Present : Hutchinson C.J. and Middleton J. 1916.

JOHN GOSNELL & CO., LTD. *v.* SIVAPRAKASAM.

278—D. C. Colombo, 30,742.

Trade mark — Colourable imitation — "Famora" and "Farina" — Infringement—Evidence—Opinion of witnesses as to the possibility of deception inadmissible.

Plaintiffs' toilet soap had a registered trade mark, the essential particulars of which were the word "Famora" and the device of a lady with a mirror. The defendant sold a toilet soap called "Farina." The device on the plaintiffs' boxes was different to that on the defendant's.

Held, that defendant had infringed the plaintiffs' trade mark, as the use of the word "Farina" was calculated to cause defendant's soaps to be taken by ordinary purchasers for the soaps of the plaintiffs.

The law relating to infringement of trade marks may be stated in a few propositions:—

(1) It is unlawful for a trader to pass off his goods as the goods of another.

(2) Even if this is done innocently, it will be restrained.

(3) *A fortiori* if done designedly, for this is fraud.

(4) Although the first purchaser is not deceived, if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal.

THE facts are stated as follows by the learned Acting Additional District Judge (E. W. Jayewardene, Esq.):—

The plaintiff company is the proprietor of a trade mark consisting of the word "Famora" and of the device of a female figure holding up a mirror, and duly registered on August 16, 1905. The plaintiffs do a large trade in Ceylon in soaps and perfumes, and have for many years extensively used this trade mark and the word "Famora" as a trade mark in respect of soap manufactured and sold by the plaintiffs, and plaintiffs' soap has become known as "Famora Soap." The plaintiffs' soap is packed in packets bearing the word "Famora" and the said device. The packets are enclosed in white oblong cardboard boxes bearing the same device and the words "Gosnell's Famora Toilet Soap" on the cover, and bearing on the two ends of the box labels printed in black and red bearing the signature "Jno. Gosnell & Co." and certain other words in white. The boxes are packed in packets containing four boxes. The packets are wrapped in blue paper printed with the words "Gosnell's Famora Soap Tablets" and bound with a white label bearing the same device and the words "Gosnell's Famora," surrounded with a red ornamental frame showing certain coats-of-arms at the ends and a device on the back printed in black and red, similar to the labels affixed to the end of the boxes. The defendant is selling soap bearing

1910.

John Gosnell & Co., Ltd. v. Sivaprakasam

the words " Garuda Farina Soap " in white oblong cardboard boxes bearing a device of a Hindu god and two goddesses riding on a bird. The plaintiffs complain that the soap, packets, boxes, labels, and covers used by the defendant for the soap sold by him are similar to those used by the plaintiffs, and intended and calculated to deceive intending purchasers. The plaintiffs allege that the use of the word " Farina " is an infringement of the plaintiffs' trade mark, and the employment of the boxes, labels, packets, and covers by the defendant is an unlawful imitation of the get-up of the plaintiffs' goods.

The learned District Judge held that the use of the word " Farina " was an infringement of the plaintiffs' trade mark, and entered judgment for plaintiffs as prayed for.

The defendant appealed.

van Langenberg (with him *Morgan de Saram*), for the defendant, appellant.

Elliott, for the plaintiffs, respondents.

Cur. adv. vult.

November 28, 1910. MIDDLETON J.—

This was an appeal from a judgment in an action for infringing the plantiffs' trade mark, and for passing off goods not of the plaintiffs' manufacture as and for goods of the plaintiffs.

It was suggested that the learned District Judge had wrongly found that the defendant had infringed the plaintiffs' trade mark, and that the evidence did not sustain his finding that the defendant had passed off his goods as the plaintiffs'.

A further point was that evidence had been wrongly admitted as to the opinion of witnesses with regard to the possibility of deception. In *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*,[1] the House of Lords were clearly of opinion that such opinions were irrelevant and inadmissible, and they would certainly not be admissible under the sections of our Evidence Ordinance, which apply to opinions, *i.e.*, sections 45 to 51.

So far as they have been admitted in the present case, it will be our duty to overlook them, but I think that the evidence without them justifies the findings of the learned Judge, *i.e.*, on the first five issues settled. The question, then, is whether there has been an infringement of the plaintiffs' trade mark.

In my opinion the evidence in the record goes to show that the plaintiffs' soap was known as " Famora " toilet soap, a distinctive name, which would identify it with the plaintiffs' firm. " Famora " and the device of the lady with the mirror form the essential particulars of the trade mark of the plaintiffs. The device on the plaintiffs' boxes is utterly different to that on the defendant's, but the question is whether the use of the word " Farina " is calculated to cause defendant's goods to be taken by ordinary purchasers for the

[1] (*1901*) *L. R. A. C. 308.*

goods of the plaintiffs, whether there is not a strong probability of its causing deception. If so, this is an infringement by colourable imitation. It is not sufficient to justify imitation to show that the inscription is ambiguous and capable of being understood in different ays, or that a person who carefully examined and studied it might ot be misled (*Kerly 400 and 401*).

Comparing the boxes, packets, labels, wrappings, and stamping f the two soaps, I think that it is clear that the learned Judge was right in holding that the word " Farina " was put in as a colourable imitation of the word " Famora," a part of plaintiffs' trade mark, which would be calculated to deceive the native customer in Ceylon, and so would be an infringement of his trade mark.

I am not impressed with the reasons for the judgment with regard to golf balls in the case of *St. Mungo Manufacturing Company v. Viper and Recovering Company*.[1]

The general get up of the defendant's goods in comparison with the plaintiffs' leads me to the conclusion that there has been imitation with colourable differences which would be calculated to deceive. This would entitle the plaintiffs to maintain their action for passing off.

Lord Justice Kay in *Powell v. Birmingham Vinegar Brewery Company*[2] said the law relating to this subject may be stated in a few propositions:—

(i) It is unlawful for a trader to pass off his goods as the goods of another.

(ii) Even if this is done innocently, it will be restrained. *Millington v. Fox*.[3]

(iii) *A fortiori* if done designedly, for that is a fraud.

(iv) Although the first purchaser is not deceived, if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal. *Sykes v. Sykes and another*.[4]

I think, therefore, that the learned Judge was right in his findings and judgment, and would dismiss the appeal with costs.

HUTCHINSON C.J.—I agree.

Appeal dismissed.

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[1] *27 Cutler's Patent Cases 421.*
[2] *(1896) 2 Ch. Div. 79.*
[3] *3 Mylne & Craig 338.*
[4] *3 B., & C., 541.*