

(1959) 03 CAL CK 0011
In the Calcutta High Court
Case No : A.F.O.O. No. 150 of 1954

Bengal Immunity Co. Ltd.

APPELLANT

Vs

Denver Chemical Manufacturing Co. and Others

RESPONDENT

Date of Decision : 17-03-1959

Acts Referred:

Evidence Act, 1872 — Section 101, 102, 103, 104
Trade Marks Act, 1940 — Section 10(1), 10(2), 6, 6(1), 8

Citation : AIR 1959 Cal 636

Hon'ble Judges : K.C. Das Gupta, C.J;R.S. Bachawat, J

Bench : Division Bench

Advocate : A.C. Gupta, Prasun Ch. Ghose, Priti Burman and N.D. Roy, for the Appellant;B. Das and Bhola Sen, for the Respondent

Final Decision : Dismissed

Judgement

Das Gupta, C. J.

1. This appeal is against the order of the Deputy Registrar of Trade Marks refusing an application by the appellant, Bengal Immunity Co. Ltd., for registration of the word "B. I. Phlogiston" in white on a dark background with the name of the appellant, Bengal Immunity Company Ltd., and its address Calcutta below the same as the trade mark for certain medicinal preparation. As originally made the application was for registration only of the word "B. I. Phlogiston". The Registrar pointed out the objection to registration of this word "B. I. Phlogiston" as the word "B. I." prefixed to "Phlogiston" would indicate the presence of double the chemical element "Phlogiston" and would be likely to cause a confusion. Though at first unwilling to make any modification, the applicant ultimately amended his application by putting full stops after "B" and "I" and removing the hyphen before "P" so that the word as it now stands in the application is, as already indicated, "B. I. Phlogiston". To this has been added the name of the applicant company and its address. Mention must also be made of the fact that on being asked whether the applicants were claiming the right to the exclusive

use of the word "Phlogiston", the applicant made the required disclaimer. The mark was thereafter advertised and an opposition was entered by the Denver Chemical Manufacturing Company, the proprietors of a trade mark "Antiphlogistine" for a similar medicinal preparation. The opponents had applied for the registration of this mark "Antiphlogistine" on 29-4-1943. That application was allowed and the mark was registered on or about the 1st October, 1947. While the opponents also contended that the mark "B. I. Phlogiston" did not satisfy the requirements of Section 6(1) of the Trade Marks Act and was therefore, *prima facie* unregistrable, their main contention was that registration should be refused under the provisions of Section 10 Sub-section 1 of the Trade Marks Act and also u/s 8 of the same Act. Section 10(1) is in these words:

"Save as provided in Sub-section (2) no trade mark shall be registered in respect of any goods or description of goods which is identical with the trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods or which so nearly resembles such trade mark as to be likely to deceive or cause confusion.""

Sub-section (2) runs thus:

"In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of trade marks which are identical or nearly resemble each other *** in respect of the same goods or description of goods, subject to such conditions and limitations, if any, as the Registrar may think fit to impose."

Section 8 provides *inter alia*:

"That no trade mark should be registered which consists or contains any matter the use of which would, by reason of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Court of Justice."

2. The Deputy Registrar held that the mark sought to be registered by the appellant satisfied the requirement of Section 6(1) of the Trade Marks Act. But holding that the mark so nearly resembles the trade mark "Antiphlogistine" belonging to the opponents as to be likely to deceive or cause confusion and that there was no case made out for permission under Sub-section (2) of S, 10, he held that the mark offended against the provision of Section 10(1) of the Act. He was also of opinion that the mark was not registrable because of the provisions of Section 8 of the Act. It was on these grounds that he made the order of refusal against which the present appeal has been preferred.

3. The first question for decision is whether the Deputy Registrar is in error in thinking that the mark "B. I. Phlogiston" so nearly resembles the mark "Antiphlogistine" as to be likely to deceive or cause confusion. There is in this case no evidence of confusion having been actually caused, though admittedly the medicine with the mark "B. I. Phlogiston" has been on the market for a

considerable time along with the medicine of the opponent company with the mark "Antiphlogistine". I am unable, however, to attach any importance to this lack of evidence as regards actual confusion. In my opinion, it is unreasonable to expect any evidence of such confusion. If there was any question of retail trader being confused when making their own purchases, one might have expected some tradesmen coming forward to give evidence that there has been such confusion, I agree that the resemblance in this case is not such as was likely to deceive or cause confusion to traders, when making their purchases. The real question is whether the resemblance is such as is likely to deceive or cause confusion to members of the public trying to obtain the medicine known to them as "Antiphlogistine". If any member of the public, has actually been confused or deceived and as a result thereof got a pot of the appellant's preparation "B. I. Phlogiston" when they asked for and wanted a pot of "Antiphlogistine" and found later that there has been such confusion, it is unreasonable to expect that he would take the trouble of complaining to the trader from whom he got the goods. All that he was likely to do would be more careful next time and to see that no such mistake was made again. The absence of any evidence as regards any actual case of confusion or deception is, therefore, to my mind of no value whatsoever.

4. Whether or not there is any resemblance and whether or not the resemblance is such as is likely to deceive or cause confusion are questions which have to be decided by the Registrar and the Court on the basis of their own understanding of the matter. As was pointed out by Lord Macnaughton in *Paton and Co. Ltd. v. Sneltly Lampan and Co. Ltd.* (1900) 7 RPC 628 at p. 635,

"The Judge looking at the exhibits before him and also paying attention to the evidence adduced, must not surrender his own independent judgment to any witness whatsoever."

Lord Halsbury in *North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co.* 1899 AC 83 said:

"Is this name so nearly resembling the name of another firm as to be likely to deceive? That is a question upon which evidence of course might be given, as to whether or not there was another brewery either in the one place or in the other or whether there were several breweries nearly resembling it in name; what the state of the trade was, and whether there was any trade name; all those are matters which are proper to be dealt with upon evidence; but upon the one question which your Lordships have to decide, whether the one name is so nearly resembling another as to be calculated to deceive, I am of opinion that no witness would be entitled to say that, and for this reason: that that is the very question which your Lordships have to decide."

The position clearly is that the Registrar in the first place and then when the matter goes to the Court, the Court has to decide for itself quite apart from evidence of cases of actual confusion or the opinions of experts as to the

likelihood of confusion, as to the inherent probability of the confusion. In making a decision on this question the Registrar and the Court has to take into consideration all the surrounding circumstances--the extent of the resemblance, visual or phonetic, the nature of the market of the goods, the character, education and general mental equipment of the persons who are likely to purchase these goods and all other matters which are relevant. While it is not possible to lay down the tests which have to be applied, it is helpful to remember the principle adopted by eminent judges in similar matters. An authoritative statement of such principle is to be found in the Pianotist Co.'s application (1906) 23 RPC 774 in these words of Parker, J. :

"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 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. If, considering all those 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 the registration in that case."

5. In applying this principle to the present case I find that while between the trade mark "Antiphlogistine" as registered which is in script, and the mark now applied for, the visual resemblance may not be great, there is considerable resemblance in sound. It seems to me reasonable to think that when uttering a word of so many syllables as "Antiphlogistine" or "B. I. Phlogiston," the first two syllables of "Antiphlogistine" and the first syllable of "B. I. Phlogiston" are likely to be pronounced indistinctly. I am also of opinion that most people would pronounce the last syllable "tine" as "tin" the result of which would be that unless the elocution is very clear, the last syllable "tine" of "Antiphlogistine" and the last syllable "ton" of "B. I. Phlogiston" would sound almost the same.

6. It is necessary also to bear in mind that the majority of the people of this country have an imperfect acquaintance with the English language. Add to it the usual imperfect recollection of the names of medicines, and it becomes clear that most people would, if on being asked for a pot of "Antiphlogistine" they be given a pot of "B. I. Phlogiston", fail to detect the difference. The portion of "Antiphlogistine" which is likely to linger in their imperfect recollection is "phlogistine" and when given "B. I. Phlogiston" they would in most cases, I think, be deceived into thinking that what they were getting would be the same thing.

7. It is necessary to remember also that in many cases people act as their own doctors and do not take the trouble or expense of consulting a doctor for minor ailments like inflammations or abscesses. If in the past a doctor has prescribed "Antiphlogistine" for such ailments, they would go to the chemist and ask for

"Antiphlogistine" or telephone for "Antiphlogistine" without a written prescription of a doctor. The chemises assistant, I am sure, would know well that "B. I. Phlogiston" and "Antiphlogistine" are different preparations. Without being dishonest, however, he may sometimes supply to the customer "B. I. Phlogiston" even though "Antiphlogistine" has been asked for, for the simple reason that he has not got "Antiphlogistine" in stock. It may sometimes even happen, if the order is placed on the telephone, that even the chemist's assistant would wrongly hear "B. I. Phlogiston" for "Antiphlogistine." Close examination of the trade mark would certainly show to the customer that the things are different, but such close examination often takes place long after the actual purchases and--often the examination is made just at the time or immediately before the use of the medicine,--and then it is too late to change the goods. Even if it is possible to change the goods, most people would be lazy to try. The result of all this would be that a customer has been deceived into accepting the appellant's manufacture while what he wanted was the opponent's manufacture.

8. As I have indicated above the great similarity in sound will often confuse retail traders in relation to their customers. Such confusion is very likely to arise when the pronunciation of the word "Antiphlogistine" is not distinct, specially when the order is made on the telephone. If the customer himself knows of the two manufactures marketed in the name of "Antiphlogistine" and "B. I. Phlogiston," he is likely to take more care about the pronunciation of the name and there may not be confusion. In deciding whether the similarity is such as is likely to cause confusion, however, we have to take the case of a customer who knows of "Antiphlogistine" and its reputation either from actual experience or otherwise but does not know of "B. I. Phlogiston." Such a customer is not likely to be particularly careful of pronouncing the different syllables as distinctly as might be desired and when the order is placed on the telephone, the tradesman may well be in doubt as to which of the two products the customer is asking.

9. And when a customer who knows or has heard of "Antiphlogistine" but does not know about "B. I. Phlogiston," is offered a pot of "B. I. Phlogiston," he may in many cases be led to suppose that this is in some way connected with the preparation "Antiphlogistine" and accept it on that confusion.

10. We have to remember in this connection a circumstance which I have already indicated that many people in this country who are likely to be customers of a medicinal preparation of this kind, are illiterate and of those who are literate, many cannot read English. They are very likely to go by the sound of the name and where, as in the present case, the dominating feature of the two words "Antiphlogistine" and "B. I. Phlogiston" is the "phlogistine" and "phlogiston," the chances of confusion and deception are considerably increased in the cases of such customers.

11. It is necessary also to remember that the burden of proving that the resemblance in the marks is not likely to deceive or to cause confusion is on the applicant and where there is doubt whether there is such likelihood or not, he will

not be entitled to registration. In the present case, for the reasons I have already mentioned, I am of opinion that the word "B. I. Phlogiston" resembles the registered trade mark "Antiphlogistine" so much as to be likely to deceive and to cause confusion.

12. But, argued Dr. Gupta, a refusal of the applicant's prayer for registration of the mark "B. I. Phlogiston" on the ground of its resemblance to "Antiphlogistine" would amount practically to a recognition of the opponent's monopoly in a common English word "phlogiston." No person has a monopoly in common words of the language and he cannot obtain the monopoly in such a word by merely corrupting the ordinary form of the word. Dr. Gupta drew our attention to the decision of the House of Lords in *Yorkshire Copper Works Ltd. v. Registrar of Trade Marks* 1954 1 WLR 554 and the observations of Lord Cohen therein, where the importance of the Court being careful not to allow any claimant to obtain a monopoly further than is consistent with reason and fair dealing was emphasised. There Lord Cohen quoted with approval the statement of the principle by Sir Herbert Cozens-Hardy in these words in the *Prefection Soap* case: *In re Crossfield and Sons Ltd.* (1910) 26 RPC 837):

"Wealthy traders are habitually eager to enclose art of the great common of the English language and to exclude the general public of the present day and of the future from access to the inclosure,"

and to Farwell L.J.'s observation in the same case:

"The court is careful not to interfere with other persons' rights further than is necessary for the protection of the claimant, and not to allow any claimant to obtain a monopoly further than is consistent with reason and fair dealing."

13. Of the wisdom of the principle laid down in these words, there can be no doubt. The provisions of Section 6 of the Indian Act are intended to protect all common words of the language from the monopoly that would result from registration as a trade mark. The *Yorkshire Copper Works Ltd.* case 1954 1 WLR 554 to the observations in which Dr. Gupta has drawn our attention was itself concerned with the question whether the word "Yorkshire" was registrable as a trade mark. It did not come within paragraphs (a), (b), (c) or (d) of 9(1) of the English Act which is almost word for word the same as Section 6 of our own Act. What had to be decided was whether it fell within 9(1)(e), on the ground that it was a distinctive mark. The court held against the contention that it was so distinctive and it was in this connection that the observations of Sir Herbert Cozens-Hardy and Farwell L. J. were quoted with approval by Lord Cohen.

14. If the question before us was whether registration of the word "Antiphlogistine" was rightly allowed, the question raised by Dr. Gupta that this would amount to giving the manufacturers of "Antiphlogistine" a monopoly in the English word "phlogiston," would require consideration. We, however, have not to deal now with that question. The word "Antiphlogistine" has already been put on the register of trade marks and the question before us is whether the word "B. I.

Phlogiston" is so similar to the word "Antiphlogistine" as to be likely to deceive or cause confusion. If it is found that it is so likely to deceive or cause confusion or it is found that the applicant has been unable to discharge the onus that lay on him to show that it is not likely to deceive or cause confusion. I am unable to see how the question whether the refusal of the applicant's prayer would result in granting a monopoly to the opponent to the use of the word "phlogiston" arises at all.

15. The appellant then falls back on the provisions of Section 10 Sub-section (2) and contends that as his trade mark "B. I. Phlogiston" has for many years been used concurrently with "Antiphlogistine," registration should be allowed even though it may be made subject to conditions and limitations. Leaving out of account the difference between the mark as used by the applicant before he amended his application and the mark as used after such amendment, namely, that the mark used earlier was "B. I. Phlogiston" and the mark in recent use is "B. I. Phlogiston," I am prepared to agree that the mark of which registration is now asked for has been used concurrently with the mark "Antiphlogistine" from 1934 onwards. That would certainly be long concurrent use. It is also reasonable to think that the applicant's goods have acquired a reputation of their own under the name "B. I. Phlogiston" with people who may or may not know of the opponents goods "Antiphlogistine." If this concurrent use had been honest concurrent use, I would have thought this to be a proper case where concurrent registration" should be allowed.

16. I am unable to persuade myself, however, that this use has been honest. We find that the opponents had put their preparation "Antiphlogistine on the Indian market as early as 1902 and this word was recorded in their name in the Office of the Registrar of Deeds and Assurances, Calcutta in 1908 and later at the office of the Chamber of Commerce in Upper India in 1922. It was again registered with the Madras Chamber of Commerce in 1932. It is reasonable to think and it is not disputed that by this date 1932, the opponent's goods "Antiphlogistine" had acquired a reputation in the Indian market. The opponent's claim to ownership of this mark "Antiphlogistine" was advertised in the Madras Mail on 4-3-1932; in the Statement on 19-12-1933; and the Civil and Military Gazette in 1934. When the applicant company put its own preparation of a similar medicine on the market in 1933, it was issued under the name "Bi Phlogistic Balm." It was sometime next year, 1934 that the name was changed into "Bi Phlogiston." No explanation has been offered for this change. I find it impossible to think of any other explanation for this except that the applicant company knowing that "Antiphlogistine" had acquired a reputation in the market, wanted to take advantage of that reputation by marking its own goods under a name as similar to it as was thought safe. It is worth noticing in this connection that "phlogiston," according to dictionary, means an inflammatory element. To any person who might know the meaning of the word "Phlogiston" the "B. I. Phlogiston" would mean, remembering that "B. I." stands for Bengal Immunity, Bengal Immunity's inflammatory element. While it is true that one of the requirements of a trade

mark if it is to be registrable, is that it has to be distinctive and must not be descriptive, I am unable to persuade myself that the applicant company would have chosen a mark which would, on the face of it, indicate not that their medicine would remedy inflammation but that it promotes inflammation, were it not for some ulterior motive which overrules such consideration. That ulterior motive, it is in my opinion reasonable to think, was to take advantage of the reputation acquired by "Antiphlogistine."

17. I have, therefore, come to the conclusion that the Deputy Registrar is right in thinking that the applicants have not acted bona fide in adopting their mark so nearly resembling the opponent's mark of admitted reputation. Clearly, therefore, there was no honest concurrent user within the meaning of Section 10(2) of the Act.

18. As a last resort Dr. Gupta contended that even if the concurrent use is found not to be honest there are here "other special circumstances" because of which action should be taken under Sub-section (2) of Section 10. He has tried to persuade us that the hardship caused to the applicant by the refusal of his mark, which itself has gained a reputation of its own by use for a number of years, will be out of all proportion to the damage likely to be caused by the likelihood of confusion or deception that might result if the application be allowed. He has in this connection drawn our attention to the evidence that a very large number of stockists stocked the applicant's preparation and that the sales have been considerable. I am inclined to accept the evidence that a very large number of stockists throughout the country stocked the applicant's preparation and that the sales have been considerable at least during the year following 1939. I am not so sure, however, that a part of these sales has not been due to the confusion that was actually caused by the similarity of the applicant's mark to the opponent's mark "Antiphlogistine." Even if I assume, however, for argument's sake that the hardship caused to the applicant by the refusal of the application will be much greater than the damage caused to the public or to the opponent, I find it impossible to accept as correct the proposition of law that even where concurrent use has been proved to be dishonest, it is open to the Registrar to permit registration on the basis of "other special circumstances." As I read the Section, the intention of the legislature clearly was that in two classes of cases registration would be permitted when there is identity or resemblance likely to deceive or cause confusion--the first class to consist of cases of honest concurrent use and the second class to consist of cases where there are special circumstances not being cases of dishonest concurrent use. It is well to remember that the whole idea behind the law of registration of trade marks is to prevent fraudulent use of the marks of one proprietor by another proprietor.

19. The dominant purpose of the law for registration of trade marks being the prevention of dishonest and fraudulent use of marks, how could the legislature possibly permit registration in favour of a person who has been proved to have acted dishonestly? In my opinion, the legislature did not intend to permit

registration on the ground of any circumstance whatsoever in a case where the applicant had already used the mark dishonestly. Dr. Gupta's contention that registration should be permitted on the ground of "other special circumstances" must, therefore, be rejected, as in this case, as I have already stated, the use by the applicant of the mark now sought to be registered, has been shown to be dishonest.

20. This is sufficient to dispose of the appeal. As, however, one ground of objection raised by the opponent to the application was that the mark did not satisfy the requirement of Section 6 (1) of the Act, I think it proper to consider that question also. For the applicant, the case on this point was that the mark had the essential particulars mentioned in Section 6(1)(d), that is, it contained a word having no direct reference to the character or quality of the goods and not being a geographical name. Though the word "Phlogiston," as already pointed out, means an inflammatory element the word is not in common use as was pointed out by the Deputy Registrar. It would be unreasonable, in my opinion, to say that "B. I. Phlogiston" has direct reference to the character or quality of the goods. But urged Mr. Das, that even so it is not distinctive. It seems to me that ordinarily when one of the particulars mentioned in (a), (b), (c) or (d) is shown to be present, the presumption is that the] mark is distinctive. Quite apart from that, however, I am of opinion that this mark is inherently adapted to distinguish the applicant's goods from other similar goods in the trade. I have, therefore, come to the conclusion that the Deputy Registrar is right in his view that the mark "B. I. Phlogiston" is distinctive and satisfies the requirement of Section 6(1) of the Act.

21. As however the mark offends against the provisions of Section 10(1) of the Act and no case is made out for action u/s 10(2), the application is bound to fail. The findings as regards the likelihood of deception or confusion as made above also bring into operation the provisions of Section 8 of the Act so that under that section also the application for registration must fail.

22. I would, accordingly, dismiss this appeal with costs.

Bachawat, J.

23. I agree.