**ALLAHABAD HIGH COURT**

Ram Rakhpal

Vs.

Amrit Dhara Pharmacy

Original Suit No. 2 of 1955

(Desai, J.)

14.12.1956

**JUDGMENT**

**Desai, J.**

1. This is a suit for the removal of an entry of the trade mark Amritdhara from the register of trade marks, for adding a note of disclaimer of any exclusive right to the word Amritdhara to the entry relating to the trade mark in the register and for imposing such limitation or condition on the registration of the trade mark Amritdhara as this court may deem just and proper. It is an admitted fact that on 21-8-1942 Pandit Thakur Dutt Sharma, defendant No. 2, managing proprietor of the Amritdhara Pharmacy Ltd., Dehra Dun, defendant No. 1, made an application No. 3813 before the Registrar of Trade Marks, Bombay, defendant No. 3, for registration of trade mark Amritdhara in class 5 of pharmaceutical substances. The trade mark was advertised in the Trade Marks Journal as required under Section 15 (1) of the Trade Marks Act (Act No. V of 1940), but nobody objected to the registration of the trade mark. Consequently the Registrar registered the trade mark on 16-2-1946 with effect from 21-8-1946. The registration was initially for three years; it was subsequently renewed for 15 years with effect from 21-8-1949. The plaintiff is admittedly the proprietor of the Dardnashik Dawakhana, a pharmacy situated in Moradabad. He
is manufacturing in the pharmacy a drug known as Amrit Sukh-jiwan Dhara.

2. The case of the plaintiff is as follows : The plaintiff has been manufacturing Amrit Sukhjiwan Dhara, under that very name, for more than 50 years and has been advertising it extensively and continually. He got the name and the style registered as a trade mark with some Chamber of commerce in Calcutta in 1929. On the coming into force of the Trade Marks Act, 1940 (to be referred to as "the Act" in the rest of the judgment) he deposited the trade mark before defendant No. 3 on 12-5-1941 as required under Section 85 of the Act and his application No. 13699 for registering his trade mark was pending before him. The defendants 1 and 2 (who will henceforth

be referred to as "the defendants") prosecuted him in the court of the City Magistrate, Dehra Dun, (case No. 67 of 1951) for the offences of Sections 482 and 486, I. P. C., and the case was pending. In this case the defendants admitted the fact of the deposit of his trade mark with the Registrar. They also filed a suit (suit No. 5 of 1951) against him for (1) damages for infringement of their trade mark Amritdhara by manufacturing and selling Amrit Sukhjiwan Dhara and (2) an injunction to restrain him from doing so in the court of the District Judge, Saharanpur. On account of these proceedings pending against him he considered himself aggrieved by the entry of the defendants' trade mark in the register. The trade mark was not register able at all because it does not contain any of the essential particulars mentioned in Section 6 of the Act; the words "Amrit" and "dhara" are not invented words; they are words used in books and the name Amritdhara has been used for medicines for long. They have direct reference to the character or quality of the medicine, are laudatory and are not a distinctive mark, inasmuch as they have not been adapted to distinguish the defendants' medicine from similar medicines manufactured by others. The trade mark consists of words, the use of which is likely to deceive or to cause confusion and is contrary to the law contained in Section 6 of the Act. The words are publici juris and their use is disentitled to protection in a court of justice. The main constituents of the medicine Amritdhara, pepermint, campher and thymol, are known to a large number of people in the country and the prescription is mentioned in a number of Ayurvedic books. The name Amritdhara is the commonly used and accepted name of a single-chemical compound, but the chemical or technical name of the compound is not known. The defendants secured registration from defendant No. 3 by deceiving him by misrepresenting to him that they had been manufacturing the medicine Amritdhara continuously since 1901 and had spent 10-12 lakhs of rupees on its advertisement. They manoeuvred in getting the fact of their applying for registration concealed from the plaintiff in spite of knowing about his deposit of his trade mark No. 13699. Defendant 3 also committed illegally in registering the trade mark without giving him a notice of the defendants' application which he was bound to give under the rules framed by Government under the Act. He did not object to the registration of the defendants' trade mark because he was not aware of their application. Since the entry of the trade mark in the register was made wrongly, it should be removed from the register; it is not his case that the entry continues wrongly in the register.

3. The case of the defendants is as follows: Sri Thakur Dutt Vaid invented the medicine and called it Amritdhara in 1901. In 1907 he got it registered under Act No. III of 1877. The trade mark Amritdhara was rightly registered. It is not descriptive and has no direct reference to the nature or quality of the medicine which is used for toothache, headache, stomachache etc. It is not laudatory. It is an invented word. It is also a distinctive mark and all medicines bearing names of which Amrit or dhara is a part are taken by the public to be Amritdhara. No deception was practised by the defendants when applying for the registration of the trade mark. It is not contrary to any law, is not likely to deceive or cause confusion and is not disentitled to protection in a court of justice. Though some people might have guessed some of the ingredients used in Amritdhara, its exact composition is not known to anybody. People only make conjectures about

its exact composition. The trade mark is not publici juris and in any case it was not at the time of the registration. Amritdhara is a fancy name and there is no medicine of that name at least having the same qualities and in liquid form. It is not true that the plaintiff has been manufacturing Amrit Sukhjiwan Dhara for the last 50 years. In his affidavit before the registrar he had said that he had been manufacturing it since 1924. The defendants came to know of the manufacture of the medicine by the plaintiff in 1951 and at once prosecuted him and filed a suit against him in the courts at Dehra Dun and Saharanpur respectively. The application of the defendants for registration of the trade mark was advertised in the Trade Marks Journal and that was sufficient compliance with the law; the registrar was not bound to give a notice to the plaintiff of the application. The plaintiff had not deposited his trade mark with the registrar before 21-8-1942 but even if the registrar was bound to give notice to him of the defendants' application, his failure to do so did not affect the registration. The registration of the trade mark had, after the expiry of seven years from the date of registration became valid in all respects and could not be expunged from the register under Section 46. Amritdhara was not the commonly used and accepted name of a single chemical compound. The plaintiff was not an aggrieved person within the meaning of Section 46 of the Act; even if he had been an aggrieved person on account of his applying for registration of his trade mark, he ceased to be so on his application being dismissed by the registrar. In the end special costs were asked for.

4. In reply it was stated by the plaintiff that he could not say since when the defendants had been using the trade mark continuously; he said, however, that they were doing so since 25-2-1937. He denied that the medicine was invented by the defendants or that they were carrying on business since 1901. He denied that the defendants came to know of his medicine Amrit Sukhjiwan Dhara only in 1951 and asserted that they came to know about it in 1924 at least when he filed the affidavit before the registrar. He pointed out that the defendants did not claim that they invented the name Amritdhara. He denied that 10-12 lakhs of rupees were spent by them on advertising Amritdhara. Finally he denied that proceedings for rectification of the register under Section 46 (2) of the Act are legal proceedings within the meaning of Section 24 and that the expunction of the trade mark from the register was barred by the provisions of Section 24.

5. The registrar did not appear before the Court but sent a written statement. He referred to (1) the affidavit filed before him by Sri Thakur Datt Vaid affirming that the name of Amritdhara was invented by him in 1901 and had since then been continuously used, that he had spent 10-12 lakhs of rupees on advertising the medicine, that the trade mark had become a household word for the said medicine manufactured by him and that he had taken proceedings against persons infringing the trade mark in 1915 and subsequently and (2) the affidavit filed by the plaintiff for registration of the trade mark Amrit Sukhjiwan Dhara in which he affirmed that he had been using the trade mark since 1924 as a distinctive trade mark in respect of medicines and that the goods bearing the trade mark Amrit Sukhjiwan Dhara had come to be known to be the goods manufactured by him. He stated that the application of the defendants was advertised in the Trade

Marks Journal in compliance with the provisions of Section 15 (1) of the Act, that none opposed the registration, that seven years from the original registration of the trade mark expired on 21-8-1949, that the validity of the registration could not now be challenged except on the ground that the registration was obtained by fraud or that the trade mark offends against the provisions of Section 8, that at the time of the registration it was not proved before him that Amritdhara was publici juris and that the plaintiff applied on 22-1-1949 for registration of the trade mark Amrit Sukhjiwan Dhara which was claimed not to have a direct reference to the character or quality of the medicine.

6. The following issues were framed :

1. Does "Amritdhara" contain an invented word, or has it any direct reference to the character or quality of the drug, or is it a distinctive mark ?
2. Is the trade mark "Amritdhara" likely to deceive or cause confusion ?
3. Is the medicine known as "Amritdhara" a 'Publici jurisi, and if so, is the trade mark disentitled to protection in a court of justice ?
4. Is the use of the trade mark "Amritdhara" contrary to any law for the time being in force ?
5. Is "Amritdhara" the name of a single chemical compound ?
6. Is the trade mark "Amritdhara" a commonly used and accepted name of a single chemical compound ?
7. Is a proceeding under Section 46 (2) of the Trade Marks Act, a legal proceeding within the meaning of Section 24 ?
8. Are the statements of the opposite party made to the Registrar that he started business in 1901, that he has been continuously using the trade mark "Amritdhara" since then and that he has spent Rs. 12,00,000/- on advertisement, false ? Does his making these false statements amount to a fraud within the meaning of Section 24 of the Act, and did the opposite party obtain registration of the trade mark by such a fraud?
9. Did the applicant deposit his trade mark before the Registrar on 12-5-1941?
10. What is the effect of the Registrar's not giving a notice to the applicant as required under Rule 23 of the Trade Marks Act?
11. To what relief, if any, is the applicant entitled?

7. Under an order made by me all the affidavits containing the pleadings are to be treated as evidence. The parties also produced documentary evidence and examined witnesses. The plaintiff examined only one witness, his son Sita Ram. He deposed about the manufacture of Amrit Sukhjiwan Dhara, the civil suit and the criminal case filed against him by the defendants and about the ingredients of the Amritdhara. He admitted that his application for registration of his trade mark made on 22-1-1949 has been dismissed and that every application for registration is advertised in the Trade Marks Journal. The defendants examined Sri Thakur Dat Sharma only. He deposed that he introduced the medicine Amritdhara in 1901, that in the beginning its name

was Amrit ki Dhar, that the name was changed to Amritdhara two years later, that the trade mark was registered in 1907 under Act No. III of 1877, that the word Amritdhara became associated with him and his medicine prior to 1915, that the medicine contains ingredients in addition to the three ingredients mentioned above, that what he meant by saying that he invented the word Amritdhara was that it was never used for a medicine previously, that there are medicines referred to in standard books on Ayurvedic system consisting of the word "Amrit" joined with another word and that the trade mark Amritdhara has been distinctive since 1903.

8. "Trade mark" is defined in Section 2 (1) to meant a mark used in relation to goods for the purpose of indicating a connection in the course of trade between them and some person having the right as a proprietor (or as a registered user) to use the mark. All registered trade marks are to be entered in the register of trade marks, vide Section 4. A person claiming to be a proprietor of a trade mark and desiring to have it registered is required by Section 14 to apply in writing to the registrar, who, subject to the provisions of the Act, may refuse the application or may accept it absolutely or subject to such amendments, additions or limitations, if any, as he may think fit.
The provisions which restrict the discretion conferred by Section 14 are those contained in Sections 6 to 13. In this suit I am concerned with the provisions of Sections 6, 8 and 9 only. When an application for registration has been accepted. the registrar is required by Section 15 to advertise it in the prescribed manner. If any person wants to oppose the registration, he must give notice in writing to the registrar during the prescribed time from the date of the advertisement. The registration of the trade mark is originally for a period of seven years but may be renewed for a period of 15 years from time to time, vide Section 18. It is laid down in Section 23 that in all "legal proceedings" relating to a trade mark registered under the Act the fact that a person is registered as proprietor thereof shall be prima facieevidence of the validity of the original registration and in Section 24, that

> "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 a registration was obtained by fraud, or unless the trade mark offends against the provisions of Section 8." "Any person aggrieved.....by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register.....may apply.....to a High Court or to the Registrar, and the tribunal may make such order for expunging or varying the entry as it may think fit"; this is Section 46 (2). Section 6 lays down that a trade mark shall not be registered unless it contains at least one of the five essential particulars mentioned in paragraphs (a), (b) etc. It is not the case of the defendants that the trade mark contains the particulars mentioned in paragraph (a) or (b). Paragraph (c) contains "one or more invented words", paragraph (d) "one or more words having no direct reference to the character or quality of the goods" and paragraph (e) "any other distinctive mark", provided that if it is a word, other than an invented word or a word having no direct reference to the character or quality of the goods, it shall not be registrable except upon evidence of its distinctiveness.

Under the Act only a trade mark can be registered, i.e., the subject-matter of registration must be a trade mark as defined in the Act. But the Act does not permit every trade mark to be registered; a trade mark is required to possess certain qualifications before it can be registered and certain trade marks are absolutely prohibited from being registered. The qualification that a trade mark must possess are mentioned in Section 6, which absolutely prohibits registration if there is an absence of any of the essential particulars. It is to be noted that the section does not enjoin registration merely because it consists of one of the particulars and the Registrar's discretion to refuse registration granted by Section 14 is not taken away by Section 6.

Another fact to be noted is that a trade mark is eligible for registration if it consists of any one of the particulars and is not required to consist of more than one of the particulars. In *Eastman Photographic Materials Co. Ltd. v. Comptroller-General of Patents, Designs, and Trade-Marks*[1], ("Solio" case), it was pointed out by Lord

[1]1898-15 RPC 476 : 1898 AC 571

Herschell that the particulars designated under the paragraphs (a) to (e) are treated as separate and distinct and that there is no warrant for transferring the words found in any of these particulars to any other of them. Lord Shand stated at page 584 :

> "The separation of the clauses in the section of the statute in question by the letters 'd' and 'e' and the alternative participle 'or' satisfy me that the two clauses are independent and to be construed as independent provisions - so that the terms of (e) do not control or affect the terms of (d)."

If the subject-matter of registration is a trade mark and contains one invented word, it is eligible for registration even if the trade mark does not contain any other particular, or it was not adapted to distinguish the applicant's goods from others,' It is stated by Kerly on Trade Marks, seventh edition, page 105,

> "Although the paragraphs of Section 9 (1) are to be considered as independent in each case the mark proposed to be registered must not only fall within the terms of at least one paragraph, but must also be distinctive."

Section 9 (1) of the English Trade Marks Act, 1938, is exactly similar to Section 6 of our Act minus the proviso at the end. There is no warrant for the observation that a trade mark must not only contain any one of the particulars but also be distinctive. A trade mark is required to be distinctive only if it is eligible for registration under para. (e) but not if it is eligible for registration under any other paragraph. If the subject - matter consists of any of the particulars mentioned in paragraphs (a) to (d) but does not amount to a trade mark, there is no question of registering anything and there would be no occasion for considering the provisions of Section 6 at all. Some idea of distinctiveness, whether adapted or acquired, is there in the definition of 'trade mark', and an invented word is not eligible for registration unless it is used for the purpose

of indicating (or so as to indicate) a connection between the goods and the applicant. As I would show subsequently, if an invented word is used to describe an article invented or manufactured for the first time and not to indicate a connection between it and the applicant for registration, it would not be a trade mark and no question of registering would arise; "linoleum" and "gramophone" are examples of such invented words. If a trade mark consists of a word that is not invented i.e., of a word belonging to the language, it may be a word having no direct reference to the character or quality of the goods in which case it is eligible for registration under paragraph (d), or a word that has such reference, in which case it would be registrable only if it is a distinctive mark within the meaning of paragraph (e). Sub-section (2) explains what is meant by a distinctive mark; it means a mark adapted to distinguish the goods with which the applicant for registration is or may be connected in the course of trade from goods in respect of which no such connection exists. If a trade mark is inherently adapted to distinguish the applicant's goods, it may be held to be so adapted to distinguish. Or if by reason of the use of the trade mark or of any other circumstance it has in fact been so adapted to distinguish, it can be held to be so adapted to distinguish. This is the purport of sub-section (3). The proviso to it deals with old trade marks e. g., trade marks continuously used from a date prior to 25-2-1937 up to the date of the application for registration; in respect of them it is not essential for the applicant to prove that they were adapted to distinguish and the Registrar may register them on being satisfied from evidence that they have acquired distinctiveness.

A trade mark may consist of a mark or of a word and if it consists of a word, other than an invented word or a word having no direct reference to the character or quality of the goods alleged to be registrable under paragraph (e), the applicant is required to prove its distinctiveness. This confirms what I said earlier that distinctiveness is an essential requisite of a trade mark only if it is sought to be registered under Paragraph (e) and consists of a word. But if the trade mark is an old trade mark, it need not be proved to have been adapted to distinguish, if it in fact has distinguished the applicant's goods from others', it may be registered under paragraph (e). There is a well recognized distinction between a trade mark adapted to distinguish and a trade mark which in fact distinguishes; the former is a distinctive trade mark but not the latter. In re; Lea (R. J.) Ltd's Application. (1931) 1 Ch 446 at p. 463 ("Boardman's Mixture" case), Hamilton L. J., observed :

> "The mere proof or admission that a mark does in fact distinguish does not ipso facto compel the judge to deem that mark to be distinctive. It must be further 'adapted to distinguish', which brings within the purview of his discretion the wider field of the interests of strangers and of the public".

In *In re Leopold Cassella and Co*[2]*.,* Buckley L. J., with regard to the words "adapted to distinguish the goods of the proprietor of the trade mark from those of other persons" said at page 244 :

> "By these words the Act seems to me to contemplate that the word which it is sought to

register is one which, as a word, is adapted to distinguish the goods, and not a word which may by user acquire the capacity of distinguishing the goods".

This observation was approved of by Kennedy L.J., in *W. and Sharpe Ltd. v. Solomon Brothers Ltd*[3]*.,* See also in the matter of India Electric Works Ltd., 49 Cal WN 425, ("India Fans" case), at pages 427-428 and *Bailey and Co v. Clark Son and Morland, Ltd*[4].. Distinguishing the applicant's goods from others' goods is what is known in the English law as the secondary meaning or significance and in the American law as the special significance. In the Restatement of the Law of Torts, Volume III, paragraph 716, at page 559, it is stated :

"This special significance, once acquired, is thereafter its primary meaning in the market, though lexicographically it may have an earlier, different meaning. Therefore, a designation may become a trade name though in its original meaning it is simply a descriptive term."

In the *Cellular Clothing Co. v. Maxtor. and Murray*[5]*,* ("Cellular" case), Earl of Halsbury I. C. referred to "the secondary meaning which the pursuers
seek to affix to it as denoting goods manufactured or sold by themselves". In the
*Canadian Shredded Wheat Co. Ltd. v. Kellogg Co. of Canada Ltd*[6]*.,* , it was pointed

[2](1910) 2 Ch 240( 'Diamine' case) [4](1938) 55 RPC 253 at p. 263 [6] AIR 1938 PC 143 at p. 147
[3](1915) 84 LJ Ch 290 ("Classic" case) [5](1899) AC 326

out that the acquisition of secondary meaning consists of conveying that the name has
become distinctive of a particular manufacturer. An invented word has no meaning : whatever meaning it acquires is its first meaning, but it may be either to describe the goods to which it is applied, in which case it is not a trade mark, or goods of a particular person, in which case it is. A word belonging to the language, whether or not having reference to the character or quality of the goods, has a primary meaning assigned to it in the vocabulary; if it acquires a secondary meaning, viz., that of goods manufactured by a particular person, it becomes registrable. Even a name can acquire a secondary meaning.

"National" has been held to be a registrable trade mark for cash registers (see Re. National Cash Register Co.'s Application, (1917-34 RPC 354) (HI), 43 Empire Digest, 152), "regimental" for cigarettes (See *In re Imperial Tobacco Co.'s Trade Marks*[7]*,* "Quaker" for whisky (see Re. Ellis and Co.'s Trade Mark, ((1904) 21 RPC 617 (II), 43 Empire Digest, 199), "radiation" for gas appliances (See Radiation Ltd.'s. Application, 47 RPC 37, referred to by Kerly at page 166) and "sheen" for sewing cotton (J. and P. Coats, Ltd.'s Application, 53 RPC 355 cited by Kerly at page 150); all these words belong to English language and have certain (primary) meanings, but the trade marks consisting of these words were held registrable on account of their having acquired secondary meanings, viz., 'cash registers manufactured by X", "cigarettes manufactured by Y" etc.

Not all common words, i. e., words existing in the lexicography, can acquire a secondary meaning; some words are incapable of acquiring it, for instance ordinary laudatory words, or words which form part of the common stock of English language and ought to be open to the whole world and cannot be monopolized by any individual. In *In re Joseph Crosfleld and Sons Ltd*[8]*.,* ("Perfection" case), Cozens-Hardy M. R. said at pages 141-142 :

> "There are some words which are incapable of being so adapted, such as 'good', 'best' and 'superfine'. They cannot have a secondary meaning as indicating only the goods of the applicant. There are other words which are capable of being so adapted, and as to such words the tribunal may be guided by evidence as to the extent to which use has rendered the word distinctive, It is easy to apply this sub-section to geographical words, and it is possible to suggest words having direct reference to character or quality which might be brought within it. But an ordinary laudatory epithet ought to be open to all the world, and is not, in my opinion, capable of being registered."

In the "Classic" case, the word "classic" was held by Kennedy L. J., to be incapable of being treated as adapted to distinguish or as having a secondary meaning as indicating only the goods of the applicant. He observed : "It appears to up to be authoritatively settled that there are certain kinds of words that cannot be treated as adapted to
distinguish". He referred to the case Registrar, Trade Marks v.W. and G. Du Cros.

[7](1918) 2 Ch 207

[8](1910) 1 Ch 118

Ltd., (1913) AC 624 (W. and G." case), where Lord Parker said at page 635 that

> "both the Legislature and the Courts have always shown a natural disinclination to allow any person to obtain by registration under the Trade Marks Act a monopoly in what others may legitimately desire to use."

In the Diamine Case (C) (supra) Buckley L.J., laid down that some words including laudatory epithets are not capable of being registered but ought to be open to all the world. He found it impossible to say that a laudatory epithet cannot acquire a secondary meaning, but thought it to be incapable of being adapted to distinguish the goods. In *In re Berna Commercial Motors Ltd., ("Berna" case)*[9]*,* J., observed :

> "Laudatory epithets are, in my opinion, in a totally different class, because necessarily they cannot have acquired a simple secondary significance, and also because it must always be open to tradesmen to apply laudatory epithets to their own goods, and it would be monstrous to deprive them of the privilege of so describing their goods when in competition with rival traders", (p. 419). Even if it be said that a laudatory epithet can acquire a secondary meaning, the policy of the law is not to protect a trade mark

consisting of a laudatory epithet. Kennedy L. J., said in the "Classic" case at page 295 : "It is apparent from the history of trade marks in this country that both the Legislature and the Courts have always shown a natural disinclination to allow any person to obtain by registration under the Trade Marks Act a monopoly in what others may legitimately desire to use". If a trade mark consists of a laudatory epithet, it would be disentitled to protection in a court of justice within the meaning of Section 8 (a) and the Registrar would have no discretion to register it.

Venkateswaran in his book on the Trade Marks Act writes at page 151 that the proviso is unnecessary, basing the observation on the fact that the English Trade Marks Act of 1905 had omitted a proviso in respect of old trade marks similar to the provisos existing in the earlier Acts of 1875 and 1883. With great respect to the learned commentator I do not think that the proviso in our Act can be said to be redundant. The effect of the proviso is that the Registrar must not refuse to register an old trade mark, claimed to be registrable under paragraph (e), only on the ground that it was not adapted to distinguish. If the proviso were not there, an old trade mark not adapted to distinguish and not coming within any other paragraph of Section 6 (1) would not have been resistrable even though in fact it had distinguished the applicant's goods from others; under the proviso it is made registrable. The proviso does away, in relation to old trade marks, with the distinction pointed out above, between a trade mark adapted to distinguish and a trade mark which in fact distinguishes without being so adapted. The relevant words in Section 9 of the English Act of 1905 are different from those of Section 9 of the English Act of 1938 and of sub-sections (2) and (3) of Section 6 of our Act. The proviso merely permits registration of a trade mark upon evidence of its acquired distinctiveness: under Section 9 of the English Act of 1905 a trade mark could be registered on the ground of its acquired distinctiveness and hence there was no necessity of any proviso. Up to

[9](1915) 84 LJ Ch 416

1938 a trade mark could be registered in England on the ground of its acquired distinctiveness; the Act of 1938 changed the law and made a trade mark falling within paragraph (e) registrable only upon evidence of its being adapted to distinguish the goods. Since the Parliament for some reason decided not to register after 1938 trade marks on the ground of acquired distinctiveness and old trade marks could have been registered on the ground of acquired distinctiveness up to 1938, there was no occasion for inserting in the Act of 1938 a proviso similar to ours. There was a need for the proviso in India where there was no Trade Marks Act prior to 1940.

9. The date at which the distinctiveness of a trade mark must be established is the date of the application for registration; Kerly, at page 138.

10. Sections 8, 9 and 10 which forbid registration of certain trade marks necessarily apply to trade marks which otherwise would have been registrable. They impose disqualifications which can exist side by side with the qualification mentioned in Section 6. A trade mark may be

qualified for registration under Section 6 and yet be disqualified under Section 8, 9 or 10. If a trade mark does not possess the necessary qualification and is, therefore not registrable, there would be no occasion for considering the provisions of these sections. Section 9 of the English Trade Marks Act, 1905 is similar to our Section 6 and Section 11 is similar to our Section 8. In the case of Imperial Tobacco Co., Swinfen Eady M.R. observed at page 223 with reference to Sections 9 and 11 of the Act of 1905 as follows :

> "Section 11 ..... is intended to exclude from registration what would otherwise be included in or covered by Section 9 .....It does not extend to a mark which was not originally entitled to protection because it did not contain or consist of one of the essential particulars under Section 9 ....."

Warrington, L.J., put the matter thus at pages 228-229:

> "The Legislature has, I think, under Section 11 inserted a provision in the nature of a qualification of, or proviso to, Section 9 - that is, you shall not register certain matters which may come within Section 9, but which are open to objection on other grounds. To say that Section 11 prohibits the registration of a mark which because it is not within Section 9 is not entitled or is disentitled to protection in a Court of justice seems to me to attempt to do that which is unnecessary, because such a matter could not have been registered by reason that it did not come within Section 9, and therefore there was no occasion to prohibit it. It seems to me that the section must be a prohibition against registering something which but for the prohibition might have been registered".

He added at page 229 that Section 11 "points to something which has inherently, a vice disentitling it, according to the general principles of law which are acted upon in any Court of justice, from protection in a court." As stated by Kerly at page 237 "the section is directed to some positive objection to registration and not to mere lack of qualification." The words "contrary to any law" in paragraph (c) of Section 8 must be construed in the light of what is said above; the trade mark must be contrary to some law other than that contained in Sections 6, 8, 9 etc., of the Act. If a trade mark is not registrable under any of the provisions of the Act itself, there would be no need of enacting Section 8 (c). In the Imperial Tobacco Co. case, Swinfen M. R. rejected the contention that a trade mark that ought not to have been registered as coming within Section 9 of the 1905 Act is contrary to any law within the meaning of Section 11 of the same Act. Similarly the words "otherwise be disentitled to protection in a Court of justice" in paragraph (a) refer to absence of qualification other than that contained in Section 6 of the Act and to disqualifications other than those contained in Sections 8, 9 etc., of the Act. If a trade mark consists of a matter which is blasphemous or obscene or indecent or seditious, it would not be protected by a court of justice.

In *In re Anderson's Trade Mark*[10], ("Lidrig's extract of Meet" case) (O) Chettey J., thought that "the words or otherwise are sufficient to exclude the registration as part of a trade mark of words

which are merely descriptive of the article." But in the later case of Imperial Tobacco Co. (I). Swinfen Eady M. R. rejected the contention that a trade mark is not entitled to protection in a court of justice on the ground that it was an attempt on the part of an individual trader to monopolize a device which was the common property of the public.

11. Now I shall take up the issues. I shall begin with the less controversial issues.

12. Issue No. 5.- This issue was not pressed. Not only Amritdhara is a mixture and not a compound but also there is not a single chemical compound which bears the name Amritdhara. The issue is decided against the plaintiff.

13. Issue No. 6.- This issue also is not pressed and for the reasons given above is decided against the plaintiff.

14. Issue No. 4.- This issue was not seriously pressed. There is no law which prohibits the use of word "Amritdhara" in a trade mark. It was conceded that the only law which is contravened by the use of it in trade mark is that contained in Section 6 of the Act. I have explained above that the words "contrary to law" do not mean contrary to law contained in Section 6 etc., of the Act. The issue is, therefore, decided against the plaintiff.

15. Issue No. 2.- Whether a trade mark is likely to deceive or to cause confusion or otherwise be disentitled to protection in a court of justice is a question of fact; see Kerly on pages 237 and 238. The plaintiff has led no evidence on this issue; his affidavits merely contain conclusions that the trade mark is likely to deceive etc., and are not supported by any facts. It was argued by Sri D. P. Agarwala that the trade mark Amritdhara is likely to deceive by making people think that it contains nectar or has the efficacy of nectar and that it is likely to be confused with Amrit Sukhjiwan Dhara. It was also contended that text books refer to many medicines, the names of which contain the word "Amrit" and that people might be deceived into thinking that Amritdhara is one of those text book medicines. In the *Leather-Cloth Co. Ltd. v The American Leather-Cloth Co. Ltd*[11]*.,* Lord Westbury L. C. observed at page 201 :

[10](1884) 26 Ch D 409 at p. 415

[11]1883-33 LJ (NS) Ch 199

> "Where any symbol or label claimed as a trade mark is so constructed or worded as to make or contain a distinct assertion which is false,..... ..... no property can be claimed in it .....The sale of an article stamped with a false statement is protanto an imposition upon the public."
>
> "Diamine" was applied to substances even though they did not contain any amine groups and, therefore, the use of the word was held by Cozens-Hardy M. R. to be misleading and deceptive: vide "Diamine" case (supra). In *Eno v. Dunn*[12]*,* Lord Watson was of the opinion that the use of the words "Fruit salt" by Dunn for his baking powder might have the effect of deceiving the public. Eno's Fruit Salt is an effervescent drink and though there can be no risk of any member of the public confusing it with Fruit Salt Baking

> Powder, there might be a supposed connection between the two articles in the minds of many persons who might assume that the baking powder has been manufactured with Eno's Fruit Salt and purchase it in that belief.

In *Siegert v. Findlater*[13]. ("Angortura Bitters" case) R), it was held that it was fraud on the part of Meinhard to class his stuff as Angostura Bitters when Aromatic Bitters prepared by Siegert had already come to be known as Anostura Bitters. Fry J., observed at page 814 that the phrase "Angostura Bitters" meant in England a bitter of the kind made by Siegert where as the bitter made by Meinhard was not of that kind but distinct from it. In the "Perfection" case, Swinfen Eady J., was of the opinion that the use of the word "perfection" for soap might be misleading if subsequently a vastly superior soap is produced by another manufacturer and more nearly attains perfection than that of Messrs. Crosfield. FletcherMoulton L. J., on the other hand observed at p. 149 :-

> "The use of inordinate laudation of his goods by a trader is too deeply rooted and too ineradicable not to be well known to all the public, and I do not believe that any person buying soap would suppose that it was perfection merely because the maker calls it so".

Farwell L. J., said at page 153 that the words "calculated to deceive" do not require any fraudulent intent and that it is sufficient if the tribunal thinks them calculated to deceive. Since this trade mark was passed by a Government department like the Board of Trade, he thought that it might well mislead thousands of poor people buying the soap into the belief that the Government department had inquired into its merits and had been satisfied that it was "perfection". In the same case the word "Orlwoola" if applied to goods not wholly made of wool was held to be a mis-description so certain to deceive that its use would hardly be otherwise than fraudulent. "Livron" was the registered trade mark of a tonic medicine manufactured by Boots Pure Drug Company, Ltd., the company invented the name from the words "liver" and "iron". There was, however, at the date of the registration a town in France called Livron, in which Societe Des Usines Chimiques Rhone-Poulenc had a factory and carried on a business similar to that of Boots Pure Drug Company Ltd. It was held In re, Application of The Societe Des Usines Chimiques Rhone-Poulenc : Re Trade Mark, "Livron", Of Boots Pure Drug Co. Ltd., (1937) 4 All England Reporter

[12](1890) 15 AC 252

[13](1878) 7 Ch D 801

23 ("Livron" case), that the use of the word "Livron" by the Boots Pure Drug
Company was calculated to deceive "having regard to the existence in a place of the same name, of a company carrying on the same business, and manufacturing articles of the some class (vide Sir Wilfried Greene, M. R. at page 30). The only false statement or suggestion said to be contained in the trade mark Amritdhara is that it contains, or has the efficacy of nectar. People

have heard of nectar but I do not think anybody claims to have seen it. It is known to be the food or drink of gods but is not known to exist on the earth. I do not think anybody is at all likely to be deceived into thinking that Amritdhara is made up of nectar or has any concern with it.

> "Amrit" is a part of many names of medicines and people have been used to names of medicines containing it. People who know what nectar is also know that it is not to be found on the earth and that the medicine does not contain it. It is true that there need not be actual proof of anybody's being deceived and that a tendency to deceive is enough; the words used in the section themselves are "likely to deceive". The trade mark, in order to be disqualified, must, however, be likely to deceive, and I am unable to say that Amritdhara is of that nature.

16. Confusion that is sought to be prevented by Section 8 is confusion arising from the mode of using the trade mark or from its similarity with another trade mark or from any other particular trade mark being known in the market by a particular name. Confusion may arise from the use of a trade mark for a particular stuff on account of its identity with another trade mark for quite a different stuff; see In Re. National Machinery Company's Application. (1941) 58 RPC 128 - (1941) Mews Digest, Column 244. There were no trade marks in existence in 1946 with which the trade mark Amritdhara might be confused by the public. I was not referred to anything in the mode of using the trade mark which might cause confusion. The issue, therefore, is decided in the negative.

17. Issue No. 1 :- The trade mark Amritdhara consists of just one word; it is not at all an invented word. It is a compound word formed out of the words "amrit" and "dhara", both of which are common words to be found in dictionaries and have meanings which are known to the public. The word "Amritdhara" may not be found in a dictionary, because a dictionary does not contain all compound words. But the absence of a word in a dictionary is not the test of its being an invented word. A word formed by combining two words can never amount to an invented word even if they are mis-spelt or truncated before being combined; a word like "amritdhara" formed by combining two words without mis-spelling or truncating them can still less amount to an invented word. Not only does the word consist of two words which are in common use but also it has a meaning and a meaning that has some reference to the character or nature of the medicine. Even if an ordinary word may be applied in such a manner that the application of it in that manner is fanciful and the word applied in that manner is treated as an invented word, that would be extending the Act which requires an invented word and, in the words of Rigby L. J.

> "If you ask us to extend the Act in that way you must take care that the word taken, if a common ordinary word, is of such a nature that it is obviously unmeaning as applied to the particular case that it is obviously non-descriptive." (Vide in re, Trade Mark No. 58, 405, "Bovril", (1896) 2 Ch 600. Lindley L.J., observed in In re, Farbenfabriken Application, (1894) 1 Ch 645, at p. 652 (V). "Any word which is in fact new, and not what may be called a colourable imitation of an existing word, is.....an "invented

> word" ..... Novelty is, I think, an ingredient in a lawyer's idea of invention. "Kay L. J., observed at page 656.
> "Invented words mean words that have no meaning". A. L. Smith, L. J., said at page 658 that an invented word must be a word coined for the first time. The last two Lord Justices also hold that an invented word is incapable of having any reference to the goods, but they were overruled in this respect by the House of Lords in the "Solid" case (supra).

In In re, Farbenfabriken case "Somatose" (V) as applied to a pharmaceutical powder was held to be not an invented word because the word had some reference to the character or quality of the powder which was made of meat and could be easily absorbed into the body : but the House of Lords held that the word "solio" is an invented word even if it suggests some reference to the character of the articles. In In re, La Societe le Ferment's Application. (1912) 81 LJ Ch 724, Cozens-Hardy, M. R. held that "lactobacilline" is an invented word and is registrable as such even though it has direct reference to the character of the lactic ferment. In the old English Act prior to the Trade Marks Act, 1905 the words used were "fancy words" and not "invented words". For some reason the provision that a trade mark should consist of a fancy word was held to be unsatisfactory and the law since 1905 is that it must consist of an invented word. In In re, Van Duzer's 'Trade Mark : In re, Leaf's Trade Mark, (1887) 56 LJ Ch 370, it was held that the word "Melrose" as applied to a hair restorer and the word "electric" as applied to a velvet respectively were not fancy words and Cotton, L. J., said at page 375, "it must be a fancy word; and, in order to come within that description, it must be a word which obviously cannot have reference to any description or designation of where the article is made, or what its character is". "Melrose is the name of a place and it was said to be probable that Melrose Hair Restorer might be thought to have been manufactured at Melrose. The word "electric" was held to be a word of description and therefore not a fancy word. Lindley L. J., said at page 377 :-

> "To be a fancy word ..... the word must either have, to ordinary English people..... .....no meaning, like the word 'Eureka' or the word 'Aeilyton' or if it has any meaning at all, it must be obviously meaningless when used as a trade mark. If it is not obviously meaningless, it appears to me it has not the characteristics of a fancy word".

Later on Lindley, L. J., substituted the words "obviously non-descriptive" for the words "obviously meaningless", see the observation of Cotton L. J., in *Waterman v. Ayres*[14], In this case the word "reversi" as applied to a game in which the play consisted of taking or reversing the opponent's counters was held to be not a fancy

[14](1888) 57 LJ Ch 893

word because it was not intended to describe the game. Similarly in In re, Talbot's Trade Mark, (1894) 63 LJ Ch 264, the word "emolliolorum" was held to be not a fancy word because it conveyed to the mind of the ordinary Englishman that the leather dressing would act by softening the article to which it was applied. An invented word is not quite the same thing as a fancy word and while a common word may amount to a fancy word where it is not descriptive and can have

no meaning whatsoever with reference to the article to which it is applied, it cannot be an invented word. The word "Diabolo" as applied to a top to be used in a game which was a revival of a game known in France as "le diable" and in England as "the devil on two sticks" was held to be not an invented word. In *Philippart v. Whitely Ltd., "Diabolo*[15]*"* Parker J., observed at p. 279. "To be an invented word, within the meaning of the Act a word must not only be newly coined in the sense of not being already current in the English language, but must be such as not to convey any meaning, or at any rate any obvious meaning to ordinary Englishmen. It must be a word having no meaning, or no obvious meaning, until one has been assigned to it". Since the word "diabolo" was likely to be thought to contain a reference to the devil. It was held to lack one of the required characteristics of an invented word. If a word was invented or selected because of the probability of its suggesting to an ordinary Englishman the devil, the conclusion that it would carry this suggestion was necessarily corroborated. The word so coined was invented with the object of making the suggestion that the revived game was identical with the old game of "le diable" and, therefore, it was not an invented word. In the "Solio" case, Lord Herschell conditionally agreed with A. L. Smith L. J., that an invented word is incapable of having reference to the character or quality of goods, because it is an entirely new unknown word and observed at page 581 that" 'an invented word' has of itself no meaning until one has been attached to it." Later he stated :

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> "I do not think the combination of two English words is an invented word, even although the combination may not have been in use before." Lord Macnaghten observed at page 583 :
>
> "The word must be really an invented word. Nothing short of invention will do.....If it is an invented word, if it is 'new and freshly coined'.....It seems to me that it is no objection.....that it may contain a convert and skillful allusion to the character or quality of the goods. I do not think that it is necessary that it should be wholly meaningless." Lord Shand put the matter thus at page 585 :
>
> "There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required; but words, I think, should be clearly and substantially different from any word in ordinary and common use. 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."

In *Howard Auto-Cultivators, Ltd. v. Webb Industries Proprietary Ltd*[16]*.,*

[15]1903-2 Ch 274

[16]72 CLR 175(Z-2)

the High Court of Australia refused registration of the word "Rohee" in respect of a cultivating implement, being of the view that it was not an invented word but merely a compounded

combination of the known words "row" and "hoe". Rich J., relied upon the "Diabolo" case (Z-1) and observed that an invented word must not carry any meaning or any obvious meaning to a man in the street, and Dixon J., stated at page 181 :

> "The fact that a word is not included in the dictionaries is not enough to show that it is an invented word.....The materials from which such a word has been fashioned cannot be neglected and if it is compounded of elements of which the source is manifest and the intended meaning is transparent, it becomes a question whether there is anything more than a colourable attempt at reproducing some of the sounds and all the sense of an expression belonging to common speech."

In the "Cellular" case Earl of Halsbury, L.C., agreed with the observation that "an invented word has either no meaning at all, or no meaning in relation to the goods which it denotes", while Lord Shand said at page 339 :

> "The idea of an invented or fancy word used as' a name is that it has no relation, and at least no direct relation, to the character or quality of the goods which are to be sold under that name. There is no room whatever for what may be called a secondary meaning in regard to such words."

The word "Phosphotone" as applied to a nervine tonic was held to be not invented word : see *Chemical Industrial and Pharmaceutical Laboratories, Ltd. v. P rasanta Rotan Dhan*[17]*,*

18. My conclusion is that "Amritdhara" is not an invented word. It is a mere combination of two words in common use in Hindi. Even if there were any invention, it consists only in joining the words together but not so as to produce a word with no meaning at all. The word "amritdhara" has not only a meaning but also a meaning with reference to the medicine to which it is applied; it suggests a liquid medicine to be taken internally and having the power of curing a number of diseases as nectar is supposed to do. The word "Chocaroon" in respect of a sweetmeat of the same character as chocolate macaroon is an invented word as held in Williams and Co.'s, Ltd. Application, Re, (1917) 86 LJ Ch 273 (Z-4) : "Lactobaciline" also is an invented word as held in (1912) 81 LJ Ch 724 (W). But the word Amritdhara cannot be placed on the same footing and held to be an invented word. In the end I may mention that defendant No. 2 deposed that he claims the word Amritdhara to be invented simply because it was never used for a medicine previously; this is not the test of an invented word. An invented word is a word that never existed previously and not a word that existed but was not applied to a particular article previously.

19. The word "amritdhara" cannot be said to have no direct reference to the character of the medicine to which it is applied. A trade mark registrable under Section 6 (d)

[17] AIR 1950 All 258 (Z-3)

can be an ordinary or common word having some significance, but it must not have any significance in relation to the goods to which it is applied. "It is the significance of the designation in connection with the goods upon which it is used, not its abstract significance, which is determinative"; see Re-statement of the Law, Volume III, paragraph 721. The word "plow" cannot be a trade mark for ploughs but can be a trade mark for tomato juice. That word may have a suggestive significance in connection with the goods does not render it inappropriate for use as a trade mark. "The test is the imaginativeness involved in the suggestion, that is, whether the suggestion is so close and direct that it is apparently descriptive and generally useful in approximately that form to all merchants marketing such foods or is so remote and subtle that, it is fanciful and not needed by other merchants of similar foods" (ib). In the case of Diabolo (supra) the word was held to have reference to the character of a top, because it suggested a kind of article or the use to which it was to be put. It was also selected to suggest of the revived game so identical with the old game of lediable. On the same reasoning the word "Amritdhara", which was selected with the object of suggesting that the medicine was to be taken internally for treatment of ailments, has a reference to the nature of the article which cannot be said to be remote or fanciful. The word "Cellular" as applied to a cloth was held to be descriptive (i. e. having a direct reference to the character or quality of the goods) in the "Cellular' case; so also "Phosphotone", as applied to a nervine tonic in the "Phosphotone" case (Z-3), "Diamine" as applied to a dye in "Diamine" case, "Gramophone" in In re, Gramophone Company's Application, (1910) 2 Ch 423 (Z-5), and "Sheen" as applied to sewing cotton in In re, Coats Ltd., Trade Mark,, (supra).

> "Charm" as applied to hosiery was held to bear direct reference to the character of the goods in In re, Keystone Knitting Mills Trade Mark, (1929) 1 Ch 92 ("Charm" case) (Z-6). "Nectar" was held to have reference to the character or quality of the goods, tea, coffee, and cocoa in In re, Harrisons and Crosfield's Application, (1900) 18 RPC 34 (Z-7).

20. A trade mark may consist of a mark or a word. There is no exclusive right to the mark except in connection with the goods to which it is applied and to prevent deception or mistake. A trade mark does not confer any exclusive right to make or sell the kind of goods donated by the Mark. Unless a person has a patent for his goods, similar goods may be made and sold by anyone. "But the exclusive right to the use of words is much more burdensome to other people than the exclusive right to the use of a mark. A person who designs or adopts a mark to denote his goods imposes no unreasonable burden on rivals in trade by forbidding them from using the same mark to denote similar goods if the public are thereby misled. But to monopolise the use of words imposes a much more serious burden." (Per Lindley L. J., in *Powell v. Birmingham Vinegar Brewery Co*[18]*.,* Consequently limits have been placed upon the right to complain of the use of words; for example a man cannot be permitted to use his own initials as a trade mark, because it would be intolerable to confer upon him the right to prevent other people of the same name from honestly using them to denote their own goods, or if a person uses words which simply describe the kind of the goods he makes or sells, it

[18](1896) 2 Ch 54, at p. 69 ("Yorkshire Relish" case) (Z-8)
would be intolerable to confer upon him the right to prevent other persons from honestly using the same words to describe what they make or sell (ib., p. 69).

21. The difference between paragraphs (c) and (d) of Section 6 (1) is that if a trade mark consists of an invented word, which necessarily means that the word has no meaning in relation to the goods, the question of its having direct reference to the character or quality of the goods cannot possibly arise, whereas if it consists of a common word, i. e., an uninvented word, it must be such a word as has no direct reference to the character or quality of the goods. The reason, as given by Lord Herschell in the "Solio" case (supra) at page 580 is :

> "The vocabulary of the .....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 goods." In the words of Rigby L.J., in the "Bovril" case it must be "of such a nature that it has obviously no meaning as applied to the particular goods that it is obviously non-descriptive "(p. 610) Rigby L. J., also pointed out on the same page that even if a word can be shown that it is, when interpreted, a descriptive word, and if such an idea would not occur to an ordinary buyer, it would not be deemed to be a descriptive word. It is not possible to say that a person who hears of an article Amritdhara would not think that it is a medicine to be taken internally and not likely to do any harm.

22. A descriptive word may be regarded by a purchaser as descriptive even though it describes the goods inaccurately or incorrectly. "The issue is not whether the designation describes accurately but whether it describes" (See Re-statement of the Law, Volume III, paragraph 721, at page 580).

23. If "amritdhara" was not an invented word nor a word having no direct reference to the character or quality of the medicine, it could not be registered unless it was a distinctive mark within the meaning of paragraph (e). It could be distinctive if it was adapted to distinguish the medicine from other medicines, or if it was continuously used as a trade mark from before 25-2 1937 on the ground of its having acquired distinctiveness. Since a distinctive mark cannot be registered except upon evidence of its distinctiveness, it means that it must have acquired distinctiveness prior to the date of the application for its registration. Evidence of its acquiring distinctiveness after the date of the application, or at least after the registration, would be wholly irrelevant. An application for the removal of a trade mark is to be decided as on the date of the registration. In the "Livron" case (supra) it was held that in a case for expunction of a registered trade mark the Court must put itself back to the date of the application for registration and consider the matter on the footing that the full facts were then before the Registrar. In (1938) 57 RPC 137 (1940 Mews Digest Column 299) ("Shredded Wheat" case) the House of Lords held that the relevant date for the evidence of distinctiveness is the date of the application and that no

weight should be attached to such evidence relating to a period after the mark has been registered and the proprietor has thus obtained a monopoly right.

24. Just as a word is not necessarily qualified for registration merely because it is an invented word or a word having no direct reference to the character or quality of the goods and must in addition be a trade mark, as defined in the Act, so also any other distinctive mark must be a trade mark before it can be registered. When the distinctive mark is an ordinary plain word, heavy onus lies upon the applicant to prove that it has acquired distinctiveness; see the "Perfection" case (supra) at page 128 and the "Classic" case (supra) at page 297. Paragraph (e) deals with words which are not registrable under the previous paragraphs and particularly paragraph (d) and, in the words of Farwell L. J., in the "Boardman's Mixture" case (supra)

> "when the Legislature has shown that certain words are prima facie not included, the Court ought to be careful in exercising a discretionary jurisdiction to enlarge such area and should remember that the owner of a trade mark under the Act enjoys a monopoly after seven years for all time".

The reason for the rule as given in the Re-statement of the Law, Volume III, paragraph 715, at page 555, is;

> "Ordinary words were deemed inappropriate because they conveyed a meaning unrelated to the source of the goods and because, as common words of the language, they were deemed to be of the public domain and not subject to exclusive appropriation which might tend to impoverish the language and impede competition."

25. Paragraph (e) deals with any trade mark and is not confined only to a word. Since in the present case I am concerned with a word only, I shall deal with the clause as if it referred only to words. I am also concerned at the moment with only such words as may obviously have some meaning in relation to the goods. A plain common word of the language has the meaning (i.e., the primary meaning) given to it in the vocabulary. If it has only that meaning, it cannot be registered because since it has no other meaning, it cannot possibly mean the goods of the applicant. If it can be registered, it can be only on the ground of its having acquired distinctiveness, that is, a secondary meaning or special significance that the goods belong to the applicant. Even a descriptive word can acquire a secondary meaning, though the onus to prove that it has is heavy. It was recognized by Parker J., in the Gramophone case (Z-5 ) (supra) that a trade mark sought to be registered under paragraph (e) may be a descriptive mark; he stated at page 426 that an application for registration under this paragraph "in effect admits that the word sought to be registered has some direct reference to the character or quality of the goods." In the Cellular case (supra) Earl of Halsbury stated at page 336 that an applicant can prove that "an ordinary word in the English language, properly applicable to the subject-matter of the sale, was one which had so acquired a technical and secondary meaning, differing from its natural

meaning, that it could be excluded from the use of everyone else." Cozens-Hardy M.R. had no difficulty in conceiving that word having direct reference to the character or quality of the goods may be adapted to distinguish vide In re, California Fig Syrup Co., (1910) 1 Ch 130 (Z-9). In the same case Fletcher Moulton J., repelled as fallacious the argument that a descriptive word is inherently incapable of being distinctive; he said that there is no natural or necessary incompatibility between distinctiveness and descriptiveness.

26. Amritdhara though found to have direct reference to the quality could be distinctive, but heavy onus lay upon the defendants to prove to the Registrar that it had done so. The position before me is, however, quite the reverse. The defendants are no longer required to discharge the onus before me ; on the other hand it is for the plaintiff to prove that the trade mark was not registrable. The question before me is not either of registering a trade mark or of restraining by an injunction an infringement of a trade mark, but of removal of a trade mark from the register and that too after the expiry of seven years. The distinction between the two was stressed by Lord Watson in (1890) 15 AC 252 at p. 257, in the following passage :

> "These prohibitory clauses cast upon the applicant the duty of satisfying the comptroller, or the Court, that the trade mark which he proposes to register does not come within their scope. In an inquiry like the present, he does not hold the same position which he would have occupied if he had been defending himself against an action for infringement. There, the onus of shewing that this trade mark was calculated to mislead rests, not on him, but upon the party alleging infringement; here he is in petitorio, and must justify the registration of his trade mark by shewing affirmatively that it is not calculated to deceive. It appears to me to be a necessary consequence that, in dubio, his application ought to be disallowed."

In In re, Leonard and Ellis's Trade Mark ( 'Valvo line" case), (1884) 26 Ch D 288 (Z-9-a). The Earl of Selborne L. C. observed at page 294 :

> "Notwithstanding the general rule that no man is bound to prove a negative. I am disposed to think that the person applying to have it removed must shew some ground for putting on the party who has registered the duty of making out his right to retain it on the register." In the Imperial Tobacco Company's case (supra) Eve J., laid down that the burden of establishing the proposition that a registered trade mark is contrary to law or calculated to deceive lies upon him who asserts it. In the "Charm" case (Z-6) (supra) Lord Hanworth M.R. cast the onus upon the applicant for removal of a registered trade mark to establish his case. See also the case of "Shredded Wheat" (H) (supra).

27. Amritdhara may be said to be a laudatory epithet. "Amrit" means nectar and "dhara" means stream or flow. The medicine is in liquid form and is meant to be taken internally for cure of aches and pains. To call it nectar or stream of nectar is nothing but to exaggerate its quality. As a

laudatory epithet it cannot be held to be capable of being adapted to distinguish; any manufacturer of a liquid medicine to be taken internally for cure of ailments would like to call it nectar. But to say that a laudatory epithet is incapable of being adapted to distinguish is not the same thing as saying that in a particular case it has not distinguished. Though it may not be a distinctive mark within the meaning of sub-sections (2) and (3) of Section 6, it may be a distinctive mark within the meaning of the proviso.

28. It is essentially a question of fact whether Amritdhara was adapted to distinguish the medicine manufactured by the defendants from similar medicines manufactured by others. Sri Thakur Datt Sharma deposed that he invented the medicine in 1901, at first gave it the name Amrit ki dhar and changed it two years later to Amritdhara and got the trade mark registered in 1907 under an Act of 1877. He applied for its registration under the Act in 1942. All that he deposed about its distinctiveness is that the medicine became so popular that even before 1915 the word "Amritdhara" came to be associated with them and their medicine, that the word was never used by anyone for any medicine prior to 1901 and 1903 and that it became distinctive in 1903. He has not at all explained how he adapted the word to distinguish his medicine from others' medicines. I shall deal with the question whether the word became distinctive by user subsequently; at present I am dealing with the question whether it was adapted to distinguish. The Registrar has sent a copy of the affidavit made by the defendants in proof of their claim that Amritdhara was a distinctive mark. In that affidavit also all that they affirmed is that their medicine became popular as soon as it was invented, that Amritdhara had become well known in the trade and come to mean the medicine manufactured by them, that they had advertised it extensively, that in 1915 they restrained a certain firm of Lahore from calling their medicine "Amritdhar" and "Amritban", that in 1926 the silver jubilee of Amritdhara was celebrated and that in 1936 they obtained a decree against a firm of Alwar for infringement of their trade mark. All this may prove that the name "Amritdhara" came gradually to distinguish the medicine manufactured by the defendants from similar medicines manufactured by others, but not that it was intended at the time of its appropriation to distinguish. There is nothing to show that in 1903 it meant the medicine manufactured bythe defendants and not that manufactured by any one. The test of being adapted to distinguish is "what the word.....meant as used at the time when the defendants intended to attribute it to their manufacture" (Per Fry J., in the "Linoleum" case, *Linoleum Manufacturing Co. v. Nairn*[19], The Registrar in his reply has not said that the word was adopted to distinguish the defendants' medicine.

29. In deciding whether a distinctive trade mark was adapted to distinguish the goods the tribunal may take into consideration whether it was inherently so adapted to distinguish or whether in fact by reason of the user or by any other circumstances it was in fact so adapted. "Inherently adapted" means that it has an innate quality of distinctiveness, vide 49 Cal WN 425 (E). In the "Diamine" case (supra) Buckley L. J., said at page 245 :

> "The trader may take a word which from something in the word itself say the fact that no one had ever heard the word before, that it was an invented word, or that it indicated the

particular trader as distinguished from another trader, but always from something found in the word itself as distinguished from the way in which it is used is such as to answer the description of being adapted to distinguish the goods."

Reference may also be made to the "Classic' case at pages 294-295. A surname is not inherently adapted to distinguish; see the "Boardman's Mixture" case (supra). In the "Perfection" case (supra) Swinfen Eady J., stated at page 124 with reference to the
[19](1878) 7 Ch D 834 at p. 836 (Z-10)
trade mark "Perfection."

> "It is an ordinary English word, expressing of the highest quality extensively used by the mercantile community to describe and recommend their goods.....It is not in the least calculated to distinguish the goods to which it is applied as those made or sold by one person more than another."

I find that Amritdhara was not inherently adapted to distinguish.

30. Another fact that could be taken into consideration by the Registrar is whether by user Amritdhara had in fact been adapted to distinguish by reason of any other circumstances. The Registrar was only required to have regard to this fact and not to treat the user as decisive. It was pointed out by Cozens-Hardy M.R. in the California Fig Syrup "Perfection" case (Z-9) at page 141. "Mere user is not necessarily decisive. The words in the proviso are "may take into consideration" and these words must not be treated as equivalent to a positive command to grant the application." Before there can arise a question of distinguishing the applicant's goods, there must be other goods to be distinguished from. If the applicant is the sole manufacturer of the goods, that is, nobody else manufacture goods of the same or similar kind, there is nothing from which his goods can be distinguished and no question either of being adapted to distinguish or of having acquired distinctiveness by user can arise. In the "Linoleum" case (supra) one Mr. Walton invented a new substance, e. g., solidified or oxidised oil and gave it the name "Linoleum". No other name had been given to this substance thereafter and Linoleum was the name by which the solidified or oxidised oil had come to be known. It was claimed on behalf of Walton that the substance had always meant the manufacture of Walton. Fry J.'s reply was that in a sense it was true because Walton being the only manufacturer of the substance, the name meant the substance manufactured by him. He proceeded on page 837 :

> "But, nevertheless, the word directly or primarily means solidified oil. It only secondarily means the manufacture of the plaintiffs, and has that meaning only so long as the Plaintiffs are the sole manufacturers. In my opinion, it would be extremely difficult for a person who has been by right of some monopoly the sole manufacturer of a new article, and has given a new name to the new article, meaning that new article and nothing more, to claim that the name is to be attributed to his manufacture alone after his competitors are at liberty to make the same article."

On page 838 he observed :

> "The plaintiffs having invented.....a new subject-matter, use merely the name distinguishing that subject-matter, but do not use a name distinguishing that subject-matter as made by them from the same subject-matter as made by other persons. The two cases are essentially different."

In the "Shredded Wheat" case (supra) it was said that there could be no evidence of the acquisition of a secondary meaning in the absence of rival producers of the same article. In "Angostura Bitters" case (supra) Fry J., observed on page 813 :

> "It is to be observed that the person who produces a new article, and is the sole maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article, there is nothing to distinguish it from. No distinction can arise from using the name of the class so long as the class consists of only one species, for then the name of the species and the name of the class will be the same."

Braided Fixed Stars were at first manufactured only by Messrs. Palmer and Son and so they were known in the trade as of their manufacture. This fact was relied upon by Messrs. Palmer and Son in support of their claim that they used the words as their trade mark. Lindley L. J., refuted the claim observing

> "those goods were know in the trade as of their manufacture. Of course they were, but that is not.....the test of this case. It is the test where there are a number of manufacturers and where a trade mark is affixed to the goods of each manufacturer ; or where there are several manufacturers, and one of them adopts a trade mark to designate, not a particular class of goods but the goods which he makes as distinguished from similar goods made by several people."

See In re, J. B. Palmer Trade Mark, (1883) 24 Ch D 505, at p. 521 ("Braided Fixed Star" case) (Z-11) In Cellular case (supra) Lord Davey observed on page 343 :

> "Where a man produces or invents, if you please, a new article and attaches a descriptive name to it a name which, as the article has not been produced before, has, of course, not been used in connection with the article and secures for himself either the legal monopoly or a monopoly in fact of the sale of that article for a certain time, the evidence of persons who come forward and say that the name in question suggests to their minds and is associated by them with the plaintiff's goods alone is of a very slender character, for the simple reason that the plaintiff was the only maker of the goods during the time

> that his monopoly lasted and, therefore, there was nothing to compare with it, and anybody who wanted the goods had no shop to go to or no merchant or manufacturer to resort to except the plaintiff."

He approved of the above quoted observation of Pry L. J., in the "Angostura Bitters" case. Reference may also be made to the observations in the "Phosphotone" case at page 260 (Z-3) (supra). When the applicant is the sole manufacturer of a stuff invented by him, any name that he gives to it must necessarily become the name of the stuff. It cannot have the secondary meaning because there is nothing to distinguish from. In the "Valvoline" case (Z-9-a) (supra) Pry L. J., found it difficult to imagine that" one word can both describe the thing as made by anybody and the thing as made by a particular maker." In that case also "Valvoline" was the name given to an oil by its inventor and the word was held to mean the particular kind of oil and not the oil manufactured by the inventor. Earl of Selborne pointed out the difference between the use of a name as a trade mark and the use of it as a descriptive term and said that

> "if the article itself is publici juris and anybody may make it, then people who make it are at liberty, provided they do so honestly, to describe it by the descriptive term by which it is popularly known in the trade, and no right of monopoly to that descriptive term can be acquired otherwise than by using it as a trade mark." Cotton L.J., observed in the case at page 301
> "When a man invents a new article, and invents a word as descriptive of that article, then if all the world are at liberty to make that article he stands in a very great difficulty as regards claiming to himself the exclusive use of that name."

In the "Chocaroon" case (Z-4) (supra) "Chocaroon" though an invented word, was held not used for the purpose of indicating the goods of the applicant and so its registration was refused. It was held to mean a particular kind of sweet-meat and not a sweet-meat manufactured by the applicant. In "Yorkshire Relish" case (Z-8) Lindley L. J., stated the law as follows :

> "If a person makes or sells an article and calls it by a particular name, the use of that particular name by others for the same sort of goods is not necessarily an infringement of his rights even if the name is not obviously descriptive.....If a person makes an article not patented and gives it a certain name by which the article comes to be known in the market, anyone who can make the same kind of article can call it by the name by which it is known." (P. 72).

At page 73 he said :

> "Where a man has long been the sole maker of a particular kind of article which he has always called by some name by which his goods are known.....a rival trader cannot, of course, adopt the trade name and make up his own articles so as to make them look like or pass for the others. If he can avoid doing this there is no law to prevent him from

making and selling goods of the same sort as the others', nor from calling them by the name by which alone they are known in the market."

In the "Gramophone" case (Z-5) (supra) Parker J., laid down at page 436 that

"the name by which an article is popularly known ought not to be admitted to registration as a trade mark for that article although in the trade it may have come to connote the source of manufacture."

The defendants were the sole manufacturers of the medicine composed essentially of thymol, peppermint and menthol for cure of headache, toothache, stomackache etc.; therefore, the name Amritdhara given by them to the medicine only meant the medicine. This was in fact admitted by defendant No. 2 who stated that Amritdhara was the name given to the medicine. It subsequently came to be known as the medicine manufactured by the defendants. It was because nobody else was manufacturing medicine of that kind.
What was used by the defendants was the name and not the trade mark whereas what the Registrar had to consider was the use of the trade mark and not of the name. The difference between use of a word as a trade mark and as a description of the goods was pointed out in the "Diamine" case at page 245.

31. Farwell L. J., stated in the "Boardman's Mixture" case at page 454 :

"Actual use may be enough.....to support an action for passing of.....but it is quite another thing to say that the use is enough to have displaced the ordinary meaning of any family name and to have turned such name quoad .....any other article into meaning primarily not a man or a family but an article." In *Standard Ideal Co. v. Standard Sanitary Manufacturing Co*[20]*.,* ("Standard" case) , Lord Macnaughten delivering judgment of the Judicial Committee of the Privy Council held that "Standard" as applied to sanitary fittings was not a registrable trade mark and observed at page 90 :
"A common English word having reference to the character and quality of the goods in connection with which it is used, and having no reference to anything else, cannot be an apt or appropriate instrument for distinguishing the goods of one trader from those of another. Distinctiveness is the very essence of a trade mark."

32. In the "Cellular" case Lord Shand thought it almost impossible for anyone to obtain the exclusive right to the use of a word which was descriptive only while Lord Davey thought that it was extremely difficult to prove that a common or descriptive word has acquired distinctiveness. In the 'Solio' case Lord Herschell said that "no one ought to be permitted to approriate to himself the exclusive use of a word that has reference to the character or quality of the goods". The authorities on this question are not unanimous and occasionally a descriptive word has been held to be capable of losing its primary meaning, for example the word "Sheen" (Vide the "Sheen"

case ). In (1910) 1 Ch 130 ("Orlwoola case") , Farwell L. J., doubted if any amount of evidence could prove that the word "Orlwoola" had lost its primary meaning "all woolly" and acquired a secondary meaning. Whether a trade mark is or is not adapted to distinguish the goods "appears to depend largely on whether other traders are or are not likely to desire in the ordinary course of business to make use in connection with their goods of the particular letter or letters constituting the mark"; per Lord Parker in the W. and G. case, at page 635. Any manufacturer of a medicine to be taken internally for relief of pain etc. would like to call it "Amrit".

33. My conclusion is that the trade mark Amritdhara had not been adapted to distinguish either inherently or in fact used before the date of the application for its registration. It was only the name of a medicine made from camphor, thymol and menthol for the purpose of relief from pain and ache. There is no evidence of anything in the use of the trade mark on account of which it might have acquired a secondary meaning.

34. Now I come to the effect of the proviso. Rest of the section is borrowed from the English Act but the proviso is a new thing. It dispenses with the proof of a trade mark

[20](1911) 80 LJ PC 87

being adapted to distinguish or having in fact been adopted to distinguish by user when it has been used continuously from before 25-2-1937, and regardless of whether it was adapted to distinguish or not the mere fact that it has come to distinguish may be taken as sufficient by the Registrar. Defendant No. 2 has stated in his affidavit and also in his deposition that he has been calling his medicine Amritdhara since 1903 and had got the trade mark registered in 1907. The plaintiff's counsel almost admitted that the defendants had been using the trade mark continuously from before 25-2-1937 upto the date of the application for registration. Consequently the Registrar could not refuse the registration merely because they did not prove that it had been adapted to distinguish. There is evidence of defendant No. 2 to the effect that Amritdhara has become associated with the medicine prepared by the defendants. They have also filed copies of statements made by Sri Duni Chand Barrister, Sri Rambhaj Dutt Choudhary pleader, Sri Mangu Lal Rai Bahadur, Sri Mohan Lal Rai Bahadur and Sri Kun Behari Thapar Rai Bahadur, all of Lahore, in a suit brought by defendant No. 2 against a firm of Lahore for injunction against infringement of the trademark and damages. These gentlemen had stated that by Amritdhara they understood the medicine manufactured by the defendants and no other medicine. They were respectable witnesses and their evidence is entitled to considerable weight. They are all dead. The relevancy of the statements made by them lies in this fact that they were the statements produced by the defendants before the Registrar to prove that Amritdhara had acquired distinctiveness and was entitled to registration. The statements certainly prove that Amritdhara had acquired distinctiveness before the application for registration and the Registrar had jurisdiction under the proviso to register it.

35. My reply to the issue is that Amritdhara does not contain an invented word, that it has direct reference to the character or quality of the medicine and that it has a distinctive mark within the

meaning of Paragraph (e) read with the proviso to sub-section (3), at the time of the application for its registration.

36. Issue No. 3 :- The law regarding public juris is laid down in *Ford v. Foster*[21], ("Eureka" case) . Ford brought out a shirt of a particular shape and gave it the name "The Eureka". Foster got shirts made by a firm of tailors in Eureka shape. Till then there had been no use of the word "Eureka" as applied to shirts in the market. The shape had become very popular from the very beginning, but there was nothing to show that the word "Eureka" meant at any time anything but the shirts manufactured by Ford. The Court repelled the contention of Foster that the word "Eureka" had become publici juris. It was recognized that the word which was originally a trade mark, to the exclusive use of which a particular trader might have been entitled, may subsequently become publici juris but the test to determine whether a word that was originally a trade mark has become publici juris or not was stated in the following words by Sri G. Mellish, L. J. :

> "....the test must be, whether the use of it by other persons is still calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use that

[21](1872) 7 Ch A 611 at p. 623

> nobody can be deceived by the use of it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent the trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trade mark, the right to the trade mark must be gone." (p. 628)

A firm began to manufacture in 1864 corn-flour under the name "Maizena". Subsequently other firms also started using "Maizena". In *National Starch Manufacturing Co. v. Munn's Patent Maizena and Starch Company*[22], ("Maizena" case) , it was stated by Lord Ashbourne at page 279 that if the word had become descriptive of the article as a product of maize and did not denote such product to be of the manufacture of a particular person, it must be regarded as having become, in the sense of law, publici juris and was no longer registrable. The firm knowing that other persons were manufacturing and selling "Maizena" gave no indication of its objection to their acts, it was, therefore, held to have left the word "derelict leaving its use unfettered and free to become publici juris". The test laid down by Mellish, L. J., in the Eureka case was approved of by Pollock, M. R. in *Havana Cigar and Tobacco Factories, Ltd. v. Oddenino*[23], ("Corona" case) . Lindley, L. J. observed in the "Yorkshire Relish" case (supra) at page 73.

> "There is another way in which a name originally a good trade name may lose its character and become publici juris - i.e. where the first person using the name does not

> claim the right to prevent others from using it, and allows other persons to use it without complaint. The name then comes to denote the article and nothing more; the name becomes publici juris, and any one who is at liberty to make the article can call it by the name by which it is usually known. *Ford v. Foster* is the leading authority on this head. No name, however, can become publici juris in this way so long as the person originally entitled to the use of the name asserts his rights in that respect. Moreover, it is for those who assert that a trade name has become publici juris to prove it."

The facts in the case were that Birmingham Vinagar Brewery Company had been manufacturing for many years a sauce prepared from a secret recipe and called it "Yorkshire Relish", which words were impressed into the glass of the bottles. It had also registered the words "Yorkshire Relish" as an old trade mark, but after litigation with Powell the trade mark had been expunged. The company had, however, succeeded in preventing any other person from using the words to denote a sauce. Powell had not discovered its secret but was making and selling under the name of Yorkshire Relish and in similar bottles a sauce very much like the company's. It was held by the Court that the term "Yorkshire Relish" had not become publici juris and that the company was entitled to restrain Powell from selling his sauce as "Yorkshire Relish" without better distinguishing it from its sauce : In In re, Hyde and Co's Trade Mark, (1878) 7 Ch D 724 ("Bank of England" case ) , the Court was concerned with the trade mark "Bank of England" applied to sealing-wax. The words had been used by a great number of manufacturers of sealing-wax; they were words commonly used

[22](1894) AC 275

[23](1924) 1 Ch 179 at p. 190

in the trade and no longer distinguished one man's goods from another's, and in spite of the knowledge of this fact Hyde and Co. got them registered as its trade mark. Its contention that it had the right to use them as the trademark because it was the first person to use them was repelled and the Court expunged the trade mark from the register. In the "Valvoline" case (Z9a) the Earl of Selborne L. C. stated at page 296 that if the article itself is publici juris, and anybody can make it, people who make it are at liberty, if they do so honestly, to describe it by the descriptive term by which it is properly known in the trade.

37. There is no evidence to prove that Amritdhara had become publici juris before it was registered. It has not been used as the name of any medicine, similar or dissimilar, manufactured by anybody else. Other manufacturers of medicines, similar or dissimilar, have used words which contain the word "amrit" or the word "dhara" but not the word "Amritdhara". The trade mark Amritdhara is not infringed by a trade mark containing the word "amrit" or the word "dhara". The reason is, as stated in the "Regimental" case (supra) by Astbury J., at page 213, that

> "The Courts should be careful to prevent any undue extension in this direction by holding that an ordinary and common word is an infringement by way of colourable imitation of

another word, equally common and ordinary, which has been allowed in the past to find its way upon the register."

The words "Amrit", "Lakshmandhara", "Piyush dhara" and Jagat Amritdhara are common words and so also is the word "Amritdhara" and one common word is not an infringement of a colourable imitation of another common word. The trade mark "Regimental" is not an infringement of the trade mark "Regiment", as decided in the above case. The plaintiff deposed that he has seen the prescription of Amritdhara in some books and that many people know how to make it. I am not concerned with any patent rights that may be claimed by the defendants in the medicines and, therefore, am not concerned with the question whether other people can manufacture a medicine similar to Amritdhara or not : the question is whether they can call it Amritdhara or not, which is an entirely different question. Defendant No. 2 deposed that Amritdhara contains ingredients other than menthol, thymol and camphor that they are a trade secret. He further stated that people are guessing at the exact of the Amritdhara. If that is so, it cannot be said that Amritdhara is manufactured by other persons. The plaintiff had to concede that Amritdhara may be containing ingradients other than the three ingredients named by him. Thus the evidence of defendant No. 2 stands unrebutted. I am not at all satisfied that anybody knows the exact prescription of Amritdhara or is manufacturing it. If others manufacture similar medicines, it does not mean that Amritdhara has become publici juris. Defendant No. 2 has deposed that he has taken proceedings against all persons who described their medicines with words containing "amrit" or "dhara"; the defendants filed a suit against a firm in 1915 for calling its medicine "Amritdhar". They did not take any action against the plaintiff for calling his medicine Amrit Sukhjiwan Dhara. The explanation of defendant No. 2 for this is not convincing, but the defendants' failure to take action against the use of the name of Amrit Sukhjiwan Dhara does not amount to Amiritdhara having been left derelict as publici juris. The trade mark Amrit Sukhjiwan Dhara may not be even held to be an infringement of Amritdhara trade mark. Amritdhara has direct reference to the quality or nature of the article but that does not render it disentitled to protection. It is a laudatory epithet but not of such a nature as could not distinguish the defendants' medicine from others' and has been found to do so. I do not consider it disentitled to protection. The issue is answered in the negative.

38. Issue No. 7 :- What is a legal proceeding within the meaning of Section 24 of the Act is not defined anywhere, but it is obvious that the phrase "legal proceedings" has been used to distinguish the proceedings to which the section applies from others. An indication of the meaning to be attached to the words can be had from the result of the inquiry what are the possible proceedings relating to a registered trade mark. Such proceedings would broadly fall into two classes, (1) of proceedings for cancellation or alteration of the registration, or alteration or cancellation of a registered trade mark, and (2) of proceedings for enforcement of the right conferred by the registration of the trade mark or to prevent infringement of it, or any punishment for falsification of the register or for falsely representing the trade mark as registered. The proceedings of the latter class are invariably to be taken in a court of law and are

undoubtedly legal proceedings; they are proceedings to enforce the law in one way or another. Proceedings of the former class are to be taken before a tribunal which consists either of a High Court or of the Registrar. The High Court, when it exercises the powers of rectification and correction of the register conferred by Section 46. is expressed to act as a "tribunal" and not as a "court". The Registrar when exercising the powers conferred upon him under Sections 46, 47 and 48 for the rectification and correction of the register or an entry in it also is expressed to act as a "tribunal".

> "Tribunal" is defined in Section 2 (m) to mean the Registrar or the Court concerned before which "the proceeding concerned" is pending. Therefore the proceeding pending in a High Court under Section 46 is according to the Act itself a "Proceeding", i.e., a mere proceeding as distinguished from a "legal proceeding". Proceedings for the registration of a trade mark are always taken before the Registrar; they are departmental proceedings and not legal proceedings. According to Lord Ghow on "W. and G." case they are administrative though also quasi-judicial. Proceedings under Section 46 for the cancellation or rectification of the registration are of the same nature as proceedings for registration and should be deemed to be departmental proceedings even if they are taken before a High Court.

It seems that since an application for rectification or cancellation of an entry in the register may take the form of an appeal from the Registrar's order, jurisdiction has been conferred upon the High Court also to order correction or rectification, but the nature of the jurisdiction exercised by it is exactly the same as that exercised by the Registrar, if the application had been made to him. A proceeding cannot be held to be a legal proceeding simply because it is taken in a High Court, because there is no ban on a High Court being invested with jurisdiction over proceedings which are not "legal proceedings".

39. The purpose of Section 24 is to furnish conclusive evidence of the "Validity" of a trade mark in certain circumstances; it provides a rule of evidence to be applied in a legal proceeding. The justification that exists for applying such a rule in a legal proceeding does not exist in a proceeding under Section 46. The latter proceeding, in its very nature, is a proceeding in which the justification of the registration is directly questioned; there may be sense in laying down that no proceeding under Section 46 shall be taken after the expiry of seven years, but there would be no sense in permitting such a proceeding after the expiry of seven years and then barring an inquiry into the justification by applying Section 24 to it. There is no time limit imposed by the Act upon an aggrieved person's right to make an application under Section 46; he can make it even after the expiry of seven years from the date of the original registration. Section 3 of the English Trade Marks Act of 1875 contained a provision similar to those of Sections 23 and 24 of our Act and Section 5 contained provisions for the rectification of the trade marks register and it was held in the "Braided Fixed Stars" case (Supra) that no limitation of time was expressed in Section 5. In *In re Edwards v. Denis* [24]("Neptune" case) , Cotton L. J., observed that the 3rd

section was no bar to an application under the 5th section for rectification of the register and that the Court was bound to consider whether the trade mark was properly on the register because although it might have been on for five years, if it ought not to have been on at all, then it could be taken off and that the 3rd section was no bar to an application for rectification. Lindley L. J., put the matter in these words at pages 477-478 :

> "When we come to look at Sections 3 and 5 it is clear that they do not depend upon one another, Section 5 not being consequent on Section 3. The meaning of the sections is this. When a man brings an action for infringement, if he has been on the register for five years, Section 3 is conclusive as to his right to bring the action, and in that particular action such registration is conclusive evidence of his right to the exclusive user of his trade-mark; but, having regard to Section 5, it appears to me that the register can be rectified in respect of that trademark, notwithstanding the five years' registration, if proper proceedings are taken for that purpose." See also Kerly at pages 271-272. If aggrieved person is permitted to apply for cancellation or correction of an entry after the expiry of seven years, he must also be permitted to show that the registration was wrong. In other words the bar imposed by Section 24 would not operate in such a proceeding. i.e. such a proceeding should not be trusted as a "legal proceeding".

40. Section 23 may be referred to; it lays down that in all legal proceedings relating to a registered trade mark the fact that a person is registered as its proprietor shall be prima facie evidence of the validity of the original registration. The distinction between this provision and the provision of Section 24 seems to be that the entry of a trade mark in the register is prima facie evidence of its validity, but after seven years it becomes conclusive evidence (except in case of fraud on infringement of provisions of Section 8). A question of prima facie evidence would arise in a proceeding in a court where the validity of the trade mark is attacked not directly but only collaterally.

[24](1885) 30 Ch D 454

In a proceeding under Sections 46, 47 or 48 there would not arise any question of applying the provisions of Section 23; if so, there would not arise any question of applying the supplementary provisions of Section 24.

41. There are separate provisions for entries of certification trade marks and their removal or alteration. The Central Government is given the power of cancelling or varying the registration of a certification trade mark vide Section 59. A proceeding for cancellation or varying taken before the Central Government would hardly be said to be a legal proceeding; a proceeding under Sections 46, 47 or 48 being of a similar nature should also be not said to be a legal proceeding.

42. Section 74 (1) of the Act refers to "any suit or other legal proceeding"; these words suggest that the legal proceeding must be of the nature of a suit. The words used in the next Section 74A are "all proceedings under this Act before a High Court"; it is significant that the proceedings

before the High Court are not designated "legal proceedings", and it may be said that a proceeding before a High Court under Section 46 is a mere proceeding and not a legal proceeding. Sections 40 and 41 of the English Trade Marks Act, 1905, are exactly similar to Sections 23 and 24 respectively of our Act, but for only one difference, which is that in the English Act, the words "(including applications under section thirty five of this Act)" are added after the words "relating to a registered trade mark." Section 35 of the English Act deals with rectification of register. Similar provisions in the English Trade Marks Act, 1938, are to be found in Sections 46 and 13 respectively; there the words added are "(including applications under Section 32 of this Act"), Section 32 being similar to our Section 46. Our Act though based on the English Act of 1938 makes a departure by omitting the words "(including applications under Section 46 of this Act)". This departure is deliberate and could have only one meaning, viz., that legal proceedings within the meaning of Section 24 are not to include applications under S .46. It is by no means certain that in the English Act the words were added by way of abundant caution; they are not to be found in other section which also use the words "legal proceeding", such as Sections 46, 47 etc. But even if it be said that they were used by way of abundant caution, their omission in our Act puts a different complexion on the matter. Once the words were added, even if by way of abundant caution, their omission must be attributed not to a desire for economy by doing away with redundant words but to a departure from the Policy. Once a phrase is thought by the Legislature to be ambiguous and some words are added to remove a possible doubt, they must continue to be used so long as the phrase continues to be used in the same sense. If the words had been omitted from the English Act of 1938, "legal proceedings" would not have included applications for rectification. The same would be the case with Section 24 of our Act.

43. A word which is the commonly used and accepted name of any single chemical element or compound cannot be registered as a trade mark. It is laid down in Section 9 of the Act (an exact copy of Section 15 (3) of the English Act of 1938) that if it is still registered, the registration "shall, notwithstanding anything in Section 24, be deemed for the purposes of Section 46 to be an entry made in the register without sufficient cause" etc. The words "notwithstanding anything in Section 24, be deemed for the purposes of Section 46" suggest that the provisions of Section 24 may be applicable in a case under Section 46; otherwise there would have been no necessity of using the words "notwithstanding anything in Section 24." This is the only provision in the Act which supports the contention that legal proceedings include rectification proceedings. I do not think that the legislature ever intended this result to flow from what it enacted in Section 9. As I said earlier, Section 13 of the English Act of 1938, corresponding to Section 24 of our Act, applied (expressly) to rectification proceedings and, therefore, Parliament quite properly used in Section 15 (3) the words "notwithstanding anything in Section 13 of this Act." The Indian Legislature, when enacting Section 9, did not take into consideration the difference between Section 13 of English Act and Section 24 of our Act, which was a material difference as regards proceedings under Section 46 of our Act and blindly reproduced the language of Section 15 of the English Act. The use of the words "notwithstanding anything in Section 24" in our Act seems to be a mistake. In, In the matter of Om Prakash Karam Chand AIR 1956 Punjab 4 (Z-18) an

application for expunction of a registered trade mark under Section 46 of the Act was dismissed, because the registration was not alleged to have been obtained by fraud and the trade mark was not found to offend against the provisions of Section 8. Kapur J., applied the provisions of Section 24 to the rectification proceedings but without discussing the question whether one includes the other. He seems to have assumed that it does. The learned Judge relied upon decisions of the English Courts, but they dealt with law which materially differs from our law, as pointed out above. With great respect to the learned Judge I cannot see my way to holding that proceedings under Section 46 are legal proceedings.

44. In the "Charm" case (Z-6) (supra) it was held that "other legal proceedings" in Section 18 (10) of the Patents, Designs and Trade Marks Act, 1883, included a proceeding for the revocation of a patent. But the decision is based not upon the interpretation of the words "legal proceedings" but upon the express provision "including applications under Section 35 of this Act."
45. I answer the issue in the negative.

46. Issue No. 8. Since the provisions of Section 24 are held inapplicable in proceedings under Section 46, it is unnecessary to consider whether the defendants obtained the registration of their trade mark by fraud. But even otherwise the issue must be answered against the plaintiff. Defendant No. 2 has deposed that he had started business in 1901, that the amount of rupees 10-12 lakhs stated by him to have been spent on advertisement in his affidavit to the Registrar was only an estimate and that he did not have his account books with him. There is nothing in rebuttal of his statement. The plaintiff did not depose anything about the commencement of the defendant's business and the money spent by them on advertising their medicine. His mere statement in the affidavit that the representations made by them to the Registrar were false is not sufficient to rebut them. It was for him to discharge the heavy onus of proving the falsity of the representations and he has failed to discharge it. There is also no disproof of the statement made by the defendants to the Registrar about their continuous use of the trade mark since 1901. Even if the defendants made some exaggerated or even false statements and thereby induced the Registrar to register the trade mark. I do not think it would amount to their obtaining the registration by fraud within the meaning of Section 24.
Obtaining a favourable order by giving false evidence has never been held to amount to obtaining it by fraud. Fraud is conduct involving "dishonesty or grave moral culpability." It is, "conduct which vitiates every transaction known to the law"; see the *Farley (Aust) Proprietary Ltd. v. J. R. Alexander and Sons (Queens land) Proprietary, Ltd., "Buz case*[25]*"* A registration of a trade mark procured by fraud, whether another trader or the Registar was defrauded, would be equally open to attack. The Registrar, who is alleged to have been defrauded, makes no complaint on this score. When the defendants made this statement before him, the plaintiff had not applied for registration of his trade mark and the defendants could not have intended to deceive him. The issue is, therefore, decided in the negative.

47. Issue No. 9. The statement of the plaintiff that he deposited his trade mark in the Registrar's

office on 12-5-1941 is not denied in the counter-affidavit or by the Registrar. The defendants' counsel only pleaded that the plaintiff has not produced the best evidence, viz., the receipt that must have been granted to him by the Registrar. I reject the plea because if what the plaintiff stated were false, it would have been easy for the defendants to prove so. In the absence of any evidence that he did not deposit his trade mark, the issue must be answered in the affirmative.

48. Issue No. 10. In the Trade Marks Rules, 1942, it is provided that an application for registration of a trade mark required to be advertised under Section 15 (1) of the Act must be advertised in the Journal, vide R. 27, and the defendants' application was advertised in the Journal. In R. 23 (3) it is provided that where it appears to the Registrar that a trade mark submitted for registration so nearly resembles a trade mark deposited under Section 85 in respect of the same goods, as to be likely to deceive or to cause confusion, he may give notice of the application for registration to the depositors. This is only a directory provision and not mandatory; whether to give notice to the depositor or not is expressly left to the discretion of the Registrar. If he likes to hear the depositor before making up his mind whether the trade mark sought to be registered is likely to deceive or cause confusion or not, he will give him a notice so that he may appear before him and make his submission. Since it is for him to decide first whether the trade mark sought to be registered so nearly resembles a trade mark deposited under Section 85 as to be likely to deceive or cause confusion, the matter had to be left to his discretion, because in every case in which he did not give a notice to the depositor he could plead that he did not consider the deposited trade mark so similar to the trade mark sought to be registered as to deceive or cause confusion. The time within which a notice of opposition to the registration of a trade mark is given is four months from the date of advertisement in the Journal, vide R. 30. Even when the Registrar gives a notice under Rule 23 (3) to the depositor of a trade mark, he gets four months from the date of the advertisement in the Journal for making an objection to the registration. This suggests that it was not the intention of the Government that the Registrar must invariably give a notice of the application to the depositor and his failure to do so cannot have any effect upon the registration.

The test whether the trade mark sought to be registered resembles so much a deposited trade mark is a subjective test and to an objection that no notice was given to the depositor it would be a sufficient answer for the Registrar to say that he did not consider the resemblance so great as to render the trade mark sought to be registered

[25]75 CLR 487 (Z-19)

likely to deceive or cause confusion and it would have been useless to permit the registration to be attacked merely on the ground of his failure to give a notice. I do not see any force in the contention that the word "may" in the rule means "shall" and that the only right that a depositor has under the Act is to get the notice. It may be that, that is his only right or benefit but it does not follow that it cannot be conditional; it can be conditional upon the Registrar's seeing such a resemblance between the deposited trade mark and the trade mark sought to be registered as is likely to cause deception or confusion. I was referred to (1878) 7 Ch D 724 at p. 726 (Z-16) and *Monappa v. Ramappa*[26], where it was observed by Ramaswami J., at page 189 that "there is no

legal obligation on persons interested to see an advertisement in the Trade Marks Journal." It does not follow from this that advertisement in the Journal is not enough and that the Registrar must give a notice to the depositor. What Ramaswami J., meant is as stated by him in the next sentence, that if a person interested does not see an advertisement, he cannot be in a worse position than he would have been in previously. A person may not be penalized for not seeing the Journal, but the law may consider that publication in the Journal is enough. It was argued on behalf of the plaintiff that the consequences of not giving a notice of the application to the depositor may be serious in as much as after the expiry of seven years from the date of the registration, the trade mark would be taken to be valid in all legal proceedings. It was pointed out that an order registering a trade mark takes effect from the date on which the application for registration was made and that the period of seven years mentioned in Section 24 of the Act may in practice mean only one or two years to a person who knows about the registration only after it has been ordered by the Registrar. The reply to this argument would be that the Act does not provide for any notice to the depositor and that if the Government themselves have not made the giving of a notice obligatory, it is not open to a High Court to say that it is obligatory. The grounds on which an entry in the register may be expunged or varied are stated in Section 46 (2) of the Act. They are exhaustive inasmuch as it cannot be expunged or varied on any other ground. The omission on the part of the Registrar to give a notice of an application for registration to a depositor is not a ground for expunging or varying an entry of the trade mark in the register. Naturally when the Act itself does not provide for the giving of a notice, it could not possibly provide for the effect of an omission to give it or mention it as one of the grounds for expunging the entry. I hold that the effect of the Registrar's omission to give a notice of the defendants' application to the plaintiff has no effect on the registration of the defendants' trade mark.

49. Issue No. 11. The plaintiff's claim that he was a person aggrieved within the meaning of Section 46 (2), by the entry of the trade mark in the register was disputed by the defendants. The words "an aggrieved person" have been explained by a number of authorities. Lord Watson observed in *Powell v. Birmingham Vinegar Brewery Co. Ltd*[27].

> "Any trader is, in the sense of the statute, 'aggrieved' whenever the registration of a particular trade-mark operates in restraint of what would otherwise have been his legal rights. Whatever benefit is gained by registration must entail

[26] AIR 1956 Mad 184 (Z-20)
[27](1894) AC 8 at p. 12 (Z-21)

> and corresponding disadvantage upon a trader who might possibly have had occasion to use the mark in the course of his business." and Lord Herschell L.
>
> C., observed at page 10 :
> "Whenever it can be shewn.....that the applicant is in the same trade as the person who

registered the trade-mark, and wherever the trade-mark if remaining on the register would or might limit the legal rights of the applicant so that by reason of the existence of the entry upon the register he could not lawfully do that which but for the appearance of the mark upon the register he could lawfully do, it appears to me that he has a locus standi to be heard as a person aggrieved."

In the Shell *Company of Australia, Ltd. v. Rohm and Haas Co*[28]*.,* Williams J., observed that the expression "an aggrieved person" has been given a wide meaning and a person who had applied for registration of trade mark Dithane was held to be aggrieved by the registration of the trade mark Ditrene because his application might be hampered by the presence of the trade mark on the register. The purpose behind the requirement that an applicant for rectification must be an aggrieved person is to prevent the register being attacked by common informers or for sentimental reasons; see 75 CLR 487 at p. 491 (Z-19). In *In re, Ralph's Trade Mark; Ralph v. Taylor*[29]*,* Pearson J., observed at page 198 :

"I can hardly conceive any persons who could fee described as aggrieved, if persons against whom an injunction is sought for the use of that which they say ought not to be on the register, are not persons aggrieved." In In re. Trade-Mark of La Societe Anonyme Des Verreries De L'Etoile. (1894) 1 Ch D 61 ("Star Brand" case) Henry Brooks and Co. which had registered its trade mark "Star Brand" for glass, was held to be aggrieved by the registration of "Red Star Brand" for glass manufactured by another company. The plaintiff was manufacturing medicine similar to Amritdhara. He had also applied for registration Amrit Sukhjiwan Dhara. The defendants had filed a suit and a criminal case against him for infringement of their trade mark. Therefore, he was an aggrieved person. It was contended that he ceased to be an aggrieved person on his application for registration of his trade mark being refused; there is no force in this contention and Sri P. N. Bakhshi confessed that he could not cite any authority in support of it.

50. Since I have held that the proceedings before me are not legal proceedings, the trade mark Amritdhara is not entitled to the presumption of validity under Section 24. Amritdhara has been found to be entitled to registration as a trade mark and to be not subject to any of the disqualifications mentioned in Section 8 etc. It is not the case of the plaintiff that Amritdhara has wrongly remained on the register or that there is any error or defect in the entry. He wants its removal on the only ground that it was made without sufficient cause. The entry of the trade mark Red Star Brand was held to have

[28]78 CLR 601 (Z-22)

[29](1884) 25 Ch D 194

been made without sufficient cause because it resembled the trade mark Star Brand of

Henry Brooks and Company so nearly as to be calculated to deceive; see the case of "Star Brand" (Z-24) (supra). It is stated by Kerly that a trade mark can be removed on the ground that it did not contain any of the essential particulars mentioned in Section 6; that would be the clearest case

of an entry made without sufficient cause. In the "Valvoline" case (Z-9-a) (supra) valvoline was removed from the register on the ground that it did not contain any of the essential particulars. In the "Regimental" case (supra) it was held that a trade mark can be removed from the register if it was disentitled to protection in a Court of justice. In the 'Livron' case (supra) Livron was removed from the register on the ground that it was calculated to deceive. In (1894) 63 LJ Ch 264, the trade mark Emolliolorum was removed from the register on the ground that it was calculated to deceive on account of its similarity with the Molliscorium trade mark. Stirling J., approved of the following statement of Bowen L. J., in *Paine and Co. v. Damiells and Sons' Breweries*[30], to the effect that "if on a motion like the present the attention of the Court is called to an entry on the register of a trade mark which cannot in law be justified as a trade mark, it seems to me that the Court's duty may well be, whatever the demerits of the applicant, to purify the register and to expunge the illegal entry in the interests of trade. "No such ground is made out for expunction of Amritdhara from the register. In the 'Perfection' case (supra) the Master of Rolls stated at page 142 that a laudatory epithet, if allowed to be registered, could not be removed after seven years.

51. The Registrar had discretion whether to register the trade mark or not and in the present case he had exercised it in favor of registration. His discretion is not to be lightly interfered with; see the "India Fans" case at p. 429 and *George Banham and Co., Ltd. v. F. Reddaway and Co. Ltd.,* In the latter case it was laid down that the Registrar's discretion should not be interfered with unless he has clearly gone wrong and that whether a trade mark is registrable or not is a practical question to be settled by considering all the circumstances. The defendants are very old manufacturers of Amritdhara. The plaintiff knew at least in 1935 of the use of Amritdhara by them, but he never took any action against them. He neglected to read the Trade Mark Journal even after depositing his trade mark. In these circumstances it would not be proper now to direct removal of the trade mark even if it might be said to have been made without sufficient cause.

52. The plaintiff is not entitled to any relief.

53. In accordance with the above findings I dismiss the suit with costs.
Suit dismissed.

[30](1893) 2 Ch 567 (Z-25)
[31] (1927) AC 406 (Z-26)