

1937

Present : Abrahams C.J.

## CADER SAIBO &amp; CO. v. MOWLANA.

665—P. C. Colombo, 4,083.

*Trade mark—Registering of trade mark in respect of fabrics and paper bags—Trade mark consisting of the word Mowlana—Use of similar bags by dealer of the name of Mowlana to wrap goods sold at his shop—No infringement of trade mark—Ordinance No. 13 of 1889, s. 3 (1) (b and d) and s. 6 (1) (c and d).*

The complainants, a firm of merchants, dealing in fabric, registered in respect of it a trade mark consisting of the word "Moulana" in block capitals. At the same time they obtained registration in respect of goods of another class consisting of paper bags, wrappers, and containers, the trade mark "Moulana" written obliquely across the bag in cursive writing terminating with a flourish.

The accused who was a dealer in drapery and oilmanstores and whose name was "Moulana" used the word on paper bags, printed in the same style as the word figuring in the complainant's bags, in order to indicate that the goods which were enclosed in them were purchased at the shop at which he traded.

*Held*, that the use of the paper bags for the purpose indicated, did not amount to an infringement of the complainant's trade mark.

**T**HE accused was charged under section 3 (3) of the Merchandise Marks Ordinance, No. 13 of 1888, with the following offences:—

- (1) that he did falsely apply to goods a mark (consisting of the word "Mowlana" printed obliquely across the face of paper bags or containers for packing or parcelling goods or as a covering or wrapper, for goods), which mark so nearly resembled the complainant's trade mark as to be calculated to deceive;
- (2) did cause the aforesaid mark to be falsely applied to goods;
- (3) did have in his possession for the purpose of his trade, paper bags or containers to which the aforesaid mark has been falsely applied.

He was convicted on the second and third charges and fined Rs. 100 on each count.

*H. V. Perera, K.C.* (with him *M. Maharoo*), for accused, appellant.—A trade mark must be registered in respect of "goods". The Ordinance defines "goods" as anything that is the subject of trade, manufacture, or merchandise. Complainant's mark is registered in respect of goods enumerated in class 38, *i.e.*, stationery, such as paper bags, envelopes, wrappers, &c. Complainant, therefore, had exclusive right to deal in stationery under his registered mark.

It is no offence for anyone to apply the same mark to other goods.

The accused never sold stationery and therefore it cannot be said that he has infringed complainant's rights. Before accused could be convicted it must be shown that he used the mark in question *qua* trade mark. (*Abdul Azeez v. Seyed Mohamed Buhary*).

The mere use of one's own name in connection with one's trade is not user as a trade mark.

Accused's use of the mark on the paper bags did not indicate that he was a dealer in or manufacturer of the paper bags. (*In re Powell's Trade Mark*¹.)

F. A. Hayley, K.C. (with him N. K. Choksy), for complainant, respondent.—By registering the mark in respect of goods in class 38, which included paper bags the complainant obtained the right to prevent other persons using the same mark upon paper bags.

The accused had not obtained the consent of the complainant and therefore he had used the mark "falsely" within the meaning of the term as used in the Ordinance.

User of one's own name in certain circumstances may amount to infringement of another's rights.

It is no defence to state that the accused never sold stationery.—He might do so at any time.

Counsel cited *Teofani Cigarettes case*², *Valentine Meat Juice case*³, *Brinsmead Piano case*⁴.

*Cur. adv. vult.*

November 12, 1937. ABRAHAMS C.J.—

The appellant was charged with the following offences, that he—

- (1) did falsely apply to goods a mark (consisting of the word "Mowlana" printed obliquely across the face of paper bags or containers used for packing, placing in them, or parcelling goods of the accused or used as a covering or wrapper for goods of the accused), which mark so nearly resembles Registered Trade Mark No. 6,073, consisting of the word "Moulana", as to be calculated to deceive, and that the accused did so in breach of section 3 (1) (b) read with section 6 (1) (c) of Ordinance No. 13 of 1888 and did thereby commit an offence punishable under section 3 (3) of the said Ordinance ; or alternatively
- (2) did cause the aforesaid mark (to wit, the word "Mowlana" printed obliquely across the face of the paper bags or containers used for packing, placing in them, or parcelling goods of the accused in them or used as a covering or wrapper for goods of the accused), which said mark so nearly resembles Registered Trade Mark No. 6,073 as to be calculated to deceive, to be falsely applied to goods within the meaning of section 3 (1) (f) read with section 6 (1) (c) and did thereby commit an offence punishable under section 3 (3) of Ordinance No. 13 of 1889 ;
- (3) did have in his possession for the purposes of his trade, things, to wit, paper bags or containers used for packing, parcelling, or placing in them goods of the accused or used as covering or wrapper for the goods of the accused, to which a mark consisting of the word "Mowlana" printed obliquely across the face of the said paper bags, used as aforesaid, has been

¹ (1893) 2 Ch. D. 388, at p. 403.

² 30 R. P. C. 76 ; 446.

³ 17 R. P. C. 1. ; 673.

⁴ 30 R. P. C. 137.

falsely applied and which mark so nearly resembles Registered Trade Mark No. 6,073, as to be calculated to deceive and that the accused did so in violation of the provisions of section 3 (2) of the said Ordinance punishable under section 3 (3) thereof ;

- (4) did apply a false trade description to goods within the meaning of section 3 (1) (d) read with sections 4 (2) and 6 (1) (c) of the said Ordinance or alternatively did cause the same to be applied within sections 3 (1) (d) and (f) read with sections 4 (2) and 6 (1) (c) of the said Ordinance, in that he did place or enclose or cause to be so done goods of his which have been sold, in a covering or wrapper, to which the said false trade description, consisting of the word or mark "Mowlana" printed obliquely across the face of such covering or wrapper, had been falsely applied, and which said word or mark is reasonably calculated to lead persons to believe that the goods of the accused are the goods or merchandise of the owners of the said Registered Trade Mark No. 6,073, and that the accused did thereby commit an offence punishable under section 3 (3) of Ordinance 13 of 1889.

He was convicted on the second and third charges and fined Rs. 100 on each. The facts of the case are very interesting and unusual, indeed so far as I am aware unique. The complainant firm are a firm of merchants who deal extensively in silk, cotton, and woollen piece goods. They claim to have a large capital and have two shops in Colombo and a branch in Kandy. They deal in particular with a fabric to which they attach the name "MOULANA" and in respect of which they obtained registration under the Trade Marks Ordinance, No. 15 of 1925, on October 30, 1934. This trade mark consisted of the word MOULANA, in block capitals, enclosed within a lozenge shaped figure. At the same time they also obtained registration in respect of "all goods in class 38", that is to say, broadly speaking, paper bags, wrappers and stationery. The trade mark in this case consisted of the word "MOULANA" *simpliciter* in large block cursive writing terminating with a flourish. This word appears printed in very large form obliquely across the bags and wrappers in which their goods were enclosed, upon which bags and wrappers are also printed in characters considerably smaller than the word "MOULANA" the exact name of the firm, and their trade, addresses, and the description of the goods in which they deal. They do not manufacture or sell and have never manufactured or sold goods in class 38.

The appellant in this case is actually named S. O. B. S. A. Moulana. He also deals in piece goods and has a shop in Colombo not far away from a shop called Zacharias Stores with which the complainant firm claimed to have some connection. He describes himself as a general merchant, dealer in drapery and oilman stores, &c., and as a Gents' Tailor. In December of last year it was brought to the notice of the complainant firm that the appellant was using paper bags and wrappers across which the word "MOWLANA" was printed obliquely in characters precisely the same style as the word "MOULANA" figuring

on the complainant's paper bags. The appellant's bag and the complainant's bag were exhibited in the lower Court. There is no doubt that the word "MOWLANA" very closely resembles the word "MOULANA". It is printed in red instead of in black and the appellant's address appears below it. But it is very difficult to resist the conclusion that it was put upon the bag in order to create the impression that the appellant's store was in some way connected with the bigger firm. A trifling difference in the spelling of the two words, and the difference in the colour in which they are printed, is an endeavour to assert a plausible sort of reason that there was no intention to imitate.

Now, it is not complained that the appellant has infringed the complainant's trade mark rights in respect of the "Moulana Fabric" nor is it complained that he is endeavouring to pass off his piece goods as the piece goods of the complainant firm. Complainant's point of view has been stated in the most concise language by Mr. Hayley. This is what he seems to say: "I have a trade mark 'MOULANA' in respect of paper bags and wrappers. It is perfectly true that I do not make nor do I sell paper bags or wrappers, nor does the appellant, but that does not matter. He is using for the purposes of his trade in piece goods and other wares paper bags to which he has applied or caused to be applied my trade mark, and that is an offence". To this the appellant says first of all, "it is immaterial whether I am manufacturing or selling paper bags and wrappers. It is said that I am infringing a trade mark but I am not trading in paper bags and wrappers. Further, I am using the word 'MOWLANA' on the paper bags merely as my name to indicate that the goods which are enclosed in the paper bags and wrappers were purchased at my shop in which I trade under my own name of Mowlana".

It seems to me that the contention of the appellant must prevail. He is accused of falsely applying or causing to be applied to goods another trade mark. The expression "goods" is defined in section 4 of the relevant Ordinance as "anything which is the subject of trade, manufacture, or merchandise". The word "merchandise" is, of course, a word cognate to the word "trade". The question naturally suggests itself; the subject of trade, manufacture, or merchandise, in respect of whom? In a charge of falsely applying a trade mark to goods, I think the person referred to must be the person who is charged. They must be his goods and therefore he must be trading with them and manufacturing them or in some other way treating them as merchandise, that is to say, dealing with them as a merchant. It cannot be said that merely because these articles are adjuncts and are ancillary in some way to the appellant's trade as a piece goods merchant or tailor that he is trading with them or dealing with them commercially. Looking at the matter in an ordinary commonsense way we should not expect a confectioner to speak of the silver paper in which he wraps up his chocolates as his goods, or the green-grocer to speak of the baskets in which his cabbages or turnips are sent round to his customers as his goods.

It further appears to me that the second contention of the appellant is also perfectly sound. To be convicted of falsely applying a trade mark to goods, the trade mark must be applied *qua* trade mark. In the

case of *Abdul Azeez v. Seyed Mohamed Buhary*<sup>1</sup> it was said, "Now, section 3 (1) (b) of the Merchandise Marks Ordinance penalises 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". Now the word "MOWLANA" has certainly not been applied by the appellant to his paper bags in such a way as to indicate to the public that the paper bags have been manufactured or sold by any particular person; that is not the impression that a member of the public would get. The word has clearly been applied to indicate that the goods enclosed in the bags were purchased at a shop owned by a proprietor whose actual name was Mowlana or who traded under the name of MOWLANA, and whether that proprietor was represented in any way as being connected with another firm is, I am satisfied, certainly not to the purpose.

I cannot help thinking that a reference to the purposes for which trade marks exist would not be out of place. I should like, with respect, to cite a passage from the judgment of Bowen L.J. in the case of *In re Powell's Trade Mark*<sup>2</sup>; "The function of a trade mark is to give an indication to the purchaser or possible purchaser as to the manufacture or quality of the goods—to give an indication to his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market. It tells the person who is about to buy, or considering whether he shall buy, that what is presented to him is either what he has known before under the similar name, as coming from a source with which he is acquainted, or that it is what he has heard of before as coming from that similar source". Trade Marks which are registered for one particular purpose may not be used for some other purpose. The complainant must be taken to have intended to protect his paper bags and stationery from the unfair competition of people desiring to represent their paper bags and stationery as his, and he is restricted to actions against such unfair competition.

As regards the third charge, it seems obvious that the key words are "for any purpose of trade or merchandise", and I think that that must mean trading in these goods or things, and not trading in goods in which these things are a necessary or useful adjunct. I quash the convictions and acquit the appellant.

*Convictions quashed.*

<sup>1</sup> 9 C. L. W. 88 and 2 C. L. J. 171.

<sup>2</sup> (1893) 2 Ch. D. 388 at p. 403.