

MANU/WB/0109/1977

Equivalent Citation: AIR1977Cal413, 81CWN885, 81CWN885

**IN THE HIGH COURT OF CALCUTTA**

A.F.O.O. No. 190 of 1969

Decided On: 14.06.1977

Appellants: **The Imperial Tobacco Co. of India Ltd.**

**Vs.**

Respondent: **The Registrar of Trade Marks and Ors.**

**Hon'ble Judges/Coram:**

*Sankar Prasad Mitra, C.J. and S.K. Datta, J.*

**Counsels:**

*For Appellant/Petitioner/Plaintiff: Noni Coomar Chakravarti, Rathindra Nath Das and B.C. Bachawat, Advs.*

*For Respondents/Defendant: B. Das, N.C. Roy Chowdhury and Dipak Shome, Advs.*

**JUDGMENT**

**S.K. Datta, J.**

**1.** This is an appeal from the judgment and order of P. B. Mukharji, J. (as his Lordship then was) dated May 24, 27 and 28, 1968 in an appeal under Section 109 of the Trade and Merchandise Marks Act 1958 (hereinafter referred to as the said Act). By that judgment the order of the Registrar of Trade Marks dated March 26, 1968 rejecting the application for registration of a trade mark filed by the Imperial Tobacco Company of India Ltd. in Part A of the Register or alternatively in Part B of the Register, was affirmed. The trade mark for registration is a label, used as wrapper of packets of cigarettes bearing the device of snow clad hills in outline with the word 'Simla' written prominently in various panels of the label with small inscription that the content is 'a product' of the applicant company. The application had been made for registration of the trade mark in class 34 in respect of manufactured tobacco. In course of hearing of this appeal, an application has been filed stating that the name of the appellant has since been changed to I. T. C. Ltd. under the provisions of the Companies Act, 1956 and accordingly name of the applicant has been amended to read as "I. T. C. Ltd." by order of this court and the cause title has been directed to be amended in consequence.

**2.** The appellant filed an application on April 20, 1960 for registration of the said trade mark in Part A of the register stating that the said trade mark was 'proposed to be used' in respect of manufactured tobacco in class 34. The Registrar of Trade Marks sent a reply on December 9, 1960 to the following effect:

"..... Word 'Simla' which forms the essential and distinguishing feature of the mark is a famous geographical name and is not registrable except on very strong evidence of distinctiveness. No such evidence is possible as the mark is proposed to be used. You should therefore show cause why the application should not be refused....."

**3.** By its letter dated July 17, 1963 the appellant withdrew the application and on the same date filed a fresh application for registration of the same trade mark in class 34 in respect of manufactured tobacco. It was stated therein that during the period from April 1960 to June 30, 1963, about 42 crores of such cigarettes under the said trade mark had been sold throughout India while Rupees 15.50 lakhs had been spent as advertisement costs, the value of cigarettes sold being Rs. 1.14 crores. In support of the application the appellant also filed 22 affidavits from consumers, dealers and shopkeepers throughout the country to establish that the trade mark had in the meantime acquired distinctiveness and further, it appears the cigarettes have been in continuous use since then.

**4.** Thereafter there was a hearing of the application before the Deputy Registrar of Trade Marks, Calcutta and by letter dated December 29, 1965 issued by the Asstt. Examiner of Trade Marks the appellant was informed that the materials on record and arguments advanced on its behalf were duly considered by the Deputy Registrar and the said application for registration of the trade mark either in Part A or Part B of the Register had been refused by him.

**5.** The Deputy Registrar forwarded grounds of his decision under Section 18(6) of the Act dated March 28, 1966 to the appellant on its requisition. Against this decision, the appellant preferred an appeal to this Court under Section 109(2) of the Act which was heard by P. B. Mukharji J. and was dismissed as already stated. Thereafter the appellant preferred a further appeal to the Bench of this Court under Section 109(5) which has been heard by us.

**6.** The Deputy Registrar who heard and considered the application held that though the trade mark is composite in character, its essential feature was 'Simla'. 'Simla' in its only and obvious signification is a well known geographical name and the chief town of a State and further the word 'Simla' was inherently not adapted to distinguish the goods of any particular trader. In regard to the contention that the mark had become distinctive on the material date by reason of extensive sales and advertisement, it was held that it would be unwise to accept the trade evidence as conclusive on question of acquired distinctiveness. The Deputy Registrar was unable to hold that the mark had become distinctive even on the material date while a word purely geographical in its signification, it was held, should not be registered whatever be the evidence as to its distinctiveness. As to deceptiveness of mark as to the place of origin of the goods, though no tobacco had been grown in or around Simla and there was no market as such for tobacco, an ordinary smoker without having any special knowledge, might associate the origin of cigarettes with Simla. The Deputy Registrar was also of opinion that it could not be predicated that the name would not be required, then or later, by other traders for bona fide use in respect of similar goods and thus it would be wrong, in exercise of his discretion, to accord registration of the name to the appellant.

**7.** As to registration in Part B of the register, the Deputy Registrar observed as follows:-

"..... I would refuse registration of the mark even in Part B of the Register because of its inherent incapacity to distinguish the goods of a particular trader and in the exercise of my discretion. Registration in any form, whether in Part A or Part B will confer a kind of monopoly right on the registrants and will naturally interfere with the bona fide rights of such traders in the locality, dealing with the same goods. Such monopoly rights must not be granted, otherwise wealthy applicants will divide amongst themselves all the names of

important cities and towns of India to the embarrassment and prejudice of small traders....."

The application for registration, as already stated, was accordingly refused.

**8.** The learned Judge was also of opinion that 'Simla' was neither an invented word nor a word having a dictionary meaning. Its geographical signification was thus plain and unequivocal and the snow-clad hills in outline in the label made the geographical significance inescapable. Even so, it was held, a geographical word is not an absolute disqualification for the purpose of registration in Part A of the Register, as Section 9(2) of the Act provides that a geographical name "shall not be registrable in Part A of the register except upon evidence of its distinctiveness". A geographical name in its ordinary signification can thus be registered upon evidence of distinctiveness and such evidence will establish if the mark has acquired distinctiveness. This is the position in law in England and is also the statutory position in law under the Trade and Merchandise Marks Act of 1958. The affidavit evidence by dealers adduced by the appellant in support of the proof of acquisition of distinctiveness was considered insufficient to establish distinctiveness in "a magically short time of barely three years", as "distinctiveness of goods in a trade by association with a particular name requires normally a hard laborious time consuming process in business". The court agreed with the finding of the Registrar that the appellant's mark had not become distinctive and evidence is not such as to prove such distinctiveness.

**9.** As to registration in B Part of the Register, the Court referred to the guidelines laid down in Sub-section (5) of Section 9 which were considered to be illustrative and not exhaustive. The first consideration in Clause (a) is that the mark must be inherently distinctive or is inherently capable of distinguishing. The second feature in Clause (b) is where by reason of the use of trade mark or any other circumstances the trade mark is in fact so adapted to distinguish or is in fact capable of distinguishing. The Court was of opinion that even applying either of the tests, 'Simla' trade mark is neither inherently distinctive nor is inherently capable of distinguishing the appellant's goods. The court further found that the use of the trade mark 'Simla' or any other circumstances in fact does not make the appellant's trade mark adapted to distinguish or capable of distinguishing the appellant's goods. The court felt that the term 'capable of distinguishing' connotes both present capability with reference to goods, market, geography, consumer as also future potentiality, while adapted to distinguish implies the nature of adaptation in the mark and also what is in the mark which is adapted to distinguish. The court agreed with the discretion of the Registrar in refusing registration of the trade mark either in Part A or Part B of the Register and the appeal was accordingly dismissed. This judgment is reported in MANU/WB/0105/1968 : AIR1968Cal582 .

**10.** Mr. Noni Coomar Chakrabarti learned counsel for the appellant has challenged the judgment of Mukharji. J. As unsustainable in law on various points. On the finding that a geographical word is not an absolute disqualification for registration, it was contended, the learned Judge should have accepted, upon the affidavit evidence, that the trade mark had acquired distinctiveness during the period of three years it had been offered to public who had spent over Rs. 1.14 crores for 'Simla' cigarettes, there being no rule of law laying down the minimal period for acquisition of distinctiveness by use. Though contending that upon the evidence adduced and unchallenged, the appellant is entitled to have its trade mark registered in Part A of the register. Mr. Chakravarti submitted that the appellant will be content, for the time being, if its trade mark is registered in Part B of the Register. Accordingly with-out giving up his objections in

regard to the refusal of registration in Part 'A' of the Register, he concentrated his attack against the refusal of registration of the trade mark in Part B of the Register.

**11.** The relevant provisions of the Trade and Merchandise Marks Act, 1958 (Act 43 of 1958) are as follows: --

**6.** The Register of Trade Marks.-- (1) For the purposes of this Act, a record called the Register of Trade Marks shall be kept at the Head Office of the Trade Marks Registry, wherein shall be entered all registered trade marks with the names, addresses and descriptions of the proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of registered users, disclaimers conditions, limitations and such other matters relating to registered trade marks as may be prescribed \* \* \*

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**7.** Part A and Part B of the register.--(1) The register referred to in Section 6 shall be divided into two parts called respectively Part A and Part B.

(2) The Register of Trade Marks existing at the commencement of this Act shall be incorporated with and form part of Part A of the register, and this part shall comprise all trade marks entered in the Register of Trade Marks existing at the commencement of this Act and all trade marks which after such commencement may be entered in Part A of the register.

(3) Part B of the register shall comprise all trade marks which after the commencement of this Act may be entered in Part B of the register \* \* \*

**9.** Requisites for registration in Parts A and B of the register.-- (1) A trade mark shall not be registered in Part A of the register unless it contains or consists of at least one of the following essential particulars, namely:--

(a) the name of a company, individual or firm represented in a special or particular manner;

(b) the signature of the applicant for registration or some predecessor in his business;

(c) one or more invented words;

(d) one or more words having no direct reference to the character or quality of the goods and not being according to its ordinary signification, a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in India;

(e) any other distinctive mark.

(2) A name, signature or word, other than such as fall within the descriptions in Clauses (a), (b), (c) and (d) of Sub-section (1) shall not be registerable in Part A of the register except upon evidence of its distinctiveness.

(3) For the purposes of this Act, the expression 'distinctive' in relation to the goods in respect of which a trade mark is proposed to be registered, means adapted to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no

such connection subsists either generally or, where the trade mark is proposed to be registered subject to limitations in relation to use within the extent of the registration

(4) A trade mark shall not be registered in Part B of the register unless the trade mark in relation to the goods in respect of which it is proposed to be registered is distinctive or is not distinctive but is capable of distinguishing goods with which the proprietor of a trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations in relation to use within the extent of the registration.

(5) In determining whether a trade mark is distinctive or is capable of distinguishing as aforesaid the Tribunal may have regard to the extent to which-

(a) a trade mark is inherently distinctive or is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact so adapted to distinguish or is in fact capable of distinguishing as aforesaid.

(6) Subject to the other provisions of this section, a trade mark in respect of any goods-

(a) registered in Part A of the register may be registered in Part B of the register: and

(b) registered in Part B of the register may be registered in Part A of the register;

in the name of the same proprietor of the same trade mark or any part or parts thereof.

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**28.** Rights conferred by registration.--(1) subject to the other provisions of this Act, the registration of a trade mark in Part A or Part B of the register shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under Sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.....

**29.** Infringement of trade mark.-- (1) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or a registered user thereof using by way of permitted use, uses in the course of trade a mark which is identical with, or deceptively similar to. the trade mark, in relation to any goods in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) In an action for infringement of a trade mark registered in Part B of the register an injunction or other relief shall not be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of the mark of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods in respect of which the trade mark is registered and some person having the right, either as registered proprietor or as registered user, to use the trade mark. 12. As is well known, the laws relating to trade marks are based on and similar to those in United Kingdom. The latest Act in that country is the Trade Marks Act 1938 consolidating as its preamble indicates, the Trade Marks Act, 1905, the Trade Marks Act, 1919 and the Trade Marks (Amendment) Act, 1937. The 1905 Act contemplated only one Register of Trade Marks and Parts A and B in the register were introduced for the first time by the Act of 1919, provisions whereof had been since also incorporated in 1938 Act. Section 2 of 1919 Act provided that where any mark has for not less than two years been in bona fide use in the United Kingdom upon or in connection with goods for sale in United Kingdom or exportation abroad, as indicating the goods of the proprietor, he may apply for registration in Part B of the Register and the Registrar may refuse registration if it is not inconsistent with the provisions of Section 11 (deception) or Section 19 (identical mark) or if he is not satisfied that mark has been so used as aforesaid or that it is capable of distinguishing the goods of the applicant. It may be noted that the conditions for registration in Part B Register according to the above section appears to be disjunctive, the intervening preposition being 'or'.

**13.** The Indian Act of 1958 repealed the earlier Trade Marks Act, 1940 and this earlier Act had no Part A or B in Register of Trade Marks maintained for the purpose. Part B of the Register was introduced for the first time in our 1958 Act and the Objects and Reasons for such introduction have been set out in respect of Section 9(5) as follows:--

"The requisites for registration in Parts A and B of the register are laid down in this clause. A mark which is distinctive (a term the definition of which occurs in Sub-section (3), is to be understood to apply wherever it occurs in the Act-- J.C.R.) that is to say, adapted to distinguish, is registrable in Part A of the register. A less stringent test is proposed for registration in Part B register. A trade mark which is not distinctive but which is capable of distinguishing may be registered in Part B of the register. The establishment of the Part B register will bring on the register many valuable trade marks which are in use but not registrable and facilitate the registration of these Indian owned marks in foreign countries where a certificate of home registration is a condition precedent to registration. Such a provision is essential in view of the expanding export trade of this country....." S.O.R."

**14.** Sub-section (1) of Section 9 of the British Act of 1938 lays down the essential particulars for registration in Part A of the register and Clauses (a), (b), (c), (d) and (e) are similar to provisions of Section 9, Sub-section (1), Clauses (a), (b), (c), (d) and (e) of our Act. Sub-sections (2) and (3) of Section 9 of our Act is similar to Clause (e) of Sub-section (1) and Sub-section (2) of Section 9 of the British Act and they are in similar terms. Sub-section (3) of Section 9 of the British Act provides the guidelines for determining whether a trade mark is adapted to distinguish in regard to registration in Part A which is as follows:--

"Sec. 9. (3) In determining whether a trade mark is adapted to distinguish as

aforesaid, the tribunal may have regard to the extent to which-

(a) the trade mark is inherently adapted to distinguish as aforesaid: and

(b) by reason of the use of the trade mark or any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid."

**15.** Sub-section (1) of Section 10 of the British Act of 1938 provides that a trade mark will be registrable in Part B of the register, if it shall be capable of distinguishing goods with which the proprietor is connected in course of trade from goods in case of which no such connection exists. Sub-section (2) of this Act of 1938 is as follows:--

"(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which-

(a) the trade mark is inherently capable of distinguishing as aforesaid and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid "

The guidelines for registration in Part A of the register as provided in Section 9 (3) of the British Act and those for registration in Part B of the register as provided in Section 10 ( ) of the British Act have been combined in Sub-sections (4) and (5) of Section 9 of our Act of 1958 which we have quoted above. We have referred to the provisions of the British Act in some detail, as the decisions cited are under the said Act and naturally have reference to its provisions.

**16.** Mr. Chakravarti has referred to the above provisions and submitted that the conditions for registration in Part B of the register have been fulfilled by the trade mark sought to be registered. He submitted that the trade mark is inherently distinctive or is inherently capable of distinguishing the appellant's goods from others or in the alternative, the trade mark by reason of its use has become adapted to distinguish or is capable of distinguishing as aforesaid, as required in Clauses (a) or (b) of Sub-section (5) of Section 9 of our Act. He submitted that these clauses are disjunctive and if any of the tests are satisfied, the appellant is entitled to registration at least in Part B register. These contentions have been strongly disputed by Mr. Roy Choudhury learned counsel for the respondents, who has referred to the conjunctive pronoun 'and' used in connecting Clauses (a) and (b) of Section 9(5). The tests required for registration in Part B of the register are both as provided in Clauses (a) and (b), so that, it is submitted, even, if it can be said that the trade mark is capable of distinguishing by use it is neither inherently distinctive or inherently capable of distinguishing the appellant's goods to the extent necessary.

**17.** In Halsbury's Laws of England Third Edition, Volume 38, Art. 880 it is laid down as follows: --

"880. Requirements for registration in Part B.-- To be registrable in Part B of the register, a mark must be capable of distinguishing goods for which it is registered and in judging of such capacity the tribunal may take into account both the inherent qualities of the mark and the extent to which user or other circumstance has rendered it so capable."

**18.** In Kerly's Law of Trade Mark and Trade Names (10th Edition) it has been observed:--

"3.72...It will be apparent on comparing Section 10 with Section 9 that so far as registrability is concerned, the differences between Part A and Part B are (1) that in the former the mark must be "adapted to distinguish" and in the latter "capable of distinguishing" (the context being virtually identical); and (2) that in the case of names, signatures or words which do not fall within paragraphs (a) to (d) of Section 9(1), so that registration in Part A can only be granted upon evidence of distinctiveness such evidence is not required for Part B if it is possible without evidence to satisfy the tribunal that the mark is capable of distinguishing the goods."

**19.** Even so, the provisions both of Sections 9(2)(b) & 10(2)(b) of the British Act and our Section 9(5), Clause (b) also require evidence of use to establish that the trade mark is in fact adapted to distinguish or capable of distinguishing the goods in respect whereof registration is sought for.

**20.** In considering the implication of the words "adapted to distinguish" for registration in Part A of the register, and words "capable of distinguishing" for registration in Part B of the register, in the case of 'Weldmesh' trade mark reported in 1965 RPC 590, Lloyd-Jacob J. observed as follows: --

"..... Section 9 and Part A of the register are concerned with the registration of marks the primary significance of which is that they are adapted to distinguish the goods of the proprietor and the qualification for registration is the possession of such significance and this may be immediately evident or require use or special circumstances to demonstrate it, Section 10 and Part B of the register are concerned with an alternative method of registration for marks which can be shown to be capable of distinguishing goods of the proprietor and this is secured by proof of the development of a secondary meaning which outweighs the apparently non-distinctive character of the mark when viewed in isolation. It is, therefore, not unreasonable to regard the two expressions 'adapted to distinguish' and 'capable of distinguishing' as being deliberately chosen so as to direct the particular enquiry aright, the former emphasising that it is because of the presence of a sufficient distinguishing characteristic in the mark itself that distinctiveness is to be expected to result whatever the type and scale of the user and thus secure an estimation of a positive quality in the mark; and the second that, in spite of the absence of a sufficient distinguishing characteristic in the mark itself, distinctiveness can be acquired by appropriate user, thereby overcoming a negative quality in the mark."

**21.** This interpretation was approved by Willmer L. J. in Court of appeal where the 'Weldmesh' case 1965 RPC 590 went up in appeal and the other law lords did not expressly or by implication disapprove the proposition (vide 1966 RPC 220), as also noted in the judgment under appeal before us.

**22.** In regard to registration in Part B of the register, provisions have been made in Sub-section (4) of Section 9. The essential conditions are that the mark in relation to goods proposed to be registered is (1) distinctive or (2) if not distinctive, capable of distinguishing the goods of the applicant from those of others. To be distinctive (which means adapted to distinguish) or capable of distinguishing the goods as aforesaid, there may be some inherent qualities or distinguishing characteristics in the mark itself which may make it so distinctive or capable of such distinguishing the goods of the applicant from others. The degree or extent of such inherent quality that may satisfy the requisite qualification for registration is left to the discretion of the Tribunal to



determine, with his expert knowledge as the extent of quality is always variable from mark to mark.

**23.** If however the mark has no inherent distinguishing qualities or features, the distinctiveness may be acquired by appropriate user or other circumstances thereby overcoming the negative quality in the mark. Here again the Tribunal has been given the discretion to register a mark in the B part of the register taking into account the extent of the distinctiveness or capability of distinguishing the applicant's goods from others in fact acquired by reason of the use of the trade marks or other circumstances. There is thus actually no question of exclusion of one clause by another in Sub-section (5) of Section 9 but all relevant factors are to be taken into consideration by the Tribunal who as an expert will exercise his discretion in the light of the provisions of law and judicial interpretation thereof. As has been pointed out by Kerly, a decision upon registrability involves balancing an inherent tendency to unregistrability on the one hand against evidence showing distinctiveness in fact on the other.

**24.** All these are subject to the condition that where inherent unsuitability is so strong no degree of distinctiveness in fact can counter-balance it, so that some marks are totally unregistrable. This is for the reason that if any mark for example violates the requirements of Sub-clause (d) of Sub-section (1) of Section 9 such mark because of inherent infirmity can never be distinctive or capable of distinguishing the goods of the applicants sought to be registered from others goods either inherently or by reason of user of the mark or other circumstances.

**25.** A geographical name according to its ordinary signification is such mark inherently or otherwise incapable of registration subject to such minor exceptions in regard to other aspects as noticed in judicial decisions referred hereinafter, in Corpus Juris Vol. 63 (1933 Edn.), in Chapter of Trade Marks etc. Art. 53 (pp. 356-7) it is stated:

"Geographical terms and words in common use to designate a locality, a country, or a section of country cannot be monopolised as trade marks; but a geographical name not used in geographical sense to denote place of origin, but used in an arbitrary or fanciful way to indicate origin or ownership regardless of location, may be sustained as a valid trade mark."

According to Section 9. Sub-section (1). Clause (d) of our Act, a trade mark for registration in 'A' part of the Register must contain one or more words having no direct reference to the character or quality of the goods and not being according to its ordinary signification, a geographical name.

**26.** The first point for consideration is whether the test of Clause (b) of Section 9(5) has been satisfied in this case, that is, if by reason of use the mark in fact has become distinctive as adapted to distinguish or is in fact capable of distinguishing the goods of the appellant from others. The appellant has submitted affidavit evidence to prove that on the date of application on July 20, 1963 the goods (cigarettes) introduced in 1960, have in course of three years user reached fantastic figure of sale at over Rs. 1.14 crores with advertisement costs of over Rs 15.50 lakhs, Mr. Chakraborty also filed an application before us in support of his case that the sale figure has been constantly increasing since along with costs of advertisement We have however thought it fit to confine ourselves to facts as existing on the date of application which is the usual practice followed in such cases. Though evidence as to subsequent events may be admissible as throwing light on the question, we shall proceed on the basis that the 'Simla' cigarettes have not been withdrawn from the market and the sale of 'Simla'

cigarettes has been continuing. Even so, the acquisition of distinctiveness should be on the date when the application is filed for registration, and the law does not require or provide for acceptance of evidence of subsequent events.

**27.** Before we proceed further, we shall consider two aspects of the controversy in respect whereof grievance has been made before us. The learned Judge did not approve of the conduct of the appellant in not withdrawing its earlier application of April 20, 1960 till the date of filing the present application on July 20, 1963 while in the meantime the appellant went on building its trade. As laid down in Kerly's book referred to above, "an applicant is entitled to withdraw an application and to make a second application so as to obtain the advantage of a longer period of use and earlier application was obviously kept pending to meet a possible challenge in the meantime. That context, we say with respect, has no bearing on the merits of the application.

**28.** As to evidence also, the learned Judge found affidavits of dealers and employees unacceptable as they were not disinterested witnesses while the affidavits of smokers were held not dependable. We are unable to subscribe to this view, as who else other than dealers and their employees would be the fit persons to state of the position in the market, the consumers' demand and of the sale figures in respect of the goods. There is also no reason to disbelieve the smokers in the context of the huge sale figures even on the date of the application.

**29.** Let us now examine if the trade mark could have attained the distinctiveness on the date of application. There can be little dispute that the acquisition of distinctiveness of a trade mark is a long laborious and time consuming process. Even so, no time limit is fixed by statute and in the British Act of 1919 two years bona fide user was considered sufficient. There may be a case where for sundry reasons, a trade mark may attain the requisite distinctiveness within a "magically short period and it is not possible to predicate or lay down any hard and fast rule about the period of time on the expiry whereof only a trade mark by user can attain distinctiveness required under the statute. Every case will depend on the attending circumstances and evidence adduced in support of the acquisition of distinctiveness.

**30.** We shall now consider if the trade mark has attained 'distinctiveness' on the date of the application. 'Distinctiveness' has been understood to mean 'some quality in the trade mark which earmarks the goods so marked as distinct from those of other producers of such goods'. In Liverpool Cables Case ((1929 6 RPC 99) the trade mark applied for registration was 'Liverpool Cables' in respect of electric cables. In Glastonburys case ((1938) 55 RPC 253), the trade mark was 'Glastonburys' in respect of slippers etc. In Yorkshire case ((1954) 71 RPC 150) the trade mark sought to be registered was 'Yorkshire' for solid-drawn tubes and capillary fittings of copper or copper-alloys. In Tijuana Smalls case 1973 RPC 453 the trade mark under consideration was 'Tijuana Smalls' the first word in block capitals. In all these cases the trade mark was a word or combination of words and it was claimed that by reason of user, the trade mark has acquired a secondary meaning distinguishing goods under the mark sought to be registered as of the applicants from similar goods of others.

**31.** In the trade mark we are concerned with there is no dispute that though the mark is composite in character, including word 'Simla' in bold character with snow clad hills in outline and an inscription that the product is of the appellant in ordinary character or manner, the word 'Simla' is the prominent feature of the mark and distinctiveness is claimed in respect of the word 'Simla'. Even so the trade mark is not confined to the word 'Simla' and in the affidavits filed by the smokers on behalf of the appellant, the

deponents say that the 'Simla' label bears the inscription in ordinary character of being the product of the appellant whose products are of good and standard tobacco. It is accordingly not possible to say that the word 'Simla' by itself has acquired a secondary meaning to its customers, so as to conjure in their mind the cigarettes belonging to the appellant only and to none else even if the mark did not contain the inscription that it was a product of the appellant. A trade mark like 'Simla' on goods to distinguish them from" others goods as claimed must be the trade mark on its own without any assistance from indications like such goods being a product of the appellant. That is not the case possible here, as the mark 'Simla' does not stand on its own, so that it is not possible to say that by reason of the use 'Simla' is adapted to distinguish or capable of distinguishing as the goods of appellants to the exclusion of goods of others.

**32.** As we have seen 'Simla' is not an invented word; and though it has no reference to the character or a place of origin of the goods sought to be registered it is not inherently distinctive or adapted to distinguish "as there is no sufficient distinguishing characteristic in the mark itself so that distinctiveness might be expected to result whatever the type and scale of user and thus secure an estimation of the positive quality in the mark." This infirmity brings the trade mark out of the operation of Clause (a) of Section 9(5). There is no other circumstances pleaded and the user of the trade mark 'Simla' by itself as we have seen, on the evidence adduced cannot be said in fact as distinctive or capable of distinguishing the goods of the appellants from others by use in consequence whereof Clause (b) of Section 9(5) has also no operation. In arriving at this conclusion, we are not influenced by the finding that three years' time is too short for acquisition of distinctiveness, as there may be cases where a product may attain such distinctiveness within a short spell of time for its inherent qualities of the product.

**33.** Even assuming that the trade mark 'Simla' has become capable of distinguishing by use thus fulfilling the condition of Clause (b) of Section 9(5) entitling registration in Part B of the register, there are other formidable hurdles in the way for registration as already noted.

**34.** As we have seen, the mark 'Simla' is a geographical name and the snow-clad hills in outline in the mark indicates its use in ordinary or geographical signification, so that the mark is neither a fancy or invented word nor one with a secondary meaning As has been observed in Karly's Treatise (10th Edition).

"8.51. A word is not debarred from registration under Section 9(1)(e) as a distinctive word merely because it is geographical and so cannot be registered under Section 9(1)(d). Some geographical names can be inherently adapted to distinguish the goods of particular traders, but only if it can be predicated that they are such names as it would never occur to any other trader in such goods to use. At the other extreme, the name of a major industrial area or city will be totally unregistrable in respect of almost any goods. In between come the marks calling for more or less evidence that they are distinctive in fact.... it may tip the balance that the applicant can show that he has a natural or legal monopoly of the production of goods concerned in the place concerned: but that alone will not make a geographical name registrable without substantial evidence of distinctiveness."

Though Clause (d) of Section 9(1) which refers to geographical name in ordinary signification relates to registration in Part A of the register, the distinctiveness of the trade mark which makes it capable of distinguishing the applicant's goods, as required

in Clause (b) of Section 9(5) in respect of registration in Part B of the register, it is a vital and essential element for the purpose. Such distinctiveness is not possible for any geographical name in its ordinary or geographical signification. Though the rule has been relaxed in respect of small and insignificant place or where there is no geographical significance of the mark, if the geographical name propounded for registration is the name of an important country or a large district, county or city of commercial importance or has a geographical signification, the mark will be refused registration notwithstanding evidence of long and extensive use. In Liverpool Electric Cable Co. Ltd.'s case ((1929) 46 RPC 99) where registration was sought for trade mark 'Liverpool' in both Parts A and B of the register it was held that the name of an important commercial centre as Liverpool, even though it may in fact be distinctive of the goods in respect of which it is sought to register it is not registrable. In respect of Monte Rosa Cigarettes or Teneriffe Boiler Plates it was noted that there was no geographical significance in the mark which were mere pet names. It was further held that Liverpool being a well known city is geographical and not capable of distinguishing the goods of any particular trader and such registration will tend to embarrass traders who are in the trade or who may hereafter so trade as they would have difficulty in describing their goods if prevented from using the word 'Liverpool' Cables.

**35.** In *A. Bailey & Ltd. v. Clark, Son & Morland Ltd.* (1938) 55 RPC 253 known as *Glastonburys'* case, the respondents obtained registration as a trade mark of the word 'Glastonburys' used in connection with goatskin slippers and the appellants brought an action to rectify the register by expunging trade mark 'Glastonburys'. The prayer was allowed on the ground that (in spite of 'S') Glaston-bury was a geographical name prima facie unregistrable under Section 9 and evidence was unsuitable to prove the word to be generally distinctive of the respondents' goods and the word was not adapted to distinguish. The court of appeal held that 'Glastonburys' had become distinctive and had acquired as secondary meaning indicating exclusively the goods of the respondents. The House of Lords on further appeal held that the mark was not adapted to distinguish the goods of the respondents from those of other persons and its presence in the register would hamper rights of other traders. It was held that the word 'Glastonburys' is obviously a geographical name indicating the town of Glastonbury which had a reputation of manufacturers of Sheepskin slippers and parties were such manufacturers. It was observed that the respondents and future manufacturers of slippers in Glastonbury or their retail customers should not be hampered or restricted by the presence of the mark on the register while evidence was also insufficient to prove distinctiveness or that the mark was a fancy name.

**36.** In respect of *Yorkshire Copper Works Ltd.*'s application for registration of the trade mark 'Yorkshire' ((1954) 71 RPC 150) on its goods of copper tubes and capillary fittings, the House of Lords proceeded on the basis that the trade mark had acquired 100 per cent distinctiveness. It was held that as the mark is beyond question a geographical name, even though it has no direct reference to the character or quality of goods, it cannot be registered if it is according to its ordinary signification a geographical name. Lord Simonds L. C., observed that the Registrar could not have come to any other conclusion than refusal of the application.

"Unless having found distinctiveness in fact, he (the tribunal) needed to pay no regard to the other factor of inherent adaptability, he was faced with by the fact that there could not well be a geographical name less inherently adapted "than Yorkshire to distinguish the goods of the appellants (applicants)" ..... For just as a manufacturer is not entitled to a monopoly of a laudatory or descriptive epithet, so he is not to claim for his own a territory whether country, county or

town, which may be in the future if it is not now, the seat of manufacture of goods similar to his own."

**37.** The position emerging from the statutory provisions and the judicial interpretations thereon appears to be that a trade mark in Part B of the Register will be registered if the mark is distinctive or capable of distinguishing the applicant's goods from others. In determining whether the mark is distinctive or capable of distinguishing, the Tribunal shall have regard if the mark is inherently distinctive or is inherently capable of distinguishing as aforesaid. If not, the Tribunal will further examine if by reason of use or other circumstances, the trade mark has in fact become distinctive (as adapted to distinguish) or capable of distinguishing as aforesaid. All the same the Tribunal will refuse registration in respect of either parts of the register if the trade mark is inherently incapable of being distinctive or inherently incapable of distinguishing the goods of the applicants from others. Such reasons obviously are the disabilities violating the provision of Clauses (c), (d) and (e) of Sub-section (1) of Section 9 of our Act which again may not be exhaustive. The courts of law have further imposed the condition that no trade mark should be allowed to be registered which may hamper or embarrass the traders or trade now or in future in respect of the place or country which is proposed to be registered.

**38.** Mr. Chakrabarty has referred us to the decision in Tijuana Smalls' case where registration in respect of cigars was allowed in Part B (1973 RPC 453). Tijuana is a town in Mexico with inhabitants over 2 lakhs. Graham J. in allowing registration in Part B held that the question whether a geographical word could be registered was one of degree. These words whose primary signification is geographical and where the geographical significance is so general and so likely to be adapted or desired for use by more than one trader, it would be wrong, however distinctive they might in fact have become ever to allow one trader by registration to seek to monopolise them (e. g. Yorkshire or Liverpool). There are other 'geographical' words (e. g. North Pole) where, for one reason or other, when considered as applied to the goods in respect of which it is sought to register them, it is clear that the use is in fact clearly not geographical but fanciful, and was therefore, at least, capable, particularly by use, of being distinctive in practice of one of manufacturers' goods. Registration could, therefore, in such cases be allowed without causing inconvenience to or encroaching upon the reasonable trading rights of other manufacturers. The learned Judge found that the conclusion that Tijuana, an arid area, could well become tobacco producing centre being so improbable should be rejected.

**39.** Strong reliance was placed on this decision by Mr. Chakravarti who contended that Simla was never a tobacco producing centre or likely to be so and there is no chance or occasion for any prejudice being caused to other traders or manufacturers. He also referred to the Trade Marks Journal published by the Government containing advertisements of various geographical names for acceptance: 'Sheemla' for agarbati, 'Gulmarg' for wire, 'Shalimar' for engineering goods 'Kalighat' for biddies were cited and referred. In all such cases it appears that the names prima facie are fanciful without geographical or ordinary signification and at this stage it will not be proper to depend on those marks without further material or evidence. The propositions of law in respect of geographical names have been referred to above and in view of the imprint of snow clad hills in outline in the trade mark 'Simla' the ordinary or geographical signification is obvious and patent even though it has no reference to the quality or place of origin of the goods as at present advised. Further, registration of such trade mark may hamper or embarrass the trade or traders in or around the locality in future as held by judicial authorities cited earlier in similar cases. Also 'Simla' is too prominent a city, the capital

of Himachal Pradesh, well known in the country and abroad and in its ordinary or geographical significance it is inherently neither distinctive nor adapted to distinguish also nor capable of distinguishing the goods of the appellant as a particular trader from those of others. and is also hit by the provisions of Section 9. Sub-section (1). Clause (d) of the Trade and Merchandise Marks Act, 1958. In view of the above position, the Deputy Registrar in reflecting the application for registration is Part A or Part B of the Register rightly exercised his discretion conferred on him by law.

**40.** For the aforesaid reasons the appeal fails and is dismissed without any order for costs in the circumstances.

**Sankar Prasad Mitra, C.J.**

**41.** I agree.

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