

(1978) 11 CAL CK 0028

Calcutta High Court

Case No: Appeal from Original Order of Deputy Registrar No. 560 of 1968

G.D. Pharmaceuticals Pvt. Ltd.

APPELLANT

Vs

Registrar of Trade Marks

RESPONDENT

Date of Decision: Nov. 7, 1978

Acts Referred:

- Trade and Merchandise Marks Act, 1958 - Section 15(1), 15(2), 18, 18(4), 4(1)
- Trade Marks Act, 1905 - Section 10, 10(2), 11, 12(2), 19
- Trade Marks Act, 1938 - Section 13, 30, 8

Citation: 83 CWN 302 : (1978) 2 ILR (Cal) 514

Hon'ble Judges: Sabyasachi Mukharji, J

Bench: Single Bench

Advocate: Somenath Chatterjee and Anindra Mitra, for the Appellant; N.C. Roy Chowdhury, for the Respondent

Final Decision: Allowed

Judgement

Sabyasachi Mukharji, J.

This is an appeal from the decision of the Deputy Registrar of Trade Marks dated May 14, 1968, whereby the Deputy Registrar has rejected the application by the Appellant for registration in Pt. A of the Register of a trade mark consisting of the mark "Jidi" in Class 5, in respect of "medicinal preparations". Without advertising the said application on the objection of the registry the application for registration was rejected by the Deputy Registrar u/s 18(4) of the Trade and Merchandise Marks Act, 1958. The said sub-section of Section 18 authorises the Registrar to refuse an application subject to the provisions of the Act.

2. The Deputy Registrar was of the view that the expression "Jidi" was phonetically equivalent to the letters "G.D." and as such, was not registrable except upon evidence of distinctiveness and as according to the Deputy Registrar the mark was used only for a few months no evidence of distinctiveness was possible. The Deputy

Registrar was of the view that as the mark was phonetically equivalent to the letters "G.D." was not considered to be prima facie adopted to distinguish except upon proof of the distinctiveness which according to the Deputy Registrar was not there.

3. On behalf of the Appellant reliance was placed on d.(b) of subs(5) of Section 9 of the Act. The said sub-section reads as follows:

In determining whether a trade mark is distinctive or is capable of distinguishing as aforesaid, the Tribunal may have regard to the extent to which (a) a trade mark is inherently distinctive or is inherently capable of distinguishing as aforesaid; and (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact so adopted to distinguish or is in fact capable of distinguishing as aforesaid.

4. The Appellant contended that there were other circumstances or special circumstances and in support of this contention reliance was placed on the registered trade marks Nos. 14609 and 149774. These two trade marks were registered in favour of the Appellant, the first one being since 1943 and the second one since 1951. The Registered Trade Mark No. 14609 consisted of the word "Asmolin" in bold letters appearing at the centre of the mark with a device of an elephant head appearing at the top thereof. From the tusk of the elephant hangs a small board with the letters "G.D." appearing thereon according to the Deputy Registrar in an insignificant manner.

5. I have looked at the mark. The letters are very small. The Deputy Registrar felt that the letters "G.D." appeared on the mark in such small dimensions that no special importance could be attached to them and therefore, the said mark was registered with the claim "G.D." without any disclaimer in respect of the fact that there was no evidence of distinctiveness. The Appellant had claimed before the Deputy Registrar that as no disclaimer was required and as the letters "G.D." was included in the said Registered Trade Mark 14609 in favour of the Appellant the Appellant was entitled to the exclusive use of the said two letters.

6. In this connection the Deputy Registrar has relied on Sub-sections (1) and (2) of Section 15 of the Act which is to the following effect:

(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and the part as separate trade marks,

(2) Each such separate trade mark shall have all the conditions applying to and have all the incidents of, an independent trade mark.

The Deputy Registrar rejected the claim of the Appellant and observed:

In the first place" it is not the registration of the letters "CD." but of the expression "Jidi" which the Applicants seek. In obtaining registration of their trade mark No.

14609, the Applicants had not furnished any evidence of distinctiveness for the letters "CD." Therefore, if the Applicants now come out with a claim for registration of the letters "G.D.", it would be mandatory upon them to produce satisfactory evidence of distinctiveness for them. The same principle applied to be question of the expression "Jidi". As the letters "G.D." have not been registered by themselves on satisfactory evidence of distinctiveness the Applicants' contention that the expression "Jidi" has become distinctive on the basis of the alleged distinctiveness of the letters "G.D." is not acceptable and fails.

7. The Appellant also claimed that since 1967 upto 1964 the Appellants were the owners of the following marks with the prefix "Jidi".

Application No.	Goods
Word "Jidithalin"	178539
Registered	
Word "Jidithalin"	189561
Word "Jidithalin"	196737
Word "Jidithalin"	225612
Application No.	andnbsp;
Word "Jidithalin"	227654
pending	
Word "Jidithalin"	227655

8. Before the Deputy Registrar on behalf of the Appellant reliance was placed on the "Vezeet" case (1), but the Deputy Registrar mainly relied on the "Parker-Knoll" case (2). The Deputy Registrar held, inter alia, as follows:

The mere fact that the Applicant's marks contained the same prefix "Jidi" cannot be deemed to be special circumstances enabling them to register that prefix per se, when that prefix is the phonetic equivalent of the letters "G.D." and when the alleged user thereof prior to the date of the application for registration thereof is too meager and short for the prefix to have acquired distinctiveness or become capable of distinguishing. The two Registered Trade Marks Nos. 14609 and 149774 are both composite marks containing the letters "G.D." and the mere registration of those marks does not give them an exclusive right to the use of the letters "G.D." per se or the prefix "Jidi" per se, which is the phonetic equivalent of those letters, as a separate mark by itself. The "Vezet" case is not much in point. The authority applicable to the facts of the present case is the "Parker-Knoll" case, where, despite the registration of "Parker-Knoll" by the Registered proprietors, the Register was rectified in respect of the trade mark consisting of the word "Knoll" registered by them, by removing that mark from the Register as it had not acquired distinctiveness on the date of the registration and had never been used as a trade mark by itself. Inasmuch as the Applicants had never used by itself as a separate

and distinctive mark the expression "Jidi" except from January, 1965, there can be little or no evidence of distinctiveness in respect of the application for registration filed by them on 15th September, 1965. The user of the mark till that date being about 8 and $\frac{1}{2}$ months (even this user is not proved) is too insufficient for the goods bearing the mark to have been introduced in most of the markets in India, much less in the mark to have acquired distinctiveness or to have become capable of distinguishing. Phonetic equivalents of mere letters are treated on the same footing as those letters and are not registrable, whether in Part A or Part B of the Register, except on the evidence establishing that the mark has acquired distinctiveness or become capable of distinguishing by long and extensive user prior to the date of the application.

Accordingly, u/s 18(4) of the Act the application was refused because of the bar u/s 9 of the Act.

9. It is indisputable that under the Act the Registrar has a discretion to grant or not to grant registration and provided that such decision or discretion has been exercised on valid grounds the Courts do not interfere with such discretion or decision. I have already set out Sub-section (5) of Section 9 of the Act, Sub-sections (1) to (4) of Section 9 of the Act provide as follows:

9. Requisites for registration in Parts A and B of the register:

(1) A trade mark shall not be registered in Part A of the register unless it contains or consists of at least one of the following essential particulars, namely:

(a) the name of a company, individual or firm represented in a special or particular manner;

(b) the signature of the Applicant for registration or some predecessor in his business;

(c) one or more invented words;

(d) one or more words having no direct reference to the character or quality of the goods and not being according to its ordinary signification, a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in India;

(e) any other distinctive mark.

(2) A name, signature or word, other than such as fall within the descriptions in Clauses (a), (b), (c) and (d) of Sub-section (1) shall not be registrable in part A of the register except upon evidence of its distinctiveness.

(3) For the purposes of this Act, the expression "distinctive" in relation to the goods in respect of which a trade mark is proposed to be registered, means adopted to distinguish goods with which the proprietor of the trade mark is or may be

connected in the course of trade from goods in the case of which no such connection subsists either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(4) A trade mark shall not be registered in part B of the register unless the trade mark in relation to the goods in respect of which it is proposed to be registered is distinctive, or is not distinctive but is capable of distinguishing goods with which the proprietor of a trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

10. The main question involved in this appeal is whether the Deputy Registrar has correctly applied the tests for determining "other circumstances" in Clause (b) of Sub-section (5) of Section 9 of the Act. The point that perhaps requires emphasis is that user of the trade mark is not synonymous with "other circumstances". Bearing the above point it is necessary to examine several decisions where this aspect has been examined.

11. In the case of *Imperial Tobacco Company v. Registrar of Trade Marks* AIR 1947 Cal. 415 the Court observed as follows:

In determining whether the mark is distinctive or capable of distinguishing, the Tribunal shall have regard if the mark is inherently capable of distinguishing as aforesaid. If, not the Tribunal will further examine if by reason of use or other Circumstances, the trade mark has in fact become distinctive (as adapted to distinguish) or capable of distinguishing as aforesaid. All the same the Tribunal will refuse registration in respect of either part of the register if the trade mark is inherently incapable of being distinctive or inherently incapable of distinguishing the goods of the Applicants from others. Such reasons obviously are the disabilities violating the provision of Clauses (c), (d) and (e) of Sub-section (1) of Section 9 of the Act which again may not be exhaustive. The Courts of law have further imposed the condition that no trade mark should be allowed to be registered which may hamper or embarrass the traders or trade now or in future in respect of the place or country in which it is proposed to be registered.

The Court also observed as follows *Supra* (421):

If however the mark has no inherent distinguishing qualities or features, the distinctiveness may be acquired by appropriate user or other circumstances thereby overcoming the negative quality in the mark. Here again the Tribunal has been given the discretion to register a mark in the B Part of the register taking into account the extent of the distinctiveness or capability of distinguishing the Applicant's goods from others in fact acquired by reason of the use of the trade marks or other circumstances. There is thus actually no question of exclusion of one

clause by another in Sub-section (5) of Section 9 but all relevant factors are to be taken into consideration by the Tribunal who as an expert will exercise his discretion in the light of the provisions of law and judicial interpretation thereof.

12. It is, secondly, important to bear in mind that though the word "Jidi" is phonetically similar (if not equivalent in Indian pronunciation) and though it is not an invented word it can be considered to be a "coined word" which has formed part of the registered trade mark of the Appellant in respect of similar "medicinal preparation" registered during 1957 to 1964.

13. In this connection reference may be made to the decision in the case of "Flowstacka" (1968) R.P.C. 66 trade mark where an application to register the mark "Flowstacka" in relation to machines for lifting, loading and transporting goods was refused by the Registrar on the ground that the mark had a direct reference to the character and quality of the goods, although he indicated that he would be prepared to advertise the mark before acceptance for registration in Pt. B of the register. On appeal to the High Court, the Registrar did not object to the Applicants' filing evidence of the extent of their use of other marks beginning with the letters Flow and of their reputation in the trade, which showed that the Applicants' range of goods bearing a variety of marks beginning with Flow were very well known in the mechanical handling Article It was held:

(1) that although the word Flowstacka was rightly regarded by the Registrar as a combination of the words "flow" and "stacker", the evidence showed that many people in industry if confronted with the mark would have associated it with the Applicants' goods. But to some people the mark would be descriptive of the function of the machine and therefore the Registrar had rightly found that the mark should be rejected u/s 9(1)(d) because it had a direct reference to the character and quality of the goods.

(2) That the mark, nevertheless, qualified for registration in Part A of the register as being, on the evidence, adapted to distinguish the Applicants' goods within Section 9(1)(e). Applying the recognised test of inquiring whether other traders would without improper motive desire to use the mark, or one resembling it, it appeared in the present case, taking into account the Applicants' numerous registrations of marks with the Flow prefix, that such improper motive would be suspected if any other traders sought to use a similar mark for their goods.

Accordingly the appeal was allowed. Cross J. observed as follows Supra (72-73):

The word Flowstacka, although not an invented word and though, as I assume, referring directly to the character of the goods, is not an ordinary English word or an ordinary combination of two English words. It is a "coined" word, just as was the word Trakgrip in Dunlop Rubber Company's Application, (1942) 59 R.P.C. 134. Trakgrip was not an invented word and it clearly referred to the character and quality of the goods in question, namely, the power of holding the power of holding

the surface of the road or track which the tyres in question were supposed to possess. Nevertheless the Judge held that the word Trakgrip was distinctive and not merely descriptive. The test which he applied was that suggested by Lord Parker in *Du Cross Ltd.'s Application*, (1913) 30 R.P.C. 660, namely, whether other traders are likely in the ordinary course of their business and without any improper motive to desire to use the same mark or some mark nearly resembling it upon or in connection with their own goods.

Applying that test, I think that this mark is inherently adapted to distinguish the Applicants' goods. To my mind, Flowstacka is not a mark which other traders would be likely in the ordinary course of their business and without improper motive to use in connection with machines for handling goods. Indeed, having regard to the number of Flow marks already used by the Applicants, I should suspect that any manufacturer who wished to use the word was actuated by an improper motive.

Turning to Sub-section (3)(b) there was, as I have said, no evidence before the Registrar of any user of this mark by the Applicants before the date of application. Were then there any other circumstances tending to show that the mark was in fact adapted to distinguish the Applicants' goods? To my mind, the fact that the Applicants had been for a number of years before the application to register this mark using many other marks with the Flow prefix in connection with other goods of a broadly similar character is a circumstance which tends to show that this Flow mark is in fact adapted to distinguish the goods of the Applicants in respect of which they seek to register it.

In the result, therefore, I shall direct the Registrar to proceed with the registration.

14. In the case of *British Petroleum Company Ltd. v European Petroleum Distributors Ltd.* (1968) R.P.C. 54 the Plaintiffs had marketed petrol and oils under five registered trade marks all comprising the letters B.P. with varying surrounds and a sixth trade mark for the letters B.P. alone. By this action they alleged infringement of these registered trade mark by the Defendants, distributors of cut-price petrol under the mark B.P. The Defendants in their counter claim attacked the validity of the Plaintiffs' sixth mark (the other marks, registered for more than seven years, being protected by Section 13 of the Trade Marks Act, 1938) They contended, that the mark was not distinctive and should never have been registered and that it was deceptive as suggesting a connection in the course of trade between the proprietors of the mark and the petrol sold under it, whereas the petrol was sold by an associate company of the Plaintiffs' and although the other five marks were the subject of a registered user agreement, the sixth was not. It was held that (1) that a two-letter mark could be registered on proof of user for a substantial time over the whole country, which proof had doubtless been given at the time of the registration of the first B.P. mark. Referring to *Kerry on Trade Marks* (9th ed., 1966, para. 283) where it was said that since the *W and G*. case, two-letter marks are not registered the learned Judge observed that as a mere matter of fact that was not so;

but further the learned Judge was of the view that it was not right to say that no two-letter mark ought ever to be registered. The learned Judge further held that as there was a subsisting trade connection between the Plaintiffs and their associated companies and the mark was in fact used under the same conditions and restrictions as were the marks which were the subject of registered user agreements, it was irrelevant that there was for some time no registered user agreement in respect of the sixth mark. It was, further, held that for the determination of the issue of infringement u/s 4(1) it had to be decided whether the marks so nearly resembled each other as to be likely to deceive or cause confusion, it being irrelevant here, in contrast to an action for passing off, whether or not the Defendant accompanied his user of the offending mark with other material to indicate that there was no trade connection between his goods and the registered proprietor. In the circumstances of the retail petrol trade the likelihood of confusion appeared remote, there was no evidence of confusion and accordingly the action for infringement, as well as the counterclaim for rectification were dismissed. It was observed by Cross J. as follows:

In considering whether or not the mark is inherently adapted" to distinguish the goods it is relevant to ask oneself whether and to what extent if the proposed mark was not given a statutory protection other producers of the goods would be likely in the normal course of events to wish to use the mark themselves. In the case of a mark consisting simply of letters of the alphabet the answer to this question must depend to a large extent on the number of letters and the parity of the combination the "W and G" case [du Cross" Application, (1913) 30 R.P.C. 660] decided under the Act of 1905 the House of Lords considered the question in relation to a two-letter mark consisting of two common initial letters W and G. There the user was proved for some five years, but only in the London area. Registration was refused, but as I read the judgment and in particular the speech of Lord Parker---that was not because the letters W and G were thought to be so inherently unadapted to distinguish the goods in question (taxi cabs) as to make registration in principle impossible, but because the user proved, specially as regards area, was thought not to be enough to justify registration in a case where the inherent distinctiveness of the mark was so slight. In Kerly on Trade Marks (9th ed., 1966, para, 283) it is said that since the W and G case two-letter marks are not registered. This case shows that as a mere matter of fact that is not so; but further I do not think that it is right to say that no two-letter mark ought ever to be registered. Of course, if the letters constitute a common combination, as they do in this case, the mark ought only to be registered on proof of user for a substantial time over the whole country, but no doubt proof of such user was given when the first B.P. mark was registered in 1921. 15. Leaving aside for the present the two cases, namely the Vezeet's case (Supra) and the Parker-Knoll case (Supra) which I shall discuss later, it may be relevant to discuss the other cases to which my attention was drawn. My attention was drawn to the decision in the case of the Registrar of Trade Marks v. W. and G. Du Cross Ltd.

(1913) A.C. 624. There motor cab proprietors in London applied for registration as trade marks for motor vehicles of two marks used by them for about three years on and in connection with their motor cabs in London. One mark consisted of the letters "W and G" (joined by the copulative symbol "and") written in a running hand with a distorted tail to the "G" ending up under the "W" The other mark consisted of "W and G" in ordinary block letters. These marks had become in fact distinctive in the London district but not elsewhere. The Registrar refused the applications. On appeal it was held that the marks were not distinctive within the meaning of the word in Section 9, Sub-section (5), of the Trade Marks (sic) 1905 and were therefore not registrable. In that case (Supra) Lord Parker observed as follows:

My Lords, if either mark be registrable, it must be because it is a distinctive mark within the meaning of Section 9, Sub-section 5, of the Act. "Distinctive" is defined as meaning "adapted to distinguish the goods of the Applicant for registration from the goods of other persons". This definition is found for the first time in the Act of 1905. But the word "distinctive" was, I think, used in all the earlier Acts in the sense of "adapted to distinguish". The difficulty lies in finding the right criterion by which to determine whether a proposed mark is to be considered on the hypothesis that it will be admitted to registration and in conjunction with the monopoly of user which such registration confers. I can imagine no mark which would not be adapted to distinguish the goods of the proprietor from those of other persons. Nothing could be better adapted for this purpose than some letter or combination of letters which no one else was at liberty to use. In my opinion, in order to determine whether a mark is distinctive it must be considered quite apart from the effects of registration. The question, therefore, is whether the mark itself, if used as a trade mark, is likely to become actually distinctive of the goods of the person so using it. The Applicant for registration in effect says, "I intend to use this mark as a trade mark, i.e., for the purpose of distinguishing my goods from the firasp of other persons" and the Registrar or the Court has to determine before the mark be admitted to registration whether it is of such a kind that the Applicant, quite apart from the effects of registration is likely or unlikely to attain the object he has in view. The Applicant's chance of success in this respect must, I think, largely depend upon whether other traders are likely in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods. It is apparent from the history of trade marks in this country that both the Legislature and the Courts have always shown a natural disinclination to allow any person to obtain by registration under the Trade Marks Acts a monopoly in what others may legitimately desire to use. For example, names (unless represented in some special manner) and descriptive words have never been recognized as appropriate for use as trade marks It is true that they became registrable for the first time under the Act of 1905, but only if distinctive and they cannot be deemed distinctive without an order of the Board of Trade or the Court. This registration does no apply to marks consisting of a letter or combination of

letters, but before such a mark be accepted the Registrar or the Court has to be satisfied that it is adapted to distinguish the goods of the Applicants from those of others. It need not necessarily be so adapted and whether it is or is not so adapted appears to depend largely on whether other traders are or are not likely to desire in the ordinary course of their business to make Use in connection with their goods of the particular letter or letters constituting the mark.

Though the aforesaid observations are relevant and instructive the facts of the case before the House of Lords were entirely different.

16. In the case of *In the Matter of Garrett's Applications* 35 R.P.C. 117 the facts were as follows:

In 1898 (sic) trading as Osborne, Garrett and Company, registered "Ogee" as a Trade Mark in Class 12 for cutlery and edged tools. In 1903 he registered the same Mark in Class 2 for chemical substances used for sanitary purposes and in Class 8 for apparatus for razors, scissors, etc. in 1915 he applied to register "Ogee" as a Trade Mark in Class 3 for chemical substances used in pharmacy, in Class 48 for perfumery and in Class 50 for hair frames and miscellaneous articles. The application was refused by the Registrar of Trade Marks, who held that the Mark was a mere spelling out of the letters "O.G." the initials of the Applicant's trade name and that letters were not registrable as distinctive marks. He refused registration on this ground u/s 9 of the Trade Marks Act 1905 as well as in the discretion vested in the Registrar. "Ogee" is a word found in Dictionaries and is a well-known term in architecture and carpentry, meaning a moulding with a double-curved line. The Applicant appealed to the Court. It was held, that "Ogee" prima facie meant the Dictionary word and that having regard to the long use of the word by the Applicant and his registrations of it in other Classes, the present registration ought to be allowed on the Applicant disclaiming any exclusive right to the letters "O" and "G" or either of them by virtue of the present registration. From this decision the Registrar appealed to the Court of Appeal and it was held that the Registrar has a discretion under Sub-section (2) of Section 12 of The Trade Marks Act, 1905, to refuse or to accept an application to register; that the discretion was now to be exercised by the Court, but the discretion of the Registrar would not be lightly interfered with and that his discretion had been rightly exercised; that the mark in the present case appealed to the ear as well as to the eye and therefore confusion might arise and that the disclaimer did not improve the Applicant's position.

Lord Cozens Hardy M.R. observed Supra (122) as follows:

A question of general importance was argued before us, namely, whether in a case like this the Registrar has any discretion. The mark falls u/s 9, paragraph 4, as a word having no direct reference to the character or quality of the goods and it is argued that the Registrar is bound to accept the application unless the case falls

within the terms of Section 11 or Section 19. In my opinion this contention ought not to prevail. There is no absolute right to registration of a Trade Mark. Section 12, Sub-section 2, is express : "Subject to the provisions of this Act the Registrar may refuse such application or may accept it absolutely or subject to conditions, amendments, or modifications". The words are clear. The Registrar must not disregard Section 9 which defines the essential particulars of a registrable Trade Mark, nor must he disregard the prohibitory Sections 11 and 19. But subject to these limitations he has a discretion either to refuse or to accept; this is my view apart from authority.

Philimore L.J. observed *Supra* (126, 127) as follows:

It appears to me, therefore, that the Registrar legitimately exercises his discretion when he considers, in an application made under paragraph 4, whether or not the mark is so distinctive that it will not only escape the prohibition of Section 11, but be in fact not likely to give occasion to confusion in the case of another trader using, as he legitimately may, his own initials. This leaves one further division of the first point to consider. In doing so, should we have regard to the ear as well as to the eye? That where a proposed Trade Mark consists of words descriptive of a device which has been already registered this may be a good ground for refusing registration or even for expunging a Trade Mark already registered, is shown by the "Red Star" case (11 R.P.C. 142) and the "Golden Fan" case (13 R.P.C. 288) which were both decisions of this Court. Whether a word the sound of which also represents the sounds of two initials is within this principle is more disputable. In the "Vezet" case (22 R.P.C. 568) decided in 1905 it appeared that the Dutch pronunciation of the letters "V.Z." would be "Vezet". But in the circumstances of the case, which were somewhat special and having regard to the fact that the sound was a Dutch and not an English one, Lord Justice Warrington (then Mr. Justice Warrington) overruled the Registrar and allowed the registration, taking a disclaimer or condition similar to that which was offered in the present case, namely, that the Applicants did not claim to prevent the use of initials. I think that all that can be said upon this subject is that the similarity to the ear may always be a ground for the exercise of discretion in the direction of refusal. Now I come to the second point which was raised before us, whether, in the exercise of our discretion, we should allow this application for registration to proceed. The case is a very special one. There are few words which correspond with special initials. There are more combinations of words which would correspond. Thus "Double you and gee" "Doubled you and see" or some sentences with the pronoun T such as "I see", might out of initials. I do think that it ought to matter that the word happens to correspond with the initials of the Applicant's firm. If his firm had been Smith and Robinson the same conditions ought, I think, to apply. No doubt the fact that the words do spell the initials of the Applicant's firm may have opened the eyes of the Registrar; still I think that is immaterial. I have been in considerable doubt on this question of discretion. The Applicant's word is a real though rare

word. He has the judgment of Mr. Justice Sargant in his favour and he has had this very Trade Mark Registered in other Classes. On the other hand, this is a-matter of practical experience where the judgment of the Registrar is of great weight. It was a mistake, I think, of Mr. Justice Sargant to say that the Registrar had misdirected himself. On the whole I rather submit myself in this matter to the judgment of the other members of the Court, who have had greater experience in these cases and I concur with them in allowing this appeal.

17. In the case of "Esso" Trade Mark (1972) R.P.C. 283 there was an application made to Registrar in respect of tyres for vehicle wheels and parts and fittings for land vehicles and watercraft, the letters "Esso" within an oval border, the "E" being in a form of script and the mark being limited to specified colours. There being no use of the mark on the goods applied for, the Registrar proceeded on the basis that he had only a prima facie case to consider, although there were already on the register, in respect of a fairly wide range of goods, a large number of trade marks consisting of "Esso" within an oval border, some of them in the colours of the mark applied for. The Registrar refused registration on the basis that, inasmuch as the ear as well as the eye had to be considered, the application was in effect one to register "S" and "O" and that those letters were not inherently capable of distinguishing. On appeal to the Court the Applicants argued that the mark applied for had an inherent capacity to distinguish and also that the Registrar had been wrong in treating it as a prima facie case. They were allowed by the Court to file evidence as to their previous registrations and as to their extensive use of the mark "Esso" for motor fuel and oil. It was held allowing the appeal in part, (1) that this was a case where at least there was some inherent capacity to distinguish and in which there were other circumstances proper to be considered. It was relevant to consider under "other circumstances" in Section 10 the undoubted extensive use of the trade mark Esso for very many years prior to the application in relation to certain classes of goods, notably motor fuels and lubricants and it was further held that the application should be allowed to proceed as to cover those categories of goods, falling within the specification of the application, that could on a reasonable basis be said to be fairly closely allied to the pre-existing fields of the Applicants' activities. Having regard to the evidence, the application was allowed to proceed in respect of tyres for vehicles wheels. Whitford J. observed *Supra* (289, 290) as follows:

Now this being a "B" mark, the question to be considered is whether it is capable in relation to the goods which I have specified of distinguishing the goods of the Applicants and Sub-section (2) of Section 10 says that, when this question is considered, regard must be had to the extent to which the trade mark is (a) inherently capable of distinguishing and (b) by reason of use or other circumstances in fact capable of distinguishing. The hearing officer came to the conclusion that, inasmuch as the ear as well as the eye had got to be considered, this was a case which consisted essentially of what could be considered as being an application to register the letters "S" and "O" and that these letters were not inherently capable of

distinguishing and that might on one view of the matter have been enough to decide this case. I say that because counsel for the Applicants proceeded in this appeal upon this basis, that, if one applies the reasoning of the House of Lords in *Yorkshire Copper Works Ltd.'s Application*, (1954) 71 R.P.C. 150, which was an application u/s 9 of the Act to register a trade mark "Yorkshire", it is plain that, if one is to succeed, there must at least be some inherent capacity to distinguish and unless there is, there is no point in going forward further to consider whether by reason of use or special circumstances the mark is capable of distinguishing or, in the terms of Section 9, adapted to distinguish. It appears to have been accepted in the House of Lords when the "Yorkshire" case was argued that the case would have been the same if the application in that case had been an application u/s 10 and the Yorkshire case was considered and decided upon the assumption that the Void was established by evidence as being 100 per cent distinctive in fact of that particular Applicant's goods. There had been a long use in that case, so that, if one merely looked at the question of use, then the conclusion must be that the mark was adapted to distinguish, but it was held, being a geographical name, that it was not inherently adapted to this end and this is the reason why it was refused.

I have come to the conclusion in this particular case that there is a certain inconsistency so far as this ground of objection is concerned between the finding which has been made as to whether the mark is inherently capable and the already existing registrations of the mark. These include both "IV" and "A" registrations and if in fact the decision of the hearing officer in the case under review were right, it must, I think, follow so far as the earlier registrations are concerned that they ought never to have been admitted, because none of them could be any more inherently capable of distinguishing than the present application; not one of them was inherently adapted to distinguish.

Over and beyond that of course it may be possible that none of the other marks should ever have been admitted to registration. If one merely considers the mark, I take the view, which was quite plainly I think taken by all the Judges who considered the W and G case in the *Ogee* case to which I have already referred, that that case does not lay down any rigid rule which would lead to this conclusion, that marks consisting of two letters can never be registered. There are of course substantial differences between the mark that was being considered in the W and G case, which was the letters simpliciter conjoined by the ampersand and the present case, which consists of what could be described as a four letter word, if I may be permitted to use the expression, which may or may not be taken in speech to be no more than the equivalent of the two letters "So". The House of Lords in the W. and G. Application were basically concerned with the difficulty that might arise by reason of the fact that the use of these initials by persons who had names with these initials and they instanced, for example, Mr. William Green, or a firm such as Weston and Gibbs, might be precluded by the registration sought.

So far as any question of general principle is concerned, Lord Parker observed *Supra* (672):

In my opinion, in order to determine whether a mark is distinctive it must be considered quite apart from the effects of registration. The question, therefore, is whether the mark itself, if used as a trade mark, is likely to become actually distinctive of the goods of the persons so using it. The Applicant for registration in effect says, "I intend to use this mark as a trade mark, i.e., for the purpose of distinguishing my goods from the goods of other persons" and the Registrar or the Court has to determine, before the mark be admitted to registration, whether it is of such a kind that the Applicant quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The Applicant's chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.

Thereafter, discussing the evidence the learned Judge observed *Supra* (292) as follows:

Having concluded, as I have, that this is a case where at least there is some inherent capacity to distinguish, I have also concluded that this is a case in which there are other circumstances proper to be considered which would appear to me to point to the conclusion that this application for registration should in part at least be allowed to proceed.

I can well understand that the Officer who acted for the Registrar at the hearing came to the conclusion which he in fact reached upon a wholly different basis of presentation to the basis which has been argued before me and I have unfortunately, therefore, not had the opportunity of his views upon the case presented as it was presented to me. It was, however, indicated that it would be desirable both from the point of view of the Applicants and the Registrar that the matter should be dealt with upon the basis on which it was argued in this Court.

The conclusion to my mind must be this, that the present application should be allowed to proceed so as to cover those categories of goods falling within the specification of the present application which can on a reasonable basis be said to be fairly closely allied to the pre-existing fields of the Applicants' activities.

18. It now remains for me to discuss the two cases which have been elaborately discussed by the Deputy Registrar. In the case of *In the matter of Verschure and Zoon's Application to Register a Trade Mark Supra* of the facts were as follows:

A firm of Dutch cheese merchants, carrying on business in London, applied to register the word "Vezet" as a trade mark for cheese. The letters "V Z" were the initials of the firm-name and in Dutch would be pronounced "Veezet" and the

Comptroller refused registration on the ground that the word was only the equivalent of the Dutch letters. The Applicants were the registered proprietors of a trade mark consisting of the letters "V Z" registered as an old mark. It was held that, in view of the exclusive rights conferred on the Applicants by their old mark, the objections to the mark ought not to prevail; and that the application should be proceeded with, a condition, however, being made that the Applicants should not claim by virtue of the registration of the word "Vezet" the right to restrain the use of the letters "V Z".

Counsel for the Applicant as it appears submitted as follows and Mr. Justice Warrington observed Supra (372) in respect thereof as follows:

Parker. The Court has power to make conditions as to the registration. I would obviate my objection if your Lordship said that this mark should only be registered on condition that the Applicants do not claim by virtue of the registration of this mark to prevent the use of "V Z". That should show their bona fides and it would obviate my objection. Of course, that would leave them with what rights they have under the old mark. We so often find and it might be although I am not saying so in this case, because I do not know, but it might be that they were only applying for this simply and solely because they knew they could not enforce the other.

Warrington J. They are not to claim under this registration, but it will not affect their rights under the other registration. I think that is quite right and reasonable.

19. The Deputy Registrar came to the conclusion that "Vezet" cause does not apply to the instant case. I will discuss the several reasons indicated by the Deputy Registrar for his conclusion. Supra (372). The Deputy Registrar has opined that the Vezet's case was decided in 1905 by a learned single Judge while "Parker-Knoll" case was decided in 1961 by the Court of Appeal in England. I am unable to attach much significance of this fact on which emphasis has been laid by the Deputy Registrar. Neither the decision of the learned single Judge nor the decision of the Court of Appeal in England is of any binding force on us. But the observations in the said decisions so far as they are material and relevant to our present case are entitled to highest respect and consideration. From that point of view in my opinion the "Vezet" case is more appropriate than the facts involved in "Parker-Knoll" case. The Deputy Registrar has also emphasised that the law followed in Vezet's case was based on the U.K. Trade Marks Act of 1888 whereas the law applied in Parker-Knoll case is based on 1938 U.K. Act and the Deputy Registrar thought that the provisions of the later Act were more akin to the present Indian Trade Marks Act than the old U.K. Act of 1888. So far as the principles to be applied in deciding the controversy in this case and the claim of the Appellant involved, in my opinion, the difference in the provisions of the two respective Acts in England referred to by the Deputy Registrar is not of any significance or of any material significance. Therefore, this aspect of the reasoning of the Deputy Registrar cannot, in my opinion, be supported. (2) The Deputy Registrar has also observed that the word "Vezet" was regarded as an

invented word or a non-descriptive word whereas in the present case the Applicants themselves had conceded that "Jidi" was phonetically equivalent to "G.D." [See p. 18, lines 10 to 20 of the Paper Book*]. The Deputy Registrar on this aspect completely ignored the fact that the word "Jidi" even if it is not a word of description or an invented word is certainly a word which can be described to be a coined word. The Deputy Registrar has, further, observed that if the letters "G.D." by themselves had been registered on evidence of distinctiveness then possibly the "Vezet" case might have been to the point in the instant case before me. The Deputy Registrar on this aspect, completely, in my opinion ignored that the fact that Registered Trade Mark 149774 consisted of the name "G.D." and Company and that mark was accepted for registration on the basis of evidence of distinctiveness. The Deputy Registrar was of the opinion that the evidence in respect of "G.D." and Company could not be regarded as relevant for "G.D." much less for Jidi.

20. The fundamental error into which the Deputy Registrar fell, in my opinion, seems to be that in considering whether there are other circumstances as indicated in Clause (b) of Section 9(5) of the Act, the different items of evidence could not and should not be regarded piecemeal but should be considered in totality in conjunction with each other. I agree with the Deputy Registrar in so far as he says that the registration of the name "G.D. and Company" by itself could not be regarded as sufficient evidence of distinctiveness of the phonetically similar word "Jidi". But as I have indicated before that factor could not and should not be taken into consideration in isolation. On the other hand it is apparent that the trade mark Nos. 178539, 189561, 196737 and 225612 consisted in part at least of the expression "Jidi" in respect of same or similar goods and these have been registered during the period 1957 to 1964 and were still continuing to be on the register at the date when the present application of the Appellant had been made. There were two other pending applications in respect of similar or identical goods with the expression which included partly the word "Jidi" in the Application Nos. 227654 and 227655. As I have said before these by themselves taken separately would not perhaps have been evidence of distinctiveness of the word "Jidi" as such, but taken in conjunction with the other factors enumerated before, in my opinion, these are sufficiently good evidence with any other circumstances which require that the application of the Applicant should be accepted and should proceed with the other process necessary for requiring registration. The word "V.Z." had been registered and the Deputy Registrar assumed that the same must have been upon the proof of distinctiveness. There was no material basis for that assumption. For the reasons above I am unable to sustain the grounds upon which the Deputy Registrar based his rejection of the "Vezet" case.

21. The Deputy Registrar has relied on the decision in the case of Parker-Knoll Limited v. Knoll International Limited (Supra). The decision of the Court of Appeal is, however, reported in 1961 R.P.C. at p. 346. There in a group of proceedings involving Parker-Knoll companies as proprietors of registered trade marks

"Parker-Knoll" and "Knoll" Russell J. granted injunction to restrain infringement of trade mark and passing-off, holding that the Plaintiffs had a large and established trade in the United Kingdom under the name "Parker-Knoll" which was unique to them and the significant and memorable part of that name being "Knoll". The learned Judge also refused to order the associated mark "Knoll" to be expunged. The Defendants thereupon appealed to the Court of Appeal. It was held by the Court of Appeal reversing the judgment of Russell J. that use of a mark was not use of all the words forming part of that mark, so as to enable those words to be registered as marks in use and the Court of Appeal, further held that Section 30 of Trade Marks Act, 1938, applied to such words only after these words were registered. The Plaintiffs extensively used a mark "Parker-Knoll" and registered "Knoll" being a surname and there not having by user made of the same by the Plaintiffs indicating distinctiveness of their goods it was entered in the Registrar without sufficient cause and therefore should be ordered to be expunged. The Court of Appeal further held that an injunction to restrain infringement of a trademark by a company might be properly qualified by the proviso providing that the order was not to interfere with any bona fide use by the Defendants of their full name with or without the word "Limited" as provided in Section 8 of the 1938 Act. The Court refused to make the declaration that the use of a particular form of words made it clear that there was no infringement but a proper use of the Defendants' name. In that case one of the significant factors which has to be noted as was observed by Lord Justice upon (2) was that there was evidence by a number of persons in the trade that the word "Knoll" meant the goods of the Appellant in that case i.e. the original Defendants. This in my opinion is a very significant factor which has to be borne in mind especially the stage at which the Deputy Registrar in the instant case has refused to proceed with the application for registration u/s 18(4) of the present Act with which I am concerned in ignoring other circumstances as contemplated in Section 9(5)(b) of the Act. As I have mentioned before the Parker-Knoll case went up ultimately to the House of Lords and there the decision of the Court of Appeal was sustained. According to me the controversy that arose in the Parker-Knoll case was in a slightly different context and the observation, of the Court of Appeal upon which the Deputy Registrar has relied must be understood in that light.

22. As I have mentioned before the opinion of the Deputy Registrar is entitled to respect specially in view of his specialized knowledge of the trade and should be departed from only upon cogent evidence. But for the reasons I have indicated before, I am of the opinion, that the Deputy Registrar has proceeded on an erroneous basis and erroneous principle and therefore, the decision of the Deputy Registrar cannot in this case be sustained. The order of the Deputy Registrar rejecting the application u/s 18(4) is therefore set aside and the Deputy Registrar is directed to proceed with the consideration of the application in accordance with law and in accordance with the observations made in this judgment. The Deputy Registrar would be free to obtain from the Applicant the disclaimer or undertaking

like or in the manner that Mr. Justice Warrington imposed in the case of In the matter of Verschure and Zoon's Application to Register a Trade Mark (Supra) as indicated before.

23. The appeal is, therefore, allowed and the decision of the Deputy Registrar is set aside. The Deputy Registrar is directed to proceed with the application of the Applicant in accordance with law.

24. In the facts and circumstances of the case, however, the parties will pay and bear their own costs.