

Corn Products Refining Co

Vs

Shangrila Food Products Ltd

Civil Appeal No. 319 of 1955

(S. K. Das, J. L. Kapur, A. K. Sarkar JJ)

08.10.1959

JUDGMENT

SARKAR J. –

This appeal arises out of an application made under the Trade Marks Act, 1940, hereinafter called the Act, for registration of a trade mark. The application was made by the respondent and it was opposed by the appellant.

The respondent is a manufacturer of biscuits. On November 5, 1949, it made the application for registration of the mark 'Gluvita' in respect of the goods specified in class 30, which mark, it appeared later, it had not used prior to that date. The Registrar ordered the application to be advertised before acceptance on the respondent's agreeing to limit the registration to biscuits only which were one of the classes of goods specified in class 30.

The appellant is a corporation organised under the laws of the State of New Jersey in the United States. On August 31, 1942, it had registered the mark 'Glucovita' under the Act in class 30 in respect of "Dextrose (d-Glucose powder mixed with vitamins), a substance used as food or as an ingredient in food; glucose for food." On the same date the appellant had also registered the same trade mark in class 5 in respect of "Infants' and invalids' foods."

The appellant opposed the respondent's application contending that it should be refused under ss. 8(a) and 10(1) of the Act to which opposition the respondent duly filed a counter statement. Both sides filed affidavits in support of their respective cases.

The Deputy Registrar held that s. 10(1) did not apply, for biscuits included in class 30 were not goods of the same description as glucose powder mixed with vitamins which was in the same class. He further held that the words 'Glucovita' and 'Gluvita' were not visually or phonetically similar and that there was no reasonable likelihood of any deception being caused by or any confusion arising from, the use of the respondent's proposed mark. In regard to s. 8(a), he held applying the cases of *In re* : an application by Smith Hayden & Coy. Ltd. [(1945) 63 R.P.C. 97] that the syllable 'co' which was absent in the respondent's proposed mark sufficiently distinguished the two marks and made it impossible for any one to be deceived or confused. One of the findings made by the Deputy Registrar was that the appellant had acquired a reputation and goodwill for its trade mark 'Glucovita' in respect of glucose powder mixed with vitamins.

The appellant then preferred an appeal to the High Court at Bombay from the order of the Deputy Registrar. That appeal was heard by Desai, J., exercising the original jurisdiction of that Court. It

was not seriously pressed before him on behalf of the appellant that the goods were of the same description and he himself also came to the conclusion that they were not so. He, therefore, held that the registration could not be refused under s. 10(1) of the Act. Desai, J., agreed with the Deputy Registrar's finding that the appellant had acquired a reputation among the public for the mark 'Glucovita' in respect of glucose powder mixed with vitamins. He however disagreed with the view of the Deputy Registrar that the respondent's mark was not likely to cause deception or confusion. He held that the two marks were sufficiently similar so as to be reasonable likely to cause deception and confusion. He, therefore, set aside the order of the Deputy Registrar and held that the respondent's mark could not be registered in view of s. 8(a).

Now the respondent appealed from the judgment of Desai, J. This appeal was heard by Chagla, C.J., and Shah, J., of the same High Court. The learned Judges of the appellate bench took the view that there was no evidence that the appellant's mark had acquired any reputation among the public but that the evidence produced showed that it had acquired a reputation among the tradespeople only who were discerning and were not likely to be deceived or confused. According to them, the public not being aware of the reputation of the appellant's trademark were not likely to be deceived or confused by the use by the respondent of its proposed trademark. They also held that the evidence established that there were a series of marks in which the prefix or suffix 'Gluco' or 'Vita' occurred and that it could not therefore be said that the common features 'Gluco' and 'Vita' were only associated with the manufacture of the appellant's goods. On both these grounds they held that the proposed mark of the respondent was not likely to confuse or deceive any one. In the result, they set aside the order of Desai, J., and restored that of the Deputy Registrar. The appellant has now appealed to this Court from the judgment of the appellate Judges of the High Court.

As we have earlier stated, the appellant had opposed the registration of the respondent's mark under s. 8(a) and also under s. 10(1). In order that s. 10(1) might apply to the case, the appellant had to establish that its mark had been registered in respect of the same goods or description of goods for which the respondent had made its application for registration. On this question the decisions of the Deputy Registrar and Desai, J., are against the appellant. Before the appellate Judges of the High Court the appellant proceeded on the basis that the goods were not of the same description. Before us also the appellant has adopted the same attitude. That puts s. 10(1) out of the way. We are thus left only with the question whether s. 8(a) prevents the registration of the respondent's mark.

In our judgment the view of the appellate Judges of the High Court that there was no evidence that the appellant's trade mark had acquired a reputation among the public cannot be sustained. In coming to this view, they relied on the affidavits filed by the appellant wherein it was stated that "Glucovita is a well-known mark in the trade" and denoted only the products of the appellant. We think that the learned appellate Judges put too strict a meaning on the words "in the trade" in thinking that they referred only to the tradespeople. In our view, these words may refer also to the public. If they do, then of course, that would be evidence that the appellant's mark had acquired a reputation among the public.

But apart from this, there is other evidence on the record to support the conclusion that the appellant's mark had acquired a reputation among the public. The appellant had in its opposition categorically stated that its mark had acquired a reputation among the Indian buying public. There is no clear denial of this in the counter-statement filed by the respondent. There is further ample evidence to show that the appellant's goods under its mark 'Glucovita' were sold in very large quantities in small containers of one pound and four ounces capacities. The small sizes of the containers would indicate that the goods were sold to the public for if those sales had been to

tradespeople for industrial purposes, they would have been made in bulk on in much larger containers. It appears that the appellant spent considerable sums for the advertisement of its mark 'Glucovita' in ordinary popular journals and this would indicate that it had a large sale for its goods among the general public. But the most conclusive evidence of the sale of the appellant's goods under the mark 'Glucovita' to the general public comes from the affidavits filed by the respondents itself. From the affidavit of K. M. Jamal, a partner in a firm of Pawar and Co., filed by the respondent, it appears that "a number of customers come to buy the products 'Gluvita' and the products 'Glucovita'." Similar statements appear in eight other such affidavits. The evidence provided by these affidavits make it perfectly clear that the appellant's mark had acquired a reputation among the general buying public. We think it right in this connection also to refer to the respondent's grounds of appeal against the judgment of Desai, J. In these the respondent does not dispute, and in fact it assumes, that the appellant's mark had acquired a reputation among the public. We are, therefore, fully satisfied that the appellant has established that its mark has acquired a reputation among the buying public.

In connection with the question of reputation, the learned appellate Judges seem to have fallen into another curious error. They said "A commodity may acquire reputation by its being made by a particular manufacturer and the consumers may require not a particular commodity but the commodity made by a particular manufacturer. It is only in the latter case that it could be said that the commodity manufactured by a particular manufacturer has acquired a reputation among the public. On those affidavits there is not even a suggestion that the public wanted the 'Glucovita' powder mixed with vitamins manufactured by the respondent and not by anybody else." The respondent referred to by the learned Judge is the appellant before us. We are unable to agree with the view expressed by them. It seems clear to us that what is necessary is that the reputation should attach to the trade mark; it should appear that the public associated that trade mark with certain goods. The reputation with which we are concerned in the present case is the reputation of the trade mark and not that of the maker of the goods bearing that trade mark. A trade mark may acquire a reputation in connection with the goods in respect of which it is used though a buyer may not know who the manufacturer of the goods is.

In our view, therefore, it would be wrong in this case to say that the appellant's trade mark had not acquired any reputation among the general public and that hence there is no reasonable apprehension of their being confused or deceived by the use of the respondent's proposed mark.

The second point on which the learned appellate Judges based themselves in arriving at the conclusion that there was no reasonable apprehension of confusion or deception was, as we have earlier stated, that there were various trade marks with a prefix or suffix 'Gluco' or 'Vita' and that made it impossible to say that the common features 'Glu' and 'Vita' were only associated with the appellant's products. This view was founded on a passage which the learned appellate Judges quoted from Kerly on Trademarks, 7th Edn. p. 624. That passage may be summarised thus : Where there are a "series" of marks, registered or unregistered, having a common feature or a common syllable, if the marks in the series are owned by different persons, this tends to assist the applicant for mark containing the common feature. This statement of the law in Kerly's book is based on *In re* : an application by Beck, Kollar and company (England) Limited [64 R.P.C. 76]. It is clear however from that case, as we shall presently show, that before the applicant can seek to derive assistance for the success of his application from the presence of a number of marks having one or more common features which occur in his mark also, he has to prove that those marks had acquired a reputation by user in the market. We will read a portion of the judgment at pp. 82 & 83 in Beck, Kollar & Co's case [64 R.P.C. 76] from which what we have stated earlier, appears :

"I am disposed to agree with Mr. Burrell's submission that the "series" objections is primarily founded upon user, because the inference which the Registrar is asked to draw is that traders and the public have gained such a knowledge of the common element or characteristic of the "series" that when they meet another mark having the same characteristic they will immediately associate the later mark with the "series" of the marks with which they are already familiar. But I do not think that this statement necessarily implies that the whole issue must be determined solely under the provisions of sec. 11, as I will now endeavour to explain.

"When an application for registration is before the Registrar it frequently happens that the search for conflicting marks reveals several marks having some characteristic feature in common with the mark of the application, which marks may stand on the Register in the name of one proprietor only, or in the name of several different proprietors. At this stage, when the matter is one between the applicant and the Registrar, the latter generally has before him no evidence as to whether the registered marks are in actual use or not, but in forming an opinion under Sec. 12 as to whether or not confusion or deception is likely to arise, he is bound, I think, in the absence of evidence to presume that, prima facie some at least of the registrations have been effected bona fide by persons who at the date of their respective applications were using or proposed in the near future to use their marks. If, therefore, all the marks were owned by one proprietor, the Registrar would presume that the latter was using a "series" of marks and judge the conflict between the applicants' mark and each of the proprietor's marks with this consideration in mind. Of course, if the registrations merely consisted of one and the same word registered separately in respect of several articles to be found in a single class of the Trade Marks Schedules, the Registrar would in general regard all these registrations as but the equivalent of a single registration covering all the items, for they would not constitute a "series" as now under discussion. On the other hand, if the registered marks found were owned by several different proprietors, this would be a circumstance which might considerably assist the applicant, who would be in a position to submit that the common characteristic was one well recognised in marks in use in the particular trade. In short, when the Registrar comes to compare the applicant's mark with the registered marks, using the principles laid down in the "Pionotist" case the presence of marks on the Register other than the one with which the comparison is being made is regarded as one of the surrounding circumstances which he is required to take into account.

"But when the same question comes before the Registrar in opposition proceedings, it appears to me that he is no longer in a position to make any presumption as regards the surrounding circumstances, but that before he can draw the suggested inference based upon the user of other marks either in the applicant's or the opponent's favour, any such user must be established by evidence (see, e.g. Harrods Ld.'Application, 52 R.P.C., p. 70, 1. 39-p. 71, 1. 15, where the Registrar refused to draw the necessary inference in favour of the applicants in the proceedings)."

We have no reason to think that Kerly in stating the law on the subject intended to depart from the principle stated in the passage that we have just now read, from Beck, Kollar & Co's case.

We may also refer to In re : Harrods' application [52 R.P.C. 65] mentioned in the quotation from

Beck, Kollar & Co's case [64 R.P.C. 76] set out in the preceding paragraph. It was there said at p. 70,

Now it is a well recognised principle, that has to be taken into account in considering the possibility of confusion arising between any two trademarks, that, where those two marks contain a common element which is also contained in a number of other marks in use in the same market such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those features. This principle clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the market in which the marks under consideration are being or will be used.

The series of marks containing the common element or elements therefore only assist the applicant when those marks are in extensive use in the market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now in the present case the applicant, the respondent before us, led no evidence as to the user of marks with the common element. What had happened was that Deputy Registrar looked into his register and found there a large number of marks which had either 'Gluko' or 'Vita' as prefix or suffix in it. Now of course the presence of a mark in the register does not prove its user all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register. If any authority on this question is considered necessary, reference may be made to Kerly p. 507 and Willesden Varnish Co. Ltd. v. Young & Marten Ltd. [39 R.P.C. 285 p. 289]. It also appears that the appellant itself stated in one of the affidavits used on its behalf that there were biscuits in the market bearing the marks 'Glucose Biscuits', 'Gluko biscuits' and 'Gluko Lactine biscuits'. But these marks do not help the respondent in the present case. They are ordinary dictionary words in which no one has any right. They are really not marks with a common element or elements. We, therefore, think that the learned appellate Judges were in error in deciding in favour of the respondent basing themselves on the series marks, having 'Gluko' or 'Vita' as a prefix or a suffix.

We have already said that in our view the mark 'Glucovita' has acquired a reputation among the general buying public. The first question that then arises is whether the marks 'Glucovita' and 'Gluvita' are so similar as to be likely to cause confusion to the buying public or deceive them. On this matter, we have not the advantage of the view of the learned appellate Judges of the High Court. They did not express any view on this aspect of the question at all. We are however inclined to think that their answer to the question would have been in the affirmative. However that may be, the Deputy Registrar felt that the words were not so similar as to be likely to give rise to confusion or to cause deception. He felt that the syllable 'co' in the appellant's mark was an emphatic characteristic and was not likely to be slurred over. He apparently felt that this syllable would prevent any confusion arising between the two marks or any person being deceived by the use of them both. He thought that the test down in what is called the "Ovax" case (In re : an application by Smith Hayden and Co. Ltd. [63 R.P.C. 97] should be applied and that the emphatic characteristic of the second syllable in the mark 'Glucovita' should decide that there was no likelihood of confusion arising. Desai, J., thought that the Deputy Registrar was wrong.

We think that the view taken by Desai, J., is right. It is well known that the question whether the two marks are likely to give rise to confusion or not is a question of first impression. It is for the court to decide that question. English cases proceeding on the English way of pronouncing an English word by Englishmen, which it may be stated is not always the same, may not be of much assistance in our

country in deciding questions of phonetic similarity. It cannot be overlooked that the word is an English word which to the mass of the Indian people is a foreign word. It is well recognised that in deciding a question of similarity between two marks, the marks have to be considered as a whole. So considered, we are inclined to agree with Desai, J., that the marks with which this case is concerned are similar. Apart from the syllable 'co' in the appellant's mark, the two marks are identical. That syllable is not in our opinion such as would enable the buyers in our country to distinguish the one mark from the other.

We also agree with Desai, J., that the idea of the two marks is the same. The marks convey the ideas of glucose and life giving properties of vitamins. The *Aquamatic* case (*Harry Reynolds v. Laffeaty's Ld.*) [1958 R.P.C. 387] is a recent case where the test of the commonness of the idea between two marks was applied in deciding the question of similarity between them. Again, in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonable likely to cause a confusion between them.

It was then said that the goods were not of the same description and that therefore in spite of the similarity of the two marks there would be no risk of confusion or deception. We are unable to accept this contention. It is true that we have to proceed on the basis that the goods are not of the same description for the purposes of s. 10(1) of the Act. But there is evidence that glucose is used in the manufacture of biscuits. That would establish a trade connection between the two commodities, namely, glucose manufactured by the appellant and the biscuits produced by the respondent. An average purchaser would therefore be likely to think that the respondent's 'Gluvita biscuits' were made with the appellant's 'Gluco vita' glucose. This was the kind of trade connection between different goods which in the "*Black Magic*" case (*In re : an application by Edward Hack* [58 R.P.C. 91]) was taken into consideration in arriving at the conclusion that there was likelihood of confusion or deception. The goods in this case were chocolates and laxatives and it was proved that laxatives were often made with chocolate coatings. We may also refer to the "*Panda*" case (*In re : an application by Ladislav Jelinek* [63 R.P.C. 59]). The goods there concerned were shoes and shoe polishes. It was observed that shoe polishes being used for shoes, there was trade connection between them and that this might lead to confusion or deception though the goods were different. The application for registration was however refused under that section of the English Act which corresponds to s. 8 of our Act on the ground that the opponents, the manufacturers of shoes, had not established a reputation for their trademark among the public.

It is true that in both the above-mentioned cases the two competing trade marks were absolutely identical which is not the case here. But that in our opinion makes no difference. The absolute identity of the two competing marks or their close resemblance is only one of the tests for determining the question of likelihood of deception or confusion. Trade connection between different goods is another such test. *Ex hypothesi*, this latter test applies only when the goods are different. These tests are independent tests. There is no reason why the test of trade connection between different goods should not apply where the competing marks closely resemble each other just as much as it applies, as held in the "*Black Magic*" and "*Panda*" cases, where the competing marks were identical. Whether by applying these tests in a particular case the conclusion that there is likelihood of deception or confusion should be arrived at would depend on all the facts of the case.

It is then said that biscuits containing glucose are manufactured with liquid glucose whereas the appellant's mark only concerns powder glucose. We will assume that only liquid glucose is used in

the manufacture of biscuits with glucose. But there is nothing to show that an average buyer knows with what kind of glucose, biscuits containing glucose are or can be made. That there is trade connection between glucose and biscuits and a likelihood of confusion or deception arising therefrom would appear from the fact stated by the appellant that it received from a tradesman an enquiry for biscuits manufactured by it under its mark 'Glucovita'. The tradesman making the enquiry apparently thought that the manufacturer of 'Glucovita' glucose was likely to manufacture biscuits with glucose; he did not worry whether biscuits were made with powder or liquid glucose. Then again it is stated in one of the affidavits filed by the appellant that the respondent's director told the appellant's manager that the respondent had adopted the name 'Gluvita' to indicate that in the manufacture of its biscuits glucose was used. Those statements of behalf of the appellant are not denied by the respondent. So, a trade connection between glucose and biscuits would appear to be established. We are therefore of opinion that the commodities concerned in the present case are so connected as to make confusion or deception likely in view of the similarity of the two trade marks. We think that the decision of Desai, J., was right.

In the result, we set aside the order of the learned appellate Judges of the High Court and restore that of Desai, J. The appeal is accordingly allowed. The appellant will get the costs before the appellate Judges in this High Court and in this Court.

Appeal allowed.

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