

(1971) 08 DEL CK 0003

In the Delhi High Court

Case No : F.A.O. (O.S.) No. 32 of 1968, from judgment of Jagjit Singh J., D/-
11-12-1967

Mohd. Rafiq and Another

APPELLANT

Vs

Modi Sugar Mills Ltd.

RESPONDENT

Date of Decision : 02-08-1971

Acts Referred:

Citation : AIR 1972 Delhi 46 : (1971) ILR Delhi 487

Hon'ble Judges : H.R. Khanna, C.J.;S.N. Shankar, J

Bench : Division Bench

Advocate : D.D. Chawla and Nand Kishore, for the Appellant; N.K. Anand, for the Respondent

Judgement

H.R. Khanna, C.J.—This appeal by Mohd. Rafiq and Mohd. Shafiq is directed against the order of the learned Single Judge whereby an application filed by the appellants against Modi Sugar Mills Ltd., respondent u/s 107 of the Trade and Merchandise Marks Act, 1958 (Act No.43 of 1958) (hereinafter referred to as "the Act") for rectification or register of trade marks was dismissed.

2. The registration of trade mark "SUN" in respect of lanterns and globes for lamps was obtained with effect from May 19, 1954 by Modi Supplies Corporation Limited in the name of Modi Lanterns Works, Modi Nagar. The respondent-company was registered as the subsequent proprietor of that trade mark with effect from May 25, 1956. The registration was renewed for a period of seven years with from May 19, 1961. A suit was instituted on March 31, 1962 by respondent-company against the appellants in the Court of District Judge, Delhi, for permanent in-junction, rendition of accounts and damages on the allegation that the appellants had started manufacturing and selling lanterns under the trade mark "SUNSHINE". It was stated that the manufacture and sale of lanterns under the trade mark "SUNSHINE" constituted infringement of the respondent's well-known trade mark and was an attempt to pass off goods. The mark adopted by the appellants was stated to be a colourable imitation of the respondent's

registered trade mark. The appellants in their written statement in that suit, inter alia took the plea that the trade mark "SUN" could not be registered being not distinctive it was also stated by the appellants that they would initiate proceedings in the High Court for rectification of the register. Application u/s 107 of the Act was thereafter filed by the appellants on September 24, 1963.

3. According to the appellants, they in partnership with a third person had been manufacturing lanterns and lighting appliances under the trade name "SUNSHINE" for more than eleven years and their trade mark became distinctive of the goods of their firm by long usage. The validity of the registration of the trade mark "SUN" was challenged and it was stated that the said trade mark was liable to be taken off the register of trade marks. According to the appellants, the word "SUN" was descriptive of lanterns and lighting goods and could not be registered as a trade mark for such goods. It was added that "this word cannot be distinctive of the goods such as lanterns or other lighting appliances." Some other grounds were also taken but we are not now concerned with them.

4. The respondent-company in its reply stated that the trade mark "SUN" had been validly registered and that the petition for rectification of the register was liable to be dismissed.

5. Following issue was framed in the case:--

"Whether the petitioner is entitled to the relief of rectification as asked for?"

Evidence was thereafter adduced by the parties. The evidence of the respondent indicated that it had been selling "SUN" brand lanterns of about rupees thirty or thirty-five lakhs per year.

6. The learned Single Judge held that the word "SUN" could not be considered to have a reference, much less a direct reference, to the character or quality of the goods in respect of which it was registered as a trade mark. Reference was then made to Section 32 of the Act and it was held that after the expiry of seven years from the date of registration, the original registration of the trade mark had to be taken valid in all respects unless the registration could be cancelled under any of the clauses of the above section. None of the clauses was found to be applicable. In the result the petition was dismissed.

7. Mr. Chawla, learned counsel for the appellants, has not disputed that the period of more than seven years had elapsed from the date of the original registration of the trade mark up to the date when the suit was filed by the respondent-company against the appellants, but, according to him, the case of the appellants was covered by clause (c) of Section 32 of the Act. The section reads as under:--

32. Subject to the provisions of Section 35 and Section 46, in all legal proceedings relating to a trade mark registered in Part A of the register (including applications u/s 56), the original registration of the trade mark shall, after the expiration of seven years from the date of such registration, be taken to

be valid in all respects unless it is proved-- (a) that the original registration was obtained by fraud, or

(b) that the trade mark was registered in contravention of the provisions of Section 11 or offends against the provisions of that section on the date of commencement of the proceedings; or

(c) that the trade mark was not at the commencement of the proceedings distinctive of the goods of the registered proprietor."

It is argued by Mr. Chawla that the trade mark "SUN" was not, at the commencement of the proceedings, distinctive of the goods of the respondent company. It is now well-established that the words "at the commencement of the proceedings" in clause (c) of Section 32 mean the commencement of proceedings in which the question as to the conclusive character of the registration as laid down in Section 32, arises. Such a question may arise in a suit for infringement of the trade mark in which the registered proprietor may rely on Section 32 to prove his title to the registered trade mark as also in rectification proceedings filed as a result of such a suit, and the period of seven years would have to be calculated according to the particular proceedings in which the conclusive nature of the validity of registration is relied upon. See *National Bell Co. V. Metal Goods Mfg Co.* Air 1971 Sc 898

In order to determine whether a trade mark was distinctive of the goods of the registered proprietor, reference may be made to sub-sections (3) and (6) of Section 9 of the Act of the Act which read as under"-

"9. (1) x x x

(2) x x x

(3) For the purposes of this Act, the expression "distinctive" in relation to the goods in respect of which a trade mark is proposed to be registered, means adapted to distinguish 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 either generally, or where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(4) x x x x

(5) In determining whether a trade mark is distinctive or is capable of distinguishing as aforesaid, the tribunal may have regard to the extent to which-

(a) a trade mark is inherently distinctive or is inherently capable of distinguishing as aforesaid; and

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

The opening words of sub-section (3), viz., "For the purposes of this Act" show that the definition of the word "distinctive", as contained in that sub-section, would also hold good for construing the word "distinctive" in C1. (C) of Section 32 of the Act. The most imperative requisite of the word "distinctive", when used in relation to the goods in respect of which a trade mark is registered, is that the trade mark should be "adapted to distinguish" the goods of the proprietor from the goods of other persons. Dealing with the words "adapted to distinguish", Cozens. Hardly M.R. observed In the matter of an Application by Joseph crossfield & Sons Ltd (1909) 26 Rpc 854

"There are some words which are incapable of being so "adapted" such as "good", "best", and "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 and guided by evidence as to the extent to which use has rendered by word distinctive. It is easy to apply this paragraph to geographical words, and it is possible to suggest words having direct reference to character or quality which might be brought within it. But an ordinary laudatory epithet ought to be open to all the world, and is not, in my opinion, capable of being registered. It may be that within a particular area the applicant might succeed in a passing-off action against a trader who used to epithet without sufficiently distinguishing his goods from the goods of the applicant. But that would not justify the Court in giving the applicant a monopoly throughout the United Kindgom in the use of a laudatory epithet."

The court of appeal in that case held that the application to register trade mark "Perfection," should not be allowed, because "Perfection" was a laudatory term. Farewell L.J. in the course of his judgment observed:

"But the whole basis of the enactment is that the word or words to be registered must be distinctive, i.e., adapted to distinguish the goods of the proprietor of the Trade Mark from those of other persons: and this is obviously right and just, for a Trade Mark is necessarily a monopoly, and although it is no doubt proper, and not injurious to any honest man, to allow a trade to monopolise a Trade Mark in certain cases, it would be wrong to allow to any one man a monopoly of ordinary words, commonly used in the trade, and descriptive of the nature of colour, or laudatory, of the quality of the goods: e.g., "cotton", "blue", "good". The question is not merely one between the applicants and the opponents who appear before the tribunal; no agreement between them ought to influence such a tribunal; as Lord Bowen said in Paine and Co.'s Trade Marks L R.(1893) 2 Ch. 567 "The purity of the register of Trade Marks is of much importance to trade in general, quite apart from the merits or demerits of particular litigants, "and it is the duty of the tribunal to see that no word not "adapted to distinguish" shall be put on the Register in the interest of other traders, wholesale and retail, and of the public. If this were not so the large and wealthy firms with whom the smaller folk are unwilling to litigate, could by a system of log-rolling--such as is

suggested by Crossfield and Sons", (1909) 26 Rpc 854 letters in the present case -- divide amongst themselves all the ordinary words of description and laudation in the English language."

8. Relying upon the above observation, Mr. Chawla on behalf of the appellants contends that the word "SUN" when used in respect of lanterns is a laudatory term which has reference to the character or quality of the goods, and as such the word "SUN" could not be the subject-matter of a trade mark for lanterns. Reference in this context has also been made to the case of *Harrisons and Crossfield*, reported in (1900) 18 Rpc 34 In that case the Court held that the word "Nectar" when use in respect of tea, coffee and cocoa, had reference to the character or quality of the goods and was intended to convey to the mind of the person who bought the article that it was impossible to have anything superior in the way of a drink to the said article.

9. No attempt was made at the hearing of the appeal to assail the evidence of the respondent that their annual sale of the lanterns in question was to the tune of rupees thirty or thirty five lakhs. No contention was also raised that the word "SUN" could not be adapted to distinguish articles other than lanterns or lighting appliances, but it was urged that so far as lanterns and lighting appliances were concerned the word "SUN" could not be adapted to distinguish articles other than lanterns or lighting appliances, but it was urged that so far as lanterns and lighting appliances were concerned the word "sun" had a laudatory connotation and as such was inherently incapable of being distinctive of the goods of the registered proprietor.

10. We are unable to accede to the contention that the word "SUN" used in respect of the lanterns manufactured by the respondent is a laudatory term having reference to the character and quality of those lanterns. It is no doubt true that the rays of sun dispel darkness and lanterns too are used for dispelling darkness. It does not follow from that the use of trade mark "SUN" for the lanterns has reference to the character and quality of those lanterns. The reference to the character and quality, in our opinion, should be direct and plain and not remote and far-fetched. Likewise, the word, which is sought to be construed as laudatory, should have obvious signification of praise, and not one out of which an inference of praise has to be spelt out by a laboured process. Sun is the body which is the gravitational centre and source of light and heat to our planetary system. The element of praise is neither self evident in the word "sun" nor can the said word be considered to be descriptive of the character or quality of the lanterns. A contrary view must necessarily result in stretching the connotation of the word "sun" to limits which, in our opinion, are impermissible. We, Therefore, find it difficult to hold that the word "sun" is inherently incapable of being distinctive of the lanterns manufactured by the respondent. In the matter of *the Eastman Photographic Materials Co. Ltd. V. The comptroller-General of Patents, Designs and Trade Marks* 1898 Ac 571, the House of Lords held that the word "Solio" when used in respect of photographic paper was

capable of registration as a trade mark. The contention that the word indicated the character or quality of the goods was repelled.

11. Mr. Anand on behalf of the respondent has pointed out that the present is not a case wherein the "SUN" is sought to be registered as a trade mark for the first time. On the contrary the above trade mark has been on the register for a long time. The appellants, it is submitted, seek to get the trade mark removed from the register. The approach in such a case, according to Mr. Anand, has to be different from that in a case wherein the word in question is sought to be registered as trade mark for the first time. Reference in this context is made to the following observations on page 225 In the matter of *Borroughs Wellcome and Co.'s Trade Marks and In the matter of the Patents Designs and Trade Marks Acts. 1883 to 1888 (1904) 21 Rpc 217*:

"the court when it has had to deal with a question of fact of this sort, long after the date of the registration, has laid down a rule that in such a case the presumption ought to be in favor of the persons who have had that registered Trade Mark for a length of time and the onus of proof as to what was the user of the word, and what it was understood as conveying at the date of registration, ought to be thrown upon the persons who seek, after such a lapse of time, to save that the Trade Mark ought not to have been registered. But I should be very sorry if it was supposed from what I am saying that I in any way mean to suggest that this sort of presumption in favor of the Trade Mark, which has been registered for such a long period, ought to be allowed to overmaster the plain evidence showing that the Trade Mark having regard to the state of things at the date of the registration ought not to have been registered. I take it, if you had something registered as a Trade Mark, which the evidence showed clearly ought not to have been registered at the date when it was, that no presumption would justify us in keeping such a Trade Mark on the Register."

It is, in our opinion, not necessary to dilate upon this aspect of the matter beyond saying that advantages accrue to the proprietor of the trade mark upon its registration especially after passage of seven years. According to Section 31 of the Act, registration of trade mark is to be prima facie evidence of its validity. Section 32 of the Act, which has been reproduced above, confers validity upon the original registration of the trade mark after the expiration of seven years from the date of such registration except in cases covered by the clauses of that section. The appellants in the present appeal have attempted to bring their case within the purview of clause (c) of Section 32, but their attempt in this respect has not been successful.

12. The result is that the appeal fails and is dismissed, but with no order as to costs.

13. Appeal dismissed.