
(1980) 03 DEL CK 0012

In the Delhi High Court

Case No : Original Appeal No. 2 of 1976

Registrar of Trade Marks

APPELLANT

Vs

Hamdard National Foundation (India)

RESPONDENT

Date of Decision : 04-03-1980

Acts Referred:

Citation : AIR 1980 Delhi 180 : (1980) 17 DLT 521 : (1980) RLR 514

Hon'ble Judges : S.N. Kumar, J;Rajinder Sachar, J

Bench : Division Bench

Advocate : Arun Kumar, N.K. Anand and Praveen Kumar, for the Appellant;

Judgement

Rajindar Sachar, J.

(1) At the end of argument we announced the dismissal of the appeal. We now proceed to give our reasons for the same. This is an appeal against the order of the learned single judge by which he set aside the order of the Registrar of Trade Marks and allowed the application of the respondent to have their trade mark consisting of the word (SAFI) registered in Class 5 in Schedule IV in respect of medicinal preparation under the Trade and Merchandise Marks Act, 1958 (to be called the Act). The respondents are well known manufacturers of medicinal preparations amongst others of "SAFI" a preparation meant for purification of blood

(2) Section 6 of the Act requires the maintenance of a Register of Trade Mark wherein shall be entered all registered Trade Marks. Section 7 of the Act says that the register shall be divided in two parts called respectively part "A" and part "B". Section 8 of the Act provides that the trade mark may be registered in respect of any or all of the goods comprised in a prescribed Class of goods. The Trade and Merchandise Marks Rule 1959 have been framed under the Act. Rule 22 provides that for the purpose of registration of the trade mark goods shall be classified in Fourth Schedule. The Fourth Schedule in classification of goods item 5 amongst others, mentions pharmaceutical. Medicinal preparation admittedly falls

under this class.

(3) The respondents applied for registration of the trade mark consisting of the word "SAFI". Though, originally the application was made for registration in part "A", but as later on it was modified and registration was sought in part "B" only. We are only concerned with the eligibility for registration in part "B" of the Register. The Registrar of Trade Mark, however, refused it on the ground that "SAFI" was a descriptive word having direct reference to the character and quality of the goods and is not inherently capable of distinguishing the applicant's goods within the meaning of Section 9 of the Act. In appeal by the respondent the learned single judge, however, took a different view and held that the word "SAFI" cannot be held to be descriptive of the quality or the character of the goods of the respondent and on that finding he granted to the respondent trade mark to be registered in part "B" of the register. The Registrar of Trade Mark being aggrieved has come up in appeal.

(4) Section 9(1) lays down the requisites for registration in Parts "A" and "B" of the register and by Clause D provides that a trade mark shall not be registered in Part "A" of the register unless it contains or consists of at least one or more words having no direct reference to the character or quality of the goods. Thus, this is a negative mandate which means that no trade mark will be registered in Part "A" of the register if it contains a direct reference to the character or quality of the goods. Though the trade mark was sought to be got registered in Part "B", the discussion before the learned single judge seems to have proceeded as if the trade mark was being sought to be registered in Part "A" of the Register. The learned judge, therefore, only considered whether the word was descriptive of quality of goods and having found that the word "SAFI" was not understood in common use and in its ordinary meaning as meaning "pure, clear, fine," naturally found no hurdle in respondent's getting registration.

(5) As before the learned judge, Mr. Anand, the learned counsel for the respondent also tried to convince us to hold that the word "SAFI" is an unusual word, totally unknown in the common parlance and has no direct reference to the character or quality of the goods of the respondent. Though the learned judge ultimately held that the word "SAFI" is not descriptive, yet he did say that prima facie it could be urged that the word "SAFI" is descriptive in character. That the word "SAFI" in dictionaries is defined as "pure, fine, clear" cannot be disputed. There is also equally no doubt that it is not the only meaning of the word "SAFI" and as it was even noticed by the Registrar the word "SAFI" also means cloth which is used for straining beverages and medicines. Mr. Anand) the learned counsel for the respondent has shown us extracts from a number of dictionaries which show "SAFI" to mean a small cloth meant for cleaning hand, one dictionary gives its meaning as duster. The learned judge apparently because of the various meanings attributed to the word "SAFI" was not satisfied that this word in common parlance means only a pure and clear and thus the word "SAFI" cannot be held descriptive of the quality of the goods of the trader. Now, even Mr. Anand

did not dispute that if the word used was "SAFAI" or "SAF" which also means pure, "clear", he could not dispute that these words would have direct reference to the character and quality of the goods of the respondent. In that sense it would immediately come within the prohibition of Section 9(1)(d). He, however, maintained that the word "SAFI" though resembling to the word "SAFAI" and "SAF" still is so unusual that it cannot be said to be descriptive. Frankly, we are not very sure that it can be straight way accepted that the word "SAFI" is so unusual and so uncommon in the trade that it will not denote a resemblance to the word "SAFAI" or "SAF" so as not to fall within the prohibition of Section 9(1)(d), as being a word descriptive in character. But we do not propose to give any final opinion on this aspect because we are concerned only with the question whether the respondent was entitled to have his trademark registered in Part "B" of the Register and, Therefore, we would not like to decide the matter on this ground.

(6) Section 9(4) provides that a trade mark shall not be registered in part "B" of the register unless the trade mark in relation to the goods in respect of which it is proposed to be registered is distinctive, or is not distinctive but is capable of distinguishing goods with which the proprietor of a trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists.....Section 9(5) further reads as under :

"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 of any other circumstances, the trade mark is in fact so adapted to distinguish, or is in fact capable of distinguishing as aforesaid."

(7) It will, thus, be seen that trade mark in order that it may be registered in part B need not necessarily be distinctive. It is enough if it is capable of distinguishing the goods of the applicant from those of other manufacturers or traders. In the present case the Registrar found as a matter of fact that the trade mark "SAFI" for the medicinal preparation has been used continuously by the respondent for the past more than 20 years. This was about six years back when he gave his decision. There was no evidence led before the Registrar to show that any other manufacturer of medicinal preparation was also using the trade mark "SAFI" for similar goods. There was also no evidence led before the Registrar that the word "SAFI" has been used by some other trader and the respondent's user was with a view to make a dishonest user of the same so as to take unfair advantage. The evidence was thus clear and un rebutted that in the trade circles the word "SAFI" is connected to the medicinal preparation which is being sold by the respondent. Though it may well be open to serious argument whether or not direct reference at all to the character or quality of the goods manufactured by the respondents, this does not mean that the Trade Mark "SAFI" is not capable of distinguishing the goods of the respondents from others in the trade. It cannot be

doubted that by constant use of the Trade Mark "SAFI" for such a long time the respondents can legitimately claim that this Trade Mark is almost exclusively connected with their goods. Though the Registrar did say that the word SAFI was inherently incapable of distinguishing the respondents goods within the meaning of Section 9 of the Act, no reasons have been given in support of such a finding. The Registrar apparently thought that if the word is descriptive it inevitably and in all circumstances means that it is not capable of distinguishing the goods of a particular trader from that of the others. But this view is not supportable in law. In every case the question is a question of fact that is to say, where evidence proves conclusively that descriptive word has lost its primary meaning, and has acquired a secondary meaning, it is a question of fact whether the registration of that mark will or will not cause confusion. The word is not merely by reason of the fact that it is a descriptive word incapable of registration. See: In the matter of an Application J & P Coats Ltd. for Registration of Trade Mark 53 R.P.C. 355 . There are words which have a direct relation to the character and quality of goods which nevertheless may lose their primary meaning and acquire in a particular trade a Secondary meaning as indicating to people interested, whether as traders or as the public in trade, the goods of a particular manufacturer. When that does occur and the evidence shows that the word has attained a secondary meaning then, in my opinion, the word is registrable as a trade mark. [See : 53 R. P. C. 355 (supra)].

(8) It is, Therefore, possible that there may be some words which though they may have reference to the character and quality of goods yet have over a course of period, become associated with the goods of a particular trader and in that sense they would certainly be capable of distinguishing the goods of a particular trader and which would satisfy the test of S. 9(5) of the Act and would be entitled to be registered in Part "B" of the register.

(9) As a result we are satisfied that the respondent had made out a case that his trade mark "SAFI" was capable of distinguishing his goods from those of others in the Trade and, Therefore, he was entitled to claim registration in Part "B" of the register. We, thus, have come to the same conclusion as the learned single judge, though for different reasons, with the result that the appeal will have to be dismissed which we do but with no order as to costs.