Present : Porter and Schneider JJ.

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SHAW, WALLACE & Co. v. THE EGYPTIAN PHOSPHATE CO., LTD.

10—D. C. Colombo, 1,048.

Trade mark—Registration of invented words.

An application to have the words "Tetraphos" and "Radiophos" registered as trade marks in Class 2 in respect of chemical manures was allowed, as they were invented words.

"An invented word is allowed to be registered as a trade mark not as a reward on merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases."

THE facts are set out in the following judgment of the District Judge (A. St. V. Jayawardene, Esq.) :—

These are applications for the registration of two words as trade marks by certain persons carrying on business under the name of Shaw, Wallace & Co., as manufacturers of fertilizers and chemical manures, and their applications are opposed by the respondents "The Egyptian Phosphate Co., Ltd.," who are proprietors of a trade mark "Ephos" in respect of the same class of goods, and whose local agent is the Colombo Commercial Co. The two words the applicants seek to register are "Radiophos" and "Tetraphos," and they are to be used as trade marks in respect of manures which fall under Class 2 in the classification of goods in the Trade Marks Rules of 1906. They applied in the usual way, and the respondent objected to the registration on various grounds. The registrar has, therefore, referred the matter to Court under section 10 of the Trade Marks Ordinance of 1888.

The two applications were heard together by agreement between the parties on certain issues framed at the trial.

The main issues arising in the case are : First, are the words "Radiophos" and "Tetraphos" invented words ? Secondly, if so, do they have such resemblance to the opponents' trade mark "Ephos" as to be calculated to deceive ?

Now, under section 2 of "The Local Trade Marks Ordinance, 1888," as amended by Ordinance No. 4 of 1890, a trade mark must consist of or contain at least one of the following essential particulars : (*a*) —— ; (*b*) —— ; (*c*) —— ; (*d*) an invented word or invented words ; (*e*) a word or words having no reference to the character or quality of the goods, and not being a geographical name. This section is a reproduction of section 64 of the English Trade Marks Act of 1883 as amended by the Act of 1888. Therefore, in the first place, the applicants have to prove that the words in question "Radiophos" and "Tetraphos" are invented words. To take the word "Radiophos" in respect of which registration is claimed in case No. 1,048. Is this an "invented word" ? The word consists of two parts "Radio" and "Phos." Now an invented word has been variously defined. *In re Fabenfabrik en Application*[1]

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[1] *(1894) 1 Ch. 645.*

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known as the "Somatose" case, Lindley L.J. said: "There is no statutory definition nor description of an 'invented word,' and I cannot myself see any legitimate grounds for limiting its ordinary meaning. Any word which is in fact new, and not what may be called a colourable imitation of an existing word, is, in my opinion, an 'invented word' within the meaning of the statute under consideration. It is true that several persons may independently hit upon the same word, but a word already invented and known would hardly be called an invented word, because somebody afterwards happened to hit upon it himself. Novelty is, I think, an ingredient in a lawyer's idea of invention . . . . It is true that the syllables of which it is compounded are well known, and are even in common use amongst chemists and medical men. But a new word of more than one syllable may be an invented word, although all the syllables composing it are known and are in use." In the case known as the "Solio" case,[2] Lord Macnaghten said: "And now, if a proposed trade mark consists of or contains 'an invented word or invented words,' it is capable of registration. But the word must be really an invented word. Nothing short of invention will do. On the other hand, nothing more seems to be required. If it is an invented word, if it is 'new and freshly coined' (to adapt an old and familiar quotation) it seems to me no objection that it may be traced to a foreign source, or that it may contain a covert 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." In the same case, Lord Shand also defined an "invented word" thus: "There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required; but the words, I think, should be clearly and substantially different from any word in ordinary and common 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 would be understood as intended to convey the meaning of such a word." Does "Radiophos" comply with these requirements of an "invented word." It may be stated at once that an "invented word" does not become disentitled to registration, because it has some reference to the character or quality of the goods in respect of which it is sought to be registered. This was laid down by the House of Lords in the "Solio" case (*supra*) just referred to, thus over-ruling the decision in the "Somatose" case on the point (*supra*). Taking the two parts of the word "Radiophos" separately, radio is not an "invented word." It is a word that has passed into the English language, and appears to be much used by chemists and others. It means having the properties of or pertaining to radium, and the booklet A 2 and the opponents' advertisements O 1 and O 2 provide examples of its use. In A 2 it is stated that "Radio-active properties, closely resembling the induction of activity ascribed to radium, have been observed, &c., and again "Radio-activity," such as is emitted by certain phosphates . . . . and in O 2 the opponents states that his "Ephos" contains a certain proportion of radio-active material, &c., and O 1 contains the statement that "The Radio-active properties of 'Ephos' increase the yield, &c." So that the term "Radio" derived from the word radium must be taken as being well known, and one that has become current in the English language, especially among persons who deal in manures. "Phos" is a Greek word meaning "light," and in the English language it is found is such words as "phosphorous," "phosphates," and their

[2] *(1898) A. C. 571 (583).*

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derivatives. This syllable, too, has not been invented by the applicants, but seems to be used as a suffix or prefix to describe or indicate the presence of phosphoric acid or phosphates in any substance or preparation generally manurial. The applicants themselves have provided numerous instances in which it has been so used "Ammophos" (A 3), "Virophos" (A 7A), "Basphos" (A 7E), "Tonophos" (A 7G), "Indiphos" ( ), "Phoslag" (A 7E), and the opponents' own trade mark "Ephos," also Phosferine. The applicants, therefore, are attempting to register as an "invented word" a word consisting of two syllables neither of which has been invented or freshly coined by them. No doubt in some cases the combination of well-known words or syllables might produce an invented word as pointed out by Lindley L.J. in the "Somatose" case (*supra*), but such cases would be very rare, and we must also bear in mind the observation of Lord Shand in the "Solio" case (*supra*) where he said: "At the same time, I agree with your Lordships and what has been said by my noble and learned friend Lord Macnaghten in thinking, especially after the decision to be given in this case, that the Comptroller-General will be fully warranted in taking care that there shall not be admitted under the guise or cover of words called 'invented' by the applicant, words really in ordinary use, which might in a disguised form have reference to the character or quality of the goods. There must be invention and not the appearance of invention only," and that of Joyce J. in *Christy v. Tipper* [1] when declaring the word "Absorbine" not to be an "invented word." "None of the syllables or parts of which the word is composed was invented and I see no invention in the combining of them so as to form the whole." Counsel for the applicants rely on two cases in support of their contention that "Radiophos" is an invented word, one is *In re Linotype Co.'s Trade Mark.*[2] In this case the word "Tachytype" was in question, and it was sought to be registered as a trade mark for typographical composing, and casting machines. Registration was objected to on the ground that it was composed of the word "Tachy" derived from a Greek word meaning "quick," and the common English word "type" and was not an invented word. Cozens Hardy J. allowed it to be registered remarking: "Now it is plain that the word 'Tachytype' comes within the term an 'invented word.' I doubt whether anybody not being a scholar, more or less, would have the faintest conception of what the word means. The man in the street I am quite certain would be entirely ignorant of any meaning that could be attached to it. I have had my attention called to certain dictionary words which represent the Greek 'Tachus' as a prefix to certain words. All that I can say is that there has not been one single word in that list which I heard of before. That is a confession of ignorance which I frankly make, and if I did not hold that 'Tachytype' is in itself a word falling within the term an 'an invented word' I should be disregarding the observations of the Law Lords in the 'Solio' case (*supra*)." The considerations which induced the Court to allow the word "Tachytype" to be registered have no application to the word "Radiophos," for what was said of the syllable, "Tachy" by the learned Judge cannot be said of "Radio" or of "phos" as I have attempted to point out above. In the other case which may be called the "Parlograph" case,[3] the applicant sought to have the word "Parlograph" registered in respect of sound recording and reproducing machines, the registrar refused to register it, but Sargant J. allowed it to be registered. He said: "Then comes the question whether this bastard word is or is not an invented word. It seems to me clearly to be an invented word. It is a combination of

[1] *(1904) 1 Ch. 696, 702.*

[2] *(1900) 2 Ch. 238.*

[3] *(1914) 2 Ch, 103.*

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two roots from foreign languages—the one 'Parl' coming from or through the French and denoting speech, and the other 'graph' being a Greek root denoting writing, and there is no doubt whatever—I am glad to say there is no doubt—that no such word as this is to be found in any English dictionary, or has in any way been introduced into the common language of the realm. That being so I am clearly of opinion that, within the decision of the 'Solio,' case (*supra*), this word is an 'invented word or words.'" This case, no doubt, appears at first sight to be a valuable authority for the applicants, but I think it can be distinguished. The syllable "Parlo" unlike "Radio" is not in use in the English language and was, in reality, an invention of the applicants there. If "Parlo" like "Radio" had been current in the English language, I am sure the decision of the Court would have been different. In "Parlograph" there was at least one syllable which had the merit of invention, but of "Radiophos" the same cannot be said. As Judges have held in numerous cases, it is always a question of fact, whether a word is an "invented word" or not. Taking everything into consideration I am of opinion that "Radiophos" is not an "invented word," and that the applicant is not entitled to have it registered as a trade mark. As regards the word "Tetraphos" different considerations apply. It is clearly, in my opinion, an "invented word." It was said that tetraphosphate is a term known to scientists, but no book or dictionary has been produced in which the word occurs. It seems to me to stand on the same footing as "Tachytype," "Parlograph," and adopting the reasoning of Cozens Hardy J. in the "Tachytype" case, already referred to, I hold, "Tetraphos" to be an invented word, and as such the applicants are entitled to have it registered. Then comes the question: Does it have such resemblance to the opponents' registered trake mark "Ephos" as to be calculated to deceive? I do not think there is any likelihood of deception if this word is allowed to be registered. In considering whether deception is likely to result, we must have regard to all the circumstances of the trade in connection with which the trade mark will be used. Manure is sold wholesale, and not by the tin, packet, or bottle, and according to the evidence of the witness called by the opponent, orders for manure are received by letter. It is not purchased by the man in the street, but by estate owners who, one may assume, are men of intelligence and would devote some consideration to its purchase, and it must also be presumed until the contrary is proved that the applicants will make an honest use of their trade mark. The opponent does not suggest that the applicants would make a dishonest use of their mark and attempt to pass off their manure as the manure of the opponent. In the "Neola" case [1] in which the proprietors of the trade mark "Pianola" opposed the registration of the word "Neola." In respect of piano-players, a musical instrument, on the ground that the word "Neola" was calculated to deceive Parker J. (afterwards Lord Parker of Waddington) used language very opposite to the present case which I adopt. He said: "That section (referring to section 72 of the English Act which corresponds to section 15 of the Local Ordinance) has been the subject of judicial decision on many occasions, and I think without going into the details of the cases, it may be taken the law is as follows: You must take the two words. You must judge of them—both by their look and by their sound. You must consider the goods to which they are applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances, and you must further consider what is likely to happen if each of these trade marks is used in a normal 'way as a trade mark for the goods of the respective owners of the marks.' If considering

[1] *(1906) 23 R. P. C. 774.*

all these circumstances you come to the conclusion that there will be a confusion—that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods—then you may refuse the registration or rather you must refuse registration in that case . . . . Now the mark which is proposed to be registered and which the registrar has passed is 'Neola,' and the argument before me has taken two lines. In the first place it is suggested that the importance of the trade mark 'Pianola' lies in its termination, and that anybody who takes a word with a similar termination may cause confusion in the mind of the public. The second way it is put to me is that the sounds of the words, although the look of the words may be different, are likely to be so similar that a person asking for a 'Pianola' might have a 'Neola' passed off on him and *vice versâ*. Of course, one knows that the person who buy these articles are generally persons of some education (it is not quite the same as somebody going and asking for washing soap in a grocer's shop,) and some consideration is likely to attend the purchase of any instrument of the cost of either of these instruments, whether it be a 'Pianola' or a 'Neola.' Now, my opinion is that having regard to the nature of the customer the article in question and the price at which it is likely to be sold, and all the surrounding circumstances no man of ordinary intelligence is likely to be deceived. Considering, therefore, the conditions under which manure is sold in Ceylon, it is difficult to see how purchasers could be deceived, unless there is fraudulent substitution of one manure for another. The opponent admits that the applicants are not likely to supply 'Tetraphos' when 'Ephos' is ordered. In fact such a fraudulent use cannot be taken into consideration in deciding whether a mark should be registered or not, for as Lord Bowen remarked in *In re London Trade Mark*[1] : A trade mark is calculated by its resemblance to deceive if in the course of its legitimate use in the trade, it is likely to do so. For these reasons I hold that the word 'Tetraphos' has no such resemblance to the trade mark word 'Ephos' as to be calculated to deceive. The applicants are therefore entitled to have it registered. I also hold that the word 'Radiophos' would not be calculated to deceive if the applicants are otherwise entitled to have it registered as a trade mark. An issue has been raised as to whether the applicants are entitled to have the trade mark 'Ephos' expunged from the register on the ground that the word is descriptive of the character and quality of the opponents' goods. I have already referred to this matter incidentally. It is not necessary to decide the question whether the word 'Ephos' is descriptive of the character and quality of the opponents' goods, in view of the decision of the House of Lords in the 'Solio' case (*supra*). The fact that an invented word has some reference to the character or quantity of the goods to which it is to be applied is no ground for refusing to register it. In that case their Lordships held that the words in sub-section (*e*) 'having no reference to the character or quality of the goods' did not qualify the words 'an invented word or invented words' in sub-section (*d*). These remarks apply to a similar objection raised to the word 'Tetraphos' by the applicants."

I answer the issues as follows :—

(1) "Radiophos" is not an invented word.

(2) No.

(3) "Radiophos" is slightly descriptive, but not deceptive in respect of the character and quality of the applicants' goods, but registration cannot be refused for that reason.

[1] *(1886) 23 C. D. 109 (119).*

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(4) The word " Ephos " is also descriptive very slightly of the character and quality of the opponents' goods ; it cannot be struck off the register for that reason.

(5) Yes.

(6) No.

(7) " Tetraphos " may be slightly descriptive, but is not deceptive in respect of the character and quality of the applicants' goods, but the applicants are nevertheless entitled to register it as a trade mark.

(8) " Tetraphos " is not a contraction of a word in ordinary use in the English language.

I refuse the application to register the word " Radiophos " as a trade mark. I direct that the registration of the word " Tetraphos " as a trade mark be proceeded with by the registrar. As each party has partially succeeded, I make no order as to costs.

Hayley (with him *Garvin*), for applicant, appellant in Nos. 10 and 11 and for applicant-respondent in No. 10A.

Samarawickreme (with him *Navaratnam*), for respondent in Nos. 10 and 11 and for appellant in No. 10A.

Cur .adv. vult.

June 27, 1923. PORTER J.—

The applicants on January 11, 1922, applied to the Registrar-General in terms of section 3 of Ordinance No. 14 of 1888 to have have the words "Tetraphos" and "Radiophos" registered as trade marks in Class 2 in respect of chemical manures, and on the respondents opposing the said application, the applicants were required to make application to the District Court in terms of section 10 of the said Ordinance. The applicants duly applied for registration in the action, No. 1,049 Special, in respect of the word " Tetraphos," and in action, No. 1,048 Special, in respect of the word "Radiophos" making the respondents, respondents in the said actions. At the hearing of the said applications which were consolidated by order of the learned District Judge, the following issues were framed :—

Radiophos.

(1) Is the word "Radiophos" an invented word and registrable as such ?

(2) Does the word "Radiophos" so nearly resemble the word " Ephos " as to be calculated to deceive ?

(3) Is the word "Radiophos" descriptive or deceptive in respect of the character and quality of the applicants' goods, and, if so, were the applicants not entitled to registration ?

(4) Is the word "Ephos" descriptive of the character and quality of the opponents' goods, and, if so, should the name be struck off the register ?

(5) Is the word "Tetraphos" an invented word and registrable as such ?

(6) Does the word "Tetraphos" so nearly resemble the word "Ephos" as to be calculated to deceive ?

(7) Is the word "Tetraphos" descriptive or deceptive in respect of the character and quality of the applicants' goods, and, if so, were the applicants not entitled to registration ?

(8) Is the word "Tetraphos" a contraction of a word in ordinary use in the English language, namely, tetraphosphate and, if so, are the applicants not entitled to registration ?

On November 17, 1922, the learned District Judge delivered judgment directing that the registration of the word "Tetraphos" be proceeded with, and finding that the appellants were not entitled to have the word "Radiophos" registered, inasmuch as the same was not an invented word. The learned District Judge further ordered that as each party had partially succeeded, there would be no costs of these actions. From this judgment the appellants appeal.

I agree with the learned District Judge that "Tetraphos" is a registrable word, and with this part of his judgment I entirely agree ; but with regard to his finding that "Radiophos" is not registrable I find myself, with deference, in some disagreement. It is purely a question of fact. Is it an invented word ? The learned District Judge finds as a fact that radio is derived from the Latin word "Radium," which has now become a well known English word, and radio an equally well-known adjective derived from the noun "radium." I cannot, however, consider that there is any similarity between the words "Radiophos" and the word "Ephos," nor can I think that the average "man in the street" could be deceived when demanding "Ephos" if he received "Radiophos." I am of the opinion that "Radiophos" is an invented word, there is direct evidence that the word was invented by the Calcutta agent of the applicants, and consequently is registrable. I would allow this appeal with costs. The application to strike off the word "Ephos" from the register has not been proceeded with, in view of my finding as to "Radiophos." I would, therefore allow the word "Ephos" to remain on the register. Decree to be entered in terms of my brother Schneider's judgment.

SCHNEIDER J.—

By the close of the argument of these three appeals, which are connected with one another, we were agreed that appeal No. 10 in regard to the application for the registration of the trade mark "Radiophos" should be allowed with costs in both Courts, while appeal No. 10A should be dismissed with costs, and appeal No. 11 should be allowed with costs.

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As my brother undertook to write the principal judgment, I need not discuss the facts or the law at length, but I would state very briefly that we felt that we could not accept the main reasons given by the learned District Judge for not holding that the word " Radiophos " was an invented word. The decisions of the English Courts are accepted by our Courts as of the highest authority, for the reason that our legislation is very closely modelled upon the English law in the matter of trade marks. It appears to me that " Radiophos " is an " invented word " within the principles upon which the " Solio " case[1] and the " Tachytype " case[2] were decided.

From the history of the legislation in England, we know that the clauses—

" (*d*) An invented word or invented words ; or

" (*e*) A word or words having no reference to the character or quality of the goods and not being a geographical name.[3]"

which are to be found in our Ordinances were introduced for the purpose of obviating the difficulty which had been experienced in construing the term " fancy-word," and that in the light of the " Solio" case (*supra*) a number of words are now rendered registrable as new marks which were considered unregistrable as not coming within the term " fancy-word" or " invented word or words," as those words were interpreted by the Courts, while still under the influence of the impression which existed before the decision of the "Solio" case (*supra*). Thus, "Washerine," " Monobrut," "Satinine," "Emolliolorum," "Somatose," "Absorbine," "Bioscope," "Gramophone," " Hæmatogen," " Diabolo," and " Solio" (before appeal) were rejected, while "Mazawattee," "Kynite," "Savonol," "Tachytype," and "Kodak" were accepted as invented words. Sebastian, in his *Law of Trade Marks at pp. 57 and 58,* says : " In one of the cases on this subject, Lord Justice Kay said . . . . an invented word is allowed to be registered as a trade mark, not as a reward on merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases . . . ." Again, " I do not think that a foreign word is an invented word, simply because it has not been current in our language. At the same time, I am not prepared to go so far as to say that a combination of words from foreign languages so little known in this country that it would suggest no meaning except to a few scholars might not be regarded as an invented word." There is proof in the cases now in appeal that " Ephos " and " Ammo-phos " (for manures) have been registered in Ceylon and " Virophos" (medicated human food) ; " Ammo-phos" " Ephos," " Basphos," " Phoslag " (for fertilizers) ; " Tonophos " (table waters) have been registered in England. I, therefore, see

[1] "*In re Eastman's Photographic Materials Co., Ltd.*" (*1898*) *A. C. 571.*
[2] "*In re Linotype Co., Ltd.*" (*1900*) *2 Ch. 258.*
[3] *Section 2 (1) (d) and (e) of the Trade Marks Ordinance, No. 14 of 1888.*

no reason why the word " Radiophos " should not be registrable. Its registration would deprive no member of the community of his rights to use the existing vocabulary as he pleases.

In appeal No. 10 the applicants for registration of the rejected word " Radiophos " prayed that the registrar be ordered to strike the word " Ephos " off the register, if this Court should uphold the decision of the District Court rejecting the word " Radiophos." This strikes me as a singular application to be made in that petition of appeal, but this part of the prayer of that petition need not be considered in view of our decision that the word " Radiophos " is registrable.

I agree with the learned and well-reasoned judgment of the District Judge as regards the registration of the word " Tetraphos."

Appeal No. 11, as to the order regarding costs, must be allowed with costs. The reasons given by the learned District Judge for his order as to costs fail in that we have decided that the word " Radiophos " should be registered. The applicant accordingly succeeds in both his applications. He is entitled to his costs in the District Court in both actions Nos. 1,048 and 1,049.

I would accordingly direct that the orders be made in all three appeals as stated above.

Varied.