

(1958) 07 CAL CK 0007
In the Calcutta High Court
Case No : A.F.O.O. No. 41 of 1955

London Rubber Co. Ltd.

APPELLANT

Vs

Durex Products (Incorporated) and Another

RESPONDENT

Date of Decision : 10-07-1958

Acts Referred:

Trade Marks Act, 1940 — Section 10, 10(1), 10(2), 10(3), 16(1)

Citation : AIR 1959 Cal 56 : (1959) 1 CALLT 241 : 64 CWN 110

Hon'ble Judges : P.B. Mukharji, J;B.S. Bachawat, J

Bench : Division Bench

Final Decision : Dismissed

Judgement

P.B. Mukharji, J.—This is a trade mark appeal u/s 76 of the Trade Marks Act, 1940, from the decision of Sri Nagaraja Sastri, Deputy Registrar, Trade Marks. It relates to the well-known Durex contraceptives.

2. The appellants are the London Rubber Company Limited who opposed the application of "Durex Products (Inc.) for registration of the Trade Mark "Durex" in Class X. Durex Products (Inc.) are one of the respondents in this appeal. The other respondent is the Registrar of Trade Marks.

3. This Court in this appeal did not have the advantage of the appearance of any one of these two respondents. This disadvantage has, however, to a considerable extent been offset by a sensible, comprehensive and well-reasoned judgment of the Deputy Registrar of Trade Marks.

4. The dispute relates to the mark "Durex" applied to contraceptives. The material portion of the decision from which this appeal is preferred is set out below ;

"Having considered all the above aspects, I think, as the marks are admittedly identical, an imposition of the condition that the Applicant's use of the name "Durex Products Inc.", on the packings and containers of the goods, will

safeguard the public further from tangible possibility of confusion between the marks. Hence my order is that the application do proceed to registration subject to the limitations that: (1) the designation of goods shall read "Vaginal diaphragms, instruments for inserting vaginal diaphragms and models for demonstrating insertion of vaginal diaphragms and applicators for vaginal jellies" and (2) the name "Durex Products Inc.", shall appear on the packings and containers of the goods."

5. The appellants London Rubber Company Limited have appealed from that decision. They object to the application of the "Durex Products Inc." for registration of the trade mark in class X, Class X of the 4th Schedule of the Trade Mark Rules, 1942, made under the Trade Marks Act, 1940, reads as follows :

"Surgical, medical, dental and veterinary instruments and apparatus (including artificial limbs, eyes and teeth.)".

I should have thought that these contraceptives over which the present dispute arises were neither surgical nor dental nor veterinary instruments nor apparatus but I am told that by a certain stretch and strain on the word "medical" they may perhaps be brought thereunder although I am greatly puzzled how they are medical. Nothing, however, turns on the classification so far as this appeal is concerned and I shall say nothing more.

6. The facts of this trade mark dispute should be clearly stated. The London Rubber Company Ltd. is the trading name of Elarco Limited of London. They entered opposition on 29-3-1951 to the application No. 122251 of the "Durex Products Inc." of New York City. That application was made as early as 28-5-1946 in respect of "Contraceptive devices, including prophylactic sheaths or condoms, vaginal diaphragms, instruments for inserting diaphragms and models for demonstrating insertion of diaphragms, vaginal jellies, applicators for vaginal jellies and surgical lubricating jellies." The applicants wanted to register the mark "Durex". The appellants who were opponents before the Registrar disputed the claim of the applicants. The appellants' case was that they were well-established manufacturers of surgical rubber goods and proprietors in India of the trade mark "Durex" and that they had been using this trade mark in India since 1932. They also pleaded an Indian Declaration of this mark recorded in India on 4-10-1934 and the fact that it was also registered in the United Kingdom on 17-10-1932. It was the case of the appellants that they applied for registration on 23-12-1946 in respect of the word "Durex" in Class X. The substance of the complaint of the appellants was that the mark applied for by the applicants, namely, "Durex" was identical with their mark "Durex".

7. This account of facts may be enlarged by a few dates relevant for the purpose of disposing of this appeal. The application for registration by "Durex Products Inc." was made on 28-5-1946 prior to the application of the appellants for registration which was made on 23-12-1946. Opposition by the appellants was made on 29-3-1951. The appellants got their mark registered on 11-7-1951.

Thereafter on 24-7-1954 the appellants' registration was renewed for a period of 15 years from 23-12-1953. The opposition to the present application was heard on or about 3*8-1954. The present decision from which the appeal is preferred was made on 31-12-1954. The decision permitted the "Durex Products Inc." to proceed to registration of their mark "Durex" with the conditions mentioned before.

8. Mr. S. Chaudhuri, learned counsel for the appellants, contended at the outset that the decision of the Deputy Registrar in this case was a decision in violation of the express statutory provisions contained in Section 8 of the Trade Marks Act. His contention is that implicit in the decision of the Deputy Registrar is the finding that the trade mark "Durex" was likely to deceive or cause confusion. The gist of this argument is that no mark which is likely to deceive or cause confusion can be registered under any circumstances. Therefore, he contends that the prohibition of Section 8 of the Act applies. Section 8(a) of the Trade Marks Act, 1940, inter alia provides :

"No trade mark nor part of a trade mark shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would--

(a) by reason of its being likely to deceive or to cause confusion or otherwise be disentitled to protection in a Court of Justice."

He argued with considerable force that the express reference in the Deputy Registrar's decision to the "tangible possibility of confusion" makes it quite clear that this mark was likely to cause confusion. Therefore, on the plain reading and interpretation of Section 8 of the Act this trade mark "Durex" should not have been registered in favour of the respondent "Durex Products Inc.".

9. I am unable to accept that argument. I shall state my reasons briefly. Section 8 of the Act does not stand alone. Section 8 deals with the prohibition of registration of certain matters. Section 10 of the Act deals with prohibition of registration of identical or similar trade marks. Section 10(2) of the Trade Marks Act, 1940, provides :

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

A Statute and specially its sections on the same subject should be read as a whole so that a harmonious* and not conflicting construction of its different sections can be achieved. If Section 8 of the Act is to be read exclusively without regard to Section 10 then impossible consequences will follow. If Section 8 of the Act is to be interpreted as meaning that there is always an unqualified prohibition to register any matter which is likely to cause deception or confusion then I do

not see how Section 10(2) of the Act can claim to provide for registration of identical or resembling marks. Identity or similarity of trade marks is ex-hypothesi likely to cause deception or confusion but even then identical or similar trade marks are made registrable under certain conditions. As I read these two sections--Sections 8 & 9 (sic) of the Act--I come to the conclusion that the law prevents registration of a trade mark which is likely to deceive or cause confusion but in the case of identity or similarity of trade marks which is also or may also be a ground for confusion or deception, the trade mark could be registered under certain conditions or limitations as the Registrar may think fit to impose. I read this provision of the law as an exception to the general prohibition against registration where the mark is likely to deceive or cause confusion.

10. In order to meet this construction Mr. Chaudhuri contends that Section 10 should be limited only to cases where a trade mark is already on the register, and by invoking on the dates I have already given, the trade mark law of relation back contained in Section 16 which provides that the date of registration shall be deemed to be as from the date of the application for registration, Mr. Chaudhuri argues that this section has no application. The inspiration for this argument of Mr. Chaudhuri was drawn from Sub-section (1) of Section 10 of the Act using the words "already on the register or already registered". He nourished his inspiration by the observation of Harries, C. J. in the unreported decision in B. C. I. Ltd. v. Bangoday Cotton Mills, Ltd., Appeal No. 66 of 1947 (Cal) (A), where the learned Chief Justice said :

"As I have stated earlier, the Deputy Registrar of Trade Marks also held that the respondents were entitled to the protection given by Sub-section (2) of Section 10 of the Indian Trade Marks Act. That section can have no application to the present case because it deals with applications for registration of a mark similar to a mark already on the register. It is conceded that none of the opponents' marks were registered at the time the application was made, and, therefore, "Section 10 can have no application. Mr. Dutta Roy did not suggest, and rightly, that this section could possibly apply."

This observation was made by the learned Chief Justice sitting with N. C. Chatterjee, J. who, however, did not share expressly this particular view. With great respect to the learned Chief Justice we find it difficult to support the correctness of that observation, Were it necessary and were we satisfied that this was the observation of a Division Bench we would have been prepared to refer the matter to a Full Bench, but as I have already indicated, this statement did not form part of a decision of the Division Bench and Chatterjee, J. did not share this view on Section 10 of the Act, Further, it is obvious that this observation was made by Harries, C. J. ad invitum and ex concessis so that it could not be regarded as a decision of the Court upon arguments.

12. It is, therefore, necessary to state our view on Section 10 of the Trade Marks Act. Mr. Chaudhuri's main contention is that because there is express reference in Sub-section (1) of Section 10 to the provisions of Sub-section (2), therefore

Sub-section (2) of Section 10 of the Act should not be read independently but as a proviso to Section 10 (1) of the Act. I am unable to accept that construction. It is true that Section 10(1) of the Act begins with the words "save as provided in Sub-section (2)". That only means that the provisions of Sub-section (1) of Section 10 of the Act are to be read as modified by the provisions contained in Sub-section (2) and not the other way about which Mr. Chaudhuri contended. Secondly, the language used in Sub-section (2) of Section 10 makes it indisputably and indubitably clear that it has no reference to Sub-section (1) of Section 10. I have quoted elsewhere the exact language of Sub-section (2) of Section 10 of the Act. It deals with all cases of honest concurrent use or of other special circumstances in which registration of trade marks by different proprietors although they are identical or merely resembling each other could be granted by the Registrar subject to such conditions and limitations as he thinks fit to impose. My reading of Section 10 is that in Sub-section (1) the prohibition is against registering a trade mark which competes with another registered trade mark. Sub-section (2) of Section 10 of the Act imposes no such limitation. Sub-section (2) of Section 10 cannot be confined only to the cases of competition between a registered trade mark and an unregistered trade mark but on the plain language of it must also include cases of competition between even unregistered trade marks none of which is on the register, so long as the fact of honest concurrent use or other special circumstances are present. Sub-section (3) of Section 10 also suggests that the observation of Harries, C. J. cannot be correct. That Sub-section (3) deals with those cases where none of the marks are registered and where the facts either of honest concurrent use or of other special circumstances are non-existent. I am satisfied on the construction of Section 10(2) of the Act that the present appeal comes within its ambit. On a point of construction I am not an enthusiast to travel to other statutes for the purpose of inspiration. Lest it be said that the interpretation put on Section 10(2) is too unconventional for the orthodox way of looking at it, I shall take the liberty of referring to the 7th Edition of Kerly on Trade Marks. Commenting on the English provisions reasonably in *pari materia* with the Indian statutory provisions, the learned Editor says at page 229 :

"Sub-section (2) of Section 12 provides a remedy for such a state of things by conferring on the Court, or the Registrar, in cases of honest concurrent use or of other special circumstances, power to permit registration, either of the unregistered trade mark, or, if neither is registered, of both trade marks, subject to such, if any, conditions and limitations as may be thought fit In exercising its discretion under the section the Court or the Registrar will have regard to the interests of the public as well as those of the owners of the trade marks." Section 12(2) of the English Trade Marks Act 1938 uses the identical expressions "honest concurrent use or of other special circumstances."

13. This disposes of Mr. Chandhuri's main objection to this decision of the Deputy Registrar. Incidentally it also disposes of his other objection, that the decision of the Deputy Registrar imposing limitations and conditions was beyond

his powers. That objection is also equally met by this construction. His contention that only Section 8 of the Act applied was called in aid by him to suggest an argument at the Bar that the Registrar had no power u/s 8 of the Act to impose any condition or limitation. Without deciding the point whether the Registrar has such power u/s 8 or not, it is quite clear that the Registrar in this case has ample power u/s 10(2) of the Act to impose the two conditions which he has imposed in the decision under appeal. The Registrar's power to impose condition in this case is justified by the express provisions contained in Section 10(2) of the Trade Marks Act, 1940 which gives the Registrar power to impose such conditions and limitations as he thinks fit. Secondly, in this case the Registrar's power to impose conditions is in my view also justified by the clear provisions contained in Section 15(4) of the Act which expressly again gives the Registrar the power to decide whether and subject to what conditions and limitations, if any, the registration is to be permitted.

14. In the view that I am taking of Section 10(2) of the Trade Marks Act, 1940, it does not become any more necessary for the purpose of this appeal to construe the expression "already on the register or already registered" in Sub-section (1) of Section 10 of the Act. It may be that the doctrine of "relation back" u/s 16(1) of the Act does not apply to the expression "already on the register or already registered" not only because Section 16 appears in Chapter III relating to "procedure for and duration of registration so that the statute there provided that the date of registration shall be deemed to be the date of the application for registration but also because the expression "already on the register or already registered" in Section 10(1) of the Act might mean the date actually on which the trade mark is put on the register and not the notional date as provided in Section 16(1) even though such notional date is for the purposes of the Act. As at present advised I do not propose to venture any opinion on this point of construction.

15. Mr. Chaudhuri then submitted that although there was honest use in this case there was no concurrent use within the meaning of Section 10(2) of the Act. The burden of his argument on this point concerns the volume of use. On this he enters the arena of disputed facts. The point of his argument was that if there was no concurrent use within the meaning of Section 10(2) of the Act, Section 10(2) will not be able to protect the decision of the Deputy Registrar.

I am satisfied on this particular question of fact that there has been honest concurrent use within the meaning of Section 10(2) of the Act and I shall state the fact and my reasons as briefly as possible.

16. Florence S. Goodwin in her affidavit dated 6-8-1952 says :

"Your deponent knows that Durex Products Incorporated has done a substantial business in India since 1930."

Now she is the President of Durex Products Inc. The criticism made of this statement is that she had not shown the nature and volume of the business and

the exhibits that she had annexed to her affidavit indicated rather small orders and business. Sitting here in appeal under the Trade Marks Act I shall hesitate more than in ordinary appeals to disturb a finding of fact unless I am satisfied without doubt that the fact found by the Registrar is wrong. The statement of the deponent Florence S. Goodwin on affidavit that a substantial business in India since 1930 has been done by "Durex Products Inc." is to my mind dependable evidence on which I should act and rely. It is the statement of the President who is the head of the organisation of Durex Products (Inc.). What particulars should have been given may be a matter of criticism, but it lay in the hands of the opponents who are the appellants before us to ask for particulars or to deliver interrogatories. They did neither.

17. I should also emphasise that in Section 10(2) of the Act it is the "opinion of the Registrar" which is expressly said to judge if the case of honest concurrent use makes it proper to permit registration. I do not for a moment hold the view that such opinion of the Registrar once expressed is final and cannot be revised by this Court. In fact, I hold the opposite view and hold that the opinion of the Registrar can be revised by this Court hearing an appeal u/s 76 of the Act, but the point of importance emphasised is that the statute regards the opinion of the Registrar as the first standard. Unless that standard is obviously not discharged, this Court should hesitate on a disputed question of fact to take a contrary view on the ground merely that a different view is possible.

18. In this case I am satisfied on the evidence not merely of Florence S. Goodwin but on the affidavits that have been used and are on the record in the paper book that the fact of honest concurrent use as found by the Registrar cannot and should not be disturbed.

19. The question of the volume of use is always a relevant question in considering "honest concurrent use" u/s 10(2) of the Act. It depends on the facts of each case. There is no express statutory emphasis that the use should be large and substantial". Kerly at page 235 of the 7th Edition on Trade Marks quotes Lyle and Kinahan, Ltd."s application 24 R.P.C. 249 (A1) & other cases for the proposition that it is not necessary for the applicant's trade to be larger than that of the opponent. My own opinion is that the use has to be a business use. It has to be, a commercial use. It certainly will not do if there is only a stray use. But it is not possible in my view to lay down any hard and fast rule on the volume of the use necessary u/s 10(2) of the Act. The illustration that I have in view is the possible case of a small trader who with a very limited clientele honestly and regularly sold certain goods under a particular trade mark for a long time although such use or sale may be by comparison extremely small compared to a very big international business dealing with similar goods with similar trade mark. Even so, if there is honest concurrent use I should think the small trader is entitled to protection of his trade mark. Trade mark is a kind of property and is entitled to protection under the law, irrespective of its value in money so long as it has some business or commercial value. Not merely the interest of the public

but also the interest of the owner are the subject concern of trade mark legislation.

20. Mr. Chaudhuri on the question of use has submitted that during the War there was almost negligible sale of the products of the Durex company. There, again, that is not a sufficient argument on the facts of this case. I find from the affidavit of V. D. Navani dated 24-12-1953 the explanation given that during the war period the import of rubber contraceptives in the Dollar area was banned and he even refers to the fact that any one could import rubber contraceptives from England and the soft currency area and it required import license to get these goods from the U.S.A.

21. The registration can be permitted by the Registrar u/s 10(2) of the Trade Marks Act, 1940 not only on the ground of "honest concurrent use" but also on the ground of "other special circumstances". The words "other special circumstances" are also to be found in Section 12(2) of the English Act which I have mentioned above and the learned Editor of the 7th Edition of Kerly's Trade Mark at page 235 observes : "the words "or (if other special circumstances" have not been the subject of judicial decision,"

22. For my own part I should think that the words "other special circumstances" are designedly left vague by the statute. It is difficult to exhaust or categorise such special circumstances in which competing trade marks could be permitted to be registered with limitations and conditions. The word "other" in the expression "other special circumstances" even construed ejusdem generis with "honest concurrent use" can include a variety of special circumstances relating to the use of a trade mark. No question of honesty is raised here. It is conceded that the use is honest. There appear to be also special circumstances in this case in favour of the "Durex Products Inc." . In the first instance the word "Durex" is the name of the company itself. The company used its own name on its own product which every company should be entitled normally to use unless there be cogent reasons against it. Secondly the use has been for a considerable period of time. The company was incorporated in January, 1928 in New York. On 24-2-1930 "Durex Products Inc." applied to the United States Patent Office for the registration of the trade mark "Durex" and in that application it is expressly said by Florence S. Goodwill's affidavit that the use of the trade mark "Durex" upon the product is shown for the period beginning from March, 1928. The fact is that the user having been established, it would be a hardship now to deny registration to such an old mark. That also is in my view a factor which could certainly be considered under the words "other special circumstances" in Section 10(2) of the Act. Thirdly the socio-economic consideration of the user of these contraceptives also in my view relate to "other circumstances" in Section 10(2) of the Act. The Deputy Registrar in this case has taken into consideration the socio-economic view that contraceptives are necessary in the Indian context for the welfare of the nation. Without expressing my personal view either in favour or against the use of any contraceptive I cannot say that the Registrar was wrong

in law in paying consideration to the socio-economic reasons for the use of the trade mark "Durex" for contraceptives in the Indian Market as relevant under "other special circumstances". Fourthly, the "other special circumstances" is the fact that the applicant mark is largely confined to contraceptives for use by women and the appellants' admission contained in the letter of 27-10-1949 from Remfry and Son that the present application No. 122251 of "Durex Products Inc." is for very different goods. That also in my view is a special circumstance in this case.

23. Mr. Chaudhuri has relied on the well-known doctrine in the trade mark law that the applicant for registration has the onus to satisfy the Court that there is no reasonable probability (not possibility) to confusion. For this purpose he relied upon a number of decisions such as the "Black Magic" case reported in 58 RPC 91 at pages 102 and 103 (B) and to the case of "Panda" (Boot Polish) 63 RPC 78 (C) and another decision re: Leeson reported in 72 RPC 75 (D). It is unnecessary to discuss in detail the principles decided in those decisions first because the whole doctrine of reasonable probability of confusion has to be understood in the light of Section 10(2) of the Indian Statute and secondly because of the facts of this case. I am satisfied on the facts of this case that "Durex Products Inc." has satisfied that onus. It is discharged by the eloquent fact that throughout there is not a single instance of confusion or deception. It sounds a little strange for the appellants to urge this particular objection because they themselves said in the letter of 27-10-1949 that the goods were very different. That is an admission that considerably lightens, if not avoids, the burden of the applicants. Independently and even apart from this significant admission the applicants on the facts of this case have discharged the onus of satisfying the Registrar of Trade Marks and this Court that there is no reasonable probability of confusion specially with the protective conditions imposed by the Deputy Registrar of Trade Marks in his decision under appeal. The most important feature to notice on this point of user is that in actual fact not a single instance of confusion or deception has occurred. Coupled with this outstanding fact is the admission of the appellants themselves that the goods were of a different kind, and I am therefore satisfied that the onus upon the applicants for registration was fully and amply discharged.

24. For these reasons, I uphold the decision of the Deputy Registrar of Trade Marks and dismiss this appeal.

25. As there is no appearance on behalf of the respondents, I make no order as to costs.

R.S. Bachawat, J.

26. Both the applicants and the opponents claim to be proprietors of the mark "Durex". The applicants applied for registration of their mark in Class X in respect of contraceptive devices including prophylactic sheaths or condoms, vaginal diaphragms, instruments for inserting diaphragms and models for demonstrating

inserting of diaphragms vaginal jellies, applicators for vaginal jellies and surgical lubricating jellies. On the date of this application neither the applicants' nor the opponents' mark was on the register. Pending the application the opponents' mark was registered. The Deputy Registrar has now directed that the application do proceed to registration subject to the limitations that (1) the designation of goods shall read "vaginal diaphragms, instruments for inserting vaginal diaphragms and models for demonstrating insertion of vaginal diaphragms and applicators for vaginal jellies and (2) the name "Durex Products Inc." shall appear on the packings and containers of the goods. The opponents have preferred this appeal from that order.

26a. The opponents contend that the applicants' mark is likely to deceive and cause confusion and its registration ought not to be permitted in view of Section 8(a) of the Trade Marks Act.

27. Section 8(a) of the Trade Marks Act, 1940 reads thus :

"No trade mark nor part of a trade mark shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would--

(a) by reason of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Court of Justice."

28. The applicants in their counter-statement averred that their mark was honestly and openly used since the year 1932 in India, that there had been no instance of confusion or deception in all this period, that the refusal of the application would cause great hardship, particularly as the word "Durex" is an essential part of their name and that they had built a trade on it and that in any event as the mark was honestly and concurrently used the applicants' mark should be registered u/s 10(2) of the Trade Marks Act

29. The Deputy Registrar on a very full review of the facts of the case has repelled the opponents' contention and has decided that the registration ought to be permitted subject to certain conditions and limitations.

30. Before us Mr. Chaudhury strenuously contended that the registration of the mark offends against the provisions of Section 8(a) of the Trade Marks Act. I am unable to accept his contention after having given anxious consideration to his arguments.

31. To attract the bar of Section 8(a) of the Trade Marks Act, 1940, the trade mark must be disentitled to protection in a Court of Justice by reason of its being likely to deceive or to cause confusion or otherwise. It is not enough that the mark is likely to deceive or to cause confusion. In spite of such likelihood the mark may be entitled to protection from a Court of Justice and may not offend against Section 8(a), Trade Marks Act. In case of honest concurrent use by more than one trader, identical or resembling trade marks may be entitled to protection in a Court of Justice. Rights arising out of such concurrent use are recognised and protected by Sections 10(2), 22(3) and 25 of the Trade Marks

Act. Section 10(2) permits registration of identical or resembling trade marks by more than one proprietor.

32. The general provisions of Section 8(a) of the Trade Marks Act do not override the special protection afforded by Section 10(2) in respect of identical or resembling trade marks, it is true that Section 8 does not open with the words "save as provided in Section 10(2)". It is to be remembered, however, that Section 10(2) of the Act also does not open with the words "save as provided in Section 8." Sections 8 and 10(2) must be read together and Section 10(2) being a special provision must be read as a proviso to the general provisions of Section 10 of the Act.

33. Mr. Chaudhury next contended that Section 10 applies only to an application for registration of mark similar to a mark already on the register. He argued that the protection under Sub-section (2) of Section 10 can be given only to a mark which offends against provision of Sub-section (1) of Section 10.

34. Mr. Chaudhury contended that Sub-section (1) of Section 10 cannot apply to the present case because the opponents' mark was not on the register on the date of the application. For this purpose he relied on the doctrine of "relation back" embodied in Section 16 and upon the principle that the rights of the parties should be determined as on the date of the application for registration. Having regard to the language of Sub-section (1) of Section 10 cogent reasons may be advanced for holding that the prohibition of Sub-section (1) of Section 10 is attracted even where the opponents' mark is entered on the register during the pendency of the application. It is not necessary for the purpose of this case to decide this precise point. I will assume without deciding that the prohibition of Sub-section (1) of Section 10 does not apply where the opponents' mark comes to be entered in the register during the pendency of the application. Even on this assumption I am satisfied that the applicant in this case is entitled to the protection of Sub-section (2) of Section 10.

35. In my opinion, Sub-section (2) of Section 10 permits registration of an identical or resembling trade mark though that mark does not offend against the provisions of Sub-section (1) of Section 10 and though the other mark is not on the register. The reasons for this conclusion are as follows :

(1) There is no warrant for cutting down the general words of Sub-section (2) of Section 10 and for limiting its protection to a mark which offends against the provisions of Sub-section (1) of Section 10.

(2) The subject-matter of Section 10 is identical or resembling mark in respect of the same goods or description of goods. Sub-section (2) of Section 10 applies where there are such identical or resembling marks whether or not one of the marks is on the register.

(3) Sub-section (3) of Section 10 on the face of it applies to a case where neither of the marks is on the register. Sub-section (3) of Section 10 clearly shows that

Section 10 is not limited in its application to a case where one of the marks is already on the register.

(4) Logically the reason for affording protection i under Sub-section (2) of Section 10 are much stronger in a case where neither of the marks is on the register than in a case where one of the marks is on the register.

36. Mr. Chaudhury strongly relied upon the observations of Harries, C. J. in Appeal No. 66 of 1947 (Cal) (A). The observations of Harries, C. J. in that case undoubtedly supports the contention of Mr. Chaudhury. Harries, C. J. appears to have observed that Section 10 can have no application to the case before him because that section dealt with applications for registration of a mark similar to a mark already on the register. I am constrained to differ from this opinion of so learned and eminent a Judge. The observations were not really necessary for the decision of that case. They appear to have been made on a concession made by learned counsel for the respondent. No reasons are given for the view so expressed. The other learned Judge, N. C. Chatterjee, J. dots not appear to have subscribed to this view.

37. On a full consideration of the materials on the record I have come to the clear conclusion that there has been honest concurrent use by the applicants in respect of the trade mark "Durex" and that the applicants arc entitled to protection and registration under Sub-section (2) of Section 10 of the Trade Marks Act. In this view I am supported by the findings of the Deputy Registrar. The learned Deputy Registrar has found that the applicants' mark has been substantially and continually used in regard to vaginal diaphragms, instruments for inserting vaginal diaphragms, models for demonstrating insertion of vaginal diaphragms and applicators for vaginal jellies, that even if the shipments to (Mrs.) D. J. R. Dadabhoy of Cumballa Hill, Bombay, in 1931 were samples, they constitute user, that those samples were subsequently followed up by regular trading of goods, on orders by others at least from 1932, and that there is no indication of a common origin for the marks ""Durex" which both parties have accidentally, spontaneously and respectively coined and adopted for the goods as good invented word. I accept these findings of fact by the learned Deputy Registrar.

38. I am satisfied that in any event since 1932 there has been honest concurrent use of the trade mark by the applicants. The applicants have used the mark in relation to the goods in respect of which the registration has been permitted by the Deputy Registrar and as indicating a connection in the course of trade between those goods and the applicants Having regard to the language of Section 2(1) (e) and Section 2(2) of the Trade Marks Act, 1940, I am satisfied that the use in relation to samples of the goods is use within the meaning of Sub-section (2) of Section 10 of the Trade Marks Act, 1940. The honesty of the use is not disputed by Mr. Chaudhury. I am satisfied that the use is honest concurrent use. The use by the applicants ran parallel to and co-existed with the use of the same mark by the opponents. In view of the pruning of their records the

applicants have been able to give only a few instances of the use. On the materials on the record I am satisfied that the use has been substantial as stated in the affidavit of Florence S. Goodwin.

39. Once honest concurrent use of identical or resembling marks in respect of the same goods or description of goods is established, the Registrar has jurisdiction to allow registration of the marks by more than one proprietor. The Registrar then has a discretion to permit or not to permit such registration. In this particular case I am satisfied that the discretion under Sub-section (2) of Section 10 should be exercised in favour of the applicants for the following reasons :

(1) The applicants have honestly and independently coined, invented and adopted the mark "Durex" and have honestly and independently applied that mark to their own goods.

(2) The word "Durex" forms an essential part of the applicants' name.

(3) The user of the mark by the applicants has been for a considerable length of time and in any event since 1932.

(4) In spite of the user of the mark for this lengthy period there has been not a single instance of confusion or deception.

(5) There will be considerable hardship to the applicants if registration of their mark is not permitted remembering that the word "Durex" is part of their name.

(6) Regard being had to the admission made by the applicants in their attorneys' letter dated 6-11-1947 that the present application is in respect of very different goods and to the further fact that it is necessary to consult a doctor before using the goods in respect of which the applicant's mark has been registered the possibility of any deception or confusion is negligible.

(7) The limitations and conditions imposed by the Registrar obviate any tangible possibility of confusion of the public in future.

40. The Deputy Registrar has also taken into account the socio-economic consideration that contraceptives are so necessary for the welfare of the nation. In exercising his discretion under Sub-section (2) of Section 10 the Registrar is bound to give due regard to the interest of the public and he is, therefore, entitled to take into account socio-economic considerations. It is to be noticed that both the applicant and the opponents claim that contraceptives are necessary and important from the point of view of family planning. It is not the case of either the applicants or of the opponents that the goods which are the subject-matter of registration are used for any immoral or improper purposes. There may be differing views on the socio-economic consideration adverted to by the Deputy Registrar but for the purpose of this case and on the materials on the record I am not prepared to dissent from the opinion of the Deputy Registrar that contraceptives are necessary for the welfare of the nation. It may be that in

some other case and on the basis of some other materials one may take a different view on this point.

41. During the second world war the use of the mark by both the applicants and the opponents was affected. During the war period the import of rubber contraceptives from the dollar area was banned. At the same time there were very little sales of the opponents' goods in the Indian market. Reid in his first affidavit says that the applicants' goods were made the subject of a free issue to all combatants of the British and Allied Armed Forces serving in the Far East campaigns including India. Considering the evidence as a whole I am satisfied that War conditions affected the applicants as also the opponents more or less and that there has been honest concurrent use of the mark by the applicants.

42. In view of the fact that the applicants' mark is entitled to protection under Sub-section (2) of Section 10 I am satisfied that the mark does not offend against the provisions of Section 8(a).

43. The learned Deputy Registrar has also pointed out that independently of Sub-section (2) of Section 10 he is entitled to take into consideration the concurrent rights of the parties. He seems to have taken the view that even apart from Sub-section (2) of Section 10 the applicants' mark does not offend against the provisions of Section 8(a). On a full review of the evidence and on the materials on the record he has found (a) that the tangible likelihood of confusion or deception is negligible in view of the fact that there has been not a single instance of confusion, (b) that the possibility of confusion in future is further reduced by the necessity of consulting a doctor before using the goods (c) that the limitations and conditions imposed by him will safeguard the public further from tangible possibility of confusion between the marks. I entirely agree with these findings. In view of these findings it may be argued by the applicants respondents forcibly that their mark is not likely to deceive or to cause confusion, and that accordingly the mark even apart from the protection which may be given to it under Sub-section (2) of Section 10 does not offend against the provisions of Section 8(a). I say nothing more on this point because in my opinion on the materials on the record the applicants are clearly entitled to protection under Sub-section (2) of Section 10.

44. For my part I do not consider it necessary to say that there are "other special circumstances" entitling the applicants to protection under Sub-section (2) of Section 10. I do not desire to express any opinion on that point in view of the fact that I am fully satisfied that there has been honest concurrent use of the mark by the applicants so as to vest jurisdiction in the Registrar under Sub-section (2) of Section 10 of the Act.

45. I agree that the appeal should be dismissed.