

(1983) 12 BOM CK 0024

In the Bombay High Court

Case No : Appeal No. 27 of 1979 in Miscellaneous Petition No. 1240 of 1975

Hiralal Parbhudas

APPELLANT

Vs

Ganesh Trading Company and Others

RESPONDENT

Date of Decision : 06-12-1983

Acts Referred:

Criminal Procedure Code, 1973 (CrPC) — Section 6
Oaths Act, 1969 — Section 3(1)
Trade and Merchandise Marks Act, 1958 — Section 12, 12(3), 56
Trade and Merchandise Marks Rules, 1959 — Rule 116(1), 116(3)

Citation : AIR 1984 Bom 218

Hon'ble Judges : Sawant, J;Lebtub, J

Bench : Division Bench

Advocate : V. Tulzapurkar, for the Appellant; H.W. Kale and V.S. Jog, for the Respondent

Judgement

Lentin, J.—This is an appeal from the Judgment and Order of the learned single Judge dismissing the appellants petition for setting aside the order passed by the Deputy Registrar of Trade Marks rejecting the appellants' application for rectification of the register.

2. The appellants are bidi manufacturers and were the proprietors of four label marks registered in Part A in the Trade Marks Register in April 1943, May 1950, August 1950, and September 1956. For the moment, broadly stated, the appellants labels comprise of the bust of a man and the name Hiralal in Devanagri script over the bust.

3. Respondents 1 and 2 (referred to hereafter as "the respondents") who carry on like business, applied on 7th January, 1970 for registration of their label which for the moment, broadly stated, comprises of the bust of a man and the name Himatlal in Devnagri script over the bust. The application was signed by the 1st respondent's partner Vallabhdas Laljibhai Patel. The respondents label was registered relating back to 29th January, 1970 in class A restricted to Gujarat

territory. On 7th October, 1970 the respondents applied for amendment of their registration application, to wit, that on their label the name "Himatlal" should be read as "Vallabhdas alias Himatlal". On 11th January, 1973 the appellants applied for rectification of the register on the ground that the respondents' label was deceptively similar to the appellants' registered trade mark. That application was rejected by the Deputy register of Trade Marks. The appellants' petition in this Court for setting aside the Deputy Registrar's order was also dismissed by the learned single Judge on the Ground that the labels are not deceptively similar with no probability of causing confusion. Hence the present appeal.

4. The main bone of contention between the parties before us is whether the respondents' label is deceptively similar to the appellants' labels. To that end, it would be appropriate to recapitulate some well-established principles. In Kerly's Law of Trade Marks and Trade Names" (10th Edition, pages 456-457) appears the following passage:--

"Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same marks as that with which he was acquainted. Thus, for example, a mark may represent a game of football; an other mark may show players in a different dress, and in very different positions and yet the idea conveyed by each might be simply a game of football; It would be too much to expect that persons dealing with trade-marked goods and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in details might well be supposed by customers to have been made by the owners of the traded mark they are already acquainted with for reasons of their own."

In *Re Sadow Ltd* (1914) 31 RPC 196 , it was held that identity of the figure in the centre is immaterial, the overall similarity between the two marks being the touchstone. In *James Chadwick and Bros. Ltd. Vs. The National Sewing Thread Co. Ltd.* , it was held by the Division Bench that it is important to find out what is the distinguishing or essential feature of the trade mark already registered and what is the main feature or the main idea underlying that trade mark and ascertain if the trade mark whose registration is sought contains the same distinguishing or essential feature or conveys the same idea. The question to be asked is that would be the salient feature of the mark which in future would lead the purchaser to associate the particular goods with that trade mark. In *Corn Products Refining Co. Vs. Shangrila Food Products Ltd.* , holding that "Glucovita" and "Gluvita" were deceptively similar, it was observed that in deciding the question of similarity between the question of similarity between the two marks

the approach must be from the point of view of a man of average intelligence and of a man of average intelligence and of imperfect recollection and to such a person the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause confusion between them. In *Amritdhara Pharmacy Vs. Satyadeo Gupta*, , coming to the conclusion that to an unwary purchaser of average intelligence and imperfect recollection, the overall structure and phonetic similarity between the two names "Amritdhara" and "Lakshmandhara" was likely to deceive or cause confusion, it was held that if a person is put in a state of wonderment it is sufficient to hold that the mark is likely to deceive or cause confusion. In *F. Hoffmann-la Roche and Co. Ltd. Vs. Geoffrey Manner and Co. Pvt. Ltd.*, , it was held that marks must be compared as a whole, the true test being whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark. Microscopic examinations not called for. Both visual and phonetic tests must be applied. In *Parle Products (P) Ltd. Vs. J.P. and Co., Mysore*, it was held that what must be considered are the broad and essential features of the two marks which should not be placed side by side in order to find out the differences in design. It is enough if the impugned mark bears an overran similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. Each case must be judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it.

5. What emerges from these authorities is (a) what is the main idea or salient features, (b) marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole, (c) overall similarity is the touchstone, (d) marks must be looked at from the view and first impression of a person of average intelligence and imperfect recollection, (e) overall structure phonetic simitant and both visual and phonetic tests must be applied, (f) the purchaser must not be put in a state of wonderment, (g) marks must be compared as a whole, microscopic examination being impermissible, (h) the broad and salient features must be considered for which the marks must not be placed side by side to find out differences in design and (I) overall similarity is sufficient. In addition indisputably must also be taken in-to consideration the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances.

6. With these well-established principles in the forefront, it is time to consider the essential features of thd labels in the present case.

7. The appellants' mark comprises (i) of the word "Om" in Devnagri script at the top centre against a black background; (ii) under "om there is a black curvy band across which is written Hiralal Chhap Bidi" in devnagri script; (iii) underneath and in the centre of the label is the bust of a man; (iv) on either side of the bust there is a scroll and (v) a thick black band runs across the bottom of the label.

8. Coming to the respondents' label, is not in dispute, as rightly and fairly conceded by the respondents' learned counsel Mr. Kale, that all the features and various placements in the respondents' label are the same as those in the appellants' labels except for the bust and the words "Himatlal special Bidi" with emphasis on "Himatlal urging that while the appellants' bidi are known as "Himatlal Bidis". It is on these two features that Mr. Kale concentrated his arguments.

9. In support of his first submission, that the two busts are entirely different, Mr. Kale invited us to compare the labels by placing them side by side and emphasized the dissimilarities in the two busts, namely, that in the appellants labels the is of a man (i) apparently in his forties, (ii) with a down turned longish moustache, (iii) wearing a turban and closed collar coat and (iv) with a shawl across the shoulder whereas the respondents bust is (a) of a younger man in his apparent thirties, (b) clean-shaven and bare-headed, (c) wearing glasses and (d) an open-neck shirt. On such dissimilarities Mr. Kale invited us to hold that the respondents label is not

10. It is true that these dissimilarities in the two busts do emerge but they do so on a close scrutiny of the labels placed side by side contrary to the well established principles. The question we must ask ourselves is : What would be the effect on the mind of a person of average intelligence and imperfect recollection? Applying that test with the well-established Principles . The would be the effect on the mind of a person of average intelligence and imperfect recollection? Applying that test with the well established principles summarised in para 5 earlier, there can be no manner of doubt that the respondents label is deceptively similar to the appellants labels. It would be highly improbable to expect an ordinary person of average intelligence and imperfect recollection (as against the well-trained eye) to recall the exact nature and features of the appellants bust before being led into confusing it with the respondents bust and consequently purchasing the respondents bids in the belief that he was purchasing the appellants bidis. This is all the more manifest that as stated earlier all the other features and various placements in the respondent label are indisputably and admittedly the same as the appellants labels.

11. Coming to Mr. Kales second limb of his submission, he urged that bidi smokers are confused in their choice of brands and would for those of the respondents, bidi for those of the appellants, because on the respondents label is mentioned "Himatlal Special Bidi", whereas on the appellants' label . Mr. Kale laid emphasis on :Himatlal" and "Hiralal" as the distinction between which consumers would ask for the bidis. Mr Kale further urged that the respondents bidis are sold only that in Gujarat territory, where unlike in other parts of the country , purchases would know "Himatlal". He relied on the following passage in Kerly's Law of Trade Marks and Trade Names 10th Edition at page 473:-

"Marks deceptive in particular markets :

Marks which are readily distinguishable by Englishmen, or persons who can read English, may so resemble each other as to be calculated to deceive foreigners whose language is not only different from English, but written in different characters and in a different manner..."

12. These contentions are as fall "Hiralal" and "Himatlal" are both common Indian names. There is a great deal of similarity in the phonetics of these two words be they toured in Gujarat by consumers who may even be illiterate. This phonetic similarity taken in conjunction with the otherwise similarity in the get up of the offending label with the appellants labels would to our minds, undoubtedly confuse an ordinary purchaser of average intelligence and imperfect recollection and who may even be illiterate.

13. We have no hesitation in coming to the finding that the respondents label is deceptively similar to the appellants labels and is likely to deceive or cause confusion.

14. There is also evidence on record that deception was actually caused and that confusion actually resulted. To start with the conduct of the respondents in applying for amendment of their registration so as to read "Vallabhdas alias Himatlal". Is significant and reveals their anxiety to come as close to the appellants' labels on the sudden pretext that the pet-name of the 1st respondents partner Vallabhdas Laljibhai Patel (who had signed the registration application is infact Himatlal. On this aspect the learned single Judge has correctly observed that there is no evidence to support any such theory. What is more, evidence in the form of affidavits filed before the Deputy Registrar by not less than 3 consumers and not less than 4 dealers with specific instances. Bring to the forefront that deception was practised and confusion resulted as a result of the respondents label. The burden thereupon shifted to the respondents who insignificantly chose to lead no evidence to establish the contrary and chose merely to content themselves by making a general denial in their affidavit before the Deputy Registrar. It was for the respondents to have established by cogent evidence before the Deputy Registrar what is now urged by their learned counsel, viz. (i) that bidis were counsel, viz asked for as : Himatlal Bidis, and (ii) that other features on the label are common to the trade including the syllable la after :Hira and "Himat" Nothing of the kind was even remotely attempted to be done by the respondents before the Deputy Registrar. Thus the appellants have succeeded in establishing both deception as well as confusion.

"The question whether one mark so nearly resembles another as to be likely to deceive is a question for the tribunal and is not a matter for a witness. Thus where the case turns on phonetic resemblance. Once the evidence has established how the marks are pronounced in use, the judicial ear has the final say. "The question of infringement . the question whether one mark is likely to cause confusion with another, is a matter upon which the judge must make up his mind and which, he and he alone, must decide. He cannot abdicate the

decision in that matter to witness before him."

15. Reliance by Mr. Kale on this passage is misplaced. We do not say that confusion is likely to be caused because of the contents of these affidavits, but after applying the well-established principles in such cases. To quote from Kerly from the very next sentence at which Mr. Kale fell short -

On the other hand, it is equally the true he must be guided in all these matters by the evidence before, him and where the evidence is that there has been no confusion that is that material matter which the judge must take into account".

16. Here the evidence is to the contrary.

17. Mr. Kale now says that those affidavits should not be considered as they do not conform to Rule 116(1) and (3)(a) of the Trade and Merchandise Marks Rules, 1959, inasmuch as they are not headed in the matter or matters to which they relate "as required by sub-rule (1) and have not been taken" before any Court or person having by law authority to receive evidence, or before any officer empowered by such Court as aforesaid to administer oaths or to take affidavits "as required by sub-rule (3)(a).

18. There is no merit in this contention. In respect of the offending label, the appellants had filed a passing off action against had filed a passing off action against the respondents in the Court of learned District Judge at Himatnagar on 27th March, 1974. In that suit, two dealers affidavits and one consumers affidavit and been affirmed before the learned Civil Judge (Junior Division). True copies of those affidavits were with leave of the Deputy Registrar taken on record, and considered by her. In addition the appellants filed before the Deputy Registrar taken on record, and considered by her. In addition the appellants filed before the Deputy Registrar filed before the Deputy Registrar two dealers affidavits and two consumers affidavits with the correct heading and which declared before the Executive magistrate, Taluka Bhuj. Section 3(1)(a) of the Oaths Act, 1969 empowers "all courts and persons having by law authority to receive evidence to administer oath. Section 6 of the Criminal Courts, Executive magistrates being one of them. Thus Executive Magistrates being empowered to administer oath, the swearing of certain affidavits before the Executive Magistrate was legal and proper. No objection was taken by the respondents before the Deputy Registrar to the filing of any of these, affidavits. It is only now at the appellate stage, is it sought to be urged for the first time that these affidavits should not be considered. In view of these circumstances, Mr. Kale's unfounded and belated resort to R. 116(1) and (3) (a) must only redound to the respondents utter desperation in now attempting to negate willy-nilly in now effect of those affidavits and which the respondents themselves and (perhaps with wisdom) did not choose to do at any time before.

19. Even assuming for the sake of argument that none of these affidavits can be looked in to as suggested by Mr. Kale, even so in the light of the discussion earlier, the respondents label is deceptively similar to the appellants labels and

that should be the end of the matter.

20. It is also not without its own significance that the appellants have also disclosed their vast sales in also disclosed their vast sales in Gujarat territory from Rs. 1,02,25,24,243,75 to Rs. 1,73,81,544,1 during the relevant period , as also the vast amounts spent by them from rs. 2,74,448,97 to Rupees 3,93,599,53 over advertisements during this period. Small wonder at the respondents attempt to cash in on the respondents attempt to cash in on the appellants vast sales and publicity by getting their label as close as possible to the appellants labels.

21. It was urged by Mr. Kale that the respondents were entitled to the benefit of Section 12(3) of the Act on the ground of honest concurrent user. This plea is certainly not been open to the respondents. The entire modus operandi of the respondents has been far from honest . It is also not without its own significance that no explanation has ... adopted their mark. Beyond Mr. Kale's plea thrown across the Bar, there is nothing on record that the get-up of the labels is usual and commonly used by bidi manufacturers. It is manifest that the entire exercise has been engineered by the respondents against a vastly successful competitor, namely, the appellants. Where a case is not founded on truth such as the present, to such a person the benefit of Section 12(3) IS NOT AVAILABLE. Mahomed Omer Mahomed Noorulla Sahib Vs. S.M. Nooruddin, Furthermore this is not a lis between the two parties. It is public interest and that must be of primary consideration and the purity of the register must be maintained, Kanshiram Surinderkumar a firm Vs. Thakurdas Deomal Rohire and Others,

22. It was finally urged by Mr. Kale that the discretion exercise by the Deputy Registrar u/s 56 of the Act in the respondents favour should not be lightly disturbed and the appellate Court should therefore not disturb the judgment and order of the learned single Judge. We ask ourselves; Pray where at all arises the Deputy Registrar did not exercise any discretion under Section 56 in rejecting the appellants application for rectification. It must be remembered that the concept of discretion is distinct from that of adjudication. When the Deputy Registrar rejected the appellants application for rectification on the ground that the two marks are not deceptively similar, she did not use any discretion but adjudicated upon the rival contentions of the parties. It would be trite to say that exercise of discretion can arise in favour of a party when adjudication by the Registrar is against that party. In the present case, the Deputy Registrar's adjudication was in fact in favour of the respondents, with the result that there was no occasion for the Deputy Registrar to exercise any discretion. If the Deputy Registrar had held that the two marks were deceptively similar (which she did not) but that in exercise of her discretion she did not consider it necessary to pass an order for rectification , it could be said that the Deputy Registrar having exercised the discretion in favour of the respondents , interference with such discretion was not called for. Nothing of the kind can be said in the present case where in fact the Deputy Registrar

has held that the two marks are not deceptively similar. In any event, this court having come to the conclusion that the two marks are deceptively similar, this cannot be a case for the exercise of discretion In favour of the respondents as their case is not founded on truth and also in view of the uncontroverted evidence of actual deception Perpetrated and confusion caused.

23. In the result the appeal is allowed and the judgment and orders of the learned single Judge and the Deputy RRRRRRegistrar respectively are set aside and the appellants application for rectification is consequently allowed. The respondents shall pay to the appellants the costs thorugout;

24. The Prothonotary and Senior Master is requested to send a copy of this Judgement to the RRRRRRegistrar for requisite action.

25. On Mr. Kale"s application operation of the order stayed for the a period of 2 weeks from today.

26. Appeal allowed.