

The Indian Law Reports.

Calcutta Series.

CRIMINAL REVISION.

Before Henderson and Khundkar JJ.

SRI NARAYAN

v.

MAHAMMAD ABU SALEH.*

Trade Mark—*Elements necessary to constitute a trade mark—Defence witnesses called by one accused, if can be relied upon to convict a co-accused—Indian Penal Code (Act XLV of 1860), s. 486.*

For the purpose of s. 486 of the Indian Penal Code, it is not necessary that the mark in question should be the exclusive property of any body. The only consideration which is of importance is whether the mark has come to be so identified with the merchandise of the person using the mark as to be regarded as a distinctive make to denote that particular merchandise.

In order to prove that a trade-mark is an imitation of another, it is not necessary that there should be a resemblance in every case. It is sufficient if resemblances are of such a nature as to be calculated to mislead an unwary purchaser. The question is really one of fact.

Emperor v. Tapidas Durlabhdas (1) and Hecla Foundry Company v. Walker, Hunter & Co. (2) referred to.

Per HENDERSON J. If the prosecution desired to use the evidence given by the principal accused to convict the abettor, they should have tried the latter separately and called the defence witnesses for the former as the prosecution witnesses against the latter so that he might have been able to cross-examine them.

CRIMINAL REVISION.

The material facts of the cases and arguments in the Rules appear sufficiently from the judgments.

Noad, Hira Lal Ganguly and Sudhir Chandra Chowdhury for the petitioners.

Narendra Kumar Basu, Probodh Chandra Chatterjee and Bireswar Chatterjee for the opposite party.

*Criminal Revision, Nos. 4 and 5 of 1940, against the order of S. Wajid Ali, Third Presidency Magistrate of Calcutta, dated Dec. 22, 1939.

(1) (1907) 9 Bom. L. R. 732.

(2) (1889) 14 A. C. 550.

1940

Criminal Revision Case No. 4 of 1940.

Sri Narayan
v.
Mahammad Abu
Saleh.

KHUNDKAR J. This is a Rule calling upon the Chief Presidency Magistrate of Calcutta and the complainant opposite party to show cause why the convictions and sentences passed on the petitioners should not be set aside.

The petitioners have been convicted of an offence under s. 486 of the Indian Penal Code. The case for the prosecution was that they were selling in the market packets of *birhis* to which were attached two labels which are counterfeits of labels employed as a distinctive mark of *birhis* of which the complainant was the manufacturer.

In support of the Rule, it has been argued by Mr. Carden Noad, firstly, that the labels which are associated with the goods of the complainant are not trade-marks. Now, the definition of a trade-mark as contained in s. 478 of the Indian Penal Code is in the following terms :—

A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade-mark.

Upon the evidence in the case and the learned Magistrate's findings, the complainant has been using his labels from the year 1933 and these labels have come to be associated in the market with his goods. The labels of the complainant are, therefore, undoubtedly a trade-mark.

This brings us to the second argument advanced by Mr. Carden Noad. His contention is that the complainant had no exclusive right to the labels which he claims as his. It seems to us that this contention is based upon a misconception. For the purposes of s. 486, it is not necessary that the mark in question should be the exclusive property of any body. Whatever may be the law with regard to such matters as copyright or patents, there can be no question that the only consideration which is of importance with

reference to the provisions of s. 486 is, whether the mark in question has come to be so identified with the merchandise of the person using the mark as to be regarded in the market as a distinctive mark to denote that particular merchandise. The Magistrate has so found and his finding is amply supported by the evidence.

1940
 Sri Narayan
 v.
 Mahammad Abu
 Saleh.
 Khundkar J.

In the third place, it has been contended that, in any event, the labels, which were attached to the *birhis* which the accused were selling, were not counterfeits of the complainant's labels. Counterfeiting has been defined in s. 28 of the Indian Penal Code in the following way:—

A person is said to "counterfeit" who causes one thing to resemble another thing, intending by means of that resemblance to practise deception, or knowing it to be likely that deception will thereby be practised.

Explanation 1. It is not essential to counterfeiting that the imitation should be exact.

Explanation 2. When a person causes one thing to resemble another thing, and the resemblance is such that a person might be deceived thereby, it shall be presumed, until the contrary is proved, that the person so causing the one thing to resemble the other thing intended, by means of that resemblance, to practise deception, or knew it to be likely that deception would thereby be practised.

The complainant's labels and those which the petitioners are convicted of having used are before us. They each consist of two slips of coloured paper bearing certain figures and words which are partly in the vernacular and partly in English. Looking at these labels side by side, we find the resemblance between them to be remarkable to a degree. The get-up and general appearance of the labels of the accused are so similar to those of the complainant that it is only by a close scrutiny that the differences, such as they are, can be detected. We have no doubt in our minds that the class of persons to whom *birhis* are sold would easily be deceived by the appearance of accused's labels into supposing that the goods that they were purchasing were those of the complainant. The question is really a question of fact and it is

1940

Sri Narayan
v.
Mahammad Abu
Salih.
Khundkar J.

concluded by the Magistrate's findings. It is not necessary in the present case to lay down any proposition of law regarding the extent of similarity to establish that one article is the counterfeit of another, but if authority were needed upon such a question I would refer to the case of *Emperor v. Tapidas Durlabhdas* (1). In that case it was clearly laid down that, in order to prove that a trademark is an imitation of the other, it is not necessary that there should be a resemblance in every case. It is sufficient if the resemblances are of such a nature as to be calculated to mislead an unwary purchaser. Again in the words of Lord Herschell in the case of *Hecla Foundry Company v. Walker, Hunter & Co.* (2)—

It seems to me, therefore, that the eye must be the judge in such a case as this, and that the question must be determined by placing the designs side by side, and asking whether they are the same, or whether the one is an obvious imitation of the other.

Finally, Mr. Carden Noad has referred to the fact that labels similar in size, shape and colour are commonly used in the market in connection with the sale of packets of *birhis*. This contention, in our judgment, has no bearing whatever upon the question which we have to decide in this case. It may or may not be that the use by dealers of labels of the kind to which Mr. Carden Noad has made reference would amount to an offence. But the mere fact that labels more or less similar to that of the complainant are used by others for the purpose of marking packets of *birhis* which are not the manufacture of the complainant is no answer to the charge made against the petitioners in the present case.

Upon the evidence and the findings of the learned Magistrate, no less than upon a comparison of the complainant's labels with those of the accused, we are satisfied that the conviction of the petitioners must be upheld.

(1) (1907) 9 Bom. L.R. 732.

(2) (1889) 14 A. C. 550, 555.

Upon the question of sentence, however, we think that the ends of justice will be satisfied if we reduce the sentence of imprisonment passed upon petitioner No. 1 to the period already undergone. The sentences of fine in the case of both the petitioners as also the order of compensation will, however, stand. Petitioner No. 1 must surrender to his bail to pay the fine.

1940
 Sri Narayan
 v.
 Mahammad Abu
 Saleh.
 Khundkar J.

Criminal Revision Case No. 5 of 1940.

The two petitioners have been convicted under s. 485 read with s. 109 of the Indian Penal Code upon the allegation that they abetted two other persons—Phanindra Mohan Banerji and Tarak Das Ray who were charged with being in possession of instruments for the purpose of counterfeiting the complainant's trade-mark.

Those two persons were put upon their trial for an offence under s. 485 of the Indian Penal Code along with the petitioners but they were acquitted, and this Rule calls upon the learned Chief Presidency Magistrate, Calcutta, and the opposite party to show cause why the conviction of the petitioners and the sentences passed upon them for the offence of abetment should not be set aside.

Upon reading the learned Magistrate's judgment in this case we found it difficult to discover what the case for the prosecution was. We have been informed by Mr. N. K. Basu, who appears on behalf of the complainant opposite party to oppose this Rule, that the prosecution made the following allegations. The two petitioners placed with the two accused, who have been acquitted, an article described as a Litho Stone from which certain labels which were trade-marks of the complainant's goods were to be counterfeited. They instructed those two persons who are printers to make certain alterations in that instrument and to print certain labels from the die as altered. The alteration was such as to make the labels finally

1940
Sri Narayan
 v.
Mahammad Abu
Salih.
Khundkar J.

printed a clear counterfeit of the labels of the complainant. We have not found it possible to gather such a case from the somewhat sketchy judgment of the learned Magistrate. The charge against the accused persons embraced, for some reason best known to the prosecution, two counts. The first related to the printing of the complainant's labels and the second to the counterfeit labels. The material finding of the Magistrate is contained in one short sentence which is as follows:—

Accused 3 and 4 at whose instance the articles were prepared are found guilty under s. 485 read with s. 109 of the Indian Penal Code.

We do not know to which count of the charge this finding relates. It is impossible to discover from the Magistrate's judgment whether he was convicting the petitioners in respect of certain labels printed by the other accused which were admittedly the trademark of the complainant, or whether he was convicting them with reference to the counterfeit labels, large numbers of which also were proved to have been printed.

The two petitioners are the persons who were convicted of an offence under s. 486 of the Indian Penal Code and with which conviction we have dealt in Criminal Revision Case No. 4 of 1940. In all the circumstances of the case, we are inclined to think that the further prosecution of these petitioners for an offence under s. 485 read with s. 109 was, to say the least, uncalled for.

The convictions and sentences passed upon the petitioners in this case are set aside and it is directed that they be acquitted. Petitioner No. 1 will be discharged from his bail.

HENDERSON J. I agree that the Rules must be made absolute to this extent and have little to add.

The question whether the complainant's label is a mark used for denoting the goods of the manufacture of his firm or whether it is the sort of thing which is

used by everybody dealing with *birhis* in the market is a matter of evidence and a question which the Magistrate had to decide. There was evidence in support of his conclusion and it is impossible for us to interfere in revision.

1940
 Sri Narayan
 v.
 Mahammad Abu
 Saleh.
 Henderson J.

In the second case in which the petitioners were convicted of abetment there has been so much confusion that it would be quite impossible to uphold the conviction. The prosecution was in connection with two dies which were found in the printing press belonging to the principal accused. One die was of the complainant's label and the other of the petitioners' label. It appears that the prosecution theory is that the former was made for the purpose of enabling the other die to be made. The other die, of course, was used for printing the petitioners' labels.

I am bound to say that I cannot understand what useful purpose the prosecution thought was being served by having two charges. The charge in relation to the petitioners' die was obviously quite enough.

There is really no evidence which would support the prosecution case with regard to the complainant's die. I myself do not quite see how the printing of the petitioners' labels will in any way be assisted by the fact that the complainant's die was given to the press. Whether it was there for the purpose suggested by the prosecution or whether other unknown persons were using it for printing copies of the complainant's label cannot be anything more than a matter of speculation.

It is, of course, quite easy to say that somebody in connection with the petitioners' firm must have been responsible for ordering the printing of their label. On the prosecution evidence, it is impossible to say which of the two petitioners, if either, was guilty. The learned Magistrate has convicted them upon the defence evidence given by the principal accused. This, of course, was entirely without justification. If the prosecution wished to use this

1940

Sri Narayan
 v.
Mahammad Abu
Saleh.
Henderson J.

evidence, they should have tried the abettors separately and then used the defence witnesses as prosecution witnesses against the abettors so that the petitioners might have been able to cross-examine them.

There is a further confusion in the actual order recorded. We do not know whether the petitioners have been convicted of both the charges or one only and on what charge this sentence has been imposed. It might, of course, be possible for the petitioners to be legally convicted on a re-trial. I should certainly not agree to any such course. Once they have been convicted on the main charge under s. 486, there was absolutely no point in prosecuting them again on this alleged abetment. I further desire to say that, in my opinion, they ought not to have been imprisoned when it has not been shown that they have already been punished for this offence.

Rule in Revision No. 4 discharged.

Rule in Revision No. 5 made absolute.

A. C. R. C.