

1937

Present : Maartensz and Hearne JJ.

LEVER BROS. v. R. M. RENGANATHAN PILLAI.

202—D. C. Colombo, 4,160

Trade mark—Action for infringement and passing off—Impression of symbols—Similarity of impression—Calculated to deceive—Damages.

The plaintiff was the proprietor of a trade mark in respect of perfumed toilet soap. The trade mark consisted of a label having printed thereon the word "Lux" and certain designs within a fancy border.

The cake of soap had on one side the word "Lux" cut into it, below it a floral design followed by the words "toilet soap" on the other side were cut the words "Lever Bros."

The soap imported by the defendants was contained in a wrapper, the prominent feature of which was the word "Rex" smaller in size than the letters forming the word "Lux" and of a different shade.

To the left of the word "Rex" and below it was the picture of a man on a camel and some palm trees and pyramids in the distance, on one side of the cake appeared the word "Rex" and a floral design similar to the design on the plaintiff's soap, followed by the words "made in Japan".

Held, that the marks of the wrapper on the soap imported by the defendant were calculated to deceive and amounted to an infringement of plaintiff's trade mark.

Held also, by Hearne J. that the fact that the soap imported by the defendant had been detained at the Customs and had not reached the Ceylon market did not disentitle the plaintiff from bringing the action.

THE plaintiff is the owner of a registered trade mark bearing No. 5,321 and called "Lux", used in connection with the sale of perfumed soap. The plaintiff instituted this action against the defendant alleging that the latter had infringed the plaintiff's trade mark by using a wrapper on the defendant's soap called "Rex" which wrapper bore a colourable imitation of the plaintiff's mark.

The plaintiff also sued the defendant for an injunction restraining the defendant from passing off his goods as those of the plaintiff, and for damages.

The learned District Judge entered judgment for the plaintiff, and the defendant appealed.

H. V. Perera, K.C. (with him *N. Nadarajah* and *S. J. V. Chelvanayagam*), for defendant, appellant.

F. A. Hayley, K.C. (with him *N. K. Choksy*) for plaintiffs, respondents.

Cur. adv. vult.

October 5, 1937. MAARTENSZ J.—

The plaintiffs who are the proprietors of a trade mark duly registered in respect of perfumed toilet soaps have brought this action to restrain the defendant from selling certain soaps imported by him on the ground that the mark on the imported soap and on the wrapper is calculated to deceive, and amounts to an infringement of plaintiffs' trade mark.

The plaintiff's trade mark consists in the main of a label having printed thereon the word "Lux", and certain designs within a fancy border.

The plaintiff's soap is oblong in shape, with bevelled edges and white in colour. On one side of the cake is cut in the word "Lux"; in the middle of the cake, below it, is a floral design followed by the words "Toilet Soap". On the other side is cut the words "Lever Brothers" enclosed within an oblong panel.

The cakes of soap imported by the defendant are of the same shape and size, with bevelled edges, but rather darker in colour.

On one side of the cakes appears the word "Rex" and a floral design similar to the design on plaintiffs' soap, followed by the words "Made in Japan" and the number "No. 4440". On the other side appear the words "Rilax Soap Factory" within an oblong panel of exactly the same size as the panel on plaintiffs' soap. Outside the panel appear the words "Made in Japan".

The salient feature on the cakes of soap sold by the plaintiffs and imported by the defendant is, in my opinion, the two words of three letters, both of which end in the letter X. Both of them are Latin words and the letter E of the word "Rex" can be given the sound of the letter U, so that the word "Rex" can have a sound similar to the word "Lux". The defendants' mark of "Rex" and the floral design below it placed on a cake of soap of exactly the same size and shape as the soap sold by the plaintiffs is, in my judgment, calculated to deceive. The two soaps are also similar in smell, which would add to the possibility of deception.

The plaintiffs' soap is put up in a creamy wrapper of paper, patterned in small squares. The word "Lux" is printed prominently on it in dark mauve, each letter being made up of small squares. Under this word appear the words "Toilet Soap" followed by a floral design.

On each edge of the wrapper there is an ornamental design in green with mauve and yellow dots. The design is made of tiny squares.

The defendant's soap is put up in wrappers of smooth paper, rather darker in colour. The prominent feature is the word "Rex", smaller in size than the letters forming the word "Lux", and of a different shade of mauve. The letters forming the word "Rex" are built up in a slightly different way to the word "Lux".

To the left of the word "Rex" and below it there is the picture of a man on a camel, and some palm trees and pyramids in the distance.

On each side of the wrapper is an ornamental design in green with mauve and yellow dots. The design is of a different pattern to the design on plaintiffs' wrapper, and is made up of circular dots. Placed side by side the difference in the patterns is obvious. Apart, however, there is every possibility of one pattern being mistaken for the other.

It was very strongly urged that the picture of the man on the camel and the pyramids and palm trees would enable a would be purchaser to distinguish the difference between the two wrappers, and that therefore the defendant's wrapper was not calculated to deceive. On the other hand it was urged that a would be purchaser, seeing a wrapper very similar in appearance to the plaintiffs' wrapper in other respects, might well think that the plaintiffs had merely made an alteration in the design of their wrapper.

We were referred to various cases by Counsel on both sides. But I do not think it necessary to examine them all. It is impossible to say from the decided cases what amount of resemblance is necessary for the Court to hold that a mark is calculated to deceive. But the case of *John Gosnell & Co., Ltd. v. Sivaprakasam*¹ is of the greatest assistance to the plaintiff, as the Court in that case held that the use by the defendant of the word "Farina" with a certain device on the soap sold by him was an infringement of plaintiffs' mark, the essential features of which were the word "Famora" with a device which was different to the device on defendant's mark.

In an action for infringement the plaintiff can rely only upon the imitation of his trade mark. In the case of a colourable imitation, which is what the defendant's mark is said to be, the test is whether or not the defendant's mark is calculated to cause his goods to be taken by ordinary purchasers for the goods of the plaintiff.

The marks must be compared as they are seen in ordinary use on the goods they are used for, provided the plaintiff's mark does not substantially differ from the mark on the register.

The plaintiffs' mark, as used, does not differ from the registered mark, and the two marks as used do in my opinion so resemble each other that defendant's mark is calculated to cause his soap to be taken for plaintiffs' soap.

As regards the second cause of action I agree with the District Judge that there is sufficient material upon which to hold that the defendant intended to pass off his soap as the plaintiffs' soap.

The grounds upon which damages were claimed are not set out in the plaint. I do not think that the plaintiff can claim as damages the amount he had to pay the Customs for detaining the goods which is the basis of the District Judge's estimate of the damages.

I do not think, however, that the sum awarded is more than nominal and I see no reason to interfere with the District Judge's order as to damages.

I am of opinion that the appeal should be dismissed with costs and direct accordingly.

¹ (1910) 15 N. L. R. 33.

HEARNE J.—

This is an appeal by the defendant from the judgment and decree passed by the District Judge of Colombo in case No. 4,160 of his Court.

The plaintiffs first cause of action was one for infringement. The goods, the marks on which were alleged to be an infringement of the plaintiffs' mark, had been detained by the plaintiffs at the Customs and had not reached the Ceylon market. This, however, did not disentitle them to bring their action. There is authority for this *Upmann v. Forrester*¹. The plaintiffs second cause of action was designed to prevent the goods in question reaching the Ceylon market. It was alleged in the alternative that the "get-up" of the goods was calculated to deceive and to enable goods, not of the plaintiffs manufacture, to be passed off as and for the plaintiffs' goods. It is clear that they were entitled to the remedy of an injunction assuming the facts pleaded could be established.

I have no doubt that in granting a perpetual injunction in terms of the plaintiff's prayer the Judge acted wisely and properly. I agree with him that the totality of resemblances in the "get-up" of the defendant's soap to the plaintiffs' soap was undoubtedly calculated to pass off or to cause to be passed off the defendant's soap as and for the plaintiffs' soap.

The alleged infringement of the plaintiffs' mark in regard to which the Judge also found against the defendant is one that must be examined with greater care. For the plaintiffs can rely only upon the imitation of a registered mark to which they are exclusively entitled and not "those additional things proved to be connected with his trade or goods" upon which they may also rely in a "passing off" action.

The imitation by the defendant of the plaintiffs' mark would not, I venture to think, be likely to deceive literate persons. Some of the distinctive features of the plaintiffs' mark, in particular the border on the wrapper, have been reproduced by the defendant with an exactness that would be calculated to lead the unwary into thinking that the mark on the defendant's goods was the registered mark of the plaintiffs. But the word Rex (this is the name of the defendant's soap) is so unlike Lux (the trade name of the plaintiffs' soap) as to make deception in my opinion unlikely in the case of literate persons. On the other hand in the case of illiterate persons it might very well, as the Judge has found, be otherwise. An illiterate person is not concerned with letters of which he has no knowledge. The impression he receives of the name of a soap printed on a wrapper is an impression of symbols. Where a three lettered word is used in each case, the last of which "X" is one which, for reasons given by the Judge, is known to him, this mental impression of symbols, similar as to number and identical as to one of them in shape, coupled with the mental impression of the other features of the wrapper which were imitated to an extent that was only limited by the defendant's ideas of safety, would most probably deceive an illiterate into mistaking the defendant's mark for that of the plaintiffs. The Judge directed himself very properly in answering the test question, "Is the spurious mark likely to deceive?"—in reference to the persons who are the probable

¹ 24 Ch. D. 231 ; (1883) 52 L.J. Ch. D. 946.

purchasers of a cheap soap. The case of *John Gosnell & Co., Ltd. v. Sivaprakasam*¹, is an illustration of the trend of decisions in this class of case.

The plaintiffs did not suffer any injury consequent on the infringement of their registered mark, and are only entitled to nominal damages. The Judge related the amount decreed in their favour (Rs. 500) to the actual out of pocket expenses incurred by the plaintiffs in seeking to protect themselves. I am not at all sure that this is correct. But in all the circumstances of the case I do not regard Rs. 500 as being anything more than nominal.

I would dismiss the appeal with costs.

Appeal dismissed.

¹ (1910) 15 N. L. R. 33.