

(1954) 04 CAL CK 0016

Calcutta High Court

Case No: A.F.O.O. No. 162 of 1951

Messrs. Hindustan Development
Corporation Ltd.

APPELLANT

Vs

The Deputy Registrar of Trade
Mark and another

RESPONDENT

Date of Decision: April 12, 1954

Acts Referred:

- Trade Marks Act, 1940 - Section 6(1)(d)

Citation: 59 CWN 320

Hon'ble Judges: Chakravartti, C.J; S.R. Das Gupta, J

Bench: Division Bench

Advocate: B. Das and P.K. Sens, for the Appellant; S. Choudhury and P. Ginwala for Respondents, for the Respondent

Judgement

1. This appeal came up for hearing before my Lords the Chief Justice and S. R. Das Gupta, J. The learned Judges differed on certain points. In accordance with Clause 36, Letters Patent the learned Judges stated the points on which they have differed. The points are the following :

1) Whether the word "Rasoi", if and when used as trade mark for the hydrogenated ground-nut oil manufactured by the appellant company, has a direct reference to the character or quality of the goods within the meaning of Section 6(1)(d). Trade Marks Act, 1940 and is, as such, outside the ambit of that clause?

2) If the answer to the first question be in the negative, that is to say, if the true view be that the word "Rasoi" when used as a trade mark for the appellant's oil, cannot be said to have such direct reference, must the mark be still proved to be distinctive in order to be eligible for registration, or should it be taken to be regarded as prima facie distinctive by the Act itself?

3) Whether, even if the word "Rasoi", when used as a trade mark for the appellant's oil, can be said to have no direct reference to the character or the quality of the goods and even if its distinctiveness were to be taken as established, must the word be held to be still ineligible for registration in view of the fact that it is a common word of the language of which no monopoly should be granted to any particular trade?

2. By a determination made by the learned Chief Justice on 4.2.1954 the case has been placed before me.

3. I shall now proceed to deal with the above points in the order stated above.

4. The facts of this case have been fully set out, if I may say so with respect, in the judgment of My Lord the Chief Justice and need not be restated.

5. I shall take the first point first.

6. In order to answer the questions it is necessary to refer to the definition of the word "Mark" and "Trade Mark". The word "Mark" is defined in Section 2(1)(f) as including among other things a "word". The word "Trade Mark" is defined in Section 2(1)(e). Compendiously stated it is a "mark" used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right to use the "mark".

7. Section 6(1) of the Act provides that a trade mark shall not be registered unless it contains or consists of at least one of the several particulars specified in clauses (a) to (e) of the sub-section. The sub-section is couched in the negative form. Its effect is that in order to be eligible for registration a mark must contain at least one of the particulars so specified. In other words, the absence of any one of the particulars will disqualify the mark for registration though the presence of any one of them will not, ipso facto, make the mark eligible for registration. Sections 8, 9, 10 and 14(1) lay down certain other matters which may be taken into consideration in directing registration of a trade mark.

8. The first question which I have already quoted depends upon the true view of Section 6(1)(d) of the Act which provides that a trade mark shall not be registered unless it contains or consists of one or more words having no direct reference to the character or quality of the goods. I shall first construe the clause and then discuss the cases which had been cited before me. The mark in respect of which registration has been applied for is the word "Rasoi".

Section 6(1)(d) will apply if the word "Rasoi" has no direct reference to the character or quality of the goods in question which are hydrogenated ground-nut oil. The word "Rasoi" has a variety of meanings. The Deputy Registrar of Trade Marks has collected from different dictionaries the various meanings of the word "Rasoi". They are cook-room, kitchen, cooking, cookery, cooked-food.

In considering whether a mark has reference to the character or quality of the goods, the mark must be looked at, not in its grammatical significance but as it would represent itself, to the public at large. As the learned Chief Justice points out such a question is a practical question to be decided by the common understanding of the term among those who used it or have occasion to use it in the course of their daily lives and not by what may be recondite meanings to be found in dictionaries. Hence for our present purpose the word "Rasoi" may be taken to mean "cooking".

The requirement of Section 6(1)(d) of the Act is that the word "Rasoi" should have no direct reference to the character or quality of the goods. The word "character" has been defined in Murray's New English Dictionary, Vol. II, Part I, to mean a feature, trait characteristic and the word "characteristic" has been defined to mean a distinctive mark, trait, or feature, a distinguishing or essential peculiarity or quality. It is admitted that the normal use of hydrogenated ground-nut oil is for cooking purposes. The use of the commodity as intended or adapted, undoubtedly forms part of its character. "Philippart v. William Whiteley Ltd.", (1908) 2 Ch 174 at p. 283. To people in the trade and to the consumers, the word "Rasoi" would thus imply a direct reference to the character of the goods.

Mr. Das, learned Counsel for the appellants, contended that the word "character" or "quality" merely denotes something material to the composition of the goods. Reference was made to certain observations of Vaughan-Williams, L.J., - "In the matter of Burroughs Wellcome & Co."s Trade Marks, (1904) 21 RPC 217, known as the "Tabloid Case". The observations relied on are as follows:

"Now I have to ask myself what was the character of this Trade Mark of 1884? What did the word "Tabloid" convey at the moment it was understood at the time it really conveyed to the hearers no peculiar quality of the goods which were offered to the public. I think that the word "Talboid" may properly be described at that time as being a fancy word..... When one is dealing with the question whether a word is descriptive, I think one must always bear in mind that for a word to be really descriptive, it must describe something which is material to the composition of the article to which the trade mark is intended to apply."

9. The observations must be read as a whole. The observations are not intended to imply that the composition of the article is the only material element to be considered in finding out the meaning of the word character or quality of the goods. The observations had reference to the question whether the word "Tabloid" was descriptive or distinctive. This will appear from the observations of the Lord. Justice at page 227.

"I want to say with reference to them, that according to my view, the word "Tabloid" was, in substance, an unknown word at the moment when Messrs. Burroughs Wellcome & Co. adopted it."

The construction suggested by Mr. Das would unduly limit the meaning of the word "character" or "quality". Various words can be imagined as trade mark which have no direct reference to the character or quality of the goods but which at the same time have no connection with the composition of the articles. In my opinion, the word "character" or "quality" of the goods means their nature or peculiarity or quality and not merely their composition.

10. Section 6(1)(d) requires that the reference to the character or quality of the goods must be direct. In order to understand the connotation of the word "direct", reference was made to the previous changes in the Statute law so far as this requirement is concerned. It may be conceded that it is not only legitimate but highly convenient to refer both to the former Act and to the ascertained evils to which the former Act had given rise and to the later Act which provided the remedy. The corresponding provision in English Act of 1938 is contained in Section 9 clause (d) which merely reproduced Section 9(4), Trade Marks Act, 1905.

In the Trade Marks Act of 1888 which preceded the c of 1905, the corresponding provision was contained in Section 6(4)(e) which reads as follows:

"A word or words having no reference to the character or quality of the goods, and not being a geographical name

It thus appears that the word "direct" was introduced by the Act of 1905. the reason for this addition was to give effect to the view taken by the House of Lords in the case of - "Eastman Photographic Materials Co."s Application", (1898) AC 571, known as the "Solio Case" that simply because the word "Solio" suggested the sun, it could not be said that the word "solio" had some reference to the character of the photographic paper known as "solio".

It is true that the introduction of the word "direct" shows that the mere fact that the word "mark" has some reference to the goods does not render it incapable of registration. The Reference must be a direct one. A mere suggestive reference is not sufficient. In the present case the mark "Rasoi" as I have already stated, directly refers to the character of the goods which are used ordinarily for cooking purpose.

11. I shall now deal with the cases which are cited by the Bar.

12. Mr. Das learned Counsel for the appellants relied on the cases of - "In the matter of Compagnie Industrielle Des Petroles"s Application", (1907) 2 Ch 435, known as the "Motorine" case; - "In the Matter of the Trade Mark "Radiation", (1930) 47 RPC 37, known as "Radiation case; - "In the mater of an application by J & P Coats Ltd." (1936) 53 RPC 355, known as the "Sheen" case; and - "In the matter of Boots Pure Drug Co"s Trade Mark "Livron", (1937) 54 RPC 161, known as the "Livron" case.

13. I shall deal with these cases in the order I have stated.

14. In the "Motorine case, the facts were as follows:

In 1901 a company had registered "Motorine" as their trade mark for lubricating oils under that name. In 1907 another Company which had also dealt largely in petrol spirit under the name "Motoricine" applied for registration of "Motoricine" as their trade mark. This application was opposed by the former Company. The applicant Company appealed against the said order and also moved for expunging the trade mark "Motorine" from the Register.

Warrington, J., dismissed the application on the ground that the word "Motorine" had no direct reference to the quality or character of the goods and was therefore eligible for registration u/s 9(4), Trade Marks Act 1905. It was observed that though the word "Motorine" suggests that in some way they are oils which are to be used in connection with a motor, but beyond that it has no reference either to the character or quality and such reference as the use of the two syllables of the word "motor" in the word "motorine" as to the character or quality, seems not to be that direct reference which the Act contemplates.

The decision does proceed on the footing that though the word "motorine" may suggest motors, it did not suggest lubricating oil which was not exclusively used on motors but was used for various other purposes as well. The "Radiation" case, was a decision of the Comptroller General. The word Radiation was used in respect of gas stoves. The word "Radiation" was not descriptive of gas stoves and as such was capable of becoming distinctive by long user.

In Kerly on Trade Marks, 7th Edn. p. 184, the "Radiation" case is said to be a border line case and not one which is likely to be repeated. In the "Sheen" case, the word "Sheen" was proposed for registration as a mark in respect of machine twist or mercerized sewing thread. The Registrar refused registration. On appeal the decision was affirmed by Luxmore J. the judgment of Luxmore J., was affirmed by the Court of Appeal. On a further appeal by the Registrar, Lord Wright observed that the word "Sheen" had become distinctive of the applicant's goods, that the word "Sheen" is not a laudatory word like "perfection" "best artistic" and that in the sewing cotton trade the attribute of glossiness which the word "Sheen" was intended to convey was referred to as lustre and the word "Sheen" was not used with reference to the glossiness of the thread.

In the "Livron" case, the Registrar expunged registration of the mark "Livron" and his decision was affirmed on appeal. On appeal Crossman J., thus observed at page 180:

"In my judgment "Livron" is a word whose only signification is geographical, and hence does not contain the essential particulars in Section 9(4)".

The cases cited by Mr. Das do not support the view that the word "Rasoi" cannot be held to have direct reference to the character and quality of the goods.

15. Mr. Chaudhury, learned Counsel on behalf of respondents, referred to certain cases in support of his submission that very little reference to the character of the goods has been considered sufficient to exclude the applicability of the corresponding Section 9(1)(d) of the Indian Act of 1938 or Section 9(4) of the English Act of 1905.

Reference was made to the cases of - "In Re: Joseph Crosfield & Sons Ltd.: In re : California Fig Syrup Co.; In re : H. N. Brock and Co.", (1910) 1 Ch 130. The case of "In Re Joseph Crosfield & Sons Ltd.", known as " "Perfection" case", related to an application to register the word "Perfection" as a trade mark in class 47 for common soap. This was disallowed by the Registrar and the Registrar's decision was affirmed by Swinfen Eady, J. On appeal the judgment was affirmed.

Farwell, L. J. observed that "Perfection" was not registrable as adapted to distinguish Crosfield soap and that no amount of user could possibly withdraw the word "Perfection" from its primary and proper meaning in the soap trade and make it means Crosfield's and that the word being a mere laudatory word, it was idle to call it a trade mark.

In the "California Fig Syrup Company's case, the learned Judge was of opinion that the evidence given of user was not sufficient to give the trader the exclusive right to "California".

In "H. N. Brock & Co's case", registration was claimed in respect of "Orlwoola". It was held that "Orlwoola" that is, "all wool" cannot be regarded as distinctive, the words are purely descriptive of their nature.

In the case of - "In Re Cassella & Co.", (1910) 2 Ch 240, known as the "Diamine" case registration was applied for in respect of the word "Diamine" on the ground that the applicants have been using the word as a trade mark for their dyes for about 20 years. The application was rejected on the ground that the word "Diamine" was a known chemical term which indicated that the word contained two amine groups. It was held that this fact was sufficient to indicate that registration was applied in respect of goods which contained two amine groups and that the word was descriptive of the character and quality of the goods.

In the case of - "Keystone Knitting Mills Ltd.", (1928) 45 RPC 421, known as the "Charm" case, the word "Charm" was held to have direct reference to the character and quality of the goods when used in respect of ladies stockings.

The case of - "In re R. J. Lea Ltd.", (1913) 1 Ch 446, related to registration of the word "Boardmans" in respect of manufactured tobacco. The word "Boardmans" was surname of an individual. The application was rejected by Joyce J. on the ground that a mere surname of an individual was not adapted to distinguish the goods of the applicant within the meaning of Section 9(5). In appeal the decision of Joyce J., was affirmed.

Reliance was also placed by Mr. Chaudhury on the decision of - "In Re : Application by the National Machinery Co.", (1941) 58 RPC 128 known as the "Dex" case. The application was for registration of the word "Dex" as a trade mark for bolts and screws including deckbolts. The application was refused by the Assistant Comptroller on the ground that the word "Dex" was orally indistinguishable from "decks" and that the "decks" was a perfectly well-known English word in common use and was likely to deceive or cause confusion. It was also pointed out that the word "decks" had direct reference to the character and quality of certain bolts under the terms of para. (d) of Section 9(1).

The decision of the Assistant Comptroller was affirmed on appeal by the High Court and by the Court of Appeal principally on the ground that the discretion of the Assistant Comptroller was exercised properly.

Mr. Chaudhury also referred me to the decision - "In Re. La Marquise Footwear's Application", (1946) 2 All ER 497. The application was for registration of "Oomphies" as footwear for ladies which was allowed by Evershed J., and the ground suggested was that the word "Oomph" was an American slang for sex appeal and that it had no direct reference to the character and quality of the goods. It was observed that

"in approaching a problem of this kind, one has to bear in mind that the Court must consider, as the legislature considered, whether the use of the particular marks in reference to particular goods would embarrass or harass other traders, and it seems to me that, where you take an ordinary word in common use, properly applicable in its ordinary meaning to the class of goods to which it is sought to be applied by the applicant, the Court will not give to the applicant in effect a monopoly of that epithet. Where, however, you take a word which is exceedingly uncommon by comparison, different considerations apply, and, if you say that it has a direct reference, you are going to assume that this word has a much more precise significance and a much greater circulation than, I think on the evidence, it has."

16. Reference to case is not of much help in finding out whether or not a particular word has direct reference to the character and quality of goods unless the decision lays down in principle of construction. The cases merely indicate the length to which the Courts have gone in construing the expression "direct reference to the character and quality of the goods."

17. My conclusion therefore is that the word "Rasoi" has direct reference to the character and quality of the goods and is not eligible for registration. The answer to question No.1 is therefore in the affirmative.

18. I shall now take up the second question. The second question involves an enquiry as to whether the requirement of distinctiveness attaches to each one of the clauses in Section 6(1) including Section 6(1)(d).

Section 6(1)(e) provides that a trade mark shall not be registered unless it contains or consists of "any other distinctive mark, provided that a name, signature, or any word, other than such as fall within the descriptions in the above clauses, shall not be registrable except upon evidence of its distinctiveness" Section 6(1)(a), (b), (c), (d), (e), Trade Mark Act correspond to paras 1, 2, 3, 4 and 5 of Section 9 of the English Act.

In the case of - "In the matter of an Application by Fanfold Ltd." (1928) 45 RPC 325, the question arose whether a mark, in order to be registered under any of the paragraphs of Section 9, Trade Marks Act (which corresponds to Section 6 of the Indian Act) must be distinctive. The question was answered in the affirmative. At p. 331 Lord Hanworth M.R. observed as follows:

"Therefore, the plea that is raised by Mr. Shelle6y that to ask for distinctiveness in para (1) is to ask for something more than the Statute requires, because it enables you to use your name in a special or particular manner, as answered by the difficulties which would arise if a plain name was accepted with the slightest possible addition of some particular or special feature to mark it. In my judgment Tomlin J. came to a right conclusion upon the meaning of the Section 9. I think it does require that there should be distinctiveness. Para (5) says: "Any other distinctive mark". The use of the word "other" seems to be of importance. The paragraph goes on but a name, signature or word or words, other than such as fall within the descriptions in the above paras (1), (2), (3) and (4) shall not be registrable under the provisions of this paragraph except upon the evidence of its distinctiveness". Finally, after the proviso, which does not apply, the words to be found for the purposes of this Section not any particular paragraph or part of a Section - "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons".

The Master of the Roll went on to add:

"The result of that, is this, that in order to be registrable under para (1) you must, first of all, have a name which is represented in a special or particular manner; but (it may be either superadded or interpreting what is meant by "special or particular manner") there must be distinction, and that distinction is required so that there may be an indication that the goods on which the mark is put are the goods of the proprietor, and the distinction must be one which is adapted to distinguish those goods of the proprietor for the purpose of enabling the definition of a trade mark to be fulfilled, a definition to which I have already referred."

19. The above observations clearly support the view that distinctiveness must be proved to exist in respect of the clauses (a) to (e) of Section 6(1). It does not appear as S. R. Das Gupta J. thought that Lawrence answered in affirmative by Lord Hanworth, did not arise in that case. Reference to the judgment of merely reserved his opinion on this question. The same view as to the effect of Section 9(5)

corresponding to Section 6(1)(e) was taken in (1937) 54 RPC 161 at p. 179.

In *Kerly on Trade Marks* at page 105, it is stated that

"Although the paragraphs of Section 9(1) are to be considered as independent, in each case the mark proposed to be registered must not only fall within the terms of at least one paragraph, but must also be distinctive.

The cases above cited have been followed by a Bench of this Court. Harries C.J., and Chatterjee J. in their decision in - "*B. C. L. Ltd. v. Bangodaya Cotton Mills Ltd.*". Appeal No.66 of 1947, D/- 23.6.1949. It was laid down that no trade mark can be validly registered unless it contains at least one of the particulars enumerated in Section 6(1), Indian Trade Marks Act, 1940 and that to comply with the sub-section the particulars relied on must also be distinctive". My conclusion therefore is that even if the word "Rasoi" cannot be said to have such direct reference to the character and quality of the good within Section 6(1)(d) of the Act, the mark "Rasoi" must still be proved to be distinctive in order to be eligible for registration.

20. Question No.2 is answered accordingly.

21. Question No.3 raises the question whether the word "Rasoi" even if it be held to have a direct reference to the character and quality of the goods and to be distinctive would the word "Rasoi" nevertheless be ineligible for registration in view of the fact that it is a common word of the language of which no monopoly should be granted to a particular trader. It is undoubtedly true that the common words, of a language are public property and that no one should be allowed to appropriate one of such words to his exclusive use and thereby deprive other persons of the legitimate right to use the said word.

This was observed by Fry L.J. in the case of - "*In Re : Dunn*", (1889) 6 RPC 379, (Fruit Salt for Baking Powder) and was reiterated by Fletcher Moulton L.J. in (1910) 1 Ch 130, and by Cozens-Hardy M. R. in the same case and by Evershed J., in (1946) 2 All ER 497 ". The above observations are however to be read as not imposing an absolute bar to the registration of a common word as a trade mark.

The principles laid down in the above case would ordinarily disentitle the applicant to have a common word registered. In exceptional circumstances the rule may however be inapplicable viz., where the common word has lost its primary meaning by long user of the word by a trader in relation to his goods and has become identified with the particular goods of that trader. In such a case the principle above enunciated will not be applicable.

In the present case however the word "Rasoi" has not become distinctive of the applicant's goods and as such it is also ineligible for registration on the ground that no trader can have ordinarily a monopoly of an ordinary word of the language.

22. Question No.3 is answered accordingly.

23. Costs will abide the result. Certified for 2 Counsel.