
(1964) 05 P&H CK 0001
In the Punjab And Haryana At Chandigarh
Case No : F.A.O. No. 61 D of 1963

Stadmed Private Ltd., Calcutta

APPELLANT

Vs

Hind Chemicals, Kanpur

RESPONDENT

Date of Decision : 20-05-1964

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 109, 109(5), 11, 18, 20(1)

Citation : AIR 1965 P&H 17

Hon'ble Judges : I.D. Dua, J;D.K. Mahajan, J

Bench : Division Bench

Advocate : N.K. Anand, for the Appellant; Anoop Singh and M.K. Chawla, for the Respondent

Judgement

D.K. Mahajan, J.—This is an appeal under S. 109 of the Trade and Merchandise Marks Act, 1958 - hereinafter referred to as the Act. It is directed against the order of the Assistant Registrar of Trade Marks dated the 3rd January, 1963. By this order the Assistant Registrar allowed the application of Messrs Hind Chemicals Limited—hereinafter referred to as the respondent company - under S. 20(1) of the Act and rejected the opposition which was by Stadmad Private Limited - hereinafter known as the appellant Company. The appeal came up for hearing in the first instance before P.C. Pandit, J. on the 20th November, 1963. The learned Judge by his order of the same date directed that the appeal be heard by a Division Bench in view of the provisions of S. 109(5), particularly as the questions involved were of considerable importance and were not free from difficulty.

2. The facts shortly stated are that on 25-9-1957 the respondent-company made an application u/s 18 of the Act for the registration of a trade mark consisting of the word "Entozine" in cl. (5) (sic) in respect of their pharmaceutical preparation. This preparation has been put in the market for treatment of bacillary and amoebic dysenteries. This, medicine has been sold since 1952 under this trade name. In accordance with the proviso to S. 20(1) of the Act, the application was

advertised. A notice of opposition was filed by the appellant-company on the 29th April, 1961. The challenge to the registration of the trade mark was on the following grounds:-

1. that the appellants were the proprietors of the trade mark "Stadmed Entrozyme" which they had been using since 1954 and in respect of which they had filed an application for the registration of the trade mark and the application was still pending;

2. that the use of the mark applied for by the applicants would be likely to deceive or cause confusion and so its registration would be opposed to the provisions of section 11 of the Act;

3. that the mark sought to be registered was phonetically too close to the word "Entrozyme" and was not adapted to distinguish the goods of the applicants; and

4. that the applicants were not the proprietors of the trade mark.

3. The counsel for the appellant-company gave up all the grounds set up before the Assistant Registrar excepting those under S. 9 of the Act. Only two contentions were raised before the Assistant Registrar, namely,-

1. that the word "Entozine" did not qualify for registration as an invented word; and

2. that on the date of the application this word was not distinctive of the applicants' goods.

4. The Assistant Registrar came to the conclusion that the word "Entozine" was an invented word and that the applicants' mark had become distinctive of their goods on the date of their application. It may be mentioned that both these grounds are mutually exclusive. Registration can be allowed if any one of those grounds is proved. In the present case, both the grounds were proved and accordingly the registration of the trade mark was allowed and the opposition was dismissed.

5. It will be appropriate at this stage to mention that an earlier application had been filed by the appellant-company for the registration of their trade mark "Stadmed Entrozyme" under the same clause (5) as was done by the respondent-company with regard to their trade mark "Entozine". This application was filed on the 8th February 1956. It was advertised in the Trade Mark Journal subject to the disclaimer of word "Entrozyme". In June, 1957 opposition was lodged by the applicants (the present respondent-company) to the registration of this trade mark. This opposition is No. 3880 and is still pending decision before the Registry Branch Calcutta. The present petition is obviously a counterblast (sic) the petition filed by the appellant to which the present respondent have filed opposition at Calcutta.

6. The learned counsel for the appellant company did not seriously raise the second contention before us which was raised and decided against his client by

the Assistant Registrar. There (sic) ample material on the record on the basis of which the Assistant Registrar has come to the finding that the word "Entozine" has become distinctive of the applicants goods hat is how the matter has been dealt with by the Assistant Registrar:

According to the affidavit dated 5th May, 1960 it Shri Mahendra (sic) (Exhibit M.R.) to the affidavit in support of the application) which was filed in application No. 181682, the applicants" developed a preparation for the treatment of dysentery and named it as "Entozine". They have done a large business in India since the year 1952 in connection with its preparation. In para 5 of his affidavit figures of yearly sale of the preparation under the trade mark "Entozine" for the period between 1952/58 to 25th September, 1957 (the date of the filing of the application are set out. Beginning with Rs. 3692/-, the figures progressively increase to Rs. 22158/- in 1957. Shri Rohatgei points out that the applicants have extensively advertised their goods under the trade mark "Entozine" and spent a sum of Rs. 10,000/- per annum and that important dealers in India recognise the goods of the applicant company by the said trade mark. The evidence is supported by documentary proof such as bills, orders from dealers and advertisement cuttings. At the instance of the opponents. the applicants produced their books of accounts. These books also prove that the applicants have used their mark from the year 1952. On the whole I am satisfied from the evidence in support of the application that the applicants" mark had become factually distinctive of their goods on the date of the application.

No fault can be found with the observations of the Assistant Registrar quoted above and they are fully borne out on the record and, therefore, his finding on this part of the case must stay.

7. The matter that was seriously debated before us related to the first contention raised before the Assistant Registrar, namely, that "Entozine" was not an invented word. The principles on which the disputed question, that is, whether a particular word is or is not an invented word, is to be determined, are well settled and admit of no dispute. It is only in their application to the facts of a given case that difficulty has arisen and a heap of case law has grown. But if the principles that have been settled are kept in view, most of the cases that may arise from time to time will present no difficulty. Of course, there have been and will be border line cases. The present case, however, is not one of the border line cases and it, therefore, does not present much difficulty.

8. The statutory provision is contained in S. 9 of the Act, the relevant part of which is in these terms.

9(1) A trade mark shall not be registered in part A of the register unless it contains or consists of at least one of the following essential particulars, namely:

(a) * * *

(b) * * *

(c) one or more invented words;

(d) 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 or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste, or tribe in India;

(e) any other distinctive mark

(2) * * *

This provision is similar to Ss. 9 and 10 of the English Act of 1938.

9. The leading authority on the subject is the decision of the House of Lords in what is commonly known as the Solio Case, Eastman Photographic Materials Co., Ltd's Application for a Trade Mark (1898) 15 R.P.C. 476.

10. Lord Chancellor, while dealing with the question whether "Solio" is or is not an invented word came to the conclusion that it was an invented word. The reasons which prevailed with the Lord Chancellor are to be found in his speech at page 483. I have taken the liberty of quoting in extenso the same for facility of reference:

I think it is an invented word within the meaning of this Statute. I know of no such words as "Solio" in any sense which would make it intelligible here, although it is an Italian word meaning a throne, and although it is a Latin word in the objective case with the same meaning.

No much reliance however is placed upon the word having some meaning in a foreign tongue; but what is put is that it may have extracted from it some meaning in relation to the character or quality of the goods, because the letters S.O.L. may be understood to mean the sun it is true that Shakespeare in "Troilus and Cressida" speaks of our Planet (sic) and that inasmuch as the goods in question are photographic papers and sunlight (sic) operative in producing impressions on photographic paper, it comes within the prohibition against using words which are descriptive of the character, of quality of the goods in respect of which the word is sought to be registered.

My answer is that "Solio" is not "Sol" and "Sol" is not "Solio". It certainly is a very strange thing that you should take three letters out of a word, and by the somewhat circuitous process that has been adopted here, arrive at the conclusion that it is not an invented word, and that it does describe the character and quality of the goods. My Lords, I desire to give my opinion with reference to the particular word and not to go behind it. I can quite understand suggesting other words - compound words or foreign words - as to which I would be impossible to say that they were invented words, although, perhaps, never seen before (sic) that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before. Suppose a person were to attempt to register as a single English word

"Chespandgood" or even, without taking so gross an example, using a word so slightly differing from an ordinary and recognised word as to be neither an invented word nor, avoiding the prohibited choice of a word, indicating character or quality. The line must be sometimes difficult to draw; but to my mind the substance of the enactment is intelligible enough, and the Comptroller has to make up his mind whether in substance there has been an infringement of the rule. Of course, also, words which are merely misspell but which are nevertheless in sound ordinary English words, and the use of which may tend to deceive, ought not to be permitted.

Lord Herschell, in his speech, part of which I am quoting for facility of reference, observed thus:

The vocabulary of the English language is common property; it belongs alike to all; and no one ought to be permitted to prevent the other members of the community from using, for purposes of description, a word which has reference to the character or quality of the goods. * * * But with regard to words which are truly invented words-words newly coined, which have never therefore been used - the case is, as it seems to me, altogether different; and the reasons which required the "insertion" of the condition are altogether wanting. If a man has rightly invented a word to serve as his Trade Mark, what harm is done what wrong is inflicted if others be prevented from employing it, and its use is limited in relation, to any class or classes of goods to the inventor?" * * * An invented word has itself no meaning until one has been attached to it. * * * An invented word is allowed to be registered as a Trade Mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases.

While dealing with the word "Solio" the dispute about which was before the House of Lords, the learned Law Lord made the following observations at page 485 of the speech.

Coming now to the particular case under discussion, I cannot doubt that the word "Solio" is an invented word, unless it is to be regarded as the Italian word Solio, which means a throne in which case it has certainly no reference to the character or quality of photographic paper. If it is not to be so regarded, it has of itself no meaning. As I have said, I think it unimportant, if it be an invented word whether it has reference to the character or quality of the goods or not; but if this were the test of the validity of the word as a Trade Mark, I must say that I think there is no such reference. I daresay that it might occur to some minds given to etymology that sol, the latin word for son, was a component part of it when they found it connected with photographic paper, but the same minds would equally find other root bases for the word if they found it connected with boots or agricultural implements. It seems to me to have no reference to the character or quality of the goods in the sense in which those words must have been used by the Legislature. I think the judgments appealed from ought to be reversed.

Lord Macnaghten, in his speech, at page 486 made the following observations:

But the word must be really an invented word; nothing short of invention will do. On the other hand nothing more seems to be required. If it is an invented word - If it is "new and freshly coined" (to adapt an old and familiar quotation). It seems to me that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods - I do not think that it is necessary that it should be wholly meaningless. To give an illustration, everybody will remember that in a book of stinking humour and fancy which was everybody's band when it was first published there is a collection of strange words where "there are (to use the language of the author) "two (sic) packed up into one word. No one would say that those were not invented words (sic) they contain a meaning - a meaning is wrapped up in them it you can only find it out.

Lord Shand in his speech at page 487 observed:

There must be invention, and not the appearance of intention 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 sense. 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.

11. These tests laid down in the Solio Case have stood the test of time and have been the guiding principles in the determination of cases where the question arose whether a word is or is not an invented word.

12. Coming to the word, with regard to the registration of which as an invented word, the controversy has arisen in the present case, namely, "Entozine", it may be mentioned that the word "Ento" has been derived from the Greek word "Entos" "Entos" after its adaptation to the English language has been given the form of "Ento" or "Ent". The word "Ento" or "ent" means "a combining form signifying within, inner" (in Blakiston's New Gould Medical Dictionary, Second Edition). "Ento" or "Ent" have been used as prefixes to various words in the medical dictionary. Wherever any inner or internal condition of a particular organ is to be described, either the word "Ento" or the Word "Ent" is attached to the word pertaining to that organ. For example, "entocoele" (ento - coele means internal hernia; "entochoroidea" (ento - choroidea) means the inner lining of the choroid membrane of the eye, made up mainly of capillaries; "entocine" (ento - cine) means Trade mark for a vaccine for immunization against the common cold; "entocone" (ento - cone) the posterior lingual cusp of a mandibular molar tooth; etc. Again, "entoptic" (ent -optic) means pertaining to the internal parts of the eye; "entophthalmia" (ent - ophthalmia) means inflammation of the

internal parts of the eyeball, etc. "Ento" or "Ent" is not only confined as prefixes to medical terminology but is of wider use (sic) where some inner condition is to be described of any substance or thing.

13. With regard to the appellant company's trade mark "Stadmed Entrozyme", a petition for the registration of which is pending in the Calcutta Registry, the Assistant Registrar advertised the trade mark subject to the disclaimer of the word "entrozyme". "Entro" is a suggestive word which in ordinary parlance denotes "intestine". The word "zyme" has also distinct meaning, that is, an organised ferment; and that is why the Assistant Registrar advertised the appellant-company's trade mark subject to a disclaimer of the word "Entrozyme". This amount (sic) be said so far as the respondent-company is concerned. The word "Ento" like the word "Sol" means "within" and the word "within" does not signify "within what". The word "Zine" has no meaning and as observed by Lord Chancellor-

it certainly is a very strange thing that you should take three letters out of a word, and by the somewhat circuitous process that has been adopted here, arrive at the conclusion that it is not an invented word, and that it does describe the character and quality of the goods.

In the Sollo Case, the word "Sol" was sought to be taken out from the word "Solio" and as the word "Sol" meant "sun" and the Solio trade mark was applied for photographic goods, it was urged, and without success, that the word "Sol" described the character and quality of goods. The same argument is raised by the appellant-company so far as the word "Entozine" is concerned. As "Ento" means within, it is argued that the word "Entozine" is suggestive of something for the intestines. I am, however, unable to agree with this and the reasons for repelling this argument are stated in the Solio case and they apply with equal force to the present case. I am, therefore, clearly of the view that the word "Entozine" is an invented word and does not describe either the character or the quality of the goods. I even go further and hold that it does not even give rise to any suggestion to that effect.

14. I may also state here that the words "Entrozyme" and "Entozine" have no phonetic similarity, in "Entro" the letter "r" is not silent and in "zyme" the letter "m" is not silent. Moreover, as observed by the Assistant Registrar of Trade Marks, the goods sold under the names "Entozine" and "Entrozyme" cause no confusion, particularly when the goods are Schedule "H" drugs and can only be obtained on doctor's prescription.

15. A large number of cases were cited before us. In some cases the word was held to be an invented word and in others it was held not to be an invented word. All those cases are collected in the Law of Trade and Merchandise Marks by Dr. S. Venkateswaran, 1963 Edition, at pages 71 to 73. In all these cases, the test in Solio's case was applied and on the basis of that test the various Courts came to the conclusion either in favour of the registration of the word as an

invented word or against it. This case seems to present no difficulty because the word "Entozine" has no particular meaning and is not suggestive that the goods which are to be sold under this trade mark have anything to do with intestinal trouble. Of course, if the word "Entro" had been used, the suggestion that the goods so described were to be used for intestinal trouble would have been obvious.

16. A contention was raised by the learned counsel for the respondent-company that in case of doubt whether "Entozine" is an invented word or not, this Court should not interfere with the discretion exercised by the Assistant Registrar in registering it. In view of what has been stated above, it is not necessary to examine this argument at all.

17. After giving the matter our careful consideration, we are definitely of the view that the Assistant Registrar was right in holding that the word "Entozine" is an invented word and has, therefore, rightly allowed its registration. The appeal accordingly fails and is dismissed, but there will be no order as to costs.

Inder Dev Dua, J.

18. I agree.