

1933

Present : Garvin S.P.J. and Maartensz A.J.

ABDUL CADER v. THE MADRAS PALAYAKAT
COMPANY, LTD.

147—D. C. Colombo, 1,910.

Trade Mark—Application for registration—Opposed on the ground that it so nearly resembles another as to be calculated to deceive—Burden of proof—Test to be applied—Leading characteristics—Ordinance No. 15 of 1925, ss. 11 and 19.

Where an application for registration of a trade mark is opposed on the ground that the applicant's trade mark so nearly resembles the opponent's as to be calculated to deceive, and it is established that they resemble each other,—

Held, that the burden of proving that there is no reasonable probability of deception is on the applicant.

The question whether the two trade marks so nearly resemble each other as to be calculated to deceive must be determined by considering what is the leading characteristic of each and whether the main impression which would remain with any person seeing them at different times is the same.

A PPEAL from a judgment of the District Judge of Colombo.

This was an application to register a trade mark consisting of a device, containing within it the initials "M. S. M. A." and the numerals and sign 60×60 , under the provisions of the Trade Marks Ordinance, No. 15 of 1925.

The respondent company claiming to be the owner of trade mark No. 5,013 opposed the application on the grounds—

- (a) that the mark propounded so nearly resembled mark No. 5,013 already on the register as to be calculated to deceive.
- (b) the registration of the mark propounded would seriously interfere with the use by the opponents of their mark which they and their predecessors in title have lawfully used in Palayakat sarongs.
- (c) that the goods on which the mark propounded is to be used are of such a nature that the mark as appearing on the said goods will be calculated to deceive.

The Registrar-General held that the application to register the trade mark should be allowed.

The opponent appealed to the District Judge, who allowed the appeal.

R. L. Pereira, K.C. (with him *Tisseverasinghe* and *N. K. Choksy*), for applicant, appellant.—The opponent cannot object to the mark propounded because it contains the figures " 60×60 ". That has been disclaimed in the opponent's registration. As they have no right to its exclusive use they cannot complain at its inclusion in our mark. Nor can our mark be said to be "calculated to deceive" because of the incorporation of that feature.

The applicant's affidavits prove that the propounded mark is known as the "mango mark". This is supported by the tapering to a point of the lines enclosing the letters and figures, at both ends of the enclosing lines.

The affidavits of the opponents clearly prove that the opponent's sarongs are known as "60 × 60" sarongs, and they complain that if the applicants' mark is registered, the applicants sarongs will also come to be similarly called. This cannot be a ground for refusing registration of a trade mark in the absence of proof that fraud was intended to be committed. The finding of the Registrar is that there is no proof of an intention to defraud. In these circumstances registration cannot be refused on this ground. Moreover, as "60 × 60" is not exclusively the mark of the opponents, they cannot oppose registration by reason of the inclusion of these figures even if the effect would be that the applicant's goods may also be called "60 × 60" sarongs. The only substantial ground on which the opposition is based is this and so the opposition must fail.

Counsel referred to 24 N. L. R. 396; (1916) 2 A. C. referred to therein; *Payton v. Snelling*¹.

Hayley, K.C. (with him *H. V. Perera* and *H. E. Garvin*), for respondents.—The Registrar is entitled to take into consideration the fact that the opponent's goods are known as "60 × 60" sarongs even though they may have disclaimed rights to their exclusive user. They do not cease to be part of the opponent's mark merely because exclusive rights to them have been disclaimed.

The illiterate persons who buy this class of goods have to be considered.

The "nett impression" of both marks is very similar.

The juxtaposition of the various parts of the applicant's mark corresponds with that of the corresponding parts in the opponent's mark.

The Court is entitled to take into consideration the parts of a propounded mark, which are common features, in comparing it with the opponent's mark. (*In re Christiansens Mark*, 3 R.P.C. at 61 and 64.)

February 22, 1933. GARVIN S.P.J.—

I agree. The most prominent feature of the opponent's registered trade mark is that part of it which is composed of the initials M.P. COY., written in a curve with the convexity upwards, below it the word MADRAS written in a curve with the convexity downwards and in the oval enclosed within the two curves the figures 60 × 60, thus :

M.P. COY.
60X60
MADRAS.

¹ (1901) A. C. at 308.

So also in the mark which the appellant is seeking to put upon the register the feature which arrests the eye is that part of it which consists of the initials M. S. M. A., the figures 60×60, and the word MADRAS grouped together in identically the same manner and written in similar letters, thus:

M. S. M. A.
60X60
MADRAS.

In each case there are curved lines which enclosed these letters, which enable the appellant to point to certain differences but these lines are a relatively insignificant feature; what arrests the eye are the letters and figures in their relative positions.

The opponent has no exclusive right of user in the figures 60 × 60 nor in the word MADRAS but he has incorporated them in his trade mark and placed them in such a relationship to the initials of his firm and to each other and in such a manner that the composition presents a definite and distinctive picture.

The Trade Marks Nos. 4,857 and 5,089 serve to illustrate two of the numerous different and other ways in which the figures 60 might be incorporated in a trade mark. Similarly the word Madras, if the appellant had any special reason for wishing to incorporate it in a trade mark, might have been written or placed differently.

He has deliberately chosen to place them in similar figures and characters and in identically the same position in relation to his initials and each other as the opponent has done, in what the District Judge refers to as "little more than an attempt to copy the opponent's mark with just such necessary variations in detail to be able to say it is different".

MAARTENSZ A.J.—

The appellant in these proceedings, claiming to be an owner and proprietor of a trade mark consisting of a device containing within it the initials "M. S. M. A." and the numerals and sign "60 × 60" applied to the Registrar under the provisions of the Trade Marks Ordinance, No. 15 of 1925, for the registration thereof on November 23, 1930.

The respondent company claiming to be the owner of Trade Mark No. 5,013 opposed the application on the following grounds, namely:—

- (a) "The mark propounded so nearly resembles Trade Mark No. 5,013 already in the register as to be calculated to deceive. The said Trade Mark No. 5,013 of which the opponents are the registered proprietors was advertised in the *Government Gazette* No. 7,793 dated July 24, 1930, at page 1949 of Part I. thereof.
- (b) The registration of the mark propounded would seriously interfere with the use by the opponents of their said mark No. 5,013 which they and their predecessors in title have lawfully used

in Palayakat Sarongs, goods coming under class 38, first as an unregistered trade mark and later as a registered trade mark since 1925.

- (c) The goods on which the mark propounded is to be used are of such a nature that the mark as appearing on the said goods will be calculated to deceive”.

The applicant filed a counter notice denying the allegations in the notice of opposition and asserting that the essential difference between the two trade marks were plain enough and that there was no possibility of deception.

The applicant's mark is said to be “the representation of half section of a mango fruit with the seed section in the middle well depicted in thick bold outline and called and known as the mango mark”.

The device is an oval shaped figure with pointed ends, within it is a similar figure smaller in size. Between the lines on top are the letters M. S. M. A. being the applicant's vilasam, between the lines at the bottom is the word Madras. In the middle of the smaller oval there are the figures and sign 60 × 60.

The Registrar of Trade Marks in the *Gazette* Notice stated that the “registration of the trade mark would give no right to the exclusive use of the letter X and the numerals 60”.

The applicant applied to register the trade mark in class 38 in respect of sarongs and camboys.

The opponent's device consists of two curved ribbons placed so as to form two nearly complete ovals one within the other. In the upper ribbon appear the letters “M. P. COY.” being a short form of the opponent's business name which is the Madras Palayakat Company. In the lower ribbon the word “Madras”. In the smaller oval appear the figures and sign 60 × 60. Above the upper ribbon and below the lower ribbon there is a decorative design.

Affidavits from various traders in cloth were filed by both sides.

The opponent company claimed and supported its claim by affidavits of other traders in camboys and sarongs, that the figures 60 × 60 were identified with the camboys and sarongs manufactured by the company and that its goods were known in the trade as 60 × 60 camboys.

The opponent denied the truth of the statement made in the applicant's affidavit that the figures 60 × 60 are common to the trade and used to indicate the size of the yarn used in the manufacture of palayakat sarongs and camboys.

The Registrar-General held that the applicant's application to register his mark should be allowed. He was of opinion that if the common feature to which the opponent company had no exclusive rights were left out of consideration the marks could not be said to be similar as “the general outline of the applicant's mark is quite different from that of the opponents”.

He also held that there was no proof of the intention of the applicant to pass off his goods as those of the opponent company.

The figures 60 × 60 he observed appeared in two other marks on record and was of opinion that, whether they were registered with the opponent's consent or not, they therefore lost their distinctive character.

The Registrar expressed no opinion regarding the credit to be attached to the affidavits filed on either side. The opponent appealed to the District Court.

The learned District Judge allowed the appeal. He was of opinion that "quite apart from the consideration of the lettering 60 × 60" it was for the applicant to establish that the proposed design does not so nearly resemble that of the opponent company as to be calculated to deceive.

The District Judge then proceeded to consider the differences in detail of the two designs when looked at together and the similarity in the design apart from each other particularly when the figures 60 × 60 are taken into consideration as forming part of the two designs, and came to the conclusion that the proposed mark was "little more than an attempt to copy the opponent's mark with just such necessary variations in detail to be able to say it is something different".

His finding is as follows:—

"It appears clear that there are such resemblances between the proposed mark and his (the opponent's) mark that if registration is allowed it is likely to lead to deception."

The applicant has appealed to this Court from the finding of the District Judge.

There is one ground of appeal relied on by the applicant which might conveniently be disposed of first. That is the argument that the figures 60 × 60 have been used in other marks for the same class of goods and that therefore the applicant is entitled to use the numerals and figures as part of his mark.

The trade marks referred to appear in *Gazette* No. 7,741 dated October 18, 1929, and *Gazette* No. 7,799 dated August 22, 1930. They are respectively numbered 4,857 and 5,069.

The assistant manager of the opponent company in his affidavit at page 45 of the record affirmed as follows:—

"These figures are only used in one Trade Mark No. 7,799 by S. H. Badsha Sahib and Co., and this registration was not opposed as there was a concurrent user and the mark was registered with our consent. The proprietor of the Trade Mark No. 7,741 is N. V. R. L. Letchuman Aiyar who was a partner in the Madras Palayakat Company and is a large shareholder in the present company, and the said mark was withdrawn from the market in 1929, and is not now being used. Apart from the opponent company and S. H. Badsha Sahib and Co., no other party is lawfully using the 60 × 60 device and no other parties have any right to the same and I deny that the device is common to the trade."

Apart from the explanation furnished by the opponent company's manager as to how these marks came to be registered without opposition, I can understand no opposition being offered as the marks are so entirely unlike the opponent's mark that even with the figures 60 × 60 no one could be deceived into believing that sarongs and camboys bearing the mark were sarongs and camboys sold by the opponent company.

The main contention in appeal was that the opponent's opposition to the registration of the proposed mark was founded on the figures 60 × 60 in the opponent's device and that having no exclusive right to the figures they cannot oppose the registration of a device containing the same figures.

The opponent company has filed nine affidavits from different traders in cloth expressed in similar terms indicating that they were all prepared from one draft.

In every one the deponent describes himself and the number of years he has been doing business and affirms—

- (1) that the opponent's sarongs are referred to in his orders as 60 mark sarongs and that this reference is well known in the trade to mean a reference to sarongs manufactured by the opponent company and bearing their registered trade mark consisting among other things of the figures 60 × 60 with a certain device.
- (2) that sarongs bearing this mark are well known in Ceylon and have acquired an excellent reputation and that customers in describing what kind of sarongs they want refer to sarongs bearing the mark as 60 mark sarongs, and the mark is distinctive of the opponent company's sarongs.
- (3) that he has been shown a copy of this mark the applicant seeks to register and is of opinion that it is so similar to the opponent's company's registered mark that its use will cause considerable confusion and is likely to cause deception especially as in view of the fact that traders and customers are most likely to refer to the mark propounded in the same way as they refer to the opponent's mark. In addition to which the general arrangement of the design, the lettering and the get-up of the whole mark is strikingly similar to the opponents' mark.
- (4) that "in cases where purchasers look at the general design they are most likely to be deceived".

In addition to these affidavits there is one by another dealer in cloth to prove the same facts in somewhat different terms and an affidavit by the assistant manager of the opponent company who affirmed that the 60 mark was distinctive of the opponent company's sarongs and produced invoices showing that the company's sarongs have been sold under the description "60 × 60".

The applicant filed six affidavits in addition to his own denying that the figures 60 × 60 were distinctive of the opponent's goods, that the two marks resembled each other, and asserting that the applicant's mark belongs to the applicant and has been in the market for some years.

They all affirmed that the figures 60 × 60 indicate the grade or texture of the yarn used and are used by all traders.

The statements made in the applicant's affidavit were denied by the assistant manager of the opponent company in a counter affidavit.

Neither the Registrar of Trade Marks nor the District Judge has expressed any opinion as to the probative value of these affidavits.

It is quite impossible that one set of affidavits should be preferred to the other.

Mr. Hayley for the opponent contended that the burden of proving that the mark is not calculated to deceive is on the applicant and that there being no way of determining which set of affidavits contained the truth, we must accept the opponent's affidavit.

In support of this contention he cited the dictum of Lord Watson in the case of *Eno v. Dunn*¹, that the "prohibitory clauses (referring to section 72, sub-section (2) of the Act of 1883—section 11 of our Ordinance embodies with certain alterations section 72 of the Act of 1883) cast upon the applicant the duty of satisfying the Comptroller, or the Court, that the trade mark which he proposes to register does not come within their scope. In an inquiry like the present the applicant does not hold the same position which he would have occupied if he had been defending himself against an action for infringement. There, the onus of showing that his trade mark was calculated to mislead rests, not on him, but upon the party alleging infringement; here, he is *in petitorie*, and must justify the registration of his trade mark by showing affirmatively that it is not calculated to deceive. It appears to me to be a necessary consequence that, *in dubio*, his application ought to be disallowed".

I do not think the dictum has the far-reaching effect attributed to it, and I am of opinion that we cannot, on the strength of it, hold that the opponent has proved that the figures 60 × 60 have become identified with the sarongs and camboys manufactured by the company.

The effect of this decision I shall deal with later on. However that may be the opponent company has not by registering its mark acquired the exclusive right to the use of the sign and numerals and cannot prevent the applicant using them unless it can establish that the way in which the applicant proposes to use them results in the applicant's mark so nearly resembling his mark as to be calculated to deceive.

The relevant sections restricting the registration of a trade mark are sections 11 and 19 of the Trade Marks Ordinance, No. 15 of 1925.

Section 11 enacts:—"It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a court of justice or would be contrary to law or morality, or which in the opinion of the Registrar or the court is likely to offend the religious or racial susceptibilities of any community, or any scandalous design."

Section 11 reproduces section 11 of the Trade Marks Act of 1905 with the addition of the words "or which in the opinion of the Registrar or the court is likely to offend the religious or racial susceptibilities of any community."

Section 19 reproduces section 19 of the same Act with a difference as regards the date in the case of old marks. It provides that:—"Except by order of the court or in the case of trade marks in use before the twenty-fifth day of March, one thousand eight hundred and eighty-nine, no trade mark shall be registered in respect of any goods or description of

¹ (1890) 15 A. C., p. 252.

goods which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods or so nearly resembling such a trade mark as to be calculated to deceive.”

If we discard the evidence afforded by the affidavits, and I think we must discard that evidence, there remains the simple question whether the applicant's trade mark so nearly resembles the opponent's trade mark as to be calculated to deceive.

If they so resemble each other then the burden of proving that there is no reasonable probability of deception is cast on the applicant. *Vide Eno v. Dunn (supra)*. That is the effect of Lord Watson's decision referred to earlier.

The applicant has not discharged that burden and I need only decide the question whether the opponent's mark so nearly resembles the applicant's mark as to be calculated to deceive.

The question should be determined “by considering what is the leading characteristic of each. The one might contain many or even most of the same elements as the other, and yet the leading, or it may be, the only impression left on the mind might be very different; whilst on the other hand a critical comparison of the marks might disclose unseen points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same.”

I have quoted from the Report of Lord Herschell's Committee reproduced in Kerly on Trade Marks at page 271. The principles are stated to be in accordance with the leading case of *Johnstone v. Orr Ewing*¹, and the *Taendstikker Case*², cited as *Re Christiansen's Trade Mark*. In the latter case the question arose as to the resemblance between two match box labels.

The two labels resembled each other in all the details common to the trade mark. The only difference was that the word Nitedals was used in the registered mark and the word Medals in the corresponding space in the proposed mark.

The Court of Appeal reversing the decision of Chitty J. refused to allow the registration of the proposed mark.

Lord Esher in his judgment said:—“The trade mark is the whole thing—the whole picture on each. You have, therefore, to consider the whole. Mr. Justice Chitty has looked at the distinguishing features. He, I think, only looked at it to see whether, with that distinction, the whole was like or unlike. That is what he did, but the argument raised by Mr. Romer, and which was not only shadowed but plainly put forward by his skilful cross-examination, was this: the moment there is any distinction in any part, the things are at once unlike. That is his point. Therefore he cross-examined the people thus:—The lamps or the medals are alike, and they are common? Yes. The work at the bottom is common to the trade, and it is the same in both? Yes; but it is common to the trade. Therefore, he says, everything but the words *medals* and *nitedals* is common, and those two are different, and therefore the whole is different. It seems to me he has fallen into this

¹ (1882) 7 A. C., p. 219.

² 7 R. P. C., p. 260.

fallacy—he takes each thing by itself, and says either it is common or it is the same, and leaves out altogether the mode in which the things are put together in the two pictures.”

Lindley L.J. was of the same opinion.

Kerly sums up the effect of the judgments at page 273 thus :—“So that where common marks are included in the trade marks to be compared, or in one of them, it appears, from the judgments just quoted, that the proper course is to look at the marks as wholes, and not to disregard the parts which are common, although Cairns L.C. in the *Orr Ewing Case* expressed a different opinion.”

*Farrow's Case*¹ is cited by Kerly as a good illustration of Lord Esher's Rule. There both the applicant and the opponent were mustard merchants, and both used square boxes covered with yellow labels printed in black and red, for these boxes were common to the trade. The applicant placed upon his labels a picture of a charging buffalo, and the opponent a picture of a bull's head: both pictures were contained within silver rings, and these rings were also common to the trade. Stirling J. said that the buffalo and the bull's head, as printed in the *Trade Mark Journal*, were very different, but when they were placed upon the coloured labels, the applicant's label too closely resembled that of the opponent to be admitted to the register.

According to the rule in the *Taendstikker Case*, in comparing the two marks which are the subject of this appeal we cannot disregard the numerals and sign 60 × 60, whether it is common to the trade or not or the word Madras.

The two marks have in common the initials or vilasam of the manufacturer on the top of the device, the word Madras at the bottom placed within double lines, and the numerals and sign 60 × 60 in the oval shaped figure formed by the inner lines of the two double lines.

The lettering in the applicant's mark is somewhat larger and thicker than the lettering in the opponent's registered mark but the numerals and sign are almost identical in size and thickness.

The leading characteristics in each are the numeral and sign in an oval figure between the word Madras and certain letters. The only difference is in the letters, even in the letters the first letter M is common to both.

No doubt the two marks placed side by side would at once show up the difference in the two devices, the main difference being the way in which the ends terminate; but the idea which would remain with any person seeing them apart at different times would be the numerals and sign 60 × 60 in an oval shaped figure between certain letters.

I am of opinion therefore that the applicant's mark so nearly resembles the opponent's mark as to be calculated to deceive and would dismiss the appeal with costs.

Appeal dismissed.

¹ (1886) 3 Reports of Patent Cases, p. 54.