

1930

Present: Dalton and Akbar JJ.

JAMES *et al.* v. SOFER.

219—D. C. (Inty.) Colombo, 1,541.

Trade marks—Opposition to registration—Grounds of objection not taken before Registrar—Right to take in appeal—Ordinance No. 15 of 1925, s. 14 (8).

A party opposing an application for the registration of a trade mark is not entitled to raise at the hearing of an appeal from the decision of the Registrar a ground of objection which he did not take before the Registrar but which was known to him at the time.

A PPEAL for an order of the District Judge of Colombo.

H. V. Perera (with Garvin), for appellant.

Hayley, K.C. (with Choksy), for first and second respondents.

February 19, 1930. DALTON J.—

The applicants, two persons carrying on a partnership under the name of A. F. Jones & Co., applied under the provisions of Ordinance No. 15 of 1925 (The Trade Marks Ordinance) in January, 1927, for the registration of a trade mark in respect of tea, the mark consisting, amongst other things, of the device of a camel. The application was opposed by the present appellant, M. D. Sofer. The opposition was in the prescribed form (document "B") setting out the following grounds of opposition:—

- (1) The said trade mark resembles a trade mark I have used for a long time and to register which I made application in June, 1924, through Messrs. Harrison & Crossfield, Ltd., Colombo. I enclose a print of my mark.
- (2) Application for registration *re* the said mark has been made for goods in the same class as mine, to wit, tea.
- (3) The essential feature of the trade mark that is now proposed to be registered is the figure of a camel, which is also the exclusive feature of my mark.
- (4) A claim is made by me for the exclusive use of this design for tea.

Affidavits were filed by applicants and the opposer, and after hearing Counsel for both parties, the Registrar dismissed the opposition and admitted applicants' mark for registration. On the question of user he held that applicants had proved that they had a longer use of the mark than the appellant.

Appellant thereupon appealed to the District Court, Colombo, under the provisions of section 14 (5) of the Ordinance. When the matter came before the District Court, Counsel for appellant stated he wished to raise further grounds of opposition, alleging that such further grounds of opposition had been considered by the Registrar in his decision and that he required no leave of the Court to do so. The learned District Judge held that it was immaterial whether the Registrar had or had not considered grounds of objection outside those set out by the opposer; that the raising of further grounds is expressly governed by the provisions of section 14 (8) of the Ordinance, and on the appeal appellant must be restricted to the grounds of opposition set out in the document " B " filed by him.

Thereupon Counsel for appellant asked for the leave of the Court to state further grounds of opposition. Upon this application the learned District Judge directed a written motion to be put in setting out the further grounds of objection which he wished to raise so that applicant should have notice so that he might know exactly what the further grounds of opposition were, and also decide whether or not he would withdraw his application. Appellant thereupon filed further grounds set out in document X. The effect of the further grounds was to show that there was a trade mark No. 2,166 identical with applicant's mark on the register, that so long as that mark remains on the register applicants cannot proceed with their application, and that their user of the mark sought to be registered was unlawful. The learned Judge refused their application, basing his refusal upon the decision of Swinfen Eady J. *In the Matter of an Application for a Trade Mark by Kenrick and Jefferson, Ltd.*¹. He thereupon proceeded with the appeal on the question of user. He has dealt with this question at considerable length and has come to the same conclusion as the Registrar. The appeal was therefore dismissed with costs.

The opposer now appeals to this Court under the provisions of section 51 of the Ordinance, both from the conclusion of the District Judge on the question of user and from his refusal to allow appellant leave to raise new grounds of objection.

On the question of user, as between the parties before us, I see no reason whatsoever to differ from the finding of the Registrar and the District Judge upon this point. There is ample evidence to support their finding and it must stand.

The principal ground of appeal is on the question of allowing or disallowing fresh grounds of objection. To deal with that it is necessary to refer in more detail to what took place before the Registrar.

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I have set out above the original grounds of objection of the appellant. To them the applicants filed a counter statement as prescribed setting out the alleged facts of their user of the device. That statement contains amongst others the following paragraph:—

- (2) That we have made every endeavour to register this mark since 1920, but application was refused by the Registrar of Trade Marks as a mark, the essential particulars of which were the device of three camels and the word "Camels" was already on record under No. 2,166 in class 42 in the name of Peek Bros. and Winch, Ltd.

Tea amongst other foods falls within class 42.

The parties thereupon filed affidavits in support of their cases, and no mention is made by the opposer of mark No. 2,166 until his last affidavit D 3 where in the last paragraph he makes the following statement:—

If as the applicants state in their counter statement Messrs. Peek Bros. and Winch have already registered this trade mark in their name for goods under class 42, I doubt whether the application by the applicants for registration of this mark can be allowed without the consent and approval of Messrs. Peek Bros. and Winch.

Before the matter came on for hearing then before the Registrar the opposer was fully aware of the fact that mark No. 2,166 was on the register. His grounds of opposition show that he was putting forward a claim to the exclusive user of the mark, the subject of the applicants' application. It must have been obvious to him therefore that if mark No. 2,166 was identical in all essential particulars with that, the subject of the present application, it was not only a bar to applicants' claim but also to his claim to register it for himself. I take it therefore he must, with these facts in his knowledge, have elected not to put forward any ground of objection based upon the alleged existence on the register of the mark that applicants were seeking to register.

Any ground of objection based upon the allegation that the mark resembles a mark or marks already on the register must be supported by the requisite information set out in Rule 45 of the Trade Mark Rules, 1926. It is clear there was no such ground of objection raised before the Registrar. Counsel for appellant urges however that the Registrar dealt with this objection. When the Registrar's judgment was read to us at first there seemed to me to be some ground for this argument, but further examination shows that he was merely dealing with an argument raised by Counsel at the end of his opening, an argument not based upon any of the grounds of objection. The Registrar points out that that aspect of the case had already been decided, not of course in the proceedings then

going on before him, but when the application had been received. It is clear to me that he did not deal with any such ground of opposition at the hearing before him because he could not do so. The provisions of section 14 (8) of the Ordinance are definite. He had further no material before him to deal with it, even if he had the power to deal with it without it being raised in the grounds of objection. Counsel for appellant before the Registrar in opening his case did state that so long as mark No. 2,166 was on the register the application of the applicants could not be allowed, but that was no part of his case. The Registrar deals with this argument in his decision. He points out that when the present applicants applied in December, 1925, to register this mark, the Registrar at that time seems to have considered that the mark was similar to and likely to be confused with the mark No. 2,166 then and still on the register. Upon this applicants abandoned their application, not questioning the opinion expressed then. They have however renewed their application again and the Registrar definitely points out that this question of the similarity of mark No. 2,166 with the device they wish registered has been duly considered and the application has been allowed to proceed. There is nothing before us to show that that conclusion was wrong. It will be noted that no objection has been lodged by any owner of the mark No. 2,166, although that would not relieve the Registrar from the duty imposed upon him under sections 11 and 19 of the Ordinance of not registering certain marks mentioned. The question of the identity of mark No. 2,166 with the mark that applicants seek to register did not arise in the proceedings before the Registrar and does not arise before us. The appellant (opposer) had full opportunity if he wished to raise the question, and I think the District Judge was quite right in refusing to allow him to raise it on appeal before him. The reasoning applied by Swinfen Eady J. in the case cited above has exact application to this case. He said there that it would be an exceedingly bad precedent if he were to say that, without any explanation at all, without any special grounds, an opponent was at liberty to bring forward on appeal as a matter of course grounds of objection which he knew of before the Registrar but deliberately abstained from raising. As in that case, so here, as I have pointed out above, there is some ground for the conclusion that the opposer deliberately abstained from raising this ground of objection. No explanation has been offered, no special ground has been put forward, apart from the argument that the Registrar dealt with this objection which, as I have pointed out, is not correct. The appeal is dismissed with costs.

AKBAR J.—I agree.

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Appeal dismissed.