

APPELLATE CRIMINAL.

Before S. K. Ghose J.

NAGENDRANATH SHAHA

v.

EMPEROR.*

1929

Dec. 6.

Trade Mark—Infringement—Standard of comparison—Limitation—Indian Penal Code (Act XLV of 1860), s. 482—Indian Merchandise Marks Act (IV of 1889), s. 15.

In a prosecution for infringement of trade mark, the standard of comparison applied should be not that of the expert, but of the public, the unwary purchasers.

Wotherspoon v. Currie (1) referred to.

If, in minor details, the trade mark of the complainant and that used by the accused are different, but they resemble in essential matters, that is to say, general appearance, the prominent portion of the device, the colouring, etc., the two trade marks are similar, as contemplated by section 482 of the Indian Penal Code.

The limitation under section 15 of the Indian Merchandise Marks Act runs from the date of the infringement complained of, and "offence" means the offence charged.

Buppell v. Ponnusami Tevan (2) distinguished.

Akshoy Kumar Dey v. King-Emperor (3) followed.

APPEAL by the accused.

The appellant, who was the sole agent of the National Tobacco Company and used to sell *birhis* in packets with the label "National Tobacco Co.—Stag "Brand Bidi"—the figure of a deer with the figure 333 on it "Sol. Ag. N. N. Shah 4, Baitakkhana 2nd "Lane, Calcutta," was charged, on the 19th March, 1929, at the instance of the complainant, Manilal Anandji, with having infringed his trade mark, which was as follows:—

"Deer Brand Bidi—figure of a deer with the "words R. G. No. 1680 on it Vrajlal Manilal and Co. "Gondia, C. P."

*Criminal Appeal, No. 505 of 1929, against the order of T. Roxburgh, Chief Presidency Magistrate of Calcutta, dated July 2, 1929.

(1) (1872) L. R. 5 H. L. 508.

(2) (1899) I. L. R. 22 Mad. 488.

(3) (1928) 32 C. W. N. 699.

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A charge, on another count, was that the accused's label, on another quality of *birhi* consisted of a flower, within the circumference of which was written the registered number, while in the complainant's label there was a star, at the centre of which were the words "No. Trade Mark" and "Regd.," and, that by these the accused intended to pass his goods as having been manufactured by the complainant. The complainant stated, at the trial, that in September, 1927, he found the accused infringing the mark and addressed letters to him and he promised to discontinue it, but shortly after he was again found infringing the mark. The defence of the accused was that the complainant had no right in the trade mark used by the accused and that his case was time-barred under section 15 of the Merchandise Marks Act, as the prosecution was launched more than one year after the detection of the infringement. Evidence was given, on behalf of the accused, to show that a deer mark was used by several dealers in *birhi*, and, that the star mark of the complainant and the flower mark of the accused were absolutely different, and, similar figures were used by all *birhi* dealers to indicate different kinds of *birhis*. The Chief Presidency Magistrate of Calcutta, who tried the case, held that the complainant had established his exclusive right to the use of the two brands, and that the accused was using a palpable imitation of those labels, and, sentenced him to fines of Rs. 500 and Rs. 200, in default to rigorous imprisonment for 3 months and 2 months respectively, and, also ordered all blocks and materials of the infringing brands to be seized and made over to the complainant.

The accused, thereupon, appealed to the High Court.

Mr. Mrityunjay Chattopadhyay, for the appellant.

Mr. A. N. Chaudhuri, for the Crown.

Mr. Prabodhchandra Chatterji, for the complainant.

S. K. GHOSE J. The case against the appellant is that he has infringed two trade marks belonging to the complainant Manilal Anandji, one a white deer on a red background and the other composed of figures 4 and 5 on a black ground in the shape of a star on a yellow label. Both the marks were used as trade marks on packets of "birhi" sold by the complainant. The learned Chief Presidency Magistrate has found that, in respect of the figures on the second trade mark, the complainant had no monopoly; but, as regards the rest of the device of the second trade mark, and as regards the first trade mark, the prosecution case has been established. He has, accordingly, convicted the appellant under section 482 of the Indian Penal Code, and sentenced him to pay fines of Rs. 500 and of Rs. 200 respectively on the two counts and in default to undergo rigorous imprisonment for three months and two months respectively. In this Court, it is not disputed that the complainant did have the trade marks as alleged by him. The question is as to whether it has been established that the appellant used false marks in respect of the two trade marks produced by the complainant. I have before me three sets of trade marks which are relevant to the case and I may say at once that in minor details the trade marks of the complainant and the trade marks used by the accused are different; but that, in essential matters, that is to say, as regards the general appearance, the prominent portion of the device, the colouring, and so forth, the two sets of trade marks are similar. This view was also taken by the learned Magistrate. The question is, what is the standard of comparison? It has been held that, for the purpose of establishing a case of infringement, it is not necessary to show that there has been the use of a mark in all respects corresponding with that which another person has acquired an exclusive right to use, if the resemblance is such as, not only to show an intention to deceive, but also such as to be likely to make unwary purchasers suppose that they are purchasing the article sold by the party to whom the right to use the trade mark

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belongs. *Wotherspoon v. Currie* (1). Therefore, the standard of comparison is not that of the expert; but it is that of the lay public; of "the unwary purchasers." In the present case, it would be correct to say that it would be the standard of the ignorant people who use these sorts of "*birhis*" and purchase them from the *bazar*. In view of these considerations, it seems to me that the learned Magistrate correctly held that the trade marks which had been used by the appellant were false trade marks. In the lower court the accused also appears to have given "an undertaking "to drop the use of both trade marks."

The next point, which has been urged in support of the appellant, in so far as the prosecution with regard to the stag brand is concerned, is that it is barred by limitation under section 15 of the Merchandise Marks Act. It is pointed out that it is admitted and found that the complainants first came to know of the infringement in September, 1927, and he brought the case in March, 1929, and it is contended that the case was brought more than a year after the first discovery of the offence and that, therefore, it is barred by limitation. In support of this I am referred to the case of *Ruppell v. Ponnusami Tevan* (2). In that case, however, it appears the complainant had not shown that he believed that the use of the alleged counterfeit trade mark had been discontinued after the first discovery in 1893. This case was considered in *Akshoy Kumar Dey v. King-Emperor* (3). There it was held that the word "offence" under section 15 of the Merchandise Marks Act meant the offence charged. Mr. Chaudhuri for the Crown has pointed out that, in the present case, the offence charged is an infringement in June, 1928, which is well within time. It is contended that, in *Akshoy Kumar Dey's case* (3), the decision went upon the supposition that it was not found that, before the 10th March, 1926, which was the date of the offence charged, the prosecution party was aware that the offence

(1) (1872) L. R. 5 H. L. 508, 519.

(2) (1899) I. L. R. 22 Mad. 488.

(3) (1928) 32 C. W. N. 699.

had been committed. In the present case, however, it is established that, after the original discovery in September, 1927, some action was taken by the complainant, and, as the result, the appellant gave an undertaking not to make use of the trade marks. It is contended that nevertheless the complainant must have known that the accused was going on infringing the trade marks, because their places of business are only a hundred steps apart. But it does not appear from the evidence that the complainant actually knew that the infringement of the trade mark had been continued. No doubt, there was no written undertaking, but there was a verbal undertaking and this is deposed to by the pleader (prosecution witness No. 4) and the complainant himself. This part of the evidence has not been challenged in cross-examination. There are also two letters written by the complainant's agents to the accused and these were found in the *gadi* of the accused. They are of June, 1928, and they refer expressly to the fact that the accused had given an undertaking. Therefore, it comes to this that, after the original discovery in September, 1927, the accused had given an undertaking to desist from infringing the trade mark any further and that there is nothing to show that before June, 1928, the complainant was aware that there had been a fresh infringement. It is contended that nevertheless the limitation must run from the original discovery in September, 1927. Mr. Chaudhuri for the Crown has contended that if that be so, then the undertaking would be meaningless and that the complainant would be put upon his watch to see whether there was going to be another infringement within one year of the first discovery; and it might be that, if there was a subsequent infringement after one year of the original discovery, then the second offence would not be punishable at all. This position reduces the argument advanced on behalf of the appellant to an absurdity. But, as has been pointed out in the case referred to above, the offence mentioned in section 15 of the Merchandise Marks

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Act is the offence charged, and this seems to me to be the only common sense view that can be taken in the present case. In this case, the prosecution is clearly within time. No other points are pressed in this appeal. The conviction of and the sentences passed on the appellant are confirmed.

The appeal is dismissed.

Appeal dismissed.

A. A.