

## London Rubber Co. Ltd vs Durex Products on 4 March, 1963

**Equivalent citations: 1963 AIR 1882, 1964 SCR (2) 211, AIR 1963 SUPREME COURT 1882**

**Author: J.R. Mudholkar**

**Bench: J.R. Mudholkar, Raghubar Dayal**

PETITIONER:  
LONDON RUBBER CO. LTD.

Vs.

RESPONDENT:  
DUREX PRODUCTS

DATE OF JUDGMENT:  
04/03/1963

BENCH:  
MUDHOLKAR, J.R.  
BENCH:  
MUDHOLKAR, J.R.  
SUBBARAO, K.  
DAYAL, RAGHUBAR

CITATION:  
1963 AIR 1882                      1964 SCR (2) 211

ACT:  
Trade Mark-Registration of--"Durex"-Opposition Marks  
indentical--Registration allowed by the Registrar on the  
grounds of honest concurrents user- Order of the Registrar  
restored-Trade Marks Act, 1940 - (V of 1940), ss. 8 (a), 10  
(2).

HEADNOTE:  
The respondent made an application before the Deputy  
Registrar of Trade Marks for registering the mark, "Durex"  
used by it on the packing of the contraceptives manufactured  
and marketed by it. The registration was disputed by the  
appellant on the ground that it has been using the trade  
mark "Durex" in India since the year 1932 and its  
registration was renewed in the year 1954, for a period of  
15 years. The Deputy Registrar of Trade Marks over ruled  
the objection and admitted the mark "Darex" to registration

as sought by the respondent. An appeal preferred to the High Court against this order was also dismissed. The appellant's main contention in this court was that as the marks are identical, the registration had to be refused under s. 8 (a) of the Act, the provisions of which are not subject to the provisions of s. 10 (2). Further, the requirements of s. 10 (2) were not satisfied in this case and its provisions were not applicable.

Held, that though the language of s. 8 (a) is slightly different from that of s. 11 of the English Act and that of s. 10 (1) from that of s. 12 (1) of the English Act, there is no reason for holding that the provisions of s. 8 (a) would not apply where a mark identical with or resembling that sought to be registered is already on the register. The language of s. 8 (a) is wide and though upon giving full effect to that language the provisions of s. 10 (1) would, in some respects, overlap those of s. 8 (a), there can be no justification for not giving full effect to the language used by the legislature: -

Re Hack's Application, (1940) 58 R. P. C. 91; Re, Arthur Fairest Ltd's application (1951) 68 R. P. C. 197; Sno v. Dunn, [1890] 15 A. C. 252, referred to.

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Held, further, that the provision of Sub-s. (2) of s. 10 are by way of an exception to the prohibitory provisions of the Trade Marks Act. Those provisions are contained in s. 8 (a) and s. 10 (1).

Ram Narain Sons Ltd. v. Assistant Commissioner of Sales Tax, [1955] 2 S. C. R. 483, held inapplicable.

Bass v. Nicholson & Sons Ltd., (1932) 4 R. P. C. 88; Spillers Ltd's application, (1952) 69 R. P. C. 327; Alexander Pierice & Sons Ltd's application, (1933) 50 R. P. C. 147 and Re Kidax (Shirts) Ltd's application, (1960) R. P. C. 117 C.A., relied on.

Held, also, that no hard and fast rule can be laid down regarding the volume of use for the purposes of Sub-s. (2) of s. 10. Ordinarily it would be sufficient if it is shown that there was a commercial use of the mark. There was such a use in this case, cannot be disputed and the honest concurrent use of the mark by the respondent for a considerable period has been established. The circumstances in this case can be properly regarded as special circumstances to justify the registration of the mark and there is hardly any likelihood of confusion or deception.

JUDGMENT:

CIVIL APPELLATE JURISDICTION : Civil Appeal No. 26 of 1961. From the judgment and order dated July 10, 1958 of the Calcutta High Court in Appeal from Original No. 41 of 1955. G. S. Pathak, B. Sen and D. N. mukherjee, for the appellant.

H. N. Sanyal, Additional Solicitor-General of India, A. N. Sinha and B. N. Ghosh, for respondent No. 1. 1963. March 4. The judgment of the Court was delivered by MUDHOLKAR J.-In. this appeal by a certificate granted by the High Court of Calcutta under Art. 133 (1) (c) of the Constitution, the question which arises for consideration is whether the Deputy Registrar of Trade Marks, Calcutta, was right in admitting to registration the trade mark "Durex" which respondent No. 1 claims to own and is using on the packing of the contraceptives manufactured and marketed by it. The Durex Products Inc., of New York City, U. S. A. made an application before the Deputy Registrar of Trade Marks on May 28, 1946 for registering the mark "Durex" used by it on "contraceptive devices including prophylactic sheaths or condoms, vaginal diaphragms, instruments for inserting diaphragms and models for demonstrating insertion of diaphragms, vaginal jellies, applicators for vaginal jellies and surgical lubricating jellies." Its claim is disputed by the London Rubber Co., Ltd., London, the appellant before us by lodging an opposition to the registration on March 29, 1951. The appellant claims to be well-established manufacturer of surgical rubber goods and proprietor in India of the trade mark "Durex" which it has been using in India since the year 1932 i. e., from the year in which it was registered in the United Kingdom. On December 23, 1946 the appellant applied for registration of the word "Durex" in "clause X" which application was granted on July 11, 1951. Thereafter, on July 24, 1954 the registration was renewed for a period of 15 years as from December 23, 1953. The respondent No. 1's application as well as the appellant's opposition came up before the Deputy Registrar of Trade Marks who, by order dated December 31, 1954, overruled the objection and admitted the mark "Durex" to registration as sought by the respondent No. 1. Against this order an appeal was preferred before the High Court of Calcutta under s. 76 of the Trade Marks Act, 1949 which was dismissed -by a Division Bench of that Court on March 9, 1959 After obtaining a certificate of fitness from the High Court the appellant has come up before us.

On behalf of the appellant the main contention urged by Mr. Pathak is that as the marks are identical, deception of various purchasers was inevitable and that, therefore, registration had to be refused under s. 8 (a) of the Act. In admitting the mark to registration the Deputy Registrar was, according to him, in error in applying the provisions of s. 10 (2) of the Act inasmuch as the provisions of 8 (a) are not subject to those provisions. Further, according to him, the requirements of s. 10 (2) were not satisfied in this case.

Section 8 of the Act reads thus "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) 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 the citizens of India ; or

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

On the face of it, this is a general provision which prohibits registration of certain kinds of trade marks as indeed would appear from the heading of the section. The appellant's objection to the registration of the, mark in question would not fall under cl. (b) or cl. (c) of s. 8 but only under cl.

(a). It may fall under that clause because by reason of the identity of the, word "Durex" it would be open to the Registrar to say that deception of the purchasers or confusion in the purchasers' mind was likely to occur. Upon the findings in the case it would appear that the appellant has been using this mark for a long time and has acquired a reputation for its products and since the respondent's mark is identical with it, the Deputy Registrar would have had to reject the respondent's application if this case were governed solely by the provisions of s. 8 (a). The only remedy for the respondent No. 1 would, in that case, have been to establish its right to the mark by instituting a suit for that purpose.

The Deputy Registrar, however, as already stated, resorted to the provisions of sub-s. (2) of s. 10 in admitting that mark to registration. We will quote whole of s. 10 as the provisions of sub-s. (1) as well as of sub-s. (3) were referred to in the argument before us along with the provisions of sub-s. (2). Section 10 of the Act reads thus :

"(1) Save as provided in sub-section (2), no trade mark shall be registered in respect of any goods or description of goods which is indetical with a trade mark belonging to proprietor and already on the respect of the same goods or description goods, or which so nearly resemble such trade mark as to be likely to deceive or cause confusion. (2) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do he may permit the registration by more than one proprietor of trade marks which are identical or nearly resemble each other in respect of the same goods or description of goods, subject to such conditions and limita-

tions, if any, as the 'Registrar may think fit to impose, (3) Where separate applications are made by different persons to be registered as proprie- tors respectively of trade marks which are identical or nearly resemble each other, in respect of the same goods or description of goods, the Registrar may refuse to register any of them until their rights have been determined by a competent Court."

On the face of it, sub-s. (2) permits the Registrar or Deputy Registrar to admit to registration marks which are identical or nearly resemble one another in respect of the same goods or description of goods provided he is of opinion that it is proper to do so because there was honest concurrent use of the mark by more than one proprietor or because of the existence of special circumstances. He would, further, be entitled to impose such conditions on the user of the mark as he thought fit. Mr. Pathak, however, contends that sub-s. (2) is merely a proviso to sub-s. (1) and as such it cannot apply to a case which squarely falls under s. 8 (a). Being a proviso to sub-s. (1), the argument proceeds, it must apply to the matter contained in the main provision and that since sub-s. (1) applies only to a case where a competing trade mark is already on the register it cannot apply to a case falling under s. 8 (a) which provision deals, according to him, only with cases where there is no mark on the register. He contends that the language used in sub-s. (2) is in material respects identical with that used in sub-s. (1) and thus establishes the mutual connection between the two provisions. A similar argument was advanced before the High Court and was rejected by it, in our opinion rightly.

If we compare the provisions of s. 8 (a) and s. 10 (1) it would be clear that the object of both these provisions is to prohibit from , registration marks which are likely to deceive or cause confusion.

Deception or confusion may result from the fact that the marks are identical or similar or for some other reason. While sub-cl. (a) of s. 8 is wide enough to cover deception or confusion resulting from any circumstance whatsoever sub- s. (1) of s. 10 is limited to deception or confusion arising out of similarity in or resemblance between two marks. In other words the enactment of this provision would show that where there is identity or similarity in two marks in respect of the same goods or goods of the same description, registration at the instance of another proprietor would be prohibited where a mark is already on the register as being the property of another proprietor.

The provisions of ss. 8 and 10 of the Act are enabling provisions in the sense that it is not obligatory upon a proprietor of a mark to apply for its registration so as to be able to use it. But when a proprietor of a mark, in order to obtain the benefit of the provisions of the Trade Marks Act, such as a legally protected right to use it, applies for registration of his mark he must satisfy the Registrar that it does not offend against the provisions of s. 8 of the Act. The burden is on him to do so. Confining ourselves to cl. (a) the question which the Registrar has to decide is, whether having regard to the reputation acquired by use of a mark or a name, the mark at the date of the application for registration if used in a normal and fair manner in connection with any of the goods covered by the proposed registration, will not be reasonably likely to cause deception, and confusion amongst a substantial number of persons (1). What he decides is a question of fact but having decided it in favour of the applicant, he has a discretion to register it or not to do so vide *Re Hack's Application* (2). But the discretion is judicial and for exercising it against the applicant there must be some positive objection to registration, (1) See 38 Halsbury's Laws of England, pp, 542, 543, (2) (1940) 58 R. I. ? C. 91.

usually arising out of' an illegality inherent in the mark as applied for at the date of application for registration, vide *Re Arthur Fairest Ltd's application* (1). Deception may result from the fact that there is some misrepresentation therein or because of its resemblance to mark, whether registered or unregistered, or to a trade name in which a person other than the applicant had rights vide *Sno v. Dunn* (2). Where the deception or confusion arises because of resemblance with a mark which is registered, objection to registration may come under s. 10 (1) as well (3). The provisions in the English Trade Marks Act, 1938 (1 & 2 Geo. 6 c. 22) which correspond to s. 8 and 10 (1) to 10 (3) of our Act are ss. II and 12 (1) to 12 (3). Dealing with the prohibition of registration of identical and similar marks Halsbury has stated at pp. 543-544, Vol. 38, thus.

"Subject to the effect of honest concurrent use or other special circumstances, no trade mark may be registered in respect of' any goods or description of goods that (1) is identical with a trade mark belonging to a different proprietor and already registered in respect of the same goods or description of goods ; or (2) so nearly resembles such a registered trade mark as to be likely to deceive or cause confusion."

Since the Trade Marks Act, 1940 is based on the English statute and the relevant provisions are of the same nature in both the laws, though the language of s. 8(a) is slightly different from that of s. 11

of the English Act and that of s. 10(1) from that of s. 12(1) of the English Act, we see no reason for holding that the provisions of s. 8(a) would not apply where a mark identical with or resembling that sought to be registered is already on the register. The language of s. 8(a) is wide and though upon giving full effect to that language the provisions of s. 10(1) would, in some respects, overlap those of s. 8(a), there (1) (1951) 68 R.P.C. 197. (2) [1890] 15 A.C. 252. (3) See note 'k' at p. 542 of 38 Halsbury's Laws of England.

can be no justification for not giving full effect to the language used by the legislature.

It would be useful to set out the comparison between s. 12(1) and s. 11 of the English Act made by Kerly on Trade Marks, 8th edn. p. 158. What is stated there is as follows :

"A registration may often be refused under section 11 when refusal could not be justified under section 12(1) owing to the goods being of a different description. In other cases where an opponent is registered but might be unable to prove a reputation for it by use, section 12(1) is more effective in securing refusal of an application than section 11, e.g., Huxley's application (1). The criterion which decides whether the Registrar should make the comparison of an applicant's mark with an opponent's mark under section 11 or under section 12(1) is whether he is considering the proved use of the opponent's mark.

Prima facie, however, the scope for possible confusion under section I"" is wider than the scope for confusion under section II."

In the case before us the Deputy Registrar has permitted the registration of the respondent's mark though it is identical with that of the appellant's and though the appellant's mark was not registered at the date of the respondent's application upon the ground of honest concurrent use of the mark by the respondent from the year 1928 and also on the ground that there are other special circumstances. Mr. Pathak has challenged the finding about concurrent use and also the finding that there are special circumstances justifying the registration of the, respondent's mark. We shall deal with the arguments advanced by him on these points later in our (1) (1924) 41 R. P. C. 423,439.

judgment. For, before we do so we must deal with his argument, which is indeed his main argument, that the grounds given by the Deputy Registrar for registering the mark are not available in this case because it falls under s. 8(a) of the Act and not under s. 10(1).

We have already quoted s. 10(2) which empowers the Registrar, in the case of honest concurrent use or other special circumstances, to permit the registration by more than one. proprietor of trade marks which are identical or nearly resemble each other in respect of the same goods or description of goods, subject to such conditions and limitations, if any, as he may think fit to impose. If this provision is considered by itself, upon its plain language it permits simultaneous registration of identical or similar marks at the instance of several proprietors, quite irrespective of the question whether an identical or similar mark is already on the register. The question, however, is whether sub-s. (2) can be regarded by itself or it is, as contended by Mr. Pathak, only a proviso to sub-s. (1)

and being a proviso it must apply only to cases which are contemplated by the main enacting provision, that is, sub-s. (1) of s. 10. He concedes that sub-s. (2) is not described by the legislature as a proviso to sub-s. (1) but he wants us to construe it as a proviso because it occurs in the same section as sub-s. (1) and its language is similar to that of sub-s. (1).

Mr. Pathak points out, and rightly, that sub-s. (1) of s. 10 deals solely with a case where a trade mark is already on the register and says that since on the date of the application made by the respondent the appellant's mark was not on the register this provision would not apply. The condition for the applicability of sub-s. (1) is undoubtedly the existence of an identical or similar mark on the register. According to him, it is only when this condition is satisfied that the ban upon registration imposed by sub-s. (1) can be lifted under sub-s. (2). He lays particular stress on the opening words of sub-s. (1) "save as otherwise provided in sub-s. (2)" and contends that full effect cannot be given to them unless sub-s. (2) is read with sub-s. (1).

In support of this contention he has referred us to *Ram Narain Sons Ltd., v. Assistant Commissioner of Sales Tax*(.). That was a case where this Court was considering the proviso to Art. 286(2) of the Constitution and the Court held that a proviso was meant only to lift the ban under Art. 286(2) and nothing more. Bhagwati J., who delivered the judgment of the Court has observed thus :

"It is a cardinal rule of interpretation that a proviso to a particular provision of a statute only embraces the field which is covered by the main provision. It carves out an exception to the main provision to which it has been enacted as a proviso and to no other."

These observations, however, must be limited in their application to a case of a proviso properly so called and there is no justification for extending them to a case like the present where the legislature has, when it could we I do so if that were its intention, not chosen to enact it as a proviso. The decision.. therefore, affords no support to the contention.

The fact that sub-s. (2) is part of the same section as sub- s. (1) cannot justify the conclusion that it was enacted solely for the purpose of lifting the ban enacted by sub-s. (1). Its language is wide enough to embrace a mark which is already on the register as well as a mark which is not on the register at all. The mere fact that sub-s. (1) is made subject to the provisions of sub-s. (2) cannot justify the narrowing of the scope of the language used by the (1) [955] 2 S. C. R, 483, 493.

legislature in sub-s. (2). Indeed, it is the duty of the court to give full effect to the language used by the legislature. It has no power either to give that language a wider or narrower meaning than the literal one, unless the other provisions of the Act compel it to give such other meaning. Thus, for instance, if there had been no provision like s. 8(a) and the only provision relating to the prohibition of registration of marks was the one contained in sub-s. (1) of s. 10 the Court would have been compelled to construe the language of sub-s. (2) in = a way as to confine its operation to cases which fall under sub-s. (1). Full effect can be given to the opening words of sub-s. (1) of s. 10 by construing them to mean that sub-s. (1) is subservient to sub-s. (2). No violence is done to those words nor anything detracted from their meaning by so construing them. Further, apart from sub-s. (2) there

is sub-s. (3) in s. 10. If sub-s. (2) is to be given restricted meaning sub-s. (3) also will have to be given a restricted meaning and confined to cases where there is already a mark on the register. To do so would clearly be an untenable construction of sub-s. (3). That provision contemplates applications by different proprietors for registration of trade marks which are identical or nearly resemble each other in respect of the same goods or description of goods. The competition there contemplated is amongst proprietors whose marks are not on the register and is not limited to cases in which a mark of any other proprietor which is identical or similar to that of the competitors is already on the register. For, there is no reference in that provision to a proprietor whose mark is already on the register. If, therefore, subs. (3) cannot be limited to cases which fall under sub-s. (1) there is additional reason why sub-s. (2) cannot be so limited either. Then there is another reason why such a limitation cannot be placed upon the language used in sub-s. (2). If it were limited in the manner contended for on behalf of the appellant, the result would be that a mark which is not on the register will get a higher protection than a mark which is already on the register. Thus, honest concurrent use or other special circumstances would never be a ground for obtaining registration of an identical or similar mark unless there is on the register already a mark which is identical with or similar to the one mark which is sought to be registered. That would,, indeed, create an extraordinary situation. As we have already stated, the appellant's mark was in fact registered on July 11, 1951 and if Mr. Pathak's argument is accepted the very next day after the registration of the appellant's mark it would have been open to the respondent to apply for registration of its mark and the Deputy Registrar would have had the jurisdiction to register it under sub-s. (2) of s. 10, though he lacked that jurisdiction prior to the registration of the appellant's mark. We cannot ascribe to the legislature an intention to create such a situation, a situation which can only be described as ludicrous.

In our opinion the provisions of sub-s. (2) of s. 10 are by way of an exception to the prohibitory provisions of the Trade Marks Act. Those provisions are contained in s. 8(a) and s. 10 (1). It has been held in *Bass v. Nicholson* (1), that a trade mark is not necessarily entitled to protection because its use might deceive or cause confusion and, there- fore, s. 11 does not override s. 12 (2) of the English Act. In *Kerly on Trade Marks*, 8th edn. the position is stated thus :

"It is not correct to consider section II with. out any regard to the provisions of other sections of the Act. The general prohibition contained in section 11 does not cover the cases where the tribunal thinks fit to exercise the discretion conferred by use under section 12 (2)" (pp. 168-9). In support of this statement of the law reliance is placed on *Spillers Ltd's Application* (2). In this (1) (1932) 49 R.P.C. 88. (2) (1952) 69 R,P,C, 327, case it was contended on behalf of the appellants before the High Court that as the Assistant Comptroller in considering s. 11 had reached the conclusion that confusion was likely to be caused it was not open to him to exercise any discretion under s. 12 (2). Danckwerts J., who heard the matter observed :

"This contention renders it necessary to con- sider the relations of secs. 11 and 12. For this purpose the decisions on the former sects. 11, 19 and 21 of the Trade Marks Act, 1905, are of the greatest materiality." (p.



435).

He then considered those decisions and observed at p. 337 thus:

"It seems to me that the construction put by the House of Lords in the cases to which I have referred on secs. II, 19 and 21 of the 1905 Act, must also apply to secs. 11 & 12 of the 1938 Act; and lead to the conclusion that cases where the Court of Registrar thinks fit to exercise the discretion conferred by sec. 12 (2) do not fall within the general prohibition contained in sec. II."

No doubt that was a case which fell under s. 12 (1) of the English Act but the view expressed by the learned judge as well as his further observations support the statement of law by Kerly on Trade Marks. The observations of the learned judge are :

"This being so, it would appear logical in cases which come within sec. 12 (1) to consider first whether the case is one in which the discretion conferred by sec. 12 (2) should be exercised so as to allow registration of the mark, and if the answer is in the affirmative, it cannot be necessary to consider sec. 11 separately, because if there are reasons other than resemblance to an existing mark which cause the proposed mark to be disentitled to the protection of the Court, such reasons must surely affect the exercise of the discretion conferred by sec. 12 (2). It is not possible, as it seems to me, to apply the provisions of the Act as though they were in separate compartments.

In the result, if there is any likelihood of confusion being caused, in my view it would not be right to interfere with the Assistant Comptroller's exercise of the discretion under s. 12(2)".

This case was carried right up to the House of Lords. But the view taken by the learned judge as to the applicability of s. 12 (2) even to cases under s. II was not challenged by the unsuccessful party nor has the House of Lords said anything which would throw doubt on the correctness of the view taken by the learned judge on the point. In Halsbury's Laws of England, Vol. 38, the legal position is stated thus at p. 543 "The foregoing provision (s. 11) does not override the statutory effect of honest concurrent use and an objection under the foregoing provision may be disposed of if there is evidence that the mark has been honestly used without confusion resulting." In support of this statement reliance has been placed on *Bass v. Nicholson & Sons Ltd.*, (1), as well as *Alexander Pierie & Sons Ltd.'s Application* (2), and *Be Kidax (Shirts) Ltd.'s Application* (3). These decisions have a direct bearing upon the provisions which we have to construe here and lend support to the view which we have taken. (1) C 1932) 49 R.P.C. 88. (2) (1933) 50 R.P.C. 147. (3) (1960) R.P.C. 117 C.A. The next question for consideration', is whether the High Court and the Deputy Registrar were right in coming to the conclusion that there was honest concurrent use of the mark by the respondent. In the High Court Mr. S. Chaudhari who appeared for the present appellant conceded that there was honest use in this case but there was no concurrent use within the meaning of s. 10 (2). The burden of his argument on this point was regarding the volume of the use.' Mr. Pathak has confined his argument likewise. Evidence was led in this case on behalf of the respondent for establishing the

volume of use of the mark in India. That evidence was accepted by the Deputy Registrar. One piece of evidence consisted of an affidavit sworn by Florence S. Goodwin, who is the President of Durex Products Inc. There, among\* other things, she has stated : "Your deponent knows that Durex Products Incorporated has done a substantial business in India since 1930." P. B. Mukherji J., who was one of the Judges constituting the Bench which heard the case has described that statement as "'dependable evidence on which he was prepared to rely and act. He also accepted other affidavits filed in the case as well as the opinion of the Deputy Registrar on the point and then observed The question of volume of use is always a relevant question in considering 'honest con- current use' under section 10 (2) of the Act. It depends on the facts of each case. There is no express statutory emphasis that the use should be large and substantial. Kerly at page 235 of the 7th edition on Trade Marks quotes Lyle and Kinahan Ltd.'s Application 24 R. P. C. 249 and other cases for the proposition that it is not, necessary for the applicant's trade to be larger than that of the opponents My own opinion is that the use has to be a business use. 'It has to be' a com-

227 commercial use. It certainly will not do if there is only a stray use."

After pointing out that it is not possible to lay down a hard and fast rule on the volume of use necessary under sub- s. (2) of s: 10, he gave a pertinent illustration of a small trader who sold goods under a particular trade mark for a long time though his use or sales were small in comparison with big international trader% dealing in similar goods bearing a similar trade mark and then observed :

"Even so, if there is honest concurrent use I should think the small trader is entitled to protection of his trade mark. Trade mark is a kind of property and is entitled to protection under the law, irrespective of its value in money so long as it has some business or commercial value. Not merely the interest of the public but also the interest of the owner are the subject and concern of trade mark legislation."

With respect, we agree with the learned judge that in ascertaining the volume of the use it is relevant to consider the capacity of the applicant to market his goods and whether the use was commercial or of other kind. The other learned judge, Bachawat J., observed :

"On the materials on- the record I am satisfied that the use has been substantial as stated in the affidavit of Florence S. Goodwin."

It was contended by Mr. Pathak that originally only samples of the contraceptives were exported to India by the respondent and during the war years their sales were negligible. No doubt, for introducing the goods to India samples were originally sent in the year 1928 or go but subsequent to that, the affidavit of Goodwin on -which reliance has been placed by the High Court and the Deputy Registrar, shows that substantial quantities of contraceptives were exported to India. There might have been a diminution in the volume of use during the war period because of a ban on imports of contraceptives from the dollar area but that was only for a short time. But even before this ban was imposed the volume of use of the respondent's mark in India was considerable. No hard and fast rule can be laid down regarding the volume of use for the purposes of sub-s. (2) of s. 10. Ordinarily it would be sufficient if it is shown that there was a commercial use of the mark., That there was such a

use in this case cannot be disputed. In the circumstances we agree with the High Court and the Deputy Registrar that honest concurrent use of the mark by the respondent for a considerable period has been established. This would be sufficient to dispose of the appeal and would have been sufficient for disposing of the appeal before the High Court. The High Court has, however, considered the alternative ground on which the registration has been ordered. That ground is the existence of special circumstances. The special circumstances are set out fully in the judgment of Mukharji J., and they are as follows :

"In the first instance the word 'Durex' is the name of the company itself. The company used its own name on its own product which every company should be entitled normally to use unless there be cogent reasons against it. Secondly, the use has been for a considerable period of time. The company was incorporated in January, 1928 in New York. On 24 February, 1930 'Durex Products Inc.' applied to the United States Patent Office for the registration of the trade mark 'Durex' and in that application it is expressly said by Florence S. Goodwin's affidavit that the use of the trade mark 'Durex' upon the product is shown for the period beginning from March, 1928. The fact is that the user having been established, it would be a hardship now to deny registration to such an old mark. That also is in my view a factor which could certainly be considered under the words 'other special circumstances' in section 10 (2) of the Act. Thirdly, the socioeconomic consideration of the user of these contraceptives also in my view relate to 'other circumstances' in section 10 (2) of the Act. The Deputy Registrar in this case has taken into consideration the socioeconomic view that contraceptives are necessary in the Indian context for the welfare of the nation. Without expressing my personal view either in favour or against the use of any contraceptive I cannot say that the Registrar was wrong in law in paying consideration to the socioeconomic reasons for the use of the trade mark 'Durex' for contraceptives in the Indian Market as relevant under 'other special circumstances.' Fourthly the 'other special circumstances' is the fact that the applicants' mark is largely confined to contraceptives for use by women and the appellants' admission contained in the letter of 27 October, 1949 from Remfry and son that the present application No. 122251 of 'Durex Products Inc.' is for very different goods. That also in my view is a special circumstance in this case."

In our opinion the 1st, 2nd and the 4th circumstances can be properly regarded as special circumstances and would justify the registration, though not the third one. The reason is that a special circumstance must be connected with the use of, the mark. It has been pointed out in Kerly on Trade Marks at pp. 164-5 thus;

"The words 'or other special circumstances' were held in *Holt & Co., (Leeds) Ltd v Application (1957) R., P. C. 289*, to include any circumstances peculiar to the application in relation to the subject-matter of the application and this includes use by an applicant of his mark before the conflicting mark was registered or used."

We agree with this view and, therefore, do not regard the third circumstance as relevant. Even so, the other three circumstances would be sufficient to justify the registration-of the mark.

It was faintly argued that the respondent has not discharged the burden of establishing that there was no reasonable probability of confusion. This question cannot arise in a case of honest concurrent use. However, we may point out that the High Court, after observing that the burden was undoubtedly on the respondent to establish that there was no reasonable probability of confusion, has held that that burden is discharged by the eloquent fact that throughout there has not been a single instance of confusion. In our opinion there is hardly any likelihood of confusion or deception here because the respondent's goods are confined to contraceptives for use by women which can only be used with medical assistance while the appellant's contraceptives are essentially for men. Upon this view we uphold the order of the High Court and dismiss the appeal with costs. Appeal dismissed.