

(1972) 10 MAD CK 0041
In the Madras High Court

K.R. Chinnikrishna Chetty trading as Ragha and Company	APPELLANT
Vs	
K. Venkatesa Mudaliar and K. Krishnamurthy Mudaliar trading as Ambal and Company and Another	RESPONDENT

Date of Decision : 06-10-1972

Acts Referred:

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

Citation : (1973) 2 MLJ 98

Hon'ble Judges : V.V. Raghavan, J

Bench : Division Bench

Judgement

V.V. Raghavan, J.—The above appeal arises out of application No. 213575 in Clause 34 made by the appellant for registration of "Radha's Sri Andal" snuff manufactured by them. The said trade mark was advertised in the Trade Marks Journal dated 1st September, 1963 and the first respondent, who is trading under the name and style of " Sri Ambal Snuff" opposed the registration. The grounds of opposition are:

- (1) For the last over half a century, they have been regularly and in the course of trade using in connection with snuff of their manufacture trade marks containing the expression " Sri Ambal Snuff" with or without certain devices.
- (2) That their marks had been registered under Nos. 89995, 125808 and 146291;
- (3) That by long and extensive user the abovesaid marks have come to and denote to the trade and the public that snuff bearing those marks is their merchandise;
- (4) That they are interested in preventing the use or registration of any trade mark which was calculated to pass off as and for their well known " Sri Ambal Snuff" or which is otherwise likely to cause confusion and deception among the public ;
- (5) That the applicant's mark contains the expression " Sri Andal" of which the

material and essential feature is " Sri Andal" which is deceptively similar to the expression " Sri Ambal and that, therefore, the registration of the mark would offend against the provisions of Section 12 (i) of the Trade and Merchandise Marks Act, 1958 ;

(6) That by reason of the reputation acquired by their marks the use of the applicant's mark is likely to cause confusion and deception and that, therefore, registration of the mark would offend against the provisions of Section 11 of the Act;

(7) That as the expression " Radha's Sri Andal" is merely a combination of two personal names or surnames, the registration of the mark would offend against the provisions of Section 9 of the Act ;

(8) That an application containing a mark substantially similar to the mark seeking registration had been dismissed by the Madras High Court ;

(9) That having regard to the unmeritorious conduct of the applicant in adopting and seeking registration of a mark which infringes their mark, the applicant's mark is disentitled to protection in a Court, and that, therefore, registration is prohibited by Section 11 of the Act ; and

(10) That the applicant not having come to Court with clean hands, he is not entitled to the discretionary order vested in the Tribunal.

2. The applicant filed a reply and contended that the mark propounded for registration in the above application is entitled to be registered and that the opposition is unsustainable in law.

3. The application for registration was heard by the Assistant Registrar of the Trade Marks, Madras. The Registrar before dealing with the claim referred to certain previous proceedings between the parties relating to the applicant's previous application No. 183961 for registration of a label mark in class 34 in respect of a designation of goods which was worded "snuff" manufactured in Madras. The essential feature of that label was a picture of goddess Andal and the legend " Sri Andal." The present respondents opposed the registration of that mark on the ground that the legend appearing on the mark was deceptively similar to the legend "Sri Ambal" appearing on their registered marks (opposition No. Mas. 40). The Assistant Registrar on the first occasion dismissed the application holding that there was no deceptive similarity between the opponent's and the applicant's marks.

4. The opponents filed C.M.A. No 266 of 1961 to the High Court, Madras, and this appeal was allowed by Jagadeesan, J. and the registration ordered by the Assistant Registrar was set aside. The Judgment of Jagadeesan, J. was confirmed in Letters Patent Appeal No. 57 of 1962. The Judgment is reported in K.R. Chinnikrishnan Chettiar v. Sri Ambal and Company, and another (1964) 2 M.L.J. 206. In the course of the hearing of the Letters Patent Appeal the applicant filed C.M.P. No. 8934 of 1962 and sought leave of the Court to amend the legend

appearing in his mark by substituting (1) "Radha's Sri Andal " for " Sri Andal". That application was dismissed. But the learned Judges made the following observations in the judgment:

The appellant has filed C.M.P. No. 8934 of 1962 before us expressing his intention to amend his trade mark by substituting Radha's Sri Andal for Sri Andal. The appellant prays to permit the amendment of the applicant and that we may direct the Registrar to notify the amendment and to proceed with the application for registration 133961 according to law. We think it is sufficient to observe that, phonetically speaking " Radha's Sri Andal" appear to us to be a different appellation altogether with widely varying structural and phonetic components. It will be open to the appellant to apply to the Registrar for appropriate relief.

The Judgment of the High Court was confirmed by the Supreme Court in K.R. Chinna Krishna Chettiar Vs. Shri Ambal and Co., Madras and Another, .

5. The Assistant Registrar had to consider the present application before the Supreme Court disposed of the appeal referred to above. The Assistant Registrar held that Section 9 of the Act is not a bar to the registration of the applicant's mark, that the applicant is a proprietor of the mark, that Section 11 (a) of the Act is not a bar to the registration of the applicant's mark. On the question whether the legend " Radha's Sri Andal" is visually similar to the legend " Sri Ambal", the Assistant Registrar held that the legends will not look "alike. As regards phonetic similarity also, the Assistant Registrar held that " Radha's Sri Andal" is not as close to the sound of "Sri Ambal" as to confuse or deceive a normal purchaser of snuff and that there is not reasonable probability of confusion or deception of the competing marks. The Assistant Registrar ultimately came to the conclusion that the applicant had discharged the onus which lay on him of establishing that the registration of his mark is not barred by Section 12 (1) of the Act. The Assistant Registrar further observed that the sale under of the applicant's mark commenced on 21st January, 1962, that snuff to the value of over 6 lakhs of rupees was sold under the mark Radha's Sri Andal, that during the period and during the interval between the adoption of the mark and the date of filing evidence in support of application (nearly 2 years) the goods of both the parties have been sold side by side under their respective marks and that during this period there has not been a single instance of confusion and that consequently there is no deceptive similarity between the marks of the applicant and the respondents. In the result, the opposition bearing No. MAS 237 was dismissed and the application was ordered.

6. Against the said judgment C.M.A. No. 58 of 1966 was preferred to this Court. Ganesan, J., allowed the appeal holding that by reason of the final decision of the Supreme Court it is no longer open to the appellant for registration to contend that his legend " Sri Andal" is not deceptively similar to the Respondents' legend "Sri Ambal" and that the addition of the word " Radha" to the respondents' legend "Sri Andal" would not make any material difference. The learned Judge

further observed that the first respondent's trade mark " Radha's Sri Andal Snuff" is deceptively similar to the appellant's trade mark " Sri Ambal Snuff " and that it is not open to the first respondent while amending the design particularly after the adverse judgment of the High Court against them to retain the offending legend " Andal " as part of the new trade mark. In the result, the appeal was allowed and the order of the Assistant Registrar was set aside. The present appeal is filed against the said judgment.

7. Before dealing with the contentions put forward in the appeal it is necessary to appreciate the observations of the Supreme Court in K.R. Chinna Krishna Chettiar Vs. Shri Ambal and Co., Madras and Another, , in the case between the same parties relating to the registration of the appellant's trade mark " Sri Andal " Madras snuff and its opposition to registration by the respondents, who had previously registered their trade mark as " Sri Ambal" Parimala Snuff. The Supreme Court held that the essential feature of the appellant's trade mark was " Andal " while that of the respondents was " Ambal". Notwithstanding the fact that " Sri Andal " and Sri Ambal are separate divinities, Sri Andal was Vaishnavite woman saint of Srivilliputtur Village and was deified because of her union with Lord Ranganatha, while Sri "Ambal" is the consort of Siva or Maheswara. Their Lordships held that the resemblance between the two marks must be considered with reference to the ear as well as the eye and that there is a close affinity of sound between the words " Ambal" and "Andal". In the result, they confirmed the decision of the Division Bench of this Court, which confirmed the decision of the Single Judge, Jagadeesan, J., setting aside the order of the Assistant Registrar directing registration. As referred to already, the appellant during the pendency of the appeal before the High Court filed his application No. 212575 seeking registration of the appellant's snuff as ""Radha's Sri Andal"" Madras Snuff. The attention of the Supreme Court was drawn to the above fact and the observations of the Division Bench in regard thereto, the Supreme Court refused to express any opinion whether the use of the expression "Radha's Sri Andal" would still amount to an infringement of the respondent's mark. Sri V. K. Thiruvengkatachari, Counsel for the appellant contends : (1) That there is no visual similarity between the appellant's and the respondents' marks; (2) That phonetically the appellant's mark "Radha's Sri Andal" Snuff has no connection with the respondents' "Ambal Snuff"; and (3) That the appellant's goods have been sold side by side with the respondents' goods and that there is no evidence of any confusion in the minds of the customers. In this connection, the learned Counsel referred to the following passage in Halsbury's laws of England, Third Edition, Volume 38, page 592:

The Court attaches importance to evidence that both marks have actually been in use for a long time, or that goods bearing the marks have been sold through the same outlets to the public, without any instance of confusion having arisen.

It is no doubt true that there is no visual similarity attracting the eye between the appellant's mark proposed to be registered and the respondent's existing

mark. Phonetically also there is no similarity. But when the Supreme Court held that the appellant's legend " Sri Andal", is deceptively similar to the respondent's legend " Sri Ambal", the question for consideration will be whether the addition of the word " Radha " to the appellant's legend would make any material difference. According to the appellant it would, on the other hand, the respondents' contention is that it would not make any material difference.

" Sri Chellasami, the learned Counsel appearing for the first respondent has brought to our notice several decisions dealing with the similar questions and it is, therefore, necessary to find out whether the infringement originally found still continues notwithstanding the addition of the word " Radha " to the appellant's legend. The learned Counsel contends that notwithstanding the addition of the word " Radha " the essential feature or the leading characteristic of the appellant's mark is still that of "Sri Andal " and therefore objectionable. The essential feature or the leading characteristic may be ascertained by the eye or by the ear, in this sense that the goods bearing the mark may be likely to become known by a certain name and according to the learned Counsel for the first respondent the essential feature of the appellant's mark is " Sri Andal" and that of the first respondent is " Sri Ambal". In this connection, the learned Counsel referred to the following passage in the Law of Trade and Merchandise Marks by Dr. S. Venkateswaran at page 196:

The adoption of a single leading characteristic or essential feature of the plaintiff's trade mark may constitute an infringement, notwithstanding that each mark contains other matter which distinguishes one from the other. It must, however, be borne in mind that the Courts have always set their face against conferring upon the proprietor of a trade mark a monopoly wider than what is justified.

The learned Counsel referred to the decision of the Privy Council in *De Cordova and Ors. v. Vick Chemical Company* 68 R.P.C. 103. The head-note in the said decision, which brings out the facts as well as the position runs as follows:

V. sued for infringement of two trade marks registered in Jamaica (one containing, and the other consisting of, the word " Vapo Rub " by the importation and sale of jars of ointment marked " Karsote Vapour Rub". The defendants contended that the first mark was not infringed, and that the second was invalidly registered, being merely descriptive of the goods concerned (an ointment of the vapour rub type), and having been registered (although a word, not being an invented word) "and having direct reference to the character of the goods without an order of the Court deeming it to be distinctive. They further contended that the words " Vapour rub " as used by them were a mere bona fide description of the character of their goods.

Held, 1. That the word "Vapo Rub" was an essential feature of the first mark, that the words " Vapour rub " so closely resembled that word as to be likely to deceive, and that the mark was infringed ;

2. That the second mark, although descriptive, was on the evidence distinctive of V's goods.

3. That the second mark was not an invented word, and had direct reference to the character of the goods, and having been registered without an order of the Court was liable to be expunged ; but that the Court below had a discretion not to expunge it, and there being clear evidence that the mark was in fact distinctive when registered, and there being no grounds for saying that this discretion had been exercised upon wrong principles, it should not be interfered with.

4. That the term " vapour rub " being (in Jamaica, although not in England) an indication that the goods were V's goods and not a description of character or quality, the use of that term in Jamaica could not be a bona fide description of the character or quality of goods.

5. That the Defendants had been guilty of passing-off.

6. That the appeal should be dismissed.

Lord Radcliffe in the course of the judgment observed as follows:

In the light of these considerations their Lordships think that "Vapo Rub" must be treated as an essential feature., or, to use an alternative phrase, a material or substantial element, of Trade Mark, 1852, and that the Appellants have infringed the mark by selling their ointment under the designation Karsote Vapour Rub ", for the word " Karsote" prefaced to " Vapour Rub " is quite insufficient in itself to dissolve the confusion that is bound to arise from associating the Appellants' goods with a word so distinctive as " Vapour Rub.

The learned Counsel next referred to the decision of the Supreme Court reported in Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co., . The appellant in the appeal before the Supreme Court was Ruston and Hornby Limited, a limited liability company incorporated under the English Companies Act with its registered office at Lincoln, England and carrying on business in the manufacture and sale of diesel internal combustion engines and their parts and accessories. Ruston Hornsby (India) Limited, a company registered in India under the Companies Act, 1956 was a subsidiary of the appellant, carrying on business in the manufacture and sale of diesel internal combustion engines and their parts. Their registered trade mark Ruston being registration No. 5120 in class 7 in respect of internal combustion engines. The respondent was manufacturing and selling diesel internal combustion engines under the trade mark, " Rustam". In June, 1955 the appellant coming to know of the respondent manufacturing and selling diesel internal combustion engines under the trade mark "Rustam", sent a letter through its attorneys to the respondent and called upon it to desist from using the trade mark " Rustam" on its engines as it was an infringement of the registered trade mark " Ruston". The respondent's reply thereto was that its registered mark was "Rustam India" which they were using and therefore the

appellant's trade mark " Ruston " was not infringed in any manner. The appellant instituted a suit against the respondent for a permanent injunction restraining the respondent from infringing the trade mark " Ruston". The trial Judge dismissed the suit holding that there is no visual or phonetic similarity between "Ruston" and "Rustam". The said judgment was reversed in appeal by the Allahabad High Court and their Lordships held that the use of word "Rustam" by the respondent constituted infringement of the appellant's trade mark ""Ruston". But the learned Judge then proceeded to hold that the use of the words " Rustam India " was not an infringement because the plaintiff's engines were manufactured in England and the defendant's engines were manufactured in India and that the suffix "India" would be a sufficient warning that the engine sold was not a " Ruston " engine manufactured in England and that the respondent was permitted to use the combination " Rustam India."

8. The appellant took up the matter to the Supreme Court by Special Leave. Their Lordships pointed out the distinction between an infringement action and a passing off action and observed as follows:

In the present case the High Court has found that there is a deceptive resemblance between the word "Rustam" and the word " Ruston " and therefore the use of the bare word "Rustam" constituted infringement of the plaintiff's trade mark " Ruston". The respondent has not brought an appeal against the judgment of the High Court on this point and it is, therefore, not open to him to challenge that finding. If the respondent's trade mark is deceptively similar to that of the appellant the fact that the word "India " is added to the respondent's trade mark is of no consequence and the appellant is entitled to succeed in its action for infringement of its trade mark.

We are accordingly of the opinion that this appeal should be allowed and the appellant should be granted a decree restraining the respondent by a permanent injunction from infringing the plaintiff's trade mark " Ruston " and from using it in connection with the engines, machinery and accessories manufactured and sold by it under the trade mark of "Rustam" or "Rustam India".

The next case referred to by the learned Counsel related to the trade mark "Bulova Accutron" reported in *Bulova Watch Company Limited v. Accurist Watches Limited* (1969) R.P.C. 102. The facts therein are that Bulova Watch Company Limited of Toronto, Canada, applied for the registration of the trade mark Bulova Accutron in Clause 14 in respect of " Horological and Chronometrical instruments and apparatus, and parts and fittings for all these goods." The registration of their trade mark was opposed by Accurist Watches Limited on the ground that the mark applied for so closely resembled their trade mark Accurist which was registered under No. 6.177.19 in respect of "wrist watches" and under No. 694786 in script form, in respect of "Pocket Watches, watch bracelets and straps, timepieces and alarm clocks" In earlier proceedings concerning the opposition by the opponents comprising the word Accutron, simpliciter, for the same goods as those of the present application, the Assistant Comptroller and

Buckley, J., on appeal to the High Court were of the view that when the two marks were viewed side by side, there was possibility of deception and confusion and the applicant's mark to registration was refused. Thereafter the applicant applied for the mark consisting of two components viz., Bulova Accutron in the place of Accutron originally applied for. The question which arose was whether the combination of the word Bulova with the word " Accutron would still cause confusion with the respondents trade mark "Accurist". The Assistant Registrar, answered the question in favour of the respondent.

9. On appeal Stamp, J., extracted a passage from the judgment of the Assistant Registrar with which His Lordship fully agreed. The passage runs as follows:

The present issue is not simply a comparison of two words ; but the comparison of one word with a composite mark the second component of which has been held to be confusingly similar to Accurist. Can this component be said to be rendered innocuous now that it appears with and is preceded by Bulova? I do not think that I can hold that it is and that there is any less risk of deception or confusion. I think that a person having, for example, an imperfect recollection of Accurist is just as likely to confuse it with Accutron in the composite mark. As Bulova and Accutron do not hold together as a phrase or present a wholly different meaning from the separate components, I think that their combination will be taken by many persons on first impression as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products. A person meeting Bulova Accutron and confusing the latter word with Accurist is, I think, likely to consider that Bulova is another mark which he had previously not observed or which had not been drawn to his attention before. There is no evidence to support Mr. Loftus's assertion, in his declaration of 13th November, 1964, paragraph 17, that the trade and public will refer to the watches by the name Accutron alone, but I think that there is a tangible danger that a substantial number of persons will confuse the Accutron component of the mark applied for with Accurist, and consequently will conclude that the goods emanate from the same trade source as Accurist watches, believing that the Bulova component, if it makes an impact, is a house mark or another mark of the same concern.

The learned Judge further observed as follows:

If what had to be considered was a side by side comparison, the additional word would have had a vital significance, but where imperfect recollection is relevant what has to be considered is how far the additional word is significant to prevent imperfect recollection and the resultant confusion. Particularly having regard to the fact that Bulova is the house name of the applicants and has a significance other than as a trade mark, its addition before the word Accutron does not in my judgment serve to prevent the deception or confusion which would in the view of the Court of Appeal have been caused but for that adoption. As the Assistant Registrar remarks in his decision : " As Bulova and Accutron do not hold together as a phrase or present a wholly different meaning to the separate, components, I

think that their combination will be taken by many persons on first impression as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products." I would add that the combination of the two words is likely to be taken by other persons on first impression as an indication that the part of the trade mark which consists of Bulova is a house name of the marketers of the watches, that the trade mark is Accutron and that they will confuse them with watches marketed under the trade mark Accurist simpliciter.

The learned Counsel next referred to a series of decisions particularly the following:

Parle Products (P) Ltd. Vs. J.P. and Co., Mysore, . In the matter of Helana Rubinstein Limited's application for the Registration of a Trade Mark (1960) R.P.C. 229; Aristoc Limited v. Rysta Limited 62 R.P.C. 65, and Ciba Ltd. Vs. M. Ramalingam and S. Subramaniam trading in the name of South Indian Manufacturing Co. and Another, . The facts in Parle Products (P.) Limited are that the appellants are manufacturers of biscuits and confectionery and are owners of certain registered trade marks, one of them being " Gluco " used on their half pound biscuit packets. Another registered trade mark of theirs is a wrapper with its colour scheme. The wrapper is used in connection with the sale of their biscuits known as "Parle's Gluco Biscuits". The respondents are the manufacturers and sellers of biscuits with their trade name " Glucose Biscuits". The colour scheme of the wrapper of the respondents was substantially similar to that of the appellants with variation in detail. The trial Court meticulously examined the features found on the two wrappers and held that there were distinguishing features of the wrappers and there was no chance of a seller committing fraud on a customer and an ordinary purchaser would certainly refuse to purchase the defendants' goods if it was offered to them as and for the plaintiffs' goods. The trial Court, therefore, held that the plaintiffs had failed to establish their case.

10. On appeal the High Court came to the same conclusion viz., that the defendants' wrapper was not deceptively similar to the plaintiffs' and dismissed the appeal. The appeal to the Supreme Court was filed by Special Leave and the learned Judges observed at page 622 as follows:

It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall 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. In this case we find that the packets are practically of the same size, the colour scheme of the two wrappers is almost the same ; the design on both though not identical bears such a close resemblance that one can easily be

mistaken for the other. The essential features of both are that there is a girl with one arm raised and , carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Gluko Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Any one in our opinion who has a look at one of the packets today may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs' if shown to him some time after he had seen the plaintiffs' . After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think, it necessary to refer to the decisions referred to at the bar as in our view each case will have to 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.

11. The second of the decisions referred to is in the matter of Helena Rubinstein Limited's Application for the Registration of a Trade Mark 1960 R.P.C. 229, relating to the registration of similar marks--" Skin Dew " and " Skin Deep".

12. The next case is Aristae Limited v. Rysta Limited 62 R.P.C. 65 which related to the registration of the word "Rysta" in class 25 for stockings opposed by the owners of the mark "Aristoc" registered for the same goods.

13. Ciba Ltd. Vs. M. Ramalingam and S. Subramaniam trading in the name of South Indian Manufacturing Co. and Another, , dealt with the registration of the respondents' product Cibol objected to by the appellants whose registered trade mark was "Cib" or "Ciba. "

14. Though at one stage we considered that the addition of the word " Radha " to the legend "Sri Andal" makes all the difference, after our attention was drawn to the three cases referred to above viz., (1) relating to the Vick Vapo Rub, where the objection to the registration of the respondents' Vapo Rub which infringed the appellants' registered mark was sought to be got over by adding a word "Karsote" to the respondent's legend, and (2) where the objection to the registration of the respondents' trade mark " Rustam " was sought to be met by the addition of the word " India" to the objected legend and (3) where the word "Bulova" was sought to be added to the legend "Accutron" which legend was held to infringe the respondents' Trade Mark "Accurist", we are persuaded to come to the opposite conclusion that the addition of the word " Radha " to the legend " Sri Andal" will not make the slightest difference and that the view of the learned Judge is correct The appellants' snuff sold under the trade name " Sri Andal" the registration of which was objected to by the respondents, has been in the market for some years and the objection to its registration has now been finally upheld. The question for consideration now will be whether by the addition of the word "

Radha " to the objected legend makes a vital difference. When the two marks are compared side by side the question will be whether the addition of the word will make any vital difference. As observed by Stamp, J. in *Bulova Watch Company Limited v. Accurist Watches Limited* (1969) R.P.C. 102. where imperfect recollection is relevant what has to be considered is. how far the additional word is significant to prevent imperfect recollection and the resultant confusion." We are of opinion that the combination of the two words " Radha's Sri Andal" is likely to be taken by snuff-users as the snuff manufactured and marketed by the appellant originally as "Sri Andal". The appellants' learned Counsel sought to distinguish the above three cases on the ground that in the aforesaid decisions the new word sought to be added was only the name of the country of manufacture while in the present case, the addition of the word "Radha" to the legend "Sri Andal" is a combination which has nothing in common with the respondents' legend "Sri Ambal". We are unable to accept the ground of distinction made by the learned Counsel. We are of opinion that there is a tangible danger that a substantial number of persons will confuse the appellants' "Radha's Sri Andal" mark applied for with the respondents' legend "Sri Ambal Snuff".

15. In the result, the appeal fails and is dismissed with costs.