

Present : Fisher C.J. and Drieborg J.

1928.

CHESEBOROUGH MANUFACTURING CO. v. KUDHOOS.

96—D. C. Colombo, 1,402.

Trade mark—Application to expunge—Resemblance between the two marks—Calculated to deceive—Passing-off action—Ordinance No. 14 of 1888, s. 28 (1).

In an application to expunge a trade mark from the register the applicant must prove that the two marks so resemble each other as to deceive purchasers of ordinary caution.

Such a proceeding is in the nature of an action for infringement, and the applicant is not entitled to rely on additional matters which are connected with the trade or goods, and relevant in an action for passing off.

A PPEAL from an order directing the appellant's trade mark to be expunged from the register on the ground that it resembles the respondent's mark so clearly that it is calculated to deceive. The respondent applied to the Court under section 28 (1) of Ordinance No. 14 of 1888.

Garvin, for appellant.—The decision of the District Judge is based on the alleged similarity of the get-up. The get-up is immaterial. It is only the mark as a whole that should be looked at. Occasional points of similarity should not be made a ground for refusal to register (*Lever Bros. v. Bedingfield*¹).

The probability of deception must be substantiated². The buyers in this case are educated persons and a comparison of the marks shows that there is no likelihood of confusion (*Welsbach Incandescent Gas Light Company v. New Sunlight Incandescent Ltd.*³). It is no ground for refusal that the mark may be dishonestly used, and the presumption is in favour of honest user. There is no monopoly in common features (*Payten Ltd. v. Titus Ward*⁴).

The application should date to the date of disclaimer.

Counsel cited the following authorities :—*In re Bass Ratcliff v. Gretton Ltd.*⁵; *The Society of Motor Manufacturers v. Motor Traders Insurance Company, Ltd.*⁶; *Bond & Sons v. Bagrto Hutton & Company, Ltd.*⁷

Hayley, K.C. (with *N. K. Choksy*), for applicant, respondent.—It is clear from the resemblances in the marks, as well as in their mode of user in actual trade, that there was an intention to deceive by the use of the contested label.

¹ 16 R. P. C. 3.

² 27 Hals. 716.

³ 17 R. P. C. 401.

⁴ 17 R. P. C. 58.

⁵ 19 R. P. C. 544.

⁶ (1925) 1 Ch. 675.

⁷ (1916) 2 A.C. 382.

1928. *Cheseborough Manufacturing Co. v. Kudhoos* If an intention to deceive is proved, it is presumed that the deception has been successful, both in an action for passing off as well as in an action for infringement of a trade mark. (Proctor v. Bayly & Son¹; Lambert & Butler Ltd. v. Goodbody²; In re Cheseburgh Manufacturing Company, Ltd.³)

The Court must see the marks as they will appear in actual use. The colour also is a material factor in this connection. (Kerly, pp. 243, 252, 280, 281.)

Counsel cited the following authorities:—*Re Christiansens Trade Mark*⁴; *Pinto v. Badmon*⁵; *In re Turney & Sons' Trade Mark*.⁶

October 17, 1928. FISHER C.J.—

This is an appeal from an order directing the appellant's trade mark to be expunged from the register on the ground that it resembles the respondent's mark so closely that it is calculated to deceive.

The respondent applied to the Court under section 28 (1) of Ordinance No. 14 of 1888 (Legislative Enactments, Vol. I., p. 976), which provides that "the court may on the application of any person aggrieved . . . by any entry made without sufficient cause in any such register make such order for . . . expunging or varying the entry as the court thinks fit."

Under a similarly worded English Enactment (section 90 of the Patents, Designs, and Trade Marks Act, 1883) it was held that if in proceedings to expunge a mark an applicant makes out a case which would have justified the registering authority in refusing to register on the ground that the respondent's mark so nearly resembles the applicant's mark as to be calculated to deceive the entry must be taken to have been "made without sufficient cause." (See *re Trade Mark of La Societe Anon. des Verreries de l' Etoile*.⁷)

The issue upon which the Court decided this case is as follows: "Does the respondent's mark so resemble the applicant's mark as to be calculated to deceive, and is it an infringement of the applicant's mark?" The evidence was largely directed to matters specially appropriate to a passing-off action, and it is to be gathered from observations of the learned Judge in his judgment that in forming an opinion as to the resemblance of the two marks he allowed his mind to be influenced by the similar appearance and get-up of certain bottles which were put in evidence. He says, for instance, "respondent's pomade is sold in bottles like P4 and there can be no doubt that the applicant's bottles P1 and P4 resemble each other very closely. The bottles are of the same size

¹ 6 R. P. C. at 538.

² 19 R. P. C. at 381.

³ 19 R. P. C. 342.

⁴ 3 R. P. C. 54.

⁵ 8 R. P. C. 181 at 191.

⁶ 11 R. P. C. 37.

⁷ (1894) 1 Ch. 61.

and have very similar letters impressed on the bottles. The size of the two labels is the same and the background is similar." Later on he says "the words on the respondent's bottles appear to have been arranged in such a way as to make the effect similar."

1928.
FISHER C.J.
Chesborough
Manu-
facturing Co.
v. Kudhoos

But this is not a passing-off action, it is in the nature of an action for infringement. The distinction between passing-off action and actions for infringement is pointed out in *Kerly on Trade Marks, 5th ed.*, p. 472, in the following words: "the essential difference is plain enough. In an action for infringement the plaintiff can rely only upon the imitation of his registered mark, while in an action for passing-off he may rely on other things, or on additional things which are connected with his trade or goods."

We have nothing to do therefore with the get-up, and must look at the two marks in question as they appear on the register and then form an opinion as to whether the mark of the appellant so resembles that of the respondent that ordinary purchasers purchasing with ordinary caution are likely to be misled. (*Sebastian, 5th ed.*, p. 146). It is to be noted that this article is not an article of necessity, and the persons who purchase it are likely to be intelligent and educated. Neither of the marks in question have any predominating distinctive feature. They differ therefore in that respect from marks which have been the subject-matter of discussion and litigation, such as a diamond shape, a star, or an elephant. For an application such as this to succeed it must be proved that the label is deceptive in itself. We are in the same position as the Registrar would have been had the registration of the appellant's mark been objected to by the respondent. As pointed out in *In re Trade Marks of Bass & Co.*¹ the question is one of fact, and treating it as a question of fact and comparing the registered marks with each other, I am of opinion that the appellant's mark does not so resemble the applicant's mark as to be calculated to deceive and is not an infringement of the appellant's mark. The case of *In re Turney & Sons' Mark*,² which was cited to us, does not touch this case. That was an appeal against the refusal of the Registrar to register the mark, and there was evidence before the Court with which the Court was impressed that if the mark was registered it would be used, and that the applicants intended to use it in such a way as to lead to its being mistaken for the mark of those who opposed the registration. The Court declined to allow the register to be used for such a purpose and dismissed the appeal. Nor are the cases which were cited to us to support the proposition that when once a Court is satisfied that there is an intention to deceive it will readily come to the conclusion that the intention had been successfully given effect to in point in this case. That proposition is only applicable

¹ (1902) 2 Ch. 579.

² 11 R. P. C. 37.

1928. to cases of passing-off. When the Registrar has a label submitted
FISHER C.J. to him for registration, the question he has to consider is whether the
Cheseborough label as submitted to him for registration is likely to be mistaken
Manu- for another. As I have pointed out, we are in the same position as
facturing Co. the Registrar and must decide the question on the same materials.
v. Kudhoos

It is not necessary to decide the other point raised by Mr. Garvin, namely, that the proper date to be assigned to the respondent's application is the date when the disclaimer was made, but there is a decision which seems to be against his contention. See *J. Wigfull & Sons, Ltd. v. J. Jackson & Son, Ltd.*¹

The appeal must be allowed. The order of the learned Judge will be set aside, and the respondent will pay the costs of the appellant in this court and in the court below.

DRIEBERG J.—I agree.

Appeal allowed.

