

# LAW OF TRADE MARKS

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- I. Registration of trade marks
- II. Infringement and passing off

This survey of trade mark cases presents the general principles of law laid down by the Supreme Court of India during 1970. Although only a few cases came before the court during the survey period, an attempt is made to point out their special significance.

## I. REGISTRATION OF TRADE MARKS

### Deceptive similarity

The *Trade and Merchandise Marks Act, 1958* provides for protection of trade marks by their registration.<sup>1</sup> It protects traders against any infringement in future course of business. The registration is a *prima facie* evidence that the registered proprietor is the legal owner of the trade mark. The Act empowers the Registrar of Trade Marks to examine thoroughly and to see that there is no deceptive similarity or any cause of confusion before a trade mark is registered.

In *K. Krishna Chettiar v. Ambal & Co.*,<sup>2</sup> the Supreme Court had to consider two points: first, the criteria to decide likelihood of deception with enlisting trade mark while registering a new trade mark; second, whether the Registrar's opinion as an expert in the matter, should be lightly disturbed.

In this case, the appellant filed an application for registration of a trade mark which consisted of a label containing three panels. The first and third panels contained in Tamil, Devanagri, Telgu and Kannada the equivalents of the words "Sri Andal Madras Snuff", and the second panel in the centre contained the picture of goddess Sri Andal and the legend "Sri Andal". This trade

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1. Section 4 to 17. See also V.D. Kulshreshtha, *Commentary on the Trade and Merchandise Marks Act, 1958*, 33-161

2. A.I.R. 1970 S.C. 146.



mark was in respect of "snuff manufactured in Madras". The respondent opposed its registration on the ground that the proposed trade mark was deceptively similar to their registered trade marks which they were using for some than half a century. The respondents were the proprietors of two registered trade marks. The first<sup>3</sup> trade mark consisted of a label which contained a device of a goddess Sri Ambal seated on a globe floating on water enclosed in a circular frame with the legend "Sri Ambal parimala Snuff" at the top of the label and the name and address "Sri Ambal and Co., Madras" at the bottom. Another<sup>4</sup> Trade Mark consisted of the expression "Sri Ambal".

The main question to be decided was whether the appellants proposed trade mark "Sri Andal" was deceptively similar to the respondents' mark "Sri Ambal". The Registrar of Trade Marks held that the sound of "Ambal" does not so nearly resemble the sound of "Andal" in spite of certain letters being common to both the marks, as to be likely to cause confusion or deception among a substantial number of persons. The respondents filed an appeal and the Madras High Court held that the words "Ambal" and "Andal" have great phonetic similarity and that they are undistinguishable having the same sound and pronunciation. It was also stated that the danger of confusion between the two phonetically allied names was imminent and unavoidable. The appellant's application for registration of trade mark was, therefore, rejected and the respondents' appeal was allowed. Further, the Division Bench of the Madras High Court dismissed the appeal. On special leave the Supreme Court approved the findings of the Single and Division Benches of the Madras High Court.

According to the Supreme Court the word "Ambal" was an essential feature of the respondent's trade mark. The appellant's trade mark if used in a normal and fair manner would be known by its distinguishing feature, "Andal". The Court held that there was a striking similarity and affinity of sound between the words "Andal" and "Ambal" and that there was a real danger of confusion between the two marks. Bachawat J., observed:

There is no visual resemblance between the two marks, but ocular comparison is not always the decisive test. The resemblance between the two marks must be considered with reference to the

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3. Trade Mark No. 126808.

4. Trade Mark No. 146291.

ear as well as the eye. There is a close affinity of sound between "Ambal" and "Andal".<sup>5</sup>

While considering the second question the Supreme Court expressed the view that the opinion of the Registrar of Trade Mark is based on expert knowledge and it should not be lightly disturbed. But where there are concurrent findings of the two appellate courts they are binding in appeal under article 136 of the Constitution. The appellants should prove that the concurrent findings of the two courts was erroneous and the conditions of section 12(1) of the *Trade and Merchandise Marks Act* should also be fulfilled.<sup>6</sup>

The question of "deceptive similarity", in connection with the registration of a trade mark, was also considered by the Supreme Court in *Roche & Company v. Manners & Company*.<sup>7</sup> In this case the appellant was granted registration of its trade mark "PROTOVIT" in respect of Pharmaceutical preparations which was used on Multivitamin preparations in liquid and tablet form. After about eleven years the respondents applied for registration of its trade mark "DROPOVIT" in respect of medicinal and pharmaceutical preparations and substances and their trade mark was also registered. Subsequently the appellant applied for rectification of the Register by removal therefrom of the respondent's trade mark on the ground that the respondent's mark was likely to deceive or cause confusion. Mr. Justice Tarkunde of the Bombay High Court upholding the decision of the Joint-Registrar of Trade Marks rejected the appeal holding that there was no deceptive similarity between the two trade marks. The Division Bench also dismissed the appeal. The question before the Supreme Court for consideration in appeal was whether the word respondent's mark "DROPOVIT" was deceptively similar to the appellant's mark "PROTOVIT". The Supreme Court also rejected the appellant's plea for rectification of the register on the ground that there was no likelihood to deceive or cause confusion by the respondent's trade mark. Laying down a very important principle of law through the judgment of the Supreme Court, Mr. Justice Ramaswami observed:

It is also important that the marks must be compared as a whole. It is not right to take portion of the word and say that because

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5. *Id.* at 149.

6. *Id.* at 148.

7. A.I.R. 1970 S.C. 2062.



that portion of the word differs from the corresponding portion of the word in the other case there is no sufficient similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark.<sup>8</sup>

## II. INFRINGEMENT AND PASSING OFF

### Distinction and similarity

In *Ruston and Hornsby Ltd., v. Zamindara Engineering Company*,<sup>9</sup> a novel fact situation was presented before the Supreme Court to decide whether the respondent infringed the appellant's trade mark. The appellant, Ruston Hornsby (India) Ltd., a subsidiary of an English Company, was manufacturing and selling in India internal combustion engines under the trade mark "RUSTON". The respondent, Zamindara Engineering Company, was carrying on business in the manufacture and sale of diesel internal combustion engines under the trade mark "RUSTAM INDIA". The appellants claimed that the respondent's use of trade mark "RUSTAM INDIA" was an infringement of its registered trade mark "RUSTON". The Allahabad High Court held that there was a deceptive resemblance between the word "Ruston" and the word "RUSTAM" and, therefore, it constituted infringement by the respondent. In appeal it was observed by the Supreme Court that this point was not raised by the appellant and that the main question for decision was whether the suffix "INDIA" used by the respondent may be permitted. The Supreme Court held that as the respondent's trade mark was deceptively similar to that of the appellant, the fact that "INDIA" was added to "RUSTAM" was of no consequence and its use infringed the trade mark of the appellant.

The decision of the Supreme Court gained special importance as it clearly laid down the points of distinction and similarity between an action for infringement and an action for passing off. Delivering the judgment of the Court, Mr. Justice Ramaswami observed :

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8. *Id.* at 2065. The Court also relied on the decisions in *Aristoc Ltd. v. Rysta Ltd.* (1945). 62 R.P.C. 65, *Tokalon Ltd. v. Davidson & Co* (1915) 32 R.P.C. 133.

9. A.I.R. 1970 S.C. 1649.

Apart from the question as to the nature of trade mark the issue in an infringement action is quite different from the issue in a passing off action...nevertheless...in an infringement action, an injunction would issue as soon as it is proved that the defendant is improperly using the trade mark...the action for infringement is a statutory right. It is dependent on the validity of the registration.....On the other hand the gist of a passing-off action is that. A is not entitled to represent his goods as the goods of B but it is not necessary for B to prove that A did this knowingly or with any interest to deceive.<sup>10</sup>

Referring to the similarities in the two actions, Mr. Justice Ramaswami observed :

The two actions, however, are closely similar in some respects..... "The statute law relating to infringement of trade marks is based on the same *fundamental idea* as the law relating to passing-off".<sup>11</sup> The test as to likelihood of confusion or deception arising from similarity of mark is the same both in infringement and passing-off actions.<sup>12</sup>

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10. *Id.* at 1650.

11. As observed by the Master of the Rolls in *Savilla Perfumery Ltd , v. June Perfect Ltd.* (1914) 58 R.P.C. 147.

12. *Id.* at 1651.