

(1961) 08 BOM CK 0001

In the Bombay High Court

Case No : Misc. Petition No. 324 of 1960

Nekumar K. Porwal

APPELLANT

Vs

Mohanlal Hargovindas

RESPONDENT

Date of Decision : 19-08-1961

Acts Referred:

English Trade Marks Act, 1938 — Section 32, 32(1), 32(4), 32(5)

Trade and Merchandise Marks Act, 1958 — Section 10, 10(1), 11, 12(1), 12(3)

Citation : AIR 1963 Bom 246 : (1962) 64 BOMLR 616

Hon'ble Judges : Shah, J

Bench : Single Bench

Advocate : Baptista, Shavaksha and Kane, for the Appellant; Murzban Mistree and C.V. Nagaraja Sastri, for the Respondent

Judgement

1. This is a petition by way of an appeal against the order passed by the Deputy Registrar of Trade Marks (Mr. M. L. Kapoor) on 8th July, 1960 to the effect that the Register of Trade Marks be rectified by deleting the word "Bull" from the caption "Bull Dog" appearing in Drvanagri characters in the Registered Proprietor's mark, in an application for rectification filed by the respondents herein on 21st November. 1956 in respect of trade mark No. 131148 originally registered in the name of Kesharimal Pyarehand Porwal trading as Pyarchand Kesharimal Porwal, Kamptee, District Nagpur. but at present standing in the name of the petitioner. This application for rectification was based on the grounds, that the respondents were proprietors of registered trade marks Nos. 504 and 132940, that they were injured in their business and embarrassed by the registration of trade mark No. 131148, that the entry of Trade Mark No. 131148 in the Register had been made without sufficient cause, that the said entry wrongly remained on the Register, that the said trade mark was deceptive inasmuch as it bore the caption "Bull Dog" although the device contained therein was that of a lion and that the registration of the said Trade Mark No. 131148 offended against the provisions of Section 11 of the Trade and Merchandise Marks Act, 1958, and the relief that was claimed in the application was the

removal of Trade Mark No. 131148 from the Register. In the statement of case accompanying the application for rectification, it was stated that the respondents had actually opposed the registration of trade mark No. 131148 but "on account, of unavoidable circumstances the applicants (respondents) for rectification were unable to file evidence in support of the opposition and the opposition was consequently treated as abandoned and mark No. 131148 was registered."

2. The Petitioner by his counter-statement filed on 22nd February, 1957 resisted the respondents' application for rectification and alleged that his application for registration of his trade mark No. 131148 was actually opposed by the respondents, that he had filed his counter-statement in that opposition, that the respondents had failed, to lead evidence in support of their said opposition and had ultimately informed the Registrar that they did not desire to file any evidence, that subsequently, the respondents of their own accord had withdrawn their opposition and thereupon trade mark No. 131148 was duly registered, that the registered proprietor of that mark had been using the said mark ever since 1910 and had built up a vast trade and reputation and that his trade mark had been rightly registered. The petitioner denied that the device in his registered mark was not that of a "Bull Dog" or that it was a device of a lion and asserted that his trade mark did not offend against the provisions of Section 11 of the Trade and Merchandise Marks Act, 1958 as alleged. He also contended that the respondents had acquiesced in the registration and use of his mark and were accordingly estopped by their conduct from proceeding with their application for rectification.

3. In support of the application for rectification an affidavit dated 23rd May, 1957 of Desai bhai Laldas who happens to be the manager of the respondent firm was filed in course of which it was inter alia stated that the respondents were proprietors of trade marks Nos. 504 and 132940 both registered in Class 34 in respect of bidis, that trade mark No. 504 consisted of a label containing the device of a lion as its essential feature, that the respondents had been using their aforesaid marks for more than past 30 years and that the bidis of the respondent firm bearing their aforesaid marks were known as "Sher Chhap Bidis". In the said affidavit it was admitted that the respondents had opposed the registration of trade mark No. 131148 of the registered proprietor but that they were unable to file evidence in support of the opposition and consequently their opposition was treated as abandoned. Curiously enough, however, it was emphatically asserted in paragraph 8 of the said affidavit that the respondents had not withdrawn their opposition to the registration of trade mark No. 131148 which assertion was wholly untrue in view of the earlier statements to the contrary in the very same affidavit. It was further stated in that affidavit that the device appearing in the registered trade mark No. 131148 was not of a "Bull Dog" but was that of a lion and that consequently that trade mark was deceptive, and offended against the provisions of Section 11 of the Trade and Merchandise Marks Act, 1958, and was consequently disentitled to protection.

4. As against this affidavit filed on behalf of the respondents, the petitioner himself tiled an affidavit dated 1st October, 1957 in support of the valid registration of his trade mark and a number of other affidavits from traders as well as consumers were also filed on his behalf. The Petitioner in his affidavit reiterated and confirmed alt that he had stated in his counter-statement as aforesaid and further stated that he and his predecessors-in-title had been using the trade mark No. 131148 since 1910, that he had been able to collect his books of account from the year 1924-25 to the year 1955-56, that his bidis bearing the aforesaid mark were referred to as "Bull Dog" bidis by the traders and the consuming public and that not a single case of confusion or deception had been brought to his notice during the last more than 32 years. The petitioner further stated in his affidavit that the application for registration of trade mark No. 131148 was opposed by the respondents and that they had knowingly and wilfully withdrawn their said opposition and that accordingly, they were estopped from applying for rectification of the register in respect of the said mark. The other affidavits that were filed on his behalf testified to the fact that the bidis bearing the registered trade mark No. 131148 had been very popular since long and were asked for, bought and sold by reference to the words "Bull Dog".

5. In reply to the affidavits filed by and on behalf of the petitioner, affidavits were filed on behalf of the respondents not only by the said Desaibhai Laldas who had made an affidavit in support of the application for rectification as aforesaid, but also by dealers in the respondents" Sher Chhap bidis as well as consumers thereof. The affidavits filed by Desaibhai Laldas dated 4th February 1959 and 28th May, 1959 respectively merely denied the statements made in the various affidavits filed by and on behalf of the petitioner, It may be noted, however, that even in his affidavit in reply dated 4th February, 1959, this Desaibhai Laldas persisted in denying that the respondents had withdrawn the opposition No. 1299 to the registration of trade mark No. 131148 despite the fact that he had in his earlier affidavit in support of the application for rectification clearly stated that the respondents were unable to file evidence in support of their opposition and consequently their opposition was treated as abandoned.

6. This application for rectification was heard by the Deputy Registrar of Trade Marks on 22nd and 23rd March, 1960. In course of the hearing it was urged by the learned counsel for the petitioner before him that the respondents were, in view of their conduct, estopped from asserting that they were "a person aggrieved" within the meaning of Section 56 of the Trade and Merchandise Marks Act, 1958, and consequently, they could not maintain the application for rectification of the register. Arguments were heard on this preliminary objection as well as on the merits of the application for rectification. So far as the preliminary objection was concerned, the Deputy Registrar of Trade Marks came to the conclusion that, despite the withdrawal of the opposition by the respondents to the application for registration of the trade mark in question, the respondents were "persons aggrieved" within the meaning of Section 56 of the Act on account of the allegations made in the application for rectification, but he

held that they were estopped by their conduct from urging that they were "persons aggrieved" "in so far as the resemblance between their trade marks Nos. 504 and 132940 and the Registered Proprietor's Trade Mark No. 131148 is concerned and in so far as the application for rectification is based on the said ground it cannot be maintained by them". As regards the respondents' claim for rectification of the Register on the ground that the device appearing in the registered proprietor's trade mark No. 131148 was that of a lion but had been mis-described as that of a "Bull Dog", the Deputy Registrar held that the respondents could not be said to be "persons aggrieved" observing as follows :

"Whether the registered proprietor's trade mark No. 111148 contains the caption "Bull Dog" "Elephant", "Horse". "Zebra" etc., is not something: which in any way interferes with, injures or embarrasses the applicants for rectification in their trade or business under their registered trade marks. Nos. 504 and 132940 and the plea that the registered proprietor's mark in question contains the misdescription "Bull Dog" cannot be sustained as a grievance for rectification of the Register. It is the alleged resemblance between the registered proprietor's trade mark No. 131148 and the applicants for rectification trade marks Nos. 504 and 132940 which could be a valid grievance for rectification of the Register, but which, for what I have stated elsewhere in this judgment, is no longer available to the applicants for rectification. Apart from that. having regard to the letter dated the 7th February, 1952 addressed by the Advocate for the applicants for rectification to the Registrar of Trade Marks in relation to opposition No. 1299, the applicants for rectification were never a "person aggrieved" with regard to the caption "Bull Dog" appearing on the registered proprietor's Mark."

The Deputy Registrar accordingly was of the view-that the respondents could not be said to be "persons aggrieved" in so far as the alleged misdescription of the petitioner's device was concerned. As stated earlier, however, the Deputy Registrar was of the view that they could be said to be "persons aggrieved" only in so far as the petitioner's trade mark No. 131148 was alleged to resemble the respondents' trade marks No. 504 and 132940 in their application for rectification, but that they were estopped by their conduct from urging that they were "persons aggrieved" within the meaning of Section 56 of the Act in so far as the alleged resemblance between the two trade marks was concerned. On merits, the Deputy Registrar held that the respondents had failed to prove prior user of their trade mark which formed the basis of their application for rectification and that consequently, they were not entitled to rectification of the register on the ground of the alleged deceptive resemblance between their registered trade marks No. 504 and 132940 and the registered proprietor's trade mark. No. 131148. The Deputy Registrar in this connection observed that if the user of their aforesaid trade marks had started from a date prior to the date of commencement of user by the registered Proprietor of his trade mark No. 131148, the latter would be entitled to remain on the register on the ground of honest concurrent user u/s 12 (3), of the Trade and Merchandise Marks Act, 1958, On the question as to whether the device on the, petitioner's trade mark

No. 131148 was that of lion, the Deputy Registrar came to the conclusion that the device did not represent a lion but it resembled the device of a St. Bernard dog or a Tibetan Mastiff or a Himalayan dog. In view of his finding that the respondents were not entitled to rectification of the register on either of the two grounds stated in their application for rectification, it was not really necessary for the Deputy Registrar to determine as to whether there was any resemblance between the device appearing in the trade mark No. 131148 and the one appearing in the respondents' trade marks. Having, however, held that the device in the petitioner's trade mark was that of a St. Bernard dog or a Tibetan Mastiff or a Himalayan dog, the Deputy Registrar proceeded on his own to consider as to whether the description of the device in the petitioner's trade mark as a "Bull Dog" was correct, and finding that the said device did not represent a "Bull DOG" in the true sense of the term, but either represented a St Bernard dog, or a Tibetan Mastiff or a Himalayan dog, he proceeded to make an order in the name of purity of the register and in the interest of the public, that the word "Bull" from the caption "Bull Dog" be deleted and that the register of trade marks be rectified accordingly. It is against this order that the petitioner has filed the present petition by way of an appeal in this Court.

7. The respondents have in their turn filed cross-object ion disputing such of the findings of the Deputy Registrar as have been recorded against them. The respondents have also filed an application for permission to lead additional evidence in this Court which application, however, was not pressed by Mr. Mistree, the learned counsel for the respondents. The said application is, therefore, dismissed with costs.

8. It was contended by Mr. Shavaksha, the learned counsel for the petitioner that the respondents, while they made their application for rectification of the Register of trade marks, were not really "persons aggrieved" within the meaning of Section 56 of the Trade and Merchandise Marks Act, 1958 so as to enable them to make any application for rectification of the petitioner's mark u/s 56 of the Act. In support of this contention, Mr. Shavaksha relied upon the fact that the respondents had admittedly withdrawn their opposition to the petitioner's application for registration of his mark No. 131148 and that, therefore, they should be deemed to have had no grievance at all by reason of the petitioner's mark having been registered in pursuance of his application for registration. He urged that by their conduct in withdrawing their opposition to the petitioner's application for registration of his mark, the respondents clearly indicated that they were not likely to be at all injured in their business and that they would have no grievance of any kind whatever if the petitioner's mark was registered as applied for by him. In his submission, therefore, the respondents were no longer "persons aggrieved" by reason of the registration of the petitioner's mark and, therefore, they were not entitled to make any application for rectification of that mark u/s 56 of the Trade and Merchandise Marks Act, 1958. Mr. Baplista, appearing for the Registrar of Trade Marks, on the other hand, contended that the respondents, despite their conduct in withdrawing their opposition to the

petitioner's application for registration of his mark, were nonetheless "persons aggrieved" within the meaning of Section 56 of the Trade and Merchandise Marks Act, 1958 in as much as the question as to whether a person was a "person aggrieved" within the meaning of that section was to be determined not by any such conduct on the part of the respondents but by the allegations made in their application for rectification showing that they were doing business in/the-same kind of goods and that they were likely to be injured in their trade if the petitioner's trade mark, continued to exist on the register of trade marks. In support of this contention, Mr. Baptista invited my attention to a passage in Kerly on Trade Marks 8th Edition, at page 180 which is as follows :

"The phrase "any person aggrieved" has been very liberally construed, and except, perhaps, in the case of a mark consisting of a name, it would be difficult to find any person engaged in the trade concerned, or any allied or connected trade, who is prevented by the qualification which it requires-from moving to rectify the Register. The persons who are aggrieved are, it is held, all persons who are in some way or other substantially interested in having the mark removed -- where it is a question of removal -- from the Register, on persons who would be substantially damaged if the mark remained."

These observations of the learned author were adopted with approval by this Court in Ciba Ltd. Vs. M. Ramalingam and S. Subramaniam trading in the name of South Indian Manufacturing Co. and Another, . In that case it was contended on behalf of the respondents that the appellants were not "a person aggrieved". It was a case in which the respondent had applied to the Registrar of Trade-Marks for registration of a label which contained the word "Cibol" already registered, made an application for rectification of the Register by removal of the respondent's trade mark. The Registrar ordered the rectification prayed for, but the decision of the Registrar was reversed by Mr. Justice Coyajee-in appeal which decision in turn was reversed by the Court of Appeal. Dealing with the contention raised on behalf of the respondent as aforesaid. Chagla C. J. observed as follows (at p. 563) (of Bom LR) : (at p. 60 of AIR) :

"It is difficult to conceive of a person more aggrieved than the appellants because the appellants' case is that the product of the respondents-is likely to be sold as the product of the appellants and Kerly on Trade Marks at p. 256 states that the phrase "any person aggrieved" has been very liberally construed and that the persons who are aggrieved are all persons who are in some way or other substantially interested in having the mark removed -- where it is a question of removal --from the register, or persons who would be substantially damaged if the mark remained. This definition clearly brings within its ambit the appellants".

The best definition of the expression "person aggrieved" appears to have been given by Lord Herschell in Powell v. Birmingham Vinegar Brewery Co., (1894) AC 8. It is as follows :

"Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark if remaining on the Register, would or might limit the legal rights of the applicant, so that by reason of the existence of the entry on the Register he could not lawfully do that which but for the existence of the mark upon the Register he could lawfully do, it appears to me he has a locus standi to be heard as a person aggrieved." The grievance, however, of the applicant in such a case must be substantial and a fanciful suggestion of grievance is obviously insufficient. A merely sentimental grievance does not make a person "aggrieved" within the meaning of this section. Where a person shows himself to be a "person aggrieved" in the light of the observations quoted above, by making necessary statements in the application for rectification in that behalf, such person would obviously have the locus for the purpose of making an application u/s 56 of the Trade and Merchandise Marks Act, 1958, although at the hearing of the application he may not eventually be found to be such person, e.g. by his conduct, as in this case, in withdrawing his opposition to the application for registration of a trade mark and thereby allowing the trade mark to be registered without any objection from him. Reference in this connection may be made to In the matter of Actomin Products Ltd. (1952) 69 R.P.C. 166 and Monappa v. Ramappa, AIR 1956 Mad 184. In the first case, which was decided by the Assistant Comptroller, a question was raised as to whether the applicants could be said to be "persons aggrieved" within the meaning of Section 32 of the English Trade Marks Act, 1938, until the breach of the contract in question was established. In answering this question the Assistant Comptroller observed as follows :

"In my view, although the "locus standi" of an applicant for rectification u/s 32 is, of course, challengeable, it is an essential preliminary qualification which is to be tested prima facie upon the assumption that the facts alleged as the basis of the "locus" are true. For example, if an applicant for rectification of the Register u/s 32 alleges that a mark was wrongly entered upon the Register because it had an undue resemblance to a mark which the applicant was already using in relation to identical goods, such an applicant would prima facie have established a "locus" as an "aggrieved" person, although he might fail eventually to satisfy the Tribunal as to the alleged resemblance of the two marks."

These observations were followed with approval in the latter case by the Madras High Court. Ramaswami J., while dealing with the question of locus standi of an applicant for rectification of the register of trade marks observed in paragraph 15 of the judgment at page 187 as follows :

"In determining the "locus standi" of an applicant the allegations as to facts made by him should, "prima facie", be assumed to be true although they may be challenged."

That, it is clear that the respondents in this case in view of the allegations made by them in their application for rectification were undoubtedly "persons

aggrieved" within the meaning of Section 56 of the Trade and Merchandise Marks Act, 1958, so as to enable them to make an application for rectification of the petitioner's trade mark under that section. It must be observed, however, that the locus thus obtained by the respondents could be challenged by the petitioner before the Registrar and it was in consequence of this challenge that the Deputy Registrar came to the conclusion that the respondents were not really "persons aggrieved" in regard to the petitioner's trade mark in so far as they sought rectification of the register of trade marks on the two grounds mentioned in their application.

9. I have already observed in the earlier part of this judgment that in view of the finding arrived at by the Deputy Registrar of Trade Marks that the respondents by their conduct were not "persons aggrieved" and, therefore, could not obtain any relief on either of the grounds mentioned in the application, it was unnecessary for him to go into the question as to whether there was any similarity between the device in the petitioner's trade mark and the device in those of the respondents. The Deputy Registrar, however, in the name of public interest and purity of the register of trade marks went into this question quite at length and came to the conclusion that there was no similarity between the two devices at all. With this conclusion the Deputy Registrar should have really dismissed the respondents' application for rectification, but again, in the name of public interest and purity of the register of trade marks, he went into the question as to whether the Register required any rectification by reason of the misdescription of the animal on the petitioner's trade mark. Relying upon certain statements of law in *Kerly on Trade Marks* the Deputy Registrar thought that even in such matters the question of rectification of the Register was not one between the respondents for rectification on the one hand and the Registered proprietor on the other, and holding that the description of the device in the petitioner's trade mark was inaccurate, he ordered the deletion of the word "Bull" from the caption "Bull Dog" appearing in the device.

10. Mr. Shavaksha, the learned counsel for the petitioner, vehemently urged that the Registrar had no jurisdiction whatever to go beyond the contentions raised by a "person aggrieved" in an application for rectification u/s 56 of the Act and that, therefore, it was not competent for him in the present case to go into the question _as to whether the animal on the petitioner's device was correctly described or not. Mr. Shavaksha further contended that even assuming that the Deputy Registrar had the power to decide such a question in an application for rectification of Register which did not raise such question at all, the Deputy Registrar was in error in thinking that such misdescription was likely to deceive or confuse and that, therefore, it required to be rectified. He urged that the mark was being used ever since 1910 by the petitioner in connection with the bidis prepared and sold by him and his predecessors-in-title and the bidis sold under that mark were popularly known as "Bull Dog" bidis. He pointed out that, as a matter of fact, a number of affidavits had been filed on behalf of his client both by dealers and consumers of the petitioner's bidis testifying to the fact that the

petitioner's bidis were popularly known as "Bull Dog" bidis and that there was no evidence whatever before the Deputy Registrar to enable him to come to the conclusion that such mark was likely to deceive or confuse anybody at all. Mr. Shavaksha urged that, on the contrary, by deleting the word "Bull" from the caption "Bull Dog" people who have been in the habit of smoking these bidis would be definitely confused wheain in answer to the demand for "Bull Dog" bidis they were offered "Dog" bidis and that the dealers would be at great pains to explain to the consumers that the "Dog" bidis that they were offering were the same as the "Bull Dog" bidis which they used to buy in the past.

11. Taking the first of these questions as to whether the Deputy Registrar had jurisdiction in the present case to order the deletion of ihe word "Bull" from the caption "Bull Dog" of his own motion in an application filed by the respondents which sought the expungemet of the petitioner's trade mark from the Register out-right, Mr. Shavaksha urged that the Deputy Registrar had no such power u/s 56(2) of the Trade and Merchandise Marks Act, 1958, but that he had an independent power given to him to do any such thing under Sub-section (4) of Section 56 of that Act. Mr. Baptista, the learned counsel for the Registrar, however, stated that he did not rely upon Sub-section (4) of Section 56 of that Act but that he would justify the action of the Deputy Registrar in this case under Sub-section (2) of that section. The question, therefore, that I have now to consider is as to whether on a true construction of Sub-section (2) of section 56 of the Trade and Merchandise Marks Act, 1958, the Registrar has at ail any power to make, expunge or vary any entry on any ground other than those mentioned in the application for rectification by a "person aggrieved". Before dealing with this question, I may mention that Mr. Shavaksha had also challenged the authority if the Deputy Registrar to make any such order even under that Sub-section of that section on the ground that the Deputy Registrar was not shown to have the functions of the Registrar under that section delegated to him by the Registrar under Sub-section (2) of Section 4 of the Act. Mr. Baptista in answer to this contention handed in a copy of an office order No. 62 (1959 series) which is shown to have been passed by the Controller-General of Patents, Designs and Trade Marks under Sub-section (2) of section 4 of the Act authorising among others the Deputy Registrar of Trade Marks to discharge the respective functions of the Registrar under the Act. Among these functions, in clause 2 against the heading "Deputy Registrar of Trade Marks", arc mentioned (1) "Hearings in respect of applications for registration, opposition proceedings, rectification and correction of the Register, all interlocutory applications and all other matters connected with the above". From this order it is clear to deal with matters of rectification of the Register u/s 56 of the Act.

12. Now, turning to the question of the Deputy Registrar's jurisdiction under Sub-section (2) of Section 56 of the Act to make the order which is the subject-matter of this petition, that Sub-section may first be reproduced and it is as follows :

"Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to a High Court or to Registrar, and the tribunal may make such order for making, expunging or varying the entry as it may think fit".

I may as well quote here Sub-section (4) of "that section which is as follows :

"(4) The tribunal, of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in Sub-section (1) or Sub-section (2)."

Sub-section (2) as quoted above may at this stage be compared with Sub-section (1) of Section 32 of the English Act of 1938. That Sub-section is word-ed as follows :

"Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to the provisions of section fifty-four of this Act, to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as the tribunal may think lit."

It may be noted that Sub-section (3) of Section 56 of our Act is verbatim the same as Sub-section (2) of Section 32 of the English Act. Sub-section (4) of that section of our Act, however, does not find place in the English Act, Instead, Sub-section (3) of Section 32 of that Act provides as follows :

"In case of fraud in the registration assignment or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section".

Sub-sections (5) and (6) of Section 56 of our Act are again verbatim the same as Sub-sections (4) and (5) of Section 32 of the English. Act. It will be noted that Sub-section (2) of Section 56 of our Act is in all material particulars the same as Subsection (1) of Section 32 of the English Act, and it there be any authorities laying down the scope of the provisions of Sub-section (1) of Section 32 of the English Act, they would, in my opinion, by the proper guide for the purpose of construing the provisions of Sub-section (2) of Section 56 of out Act Kerly in the 8th Edition of his treatise on Trade Marks while dealing with the question of the exercise of the jurisdiction u/s 32 of the English Act says at page 184 as follows :

"Where the mark was incapable of registration it must be removed.....

The question of the grievance of the. applicant being merely one of locus standi, if on the face of the proceedings the applicant is enabled, as a person aggrieved, to bring his application before the tribunal, the tribunal has jurisdiction to rectify

the Register, which, in the case of a mark not belonging to the class of marks admitted to registration under the Act, it ought to exercise, even under circumstances in which the applicant is precluded from exercising the right with which the registration interferes. Thus, in the *Stone Ales* case the Court of Appeal removed the plaintiff's mark, "Stone Ale," from the Register on the application of the defendant, although they maintained the injunction granted by Chitty J., restraining the defendant from selling goods not of the plaintiff's manufacture under the name in question. The Conduct of the applicant is irrelevant -- The demerits of the applicant in any such case are irrelevant to the question whether rectification should "be ordered or not. The question is not between the applicant on the one hand and the respondent on the other, but between the public and the respondent."

This statement of the law makes it clear that it is not in all cases that the Tribunal has jurisdiction to rectify the register on any ground it pleases apart from the grounds stated by the applicant for the rectification of the register in his application. It is only in cases where a mark in its very nature is incapable of registration under the Act that the tribunal has jurisdiction to rectify the register and expunge the offending entry from the register, and it is in this connection that the demerits of the applicant are said to be irrelevant to the question whether rectification should be ordered or not, and it is again in this connection that the question would not be one between the applicant on the one hand and the respondent on the other, but between the public and the respondent. It was, however, urged by Mr. Baptis^a on behalf of the Registrar that despite what Kerly might have stated in the aforesaid paragraphs of his Treatise, all necessary rectifications should be made in the register of trade marks whenever the Registrar in course of any proceedings before him for rectification of the Register comes across circumstances in which such rectifications are called for in his view in as much as the purity of the Register of Trade Marks has got to be maintained at any cost. Now as regards this purity of the Register Kerly has again at page 183 of his Treatise stated as follows under the heading "Purity of the Register".

"In one case it was suggested that, although the applicant was not a person aggrieved, the Court would, in the interests of the public, rectify the Register if the mark was bad. Even if the Court would, under any circumstances, take such a course in the absence of a person aggrieved, it would only do so in the case of a registration which was on the face of it illegal or improper.

In *Lever Bros., Port Sunlight, Ltd. v. Sunni Wite Products, Ltd.*, (1949) 66 RFC 84 it was held that although the plaintiffs, had laid themselves open to attack u/s 26, by reason of non-use, nevertheless the imp each able entries were not "illegal" or improper, and therefore were not such as the Court was bound to take cognisance of in the interests of the purity of the Register."

In the matter of the Trade Mark of Wright, Crossley and Co., (1898) 15 R.P.C. 131, Romer, J. observed (at page 133) as follows :

"As Lord Justice Bowen pointed out in the case of *Paine and Co. v. Daniells and Sons*" *Breweries*, (1893) 2 Ch 567 to which my attention has been called the Court deals, differently with Trade Marks according to whether the registration was on the face of it, as it were, originally illegal or improper. The Court, in a case of a clearly illegal registration, will certainly "not look with any particularity into the question as to who the applicant is who comes and calls the attention of the Court to the fact of the illegal and improper registration. But, as Lord Justice Bowen said in that case, at! page 584, the matter is wholly different if the Trade Mark complained of is one which is not of itself illegal or improper As I have said, all cases of this kind, where the original registration is not illegal or improper, ought to be considered as questions of common sense, to a certain extent, at any rate; and I think the applicants ought to show something approaching a sufficient or proper reason for applying to have the Trade Mark expunged. It certainly is not sufficient reason that they are at loggerheads with the respondents or desire in some way to injure them."

These observations are undoubtedly made in regard to the question as to whether it was necessary for the applicants in that case to show that they were "persons aggrieved" before being entitled to make an application for rectification of the Register. They, however, do indicate the circumstances in which the Court suo motu would order expungement of an entry from the Register of Trade Marks namely, where a trade mark, as already stated, was incapable, in its very nature, of registration under the Act, or where the registration has been illegal or improper. In no other case would the Court exercise its jurisdiction to interfere with the registration of a trade mark by way of expunging or varying the entry in that behalf. In all other cases, however, the person making the application for rectification of the Register has to state and substantiate the grounds on which he seeks the rectification of the Register in respect of any particular trade mark, besides showing that he is a "person aggrieved" within the meaning of the section. In the *Lever Bros*" case, (1949) 66 RPC 84 the Court refused to take cognisance of the entries, though impeachable by reason of non-use in respect of certain trade mark, in the interests of the purity of the Register, because they were neither illegal nor improper. From these authorities, it will be clear that where a trade mark is not inherently incapable of registration or where the entry on the Register is not illegal or improper in the sense that it contravenes any of the provisions of the Act. the Court or the Registrar under Subsection (2) of Section 56 of our Act would have no jurisdiction whatever to exercise the power of rectification except on the ground and in the manner urged by the applicant being a "person aggrieved" in his application for rectification. In order, however, to show that the obligation to maintain the purity of the Register is of a much wider character than what has been pointed out by Kerly in the passage, aforesaid and by Romer, J. in the case cited above, Mr. Baptista relied upon the observations of Chagla C. J. in *Ciba Ltd. Vs. M. Ramalingam and S. Subramaniam trading in the name of South Indian Manufacturing Co. and Another*, . The learned Chief Justice quoted Section 46 of the Trade Marks Act, 1940 and also

Section 10(1) of the said Act and then proceeded to observe as follows :

"Broadly, the case of the appellants is that the trade mark "Cibol" so closely resembles their trade mark "Ciha" and that their trade mark "Ciba" was already on the register on August 24, 1946, and therefore, the trade mark of the respondents, should not have been registered on November 3, 1949. The appellants had also sought to bring their case u/s 8, but as we were satisfied that the case clearly fell within the ambit of Section 10(1) we did not permit Mr. Bhabha to elaborate his arguments with regard to his clients'" case u/s 8.

Now, in considering both Section 46 and Section 10, it has got to be remembered that the primary duty of the Court is towards the public and the maintenance of purity of the register. When a case is sought to be made out that a particular trade mark is likely to deceive or cause confusion, the contest is not so much between the parties to the litigation as it is a contest between the party defending his right to a particular trade mark and the public, and the duty of the Court must always be to protect the public irrespective of what hardship or inconvenience it may cause to a particular party whose trade mark is likely to deceive or cause confusion. The object of maintaining a trade mark register is that the public should know whose goods they are buying and with whom particular goods are associated. It is, therefore, essential that the register should not contain trade marks which are identical or which so closely resemble each other that an unwary purchaser may be likely to be deceived by thinking that he is buying the good; of a particular person or a particular firm or a particular industry, whereas he is buying the goods of another person or firm or industry."

These observations, in my opinion, do not support Mr. Baptista's contention that in the name of purity of the register of trade marks, it is open to the Registrar u/s 56(2) of the Act of 1958 to order rectification of the register for any defect or error "in the entry which has no relation whatever to the entry of any other trader and as such calculated to deceive the public into buying the goods of one person as if it belonged to another person. Sub-section (2) of Section 46 of the Act of 1940 corresponds to Sub-section (2) of Section 56 of the Act of 1958 and Sub-section (1) of Section 32 of the English Act of 1938, which have already been reproduced in this judgment. Sub-section (1) of Section 10 of the Act of 1940 which corresponds to Sub-section (1) of Section 12 of the present Act provided that no trade mark shall be registered in respect of any goods or description of goods which is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or which so nearly resembles such trade mark as to be likely to deceive or cause confusion. According to Chagla, C. J., where a trade mark contemplated by Section 10 is registered, the question of purity of the register would arise and it would be only in such cases that the matter would be one between the party defending his right to a particular trade mark and the public, and the duty of the Court in those cases would always be to protect the public irrespective of what hardship or inconvenience it may cause to a particular

party whose trade mark is likely to deceive or cause confusion. The case before me is not one of that type and, therefore, the question of the purity of Register does not arise so as to entitle the Deputy Registrar to make the impugned order.

13. Mr. Baptista next relied upon the following observations of Farewell, J. in *Bourne v. Swan and Edgar Ltd.*, (1903) 20 R.P.C.105 :

"I think it must be taken to be settled, on the authorities that have been called to my attention, that the right of an applicant is not a matter of his own concern alone, but, as Lord Justice Bowen said, "The purity of the Register of Trade Marks is of as much importance to the trade in general, quite apart from the merits or demerits of the particular litigants" ."

That, however was a case of two rival trade marks and the plea was that the defendant's mark was likely to deceive the public. "It was in this connection that the above observations were made, by the learned Judge. One of the marks was unregistrable under the Act and hence it was illegal and the registration thereof was accordingly illegal, I have already observed that in case of illegal entries on the Register of Trade Marks, the Court undoubtedly has jurisdiction to expunge the entry from the Register with a view to maintain the purity of the Register and in the interests of the public. This decision, in my opinion, is in conformity with the view taken by the English Courts in the cases already referred to by me and it does not help Mr. Baptista in his contention that the Registrar can pass any order varying an entry in the Register of Trade Marks though such entry is not in itself illegal or improper.

14. In view of these decisions, I am inclined to hold that Sub-section (2) of Section 56 of the Trade and Merchandise Marks Act, 1958 does not empower the Registrar to make any order under that Sub-section except on the grounds specified in the application for rectification of the Register by a person aggrieved and to the extent such rectification is prayed for. If an entry is found to be illegal or improper in the sense indicated above, the Registrar may, under that Sub-section, make any order he thinks fit, but that Sub-section, in my opinion, does not empower the Registrar to make any order concerning an entry on the Register of Trade Marks even where the entry is not illegal or improper in that sense. If any such order is to be made, the Registrar, I think, must proceed under Sub-section (4) of Section 56 of the Act.

15. Assuming I am wrong in this interpretation that I have put upon Sub-section (2) of Section 56 of the Act of 1958 and the Registrar can be said to have power under that Sub-section to make such orders as he thinks fit even in cases where the entry is neither illegal nor improper, the question that arises is as to whether the Deputy Registrar in this case was justified in making the impugned order. As I have already observed above, the Deputy Registrar has taken the view that by naming the dog in the device of the petitioner's mark as a "Bull Dog", the misdescription is likely to deceive or cause confusion apparently in the minds of the public. Admittedly, no evidence was led before him to show any such

deception, or confusion in the minds" of the public in regard to the petitioner's bidis and in the absence of any such evidence, I very much wonder how the Deputy Registrar could come to the conclusion that merely by naming the dog in the petitioner's device as a "Bull Dog" instead of a St. Bernard Dog or a Tibetan Dog or a Himalayan Dog, as he thinks the dog in the device really is, any deception is likely to be practised or any confusion is likely to be caused in the mind of any consumer of the petitioner's bidis. It is in evidence that the petitioner's bidis have been in the market ever since 1910 and are known as "Bull Dog" bidis. It is also in evidence of the dealers in those bidis that the consumers wanting those bidis demand them as "Bull Dog" bidis. If for all these 50 years the demands of the consumers for the petitioner's bidis have been met by the petitioner's dealers by supplying "Bull Dog" bidis and if these "Bull Dog" bidis have earned a firm reputation among the consumers thereof, I do not for myself see any likelihood of any deception being ever practised upon any such consumer or any confusion being created in their minds by reason of the continuous use of the same caption "Bull Dog" on the mark of the petitioner. On the contrary, as I have already stated above, there is likely to be confusion, if not deception, in the minds of these consumers if the petitioner's bidis were offered only under the name "Dog" as suggested by the Deputy Registrar, because, in that event the consumers quite naturally would be inclined to ask the dealers as to what had happened to the "Bull Dog" bidis which they were accustomed to use for years and why it was that the dealers were offering "Dog" bidis instead of "Bull Dog" bidis and the dealers will be put to the trouble of explaining to these consumers time and again that the bidis that they are now offering as "Dog" bidis were the same as the "Bull Dog" bidis of the past. In my opinion, the Deputy Registrar is in error in his conclusion that the expression "Bull Dog" on the petitioner's mark is likely to deceive or create confusion within the meaning of Section 11(a) of the Act.

16. Coming to the question of misdescription of the device, it is not such a misdescription that a horse is called a dog or a cow is called a horse. After all, the Deputy Registrar has himself found the device as undoubtedly of a dog, but not of the kind indicated thereon. According to him, it is a device of another type of dog altogether, but the correct description of this Dog could only be given by a dog fancier and there is no evidence to show that the petitioner or his predecessor-in title who got the mark registered was a dog fancier, nor is there any evidence to show that a common consumer of the petitioner's bidis is a dog fancier so as to distinguish between different kinds of dogs. It may be noted that a Bull Dog or a St. Bernard Dog is not a breed of this country. It is an imported animal and the people in this country, illiterate as they are and not claiming to be dog fanciers in any sense of the term, cannot be expected to distinguish between one kind of dog and another. Besides, accustomed as the consumers are to buy and smoke what is known to them as "Bull Dog" bidis, they are seldom expected to look into the design of the dog on the mark and try to find out as to whether the device is really the device of a "Bull Dog" or not. In these

circumstances, I do not think that the Deputy Registrar was at all right in making the order deleting the word "Bull" from the caption "Bull Dog" appearing on the device of the petitioner. My attention in this connection was drawn by Mr. Shavaksha to the observations of Shah, J. in *James Chadwick and Bros. Ltd. Vs. The National Sewing Thread Co. Ltd.*, :

"Apart from the alleged resemblance with the mark of the respondents both visual and phonetic (which I have held that the mark does not heart which might have caused deception or confusion. I fail to see what deception or confusion the misdescription of the bud in the mark may cause. It is true that the Registrar is concerned with maintaining purity of trade practices and is entitled to prevent fraudulent exploitation of characteristics of associations of well-known objects, persons, institutions, creatures or things; but in my judgment it is no part of his duty to insist that an imprint of an object shall strictly correspond with the accepted or recognised characteristics of the object it purports to represent, and a variation from that standard will be a ground for rejection of a proposed trade mark."

That was a case in which a picture of a bird was named "Vulture" and it was contended that the design was really not of a vulture but of an eagle. The learned Judge found on comparison between the marks of the petitioners and the respondents that there was a good deal of similarity between the marks and having found that, the learned Judge observed that whether the bird so represented was called an eagle, or a kite or a vulture or a combined representation of different characteristics of all the three, he could not see how public interest, or public order, or public decency, or public morality was going to suffer thereby. These observations of the learned Judge were noted by the Court of Appeal in that case, but the Court of Appeal did not express any opinion on those observations holding as they did that there was a good deal of similarity between the marks of the petitioners and the respondents. Apart from these observations, however, to me, it is clear that so long as the device of the petitioner showed a Dog it did not matter at all what kind of Dog it was expressed to be and the misdescription in that behalf, if any, in my opinion, is not likely to deceive or cause confusion in the minds of the consumers within, the meaning of Section 11(a) of the Act of 1958.

16a. Mr. Baptista, however, relied upon Clause (c) of Section 11 of the Act and urged that the petitioner's mark was one "which would otherwise be disentitled to protection in a Court". Speaking for myself, I do not see how the petitioner is disentitled to protection in a Court by reason of the alleged misdescription of the petitioner's device. For all these reasons, I am of the opinion that the order passed by the Deputy Registrar for rectification of the Register by deleting the word "Bull" from the caption "Bull Dog" appearing on the petitioner's device should be set aside and the application for rectification filed by the respondents should be dismissed with costs.

17. As regards the cross-objections filed by the respondents in respect of the

findings of the Deputy Registrar recorded against them, Mr. Mistree, the learned counsel for the respondents, urged that the Deputy Registrar was in error in not expunging the petitioner's mark from the Register and the reason that he stated was that the respondents' marks were registered prior to that of the petitioner. The Deputy Registrar has considered this point in detail and come to the conclusion that there was abundant evidence on record to show that the petitioner's mark was very much prior in use to the respondents' marks and that, therefore, although the respondents' marks happened to be registered earlier than the petitioner's mark, the respondents could not really be said to have been aggrieved by the registration of the petitioner's mark. The Deputy Registrar has also held, and in my opinion quite rightly that the registration of the petitioner's mark would be justified also u/s 12 of the Act on the ground of concurrent user. Accordingly, there is no force in the contention urged by Mr. Misters and the Deputy Registrar was perfectly right in rejecting the respondents' contention in that behalf. No other points were seriously urged by Mr. Misters in support of the respondents' cross-objections and, therefore, the cross-objections shall also stand dismissed with costs.

18. The result is, the petition is allowed with costs and the cross-objections of the respondents are dismissed with costs. The Registrar to bear his own costs both of the petition as well as the cross-objections.

19. Petition allowed.