

Mar. 28, 1911

Present : Lascelles A.C.J. and Van Langenberg A.J.

LUKMANJEE v. AKTIEBALAGE.

60—D. C. Colombo, 459.

Trade mark—Matters to be considered on application for registration—Disclaimer of any right to exclusive use of any part of device must be made in application itself.

In considering the question whether a trade mark sought to be registered has such a resemblance to the opponent's registered trade mark as to be calculated to deceive, the Court must not merely look at the marks as they stand side by side, but to the appearance they would present in actual use when fairly and honestly used.

When the essential particulars consist partly of words in the English language, regard may be had to the fact that the article may be sold in a market where the purchasers cannot read English characters. But the most important principle is that the mark must be looked at as a whole, and regard must be had for what has been termed "the net impression."

A person applying for the registration of a trade mark must disclaim in the application itself any right to the exclusive use of any part of his device. A disclaimer cannot be made to the Court during the inquiry.

THE facts appear sufficiently from the judgment.

Morgan de Saram, for appellant.

Hayley (with him *Elliott*), for respondent.

Cur. adv. vult.

March, 28, 1911. LASCELLES A.C.J.—

This is an appeal from the refusal of the District Court of Colombo to direct registration of the applicant's mark relating to safety matches. The question involved is whether the mark has such resemblance to the opponent's registered trade mark as to be calculated to deceive.

It is admitted that application No. 482 ("Three Bowls") rests on the same footing as the application under consideration (481), and that its admission or rejection depends upon the result of this

appeal. The particulars of the mark which the appellant seeks to have registered are as follows :—

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The essential particulars of the trade mark are as follows :—(a) The distinctive device as above set forth ; (b) the words “ Three Cups ” ; (c) the body colour of the label is yellow. The three cups are printed in red on the yellow body colour in the middle of the label. The words “ Three Cups ” are printed on the upper part of the label, and the words “ Safety Matches ” are printed on the lower part of the label, all in yellow type on black semi-circular bars. The four scrolls are in yellow, in the four corners of the label, on red ground. On either side of the label there are three red lines, as in the label indicated. The whole of the label is enclosed on all four sides in two bands and a thin black band, and the outermost band in yellow. The applicant disclaims any right to the exclusive use of the added matter.

The opponent's trade mark is represented in the *Government Gazette* of December 4, 1896.

The applicant's mark differs from the opponent's trade mark in certain respects. It bears the words “ Three Cups ” instead of the words “ Three Stars,” and the design of three cups with saucers instead of three stars. In other respects, including the colour of the different parts of the design, the applicant's mark corresponds exactly with the opponent's label. The general resemblance between the two is very striking. In comparing the applicant's mark, it is important to bear in mind the principles on which such comparison should be made. The Court must not merely look at the marks as they stand side by side, but to the appearance they would present in actual use when fairly and honestly used. (*Johnston v. Orr-Ewing*.¹) When the essential particulars consist partly of words in the English language, regard may be had to the fact that the article may be sold in a market where the purchasers cannot read English characters. (*Ibid*). But the most important principle is that the mark must be looked at as a whole, and regard must be had for what has been termed “ the net impression.” (*The Taendstikker case*.²)

Bearing these principles in view, there is no room for doubt that in spite of some differences in detail the applicant's mark regarded as a whole is calculated to deceive purchasers into the belief that they are buying goods bearing the opponent's trade mark.

The applicant has repeated the request which he made in the District Court, that he might be allowed to register his mark on the condition of disclaiming the right to the exclusive use of any part of his device except the three cups, treating the rest of the device as common to the trade.

A reference to “ The Trade Marks Ordinance, 1888,” as amended by subsequent Ordinances, shows that such a disclaimer is not

¹ 7 App. Cases 219.

² 3 R. P. C. 54.

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permissible. Our Ordinance is a reproduction of the Imperial Act of 1883, as amended by the Act of 1888. The conditions under which disclaimers are allowed are strictly defined.

The Ordinance allows the addition to the essential particulars of "any letters, words, or figures, or combination of letters, words, or figures," but requires the applicant to state in his application the essential particulars of his trade mark, and to disclaim any right to the exclusive use of the added matter (section 2). The Ordinance also, by section 17, allows the addition of any distinctive word or combination of words, though the same is common to the trade, upon a similar condition as to disclaimer. In both cases the Ordinance requires that the disclaimer must be made in the application ; and the English Courts have treated this requirement as imperative. See *Kerley on Trade Marks* (3rd ed.), p. 218. These provisions obviously do not allow a disclaimer of the nature suggested.

I think that the decision of the District Judge is right, and that the appeal should be dismissed with costs.

VAN LANGENBERG A.J.—

I am of the same opinion.

Appeal dismissed.

