

Suby and Another
v.
T. Suby Ltd.

COURT OF APPEAL.

WIMALARATNE, P. AND RODRIGO, J.
S.C. 127/71 (INTY)—D.C. COLOMBO 1308/SPL.
DECEMBER 12, 1979.

Trade mark—Application for registration thereof—Objection by registered mark owner—Registration granted by Registrar but disallowed on appeal to District Court—Approach to such question by Court of Appeal—Meaning of words “calculated to deceive”—Considerations in determining such question—Trade Marks Ordinance (Cap. 150), sections 9, 10, 17—Code of Intellectual Property Act, No. 52 of 1979, sections 99(1), 100(1), 142.

The appellant sought registration of his trade mark for marketing tea and cardamoms under the Trade Marks Ordinance (now replaced by Act No. 52 of 1979). Objections were lodged to his registration by the respondent on the ground that the applicant's mark was likely to deceive and cause confusion with the respondent's mark, but the Registrar allowed the registration. On appeal to the District Court, the objections were upheld on the ground that to permit registration of the applicant's trade mark would very probably cause confusion with the respondent's mark.

The respondent's registered trade mark was that of a boy in a tunic coat and turban holding a sprig of leaves standing against a background of tea bushes. In the foreground is a factory and range of hills. On the left and on the right-hand side at the top in a line with the turban are two or three small Arabic characters on each side and right at the top above the turban are about seven Arabic characters much larger in size than those on either side. This trade mark was used by the respondent on his packets and chests of tea sold in the Middle East but instead of the Arabic characters he had the words “Boy Brand Trade Mark” printed at the top of the turban. The respondent's tea was referred to in the market as “Suby's Boy brand” or just “Boy Brand” tea.

The appellant's proposed trade mark consisted of the bust of a young cowboy bare headed, with a different type of upper garment, with sprigs of tea leaves below it and the printed words “Cowboy Brand”. It was contended for the appellant that the conjoint effect of the several divergent features in the registered mark of the respondent is to present a totally different visual impression from that produced by the appellant's mark.

Held

The picture of the boy in both marks stands out strikingly and despite the many differences of posture and ornamentation, the net result is that the proposed mark is calculated to deceive in the sense in which this phrase has been interpreted by the Courts.

Per RODRIGO, J. “In the new Act, No. 52 of 1979 there is a section (section 142) which enjoins honest practices in commercial competition. The applicant ought to be aware of the registered trade mark of the opponent. While it is true that the applicant is free to adopt a device which appeals to his artistic sense yet he could have struck upon a device and a brand name which is quite distinctive of his enterprise and goods from that of the registered trade mark without bringing in a feature to strikingly resemble the central feature of the registered trade mark and seek to differentiate it with details of posture and ornamentation such as a different jacket on the boy.”

Cases referred to

- (1) *Maeder's Application*, (1916) 1 Ch. 304; 85 L.J. Ch. 737; 33 R.P.C. 77.
- (2) *Abdul Cader v. Madras Palayakat Co. Ltd.*, (1933) 35 N.L.R. 48; 12 C.L. Rec. 213; 10 Times of Ceylon L.R. 107
- (3) *Veeravagoopillai v. Saibo*, (1934) 36 N.L.R. 317; 14 C.L. Rec. 98; 12 Times of Ceylon L.R. 54.
- (4) *Lukmanjee v. Aktiebalage*, (1911) 14 N.L.R. 414; 5 Leader Repts. 38.

APPEAL from the District Court, Colombo.

C. Ranganathan, Q.C., with H. L. de Silva, for the appellant.

S. J. Kadirgamar, Q.C., with K. N. Choksy and Lakshman de Alwis, for the respondent.

Cur. adv. vuit.

January 18, 1980.

RODRIGO, J.

This is an appeal from the refusal of the District Court of Colombo to direct registration of the applicant-appellant's (applicant) mark for marketing tea and cardomoms. It was sought to be registered under section 10 of the Trade Marks Ordinance, (Chapter 150) now repealed by Act No. 52 of 1979 and objections have been lodged to its registration under section 9 and section 17 before the Registrar. The objections have been upheld by the District Court of Colombo on an appeal taken to it by the opponents and, this appeal before this Court raises for consideration the question whether the propounded trade mark should be refused registration on one or more of the grounds specified in sections 9 and 17 of the Ordinance.

The trade mark consists of the device of a bust of a cowboy with sprigs of tea leaves below it and the words "Cowboy Brand". The trade mark is in respect of tea and cardomoms meant chiefly for export to the Middle East markets in packets as well as in chests. The bust of the boy carries an uncovered head with black straight hair parted on a side with face of a boy of 16-17 years of age and wearing an upper garment with a collar like that of a shirt on one side of his neck and on the other side a scarf with three buttons in front, and a bit lower down the bust and meeting the buttons on either side and extending up to the shoulders a border of tassels. The arms are not noticeable and there appears sprigs of leaves, presumably tea leaves, running the full length of the bottom of the bust with two words "Cowboy Brand" below it centering the bust above it. The boy, however, looks too cissy if the description is meant to carry the image of a cowboy that one is familiar with in American Westerns. In those films the cowboy is chiefly a tough looking character with a hat on his head worn at a rakish slant and carrying a belt round the waist with a pistol in it also worn at a slant.

The opponent has already registered as a trade mark the device of a boy in tunic coat and turban holding a sprig of leaves standing against the background of tea bushes. In the foreground is a factory and range of hills. The sprig of leaves is held by his right hand bent at the elbow and turned up parallel to the body while the left hand is straight down along the body. On the left and on the right hand at the top in a line with the turban are two or three small Arabic characters on each side but right at the top above the turban are about seven Arabic characters much larger in size than those on either side. Though this is the opponent's registered trade mark it is in evidence that in actual practice the trade mark actually used by the opponent on his packets and chests of tea sold in the Middle East is the picture of the boy without the Arabic letters and the factory but only sprigs of leaves at the bottom of his waist and the English words "Boy Brand Trade Mark" at the top above the turban. It is said that the opponent's tea is referred to in the market as "Suby's Boy Brand" tea or just "Boy Brand" tea.

The principal ground of objections by the opponent is that the applicant's propounded trade mark is likely to cause confusion with his trade mark and that it will interfere with the use by the opponent of the brand name "Suby's Boy Brand" or "Boy Brand" which the opponents are lawfully using.

The District Court had upheld the objections holding with the opponent that to permit registration of the applicant's trade mark would very probably cause confusion with the opponent's trade mark and that the applicant's proposed trade mark is not distinctive. The learned District Judge had discussed several English decisions on matters that fall under section 9 and section 17 of the Trade Marks Ordinance and taken a view against the applicant.

What then should be the approach of a Court of Appeal resolving this dispute when the Registrar has taken one view and the District Court has taken a contrary view on an appeal from the Registrar's decision? It has been said that a decision on the question whether a mark is likely to deceive or cause confusion is not an exercise of discretion by a tribunal but a finding of fact and, even when a court is considering the matter in appeal, it is free to exercise its own mind.

Our Trade Marks Ordinance is a reproduction of the English Act of 1883 as amended in 1888. The English Act, however, has now been further amended by the Act of 1938; and the Ordinance repealed by Act No. 52 of 1979.

Under section 9 of the Trade Marks Ordinance a trade mark cannot lawfully be registered if it is calculated to deceive. Likewise under section 17 a trade mark shall not be registered in respect of goods or description of goods if it is identical with one that is already registered in respect of the same goods or description of goods or, so nearly resembles the registered trade mark as to be calculated to deceive.

The words "calculated to deceive" have been held by English courts in interpreting the self same words in the English enactments of 1888 as meaning not more than likely to deceive. The English Act of 1938 has replaced the word "calculated" with the word "likely" bringing it into line with judicial interpretation. Our Ordinance, however, continued to use the same words "calculated to deceive" and it seems to me that the interpretation given in the judgments of our courts to the words "calculated to deceive" as meaning "likely to deceive" derives further justification from the use of the latter words in the new English Act.

The foundation upon which the law relating to trade marks and trade names developed is found in the dicta of James, L.J. that:

"No man, is entitled to represent his goods as being the goods of another man; and no man is permitted to use any mark, sign or symbol, device or means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer". *Kerly on Trade Marks* (9th Ed.).

This principle has a wider application than merely to the case of trade marks proper. "Conduct of every kind which is calculated to pass off the goods of the defendant as those of the plaintiff, falls within them, whether it consists of the imitation of the symbol expressly adopted by the plaintiff to distinguish his goods and to identify them with him, that is, his trade mark.....or of the imitation of the general appearance, the "get-up" of his goods as they appear in the market; or of the imitation of the name in which he trades."

"The litigation of trade mark cases was, however, found to be extremely costly, and otherwise unsatisfactory. These evils, and the unsatisfactory state of the law in regard to the false marking of goods in general, led to an urgent demand from the traders of the country for more efficient protection and in 1862 a Select Committee of the House of Commons was appointed to consider several trade marks and

Merchandise marks Bills before Parliament. The Trade Marks Registration Act, 1875, established the present Register of Trade Marks. The object of this Act was two fold: it was directed to diminish the difficulty and cost of, or to remove altogether the necessity for, the proof of title by use and reputation; to secure the publication of marks which had been appropriated as trade marks; to define the rights of their proprietors, for the information of traders; and further, to limit the classes of marks which should be capable of being so appropriated. The Act, accordingly, provided that registration should be prima facie evidence of the right of the registered proprietor to the exclusive use of the trade mark in connection with goods of the class for which it was registered and used, and should, after the expiration of five years, be conclusive evidence of such right, so long as the trade mark remained upon the Register and the proprietor of the mark remained the owner of the goodwill of the business in which it was used."—*ibid.*

Later the Act of 1883 was enacted as amended by the Act of 1888 and our Ordinance is a reproduction of these Acts.

Since a Court sitting in appeal is free to exercise its own mind the objections have to be considered afresh and "not as how witnesses would look at it but as how the court itself would look at the two contending marks". It is useful to keep in mind the oft-quoted proposition that each case must be decided on its own facts and the decided cases are only a thin guide. The material considerations arising in connection with a resolution of the disputes are really practical and could be looked at from a "business and common sense point of view". The standard by which the matter is to be judged is whether the mark in respect of the goods or description of goods is the same or so nearly resembles the registered mark as to be likely to deceive. The words "calculated to deceive" have been held in the English case of *Maeder's Application* (1) by Sargant, J. as meaning "so nearly identical as to be confusing". The words, as I said, have altogether being replaced in the 1938 Act with the words "likely to deceive or cause confusion". Since "likely to deceive" does not necessarily involve an intention to deceive the word "deceive" has been held to cover various matters better regarded as "causing confusion". Though there had been authorities drawing a clear distinction between "deception" and "confusion" they were cases of passing-off and for all practical purposes "likely to deceive" and "likely to cause confusion" are interchangeable, and the cases on trade marks have dealt with this phrase accordingly. It is also useful to remember that

when an opponent objects to the registration of a proposed trade mark the burden is on the applicant for registration of showing affirmatively that the proposed mark is not likely to deceive or cause confusion, and if the matter is left in doubt the application is disallowed. See *Abdul Cader v. Madras Palayakat Co. Ltd.*

(2) The position is different in actions for infringement.

The Act of 1979 uses the words "likely to mislead the public"—see section 99 (1) (k) and section 100 (1) (a). This, in my view, does not substantively alter the law.

"It is not possible to discover from the decided cases any standard as to the amount of resemblance which may suffice to deceive or cause confusion. As Lord Cranworth said in *Seixo v. Provezende*, "What degree of resemblance is necessary is from the nature of things incapable of definition *a priori*". Nor is the standard always the same". *Kerly on Trade Marks* (9th Ed.).

It therefore follows that rules of comparison in so far as they are rules of comparison are only guides drawn from typical situations.

I shall now analyse the devices and words in dispute in the case before me and see how they stand against the tests applied in the rules of comparison so called, being mindful, however, of the position that they are modes of approach adopted by English courts in forming impressions of the devices examined by them.

The central feature of the devices is the bust of a boy of the same age and facial likeness. When the two devices are looked at as a whole this picture of the boy strikes full in the eye and holds itself in focus for a long while before it releases the eyes for a less attentive look at the details around it. This, at first blush, is the net impression—the picture of a young boy. I have described my impressions by looking at the pictures side by side.

Then I experimented by looking at the pictures separately interrupted by one hour. First I looked at the registered mark of the opponent and then, at the end of the hour, at the proposed mark. The impression of two boys that looked alike was vivid though naturally I could remember that the registered mark was more crowded with details though it is not every one of them that I could recall notwithstanding the proximity of time. The recollection then of the details though they vary in their visual and memorable effect was imperfect, but not of the central picture of the boys. In the registered mark there is a brand name in Arabic, or so I was told by counsel. That hardly

created any impression on me. In fact, I found myself tending to ignore it. In the proposed mark, the brand name is in English. So that, when I give it thought, and giving it thought only, I become conscious of some differences in detail. When no effort is made to recall the details, I cannot escape the impression that the details and differences in them are irrelevant to my mind and are not part and parcel of the central picture of a boy. The ultimate purchasers of these goods are not specialised purchasers but are ordinary consumers who would buy a packet of tea in common use. The net result of this analysis can best be expressed in the words of Lord Silbourne "To such persons or at least to many of them, even if they took notice of the differences between the two labels, it might probably appear that they were only differences of ornamentation, posture and other accessories leaving the distinctive and characteristic symbol substantially unchanged. Such variations might not unreasonably be supposed to have been made by the owners of the plaintiff's trade mark themselves for reasons of their own." This, of course, was said by Lord Silbourne with reference to natives of India and Aden who could not understand the English on the labels. Here one brand name is in Arabic. But its place in the get up is that of a poor relation and not much notice is expected to be taken of it. Lord Silbourne's remarks related to pictures of two elephants on each mark with differences in arrangement and accessories. The consumers are most unlikely to refer to the mark as that of an elephant carrying that and this and with its trunk poised this way or that way. They would refer to the mark and keep it in mind just as that of an elephant. So will consumers, in my view, in the present case. They will ignore or forget in course of time the details and remember only the picture of the boy as being good enough.

In *Veeravagoopillai v. Saibo* (3) which carried Lord Silbourne's remarks just referred to, the contending marks were that of a standing monkey on the one hand and on the other that of a strong man in the standing position holding up a pair of dumb bells. Both marks were sought to be registered in respect of flour. They carried different brand names. Still Akbar, J. and Garvin, J. thought that the marks were confusing and the applicant's mark ought not to be registered.

In *Lukmanjee v. Aktiebalage* (4) the contending marks carried prints of three cups and saucers with the words "Three Cups" on the top and the words "Safety Matches" below and a device of three stars with the words "Three Stars" and "Safety Matches" with some difference in colour of the labels. Lascelles,

A.C.J. rejected registration of the mark with the three cups, holding there was too much of resemblance with the three stars.

It is submitted for the applicant that the conjoint effect of the several divergent features in the registered mark is to present a totally different visual impression from that produced by the propounded mark. But the fact of the matter is that from among the divergent features the boy stands out strikingly. The differences do not quite catch the eye and, in my view, they will fade away from the memory in a short time. Most people do not carry in their minds an exact picture of what they see but still retain the central idea of what they have seen.

In the new Act No. 52 of 1979, there is a section (section 142) which enjoins honest practices in commercial competition. The applicant ought to be aware of the registered trade mark of the opponent. While it is true that the applicant is free to adopt a device which appeals to his artistic sense, yet he could have struck upon a device and a brand name which is quite distinctive of his enterprise and goods from that of the registered trade mark without bringing in a feature to strikingly resemble the central feature of the registered trade mark and seek to differentiate it with details of posture and ornamentation such as a different jacket on the boy.

The net result is, I find, the central feature constituted by the figure of a boy in the proposed mark so nearly resembles the central feature or the idea of the figure of the boy in the registered trade mark of the opponent as to be calculated to deceive the ultimate purchasers in the sense the phrase has been understood in a series of judgments.

I would, therefore, dismiss this appeal with costs. I make order accordingly.

WIMALARATNE, P.—I agree.

Appeal dismissed.

K. Thevarajah,
Attorney-at-Law.