

(1955) 07 BOM CK 0010

In the Bombay High Court

Case No : O.C.J. Miscellaneous Petition No. 112 of 1955

Zenith Colour Trading Co.

APPELLANT

Vs

Taherally Esufally Rangwala

RESPONDENT

Date of Decision : 25-07-1955

Acts Referred:

Trade Marks Act, 1940 — Section 24

Citation : (1956) 58 BOMLR 912

Hon'ble Judges : Tendolkar, J

Bench : Single Bench

Final Decision : Dismissed

Judgement

Tendolkar, J.—This is a petition for rectification of the register of Trade Marks by entering in entry No. 80747 the disclaimer of the device of a cow and the word "cow" and its equivalents in Indian regional languages. The respondents deal in colours and dyes, and on June 12, 1943, they registered a trade mark consisting of a label, one feature of which is a cow. That registration is under No. 80747. The petitioners allege that in respect of colours and dyes manufactured by them they also used a label, the principal feature of which is a cow. They further allege that at the date of the respondents' application for registration there were current in the trade of colours and dyes several names, one of the principal features of which was a cow, and, therefore, the device of a cow was then common to the said trade, and lastly they allege that if the device of a cow is held not to have been common to the trade at the date of the application for registration, such device became common by reason of its adoption by many other manufacturers of dyes and colours with the knowledge of respondents No. 1. They, therefore, seek to have the entry rectified by putting in a disclaimer of the device of a cow and the word "cow" or its equivalents in Indian regional languages.

2. A preliminary objection has been raised by Mr. Shavaksha to this petition. He contends that by reason of the provisions of Section 24 of the Indian Trade Marks

Act the petition ought to be dismissed because the registration of respondents No. 1 has become final and conclusive by reason of the lapse of a period of 7 years from the date of registration.

3. Now, Section 24 is in the following terms:

In all legal proceedings relating to a registered trade mark, the original registration of the trade mark shall after the expiration of seven 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 Section 8.

It is clear that the object of the section 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. If any person wishes to have the registration rectified, he must of necessity adopt proceedings within the period of 7 years. But what Mr. Shah argues is that the words "the date of such original registration" in this section do not mean what may be termed "the deemed date" of registration but they mean the "actual" date of such registration.

4. Now, Section 14 of the Trade Marks Act provides for an application for registration. When an application is accepted, Section 15 provides for the advertisement of the application and any person is entitled to give a notice of opposition to the registration. Then Section 16 provides that when there is no opposition, or where there having been opposition the Registrar has decided in favour of the applicant, the Registrar shall register the said trade mark. Obviously, therefore, there is of necessity a time lag between the date of application and the date of actual registration; but Sub-section (1) of Section 16 provides inter alia as follows:

the trade mark, when registered, shall be registered as of the date of the making of the said application."

In other words, the registration dates back to the date of the application and the Sub-section further provides:

and that date shall... be deemed for the purposes of this Act to be the date of registration.

Therefore, the date of application is under this section the "deemed" date of registration while the "actual" date of registration must of necessity be a subsequent date; and the plea of Mr. Shah is that when Section 24 refers to "the date of such original registration", it does not refer to the "deemed" date of registration but it refers to the "actual" date of registration.

5. In support of this contention, Mr. Shah in the first instance relies on the words "the original registration" appearing in Section 24. His contention is that this can only refer to the actual registration and not to merely the application for registration. Now, the words "original registration" appear to me to have been

used in this section in contra-distinction to registration of assignments which may be made after the date of what may be termed the first registration. Section 35 provides for the registration of assignments of a registered trade mark, and when such a registration takes place, the assignee of the trade mark becomes entitled to all the rights in respect of the trade mark that his assignor had by reason of the original registration, and in my opinion, therefore, the words "the original registration" in Section 24 do not relate to the actual factum of registration but relate to the first registration as against any subsequent registration of an assignment of a trade mark. Then Mr. Shah argues that the date mentioned in Section 24 is "the date of such original registration" and not "the date of registration" which are the words used in Section 16(1), and, therefore, he seeks to argue that "the date of such original registration" must be something different from the date of registration mentioned in Section 16(2). Now, in the first instance, as I have held above, the word "original" only signifies in this section the first registration in contra-distinction to the registration of any subsequent assignments of a registered trade mark, and, when the section speaks of "the date of such original registration," it does not mean anything more or less than saying from the date of registration which is the first registration. It seems to me to be impossible to give to the words "the date of such original registration" the meaning that it, means the date of actual registration and not of "deemed" registration, because Section 16(1) clearly provides that the date of the application shall be deemed to be the date of registration for the purposes of this Act which includes the purpose of Section 24 as well. Mr. Shah attempted to point out that such an interpretation of Section 24 may lead to hardships because he says that it may well happen that an application for registration may remain pending for over seven years and the actual registration may take place more than seven years after the date of the application for registration, and in such a case the registration will be final the moment it is made. He drew my attention to a statement by a living author in a book on the Trade Marks Act that there was such a large rush of application for registration of trade marks under the Act of 1940 that some applications were not even advertised for seven years with the consequent result that they could not possibly have been disposed of within a period of seven years. Now, in the first instance if the true meaning of Section 24 is what I conceive it to be, the consequence to which it may lead in a given case or cases cannot enable a Court to put some other meaning on the section; and in the second place the Court is not entitled to assume that the machinery of the Trade Marks Act will move in such a leisurely fashion that applications for registration of trade marks will not in any appreciable number of cases be registered for more than seven years. The procedure prescribed, viz., the advertisement of the application, the notice of opposition, and the determination of such opposition by the Registrar should certainly not ordinarily take anything like seven years and the possibility that it may in rare cases take longer than seven years does not in any manner affect the meaning to be attached to the words in Section 24.

6. Then Mr. Shah has attempted to argue that in any event Section 24 only applies to cases in which rectification is sought in the light of circumstances which exist at the date of registration, and if rectification is sought on any grounds which arose subsequent to the date of registration, Section 24 has no application at all. Now, Section 46 of the Act deals with the power of rectification, and the particular Sub-section with which we are concerned in this petition is Sub-section (2) which provides as follows:

Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to a High Court or to the Registrar....

Now, Mr. Shah's contention is that the entry is remaining" wrongly on the register inasmuch as in any event the device of a cow has become common to the trade since the date of registration and with the knowledge of respondents No. 1; and in so far as his petition is based on this ground in any event Section 24 has no application to the petition. Now, I must confess that I find it extremely difficult to appreciate this argument. Obviously Section 24 will apply to any application for rectification. "Why a particular set of applications are to be excluded from the scope of Section 24, Mr. Shah has not been able to point out. There are no words in Section 24 which would even give rise to an argument that the validity which registration obtains by reason of the lapse of seven years is restricted only to a challenge to the registration arising out of circumstances which existed at the date of the registration. It may well be that u/s 46 a person is entitled to apply for rectification on grounds which have arisen subsequent to the date of registration; but even that right is subject to the provisions of Section 24, because the effect of Section 24 is that registration becomes final and conclusive after a period of seven years and nobody can challenge it. I see, therefore, no substance in this plea of Mr. Shah as well.

7. Mr. Shah drew my attention to a passage in Kerly on Trade Marks, 1950 edn., at page 329, where the learned author, dealing with Section 13 of the English Trade Marks Act of 1938, which corresponds to Section 24 of our Act, observes that the word "registration" is open to some ambiguity. This observation of the learned author is followed by the remark "it may mean the act of putting on the Register (as in Section 19(2), or the fact of being on the Register (as in Section 15)." Now, with very great respect to the learned author, I must confess that I find it somewhat difficult to follow the reference to Section 15. The reference to Section 19(2) of the English Trade Marks Act of 1938 is clear enough and that deals with "actual registration"; but when you come to Section 15, I am quite unable to see what is the distinction between the meaning of the word "registration" as used in Section 15 as opposed to the meaning of the word as used in Section 19(2), "The fact of being on the register" which Kerly refers to "as in Section 15" appears to me to be the consequence of the act of putting on

the register which he refers to "as in Section 19(2)"; but whatever the distinction that the learned author had in view, when one looks at the context in which he emphasises the opinion that the word "registration" is open to some ambiguity, it appears that he is referring not to the date of registration, which phrase appears in Section 13 but to the proviso that relates to registration if obtained by fraud. No doubt in that context it may be arguable that the fraud must be antecedent to the date of the application for registration or that it may be antecedent to the date of the actual registration; and in that context it would be legitimate to say that the word "registration" is ambiguous, but I do not read this passage as meaning that the word "registration" in the words "the date of registration" as used in Section 13 of the English Act of 1938 is in any sense ambiguous.

8. Mr. Shah also drew my attention to a reported case of a rectification application having been entertained after seven years; but obviously in that case *Electrolux Ltd. v. Electrix Ltd.* (1953) 71 R.P.C. 23 as the report shows, no question was raised as to the provisions of Section 13(1) of the English Trade Marks Act of 1938 and the Court was not called upon to determine whether the application was barred by reason of Section 24 of the Trade Marks Act of 1940.

9. Mr. Shavaksha, on the other hand, has relied on the case of *In the Matter of a Trade Mark of Keystone Knitting Mills Ltd.* (1928) 45 R.P.C. 193 : 45 R.P.C. 421. In that case the application for registration was made on December 16, 1920, and although the application for rectification was made within seven years, viz., on July 15, 1927, the case was heard and the application allowed on March 2, 1928, i.e., after the period of seven years had elapsed. The Act then applicable was the English Trade Marks Act of 1905, Section 41 whereof is in all material particulars a verbatim reproduction of our Section 24. The point made by Mr. Shavaksha is that in this case it appears from a copy of the Trade Marks Journal which Mr. Shavaksha has produced that the application for registration was advertised on August 24, 1921, and obviously the actual registration could only have been made at some subsequent date. But it was assumed throughout the proceedings that the period of seven years began to run from December 16, 1920, i.e., the date of the application for registration, and not from some date subsequent to August 24, 1921, which would obviously have brought the date of the final order within seven years from such date. Indeed Mr. Justice Clauson, in order to get over the period of seven years from the date of the application for registration, actually dated back his judgment to December 15, 1927. The Court of Appeal held this to be wrong; but held that he had authority to make that order on March 2, 1928, on the ground that the application for rectification had been presented within seven years from the date of the application for registration. Now, there is no doubt that so far as Clauson J. was concerned, if he had taken the view that the period of seven years began to run from some date subsequent to August 24, 1921, he would not have had to date back his judgment to December 15, 1927. But apart from this, since the petition for rectification was within time from the date of application for registration, ipso facto it was within time, viz., within seven years from subsequent date, viz., the

date of its actual registration, and therefore there could be no occasion to discuss or to decide whether the date of registration from which the seven years" period is to be counted is the deemed date of registration or the actual date of registration, and this case, therefore, is not of much assistance in deciding the point.

10. On the whole, I am of opinion that the contention that Section 24 refers to the actual date of registration as the starting point for counting the period of seven years at the end of which the registration becomes final and conclusive is not tenable and the words "date of registration" mean "deemed" date of registration, viz., the date of the application.

11. The result, therefore, is that I have got to consider whether this petition is saved by any of the two saving clauses in Section 24; and those are that notwithstanding the lapse of seven years, the registration will not be valid if it was obtained by fraud or if a trade mark offends against the provisions of Section 8.

12. Now, so far as the first of these grounds is concerned, there is no doubt an averment in para 7 that the trade mark was obtained by fraud; but a mere allegation of fraud has no meaning in a pleading. There are no particulars of fraud given anywhere in the petition and, therefore, the plea of fraud must be treated as non-existent.

13. With regard to the latter part of the proviso, the trade mark is said to offend against Section 8 by Mr. Shah because he says that in terms of Sub-section (a.) of Section 8 it is likely to deceive or to cause confusion. That again is nowhere pleaded. What is pleaded is that a cow is a common feature in the trade of colours and dyes, and therefore a disclaimer should be inserted in the registration. It is not pleaded that by reason of the use of the cow there is likely to be deception or confusion. This is, therefore, not a case which falls within the proviso to Section 24.

14. The result, therefore, is that the preliminary objection raised by Mr. Shavaksha must succeed and the petition is dismissed with costs. Counsel certified.