

CRIMINAL REVISION.

Before Biswas J.

LOKE NATH SEN

v.

ASHWINI KUMAR DE.*

1937

July 30 ;
Aug. 2, 3 ;
Sep. 1.

Trade-mark—Registration of a design under the Indian Registration Act, Effect of—Indian Penal Code (Act XLV of 1860), ss. 478, 482, 486.

In India there is no system of registration of trade-marks as in England. All we have here is the registration of a declaration of ownership as regards a particular design under the Indian Registration Act which represents nothing more than the opinion and claim of the declarant. It cannot be equivalent to registration of a trade-mark under the English Trade Marks Act. The Indian Registration Act deals with documents and not with trade-marks. A mark in order to be a trade-mark as defined in s. 478 of the Indian Penal Code must be "distinctive" in the sense of being "adapted to distinguish the goods of the proprietor of a trade-mark from those of other persons".

A mark which merely describes the quality or origin of an article or is such as is commonly used in the trade to denote goods of a particular kind is not "distinctive". To determine whether a mark has become a trade mark, the Court has to take into consideration the extent to which its user has rendered the mark in fact distinctive of the goods in question.

Swadeshi Mills Company, Limited v. Juggi Lal Kamlapat Cotton Spinning and Weaving Mills Company, Limited (1) and *Juggi Lal Kamlapat v. Swadeshi Mills Company, Ltd.* (2) referred to.

A surname is not often suitable for the purpose of a trade-mark.

In Re : *Cadbury Brothers* (3) referred to.

CRIMINAL REVISION by the accused.

The material facts of the case and arguments in the Rule appear sufficiently from the judgment.

Suresh Chandra Talukdar and Bhagirath Chandra Das for the petitioner.

*Criminal Revision, No. 542 of 1937, against the order of S. M. Masih, Sessions Judge of Mymensingh, dated May 11, 1937, confirming the order of K. P. Sen, Magistrate, First Class, Mymensingh, dated Mar. 6, 1937.

(1) (1926) I. L. R. 49 All. 92.

(3) [1915] 1 Ch. 331

(2) (1928) I. L. R. 51 All. 182 ;

L. R. 56 I. A. 1.

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Narendra Kumar Basu and Sachindra Kumar Ray
 for the opposite party.

Cur. adv. vult.

BISWAS J. The petitioner in this case has been convicted under ss. 482 and 486 of the Indian Penal Code for using a false trade-mark and selling goods marked with a counterfeit trade-mark. The trying Magistrate fined him Rs. 100 under each section, in default, sentenced him to simple imprisonment for three months. On appeal, the learned Sessions Judge maintained the fine under s. 482 only, passing no separate sentence under the other section.

Both parties are dealers in and manufacturers of umbrellas at Mymensingh. The complainant's business is of over 25 years' standing, while the accused is said to have been carrying on his business for 10 years or so. The prosecution case is that the complainant manufactures three brands of umbrellas, which are all known in the market as "Ashwini Chhâti" after the name of the complainant Ashwini Kumar De. One of these brands bears a design printed on the inside, being exhibit 1 in the case, and it is this which the accused is charged with having infringed. The design consists of the picture of a swan holding a closed umbrella between its beaks in the centre, with the name "Sree Ashwini Kumar De" in prominent type stretching over it like an arch from end to end, and the figure 8A4 (the letter "A" overlapping the digits 8 and 4) on the top of it. Below in smaller type are the words "Mymensingh Burra Bazar", while in the space between, in slightly smaller type, are the words "Trade Mark" and "registry Number 964" in two lines, intercepted in the middle by the figure of the swan, the first word of each line being on the left. The other two brands do not bear any such design, but simply the name "Ashwini Kumar" and "Ashwini Kumar De" respectively. The complainant claims the exclusive right to use these names also as a trade mark, but as

already stated, the charge is in respect of the design, exhibit 1 only. The false trade-mark which the petitioner is alleged to have used in colourable imitation of this design is on certain brands of umbrellas of his manufacture, of which exhibits II to IV are samples. This offending mark also contains the figure of a swan, but holding an open umbrella in its mouth, with the name "Sree Ashwini Kumar Das" (and not De) similarly arching over it, surmounted by the figure "84" (but without the letter "A" between 8 and 4, as in exhibit 1). Below are two lines, "proprietor Sree Loke Nath Sen" and "Mymensingh *Chhota Bazar*", and there is also the word "Trade" on one side of the swan and the word "Mark" on the other in the same line.

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Apart from the design, exhibit 1, the complainant's umbrella also bears to the right of the same an oval impression containing within it the words "Ashwini Kumar De Marka" and the figure "964", together with a warning to purchasers to note the number at the time of purchase. The figure 964, it may be explained, is the number under which it appears the complainant had a declaration of ownership registered on August 23, 1926, under the Indian Registration Act in respect of the device in exhibit 1. The offending brand of the accused's manufacture, exhibit II, also reproduces a similar oval design, only substituting the surname "Das" for "De" and the figure "965" for "964". No significance is attributable at all to the figure "965": the accused claimed at one stage that this was the number under which he had also "registered" his mark, but failed to substantiate this as a fact.

The first question is, whether the device in exhibit 1 is a valid trade-mark. A trade-mark is defined in s. 478 of the Indian Penal Code as a mark used for denoting that the goods are the manufacture or merchandise of a particular person. This implies that the mark must be "distinctive" in

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the sense of being "adapted to distinguish the goods of the proprietor of a trade-mark from those of other persons". If a mark merely describes the quality or origin of an article, or is such as is commonly used in the trade to denote goods of a particular kind, such a descriptive mark would obviously not be a distinctive mark. For this reason, it has been said that a surname is often not suitable for the purposes of a trade-mark: as Neville J. very expressively puts it in *In re : Cadbury Brothers Application* (1):

The right to the surname that a man uses is shared with every person who elects to use the same name, and consequently, he has got about as much monopoly in it as he has in the air that he breathes.

The device of a pictorial representation would obviously be more appropriate as a trade-mark, but it will still have to be "distinctive".

In England, where there is a system of registration of trade-marks under the Trade Marks Act (5 Edw. VII, c. 15), proof of such distinctiveness in a Court of law does not often present any difficulty. Where, however, as here, no such system exists, the question is one which falls to be determined by the Court itself on evidence. In India, all we have is registration of a declaration of ownership as regards a particular design under the provisions of the Indian Registration Act. Obviously, this is not and cannot be equivalent to registration of a trade-mark under the Trade Marks Act. The Indian Registration Act deals with documents, not with trade-marks. The declaration of ownership represents nothing more than the opinion and claim of the declarant. "In a country like India, where there is no statute for registering trade-marks", it has, therefore, been said, "a right to a trade-mark is acquired by user". See *Swadeshi Mills Company, Limited v. Juggi Lal Kamlapat Cotton*

(1) [1915] 1 Ch. 331.

Spinning and Weaving Mills Company, Limited (1), confirmed on appeal by the Judicial Committee in *Juggi Lal Kamalapat v. Swadeshi Mills Company, Ltd.* (2).

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It is clear, therefore, that the complainant in this case cannot rely merely on the fact of registration of the declaration of ownership in support of his claim. It appears, however, to have been assumed here by the parties as also by the Courts that the fact of such registration would be sufficient to establish the complainant's exclusive title to the trade-mark in respect of which such "registration" took place. The only point which the petitioner himself raised was that the complainant had no such exclusive right to the use of the name "Ashwini Kumar", seeing that this name had not been similarly "registered". On the assumption which was involved in this plea, the learned Sessions Judge had of course not much difficulty in disposing of it by simply pointing out that the name was a part of the design and as such was equally entitled to protection.

I do not think that the question which arose for determination in the case was at all approached from the correct point of view. What the Court had to determine was whether the trade-mark claimed by the complainant was a distinctive mark, and for that purpose it had to take into consideration the extent to which its user had rendered the mark in fact distinctive of the goods in question. The evidence which the complainant actually gave was more that purchasers bought the umbrella according to the name than that it was bought according to the mark. He himself deposed that he had "registered" the mark, that is, had registered a declaration of ownership in respect of it, and that

(1) (1926) I. L. R. 49 All. 92.

(2) (1928) I. L. R. 51 All. 182;
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his umbrella with this trade-mark was known in the market as "Ashwini *Chhattâ*", and his witnesses said that they merely asked for "Ashwini *Chhattâ*" and were supplied with umbrellas of the complainant's manufacture. Only one witness, P. W. 3, said:—

"I saw the name Ashwini printed on the umbrella. So I thought that it was a genuine Ashwini *Chhattâ* and purchased it. I have used Ashwini *Chhattâ* before."

P. W. 5 merely said that he remembered that the name of Ashwini and a swan were printed on a genuine Ashwini *Chhattâ*, but did not remember what else was printed on it. Some dealers were also examined on behalf of the complainant. One of these, P. W. 7, said:—

By Ashwini *Chhattâ* people mean the umbrella with Ashwini brand manufactured by Ashwini Kumar De of Barhabâzâr, Mymensingh. I do not know of any other brand of Ashwini *Chhattâ* in the market. People desirous of purchasing Ashwini brand umbrella want us to give them Ashwini *Chhattâ*. They do not give us any other detail of the brand.

The next witness, P.W. 8, spoke to the same effect. P. Ws. 9, 10 and 11 merely stated that purchasers demanding Ashwini *Chhattâ* were given by them umbrellas of the complainant's manufacture.

All this evidence may be good evidence of a trade-mark in the name "Ashwini *Chhattâ*", but not in the design, exhibit 1, which is the subject matter of the charge in this case. Except the complainant himself, none of his witnesses refer even to exhibit 1 in terms. P. W. 5 merely stating that he remembers that the name Ashwini and a swan are printed on a genuine Ashwini *Chhattâ*. In cross-examination the case was definitely put to the complainant that there were several brands of umbrellas in the market with the figure 84 and a swan in different postures. This he could not deny. This is what he said:—

Shown an umbrella with the trade-mark—84—Sree Ashwini Kumar Ghatak—a swan holding an open umbrella between its bills, the witness says:—"I have not seen an umbrella with similar brand in the market before this day".

Again :—

Exhibit 1(c) is an umbrella manufactured by Butto Kristo Paul and Sons. I have also seen umbrellas manufactured by Ashutosh Paul. Its trade-mark also consists of the figure 84 and a swan holding an umbrella between its bills.

Again :—

The trade-mark of Nagendra Nath Ghatak consists of his name and a swan holding an open umbrella between its bills.

The evidence clearly shows that the figure 84 and a swan are features which cannot be claimed as peculiar or special to any one brand of umbrella in the umbrella trade. It is difficult to see, therefore, how the complainant can claim exclusive title to exhibit 1 as a distinctive trade-mark. The foundation of his case failing, the further question as to whether the mark which the accused is alleged to be using is a colourable imitation of that of the complainant does not arise.

I need only add that I intimated to the parties that in view of the meagreness of the evidence on the record on what appeared to be the crux of the case I was willing to order a re-trial, but Mr. Basu on behalf of the complainant was not prepared to avail himself of this opportunity. On the materials on the record, therefore, I have no other alternative but to make the Rule absolute, and set aside the conviction and sentence passed on the petitioner. The fine, if paid, will be refunded.

Rule absolute.

A. C. R. C.

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