

(1980) 09 MAD CK 0047
In the Madras High Court
Case No : A.A.O. No. 799 of 1977

R.S.K.V. Raghavan trading as R.S. Krishna and Co., Mayuram APPELLANT
Vs
G. R. Gopal and Co. and Others RESPONDENT

Date of Decision : 19-09-1980

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 21, 59, 9(2)

Citation : AIR 1981 Mad 262 : (1981) 94 LW 370 : (1981) 2 MLJ 30

Hon'ble Judges : Ramanujam, J

Bench : Single Bench

Advocate : V. N. Krishna Rao, for the Appellant; Janakiram, for the Respondent

Judgement

1. This appeal is directed against the dismissal of an application filed by the appellant u/s 56 of the Trade and Merchandise Marks Act for rectification of the register by removing the trade mark NG. 164933 or by deleting from the said mark the words "Thennamarakkudi oil."

2. The facts as set out in the application for rectification are as follows :The appellant's father Santhanakrishna Naidu started, in or about the year 1918. a business in the manufacture and sale of a medicinal oil preparation for curing sprains. and fractures under the name and style of R. S. Krishna and Co. In order to distinguish his goods from that of the other merchants the appellant's father adapted mark consisting of a device in which the word "Thennamarakkudi oil" formed an essential part. The appellant's father, and. after his death. the appellant have been continuously using the said mark on the tins of the medicinal oil prepared and sold by them. The mark adopted by them for their goods had been registered in the name of appellant's father under No. 89873 and a certificate of registration dated 4-3-1949 has been issued. After the appellant's father he has been continuing the business as sole Proprietor and using his mark on the oil manufactured by him. In or about October 1952. the first respondent company has been using a similar trade mark in the medicinal oil Preparations with the same name,

The appellant Issued a lawyer's notice dated 7-10-1952. apprising the first respondent about his prior user of the mark by his father and about the registration of the same. The first respondent by his reply dated 13-10-1952 Promised to take step to effect the changes in the mark but, however, without effecting any change in the mark it has been selling medicinal preparations of "Thennamaraikkudi oil." Subsequently he came to know that the first respondent had also registered his mark as No. 164933 in pursuance of an application made on 11-7-1954. Hence the appellant had to file an application for rectification of the register on the ground that the mark containing the words "Thennamarakkudi oil" registered by the first respondent is a clear infringement of his mark and its use by the first respondent is likely to cause deception or confusion in the minds of the Purchasing public.

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3. The said application for rectification was resisted by the first respondent contending that "Thennamarakkudi" is a village in Nannilam taluk in Thanjavur district where a family of native physicians used to manufacture such oil preparations and sell it to the public more than half a century ago. and their operation. took its name from the village. that in view of the popularity of that oil several merchants in Thennamarakkudi Mannaradi. Mavuram. Kumbakonam and other places in Thanjavur district. have been selling the medicinal oil as Thennamarakkudi oil. and that, the said word is not distinctive of the medicinal oil prepared and sold by the respondent.

4. The Assistant Registrar of Trade Marks dismissed the application for rectification by his order dated 22-5-1961 on the ground that "the appellant had not adduced any evidence of the distinctiveness of the word "Thennamarakkudi" as Postulated u/s 9 (12); that there was no evidence to show that" there was a quality in the word "Thennamarakkudi" which earmarked the appellant's goods as distinct from those of other producers of such goods. The appellant cannot have a monopoly of the word in question and that in the absence of such a monopoly he cannot prevent other persons from using that word,

5. The appellant took the matter in appeal. Venkatadri J. dismissed the appeal holding that the application for rectification has rightly been refused by the Assistant Registrar of Trade Marks as "Thennamarakkudi" was a geographical name in which none can acquire a trade mark. The matter was taken further in Letters Patent Appeal by the appellant in L. P. A. No. 66 of 1965. On the ground that the appellant cannot be called upon in his application for rectification under S. 56(2) to prove the invalidity of his own registration on the ground of want of distinctiveness and that it is for the Person who wanted to contend to the contrary to lead evidence to establish that Thennamarakkudi oil has not been used to denote the distinctive character of the medicinal Preparation of the appellant. the Letters Patent Appeal was allowed and the matter was remitted to the Assistant Registrar of Trade Marks for fresh disposal in the light of the appellate judgement.

6. After the said remit order the Assistant Registrar of Trade Marks considered the matter afresh and by his order dated 19th February, 1976. He again rejected the application for rectification and the reasons for refusing rectification of the register are these:-

1. Thennamarakkudi oil had no status as a distinctive expression at any time much less. on the date of the commencement of these rectification proceedings.

2. The appellant himself did not demur against the use of the expression Thennamarakkudi by other Person but he objected only to the use of a similar label by him:

3. Thennamarakkudi oil is a common descriptive expression of a medicinal oil Preparation and the word "Thennamarakkudi" was not distinctive of the applicant's goods and therefore the appellant cannot claim any valid exclusive right or conclusive title to the expression "Thennamarakkudi oil" by virtue of the registration of his mark under No. 89873; and

4. It is open to the first respondent to Drove invalid a registration to any word or words contained in a trade mark if the word or words are not descriptive the goods manufactured by the appellant and as a fact. the first respondent herein has clearly proved by evidence that the words "Thennamarakkudi oil appearing in the appellant's mark have a well known. and established use f the name or description of ayurvedic medicinal oil and the words are benefit so used by Persons trading in the said medicinal oil and, therefore. Thenriamarakkudi oil should be taken as a general term or Public juris. descriptively used to denote a medicinal oil having certain ingredients and used for the cure of certain diseases and the expression has been commonlv. appropriated by all merchants in the trade for describing a medicinal oil. The correctness of the view taken by the Assistant Registrar has been challenged in the appeal by the appellant.

7. According to the appellant. the Assistant Registrar of Trade Mark.,, has gone beyond the remit order. that the remit order merely directs the Assistant Registrar to allow the parties to adduce evidence on the distinctive character of the words "Thennamarakkudi oil" but the Assistant Registrar has proceeded on the basis that it is geographical name and therefore, no one can claim a trade mark in respect of that time. A perusal of the order of the Assistant Registrar clearly indicates that he has not dismissed the rectification application merely on the ground that "Thennamarakkudi" is a geographical name. The learned counsel for the appellant further submits that the evidence does not sustain the finding of the Assistant Registrar that Thennamarakkudi is not a distinctive name for the medicinal preparation made by the appellant and that~ it is a common name applied to the preparation of the medicinal oil under a formula, Thus, the main question is whether the first respondent has made out his case that the expression "Thennamarakkudi" is a common name as used for the preparation of medicinal oil under a particular formula and it is not distinctive of the appellant's medicinal preparations.

8 In this case, admittedly the appellant did not register the word "Thennamarakkudi" as a mark. He has merely registered a label containing a device wherein the word "Thennamarakkudi" is found. However, according to the appellant the word "Thennamarakkudi" formed an essential part of the trade mark and, therefore, no one can use the word "Thennamarakkudi" in respect of Preparations made by him. But, a Perusal of the label which has been registered as his (appellants) trade mark would show that it contains not only the word "Thennamarakkudi" but also several other words and therefore the whole label containing the word "Thennamarakkudi" along with other features should be taken into consideration. It has been pointed out by the Supreme Court in Registrar - of Trade 111 rks v Ashok Chandra Rakhit Ltd. SC 558. "that when a distinctive label is registered as a Whole, such registration cannot possibly give an 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. Therefore, it is for the appellant who has filed the application for rectification to establish that the word "Thennamarakkudi" has been used in the label registered as a trade mark to distinguish his goods from those of others. Thennamarakkudi, being a geographical name, the appellant could claim a trade mark in that name only if he establishes that the geographical name has acquired a distinctive character and has been associated with his goods and therefore, it is a distinctive mark for his goods.

It has been held in a number of cases that a geographical distinctive mark any idea of the association would (e) of S. 9(1) and as if the Registrar is name adopted as a without its conveying geographical origin or come within clause such, registrable satisfied of its distinctiveness. In this case it has been found by the Registrar that several merchants in Thanjavur district are manufacturing medicinal oil preparation called "Thennamarakkudi oil" and the preparation itself took its name from the village Thennamarakkudi in Nannilam taluk. Although a geographical name is prima facie not adapted to distinguish, it may be considered for registration upon evidence of its distinctiveness as will be clear from S. 9(2) of the Act. In this case, apart from the use of the word "Thennamarakkudi" in the appellant's label no evidence has been adduced by him to show that he is the only Person manufacturing such a medicinal preparation in that place that the name has come to indicate only the oil manufacture d by him and that there are no other persons manufacturing the same oil in the Place Thennamarakkudi.

As pointed out by Graham J. in Tui uana Smalls Tm 1975 R. P. C. 453. there are words whose primary signification is geographical, and where the geographical significance is so general and so likely to be adopted or desired for use by more than one trader it would be wrong, however distinctive they may in fact have become, even to allow one trader by registration to seek to monopolies them.....There are other "geographical" words where for one reason or another, when considered as applied to the goods in respect of which it is sought to reLrFter1975 R. P. C. 453, Tujuana Smalls Tm 8 them. it is clear that the use is

infact clearly not geographical. but fanciful and is, therefore at least capable, particularly by use. by being distinctive in practice of one manufacturer's goods and registration can. therefore. in such cases be allowed without causing inconvenience to or encroaching upon the reasonable trading rights of other manufacturers. But. however. the question whether it falls in the former or latter category. will have to be decided on the facts and circumstances of each individual case.

9. In this case. the appellant had his mark registered on 6-12-1943 and we are not concerned in these proceedings as to the validity of the said mark. The appeal having arisen out of the Proceedings for rectification of the first respondent's mark we cannot now go into the question as to whether the appellant's mark containing the word "Thennamarakkudi" has been rightly registered in the year 1943. Therefore. in these Proceedings we have to consider whether the first respondent by virtue of registration of his label mark could use the word "Thennamarakkudi" on the medicinal oil Prepared and dealt with by him. In this the Assistant Registrar held that particular medicinal preparation case the goes by the common name Thennamarakkudi oil. As a matter of fact. he has referred to another instance wherein the appellant did not question the use of the word "Thennamarakkudi oil" by a rival trader but he merely objected to the similarity in the label. and ultimately 1975 R. P. C. 453, Tujuana Smalls Tm 8 compromised the -matter with the rival trader in O. S. No. 11 of 1947 wherein. he has not objected to the use of the word Thennamarakkudi oil with a slight change in the label.

It is also found by the Assistant Registrar that at least other person are using the name Thennamarakkudi on their medicinal oil preparation. It is well established that any symbol. word or get-up commonly used by traders in connection with their trade and in respect of which no particular trader can claim as exclusive right to use may be considered common to that particular trade. or public juris. Thus words, expressions or devices which are descriptive of particular goods are open to use by all persons dealing with those goods. It is true, whether a mark is, or is not common to a trade is a question of fact. It is equally well established that a mark was common to the trade at. one time may in the course of time become distinctive. and vice versa. In *Ford v. Foster*. (1872) 7 Ch A 611. it has been held that a word or device which was originally a trade mark. to the exclusive use of which a Particular trader or his successors in business may have been entitled. may subsequently become public juris and the exclusive right may be lost. Therefore. even assuming that the appellant's father used the word "Thennamarakkudi" to show a distinctive character of the medicinal Preparation as it has subsequently been used by persons making similar medicinal oil Preparations, the expression has become public juris. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it. or can be induced from the use of it to believe that he is buying the goods of the original trader the right to the trademark must have gone. The proper test to decide whether a mark which was originally a trade mark has become public

juris. is to see whether the use of it by other Persons is still calculated to deceive the public.

10. Apart from these things the appellant herein has registered his label which contains a Particular device as his trade mark it is true that the label contains the words "Thennamarakkudi oil". But there is no clear evidence whether the appellant's father at the time of registration of this label intended to claim proprietary right in the word "Thennamarakkudi". Admittedly. there is no separate registration of the word as a trade mark. Therefore, the appellant cannot be taken to have acquired a proprietary right in the word "Thennamarakkudi" though he might have acquired the proprietary right in the label by its registration. especially when Thennamarakkudi is a geographical name not shown to have been used to distinguish the medicinal oil Prepared by the appellant's father.

If the word "Thennamarakkudi" which is admittedly a geographical name, had been specially and separately registered as a mark after establishing its distinctiveness by the appellant's father the position would have been different. But where the word "Thennamarak.kudi" finds a Place along with the other features in the label is not possible to assume that the geographical name has been used in the label to show the distinctiveness of the goods. Further the conduct of the appellant in keeping quiet since the registration of the first respondent's mark in the year 1954 also indicates that the name "Thennamarakkudi" cannot be distinctive in its use. Even before the first respondent registered his name. the appellant caused a notice to be issued claiming proprietary right in the label and not Particularly with reference to the use of the word "Thennamarakkudi" nor did he file any opposition for the registration of the first respondent's mark in the year 1954. In this view. of the matter. I am inclined to agree with the view taken by the Assistant Registrar.

11. The appeal is. therefore dismissed. There will however be no order as to costs.

12. Appeal dismissed,