Attorneys for appellants: *Dastur & Co.*

Attorneys for respondents: *M. V. Jayakar.*

Appeal dismissed.

A. J. P.

ORIGINAL CIVIL

1951 March 16

Before Mr. M. C. Chagla, Chief Justice and Mr. Justice Bhagwati.

JAMES CHADWICK & BROS., LTD. APPELLANTS *v.* THE NATIONAL SEWING THREAD CO., LTD., RESPONDENTS.*

Trade Marks Act (V of 1940), ss. 8, 10, 76—High Court Rules, r. 617—Letters Patent cl. 15—Government of India Act 1915 (5 and 6 Geo. V c. 61) ss. 106, 108—Government of India Act 1935 (26 Geo. V c. 2) s. 223—Constitution of India arts. 225, 367—Interpretation Act, (1889), s. 38—General Clauses Act (X of 1897), s. 8—Appeal to the High Court under the Trade Marks Act—Appeal heard by the sitting Judge in Chambers—Second Appeal to Division Bench competent—Trade mark sought to be registered should not be such as is likely to deceive or cause confusion—The distinguishing or essential feature of the trade-mark should be found out and comparison made.

It is well-established that when a statute directs that an appeal shall lie to a court already established, then that appeal is regulated by the practice and procedure of that Court.

The practice and procedure of the High Court provides that from the decision of a single judge on the original side, there shall lie an appeal to a Division Bench.

Rule 617 of the High Court Rules provides that all appeals under the Trade Marks Act shall be presented to the Sitting Judge in Chambers. Such an appeal is, therefore, governed by the practice and procedure of the High Court and a second appeal is competent.

In making rule 617 the High Court was exercising its power conferred upon it by art. 225 of the Constitution to regulate its own procedure and to decide whether work of the High Court should be disposed of by Judges sitting singly or in Division Benches.

Although the Legislature did not expressly amend cl. 15 of the Letters Patent, still by reason of s. 38 of the Interpretation Act, the amendment must be deemed to have been made so as to substitute s. 223 of the Government of India Act 1935 for s. 108 of the Government of India Act 1915 in cl. 15. Similarly, under the Constitution art. 367 provides that for the interpretation of the Constitution s. 8 of the General Clauses Act should be resorted to. S. 8 is in terms identical with s. 38 of the Interpretation Act and so when the Government of India Act 1935 was replaced by the Constitution, any reference to s. 223 of the Act of 1935

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* O. C. J. App. No. 95 of 1950. Miscellaneous Petition No. 2 of 1950.

in any statute must, by virtue of s. 8 of the General Clauses Act, be deemed to be a reference made to art. 225 of the Constitution.

Therefore, in hearing and disposing of the appeal under the Trade-marks Act, Shah J. was exercising the jurisdiction vested in him by art. 225 of the Constitution and as his decision was a judgment within the meaning of cl. 15 of the Letters Patent, it was appealable.

National Telephone Co. Ltd. v. *Post-master General*[1]; R. M. A. R. A. *Adaikappa Chettiar* v. *R. Chandrasekhara Thevar*[2] and *Secretary of State for India* v. *Chellikani Rama Rao*,[3] relied upon.

India Electric Works v. *Registrar of Trade Marks*,[4] dissented from.

Under s. 10 of the Trade-marks Act what the Registrar has got to do is to compare the trade-mark brought for registration with the trade mark already registered and find out if there is any identity or close resemblance between the two such as is likely to deceive or cause confusion and if he so finds, then he should refuse to register the trade-mark.

Under s. 8 of the Act, the Registrar has to find whether the trade-mark brought for registration is likely to deceive or cause confusion and if he so finds, he should refuse to register it notwithstanding the fact that there is no identity or close resemblance with another trade mark.

The Registrar has to find out what is the distinguishing or essential feature of the trade mark or the main idea underlying the trade mark and what will be its effect upon an average person of ordinary intelligence. If the trade mark sought to be registered contains the same distinguishing or essential feature or conveys the same idea then the trade-mark should not be registered.

The goods sold under the appellants' trade mark were well-known and commonly asked for as "Eagley" or "Eagle" and the distinguishing or essential feature of their trade-mark was the representation of an "eagle."

The distinguishing or essential feature of the respondents' trade mark was the representation of a bird which was likely to be mistaken by an average man of ordinary intelligence for an "eagle."

Held, therefore, that the Registrar was right in refusing to register the respondents' trade mark of a bird on the ground that it was likely to deceive or cause confusion.

In re *Huxley's Case*[5]; *Saville Perfumery Ltd.* v. *June Perfect Ltd.* and *F. W. Woodworth and Co. Ltd.*[6]; In re *Chemische Fabrick Greisheim Elektron*[7]; *The Upper Assam Tea Company* v. *Herbert and Co.*[8] and In re *Pomril Ltd.*,[9] referred to.

[1] [1913] A. C. 546.
[2] (1947) L. R. 74 I. A. 264.
[3] (1916) 39 Mad. 617.
[4] [1947] A. I. R. Cal. 49.
[5] (1924) 41 R. P. C. 423.
[6] (1941) 58 R. P. C. 147.
[7] (1901) 27 R. P. C. 201.
[8] (1889) 7 R. P. C. 183.
[9] (1901) 18 R. P. C. 181.

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The petitioners National Sewing Thread Co., Ltd., applied on January 12, 1943, to the Registrar of Trade Marks for the registration of their trade mark in connection with cotton sewing thread. Their trade mark consisted of the representation of a bird perching on a cylinder of cotton sewing thread with its wings fully spread out. This mark contained the legend "Eagle Brand" and the name of the petitioners.

The appellants James Chadwick & Brothers Ltd., were the proprietors of a registered trade mark which consisted of the representation of an eagle with its wings half opened trying to stand erect on some flat object. Around the device was written the legend "Eagley Sewing Machine Thread". The appellants had been using for nearly fifty years in a most extensive way the trade marks with the representation of an eagle which they got registered in 1943. It was established that the appellants goods were well known and commonly asked for as "Eagley" or "Eagle".

When, therefore, the petitioners applied for registration of their trade mark, the appellants opposed the application.

The Registrar held that there was a close resemblance between the trade mark of the appellants and that of the petitioners such as likely to deceive or cause confusion. He also held that apart from any close resemblance the trade mark of the petitioners was such as likely to deceive or cause confusion and so he refused to register it.

The petitioners therefore appealed to the High Court.

SHAH J. who heard the appeal examined the points of similarity and dis-similarity between the two trade marks and came to the conclusion that the points of difference were so numerous and the points of similarity were so few between the two trade marks that there was no such resemblance as was likely to cause confusion and ordered the petitioners' trade mark to be registered.

Messrs. James Chadwick & Bros. Ltd., therefore, appealed from the decision of Shah J.

C. K. Daphtary, Advocate-General, appeared for the appellants.

S. T. Desai, appeared for the respondents (petitioners).

V. F. Taraporewalla, appeared for the Registrar of Trade-marks.

CHAGLA C. J. This is an appeal from a judgment of Mr. Justice Shah by which he set aside the order of the Registrar of Trade Marks and directed the Registrar to register the mark of the petitioners as a trade mark. The petitioners applied on January 12, 1943, to the Registrar of Trade Marks for the registration of their mark in connection with cotton sewing thread. There was an opposition by the appellants and the Registrar came to the conclusion that the mark which the respondent sought to register was likely to deceive and cause confusion and therefore, he refused to register the mark. From this decision of his an appeal was preferred to the High Court, and, as I just said, Mr. Justice Shah after hearing the appeal came to the conclusion that the Registrar was wrong and that the respondents were entitled to have their trade mark registered.

A preliminary objection has been taken by Mr. Desai that this appeal is not competent. The judgment of Mr. Justice Shah is subject to appeal provided it constitutes a judgment within the meaning of cl. 15 of the Letters Patent, and the relevant provisions of that clause material to this discussion are:

"And we do further ordain that an appeal shall lie to the said High Court of Judicature at Bombay from the judgment of one Judge of the said High Court or one Judge of any Division Court, pursuant to s. 108 of the Government of India Act."

Mr. Desai's contention is two-fold: (1) That no appeal lies looking to the provisions of the Trade Marks Act, and (2) that no appeal is competent under cl. 15 of the Letters Patent. Dealing with the first point, it is urged by Mr. Desai that the Trade Marks Act constitutes a special law dealing with a special subject. It is a self-contained Code and it contains all the provisions with regard to the various tribunals that have got to deal with the matters arising under that Act. In order to appreciate the contention of Mr. Desai it is necessary to look at some of the sections. Section 76 (*1*) provides:

"Save as otherwise expressly provided in this Act, an appeal shall lie, within the period prescribed by the Central Government, from any decision of the Registrar under this Act or the rules made thereunder to the High Court having jurisdiction."

Then Sub-Clause (*3*) provides:

"Subject to the provisions of this Act and of rules made thereunder, the provisions of the Code of Civil Procedure, 1908, shall apply to appeals before a High Court under this Act."

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And s. 77 provides:

"A High Court may make rules consistent with this Act as to the conduct and procedure of all proceedings under this Act before it."

What is argued by Mr. Desai is that s. 76 (*1*) provides for one appeal only to the High Court, and that appeal having been disposed of by Mr. Justice Shah, no second appeal lay to this Court. Mr. Desai rightly contends that an appeal is the creation of a statute, and if the special law does not give the right to a litigant of having two appeals, we cannot confer that right upon the appellants contrary to the express provision of s. 76 (*1*). It is further argued that under s. 76 (3) the appeals are to be regulated by the Code of Civil Procedure, and there is nothing in the Code of Civil Procedure which provides for a second appeal in cases like those falling under the Trade Marks Act. It is well established, as we shall presently point out, that when a statute directs that an appeal shall lie to a Court already established, then that appeal must be regulated by the practice and procedure of that Court. If therefore s. 76 provides that an appeal shall lie to this High Court and if that appeal is disposed of by a single Judge, if the rules of practice and procedure of this Court provide for a second appeal from a decision of a single Judge, then those rules of practice and procedure would prevail unless the statute itself expressly provided that there shall be no further appeal. In s. 76 there is no bar to any second appeal if a second appeal would lie under the rules of practice and procedure obtaining in this Court, and, therefore, what we have to find is whether under the rules of practice and procedure of this Court it was competent for the appellants to prefer an appeal from the decision of Mr. Justice Shah.

The proposition of law to which we have just referred has been laid down very clearly and succinctly by Viscount Haldane L. C. in *National Telephone Company, Limited* v. *Postmaster-General*[1] wherein he expresses the following opinion (p. 553):

"When a question is stated to be referred to an established Court without more, it, in my opinion, imports that the ordinary incidents of the procedure of that Court are to attach, and also that any general right of appeal from its decisions likewise attaches."

Therefore there must be a reference to an established Court without more, and we do not find in s. 76 anything more than a mere reference to the High Court as being the Court of appeal from the decisions of the Registrar. The Privy Council in

[1] [1913] A. C. 546.

R. M. A. R. A. Adaikappa Chettiar v. *R. Chandrashekhara Thevar*,[1] laid down that (p. 264):

"Where a legal right is in dispute and the ordinary Courts of the country are seized of such dispute the Courts are governed by the ordinary rules of procedure applicable thereto and an appeal lies, if authorised by such rules, notwithstanding that the legal right claimed arises under a special statute which does not, in terms, confer a right of appeal."

Therefore this was really a stronger case than the one we have before us. Although the special Act which their Lordships were considering, viz., the Madras Agriculturists' Relief Act, did not confer any right of appeal at all inasmuch as the ordinary Courts of the land were seized of proceedings under that Act and appeals in the ordinary Courts lay from those Courts, the Privy Council said that the right of appeal in matters falling under the Madras Agriculturists' Relief Act arose by reason of the fact that the proceedings were to take place in the ordinary Courts of the land from which there was a right of appeal. Then there is another case of the Privy Council in *Secretary of State for India* v. *Chellikani Rama Rao*.[2] In that case the Privy Council was considering the Madras Forest Act and that Act provided for an appeal from the rejection of a claim to the District Court, and the question that arose was whether an appeal lay from the District Court to the High Court, and their Lordships at p. 624 observed :

"It was contended on behalf of the appellant that all further proceedings in Courts in India or by way of appeal were incompetent, these being excluded by the terms of the statute just quoted. In their Lordships' opinion this objection is not well-founded. Their view is that when proceedings of this character reach the District Court, that Court is appealed to as one of the ordinary Courts of the country, with regard to whose procedure, orders, and decrees the ordinary rules of the Civil Procedure Code apply."

Therefore it is clear that if an appeal lies from the decision of Mr. Justice Shah to a divisional bench of this Court, there is nothing in the Trade Marks Act which excludes such an appeal or makes such an appeal incompetent. Therefore the question that we have to address ourselves to is whether under the provisions of the law an appeal does lie from the judgment of Mr. Justice Shah. Now, the High Court has framed rules under s. 77 and r. 617 provides that all applications and

[1] (1947) L. R. 74 I. A. 264, s. c. 50 Bom. L. R. 18.

[2] (1915) 39 Mad. 677, s. c. 18, Bom. L. R. 7, P. C.

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appeals under the Act shall be made by petition supported by affidavit and shall be presented to the Sitting Judge in Chambers. Mr. Justice Shah being the Sitting Judge in Chambers when this appeal came on for hearing heard it and disposed of it under this rule. It is not disputed that the decision of Mr. Justice Shah does constitute a judgment within the meaning of cl. 15, but what is argued is that Mr. Justice Shah did not decide this appeal under s. 108 of the Government of India Act, 1915, but he decided it under the rules framed under the Trade Marks Act. When we turn to s. 108 of the Government of India Act, 1915, it provides :

> "Each High Court may, by its own rules, provide as it thinks fit for the exercise, by one or more judges, or by division Courts constituted by two or more judges, of the High Court, of the original and appellate jurisdiction vested in the court."

And with regard to the original and appellate jurisdiction vested in the Court, we have to turn to s. 106 of that Act, and that section provides:

> "The several high courts are Courts of record and have such jurisdiction, original and appellate, including admiralty jurisdiction in respect of offences committed on the high seas, and all such powers and authority over or in relation to the administration of justice, including power to appoint clerks and other ministerial officers of the Court, and power to make rules for regulating the practice of the Court, as are vested in them by letters patent, and, subject to the provisions of any such letters patent, all such jurisdiction, powers and authority as are vested in those courts respectively at the commencement of this Act."

What is argued is that when the Government of India Act, 1915, was passed, the jurisdiction which was conferred upon the High Court under s. 106 was the jurisdiction which sprung from the Letters Patent and also from such laws as were passed in India up to the date of the passing of the Government of India Act. and therefore, s. 108 could only be resorted to in cases where a Judge or a division bench of the High Court was exercising jurisdiction indicated in s. 106. It is pointed out that the Trade Marks Act was passed in 1940, and although Mr. Justice Shah had jurisdiction to hear the appeal, that jurisdiction arose under the Trade Marks Act and not under s. 106 of the Government of India Act, and therefore it is further pointed out that it was not open to the High Court to appoint Mr. Justice Shah as one of the Judges to hear this appeal under s. 108 of the Government of India Act. If Mr. Justice Shah did not hear the appeal under s. 108, then his judgment was not a judgment

pursuant to s. 108 and therefore that judgment did not constitute a judgment within the meaning of cl. 15. That—and I hope I am being fair to Mr. Desai—is the argument that has been advanced before us.

Now this argument overlooks what transpired after the passing of the Government of India Act, 1915. Sections 106 and 108 were repealed along with the rest of the Act by the Government of India Act of 1935. And in place of ss. 106 and 108 we have s. 223 of the Government of India Act, 1935. That section substantially corresponds to ss. 106 and 108 and it declares that the jurisdiction of the High Court shall be the same as immediately before the commencement of Part III of the Act, and that was subject to the provisions of any Act of the appropriate Legislature enacted by virtue of the powers conferred on that Legislature by this Act. Section 223 along with the rest of the Act was in due course repealed by the enactment of our own Constitution, and art. 225 again substantially in the same terms has taken the place of s. 223 of the Government of India Act, 1935. Article 225 also declares that the jurisdiction of the High Court shall be the same as immediately before the commencement of this Constitution, subject to the provisions of any law of the appropriate Legislature made by virtue of powers conferred on that Legislature by this Constitution. What is emphasised before us by Mr. Desai is that if cl. 15 of the Letters Patent had been amended and in place of s. 108 a reference had been made to s. 223 of the Government of India Act, 1935, or art. 225 of the Constitution, there would have been no difficulty. But inasmuch as, although the Act of 1915 was repealed and the Act of 1935 was repealed, the Legislature advisedly did not amend cl. 15 of the Letters Patent, the only conclusion that can be drawn from that fact is that for the purpose of appeal under clause 15 the Legislature advisedly restricted the jurisdiction of the Court to matters which fell within the purview of the Government of India Act of 1915. Therefore, what is really emphasised is the failure of the Legislature to amend cl. 15 and to bring it into line with the progress that legislation had made.

Now, this contention overlooks the provisions of s. 38 of the Interpretation Act of 1889 and also the provisions of s. 8 of the General Clauses Act. Both the sections are in identical terms, and s. 8 of the General Clauses Act provides:

"Where this Act, or any Central Act, or Regulation made after the commencement of this Act, repeals and re-enacts, with or without

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modification, any provision of a former enactment, then references in any other enactment or in any instrument to the provision so repealed shall, unless a different intention appears, be construed as references to the provision so re-enacted."

The Government of India Act, 1915, was governed by s. 38 of the Interpretation Act. Therefore, when ss. 106 and 108 were repealed and re-enacted in s. 223 of the Government of India Act, 1935, all references in any statute made to ss. 106 and 108 must be deemed to be references made to s. 23. Therefore, although the Legislature did not expressly amend cl. 15 of the Letters Patent, by reason of s. 38 the amendment must be deemed to have been made so as to substitute s. 223 for s. 108 in cl. 15 of the Letters Patent. Similarly, under our own Constitution art. 367 provides that for the interpretation of the Constitution s. 8 of the General Clauses Act should be brought into requisition, and, as we said before, as s. 8 is in terms identical with s. 38 of the Interpretation Act, when the Act of 1935 was repealed and our Constitution was enacted, by virtue of s. 8 of the General Clauses Act any reference to s. 223 in any statute must be deemed to be a reference made to the re-enacted provision which is art. 225 of the Constitution. Therefore, it is clear that under cl. 15 when Mr. Justice Shah heard the appeal and disposed of it, he was exercising the jurisdiction vested in him by art. 225 of the Constitution, and if he was exercising that jurisdiction, then, if his decision constituted a judgment, that judgment fell within the purview of cl. 15 of the Letters Patent.

It is then urged that cl. 15, by reason of s. 108, contemplates rules being framed by which Mr. Justice Shah must exercise the jurisdiction conferred upon him sitting singly, and what is urged is that Mr. Justice Shah was exercising his jurisdiction, not by reason of any rule framed by the High Court and not under art. 225 of the Constitution, but under rules framed under the Trade Marks Act. It is true, as we just pointed out, that r. 617 does provide that all appeals shall be presented to the Sitting Judge in Chambers, but in making this rule the High Court was exercising its power which it has under art. 225 to decide whether work should be disposed of by Judges sitting singly or in division benches. The Trade Marks Act only empowers the High Court to make rules with regard to matters that arise under the Trade Marks Act. That section in no way affects or modifies the power of the High Court to regulate its own proceedings and in passing the rule, although the rule was

made under the Trade Marks Act, the High Court was exercising its power conferred upon it by art. 225 in regulating its own proceedings. Therefore, although Mr. Justice Shah disposed of the appeal pursuant to r. 617 made under the Trade Marks Act, in sitting singly and in exercising that jurisdiction he was doing so pursuant to the procedure laid down by the High Court under art. 225 of the Constitution.

Mr. Desai has very strongly relied upon a judgment of the Calcutta High Court in *India Electric Works* v. *Registrar of Trade Marks.*[1] A division bench of two Judges, Mr. Justice Gentle and Mr. Justice Das, took the view in an identical case that no appeal lay under cl. 15 from a judgment of the single Judge of the High Court disposing of an appeal under s. 76 (*1*) of the Trade Marks Act. We have gone through the judgment of both the learned Judges with the respect to which those judgments are entitled, and we find that the view taken by these two learned Judges is that the right of appeal under cl. 15 is restricted to those cases where a single Judge exercises original jurisdiction or appellate jurisdiction under cl. 16 or jurisdiction in matters where the Act of the Indian Legislature has conferred jurisdiction upon the High Court up to the date when the Government of India Act, 1915, was passed, and therefore, according to these learned Judges as the Act in question was passed in 1940, the jurisdiction exercised by a single Judge under that Act was not the jurisdiction contemplated by cl. 15 or s. 106 of the Government of India Act. With the utmost respect to these two learned Judges, they have completely overlooked the provisions of s. 38 of the Interpretation Act of 1889. If the attention of these two learned Judges had been drawn to the relevant provisions of the Interpretation Act, we are sure they would not have taken the view that cl. 15 of the Letters Patent must be construed to mean that the reference to s. 108 of the Government of India Act still continued notwithstanding the fact that that Act was repealed by the Government of India Act of 1935. We have not thought it necessary to consider whether the position would be the same with regard to jurisdiction conferred upon the High Court by an Act passed by our Parliament after the enactment of the Constitution, because these two learned Judges in Calcutta took the view that the language of s. 106 and s. 223 of the Government of India Act suggested that the jurisdiction was restricted to Acts passed up to the date of the passing of the

[1] [1947] A. I. R. Cal. 49.

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Government of India Act, 1915, or of 1935 respectively. As this particular Act was passed in 1940 before the Constitution was enacted, that question does not arise. But we must not be understood to have agreed with the view of the learned Judges of the Calcutta High Court that the jurisdiction conferred by any subsequent statute would not be the jurisdiction contemplated by art. 225 of the Constitution.

Now, coming to the facts of this case, the appellants have been using for nearly fifty years in a most extensive way two trade marks which they got registered in 1943. One of the trade marks bears the legend 'Eagley Sewing Machine Thread' and it has a representation of an eagle. That is trade mark B. 62. The other trade mark B. 59 has merely a representation of an eagle without any writing. It is also established on the record that the goods which are sold by the appellants under these two marks are well known and commonly asked for as 'Eagley' or 'Eagle.' It also appears that the respondents had made use of the trade mark which they sought to register in 1943 for about a period of two years and they had been selling their goods under that mark. Turning to the mark of the respondents, it has the representation—and I shall advisedly use a neutral expression—of a bird of prey. It bears the legend 'Peerless Quality Vulture Brand Reel Thread.' and then the name of the respondent Company. It also appears from the evidence that for the two years while they were using this trade mark they had called it 'Eagle Brand' and it was only when they applied for registration that they changed the name of the brand from Eagle Brand to Vulture Brand.

Now, the relevant provisions of the Trade Marks Act which we have to consider in deciding whether the Registrar was right in refusing registration are ss. 8 and 10 of the Act. Section 8 provides:

"No trade mark nor part of a trade mark shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would—

(*a*) by reason of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Court of justice; or

(*b*) be likely to hurt the religious susceptibilities of any class of His Majesty's subjects; or

(*c*) be contrary to any law for the time being in force or to morality."

And s. 10 provides:

(*1*) "Save as a provided in sub-s. (*2*), no trade mark shall be registered in respect of any goods or description of goods which is identical

with a trade mark belonging to a different proprietor and [already on the register...] in respect of the same goods or description of goods which so nearly resembles such trade mark as to be likely to deceive or cause confusion."

In this particular case we are only concerned with the case of a trade mark likely to deceive or cause confusion. Looking at the scheme of these two sections, it seems to be clear that s. 10 has undoubtedly a restricted operation. It deals with a case where the trade mark sought to be registered is identical with the trade mark of another proprietor or where there is a close resemblance between those two trade marks. So that under s. 10 what the Registrar has got to do is to compare the trade mark of the person applying for registration with the trade mark already registered by him, and if he finds that there is an identity between the two or there is a close resemblance such as to be likely to deceive or cause confusion, then he must refuse registration. When we turn to s. 8, it is wider in its operation. In the first place, if there is a trade mark which is likely to deceive or cause confusion, it must be refused notwithstanding the fact that there is no identity with another trade mark nor is there any close resemblance with another trade mark. The Registrar has to come to a conclusion independently of any comparison with any registered trade mark. Further, whereas s. 10 contemplates an opposition by a proprietor of a registered trade mark, opposition under s. 8 may come even from a person who is selling goods under a trade mark which is not registered. What the Registrar has to decide is merely whether, looking to all the circumstances of the case, a particular trade mark is likely to deceive or to cause confusion. In this particular case the Registrar has come to the conclusion that the trade mark in question falls both under ss. 8 and 10. According to him there is a close resemblance between the trade mark of the appellants and the trade mark of the respondents such as likely to deceive or cause confusion, and also it is his opinion that apart from any resemblance in itself the trade mark sought to be registered is one which is likely to deceive or cause confusion. The principles of law applicable to the facts of this case are well settled. The burden of proving that the trade mark which a person seeks to register is not likely to deceive or cause confusion is upon the applicant. It is for him to satisfy the Registrar that his trade mark does not fall within the prohibition of s. 8 or s. 10 and therefore it should be registered. The Registrar, in coming to the conclusion whether a trade mark should or should not be registered,

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exercises the discretion vested in him by statute and the Court in appeal should always be extremely loath to interfere with that discretion. The authorities clearly lay down that that discretion should not be interefered with unless the Court comes to the conclusion that the Registrar in coming to the conclusion that he did was clearly wrong or patently in error.

Now, in deciding whether a particular trade mark is likely to deceive or cause confusion, it is not sufficient merely to compare it with the trade mark which is already registered and whose proprietor is offering opposition to the registration of the former trade mark. What is important is to find out what is the distinguishing or essential feature of the trade mark already registered and what is the main feature or the main idea underlying that trade mark, and if it is found that the trade mark whose registration is sought contains the same distinguishing or essential feature or conveys the same idea, then ordinarily the Registrar would be right if he came to the conclusion that the trade mark should not be registered. The real question is as to how a purchaser, who must be looked upon as an average man of ordinary intelligence, would re-act to a particular trade mark, what association he would form by looking at the trade mark, and in what respect he would connect the trade mark with the goods which he would be purchasing. It is impossible to accept that a man looking at a trade mark would take in every single feature of the trade mark. The question would be, what would he normally retain in his mind after looking at the trade mark? What would be the salient feature of the trade mark which in future would lead him to associate the particular goods with that trade mark? In this case, fortunately, we have no difficulty in deciding what is the distinguishing or essential feature of the trade mark of the appellants. As we said before, it is on record that the goods sold under this trade mark are well known and commonly asked for as 'Eagley' or 'Eagle' and therefore the particular feature of the trade mark of the appellants by which the goods are identified and which is associated in the mind of the purchaser is the representation of the Eagle appearing in the trade mark. Therefore the very narrow question which arises in this appeal is whether the trade mark sought to be registered by the respondents does contain a similar or identical distinguishing or essential feature. If it does, if the trade mark conveys the idea of an Eagle and if an unwary purchaser is likely to accept the goods of the respondents as answering the requisition for

Eagle goods, then undoubtedly the trade mark of the respondents is one which would be likely to deceive or cause confusion.

The learned Judge below in a very careful judgment has meticulously examined the points of similarity and dis-similarity between the trade mark of the appellants and the trade mark of the respondents, and he has come to the conclusion that the points of difference are so numerous and the points of similarity so few that in his view there was no such resemblance as was likely to cause confusion. With very great respect, in our opinion, that was not the correct approach to the matter. What the learned Judge should have done was not to keep these two trade marks before him and to find out how they differ and how little they resemble; what he should have done was to decide for himself what was the distinguishing or essential feature of the appellants' trade mark, and then, looking at the trade mark of the respondents, to ask himself whether there was any resemblance in the trade mark of the respondents to that distinguishing or essential feature. It is true, as pointed out by the learned Judge, that the bird appearing in the respondents' trade mark is different in its posture, in its poise in the position of its head, and in the spreading of it's wings from the bird that appears in the trade mark of the appellants. But that is hardly the question. The question is whether the bird in the respondents' trade mark is likely to be mistaken by an average man of ordinary intelligence as an Eagle, and, as we said before, whether, if he asked for Eagle goods and he got goods bearing this trade mark of the respondents, he would reject them saying. "This cannot be an Eagle; I asked for Eagle goods and the bird I see before me is anything but an Eagle." The learned Judge has very frankly stated in his judgment that he is not an ornithologist. My claims to be considered that are even more slender, and I have no pretentions whatever of being able to distinguish an Eagle from a bird which is not an Eagle or indeed one bird from another. But in this case, fortunately, it is not necessary to give a judicial pronouncement as to whether the bird appearing in the respondents' trade mark is or is not an Eagle, because the pronouncement has been given by the respondents themselves, and no pronouncement can be more weighty than the pronouncement of the party who applies for the trade mark. As we said before, for two years prior to the application for registration, the respondents described this particular bird

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as an Eagle and called their brand Eagle Brand. Mr. Desai says that that was due to an honest and *bona fide* mistake. But Mr. Desai's clients have not the monopoly of making honest and *bona fide* mistakes. If an honest and *bona fide* mistake was possible in the case of the respondents, surely a similar mistake can take place and is more likely to take place in the case of people who come from a more humble and ordinary status of life. Therefore, if there is a possibility of a mistake, if there is a likelihood of this bird being mistaken or accepted as an Eagle, that possibility itself is sufficient to entitle the Registrar to say that this trade mark is likely to deceive or cause confusion.

Various cases were cited at the bar which only go to emphasize the principles to which we have been referring, and perhaps the most striking case to which the Advocate-General drew our attention is *Huxley's* case (*In the matter of an Application by William Henry Huxley (trading as Huxley and Company) to register a Trade Mark.*[1]) In that case Huxley applied for the registration of a trade mark for illuminating oils and greases, and the trade mark consisted of a label with four panels and the last of these panels consisted of a ship. The application was opposed by the Prices' Patent Candle Co., Ltd., and they were the proprietors of a registered trade mark in the same class of goods and their trade mark consisted of a picture of a ship and also of a trade mark consisting of the words "Ship Brand" and whose goods were alleged to be known under the title "Ship Brand." Although the ship was represented only in one of the four panels, Mr. Justice Tomlin refused to allow registration on the ground that as the goods of the Prices' Patent Candle Co., Ltd., had come to be associated with the name of a ship, the fact of a ship appearing in the trade mark of Huxley was sufficient to disentitle Huxley to registration as it was likely to deceive or cause confusion. We find the principle laid down in this case that if the matter is *in dubio* and if the Court is left in the frame of mind of doubt, it is the duty of the Court to refuse the application, and, as Mr. Justice Tomlin points out, that in that event the applicant has not discharged the onus which the law put upon him. The learned Judge also points out that

"If that is a reasonable view (viz. the view taken by the Registrar that it should not be registered as it was likely to deceive) of the possible effect of this proposed trade mark, it seems to me to conclude this

(1) (1924) 41 R. P. C. 423.

case and to render it impossible for the Court to say that the application should succeed."

Therefore, if the view of the Registrar in this case is a reasonable view of the possible effect of registering the respondents trade mark, then the matter is concluded and the Court should not interfere with the discretion exercised by the Registrar. Could it be said, therefore, in this case that the view taken by the Registrar is not a reasonable view?

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Reliance was also placed on *June's* case (*Seville Perfumery Ltd.* v. *June Perfect Ltd., and F. W. Woolworth & Co. Ltd.*[1] In that case the distinguishing feature of the registered trade mark and the proposed trade mark was the word "June," and the Master of the Rolls in his judgment at p. 162 observes:

"Now the question of resemblance and the likelihood of deception are to be considered by reference not only to the whole mark, but also to its distinguishing or essential features, if any."

The learned Master of the Rolls also says that (p. 162):

"In such cases the mark comes to be remembered by some features in it which strikes the eye and fixes itself in the recollection. Such a feature is referred to sometimes as the distinguishing feature, sometimes as the essential feature, of the mark."

Therefore the test we must apply in this case is, what is the feature in the appellants' trade mark which strikes the eye and fixes itself in the recollection, and the only answer to this question is that it is the Eagle which so strikes the eye and fixes itself in the recollection. Then we have the case of *C. F. G. E. (In the matter of the Application of the Chemische Fabrik Greisheim Elektron for Registration of a Trade Mark)*[2] and this case was cited before us by the Advocate General in order to draw our attention to the considerable dissimilarity between the proposed and the registered trade mark. The reason why registration was refused to the proposed trade mark was that the registered trade mark was a representation of primitive Eastern Dye Works and the same idea was conveyed by the proposed trade mark. It was urged before Mr. Justice Neville that one trade mark was a representation of Japanese Dye Works and the other was Chinese. That argument did not find favour with the learned Judge and he answered it by saying that if orders were sent from the East to agents of either of these firms and they were told to send goods which had obtained popularity in the market by the trade mark representing Eastern Dye Works, goods bearing either trade mark would

[1] (1941) 58 R. P. C. 147. [2] (1910) 27 R. P. C. 201.

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have answered to the requisition, and the main ground on which the learned Judge refused registration was that the main feature of both the pictures was identical, and according to the learned Judge that concluded the question. Our attention has also been drawn to one case of an Elephant Trade Mark in *The Upper Assam Tea Company* v. *Herbert and Co.*[1] where from the trade marks printed in the report it is clear that the two elephants in the two trade marks look entirely different judging by the way they are represented, and yet, because the goods had been associated with the name of the elephant, injunction was granted to restrain the defendant who also wanted his goods to be sold under a trade mark, the main feature of which was an elephant. There is another case (*In the Matter of Farrow's Trade Mark*[2]) where we have trade marks of two buffaloes which look entirely dissimilar, and yet, again, as the goods had come to be associated with the buffalo, registration was refused to the subsequent applicant. There is another case also laying down the same principle in *In the Matter of the Application of Pomril, Ld., for Registration of a Trade Mark,*[3] where the goods in question were cider and the proposed trade mark had the name 'Pomril' written on half cut apple and the opposition came from sellers of cider who had their trade mark also containing an apple with the name "Apple Brand". In one case the name was "Pomril" and in the other case the name was "Apple Brand", still registration was refused as the apple was considered to be the distinguishing and essential feature.

I should like to make it clear that there may be cases where dissimilarity in the object represented may be the deciding factor. If, for instance, this particular class of goods are sold by several dealers, all under different kinds of Eagle trade marks, then the purchaser is expected to know the difference between one trade mark and another, knowing as he does that more than one person sells goods under the same appellation. But when we have a case, as we have in this case, where only the appellants sell this class of goods under the Eagle Brand and their goods are known as Eagle or Eagley, then the position is very different, and any attempt to sell goods under a trade mark which fixes in the mind of the purchaser the association of an Eagle would not be justified.

(1) (1889) 7 R. P. C. 183.
(2) (1890) 7 R. P. C. 260.
(3) (1901) 18 R. P. C. 181.

There is one further point also to which a passing reference might be made. The Registrar has taken the view that the trade mark should also be refused registration on the ground that it contains a mis-statement of fact. According to the Registrar, a bird which is an eagle is sought to be passed off as a vulture, and the Registrar has taken the view that under s. 8 it is open to him to refuse registration, not merely on the ground that the trade mark is likely to deceive or cause confusion or otherwise or that it is scandalous or that it is likely to hurt the religious susceptibilities of any class of Indian subjects or is contrary to law or to morality, but according to him his jurisdiction is more extensive and under the expression " or otherwise " it is competent to him to refuse registration in cases like the one before us. This raises rather an interesting and important question as to whether the expression " or otherwise" occurring after the words "by reason of its being likely to deceive or to cause confusion " is *ejusdem generis*. If it is *ejusdem generis*, then it is not open to the Registrar to extend the genus or the class referred to by sub-cl. (*b*) of s. 8. If the applicant had made a mistake in the mark itself and if that mistake is not likely to deceive or cause confusion, then if that was the correct interpretation of the section, it would not be open to the Registrar to refuse registration. That is the view the learned Judge has taken. But as the question does not arise before us and as we are holding that this particular trade mark is likely to deceive or cause confusion, it is unnecessary to consider whether it was open to the Registrar to refuse registration on a different ground, viz., that it contained a mis-statement as to the object represented by the trade mark even though that mis-statement might not lead to any deception or confusion. Even in the decision to which our attention was drawn in *In the Matter of Broadlead's Application for Registration of a Trade Mark*,[1] the learned Judge was fortunately spared the necessity of considering the English section which corresponds to our own section.

Mr. Desai has strongly urged that our jurisdiction in the second appeal should be circumscribed and we should not interfere with findings of fact by the lower Court. Mr. Desai says that Mr. Justice Shah having exercised his discretion and having come to the conclusion that this trade mark should be registered, we in appeal should not interfere with that decision. In coming to the conclusion that we have, we have not in any

[1] (1950) 67 R. P. C. 209, 213.

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way come to any finding of fact which is contrary to the findings of fact arrived at by the learned Judge below. In reality, all facts were found by the Registrar who decided this matter on affidavits which he was entitled to do under the Act, and therefore there is really no dispute in this appeal as to what are the proved or admitted facts. The only question that arises in this appeal is whether the discretion exercised by the Registrar was clearly wrong and whether the learned Judge below was right in interfering with that discretion. If we come to the conclusion that the learned Judge was in error in interfering with the discretion exercised by the Registrar, it is perfectly competent to us even in second appeal to set the Court below right and to come to the conclusion that the discretion exercised by the Registrar should not be interfered with.

The result therefore is that the appeal must be allowed and the order of the Registrar restored with costs throughout. The question of costs of the Registrar to stand over.

The question arises as to what is the proper order we should make with regard to the costs of the Registrar of Trade Marks. The Act itself provides by s. 74A that in all proceedings under this Act before the High Court the costs of the Registrar shall be in the discretion of the High Court, but the Registrar shall not be ordered to pay the costs of any of the parties. Undoubtedly, the matter before Mr. Justice Shah was a proceeding under the Act and to the extent that this is an appeal from that proceeding the appeal is a continuation of the proceeding and therefore there is no discretion in us to order the Registrar to pay the costs. But subject to that it is a question of our discretion as to what proper order should be made with regard to the Registrar's costs. But s. 74A is also important from another point of view that it seems to indicate the view of the Legislature that it is important and necessary that the Registrar should appear in matters which go to the High Court, and in order to safeguard his costs the statutory provision is made that he should not be ordered to pay the costs. Turning to our own rules, r. 617 deals with applications and appeals under the Act which are to be before the Chamber Judge, and r. 619 provides that all applications to the Court, whether by way of appeal or otherwise, shall be served on the Registrar who shall have a right to appear and be heard and shall appear if so directed by the Court. We are not prepared to accept Mr. Taraporewalla's contention that by reason of these rules the Registrar is a party to this appeal. The rules do not provide that he should be a party, nor has he made any application to

be made a party and no order has been made making him a party. But r. 619 gives him a right to appear before the Chamber Judge and there is an obligation to serve him, and therefore when the matter comes in appeal to this Court, on general principles, if he had a right to appear before Mr. Justice Shah, he has equally a right to appear before the Court of appeal. If he has a right to appear before us, the question is, what is the proper order in the exercise of our discretion we should make in this particular case.

Now, Mr. Justice Shah took a view contrary to that of the Registrar. The appellants have appealed against that order and the Registrar is here to support his order and to see that that order is maintained by this Court. This Court having taken the view that the learned Judge's decision was erroneous and that the Registrar made the right order, he has succeeded in getting the Court to uphold his order. Therefore there does not seem to be any reason why he should not be looked upon as being in the position of a successful appellant and should not get his costs from the respondent. The English practice which, if wholesome, ought to help us in regulating our own practice, is stated by Halsbury in Vol. XXXII, p. 581, as:

> "The general rule is for the unsuccessful parties to pay costs, but if the Registrar is unsuccessful he receives his costs in the High Court, though there is no fixed rule in the Court of Appeal."

Therefore there is no question as to the practice in England with regard to the case where the Registrar is successful; he gets his costs both in the High Court and in the Court of appeal. When he is unsuccessful, even so he gets his costs in the High Court, although as far as the Court of appeal is concerned the rule is not fixed. Therefore there should be no objection to our adopting this practice, viz., that before the Chamber Judge ordinarily the Registrar should get his costs, whether he is successful or unsuccessful, and in the Court of appeal ordinarily if he is unsuccessful he should not get his costs and if he is successful ordinarily he hould get his costs. There is no reason why in this particular case we should depart from the general practice we have just laid down. As the Registrar is successful, he should get his costs from the unsuccessful respondents.

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Appeal allowed.

A. J. P.