

(1972) 01 CAL CK 0018
In the Calcutta High Court

Case No : Appeal No. 191 of 1968 and Matter No. 682 of 1968

Prem Nath Mayer

APPELLANT

Vs

Registrar of Trade Marks and Another

RESPONDENT

Date of Decision : 28-01-1972

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Section 100

Trade and Merchandise Marks Act, 1958 — Section 109(5), 11, 12

Citation : AIR 1972 Cal 261 : 76 CWN 459

Hon'ble Judges : B.C. Mitra, J;Ajay K. Basu, J

Bench : Division Bench

Advocate : I.P. Mukherjee and D.P. Mukherji, for the Appellant; A.C. Roy and Amal Kumar Roy, for the Respondent

Final Decision : Allowed

Judgement

B.C. Mitra, J.—On April 28, 1960 the second respondent filed an application for registration, in Part A of the Register, of a trade mark consisting of a label containing the image of a Goddess seated on a Lion and the words "Ma Durga Brand in class V., "in respect of agricultural implements specially for chaffcutter blades". The application was thereafter advertised in the Trade Mark Journal. The application for registration was opposed by the appellant, and the opposition was based on the provisions in Sections 11 and 12(1) of the Trade and Merchandise Marks Act, 1958, (hereinafter referred to as the Act). The appellants in their opposition claimed that they were the prior users of a trade mark, which was duly registered, under the provisions of the Act being trade mark No. 12301 registered in Class VII in respect of, inter alia, "Chaffcutter Blades and Knives". The substance of the appellant's contention in the opposition to the registration of "Ma Durga Brand" with the device mentioned above, was that the mark proposed to be registered, resembled the registered trade mark of the appellant and such resemblance would lead to confusion and deception. This part of the opposition is based on Section 12(1) of the Act which runs as follows:

"Save as provided in Sub-section (3) no trade mark shall be registered in respect of any goods or description of goods which is identical with or deceptively similar to a trade mark which is already registered in the name of a different proprietor in respect of the same goods or description of goods."

The second branch of the opposition is founded on Section 11(a) of the Act which is as follows:

"A Mark-

(a) the use of which would be likely to deceive or cause confusion,

XX XX XX

shall not be registered as a trade mark."

2. By an order dated November 7, 1964, the Deputy Registrar of Trade Marks dismissed the appellant's opposition. Being aggrieved by the Deputy Registrar's order the appellant preferred an appeal to this Court u/s 109 of the Act. This appeal was dismissed by a judgment and order dated April 24, 1968, against which this appeal has been preferred.

3. The foundation and basis of the bar imposed by Section 11 in the Act, against registration of certain marks, is the acquisition of a reputation by other users of similar marks, to such an extent that the registration of the mark of the applicant would be likely to deceive or cause confusion. In other words, if the Registrar is satisfied that a mark proposed to be registered would deceive or confuse a buyer in the market, because there are similar marks in use by persons who have acquired a reputation with regard to such marks, the Registrar would decline to register the mark.

4. The first question that arises is on whom does the onus lie to prove that the use of the mark would not deceive or cause confusion? Does the onus lie upon the applicant who has made the proposal for registration of the mark? Or does it lie upon the party who has given notice of opposition to the registration of the mark? The provisions in Section 11 of the Act are *pari materia* with Section 11 of the English Trade Marks Act, 1938, which is as follows:--

"11.-- It shall not be lawful to register as a trade mark or part of a trade mark in matter the use of which would, . by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a Court of Justice, or would be contrary to law or morality or any scandalous design."

5. The English Courts have held that the onus of proving that the use of a mark would not deceive or cause confusion lies on the applicant. In Kerly's 9th Ed. P. 448 the law is stated to be as follows: "In such cases the onus is on the applicant to satisfy the Registrar that the Trade Mark applied for, is not reasonably likely to deceive or cause confusion, so that refusal to register does not involve the conclusion that the resemblance is such that either an infringement action or a passing-off would succeed." Relying upon these observations in the text book

and also on several decisions of the English Courts, and also of the Courts in India, to which I will presently refer, Mr. I. P-Mukherjee, Counsel for the appellant contended that the onus is entirely on the applicant to prove that the registration of his mark would not lead to deception or confusion. In support of this contention reliance was placed by Counsel for the appellant on a decision of the Supreme Court *Amritdhara Pharmacy Vs. Satyadeo Gupta*, . In that case an application was made for registration of a trade name of a medicinal preparation known as "Lakshmandhara". The applicant claimed that the mark known by that name was distinctive to the article, and that there was turnover of a large sum of money. Opposition was filed by a company known as Amritdhara Pharmacy Ltd. It was contended by the opponent that the word "Amritdhara" was already registered as a trade name for medicinal preparation which had been introduced as early as 1901. The contention of the applicant was that the two names "Amritdhara" and "Lakshmandhara" were distinctively different, and no one could pass off one for the other. The Registrar allowed the registration of the applicant's name, but for the State of Uttar Pradesh only. Appeals were preferred against the decision of the Registrar. The Allahabad High Court held that there was no possibility of confusion and deception, and there was no justification for refusal to register the trade mark "Lakshmandhara" for the whole of India. Against this decision, an appeal was taken to the Supreme Court, Dealing with the question of onus, the Supreme Court held in paragraph 7 of the Report, that on an application to register, the Registrar or an opponent might object that the trade mark was not registrable and in such cases, the onus was on the applicant to satisfy the Registrar that the trade mark applied for, was not likely to deceive or cause confusion. It was also held that where it was thought that there was doubt as to whether deception was likely, the application should be rejected. Dealing with the question of deception and resemblance it was held in paragraph 9 of the Report: "we agree that the use of the word "Dhara" which literally means "current or stream" is not by itself decisive of the matter. What we have to consider here is the overall similarity of the composite words having regard to the circumstances that the goods bearing the two names are medicinal preparations of the same description. We are aware that the admission of a mark is not to be refused, because unusually stupid people, "fools or idiots", may be deceived. A critical comparison of the two names may disclose some points of difference but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name. The trade mark is the whole thing -- the whole word is to be considered." I shall deal with the question of deception or confusion later, but on the question of onus It seems to me that the view of the Supreme Court was that the onus of proof that registration would not lead to deception or confusion, was on the applicant for registration.

6. Let us now test the contention that the onus lies on the opponent and not on

the applicant. Supposing in a case there is no opposition at all either from the owner of a registered mark or from the user of a similar mark which is not registered. In such a case, when considering the application what is the Registrar to do? The requirement of Section 11 of the Act is mandatory in nature. The Registrar may himself raise an objection to registration and if he does, who is to prove that there would be no deception or confusion? As the Registrar has to be satisfied that the mark would not deceive or confuse, he has to be satisfied that such would not be the result if the mark is registered. In such a case the applicant must prove that the applicant's goods when marketed with the mark proposed to be registered, would not lead to deception or confusion among buyers. Supposing again the Registrar does not raise any objection on his own, even then, the mandatory provisions of Section 11 prohibits the Registrar from registering a mark, the use of which would be likely to deceive or cause confusion. The Registrar has to be satisfied on these two points, and such satisfaction can be obtained only when the applicant proves by such evidence as he can tender, that deception or confusion would not be the result of marketing the goods with the proposed registered mark. Looked at either way it seems to us the onus, so far as Section 11(a) is concerned is upon the applicant for registration.

7. The question of onus also came up for consideration before a Division Bench of the Bombay High Court in *James Chadwick and Bros. Ltd. Vs. The National Sewing Thread Co. Ltd.*, . In that case an application was made for registration of a mark in connection with cotton sewing thread. Opposition was filed and the Registrar came to the conclusion that as the mark sought to be registered was likely to deceive and cause confusion, registration was refused. An appeal was preferred to the High Court and the trial Court came to the conclusion that the mark ought to be registered. From this decision an appeal was preferred to the Division Bench. Dealing with Section 10 of the Trade Marks Act, 1940, which corresponds to Section 11 of the Act with which we are concerned, the Division Bench held that the burden of proving that the trade mark sought to be registered was not likely to deceive or cause confusion, was upon the applicant and it was for him to satisfy the Registrar that his trade mark did not fall within the provisions of Section 8 or 10 and therefore it should be registered. This decision went up in an appeal to the Supreme Court. The decision of the Supreme Court is in *National Sewing Thread Co. Ltd. Vs. James Chadwick and Bros. Ltd. (J. and P. Coats Ltd., Assignee)*, . The Supreme Court upheld the decision of the Division Bench of the Bombay High Court and in dealing with the question of onus, held in paragraph 22 of the Report that the burden of proving that the trade mark which a person sought to register was not likely to deceive or cause confusion was upon the applicant. The English decisions also adhere to the view that in an application for registration of a new mark, the onus is on the applicant to prove that the mark proposed to be registered is not likely to deceive or confuse. Reliance was placed by Mr. Mukherjee on in the matter of an Application by *Smith, Hayden & Co. Ltd.* (1946) 63 RPC 97. In that case

Evershed J., held that the onus lay upon the applicant for registration to satisfy the Court that a negative answer should be given to both questions.

8. This trial Court, however, came to the conclusion that the provisions in the Trade and Merchandise Marks Act, 1958 and the Rules thereunder, show that the onus shifts from one person to the other. We have carefully considered the relevant Rules, and we have compared them with the Rules under the English Act. We find that the Rules under the Indian Act are substantially the same as those under the English Act. In the view of the trial Court, although Rules 37 to 43 indicate that the preliminary onus lies upon the applicant, Rules 51 to 55 indicate that the onus shifts to the opposer to support his grounds of opposition by evidence. Rules 51, 52, 53, 54 and 55 of the Indian Rules correspond to Rules 46, 47, 48, 49 50 and 51 of the English Rules. The English decisions in laying down that the onus lies on the applicant have construed the English Rules and came to the conclusion that it was for the applicant to prove that there would be no deception or confusion if a trade mark was registered.

9. Turning now to Rules 51 to 55 of the Indian Rules, let us see if there is any indication of shifting of onus from applicant to the opposer. Rule 51 deals with notice of opposition and prescribes what is to be included in such notice. Rule 52 deals with counter statement required by Section 21(2) of the Act. Rule 53 deals with the evidence in support of opposition. It says that within two months from the service of a copy of counter-statement upon him, the opponent shall file with the Registrar such evidence by way of Affidavit as he may desire to adduce in support of his opposition. R. 54 deals with the evidence in support of an application and says that within two months from the receipt by the applicant of the Affidavit in support of the opposition, or of intimation that the opponent does not desire to adduce any evidence, the applicant shall leave with the Registrar such evidence by Affidavit as he desires to adduce in support of his application. R. 55 deals with the evidence in reply by the opponent and says that within a month of receipt by the opponent of copies of the applicant's affidavit, the opponent may leave with the Registrar evidence by affidavit-in-reply. These are the relevant Rules which were considered by the Trial Court and which are to be considered by us in determining if there is any indication that the onus shifts from the applicant to the opponent at any stage. As I read the Rules I see nothing therein to justify the conclusion that the onus shifts from the applicant to the opponent at any stage. On the contrary, the indication in Rule 54 is clear, that the onus lies upon the applicant because that rule says that even if the opponent does not file any affidavit to adduce evidence in support of the opposition, the applicant has to file within two months from the receipt of copies of the affidavits in support of the opposition, such evidence by way of affidavits as he desires to adduce in support of his application. This Rule, in my view, makes it clear that even if the opponent is unable or unwilling to adduce any evidence by Affidavit in support of his opposition, the applicant must file his evidence by Affidavit in support of the application. The Rules therefore do not enjoin a shifting of the onus from the applicant to the opponent at any stage of

the proceedings. The onus of proving, that the mark if registered, will not lead to confusion or deception, is squarely upon the applicant. Furthermore, the question as to on whom the onus lies, has been settled and set at rest by the Supreme Court in the two decisions mentioned earlier, and I do not think it can now be held that the onus lies upon the opponent and that it shifts from the applicant to the opponent at any stage of the proceedings.

10. There is one other decision on the question of onus to be referred to before I proceed to consider the evidence produced by the second respondent in support of his application. That is a decision of the English Court of Appeal *Orr Ewing & Co. v. R. Johnston & Co.*, (1880) 13 Ch D 434. That was an action to restrain the defendants from imitating the plaintiff's trade mark. The plaintiffs were merchants of Turkey red yarn, the business consisting chiefly in the dyeing and exporting of yarn and other fabrics to various countries. Besides selling goods to merchants they exported goods to their own agents in India. Amongst other marks the notable mark on the wrapper of the yarn exported was a golden Crown on each side of which was golden elephant with its head turned away from the Crown. The defendants were also general merchants and exported to India Turkey red yarn. They used a ticket on the outside wrapper of the yarn, on which was printed in gold the figure of the Goddess Minerva and a tiger. The Goddess had in one of her hands a shield on which the figure of Ganapatty was printed. There were also two golden elephants and a golden banner. The two elephants were placed on each side of Ganapatty with their heads turned towards Ganapatty. The plaintiffs had applied for registration of their two-elephants ticket but their application was refused. The evidence showed that the plaintiff's yarn had become known in the Bombay market as "The Hathi". The evidence also showed that the defendants' ticket would not deceive the merchants in Bombay who purchased plaintiffs' yarn. Fry J., in the trial Court held that the defendants had taken a large part of the plaintiffs' mark as the two elephants at the top corners of the plaintiff's ticket were repeated in the top corner of the defendants' ticket. On the question of onus it was held that it was for the defendants to prove that their ticket would not deceive purchasers into the belief that their goods were the goods of the plaintiffs. It was further held that in a case where a party had taken a substantial part of another man's tickets or marks, the onus was upon him to prove that there would be no deception. An appeal was taken to the Court of Appeal from this judgment. The Court of Appeal affirmed the judgment of Fry J. Dealing with the question of onus, Cotton L. J., observed at P. 463 of the report: "Where the addition to the ticket is shown to be such as is calculated to deceive, then a burden is thrown upon them of satisfactorily explaining how and why they made the particular addition. That, I think, is what Mr. Justice Fry meant -- not that in all cases where fraud is charged, or in a case of this sort, the burden of proof is not on the plaintiff to make out his case, but that where the defendants do use under suspicious circumstances, a ticket which of itself is calculated to deceive, then the burden of proof is thrown upon them to displace that prima facie evidence against them

and to show that in fact they were innocent in doing that which is not innocent, because it is calculated to deceive." I shall refer to this decision at greater length in dealing with the question of deceptive similarity u/s 12(1) of the Act.

11. I shall now proceed to consider the evidence produced by the second respondent in support of his application for registration to see if he had discharged the onus which lay upon him. The Registrar noted that a Bill Book was produced by the respondent containing the Carbon copy of Bill No. 224/16 of January 25, 1960. Keeping in mind the fact that the application was made on April 18, 1960, it should be seen that this Bill was the only evidence of sale of the respondent's goods and the Registrar came to the conclusion that the respondent's mark was in use prior to the date of his application. Copies of several other Bills, however, were filed with the Registrar but excepting for the one, mentioned above, all of them relate to a period subsequent to the application for registration.

12. In addition to the Bills which were produced by the second respondent in support of his application for registration, he relied on several Affidavits to which I will now refer. The first of these is an affidavit of Bhagwati Prashad dated December 1, 1962. He is the proprietor of a firm of Commission Agents. He says in paragraph 3 of the affidavit that chaff-cutter blades manufactured by the second respondent were handled by his firm from 1959. He does not say how many chaff-cutter blades his firm handled and on what dates. In paragraph 4 he says that chaff-cutter blades bearing the name "Ma Durga Brand" are very popular, and in paragraph 5 he says that customers ask for these blades by that name. He is significantly silent about the names and number of customers who had asked for these blades by that name. In paragraph 6 he says that he received no report of confusion among customers, between the chaff-cutter blades bearing the mark "Ma Durga Brand" and "Lion Brand". This is a strange statement because the deponent does not say that he had dealt, in course of his business, with the blades bearing mark "Lion Brand". The question of confusion can arise only if one deals with the blades bearing the two different marks.

13. The next affidavit is that of Kanhayalal Gupta dated December 8, 1962. He is a trader dealing in hardware goods and had dealings with the firm of the second respondent. He sells chaff-cutter blades manufactured by the second respondent. According to him the blades bearing the mark "Ma Durga Brand" are popular in the market and customers prefer the goods, known as "Ma Durga Brand Chaff-cutters." In paragraph 6 he says that he had not received from his customers any report of confusion between the goods of the appellant and the second respondent. Here again the deponent does not say that he has dealt with the goods of the appellant. For that reason he is hardly competent to give any views on confusion among purchasers of chaff-cutter blades. This deponent again says nothing about the number of blades of the second respondent that he has dealt with or disposed of in course of his business, nor the dates of the transactions.

14. The third affidavit is by Brij Krishna Das dated December 6, 1962. He is the

agent of a concern which deals in chaff-cutter blades in Bhagalpur. He says that blades bearing the mark "Ma Durga Brand", manufactured by the second respondent were sold by him and that such blades are popular among Kisans in Bihar. He says nothing about the number of blades of the second respondent that he sold, nor the dates when such sales took place. He goes on to say that the purchasers of chaff-cutter blades do not commit mistakes in the purchase of blades bearing the mark "Ma Durga Brand" and the blades bearing the mark "Lion Brand."

15. The probative value of the three affidavits is altogether insignificant" None of the deponents said that he had ever seen the blades manufactured by the appellant and bearing the trade mark "Lion Brand". Nor have they said that in course of their trade they have dealt with these blades or have even heard of or seen such blades. The evidence in the affidavits, such as they are is in my view altogether useless for the purpose of establishing that the use of the mark "Ma Durga Brand" would not lead to confusion or deception.

16. In my view the second respondent has wholly failed to discharge the onus that the registration of his proposed mark would not lead to deception or confusion as contemplated by Section 11(a) of the Act. The onus of proving that there would be no deception or confusion if his mark was registered, was on the second respondent and on him alone. In our view, he has failed to discharge that onus and such failure debars his claim to registration of his mark u/s 11(a) of the Act. This conclusion would have been enough to dispose of this appeal but we shall now proceed to consider the question of deceptive similarity between the two marks so as to attract the provisions of Section 12(1) of the Act.

17. Section 12(1) of the Act prohibits registration of a mark which is identical with or deceptively similar to a mark which is already registered. The appellant's trade mark is a registered trade mark, and this registration, upon renewal from time to time, is still continuing and is in force. It is in this background that the question of deception has to be examined. The first thing to be borne in mind in considering this question, is the possibility of a purchaser being misled into believing that the second respondent's chaff-cutter is that of the appellant's manufacture. We have to consider, if it is likely that a purchaser who wants the "Lion Brand" chaff-cutter of the appellant would be deceived by the lion mark on the second respondent's chaff-cutter or whether the image of the Goddess is such as to caution him that he was not getting what he wanted, namely a chaff-cutter of the appellant's manufacture. A comparison of the two marks, emphasis on the difference between the two, emphasis on the lack of similarity, emphasis on the difference in the combination of words which describe the marks and a visual comparison of the two marks, are not, in our view, the proper approach in deciding a question such as this. The matter to be looked into is the impact on the mind of the purchaser, when he is offered a chaff-cutter bearing the second respondent's mark with the image of a lion and a Goddess seated upon it and the words "Ma Durga Brand" written thereunder.

18. Mr. I. P. Mukherjee, counsel for the appellant contended that it was for the Court to decide the question of deception upon examination of the two marks. He argued that the purchasers of chaff-cutters are not educated persons who could notice the difference between the words "Lion Brand" and "Ma Durga Brand", but would go by the mark as it appeared on the chaff-cutter. The impression that such a person would get, counsel contended, was that he was getting a chaff-cutter bearing the mark of a lion, and that was all he wanted. In support of this contention reliance was placed by counsel for the appellant on a number of decisions which I now proceed to discuss.

19. The first of the decisions on which the counsel for the appellant relied was (1880) 13 Ch D 434 (supra), to which I have referred earlier in another connection. In the trial Court Fry, J. held, while discussing the question of deception, that the matter to be looked into was whether one of the - parties had taken a material and substantial part of the other party's mark. In that case, it is to be remembered, the defendant's mark had two elephants, with the image of Ganapatty printed in gold in between the two elephants. The plaintiff had also two elephants in his mark but instead of the image of the Ganapatty, the plaintiff had a Crown between the two elephants. In these facts Fry, J. held, that upon looking at the two marks a large part of the plaintiff's mark which impressed the eye had been taken by the defendant, and that this mark of two-elephants was a significant mark and further that the image of Ganapatty instead of a crown in the defendants' mark made no difference. In that case also it is to be noticed, there was significant difference, as in the one case there was a Crown, and in the other the imago of the God Ganapatty, the plaintiff's mark had no "Howdahs" on the back of the elephants while the defendants' mark had them, and further that the trunks in the two marks were turned in different directions. It was held that it was the mark of the elephant which impressed the eye with a considerable amount of similarity. This decision went up in an appeal and the Court of Appeal affirmed the judgment of Fry, J. In affirming the judgment the observations of James L. J. at P. 453 of the report are significant: "Now, what would have been the only motive which can be suggested to a man of the world by a man of the world of the defendants in doing that, but to do something which was likely to be mistaken for the plaintiff's goods, which would be accepted by the customers of the man who had been in the habit of selling them as being a continuation of the same goods which he had been in the habit of supplying to them? It is not necessary for this case to decide that a man actually intended to tell a lie, or that a lie has been told. It is sufficient in the language of Lord Kingsdown, that a man who wilfully used a part of the trade mark of his neighbour, that part so used being by the user of it, calculated to enable his goods to be passed off for the goods of his neighbour. I am of opinion, independently of the mass of evidence which has been given in support of that probability, that it was probable and probable almost to a certainty that the new ticket of the defendant should tend to enable anybody so minded to represent those goods as being the goods of the same character, proceeding from the same manufacturer, as the goods which

have been formerly accepted with confidence under the mark which was a guarantee of the plaintiff's goods." The observations of Cotton, L. J., at P. 461 of the report may also be usefully quoted: "I am satisfied that very few purchasers who asked for "Two Elephants" yarn would not be misled when the parcel was produced to them having this ticket with the two elephants at the end of it. We must, in dealing with questions of this kind, not look for minute difference, or even that which appears when one hearing the case argued thoroughly with a mind directed to the particular difference, in some respect a substantial difference, but we must see what would be the effect upon the mind of the general class of buyers." Again, at P. 463 of the report it was observed: "Therefore, if we are called upon to give a judgment upon it, although, in my opinion, it is not necessary, I could not arrive at the conclusion that this particular form of ticket was arrived at bona fide by or on behalf of the defendants or without any intention of deception, but I should have said that it was done with the intention of getting for themselves by the ticket the credit which the plaintiffs had acquired in the market."

20. The decision of the Court of Appeal in *Orr Ewing and Co.*'s case, (1880) 13 Ch D 434 (supra) went up in appeal to the House of Lords and the decision of the latter is reported in (1882) 7 AC 219. The House of Lords affirmed the decision of the Court of Appeal and held that no trader had a right to use a trade mark so nearly resembling that of another trader as to be calculated to mislead incautious purchasers. One important observation of Lord Selborne, L. C., dealing with the question of modification of a trade mark to avoid confusion, may be noticed. It was held that the variations made in the infringing trade mark might not unreasonably be supposed to have been made by the owners of the trade mark themselves for reasons of their own. This dictum, in our view, is a very pertinent and significant one in deciding questions of confusion and deception likely to be caused to an unwary purchaser.

21. On this question I should refer back to the Bench decision of the Bombay High Court *James Chadwick and Bros. Ltd. Vs. The National Sewing Thread Co. Ltd.*, . In that case the appellants were using two registered trade marks for over 50 years; one of the trade marks bore the name "Eagley Sewing Machine Thread". This trade mark had the representation of an eagle. The other trade mark was a mere representation of an eagle without any writing. The goods which were sold under these two marks were known and asked for as "Eagley" or "Eagle". The respondents had used the trade mark which they sought to register in 1943 for about 2 years and they had been selling their goods under that mark. The respondent's mark was the representation of a bird of prey and bore the name "Peerless Quality Vulture Brand Reel Thread". It appeared from the evidence that for the 2 years that the respondents used this mark, they called it "Eagle Brand" and while applying for registration they changed the name from "Eagle Brand" to "Vulture Brand". Dealing with the question of confusion, because of similarity of the two marks, it was held that the Registrar had to come to a conclusion independently of any comparison with any registered trade mark. It

should be noticed that the Court was considering the provisions in Section 8 of the Trade Marks Act, 1940, which corresponds to Section 11 of the Trade and Merchandise Act, 1958. It was also held that what the Registrar had to decide was whether looking at all the circumstances of the case, the particular trade mark was likely to deceive or to cause confusion. Proceeding further to deal with the question of confusion Chagla, C. J. held that what was important was to find out what was the distinguishing or the essential feature of the trade mark already registered, and what was the main feature underlying the trade mark and if it was found that the trade mark whose registration was sought, contained the same distinguishing or essential feature or conveyed the same ideas, then the Registrar would be right if he came to the conclusion that the trade mark ought not to be registered. On the question of confusion among purchasers it was held at Pp. 152-153 of the Report: "The real question is as to how a purchaser, who must be looked upon as an average man of ordinary intelligence, would react to a particular trade mark, what association he would form by looking at the trade mark, and in what respect he would connect the trade mark with the goods which he would be purchasing. It is impossible to accept that a man looking at a trade mark would take in every single feature of the trade mark. The question would be, what would he normally retain in his mind after looking at the trade mark? What would be the salient feature of the trade mark which in future would lead him to associate the particular goods with that trade mark? Relying upon these observations, counsel for the appellant contended, and we think rightly, that the essential feature in the registered trade mark of the appellant in this case was the device of a Lion and the idea that is conveyed to a prospective purchaser is the symbol of the Lion. It is the concept or idea of a Lion that is carried in his mind by an average purchaser of ordinary intelligence. The use of the same mark of a Lion in the respondent's trade mark proposed to be registered, would undoubtedly lead to confusion in the mind of a purchaser.

22. The Division Bench of the Bombay High Court thereafter proceeded to consider the evidence in order to find out if the registration of the mark of the respondent in that case would lead to confusion. It was found that it was on record that the goods sold under the trade mark were well-known and commonly asked for as "Eagley" or "Eagle". The Division Bench, upon examination of the evidence, disagreed with the conclusion of the trial Court, which came to the conclusion that the points of difference were so numerous, and the points of similarity so few, that there was no such resemblance as was likely to cause confusion. Chagla, C. J. held that what the learned Judge was to do was not to keep the two trade marks before him, and find out how they differed and how little they resembled, but that he should have decided for himself what was the distinguishing or essential feature of the appellant's trade mark, and then looking at the respondent's trade mark decide for himself whether there was any resemblance in the trade mark of the respondent to that distinguishing or essential feature. The conclusion of the trial Court based on the evidence that the Bird appearing in the respondent's trade mark was different in its posture, in

its poise and the position of its head and in the spreading of its wines from that of the appellant's, was also criticized and rejected. It was further held that in a case where only one party sold a class of goods under a particular trade name, instead of several parties dealing in the same class of goods under similar marks any attempt to sell the goods under a trade mark which fix in the mind of the purchaser the association of a particular mark, would not be justified. We respectfully agree with the views of the Division Bench of the Bombay High Court and also the observations relating to the question of confusion arising out of similar trade marks. A question of confusion or deception in our view, cannot be decided by comparing the two marks by keeping them side by side and noting the similarities and differences between the two marks. Such a question is to be decided by the Court itself by the impression which is to be gathered by looking at the two marks, and it is the duty of the Court to find out what impression, what association of ideas and what significant feature the purchaser of an object bearing the registered trade mark would carry in his mind. A meticulous scrutiny of the similarities and differences in the two marks is hardly likely to be of any assistance in coming to a conclusion if the new mark proposed to be registered would create confusion or would lead to deception. The question of deceptive similarity of the two marks has to be answered by looking at the two marks, and then deciding if the association of ideas that would be formed in the mind would deceive or confuse, not when two objects bearing the two different marks are produced before a purchaser, but when one object bearing the new mark proposed to be registered is produced before him. This, in our view, is the correct and only method of approach to be applied in deciding a question of confusion and deception.

23. The decision of the Division Bench of the Bombay High Court, mentioned above, went up in an appeal to the Supreme Court and was upheld and approved. The decision of the Supreme Court is reported in *National Sewing Thread Co. Ltd. Vs. James Chadwick and Bros. Ltd. (J. and P. Coats Ltd., Assignee)*, . In dealing with the question of the duty of the Court in deciding questions of confusion, it was held at P. 363 of the Report: "Moreover, in deciding whether a particular trade mark is likely to deceive or cause confusion, that duty is not discharged by arriving at the result by merely comparing it with the trade mark which is already registered and whose proprietor is offering opposition to the registration of the mark. The real question to decide in such cases is to see as to how a purchaser who must be looked upon as an average man of ordinary intelligence, would react to a particular trade mark, what association he would form by looking at the trade mark, and in what respect he would connect the trade mark with the goods which he would be purchasing." Similar observations were also made by a Division Bench of the Bombay High Court in *Ciba Ltd. v. M. Ramalingam*, AIR 1058 Bom 56. In that case it was again held that it was not for a witness to tell the Court whether there was likelihood of deception and that the Court could not abdicate its function which was to decide, on looking at the two trade marks and in considering whether they resembled each other and whether

there was likelihood of deception. It was further held that if the resemblance between two marks was clear, it was the duty of the Court to remove from registration the mark which was likely to cause deception.

24. In our view, it is for the Court to decide upon looking at the two marks, whether the second respondent's mark is likely to deceive a purchaser of average intelligence. It is to be borne in mind, that such a purchaser is not likely to have the appellant's mark before him, when he is offered a chaff-cutter bearing the respondent's mark of a Lion with a Goddess seated upon it. It is true that phonetically the words written under the appellant's mark and those written under the respondent's mark are altogether different. But in judging a question of deception and confusion, it should not be overlooked that a purchaser of goods such as this may not necessarily be a literate person, able to read and write. In all probability he would go by the marks as they appear on the merchandise. We have had the advantage of looking at the marks as they appear on the two chaff-cutters manufactured by the parties. These two chaff-cutters were produced before this Court upon an order obtained under Order 41, Rule 27 of the Civil Procedure Code. The appellate Court felt and we think rightly, that the question such as this, could not be decided by the Court without looking at the marks as they appeared on the merchandise, and by merely looking at the photographic prints of such marks as printed in the Paper Book. That order was made by a Bench of which I was a member and the order was made because it was felt that in deciding the question of confusion and deception, in an application for registration of a trade mark, the best evidence would be the marks themselves as they appeared on the merchandise of the registered proprietor and also on that of the applicant for registration.

25. Counsel for the appellant next relied upon the decision in *Re: Dunn's Trade Mark* (1889) 41 Ch D 439. In that case the respondent applied to register the words "Dunn's Fruit Salt Baking Powder" as a trade mark for Baking Powder. The appellant, who had for many years used the words "Fruit Salt" as his trade mark for use in producing an effervescing drink, opposed the application. Kay, J., in the trial Court, held that although the appellant had no monopoly in the use of the words "Fruit Salt", which were descriptive only, and not deceptive, yet under the circumstances they were calculated to deceive the public within the meaning of Section 73 of the Patents, Designs and Trade Marks Act, 1883, and that the trade mark ought not to be registered. The Court of Appeal reversed the decision of Kay J., on the ground that the words "Fruit Salt" were proposed to be used by the respondent for a totally different article namely, Baking Powder which did not interfere with the appellant's trade. This decision went up in an appeal to the House of Lords whose decision is reported in (1890) 15 AC 252. The majority of the House of Lords reversed the decision of the Court of Appeal and restored that of Kay, J., and in doing so, held that although the words "Fruit and Salt" were in common use in English language, and in combination they had no technical or scientific meaning, the use of the words "Fruit Salt" by the appellant for many years was a material circumstance in considering whether the use of those words

by the respondent would be calculated to mislead. It was held that the use of the words "Fruit Salt", although such use was made in connection with a different substance, namely Baking Powder there would be a supposed connection between the two articles in the mind of many persons who would naturally assume that the Baking Powder had been manufactured with the appellant's Fruit Salt and such persons would purchase the Baking Powder in that belief. Although this decision did not deal with the question of a mark or design but a combination of common English words, yet it throws light on the considerations to be taken into account in dealing with the question of confusion and deception. The next case relied upon by counsel for the appellant was in *Re: The Australian Wine Importers Ltd.* (1889) 41 Ch D 278. In that case an application was made for registration of a trade mark and this was objected to on the ground of its similarity to a trade mark already on the register. The trade mark already registered was for Spirits and it consisted of a representation of a Golden Fleece with the words "Golden Fleece" adding in one case the words "Old Jamaica Rum" and in another "Pure Old Scotch Whisky". The applicant wanted to register a mark, not for Spirits but for Wines and the proposed mark consisted of a Golden Fleece and the words "Golden Fleece, Australian Champagne, Sparkling Verdeillio". It was held that Wines were of the same description of goods as Spirits, and the registration of the trade mark was prohibited by the Act, and also that even if there was no such prohibition, the similarity of the marks was such, as having regard to the similarity of Wines and Spirits, to be calculated to induce the public to believe the goods of the registered owner to be of the applicant and in such circumstances, the Court ought not to direct the applicant's mark to be registered. In this case again, the trade mark consisted partly of a device and a combination of words and though the combination of words was very different, yet because of the similarity of the words and the device, registration was refused. Reliance was next placed by counsel for the appellant on another decision of the House of Lords in *Yorkshire Copper Works Ltd.*'s application (1954) 71 RPC 150. In that case an application for registration was made for registering the words "Yorkshire". It was contended by the applicant that the words "Yorkshire" had lost its geographical significance and had become distinctive of the applicant's mark. The application was refused by the Registrar. It was held that the application was rightly refused. I do not think, this decision is of any assistance to the appellant as the primary question before the House of Lords was whether a geographical name can become a distinctive mark so as to make it eligible for registration. The next case relied on by counsel for the appellant was *In the Matter of an application by William Henry Huxley* (1924) 41 RPC 423. In that case an application was made to register a trade mark consisting of 4 pictorial panels intended to represent the history of oil from the well to the consumer. One of the four panels depicted a ship. The application was opposed by a company who was the registered owner of several trade marks consisting of the picture of a ship, and also of a mark consisting of the words "Ship Brand". In holding that the proposed trade mark ought not to be registered, it was observed that although there might be persons who were

sufficiently intelligent and well-informed to grasp the significance of the grouping of four pictures in one mark, there might be others equally intelligent who might take a different view of what was presented. It was further held that the four pictures in the proposed trade mark were not combined in such a way as to take away from the picture of the ship, its own individual significance, and for that reason there was probability of confusion. This decision is of great importance so far as this appeal is concerned, because the proposed mark in that case consisted of four pictorial panels, only one of which was a ship. The opponent's registered mark consisted of only the picture of one ship, yet it was held that because there was possibility of confusion, the mark ought not to be registered. In this case, it is to be recalled [hat the proposed mark was the device of a Lion with a Goddess seated upon it and the registered mark of the appellant was a Lion with a banner above it. Mr. Mukherjee argued, and we think rightly, that if the mark consisting of 4 panels, only one of which was a ship, was refused registration because it might confuse with a registered trade mark which had the picture of one ship only it should be held that the respondent's mark ought not to be registered as it was bound to deceive and confuse.

26. On a careful consideration of the two marks we find that the main feature of the two marks is the figure or mark of the Lion. The appellant's mark is a Lion with a banner covering the entire length of its body, with its tail coiled and turned up. The respondent's mark is a Lion with a Goddess seated upon it. The image of the Goddess is by no means the image of the Goddess Durga. Anyone familiar with Hindu Mythology would at once see that the image as appearing on the Lion in the second respondent's mark has not ten hands, which is an indispensable feature of the image of the Goddess as is known all over India. As I see the image, it has two hands, with a discus in one hand, and a trident in another. Counsel for the respondent said that the image is that of the Goddess with four hands but all the four hands were not discernible to the eye. In any case, a Goddess is there, seated on a Lion with arms in her hands. To us, it seems that the main feature in the two marks is the figure of the Lion in both. It is to be remembered in this connection that the merchandise over which the marks are used are identical in nature namely, chaff-cutters. The question is, what is the association of ideas which a purchaser of average intellect will have in his mind when he goes into a store or shop to purchase a chaff-cutter of the appellant's manufacture? The only concept, and the only association of ideas that such a person would have in his mind, is the mark of a Lion. If, therefore, he is offered a chaff-cutter bearing the respondent's mark of a Lion with a Goddess seated upon it, would he be deceived? Would he be so confused in his mind as to think that the chaff-cutter with the mark of a Lion and a Goddess seated upon it, is the chaff-cutter of the appellant's manufacture? We think, yes. The purchaser, upon seeking the mark of a Lion on the chaff-cutter would, no doubt, be led into believing that it is a merchandise of the appellant s manufacture. He may, as well, think that the modification of the mark with the image of the Goddess seated upon the Lion is a modification which has been made by the appellant

himself. In the mark of the second respondent the dominant feature is a Lion with a coiled and turned-up tail. The figure of the Goddess is so small compared with the size of the Lion as to become almost insignificant. When a purchaser is offered a chaff-cutter of the second respondent's manufacture with the marks mentioned above, there is, every likelihood of his being deceived into believing that he was getting a chaff-cutter of the appellant's manufacture. He will not have the opportunity of comparing the two marks and finding out the difference between the two so as to be aware of the distinction.

27. I will now refer to the cases on which counsel for the respondent relied to repel the contention regarding confusion and deception. Mr. Roy relied upon a decision of the Judicial Committee in AIR 1940 86 (Privy Council) . In that case the appellants manufactured and sold cigarette and tobacco described as "Virginia Bird's Eye" smoked in pipes. These goods were sold in packets bearing a mark, the distinguishing feature of which was the representation of an elephant. The packets and tins of cigarettes bore the designation "Elephant Cigarettes", and on tobacco the representation of the elephant appeared in red. These goods were well-known and asked for as "Elephant Mark", "Hathi Markah" and "Lal Hathi". The defendants had been manufacturing and selling chewing tobacco for a long time and sold the same in packets and tins. The goods in the packet were intended for use with lime. Both packets and tins in which the chewing tobacco was sold bore the picture of an elephant. It was in these facts that it was held that there could be no monopoly use of a mark which was the representation of an animal or any other device, and no objection could be taken to the use of identical marks on different kinds of goods. This case is of no assistance to the respondent, firstly because it was not a case of registered trade mark, and secondly what is of greater importance, is that the marks were used in a different kind of goods, namely, chewing tobacco, which differed widely in appearance and use from cigarette and tobacco used in pipes. But this decision is important for another reason namely, that it affirmed the well-known principle that the test of comparison of marks side by side was not a sound one, since a purchaser would seldom have the two marks actually before him when he makes his purchase.

28. Before proceeding to refer to the other cases relied on by Mr. Roy, I should briefly notice his contention on the question of deception and confusion. It was argued that the animal in the respondent's mark was not a Lion at all, but was some other animal. Secondly, it was argued that the image of the Goddess Durga was the distinguishing feature in the mark proposed to be registered by the respondent. Thirdly, Mr. Roy said any purchaser who could read, would at once see that the respondent's mark with the writing "Ma Durga Brand" was altogether different from the appellant's mark "Lion Brand". In my view, none of these contentions has any merit. As for the animal, it is preposterous to suggest that the Goddess Durga would be seated on an animal other than a Lion. Anyone familiar with Hindu Mythology would be shocked, if told that the Goddess Durga was seated on an animal other than a Lion. Besides, visually the representation

of the animal in the mark is quite plainly that of a Lion. The second point about the Goddess Durga, being the distinguishing feature, seems to us to be equally without any substance. As I see the mark on the respondent's chaff-cutter, it is clear to me that the image of the Goddess above the Lion is insignificant compared to the figures of the Lion in the mark. The concept that catches the eye, as I see the respondent's mark is the figure of the Lion and not that of the Goddess seated above it. It is the animal which is the dominant feature in the respondent's mark and not the deity. The third point made by Mr. Roy about the writing under the rival marks seems to me to be equally without force. It cannot be assumed that in this country everyone who goes to purchase a chaff-cutter would be a literate person and would be able to distinguish between writing of the appellant and the respondent. It is true that some of the purchasers may be able to read the writing under the mark but it is equally true that a large number of them would either not be able to read, and even if able to read, would not care to read the writing under the mark in very small and illegible character.

29. To turn now to the other case relied on by Counsel for the respondent. Reliance was placed upon the decision of the Judicial Committee in AIR 1934 167 (Privy Council) . That was an action for infringement of trade mark and the ratio of the decision was that no finding of fraud could be made by a Court when there was neither any pleading nor any evidence to support a case of fraud. On the question of confusion in an action for infringement it was held that in the absence of evidence of actual confusion a strong case must be made out to justify conclusion that confusion would result, as a result of the infringement of the mark. We do not see, how this decision is of any assistance to the respondent. Reliance was next placed on a decision of this Court in *The Singer Manufacturing Co. Vs. The Registrar of Trade Marks and Another*, . In that case an application was made for registration of the name "sagar" to be used in sewing machines. Opposition was put forward by a company who used the name "Singer" in its sewing machines. It was held that there was no similarity between the words "Sagar" and "Singer" as the former was not deceptively similar to the latter. This decision again has no application to the facts in this case in which we are concerned with both a name and a mark, the device rather than the words being the dominant feature of the mark.

30. Mr. Roy next argued that as this appeal was a second appeal, this Court should not interfere with the finding of facts made by the Registrar and the trial Court. In support of this contention he relied on the decisions in *Kunj Bihari Thakur and Others Vs. Umashankar Prasad and Others*, and AIR 1961 Rom 147.

31. We cannot accept this contention of Counsel for the respondent. In dealing with this appeal this Court is not a Court of second appeal as contemplated by Section 100 of the Civil Procedure Code. The appeal which this Court is dealing with, is not from the judgment of Court subordinate to the High Court. The trial Court dealt with the appeal as a High Court u/s 109(2) of the Act and this Court is dealing with the appeal again as a High Court u/s 109(5) of the Act. Secondly,

u/s 109(6) of the Act, the High Court in dealing with an appeal, has all the powers of the Registrar and can make any order which the Registrar could make under the Act. Then again, in dealing with the question of deception and confusion u/s 11(a) of the Act and the question of deceptive similarity u/s 12 of the Act this Court must necessarily look into the evidence adduced by the parties in order to determine whether the bar created by Section 11 and Section 12 of the Act can be invoked by a party opposing registration of a trade mark.

32. In repelling the contention of Counsel for the respondent that the Court should not go into questions of fact in second appeal. Counsel for the appellant relied on a decision of the Judicial Committee in *Jogesh Chandra Roy v. Emdad Meah* AIR 1932 PC 28 in which it was held that finding of a fact based on the failure of a party to discharge the onus of proof which the first appellate Court wrongly held to be incumbent on him, was not a finding on positive evidence and was not binding in second appeal. Reliance was also placed on another decision of the Judicial Committee in AIR 1947 19 (Privy Council) .

33. We are unable to accept the respondent's contention that this Court in dealing with the appeal u/s 109(5) of the Act is a Court of second appeal u/s 100 of the Code of Civil Procedure, and for that reason, is unable to go into questions of fact. The provisions of the Act enjoin this Court to determine questions of deception, confusion and deceptive similarity, and that can only be done by taking into consideration the evidence tendered on behalf of the parties.

34. Counsel for the second respondent next sought to raise an altogether new point, namely that the respondent was an honest concurrent user of the appellant's registered trade mark, and as such the Registrar had jurisdiction u/s 12(3) of the Act to register the second respondent's proposed trade mark. We cannot accept this contention on behalf of the second respondent for more than one reason. In the first place, this point was not raised before the Registrar or before the Court below, and is now sought to be raised for the first time. The question of concurrent use is a question of fact and a case such as this, has to be pleaded and proved. In compliance with the elaborate provisions in the Act for filing affidavits in support of the application, in answer to the opposition and also in the affidavit evidence, the second respondent nowhere suggested, much less made out a case of concurrent user. Secondly, u/s 12(3) of the Act, in the case of an honest concurrent user, a mark can be registered, if in the opinion of the Registrar, it is proper to do so. The Registrar in this case has expressed no such opinion. Nor has the respondent filed any cross-objection against the Registrar's order. It is true that this Court has jurisdiction to make any order, which the Registrar could make, u/s 109(6) of the Act and in exercise of this jurisdiction this Court, in an appropriate case, can make an order on the ground of honest concurrent use. But such an order, in our view, cannot be made having "regard to the nature of the evidence such as it is, and also the case made out by the respondent before the Registrar and the Court below. Lastly, even if the second respondent was allowed to make out a case of honest concurrent use, the only

evidence of sale of the respondent's chaff-cutter, as noticed by the Registrar, was the sale of a single chaff-cutter as proved by Bill No. 224/16 of January 15, 1960. The other evidence of sale of the respondent's merchandise, namely the affidavits of the traders to which I have referred earlier, is of no assistance in coming to a conclusion regarding concurrent use of the mark by the respondent. The contentions of Counsel for the second respondent regarding honest concurrent use must therefore be rejected.

35. For the reasons mentioned above, this appeal succeeds and is allowed. The judgment and order of the Court below and also that of the Registrar are set aside. The Registrar is directed not to register the mark of the second respondent. The second respondent to pay to the appellant the costs of this appeal and also the costs of the Court below. Certified for two Counsel.

Ajay K. Basu, J.

36. I agree.