

(1963) 09 MAD CK 0040
In the Madras High Court
Case No : O.P. No. 152 of 1959

Sona Ana Pana Baulraj and Another	Vs	APPELLANT
S.P. Vadiveu Nadar and Sons and Others		RESPONDENT

Date of Decision : 13-09-1963

Acts Referred:

Trade Marks Act, 1940 — Section 24, 46, 6(1)

Citation : AIR 1965 Mad 33

Hon'ble Judges : Sadasivam, J

Bench : Single Bench

Advocate : R. Gopalaswami Iyengar, for the Appellant; K. Rajah Iyer, for the Respondent

Judgement

(1) Petition under Ss. 46 and 72 of the Trade Marks Act, V. of 1940 for rectification of the register of Trade Marks by expunging the trade mark No. 133588 containing the trade name "Manthithoppu"

(1a) The first respondent, which is a firm of partners comprising of the second respondent and his sons, was originally doing business at Usilampatti but subsequently shifted its business to Madurai. The firm was carrying on business in the preparation and sale of a medicinal oil described as "Manthithoppu Manikatti Swamigal Sarvaroga Sanjivi thailam". The second respondent learnt the process of preparing the medicinal oil from Manikatti Swamigal of Inam Manthithoppu and got an exclusive right to manufacturer and sell the said Thailam within the district of Madurai by virtue of the agreement Ex. P. 1 dated 27-1-1933 entered into with said Swamigal. He got the label "Sarva Roga Sanjeevi thailam" marked as "A" in Ex P. 2 registered under the document at Calcutta on 10-9-1934. He issued a notice of registration in respect of the same in the issue of the tamil paper "Jayabharathi" dated 18-11-1936 as evidenced by Ex P 3. Subsequently he got the registered release deed Ex P. 4 dated 30-4-1939 from Manikatti Swamigal of Inam Manthithoppu extending his rights under Ex P 1 to the entire limits of India. He got the label found in Ex R. 7 with the several

trade names registered before the Assistant Registrar of Trade Marks Calcutta, after the Trade Marks Act of 1940 came into force. Subsequently on 3-5-1948, he applied to the Registrar of Trade Marks at Bombay under the Trade Marks Act of 1940 for registration of the label contained in Ex R 1 and it was actually registered on 2-3-1950. On the same date he got the three other trade marks Nos 133584, 133585 and 133588 registered in respect of the names "Manthitope Manikatti Swamigal" "Sravaroga Sanjeevi Thailam" and "Manthitope" found in the main label registered separately. He issued the notification Ex P 5 in the tamil daily newspaper "Thanthi" dated 9-6-1950 in respect of the said registrations. He renewed these regretted trade marks on 30-3-1955 as evidenced by Ex R 6.

(2) The first petitioner as the Manager of the Joint family consisting of himself and his brothers is carrying on business in a medicinal oil as "Manthitope N Shanmugham Kaimuri Anuboga Sarvaroga Sanjeevi thailam" at Usilampatti, Madurai District since the year 1948. His case is that his father started the business after learning the art of preparing the oil from one M. Shanmugham, son of Manthitope Manikatti Swamigal. But the said Shanmugham and another were prosecuted by the second respondent in C. C. No 1440 of 1945 on the file of the Sub Magistrate, Nilakottai, for using a false trade or property mark with intent to deceive or injure any person and knowingly or selling goods marked with a counterfeit property or trade mark and found guilty and convicted under Ss 482 and 486 I. P. C. as evidenced by Ex R 12. Both the accused preferred an appeal against their conviction. But the conviction and sentence passed against Shanmugham were confirmed as evidenced by Ex R 13.

(3) The second petitioner started a firm under the name and style of "Rajan Brothers" which was subsequently transformed into a partnership firm called G. A Rajan and Co, and the firm carried on business of manufacturing and selling the herbal oil under the name and style of "Manthitope Hanuman Sanjeevi thailam". The second petitioner claimed to have learnt the art of manufacturing the thailam from one Thangaswami Nadar of Manthitope, who was one of the many disciples of Manikatti Swamigal of Manthitope. The second respondent filed a suit against the said Thangaswami Nadar and another in O. S. No 29 of 1946 on the file of the District Munsif Court, Tirumangalam, as evidence by Ex. R. 10 and it ended in a compromise decree as evidenced by Ex. R. 11, under which the rights of the second respondent were recognised. Subsequently when the petitioners infringed the rights of respondents 1 and 2, the latter filed O. S. Nos. 4 and 5 of 1954 on the file of the District Judge, Ramanathapuram, at Madurai for injunction. Ex. R. 18 is the printed copy of the judgment in those suits, which were tried together, and it shows that respondents 1 and 2 got an injunction substantially as prayed for against the petitioners. On appeal to this court, Ramachandra Iyer J. (as he then was) found that respondents 1, 2 had acquired rights under the Trade Marks Act in respect of the registered trade marks, but vacated the injunction in respect of the registered trade marks Act in respect of the registered trade marks, but vacated the injunction in respect of the label and the name Manthitope Manikatti Swamigal mainly on the ground that the label

and the words used by the petitioners were not so similar as to constitute an infringement of the respective trade marks in question. Ex. R. 19 is the certified copy of the judgment of Ramachandra Iyer J. in the said appeals Nos. 560 and 561 of 1956 on the file of this court. But in the Letters Patent Appeal preferred by respondents 1 and 2, the injunction as granted by the District Judge was restored completely.

(4) The present application is only for rectification of the Trade Marks Register by expunging the trade Mark No. 133588 containing the trade mark name "Manthitope". Sri K. Raja Aiyar, appearing for respondents 1 and 2, raised a preliminary objection that the petition for rectification is not maintainable by reason of the provisions of S. 24 of the Trade Marks Act, 1940, which I shall hereafter refer to as the old Act so as to distinguish it from the Trade and Merchandise Marks Act 1958 which I shall hereafter refer to as the new Act. Section 24 of the old Act provides that:

"In all legal proceedings relating to a registered trade mark, the original registration of the trade mark shall after the expiration of 7 years from the date of such original registration be taken to be valid in all respects unless such registration was obtained by fraud, or unless the trade mark offends against the provisions of S. 8."

In the present case, no charge of fraud has been levelled against respondents 1 and 2. Clause (a) of S. 8 of the old Act is the only other provision which has been invoked by the petitioner as a ground for rectification of the register in respect of the trade name Manthitope. In Ex. R. 19 it was found that there is no likelihood of any confusion or deception by the use of the word Manthitope. But the said finding was given on the basis that the petitioners had failed to prove that Manthitope is the place of origin of the oils prepared by them or a place noted for production of such oils. At the time when the trade names of respondents 1 and 2 were registered, there was no scope for anyone being deceived or any confusion being caused by the registration of the said trade names as no one else was using them at that time. In fact, there are no particulars in the petition as to how the registration of the trade name "Manthitope" causes confusion or interferes prejudicial with the trade of the petitioners. Under the corresponding S. 32 of the new Act, there is another exception which provides that registration of the trade mark shall not be conclusive as to validity even after seven years if the trade mark was not at the commencement of the proceedings distinctive of the goods of the registered proprietor.

(5) But the main argument of the learned Advocate for the petitioners is that S. 24 of the old Act could be invoked only in respect of legal proceedings and that the proceedings for rectification under S. 46 of the old Act are not legal proceedings. He relied on the decision in Ram Rakhpal Vs. Amrit Dhara Pharmacy and Others, in support of his contention. But a contrary view has been taken in Zenith Colour Trading Co. v. Taherally, 58 Bom LR 912 and In the matter of, In Re: Om Parkash Karam Chand, . But the latter decision was dissented from in the

above Allahabad case. The expression "legal proceeding" in S. 19 I. P. C. has been held to mean a proceeding regulated or prescribed by law in which a judicial decision may or must be given (vide *Abhoy Naidu v. Kanniappa*, Mad 175) The phrase "legal proceeding" is any proceeding in a court of justice by which a party pursues a remedy which the law affords him. In *In re, Keystone Knitting Mills Trade Mark*, 1929 1 Ch. 92 the phrase "in all legal proceedings relating to a registered trade mark" contained in S. 41 of the Trade Marks Act, 1905 of England, has been construed.

It should be noted that S. 41 of the Trade Marks Act, of 1905, of England is also similar to S. 24 of the old Act, but for one difference, namely, the specific reference to the inclusion of applications for rectification, the specific reference to the application for rectification of the register was evidently made by way of abundant caution it was held in that case that the above phrase was designed to embrace all processes by which matters relating to a trade mark are brought to the attention of the court whether in an action commenced by a writ or by motion or originating summons. It is clear from this decision that the purpose of S. 41 of the Trade Marks Act of 1905 corresponding to S. 24 of the old Act is to consummate a possessory title obtained by registration into an absolute title after the lapse of the seven years period. Even in the decision in 58 Bom LR 912 it is pointed out that the object of S. 24 of the old Act is to provide that after the lapse of 7 years from the date of registration, nobody should be in a position to challenge the registration or to seek to rectify it. It is significant to note that S. 32 of the new Act specifically includes applications under S. 56 of the said Act corresponding to S. 46 of the old Act while referring to legal proceedings. It is true, as pointed out in the above *Ram Rakhpal Vs. Amrit Dhara Pharmacy and Others*, that S. 24 does not impose a period of limitation in respect of an application under S. 46 of the old Act. But it could not be expected to do so as S. 46 of the old Act could be invoked in respect of cases excepted under S. 24 of the old Act. It is true that the proceedings before the Registrar are not legal proceedings. But this would not show that proceedings before this court, though termed as Tribunal, are not legal proceedings. section 9 of the old Act debars the registration of the names of chemical elements as trade marks and it provides that notwithstanding anything in S. 24, such registration of names of chemical elements shall be deemed for the purpose of S. 46 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require. The words "notwithstanding anything in S. 24, be deemed for the purpose of S. 46" contained in S. 9 of the old act suggest that the provisions of S. 24 may be applicable in a case under S. 46 of the act. Otherwise, there would have been no necessity for using the words "notwithstanding anything in S. 24" But this contention has been got over in the Allahabad case by observing that the Indian Legislature in enacting S. 9 blindly reproduced the language of the English Act.

I am unable to accept this argument to get over the clear language of the legislature not only in S. 9 but also in several other sections in the old Act.

Clause (a) of S. 27(2) of the old Act refers to registered trade marks consisting of words used as name or description of an article or substance for the purpose of any proceedings under S. 46, while clause (b) of the same S. 27(2) refers to any other legal proceedings relating to the said trade mark. The words "any other" qualifying the words "legal proceeding" in S. 27(2)(b) indicate that all or at least some of the proceedings under S. 46 referred to in S. 27(2)(a) are also legal proceedings. Section 24 of the old Act relates to appearance of Registrar in proceedings involving rectification of register and it provides:

"In any suit or other legal proceedings in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Tribunal."

The learned Advocate for the petitioners was not able to show what other legal proceedings for rectification of register of trade marks other than suits could be initiated apart from the one under S. 46 of the old Act. This is a clear indication that proceedings like the present one are legal proceedings. The use of the words "all proceedings under this Act before a High Court" in S. 74-A of the old Act cannot lead to any inference that the proceedings before a High Court are not legal proceedings. Proceedings before the High Court for rectification of register are treated in English law as legal proceedings and there is nothing in the provisions of the Trade Marks Act, 1940 to hold that the Indian legislature intended that the proceedings before the High Court in respect of applications under S. 46 of the old Act should not be deemed to be legal proceedings. For the foregoing reasons I prefer the view expressed in *In Re: Om Parkash Karam Chand*, though it was assumed in those cases that proceedings under S. 46 of the old Act are legal proceedings, to the view expressed in *Ram Rakhpal Vs. Amrit Dhara Pharmacy and Others*, . Having regard to the provisions of S. 24 of the old Act the registration of the name "Manthitope" should be taken to be valid in all respects as more than seven years had elapsed after its original registration and it cannot be rectified under S. 46 of the old Act.

(6) Sri K. Rajah Aiyar appearing for respondents 1 and 2 contended that if the proceedings under S. 46 of the old Act are not legal proceedings, the present application would not be saved under S. 136(4) of the new Act. There is considerable force in this contention. The learned advocate for the petitioners contended that as he had filed the present petition under the old Act, before the new Act came into force, he is entitled to continue it either under the old Act or under the corresponding provisions of the new Act. He relied on the decision in *J.P. Hanumantha Rao Vs. N. Anantarama Iyer*, where it was pointed out that the general rule is that the rights of parties in a pending action are governed by the law obtaining at the time of the commencement of the action. It was pointed out in that decision that there is no specific provision in the Madras Buildings (Lease and Rent Control) Act, XVIII of 1960, applying it to all proceedings pending at the commencement of the Act. But it was held that the application filed by the respondent in that case was not an application made for a proceeding

commenced under any provision of the repealed Act or the rules framed thereunder, and hence the respondent in that case could not rely on any enabling provision in the new Act to maintain the application purported to have been filed under the old Act.

The learned advocate for the petitioners relied on clause (2) of S. 136 of the new Act in support of his contention. But the said clause only provides that an application, if in force at the commencement of the Act, should be deemed to continue in force under the corresponding provisions of the new Act. But the only application filed under the old Act which is saved under clause (4) of S. 136 is an application which has given rise to legal proceedings. Hence having regard to the repeal of the old Act and the saving provisions contained in S. 136 of the new Act, the present petition could be continued under the old Act, only if it is in respect of any legal proceedings. For the foregoing reasons, I am of opinion that the present petition is not maintainable.

(7) I shall proceed to consider the petition on merits on the assumption that the petition is maintainable in spite of the provisions contained in S. 24 of the old Act. Sri Gopalaswami Aiyangar, the learned advocate for the petitioners, contended that the word "Manthithope" is not an invented word but denoted only a place, and being only a geographical name could not be validly registered under the Act as a trade name in respect of the medicinal oils prepared by respondents 1 and 2. Ramachandra Iyer J. as he then was, considered this contention in detail with reference to the authorities cited by Sri Gopalaswami Iyengar, in the appeals preferred by the petitioners to this court in A. S. 560 and 561 of 1956, as evidenced by Ex. R. 19, and he rejected the contention on the ground that there is discretion to register even a geographical name if it is distinctive in its relation to particular class of goods, namely, medicinal oils of respondents 1 and 2 in this case Sri Gopalaswami Aiyangar took me through several decisions to persuade me to accept his contention.

(8) There is much force in the contention of Sri Gopalaswami Aiyangar that the trade name "manthithope" cannot be considered an invented word. The term "invented word" has been discussed in *Eastman Photographic Materials Co. Comptroller General of Patents, Designs and Trade Marks*, 1898 AC 571. It was pointed out in that decision that mere combination of two English words could not be considered an invented word even although the combination may not have been in use before. Thus in the case *In re, Registered Trade Mark Nos. 530, 535 of Boots Pure Drug Co. Ltd*, 1938-1 Ch. 54 the word "Livron" was claimed by Boots and Co. as an invented word indicating the two components of that medicine, namely, Liver and Iron. It, however appeared that there was a small town in France of the name Livron in which a French Company was having a factory and carrying on a business similar to that of the English company. It was held in the above case that the word "Livron" was not an invented word. In the decision in *Phillipart v. William Whiteley Ltd*. 1908 2 Ch. 274 Parker J. stated two considerations which are essential before a word can be invented word,

namely, that the word must be newly coined, and that it must also be a word which has no obvious meaning to the ordinary educated Englishman. It is not necessary to pursue the matter further as Sri K. Rajah Iyer appearing for respondents 1 and 2 did not seek to justify the registration of the trade mark under clause (c) of S. 6(1), but only under clauses (d) and (e) of Section 6(1) of the old Act.

(9) u/s 6(1)(d) of the old Act, a trade mark may consist of one or more words having no direct reference to the character or quality of the goods, and not being, according to its ordinary signification, a geographical name. It is stated in the counter filed by the third respondent that the 2nd respondent appears to have represented to the Registrar of Trade Marks that the word "Manthitope" meant monkey grove and as such it was not a geographical name in its ordinary significance within the meaning of Sec. 6(1)(d) of the old Act. In *In re, Magnolia Metal Co's Trade marks*. 1897 2 Ch 371 it was pointed out that in the absence of special circumstances the phrase "geographical name" should be interpreted so as to be in accordance, in some degree, with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it. Thus it was pointed out in that case that the word "Monkey" is not proved to be a geographical name by showing merely that a small and by no means generally known island has been called by that name. But it is doubtful in this case whether the trade name "Manthitope" is not in its ordinary signification a geographical name. Manthitope is a small village in Koilpatti taluk in Tirunelveli District. In fact, the 2nd respondent learnt the art of manufacturing the medicinal oil from Manikatti Swamigal, who hailed from Manthitope hence it is doubtful whether the registration of the trade name "Manthitope" could be justified under S. 6(1)(d) of the old Act.

(10) The main question for consideration in this case is whether the trade name "Manthitope" registered by respondents 1 and 2 was distinctive of their goods at the time of the registration. Under S. 74 (1) of the old Act, the Registrar has a right to appear and to be heard in proceedings involving rectification of register. Under S. 74(2) of the old Act,

"..... the Registrar may, in lieu of appearing, submit a statement writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue, or of the grounds of any decision given by him affecting it, or of the practice of the Trade Marks Registry in like cases, or of other matters relevant to the issues and within his knowledge as Registrar, and such statement shall be evidence in the suit or other proceedings."

Hence the statement filed by the Registrar in this case shall be evidence in this proceeding. The statement shows that the respondents 1 and 2 furnished evidence of distinctiveness in respect of the trade marks when they applied for registration. It is clear from the decision in *Ciba Ltd. Vs. M. Ramalingam and S. Subramaniam* trading in the name of South Indian Manufacturing Co. and

Another, , that the relief to be given under S. 46 of the old Act is a discretionary relief, and, that though the court is found to consider the case independently on merits, it would ordinarily be loath to interfere with the discretion of the Registrar. In the present case, respondents 1 and 2 have succeeded in their civil litigation in obtaining an injunction against the petitioners in respect of their trade marks. It is true the relevant question of consideration in this petition is whether the trade name "Manthitope" registered by respondents 1 and 2 was distinctive of their goods at the time of their application for registration on 3-5-1948. Apart from the evidence afforded by the statement filed by the Registrar, respondents 1 and 2 have filed a large number of letters to prove their case. Even taking the letters unto 3-5-1948, alone into consideration, it is easy to find that the medicinal oil prepared by respondents 1 and 2 had come to be recognised as the "Manthitope thailam" of respondents 1 and 2 even prior to the date of application for registration. It is true that most of the letters are letters by customers of respondents 1 and 2 for supply of the oil. But there is one letter dated 27-3-1947 by a general member of the public, namely, S. S. Ramchandran, for Manthitope oil of respondents 1 and 2 on the ground that he found it effective when he used it for himself and the members of his family. On the other hand, the petitioners, on whom the burden of proof lies to establish that the trade name "Manthitope" had not acquired any distinctiveness as claimed by respondents 1 and 2, have not adduced any evidence in support of their contention.

(11) The principles on which geographical names are generally held not suitable for registration can be easily stated, though it is a difficult task to analyse the several decisions and find out any test to decide why particular geographical names have been allowed to be registered on the ground of distinctiveness of the goods of a trader, while other geographical names have been held to be not distinctive and fit for registration. Purely laudatory words cannot be allowed to be registered as the trade name of the goods of a particular trader as it would give him a monopoly to which he is not entitled. Thus the word "perfect" could not be registered by a trader though he would have used it in connection with his soap and the name became distinctive of his soap. The principle is this put by Sir Herbert Cozens-Hardy in *In re, Joseph Crosfield and Sons Ltd. (The Perfection Soap case)*, 1910 1 Ch 130:

"Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure". In the case of a geographical word also it may be inherently adapted to distinguish as in the instances given by Fletcher Moulton L. J. in the perfection Soap case of "Monte Rosa" for cigarettes or "Teneriffe" for boiler plates. At the other end of the scale would be such words as "British, Yorkshire and Liverpool" as pointed out in *Yorkshire Copper Works v. Registrar of Trade Marks*, 1954 1WLR 54 It may appear paradoxical.

"the more apt a word is to describe the goods of a manufacturer, the less apt it is

to distinguish them; for a word that is apt to describe the goods of A, is likely to be apt to describe the similar goods of B and it is for this very reason that a geographical name is prima facie denied registrability". "For, just as a manufacturer is not entitled to a monopoly of a laudatory or descriptive epithet, so he is not to claim for his own territory, whether county, country or town, which may be in the future, if it is not now, the seat of manufacture of goods similar to his own."

Thus in the above case where a company which manufactured most of its products in Yorkshire applied for registration of the word "Yorkshire" as a trade mark for their goods it was held that even though the mark might have acquired 100 per cent distinctiveness, the word was inherently not adapted to distinguish the goods in question as that of the company. Thus in 1897 2 Ch. 371 it was observed that it cannot be said that the name Magnolia distinguished the manufacture by the claimants of the trade mark from the manufacture of the same article by other persons. Similarly in the case in 1938 1 Ch. 54 the trade name "Liveron" was held to be not distinctive of the registered proprietor of the goods as the name was that of a place where medicines of similar character were manufactured by the rival firm at the time of the registration. In the decision in *A. Baily and Co. Ltd. v. Clark Son and Morland, Ltd*, 1938 AC 557 it was held that although the trade mark "Clastonbury" was distinctive in fact, it was not "adapted to distinguish the goods of the respondent in that case who had registered the mark from those of other manufacturers of similar goods in the town of Glastonbury, who ought not to be hampered or restricted, by the presence of the mark on the register, in selecting the particular form of words by which they might desire to describe their goods as being product of a town which in fact, enjoyed a reputation in connection with the manufacture of sheepskin slippers. To take an instance from our own country, it would not be open to one trader of mats in Pathamadai to get the word "Pathamadai" registered so as to preclude the other traders of that place from using the name which is so well known in connection with mats.

But in *In re, Apollinaris Trade Mark*, 1907 2 Ch. 178 a German Company who were the owners of the Apollinaris mineral water spring was allowed to register the word "Apollinaris" on undertaking not to use the mark except in respect of water from the said spring as there was evidence of very extensive user of the word "Apollinaris" and that it meant the water from the appellants spring and no other water. It was pointed out in that decision that the word "distinctive" in the relevant clause of the Trade Marks Act of England corresponding to S. 6(1)(e) of the old Act shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons. It is not sufficient to distinguish goods from the goods but the trade mark should distinguish the goods of one proprietor from the goods of another proprietor. Thus the decision referred to by the learned advocate for the petitioners where geographical names were not allowed to be registered could be easily distinguished.

(12) It could not be said that the word "Manthitope" is not adapted to distinguish the goods of respondents 1 and 2 from those of others. It is clear from what I have stated that the trade name "Manthitope" has acquired a distinctive meaning as the names of the medicinal oil of respondents 1 and 2 and there was sufficient evidence in respect of the said distinctiveness even on 3rd May 1948 to justify the registration of the trade name. Thus there are no grounds to rectify the register of trade marks as prayed for by the petitioners. The petition is therefore dismissed with costs.

(13) Petition dismissed.