

(1949) 10 AHC CK 0032
In the Allahabad High Court
Case No : Second Appeal No. 668 of 1949

Chemical Industrial and Pharmaceutical Laboratories Ltd.	APPELLANT
Vs	
Prasanta Rotan Dhan	RESPONDENT

Date of Decision : 23-10-1949

Acts Referred:

Trade Marks Act, 1940 — Section 20

Citation : AIR 1950 All 258

Hon'ble Judges : Raghubar Dayal, J; Mushtaq Ahmad, J

Bench : Division Bench

Advocate : Walter Dutt and Man Singh, for the Appellant; Ambika Prasad and N.N. Mukerji, for the Respondent

Final Decision : Allowed

Judgement

Mushtaq Ahmad, J.—This is a defendants' appeal in a suit relating to an alleged infringement of trade-mark. The plaintiff is the proprietor of a manufacturing firm called the Indian Drug House, Allahabad, while the defendants are a firm in Bombay manufacturing and dealing with various classes of medicine. The plaintiff in 1930 put on the market a certain medicine considered to be a nervine tonic which he labelled with the words "Tonic Phosphotone" while the defendants about six years later brought out another medicine which they advertised under the title of "Cipla Phosphoton". Since this year the two medicines, as found by the trial Court, had been in the market and enjoyed each a certain degree of popularity.

2. It is necessary to visualise the precise basis on which the plaintiff sought his relief which was for a permanent injunction restraining the defendants, his servants and agents from manufacturing and offering for sale, etc., anywhere in the country any stuff with the mark and design—"Phosphotone" or in any other name, design or get-up, as amounting to a colourable imitation of the name and design of the plaintiff's medicine. The plaintiff also claimed a mandatory injunction directing the defendants to deliver to him all stocks in their possession

of their "Phosphoton" together with the packing, signboards, labels, labelled bottles and literature, as well as the blocks or dies used in printing the same. A third relief for accounts, or, in the alternative for Rs. 1,500 as damages was also claimed. As I have said, it is essential to ascertain the exact basis, as alleged in the plaint, of these reliefs.

3. The plaintiff's case was that he had on 20th March 1930, got the name "Tonic Phosphotone" registered with the Registrar of Assurance, Calcutta, who was the proper authority for that purpose, that this mark was indicative of the medicine he had produced and that the defendants by putting on the market another medicine under the name of "Phosphoton", which was only an imitation of the plaintiff's "Phosphotone", were guilty of an infringement of the plaintiff's exclusive right and monopoly of using the latter name. It is true that in his relief in the plaint, the plaintiff had used the words "passing off", while claiming an injunction against the defendants and" praying that the latter should be prevented from doing so in the circumstances mentioned in the plaint.

4. On a bare reading of the plaint, it would be manifest that the plaintiff's case was one of an alleged infringement of a registered trademark belonging to him by the defendants firm. He, no doubt, used the words "passing off" which perhaps could have been more appropriately, used only in an action known as a "passing off action" and not in a suit based on an alleged infringement of a trade-mark strictly so called. All the same, looking into the background preceding the relief in the plaint and expressed particularly in paras. 4, 5 and 11 of the same, there can be no doubt that the suit remained to be one of an alleged infringement and was not really a passing off action.

5. The nature of the issues framed, as also the scope of the enquiry made by the Courts below, and, indeed, the wide area covered by the learned counsel in their arguments before us, no doubt, embraced the utmost limits within which the owner of a trade-mark could claim relief as against a person guilty of an alleged infringement of that mark, and I have also decided to examine the entire position in the light of the relevant law and the facts found in this case, even though I shall have to travel far beyond the actual pleadings. To that extent my discussion of the various issues would be more or less academical in the sense that the controversy really arising on the pleadings admits of a much shorter examination in the decision of the case.

6. It was agreed at the bar that such registration, as the plaintiff might have obtained from the Registrar of Assurance, Calcutta, in 1930, as mentioned in para. 4 of the plaint, was of no avail in creating for him a right of exclusive use of his trade-mark, such as would result from a registration effected under the provisions of the Indian Trade-Marks Act V [5] of 1940. This being so, the privileges flowing from proceedings taken under this Act had never accrued to the plaintiff merely from his having obtained an order or certificate from the Registrar of Assurance, Calcutta. In effect, therefore, the plaintiff's trade-mark, go far as the present litigation is concerned, would be deemed to have never

been properly registered under the law. This would lead to the question as to what was the nature of the title under which the plaintiff had been selling his medicine, whether it was a merely descriptive name or an invented or coined one and the question whether, if it was merely descriptive, the plaintiff could claim a secondary meaning for the name with the concomitant right of preventing the defendants from using a, similar title for their own medicine.

7. It cannot be denied as a proposition of law that if the plaintiff had got his trade-mark registered under the aforesaid Act, he was the only person entitled to use it against the whole world and that if anybody imitated that mark he made himself liable to a charge of infringement of the same. And, in such-a case, the plain-tiff would be entitled to all the reliefs claimed by him without any objection. As we said, this seems to have been the real scheme of the plaint filed by the plaintiff. If it could be justified in fact, there would have been no difficulty in granting him the reliefs he had claimed. The scope of the enquiry hap, however, been very much expanded by the nature of the issues framed, the scope of the discussions in the judgments of the Courts below and the area covered by counsel in their arguments in those Courts and also before us. This has involved a consideration of various issues, mostly of law, as I shall presently note.

8. There can be no doubt about the legal position, and the learned counsel for the parties have not, very rightly, suggested any conflict between themselves, so far as that aspect of the case is concerned. It is admitted that in respect of a trade-mark, which is merely descriptive in the sense that it has a reference only to the nature of the product in question suggesting the ingredients, or at least the most important ingredient, of which it is made, the manufacturer can claim no monopoly of user. If anybody in such a case puts on the market a similar product under a similar name, he incurs no legal liability, being free to do so without committing any breach of law. If, however, the word used for the mark in question can be said to be an invented or coined word, with which a particular manufacturer alone can be credited, he only has the exclusive right to use it imposing a corresponding obligation on every other person to desist from using the same for his own product. In such a case the manufacturer inventing the word has a monopoly of its use and anyone imitating the same does it at his peril. This would obviously be a question of fact in each case whether a particular title under which a manufacturer has brought out his product is merely descriptive or invented.

9. I have, therefore, at once to consider this question so far as the present case is concerned. The Courts below held that the word "Phosphotone" was in this case a coined word. They were influenced in this finding almost entirely by the fact that the defendants themselves had applied for registration of their trade-mark "Phosphotone" presumably because that was a word invented by them and that, therefore, the plaintiff's words "Phosphotone" could also be taken as a coined word. This, in our opinion, was a wholly wrong approach. Whatever the defendants might have done and be it remembered that the authorities had not

allowed registration of the defendants' word by the time the suit was filed--the question whether the word "Phosphotone" was or was not a descriptive word had to be decided on its own merits and irrespective of what the defendants had done in respect of their own trade mark "Phosphoton". As I said, the term "descriptive" has reference to the nature of the product having regard to its ingredient or ingredients and not to its manufacturer. If from the title under which a certain article is sold in the market, a customer is led to think of the particular nature or quality of it and he does not necessarily think of the origin of the article, namely of the person or firm that has put it on the market, the title is purely descriptive. On the other hand, if the word is such as to suggest an allusion to the particular manufacturer who is responsible for that article, then the term is not descriptive but an invented or coined word which at once induces an idea in the mind as regards the actual person or persons who manufactured the same.

10. The term "Phosphotone" consists of two words combined after omitting certain letters, "Phosphorus" and "Tonic", suggesting that the medicine selling under that name is a tonic of which the main or the most important element is phosphorus. It has thus essentially a reference to the nature or essence of the medicine and has nothing to do with the particular person or firm that manufactured it. It was, however, argued by the learned counsel for the plaintiff-respondent that there being no such single word in English as "Phosphotone" it had to be taken as a word coined. Apart from the fact that the term, even as formed by combining two English words after omitting certain letters for the sake of brevity and elegance, retains its suggestiveness of the product for which it has been employed, it was held by Lord Herschell in *Eastman Photographic Materials Company v. Comptroller General of Patents, Designs and Trade Marks* 1898 A. C. 571 : 67 L. J. Ch. 628 that a mere combination of two English words is not an invented word, even though the combination may not have been in use before, nor indeed

"a mere variation of the orthography or termination of a word would be 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."

I am, therefore, of opinion that the term "Phosphotone" was not an invented or coined but a purely descriptive word.

11. The next question is whether this word had acquired a secondary meaning so as to suggest its origin or author, namely the plaintiff in this case. We shall have to consider this question with reference to the entire period between 1930, when it was first used, and 1945, when the suit giving rise to this appeal was filed. The period between 1930 and 1936 in which year the defendants brought out their medicine under the name of "Cipla Phosphoton" should not be taken into account as during that interval there was no competitor in the market selling his product under a similar name and, therefore, there could be no question of the plaintiff having acquired a secondary meaning for the title of his medicine as against a

rival tradesman. It was held by Fry J. in *Linoleum Manufacturing Co. v. Nairn* (1878) 7 Ch. D. 834 : 47 L. J. Ch. 430 that:

"until some other person is making the same article and is at liberty to call it by the same name, there can be no right acquired by the exclusive use of a name as showing that the manufacture of one person is indicated by it and not the manufacture of another."

Again, Lord Davey in the *Cellular Clothing Company v. Maxton and Murray* 1899 A. C. 326 : 68 L. J. P. C. 72 observed that:

"Where a man produces or invents it you please, a new article, and attaches a descriptive name to it, a name which, as the article has not been produced before, has, of course, not been used in connection with the article, and secures for himself either the legal monopoly or a monopoly in fact of the sale of that article for a certain time, the evidence of persons who come forward and say that the name in question suggests to their minds and is associated by them with the plaintiff's goods alone is of a very slender character for this very simple reason because the plaintiff was the only maker of the goods during the time that his monopoly lasted, and therefore there was nothing to compare with it, and anybody who wanted the goods had no shop to go to, and no merchant or manufacturer to resort to, except the plaintiff."

12. There could, therefore, be no question of the plaintiff acquiring a secondary meaning for the name of his medicine during (he period between 1930 and 1936, when there was no other competitor in the market. As regards the later period between 1936 and 1945, the position does not appear to be any the better for the plaintiff, so far as this point is concerned. The lower appellate Court, no doubt, quoted the law correctly by referring to the case of *Modi Sugar Mills Ltd. v. Tata Oil Mills Co. Ltd.*, Bombay A. I. R. 1943 Lah.. 196: I. L. R. (1943) Lah. 427 that a word or name which is primarily descriptive of a particular kind of goods may in course of time lose its ordinary meaning and by long user acquire a secondary meaning indicating that the goods sold under that word or name are not merely goods of that description but goods made by, a particular manufacturer. But it stopped short there and, so far as the present case was concerned, it did not record any finding at all as to whether the name "Phosphotone" had in fact acquired any secondary or descriptive meaning by virtue of long user. It appears that the learned Civil Judge only assumed that it had acquired such a meaning. The trial Court, on other hand, recorded a finding on issue 6 on this point in favour of the plaintiff, but that finding was open to two serious objections. One was that it was influenced largely by the erroneous view that the word was a coined word and the other was that it was based on a reasoning which rather destroyed than justified the finding. A third error which introduced a grave irregularity into the finding was that the learned Munsif wrongly assumed that the defendants had brought out their product as recently as 1942, although admittedly it had been put on the market as early as 1936. The year 1942 was the year in which the defendants had only applied for

registration of their title, although they had actually been selling their medicine for no less than six or seven years previously. The learned Munsif remarked as follows:

"After that the defendants firm took a fancy to the name "Phosphotone" and adopted it by dropping the last letter V. It is not disputed that the defendants' firm is a much bigger concern and commands vast resources. The result was that after the defendants adopted this name and started manufacturing this medicine, they advertised it in a far better manner. And Cipla's name being known better than that of the Indian Drug House, it was not at all surprising that the defendants could sell this medicine even to a greater extent than the plaintiff. And now the sale of this medicine by the defendants exceeds that by the plaintiff. The defendants have also been able to increase the price of the 8 oz. phial from Rs. 3-8-0 in the year 1943 (vide Ex. A-7) to Rs. 5/- in the year 1946 (vide Ex. A-19).

At present both the parties are selling this medicine in the market, and both say that their medicine has got a good market. The introduction of the medicine "Phosphoton" must have created a good deal of confusion in the market. And it is possible that some of the dealers might be associating the name of the medicine with the Cipla concern, while others might still be associating it with the Indian Drug House."

13. This would show that there is a free sale in the market of both the medicines and that the customer has always been able to know which particular medicine he is buying. There could thus be no question of the one passing for the other medicine, nor could the plaintiff's medicine, in such a case, have acquired any secondary meaning so as to entitle him to prevent the sale of the other stuff on any ground of a monopoly of name.

14. Apart from the above position, the learned Civil Judge himself pointed out that the two packages were quite different in their outer form, that the plaintiff's bottles were of 4 and 8 oz. size, while the defendants' bottles of 8 and 16 oz., that the defendants were charging a much higher price, namely Rs. 5 for 8 oz., while the plaintiff charged only Rs. 2 for 8 oz., that the plaintiff's medicine was packed in packets containing green label, while the label of the defendants' medicine was yellow, that the designs of the two labels were quite different and that while the plaintiff was using the word "Tonic" immediately preceding the word "Phosphotone", the defendants were using the word "Cipla" for distinguishing their goods from those of the plaintiff. The learned Judge after pointing out these numerous features of distinction between the two products merely remarked that:

"These differences, however, only reveal the trademark of the packages. A purchaser who only wants to purchase a certain tonic known by the name of "Phosphotone" is liable to be deceived into believing that the medicine "Phosphoton" is the same which was prescribed or suggested to him."

15. The two packages, each of a particular party, were placed before us during the arguments, and we noticed the divergent features which they presented to the naked eye, and we felt that it was not possible for any customer, however careless or unwary he was, to take the one for the other.

16. Having reserved the judgment in this case after hearing the learned counsel for the parties it occurred to the Bench that it might hear them further on the question whether there was any evidence on the record on the point of the name "Phosphotone" having acquired a secondary meaning. The litigation having already taken about four years, the Bench thought it desirable to consider such evidence and record a finding of its own instead of prolonging the case, still further by sending for a finding from the lower appellate Court. Accordingly, the appeal was listed again, and the entire evidence was read and commented upon by the learned counsel on each side.

17. Before I enter into this evidence, I must mention that it did not, in my opinion, throw any direct light on the question just mentioned. The reason obviously was that the plaintiff himself had not framed the plaint as he would have done if the relief claimed by him had proceeded on any such basis. As I observed earlier, his case was one of an infringement of a trade-mark, although, admittedly, he had never got the name of his medicine duly registered under the law. This clearly was the reason why the lower appellate Court itself had not recorded any finding on this question, the matter obviously not having been argued before it, in spite of some observations relevant thereto having been made by the trial Court under issue No. 6.

18. The evidence actually given by the witnesses thus not being quite definite, so far as this particular question is concerned, I have to see whether any inference can be drawn from it as proving the contention of the plaintiff's counsel before the Bench that the name "Phosphotone" had acquired a secondary meaning before the institution of the suit. [Their Lordships then discussed the evidence on both sides and came to the conclusion that there was no material on the record to justify a finding that the plaintiff had acquired any secondary meaning for the name of his medicine by the time he filed the suit. The judgment then proceeds as follows :

19. In view of these circumstances, I think that the contention of the learned counsel for the respondent that the term "Phosphotone" had acquired a distinctive or secondary meaning, suggesting the name of its manufacturer, was not well-founded, and I cannot accept it. It should also be remembered that there was no finding by either of the Courts below that the defendants had been guilty of fraud in representing their goods as those manufactured by the plaintiff. In cases in which such a position is made out, different considerations will, no doubt, arise, and the aggrieved party would certainly be entitled to be protected against the encroachments of a rival manufacturer. Such was the case in *Frank Reddaway and Frank Reddaway & Co., Ltd. v. George Banham and George Banham & Co., Ltd.* 1896 A. C. 199. Learned counsel for the respondent strongly

relied upon this case in support of his claim and learned counsel for the appellants sought to distinguish it on the ground that the ratio decidendi there was a finding that the defendants had been guilty of fraud in passing off their goods as those manufactured by the plaintiffs. The facts there showed that the defendants had suggested to their suppliers the removal of a particular name from the belting in order to bring it in consonance with the similar stuff sold by the plaintiffs who had brought out the article under the style of "Camel-hair Belting". That was held to be an attempt to remove a feature of dissimilarity between the articles manufactured by the plaintiffs and that brought out by the defendants, and the removal of the name betrayed a desire to introduce a fictitious identity between the two products, thereby showing that both were the manufactures of the plaintiffs' firm. The finding of fraud in that case was coupled with the finding that the term "Camel-hair" had "acquired a secondary signification in connection with belting" and did not convey to persons dealing in belting the idea that it was made of camel hair, but that it was belting manufactured by the plaintiff". This really formed the crux of the decision in that case. Referring to this case Lord Shand in *Cellular Clothing Company v. Maxton and Murray* 1899 A. C. 326 : 68 L. J. P. C. 72 remarked that:

"In the case of *Reddaway* it was held there was fraud. The person who sold the goods (the Camel hair Belting) had expressly said that he would be enabled by using that term to sell his goods as the goods of the plaintiffs, and if the term "Camel hair Belting" had really come to mean the plaintiffs' belting in the trade and with the public, and the defendant knew this, that was a case of fraud. In the case of *Reddaway*, I understand it was held that the words had acquired the secondary meaning alleged, and that the defendants' knowledge of this -was important evidence on that point."

20. This case was strongly relied upon by the learned counsel for the appellants who argued that the word "Cellular" in "*Cellular Clothing Co.*," was held there as an ordinary English word which appropriately and conveniently described the cloth and by which the goods sold by the plaintiffs were manufactured, it being further held that the term had not acquired in that case any secondary or special meaning so as to denote only the goods of the plaintiffs. The entire legal position was affirmed by their Lordships of the Privy Council in the case of *Canadian Shredded Wheat Co. Ltd. v. Kellogg Co. of Canada Ltd.* A. I. R. 1938 P. C.143 : 175 I. C.178 in which it was emphasised that words merely descriptive of patented products could not be registered as a trade-mark, that a descriptive word might have acquired a secondary meaning, and that to ascertain this it should be seen how the manufacturer used the word, whether as a trade, mark or common law trade-mark for indicating the origin of the goods or merely descriptively. It was further pointed out that the word "secondary" meant that the name had become distinctive of a particular manufacturer rather than descriptive of the goods.

21. Learned counsel for the plaintiff-respondent contended that in determining

the question whether a certain article was likely to be taken by the normal customer as one manufactured by a particular person, it was the features of similarity and not those of dissimilarity that should weigh with the Court. He relied on the case of Chetarpal Sharma Vs. Jagannath Das, That was a case, the decision of which depended on the peculiar facts which it Disclosed. Numerous aspects of similarity between the articles manufactured by two rival tradesmen were pointed out by Mears C. J. who delivered the judgment of the Bench, and his Lordship found no alternative but to hold that they were so predominant as against the few features of dissimilarity between those articles that no other conclusion was possible except that the defendants betrayed a desire to imitate the product of the original manufacturer with the definite object of passing off his own goods as the goods of that manufacturer. That is not the case here on the observations made by the learned Civil Judge himself, as I have above quoted. Learned counsel also relied on the judgment of the same Chief Justice in the The Swadeshi Mills Co. Vs. Juggi Lal, Kamlapat Cotton Spinning and Weaving Mills Co., Ltd., for the following observation :

"In the case of an infringement of trade-mark no general rule can be laid down as to what is or is not a mere colourable variation. Standards differ and education is one of the factors. All which can be done is to ascertain In every case as it occurs whether there is such resemblance as to deceive a purchaser using ordinary caution."

22. There is nothing in this enunciation which I need question. The facts of the present case do not, in my opinion, bring it within the mischief of the rule there stated. I have already pointed out by quoting from the judgment of the lower appellate Court the numerous dissimilarities between the labels and packages etc. of the two products in this case, and have held that it was not possible for the defendants to pass off his own article as a product of the plaintiff.

23. I have, therefore, come to the conclusion that the plaintiff not having registered his trade-mark and the same being merely descriptive and not having acquired any secondary meaning, nor there being a finding of fraud by the Courts below against the defendants, he was not entitled to any relief against them in the present case.

24. I would, accordingly, allow this appeal, set aside the decrees of the Courts below and dismiss the suit with costs throughout.

25. Raghubar Dayal J.-- I have read the judgment of my learned brother and agree with him in the conclusions and order proposed. I just set down my views on the legal points in the case which approach the question in a slightly different way.

26. The plaint of the suit was not very happily drafted. The suit was, however, understood by the parties concerned and by the Courts below to be really a suit relating to the defendant company passing off its product of Cipla Phosphoton as the product Tonic Phosphotone of the plaintiff company. It is also no more in

dispute that the plaintiff company has no case on the basis of the infringement of the trade-mark simply because the name Tonic Phosphotone had not been registered by it as a trade mark under the Trade Marks Act of 1940.

27. The essence of a "passing off action" is in reality an attempt by the defendant to pass off its goods as the goods of the plaintiff. In (Yorkshire Relish case) *Birmingham Vinegar Brewery Co. v. Powell* 1897 A. C. 710: 66 L. J. Ch. 763 Lord Halsbury L. C. remarked :

"The proposition of law is one which has been accepted by the highest judicial authority and acted upon for a great number of years. It is that of Turner L. J. who says in *Burgess v. Burgess* (1853) 22 L. J. Ch. 675 : 3 De G. M. & G. 896). "No man can have any right to represent his goods as the goods of another person, but in applications of this kind it must be made out that the defendant is selling his own goods as the goods of another" The most obvious way in which a man would be infringing the rule laid down by Turner L. J. is if he were to say in terms, "These are the goods manufactured by" a rival tradesman; and it seems to be assumed that unless he says something equivalent to that no action will lie. It appears to me that that is an entire delusion. By the course of trade, by the existence and technology of trade, and by the mode in which things are sold, a man may utter that same proposition, but in different words and without using the name of the rival tradesman at all. A familiar example, of course, is when, without using any name, by the identity of the form of the bottle or the form of the label, or the nature of the thing sold in the package he is making the statement not in express words but in one of those different forms in which the statement can be made by something that he knows will be understood by the public. In each case it comes to be a question whether or not there is the statement made; and if the statement is made, there can be no doubt of the legal conclusion that he must be restrained from representing that the goods that he makes are the goods, of the rival tradesman."

28. It follows, therefore, that the primary thing which a plaintiff has to prove and the Courts have to determine in a "passing off action" is whether the defendant's actions are such as lead to the conclusion that he was making a false representation to the effect that his goods were the goods of the plaintiff.

29. It is clear that the defendant, apart from the use of the word, "Phosphoton", took care to put its product in the market in such a manner as to exclude the possibility of deception. It not only made its get-up very different, but also put its product in bottles of different sizes and added the firm's name to the word "Phosphoton."

30. An ordinary purchaser who intends to purchase the plaintiff's Tonic Phosphotone is not likely to accept the defendant's Cipla Phosphoton by mistake. He would at once know that he was not getting the article he wants as it must be presumed that he was acquainted with the get up, quantity and price of a bottle of the plaintiff's Tonic Phosphotone. Persons who deal in such medicines,

namely, chemists and doctors, can have no possible excuse for obtaining by mistake one article for the other. They will be able to avoid the mistake not only from these details but also from the different names, the two full names being quite different; one being Tonic Phosphotone and the other being Cipla Phosphoton.

31. A possibility, however, exists of a chemist or dealer selling the defendant's Cipla Phosphoton or the plaintiff's Tonic Phosphotone to a customer who simply asks for Phosphotone, and who has no idea of any particular manufacture. Such possibility exists on account of the apparent unanimity in the phonetic pronunciations of the words, "Phosphoton" and "Phosphotone", but there can be no valid suggestion that the defendant company deliberately wanted to commit a fraud and to pass off its product as the product of the plaintiff. The motive, however, is not of much consequence in such actions. If it is clear that the defendant wanted to commit fraud, it might, along with other circumstances, have led to the conclusion that the word-name adopted by a defendant had, due to its prior use by the plaintiff company, got associated with the product of that company and conveyed an idea of the plaintiff's product alone when used by the public or a possible customer. Such a conclusion was drawn in the well known case of *Frank Reddaway & Frank Reddaway & Co., Ltd. v. George Banham & George Banham & Co., Ltd.* 1896 A. C. 199, where the defendant company had deliberately removed a particular name in order to let the remaining description of the article convey to a likely purchaser that the article was of the plaintiff company.

32. It is in connection with this aspect of the matter that it is to be considered whether the word, "Phosphotone" can be said to be an invented word or a mere descriptive word. If it is an invented word, it might lead to a presumption that the defendant company deliberately adopted the word invented and used by the plaintiff for a similar product, as it would be rather improbable that the defendant should be able to think of the same invented word independently. Such a conduct of the defendant would ordinarily be due to a realisation that the public associates that word-name with the product manufactured by the plaintiff company and that unless the same word-name be used, the defendant's product was not likely to secure a market. The conduct will, therefore, clearly amount to an attempt to deceive the public regarding the nature of the defendant's product.

33. In *Cellular Clothing Company v. Max-ton & Murray* 1899 A. c. 326: 68 L. J. P. C. 72 Earl of Halsbury L. C. said at page 333 :

"Then the learned Judges go on with great accuracy I think, to say : "An invented name has either no meaning at all, or no meaning in relation to the goods which it denotes; and it has been held that a trader who selects such a name for the purpose of distinguishing his goods from those of other traders is entitled to be protected in the use of the sign which he has chosen. In such a case the mere fact of the use of the arbitrary sign by rival trader raises a presumption of a design to pass off, his goods under false colours which it is not

easy to displace." Every word of that I concur with." At page 339 Lord Shand says :

"The idea of an invented or fancy word used as a name is that it has no relation, and at least no direct relation, to the character or quality of the goods which are to be sold under that name. There is no room, whatever for what may be called a secondary meaning; in regard to such words, as the Lord Advocate pointed out in the course of his argument. The word used, and attached to the manufacture, being an invented or fancy name and not descriptive, it follows that, if any other person proceeds to use that name in the sale of his goods, it is almost, if not altogether, impossible to avoid the inference that he is seeking to pass his goods off as the goods of the other manufacturer."

34. An invented word need necessarily be a word which is not in the current vocabulary of the language or languages of the country, as none would speak of a current word as an invented word. An invented word has to be thought of quite independently and is, therefore either borrowed from a foreign language which is not current in the country or will be a combination of some current words either in their original form or after some distortion, or will be an absolutely independent grouping of alphabets. A word which may be said to be invented merely because it is not in the current vocabulary of the language need not be such an invented word that no rival trader would ordinarily think of it. It would be such an invented word only if it has no direct or indirect reference to the composition or quality of the article for which it is used. If the new and so invented word has such a reference, it should not be a matter of surprise that such a word may strike a rival trader independently, because he too would like to advertise the prominent qualities or uses or ingredients of the article he deals in. In this connection reference can be usefully made to the views expressed about invented words in *Eastman Photographic Materials Company v. Comptroller General of Patents, Designs and Trade Marks* 1898 A. C. 571 : 67 L. J. Ch. 628 which dealt with the question whether the word "Solio" could be registered as an invented word under the Patents, Designs and Trade Marks Act, 1883, as amended by the later Act of 1888. The Earl of Halsbury L. C. remarked at page 577 :

"I can quite understand suggesting other words --compound words, or foreign words, as to which it would be impossible to say that they were invented words, although perhaps never seen before, or that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before. Suppose a person were to attempt to register as a single English word, "Cheapandgood", or even without taking so gross an example, using a word so slightly differing from an ordinary and recognised word as to be neither an invented word nor avoiding the prohibited choice of a word, indicating character or quality. The line must be sometimes difficult to draw. ... Of course also words which are merely misspelt but which are, nevertheless, in sound, ordinary English words, and the use of which may tend to deceive, ought not to

be permitted."

Lord Herschell remarked at p. 580:

"In a later part of the judgment to which I have already referred, A. L. Smith L. J., says that to constitute an invented word,, within the meaning of the section, it must be a word coined for the first time. "Such a word", he says, "is of necessity incapable of having reference to the character or quality of goods, because ex hypothesi, it is an entirely new unknown word incapable of conveying anything." With this --subject to a qualification to which I will refer in a moment--I entirely agree. An invented word has of itself no meaning until one baa been attached to it ...

It may no doubt sometimes be difficult to determine whether a word is an invented word or not. 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; nor do I think that a mere variation of the orthography or termination of a word would be 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. Again, I do not think that a foreign word is an invented word simply because it has not been current in our language. At the same time, I am not prepared to go so far as to Bay that a combination of words from foreign languages so little known to this country that it would suggest no meaning except to a few scholars might not be regarded as an invented word. It is in this respect that I desire to qualify my assent to A. L. Smith L. J.'s proposition that an invented word can never have a meaning."

Lord Macnaghten says at p. 583:

"But the word must be really an invented word. Nothing short of invention will do. On the other hand, nothing more seems to be required. If it is an invented word. If it is "new and freshly coined" (to adapt an old and familiar quotation), 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. I do not. think that it is necessary that it should be wholly meaningless."

Lord Shand says at p. 684:

"At the same time, I agree with your Lordships, and particularly with what has been said by my noble and learned friend Lord Macnaghten, in thinking, especially after the decision to be given in this case,, that the Comptroller General will be fully warranted in taking care that there shall not be admitted, under the guise or cover of words called "invented" by the applicant, words really in ordinary use, which might,,, in a disguised form, have reference to the character or quality of the goods. 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."

35. Keeping in view the narrow particular meaning of an invented word for the purposes of a "passing off action", I am of opinion that the word, "Phosphotone", applied by the plaintiff to its Tonic is not such an invented word,, though it may be said to be an invented word in the wider sense on account of the reason that no such word exists in the English vocabulary. The word, "Phosphotone", would clearly lead a person to think of Phosphorus and Tonic, This is the usual manner in which a good number of medicines or compounds containing phosphorous are named. In fact, the full name of the plaintiff's product is Tonic Phosphotone and it makes it very easy for the people to understand that it is a Tonic which includes phosphorus. Learned counsel for the respondent pointed out that phosphorus was not an important ingredient of the medicine mentioned in the leaflet and on the label "n the bottle. The ingredients do include a number of phosphates and it is not disputed that phosphorus is an important ingredient of a tonic for body and brain. The word is, therefore, such that it can easily strike-a person for a product which is a tonic for body and brain and which includes phosphorus in some form. I hold that the word, "Phosphotone", has reference to the ingredients and nature of the medicine and is a descriptive word.

36. For the above reasons, I agree in allowing the appeal with costs.

37. By the Court.--The appeal is allowed, the decrees of the Courts below are reversed and the plaintiff's suit is dismissed with cost throughout.