
(1963) 12 MAD CK 0062
In the Madras High Court
Case No : O.P. No. 201 of 1962

The Western India Match Co. Ltd.

APPELLANT

Vs

The Manohara Match Works and Others

RESPONDENT

Date of Decision : 19-12-1963

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 107, 108, 11, 112(2), 12

Citation : AIR 1965 Mad 42

Hon'ble Judges : Sadavisam, J

Bench : Single Bench

Judgement

(1) Petition under Ss. 56, 107 and 108, Trade and Merchandise Marks Act, 43 of 1958 for rectification of the Register of trade mark by canceling the registration of the trade mark "Matulaies" adopted by respondents 1 to 3. The petitioners are reputed manufactures of safety matches, and one of their trademark is "three mangoes" which they are using ever since 1934, on the packets and labels of the match boxes sold extensively in different districts on Andhra Pradesh and more particularly in the districts of Guntur, Krishna, Khammameth and Warangal. The first respondent is a proprietary concern of 2nd respondent, P. Muthiah Nadar, and the 3rd respondent, the joint owner of the trade mark "Matulaies". The complaint of the petitioners is that respondents 1 to 3, on or about 1959, conceived the idea of adopting the mark of "Matulaies" similar to that of the registered trade mark of three mangoes of the petitioners maliciously and with the intent of causing wrongful loss to the petitioners.

The case of the petitioners is that the mark of "Matulaies" adopted by respondents 1 to 3 is an obvious and colorable imitation of the trade mark of "three mangoes" and is calculated to deceive the eye of an unwary purchaser and equally others, resulting in confusion and deception in the minds of the purchasing public. The petitioners filed O. S. 1 of 1961 on the file of the District Court Guntur, against respondents 1 and 2 for infringement of their trade mark. But during the pendency of the suit, respondents 1 to 3 got the trade mark

"Matulaies" registered by the 4th respondent. the petitioners claim that the said registration is in contravention of the provisions of S. 12(1) of the Act and has to be expunged to maintain the purity of the register.

(2) The case of respondents 1 to 3 is that the trade mark "Matulaies" belonging to them is distinctively different from the trade mark of "three mangoes" belonging to the petitioners and that there is no infringement of the trade mark of the petitioners by respondents 1 to 3.

(3) The learned advocate for the petitioners did not for a moment suggest that any confusion is likely to arise between the trade mark used by petitioners and the trade mark used by respondents 1 to 3. The word mark "Matulaies" which is tamil word for pomegranate cannot be confused with the word mark "three mangoes" whether one sees the marks printed on the labels or hears the words marks when they are pronounced. The words are dissimilar; and it is not urged that there is any phonetic similarity between the words. The learned advocate for the petitioners rightly stated, even at the commencement of the hearing of the petition, that it is for the court to test the similarity of the trade marks and designs by comparing them. It is true that such comparison should not be made by having the labels of the petitioners and respondents 1 to 3 side by side because that is not what a customer does when he wants to purchase the goods of the petitioners. the following observations of a division Bench of this court in Ebrahim Currim and Sons v. Abdulla Saheb, 65 MLJ 617: AIR 1934 Mad 226 clearly show how comparison of the marks should be made to test similarity of two marks:

"One has got to see whether an ignorance purchaser is going to be in the position of the curt having the two things side by side and examine them critically. The purchaser probably trusts to his recollection of one or a description of it that has been given to him or seeing it on the shop window, goes to the person selling the infringement, who ex hypothesis does not give him the two the genuine one and the infringement to choose from."

(4) A person who asks for "three mangoes" mark match boxes of the petitioners will not be given "Matulaies " mark match boxes respondents 1 to S. It is clear from the affidavits filed by both parties that the customers generally ask for matches without specifying the name of any particular brand and they rely upon the labels found on the match boxes. Having looked at the two labels, namely, one containing the mark "Three mangoes" and the other "Matulaies" I have no doubt that no customer who is accustomed to or wants to purchase the "three mangoes" matchboxes will be misled or deceived into buying the "Matulaies" match boxes. It is impossible even for an unwary or ignorant purchaser who wants to buy the "three mangoes" math boxes of the petitioners and merely trusts to his recollection of the label to be misled or deceived by the label of "Matulaies" of respondents 1 to 3 as that of the three mangoes of the petitioners. In view of such vital difference between the two labels, the learned advocate for the petitioners tried to support the claim for rectification on two grounds,

namely, (1) fraudulent intent of respondents 1 to 3 pass off their goods as that of the petitioners by trying to sell them in the several districts of Andhra Pradesh where the petitioners' goods have become popular and are sold, and (2) deceptive similarity of the colour scheme and particularly yellow background.

(5) The learned advocate for the petitioners relied on the affidavit of V. M. Madhavan, Chief Marketing Officer of the petitioners firm, that

"the petitioners' match boxes with the trade mark of 'three mangoes' are particularly sold and are in great demand in the district of Guntur, Krishna, Kammamet and Warangal in the State of Andhra Pradesh and that the mind of the respondents is clear from the discreet attempt made by them to introduce their goods with the offending trade mark in the said districts."

The learned advocate for respondents 1 to 3 stated that their match boxes with the labels "Matulaies" are sold not only in the several districts of Andhra Pradesh but also in South India and Delhi. If there was really any fraudulent intent on the part of respondents 1 to 3 as alleged in the affidavit of the Chief Marketing officer of the petitioners' firm, it should have been specifically pleaded in the petition; and that has not been done. In fact, there is no reference to the alleged fraudulent intent on the part of respondents 1 to 3 even in the reply statement of the petitioners. It may be that the respondents are rival traders. On that account they cannot be prevented from carrying on the trade by using their trade mark "Matulaies" unless the petitioners are able to prove that the said trade mark and label infringed their rights.

(6) The learned advocate for the petitioners relied on the observations of Lord Lawrence in *Reddaway (F) and Co. Ltd. v. Hartley* (1931) 48 RPC 283 that where fraud is established

"the court would readily assume that the defendant would be likely to succeed in his design, however much it might on the face of it appear to a lawyer that he had sufficiently distinguished the designation which he has applied to his goods from the plaintiffs"

The following passage from the judgment of Lindley L. J. in *Slazenger and sons v. Feltham and co.* (1889) 6 RPC 531 is also to the same effect:

"One must exercise one's common sense, and if you are driven to the conclusion that what is intended to be done is to deceive if possible. I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?"

The learned advocate also relied on the following statement at page 145 in the *Law of Trade and Merchandise Marks in India* by S. Venkateswaran, 1937 Edn:

"If a mere comparison of the goods, explained by surrounding circumstances, is not sufficient, then it is allowable to prove from other sources that what is, or

may be, apparent innocence was really intended to deceive."

It is true that in passing off action probability of deception is presumed in cases of fraud; but there is no scope for invoking the principle to the facts of the present case. It is clear from what I have stated already that the petitioners have not even alleged that there was any fraudulent intent on the part of respondents 1 to 3, that the trademarks and labels in this case are totally distinct and different, and that there is no likelihood of anyone being deceived to purchasing the goods of respondents 1 to 3 as that of the petitioners by reason of the alleged similarities of the trade marks or labels on the respective goods.

(7) On a comparison of the label of the petitioners with that of respondents 1 to 3, I see no deceptive similarity of the colour scheme in the two labels. The learned advocate for the petitioners stated that he would be satisfied if the yellow background in the label of respondents 1 to 3 is changed to some other colour. But there is nothing to show that the petitioners have any monopoly for the yellow background in their labels. In fact, there is nothing to show that yellow background is not used by the manufacturers of match boxes having other trade marks.

(8) The Assistant Registrar of Trade Marks has been impleaded as 4th respondent in this petition, and he has filed a statement under S. 112(2) of the Trade and Merchandise Marks Act, 1958, which provides that such statement shall be evidence in the proceeding. In para 2 of the statement, the Assistant Registrar has stated the procedure that is followed in respect of an application for registration of a trademark. In para 3 of his statement, he has stated that the procedure has been followed in the instant case. Thus the 4th respondent made a search among the registered trade marks and pending applications and found no identical or deceptively similar marks on the register or pending registration which would bar the registration of the trade mark of respondents 1 to 3 under S. 12(1) of the Act.

It is clear from the decision in *Ciba Ltd. Vs. M. Ramalingam and S. Subramaniam* trading in the name of South Indian Manufacturing Co. and Another, that the relief to be given under S. 46 of the old Act which corresponds to S. 56, Trade and Merchandise Marks Act, 1958, is a discretionary relief, and, that though the court is bound to consider the case independently on merits, it would ordinarily be loath to interfere with the discretion of the Registrar. I have already independently considered the contentions urged by the learned advocate for the petitioners, and I do not find any ground to hold that the registration of the trade mark and label of respondents 1 to 3 was made without sufficient cause or that there is any error or defect in the entry in the register which requires rectification or correction under S. 56 of the Trade and Merchandise Marks Act, 1958.

(9) The learned advocate for the petitioners relied on the decision in *Eno v. Dunn*, (1890) 15 AC 252 where it was held that the Patents, Designs and Trade Marks Act, 1883 conferred upon the Comptroller a discretion whether to register

a trade mark or not and he ought to refuse registration where it was not clear that deception might not result. He particularly relied on the passage at p. 263 that a reasonable exercise of the discretion is to refuse registration when it is not clear that deception might not result from it. There is difference in the language of Ss. 72 and 73 of the patents, Designs and Trade marks Act 1883 of England and Ss. 11 and 12, Trade and Merchandise Marks Act 1958 of India. The words "calculated to deceive" found in the sections of the former Act do not find place Ss. 11 and 12 of the latter Act. Even assuming that the principle of the decision in the case cited above will be applicable to cases under the Trade and Merchandise Marks Act, 1958, it cannot help the petitioners in view of my finding that here is no evidence that the trade mark and design of respondents 1 to 3 are calculated to deceive the public as that of the petitioners.

(10) The learned advocate for the petitioners commented upon the fact that respondents 1 to 3 got their trade mark and label registered during the pendency of the petitioners' suit O. S. No. 1 of 1961 on the file of the District Court Guntur. But it should be noted that respondents 1 to 3 filed the application for registration of their trade mark and label even prior to the filing of the suit. Respondents 1 and 2 pleaded in the written statement that they had applied for registration of their trade mark and label, and that the same was advertised on 16-2-1961. Under S. 21 of the Trade and merchandise Marks Act, 1958 the petitioners could have filed objection to the registration of the trade mark and label of respondents 1 to 3 on the ground that it infringed their rights. But they did not do so.

(11) The petitioners have filed affidavits of stockists, retail dealers and users of their match boxes containing the trade mark "three mangoes" to show that confusion had arisen in the market on account of similarity of the trade mark and label of respondents 1 to 3. Respondents 1 to 3 have also filed a large number of affidavits to prove that there could be no such confusion. the learned advocate for the petitioners conceded even at the commencement of hearing of the petition that the court is the best judge to determine whether there is deceptive similarity of the two trade marks and labels. It is therefore unnecessary for me to discuss in detail the contents of the affidavits filed by both parties.

(12) For the foregoing reasons, the petition is liable to be dismissed and is hereby dismissed with costs.

(13) Petition dismissed.