

(1977) 04 MAD CK 0054

In the Madras High Court

Case No : Appeal against Order No. 367 of 1976 in C.M.P. No. 2948 of 1977

Nestle's Products (India) Ltd.

APPELLANT

Vs

P. Thankaraja and Another

RESPONDENT

Date of Decision : 29-04-1977

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 109, 18, 9, 9(1)

Citation : AIR 1978 Mad 336 : (1978) 1 MLJ 417

Hon'ble Judges : Balasubrahmanyam, J

Bench : Single Bench

Advocate : P.K. Kurian, for King and Partidge, for the Appellant; M.A. Rajagopalan, for the Respondent

Final Decision : Allowed

Judgement

Balasubrahmanyam, J.—In this appeal u/s 109 of the Trade and Merchandise Marks Act, 1958, M/s. Nestle's Products (India) Limited object to the grant of registration to the trade mark "INSTEAL" in favour of M/s. Alvitone Laboratories. Alvitone applied for registration of this trade mark under item No. 3 of the Fourth Schedule to the Trade Mark Rules 1959 which, inter alia, included "tea". The application was made on the footing that the trade mark was "proposed to be used" by Alvitone. The Assistant Registrar accepted Alvitone's application and granted registration to "INSTEAL" (word per se) under Part A of the Register.

2. Nestles filed an opposition before the Assistant Registrar objecting to the grant of registration to Alvitone's trade mark. Nestles contended that "INSTEAL" was not an invented word. According to them, it was easily recognizable as a portmanteau word to denote "instant tea", an expression descriptive of the character of the commodity in ordinary trade parlance. To grant registration for that word-mark in Alvitone's favour would, according to Nestles, tend to give monopoly advantages to Alvitone and rob others in the same line of trade of their right to employ the very same descriptive expression to denote their products. In support of their contentions. Nestles filed a number of affidavits from third

parties who stated that Alvitone's trade mark immediately conveyed to them the suggestion that it related to Instant tea.

3. The Assistant Registrar rejected all the grounds of objection put forward by Nestles. He held that "INSTEA" was eminently qualified for registration in Part-A of the Register u/s 9(1)(c) of the Trade and Merchandise Marks Act, 1958. He was of the view that it was an invented word. He relied on parallel cases in the books in which registration was granted to trade marks involving words similarly couched. He refuted the contention put forward by Nestles that the word INSTEA would not (sic) tend to embarrass either the trade in tea or the public which consumed it. He rejected the affidavits obtained by Nestles from third parties. He remarked that they were all in stereotyped form and came from the English educated elite who formed only a minority of tea drinkers. According to the Assistant Registrar, the mass of the people who consumed tea in the country were uneducated and they would not gain the impression that INSTEA stood for instant tea--an impression which could only be formed by an intelligent process of subjecting the word to fragmentation.

4. Mr. Kurian appearing for Nestle's in this appeal submitted that the Assistant Registrar's reasonings and findings were untenable. He said that the Assistant Registrar had not properly instructed himself in the law before proceeding to decide the question of registration in this case.

5. In the first place, Mr. Kurian submitted that "INSTEA" is a combination of two concepts, "instant" and "tea". The expression was not an invented word in the true sense. It was quite a commonplace portmanteau word, obtained by clipping the latter part of the expression "instant" and joining what was left of it to the other expression "tea". Learned counsel pointed out that "INSTEA" must suggest to everyone the idea of "instant tea". He explained that the word "instant", when used as an adjective, referred to anything which is made immediately soluble in water such, for instance, instant coffee, instant tea etc. According to him, instant tea which is the idea conveyed by the expression INSTEA, was a common trade description familiar to traders and consumers. The impression which this word created in the people's minds might tend to confuse them if the trade mark were used indiscriminately for all types of tea, such as green tea, blended tea, tea dust and instant tea. On the other hand, it may also deceive them if it was used for non-instant tea of every kind.

6. These submissions of Mr. Kurian were, however, vigorously countered by Mr. M. A. Rajagopalan, appearing for Alvitone Laboratories. He said that "INSTEA" was quite an invented word within the meaning of the statute. He accepted that the expression was capable of being sundered, with INS on the one side and TEA on the other. But he maintained that the word "INS" was by no means a conventional abbreviation of the expression "instant" or "instantaneous". He said that the abbreviation "ins" must mean many things to many men. It may mean "Insurance" or "Insured parcel". Quoting Webster, he gave further examples of what "ins" might stand for. He referred to "inscribed"; "inside"; "inspected";

"inspector"; "insular" etc. To this list, learned counsel added his own contribution, "insolvent". According to him, the usual and well-accepted shortened form for "instant" was not "his", but "inst". If Alvitone really intended its trade mark to denote instant tea, the word, according to Mr. Rajagopalan, would have been "INST TEA" and not "INSTEA". He also hazarded the argument, addressed apparently for the first time in this appeal, that the portmanteau word "INSTEA" might well be regarded as a misspelling of the expression "INNS TEA", meaning thereby "tea served at inns". Another argument inspired by the word combination and addressed by learned counsel, again, for the first time before me, was to the effect that INSTEA stood for "Alvins tea", Sans the first three letters, "Alv".

7. In the course of their respective arguments, learned counsel on both sides cited, and made me read through, several reported cases both Indian and foreign on the question of what an "invented word" is. In every one of those decisions, as I had occasion to observe, the discussion of this conception was clearly directed to the particular trade mark in question before the court at the moment. I found it difficult to draw from them any synthesis of principle. Nor could I regard any of those cases as affording a parallel for the decision in this case. Nevertheless, a study of the law reports did help me form a clear idea in my own mind of the requirements of Section 9(1)(c) of our Trade and Merchandise Marks Act in relation to invented words.

8. Section 9(1)(c) enacts that a trade mark shall not be registered in art-A unless It contains one or more invented words. The Act provides no definition for what an "invented word" is. But this omission is compensated for by the discussion we find in one or two leading decisions. The view most often quoted in this connection is that of the House of Lords in the celebrated "Solio Case" *The Eastman Photographic Materials Company Limited v. The Comptroller General of Patents, Designs, and Trademarks*, (1898) AC 571. I quote the following observations of Lord Shand and Lord Herschell as laying down the proper guideline and approach as under;--

Lord Shand: "I agree with your Lordships, and particularly with what has been said by my noble and learned friend Lord Macnaghten, in thinking, that the Comptroller-General will be fully warranted in taking care that there shall not be admitted, under the guise or cover of words called "invented" by the applicant, words really in ordinary use, which might, in a disguised form, have reference to the character or quality of the goods. There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required; but the words, I think, should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two known words, would not be an invented word; and a word would not be "invented" which with some trifling addition or very trifling variation, still leaves the word one which is well known or in ordinary use, and

which would be quite understood as intended to convey the meaning of such a word."

Lord Herschell:-- "I do not think that the combination of two English words is an invented word, even although the combination may not have been in use before; nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form."

9. Parker, J., in a subsequent case called the Diabolo Case, *Phillippart v. William Whiteley Limited* (1908) 2 Ch 274, put the matter neatly in the following passage:--

"To be an invented word within the meaning of the Act a word must not only be newly coined, in the sense of not being already current in the English language, but must be such as not to convey any meaning, or, at any rate, any obvious meaning, to ordinary Englishmen. It must be a word having no meaning or no obvious meaning until one has been assigned to it. I use the expression "obvious meaning" and refer to "ordinary Englishmen" because, to prevent a newly-coined word from being an invented word, it is not enough that it might suggest some meaning to a few scholars."

10. The two English cases, from which I have quoted, have been adopted by courts in our country for construing the expression "invented word" occurring in Section 9(1)(c) of our Trade and Merchandise Marks Act. In *F. Hoffmann-la Roche and Co. Ltd. Vs. Geoffrey Manner and Co. Pvt. Ltd.*, , the question arose before the Supreme Court as to whether "Dropovit" was or was not an invented word within the meaning of Section 9(1)(c) of the Act. In discussing the subject, the Supreme Court adopted the views expressed by Parker, J., in the Diabolo Case (1908) 2 Ch 274. The Supreme Court referred, in passing, to the observation of Lord Radcliffe in *De Cordova v. Vick Chemical Coy.*, (1951) 68 RPC 103 in which the noble Lord described the interpretation of Parker, J., as "the best standing definition of an invented word."

11. These decisions show that to be an invented word an expression must not only have been newly-coined; it must, standing by itself, convey no sense or meaning. It is, in any case, essential that the word must not give any inkling as to the type of goods to which the word relates, whether apparently or in a disguised form. The invention may be in the adoption of a foreign word; it may consist in an abbreviation; it may be an anagram; it may be formed out of a combination of two or more words, as they are, or in any clipped or altered form; it may introduce one or two meaningless syllables or letters in between words. Whatever be the mode of contrivance, if to the eye or to the ear the resultant expression conveys the same idea as would be conveyed by any recognizable expression in the common vocabulary, then the word would not be regarded by the trade mark law as an invented word. In short, an invented word must be different from any word in common speech, and the difference must be

substantial and not skin-deep, merely. In judging whether a word is invented or not, in the sense aforesaid, the Registrar and the court must take in the word as a whole in order to form a totality of impression both of sight and of sound. Too minute an analysis of the word and its components can easily lead us astray, get the subject out of focus and reduce the inquiry to a mere word-game or spelling-bee an exercise which can have little or no relevance to the purpose of statutory registration of trade marks. For gaining a correct impression about the trade mark as an invented word it is, I think permissible for the Registrar as well as the court to rely on every material that is available to them, having relevance to the inquiry. It, however, seems to me that the matter will not get decided satisfactorily by merely consulting the dictionaries or drawing upon other people's reactions. It is essentially and ultimately for the court to form a right impression about, bringing to bear its experience of life and language and trusting to its faculty of judgment.

12. As earlier mentioned, Nestles has brought on the record of this case a number of affidavits sworn to by individuals who are said to represent a cross-section of the public. All of them, to a man have sworn that "INSTEAD" at once brought to their mind the idea of instant tea. I do not think there is any reason to disbelieve their statements. The Assistant Registrar rejected the affidavits for another reason; he remarked that all of them said the same thing in the same words. He characterized the affidavits as stereotyped. I do not, however, think this criticism, repeated before me by learned counsel for Alvitone, is to the point. The affidavits were quite obviously intended as so many samples of broad public reaction on the subject of the trade mark under inquiry. It was, accordingly, quite in keeping with this function that they should all have adopted some kind of pro forma language. In this sense I feel that they could not help being stereotyped. Indeed, they might have sounded quite artificial if each of them had striven for individuality of style.

13. Another contention put forward before me on these affidavits is that they do not constitute legal evidence and are not worth consideration. This objection, again, is based on a view of the trade mark law which, in my opinion, is not quite well-informed. The Trade Marks Act confers jurisdiction on the Registrar and the court to render their determination in respect of various matters arising in proceedings taken under it. Registration of trade marks is one; action for infringement of trade marks is another; and so on. Cases in the books show that these proceedings have not to follow, as their model, the procedure prescribed for trial of suits before the law courts. Even in actions for infringement, where there is clearly a lis between adversaries which the court having jurisdiction has to adjudicate upon, decided authorities show that the evidence of witnesses can play only a subordinate role in the formation of the court's final determination. For instance, a question that often arises in infringement cases is, whether a trade mark possesses deceptive similarity to a registered trade mark. There are high precedents for the view that the court is not to be swayed by the testimony of witnesses for deciding whether the trade mark under dispute is deceptively

similar. It is said that the court should not surrender its prerogative and yield it to the opinions of witnesses. As has been observed, the real function of evidence of witnesses in such cases is to act as so many pieces of information which the court may usefully refer to, for enabling it to arrive at the right conclusion. This position, which obtains in infringement proceedings, must equally apply, in my opinion, to proceedings for registration of trade marks. Affidavits are receivable in such inquiries not so much as evidence of what they speak about, but as providing information which may be found useful and relevant for rendering the court's determination. In this view, the Evidence Act does not come into the discussion at all.

14. Mr. Bajagopalan characterized the affidavits as mere opinion evidence. I do not think this is quite an apt description, for they record the deponents' mental reactions to the trade mark, which are essentially to be regarded as states of mind. It is wise law that states of mind are states of facts, and, as facts, they are provable by evidence. Even otherwise, their relevance in the context of the inquiry before the Registrar and the court cannot be gainsaid. All that can be urged is that the affidavits are not to be regarded as the last word on the subject of whether INSTEA or any other word-mark is an invented word.

15. Mr. Rajagopalan urged one last argument on the subject of the affidavits. He said that they have all been obtained from persons knowing the English language. Their impressions about an invented word in that language cannot, it was urged, truly reflect the common reactions of ordinary men and women who gather around tea-shops, people who do not know English and whose reflexes are not English-oriented. I must say that this argument, if accepted, would shake the very linguistic foundations of our legal system. Whether we like it or not, English in our country is the language of the law. The Trade and Merchandise Marks Act is in English. The business of the Trade Marks Registry is transacted in English. The court expresses itself in English. And so on and so forth. In this milieu, I cannot see how the fact that English is not the language of the people can be accepted as a sound argument for rejecting the affidavits.

16. I do not, therefore, reject the affidavits as of no importance. At the same time, I do not completely rely on them either. For I have to address the crucial questions to myself in order to get the right answers. When the arguments opened and when, for the first time, I came across the expression "INSTEAL", my first impression was that the word had something to do with tea and had something to do with instant. This first impression, I must confess, has outlasted all the learned arguments and explanations I happened to listen to subsequently in the course of the hearing of the appeal. It seemed to me that this is a fine example of a telescoped expression such as we find in "artificial silk", "Comintern" for communist international, and "Consemply" as a newspaper equivalent of constituent assembly. One instantly assimilates these word-combinations and knows them for what they stand for even where they drop some vowels and consonants in between. It is the association of ideas that the

word produces and which the inventor of the word aims at producing. I do not minimise the resourcefulness of the person who hit upon the expression INSTEA, but I have hardly any doubt about what he was driving at. The two words out of which he fashioned his invention are quite ordinary words, and their connotations, both in the market place as well as in the kitchen, are unmistakable. They denote the particular kind of ready-made tea, which is so much ready-made that people can make a drink out of it in jiffy. In my opinion, there can be no mistaking about the character of the goods which is denoted by the expression "INSTEA" which is a condensation of the expression "instant tea."

17. The paramount consideration in a matter of this kind is not open to discussion. Whenever a trade mark offered for registration is claimed to be an invented word, registration of it can only be allowed if that word does not have the tendency to monopolise a part of the general vocabulary of the trade or restrict the use of words which traders in the line or elsewhere would be likely to need to describe their own goods. From this point of view, it seems to me that "INSTEA" has the tendency to monopolise all manufactured tea which goes by the generic description of "instant tea" or "instantaneous tea". To grant registration to this word-mark, would therefore make Alvitone as its owner a monopolist of a part of the ordinary vocabulary in which traders transact business with themselves and their customers.

18. Alvitone had claimed before the Assistant Registrar that it was not associating the mark "INSTEA" purely with reference to instant tea, but it wished to avail it for all kinds of tea and tea preparations. This was accepted by the Assistant Registrar. Mr. Kurian, learned counsel for Nestles, however, controverted this claim of Alvitone by reference to how that concern had since set about the job. Mr. Kurian sought to place before me an advertisement put forth by Alvitone and published in "The Times of India" bearing the date 29-5-1976. The advertisement appeared after the grant of registration by the Assistant Registrar. The advertisement copy announced "INSTEA" as the first Indian instant soluble tea from the "House of Alvitone". To this declaration was appended a catch-phrase or slogan: "Instead -- The incredible instant tea." Learned counsel for Nestle's filed an application in C.M.P. No. 2948 of 1977, in this regard requesting me to take in this advertisement as additional evidence in the appeal. The application was resisted by the learned counsel for the Alvitone. He said that, the advertisement, occurring, as it did, after the grant of registration after full inquiry, should not be admitted in evidence at this stage. I am not able to sustain this objection to reception of this evidence. The rationale behind the provision giving the appellate court a discretion in the matter of allowing additional evidence at the stage of the appeal is that such evidence was not available at the time of trial in the court of first instance. Admittedly, this advertisement was not there at the time when the Assistant Registrar had conducted the inquiry. In any case, the law allows an appellate court to take note of subsequent events, especially when the appellate court is convinced that such evidence is not only pertinent to the case, but will aid the decision in the appeal.

I, accordingly allow C.M.P. No. 2948 of 1977.

19. The advertisement itself, is in my view, a clear demonstration of the earlier apprehension voiced by Nestles that "INSTEA" stands for instant tea. In the context of this advertisement, the original claim of Alvitone that the trade mark was asked for not merely for "instant tea" but also for other varieties of tea, such as, "green tea", or "black tea", etc., must lose its validity. Besides, in so far as the expression "INSTEA" is Intended to refer to tea other than, "instant tea", Alvitone must face the further criticism that, if so used, it is likely to mislead people into thinking that what is offered under this trade mark is, "instant tea" and not any other kind of tea.

20. As to the last proposition, Mr. Rajagopalan argued, as I have already mentioned, that this point had not been taken before the Assistant Registrar and even in the grounds of appeal. The argument is really based on Section 11 which, it was pointed out, did not figure in the discussion before the Assistant Registrar. Mr. Kurien, however, referred to the counter statement filed by his client before the Assistant Registrar. In para 4 of that statement or notice of opposition, Nestle's Products said that the granting of monopoly rights to the mark, "INSTEA" will embarrass the trade and the public in using the expression "instant tea". In the enquiry before the Registrar, it seems to have been argued that "instea" is not adopted to distinguish the applicant's goods, as the word will be purely descriptive in respect of "instant tea" while it will be deceptive in respect of any other tea. The contentions aforesaid are found narrated in the order of the Assistant Registrar, although he rejected them as untenable. Mr. Kurien submits that all that the pleadings and arguments before the Assistant Registrar lacked was a specific reference to Section 11. This provision enacts that "a mark the use of which would be likely to deceive or cause confusion shall not be registered as a trade mark." It is the contention of Mr. Kurien that "INSTEA" is likely to deceive or cause confusion if it is used for tea other than, "instant tea". It is also likely to cause confusion if the same expression "INSTEA" were to be used for all kinds of manufactured tea whether green tea or black tea or dust tea or instant tea

21. I do not propose to resolve this preliminary controversy between the parties on the contention based on Section 11. The applicant may or may not have raised this plea in the first instance before the Assistant Registrar. In either case, there is scope for allowing the matter to be argued purely as a question of law on the basis of the materials on record. I, however, do not propose to enter into the discussion to find out how far Section 11 can apply, in the view I have earlier taken as to the failure of the expression "INSTEA" to satisfy the test) of its being an invented word u/s 9(1)(c) of the Act.

22. The result is that I allow the appeal and set aside the order of the Assistant Registrar granting registration. There will, however, be no order as to costs.