

APPELLATE CRIMINAL.

Before Mr. Justice Mosely.

T.M. MOHAMED CASSIM

v.

G.S.T. SHAIK THUMBY SAHIB.*

1939
Oct. 11.

Trade mark—Prosecution for use of false trade mark—Limitation—Burma Merchandise Marks Act, s. 15—"Offence," meaning of—Commencement of limitation—Series of infringements—Date of specific offence charged.

The period of limitation prescribed by s. 15 of the Burma Merchandise Marks Act for prosecuting an offender under the Penal Code for the use of a false trade mark is three years from the date of the commission of the offence charged or one year from the date of discovery by the prosecutor of the offence charged, whichever is less.

The word "offence" occurring in s. 15 literally means the offence in respect of which the prosecution is launched, and time begins to run from the date of the specific offence charged or from the prosecutor's first discovery of the specific instance of infringement which is the subject of the charge.

The section does not say that time runs from the first instance of infringement, where there has been a series of infringements, nor does it mean that where the infringement has been to the knowledge of the complainant, the prosecution must be initiated within one year of his first discovery of one of this series of similar offences.

Abhay Kumar Dey v. Emperor, 32 C.W.N. 699; *Aswini Kumar v. King-Emperor*, 34 C.W.N. 524; *Emperor v. Chhotatal*, I.L.R. [1937] Bom. 183 F.B.; *Muhammad Ahmad v. Bezvada Venkanna*, 32 Cr.L.J. 809; *Nagendranath v. Emperor*, I.L.R. 52 Cal. 1153; *Sirumal v. Emperor*, A.I.R. (1932) Sind. 94, referred to.

Abdul Majid v. Emperor, 17 Cr.L.J. 488; *Mohamed Jeeva v. Wilson*. 4 B.L.T. 83; *Ruppell v. Ponnusami Tevan*, I.L.R. 22 Mad. 488, dissented from,

J. K. Munshi for the appellant.

Ba Han for the respondent.

MOSELY, J.—The appellant T.M. Mohamed Cassim was found guilty of offences lying under sections 482 and 486 of the Penal Code, committed on the 26th June 1938, and was sentenced to pay fines of Rs. 150

* Criminal Appeal No. 643 of 1939 from the order of the 2nd Additional Magistrate of Rangoon in Criminal Trial No. 215 of 1939.

on both charges and also to pay Rs. 37-8 costs. It was ordered that Rs. 150 out of the fines realized be paid to the complainant as compensation.

The charges against him were that he used a false trade mark, namely, " Sun Brand Patiram-101 " on tins containing a mixture of grease and oil to indicate that they were the manufacture of the complainant firm G.S.T. Shaikh Mohideen Sahib & Brother, and that he sold or had in his possession for sale the same goods.

It is in evidence for the prosecution that the complainant had been using this mark since 1928, and made a declaration to that effect in the office of the Sub-Registrar, Rangoon, in September 1930.

The first point taken in this appeal is that the prosecution was time-barred by section 15 of the Burma Merchandise Marks Act (Indian Act IV of 1889). The present prosecution was instituted on July 2nd, 1938. On the 3rd October 1934 the complainant's agent sent a notice (*vide* copy Ex. C2) through his advocate Mr. Menon (p.w. 7) to the accused warning him under threat of prosecution to discontinue the use of this mark. The complainant G.S.T. Shaikh Thumbi Sahib was then in India. A reply (Exhibit D) was received by Mr. Menon from the accused's advocate on October 8th, 1934, denying that the accused had used the trade mark in question. The complainant was not asked whether he took any further action when this reply was brought to his notice, or whether he was satisfied with this disclaimer of the accused. It would appear that the previous action of the complainant was brought out by the prosecution in order to show the guilty knowledge of the accused, and that the point of limitation was not taken by the defence at the trial. It was not considered in the judgment of the magistrate.

Section 15 of the Merchandise Marks Act deals not only with prosecutions brought under the Penal Code

1939
 MOHAMED
 CASSIM
 v.
 SHAIK
 THUMBY.
 MOSELY, J.

1939
 MOHAMED
 CASSIM
 v.
 SHAIK
 THUMBY.
 MOSELY, J.

but with prosecutions under the Act itself or under the Sea Customs Act 1878, (sections 13 and 14 of the Act).

Section 15 reads as follows :

"No such prosecution as is mentioned in the last foregoing section", (*i.e.* brought under the three above-mentioned Acts) "shall be commenced after the expiration of three years next after the commission of the offence, or one year after the first discovery thereof by the prosecutor, whichever expiration first happens."

Two interpretations of the word "offence" have been followed, one that it refers to offences which may be continuous ones, and that where there has been a series of infringements by the accused, time runs for three years from the first instance of infringement. Where the infringement has been to the knowledge of the complainant the prosecution must be initiated within one year of the first discovery of it by the prosecutor, that is to say within one year of his first discovery of one of this series of similar offences, and not within one year of his discovery of the specific offence complained of and charged.

This view is the one that has been taken by the former Chief Court of Burma, *vide* *Mohamed Jeeva v. Wilson* (1), and again by the same Judge, Twomey J., in *Abdul Majid v. Emperor* (2). *Mohamed Jeeva's* case (1) followed *Ruppell v. Ponnusami Tevan and another* (3). The same view was taken in *Jagan Nath v. Emperor* (4), and in *Re Abdul Satar Khan Kamruddin Khan* (5).

The second view is that section 15 is to be taken literally as it stands, and that time begins to run from the date of the specific offence charged and from the prosecutor's first discovery of the specific instance of infringement which is the subject of the charge.

(1) 4 B.L.T. 83; S.C. 12 Cr.L.J. 246. (3) (1899) I.L.R. 22 Mad. 488.

(2) 17 Cr.L.J. 488. (4) 10 Sind. L.R. 45.

(5) (1935) I.L.R. 59 Bom. 551.

This view has been consistently held by the Calcutta High Court, *vide* *Abhay Kumar Dey v. Emperor* (1), *Aswini Kumar Pal v. The King-Emperor* (2) and *Nagendranath Shaha v. Emperor* (3). In later decisions of the High Courts of Madras and Bombay and of the Court of the Judicial Commissioner of Sind this second view has been adopted : *Muhammad Ahmad v. Bezvada Venkanna* (4), *Emperor v. Chhotalal Amarchand* (5),—where the question was exhaustively discussed by the referring Judge and by a Full Bench of that Court,—and *Sirumal v. Emperor* (6).

It would seem then that the only ruling in which the former view has been taken which has not been reversed on reconsideration is *Mohamed Jeeva v. Wilson* (7),—a decision of the former Chief Court of Burma, and that is a judgment published in an unauthorized Report.

Ruppell v. Ponnusami Tevan (8) was a prosecution under sections 482, 486 of the Indian Penal Code. It was held shortly that the complainants were aware of the alleged infringement five years before the prosecution was initiated, and that there was no reason to believe that the manufacture was discontinued, and had been lately revived. It was held that section 15 of the Act required that the prosecution in such a case be commenced within one year after the first discovery of the offence by the prosecutor, and it was implied that that meant the discovery of the first instance of commission of the offence, the object of the Act being to provide a speedy remedy for traders in the criminal Courts only where the aggrieved party was diligent and showed by his conduct that the case was one of urgency.

1939

MOHAMED
CASSIMv.
SHAIK
THUMBY.

MOSELY, J.

(1) 32 C.W.N. 699.

(2) 34 C.W.N. 524.

(3) (1929) I.L.R. 57 Cal. 1153.

(4) 32 Cr.L.J. 809.

(5) I.L.R. [1937] Bom. 183, F.B.

(6) A.I.R. (1932) Sind. 94, 99, 100.

(7) 4 B.L.T. 83 ; s.c. 12 Cr.L.J. 246.

(8) (1899) I.L.R. 22 Mad. 488.

1939
 MOHAMED
 CASSIM
 v.
 SHAIK
 THUMBY.
 MOSELY, J.

In *Mohamed Jeeva's* case (1) the accused had been acquitted in 1908 and 1910 on similar complaints made by the same complainant. A third prosecution started in 1910 was held to be barred by section 15 of the Act. Twomey J. there laid stress on the words "first discovery" in the section. He said that these words could not reasonably be applied to the last of a long series of similar offences extending without interruption throughout several years to the knowledge of the prosecutor. In the learned Judge's opinion they could only refer to the first instance of the offence which came to his knowledge. It was also remarked that the intention of the Legislature would be frustrated if it was held that the owner of a trade mark could stand by for several years while his trade mark was being infringed continuously, and then bring a criminal complaint in respect of some recent instance in which there had been an infringement. To interpret the section in that way, it was said, would reduce its provisions to a nullity, for it would entirely remove the bar of limitation except in cases where the series of infringements had actually ceased.

No doubt it would be uncommon to find prosecutions instituted nearly three years after the commission of the specific offence charged. No doubt too the words "first discovery" do suggest the discovery of the first of a series of similar offences: otherwise the word "first" is otiose. But the section itself contains no mention of a series of offences or of a continuing offence. Nor is the Penal Code concerned with these. It deals with a series of acts which constitute one offence (sections 33 and 37, P.C.), and in one instance only punishes the continuance of an offence, (of nuisance after warning by a Public Servant, section 291 P.C.)

(1) 4 B.L.T. 83; s.c. 12 Cr.L.J. 246.

Otherwise the Penal Code is silent concerning continuing offences. Section 486 of the Code specifically confines the offence to selling "goods or thing."

Nor is there any provision for charges relating to continuing offences in the Criminal Procedure Code.

If the word "offence" had meant only the infringement of the trade mark the section would have said so. As was said by Beaumont C.J. in *Emperor v. Chhotalal Amarchand* (1) in order to extract the meaning adopted in *Mohamed Jeeva's* case (2) in addition to the word "offence" there would have to be some such words in the section as "or an offence similar to the offence charged which has continued uninterruptedly down to the date of the prosecution."

In that case a simpler emendation perhaps would have been to have the word "offence" qualified by the word "first" as in the case of the discovery of it by the prosecutor.

"If the interpretation of the word 'offence' as meaning the very first of the series of offences was good law a person infringing another's trade mark may merely do so once clandestinely, sit quiet for three years, and then make a public use of it without any fear of a criminal prosecution"

[Mehta Additional Judicial Commissioner in *Sirumal v. Emperor* (3)].

Broomhill J., who followed *Mohamed Jeeva* (2) in *Abdul Satar Khan v. Ratanlal* (4) was evidently in some doubt of the correctness of that decision in his copious and able referring judgment in *Emperor v. Chhotalal Amarchand's* case (1). He pointed out

1939
 MOHAMED
 CASSIM
 v.
 SHAIK
 THUMBY.
 MOSELY, J.

(1) I.L.R. [1937] Bom. 183, F.B. (3) A.I.R. (1932) Sind 94, 99, 100.

(2) 4 B.L.T. 83; s.c. 12 Cr. L.J. 246. (4) (1935) I.L.R. 59 Bom. 551.

1939
 MOHAMED
 CASSIM
 v.
 SHAIK
 THUMBY.
 MOSELY, J.

(page 193 do.) that in the majority of cases which come before the Courts the offence is continuing, while it is rare that criminal proceedings are taken in respect of an infringement which has been discontinued. There is difficulty in supposing therefore that the Legislature would have thought it necessary to enact this limitation clause, if the only practical effect of it would be to stop prosecutions for stale offences in the rare cases where the infringement had been discontinued before the prosecution.

But it is only just and right, I consider, that limitation should operate where the offence has been discontinued, and should not be directed to the protection of a person who persists and continues in offending, often, it may be in a place far removed from the complainant's place of business, and without his knowledge. It could hardly have been the intention of the Legislature that a man who had done that could come and set up his business next door to the complainant with complete immunity as far as any action under the criminal law is concerned.

The question was discussed very fully in the ruling of the Full Bench in that case, and I must concur with respect in the decision arrived at, which was that section 15 must be taken in its literal meaning, and that the word "offence" means the offence in respect of which the prosecution is launched.

One argument against the interpretation adopted in *Mohamed Jeeva's* case (1) is that the section applies to offences against section 18 of the Sea Customs Act which involves the importation of goods bearing a counterfeit trade-mark, counterfeit coin, obscene books etc., and the section cannot have been intended to bar prosecutions for such offences merely because they had

gone unprosecuted, because undetected, for over three years.

Another argument is the practical difficulty in determining whether there had been a prior infringement, for dishonest traders very often proceed to their object by progressive stages, gradually approaching nearer to the make-up of their rival. Difficulties will arise and hard cases may occur in practice on either construction of section 15, but the objections to the interpretation given of it in *Mohamed Jeeva's* case (1) appear to me to be insuperable.

I agree that the considerations advanced in *Ruppell's* case (2) and in *Mohamed Jeeva's* case (1) derive most of their force from the facts of those particular cases, where there had been continuous infringement to the knowledge of the complainant.

In my opinion the limitation prescribed by section 15 of the Act is three years from the date of the commission of the offence charged and one year from the date of discovery by the prosecutor of the offence charged, whichever is less.

The solution by way of compromise offered by the learned author Mr. Venkateswaran in his Commentary on the Law of Trade and Merchandise Marks in India (page 537 *ibid*) cannot be accepted. He suggests that while "offence" in the first limiting clause means the specific offence charged, yet the words "first discovery thereof" in the second limiting clause signify the first instance of infringement where the complainant had had knowledge of that. The reason why this cannot be so is that the words "commission" and "discovery" must refer to the same offence, as is admitted there (page 537 *ante*).

1939

MOHAMED

CASSIM

v.

SHAIK
THUMBY.

MOSELY, J.

1939

MOHAMED

CASSIM

v.

SHAIK

THUMBY.

MOSELY, J.

In the present case therefore I would hold that the offence charged was not barred by limitation by virtue of section 15 of the Merchandise Marks Act.

[On the merits his Lordship held that the conviction was right and dismissed the appeal.]