
(1978) 06 CAL CK 0032
In the Calcutta High Court
Case No : Trade Mark Appeal No. 291 of 1975

Banwaridas Pugalia

APPELLANT

Vs

Colgate Palmolive Co. and Others

RESPONDENT

Date of Decision : 08-06-1978

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 11, 12, 12(3)

Citation : AIR 1979 Cal 133

Hon'ble Judges : Sabyasachi Mukharji, J

Bench : Single Bench

Advocate : A.M. Panja, for the Appellant; Gautam Chakrabarty, for the Respondent

Final Decision : Dismissed

Judgement

Sabyasachi Mukharji, J.—This is an appeal under the Trade and Merchandise Marks Act, 1958 from a decision by the learned Deputy Registrar. By the said decision the learned Deputy Registrar has refused the application of the appellant for grant of a trade mark. It appears that the appellant filed an application to register in Part A of the register a trade mark consisting of the word "FORMIS" in Class 3 in respect of "Cosmetics". The application was in due course advertised before acceptance under the proviso to Section 20(1) of the Act in the appropriate journal. On 7th June, 1973, Colgate Palmolive Company of U. S. A. filed a notice of opposition to the registration. The said application thereafter came up for hearing before the learned Deputy Registrar. It was contended before the learned Deputy Registrar that the mark in respect of which the appellant was seeking registration was not adapted to distinguish within the meaning of Section 9 of the Act on the ground that the trade mark FORMIS was phonetically equivalent to the expression "FOR MISS" and as such had a direct reference to the character and quality of the goods. The learned Deputy Registrar has rejected this opposition for registration. I am of the opinion that the learned Deputy Registrar was right in rejecting this contention. Thereafter it was

contended on behalf of the opponent that u/s 11(a) of the Act, the appellant was not entitled to the registration of the mark. Section 11(a) lays down that a mark, the use of which was likely to deceive or cause confusion shall not be registered as a trade mark. The principle is, as mentioned in the decision in the case of Amritdhara Pharmacy Vs. Satyadeo Gupta, that the Act does not lay down any criteria for determining what is likely to deceive or cause confusion, Therefore, every case must depend on particular facts and the value of the authorities lies not so much in the actual decision as in the test applied for determining what is likely to deceive or cause confusion. It is important to remember that the section does not require actual confusion but the likelihood of confusion to be the test in guiding this matter. In the case of Re: Pianotist Co.'s Application (1906) 23 RFC 774 Parker, J, observed as follows at:

"You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be 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 those trade marks is used in a normal way as a Trade mark for the goods of the respective owners of the marks."

2. Bearing the aforesaid principles in mind I have to examine whether the two words are likely to cause confusion as held by the learned Deputy Registrar, It is to be noted that the words consisted of four common, letters viz. "RMIS." While the mark of the appellant was prefaced by the word "FORM", the mark of the respondent was prefaced by the word "CHA". Apart from this, the other words were common. They are in respect of similar types of goods, viz. cosmetics and toilet preparation, if not identical. The Deputy Registrar has proceeded on the basis that now-a-days it is common knowledge that the cosmetics are used irrespective of class and creed. These are used both by literate and illiterate, rich and poor.

Learned counsel on behalf of the appellant urged before me that this was without basis and the learned Deputy Registrar has come to that conclusion without evidence. I am unable to sustain this objection. After all the learned Deputy Registrar was competent to rely on what he called the common knowledge. It is true that now-a-days cosmetics are used irrespective of class and creed and both by literate and illiterate and the fact that both the words contain four common letters "RMIS". In my opinion, there was scope for confusion, as was held by the learned Deputy Registrar. However, as is well-known, apparently both the words can be confusing having regard to the stage of development in pronunciation both among the "literate and the illiterate. As I have mentioned before, it is not actual confusion but the likelihood to cause confusion, that is the guiding factor. In view of the type of the goods, the people who use it and the alphabetical use of the words in the two trade marks in my opinion, if a view is taken or conclusion is made that FORMIS is likely to be confused as CHARMIS it cannot be

said that such a view was unjustified,

3. There was also a question whether u/s 12(1) of the Act the registration should not be granted. Both are invented words having no definite use. For the reasons mentioned hereinbefore, phonetically the impugned mark is deceptively similar to the opponent's trade mark CHARMIS. Therefore, objection u/s 12 was also sustainable. It is to be noted that the appellant had started the use of mark just one month prior to the date of the application and therefore the learned Deputy Registrar held the appellant was not entitled to the benefit u/s 12(3) of the Act. Section 12(3) of the Act requires concurrent user or other special circumstances. In this case the use for one month in the background of the user for a long period by the respondent of their own mark, in my opinion, cannot be described as concurrent user. There are no other special circumstances indicated in this case. Therefore. Section 12(3) was not attracted. In the premises, in my opinion, the decision of the Deputy Registrar cannot be interfered with.

4. The appeal therefore fails and is accordingly dismissed. Each party will pay and bear its own costs.