

1934

Present : Garvin S. P. J. and Akbar J.

VEERAVAGOOPILLAI *v.* SAIBO *et al.*

85—D. C. (Inty.) Colombo, 2,033.

*Trade mark—Application to register mark resembling respondents' trade mark—Test to be applied in determining question—Whether ordinary purchasers are likely to be misled—Burden of proof.*

The appellant applied for the registration of a trade mark, in respect of flour, called the *Hanumar* brand consisting of the figure of a monkey in a standing position.

The respondents had registered a trade mark in 1913, also in respect of flour, called the *Pahlwan*, consisting of a strong man in a standing position holding up a pair of dumb-bells. Respondents' trade mark was known in the trade as the man mark.

*Held*, that the trade mark proposed by the appellant so nearly resembled the respondents' as to be calculated to deceive the public.

*Held, further*, that in the circumstances, the burden was on the appellant to satisfy the Court affirmatively that his mark was not calculated to deceive.

**A** PPEAL from an order of the District Judge of Colombo.

A. E. Keuneman (with him Choksy and D. W. Fernando), for applicant, appellant.

H. V. Perera (with him Garvin), for opponents, respondents.

*Cur. adv. vult.*

December 4, 1934. AKBAR J.—

This is an appeal from an order of the District Judge disallowing the application of the appellant to register a trade mark bearing No. 5,598 called the "Hanumar" brand consisting of the figure of a monkey in a

standing position in respect of flour. The application was opposed by the respondents on the ground that the applicant's trade mark so nearly resembled their registered trade mark No. 1,048 also in respect of flour as to be calculated to deceive the public. This latter trade mark was registered so far back as 1913 and consisted of a strong man in a standing position holding up a pair of dumb-bells in his extended hands and was called the "Pahlwan" brand (the word Pahlwan meaning a champion wrestler or strong man in Hindustani). On opposition before the Registrar the application of the appellant was allowed, but on appeal to the District Judge the Registrar's order was reversed and order was made refusing the registration of the appellant's trade mark.

Evidence has been put in in the form of affidavits and it is clear from the respondents' affidavits that they were doing a large business in flour both wholesale and retail and that their trade mark had come to be known as "the man mark". No evidence has been put in to the contrary, and the respondents' evidence on these two points has been accepted by the Registrar and the District Judge. The Registrar held against the respondents because he was of opinion (1) that the designation "man mark" used by the public was not a correct description of respondents' trade mark which was registered as "the Pahlwan mark", and (2) that the two trade marks were readily distinguishable, as appellant's figure has hair over body and a tail.

As regards the first point mentioned by the Registrar, in a case reported in 53, *L. T., N. S.* (1885) p. 23, a firm of distillers registered as a trade mark for their cherry brandy a hunting scene in connection with the word "Sportsman" and their cherry brandy consequently became generally known as "The Sportsman's" and also as "Huntsman's" and "Hunters" Cherry Brandy. Some years afterwards another firm of distillers registered a trade mark also consisting of a hunting scene and the words "Huntsman's cherry brandy", but there was no resemblance between the two hunting scenes. It was held that notwithstanding the dissimilarity in the designs the latter trade mark was "calculated to deceive". Kay J. said as follows:—"I must take it as clearly established that before the defendants registered their trade mark the plaintiffs had acquired quite generally the name of 'Huntsman's Cherry Brandy' for their brandy. I have very little difficulty in adding to that the inference that the defendants were perfectly well aware of that fact. If the defendants did not intend to pass off their cherry brandy as that of the plaintiffs, why did the defendants choose a trade mark so similar to that of the plaintiffs and calculated to induce people to buy cherry brandy under that name—a name which had become the distinguishing mark of the plaintiffs' cherry brandy? The name 'Huntsman' is not one which the plaintiffs themselves had assumed, but it was one which the public have given to their goods, because of the picture selected by them as a design. The question resolves itself therefore into this simple proposition. The plaintiffs having registered in 1876 a picture of a hunting field, and the name 'Sportsman' on that account, the name of 'Huntsman' has been largely given by the public to cherry brandy manufactured by the plaintiffs. The defendants knowing that perfectly well, in 1884 put upon the

register, for cherry brandy made by them, a trade mark consisting also of a picture of a hunting field; but instead of calling it 'Sportsman Cherry Brandy' they called it by that other name under which the plaintiffs' cherry brandy has become known, viz., 'Huntsman's Cherry Brandy'. The inference, to my mind, is irresistible that that has been done by the defendants for the purpose of passing off their cherry brandy as that of the plaintiffs. I can only say that the strongest possible evidence that the defendant's trade mark is calculated to deceive is afforded by the defendants themselves, as they have adopted it for the very purpose. The register must, therefore, be rectified by striking out the defendants' trade mark, and the defendants must pay the costs of the motion".

In the case before me the affidavits show that the respondents' trade mark had been used even before 1913 and that it has been known to the public as "the man mark" brand of flour, and that the appellant was a customer of the respondents' firm and had bought flour for a number of years under this mark; and that respondents' flour under this mark is very well known in the market and has a very good reputation. In the words of Kay J., "the name 'Huntsman' is not one which the plaintiffs themselves had assumed, but it was one which the public have given to their goods, because of the picture selected by them as a design". Here too it is the public which has given the name "man mark" to respondents' trade mark, although the word used by them in their trade mark was "Pahlwan", and the name given by the public was due to the figure of a man in a standing position selected by them in their design.

It is the idea of the mark that has to be considered. In the words of the report of Lord Herschell's Committee, "The tendency of the office has been to construe the words of the Act more favourably towards applicants for new marks than the trade have thought right. We think the difference has arisen in part from the wording of the Act. The Controller has felt unable to say that two marks 'so nearly' resemble each other as to be calculated to deceive. He has thus not considered himself at liberty to take into consideration to the extent he otherwise might, the character of the market in which the mark is to serve its purpose. Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same; so that a person acquainted with the mark first registered, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing".

In the words of Kerly on Trade Marks, "when the goods of a particular trader have become known by a name derived from his trade mark, any other mark which would be likely to suggest the use of the same name for the goods on which it is used so resembles the former as to be calculated

to deceive". So that it will be seen that the Registrar was wrong in his first ground for allowing the registration of the appellant's trade mark. What strikes one in this case is that the appellant in spite of the fact that he had an infinite number of designs to select from chose a standing figure of a man or monkey. The figure selected is not in a sitting posture or in a sleeping position. It is true that the appellant's trade mark is called the "Hanumar" brand and it is meant to represent a monkey. There is a loop on its right side which is said to be the tail and a long flourish over its head which is said to be the continuation of the tail. But the fact remains that both the trade marks consist of standing figures facing the person looking at them.

Nor does the second ground given by the Registrar appeal to me. There is no doubt that if the two figures are placed side by side, points of difference will be noted at once. But that is not the test applicable to cases of this nature. One has to consider the reactions of the appellant's trade mark on the minds of the public who buy such a common everyday necessity of life as flour, that is to say, goods which will in many instances be bought by persons who are illiterate, and who will have in their minds the picture of the outline of a man in a standing position.

In the words of Lord Cranworth in *Seixo v. Provezende*<sup>1</sup>, "If the question turned on the inquiry, whether a person having a cask of the plaintiff's and a cask of the defendants' placed before his eyes could mistake the one for the other, there could be no doubt as to the result, for the marks on the one and the other are altogether different. But that is not the question or not the sole question, to be considered. The principle on which relief is given in these cases is that one man cannot offer his goods for sale representing them to be the manufacture of a rival trader. Supposing the rival to have obtained celebrity in his manufacture, he is entitled to all the advantages of that celebrity, whether results from the greater demand for his goods or from the higher price which the public are willing to give for them, rather than for the goods of other manufacturers whose reputation is not so high . . . . It is obvious that, in these cases, questions of considerable nicety may arise as to whether the mark adopted by one trader is or is not the same as that previously used by another trader complaining of its illegal use, and it is hardly necessary to say that, in order to entitle a party to relief, it is by no means necessary that there should be absolute identity.

"What degree of resemblance is necessary from the nature of things, is a matter incapable of definition *a priori*. All that courts of justice can do is to say that no trader can adopt a trade mark so resembling that of a rival, as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled. It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rule so restricted would be of no practical use.

"If a purchaser looking at the article offered to him would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer, and would purchase it in that belief, the court considers the use of such a mark to be fraudulent. But I go further. I

<sup>1</sup> (1866) L. R. 1 Ch. 192.

do not consider the actual physical resemblance of the two marks to be the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market, may be as much a violation of the rights of that rival as the actual copy of his device. It is mainly on this ground that I have come to the conclusion that the decision of the Vice-Chancellor in the present case was correct."

In the case of *Johnston v. Orr-Ewing*<sup>1</sup>, where both the plaintiff's and the defendant's marks consisted of tickets bearing pictures of two elephants with a banner between them, the figures being differently arranged, Lord Selbourne said: "Although the mere appearance of these two tickets could not lead anyone to mistake one of them for the other, it might easily happen that they might both be taken by natives of Aden or of India, unable to read and understand the English language, as equally symbolical of the plaintiff's goods. 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".

Further in comparing the marks one has to have regard "not only to their form as they appear on the register but also to the appearance they would present in actual use when fairly and honestly used; to the nature of the goods upon which they are to be employed; to the character and size of the marks themselves; and to the probability of their becoming partially or wholly blurred or modified as ordinarily stamped or printed or by ordinary wear and tear". (See *Kerly*.)

The affidavits put in by the respondents show that these marks will be put on bags of flour and that owing to blurring effects and flour dust what may remain on the bags will generally be the outline of the figure. Moreover there will be no restriction on the use of any colour in the printing of these designs on the bags, and as contended for by respondent's counsel, the slight loop on the right of Hanumar's waist and the hair on the body may be easily obliterated and what will catch the eye then will be the outline of a human figure.

As remarked by the District Judge in a case of some doubt the burden is on the applicant to satisfy the Court affirmatively that his mark is not calculated to deceive (see *Eno v. Dunn*<sup>2</sup>).

On a review of the whole case I cannot say the District Judge came to a wrong conclusion and I would dismiss the appeal with costs.

GARVIN S.P.J.—I agree.

*Appeal dismissed.*

<sup>1</sup> (1882) 7 App. Cases 219.

<sup>2</sup> 15 Appeal Cases 252.