

(1964) 01 MAD CK 0006

In the Madras High Court

Case No : Appeal Against Order No. 282 of 1961

P.S.K.V. Raghavan

APPELLANT

Vs

G. Rajagopala Pillai and Another

RESPONDENT

Date of Decision : 29-01-1964

Acts Referred:

General Clauses Act, 1897 — Section 6
Merchandise Marks Act, 1889 — Section 107, 136, 136(4), 56, 9
Trade and Merchandise Marks Act, 1958 — Section 6

Citation : (1964) ILR (Mad) 963

Hon'ble Judges : Venkatadri, J

Bench : Single Bench

Advocate : G. Ramaswami and S.M. Subramaniam, for the Appellant; T. Ramaprasadarao, for John and Row and S.K. Damodram, for the Respondent

Final Decision : Allowed

Judgement

Venkatadri, J.—This appeal arises out of an application filed by the Appellant under the Trade Marks Act for rectification of the register

either by removing the trade mark No. 164933 or by deleting from the said mark the words Thennamarakkudi oil. The Assistant Registrar of

Trade Marks refused to rectify the register and dismissed the application. It is against this order the present appeal is filed.

2. The facts that are necessary for the disposal of the appeal are the following. The Appellant's father Santhanakrishna Naidu started as early as in

1918, a business in the manufacture and sale of a medicinal oil preparation for curing sprains and fracture under the name and style of E. S.

Krishna and Company. In order to distinguish the goods of other merchants, the Appellant's father adopted in the same year a device of which the

word Thennamarakkudi forms an essential part. Ever since that year the

Appellant's father and after his death the Appellant have been continuously using the said mark on the tins of medicinal oil prepared and sold by them. The mark adopted by them for their goods was Original Photomark Thennamarakkudi Oil. This mark has become popular in the market and has been associated in the minds of the public with the goods manufactured and sold by the Appellant and his father. This mark was registered as early as in 1943, and a certificate of registration was issued on 4th March 1949, after the said mark was advertised in the Trade Marks Journal, dated 1st August 1948. The Appellant's father died in 1950 and after his death the Appellant has been continuing the business as sole proprietor.

3. In the beginning of October 1952, the Appellant came to understand that one G. R. Gopal, a partner of the Respondents, had been infringing his trade mark and he issued a notice through his Advocate R. Thambayya Naidu on 7th October 1952, apprising the said C. R. Gopal about the prior user by his father and about the registration of the same. The Respondent promised in his reply, dated 13th October 1952, through his advocate that he would take steps to effect changes in his mark. But he did not do so. On the other hand, in the year 1954 he registered his medicinal preparation as Original Photo Thennamarakkudi Oil. Hence the Appellant filed an application for rectification of the register as aforesaid on the ground that the mark containing the word Thennamarakkudi Oil registered by the Respondents is a clear infringement of his mark and is likely to cause deception and confusion in the mind of the public.

4. The application was resisted by the Respondents who contended in their counter statement that Thennamarakkudi is a village in Nannilam taluk in Tanjore district where a family of native physicians began to manufacture medicinal oil and sell it to the public over half a century ago and their preparation takes its name from the village and, therefore, it cannot denote the goods of any person, that several merchants of Thennamarakkudi, Mannargudi, Mayuram, Kumbakonam and other places in Tanjore district have been selling oil bearing the words Thennamarakkudi and that the distinctive feature of the mark of the Appellant is not Thennamarakkudi

5. The Assistant Registrar of Trade Marks disposed of the application under the provisions of the new Act. Learned Counsel for the Appellant raised preliminary objection that the Assistant Registrar of Trade Marks adopted

a wrong procedure in deciding the case under the new Trade and Merchandise Marks Act, 1958. Before considering the appeal on the merits, it is necessary for me to consider whether this case has to be decided under the Old Trade Marks Act or under the new Trade and Merchandise Marks Act, 1958, which came into force on 25th November 1959.

Mr. G. Ramaswami, learned Counsel for the Appellant, contended before me that the Trade and Merchandise Marks Act, 1958, is not retrospective in operation and will not apply to pending proceedings for rectification of the register, as Sub-Section 4 of Section 136 specifically provides that any legal proceeding pending in any Court at the commencement of that Act may be continued in that Court as if that Act had not been passed. Section 136 is the repeal and saving section. That section repeals the Indian Merchandise Marks Act, 1889, and the Trade Marks Act, 1949. The effect of a repeal is stated in Section 6 of the General Clauses Act. Section 6(c) of that Act provides that the repeal of an Act will not affect any right, privilege, obligation, or liability acquired, accrued or incurred under any enactment so repealed.

Section 6(c) says that the repeal of an Act will not affect any investigation, legal proceeding or remedy in respect of any such right, privilege, obligation, liability...as aforesaid.

Now Mr. G. Ramaswami contends that a combined reading of Section 6 of the General Clauses Act and Sub-Section 4 of Section 136 would show that the Appellant's application for rectification should be disposed of only under the provisions of the old Act and not under the new Act.

But the learned Counsel for Respondents met this argument by pointing out that Sub-Section 4 of Section 136 only says that any legal proceeding pending in any Court will not be affected by the provisions of the new Act, and that the application for rectification could not by any stretch of imagination be considered to be a legal proceedings pending in any Court. Section 107 of the new Act provides that an application for rectification of the register can be made only to the High Court in certain cases specified in that section. u/s 56 an aggrieved person has got an option to file an application for rectification or correction of the register either before the Registrar of Trade

Marks or to the High Court in a prescribed manner. The Appellant preferred to file an application before the Registrar of Trade Marks and not in the High Court. Learned Counsel for the Respondent contend that the application filed before the Registrar cannot be deemed to be a legal proceeding in any Court within the meaning of Sub-Section 4 of Section 136. Admittedly, the Assistant Registrar of Trade Marks passed an order u/s 56 of Act XLIII of 1958, and against that order an appeal lies to the High Court. I do not think that any prejudice has been caused to the Appellant by the Assistant Registrar resorting to the provisions of the new Act when disposing of the application. The learned Counsel for the Appellant was not able to show how his client would be benefited by the disposal of the application under the provision of the old Act. I am unable to see any substance in his contention and I reject it.

6. It is common case that the word Thennamarakkudi is the name of a village in Mayuram taluk, Tanjore district. Section 9(d) of the new Act

states that a trade mark containing a geographical name or a surname or a personal name shall not be registered in Part A of the Registrar. But u/s

9(2) the word Thennamarakkudi can become eligible for registration if there is evidence of its distinctiveness, that is, if the distinctive character of

the goods is proved. In Corpus Juris Secundum, volume LXXXVII, Article 43, which deals with geographical and place names, states:

Geographical terms and words in common use to designate a locality, a country, or a section of a country cannot be monopolised as trade marks,

but a geographical name not need in a geographical sense to denote place of origin but used in an arbitrary or fanciful way to indicate origin or

ownership regardless of location may be sustained as a valid trade mark.

7. It is also common case that the word Thennamarakkudi is not only used by the Appellant but also by several merchants of Thennamarakkudi,

Mannargudi, Mayuram, Kumbakonam and other places in the Tanjore district. Thennamarakkudi oil is a medicinal oil preparation which takes its

name from the village Thennamarakkudi in Nanniam taluk in Tanjore district, where, a family of native physicians began to manufacture this

medicinal oil and sell it to the public for more than half a century. Therefore, the word Thennamarakkudi cannot connote or denote the goods of

any particular manufacturer much less the Appellant. The Assistant Registrar of

Trade Marks has pointed out that the Appellant has not adduced any evidence of distinctiveness as postulated u/s 9(2) to bring the word Thennamarakkudi within the ambit of Section 9(1)(e). He has also observed that there was no evidence to show that there was a quality in the word Thennamarakkudi which ear-marked the Appellant's goods as distinct from those of other producers of such goods. The Appellant hence failed to get a monopoly to the word in question and in the absence of a monopoly, he cannot prevent other traders from using that word. It may be stated here that in a litigation between the Appellant and his brother with regard to the use of this word by the latter, the Appellant entered into a compromise in and by which he agreed to the use of the words Thennamarakkudi oil by his brother. This would show that he did not claim any exclusive right to the use of that expression.

8. It is also admitted by the Appellants Counsel that there is no similarity between his client's mark and the mark of the Respondents and the marks are not deceptively similar. But the learned Counsel seriously contends that since the client's mark has been registered without a disclaimer of the right to the exclusive use of the word Thennamarakkudi, his client has secured an absolute monopoly to the use of the word and that no mark containing the word Thennamarakkudi could go on, on the register. It is true that the Respondents did not put in any objection when the Appellant's trade mark was originally registered. But it is equally true that when the Respondents registered their mark two years ago, the Appellant also did not raise any objection at that time. It is; only now that the Appellant has filed this application for rectification of the register. The mere absence of a disclaimer does not ipso facto give Appellant an exclusive right to the use of each and every non-distinctive feature in the mark.

The Appellant has used not only the words Thennamarakudi oil, but has used several other words and the whole label containing the words Thennamarakkudi oil with other features should be taken into consideration. As pointed out by Lord Esher in *Pinto v. Badman* 8 R.P.C. 181, 191.

The truth is that the label does not consist of each particular part of it, but consists of the combination of them all.

In *The Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd.*, the Supreme Court has observed that

...where a distinctive label is registered as a whole, such registration can-lies possibly give any exclusive statutory right to the proprietor of the trade

mark to the use of any particular word or name contained therein apart from the mark as a whole.

9. The Appellant not having established that the word Thennamarakkudi was used to distinguish his goods from those of other traders cannot claim

that that word should not be used by any other person.

10. In Appeal Suit Nos. 560 and 561 of 1956, Ramachandra Ayyar, J., (as he then was) while dealing with a similar question observed that:

the registration as a trade mark of a geographical name is not absolutely prohibited as it would be if Section 6(d) (of the old Act) had remained

alone. By virtue of Section 6(e) (also of the old Act) a geographical name like any other name, if distinctive, could be registered in relation to

goods of a manufacturer.

11. It has been held in a number of cases that a geographical name adopted as a distinctive mark and without its conveying any item of

geographical origin or association would come within Clause (e) of Section 9(1) and may be registrable if the Registrar is satisfied of its

distinctiveness. For example, a food article named Everest dish or a hair cream called Himalayan Snow is certainly distinctive and there can be no

valid objection to its registrability.

12. Further where the Registrar has exercised the discretion in favour of a person that fact ought considerably to weigh with the Court, and

...the appellate Court ordinarily should be loath to interfere with that discretion. Ciba Ltd. Vs. M. Ramalingam and S. Subramaniam trading in the

name of South Indian Manufacturing Co. and Another,

13. The Appellant cannot claim any absolute monopoly to the use of the word Thennamarakkudi. As stated above, several merchants in Tanjore

district are manufacturing the medicinal oil preparation called Thennamarakkudi oil and the preparation itself takes its name from the village

Thennamarakkudi in Nannilam taluk.

14. I am of opinion that the application of the Appellant for a rectification of the Register was rightly refused by the Assistant Registrar of Trade

Marks. The appeal is accordingly dismissed, but in the circumstances without costs.