

(1967) 07 MAD CK 0014
In the Madras High Court

Kimberly Clark Corporation		APPELLANT
	Vs	
Bay's Chemicals		RESPONDENT

Date of Decision : 26-07-1967

Acts Referred:

Citation : (1968) 81 LW 23 : (1969) 2 MLJ 14

Hon'ble Judges : M. Anantanarayanan, C.J

Bench : Division Bench

Judgement

M. Anantanarayanan, C.J.—Messrs. Kimberly Clark Corporation were the owners of the trade mark Kotex, a mark relating to sanitary

napkins and belts, which were being sold by the firm in international markets. It appears that this mark had a previous history. The original

registration relating to a Wisconsin Corporation, which effected this registration at Calcutta in 1944. In 1940, this country legislated a new measure

with regard to the registration of trade marks (Indian Trade Marks Act, 1946) and the International Cellucotton Products Co., obtained rights with

regard to this particular mark. Kimberley Clark Corporation (appellants) are the successors in respect of this right.

2. The respondents before us (Bay's Chemicals) applied for registration of the trade mark Blotex, relating to the same category of goods, namely,

sanitary napkins and belts, and the appellant firm instituted a notice of opposition during the attempted registration of this mark. The objections

were overruled by the Assistant Registrar of Trade Marks, who accepted the word Blotex and placed in the Register, as the trade mark relating to

the goods traded in by the respondent firm. The dispute came up before Venkatadri, J., in C.M.A. No. 317 of 1961, and after a reference to

several of the leading decisions, the learned Judge held that the respondents were entitled to maintain the entry in the register, and that the appellants had no cause of action. The appeal was dismissed, and the present Letters Patent Appeal is instituted from the judgment of the learned Judge.

3. The grounds are restricted in scope, and there are only two arguments that appear to require notice at our hands. The first is that u/s 9 (1) (c) of the Act (XLIII of 1958), the word Blotex is not an invented word, according to the appellant's contention. One line of reasoning here is that this word is really a combination of two distinct words, namely Blot and Ex. The authorities are clear, that a word which is a bare or undisguised compound of two other words, cannot by any means be termed as "" invented word "" within the meaning of the Trade Marks Act. The other argument is that, even apart from this aspect of the case, the word Blotex has some reference to the character or quality of the marketed goods, and that, on that ground also, it cannot be termed an invented word. On the contrary, it is a Word falling within the prohibition of a reference to the character or quality of the goods, to which the mark purports to be assigned.

4. This is the first aspect of the argument. The second aspect is that, independently of this contention, the word is calculated by its close phonetic similarity to Kotex, the registered trade mark of the appellant firm, to deceive the unwary customer, and to cause confusion. Hence, it is strenuously contended, on the principles laid down by their Lordships of the Supreme Court in Amritdhara Pharmacy Vs. Satyadeo Gupta, , that we should conclude that the word Blotex is likely to deceive and confuse persons of the class who have been habitually purchasing the Kotex preparations, and for that reason that the mark should be effaced from the Register.

5. We might immediately state that, upon the question whether the word Blotex is an invented Word or not, the learned Judge after referring to certain leading decisions in which the principles are expounded, came to the conclusion that the word Blotex is not an invented word, and hence that Section 9 (1) (c) had no application to the case. Since, after a very careful consideration we are unable to agree with the learned Judge, and, on the contrary, we have no doubt whatever that the word Blotex is an invented

or coined Word, within the ambit of the principles, we might immediately deal with this matter before proceeding into the related aspect of a deceptive similarity between two marks either as regards the sound, or the orthography.

6. The learned Judge has referred to the dictum of Lord Macnaghten in *The Eastman Photographic Materials Company, Ltd. v. The Comptroller-*

General of Patents, Designs, and Trade Marks L.R. (1898) A.C. 571, and stressed that, on the test of what is an invented words, there may be no

objection even if the word does contain a covert and skilful allusion to the character or quality of the goods. Lord Macnaghten added:

I do not think that it is necessary that it should be wholly meaningless.

7. Lord Halsbury said that a compound word which is, *ex facie* a bare or undisguised combination of other complete words, could not be

regarded as an invented word. But he further said that "the line must be sometimes difficult to draw." The learned Judge also quoted the dictum of

Lord Herschell to the effect that combination of two English words would not, ordinarily, be an invented word. The principle is that there must be

invention, and not the mere semblance or appearance of an invention.

8. We have set forth these criteria, as in our view, there is no room for doubt or confusion on this aspect. But we think that there is an evident

fallacy, in applying these principles to the word *Blotex*, in the manner in which the Registrar has applied them which apparently was approbated by

the learned Judge (Venkatadri, J.). We are quite unable to regard the word *Blotex* as a compound of two distinct words *Blot* and *Ex*; the latter

word is meaningless in ordinary English usage, and it is really a Latin expression signifying "out of." The reason why we think that the trade mark

Blotex cannot be possibly regarded as a compound of these two words, is a clear and simple one. The Latin expression, *Ex*, namely, "out of" is

never used as a suffix to an English word, and if so employed, is altogether meaningless. On the contrary, the Latin expression *Ex* is generally

employed to precede another expression, when alone it makes sense, for instance, *ex post facto*.

9. Actually, we think that there is a far simpler explanation for the coinage of such words as *Kotex* or *Blotex*. Apparently, there is a current trade

fashion, in coining words descriptive of various kinds of goods, so as to end with

Tex or Ex. This is purely, a fashion springing from a presumed phonetic elegance. In this respect, other instances may be given such as Caltex, Cutex and Optrex. For that matter, the appellants cannot dispute

that the word Kotex is a coined word, and the form of the word clearly relates to a particular kind of popular trade fashion. Further, the argument

advanced before us for the appellants, relating to orthography, really cuts at the root of the contention that the word Blotex is born out of Blot and

Ex. On the contrary, the argument is that this word is deceptively similar to the word Kotex, because the letters otex are common to both.

10. We think that it would be very dangerous to regard trade marks as possibly compounded of syllables, forming words in different languages like

English and Latin and to regard them as not being "invented words" for that reason. It is obvious, for instance, that the syllables or words which are

trade marks in English, even if purely invented, might correspond to other words, in a regional language like Tamil. It would be clearly fallacious to

argue that these are not invented words, for that particular reason.

11. Another argument, which has been somewhat elaborated in the affidavit filed on behalf of the appellants is, that the name Blotex includes the

word Blot, which itself has some reference, even if not direct but oblique, to the character or quality of the goods," to which the mark is supposed

to relate; This argument appears to us to be very far-fetched, and quite unconvincing. We think that it is most unlikely that the coiners of this word

had this particular significance in mind, when the word was used. Nor do we think that it is "at all likely, that purchasers of these goods will

associate the part-word Blot, out of the word Blotex, as relating to a possible use of sanitary napkins in personal hygiene. On the contrary, it

appears to be fairly evident, if achieving popularity for the goods was the intention behind the word, that the coiners must have regarded it as quite

unfortunate to make a compound word from the word "blot", as having some veiled reference to the use of sanitary napkins in removing stains.

We have no doubt whatever that the word Blotex is a coined word, having no intended relationship either to the word "blot" or to the use of this

product in personal living, but merely following the trade fashion of the coinage of words descriptive of goods as ending in "tex" or "ex". We are

also clear that the Latin expression "ex", meaning "cut of," has no

relationship, logically or in any other manner, to the trade mark.

12. It would thus follow that the word really falls within Section 9 (1) (c) of the Act. The learned Judge (Venkatadri, J.) has given other instances

of Trade Marks from the case-law, but, in our view, there is no area of law where precedents are less directly relevant, apart from the applied

principles that they might expound, than in the region of the law relating to trade marks. The only safe rule is to proceed to the precedents for the

exposition of the leading principles, and to strictly adjudicate, in each case, on the aggregate of its particular facts. We do not think that it is

necessary to state anything more on this aspect.

13. But though the word Blotex may be an invented word, it is still possible for the appellants to contend that, in view of the long-established prior

user and registration of their mark Kotex, the registration of Blotex ought not to be allowed, because of the possibility of deception and confusion

in the minds of customers. Here, we might immediately state that this argument has to be met on its merits, and quite irrespective of the fact that the

product Kotex has not been available in the Indian market for the last few years. Whether Kotex is available or not, and whether, owing to import

restrictions, it may be difficult to import this product for some considerable time to come, or otherwise, the appellants are entitled to argue that the

issue should be squarely met and resolved, irrespective of such considerations which are purely strategic. We shall, therefore, address ourselves to

the main issue here.

14. The relevant tests have been laid down, in many precedents of the English and Indian Courts, and we do not think that it is necessary to further

digress upon the case-law. The principle is not that a discriminating and careful buyer may not be misled by the deceptive phonetic or orthographic

similarity, if it exists. The test is that of a casual buyer, not necessarily ignorant or unintelligent, but of the ordinary class of buyers, who may not

have the time or the energy to further investigate, when he is offered goods of one brand, when making a demand for goods of the other brand.

We accept this test, and certainly it is no argument to plead that a customer using the Kotex product who is careful and who is likely to make

further investigation before a purchase, is very probably unlikely to accept Blotex products for Kotex products. It is further argued that, in this

case, both words are, at any rate, invented words of English letters, with English orthography." Since, the letters ""otex"" are common to both,

though the sounds may be different, and since, in. Amritdhara Pharmacy Vs. Satyadeo Gupta, , such apparently divergent phrases as Lakshman

Dhara and Amrithadhara have been held to be deceptively similar it is pressed that we should accept the appeal, and cancel the registration.

15. For a very important reason, we are unable to agree. We think, that the learned-Judge (Venkatadri, J.) was right in deciding the main issues in

favour of the respondent-firm. As we stressed earlier, an issue of this character cannot be viewed in the abstract, or merely with regard to what

happened in other cases, where other : similar names or trade marks were before the Court. The issue has to be decided applying the leading

principles to the specific facts of the instant case, viewed in their totality. One remarkable feature of the present case is that the section of the

public, which may be taken as likely to patronise this particular category of goods, is a limited section, with very distinctive characteristics. It is,

beyond doubt, a sophisticated section of feminine society, with a flair to considerable literacy qualification. This is no speculation on our part. It is

based on the actual record, and on the several affidavits that have been produced signed by ladies who are customers of Kotex products, on

behalf of the appellant-firm. There is no doubt whatever that this particular category of goods has not pervaded levels of the public, below the

particular social stratum evidenced by the affidavits. We can certainly take judicial notice of such an obvious fact. It is true that these ladies, who

belong to a sophisticated and educated section of the public and who would appear to be of the higher middle class, if not actually affluent, have

sworn that, sometimes, they sent their maid-servants for purchasing products of this description. But even so, we think that it is most unlikely that

the customers of this kind of goods, who must be necessarily ladies accustomed to relatively high standards of living, will coach up their maid-

servants to utter the phonetic word Kotex in the right manner, when demanding the product.

16. It is likely that these ladies will send slips with the written Word, in making a demand for this class of goods. It is most unlikely that if Blotex

napkins are supplied for Kotex, such ladies will accept them, thinking that the goods are identical. Certainly, the goods may be accepted as the

best possible substitute, or as a distinct trade product serving the same purpose. But that is not the test. It is whether the casual or relatively unwary

customer of the particular class of goods, is likely to be deceived or confused by the deceptive phonetic or orthographic similarity, into accepting

goods of one brand for the other, under the erroneous impression that they are identical. In our view, such a possibility can be totally ruled out in

this case, considering the class of persons who would be the customers in respect of these goods and what can be reasonably expected of them.

17. Two other matters may be immediately cleared up. It appears that there was some prior proceedings, when there was an attempt to register a

product, namely Beautex, in respect of the same class of goods, and the registry was refused. We are unable to draw any inference from this,

except that, on the facts of that enquiry, the concerned authorities thought that the registry ought not to be permitted in accordance with the

principles of the Trade Mark Law. The other point is the one that we have already referred to, that their Lordships of the Supreme Court refused

registry with regard to a pharmaceutical preparation, where the respective words were Lakshmandhara and Amrithdhara. But it has to be noted

that the customers in respect of indigenous medical preparations of that character, will be a very different class, with Very different attributes. They

may Well be villagers, with little or no education, and easily likely to be deceived or confused, even though the phonetic similarity related only to

the latter part of the phrases in question.

18. Under these circumstances, and applying the principles that we have earlier referred to, we conclude that the learned Judge (Venkatadri, J.)

was right in declining to interfere with the registration of the word Blotex on behalf of the firm of respondents, descriptive of this character of

goods. The Letters Patent Appeal is therefore dismissed With costs.