

1933

Present : Dalton A.C.J. and Drieberg J.

LIPTON, LTD. v. RAWTHER *et al.*

31—D. C. (Inty.), Colombo, 1,812.

*Trade mark—Application for registration of trade mark in respect of tea—
Opposition on the ground that it resembled respondents' trade mark—
Similarity of device—Calculated to cause deception.*

The appellants applied for the registration of a trade mark in respect of tea, consisting of the device of a man-of-war of the cruiser type with the words "ENTERPRISE BRAND" below. The application was opposed by the respondents on the ground that the device sought to be registered so nearly resembled their own registered device as to be calculated to deceive. The respondents' trade mark was registered in respect of the same goods and the essential particulars of the mark were the device of a steamship with the words "STEAMSHIP BRAND". It was established that the respondents' tea had become known as "ship brand" tea.

Held that the appellants were not entitled to register their trade mark.

A PPEAL from a judgment of the District Judge of Colombo. The facts appear from the judgment.

H. E. Garvin (with him *Stanislaus Alles*), for appellants.

Hayley, K.C. (with him *Choksy*), for respondents.

June 23, 1933. DALTON A.C.J.—

The appellants, Lipton Limited of Colombo, applied to the Registrar-General for the registration of a trade mark in respect of tea, consisting of the device of a man-of-war with the words ENTERPRISE BRAND below. The application was opposed by the respondents to this appeal, but it was allowed by the Registrar-General. On appeal to the District Court, the learned District Judge held that the device sought to be registered so nearly resembled the registered device of the opposers as to be calculated to deceive within the meaning of section 19 of the Trade Marks Ordinance, and that the application for registration should be refused.

He therefore allowed the appeal. The applicants now appeal from that decision to this Court. The appeal raises no question of law, but depends upon matters of fact.

The respondents to this appeal who are opposing the application are the owners of a registered mark in respect of the same goods, namely, tea, the essential particulars of which are a device of a steamship with the words STEAMSHIP BRAND above and the name ALIPH in smaller letters on the bow of the ship, apparently representing its name. The man-of-war on the applicants' mark is of the cruiser type, being, it is not denied, a representation of H. M. S. Enterprise at present on the East Indies station.

The ground upon which the application for registration is opposed is that the respondents are proprietors of a mark in respect of tea consisting of the device of a ship and the words "Steamship Brand". The mark sought to be registered has the device of a ship as a very prominent feature, and so nearly resembles the registered mark as to be calculated to deceive.

The evidence before the Registrar-General shows that the respondents have sold their tea since 1926 in Africa, India, Iraq, Malaya, Japan, and parts of Europe, but not in Ceylon. They say, however, they are also finding new markets, and there is nothing to prevent them also selling in Ceylon if it is worth their while. They say their mark has become distinctive of their goods, with the result that tea shipped under the mark has come to be known in the trade as "Ship Brand" tea. This is not denied by the applicants who admit that prior to the date of their application (June 23, 1930) they had sold a very small quantity of tea bearing the mark sought to be registered.

There are the usual allegations on behalf of respondents, denied by the applicants, that the mark sought to be registered so nearly resembles the registered mark as to be calculated to deceive, and further to create confusion between the goods of the applicants and the goods of the respondents. There is no reason at all to doubt the circumstances under which the manager of the applicants says he acquired the idea of the mark he sought to register and that he had no knowledge at the time of the existence of the opponents' registered trade mark, but his statements on these points and as to the quantity of sales of tea bearing the mark sought to be registered would, in my opinion, rebut his further allegation that the applicants' tea was known and referred to as Enterprise Brand tea. I take it that he means, by that statement, that that knowledge existed outside the limits of his own firm. The ship represented in the applicants' device is, it is admitted, H. M. S. Enterprise, at present on this station. The word "Enterprise" on the device is her name, but it is probable that this word would not even to-day be so understood by a large part of the population in this Island, who would further hardly be likely to distinguish between such classes of ships as a man-of-war, a tramp steamer, and a passenger steamship. Still less would anyone be likely to know the method of propulsion, whether, for example, steam or oil. What would be prominently present to all would be the fact that a ship was represented. In the course of a year or two H. M. S. Enterprise may leave the East Indies, and thereafter

very few people would ever connect the word on the mark with the ship. There is ground, I think, for the statement that the ship is the portion of the whole device that is most distinctive, and support for the allegation that the mark if allowed to be registered might well come to be called the ship mark and tea sold with this mark upon it to be known as the "Ship Brand" tea. If that is so, it would have the effect, under the circumstances, of deceiving the public.

The practical rule to be applied in this connection is not to look at the marks as they stand side by side, since they will never be put before any customer purchasing goods in that way. He can only contrast the mark on the goods offered him with his recollection of the mark used upon those he is seeking to buy, that is a mark as seen and remembered in actual use and not necessarily in the form as it may appear on the Register. (*Kerly, on Trade Marks, 6th ed., p. 276.*) The fact that H. M. S. Enterprise is not a steamship at all has been referred to, but not as having any real bearing on the question before us.

The Registrar, in allowing the application, held that the applicant's device of a man-of-war, and the word Enterprise, was sufficiently different from the respondents' mark as to entitle the mark to be registered. The District Judge however making use of words of Tomlin J. in *Huxley's Application*¹, comes to the conclusion that the two marks judged by the eye have undoubted characteristics so much in common, that anyone who has seen the one might, when meeting the other, undoubtedly think he was seeing a second time the thing he had seen before.

When one places the two marks with which we have to deal side by side, I agree with Mr. Garvin that they have not such marked common characteristics as the two equivalent marks in the case cited by the learned Judge. But it seems to me that that is as far as he can go. I do not agree, however, that here a mere glance at the two marks is sufficient to dispel any misapprehension as to the probability that deception may occur owing to the resemblance of the two marks. This was the conclusion come to in *Boord & Son v. Bagots, Hutton & Co., Ltd.*² It was held there that all that the evidence established was that purchasers bought according to the mark, a cat, and not according to the words, and that they look to the mark for the purpose of seeing what it is they buy. If they really look to the mark it was held deception was impossible, the only way in which deception could arise being from dishonest traders deliberately supplying goods which were not the goods really asked for, simply because the label on them happened to bear the mark of a cat. It was therefore held that on the evidence there was no reasonable probability of any such deception.

Numerous cases setting out how the law is to be applied have been cited to us, of which I will refer to two. It is well settled law, says Joyce J. in *Pomril Ltd.'s Application*,³ that where any person has registered a device, for instance the picture of a star, another person cannot come, and in respect of the same goods register the word "Star" nor could he come and register the words "Star Brand". In the same way where a person has on the register the word "Star" or any other word no one else can

¹ 41 R. P. C. 423.² (1916) 2 A. C. 382.³ 18 R. P. C. 181.

come and put on the register in respect of the same goods a device being a representation of a star, if the registration of that device would probably have the effect of the word "Star" or the name "Star" being associated with the goods. The application here was to have the device of half an apple upon the Register for cider with the name Pomril in the centre. The opposers had on the register a mark consisting of the words "Apple Brand" for the same goods. Joyce J. held that the application must be refused, apart from any question of resemblance between the proposed device and the registered device, since nothing was more likely than that the word "Apple", or "Apple Brand" would be associated or would be attempted to be associated with the applicant's goods, which would lead to deception.

It has been suggested that subsequent cases have not gone as far as this case, but it is referred to in the latest edition of Kerly on *Trade Marks* as laying down good law, and in that event it seems to me to be of considerable assistance in the case now before us.

The case of *In Huxley's Application*¹, which is referred to in the decision of the Judge of the Court below, has one or two facts in common with the case before us. The nature of the mark sought to be registered was pictorial consisting of four pictures each in its frame and having behind them the general idea of depicting pictorially the passage of oil from the well to the consumer. The right hand bottom picture represents a non-sailing ship, probably a tank-steamer, or a steamer propelled by oil fuel, proceeding over the surface of the sea. This last picture was objected to by the opponents who had on the register in respect of the same goods a mark consisting of a ship meant to represent a battleship. The opposers also had on the register at least one mark consisting of the word "Ship Brand". In addition there was evidence which established that the opposers' goods had, in fact, come to be known in different parts of the world under the title of "Ship Brand".

In dismissing the appeal and affirming the Registrar's refusal to register the new mark in respect of the portion objected to, Tomlin J. (now Lord Tomlin) pointed out that the onus was on the applicant to satisfy the Court, amongst other things, that there is no reasonable probability of the public being misled in respect of the mark. The Court may be satisfied that there is no probability of deception, or it may be certain that there will be deception, or it may come to the conclusion that it is not clear that there will not be deception. If this matter is left in doubt, the Court must refuse the application, since the applicant has not discharged the onus which is put upon him.

In considering the evidence before him, Tomlin J. was satisfied that judged by the eye the picture of the battleship bore such a resemblance to the picture of the ship in the right hand corner of applicants' mark that there was every probability of confusion. I have already stated that judged by this test alone the pictures of the ships in the marks with which we are dealing have less in common than those in Huxley's case. But that case was not decided on that point only. The opposers, as the learned Judge points out, were in an unusually strong position by reason of the fact that their registered marks included the words

¹ 41 R. P. C. 423.

"Ship Brand", and by reason of the fact, on the evidence, their goods had become known as "Ship Brand". The association of the picture of a ship, a non-sailing ship of some sort he calls it, with three other pictures, would not in his opinion deprive the former picture of its own individual significance, and under the circumstances set out so long as that picture contains its own individual significance it necessarily gave rise to the probability of confusion.

As in that case, so in the case before us the respondents (opposers) seem to me to be in a strong position by reason of the fact that their registered mark includes the words "Steamship Brand" and by reason of the fact that on the evidence their tea has become known as "Ship Brand" tea. I have already dealt with the particular significance of the device of the ship on applicant's mark and I am satisfied for the reasons I have given that if that mark is allowed to go on the register, confusion between the marks will probably result and deception will follow. The principle underlying both cases I have cited seems to me to be the same.

The appeal must therefore be dismissed with costs.

DRIEBERG J.—I agree.

Appeal dismissed.

