

**(1962) 06 KAR CK 0011**  
**In the Karnataka High Court**  
**Case No : Misc. Appeal No. 155 of 1959**

A.R. Khaleel and Sons

APPELLANT

Vs

Registrar of Trade Marks in India

RESPONDENT

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**Date of Decision :** 29-06-1962

**Acts Referred:**

Trade Marks Act, 1999 — Section 6 (1), 6 (1) (d), 76

**Citation :** AIR 1963 Kar 122

**Hon'ble Judges :** M. Sadasivayya, J;B.M. Kalagate, J

**Bench :** Division Bench

**Advocate :** A.R. Srinivasa Rao, for the Appellant; D.M. Chandrasekhar, for the Respondent

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## Judgement

Sadasivayya, J.—The facts and circumstances which have led to this appeal u/s 76 of the Trade Marks Act 1940, briefly stated, are as follows:

An application dated 2-7-1958 was made to the Registrar of Trade Marks, praying for the registration of a trade mark consisting of the expression "Speed master", in the names of M.R. Khaleel and A.R. Khaleel (who were trading under the name and style of M/s. A.R. Khaleel and Sons), proposed to be used in respect of their watches, clocks and Alarm Time Pieces. By a letter dated 21-8-1958 issued from the office of the Registrar, the applicant was directed to show cause as to why the registration of the mark should not be refused on the ground that the expression "Speed-master" appeared to have descriptive reference to chronological instruments specially designed to measure time in relation to speed and therefore not adapted to distinguish. After some correspondence, the applicant asked by a letter dated 3-10-1958 for a hearing before final orders were passed. In response to this letter, the Registrar directed the Ex-Officio Deputy Registrar of Trade Marks to give a hearing to the applicant. Consequently, the Ex-officio Deputy Registrar heard the applicant's Advocate and after considering the arguments, refused the application for registration of "Speed master" as a trade mark. The main grounds for the refusal are (1) that the

expression "Speed master" is not an invented word and (2) that this expression in relation to watches or clocks, is indicative of the use for which the goods were meant and also directly descriptive of the character or quality of the goods. The Deputy Registrar was also of the opinion that this expression "Speed-master" should be kept open to trade for use in order to boost up the sales of watches and clocks in the ordinary course of business. It is against the said order of refusal, which was made on 20-6-1959 by the Deputy Registrar, that the present appeal has been preferred by the applicant. Sri A.R. Srinivasa Rao, has appeared for the appellant and Sri D.M. Chandrasekhar for the Registrar of Trade Marks.

2. The first contention which has been urged on behalf of the appellant is, that the Deputy Registrar has erred in taking the view that the expression "Speed master" is not an invented word and therefore not eligible for registration u/s 6(1)(c) of the Trade Marks Act 1940 (hereinafter referred to as the Act). It has been urged on behalf of the appellant that this expression is a combined word which is not found in the English dictionary and that for purpose of Section 6(1) (c) of the Act, it amounts to an invented word.

In support of this argument, reliance has been placed on the cases found at page 53 of 35 R.P.C., (In re, Standard Woven Fabric Co. Appln.) p. 134 of 59 R. P. C. (Dunlop Rubber Co., Ltd. v. Booth), and p. 105 of 66 R. P. C., (In re, Hallgarten's Appln.) In the first of these cases, the question was whether the word "Stonewall" was "an invented word. On the applicant therein, explaining that this expression as brought about by combining the first parts of the two words "Standard" and "Walpole", it was conceded on behalf of the Registrar that "Stonewall" was an invented word.

In the 59, R. P. C. case, the question was as to whether the word "Track grip" could be registered; the registration of that word seems to have been permitted, mainly on the ground that it had acquired familiarity from the fact that it had been long and extensively used in connection with the particular articles in which the applicants had been dealing.

In the 66 R. P. C. case, the word "Whisqueur" was allowed to be registered on the ground that it was an invented word, though it was the result of combining parts of the words "Whisky" and "Liqueur".

On behalf of the Registrar, it has been pointed out that the component parts of any of the expressions sought to be registered in the above cases, were not themselves complete words. It is pointed out that the two component parts of the expression sought to be registered in the present case, consist of the words "speed" and "master", each of which is a complete word having a definite meaning of its own; it is contended by Sri Chandrasekhar that a mere combination of two such words cannot result in an invented word.

In this connection, he invited our attention to Lord Halsbury's observations in the Solio case, In re, Eastman Photographic Materials Co. Ltd's Appln. (1898) 15 R. P. C. 476 which are to the effect that a compound word like "Cheap and good",

cannot be treated as an invented word. In the same case, Lord Herschell observed as follows:

"I do not think the combination of two English words is an invented word, even although the combination may not have been in use before....."

Lord Macnaghten stated as follows:

"The word must be really an invented word; nothing short of an invention will do.....If it is an invented word -- if it is "new and freshly coined" ..... it seems to me that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods....."

Lord Shand further stated as follows:

"There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words I think should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two known words, would not be an "invented" word, and a word would not be "invented" which, with some trifling addition or very trifling variation, still leaves the word one which is well-known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word."

The view that a word formed merely by combining two words cannot amount to an invented word, has found acceptance in the Courts in India also. In a case reported in *E. Griffiths Hughes Ltd. Vs. Vick Chemical Co.*, , where one of the questions which arose for decision was whether the word "Vapour Rub" was an invented word Rose J. (with whom Das Gupta, C. J. agreed), observed as follows:

"The argument of the respondent that the word "Vapour Rub" is an invented word can be disposed of, at the very outset by pointing out that it is not an invented word. It is plain that the word "Vapour Rub" suggests the combination of two ordinary English words "Vapour" and "Rub" with a slight distortion of the word "Vapour". It has been now authoritatively established that the combination of two English words is not an invented word even though the combination may not have been in use before; nor is a mere variation of the orthography or termination of a word sufficient to constitute an invented word if to the eye or ear the same idea would be conveyed as by the word in its ordinary form."

In *Ram Rakhpal Vs. Amrit Dhara Pharmacy and Others*, , Desai, J. while considering the question whether the word "Amritdhara" was an invented word, has observed as follows:

"It is a compound word formed out of the words "Amritdhara" and "dara", both of which are common words to be found in dictionaries and have meanings which are known to the public. The word "Amritdhara" may not be found in a dictionary,

because a dictionary does not contain all compound words. But the absence of a word in a dictionary is not the test of its being an invented word.

A word formed by combining two words can never amount to an invented word even if they are misspelt or truncated before being combined; a word like "amritdhara" formed by combining two words without misspelling or truncating them can still less amount to an invented word."

3. It is clear on a consideration of the authorities above referred to that a mere combination of two distinct words each of which has its own meaning, cannot be accepted as an invented word for the purposes of Section 6(1)(c) of the Act. The learned Advocate for the appellant has not placed before us any decided case to support a view to the contrary. In the present case the word "Speed-master" no doubt does not find a place in the English dictionary; but, that is because, the dictionary does not contain all combined or compound words. The word "speed", is a complete word in itself and has its own meaning; so also the word "master". A mere combination of two such words, cannot lie accepted as an invented word. The claim that it is eligible for registration as an "invented word" should be rejected. The view taken, by the Registrar on this point, is correct.

4. We will now consider the second ground on which the Registrar refused the appellant's application. The reasons which have been given by the Registrar for taking the view that the expression "Speed master" would be directly descriptive of the character or quality of the goods, are as follows:

"At pages 2417 and 2418 of Webster's New International Dictionary, Second Edition, the various meanings of the word "Speed" are given of which I may mention particularly the following:

Speed: Act or state of moving swiftly, hence, in general, rate of motion.

Speed (adj.): of or pertaining to speed; denoting something which regulates, indicates or attains speed; as a speed clock, gear or boat.

The word "Master" is defined as a noun meaning a person having control or authority over other persons or anything inanimate, a teacher, a highly skilled artist or workman but the noun may be applied figuratively to things; as an adjective (applied both to persons and things) meaning principal or controlling, chief, leading, commanding etc., (vide Webster's Murray's New English and Oxford Concise Dictionaries). As combined, the expression "Speed master" would mean "the person who or thing that is in control of speed or master of speed and when applied to watches and clocks would indicate that the instruments are those that are used for controlling or regulating speed.

There can be no doubt that the word "Speed" has a very close relationship with "Time", that is to say, in measuring the speed of any movement, time is the most essential factor to be considered. In the measurement of this essential characteristic it is not uncommon to find that a stop watch or an ordinary watch with a second hand being used. Therefore, the use of the expression "Speed

master" on the goods "Watches or Clocks" would only indicate the purpose or the use for which the goods are meant for or put to and would mean that eventually and by means of the instruments the speed of any movement is being controlled, mastered or indicated.

There is again the other aspect that may be attached to the word namely that the expression "Speed master" when used in relation to watches and clocks might indicate that the speed of the "movement" or the machinery contained in them has been controlled or mastered -- in other words, it might be said that the instruments neither gain nor lose but maintain always accurate time.

A further good reason for the proposition that the expression "Speed master" cannot be said to be entitled to registration rests in the use of the word "Speed" as an adjective referred to earlier as something which regulates, indicates, or attains speed, as a speed clock etc. If there are speed clocks and speed watches denoting something which regulate speed etc., it is a necessary conclusion that the use of the expression "Speed master" on such instruments would be directly descriptive of the character or quality of the goods."

While considering the question as to whether the word "Speed master" has direct reference to the character or quality of the goods in respect of which registration has been sought, it would be relevant to mention that at the hearing before the Deputy Registrar, the Advocate for the appellant had stated that the applicant was prepared to give an undertaking to the effect that this word would be used only in respect of clocks and watches and not on Stopwatches and Chronographs. The appellant has also filed a memo (dated 11-6-1962) in this appeal, stating therein that he agrees to the registration being restricted to watches, clocks and Time-pieces excluding instruments meant for measuring speed like Stopwatches, Timers, Chronographs, etc. In view of this memo, instruments specially intended for measuring speed have to be excluded and it is only in respect of ordinary watches, clocks and Time-pieces which are intended merely to denote time, that the question has to be considered as to whether the word "Speed-master" has direct reference to their character or quality.

5. u/s 6(1)(d) of the Act, a word (not being, according to its ordinary signification, a geographical name or surname or the name of a sect, caste or tribe in India) which has no direct reference to the character or quality of the goods, will be eligible for registration as a trade mark. Therefore, what is objectionable to such eligibility, is direct reference to the character or quality of the goods. A mere suggestive significance in connection with the goods would not render it inappropriate for use as a trade mark.

At page 579 Section 721, of the Restatement of the Law (by the American Law Institute), it is stated as follows:

"That a designation may have a suggestive significance in connection with the goods does not render it inappropriate for use as a trade-mark. The test is the imaginativeness involved in the suggestion, that is, whether the suggestion is so

close and direct that it is apparently descriptive and generally useful in approximately that form to all merchants marketing such goods or so remote and subtle that it is fanciful and not needed by other merchants of similar goods."

For finding out whether a particular word has any direct reference to the character or quality of the goods what has to be looked into is not the strict grammatical sense of the word, but as to what it would represent to the public at large.

In *In re, Keystone Knitting Mills Trade Mark* 3928 45 R. P. C. 421, Lord Hanworth M. R. observes as follows:

"I think one has to look at the word which is registered, not in its strict grammatical significance, but as it would represent itself to the public at large who are, to look at it and to form an opinion as to what it connotes."

Pas, J., in *Hindustan Development Corporation Ltd. Vs. The Deputy Registrar of Trade Marks and Another*, states as follows:

"In considering whether a mark has reference to the character or duality 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."

It appears to us that the contention advanced on behalf of the Registrar that the expression "Speed master" has direct reference to the character and quality of the goods, is not a sound one. The essential feature of any ordinary clock, Timepiece or watch, is to indicate the time. There being no mention of time, in the expression "Speed master", it cannot be said that the expression has any direct reference to the character of the goods.

The argument of Sri Chandrasekhar, on behalf of the Registrar, is two fold; firstly, the argument is that speed and time are intimately related to each other and that a reference to speed can be viewed as a reference to time; secondly, it is argued that the expression "Speed master" gives the impression that the speed of the mechanism of the goods (namely, Clocks, Timepieces and watches) has been mastered and that there is the likelihood of the public understanding this expression as having reference to the quality of the goods. It seems to us, that these are very far-fetched arguments. It may be that scientifically, there is an intimate relationship between time and speed. But, ordinarily, if any person looks at a watch to find out the time he does not think of speed. The majority of the members of the public who acquire watches, clocks and Timepieces, do so because they desire to have an instrument from which they can know the time whenever they want. These watches, clocks and Timepieces, which are of an ordinary nature, are neither intended nor acquired for the purpose of measuring

speed.

It was stated by Sri Chandrasekhar that often times, doctors and others in the medical profession make use of watches (with centre second hand) when they take count of a patient's pulse or heartbeats. But, it cannot be disputed that the number of people who put ordinary watches to such an incidental use is in a negligible minority when compared with the large body of the public which desire and acquire watches, Timepieces and clocks for the simple purpose of knowing the time. The mere circumstance that a small number of persons in the medical profession may use ordinary watches for counting the heart-beats of patients, will not have the effect of converting ordinary watches into instruments for measuring speed. For measuring speed there are other instruments like stopwatches, speedometers, etc., specially designed for that purpose. Such being the case, there is no reasonable possibility of the public understanding the expression "Speed master" as having reference to the character of these goods.

Ordinarily, the expression "Speed master" is not used with reference to the internal mechanism of a watch. It appears to be extremely improbable that this expression can be reasonably understood as having reference to the quality of the goods. Even assuming that the expression is, to some extent, suggestive, the suggestion is too very remote and involved and cannot amount to a direct reference to the character or quality of the goods. We are, therefore, satisfied that the expression "Speed-master" has no direct reference either to the character or quality of the goods, namely, ordinary clocks. Timepieces and watches in respect of which registration has been sought.

Sri Chandrasekhar sought to contend that even if we reach the conclusion that this expression has no direct reference to the character or quality of the goods, we ought not to interfere with the finding of the Registrar, because the Registrar has the discretion u/s 14 of the Act to refuse registration even though a mark may be eligible u/s 6(1) of the Act. This argument is not a correct one. The question of eligibility of a trade mark is one which has to be adjudged by the Registrar, in accordance with the provisions of Section 6. The fact that the Registrar may have a discretion in the matter of admitting a trade mark to registration, cannot in any way lessen his responsibility to correctly determine the question of eligibility. To determine correctly the question of eligibility u/s 6(1) of the Act, is quite distinct from the discretionary power. If in so adjudging, the Registrar reaches an erroneous conclusion on the question as to whether the requirements of Section 6(1)(d) of the Act have been satisfied or not, in the case of a particular trade mark, it will be certainly open to the appellate Court to rectify the error committed by the Registrar. It will be within the powers of the Court of appeal to do so. The appellate jurisdiction conferred by Section 76 of the Act is exercisable by the High Court in the same manner as it exercises its other appellate jurisdiction (Vide National Sewing Thread Co. Ltd. Vs. James Chadwick and Bros. Ltd. (J. and P. Coats Ltd., Assignee), .

6. It was nextly contended by Sri Chandrasekhar that even though a trade mark

satisfied the requirements for eligibility u/s 6(1) of the Act, the applicant did not have the right to have it registered and that the Registrar had a discretion u/s 14(1) of the Act to refuse the application.

In this connection, he relied on the observations of the Supreme Court in the case of *The Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd.*, . Therein, the Supreme Court observed as follows:

"If that authority has exercised his discretion in good faith and not in violation of any law such exercise of discretion should not be interfered with by the High Court merely on the ground that, in the opinion of the High Court, it could have been exercised differently or even that the High Court would have exercised it differently, had the matter been brought before it in the first instance. The proper approach in such a case is for the High Court to consider, as said by Lord Dunedin in *In re, Reddaway (F) Co's Application* (1927) 44 RFC 27 at p. 36, "Whether the Registrar had really gone so wrong as to make it necessary to interfere with his discretion."

In the above case, the Supreme Court was considering the question as to whether the Calcutta High Court was justified in reversing the decision of the Registrar of Trade Marks whereby he had rectified the register by inserting a "disclaimer of the word "Shree" forming part of the respondent Company's registered trade mark. The point for decision was as to whether the Registrar had properly exercised his discretion u/s 13 of. the Act and if that discretion had been properly exercised, whether the High Court could interfere in appeal, because it took a different view of the matter.

The Supreme Court, after a consideration of all the facts of that case, reached the conclusion that the Registrar had properly exercised his discretion and that the High Court's interference with the discretion exercised by the Registrar was due to some important aspects of the case not having been pressed before the High Court. It was in the context of those circumstances that the Supreme Court said that it was not of the opinion that the Registrar had gone so wrong as to have made it necessary for the High Court to interfere with his discretion. From what is stated towards the end of para 10 at page 564, the High Court of Calcutta had proceeded on the basis that the only reason for the decision of the Registrar was that there was an inflexible practice established in the registry whereby the word "Shree" was either refused registration as a trade mark or a disclaimer was enforced if it was a part of a trade mark. But, it was found that there were other materials to support the decision of the Registrar which had not been pressed before the High Court.

In dealing with that aspect of the matter, the Supreme Court observed as follows at page 565:

"The High Court answers the question immediately ,by saying that it did not think that any cause had been shown beyond the desirability of having a uniform practice. This, as we have already stated, is not quite correct, for apart from the

practice the Registrar did advert to the other important consideration, namely, that on the evidence before him and the statement of counsel it was quite clear that the reason for resisting the disclaimer in this particular case was that the company thought, erroneously no doubt but quite seriously, that the registration of the trade mark as a whole, would, in the circumstances of this case, give it a right to the exclusive use of the word "Shree" as if separately and by itself it was also its registered trade mark and that it would be easier for it to be successful in an infringement action than in a passing off action.

"It was precisely the possibility of such an extravagant and untenable claim that called for a disclaimer for the purpose of defining the rights of the respondent company under the registration. This aspect of the matter does not appear to have been pressed before or adverted to by the High Court.

Considering all the circumstances discussed above, we are not of opinion that the Registrar had gone so wrong as to have made it necessary for the High Court to interfere with his discretion."

The above decision cannot be of any assistance in a case in which it has not been shown that the Registrar had good reasons for exercising his discretion in a particular way. It is no doubt true that the mere fact that a particular trade mark satisfies the requirements of eligibility u/s 6(1) of the Act, will not entitle the applicant to have it registered, as of right. In spite of a trade mark being eligible u/s 6(1) of the Act, the Registrar may u/s 14(1) refuse the application. But, the discretion to refuse u/s 14(1) should not be exercised arbitrarily or capriciously, but judicially and reasonably. In (1918) 35 RFC 53 at page 58, Justice Young stated thus:

"Prima facie this Register is created by this Act for the purpose of enabling Trade Marks to be put upon it; and it would be very unfortunate if bona fide and honest applications for Trade Marks were to be refused on grounds which were fanciful and which, in a business sense, were unsubstantial".

Sub-section (2) of Section 14 of the Act states that in the case of a refusal, the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving thereat. A step further has been taken in the subsequent enactment, namely. The Trade and Merchandise Marks Act, 1958; in Sub-section (6) of Section 18 which corresponds to Section 14 (2) of the Trade Marks Act 1940, it is stated that in cases of refusal, the Registrar shall record in writing the grounds for such refusal and the materials used by him in arriving at his decision. Therefore, under the said new Act it is not even necessary for the applicant whose application had been refused, to require the Registrar to state in writing the grounds for such refusal; even without the applicant requiring it, the Registrar is bound to record in writing the grounds for refusal and the materials used by him in arriving at his decision. The requirement that the Registrar should state in writing the grounds of his decision and the materials used by him in arriving thereat is, doubtless, intended to enable the

appellate Court to find out whether the discretion of the Registrar has been exercised judicially.

We are not satisfied in the present case that there was any material justifying the Registrar exercising his discretion against the applicant. We have not been told as to what material there was before the Registrar on the basis of which he took the view that the expression "Speed master" should be kept open to the trade for use in order to boost up the sales of watches and clocks in the ordinary course of business. The applicant has not asked for the separate registration of the two component parts of the expression "Speed master". It is within the discretion of the Registrar, u/s 13 of the Act, to require that the applicant shall disclaim any right to the exclusive use of each component part separately. That would safeguard the interests of trade in regard to the user of the word "Speed" and the word "Master", separately. It may also be stated that in the course of his arguments, the learned Advocate for the appellant stated that he had no objection to such a disclaimer.

7. For the reasons above stated, the conclusion reached by us is that the expression "Speed master" is eligible u/s 6(1)(d) of the Act for registration, in respect of ordinary clocks, Timepieces and watches (other than those meant for measuring speed, like stopwatches, Times, chronographs, etc.,) and that the Registrar has not exercised his discretion judicially in refusing the application.

8. In reversal of the order of the Registrar, we direct the Registrar to proceed further with the application treating it as one restricted to clocks. Timepieces and watches other than those meant for measuring speed, like stop-watches, Timers, chronographs, etc. No order as to costs.