

## APPELLATE CRIMINAL.

*Before Mr. Justice Ghose and Mr. Justice Stephen.*

EMPEROR

v.

BAKAULLAH MALLIK.\*

1904

Jan. 19.

*Trade mark—Selling goods marked with a counterfeit trade mark—Ss. 492, 496 of the Indian Penal Code as amended by the Merchandise Marks Act (Act IV of 1889 as amended by Act IX of 1901) ss. 6 and 7—Applying a false trade description to goods.*

*Held*, a person may to some extent appropriate to his own use a name suggested by his trade, without infringing the law relating to trade marks or trade descriptions.

*Held* also, that the appellants, who sold fish-hooks in boxes similar to the respondents with a design of one fish with its head and tail turned up, cannot be held to have infringed the trade mark of the respondents, who also sold fish-hooks with the design of two fish crossed, with their heads and tails turned up.

*Held*, where the public has chosen a name for its own use such as “mash marka” (fish mark), that fact cannot be held to prevent other persons from applying a mark to fish-hooks, which may be generally known by the same term.

### CRIMINAL APPEAL.

Messrs. Ghosh, Sinha and Co., the prosecutors in the lower Court, had been importing from Europe since December 1900 fish-hooks in “packets” labelled with the design of two fish crossed with their heads and tails pointing upwards; the defendants themselves proprietors of a miscellaneous shop being among the purchasers. The prosecutors (Messrs. Ghosh, Sinha) at the hearing gave evidence to show that these goods had secured a large sale and reputation in the Calcutta market and were known as “mash marka.” In March 1902 they came to hear that the defendants were selling fish-hooks with a spurious mark as “mash marka,” the design being one fish with head and tail turned upward.

They charged that this mark was a counterfeit or a colourable imitation of their mark and likely to deceive purchasers into a

\* Criminal Appeal, No. 636 of 1903, against the order passed by Abdur Rahim, Presidency Magistrate, Calcutta, dated the 25th of July, 1903.

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belief that the merchandise denoted by it was Ghosh, Sinha's, already known in the market as "mash marka." The charge was confined to the mark or design, for apart from that, fish-hooks of the class in question admittedly were sold in boxes of similar size and get up. The colour and size of the labels were also of a similar nature common to the trader. They were convicted by the Magistrate and appealed against the conviction to the High Court, where the conviction was quashed.

*Mr. Jackson (Mr. P. L. Roy and Babu Dasarathi Sanyal with him) for the appellants.*

The respondents rely on the case of *Reddaway v. Bonham*(1) where it was held that, if everybody know "Camel hair" as Reddaway's, the latter could get an injunction. Then the Cellular Clothing Company and Maxton came up and the House of Lords resiled.

[GROSE J. Suppose the case for the prosecution is correct and their design is known throughout Calcutta as "mash marka" and yours is different in important details, if compared; I want authority that that is an offence.]

The House of Lords has allowed Bonham to use "Camel-hair" with his name on it; here the name "mash" is merely a verbal description. Both packets are known as "mash marka." In the course of time it must come to that, that one will be known as one fish and the other as two fish. *Reddaway v. Bonham*(1).

Judgment of Lord Herschell, pages 209, 214.

Judgment of Lord Macnaghten, page 219.

Judgment of Lord Morris, page 221.

*The Cellular Clothing Company v. Maxton*(2).

Judgment of Lord Halsbury, pages 332, 335.

Lord Watson, page 337; Lord Shand, 339; Lord Davey, page 343. *In re Dunn's Trade-marks.* Lord J. Fry, page 455(3). Kerly on Trade-marks, II ed., page 44.

[STEPHEN J. These are descriptive cases. Mash marka is not descriptive.]

(1) (1896) A. C. 199.

(2) (1899) A. C. 326.

(3) (1889) L. R. 41 Ch. Div. 432, 455.

It is not a fancy word; there are in other cases words that are meaningless; see Kerly, pages 182, 189.

They are seeking to make out that "mash marka" has a secondary signification—that signification must be universal—Kerly, page 479.

Verbal descriptions are worth noting, Kerly, page 571; *Coppen and Moore*(1); *Langley v. Bombay Tea Company*(2).

It has been held that there must be a "mens rea." Sections 6 and 7 of the Merchandise Marks Act, s. 488, I. P. C. Kerly 604, 610; *Gridley and Swinborne*(3). The label is different. *Blackwell v. Crabb*(4). Unwary purchasers—*Singer Manufacturing Company v. Wilson*(5); Kerly, pages 225-26.

There is no trace of the fact that this mark was put on at my instance.

*Mr. Sinha (Babu Nogendra Nath Ghose with him)* for the opposite party.

The case of *Reddaway v. Bonham* has nothing to do with this case. There the question was whether any one else could manufacture camel-hair belting; here there is no question of descriptive words.

As to the respective significations of descriptive and distinctive, see *In re James's Trade mark*(6).

The case on the other side rests on the ground that this is descriptive. Fish is not descriptive of fish-hooks. In this country I can acquire a right by user and not by registration. Time is the only point to be considered in deciding whether I have acquired the trade mark.

Indian Penal Code, ss. 478 and 480, and Merchandise Marks Act and Kerly on Trade-marks, page 249. As to similarity see *Seixo v. Provesende*(7).

Is it reasonably calculated to deceive? The test of putting marks side by side has been dealt with; Kerly, page 228. The idea of each mark is to be considered.

(1) (1898) L. R. 2 Q. B. 300.

(4) (1867) 36 L. J. Ch. 504, 505.

(2) (1900) L. R. 2 Q. B. 460, 463.

(5) (1875-76) L. R. 2 Ch. D. 434, 447.

(3) (1888) 5 T. L. R. 71.

(6) (1886) L. R. 33 Ch. D. 392.

(7) (1865-66) L. R. 1 Ch. 192.

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The distinctive symbol here is fish, whether one or two. The eye and ear must be considered in this reference, Kerly, page 233.

You can acquire a trade mark by use ; it is not necessary to show that the mark must be of universal repute. There is nothing in the Code as to that.

[STEPHEN J. You must show that "mash marka," is known over a larger area than Calcutta.]

No such area is necessary ; it is necessary in a descriptive mark and this is not descriptive.

It arises from these cases. In showing user I have to show the locality ; it is not necessary to show user in any circumscribed area.

I am not required to show where I have acquired the right, Kerly, page 240. It is sufficient if it so resembles the former that it is calculated to deceive.

*Mr. Jackson* in reply.

The evidence in this case consists of the evidence of four persons in the employ of the prosecutors. This is not the sort of evidence required in a trade-mark case. There must be a limit of time to acquire a trade-mark. If it had been a civil case, it would have been necessary to distinguish the marks.

GHOSE AND STEPHEN JJ. The appellants in the present case have been convicted on charges under s. 482 and s. 486 of the Indian Penal Code, as amended by the Indian Merchandise Marks Act, 1889, of using a false trade-mark, and selling goods marked with a counterfeit trade-mark, and under s. 6 of the Merchandise Marks Act of applying a false trade description to goods, and they are now appealing against these convictions. The main facts in the case are simple and are undisputed.

Since December, 1900 the opposite party have been selling fish-hooks, which they have imported from Europe, in packets bearing labels on which appears a design of two fish crossed, with their heads and tails bent up. These fish-hooks have been generally known in Calcutta as "mash marka" (fish mark) and have

commanded a large sale. The boxes, labels and designs have been made exhibits, but we need only notice the design of two fishes, which for present purposes may be conveniently referred to as mark A. During the season of 1903 the appellants sold fish-hooks in similar boxes, bearing similar labels, and a design of one fish with his head and tail turned up. These boxes, labels and designs have also been made exhibits, but again we need only notice the design of one fish, which we will refer to as mark E.

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No point has been raised before us on the similarity of the boxes and labels, as it is admitted that their shape and appearance are what are usual in the trade, and the inscription on the label bearing mark E is different from that on the label bearing mark A; the name of the maker in particular being truly given. But it is alleged that mark E is a fraudulent imitation of mark A, and that it is devised to enable the appellants to sell their fish-hooks as "mash marka."

Under these circumstances the opposite party's contention is that mark E is a false trade-mark, which, for present purposes, we may take to be the same as a counterfeit trade-mark, and that they have applied the name "mash marka" to these goods as a false trade description.

It has not been urged before us that mark E is in itself a false trade-mark, as being such a mark as is mentioned in section 480 of Indian Penal Code; but merely as being a mark to which the term "mash marka" is likely to be, and indeed is intended to be, applied. It is also to be noticed that a trade description as defined in section 2 of the Merchandise Marks Act does not include such marks as mark E, but that such marks are brought within the scope of section 6 of the Act by the operation of section 4 (1). Whether we consider the case of a false trade-mark or of a false trade description we have first to consider what is the real point of the case, namely, whether the mark or description is false. And in this present case the point seems to depend on whether the application of the term "mash marka" is in the language of section 480 of the Indian Penal Code or section 4 (1) of the Merchandise Marks Act "reasonably calculated to cause it to be believed (or to lead persons to believe)" that the fish-hooks sold under mark E are the merchandise of the opposite party. How far in fact does the

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law allow a man to appropriate to his own use a name which is suggested by his trade. That it does so to some extent is plain from various well known cases. In *Seiro v. Provesende*(1) quoted in Kerly on Trade-marks at p. 240, Lord Cranworth says "the defendants have adopted a trade-mark which could not fail to lead purchasers to attribute to the wines so marked the same name as that under which the plaintiff's wines were known and so to believe that in purchasing them they would be purchasing the wines of the plaintiff." The facts of that case, however, seem to be essentially different from those before us. Without considering how far

principle that was followed in an application for an injunction ought to be followed in a criminal case, it must be observed that in that case the public were directly invited to adopt the use of a definite word, though that word was a common one. In the present case as put forward by the respondent, the public had chosen a name for their own use; and, if the difference between the two kinds of fish-hooks is noticeable enough to make the public care to distinguish between them, the difference between one fish and two fish is marked enough to afford a very simple method of distinction. The facts in the milkmaid brand case, *Anglo Swiss Condensed Milk Company v. Metcalf* (2) are too different from the present facts for that case to afford us much assistance. In the "Two Elephants case" *Johnston v. Orr Ewing* (3) both marks contained two Elephants, which clearly distinguished it from the present case.

A good deal of argument has been addressed to us by Counsel on behalf of the appellants as to the effect of the decisions in the camel-hair belting case, *Reddaway v. Bonham*, 1896, App. Ca. 199, and *Cellular Clothing Company v. Mauston*, 1899, App. Ca. 327, which is distinguished from that case. As to these cases we have only to say that applying as they do to descriptive names they can have no application to the present case, since a picture of a fish can hardly be held to be a description of a fish-hook. In the present case, applying as far as we can the principles laid down in the cases we have quoted, and the sections to which we have referred, we do not think that the fact that mark A was known as

(1) (1865-66) L. R. 1 Ch. 192.

(2) (1886) L. R. 31 Ch. D. 454.

(3) (1882) 7 A. C. 219.

“mash marka” can be held to prevent other persons from applying a mark to fish-hooks, which may be generally known by the same term. The respondent’s right to the exclusive use of a mark which may acquire such a designation, is at least not plain enough for us to consider it proved as against a person charged with an offence. The essential feature of the design is, in our opinion, too common and too apt for application to fish-hooks, for a name based on it to be reasonably calculated to mislead. We do not consider, therefore, that, apart from the facts of the case, mark E is a false trade mark, merely because it is or may be known as “mash marka,” when that name is already applied to mark A. And the same remark applies to “mash marka” considered as a trade description.

We must, however, examine the facts of the case to see whether or how far any inference to be drawn from them conflicts with this view. If it appears that purchasers were misled by mark E or the use of the term “mash marka” into believing that the appellants’ goods were the merchandise of the respondents, this will go a long way to prove that the mark was calculated to produce this effect. If we find that the mark was devised to produce this effect, we shall probably be confirmed in this opinion.

It is not disputed that the term “mash marka” has been applied to the respondents’ fish-hooks, since they were first put on the market. There is also evidence which, on the whole, we believe, that the appellants supplied mark E fish-hooks when asked for “mash marka.” There is an *a priori* likelihood that this would be so, and the attempt made on behalf of the appellants to prove that mark A fish hooks were asked for under the name “Jori mash marka”, while these were called “ek mash marka,” seems to point in the same direction. The evidence that any one was misled by the appellants supplying the E mark as “mash marka” is less satisfactory. We may suppose that the witness Shaik Yacob, intended to represent himself as misled, though he did not specifically say so—Mohamed Ali’s evidence went to show that he would have been misled, had he not been buying mark E on behalf of the respondents ; but we cannot place much reliance on his evidence. Ismail bought mark E as “mash marka,” but he does not profess to have been misled by the mark itself ; on the

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contrary he noticed the difference of the mark from that to which he was accustomed and made enquiries about it. Fanindra Nath, the appellants' gomasta, gave evidence that he did not sell mark E to Mohamed Ali as "mash marka," but this we do not wholly believe.

There is no doubt some evidence of direct fraud by the appellants to pass off mark E to Ismail as the respondents' goods; but it is too vague and uncertain for us to rely on. A voucher was given to Mohamed Ali, in which the hooks supplied to him are described as "mash marka," and it is alleged that the description was put in and then struck out (exhibit F). But the insertion and erasure have not been explained in the evidence and convey nothing to our minds.

Considering all the evidence on the subject, we find nothing in it to cause us to modify the opinion we have already expressed to the effect that mark E is not a false trade mark, or a false description in the sense we have mentioned. We have not to decide, and we do not decide, whether the appellants were justified in using mark E, or in supplying their own fish-hooks, when asked for L "mash marka." But we do hold that they have not committed any of the offences with which they have been charged.

It only remains to add that we need not determine whether the appellants have proved that they acted without an intent to defraud. Their evidence on this point almost entirely consists of the indent containing the order for the mark E fish-hooks, in which no mention is made of any mark (exhibit 5A). This goes some way to prove the point, but falls short of satisfactory proof.

We much regret that recourse has been had to the criminal law to settle the matter at issue between the parties. The result is that nothing has in fact been decided and that the present proceedings have had no useful result. The appeal is allowed, the conviction and sentence being set aside. The *fine*, if realized, will be refunded.

G. M. F.