<sup>98</sup> *Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd.*, (1990) SCC OnLine Mad 503, at ¶4.

<sup>99</sup> *Id.* at ¶4.

<sup>100</sup> *Id.* at ¶4.

<sup>101</sup> *Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd.*, (1997) 4 SCC 201, at ¶ 29.

<sup>102</sup> *Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd.*, (1990) SCC OnLine Mad 503, at ¶ 29.

<sup>103</sup> *Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd.*, (1997) 4 SCC 201, at ¶ 6, 17; Rule 22, Trade Marks Rules, 1959 (India).

<sup>104</sup> *Vishnudas Kishindas Zarda Factory v. Vazir Sultan Tobacco Company Ltd.*, (1990) SCC OnLine Mad 503, at ¶ 6, 17.

Act and can be the starting point when considering claims for rewriting specifications. Further, even without their binding effect, documents such as the Nice Classification are helpful reference points to determine the existence of classes of goods and the possibility of narrower specifications.

### C. Average Consumer Test and its Application in Singapore

The average consumer test permits the rewriting of specifications based on the perspective of an average consumer in relation to the usage of the trade mark.<sup>105</sup> Thus, one can add or remove words, rephrase certain parts of the specification for precision or include qualifiers if it would ensure that the specification then more accurately reflects the perspective of the average consumer.

In the context of applying a test for partial revocation in India, the jurisprudence developed in Singapore is a helpful guide, since it relies on jurisprudence from the UK and EU in tandem to arrive at a fair specification. For example, in *Capitol Records*, the court was considering whether a specification that included “men’s t-shirts, shirts, jeans, shorts, vests, slacks, briefs, ladies’ t-shirts, blouses, slacks jeans, skirts, shorts, boys’ t-shirts, boys’ suits, shorts, jeans and shirts, sports shirts” should be rewritten on grounds of use only in relation to boys’ shorts, t-shirts, shorts, Bermudas and long pants’.<sup>106</sup> In this case, the court noted that the registration is not wide and does not need to be rewritten.<sup>107</sup> The court noted that if the specifications were for clothing and footwear, and the mark was used only for clothing, then it would make sense to rewrite the specification to exclude footwear.<sup>108</sup> But, for example, in this case, it would be pointless to narrow the specification to “boy’s shorts” or “boy’s shirts, t-shirts, shorts, Bermudas and long pants” as this does not mean that a competitor can register the same mark for men’s t-shirts.<sup>109</sup>

In *Bluestar Exchange*,<sup>110</sup> the trade mark in question was registered in respect of men’s undergarments, briefs, socks, men’s sports clothing, knitwear, singlets and swimwear.<sup>111</sup> In this case, it was argued that actual use of the registered trade mark was only in relation to socks, briefs, men’s t-shirts, singlets and swimwear,<sup>112</sup> and therefore the specification should be rewritten to “men’s undergarments and knitwear” and to replace “men’s sports clothing” with “men’s t-shirts”.<sup>113</sup> In

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<sup>105</sup> See *Thomson Holidays Ltd. v. Norwegian Cruise Line Ltd.*, (2003) RPC (32) (UK) 586, 597, at ¶¶ 7-39.

<sup>106</sup> *Capitol Records LLC v Steven Corp Pte Ltd* (2010) SGIPOS 14, at ¶40, 41.

<sup>107</sup> *Id.* at ¶44.

<sup>108</sup> *Id.*

<sup>109</sup> *Id.*

<sup>110</sup> *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long & Ors.* [2003] SGHC 169 [hereinafter “**Bluestar Exchange**”].

<sup>111</sup> *Id.* at ¶2.

<sup>112</sup> *Id.* at ¶56.

<sup>113</sup> *Id.* at ¶59.



this case, the court acknowledged that a fair specification must consider the actual use of the mark as well as the question of how the goods or services should be described.<sup>114</sup> That is, a fair specification is not merely a description of the goods or services on which the mark is used, but an assessment of what a ‘fair’ description of such goods would entail.<sup>115</sup> This assessment was made on the basis of the circumstances of the particular trade and the way that the public would perceive the use. On this basis, the court noted that the test of partial revocation cannot be very strict against the proprietor and that the use in relation to men’s t-shirts was sufficient to maintain the registration for men’s sports clothing. Specifically, the court noted that “it was not in the interest of the public or trade to try and narrow the description of the clothing in the... classification further to those specific categories for which the [registered trade mark] was in fact used. To do so would result in confusion and invite litigation.”<sup>116</sup>

In *Weir Warman*,<sup>117</sup> the specification of the mark in question was as follows: “Pumps; milling equipment; valves; parts and fittings for the aforesaid goods in Class 7”.<sup>118</sup> However, the use was only in relation to pumps and pump parts.<sup>119</sup> In this case, the court rewrote the specification to “pumps and pump parts” on the basis of the usage, but refused to qualify it further by restricting it to “particular types of pump parts” on the basis that doing so would “be unnecessarily confusing and restrictive as well as not in the interest of the public or the trade.”<sup>120</sup>

From these cases, it emerges that the courts in Singapore aim to find a middle ground between restricting the specification to the exact usage and allowing proprietors to maintain broad registration. In the process of balancing such interests, the court inevitably uses a combination of the approaches and methods used in both the average consumer test and the taxonomy test. In both the *Bluestar* case and the *Weir Warman* case, the court considered the average consumer test applied in the UK. However, in both these cases, the court’s decision did not rely solely on the perspective of the consumer based on actual use, but incorporated a certain degree of restraint in rewriting the specification to ensure that legitimate expectations of the proprietor for a ‘buffer zone’ or a commercially sensible zone of exclusivity was maintained.<sup>121</sup>

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<sup>114</sup> *Id.* at ¶59; *Capitol Records LLC v Steven Corp Pte Ltd* (2010) SGIPOS 14, at ¶41, 42.

<sup>115</sup> *Capitol Records LLC v Steven Corp Pte Ltd* (2010) SGIPOS 14.

<sup>116</sup> *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long & Ors.* [2003] SGHC 169, at ¶60.

<sup>117</sup> *Weir Warman Ltd v. Research & Development Pty Ltd.* (2007) SGHC 59 [hereinafter “**Weir Weimann**”].

<sup>118</sup> *Id.* at ¶2.

<sup>119</sup> *Id.* at ¶110.

<sup>120</sup> *Id.* at ¶ 113.

<sup>121</sup> *The Patissier LLP v. Aalst Chocolate Pte Ltd*, [2019] SGIPOS 6, at ¶ 77.

For example, in *Patissier*,<sup>122</sup> the court analysed two alternative specifications and picked the one that not only considered the actual use of the trade mark, but also included goods that could reasonably be considered similar enough to come within a coherent category in the context of the market in which the goods are sold in.<sup>123</sup> Such an approach would limit the possibility of confusion and account for the “interests of the public or the trade”.<sup>124</sup> In other words, since the process of rewriting a specification interferes with the rights of the proprietor, they must be exercised in a reasonable manner, without compromising the operational integrity of the trade mark registration system. Thus, in *Patissier*, the court also noted that the inclusion of qualifiers in specifications or inclusion of limitations should only be done if it is shown to be necessary in the context of the interests of the party seeking revocation.<sup>125</sup>

When considering an appropriate test for rewriting specifications, it is important to recognise that the specification only determines the formal boundaries of trade mark protection. The extent to which partial revocation would affect the scope of protection depends on “the breadth of the remaining categories of goods or services, the strength of the trade mark and all the surrounding circumstances that influence the assessment of likelihood of confusion.”<sup>126</sup> Thus, it may be that the change in the specification of the trade mark may not affect the scope of protection of the trade mark at all.

In *Charminar Case (SC)*, the Indian Supreme Court, in essence, used the average consumer test and did not rely on any of the taxonomic arguments.<sup>127</sup> The average consumer test is desirable because: (i) infringement also relies on consumer perspective<sup>128</sup>; (ii) since trade marks are public facing, heavier reliance should be placed on public perception when compared to taxonomic arguments. For example, in *Charminar Case (SC)*, reliance on differing trade channels to distinguish chewing tobacco from cigarettes highlights this approach.<sup>129</sup> The time period for which the mark has been used on a particular product is also relevant for determining a fair specification.

The key principles that should be relied upon for determining whether a specification should be rewritten on account of non-use have been helpful laid out in *Patissier* –

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<sup>122</sup> *Id.*

<sup>123</sup> *Id.* at ¶ 79.

<sup>124</sup> *Id.* at ¶ 67.

<sup>125</sup> *Id.* at ¶¶ 77-78.

<sup>126</sup> *Id.* at ¶75.

<sup>127</sup> *Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd.*, (1997) 4 SCC 201, at ¶ 44-50.

<sup>128</sup> *Capitol Records LLC v. Steven Corp Pte Ltd* (2010) SGIPOS 14, at ¶ 39-44.

<sup>129</sup> *Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd.*, (1997) 4 SCC 201, at ¶ 42.

*‘Firstly, the extent to which the registered trade mark proprietor’s pre-existing and future commercial interests are prejudiced by these changes to the boundaries of his intellectual property rights. Secondly, the corresponding strategic benefits potentially reaped by the applicant, who has sought partial revocation of the registered trade mark, from narrowing the scope of the goods or services in respect of which the trade mark was originally registered. Thirdly, the ramifications of the adjustments to the specifications of the registered trade mark on the trade or industry sectors in which the parties are market players. Fourthly, the impact of making the contemplated changes to the trade mark specifications on the average consumer and the public at large.’<sup>130</sup>*

## V. CONCLUSION

In a world where businesses own multiple brands and sell products and services of different descriptions and categories, the question of whether courts should be allowed to rewrite specifications due to partial non-use is an important one. The permissibility of rewriting specifications, and the applicable test to rewrite specifications, will significantly affect the brand protection strategies of businesses and the manner in which specifications are drafted. The establishment of law on these points will provide guidance to applicants of trade marks on the drafting of specifications and lend to the overarching goal of trade mark law to enlarge the field of registrability.

In this paper, the author has outlined the sparse jurisprudence on the questions posed and suggested reliance on jurisprudence from the UK, EU and especially Singapore to decide disputes relating to partial non-use. Given that the IPAB has been dissolved, it is likely that higher courts in India will hear more arguments on the issue of partial non-use. If this is the case, then establishing a clear and cogent test on the basis of which trade mark specifications can be rewritten will be important to provide certainty to proprietors and the public.

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<sup>130</sup> The Patisserie LLP v. Aalst Chocolate Pte Ltd, [2019] SGIPOS 6, at ¶ 80.