
(1968) 10 P&H CK 0027
In the Punjab And Haryana At Chandigarh
Case No : First Appeal No. 449 of 1958

J. and P. Coats Ltd.

APPELLANT

Vs

Gurcharan Singh and Brothers and Another

RESPONDENT

Date of Decision : 24-10-1968

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 41 Rule 27
Evidence Act, 1872 — Section 101
Trade Marks Act, 1940 — Section 21

Citation : AIR 1969 P&H 290 : (1970) 1 ILR (P&H) 487

Hon'ble Judges : S.B. Kapoor, J; R.S. Narula, J

Bench : Division Bench

Advocate : D.N. Awasthy and A.L. Bahri, for the Appellant; Sardari Lal Sachdev and Ujjal Singh Sahani, for the Respondent

Judgement

R.S. Narula, J.—The facts leading to the filing of this Regular First Appeal by the unsuccessful plaintiff against the decree of Shri Parshotam Sarup, Additional District Judge, Amritsar, dated August 4, 1958, dismissing the plaintiff's suit for a permanent injunction and accounts arising out of the alleged infringement of two registered trade-Marks of the appellant are these:

Messrs. J. and P. Coats Limited, an English company having its registered office in Glasgow, Scotland (hereinafter called the plaintiff), has for a long time been engaged in the manufacture and sale of sewing and embroidery threads of various kinds under different registered trade-marks. It is no more in dispute before us that the plaintiff is the owner by assignment of :-

(i) trade-mark No. B. 42 registered in respect of threads of all kinds in Class 23. The trade-mark consists of a representation affixed on the certificate of registration Exhibit P. 12 which consists of a plain picture of an elephant in black and white standing over an intertwined thread roll;

(ii) trade-mark No. B. 51 registered in respect of threads of all kinds in Class 23, a representation of which is affixed on the certificate of registration Exhibit P. 11.

The said representation consists of a circle in thick black line enclosing a white surface in which there are two parallel horizontal lines just below and just above the centre of the circle with shaded lines surface in between the said two parallel lines. On the shaded surface enclosed by the two parallel horizontal lines is written the word "elephant" in bold capital letters. On the upper parallel line stands a small picture of an elephant in black and white. The picture of the elephant is made by just drawing black lines on the white surface. At the bottom, inside the circle is another small line drawn to make the shape of a covered bowl. This is the trade-mark used by the plaintiff on the ticket affixed on the outer side of their wooden reels on which sewing thread is wound up.

2. Both these marks are registered with the Registrar of Trade-Marks, Bombay. The plaintiff has granted the right of user of both the above said trade-marks to Messrs. Jumna Thread Mills Private Limited, Bombay, and the said Bombay company is the registered user of those marks u/s 41 of the Trade Marks Act (5 of 1940) (hereinafter referred to as the Act).

3. Gurcharan Singh respondent No. 2 is carrying on the business of manufacture and sale of cotton threads at Amritsar in the Punjab under the name and style and as the sole proprietor of Messrs. Gurcharan Singh and Brothers. The cotton threads manufactured and sold by the respondents are bound in wrappers and contained in boxes on the covers of which wrappers and boxes is depicted the registered design of the respondents named "Jagjit Hathi.". In June, 1956, the plaintiff filed this suit in the principal Civil Court of original jurisdiction at Amritsar to restrain the respondents, their partners, employees, representatives, agents and servants from using their trade-mark "Jagjit Hathi Brand" in respect of sewing threads of all kinds manufactured, sold, distributed or dealt with by the respondents, and to direct the respondents by a mandatory injunction to expunge and destroy their alleged impugned marks from the reels, balls, packages, covers, advertisements etc. in connexion with sewing threads of all kinds; on the allegations that the plaintiff had come to know on or about June 11, 1955, that the respondents had started manufacturing and selling cotton threads bound in wrapper and contained in boxes containing the representations of an elephant and that the thread of the respondents was being described as "Jagjit Hathi Brand", and on the further allegation that the user by the respondents of the said representation on the goods manufactured and/or sold by them amounted to an infringement of the plaintiff's trade-mark "Elephant" and was calculated to deceive the trade and public into believing that the goods of the respondents are the goods manufactured and/or sold by the plaintiff, or its registered users. Further relief of taking accounts of all sales and profits made by the respondents from the sale of sewing threads of all kinds bearing the alleged offending mark and a decree therefore was also claimed.

4. In their written statement, dated July 27, 1956, the respondents raised various preliminary objections, with none of which we are now concerned. On the merits of the controversy they pleaded, inter alia, that the goods of the plaintiff

are not sold at Amritsar or any other place in the State of Punjab, that respondents "Jagjit Hathi" design has been registered under No. 79430, and as such they have every right to use the same on their own goods and the respondents are using the same since July, 1954, to the knowledge of the trade, and is being used by many traders in India in their own right that the simple word "Hathi" is not registrable and it does not confer any right on the persons using the same, that the Jagjit Hathi trade-mark of the respondents is in no way an infringement of the plaintiff's trade-mark, and is in no way calculated to deceive the trade or general public or even the illiterate or unwary purchasers. The respondents added in their written statement that their goods could not be passed off in any way as and for the goods manufactured by the plaintiff and bearing the alleged elephant picture, as the Jagjit Hathi mark of the respondents is absolutely distinct and wholly dissimilar to the elephant mark of the plaintiff. According to the respondents the suit of the plaintiff was merely speculative and no confusion was likely to be caused or had ever been caused to any trader or purchaser by the respondents' use of their own Jagjit Hathi mark on the goods manufactured by them as utter dissimilarity between the two sets of marks was patent. On the basis of the above pleas it was denied by the respondents that the plaintiff was entitled to any of the reliefs claimed by it.

5. In its replication, dated October 8, 1956, the plaintiff controverted the relevant allegations of the respondents, reiterated its own original stand, and added that the alleged use of the "Jagjit Hathi" mark is calculated to pass off the goods of the plaintiff and this showed the guilty intention of the respondents. The plaintiff further stated that the design of boxes could not be used to represent the sewing thread as "Jagjit Hathi mark Nalki" and that the word "Hathi" is not common to the trade. Finally the plaintiff added in its replication that the design used by the respondents is meant to deceive unwary purchasers as the use of the word "Hathi" and the pictorial representation are both calculated to mislead the unwary purchasers and the intention of the respondents is to pass off their goods as of the plaintiff.

6. The four preliminary issues arising out of some technical preliminary objections of the respondents which were framed on January 28, 1957, were decided in favour of the plaintiff by the order of the trial Court, dated June 17, 1957, None of the questions covered by those issues has been touched upon before us. Following five issues on merits were then framed by the Court below:-

1. "Whether the plaintiff is not the registered proprietor of valid trade-marks B. 42 and B. 51?
2. Whether the defendants infringed the trade-mark?
3. Whether the defendants are the proprietors of registered design Jagjit Hathi No. 79430 and with what effect?
4. Whether "Hathi" is common to the trade in relation to the goods and with what effect?

5. If issue No. 1 is not proved and issue No. 2 is proved, whether the defendants are not liable to render accounts of the profits made by them?"

7. While dismissing the suit of the plaintiff, the trial Court held in its judgment, dated August 4, 1958, that the plaintiff is the registered proprietor of valid trade-marks B. 42 and B. 51, copies of registration certificates of which are exhibits P. 12 and P. 11 respectively. On issue No. 3 it was held that the respondents are the proprietors of the registered design Jagjit Hathi No. 79430, vide certificate of registration of design Exhibit D. 4. The said design has been registered in class 5. No specific finding as to the effect of the registration of the design was recorded by the trial Judge. This was recorded by the trial Judge. This was presumably considered to be unnecessary in view of the finding on issue No. 2. On issue No. 4, the trial Court found that the representation containing the device of an elephant is common to the trade, but has so far not been used by any other threads dealer, except the parties to this case. It became unnecessary to decide issue No. 5 in view of the finding of the learned Additional District Judge on issue No. 2. On the last mentioned issue it was held that the respondents had not infringed the plaintiff's trade-marks in question as there was no marked resemblance between the two sets of marks and the only thing identical in both the sets was the picture of the elephant which also differed materially. The learned Additional District Judge further found that what the plaintiff got registered as its trade mark was the pictorial design having the picture of the elephant as shown in the representations affixed on Exhibits P. 11 and P. 12 but that the plaintiff did not get registered the elephant itself as its trade-mark. The trial Judge came to a finding that even the picture had not been imitated in this case at all. After having correctly held that in an action for infringement of trade-mark, it was not necessary to prove that someone was actually deceived by the imitation of the trade-mark, the learned Additional District Judge held that the points of dissimilarity in both the trade-marks in this case are so many and so patent and even the two wrappers used by the parties to this litigation are so distinctly different that there could be no possibility of any deceitful use of the respondents' mark or of causing any confusion to even unwary or illiterate customers. It is against the decree of the trial Court dismissing the suit of the plaintiff on the above mentioned findings that the present appeal has been brought to this Court.

8. By now issue No. 2 alone is of consequence and arguments in the appeal have, therefore, been confined to the same. The consolidated law now in force relating to trade-mark is contained in the Trade and Merchandise Marks Act (13 of 1958), hereinafter called the 1958 Act. Section 11 of the 1958 Act provides, inter alia, that a mark the use of which would be likely to deceive or cause confusion, shall not be registered as a trade-mark, Section 12 of the said Act, inter alia, prohibits the registration of a trade-mark in respect of any goods or description of goods which is identical with or deceptively similar to a trade-mark which is already registered in the name of a different proprietor in respect of the same goods or description of goods. Section 27 disentitles the institution of any

proceedings to prevent the infringement of an unregistered trade-mark though it saves the rights of action against any person for passing off goods as the goods of another person, or the remedies in respect thereof. Section 28 enumerates the rights conferred by registration of a trade-mark.

The 1958 Act has replaced the Trade-Marks Act, 1940, which has been repealed u/s 136 of the 1958 Act. Sub-section (4) of Section 136 provides that notwithstanding anything contained in the 1958 Act any legal proceeding pending in any Court at the commencement of the 1958 Act has to be continued in that Court as if the 1958 Act had not been passed. In view of the provisions of sub-section (4) of Section 136 of the 1958 Act. Section 11 12 27 and 28 of the 1958 Act correspond to Sections 8, 10, 20 and 21 of the 1940 Act respectively. As the controversy in the present appeal is related directly to Section 21 of the old Act, the relevant extract from that provision may be quoted at this stage:-

"(1) Subject to the provisions of Section 22, 25 and 26, the registration of a person in the register as proprietor of a trade-mark in respect of any goods shall give to that person the exclusive right to the use of the trade-mark in relation to those goods and, without prejudice to the generality of the foregoing provision, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade-mark or a registered user thereof using by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered.

9. In an action based on an alleged infringement of a trade-mark, the central question to be answered is whether the right conferred on the proprietor of the mark by the registration thereof u/s 21 has been infringed or not. It is clear from a reading of the above quoted extract from Section 21 of the Act that such a right cannot be infringed unless it is proved that the alleged offending mark is either (I) identical with the registered trade-mark, or (ii) it so nearly resembles the registered trade-mark as to be likely to deceive or cause confusion in the course of trade in the mark is registered. It was frankly conceded by the learned counsel for the plaintiff that the marks used by the respondents are certainly not identical with either of the two registered trade-marks of the plaintiff. The solitary question of fact on which, therefore, the success or failure of the plaintiff has now to depend is whether the alleged offending marks used by the respondents in respect of their cotton thread Nalkis, and/or wrappers do or do not so nearly resemble the registered trade-marks of the plaintiff as to receive or cause confusion in the course of the trade in relation to threads. This in turn would depend upon the answer to the question whether the respondents have copied any of the essential features of the registered trade-marks of the plaintiff. It is settled law that the identification of an essential feature depends substantially on the Court's own judgment and partly on the burden of the evidence that is available on the record of the case before it.

10. The evidence in this case is brief. Besides tendering in evidence the trade-

mark certificates Exhibits P. 11 and P. 12 in respect of their registered trade-marks B. 51 and B. 42 respectively, the plaintiff produced only one witness, namely Brij Gopal Kapur P. W. 1, an employee of the Central Agency Limited, which is the selling organisation of the plaintiff and which witness was the representative of the plaintiff in the districts of Amritsar, Ludhiana, Kangra etc. He stated that the plaintiff sells sewing thread, embroidery thread, heavy thread, kite flying thread, hosiery threads, and threads of every other kind used for every purpose. He added that the thread of the plaintiff is sold under the trade-mark of elephant and is popularly known as "Hathi Marka" throughout India. He complained that the defendants have imitated the plaintiff's trade-mark and thereby infringed it. The infringement was said to consist of the defendants' writing on their wrappers and boxes containing their sewing thread in balls and Nalkis, the words "Asli Jagjit Hathi Marka Nalki". According to this witness, the defendants supplied their said thread under such wrappers to the persons who came and asked for "Hathi Marka" thread. He claimed to have come to know of the alleged infringement in the middle of 1955 whereupon he informed his Principals who served notice Exhibit P. 6 on the defendants, to which notice defendants' reply Exhibit P. 8 was received.

In cross-examination the witness said that he did not remember if he had ever sold nay goods of the plaintiff bearing the elephant mark either in Amritsar or in any of the other districts in his beat. He also admitted that he had not received any order in writing from any trader within his beat for elephant mark goods of the plaintiff. He admitted that no person in Amritsar purchased "Elephant Mark goods of the plaintiff" either directly from the plaintiff or from the witness. He stated that so far as he was aware, the defendants used to sell only sewing thread and that also only in the shape of balls and Nalkis. Brij Gopal Kapur P. W. added that he had not seen the representation of the elephant on the tickets in the balls or Nalkis of defendants' thread, but that the representation of the elephant is put only on the boxes or wrappers containing the balls and Nalkis. He also admitted that he had noticed on some of the wrappers and the boxes. The words "Jagjit Hathi Registered D. No. 79430." He could not say if "Jagjit Hathi" was a registered design or not, and if the defendants had been using it for the previous seven or eight years. The witness stated that he was unable to produce any box or any wrapper of the defendants simply bearing the word "Hathi". He further admitted that he did not have any written complaint of anybody to the effect that the defendants ever supplied their goods bearing "Jagjit Hathi" mark when any customer asked for Hathi Marka goods from him. According to P. W. 1 the only design of the wrapper in which the goods of the plaintiff are put to sale is Exhibit P. 9. He also admitted that the plaintiff sells his sewing thread only in wrappers and not in boxes. In re-examination the witness added that the reels and balls of the plaintiff bear tickets like P. 9/1 and P. 9/2, and the wrappers on them bear the design P. 9/3. The representation P. 10 was also said to be in use on the wrappers, reels and balls etc. of the plaintiff.

The witness was recalled on July 19, 1958, and stated on that occasion that his

organisation receives thread of J, and P. Coats Limited in reels, that Exhibit P. 13 is the label which his business concern fixes on the reels, and that the goods of the witness are known by the name of "Hathi Marka". He added that elephant mark is not common to the trade-mark in the Punjab during the previous two or three years, that the plaintiff had received no orders for any such goods, that the plaintiff had not examined any witness through whom the plaintiff-firm might have been selling such goods in the Punjab prior to the previous three years, and that the could not say as to how much "Hathi Marka" thread of the plaintiff had ever been sold in Punjab without searching through the records.

11. Out of the fifteen witnesses examined by the defendants. D. W. 1 Hari Singh and D. W. 2 Hans Raj stated that they have been printing wrappers and cardboard boxes like Exhibit D. 1, Exhibit D. 2 and Exhibit D. 3 bearing the Jagjit Hathi Mark for the defendants, D. Ws 3 to 5 and 7 to 12 are shopkeepers and D. W. 6 is a tailor. They hail from different towns like Amritsar, Jullundur, Hoshiarpur, Batala, Pathankot, Dharamsala etc. The remaining two witnesses, i.e. Param Raj shopkeeper of Mandi in Himachal Pradesh and Shri Kulur Uliya Narsinga Rau, Assistant Registrar of Trade Marks Registry at Bombay, were examined on commission. D. Ws 3 to 5, the shopkeepers of Amritsar, deposed that there is a signboard on the shop of the defendants bearing the words "Jagjit Hathi Walon Ki Dookan". That the thread of the defendants is sold in Nalkis under wrappers bearing labels like Exhibit D. 1, that the goods of the defendants are only known as "Jagjit Hathi Marka" and that no one has ever asked for Hathi Marka thread from them. Out of these witnesses Bhawani Shankar D. W. 4 supported his evidence from his account books wherein the description of the goods purchased by the witness from the defendants was given as "jagjit Hathi", and he filed correct transliteration of the relevant entries which was marked Exhibit D. W. 4/1.

Santokh Singh D. W. 6 is carrying on tailoring business at Amritsar under the style "Nirman Tailors" and deposed that the defendants sell their sewing thread under the name "Jagjit Hathi" which the witness had been purchasing from the defendants for the last four or five years. The goods purchased by him were in the form of Nalkis having a wrapper on them bearing the design Exhibit D. 3. Des Raj and Prem Chand D. Ws. 8 and 9 respectively from Pathankot, Piara Lal D. W. 10 of Hoshiarpur, Hans Raj D. W. 11 of Batala, Darshan Singh D. W. 12 of Jullundur, and Param Raj resident of Mandi in Himachal Pradesh, are shopkeepers of their respective towns. They generally stated that they knew the defendants, that they had been purchasing sewing thread from the defendants for some years, that the thread of the defendants is known as "Jagjit Hathi Marka", that the packages and wrappers of the defendants bear design Exhibit D. 3, that the tickets in the thread balls and Nalkis have no picture on them, but merely carry the words "Jagjit Hathi Marka", and that they had neither ever purchased nor ever heard of any Hathi Marka thread.

Gurcharan Singh defendant put himself in the witness-box on July 19, 1958, and stated that he had been doing thread business for the last seven or eight years,

that he sells his thread under the name "Jagjit Hathi", that he has got design Exhibit D. 4 registered, that his thread is sold in wrappers and in boxes having covers Exhibits D. 1 and D. 2, that his goods are mainly sold in the Punjab, where Hathi Marka goods are not sold at all, and that he has not copied the trade-marks of the plaintiff. The witness added that he used designs Exhibits D. 1 and D. 2 on his wrappers, that Hathi Marka is common to the trade and various firms are using it, and that even at the shop of the defendants the signboard bears the caption "Jagjit Hathi Walon Ki Dookan".

The Assistant Registrar of the Trade-Marks Registry of Bombay, when examined on commission, proved the search report marked Exhibit No. 1, and stated that the said report gave a correct statement of the record of his Registry as it stood on January 25, 1957. He admitted that it had been stated in the search report that the device of an elephant appeared to be common to the trade but he could not say without further search whether the device of an elephant was common to the trade in respect of sewing thread in class 23. He further made it clear that the practice of the Trade-Marks Registry was to hold yarns and threads as goods of different description. The witness stated that he had brought with him before the Commissioner, the application of the Bombay Dyeing and Manufacturers Company Limited, the trade-mark of which contained the device of an elephant. He stated that same was true of the trade-mark contained in the application of Kohinoor Mills Limited and of the Bombay Import and Export Agency, as well as of Messrs. Rallis Brothers Limited. He further admitted that the application of Messrs. Vishram Bhagwandas and Company (relating to threads) also contained the device of an elephant. In addition to the above, the witness referred to the application of Khatau Makanji, Spinning and Weaving Company Limited, of Messrs. Petlad Turkey Red Dye Works Company Limited, and of Messrs. Aryadaya Ginning and Manufacturing Company, Ahmedabad, the trade-marks of all of which business concerns contained the device of elephant. The witness admitted the said fact, but added that though the application of Messrs. Vishram Bhagwandas and Company was in respect of thread, all the other applications referred to above which contained the device of an elephant were in respect of yarns. He admitted that marks in respect of all those applications had been duly registered.

The witness also admitted that he had with him the application of one Gurcharan Singh of Messrs. Gurcharan Singh Brothers trading as "Soot Gole Wale" of Bazar Kathian, Amritsar, dated April 30, 1957, but could not say if it was of the defendants. The said application (of the defendants) was stated by the witness to have been originally filed in respect of yarns and threads of all kinds but subsequently on August 26, 1957, permission had been sought to amend the description of the goods to sewing threads in balls and tubes, and the request was granted. He added that the mark sought to be registered by the defendants had not, however, been registered till then. In the practice of the Trade-Marks Registry is to hold a mark in class 23, where sewing threads and yarn fall, as common to the trade at the application stage if more than five different

proprietors claim use of the identical or closely similar marks which have been in use since before February 25, 1937, in respect of the same goods or goods of the same description. He further stated that if a mark is common to the trade in respect of yarns, it does not follow that the same mark is common to the trade of sewing threads. In answer to a further question in cross-examination he added:-

"If Shri Gurcharan Singh instead of filing an application for search in respect of a device of an elephant for yarns and thread had filed a regular application for sewing thread only in respect of a device of an elephant, I would have not given a report that a device of an elephant is common to the trade of sewing thread, because at that time these were not the minimum of five old marks. In order to report on an application for registration filed today I must have a fresh search report before I can say whether an elephant device is common to the sewing thread trade."

This is the entire evidence on the record of this case.

12. Before proceeding further with the consideration of the disputed issue, it appears to be appropriate to record our own impressions of the visual observation of the registered trade-mark of the plaintiff on the one hand and of the alleged offending marks of the defendants on the other. Two things need clarification at this stage. Firstly, we may not be understood to suggest by making observations about our visual impressions that absence of identity in some features or mere presence of some points of dissimilarity between the two sets of marks is enough to justify a finding to the effect that there is no infringement of a registered trade-mark. Secondly it has to be borne in mind that though the plaintiff has placed on the record of this case several marks and pictorial representations used by the plaintiff in respect of its threads in various ways, the only trade-marks in respect of which infringement can be or has in fact been complained of in this litigation is trade-mark No. B. 42, as depicted on certificate of registration Exhibit P. 12 and trade-mark No. B. 51 as per representation on certificate Exhibit P. 11.

13. We have already made a brief reference to the description of the two registered trade-marks of the plaintiff. The alleged offending marks of the defendants are used either on the tickets in the thread balls or on the covers of their cardboard boxes, or on their wrappers. On the small tickets fixed at the outer end of the central hole in the thread balls of the defendants there the no picture of anything. On the white circular paper ticket is written in black ink in Urdu script - "Jagjit Hathi". Exhibit D. 2 and Exhibit D. 3 are specimens of the covers of the cardboard boxes used by the defendants. The surface of the cover is mostly yellow in colour except for a few small placed where it is either left white or painted in some different shade to provide insets. On the two smaller sides of the cover, there is no picture and all that is written in English is - "Jagjit Hathi" at one place, and "Approx. 200 Yds." at another. In a circular inset is written in Urdu script "Jagjit Hathi". On one of the longer sides of the box is printed in prominent English letters "Gurcharan Singh & Bros. Bazar Kathian

ASR." On the other long side of the box is inscribed a guarantee in Urdu language and in Urdu script which when translated into English would read:-

"Guarantee. The (thread) ball manufactured by us definitely runs on a (sewing) machine. In case of its not running, it will be taken back without any objection and we will be obliged for such a complaint being made (to us)."

On the top of the cover, which is about eight inches long and 2 1/2 inches broad, there is first a thick blue marginal line to mark out a rectangle. Keeping the cover in a vertical position there is inside the main rectangle a smaller one about 2 1/4" x 1 3/4 in which the following is printed in bold Roman letters and numerals :-

"Approx. 200 Yards Superfine Sewing Thread No. 40."

Then there is a central rectangle about 2 1/4 x 3" in which decorative Jack arch side is made. Under each of the two ends of the arch there is a decorated pillar in darker yellow with blue top plates on which plates the arch ends are shown to rest. The bottom line of this central rectangle touches the pads under the pillars. Below the bottom line is written in the following order in different lines in blue ink on yellow surface: "Jagjit Hathi", "Regd. D. No. 79430", and then in still bolder type in white on blue surface "Gurcharan Singh & Bros., Bazar Kathian, Amritsar". In the central rectangle between the pillars and under the arch there is the picture of an elephant in blue ink. A decorated yellow Jhool is put on the back of the elephant. On the Jhool is shown a wooden frame in yellow. Inside the frame is placed a Nalki of thread drawn of yellow and black lines with a small white wrapper in the centre on which is written in Urdu script in one line "Jagjit Hathi".

14. Exhibit D. 1 is a copy of the label said to be used on wrappers in which Nalkis are wrapped for packing. In the centre there is a rectangle about 5" x 4 1/2 enclosed by a thick blue line. Then there is an arch in orange, the star insets in ref over green, the pillars in white, the elephant in dark blue, the decorated Jhool in red with blue border, the wooden frame in pink with planks in yellow and Nalki in blue with black lines with wrapper in light blue having the inscription "Jagjit Hathi" in Urdu. Within the rectangle, at the top of the arch is written in English in black ink "Jagji Hathi". "Jagji Hathi" is also written on the left side in Hindi and on the right side in Urdu. At the bottom is written in red ink over yellow surface "500 Yds". Below the rectangle on white surface is printed in blue ink in bold English type "Jagjit Hathi". On the other side of the rectangle the name and address of defendants" firm and number of registration of design is mentioned. The space on the right side of the rectangle is left blank. On the left side is written in English "Beware of Imitation" and below it in Punjabi in Gurmukhi script - that purchasers should beware of deceits and should at the time of purchasing Jagjit Hathi Marka Nalki make sure of the address of the defendants and their registered number (number of their registered design).

15. From the evidence on record and from a perusal of the various marks, following facts appear to stand proved beyond any doubt:-

- (i) Plaintiff is the proprietor of both the registered trade-marks of which representations are affixed on certificates Exhibits P. 11 and P. 12;
- (ii) that the trade-mark B-51 is used by the plaintiff on its tickets fixed on the reels of sewing threads and the trade-mark B-42 is used on the wrappers of its threads;
- (iii) that the defendants manufacture and sell sewing threads in the shape of Nalkis and balls only and not on wooden reels and use the trade-mark "Jagjit Hathi" as shown in the representation Exhibit D. 2 on the covers of their boxes and Exhibit D. 1 on the wrappers. In each of these marks there is a pictorial representation of an elephant and prominent display of the words "Jagjit Hathi" and of the name and address of the defendant's concern;
- (iv) that there has been no market for the sewing threads of the plaintiff in the Punjab for several years prior to the institution of the suit from which this appeal has arisen;
- (v) that no one has ever asked for or purchased the threads of the plaintiff by identifying them with the name of "Hathi";
- (vi) that though the picture of an elephant is common to the trade of yarns, but it is not proved to be common to the trade of sewing threads;
- (vii) that whereas the most prominent feature in the registered trade-mark of the plaintiff is the picture of a simple elephant standing on a roll of thread showing strength of the thread, the prominent feature in the alleged infringing mark is of the words "Jagjit Hathi" and the honoured position of riding a royal elephant enjoyed by the Nalkis of defendants' threads;
- (viii) that the alleged infringing marks of the defendants are neither identical with nor closely resemble the registered trade-marks of the plaintiff;
- (ix) that the following points of dissimilarity between the two sets of marks are basic and fundamental and not merely artistic variations :-
- (a) Whereas the main feature in the registered trade-marks of the plaintiff consists of the simple picture of an ordinary elephant, the most prominent feature in the alleged offending marks used by the defendants is of the repeated use of the expression "Jagjit Hathi".
- (b) the basic idea in the trade-marks of the plaintiff is to show the strength of the thread manufactured and sold by them by showing that the thread roll under the feet of an elephant does not even bend and can stand the weight of such a heavy animal; and it is not the mere picture of an elephant. On the other hand, the basic idea behind the alleged offending marks appears to be the honour which the thread produced by the defendants is receiving by placing the Nalki of the defendants' thread marked "Jagjit Hathi" to show that it is the thread of the defendants on a huge decorated royal elephant;

(c) whereas the picture in the registered trade-marks of the plaintiff is of a simple elephant without any Jhool or howdah, the elephant in the marks used by the defendants is given the royal dress and decorations;

(d) the colour scheme in the two sets of marks is entirely different and wholly irreconcilable with each other. In the marks of the plaintiff, the picture of the elephant is in simple black and white. In the marks used by the defendants, as already detailed earlier, the picture is profusely decorated and made in gaudy colours;

(e) in the circular tickets used by the plaintiff, the picture of elephant is used whereas in the circular tickets used by the defendants no picture at all is used, and only the words "Jagji Hathi" are mentioned.

16. Though stage appears to be now set for considering the relevant legal aspect and the contentions of the learned counsel for the parties on issue No. 2, it appears to be necessary at this juncture to dispose of Civil Miscellaneous 2232 C of 1959, filed in this case by the appellant under Order 41, Rule 27 of the CPC for permitting it to lead additional evidence. The additional evidence sought to be produced consists of the order of the Assistant Registrar of Trade-Marks, dated September 28, 1959, passed on the application of the defendants for registration of some trade-marks of theirs. Though it is stated in the application that the order of the Trade-Marks Registry sought to be produced decides the rights of the parties with respect to the trade-marks adopted by the defendant-respondents, it has been frankly conceded before us at the hearing of the appeal and the application that the said order does not in any manner affect the decision of this appeal on merits. The position at present is that the alleged offending marks are admittedly not the registered trade-marks of the defendants. Even if it could be assumed that the application of the defendants was for registration of those marks and such an application might have been refused, the material situation would not be changed by such an order. In any event, it is the requirement of the Court which alone can normally justify permission being granted for leading additional evidence at the appellate stage. No defect on the record of the present appeal has become apparent to us in this behalf on the examination of the evidence led by the parties. According to the authoritative pronouncement of their Lordships of the Supreme Court in *K. Venkataramiah Vs. A. Seetharama Reddy and Others*, , the requirement which can justify the letting in of additional evidence under Order 41, Rule 27 must be the requirement of the Court upon its appreciation of the evidence as it stands. We have been carefully taken through the entire evidence on the record of this case to which reference has already been made. We do not require the additional evidence sought to be led by the plaintiff for disposing of this appeal. We accordingly dismiss Civil Miscellaneous 2232-C of 1959.

17. The sole question of fact which has now to be decided by us is whether it is possible to hold on the evidence on record of this case that the alleged infringing mark of the defendants so nearly resembles the registered trade-marks of the

plaintiff as to deceive or cause confusion in the course of trade in relation to sewing threads either in Amritsar or in any other place in India. Though this question has no doubt to be decided on the evidence adduced in the case, it has to be adjudicated upon in the light of certain settled legal principles which emerge from the various decided cases and from the authoritative pronouncements of the Supreme Court.

18. I may now refer to some of the cases which have been cited before us by the learned counsel for the parties. "In the Matter of an application for registration of a Trade Mark by Sandow Ltd." (1914) 31 R. P. C. 196, the order of the Comptroller General rejecting the opposition against the registration of a trade-mark on the ground that the applicant's mark resembled the "S" mark of the opponents was, on appeal by the opponents, reversed by the Chancery Division of the High Court of Justice in England, and registration of the trade-mark of the applicant refused on the ground that, on the evidence adduced in the case, there was a reasonable probability that a section of the public might be deceived, though it had not been shown that the opponents' goods had become known to any section of the public or to any considerable number of the public as "S" goods. It was held that the Court has to have regard to the trade-marks in question and to the body of evidence. It was further held that the question to be decided in an application for registration of a trade-mark is whether the person who sees the proposed trade-mark in the absence only of the other trade-mark and in view only of his general recollection of what the nature of the other trade-mark was, would be liable to be deceived and to think that the trade-mark before him is the same as the other of which he has a general recollection.

19 In *De Cordova v. Vick Chemical Co.* (1951) 68 R. P. C. 103, the Privy Council dismissed the appeal against the order of the Court of Appeal in Jamaica holding the appellants guilty of infringing the respondents' trade-mark, and for passing off in Jamaica their ointment as "Karsote Vapour Rub" as the ointment sold by the respondents under their registered trade-mark "Vapo Rub" and held that the words "Vapour rub" so closely resembled the word "Vapo Rub" which was an essential feature of the first mark as to be likely to deceive, and, therefore, there had been an infringement of the trade-mark "Vapo Rub". Their Lordships of the Privy Council observed:-

"A mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features. The identification of an essential feature depends partly on the Court's own judgment and partly on the burden of the evidence that is placed before it. A trade-mark is undoubtedly a visual device; but it is well-established law that the ascertainment of an essential feature is not to be by ocular test alone. Since words can form part or indeed the whole, of a mark, it is impossible to exclude consideration of the sound or significance of those words. Thus it has long been accepted that, if a word forming part of a mark has come in trade to be used to identify the goods of the owner of the mark, it is an infringement of the mark

itself to use that word as the mark or part of the mark of another trader, for confusion is likely to result".

20. The Court of appeal in England held in *Baume and Co. Ltd., v. A. H. Moore, Ltd.* 1958 All ER 113, that by using the name "Baume and Cermier, Geneve" on the watches imported by the defendants from Switzerland, and sold in England, the defendants were likely to pass off their watches as those of the plaintiffs which were being sold under the trade-mark "Baume" because there was real probability that the watches marked "Baume and Cermier, Geneve" would be regarded as being the same as, or in some way, associated with the watches of the plaintiffs. At the same time, it was held that no infringement of a trade-mark was involved in the case as a particular provision in the English Trade Marks Act, 1938, protected the honest use by a person of his own name whether he traded under it or used it as a mark for his goods. It was in this context that it was observed that the addition of the words "& Mercier, Geneve" to the registered trade-mark "Baume" did not exonerate the defendants from being restrained in the passing off action.

21. In *Corn Products Refining Co. Vs. Shangrila Food Products Ltd.*, their Lordships of the Supreme Court allowed the appeal of Corn Products Refining Co. against the appellate order of a Division Bench of the Bombay High Court reversing the order of a learned Single Judge of that Court and restoring that of the Trade Marks Registry (allowing registration of trade-mark "Gluvita" used by Shangrila Company on biscuits manufactured by them in spite of the opposition of the Corn Products Refining Co.) on the ground that the mark intended to be registered closely resembled the trade-mark "Glucovita" used by Corn Products Refining Co., in respect of their glucose with vitamins as the mark "Glucovita" had acquired a reputation among the buying public and the commodities concerned were so connected as to make a confusion or deception likely in view of the similarity of the two trade-marks. It was held that the question whether the two marks are likely to cause confusion or not is a question of first impression which it is for the Court to decide, and that in deciding the question of similarity between the two marks, the marks have to be considered as a whole. Their Lordships further held that in deciding the question of similarity between the two marks, the Court has to approach it from the point of view of a man of average intelligence and of imperfect recollection, and that to such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause a confusion between them.

22. Next comes the case of *Amritdhara Pharmacy Vs. Satyadeo Gupta*, . In that case the Allahabad High Court had held that the words "Amrit" and "Dhara" were common words in the Hindi Language and the combined word "Amritdhara" meant "current of nectar" or the flow of nectar, that the two words "Lakshman" and "Dhara" were also common words which when combined together mean current or flow of Lakshman, and that, therefore, the words of common language like "Amrit" and "Dhara" could not be made the monopoly of an individual. On

the above findings, the Allahabad High Court reversed the order of the Registrar of Trade-Mark refusing the registration of "Lakshmandhara" for the whole of India. While reversing the judgment of the Allahabad High Court, the Supreme Court held that what was to be considered in that case was the overall similarity of the composite words having bearing the two names are medicinal preparations of the same description. Their Lordships observed:-

"We are aware that the admission of a mark is not to be refused, because unusually stupid people, "fools or idiots", may be deceived. A critical comparison of the two names may disclose some points of difference but an unwary imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name. The trade-mark is the whole thing - the whole word has to be considered".

After referring to various other cases, cited before the Supreme Court, their Lordships held that each case must be decided on its own facts as the degree of resemblance which might be necessary to deceive or cause confusion must in the nature of things be incapable of definition a priori. On a consideration of all the circumstances of the case, the Supreme Court came to the conclusion that the overall similarity between the two names in respect of the same description of goods was likely to cause deception or confusion within the meaning of Section 10(1) of the Trade Marks Act, 1940, and that the Registrar was, therefore, correct in refusing to register the mark "Lakshmandhara", and the High Court was in error in taking a contrary view.

23. The last judgment of the Supreme Court to which reference has been made in this connection is in, *Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, . Ayyangar, J.*, who prepared the judgment of the Court, succinctly brought out the distinction between an action for passing off on the one hand and an action for infringement of a trade-mark on the other. The learned Judge observed that while an action for passing off is a Common Law remedy being in substance an action for infringement. An action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade-mark for the vindication of the exclusive right to the use of the trade-mark in relation to the goods in respect of which it is registered. The Supreme Court held that the use by the defendants of the trade-mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. Dealing further with the distinction between the two classes of cases, their Lordships observed as follows:-

"In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the Court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights

are violated. Expressed in another way, if the essential features of the trademark of the plaintiff have been adopted by the defendant, the fact that the getup packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff".