

1871
 A. B. MILLER
 v.
 THE
 GOURIFORE
 COMPANY
 LIMITED.

3,00,000 bags, each bag being a specific item to be made complete in itself, and it was the business of the plaintiffs to tender bags according to the contract, that is to say bags which were each of them substantially 40 by 28.

Appeal allowed.

Attorneys for the appellants: Messrs. *Gray and Sen.*

Attorneys for the respondents: Messrs. *Collis and Co.*

[APPELLATE CIVIL.]

1871
 June 22.

Before Mr. Justice Norman (Offg. Chief Justice), and Mr. Justice Ainslie.

BAKER AND OTHERS (PLAINTIFFS) v. SUTHERLAND AND OTHERS
 (DEFENDANTS).*

*Copyright of Ornamental Design—5 & 6 Vict., c. 100—24 & 25
 Vict., c. 73.*

A registered proprietor of the copyright of an ornamental design within the United Kingdom, under 5 & 6 Vict., c. 100 (amended by 6 & 7 Vict., c. 65 13 & 14 Vict., c. 104, and 21 & 22 Vict., c. 70), cannot sustain an action against any person who applies such design to articles, or who sells any articles to which such design has been applied, in British Burmah.

THIS suit was brought, in the Court of the Recorder of Rangoon, and for an injunction to restrain the defendants from manufacturing, purchasing, importing, or selling in the market of Rangoon, handkerchiefs woven of silk or cotton and bearing an ornamental design invented by the plaintiffs, and registered by them in England, according to the law of the United Kingdom, and for an account, and for R. 5,000 damages for the injury done to the plaintiffs by the defendants' unlawful acts.

The plaintiffs claimed to be the owners of the copyright of the said ornamental design, which was duly registered for the years 1870, 1871, and 1872, under 5 & 6 Vict., c. 100, amended by 6 & 7 Vict., c. 65; 13 & 14 Vict., c. 104; 21 & 22 Vict.,

* No. 1426 of 1871, by the Recorder of Rangoon, under section 22 of the Recorders Act (XXI of 1863).

c. 70 ; and 24 & 25 Vict., c. 73 ; the certificate of registration was filed with the record.

1871

BAKER.

v.

SUTHERLAND

The plaintiffs alleged in the plaint that, since the registration of the ornamental design, the defendants had wrongfully and injuriously imitated the said design, and applied the imitation thereof to fabrics of inferior description to those sold by the plaintiffs, bearing the said design, and had sold such inferior goods at a lower price than the goods of the plaintiffs could be profitably sold for ; that the defendants had knowledge, or must have known, that the said design was the property of the plaintiffs, and was registered by the plaintiffs,' attorney, Mr. J. Block, of the firm of Gladstone, Wyllie and Co., and were requested to abstain from infringing the plaintiff's right, and that they had refused to abstain from the infringement thereof.

The defendants denied that they had infringed any right of the plaintiffs, and raised the defence that the Acts of Parliament abovementioned have reference only to the United Kingdom, and do not extend to the British Territories in India.

The Recorder of Rangoon referred the question to the High Court. He said, in his referring order, that it was urged by the Counsel for the plaintiffs that the case of *Sarazin v. Hamel* (1), though not precisely in point, shows that the Acts of Parliament have operation beyond the limits of Great Britain and Ireland ; that 5 & 6 Vict., c. 100, s. 5, makes the registered owner proprietor of the copyright ; and if he be in fact the proprietor of a right, then wherever there are British Courts of Justice those rights will be maintained ; that though forms of procedure in England, Scotland, and Ireland are given by one of the Acts, it does not necessarily follow therefrom that rights under the Acts will not be recognized elsewhere than in England, Scotland or Ireland ; that the summary remedies prescribed by the Acts do not interfere with the jurisdiction of the Supreme Courts of Law and Equity (*Sheriff v. Coates* (2)) ; that s. 14 of Act, 5 & 6 Vict., c. 100, and s. 87 of 6 & 7 Vict., c. 65, show an intention to protect properties in designs out of England ; that Courts of Equity

(1) 32 L. J., Ch., 380.

(2) 1 Russ. & M., 159.

1871

BAKER

v.

SUTHERLAND

act *in personam*, and that the Recorder's Court is a Court capable of enforcing equitable rights.

In support of the plea, the Recorder observed that it was urged by Mr. de Wet, the Counsel for the defendants, that no Acts passed in England since the year 1726 apply to India unless the British Territories in India are especially mentioned in them; that the Indian Government found it necessary to pass an Act to protect copyright in books in India (Act XX of 1847) at a time when an Act of the United Kingdom was in full force as to books; that the preamble to Act XX of 1847 shows that the rights under the English Act as to books were of doubtful force in India. So also as to Patents. It was equally so with regard to copyright of designs.

The Recorder was of opinion that the plaintiffs could not, in any Court in British India, have the relief prayed for in the plaint, but, at the request of both parties, the question, "whether the copyright in designs, being a right created by the Statute Law of the United Kingdom, and not thereby expressly extended to India, is a right that can be recognized and enforced by the Courts of Law in British India," was in pursuance of section 22 of Act XXI of 1863, submitted for the decision of the High Court of Calcutta.

The *Advocate-General* for the plaintiffs contended that this was a suit to restrain the piracy of a registered design, analogous to one to restrain the piracy of trade mark. The plaintiffs sue to establish their exclusive right to user of the design of which they are the sole and exclusive owners.

They complain that their design has been applied by the defendants to articles of inferior quality, and that they have thereby spoiled the market for the goods which the plaintiffs were in the habit of selling. The plaintiffs need not have sued as the registered proprietors of the design. [NORMAN, J.—Do you give up the point that they are protected by the statute?] I say the plaintiffs are entitled to the exclusive use of the design, and the Court ought to protect the right. 24 & 25 Vict., c. 73, recites 5 & 6 Vict., c. 100, and the first section says "that the said recited Act and all Acts extending or amending the same shall be construed as if the words "provided the same

be done within the United Kingdom of Great Britain and Ireland had not been contained in the said recited Act and the said recited Act and all Acts extending or amending the same shall apply to every such design as therein referred to, whether the application thereof be done within the United Kingdom or elsewhere, and whether the inventor or proprietor of such design be or be not a subject of Her Majesty.”

[NORMAN, J.—That was simply to enable foreigners, such as Frenchmen or Germans who might have invented designs to send their articles to the Exhibition of 1862, and to acquire a property in such designs which they could enforce in England.]

1872
 BAKER
 v.
 SUTHERLAND.

Mr. Montriou, for the defendants, was not called upon.

NORMAN, J. (after stating the facts.)—The question turns upon the construction of the two Statutes 5 & 6 Vict. c. 100 and 24 & 25 Vict., c. 73.

By 5 & 6 Vict., c. 100.—An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture, it is enacted (by section 3) that “With regard to
 “ any new and original design, whether such design be applicable to the ornamenting of any article of manufacture, or of
 “ any substance, artificial or natural, or partly artificial and partly natural, and that whether such design be so applicable for the pattern, or for the shape and configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means such design may be so applicable: whether by printing, or by painting, or by embroidery, or by weaving, or by sewing, or by modelling, or by casting, or by embossing, or by engraving, or by staining, or by any other means whatsoever, manual, mechanical, or chemical, separate or combined. the proprietor of every such design, not previously published either within the United Kingdom of Great Britain and Ireland, or elsewhere, shall have the sole right to apply the same to any articles of manufacture, or to any such substances as aforesaid, provided the same be done within the United Kingdom of Great Britain and Ireland.”

1871

BAKER
v.
SUTHERLAND.

And by section 4 it is provided that "No person shall be entitled to the benefit of this Act, with regard to any design in respect of the application thereof to ornamenting any article of manufacture, or any such substance, unless such design have, before publication thereof, been registered according to this Act."

The 24 & 25 Vict., c. 73, after reciting the 5 & 6 Vict., c. 100, and that it is expedient that the provisions of the recited Act should apply to designs, and to the application of such designs, within the meaning of the said Act, whether such application be effected within the United Kingdom, or elsewhere," enacts (by section 1):—"That the said recited Act, and all Acts extending or amending the same, shall be construed as if the words 'provided the same be done within the United Kingdom of Great Britain and Ireland' had not been contained in the said recited Act; and the said recited Act, and all Act. extending or amending the same, shall apply to every such design as therein referred to whether the application thereof be done within the United Kingdom or elsewhere, and whether the inventor or proprietor of such design be or be not a subject of Her Majesty."

The 7th section of 5 & 6 Vict., c. 100. for preventing the piracy of registered designs, enacts, that "during the existence of any such right to the entire or partial use of any such design, no person shall either do, or cause to be done, any of the following acts with regard to any articles of manufacture, or substances, in respect of which the copyright of such design shall be in force, without the license or consent in writing of the registered proprietor thereof (that is to say),

"No person shall apply any such design, or any fraudulent imitation thereof for the purpose of sale, to the ornamenting of any article of manufacture, or any substance, artificial or natural, or partly artificial and partly natural."

"No person shall publish, sell or expose for sale any article of manufacture, or any substance, to which such design, or any fraudulent imitation thereof, shall have been so applied, after having received, either verbally, or in writing, or otherwise, from any source other than the proprietor of such design

“knowledge that his consent has not been given to such application, or after having been served with or had left at his premises a written notice signed by such proprietor or his agent to the same effect.”

1872

BAKER.
v.
SUTHERLAND

The 8th section provides for the recovery of penalties for piracy of the design, and the 19th section empowers “the proprietor in respect of whose right such penalty shall have been incurred (if he shall elect to do so) to bring such action as he may be entitled to for the recovery of any damages which he shall have sustained, either by the application of any such design or of a fraudulent imitation thereof, for the purpose of sale to any articles of manufacture.”

The effect of 5 & 6 Vict., c. 100, appears to me to have been this, that the owner or proprietor of any design registering the same under the Acts, if such design was applied to the ornamenting of any article of manufactory in England, acquired a right to prevent any person from applying the design, or any fraudulent imitation of it, to any article of manufacture, or from selling any article to which the design is applied. But the extent of such prohibition must have been, and was, measured by the extent to which the provisions of 5 & 6 Vict., c. 100, applied. Now 5 & 6 Vict., c. 100, did not extend to India, and therefore there is nothing in that Act which would have prevented any person from applying any registered design, or selling any article to which such design had been applied in India.

24 & 25 Vict., c. 73, was passed immediately prior to the Exhibition of 1862, and it extended the privileges conferred by 5 & 6 Vict., c. 100, to the case of designs registered in England, whether the application of such designs to articles of manufacture was effected within the United Kingdom or elsewhere. But there is nothing in 24 & 25 Vict., c. 73, which extended the prohibition of the application of such design, or the sale of articles to which such design had been applied, to India or the Colonies, or to any other place to which 24 & 25 Vict., c. 73, did not extend.

I am therefore of opinion that the decision of the Recorder is correct, and that a registered proprietor of a design within the United Kingdom could not sustain an action against a person

1871

BAKER.

v.

SUTHERLAND

who applied such design, or who sold any articles to which such design had been applied, in British Burmah.

The learned Advocate General has attempted to rest the case on another ground, namely, that the plaintiff had a right in this design analogous to the right which a merchant may have in his trade mark. I think that there is no foundation for such a contention. A design for ornamenting an article of manufacture is not an indication that such article is manufactured by a particular house, and there are no allegations in the plaint that the defendants used the design in question, the same being the property of the plaintiffs, for the purpose of fraudulently pretending, or causing it to be believed, that the articles so sold by the defendants were articles manufactured, selected, or printed by the plaintiffs. The two subjects, the property in a trade mark, and the property in a registered design, are two rights totally distinct in their nature. The right put forward in the present case is simply a right in a design for ornamenting an article of manufacture, and such right is not infringed by the sale in British India of articles to which the design has been applied.

We are of opinion, therefore, that the decision of the Recorder is correct, and that it must be affirmed.

The unsuccessful party, the plaintiffs, will pay the defendants costs of this reference.
