

(1973) 02 CAL CK 0008
In the Calcutta High Court
Case No : Matter No. 491 of 1971

Chandra Bhan Agarwal and Another

APPELLANT

Vs

Arjundas Agarwal and Others

RESPONDENT

Date of Decision : 26-02-1973

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 107, 56

Citation : AIR 1974 Cal 183

Hon'ble Judges : S.C. Ghose, J

Bench : Single Bench

Final Decision : Dismissed

Judgement

S.C. Ghose, J.—This is an application made by the petitioner for the cancellation or revocation of the registration under the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as "the said Act") of the trade mark "DORA" applicable to the Ganjis or vests manufactured by the respondents and being the trade mark No. 252040. The said word "Dora" together with some designs was duly registered as trade mark on October 3, 1968.

2. The respondent firm has been carrying on business in the aforesaid Ganjis and hosiery vests since 1962 and has been using the said mark "Dora" as their trade mark in respect of goods manufactured and sold by them. The word "Dora" is an essential feature of the trade mark and together With design was considered to be a distinctive trade mark by the Registrar and was registered as such under the said Act

3. The ground for revocation or cancellation of the said trade mark as stated in the petition filed in support of the Notice of Motion is that the word "Dora" in Hindi as well as in Bengali means universally thread or strips and is commonly in daily use.

4. The respondent in resisting this application for cancellation or revocation of the said trade mark alleges that the said word "Dora" is a Hindi word and not a

feminine personal name. The said word has acquired distinctiveness by long use in connection with vests and Ganjis manufactured by the respondents and acquired the distinction of becoming a trade mark in connection with the abovementioned products of the respondent and as such was registered under the said Act. It appears from the affidavit of the respondent that the said mark "Dora" became very popular with the public and the annual sale of the products of the respondents grew from year to year. In 1967-68 such sale rose to the total sum of Rupees 17,34,098.39 p. It appears that by long user and advertisements made by the respondents to popularize the said trade mark, the said trade mark "Dora" with or without design has become popular with the purchasing public in whose mind the said mark is connected with the vests manufactured by the respondents.

5. After the petitioners had applied for registration of the said trade mark "Dora" with or without design, the Registrar of Trade Marks told the respondent that "the word "Dora" constituting the leading feature of the mark was a feminine personal name and could not be registered except in the case of distinctiveness, acquired by the said mark conclusively.

6. Thereupon the respondent duly produced evidence of distinctiveness acquired by the said mark "Dora" with or without design before the said Registrar.

7. After due consideration of the abovementioned evidence, the Registrar of Trade Marks directed circulation or advertisement of the said mark in the Trade Mark Journal. The said trade mark "Dora" with design was fully and thoroughly advertised. No one raised any objection to the registration of the same. Thereupon the Registrar of Trade Mark registered the said trade mark on October 3, 1968.

8. Clause (j) of Section 2 of the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the Act) defines "Mark" as follows:--

" "Mark" includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof;"

9. Clause (v) of the said Section 2 of the Act defines "trade mark" in the following words;

"(v) "trade mark" means-

(i) in relation to Chapter X (other than Section 81), a registered trade mark or a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark; and

(ii) in relation to the other provisions of this Act, a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user, to use the mark whether with or

without any indication of the identity of that person, and includes a certification trade mark registered as such under the provisions of Chapter VIII:"

10. Clause (d) to Sub-section (1) of Section 9 provides that a trade mark shall not be registered in Part A of the Register unless it contains or consists of at least one or more words having no direct reference of the character or quality of the goods and not being according to its ordinary specification, a geographical name or surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in India. Thus a word or words in order to be registered as a trade mark cannot have any direct reference to the character or quality of the goods e.g., the words "Perfect", "Superfine" or "Best" ex facie have a direct reference to the character or quality of the goods and thus cannot be registered as a trade mark, no amount of user of the words, "Best", "Superfine", "Perfect" can make them distinctive for the purpose of monopoly rights for they are descriptive of the goods and nothing else. Thus the words "Stone" for jars, "Paper" for books, "Wood" for tables, "Steel" for girders, are so descriptive of the goods that no amount of user can make them of "Rasoi" for vegetable oil meant for cooking. But there may be words which though descriptive of the goods may be poetic or archaic and not in ordinary use in reference to particular article e.g., "Sheen" in regard to sewing cotton is not a word which traders in cotton trade usually employ for the purpose of describing the character or quality of their trade. Therefore, if there has been long user the word "Sheen" can become distinctive and may be registered as a trade mark, as was held in the case of Coates (J. & P.) Ltd.'s application (1936) 53 RPC 355. The word "Lightning" for Zip fasteners likewise has a direct reference to the character or quality of the Zip fasteners: nevertheless the word would be registrable on evidence of long user proving distinctiveness of the mark. Similar is the case of "Fargo" for motor cars, "Golden" for ink; "Pyari" (Darling) for Beedies, "Eveready" for Batteries and "Ever sharp" for pens and pencils.

11. I now propose to discuss the cases cited at the Bar on either side.

In Hindustan Development Corporation Ltd. Vs. The Deputy Registrar of Trade Marks and Another, it was held by a majority of the Special Bench that the word "Rasoi" did not become distinctive for hydrogenated cooking oil. It had direct reference to the character and quality of the goods and was not eligible for registration. It was held in the abovementioned case that in considering whether a mark had reference to the character or quality of the goods, the mark was to be looked at not in its grammatical significance but as it would represent to the public at large, that is to say, by the common understanding of the term among those who use the goods or have occasion to use it in the course of their daily lives. It should be noted that the word "mark" as defined in Section 2(1)(f) of the Act, includes amongst others a word. The word "trade mark" as defined in the Act is a "mark" used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right to use the mark.

12. The case of *In the matter of Compagnie Industrielle Des Petroles*'s application (1907) 2 Ch 435 known as the *Motorine* case may have some bearing on the controversy in the instant case. The facts of the said case are stated hereunder:

13. In 1901 a Company had registered "*Motorine*" as their trade mark with lubricating oil and sold large quantity of such oil under that name. In 1907 another company which had also dealt largely in petrol spirit under the name "*Motorine*" applied for registration of "*Motorine*" as their trade mark. This application was opposed by the first named Company. The Registrar refused to register "*Motorine*". The applicant company appealed against the said order and also made an application for expunging the trade mark "*Motorine*" from the register. The application was dismissed on the ground that the word "*Motorine*" has no direct reference to the quality or character of the goods and was therefore, eligible for registration u/s 94. Trade Marks Act, 1905. It was held that although the word "*Motorine*" suggested oil that were to be used in connection with a motor, it had no reference either to the character or quality of the goods which were sold under the said name.

To my mind it seems that the above-mentioned case reported in (1907) 2 Ch 435 has some resemblance to the instant case.

14. In the case of *In the matter of an application of J. & P. Coates Ltd.* (1936) 53 RPC 355, the word "*sheen*" was proposed for registration as a mark in regard to Machine Twist or Merchandise Seaming Thread. The Registrar refused registration. Thereafter upon appeal the decision of the Registrar was confirmed by the single Judge. The Court of Appeal confirmed the Judgment of the single Judge. Upon appeal it was observed by Lord Wright that the word "*Sheen*" had become distinctive of the applicant's goods. The law on the point was succinctly stated by Evershed, J., in *re: La Marquise Footwear*'s application (1946) 2 All ER 497 in the following words, to wit,

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

15. In the case of *E. Griffiths Hughes Ltd. Vs. Vick Chemical Co.*, it was held that the mark "*Vaporub*" had acquired distinctiveness and thus fell within Clause (e) of Section 61 of the Trade Marks Act. Combination of two English words is not an invented word. Thus the word "*Vaporub*" was not an invented word and

suggested the combination of two ordinary English words "Vapour" and "Rub" with a slight distortion of the word "Vapour". It was further held that registration could be directed solely on the evidence of acquired distinctiveness.

16. In the instant case the mark "Dora" had been in continuous user from 1962 until the date of application for registration and even subsequent thereto and this mark had acquired sufficient distinctiveness to entitle the mark to registration.

17. In the case of all applications for registration of trade marks the rights of the party or parties are to be determined as at the date of the application for registration.

18. In *De Cordova v. Cick Chemical Co.* 195t WN 195, it was observed by Lord Radcliff stating the opinion of the Judicial Committee of the Privy Council in the said case that it was settled law that if a word forming part of a mark had come in trade to be used to identify the goods to the owner of the marks, it was an infringement of the mark itself to use that word as the mark or part of the mark of another trader for confusion was likely to result.

19. In *J.L. Mehta and Another Vs. Registrar of Trade Marks*, , *J. L. Mehla v. Registrar of Trade Marks* it was observed by Shah, J., that whenever any word was sought to be registered as a trade mark, that word should in no event be descriptive of the goods in respect of which it was sought to be registered as a trade mark and the test for ascertaining the meaning of a word was laid down in the aforesaid decision to be what a common man in the street would mean by that particular word. The word "Sulekha" which was applied to be registered as the trade mark was used as name of female person and also meant good writing. In such cases when a word has two different meanings out of which one is universally popular and the other is not, the meaning which is universally popular should be accepted and if such meaning do not amount to any description of the goods. In respect of which the word was used, there could be no objection to such word being registered as a trade mark under the Act. Thus the word Sulekha was accepted as the trade mark in respect of fountain pens.

20. In *Ciba Ltd., Basle Switzerland v. M. Ramalingam and S. Subramaniam trading in the name of Ciba Ltd. Vs. M. Ramalingam and S. Subramaniam trading in the name of South Indian Manufacturing Co. and Another*, , it was held that grant of relief u/s 46 of the Trade Marks Act, 1940, was a matter of discretion. Question of delay in making an application, although the legislature did not lay down any period of limitation for making an application u/s 46, should be considered from the point of view as to whether the applicant acquiesced and thereby caused substantial injury to the respondent. If so, that would disentitle the applicant to the relief of revocation or cancellation of the registration.

21. In the case of *The Western India Match Co. Ltd. Vs. The Manohara Match Works and Others*, , it was held by a Single Judge of the Madras High Court that the relief to be given u/s 56 of the Trade and Merchandise Marks Act, 1958, was a discretionary relief and though the High Court was bound to consider the cases

individually on merits, it would ordinarily be loathe to interfere with the discretion of the Registrar.

22. The word "Dora" in Bengali does not mean thread. The words "dore" or "dori", in Hindi as well as in Bengali means thread. It should be noted that ordinarily the words "dore" or (sic ?) user or otherwise cannot be registered as a trade mark with or without design. But as noted earlier, evidence of acquiring of distinctiveness by the said word with or without design was produced before the Registrar of Trade Marks and the Registrar accepted such evidence and registered the said word with design as a trade mark under" the Act. Where the Registrar has exercised such discretion in favour of the respondent, the Court should be wary of cancelling such trade mark and should carefully consider all the facts. The exercise of the discretion by the Registrar certainly is not final and1 conclusive but as was held in the above-mentioned case of The Western India Match Co. Ltd. Vs. The Manohara Match Works and Others, , the High Court would be slow in setting at naught the discretion exercised by the Registrar in favour of a person.

23. I am in respectful agreement with the aforesaid observations made in the above case. The facts noted by me in details in the earlier part of the judgment also, in my opinion, prove that the said word "Dora" with or without design acquired distinctiveness in connection with the vests and Ganjis manufactured by the respondents and as such was rightly registered as a trade mark under the Act

24. It should be noted that the respondent had filed a suit in the City Civil Court, Calcutta, for an injunction restraining the petitioner in the instant application (who is the defendant in the said suit in the City Civil Court) from passing off its goods by marketing the same with the word "Doro" or "Kangandoro" in imitation of the trade mark of the respondent Thereupon this application has been made, it seems, u/s 107 of the Act for cancellation of the said trade mark.

Section 107 of the Act provides as follows:

"107. Application for rectification of register to be made to High Court in certain cases--

(1) Where In a suit for infringement of at registered trade mark the validity of the registration of the plaintiffs trade mark if questioned by the defendant or where in any such suit the defendant raises a defence Under Clause (d) of Sub-section (1) of Section 30 and the plaintiff questions the validity of the registration of the defendants" trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register, and notwithstanding anything contained in Section 46, Subsection (4) of Section 47 or Section 56 such application shall be made to the High Court and not to the Registrar.

(2) Subject to the provisions of Sub-section (1) where an application for rectification of the register is made to the Registrar u/s 46 or Sub-section (4) of

Section 47 or Section 56, the Registrar may, if he thinks fit, refer the application at any stage of the proceeding to the High Court".

25. It also appears to me that power to cancel or vary registration and to rectify the register has been conferred by Section 56 of the Act. Any trader or merchant who is in any way injured or restrained in his business or embarrassed by the registration of the mark will be a person aggrieved (See Powell's Tm. case (1894) 2 RPC 4 . In the said case the law on the point was stated by Lord Herschell in the following terms, to wit;

"Whether it can be shown, as here, that the Applicant is in the same trade as the person who has registered the Trade Mark, and wherever the trade mark, if remaining on the Register, would or might limit the legal rights of the applicant, so that by reason of the existence of the entry on the Register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me he has a locus standi to be heard as a person aggrieved".

26. In view of the aforesaid enunciation of the law I have no doubt in my mind that the petitioner is a person aggrieved within the meaning of the said term used in Section 56 of the Act.

The contentions of Mr. Das that the petitioner is not entitled to apply for cancellation of the said trade mark, thereof, cannot be accepted.

27. For the reasons stated above, I am of the opinion that no case has been made out by the petitioner for the reliefs claimed in the instant application.

28. In the premises, this application must fail and is dismissed with costs.