
(1979) 06 CAL CK 0024
In the Calcutta High Court
Case No : A.F.O.O. No. 188 of 1973

Chandra Bhan Agarwal and Another	Vs	APPELLANT
Arjundas Agarwal and Others		RESPONDENT

Date of Decision : 08-06-1979

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 107, 107(1), 112, 9

Citation : AIR 1979 Cal 280 : 83 CWN 643

Hon'ble Judges : Sankar Prasad Mitra, C.J.; Salil Kumar Datta, J

Bench : Division Bench

Advocate : B. Das, D.K. De, Kalyanmoy Ganguli and Ranjan Dutt, for the Appellant; Jayanta Mitra and Sujit K. Auddy, for the Respondent

Judgement

Salil Kumar Datta, J.—This is an appeal from the judgment and order of S. C. Ghose, J. on an application u/s 107 of the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the Act) passed on February 26, 1973.

2. The respondents who are partners of H. P. Textile Mills carry on business in their firm name on large scale as manufacturers of and dealers in hosiery goods with market throughout India. They trading in their firm name are the owners of a trade mark in "A" Register which is set at page 271 of the Trade Mark Journal No. 507 of July 16, 1970. The registration recorded therein is as follows:

Class 25

The Device of the Mark.

Debanagari Characters appearing on the Mark represent the word "Dora" 252040 -- October 3, 1968. Arjundas Agarwal, Krishan Kumar Agarwal and Kashmirilal Agarwal, trading as H. P. Textile Mills, 10A, Vivekananda Road, Calcutta: Manufacturers. User claimed since 25-10-62 (Calcutta)

Gangees (Underwear)

Registration of this Trade Mark shall give no right to the exclusive use of the

letters "TM" and the device of a man. It is a condition of registration that the blank spaces appearing on the Mark shall be left blank when the mark is in actual use."

3. The respondents claimed to be the registered owners and users of the aforesaid registered trade mark which consists of a device in rectangular shape with words "Dora" in English in four places and in Debanagari in one place with figure of a man and the name of their firm with blank spaces interspersed therein. The mark "Dora" has been, according to the respondents, in extensive use on labels of cardboard boxes containing six pieces of ganjees, on neck labels, on transparent polythene bags containing ganjees and also in price tickets. The said trade mark "Dora", it is claimed, has also been extensively advertised by the respondents and has acquired wide popularity in general public as indicating the goods bearing the said trade mark "Dora" and/or its distinctive device as aforesaid as the exclusive property of the respondents.

4. The appellants with a view to make wrongful gain and to put the respondents to wrongful loss have intentionally and deceitfully made labels, cardboard boxes, price tickets and transparent polythene bags bearing marks with word "Dora" in imitation of similar marks of the respondents and putting the same over their inferior goods and selling the same in the market in their firm name C. B. Textile Mills, a name similar to the respondents' firm in infringement of the said trade mark and passing off such goods as the respondents' goods. The appellants were imitating in their goods the artistic works of the labels of the respondents for which they had the copyright under the Copy Right Act, 1957. As the appellants failed to desist from their trade activity as aforesaid on demand, the respondents instituted suits being Title Suits Nos. 567 and 568 of 1971 in the City Civil Court, Calcutta for permanent injunction restraining the appellants from infringing their registered trade mark No. 252040 and passing off such goods as the appellants' goods in the market. In the suits, it is said, interim orders have also been issued.

5. The appellants filed their written statements in the said suits questioning the validity of the registration of the trade mark of the respondents and the said suits are stated to be pending, Soon thereafter on or about December 2, 1971 the appellants filed an application in this Court u/s 107(1) of the Act contending that the word "Dora" being a common word was a kind of thread having no trade mark significance. It was further stated that the word "Dora" being a common word used for denoting thread or stripe or stripes in Hindi and Bengali could not have any distinctive use or meaning and nobody could claim exclusive use of the said word "Dora", It was not distinctive and did not qualify for registration in Part A of the Register at the time of registration. Further the said word "Dora" was of a generic nature and it could never acquire distinctiveness in spite of user nor could there be any property rights over it as the said word is common to trade. The appellants prayed that the registration of the trade mark No. 252040 dated October 3, 1968 be cancelled or revoked as otherwise the appellants would suffer

serious loss.

6. The application was contested by the respondents who filed an affidavit-in-opposition affirmed by Krishan Kumar Agarwala on December 22, 1971 wherein it was stated that the word "Dora", which is one of the essential features of the mark, with or without design, was a distinctive trade mark and was as such registered in Part A of the Register. It was denied that "Dora" ever meant thread or stripe and/or the same was a common word of generic nature in daily use. "Dora" being a feminine personal name, by long user, had acquired distinctiveness and as such the said word "Dora" with design was registered qualifying u/s 9. The respondents referred to their trade in extensive seals under the above trade mark as stated hereinbefore and denied that the word "Dora" with design could have no distinctiveness or distinctive use or meaning and nobody could claim exclusive use of the word "Dora". In fact, the trade mark "Dora" had become very popular to the purchasing public who came to know that the word "Dora" with or without design was and is the manufacture or merchandise of the respondents. It was further stated that the trade mark was registered by the Registrar on his satisfaction about the evidence of distinctiveness adduced by the respondents and such decision should not be interfered with.

7. In the affidavit in reply on behalf of the appellants affirmed by Chandra Bhan Agarwal on January 3, 1972 it was reiterated that the word "Dora" being a generic name could have no distinctiveness and thus was not eligible to registration in Part A of the Register. Since the said "Dora" had only one meaning, that is, thread or stripe in Hindi and Bengali, sale of products could not make "Dora" eligible for registration as a trade mark under the law.

8. The learned Judge took into consideration that a word or words which has or have a direct reference to the character or quality of goods cannot be registered. No amount of user of the words like "Best", "Perfect", "Superfine" having ex facie a direct reference to the character or quality of goods can make them distinctive for the purpose of monopoly rights. Similarly words "Stone" for jars, "Paper" for books, "Wood" for tables, "Steel" for girders, are also descriptive of the goods so that no amount of user can make them distinctive for the purpose of registration. There may however be words which though descriptive of the character or quality of the goods may be poetic or archaic, not in ordinary use nor descriptive of the character or quality of the goods in the trade. Such words like "Sheen" for sewing cotton, "lightning" for zip fastener, "Fargo" for motor cars, "Golden" for ink, may be registrable on evidence of long user proving distinctiveness. It was held that the word "Dora" in Bengali does not mean thread while "Dore" or "Don" in Hindi or Bengali mean thread. Such word like "Dora" with or without design cannot be registered without proof of acquisition of distinctiveness acquired by long user. But since evidence was adduced before the Registrar establishing acquisition of distinctiveness with or without design which he accepted in exercise of his discretion the Court should be wary of cancelling such trade mark. The learned Judge was satisfied that it was established that the

word "Dora" with or without design acquired distinctiveness in connection with the vests and Ganjees manufactured by the respondents and as such was rightly registered as a trade mark under the Act. The learned Judge however held overruling the contention of the respondents that the appellants as persons aggrieved had the locus standi to make the application u/s 107 of the Act. He, however, dismissed the application on merits. The appeal is against this decision under Sub-section (3) of Section 108 of the Act.

9. Mr. Das and later on Mr. De, counsel appearing for the appellants contended that the learned Judge while enunciating the established propositions of law failed to apply the same correctly in regard to the trade mark under consideration. It was submitted that the word "Dora" in Hindi and Bengali means thread or stripe which is an ingredient of the product. Such word being thus descriptive is inherently incapable of acquiring distinctiveness. If a word is incapable of acquiring distinctiveness no amount of user will remove such disqualification and Clause (b) of Sub-section (5) of Section 9 will not come into operation. When the word is an ingredient which constitutes the product it amounts to a descriptiveness whereby the capacity to distinguish is lost. Further, party cannot be allowed to impinge on the field of common language to get a monopoly right in respect of words of common parlance and use. The Registrar in granting registration of the word "Dora" with device did not at all consider that the word has a meaning and significance in language apart from its being descriptive of the product and erroneously proceeded on the basis that "Dora" was merely a feminine name.

10. Mr. De in support of his contention about the inherent incapacity for distinctiveness relied on a recent decision in respect of "Multilight Trade Mark (1978 RFC 601) when the manufacturer's appeal against the order of the Registrar refusing the application was under consideration. In agreement with the Registrar, the Board of Trade (D. W. Falconer, Q.C.) held that the word, which was not an invented one, had a direct reference to the character and quality of the goods namely light fittings. It was further observed that the mark could only be registrable in Part A of the Register if it qualifies as a distinctive mark within the terms of paragraph (e) of Section 9 (our Section 9(5)). As to that regard must be had to the extent to which the mark (a) is inherently adapted to distinguish the appellant's goods and (b) it is in fact adapted to distinguish. Though factual distinctiveness is established, this alone however strong is not decisive of registrability for regard must be had of (a) inherent distinctiveness. It was held that other traders in the line may properly desire to use the terms as a description of their goods in the ordinary course of business without improper motive, as held in Needle tip Trade Mark 1973 RFC 113 (117) and the word "Multilight" would be the most apt term to describe all such multiple light fittings and installations. Accordingly registration in A Register was refused as the mark lacked any degree of inherent distinctiveness.

11. Mr. Mitra appearing for the respondents contended on the other hand that

the word "Dora" has no reference to the character and quality of the products under consideration so that it is not inherently incapable of registration. The word "Dora" which, though it does not invariably mean thread, at the highest if at all is a descriptive word and such descriptive word can be and has been recognised in law as distinctive in fact since there is no absolute incompatibility between what is descriptive and what is distinctive. Further when evidence as to extensive user of the mark has been established before the Registrar, this Court, consistent with its uniform practice, should not interfere with a discretion when there is no patent or any illegality in regard to the registration of the mark.

12. We may profitably refer to the British law on the subject as our law is based on such law in material particulars. In Halsbury's Laws of England Third Edition, Volume 38 it is laid down as follows:

"Part A Marks. Article 859. Essential Particulars. A trade mark other than a certification trade mark (Section 61) to be registrable in Part A of the register must be distinctive and must contain or consist of at least one of the following essential particulars: (1) the name of a company, individual or firm, represented in a special or particular manner; (2) the signature of the applicant for registration or some predecessor in his business; (3) an invented word or words; (4) a word or words having no direct reference to the character or quality of the goods and not being according to its ordinary significance a geographical name or a surname, or (5) any other distinctive mark but a name, signature or word or words, other than such as fall within the foregoing heads (1) to (4) is registrable except upon evidence of its distinctiveness.

Article 871. Laudatory and descriptive words. Although no statutory limitation is imposed on words registrable on proof of distinctiveness, words of a purely laudatory or descriptive nature cannot be adapted to distinguish, however extensive the user may be. The same rule applies in general to geographical names, unless these have clearly no reference to the character or origin of the goods.

Article 874 -- Marks other than word marks. Apart from word marks, the only general requirement is that the mark must be distinctive, that is, adapted to distinguish in the foregoing sense ...As in the case of word marks, evidence may be given as to distinctiveness in fact. The distinctiveness may be either in individual features or general arrangement.

A mark may be distinctive though each part is separately disclaimed. A mark must be considered as a whole and it is not in general permissible to dissect a mark in order to destroy distinctiveness.....

Article 878 -- Evidence of distinctiveness. Since the definition of distinctiveness includes natural capacity, and also the effect of other circumstances, and in particular of user, the evidence required to establish distinctiveness may vary with the nature of the mark, but such evidence must place the matter beyond reasonable doubt, and stronger evidence is required than in passing off case,

since registration asserts a title against the world and necessitates the consideration of future possibilities as well as present circumstances,"

13. The powers of the High Court under Sub-section (1) of Section 107 of our Act, where the validity of registration of the trade mark is called in question are wide enough to direct rectification of the Register by cancellation of the registration of the trade mark or by imposition of such limitation or disclaimer as may appear to the High Court to be appropriate in the circumstance. In dealing with an application u/s 107, the Court shall take into consideration the relevant provisions of law in the background of the evidence already adduced before the Registrar or as may be adduced or available before the Court by affidavit or otherwise.

14. By Section 112 the Registrar has been given the right to appear and be heard in any legal proceeding before the High Court in which the relief sought for includes alteration or rectification of the Register in respect of any trade mark. It is however not essential that he should be made a party to the proceeding and it will be sufficient compliance of the provisions of the section if he is given the requisite notice and opportunity to appear before the Court and present his case if so advised. In this case since as a point was raised contending that the Registrar was neither made a party nor was he given any opportunity to be heard thereby rendering the proceedings a nullity, a point not pressed before the trial Judge, we directed notice to be issued through the appellants on the office of the Trade Mark Registry at Calcutta to produce the record relating to the trade mark. We are satisfied from the records produced that the Registrar was given due notice of the connected proceeding before this Court though no representation was made by him or on his behalf.

15. The word "Dora", a common feminine name, also is a material part of the trade mark which is a device as will appear from its pictorial representation being No. 252040 in the Trade Mark Registry. We have seen that the primary objection to registration is that the word has direct reference to the quality and character of the goods. The word "Dora" does not refer to any quality of the product. It refers undoubtedly to the character of the product referring to its ingredient thus descriptive of the product and would be otherwise incapable for registration except on proof of distinctiveness unless there are other grounds for refusal of registration. The evidence before the Registrar about the distinctiveness of the mark acquired by it was accepted as sufficient, a conclusion in judicial propriety should be hardly interfered with except for cogent and compelling reasons.

16. Of course the Registrar proceeded on the basis that the word "Dora" was merely a feminine name without being aware of its dictionary meaning or import in common parlance. It has been strenuously contended that no monopoly or exclusive right of use of common word "Dora" should be given to any person to trade over it. Further it is contended, the word is one which a trader in the line may desire in good faith to use in respect of his goods of business in ordinary course now or in future.

17. Apart from the conditions referred to in Section 9, the Courts have uniformly and consistently imposed a further condition, before a trade mark is granted registration. No trade mark shall be allowed to be registered which may hamper or embarrass the traders or the trade now or in future in respect of the place or country in which it is proposed to be registered. Lord Parker in the case of Registrar of Trade Marks v. W. & C, Due Cros Ltd. (1913) 30 RFC 660 lays down that the Registrar is not bound to allow registration even if the mark were in fact distinctive. He observed:

"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 in view. The applicant's chance of success in this respect must..... largely depend upon whether the traders are likely in the ordinary course of their business and without any improper motive, to desire to use the same trade 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 a special manner) and descriptive words have never been recognised as appropriate for use as trade marks."

18. "Dora" according to dictionaries is a common word of the language meaning "Suta" the ingredient of the goods and thus descriptive of the product which was granted registration with the device. Registration of a trade mark confers a title to its owners on such mark as an industrial property in rem valid against the whole world. Accordingly before the registration of a trade mark is granted, not only the trade mark must satisfy all the conditions imposed by law, it must also be ensured that no trader in the line in the course of his business at present or in future is in any way prejudiced or hampered in his business activity honestly pursued by the grant of registration which seems also to be the position here. It is on this principle that common words of the language in use or words descriptive of the products are hardly granted registration by court even if the trade mark satisfies all other conditions and is otherwise distinctive of the products of the owner thereby preventing monopoly in use of such words by the few.

19. The registration of the trade mark No. 252040 in Part A is of a device with the word "Dora" prominently displayed in various places. Such registration of the device does not entitle its registered owners exclusive use by them as a registered mark of word "Dora"- without the device in similar or connected products as appears to have been claimed by the respondents. In their affidavit-in-opposition in paragraph 5 the respondents, through Krishan Kumar Agarwal,

have stated:

"I say that the word "Dora" (which is one of the essential features of the mark) with or without design is a distinctive trade mark and was as such registered in Part "A" of the Register." This claim has been practically made in other portions of the affidavit and it has also been stated that the word "Dora" had already acquired distinctiveness with the purchasing public as being the goods of the respondents. It may be that the claim in respect of the device with the word "Dora" which was applied for registration was established when the registration was granted but since the registration of the trade mark was of a device, in our opinion, it cannot be said the word "Dora" simpliciter and bereft of the device also became a trade mark registered under the Act as claimed except under the special representation of the device registered. In fact Section 81 of the Act in Sub-section (1) Clause (b) prohibits any representation of a part of a registered trade mark not separately registered as a trade mark to the effect that it is separately registered as a Trade Mark, on pain of penalty under Sub-section (2).

20. At the time of registration of the instant trade mark it appears that the Registrar proceeded on the basis that the word "Dora" which is not an invented or archaic word was a personal feminine name without having any other significance. This position will appear from paragraph 8 of the affidavit-in-opposition on behalf of the respondents and we did not have the advantage of looking into the order of the Registrar while allowing registration of the trade mark. As we have noted earlier, the Registrar never appeared before the learned Judge nor even before this Court when he had knowledge of the proceeding, to support his order or make any representation pertaining the registration of the trade mark. It is thus obvious that the Registrar did not take into consideration the import, significance or meaning of the word as a common word in use in India's national language as evident from the dictionaries produced before us. In this state of affairs, and in the context of the principles laid down by the judicial decisions and the attending circumstances, we are of opinion that by registration no monopoly should be granted in respect of the use of the word "Dora" simpliciter which others may legitimately desire to use without improper motive. The registration of the trade mark under consideration in this appeal accordingly should be varied by providing the further condition as follows. "Registration of the trade mark will confer no exclusive right of use of the word "Dora" except as a part of the device."

21. Before we part with the case, it must be understood that we have imposed only a further condition relating to registration of the trade mark of the device. Our observations and findings will in no way prejudice the rights of the parties in the litigations pending between them and also of their rights inter se and against any trader at any time in respect of the trade mark or the word "Dora" or any other representation thereof used by the respondents, as are, available in law.

22. The appeal accordingly is allowed and the judgment and order under appeal are set aside. There will be following further condition added in respect of the

Trade Mark No. 252040 in class 25 in Part A of the Register maintained under the Trade and Merchandise Marks Act 1958, in modification of the registration in respect thereof.

"Registration of the Trade Mark will confer no exclusive right of use of the word "Dora" except as a part of the device."

The application of the appellants u/s 107 of the Act is disposed of accordingly. Let the copy of the judgment be forwarded to the Registrar of Trade Marks, Calcutta for making necessary alteration in the Register in respect of the aforesaid trade mark,

23. There will be no order for costs in the circumstances and all interim orders including those in respect of the said suits if any are vacated.

Sankar Prasad Mitra, C.J.

24. I agree.