

(1994) 04 MAD CK 0037
In the Madras High Court
Case No : T.M.A. No. 4 of 1984

R.S. Kandasamy and others

APPELLANT

Vs

New Jothi Match Industries, Raghankottai

RESPONDENT

Date of Decision : 19-04-1994

Acts Referred:

Copyright Act, 1957 — Section 62

Trade and Merchandise Marks Act, 1958 — Section 105, 18(1), 2(1), 29

Citation : AIR 1995 Mad 73

Hon'ble Judges : Thangamani, J

Bench : Single Bench

Advocate : G. Thangapandian, for the Appellant; Md. Ibrahim, for the Respondent

Judgement

1. Parties herein are manufacturers of safety matches. As per the present respondent which is a partnership concern it is well known for the quality

and has got a wide market in upper India. It is marketing its product with the label written in Hindi as ""MANDAK"" and with FROG as symbol.

The said trade-mark is also registered with the Registrar of Trade Marks. The sales of the respondent picked up during 1981-83. The consumers

are mostly illiterate and when they demand the product they have in mind the colour and design of ""MANDAK"". After the sales picked up, with a

view to attract the consumers and to assure quality, the respondent firm introduced a colour design of special type. The firm designed and printed

its trade mark with a dark blue background and orange red border in a rectangular shape. The letter ""R"" was printed with a circle near the figure

Frog in order to assure the consumer that the label has been registered under the Act. The design and scheme of colour are the respondents' own

work of art. The first appellant is also in the same trade trying to capture the market of the respondent in upper India. He is selling his product as

MAGAR"" with crocodile design. The quality of this product is very inferior and it is being pushed into the market as though it is the product of the

respondent. The colour scheme and lay out adopted by the first appellant with the label ""MAGAR"" are a colourable imitation of the colour scheme

and design of the respondent. The in lay of "R" with reference to the figure crocodile is a clear limitation and fraud on the label of the respondent's

MANDAK"". The position, size and every detail in the label bearing the ""MAGAR"" and ""MANDAK"" and the back slips would reveal

infringement of very high order with a malicious motive of cutting into the respondent's trade. With the permission of the first appellant, other

appellants are using label on account of his unrestricted use. The appellants are illegally imitating and selling matches in similar bundles with a

deceptively similar colour mark to that of the respondent and this is in violation of the rights of the respondent. So the present respondent filed

T.M.O.P. No. 93 of 1984 in the District Court, Thirunelveli u/s 62 of the Copy Right Act and Section 105(c) of the Trade and Merchandise

Marks Act seeking permanent injunction restraining the appellants from manufacturing, selling and passing off the safety matches with the label

MAGAR"" with colour design as set out in the document appended to the petition and directing them to render a true and correct account which

they had illegally acquired by passing off their imitative ""MAGAR"" trade mark safety matches and directing them to pay the respondent the

ascertained illegal profits.

2. The appellants pleaded that the registered trade mark of the respondent has no limitation for its outline or design. The nature of the trade is such

that common label are used by various competitors with similar colours. There is striking dissimilarity between their labels and those of the

respondent. A bare look at them by an unknown illiterate purchaser would enable him to make out its distinctiveness. The label of the respondent

has got a frog in the centre and the name is given as ""MANDAK"" in Hindi. ground colour is dark in their label rather than in the respondents' label.

The letter ""R"" is also different is style in both the labels. In the appellants' label, there is a crocodile with its curved tail and open mouth. Every one

knows the difference between the frog and the crocodile. There is no phonetic similarity nor deceptive similarity of any nature. In order to coerce

the first appellant and strangle his business, the petition has been filed.

3. Learned District Judge found that the size of the label of the respondent and that of the first appellant are the same and hence the colour design

may cause confusion in the mind of an unwary purchaser. Though the animals in both the labels are different, the colour pattern used for them is the

same in both the labels. The frog in the respondents' label is in an upward leaping position. The crocodile in the first appellant's label is also raising

its head towards the leaping position. The upward leaping position of both the creatures for a casual observer of poor recollection and average

intelligence may cause confusion. There is a deceptive similarity in colour pattern and the letter "R" in circle printed therein and hence the impugned

match label of the first appellant is an infringement of the respondent's match label. Accordingly, he allowed the petition and granted permanent

injunction. However, he has observed that this injunction will not stand in the way of the first appellant changing the upward hand raising position of

the crocodile and the inverted tail position in hind portion and giving up the colour pattern and design adopted by him. The appellants were further

ordered to render accounts in respect of the sales of their products with "MAGAR" from 1-7-1983.

4. The respondents in the Court below have preferred this appeal assailing the said order.

5. Learned counsel for the appellants first submitted that the respondent is not entitled to maintain the action for the reason that on the date of the

petition, his registered trade mark was not renewed after the expiry of the initial period of 7 years on 15-12-1982 itself. However, during the

hearing of this appeal, learned counsel for the respondent has produced the order of renewal obtained on the expiry of the earlier period. So this

objection on the part of the appellants regarding the maintainability of the petition is untenable.

6. Trade mark means a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade

between the goods and some person having the right as proprietor to use the mark. A trade mark may be registered in respect of any or all of the

goods comprised in a prescribed class of goods. A trade mark may be limited wholly or in part to one or more specified colours. Any person

claiming to be the proprietor of trade mark used or proposed to be used by him, can get it registered u/s 18(1) of the Trade and Merchandise

Marks Act (Act 43 of 1958). u/s 28(1) of the said Act, the registration of a trade mark shall give him the exclusive right to the use of the trade

mark in relation to the goods in respect of which the trade mark is registered. u/s 29(1) of the Act, a registered trade mark is infringed by a

person who uses in the course of trade a mark which is identical with, or deceptively similar to the trade mark, in relation to any goods in respect

of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

7. The court below has extracted the guidelines prescribed by the Supreme Court in Parle Products (P) Ltd. Vs. J.P. and Co., Mysore, in

considering whether there is infringement of trade mark. In order to come to the conclusion whether one mark is deceptively similar to another, the

broad and essential features of the two are to be considered. The keeping of the infringed mark and the infringing mark side by side to find out the

difference in design is not necessary. In the view of the Supreme Court it is not necessary to note in how many points there is similarity and in how

many others there are differences. Instead, it could be enough if the impugned mark bears such an over all similarity to the registered mark as

would be likely to mislead a person usually dealing with one to accept the other if offered to him. The question is not whether if the person is

looking at two trade marks side by side, there would be a possibility of confusion. On the other hand, the point is whether anybody who sees the in

fingering trade mark in the absence of the infringed trade mark shall be liable to be deceived and to think that the trade mark before him is the same

as the other on which he has a general recollection. For this we have to take into account the nature and kind of customers who are likely to buy

the goods. Emphasis is laid on over all similarity alone and not similarity in each and every minute detail. The totality of the impression of the trade

mark produced should be such as to cause confusion or deception in the mind of the purchasers. Tangible danger of confusion by a substantial

proof is the main test to find out whether the infringing mark is deceptively similar to the infringed mark. The test of comparison of the marks side

by side is not a sound one since a purchaser will seldom have the two marks actually before him when he makes his purchase. The eye is not an accurate recorder of visual detail and that marks are remembered rather by general impression or by some significant detail than by any photographic recollection of the whole.

8. u/s 2(1)(d) of the Act a mark shall be deemed to be ""deceptively similar"" to another mark if it so nearly resembles that other mark as to be likely

to deceive or cause confusion. Learned counsel for the appellants argued that the court below has overlooked that in a case of this kind, the

factors to be considered are broad and essential features, the over all similarity and the totality of the impression that could be gathered from both

the marks. The most important feature of each label is the figure it contains. The figure of frog and crocodile can never be similar much less

deceptively similar by any standard. The unwary purchaser going for a match box is led mostly by the figure which the label carries. The figure in

both the labels has striking features of dissimilarity which catch the eye, strikingly distinct and different. In the present case, the figure in the trade

mark of the respondent is frog and that in the trade mark of the appellants is crocodile and the difference between these two creatures is well known

to ordinary common man and the person with normal power of observation would be able to see the distinctive marks easily even though colour

pattern may look somewhat similar. Besides it is not the case of the respondent that the appellants have printed the figure crocodile in their match

boxes in such a manner that it somewhat resembles from appearing in the label of respondent. It is significant to note that labels of matches

generally resemble one another and each trade mark- is recognised by a permanent feature appearing in the middle either in the form of animal or

in the form of a bird or something and what readily strikes must also be conclusive. The totality of the impressions in both the labels can never

cause any confusion in the mind of an unwary purchaser. So I am unable to agree with the view of learned District Judge that because frog and

crocodile in the infringed and infringing marks are in upward leaping position, they are deceptively similar to each other.

9. It is the case of the respondent that after their sales picked up during (1981-83, with a view to attract more customers the firm introduced a

colour design of special type for the trade mark ""Mandak"", For the first time, the letter "R" with a circle near the frog was printed with a view to assure the customers that the label has been registered under the Act. A label for the back side of the matches has also been designed. The design and scheme of colour are its own work of art got done through experts. The colour scheme and design of the label ""MAGAR"" is nothing but a colourable imitation of the colour scheme and design of the respondent. Whereas learned counsel for the appellants points out that there are more than 50,000 match units in the southern region of Tamil Nadu and in the nature of permutations and combinations of the original seven colours, some from of resemblance is inevitable. And unwary customers will not be deceived by the colour pattern adopted by the respondent. And the respondent cannot claim that he is the inventor of any particular design and colour pattern. It cannot be said that there is no substance in this argument.

10. Regarding printing of the letter "R" learned counsel for the appellants submits that normally three sizes of match boxes are produced. They are, regularise, deluxe and small. The letter ""R"" stands for regular size and the respondent cannot claim that the use of this letter in the infringed mark will be in imitation of his design. And this explanation also appears to be plausible.

11. While the Hindi word ""MANDAK"" is printed above the figure frog on the label of the respondent, the word MAGAR is printed in HINDI above the figure crocodile appearing in the mark of the appellant. The pronouncement of the two words ""MANDAK"" and ""MAGAR"" does not make any phonetic similarity so as to cause confusion in the mind of an illiterate purchaser.

12. In A.V. Rajadurai Nadar Vs. P. Ayya Nadar and Another, , cited by learned counsel for appellants the first respondent's trade mark had at the top of red band in which the words "Camel Branch" were printed in white. The pattern was the same in the trade mark of the appellant except for the word "Ram". Below this red band, there was yellow, backgrounds in both the trade marks. The price of the match was printed in both the trade mark on the left side, except that the print in the appellant's trade mark was more prominent and the price was different. A Division Bench of

this court held that there was no similarity between the two animals in any detail whatever. The ram looked like a sam and the camel had its

likeness. Not only was there no similarity between the two animals but there was also very little chance of deception and so confusion between the

two figures. Any casual observation would without doubt bring to the mind of the person who looks, the difference between the two animals. The

Division Bench went on to observe that the expression "deceptively similar" as defined in Section 2(d) of the Trade and Merchandise Marks Act,

1953, means that in order to be that, the similarity or resemblance must be such as it would be likely to deceive or cause confusion. Any

conclusion reasonable and proper can be arrived at by a meticulous examination of each detail and then making a comparison. At the same time,

what readily strikes the eye must also be conclusive. But, when one looks at it, especially from the standpoint of a person who is most likely to use

a particular brand of matches, if it appears that the difference is prominent and it cannot lead to any similarity or a deceptive similarity or confusion,

then there could be no objection to the two different trade marks. The labels on generally resemble each other and each trade mark is recognised

by a prominent feature appearing in the middle either in the form of an animal or in the form of a bird or something else.

13. In this case also, the nature of the trade is such that common labels are used by various competitors using similar colours. So in my opinion,

even a casual observer can see the difference between the frog and crocodile and there can be no mistake between the one and the other made by

any one even if they are kept side by side or kept apart. I am unable to agree with learned District Judge that the two figures in the upward leaping

position can cause confusion in the mind of purchaser of average intelligence and poor recollection and that the appellants having crocodile figure

not in a leaping posture only cannot be objected to by the respondent.

14. In the result, the appeal is allowed and the order of the court below is set aside and T.M.O.P. No. 94 of 1983, is dismissed. Parties are

directed to bear their respective costs throughout.

15. Appeal allowed.