

1937

Present : Abrahams C.J.

ABDUL AZIZ v. MOHAMED BUHARY.

447—P. C. Colombo, 4,593.

Trade Marks Ordinance, No. 15 of 1925—Registration of silver medals—Device of pagoda and Panchayuda—Sale of medals with similar device—No infringement of trade mark—Ordinance No. 13 of 1888, ss. 3 and 4.

Where a person registered under the Trade Marks Ordinance a trade mark in respect of silver medals, consisting of two spade-shaped shields on one of which was displayed the device of a pagoda and on the other a swastika and five weapons known as Panchayuda.

Held, that the sale of medals with the device of a dagoba on one side and the Panchayuda on the other did not constitute an infringement of the trade mark as the device was not used *qua* trade mark but as part of the medals.

A trade mark registered in respect of silver medals does not extend to medals made of any other metal.

A PPEAL from a conviction by the Police Magistrate of Colombo.

On March 31, 1928, Sheik Dawood of Colombo registered a trade mark for fourteen years. The trade mark consisted of two spade-shaped shields. In the centre of one shield was depicted a pagoda and on the other a *swastika* and five weapons. For a number of years Sheik Dawood sold a number of medals called *panchayuda* with the pagoda on one side, and a large number of medals with the substitution of a dagoba instead of the pagoda. It was alleged against the accused that for some years he was in the habit of purchasing Sheik Dawood's medals, but in October, 1936, he ceased to buy them and shortly afterwards began to sell medals which were almost an exact replica of the *panchayuda* with the dagoba. These medals were made of brass and they were faced with some metallic substance which gave them a silvery appearance.

H. V. Perera, K.C. (with him *Renganathan*), for accused, appellant,—The prosecution is based on a misconception of the meaning of a trade mark. The proprietor of a registered trade mark has a right to prevent others from using the mark *qua* trade mark and not otherwise (*Farina v. Silverlock*¹). A person might register a design of a clock as the trade mark of his manufacture of clocks, but this does not entitle him to prevent the sale of clocks by another man. The accused sold some

¹ (1856) 6 De G. H. & G. 214 (1).

medals with the same symbols which are marks of good luck. The value of the medals lies in the symbols. Merely because the symbols had been registered, the complainant cannot have a monopoly of the trade.

Section 4 of the Merchandise Marks Ordinance, 1888, gives the definition of goods. Section 6 deals with the manner in which an application should be made. The goods must exist independent of the trade mark. The trade mark must not be the goods themselves (*Narumal Khemchand v. The Bombay Company, Ltd.*¹; *James v. Parry*²).

What was registered is different from the design used. Probably he could not register the dagoba. The accused had used the design but not the trade mark.

The registration was with respect to silver medals and not for ones made with base metals (*Jay v. Ladler*³).

There must be evidence that the people were deceived (*Kerly on Trade Marks* (5th ed.), pp. 563-564).

Hayley K.C. (with him *Choksy*), for complainant, respondent.—*Powell v. The Birmingham Vinegar Brewery Company, Ltd.*⁴, deals with the "passing off" of goods.

[ABRAHAMS C.J.—Could not the defence of the accused be that the complainant is using his design?]

There is the registration. The accused denied that he had those medals. The whole of his conduct was suspicious. The complainant had his trade mark registered under the Trade Marks Ordinance, 15 of 1925.

[ABRAHAMS C.J.—How was the trade mark described?]

There was no obligation to describe the trade mark. The complainant had used the pagoda and the dagoba. It is immaterial what it was, as the question is whether the accused had infringed the complainant's mark.

Forging a trade mark is defined in section 5 (a) of the Ordinance, and the accused is charged under section 3 (1) (b). Under these sections it is immaterial whether the complainant sold any medals or not. It is enough if the accused is shown to have made use of it in such a way as calculated to deceive the public. The registration takes the place of public user. A person may make use of a portion of the trade mark. That only lessens the protection. The Merchandise Marks Ordinance, 1888, must be read with the Trade Marks Ordinance, No. 15 of 1925. The section 39 *et. seq.* of the latter Ordinance relates to the effect of registration (*Kerly on Trade Marks* p. 493). No authority has been quoted that the whole of the trade mark must be in one plane. There is nothing to prevent the complainant putting one on each side. The owner can vary it.

There is no registration of trade marks in India and, therefore, the Indian cases will not help the Court.

It is immaterial whether the medals were sold because of the design or not. It is legitimate to put his mark on the whole thing. He may have the emblem without the *swastika*. This medal has all the requisites necessary under the Trade Marks Ordinance.

¹ (1914) 15 *The Criminal Law Journal of India*, 670; *A. I. R.* (1914) *Sind.* 109.

² (1885) 3 *Pat. cas.* 340.

³ (1888) 6 *Pat. cas.* 136.

⁴ (1897) 14 *Pat. cas.* 720 at 730.

[ABRAHAMS C.J.—A photograph may be attached to a box of chocolates, but yet anyone can sell the photograph without the chocolates.]

The shape has nothing to do in that case. If there was a medal of the size of a five-shilling piece, the public may demand it because of the trade mark and use it as a charm (*Young v. Cook*¹).

The accused has deceived not only as regards the trade mark, but with regard to the material as well.

The whole of the passing off is a question of fact (*Reddaway v. Banham*²; *Powell v. The Birmingham Vinegar Brewery Company, Ltd.*³).

This penal Ordinance is mainly for the protection of the public and not for the protection of a few traders.

[ABRAHAMS C.J.—You cannot contend about the silver.]

On the technical side I cannot.

H V. Perera, K.C. in reply.—The area covered by the civil action and that by the criminal action of passing off is not the same. The criminal action does not deal with the get up.

The application for the registration must refer to the goods. Consider the *Monkey Brand* case. The trade mark must be independent of the goods. It is not certain whether there is any legislation in India with regard to the registration of trade marks.

In India the civil law of trade is well developed and an application for a trade mark is immaterial. The word *panchayuda* relates to the charm itself.

The shape is characteristic of the thing itself. It is not something applied to it. A piece of metal will not have a sale at all. The market and the saleability depends on the design only.

In the case of the *Valentine Meat Juice* case the name became associated with the manufacture itself. Hence if anyone bought it, he was believed to have bought the one manufactured by that company. (*Whitstable Oyster Fishery Company v. Hayling Fisheries Ltd. and George Tabor*⁴; *Fels. v. Christopher Thomas and Brothers Ltd.*⁵).

Cur. adv. vult.

October 8, 1937. ABRAHAMS C.J.—

This case has led to a very interesting argument in trade mark law and has been very ably presented, as one would expect, by both the learned Counsel engaged. The appellant was charged in the Police Court of Colombo as follows:—

- (a) with falsely applying to goods a mark so nearly resembling Trade Mark No. 4,236 as to be calculated to deceive and thereby committing an offence against section 3 (1) (b) punishable under section 3 (3) of Ordinance No. 13 of 1888; or alternatively with causing to be applied to goods a mark so nearly resembling the said trade mark as to be calculated to deceive and thereby committing an offence against section 3 (1) (b) read with (f) punishable under section 3 (3) of the said Ordinance;

¹ (1877) 47 L. J. M. C. 28.

² (1896) 13 Pat. cas. 218 at 224.

³ (1897) 14 Pat. cas. 720 at 727.

⁴ (1901) 18 Pat. cas. 434 at 445.

⁵ (1903) 21 Pat. cas. 85.

- (b) with applying a false trade description to goods and thereby committing an offence against section 3 (1) (d) read with section 4 (2) punishable under section 3 (3) of the said Ordinance; or alternatively with causing to be applied to goods a false trade description and thereby committing an offence against section 3 (1) (d) and (f) read with section 4 (2) punishable under section 3 (3) thereof;
- (c) with selling or exposing for sale or having in his possession for sale goods to which a false trade description was applied; or alternatively to which a mark so nearly resembling Trade Mark No. 4,236 as to be calculated to deceive was applied and thereby committing an offence against section 3 (2) of the said Ordinance punishable under section 3 (3) thereof.

He was convicted on the first count alternatively, on the second count alternatively, and on count three and was fined Rs. 50 on each count (i.e., Rs. 150 in the aggregate) or in default six weeks' rigorous imprisonment.

The facts which led to his prosecution are as follows:—On March 31, 1928 one Sheik Dawood of Colombo registered a trade mark for fourteen years. The certificate of registration shows that the trade mark consisted of two spade-shaped shields about one inch long by three quarters of an inch broad, side by side. In the centre of the left hand shield is permanently portrayed a pagoda, and on the other shield is portrayed so as to occupy a considerable portion of its surface a swastika and five weapons. It was given in evidence that the swastika and the five weapons had associations sacred to members of the Buddhist faith. The trade mark was stated to be registered in respect of silver medals. It seems rather remarkable that a trade mark which is intended merely to designate that the goods to which it is attached are the goods produced of a particular manufacturer or owned by a dealer should, in this case, consist of such a large number of elaborately arranged objects, and that, in the words of a witness from the Registrar-General's Office, both faces of the medal should be registered, and it seems to me to be obvious from the outset that these peculiarities had a bearing on the intentions of the manufacturer when he registered the mark. For a number of years Sheik Dawood sold a large number of medals with the pagoda on one side and the swastika and five weapons on the other, and a large number of medals the same as these but for the substitution of a dagoba for the pagoda. Some of the medals were made of silver, some others of what is described in the evidence but not explained as alpaca silver. It was given in evidence by Sheik Dawood's attorney and manager Abdul Azeez that mostly Sinhalese Buddhists buy the medals, and that they buy them for their children, and that they are sold as "Panchauda", that is to say, five weapons. It was given in evidence by a vedarala that by itself the swastika is the sign of luck among Buddhists, and that the "Panchauda" has some curative effect where medicines fail. I think then it is manifest that the demand for these medals, which, according to Abdul Azeez were sold at 60 cents for the silver specimens and 25 cents for the alpaca silver specimens, were for their use mainly as charms though they may have had a certain ornamental quality which possibly made them attractive.

It was alleged against the appellant that for some years he was in the habit of purchasing Sheik Dawood's medals, but in October, 1936, he ceased to buy them and shortly afterwards began to sell medals which were almost an exact replica of the "Panchauda" and dagoba sided medals which he had hitherto purchased from the complainant. These medals were made of brass and they were faced with some metallic substance which gave them a silvery appearance.

Now, dealing with the first charge a point has been raised by the appellant which is immediately fatal to the conviction on that count. It is pointed out that the trade mark is registered in respect of silver medals only and therefore cannot extend to medals made of any other metal, precious or base. This point was raised in the Police Magistrate's Court, but the learned Police Magistrate waived it aside denouncing it as an extremely technical defence which, in his opinion, should not be seriously considered. It is, of course, extremely technical, but why the learned Magistrate disposes of it in that summary way I do not understand. He ought to have appreciated that the application of Sheik Dawood meant what it said and that he did not use the expression "medals" *simpliciter* or "medals of every metal" as he might have done. Learned Counsel for the respondent admits quite freely that unless silver can be extended to mean brass silvered over (and he does not suggest that it can) the appellant is entitled to succeed on that ground.

There is, however, a further ground upon which it is argued by the appellant that he is entitled to an acquittal not only in respect of this count but in respect of the others as well. He claims that he did not use the complainant's trade mark as a trade mark but that the device which was engraved upon the medals became part of the goods and was not engraved as a trade mark, that is to say, as a mark attached, or to use the words of the Ordinance "applied to the goods" (*i.e.*, the mere plain metal tablet) to indicate that the goods were those produced by a particular manufacturer in distinction to similar wares produced by other firms.

Now section 3 (1) (b) of the Merchandise Marks Ordinance penalizes any person who falsely applies to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive, and it seems to me, on analysis, to mean this, that a person applies to goods the trade mark of another person or some mark which appears to be the trade mark of another person in such a way as to lead the public to believe that that mark has been applied to the goods *qua* trade mark, that is to say, to indicate that the goods on which the mark appears are the goods of some particular person. But has the trade mark of the complainant been applied to the metal tablet in such a way as to suggest to the public that the metal tablet is the manufacture of Sheik Dawood? I cannot admit that for a moment. In view of the insignificance of the tablet itself, the number and distribution and sacred associations of the objects in the device, and the evidence given as to the reasons for which members of the public purchase the medals so engraved, I can only come to one conclusion and that is that the metal tablets are merely of importance for the purpose of displaying the device and that is the reason why the medals are purchased. Looked at in another way, the device and the tablet

upon which it is engraved combine to form a "charm" or an ornament, and the device loses its distinguishing characteristic of a trade mark (if indeed it was ever intended to have that characteristic by the complainant itself) and becomes a part of the goods to which it is applied. I am therefore of opinion that for this reason also the appellant is entitled to acquittal on the first count.

The same reasoning which relieves the appellant from liability in respect of count one, also clearly applies to count two. The wording of section 4 (2) under which it is sought to bring home liability to the appellant makes it a false trade description to apply to goods "any such figures, words, or marks, or arrangement or combination thereof, whether including a trade mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are". It is obvious that what is intended by this provision of law is the application to goods of some figures, words, or marks, placed on the goods for the same purpose as a trade mark and not placed there so as to become part of the goods themselves, as for instance the pattern on a wall paper, or the chasing of figures, or of an ornamentation upon a metal vase, so as to form with the goods upon which they are placed some new combination as in this case, where a device engraved upon a metal tablet makes a charm. In this connection an Indian case has been cited to me which bears a remarkable resemblance to this case. In *Narumal Khemchand v. The Bombay Company, Ltd.*, Hayward J.C. and Boyd A.J.C. held that a person who imported chintz printed with a particular design or pattern similar to other chintz imported by another firm was not guilty of applying a false trade description to goods under section 41 of the Indian Merchandise Marks Act, 1889. This section is identical with section 4 (2) of the Ceylon Ordinance. The Court said, "The design or pattern makes the chintz attractive for sale and is part and parcel of the goods themselves. Whereas what appears to us to be contemplated by the section is the application of some independent marks calculated to lead persons to believe the goods to be the merchandise of some other person". This reasoning applies to the case before me with even greater strength, since purchasers of chintz wanted chintz and merely selected that particular chintz because of the attractive pattern. Whereas persons in Colombo buying "Panchauda" medals were primarily purchasing them because of the design, and they merely looked upon the medal itself as the medium to enable them to purchase the design. In other words the medal was the subordinate consideration.

A number of English decisions on passing off cases were cited, but they do not help to interpret this Ordinance. A passing off action is not unfamiliar in this country and it may be, I give no opinion on this point, that the complainant had his remedy in that connection, but to say that one man has imitated the goods of another is not the same as saying that he has applied somebody else's trade mark to his own goods or given a false trade description to them.

The second count also fails and the third count automatically follows it. I quash the convictions and acquit the appellant.

Convictions quashed.