
(1954) 04 CAL CK 0002

In the Calcutta High Court

Case No : Appeal from Original Order No. 162 of 1951

Messrs. Hindusthan Development Corporation Ltd.

APPELLANT

Vs

The Deputy Registrar of Trade Marks and Another

RESPONDENT

Date of Decision : 12-04-1954

Acts Referred:

Citation : AIR 1955 Cal 519 : 59 CWN 320 : (1956) 2 ILR (Cal) 738

Hon'ble Judges : Chakravartti, C.J.;S.R. Das Gupta, J;Das, J

Bench : Full Bench

Advocate : B. Das and P.K. Sen, for the Appellant; S. Chaudhuri and Ginwalla, for the Respondent

Judgement

Chakravartti, C.J.—A cooking material constituted, or constituted mainly, of hydrogenated vegetable oil has recently come into use in this country and is commonly referred to by the generic but very inappropriate name of "Vanaspati". There are several brands of it in the market, manufactured by different concerns. The appellants, Messrs. Hindusthan Development Corporation Ltd., whom I shall hereafter refer to as the "company", have a product of their own which they brought out in 1948, and which they have called "Rasoi". Its base is said to be groundnut oil.

2. On the 4th August, 1947, before the product was placed on the market, the company made an application for registration of the word "Rasoi" in English and all Indian languages as their trade mark in respect of the "refined deodorized groundnut oil for cooking purposes" manufactured by them. That application was numbered 13041. There were certain amendments of the application hut its nature, as last amended, was as I have stated. There were two other applications, numbered 130400 and 13042, in regard to which the facts are not very clear, except that the former was withdrawn, but no further reference to them is necessary in the present case. With respect to Application No.13041, a requests was made for its amendment, so as to substitute for the bare word "Rasoi" a green and orange label, containing the word "Rasoi" and many other

words, some of which were encircled by a laurel device, and it was prayed that the registration might be restricted to the colours of the representation. Although the request was made in a general and not very clear manner by a letter dated the 12th August, 1948, a proper application in Form T.M. 16 was made only on the 21st June, 1949, in the course of the hearing.

3. After giving the company a hearing, as requested, the Deputy Registrar of Trade Marks rejected the prayer for amendment and refused registration of the mark "Rasoi". The decision was communicated to the company by a letter dated the 2nd December, 1949. Thereafter the company required the Registrar u/s 14(2) of the Trade Marks Act to state the grounds of his decision and the Deputy Registrar did so by an order dated the 13th February, 1950. On the 12th June, 1950, the company filed an appeal to this Court against the decision of the Deputy Registrar. That appeal is Appeal No.82 of 1950.

4. On the 16th June, 1950, four days after an appeal had been filed in this Court in the previous case, the company made a fresh application for registration of the word "Rasoi" "in all Indian languages and in English" as their trade mark in respect of the "hydrogenated groundnut oil" manufactured by them. It is not the company's case that the fresh application related to a different substance. By a letter dated the 6th October, 1950, the Administrative Officer of the Trade Marks Registry, writing on behalf of the Registrar, called upon the company to show cause why the application should not be refused on the ground that the proposed word had a direct reference to the character or quality of the goods concerned and was also not adapted to distinguish them as products of the company. In reply, the company, by a letter, dated the 21st October, 1950, repudiated the suggestion that the word "Rasoi" referred to the character or quality of the goods and was not adapted to distinguish them. They contended that the word had acquired a secondary meaning as denoting goods of their manufacture and had thus become adapted to distinguish them by long user and wide publicity. According to the company, the case came under Sections 6(1)(e), 6(2) and 6(3) of the Act and they claimed a hearing, as they were entitled to do u/s 70(c).

5. The company were given a hearing on the 19th and the 20th February, 1951, by the then Deputy Registrar of Trade Marks, who was a person different from the officer, who had heard the former application. He refused the application and communicated his decision to the company by a letter dated the 23rd May, 1951. Thereafter, the company required him to state the grounds of his decision which he did by an order, dated the 14th August, 1951. The present appeal, No.162 of 1951, is directed against that order.

6. Before the Deputy Registrar a question was raised as to whether the second application was maintainable in view of the pendency of the appeal arising out of the first. It was contended on behalf of the company that the first application, with the amendment prayed for, was not for registration of the word "Rasoi" alone, but of a label containing that and other words and that, in any event, the second application had been made two years later, in the course of which there

had been further user of the mark. The Deputy Registrar accepted that contention and proceeded to deal with the application on its merits.

7. On the merits, the Deputy Registrar held that the word "Rasoi" in its ordinary signification meant "cooking, cookery, kitchen, dressed, or cooked food" and therefore, as applied to a substance like the company's hydrogenated oil which was intended to be used as a cooking medium, it was a word having a direct reference to the character or quality of the goods. It did not therefore come u/s 6(1)(d) of the Act. Nor could it be held to have qualified for registration u/s 6(1)(e), because the evidence adduced of its user was not sufficient to establish that it had become distinctive of the company's goods. Besides, in the Deputy Registrar's view, the word was such that no amount of evidence could show that it had lost its primary meaning and become adapted to distinguish the company's goods from similar goods of other manufacturers.

8. Before us, each one of those findings was challenged by Mr. Das, who appeared on behalf of the company and their negatives were sought to be established.

9. It may be useful at this stage to say a word about the scope of the appeal which is a matter of some difficulty. The Trade Marks Act contemplates consideration of an application for the registration of a mark at one or two stages, as the case may be. To begin with, Section 14(1) of the Act provides that on an application being made, the Registrar may refuse the application or accept it. If he feels inclined to refuse, Section 70(c) requires him to give a hearing to the applicant before he passes his order. At such hearing, the applicant may adduce such evidence as he may desire to rely on and the Registrar may, upon considering such evidence, still refuse the application or he may accept it. If he accepts, whether initially or upon hearing the applicant, such acceptance does not mean that registration of the mark is directed. The Registrar must then, as Section 16(1) of the Act provides, cause the application to be advertised and thereafter persons desiring to oppose the registration may come forward within a prescribed time and urge such considerations or adduce such evidence as they may wish to rely on. The Registrar must then, after hearing the parties, if so required and considering the evidence, decide finally if registration is to be permitted. It will thus appear that when the Registrar refuses to accept the application, there are no further proceedings before him and the application is considered only once; but if he accepts it, there must be a further consideration at a second stage.

10. Two other provisions of the Act must now be referred to. It has already been pointed out that if, on an application being made, the Registrar does not feel inclined to accept it, he must give the applicant a hearing, but Section 15(2) of the Act provides that he may, even at that stage, cause the application to be advertised, particularly in a case coming u/s 6(1)(e), and may hear not only the applicant for registration but also his opponents, if any should come forward. When the application is so advertised before acceptance and the Registrar

accepts it after hearing the applicant and persons in opposition, if any, he may, if he thinks fit, advertise it again but is not bound to do so. There will thus again be one or two considerations of the application, according as the Registrar may direct it to be advertised once or twice, though there must be a consideration at two stages even when the application is advertised only once, when such advertisement takes place after its acceptance. The second provision which is relevant in this connection is Section 16(1) which provides inter alia that when after the acceptance of an application, it is not opposed within the prescribed time, the Registrar "shall" register the mark.

11. The difficulty about the scope of the present appeal arises in the following way. It is an appeal from an order refusing the application at the initial stage without advertisement and without hearing any opponents. The appeal is competent, because Section 76(1) of the Act provides for an appeal from any decision of the Registrar in the absence of any express provision to the contrary. If the appeal be dismissed, no difficulty will arise. But if the appeal be allowed, this Court will be holding that the Deputy Registrar was not right in refusing to accept the application and that it ought to be allowed to proceed. If the meaning of such decision be that the grounds given by the Deputy Registrar for refusing the application are wrong and that the proposed mark is fit to be registered, there will be no meaning in advertising the application and inviting opposition thereafter, as must be done u/s 15(1), nor any meaning in the Deputy Registrar proceeding to consider u/s 15(4) if registration ought to be permitted. The Deputy Registrar, being a party to this appeal, will be bound by the decision given in it by the Court and in view of that decision, none will be able to contend before him to purpose that the term is not fit for registration. Third parties, desiring to oppose registration of the mark, will thus have no real chance to have their objections considered. The same difficulty has been felt in England under the Trade Marks Act successively in force there, from which the Indian statute has virtually been copied. In the *California Syrup of Figs* case [(1910) 1 Ch. 130] which also was an appeal from an initial refusal of the application and was a case under the English Trade Marks Act of 1905, the Court of Appeal directed the application to be proceeded with, but Cozens Hardy, M.R., observed that it was not for the Court to say at that stage that the mark was distinctive and ought to be registered, which was a matter for the next stage when opponents could be heard and every possible objection raised. Moulton and Farwell, L. JJ., however, made observations on the merits of the mark but at the same time gave some indication that their opinion, even as to its distinctiveness, was only tentative, and it may, therefore, be assumed that what the Court intended to hold was only that a prima facie case that the application should be allowed to proceed had been made out. See in *re California Fig Syrup Company*, [(1910) 1 Ch. 130]. Even that view of the Court's decision given in an appeal at the preliminary stage does not remove the difficulty, because, taking the facts of the present case, if the application be directed to be accepted and its consideration to proceed but after advertisements have been issued no one comes forward to oppose the

application, the Registrar must, under the mandatory provision of Section 16(1), register the mark. A decision merely holding that the application is prima facie entitled to be accepted will thus bring about registration of the mark without the Trade Marks Registry getting any opportunity for contesting the registration further and without the Court having any further occasion to consider the eligibility of the mark with a view to a final decision. The position was the same in England under Sections 9 and 16 of the Trade Marks Act of 1905 and is the same now under Sections 9 and 18(1) of the 1938 Act. This difficulty came to be noticed in England in the subsequent case of *R. J. Lea, Limited*, [(1913) 1 Ch. 446], the "*Boardman's*" case and *Buckley, J.J.*, observed that in cases where the appeal was decided in favour of the applicant, some means would have to be found by which the decision of the question whether the mark was distinctive or not could be postponed till after the opponents had been brought in and heard. *Farwell, L.J.*, observed that in the earlier cases in which he had made an order allowing an appeal from an order refusing to accept an application, he did not appreciate that he was giving a final decision and certainly had not intended to give any. During the argument in the present case, I suggested, before *Boardman's* case was cited to us, that we might simply set aside the order of the Deputy Registrar and direct him to issue advertisements u/s 15(2) of the Act and that he might, after hearing such parties as might come forward to oppose the application, decide whether he would accept or refuse it. In that event, he would not be bound to advertise the application a second time after its acceptance if he accepted it and if he refused to accept the application and an appeal was preferred from that order, the Court would have the objections of the opponents before it and would be able to decide the eligibility of the mark finally without prejudice to anyone. It appears that a similar suggestion was made in *Boardman's* case, but as the Court dismissed the appeal, it became unnecessary to decide the question and it was left undecided.

12. I may add here that the English Act of 1905 under which the above decisions were given, provided by Section 9(5), corresponding to Section 6(1)(e) of the Indian Act, that a mark, not coming within the descriptions in the earlier clauses, could not be deemed to be a distinctive mark without an order of the Board of Trade or the Court. It might therefore be said, as indeed was said in one case, that an order of the Court, directing the application to proceed, merely removed the bar and prevented it being alleged that the registration was ultra vires. Section 6(1)(e) of the Indian Act contains no provision for permission of the Court or of any other authority and Section 9(5) of the English Act of 1908 also contains no such provision. The difficulty under these Acts is therefore greater.

13. If I felt on the merits of the present appeal that it ought not be decided against the company unless some strong grounds were made out by persons opposing the application, I would have to consider whether we ought not to direct advertisements to be issued in the first instance u/s 15(2) of the Act and the decision of the Registrar to be given thereafter or, even if we allowed the appeal on the merits, I would have to consider in what manner we might limit

the scope of our decision so as to indicate that it was not final. But as I have reached the conclusion that the appeal cannot succeed, I am not confronted with the difficulty, I have mentioned and not required to attempt its solution.

14. Before dealing with the questions debated in the appeal, it is necessary to refer to certain sections of the Act in order that the proper approach to those questions may be clearly understood. "Trade mark" has been given a rather long and involved definition in Section 2(1)(1), but for the present purposes it may be taken to be "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". "Mark" is defined in Section 2(1)(f) as including various things, one of which is "a word". Section 6(1) of the Act lays down what a trade mark must contain in order to qualify for registration and it provides that "a trade mark shall not be registered unless it contains or consists of at least one" of a number of particulars, of which various types are specified under clauses (a) to (e) of the sub-section. The provision in Section 6(1), requiring the presence of at least one of those particulars and those in sub-sections (2) and (3) explaining what "distinctiveness" means and how it is to be determined, are compendiously described in the marginal note to the Section as "distinctiveness requisite for registration", but apart from that mention of distinctiveness in the marginal note, to refer to which may not be legitimate, it is not specifically stated in any one of clauses (a) to (d) of sub-section (1) that the particulars specified therein are to be distinctive. That omission, however, is immaterial, because clause (e) begins with the phrase "any other distinctive mark" and the clear effect of that expression is to attach the adjective "distinctive" to each one of the preceding clauses. In order to satisfy the section, the particular present in a trade mark must, therefore, be distinctive, to whichever of the five varieties it may be one. But what is important to notice in the section is that its effect is only negative, since all that it provides is that registration cannot be claimed for any and every mark and that in order to be eligible for registration, a mark must contain at least one of the particulars specified. To say that is not to provide that the presence of at least one of the specified particulars will be sufficient. While the absence of particulars of the specified kinds will disqualify for registration, it does not follow that the presence of at least one of them will ipso facto qualify. There are other objections to registrability expressly specified in the Act, such as those contained in Sections 8, 9 and 10 and, above all, there is a discretion vested in the Registrar by Section 14(1) under which he may properly take into consideration various other matters which may be pertinent. Section 14(1) which lays down the jurisdiction of the Registrar contains no positive command but only provides that when a person applies for the registration of a mark, the Registrar may refuse the application or may accept it, although his powers are subject to the provisions of the Act.

15. The questions raised in the present appeal fail to be decided mainly by Sections 6(1)(d) and 6(1)(e) of the Act and, to a certain extent, by certain

principles of a general character Section 6(1)(d), so far as is material, provides that "a trade mark shall not be registered unless it contains or consists of

(d) one or more words having no direct reference to the character or quality of the goods"

16. If a proposed mark consists of a single word and that word does not refer directly to the character or quality of the goods concerned, it is a mark within Section 6(1)(d), subject to its being in itself distinctive. But, as has been already explained, even if the mark satisfies Section 6(1)(d), it does not follow that it must be registered. If, however, the word does refer directly to the character or quality of the goods, it is outside Section 6(1)(d), but it may still come u/s 6(1) (e). That Section provides that "a mark shall not be registered unless it contains or consists of -

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(e) any other distinctive mark, provided that a name, signature or any word, other than, such as fall within the descriptions in the above clauses, shall not be registrable except upon evidence of its distinctiveness."

17. We are concerned here only with a word-mark. The effect of Section 6(1)(e), read with the material part of Section 6(1)(d), is that if a word falls outside clause (d), i.e., if it is a word which refers directly to the character or quality of the goods, it may still be eligible for registration so far as Section 6 is concerned in case its distinctiveness can be established by evidence. It would appear that while a mark, whatever its character, must always be distinctive, distinctiveness in the case of categories specified in clauses (a) to (d) of Section 6(1) is contemplated as inherent and provable by considerations drawn from the mark itself, but in the case of a mark coming under clause (e), evidence is admissible and indeed required. For the purposes of the Section, "distinctive" is explained by sub-section (2) as meaning "adapted, in relation to the goods in respect of which a trade mark is proposed to be registered, to distinguish the goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists." In other words, the terms means that the mark - and when the mark is a word, the word - must be such as is capable by itself of individualizing and marking off the goods of the claimant of the trade mark from similar goods of all other manufacturers. As to how distinctiveness is to be determined, sub-section (3) of the section furnishes some guidance. It recognizes that distinctiveness may be innate or acquired and accordingly it provides that "in determining whether a trade mark is adapted to distinguish the Tribunal may have regard to the extent to which -

(a) the trade mark is inherently so adapted to distinguish, and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact so adapted to distinguish."

18. It will be noticed that the sub-section merely prescribes a rule of evidence

and lays down that in determining whether a trade mark is distinctive, it will be legitimate to take into account the two considerations it mentions. It should be noticed further that while sub-section 1(e) speaks of a "mark" which is distinctive, sub-section (3) speaks of a "trade mark" and refers in clause (b) to its use. The distinction is that though, generally, characteristics to be found in the mark itself are only to be regarded, still in a case where the mark has been in actual use as a trade mark, the result of the user of the mark, as distinguished from its innate qualities, will also be a relevant consideration. In such a case, in addition to the test of inherent adaptability to a distinguish, the test of experience is also permitted. But sub-section (3) is only permissive and does not require the Tribunal imperatively to pay regard to the result of the trade use of the mark. Nor does the sub-section, or indeed Section 6 taken as a whole, lay down anywhere that if a mark is distinctive within the meaning of Section 6 and registrable so far as that section is concerned, it must in all cases be registered. There is a difficult question, much discussed in the cases, as to whether a mark must necessarily be taken as adapted to distinguish the goods concerned when, from the evidence of user, it is found to distinguish them in fact. To that question I shall refer more fully later.

19. In the present case the Deputy Registrar has held that the word "Rasoi" has a direct reference to the character or quality of the goods and, in the second place, that neither is the word inherently adapted to distinguish the goods, nor has it been established by evidence that by user it has become so adapted. Those findings are challenged. From what I have said above regarding the scope and intent of the Act, it must be clear that the question decided by the first finding is of a comparatively smaller importance because even if the word "Rasoi" has no direct reference to the character or quality of hydrogenated oil used for cooking purposes, it will still not be registrable if, in relation to such oil, it is not or has not become distinctive of the company's goods, that is to say, adapted to distinguish them from the goods of other manufacturers. If the answer to the second question also be in the affirmative, the matter is not yet at an end. There is no question here of the word offending against the provisions of Section 8 or 9 or 10 of the Act but it may still be not registrable if it offends against any general principles laid down by the Courts from time to time, one of which is that no particular trader can be allowed to extract a word of common significance from the general public vocabulary and make its use a part of his proprietary rights. Those principles are not specifically laid down in the Act, but they can be applied by the Registrar in the course of the exercise of his discretion u/s 14(1) and unless he applies them in a way which is clearly wrong, the Courts will not interfere with his decision.

20. Taking the first question first, the substance in respect of which the trade mark is proposed to be registered in the present case is hydrogenated, groundnut oil. It is not disputed that the substance is intended to be used as a cooking medium and the advertisements exhibited by the company show that it is advertised as such. The actual use evidenced by the affidavits of the

customers is also use as a cooking medium. The mark proposed to be registered in respect of this cooking oil is the "Rasoi". The Deputy Registrar has referred to a number of dictionaries and collected the various meanings of the word, as given in them, all of which have some reference to the operation of cooking by way of denoting either the operation itself or the place where it is performed or the result which it produces. The dictionaries referred to are not of very high authority and some of the meanings given do not appear to me to be accurate, but, in any event, I do not think that a search among dictionaries can be very helpful when the question is whether a particular word has any direct reference to the character or quality of a particular kind of goods within the meaning of the Trade Marks Act. Such a question is a practical question, to be decided by the common understanding of the term among those who use it or have occasion to hear it in the course of their daily lives and not by what may be recondite meanings to be found in dictionaries. A trade mark is a mark affixed to goods offered to the public for sale and it is intended to mark off the goods to which it is affixed as the goods of a particular trader and to distinguish them from the goods of others. It is obvious that when the mark is a word, the meaning which is relevant is the common acceptance of the term among the public to whom the goods are offered and to whom therefore the word is addressed. Whether the word "Rasoi" be of Sanskrit or Persian or Arabic origin and whatever secondary shades of meaning it may have acquired by processes which often make a word come to denote two allied things, such as the doing and the deed or the container and the thing contained, there can be no doubt or dispute that the common meaning of the word and the sense in which it is most widely used is cooking or cookery. If it is used in relation to cooking oil. I do not see how it can be said that it has no direct reference to the character or quality of the goods to which it is applied. I am not forgetting that the Act requires the reference to be direct, but it must not be overlooked that, at the same time, it does not require the word to describe the goods. Reference to the character or quality is sufficient, though it must be a direct reference. In many of the English cases decided under the Act of 1905 which were cited to us from the Bar, there appears to have been consideration debate as to whether the words under examination were descriptive, but the debate was in connection with the question as to whether they were distinctive or not. It is true that the words of the corresponding Section in the English Act, Section 9(4), were also "having direct reference to the character or quality of the goods" and when it was said in certain cases that Section 9(5), corresponding to the Indian Section 6(1)(e), made even descriptive words registrable if they were proved to be distinctive, it appears to have been suggested that the words contemplated by Section 9(4) were descriptive words. But Section 9(4) did not use the expression "descriptive", nor said anything about the words describing the goods, as Section 6(1)(d) of the Indian Act does not. Direct reference to character or quality is all that the section says and contemplates. It is true that if a word merely suggests the character or quality of the goods, it cannot be said to be within the mischief of Section 6(1)(d), as the use of the word "direct" in the Section emphasizes.

That word was introduced in the English Act of 1950 in order to counteract the effect of the decisions which had refused registration to words having a merely indirect reference to the character or quality and to give effect to the principle of the decision in the *Solio* case where it was held by the House of Lords that simply because the word "solio" suggested the sun, it could not be said to have some reference to the character or quality of photographic paper - see *Eastman Photographic Materials Co's Application* [(1898) AC 571]. But the connection between the word "Rasoi" and cooking oil is far different. The directness of that connection is likely to be obscured if we consider the Indian word in relation to the English term for the substance to which it is proposed to be applied, but if we take the English term in the case of both and consider "cooking" or "cookery" against "cooking oil", the connection becomes obvious. I think if anybody tried in English to obtain registration of the word "cooking" or "culinary" as a trade mark for cooking fat, he would not have a moment's chance. How far Courts have gone in that country is illustrated by the "*Charm*" case where it was held by the Court of Appeal that the word "charm" when applied to ladies' stockings, had plainly a direct reference to the character or quality of the goods. See *Keystone Knitting Mills Ltd.'s Application* (45 RPC 421).

21. When Section 6(1)(d) speaks of the "character" of the goods, I think it means their nature and when it speaks of "quality", I think it means their properties or the merits. It is however, difficult to take the two words as mutually exclusive and I do not think they are intended to be so. On behalf of the company, Mr. Das contended that the words contemplated by the section were words which described "something material to the composition of the article" to which they were intended to be applied and he referred us to certain observations of Vaughmn-Williams, L.J., in the *Tabloid* case - in the matter of *Burroughs Well-come & Co.'s Trade Marks* [(1940) 21 RPC 217]. But that was a decision u/s 64(1)(c) of the Patents, Designs and Trade Marks Act, 1883, which did not contain the words we are trying to construe and read as "as distinctive device, mark, brand, heading, label, ticket or fancy word or words not in common use". In the passage on which Mr. Das relied, the learned Lord Justice was only considering as he said expressly, what words were "really descriptive", as distinguished from "distinctive". I do not think it can be correct to read the words "character or quality" as limited to the constituent elements of an Article or the manner of its composition. No Court in England has ever put that limited construction on them, though they have been on the statute book since the amending Act of 1888 and have been repeated with the adjective "direct" to the word "reference" in the subsequent Acts of 1905 and 1938. In my view, "character or quality" means the nature of the article, i.e., the kind of thing it is and the class to which it belongs and its properties and merits, including the use to which it is adapted. As to the last, the *Herschell Committee*, reporting on the English Act of 1883, observed as follows:

"If the words sought to be registered would be understood as suggesting a special use of the goods or their adaptability to a particular purpose, it would be

objectionable as descriptive of their character."

22. The passage, it is true, does not occur in a judicial decision and was not an elucidation of the words "character or quality" occurring in the statute then in force, for they came later. But is still of great value because of the high authority of Lord Herschell who made the leading speech in the "Solio" case and because it was on the recommendation of the Herschell Committee that the words "having no reference to the character or quality of the goods" were introduced into the then current English statute by Section 10 of the Amendment Act of 1888 and words having such reference were excluded from the category of eligible words. The passage contains nothing which cannot be accepted as correct except under the binding force of authority. In my view, the use to which a particular article is adapted and for which it is intended is a part of its character and the passage I have quoted from the Herschell Committee's Report gives a correct interpretation of one aspect of "character or quality".

23. Judged by the above test, the word "Rasoi", as applied to hydrogenated groundnut oil intended to be used as a cooking medium and in fact used as such, is plainly outside the terms of Section 6(1)(d). To the common man and indeed to everyone, who thinks and speaks in the major vernaculars of the country, the word means cooking. If it is used as a mark for cooking oil, the trader puts on the article a wordmark which, in its ordinary significance, refers directly to the character of the article as an article usable for cooking purposes or, to put it in another way, the character of a cooking medium which it bears. In my view, the reference is not less direct than it would be in the case, for example, of the word "writing", if it were to be used as a mark for pen or pencil or ink.

24. On this point, Mr. Das pressed on us the authority of three cases, the "Sheen" case, the "Motorine" case and the "Radiation" case. On behalf of the Deputy Registrar, Mr. Chaudhuri cited the "Dex" case. The "Diamine" case was also cited. As it has often been pointed out, citation of cases on questions of the present character is rarely of any help, because the fact that a particular word was held to have a direct reference to the character or quality of a particular kind of goods or to have no such reference, cannot establish that another word has or has not reference to another class of goods. But I may deal with the cases briefly. The "Radiation" case - In the matter of the Trade Mark "Radiation" (47 RPC 37) - is not a very impressive or relevant authority, because it is only a decision of a Controller-General and turned mainly on the findings that the word "Radiation" had become distinctive of the applicant's gas-stoves by user and in other ways. It is true that the judgment noticed the objection that the word described the physical process by which a gas-stove operated as a heating appliance, but it disposed of the argument by saying that the word was not likely to be required in that sense by other traders for the purpose of describing their stoves and that, as applied to stoves, it was not so directly descriptive as to be incapable for ever becoming distinctive. If the case decided anything on the present question at all, it rather decided that the word was directly descriptive,

but then its descriptiveness was not such that it could not become a distinctive mark by long association and use. Even so, Kerly's comment on the decision is that it is "very much a border line case and not one which is likely to be repeated" (see Kerly on Trade Mark, 7th Edition, p. 184). In the "Sheen" case - In the matter of an Application by J. & P. Coat Ltd. (53 RPC 355 CA), the word "sheen" was proposed as a mark for machine twist or mercerized sewing thread and again the decision that the application should be allowed to proceed, turned not on the finding that the word had no reference to the quality of the goods but on the finding that though the word denoted glossiness, the trade word for glossiness was "lustre" and that "sheen" was an obsolete word or an aesthetic word favoured only by poets and that it was not a word which had any ordinary meaning in primary use or was incapable of losing the primary meaning. The Court did not decide that the word had no reference to the quality of the goods, but that it had such reference, although the word being a poetic not in ordinary use, the reference was remote and was not sufficient to prevent the word becoming distinctive. It can by no means be said that "Rasoi" is an obsolete or aesthetic word not in common use for the designation of cooking. In the "Motorine" case - In re Compagnie Industrielle Des Petroles" Application, [(1907) 2 ch 485], the word had been registered with a disclaimer of the word "motor" as a trade mark for lubricating oil which was suitable for motors but not confined to them. Five years later, there was an application by another company that the mark should be expunged from the Register as its was a word, having direct reference to the character or quality of the goods and as such outside Section 9(4) of the English Act of 1905. The Court held that there was no such direct reference as the Section contemplated. The decision does not seem to me to assist the appellant company in the present case, because the word "Motorine" was of the nature of an invented word and although it might suggest motors, there was no reason to suppose that it suggested lubricating oil which was not a substance for special use on motors alone. Besides, lubrication is not one of the functions of motors. The reference contained in the word "Rasoi" meaning cooking, to vegetable oil used for cooking purposes is of a far different character from the reference, if any, contained in the word "Motorine" to lubricating oil. There is thus nothing in the cases cited by Mr. Das which requires me to hold that the word "Rasoi", when applied to the company's oil, cannot be said to have a direct reference to the character or quality of the goods.

25. The two decisions in the opposite sense are also not of much help, although one of them illustrates how little reference to the character of the goods has been considered sufficient to place it outside Section 9(1)(d) of the English Act of 1938, corresponding to Section 9(4) of the Act of 1905 and Section 6(1)(d) of the Indian Act. In the "Diamine" case - In re Leopold Cassella & Co. [(1940) 2 Ch. 240] registration was sought to be obtained of the word "Diamine" which the applicants had been using as a trade mark for their dyes for twenty years. The dyes contained one, two or more amine groups or no amine group at all. The application was refused on the ground that the proposed word had a common

and well-understood meaning in the language of chemists and when applied to the chemical constitution of a body, meant that such body contained two amine groups and, therefore, if used for dyes which contained two amine groups, it would be descriptive of their character or quality and if used for dyes which contained less or more or no amine groups at all it would be deceptive and that, in any event, no one should be allowed to appropriate a common word which should be open to all. In so far as the case involved the question of direct reference to the character or quality of the goods, a point dealt with particularly by Buckley and Kennedy, L. JJ., it was obviously a stronger case than the case before us. In the "Dex" case In the matter of an Application by the National Machinery Co. (58 RPC 128), the word "Dex" was sought to be registered as a trade mark for bolts and screws, including deck bolts. The application was refused by the Assistant Controller on the ground that the word "Dex" was indistinguishable to the ear from "Decks" and therefore if used as a mark for deck bolts, it would have a direct reference to the character and quality of the goods and if used for other bolts, it would be deceptive and that the same objection applied to its use for screws, the dividing line between bolts and screws being thin. Both the High Court and the Court of Appeal upheld the decision of the Assistant Controller mainly on the ground that he had exercised his discretion properly and there was no reason to interfere with it. Thus, though bolts are very small constituents of a deck, the word "Dex", hearing like "Decks", was considered to have a direct reference to the character or quality of bolts intended for use in the making of decks. In a sense, the case is nearer the present case than the "Motorine" case, particularly relied on by Mr. Das, because here also, the proposed mark is a word-mark, appealing to the ear and the word does not merely refer to the character or quality of the goods by reason of its meaning, but is the very word commonly used to describe the use for which the goods are meant and to which they are adapted.

26. I would, therefore, hold on the facts, on the true construction of Section 6(1) (d) and so far as authority is available, on authority, that the word "Rasoi", if used as a mark for the company's hydrogenated oil, would have a direct reference to the character or quality of the goods. It may be pertinent to recall that in their letter to the Register, dated the 21st October, 1950, showing cause why the mark ought to be accepted, the company themselves did not claim that it fell within Section 6(1)(d), but stated specifically their case to be that it came u/s 6(1)(e), 6(2) and 6(3)(b).

27. It does not, however, follow at once from my finding that the word must be rejected as not registrable. By reason of the provisions of Section 6(1)(e) , the word may still be eligible for registration if can be proved to be distinctive of the Company's goods, being either inherently adapted to distinguish them or having become so adapted by user or by the operation of both factors. The next enquiry, therefore, is whether the word, though it does not come within Section 6(1)(d), is still distinctive.

28. I may point out here that even if I be wrong in my first finding and the word does come within Section 6(1)(d), the next enquiry is still the same. I have already shown earlier that the effect of the opening words of Section 6(1)(e) is to attach the requirement of distinctiveness to each one of the preceding clauses and therefore, no word, coming u/s 6(1)(d), can be eligible for registration unless it is also distinctive. That meaning of Section 6(1)(e) appears to be clear from the very words of the Section, but there is also high authority in its support. In *Fanfold Ltd.'s Application* (45 RPG 199) which was a case u/s 9(1) of the English Act of 1905, corresponding to Section 6(1)(a) of the Indian Act, it was argued that if a name, proposed as a mark, was "represented in a special or particular manner" as the clause required, it was not further necessary that it should be shown to be distinctive, because the word "distinctive" did not occur in the clause. The argument was not accepted. It was held both by the High Court and the Court of Appeal that the significance of the expression "any other distinctive mark" with which clause (5) opened, was that in each of the cases mentioned in the various clauses of the Section, the mark proposed to be registered must not only under at least one of the clauses but must also be distinctive. "Section 9", observed Hanworth, M. R. "must be read, bearing in mind the reference which applies to the whole of the section and incorporates the definition of "distinctiveness" and also the conjunctive effect of "any other distinctive mark" which is to be found in paragraph (5)". See *Fanfold Ltd.'s Application* (45 RPC 199; CA 325). The matter was put even more directly by Crossman, J., in a comparatively recent case. "But I think it is also settled by authority", observed the learned Judge, "that every trade mark must be distinctive in the sense of adapted to distinguish the goods of the proprietor from those of other persons. Even if the trade mark in the present case can be said to be an invented word or a word having no direct reference to the character or quality of goods and not being according to its ordinary signification a geographical name of a surname, it ought not to have been registered if it was not in fact adapted to distinguish the goods of Messrs. Boots & Co." - In the matter of *Boots Pure Drug Co. Ltd.'s Trade Mark "Livron"* (54 RPC 161 at p. 179). If such were not the true meaning of the Section, it would lead to the strange result under clause 1(d) that any word in the multitudinous vocabulary of a language would be eligible for registration as a trade mark, if only it did not directly refer to the character or quality of the good in question. I find it wholly impossible to attribute to the Legislature an intention to lay down that provide it did not refer to the character or quality of the goods in respect of which it was used, any word, whether a noun or an adjective or a verb or an adverb, should be taken as distinctive of the goods. How a word like, say, "luck" or "get" or "absent" or to take Buckley, L.J.'s example in the "*Diamina*" case, "probably", can be distinctive in itself of any goods of any trader, I am entirely unable to see and can find no reason to think that the Legislature enacted any such absurdity. It is said that the effect of the words "any other distinctive mark" in clause 1(e) is to suggest that the clause assumes the marks mentioned in the preceding clauses to be distinctive. In my opinion so to construe the clause is to overlook

the fact that the very concept of a mark involves and implies that it is something which distinguishes the goods on which it is used and that the object of the Section being to specify particulars which would make a mark a mark, it could not have said that any word should be accepted as a distinctive mark, even without distinctiveness being proved, if only it did not refer directly to the character or quality of the goods. To my mind, there can be no doubt that the true construction of the section is that adopted in the English cases.

29. On the question of distinctiveness and indeed on the whole meaning of Section 9 of the English Act of 1905, corresponding to the same section in the Act of 1938 and Section 6 of the Indian Act the first case was the "Perfection" case - *In re Joseph Crossfield & Sons Ltd.*, [(1910) 1 Ch 118; CA 130] and what was said in that case has remained the last word save in one particular to which I shall refer later. The Act says that in determining whether a mark is distinctive, regard may be had to the extent to which it is inherently adapted to distinguish the goods of the applicant from those of others and the extent to which it is, at the time, in fact so adapted by reason of user or any other circumstances. The case was concerned with a word-mark and it was said that as to the first test, arguments had to be drawn from the word itself. As to the second, it had to be proved by evidence that although the word concerned might to be unsuitable in itself to be used as a trade mark and might have no innate quality of distinctiveness, it had acquired yet the quality in respect of the applicant's goods by being identified with them through long user. But certain words, for example words of laudation could not possibly become adapted to distinguish the goods of any particular trader, however long and whatever the extent of its user by him. In the case of other words, the fact that a word was descriptive of the character or quality of the goods would not necessarily preclude it from becoming distinctive - for descriptiveness and distinctiveness were not incompatible - and it was a question of fact in each case whether the word had acquired a secondary meaning and whether its primary meaning had been extinguished or so far submerged as to have ceased to be of any consequence. But the distinctiveness required was far higher than would be sufficient to support a passing off action. There were certain general principles too. A common word of the language, for example, which it would be natural for other traders to require to describe similar goods manufactured by them, could not be allowed to be attached by a single trader and appropriated to his exclusive use to the embarrassment of his fellow tradesmen. The other cases to be found in the reports are merely commentaries on the law as laid down in the "Perfection" case.

The first, question, therefore, is whether the word "Rasoi" is inherently adapted to distinguish the hydrogenated oil manufactured by the company from similar oil manufactured by other traders. I find it wholly impossible to hold that there is anything in the word itself which is capable of denoting and marking off the company's goods from those of other manufacturers. Indeed, inherently, it is not capable of distinguishing anybody's hydrogenated oil at all. Apart from association through user, if the word was affixed to a tin of oil manufactured by

the company and it was also affixed to a similar tin of another manufacturer, there would be no means of knowing from the other.

30. The second question, viz., whether the word has become adapted to distinguish the company's goods by reason of user or of other circumstances, might present a question of some difficulty, but on the facts of the present case, the difficulty does not arise. No circumstances other than user have been pleaded. As to distinctiveness through user, a point has been raised in the cases as to whether, if it is proved by sufficient evidence that the mark has in fact become adapted to distinguish, it is necessarily proved that it is a mark adapted to distinguish, because it is found to distinguish the goods in fact. Or, whether, in addition to proving that the mark has in fact become distinctive, it must also be proved that it is adapted to distinguish. "I agree", observed Farwell, L.J., in the *California Fig Syrup Company's* case [(1910) 1 Ch 130, at p. 154], "that the legislature has not said that if it has in fact become distinctive, then it is in all cases to be regarded as adapted to distinguish". Similarly, Hamilton, L.J., as Lord Sumner then was, observed in *Boardman's* case - *In re an Application of R. T. Lea Limited* [(1913) AC 446, at p. 463] - as follows:

"Further, the Act says "adapted to distinguish"; the mere proof or admission that a mark does in fact distinguish does not ipso facto compel the Judge to deem that a mark is distinctive. It must be further "adapted to distinguish", which brings within the purview of his decision the wider field of the interest of strangers and of the public."

31. There was a similar expression of opinion in the "*Liverpool*" case - *In re Liverpool Electric Cable Co. Ltd.'s Application*, [(1928) 46 RPC 99], particularly by Russell, L.J., as he then was, and finally and most authoritatively by the House of Lords in the *Glastonburys's* case - *A Baily and Company Ltd. v. Clerk Son and Morland*, [(1938) AC 557]. In the last-mentioned case, the House of Lords did not accept the finding of the Court of Appeal that the claimants for the registration of the word "*Glastonburys*" had proved that the word had become distinctive of their sheepskin slippers, but their Lordships were prepared to proceed on the footing that the finding was correct and held that even on that footing, it was necessary to find whether the word was "adapted to distinguish" the applicant's goods which, they held, it was not. On the other hand, in the "*Sheen*" case - *In the matter of an Application by J. & P. Coats Ltd.* (53 RPC 355 : CA 372), which was decided between the "*Liverpool*" case and the "*Glastonburys*" case, it was held by the Court of Appeal, particularly by Lord Wright, M. R. and *romer*, L.J. (who was the trial Judge in the "*Liverpool*" case) that if distinctiveness was proved by the evidence of user, there was no other question to consider than whether registration of the mark would embarrass other honest traders or cause confusion. As to what Lord Parker had said on the point in the earlier House of Lords case of *Registrar of Trade Marks v. W. & G. Du Cross Ltd.* [(1913) AC 624], different views were expressed in the "*Sheen*" and the "*Glastonburys*" case.

32. The question is one of some difficulty. A word may be inherently adapted to distinguish or it may not be so. If it be not so adapted, the applicant for its registration may try to prove by evidence that by reason of long user, the word has become distinctive of his goods and distinguishes them in fact. If he succeeds in proving such distinctiveness in fact and such factual distinctiveness establishes that the word is "adapted to distinguish" his goods, no other question arises. But if it must still be proved that the word, by itself, is adapted to distinguish, it may well be asked what purpose is served by the evidence of user or how it can logically and sensibly be said that the word is not adapted to distinguish the goods in question, seeing that it does distinguish them in fact. Where the evidence of distinctiveness in fact is not sufficient and conclusive or in other words, the extent to which the word has become adapted to distinguish is not the whole extent, it may be necessary and legitimate to consider the inherent adaptability of the word. But where the factual distinctiveness, as established by the evidence, is complete, what justification can there be for yet enquiring if the word is adapted to distinguish? Is it there that the question of the exercise of discretion comes in or is it that in determining the question of adaptability to distinguish, an area wider than that of the appellant's user must be taken into account? There is an illuminating discussion of the question and an acute analysis of case-law by the present Master of the Rolls, Evershed, M.R., in a case reported in the current volume of the Reports of Patent cases - Yorkshire Copper Works Ltd. Application (70 RPC 1), which was not cited from the Bar, but the point was not decided in the case.

33. This is the question on which subsequent cases have gone a little beyond the "Perfection" case. It seems to me that the answer is perhaps to be found in the passage. I have quoted from the judgment of Hamilton, L.J., in Boardman's case, which Lord Maugham described in the Glastonbury's case as a valuable judgment. The learned Lord Justice said, that even after it had been established that the proposed mark did in fact distinguish, the Court had to find if it was "adapted to distinguish" and that that brought "within the purview of his decision the wider field of the interest of strangers and of the public". I think the position is that what the applicant for registration establishes by proving that the mark does distinguish his goods in fact is only that it has become adapted to distinguish the goods among the present generation of customers and over a sufficiently wide area. But a trade mark, once registered, becomes valid after seven years for practically all time and it is therefore necessary to consider, before granting the monopoly, the interests of future traders and customers, against or amongst whom there will have been to start with no use of the mark and whom it cannot be proper to bind unless the mark is in itself adapted to distinguish the goods of the applicant. That question is the primary question and in deciding it, the Court can only permit itself to be influenced by evidence of the extent to which the mark has in fact become adapted to distinguish by reason of such use as has taken place. It is for that reason that Section 6(3) has been expressed in a discretionary form. The adaptability to distinguish which the Court

has to consider over and above the distinctiveness in fact is whether the mark, besides that it now distinguishes the applicant's goods can ever move, so far away from its primary meaning that instead of denoting what it originally did, it will simply be a mark or a term for the applicant's goods even to persons coming hereafter who will know it, even when they come to know it first, only as an appellation for the goods of the applicant. To what extent the Court will insist on that extreme form of adaptability and to what extent it will allow itself to be influenced by the present adaptability in fact and by other considerations, is a matter for the Court's discretion u/s 6(3).

34. The question, difficult as it is, arises only if the applicant has been able to establish by evidence that the proposed mark has become adapted to distinguish his goods in fact. In my view, the company has not at all discharged that onus. Section 6(3)(h) of the Act, read with the opening words speaks of the "extent" to which the mark is shown by user to be adapted to distinguish. Clearly, the area in which the goods have been sold and the mark has been in use must be sufficiently wide, though use in all parts and every corner of the area over which the mark will be valid is not required. In the "Perfection" case (ante), evidence that user of the mark had made it in fact distinctive "to many persons in certain large areas of the United Kingdom, but not to many other persons in those areas and scarcely to anyone outside those areas" was not considered sufficient to make the mark "distinctive" or "adapted to distinguish" for the purposes of a registration which would give the applicant a monopoly of the mark in the whole of the United Kingdom. Similarly, in Boardman's case (ante), user confined to the north of England, subject to the addition of Bristol and Cambridge and, to some extent, London, was not considered sufficient to establish such distinctiveness in fact, as was required by the law. Secondly, the evidence of user must come from customers of the goods, actual or probable, for it is to them that the mark has to be distinctive. It was pointed out in the Glastonbury's case (ante) that evidence of the applicant's trade customers, who purchased his goods from him could be of little value because, as for themselves, they knew that he was the manufacturer and as to the consumers, they could give no evidence as to what the consumers thought and any such evidence given would be only opinion evidence. Even the evidence of members of the public must be clear on the point that the mark itself has a meaning for them and that the meaning is not that the goods are of a reputed brand or of high quality but that they are of the applicant's manufacture. The evidence in Boardman's case (ante), was that among persons, who knew and liked the particular smoking mixture, it was known and spoken of as "Boardman's" and that those who knew it, asked for it by that name. Such evidence, it was held, was not evidence of distinctiveness of the mark, because it did not show that to a person, not previously acquainted with the goods, the mark would be adapted to distinguish them from the goods of other manufacturers. Lastly, in order that a mark may be proved to have acquired distinctiveness by user, it must be known that there has been user of the mark by itself. In Boardman's case (ante), the evidence was

that the word proposed for registration had only been used in combination with other words and on a specially devised label. It was held that such user was of no assistance, since the section required the proposed mark itself to have been in actual use as such and the reason was that if used only with other words or on a label in colours, it could not obviously acquire distinctiveness for itself.

35. The application of the company is for registration of the word "Rasoi" in ordinary capital letters of the English alphabet with a further prayer that the same word may be registered in all Indian languages as well. It was filed on the 16th June, 1950, and the company's own case is that the mark has been in use only since July, 1948, i.e., for less than two years before the filing of the application. The evidence adduced in support of the case that the mark has in fact become adapted to distinguish the company's goods consists of 14 affidavits, 17 specimen advertisements inserted in various daily papers and periodicals, a bundle of newspapers and magazines and copies of two other magazines, all carrying advertisements of the oil. The daily papers and periodicals in which specimen advertisements appeared are all Calcutta papers except three, one of which is a paper published at Patna, one published in Assam and one in Orissa. These last are all papers published in the English language. Among the Calcutta papers are included several issues of the same paper and the language of those papers is in one case Hindi, in three cases Bengali and in four cases English. The affidavits are by the Works Manager of the company, their own auditor, a broker, a selling agent for Calcutta, the Distributing Agent for Bihar, two trade customers buying directly from the company, the manager of a hotel, the manager of a canteen and the proprietor of another hotel, all situated in Calcutta and only four ordinary customers, of whom three are residents of a particular quarter of northern Calcutta and one of Ballygunj.

36. It seems to me hardly arguable that this evidence is sufficient to establish that the word "Rasoi" has become distinctive of the company's goods. The registration, if allowed, will make the mark valid for the whole of India. The area covered by even the advertisements constitutes only a small fraction of the country and the area over which sales have really been proved is practically limited to certain localities of Calcutta. It is true that the Works Manager speaks of agents in Bihar, Orissa and Assam, but there is no evidence of the extent of the actual sales in those States, nor of the area in which the goods are known and sold. It is quite obvious that in the major part of the country, e.g., in the Bombay, Madras, Punjab and the Uttar Pradesh States, to name only a few, there have been no sales or advertisements and the word "Rasoi" would convey no meaning in relation to the company's goods. As to the affidavits, the evidence of the company's own broker or selling agent or distributing agent is of no value at all for showing that the mark has become distinctive of the company's goods, because they do not know or identify the goods by the mark but are otherwise aware that goods bearing the particular mark are products of the company. Trade customers buying directly from the company are in the same position. Besides, they can only speak for themselves and not for the persons purchasing from

them and have not even attempted to say what the mark has come to mean to the buying public, which would be useless even if they had tried to do so, because it would be hearsay or opinion evidence. Each of the hotel and canteen witnesses counts only for a single individual, because those, who take their meals at their establishments have no occasion to buy or ask for the oil with which the food is cooked and the mark does not come to their knowledge at all. One of the hotel managers, again, says that he knows the oil to be a preparation of the company and buys it as he finds it satisfactory, so that the mark is not the source of his knowledge. The other hotel manager says that he finds the name of the company appearing on the label which displays the word "Rasoi" and he associates the word with the company's product. One of the ordinary customers says that he knows the article and asks his officer to go and get "Rasoi", who goes and brings a tin bearing a label which contains the word "Rasoi" and also the name of the company. Another says that he knows "Rasoi" to be the product of the company, because the tins which he buys have on them labels with the word "Rasoi", as also the name of the producer, inscribed on them. Only the remaining two say that they know the goods by the label, but as the label admittedly bears the name of the company, even their evidence is of poor value as evidence of the distinctiveness of the mark. The period of use is thus only about two years, the area over which use has been proved is exceedingly small and there is practically no evidence at all that the mark itself has come to denote the company's goods to anybody.

37. Nor is there any evidence that in reality the proposed mark has been in use by itself as a trade mark. So far as the label on the tins is concerned, the word "Rasoi" has been used in it in conjunction with several other words or letters, such as "HDC" and the name of the company set out in full, all against a background of yellow and green colours of arresting shades. It appears from the specimen advertisements that, there also, the word has been displayed along with other words and illustrations and it has not only been printed in letters of various fanciful shapes, but into the body of the letters have been inserted representations of fish and various vegetables, apparently swimming in or being cooked in the oil. The mark alone has thus never been in use as denoting the goods and has never had any chance of becoming distinctive by itself. Its user in various decorated forms in conjunction with other words is not the kind of user which Section 6(3)(b) of the Act contemplates or which could make it adapted to distinguish the goods on which it was so used.

38. In my opinion, the company have wholly failed to prove that the word "Rasoi" has become adapted to distinguish their hydrogenated oil by reason of user. In a well-known and oft-quoted passage in the "Perfection" case, Fletcher Moulton, L.J., observed as follows:

"The extent to which the Court will require the proof of this acquired distinctiveness to go will depend on the nature of the case. If the objections to the word itself are not very strong, it will act on less proof of acquired

distinctiveness than it would require in the case of a word which in itself is open to grave objection."

39. The word "Rasoi" is a common word of the language, in universal use in its ordinary signification and certainly nothing like the user proved in this case could induce any Court to hold that it had lost its primary meaning for all practical purposes and that in stead of denoting cooking, it had come to denote an article i.e., the goods of a particular trader and had become distinctive of them.

40. In my view, there are other objections of a general character to the registration of the word. Even if a word has no direct reference to the character or quality of the goods concerned or even if, although it has such reference, it has become adapted to distinguish the goods in fact, the Registrar or the Court is not bound to direct its registration. That principle has been stated and re-stated in the cases and the following observation of Buckley, L.J., in the "Diamine" case is as clear as any other : "The Court can (but is not bound to) direct the registration to proceed if it is satisfied that the word is, in the language of the Act, a distinctive word, that is to say, a word adapted to distinguish the goods of the proprietor of the trade mark from those of other persons". In deciding whether the Court will direct registration of a word, even if it be a distinctive word, the Court will pay regard to certain general considerations, one of which is that the common words of a language are public property and no individual member of the public ought to be allowed to appropriate one of them to his exclusive use to the derogation of the rights of others who may legitimately require it for use in connection with goods of the same class made by them. "Rasoi" is a common word and it is natural for any maker of a cooking medium to desire to use it for describing his product. The Deputy Registrar gives an actual instance where another maker of hydrogenated groundnut oil in Gujerat house used the word in a descriptive sentence appearing on the containers of his oil. No one should be granted a monopoly of such a word. "Wealthy traders", observe Cozens-Hardy, M.R. in the "Perfection" case, "are habitually eager to enclose part of the great open common of the English language and exclude the general public of the present day and of the future from access to the inclosure". That is the passage most quoted in connection with the impropriety of allowing registration of common words, but it is really a faithful echo of what Fry. L.J., has said twenty years earlier in the Fruit Salt case. "I cannot help regarding, observed the learned Lord Justice, "the attempt on Mr. Eno's part as an instance of that perpetual struggle which, it seems to me, is going on to enclose to appropriate as private property certain little strips of the great open common of the English language" - In re Dunn ("Fruit Salt" for banking-powder), [41 Ch. D. 439; (1889) 6R P.S., 379 CA]. That, he added, "is a kind of trespass against which, I think, the Courts ought to set their faces". That principle on which registration of ordinary words as trade marks is not favoured is, first, that "the vocabulary of the English language is" as Lord Herschell observed in the "Solio" case (ante), "common property, it belongs to all" and, secondly, that appropriation of such a word by a particular trader as his trade mark will cause

substantial difficulty to other traders and may also cause confusion, per Fletcher Moulton L.J., in the "Perfection" case [(1910) Ch. 130 at p. 148]. It is true that Section 26 of our Act, like Section 44 of the English Act of 1905, provides that no registration of a trade mark shall interfere with the use by any person of any bona fide description of the character or quality of his goods and it was said by Fletcher Moulton, L.J., in the "Perfection" case that Section 44 afforded a useful guidance as to whether a describable word should be registered or not, the test being whether substantial difficulty or confusion would be caused to other traders. But the House of Lords took a different view in the "Glastonbury's" case (ante). "I do not consider it necessary", observed Lord Atkin, "to invoke Section 44, the object of which appears to be to give protection to traders in respect of a name which is registered and must be treated as adapted to distinguish, and not afford a guide as to whether a name should be registered or not." "Earlier, Hamilton, L.J., had said in "Broadman's" case : "It is not safe to rely exclusively on the protection afforded by Section 44, to persons acting in good faith. They should not be exposed even to the risk of legal proceedings without full consideration." In my view, the principle of the impropriety or inexpediency of permitting registration of an ordinary word of the language, applies with great force to the word "Rasoi" and quite apart from whether it is distinctive of the company's goods or not, they ought not to be allowed to attach and appropriate a word which is in such common use and the registration of which is bound to cause risk and embarrassment to other manufacturers who may legitimately require its use for their goods. It must not be forgotten that registration of a word as a trade mark is registration of title to the word. No individual should be conferred a title to an ordinary word of the language against all others except in very special circumstances. Such circumstances would be where the word has ceased to be an ordinary word and having lost its primary meaning altogether or for all practical purposes through long user in connection with the goods of the applicant, has come to be merely an index of those goods. I find it impossible to believe that the word "Rasoi" can ever be reduced to that condition but, in any event, it has not reached that condition in relation to the goods of the company.

41. Some discussion took place at the Bar as to the discretion vested in the Registrar and the circumstances in which it would be proper for the Court to interfere with it. The Registrar has undoubtedly a discretion u/s 14(1) which says that he may accept an application or refuse it. There is again a discretion conferred by Section 6(3) which says that the Registrar may have regard to the extent to which a mark is inherently adapted to distinguish and the extent to which it has become so adapted by user. The implication is that the Registrar may not pay regard to such circumstances, if he otherwise comes to be of opinion that the proposed mark ought not to be registered. It has been said that the Court will not interfere with the Registrar's exercise of his discretion unless he is clearly wrong, but in the "Sheen" case, Lord Wright, M.R. objected to the qualification "clearly" as superfluous in the view that the Registrar must be either wrong or right and that if he was wrong, he must be clearly wrong. The correct

position seems to me to be that if the view taken by the Registrar be a possible view, the Court will not interfere with it, although it might itself have taken a different view if called upon to decide the question in the first instance. It is in that sense that it is said that the Registrar's view must be clearly wrong, that is to say, wholly untenable, if it is to be superseded. The consideration shown to the Registrar's view is due to the fact that the subject of trade marks is his special province and having a deal with hundreds of cases of various types and living, as it were, in the world of trade and marks, he possesses a special knowledge and experience which the Court lacks. The Court will, therefore, usually not take the responsibility of overruling the Registrar unless it feels that he is wholly wrong.

42. My conclusion on the whole case is that the word "Rasoi", as applied to the hydrogenated oil manufactured by the company, has a direct reference to the character or quality of the goods; that consequently it can be eligible for registration only if it is proved to be distinctive of the company's goods and adapted to distinguish them; that even if the word be held to have no direct reference to the character or quality of the goods, it must be proved to be distinctive of them in order to be admissible for registration; that such distinctiveness has not been proved; and that even if distinctiveness has been established or be not required, registration of such a common word of the language which others also may legitimately require, ought not to be allowed. So it has been held by the Deputy Registrar and I see no reason to interfere with his decision.

43. I would, therefore, dismiss the appeal with costs.

44. S. R. Das Gupta, J. - The facts leading up to this appeal have been fully and carefully set out, if I may say so with respect, in the judgment of My Lord the Chief Justice and it is unnecessary for me to state them over again.

45. There are two questions involved in this appeal. The first is whether or not the word "Rasoi" has a direct reference to the character or quality of the appellant's goods. The second is whether or not the said word "Rasoi", even if it has such reference, acquired by extensive user a distinctiveness that is to say, has become adapted to distinguish the goods of the appellant from other goods of the like nature. On the second question I am in entire agreement with the views expressed by my Lord the Chief Justice but on the first I am unable to agree with him.

46. In my opinion the word "Rasoi" has no direct reference to the character or quality of the goods in question. I am laying stress upon the word "direct". In my opinion an indirect or a suggestive reference to such character or quality would not disentitle a word from being registered as a trade mark u/s 6(1)(d) of the Trade Marks Act. The word in question must have a "direct" reference to such character or quality. In this connection I should mention that in the English law relating to trade marks, on the basis of which the Indian Trade Marks Act has

been enacted, the word "direct" has been used for the first time in the United Kingdom Trade Marks Act of 1905. In previous Act of 1888 the words used were simply "no reference to" without the word "direct". Thus it seems to me that the use of the word "direct" in the English Act was not without significance. The use of the said word shows that words having an indirect or suggestive reference to the quality or character of the goods are not excluded from paragraph 4 of Section 9 of the English Act and from sub-section (1)(d) of Section 6 of the Indian Act and are, therefore, registrable.

47. In this case the word "Rasoi" with reference to the appellants' goods may suggest that the goods of the appellant are suited for cooking but that is at best a suggestion and not a direct reference to the quality or character of the said goods.

48. In my opinion a suggestion as to the use to which the goods can be put cannot be a direct reference to the quality or character of the goods. The same view has been taken by Mr. Justice Warrington - In the Matter of the Application of the Campagnie Industrielle Des Petroles (24 RPC 585), to register a trade mark. What happened in that case was as follows : In 1901, a company registered "Motorine" as their trade mark for lubricating oils and sold large quantities of lubricating oils under that name, which became identified with their goods. In 1907 another company which had dealt largely in Petrol spirit, under the name "Motoricine" applied for registration of "Motoricine" as their trade mark. This application was opposed by the company which had their mark "Motorine" registered. The Registrar refused to register "Motoricine" and the applicant company appealed against the said order and also moved the Court to expunge the other company's trade mark "Motorine" from the register. The said appeal and the application were both dismissed. Warrington, J., in dismissing the application inter alia held that the word "Motorine" had no direct reference to the quality or character of the goods which it designated and was therefore a good trade mark u/s 9, sub-section 4 of the Trade Marks Act, 1905. His Lordship, in the course of his judgment, observed as follows:

"Now the Act of 1905, defines a registrable mark as follows: it says it "must contain or consist of at least one of the following essential particulars", and the particulars which I think are material for the present case are "a word or words having no direct reference to the quality or character of the "goods". The word "direct" is inserted in this Act for the first time. In the previous Acts it was "A word or words having no reference to the character or quality of the goods". The word "direct" is now inserted. Now is the word "Motorine" a word which has direct reference to the character or quality of the goods? The goods in question consist of lubricating oil. I cannot see how the word "Motorine" has any direct reference to the character or quality of those goods. No doubt it suggests that in some way they are oils which are to be used in connection with a motor, but beyond that it has no reference either to their character or their quality, and such reference as the use of the two syllables of the word "motor" in the word

"Motorine" as to the character or quality seems to me not to be that direct reference which the present Act contemplates."

49. These observations, in my opinion, apply with equal force to the present case. In this case also the use of the word "Rasoi" may no doubt suggest that the goods in question are to be used in connection with cooking but beyond that it has no reference either to their character or quality and such reference as the use of the word "Rasoi" may suggest, does not seem to me to be that direct reference which the Act contemplates.

50. In this connection, I would refer to the observations of Vaughmn Williams, L.J., made in the matter of Burroughs Welcome & Co.'s Trade Marks (21 RPC 217). His Lordship discussed at some length the question as to when a word can be said to be descriptive of the quality of the article to which the trade mark is meant to apply. The question which arose in that case was whether the word "Tabloid" in connection with compressed drugs in a solid form and of a particular shape was descriptive or distinctive, and whether the registration already effected should be expunged.

51. Vaughmn, L.J., observed as follows:

"In my judgment the word "Tabloid" was at the time of the registration, a distinctive word suggesting the source or the origin of the goods which were covered, or intended to be covered, by it and I think, further, that at that date the word "Tabloid" was not a descriptive word. As the word was understood at that time it really conveyed to the hearers no peculiar quality of the goods which were offered to the public. I think that the word "Tabloid" may properly be described at that time as being a fancy word. I do not myself think that, having regard to the judgments in the "Bovril" case, it could be said that a word is to be treated as a descriptive word because it might suggest some idea to the hearer. It seems to me that the trade mark which was under discussion in the "Borvil" case, proves the contrary. It is perfectly impossible to say that the word "Borvil" used in respect of an extract of meat did not suggest beef, or an ox, as the materials from which the extract was made. But the mere fact that the word "Borvil" did contain such a suggestion, to my mind is inconsistent with the idea that the fancy word must be absolutely unsuggestive. It must not be descriptive, but it need not be absolutely unsuggestive. Speaking of this, I would like to add that it is not to the interest of any community that you should deal with any subject matter which is regulated by Statute law as to make the rule of law, that you deduce from the Statute, inconsistent with the practice of mankind. Nobody supposes that, when you sit down and choose a fancy name, you ask someone to make a selection at haphazard from a dictionary of a number of words, and you then put them into a bag, and did your hand in, and leave it to chance what word it is that you select, and then use that word however foreign it may be to the subject matter to which your propose to apply your trade mark, his mind will naturally run on words that are more or less cognate to the articles with reference to which the trade mark is proposed to be registered. He sits down and

does that, and having done that, his next care is that the cognate word that he so chooses shall not be such that it really describes the quality or the form of the article to which the trade mark is meant to apply. "Then one is dealing with the question whether a word is descriptive, I think one must always bear in mind that for a word to be really descriptive, it must describe something which is material to the composition of the article to which the trade mark is intended to apply."

52. Applying the test laid down in that case, namely, that for a word to be really descriptive, it must describe something which is material to the composition of the article to which the trade mark is intended to apply to the present case the word "Rasoi" in my opinion, is not descriptive.

53. The learned Deputy Registrar of Trade Marks house held that the word "Rasoi" is descriptive of the very purpose for which the goods bearing that mark are to be used, viz., cooking and is therefore not suitable for registration. In support of that view he relied on the following passage from Herschell Committee's report :-

"If the word sought to be registered would be understood as suggesting a special use of the goods or their adaptability to a particular purpose, it would be objectionable as descriptive of their character."

54. It should be remembered that the Herschell Committee's report was made in the year 1888, but the word "direct" came to be used for the first time in the Act of 1905. The relevant provisions of the Act of 1882 were as follows:-

"A distinctive, device, mark, brand, heading, label, ticket or fancy word or words not in common use."

55. In the Act of 1888 the words used were as follows:-

"Words having no reference to the character or quality of the goods".

56. As I have already said it is in the Act of 1905 that the word "direct" came to be inserted for the first time. The language used in the Indian Trade Marks Act is copied from the English Act of 1905 and the word "direct" has been used in the said Act as well.

57. In the above circumstances the view expressed by the Herschell Committee in their report must have been a view taken with reference to the Act that was then in force has no bearing to the present question in issue before us.

58. Mr. Chowdhury appearing for the respondent strongly relied on the decision of the Court of Appeal in England given In the Matter of an application by the National Machinery Co. to Register a Trade Mark (58 RPC 128). That case, in my opinion, is distinguishable from the present one and, if at all, supports the contentions of the appellant before us than those of the respondent. What happened in that case was as follows: An American Company carried on trade in America in the manufacture of bolts and screws and similar things for several

years. They had registered in America a trade mark consisting of the word "Dex" and applied to have that trade mark registered in England. The learned Assistant Controller refused registration. The learned Assistant Controller held that the word "Dex" was really indistinguishable from and a mere mis-spelling of the ordinary plural noun "Decks". Then the Assistant Controller referred to the following passage from Robinson's Naval Construction to show that Deck-bolts are:-

Deck-bolts are galvanized iron with round head and have a square neck under the head, soaked in white lead and also under washer at point."

59. He also referred to other passages from other books for the aforesaid purpose and proceeded to observe as follows:

"There is in short a special type of bolt, with a name of its own designed in the use in ships", decks, i.e. deck bolts or bolts for decks. It is at once evident that the word "decks" is one which has direct reference to the character or quality of certain bolts under the terms of paragraph (d) of Section 9(1)."

60. On this question the Court of Appeal observed as follows :-

"The question, which has to be determined - I think - is one which like so many of these trade mark applications, is near the line. It has no doubt affected the question to some extent that both Mr. Lloyd-Jacob, before the Assistant Controller and Mr. Burrell in this Court offered to limit the use of the registration in the class which they desire by excluding deck bolts or deck screws. That I think, to some extent assist them, because there are no doubt, bolts which are known in the trade as deck bolts and do refer to particular forms of bolt which are used in ship building for the purpose of bolting the decks of ships. But I do not think that gets over the whole difficulty of the applicants". Then their Lordships proceeded to decide the appeal on other grounds. Thus apart from the fact that the actual decision of the Court of Appeal was founded on other grounds the facts in that case are different and already distinguishable from those in the present one. As appears from the grounds of the decision of the Assistant Controller and the observations of the Court of Appeal, to which I have just now referred, there was a special type of bolts, having a special shape and design, which came to be known in the trade as deck bolts and were used in ship-building for the purpose of bolting the decks of ships.

61. That being so, there can hardly be any dispute that the word "deck" used with reference to bolts must and can only mean "deck-bolt", i.e., a particular "type" or "form" or "quality" of bolts. In such a case the word "deck" must be held to have a direct reference to the character or quality of the goods in question. But that is not the position in this case. It cannot be said that there is a special type or form of ground-nut oil which has come to be known in the market as "Rasoi" used in connection with ground-nut oil can only mean that type of ground-nut oil known as "Rasoi-groundnut oil". All that the use of the word "Rasoi" may suggest, and it is nothing more than a suggestion, that the

appellant's groundnut oil is suited for cooking. That to my mind is not a direct reference to the quality of the goods. I am satisfied that the decision relied on by Mr. Chowdhury does not support his contentions.

62. A true instance of a word having direct reference to the character or quality of goods is to be found in the case of *In re. Leopold Cassella & Co.*, [(1910) 2 ch. 240]. In that case an application was made to register the word "diamine" for dyes. That word was a known chemical term which indicated that the substance to which the word was applied contained two amine groups. Cozens-Hardy, M. R., observed that the word had a direct reference to the character or quality of the goods and was therefore not adapted to distinguish the goods of the proprietor of the trade mark from those of other persons possessing the same character or quality. "It is a word", His Lordship proceeded to observe "which indicates that the body to which the epithet is applied has a certain composition and contains two amine groups" "Other persons manufacturing similar bodies containing two amine groups may reasonably desire to use this word as descriptive of the character or quality of their groups. There appears to be other single word which could express this fact."

63. Mr. Chowdhury in support of his contention also cited before us the following cases: namely, *A. Bailey & Company Ltd. v. Clark son and Morland* [(1938) AC 557]; *In re. Joseph Crossfield & Sons Ltd.*, *In re. California Fig Syrup company*; *In re. H. N. Brock & Co. Ltd.*, [(1910) 1 ch. 130]; *In re an application of R. T. Les Limited, For Registration of Trade Mark* [(1913) 1 Ch. 446]. I shall shortly indicate my views thereon. In the case of *a. Bailey & Company Ltd.*, the respondent-company had obtained registration as a trade mark of the word "Glastanburys" in connection with skin ship slippers. The appellants on becoming aware of it applied for expunging the said registration. "Glastanbury" was the name of a town where both the appellants and the respondents had for many years carried on business as makers of ships" skin slippers and the said town enjoyed a reputation in connection with manufacture of ships" skin slippers. The Court held that the said word was not adapted to distinguish. I cannot see what else could the Court hold in the circumstances of that case. In the first place the name registered was the name of a town and under sub-section 4 of Section 9 of the English Trade Marks Act of 1905, a registerable trade mark must not be a word which according to its ordinary signification is a geographical name and a word having such signification shall not except by order of the board of trade be deemed to distinctive mark. According to the Indian Act also a trade mark shall not be registered unless, amongst others, it is a word not being according to its ordinary signification a geographical name and a word having such signification shall not be registerable except upon evidence of its distinctiveness. In the second place it was held in that case that registration of such a mark would be likely to cause substantial difficulty or confusion in view of the rights of all traders to use the name of the place where they do or may in future manufacture similar goods and which in fact enjoyed a reputation in connection with manufacture of ship skin slippers. As observed by Maugham L.c., "the name

f Glastanbury used in connection with slippers might indicate, first, that they were made at Glastanbury or secondly, that they were made (there or elsewhere) out of skins tanned in a special manner commonly used at Glastanbury, or thirdly they were slippers made or marketed, irrespective of place of manufacture and of materials, by a particular manufacturer", and therefore the said word was not adapted to distinguish. The above considerations do not arise in the present case. In my opinion this case is of no assistance to us in deciding the present dispute between the parties.

64. The three cases reported in [(1910) 1 Ch. 130], namely, *In re. Joseph Crossfield & Sons Ltd.*, *In Re. California Fig Syrup Co.* and *In re. H. N. Drock & Co. Ltd.*, are equally distinguishable from the present case. In *re. Joseph Crossfield & Sons Ltd.*, the word in question was "perfection". That the word had a direct reference to the quality of goods was not in dispute in that case and the only question which had to be considered was whether or not it can be registered under sub-section 5 of Section 9 of the Act of 1905. Their Lordships held as follows:-

"No word can be registered under this sub-section unless it is "distinctive" that is to say, is "adapted" to distinguish the goods of the proprietor from the goods of other persons. There were some words which were incapable of being so "adapted" such a "good", "best", "superfine". They cannot have a secondary meaning as indicating only the goods of the applicant. There are other words which are capable of being so "adapted" and as to such words the Tribunal may be guided by evidence as to the extent to which the use has rendered the word distinctive" (Cozens-Hardy, M.R.).

65. But in this case if I hold, which I do, that the word in question has no direct reference to the quality or character of the goods, the question as to whether or not it can be registered under clause (e) of sub-section (1) of Section 6 would not arise.

66. In *re. California Fig Syrup*, the words in question were "California Syrup of Figs" and their Lordships held that the evidence was ample to establish a prima facie case of these words being identified by long use with the goods of the applicant and therefore justified their Lordships in allowing the registration to proceed. I do not see how this case helps Mr. Chowdhury in his contention. Once again it should be remembered that the word "California" was a mere geographical name and therefore the question whether or not it should be allowed to be registered had to be decided with reference to sub-section 5 of Section 9 of the Act of 1905.

67. In the third case of the series, i.e., *In re. H. N. Drock & Co.*, the word in question was "Oriwoole" and had been registered under the old law as applied to woolen goods. An application was made to remove it from the register. It was held that in substance it was "a case of registration of the words "all wool" grotesquely misspelt" and "misspelling does not affect the words when spoken"

and inasmuch as the words "all wool" are natural and necessary description of woollen goods the said words could not be registered. (Per Fletcher Moulton, L.J.). Thus it is evidence that the words in question in that case had a direct reference to the quality or character of the goods and therefore the further question which arose was whether or not the said goods were adapted to distinguish.

68. The only other case, cited by Mr. Chowdhury, which remains to be considered is "In re. An Application of R. T. Lea Limited for Registration of a Trade Mark [(1913) 1 Ch. 446]. In that case an application was made to register the "Boardman"s" u/s 9(5) of the Trade Marks Act, 1905, as a trade mark in respect of manufactured tobacco. "Boardman"s was the surname of an individual. The application was refused by Joyce, J., on the ground that the said word was not a trade mark "in actual user" within the last para of Section 9 and that a mere surname of an individual, though it may be adapted to distinguish the goods of all the persons taken collectively, who bore that surname from the goods of other persons bearing a different surname, was not adapted to distinguish the goods of the applicant within the meaning of that expression in the Act and ought not therefore to be registered u/s 9(5). Against that decision there was an appeal which was dismissed. The ground on which the said appeal was decided was that a surname is excluded from para. 4 and is therefore not prima facie adapted to distinguish and the evidence adduced to actual use of it falls far short of that universality which is required for distinctiveness within Section 9. Farewell, L.J., observed as follows:

"It is plain to my mind from the phraseology of Section 9 that the name of a company, individual, or firm by itself is not, prima facie and without more, distinctive; nor is a geographical name or surname; and if there is nothing more, I think it would be wrong for the Board of Trade or the Court to allow such to be registered. The Act in paragraphs 1 and 2 of Section 9 has been careful to limit the power of obtaining registration of such words to the distinctiveness arising out of the special or particular manner of representation or the peculiarity of signature, so that any number of individuals called "John Smith" may obtain protection for their signature, as written by them, but not for the name f "John Smith". Further, it is plain that the surname alone does not come within Section 9(1), unless it be the name of a firm, for example, "Birchams" the name or signature of an individual means that which individualises him; he may belong to the great family of Smith, but he is identified as an individual by his own prenom as distinguished from his family name. Further, "surname" is excluded from part 4, and is therefore not prima facie adapted to distinguish; the argument that the very object of a surname is to distinguish is specious but deceptive; Smith is doubtless well adapted to distinguish its bearers from Brown, but not from all or any of the members of the family of Smith. It is doubtless true that the object of the Act is to extend the area of words adapted to be used as trade marks, but when the Legislature has shewn that certain words are prima facie not included, the Court ought to be careful in exercising a discretionary jurisdiction to enlarge

such area and should remember that the owner of a trade mark under the Act enjoys a monopoly after seven years for all time and over the whole United Kingdom." Thus the question which had to be decided in that case was whether or not the word "Boardman's", being excluded from paragraphs 1-4 and therefore not prima facie adapted to distinguish, can still be registered under sub-section (5) of Section 9. That it was a word which was specifically excluded from sub-section 4 of that Section could not be and in fact was not disputed and therefore the only point which remained to be considered was whether or not it could be registered under the remaining sub-section (5) of the said Section. That question would not arise in the present case, if I hold, which I do, that the word "Rasoi" is not excluded from sub-section (d) of Section 6 of our Act, not having direct reference to the quality or character of the goods. I am clearly of opinion that the said case is also distinguishable from the present one.

69. I now come to the last contention raised by Mr. Chowdhury. He contended that words although having no direct reference to the character or quality of goods, must still be distinctive before they can be admitted to registration. In other words, a word before it can be registered must not only have no direct reference to the character or quality of goods, but must also be distinctive, i.e., adapted to distinguish. The word "Rasoi", he contended, even if it be assumed that it has no direct reference to the quality or character of the goods in question is not distinctive and therefore cannot be registered. He drew our attention to the words "any other distinctive mark" appearing in clause (e) of sub-section (1) of Section 6 of our Act and contended that the said words suggest that the marks mentioned in the previous clauses must be distinctive.

70. I am unable to accept this contention. Sub-section (1) of Section 6 provides that a trade mark shall not be registered unless it contains at least one of the particulars mentioned therein. One of such particulars has been set out in sub-clause (d) of the said Section, which inter alia reads as follows: "One or more words having no direct reference to the character or quality of the goods". Thus the plain and natural meaning of sub-section (1) read with sub-clause (d) is that one or more words having no direct reference to the character or quality may be registered, but words having such reference shall not be registered. The question is, has the use of the words "any other distinctive mark" in sub-clause (e) made the said meaning in any way different. In other words, does the use of the said words in the said sub-clause indicate, as Mr. Chowdhury contended, that the marks falling under clauses (a) to (d) of the said sub-section must also be shown to be distinctive before they can be eligible for registration. In other words, would it not be enough to show that a mark falls under one or other of the clauses (a) to (d) of sub-section (1) of Section 6 in order to make it eligible for registration? I do not think that the use of the said words in clause (e) indicates that a mark although coming under one or other of the clauses (a) to (d) has still to be shown to be distinctive before they can be eligible for registration. At this stage, I should mention that the question for consideration is whether or not such a mark is eligible for registration and not whether it should in fact be

registered. The true effect of sub-section (1) of Section 6 read with all its sub-clauses seems to me to be as follows: Marks coming under any one of sub-clauses (a) to (d) are prima facie distinctive. They are made distinctive by the Section itself and are eligible for registration. But marks which do not fall within one or other of the said sub-clauses have to be shown to be distinctive before they can be eligible for registration. A mark can be shown to be distinctive in two ways, namely, (1) if it is inherently adapted to distinguish or (2) by the use of the trade mark or by any other circumstances which makes the trade mark in fact to distinguish. In the case of a name, signature or any word not falling within sub-clauses (a) to (d) a special provision has been made, namely, that in such cases distinctiveness will have to be established by evidence. This seems to me to be the true effect of sub-section (1) of Section 6 read with all its sub-clauses. The view which I am taking in this matter is supported by the observation of Farwell, L.J., made in Boardman's case, [(1913) 1 Ch. 446] to which I have already referred. The view expressed by His Lordship, as I have understood, is that marks falling under paragraphs (1) to (4) of Section 9 of the English Act of 1905 are prima facie distinctive but in the case of marks which do not fall within those paragraphs distinctiveness will have to be established before the Court can allow the same to be registered.

71. Before concluding my judgment on this point, I should deal with the case of "In the matter of a Registered Trade Mark "Livron" of Boots Pure Drug Company (54 RPC 161), in which there is some observation by Crossman, J., on which reliance can be placed by the respondent in support of their present contention. The said observations read as follows:- "But I think it is also settled by authority and for that, I should refer to two recent cases, i.e., "Fanfold" case which is reported in 45 Patent Cases, at p. 325, where the Court of Appeal upheld the decision of Lord Tomlin, then Mr. Justice Tomlin, and the "Sheen" case, which is reported in 53 Reports of Patent Cases at p. 355 that every trade mark must be distinctive in the sense adapted to distinguish the goods of the proprietor from those of other persons. Even if the trade mark in the present case can be said to be either an invented word or a word having no direct reference to the character or quality of the goods and not being according to its ordinary signification a geographical name or surname it ought not to have been registered if it was not in fact adapted to distinguish". What happened in that case was that an application was made to expunge the mark "Livron" on the grounds that the registration was effected contrary to Section 9, paragraph 4, inasmuch as "Livron" was the name of a town. In that application the case of the opposite party was that it was not according to its ordinary signification a geographical name, that the said name, as a result of wide advertisements and use, has come to denote and distinguish exclusively the tonic of their manufacture. Registrar allowed the application. On appeal the decision of the Registrar was upheld. The learned Judge stated that the case of the applicant was first that the trade mark in question did not possess any one of the essential particulars enumerated in Section 9 of the Act of 1905. Secondly that the Registrar could in the exercise of

his discretion refuse to register a trade mark and thirdly that the said mark was calculated to deceive within the meaning of Section 11. On all the said grounds the learned Judge held in favour of the applicant. Thus it is clear that for the purpose of deciding the appeal before him it was not necessary for His Lordship to make those observations which are in the nature of obiter dicta, the appeal having been decided on other grounds. As a pure proposition of law the learned Judge, it appears, based his observations on the authority of the two decisions mentioned thereon. As for the "Sheen case" (53 RPC 355), I have read the judgments, one of which is a long one, carefully but I am unable to find anything therein to support the view expressed by His Lordship. In that case it was not disputed by the party interested to have the mark registered that it was descriptive and the only question which arose for their Lordships' consideration and which they decided was whether or not the word can still be registered under paragraph (5) of sub-section 1 of Section 9. In fact Romer, L.J., starts his judgment by saying "in this case the Court is once again asked to consider the operation and effect of Section 9(5) of the Trade Marks Act, 1905 to 1911". In the other case, i.e., In the matter of an Application by Fanfold Ltd., what happened was as follows. There was an application to register a trade mark in respect of paper forms, files and stationery mark consisting of a word "Fanfold Ltd." above a scroll which flourishes at each end. The application was refused by the Registrar on the ground that the name "Fanfold Ltd." was the sole important feature of the mark and was not represented in a special or particular manner, that the device of the scroll, its only other feature, was well known, which any printer might use and with nothing distinctive about it, that the mark did not constitute an invented word and the word either had direct reference to the quality of the goods in question or else was calculated to deceive. There was an appeal against that order which was heard by Lord Tomlin (then Tomlin, J.) and the Registrar's decision was upheld. A further appeal was preferred against the said decision and the same was heard by three Judges, namely, Lord Hanworth, M.R. Lawrence, L.J., and Russell, L.J. The question that had to be decided in that appeal was whether the applicant's mark consisted of the name of a company represented in a special or particular manner and "therefore a registerable mark within the meaning of paragraph (1) of Section 9 of the Trade Marks Act of 1905. Their Lordships held that the name was not represented in a special or particular manner. Thus the general question, namely, whether or not it has still to be shown that a mark in question is distinctive even if it comes under one or other of the clauses 1 to 4 of Section did not arise for their Lordships' consideration. There are however some observations by Lord Hanworth, M.R., which on the face of it seems to support the view that a mark although falling under one or other of the said clauses must also be shown to be distinctive before it can be registrable. The said observations of His Lordship are as follows:

"If one leaves out the name "Fanfold" and takes a common name (let me take the name of Wilson) it would seem quite plain that if you are to register the name Wilson without something which was so special or particular as to be

distinctive, it would offend or possibly offend against the sections to which I have already referred and be not registrable in consequence. Therefore, the plea that is raised by Mr. Shelly that to ask for distinctiveness in paragraph 1 is to ask for something more than the statute requires, because it enables you to use your name in a special or particular manner is answered by the difficulties which would arise if a plain name was accepted with the slightest possible additions of some particular or special feature. In my judgment Mr. Justice Tomlin came to a right conclusion upon the meaning of Section 9. I think that it does require that there should be distinctiveness. Paragraphs (1), (2), (3) and (4) do not expressly refer to distinctiveness. Paragraph (5) says "any other distinctive mark". The use of the word "other" seems to be of importance. The paragraph goes on "but a name, signature or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3) and (4) shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness." Finally, after the proviso, which does not apply, the words to be found "for the purposes of this Section", not any particular paragraph or part of a Section, "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons."

72. Those observations so far as they relate to paragraph (1) of Section 9 present no difficulty and I respectfully agree with the Master of the Rolls. The use of the words "special or particular manner" in paragraph 1 of Section 9 of the English Act and in clause (a) of sub-section (1) of Section 6 of the Indian Act shows or implies that the name in question should be represented in such a way that, because of such representation, it would stand separate or distinct by itself. In other words, to use the language of Farwell, L.J., in Boardman's case "the Act has been careful to limit the power of obtaining registration of such words to the distinctiveness arising out of the special or particular mark of representation or the particularly of signature." Distinctiveness is germane or implied in the use of the words "special or particular manner". In fact the learned Master of the Rolls himself made an observation to that effect in the subsequent portion of his judgment, His Lordship observed:

"The result of that is this, that in order to be registrable under paragraph (1) you must, first of all, have a name which is represented in a special or particular manner; but (it may be either superadded or interpreting what is meant by "special or particular manner") there must be distinction, and that distinction is required so that there may be an indication that the goods on which the mark is put are the goods of the proprietor and the distinction must be one which is adapted to distinguish those goods of the proprietor for the purpose of enabling the definition of a trade mark to be fulfilled, a definition to which I have already referred in Section 3".

73. The other portions of the said observations, where His Lordship in dealing with the general question suggests that a mark besides containing one of the essential particulars mentioned in paragraphs 1 to 4 must be shown to be

distinctive in order to be registrable u/s 9 presents some difficulty. In the first place, as Lawrence, L.J. pointed out in his judgment, this question did not arise in that case. In any event, I am constrained to say with utmost humility that I am unable to accept the reasoning of the Master of the Rolls on this question. I have given most anxious consideration to his views but I cannot agree with the same. In my opinion the use of the word "other" in paragraph 5 of Section 9 does not show that marks coming under the previous paragraphs 1 to 4 must also be shown to be distinctive. On the other hand use of the said word in the said paragraph, indicates to my mind that marks coming under one or other of the previous paragraphs are distinctive, made distinctive by the Act itself - and what paragraph 5 of Section 9 [corresponding to clause (e) of sub-section (1) of Section (6)] means is that any other distinctive mark, i.e., distinctive marks other than those mentioned in the previous paragraphs are registrable. I would once again refer to the view expressed by Farwell, L.J., to which I have already referred, namely, words not falling within paragraphs 1 to 4 [clauses (a) to (d) of the Indian Act] are prima facie not adapted to distinguish. In my opinion in such cases it has to be shown either that the said marks are inherently adapted to distinguish or the same have in fact been made distinctive by user or other circumstances. But in the case of a name, signature, or words excluded by the previous paragraphs it is necessary to be shown by evidence that they have become distinctive in fact by long user or other circumstances. This seems to me to be the true meaning of paragraph (5) of the English Act and clause (e) of sub-section (1) of Section 6 of the Indian Act. I cannot also hold that the use of the words "for the purpose of this Section the expression "distinctive" means adapted to distinguish" in sub-section (2) of our Act and in the last portion of Section 9 of the English Act has in any way altered the said meaning. It is true, as the learned Master of the Rolls observed, that the words used are "for the purpose of this Section" and not any "particular paragraph" or "part of the Section, but I cannot see how that fact in any way alters the position. All that the said words mean is that wherever in the Section the word "distinctive" appears it would mean adapted to distinguish" and nothing more. I am unable to accept the view of the Master of the Rolls and I very respectfully differ from the same. I would once again mention that those observations were not necessary for the purpose of deciding the said case and the matter does not seem to have been argued from that point of view before their Lordships.

74. The last contention of Mr. Chowdhury was that in the matter of registering a trade mark the Deputy Registrar has always a discretion and if in the exercise of such discretion the Deputy Registrar refused to accept the application this Court should not interfere with that discretion. The short answer to this contention is that assuming that he has such a discretion and ordinarily this Court should not interfere with the exercise of such discretion, the Deputy Registrar in this case has refused to accept the application on an erroneous view of law, that is to say, as to the effect of Section 6 of the Act and not in the exercise of his discretion. That being so, his decision cannot be supported on the ground of exercise of a

discretion. Mr. Chowdhury also realised the force of this answer as soon it was suggested to him and did not press this contention further.

75. The result, therefore, is that in my opinion the word "Rasoi" has no direct reference to the quality or character of the appellant's goods and therefore falls under the description given in clause (d) of sub-section (1) of Section 6 of the Indian Trade Marks Act and is registrable. I also hold that a mark coming under one or other of the clauses (a), (b), (c) and (d) of sub-section 1 of Section 6 of the Act is *prima facie* distinctive, i.e., made distinctive by the statute and it is only in the case of marks which do not come under any one of the said sub-clauses that distinctiveness has to be established before the said marks can be eligible for registration and if a mark happens to be a name, signature or a word other than those falling u/s 6(1)(d), distinctiveness has to be proved by evidence.

76. In the result I hold that the matters should be sent back to the Registrar to be dealt with by him according to law. In other words, I hold that the Registrar should proceed on the footing that the said mark is ineligible for registration and should cause the same to be advertised in accordance with the provisions of the Act. I also make it clear that the Registrar, if he so chooses, may act under the proviso to Section 15 and direct advertisements to be issued before accepting the application for registration.

77. Before concluding my judgment I express my dissent from the view taken by my Lord the Chief Justice, namely, that a common word of the language even if it be distinctive should not be permitted to be registered. In my view the Section of the Act makes no such exception. If the common word happens to be a word descriptive of the quality or character of the goods, it comes within the mischief of clause (d) of sub-section 1 of section 6. If not, it is, on the view I have taken of the matter, is ineligible for registration.

78. Owing to the difference of opinion, Chakravartti, C.J. and S. R. Das Gupta, J. stated the points on which they differed by the following order:

79. As we have differed in opinion on certain points, it is necessary to indicate the points on which we have differed in order that the case may be heard on those points by one or more of the other Judges of this Court.

80. One of us has held that the word "Rasoi", if and when used as a trade mark for the hydrogenated groundnut oil manufactured by the appellant company, has a direct reference to the character or quality of the goods and as such is outside the provisions of clause (d) of sub-section (1) of Section 6 of the Trade Marks Act. the other of us has held that the word "Rasoi", so used, has no such direct reference and consequently it is within the provisions of Section 6(1)(d). The former of us has also held that even assuming that the word, if used as a trade mark for the company's oil, cannot be said to have a direct reference to the character or quality of the goods and as such is a word within the provisions of Section 6(1)(d), it must still be proved to be distinctive in the sense of being adapted to distinguish the appellant's goods, in order to be eligible for

registration. The latter of us had held that once a word or a mark is held to be within clause (d) of Section 6(1) or, for the matter of that, within any one of the preceding clauses, it must be taken to be prima facie distinctive according to the true intendment of the statute and it will not be necessary to establish its distinctiveness by evidence. The former of us has further held that assuming the word "Rasoi", if used as a trade mark for the company's oil, can be said to have no direct reference to the character or quality of the goods and assuming further that its distinctiveness in the statutory sense need not be proved by evidence or otherwise, still the word is not admissible for registration, inasmuch as it is a common word of the language which no particular trader should be allowed to make his private property. The latter of us has held that the Act contains no such exception in favour of the common words of the language and if a word, although it may be a common word, comes within clause (d) of Section 6(1) or not coming within that clause, is still proved to be distinctive, there is nothing in the Act to require its exclusion from registration.

81. Both of us have, however, agreed that the appellants have not succeeded in proving that the mark "Rasoi" has become adapted to distinguish the oil manufactured by them by reason of its user as a trade mark of their goods.

82. The position is governed by Section 98 of the Code of Civil Procedure, read with clause 36 of the Letters Patent. Section 98 provides that where the Judges composing the Bench differ in their opinion on a point of law, they may state the point of law upon which they differ and the appeal shall then be heard upon that point only by one or more of the other Judges. Clause 36 of the Letters Patent provides that if the Judges should be equally divided, they shall state the point upon which they differ and the case shall then be heard in the same manner as prescribed by Section 98 of the Code of Civil Procedure. The difference between the two provisions is that Section 98 of the Code is limited to points of law and discretionary, whereas clause 36 of the Letters Patent covers both points of law and points of fact and is mandatory. Further, sub-section (3) of Section 98 provides that nothing in the Section shall affect any provision of the Letters Patent. The situation which has arisen must, therefore, be dealt with in accordance with clause 36 of the Letters Patent, that is to say, we have to state the points on which we have differed, whether they be points of fact or points of law, for decision of the case on those points by one or more of the other Judges of this Court. Strictly speaking, the difference between the two provisions is not very material for the purposes of the present case, because the questions are all questions of law.

83. The points on which we have differed are the following:

1) Whether the word "Rasoi", if and when used as a trade mark for the hydrogenated groundnut oil manufactured by the appellant company, had a direct reference to the character or quality of the goods within the meaning of Section 6(1)(d) of the Act and is, as such, outside the ambit of that clause?

2) If the answer to the first question be in the negative, that is to say, if the true view be that the word "Rasoi", when used as a trade mark for the appellant's oil, cannot be said to have such direct reference, must the mark be still proved to be distinctive in order to be eligible for registration, or should it be taken to be regarded as prima facie distinctive by the Act itself?

3) Whether, even if the word "Rasoi", when used as a trade mark for the appellant's oil, can be said to have no direct reference to the character or the quality of the goods and even in its distinctiveness were to be taken as established, must the word be held to be still ineligible for registration, in view of the fact that it is a common word of the language of which no monopoly should be granted to any particular trader?

84. The case will now be laid before one or more of the other Judges, as may be directed.

85. The appeal thereafter came up for hearing before Das, J., who delivered the following judgment.

86. Das, J. - This appeal came up for hearing before my Lords the Chief Justice and Mr. Justice S. R. Das Gupta. The learned Judges differed on certain points. In accordance with clause 36 of the Letters Patent, the learned Judges stated the points on which they have differed. The points are the following :-

1) Whether the word "Rasoi", if and when used as a trade mark for the hydrogenated groundnut oil manufactured by the appellant company, had a direct reference to the character or quality of the goods within the meaning of Section 6(1)(d) of the Trade Marks Act, 1940, and is, as such, outside the ambit of that clause?

2) If the answer to the first question be in the negative, that is to say, if the true view be that the word "Rasoi", when used as a trade mark for the appellant's oil, cannot be said to have such direct reference, must the mark be still proved to be distinctive in order to be eligible for registration, or should it be taken to be regarded as prima facie distinctive by the Act itself?

3) Whether, even if the word "Rasoi", when used as a trade mark for the appellant's oil, can be said to have no direct reference to the character or the quality of the goods and even in its distinctiveness were to be taken as established, must the word be held to be still ineligible for registration, in view of the fact that it is a common word of the language of which no monopoly should be granted to any particular trader?

87. By a determination made by the learned Chief Justice on 4.2.54, the case has been placed before me.

88. I shall now proceed to deal with the above points in the order stated above.

89. The facts of this case have been fully set out, if I may say so with respect, in the judgment of my Lord the Chief Justice and need not be restated.

90. I shall take the first point first.

91. In order to answer the questions it is necessary to refer to the definition of the word "Mark" and "Trade Mark". The word "Mark" is defined in Section 2(1)(f) as including among other things a "word". The word "Trade Mark" is defined in Section 2(1)(e). Compendiously stated it 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".

92. Section 6(1) of the Act provides that a trade mark shall not be registered unless it contains or consists of at least one of the several particulars specified in clauses (a) to (e) of the sub-section. The sub-section is couched in the negative form. Its effect is that in order to be eligible for registration a mark must contain at least one of the particulars so specified. In other words, the absence of any one of the particulars will disqualify the mark for registration though the presence of any one of them will not, ipso facto, make the mark eligible for registration. Sections 8, 9, 10 and 14(1) lay down certain other matters which may be taken into consideration in directing registration of a trade mark.

93. The first question which I have already quoted depends on the true view of Section 6(1)(d) of the Act which provides that a trade mark shall not be registered unless it contains or consists of one or more words having no direct reference to the character or quality of the goods. I shall first construe the clause and then discuss the cases which had been cited before me. The mark in respect of which registration has been applied for is the word "Rasoi". Section 6(1)(d) will apply if the word "Rasoi" has no direct reference to the character or quality of the goods in question which are hydrogenated groundnut oil. The word "Rasoi" has a variety of meanings. The Deputy Registrar of Trade Marks has collected from different dictionaries the various meanings of the word "Rasoi". They are cook-room, kitchen, cooking, cookery, cooked-food. In considering whether a mark has reference to the character or quality of the goods, the mark must be looked at, not in its grammatical significance, but as it would represent itself to the public at large. As the learned Chief Justice points out such a question is a practical question to be decided by the common understanding of the term among those, who used it or have occasion to use it in the course of their daily lives and not by what may be recondite meanings to be found in dictionaries. Hence for our present purpose the word "Rsoi" may be taken to mean "cooking". The requirement of Section 6(1)(d) of the Act is that the word "Rasoi" should have no direct reference to the character or quality of the goods. The word "character" has been defined in Murray's New English Dictionary, Vol. II, Part. I, to mean a feature, trait, characteristic and the word "characteristic" has been defined to mean a distinctive mark, trait or feature, a distinguishing or essential peculiarity or quality. It is admitted that the normal use of hydrogenated groundnut oil is for cooking purposes. The use of the commodity as intended or adapted undoubtedly forms part of its character. *Phillipart v. William Whitely*

Limited, Phillipparts Trade Mark "Diabots", In re., [(1908) 2 Ch. 274 (283)]. The people in the trade and to the consumers, the word "Rasoi" would thus imply a direct reference to the character of the goods. Mr. Das, learned Counsel for the appellants, contended that the word "character" or "quality" merely denotes something material to the composition of the goods. Reference was made to certain observations of Vaughan-Williams, L.J., In the matter of Burroughs Welcome & Co.'s Trade Marks [(1904) 21 RPC 217] known as the "Talboid case". The observations relied on are as follows :-

"Now I have to ask myself what was the character of this Trade Marks of 1884? What did the word "Tabloid" convey at the moment it was registered As the word was understood at that time it really conveyed to the hearers no peculiar quality of the goods which were offered to the public. I think that the word "Tabloid" may properly be described at that time as being a fancy word When one is dealing with the question whether a word is descriptive, I think one must always bear in mind that for a word to be really descriptive, it must describe something which is material to the composition of the article to which the trade mark is intended to apply."

94. The observations must be read as a whole. The observations are not intended to imply that the composition of the article is the only material element to be considered in finding out the meaning of the word character or quality of the goods.

95. The observations had reference to the question whether the word "Tabloid" was descriptive or distinctive. This will appear from the observations of the Lord Justice at page 227:

"I want to say with reference to them, that according to my view, the word "Tabloid" was, in substance, an unknown word at the moment when Messrs. Burroughs Welcome & Co. adopted it."

96. The construction suggested by Mr. Das would unduly limit the meaning of the word "character" or "quality". Various words can be imagined as trade mark which have no direct reference to the character or quality of the goods but which at the same time have no connection with the composition of the articles. In my opinion, the word "character" or "quality" of the goods means their nature or peculiarity or quality and not merely their composition.

97. Section 6(1)(d) requires that the reference to the character or quality of the goods must be direct. In order to understand the contention of the word "direct", reference was made to the previous changes in the Statute law so far as this requirement is concerned. It may be conceded that it is not only legitimate but highly convenient to refer both to the former Act and to the ascertained evils to which the former Act had given rise and to the later Act which provided the remedy. The corresponding provision in English Act of 1938 is contained in Section 9, clause (d) which merely reproduced Section 9(4) of the Trade Marks Act, 1905. In the Trade Marks Act of 1888 which preceded the Act of 1905, the

corresponding provision was contained in Section 6(4)(e) which reads as follows:

"A word or words having no reference to the character or quality of the goods, and not being a geographical name"

98. It thus appears that the word "direct" was introduced by the Act of 1905. The reason for this addition was to give effect to the view taken by the House of Lords in the case of Eastman Photographic Materials Co.'s Application [(1808) AC 571], known as the "Solio case" that simply because the word "Solio" suggested the sun, it could not be said that the word "solio" had some reference to the character of the photographic paper known as "solio". It is true that the introduction of the word "direct" shows that the mere fact that the word "mark" has some reference to the goods does not render it incapable of registration. The reference must be a direct one. A mere suggestive reference is not sufficient. In the present case the mark "Rasoi", as I have already stated, directly refers to the character of the goods which are used ordinarily for cooking purposes.

99. I shall deal with the cases which are cited by the Bar.

100. Mr. Das, learned Counsel for the appellants, relied on the cases of In the matter of Compagnie Industrielle Des Petroles's Application [(1907) 2 Ch. 485] known as the "Motorine" case; In the Matter of the Trade Mark "Radiation" (47 RPC 37) known as "Radiation" case; In the matter of an application by J. & P. Coats Ltd. (53 RPC 355) known as the "Sheen" case; and In the matter of registered trade mark "Livron" (Boots Pure Drug Co., 1936) (54 RPC 161) known as "Livron" case.

101. I shall deal with these cases in the order I have stated.

102. In the "Motorine" case the facts were as follows: In 1901, a company had registered "Motorine" as their trade Mark for lubricating oils and sold large quantities of lubricating oils under that name. In 1907 another Company which had also dealt largely in petrol spirit under the name "Motoricine" applied for registration of "Motoricine" as their trade mark. This application was opposed by the former Company. The Registrar refused to register "Motoricine". The applicant Company appeared against the said order and also moved for expunging the trade mark "Motorine" from the Register. Warrington, J., dismissed the application on the ground that the word "Motorine" had no direct reference to the quantity or character of the goods and was therefore eligible for registration u/s 9(4) of the Trade Marks Act, 1905. It was observed that though the word "Motorine" suggests that in some way they are oils which are to be used in connection with a motor, but beyond that it has no reference either to the character or quality and such reference as the use of the two syllables of the word "motor" in the word "motorine" as to the character or quality, seems not to be that direct reference which the Act contemplates. The decision does proceed on the footing that though the word "Motorine" may suggest motors, it did not suggest lubricating oil which was not exclusively used on motors but was used for various other purposes as well. The "Radiation" case was a decision of the

Controller-General. The word "Radiation" was used in respect of gas stoves. The word "Radiation" was not descriptive of gas stoves and as such was capable of becoming distinctive by long user. In Kerly on Trade Marks, 7th Edition, p. 184, the "Radiation" case is said to be a border line case and not one which is likely to be repeated. In the "Sheen" case the word "Sheen" was proposed for registration as a mark in respect of machine twist or mercerized sewing thread. The Registrar refused registration. On appeal the decision was affirmed by Luxmore, J. The judgment of Luxmore, J., was affirmed by the Court of Appeal. On a further appeal by the Registrar, Lord Wright observed that the word "Sheen" had become distinctive of the applicant's goods, that the word "Sheen" is not a laudatory word like "perfection", "best", "artistic" and that in the sewing cotton trade the attribute of glossiness which the word "Sheen" was intended to convey was referred to as lustre and the word "Sheen" was not used with reference to the glossiness of the thread. In the "Livron" case, the Registrar expunged registration of the mark "Livron" and his decision was affirmed on appeal. On appeal Crossman, J., thus observed at page 180 : "In my judgment "Livron" is a word whose only signification is geographical, and hence does not contain the essential particulars in Section 9(4)". The cases cited by Mr. Das do not support the view that the word "Rasoi" cannot be held to have direct reference to the character and quality of the goods.

103. Mr. Chaudhury, learned Counsel on behalf of the respondents, referred to certain cases in support of his submission that very little reference to the character of the goods has been considered sufficient to exclude the applicability of the corresponding Section 9(1)(d) of the Indian Act of 1938 or Section 9(4) of the English Act of 1905. Reference was made to the cases of *In Re. Joseph Crossfield & Sons Ltd.*; *In Re. California Fig Syrup & Co.*; *In Re. H. N. Brock & Co.* [(1910) 1 Ch. 301]. The case of *In Re. Joseph Crossfield & Sons Limited* known as "Perfection" case related to an application to register the word "Perfection" as a trade mark in Class 47 for common soap. This was disallowed by the Registrar and the Registrar's decision was affirmed by Swinfen Eady, J. On appeal the judgment was affirmed. Farwell, L.J., observed that "Perfection" was not registrable as adapted to distinguish Crossfield soap and that no amount of user could possibly withdraw the word "Perfection" from its primary and proper meaning in the soap trade and make it mean Crossfield's and that the word being a mere laudatory word, it was idle to call it a trade mark. In the *California Fig Syrup Company's* case, the learned Judge was of opinion that the evidence given of user was not sufficient to give the trader the exclusive right to "California". In *H.N. Brock & Co.'s* case registration was claimed in respect of "Orlwoola". It was held that "Orlwoola" that is, "all wool" cannot be regarded as distinctive. The words are purely descriptive of their nature. In the case of *In Re. Leopold Cassella & Co.* [(1910) 2 Ch. 240] known as the "Diamine" case registration was applied for in respect of the word "Diamine" on the ground that the applicants have been using the word as a trade mark for their dyes for about 20 years. The application was rejected on the ground that the word "Diamine"

was a known chemical term which indicated that the word contained two amine groups. It was held that this fact was sufficient to indicate that registration was applied in respect of goods which contained two amine groups and that the word was descriptive of the character and quality of the goods. In the case of *Keystone Knitting Mills Ltd.'s Application* (45 RPC 421), known as the "Charm" case, the word "Charm" was held to have direct reference to the character and quality of the goods when used in respect of ladies' stockings. The case of *In Re. R. J. Lea Ltd.'s Application* [(1913) 1 Ch. 446] related to registration of the word "Boardmans" in respect of manufactural tobacco. The word "Boardman's" was surname of an individual. The application was rejected by Joyce, J., on the ground that a mere surname of an individual was not adapted to distinguish the goods of the applicant within the meaning of Section 9(5). In appeal the decision of Joyce, J., was affirmed. Reliance was also placed by Mr. Chaudhury on the decision of *In Re. Application by the National Machinery Co.* (58 RPC 128) known as the "Dex" case. The application was for registration of the word "Dex" as a trade mark for bolts and screws including deckbolts. The application was refused by the Assistant Controller on the ground that the word "Dex" was orally indistinguishable from "decks" and that the "decks" was a perfectly well-known English word in common use and was likely to deceive or cause confusion. It was also pointed out that the word "decks" had direct reference to the character and quality of certain bolts under the terms of paragraph (d) of Section 9(1). The decision of the Assistant Controller was affirmed on appeal by the High Court and by the Court of Appeal principally on the ground that the discretion of the Assistant Controller was exercised properly. Mr. Chaudhury also referred me to the decision *In Re Learned advocate Marquise Footwear's Application* [(1946) 2 All ER 497]. The application was for registration of "Oomphies" as footwear for ladies which was allowed by Evershed, J., and the ground suggested was that the word "Oomph" was an American slang for sex appeal and that it had no direct reference to the character and quality of the goods. It was observed that "in approaching a problem of this kind, one has to bear in mind that the Court must consider, as the legislature considered, whether the use of the particular marks 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 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."

104. Reference to cases is not of much help in finding out whether or not a particular word has direct reference to the character and quality of goods unless the decision lays down a principle of construction. The cases merely indicate the length to which the Courts have gone in construing the expression "direct

reference to the character and quality of the goods".

105. My conclusion therefore is that the word "Rasoi" has direct reference to the character and quality of the goods and is not eligible for registration. The answer to question No.1 is therefore in the affirmative.

106. I shall now take up the second question. The second question involves an enquiry as to whether the requirement of distinctiveness attaches to each one of the clauses in Section 6(1) including Section 6(1)(d). Section 6 (1)(e) provides that a trade mark shall not be registered unless it contains or consists of "any other distinctive mark, provided that a name, signature, or any word, other than such as fall within the descriptions in the above clauses, shall not be registrable except upon evidence of its distinctiveness". Sections 6(1) (a) (b) (c) (d) (e) of the Trade Marks Act correspond to paragraphs 1, 2, 3, 4 and 5 of Section 9 of the English Act. In the case of *In the Matter of an Application by Fanfold Ltd.* (45 RPC 325), the question arose whether a mark, in order to be registered under any of the paragraphs of Section 9 of the Trade Marks Act (which corresponds to Section 6 of the Indian Act) must be distinctive. The question was answered in the affirmative. At page 331, Lord Hanworth, M.R., observed as follows:

"Therefore, the plea that is raised by Mr. Shelley that to ask for distinctiveness in paragraph (1) is to ask for something more than the statute requires, because it enables you to use your name in a special or particular manner, is answered by the difficulties which would arise if a plain name was accepted with the slightest possible addition of some particular or special feature to mark it. In my judgment Mr. Justice Tomlin came to a right conclusion upon the meaning of the Section 9. I think it does require that there should be distinctiveness. Paragraph (5) says : "Any other distinctive mark". The use of the word "other" seems to be of importance. The paragraph goes on "but a name, signature or word or words, other than such as fall within the descriptions in the above paragraph (1), (2), (3) and (4) shall not be registrable under the provisions of this paragraph except upon the evidence of its distinctiveness". Finally, after the proviso, which does not apply, the words to be found "for the purposes of this Section" not any particular paragraph or part of a Section - "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons."

107. The Master of the Roll went on to add : "The result of that is this, that in order to be registrable under paragraph (1) you must, first of all, have a name which is represented in a special or particular manner; but (it may be either superadded or interpreting what is meant by "special or particular manner") there must be distinction and that distinction is required so that there may be an indication that the goods on which the mark is put are the goods of the proprietor, and the distinction must be one which is adapted to distinguish those goods of the proprietor for the purpose of enabling the definition of a trade mark to be fulfilled, a definition to which I have already referred".

108. The above observations clearly support the view that distinctiveness must be proved to exist in respect of the clauses (a) to (e) of Section 6(1). It does not appear as S.R.Das Gupta, J., thought, that Lawrence, L.J., pointed out that the above question which was answered in the affirmative by Lord Hanworth, did not arise in that case. Reference to the judgment of Lawrence, L.J., at page 333 would indicate that he merely reserved his opinion on this question. The same view as to the effect of Section 9(5) corresponding to Section 6(1)(e) was taken in the matter of Boota Pure Drug Co. Ltd., Trade Mark "Livron" (54 RPC 161 at 179). In Kerly on Trade Marks at page 105, it is stated that "Although the paragraphs of Section 9(1) are to be considered as independent in each case the mark proposed to be registered must not only fall within the terms of at least one paragraph, but must also be distinctive". The cases above cited have been followed by a Bench of this Court, Harries, C.J., and Chatterjee, J. in their decision in Appeal No.66 of 1947 (B.C.L. Ltd., Appellant v. Bangodaya Cotton Mills Ltd., Respondent) [(unreported) dated the 23rd June, 1949]. It was laid down that "no trade mark can be validly registered unless it contains at least one of the particulars enumerated in Section 6(1) of the Indian Trade Marks Act, 1940, and that to comply with the sub-section the particulars relied on must also be distinctive". My conclusion therefore is that even if the word "Raoi" cannot be said to have such direct reference to the character and quality of the goods within Section 6(1)(d) of the Act, the mark "Rasoi" must still be proved to be distinctive in order to be eligible for registration.

109. Question No.2 is answered accordingly.

110. Question No.3 raises the question whether the word "Rasoi" even if it be held to have a direct reference to the character and quality of the goods and to be distinctive the word "Rasoi" nevertheless be ineligible for registration in view of the fact that it is a common word of the language of which no monopoly should be granted to a particular trader. It is undoubtedly true that the common words of a language are public property and that no one should be allowed to appropriate one of such words to his exclusive use and thereby deprive other persons of the legitimate right to use the said word. This was observed by Fry, L.J., in the case of *In Re. Dunn* [(1889) 6 RPC 379 CA], (Fruit Salt for Banking Powder), and was reiterated by Fletcher Moulton, L.J., in *Joseph Crossfield & Sons Ltd.* [(1910) 1 Ch. 130] and by Cozens-Hardy, M.R., in the same case and by Evershed, J., in *La Marquies Footwear's Application* [(1946) 2 All ER 497]. The above observations are however to be read as not imposing an absolute bar to the registration of a common word as a trade mark. The principles laid down in the above cases would ordinarily disentitle the applicant to have a common word registered. In exceptional circumstances the rule may however be inapplicable, viz., where the common word has lost its primary meaning by long user of the word by a trader in relation to his goods and has become identified with the particular goods of that trader. In such a case the principle above enunciated will not be applicable. In the present case however the word "Rasoi" has not become distinctive of the applicant's goods and as such it is also

ineligible for registration on the ground that no trader can have ordinarily a monopoly of an ordinary word of the language.

111. Question order3 is answered accordingly.

112. Costs will abide the result. Certified for two Counsel.

Solicitors : C. C. Bosu for the Appellant; S. K. Mandal for the Respondent.