

APPEAL FROM ORIGINAL CIVIL.

*Before Sir Lawrence H. Jenkins, K.C.I.E., Chief Justice, and
Mr. Justice Woodroffe.*

1909
Dec. 14.

JAWALA PRASAD

v.

MUNNA LAL SEROWJEE.*

Trade-mark—Registration, effect of—Vendor's mark—Infringement of trade-mark—Passing-off action—Injunction, variation of.

An action for the infringement of a trade-mark is maintainable, even though the plaintiff be not the manufacturer or selector of the goods, but merely a vendor of them.

There is no system of registration of trade-marks in India which gives a statutory title.

In a suit for the infringement of a trade-mark, the plaintiff claimed the right to the exclusive user of a flower of a particular design, but his evidence was directed to establish that his goods were recognised by the general design of a flower (*phul marka*):—

Held, that in the circumstances of the case, an association had been established between the plaintiff's particular design and the goods sold thereunder, and inasmuch as the defendants had adopted the plaintiff's trade-mark for his own purposes, the plaintiff was entitled to an injunction.

Although no specific objection was taken on appeal to the form of the injunction ordered in the Court of first instance, which proceeded on the erroneous assumption that the goods sold by the plaintiff were prepared by him, a variation should be introduced into the terms of the injunction, so as to fit it with the facts as actually established.

APPEAL by the defendants, Jawala Prasad and others, from the judgment of Fletcher J. (1).

This appeal arose out of a suit brought by the plaintiff, Munna Lal Serowjee, for an injunction to restrain the defendants from infringing his trade-mark and for damages.

The plaintiff carried on business in Calcutta as a *ghee* merchant under the name and style and firm of Munna Lal Dwarkadas, and for a period of over twelve years he had sold

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his *ghee* in Calcutta and foreign markets, tinned in canisters bearing his embossed mark, which consisted of a conventional flower on a stem with leaves, the flower being of the shape of an ellipse with an indented circumference, having within its circumference the initials of the plaintiff's firm M. D. S., and having under the design of the flower the name of the plaintiff's firm in the Devnagri character. This trade-mark was registered by the plaintiff in the year 1894.

The defendants were also dealers in *ghee*, and from October 1902 to February 1903 the plaintiff acted as commission agent in Calcutta for the sale of the defendant's *ghee*. The infringement complained of consisted in the fact that the defendants used on their canisters of *ghee*, intended for sale and export in the same markets, a colourable imitation of the plaintiff's mark. It was alleged that the defendants' trade-mark was calculated to deceive, and that it had in fact deceived, purchasers by inducing them to purchase the defendants' goods in the belief that they were buying those of the plaintiff.

The actual design of the defendants' flower was almost exactly the same as the plaintiff's mark: the initials, however, within the circumference were J. P. M., the initials of the defendants' firm, and the name of the defendants' firm was inscribed beneath the flower also in the Devnagri character. Unless the names and initials were read, the marks were not distinguishable.

It was contended by the defendants that the flower-mark or "*phul*" mark was one which was common to a large number of traders in *ghee*, and that each trader inscribed his name and initials as a distinguishing mark, and that purchasers of *ghee* invariably asked for the "*phul*" mark of the particular trader whose goods they desired to purchase.

At the hearing of the suit, the evidence adduced by the plaintiff on the question of repute was not directed to the real point at issue, *viz.*, that the plaintiff's goods were associated with his particular mark, but rather sought to establish that his goods were recognised by the general design of a flower (*phul-marka*).

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Fletcher J. came to the conclusion on the evidence "that canisters containing *ghee*, marked with the plaintiff's trade-mark, had come to be recognised in the market as *ghee* prepared by the plaintiff," and that the defendants had deliberately adopted plaintiff's trade-mark. His Lordship granted an injunction "restraining the defendants from selling or offering for sale *ghee* not prepared or manufactured by the plaintiff in canisters having embossed thereon a flower on a stem with leaves (the flower being in the shape of an ellipse with an indented circumference) without clearly distinguishing such *ghee* from the plaintiff's *ghee*," and directed an enquiry as to damages (1).

From this judgment the defendants appealed. It was admitted on appeal that the plaintiff was not the manufacturer of his *ghee*, but merely the selector and vendor.

Mr. B. C. Mitter (*Mr. S. K. Mullick* with him), for the appellants. Registration of a trade-mark in India does not give any statutory title. To succeed in a "passing-off" action local repute must be established: *Goodfellow v. Prince* (2). The decree is in variance with the evidence adduced by the plaintiff, who claimed the exclusive user of all "*phul*" or flower marks. The "*phul*" mark is a common incident of the trade and is extensively used: *Emperor v. Bakarullah Mallik* (3). Purchasers distinguish the goods of the various dealers by the initials and names. Where the mark is a common incident of the trade, closeness of resemblance is immaterial: see Kerly on Trade-marks, 3rd edition, pages 215 to 217, on the "three marks" rule. A trade-mark may be lost by extensive piracy: *National Starch Manufacturing Company v. Munn's Patent Maizina and Starch Company* (4). The defendants knew what the plaintiff's mark was all along, as they had acted as agents. Although delay does not bar the right of action [*Fullwood v. Fullwood* (5)], it may modify the relief granted and it has a

(1) (1908) I. L. R. 35 Calc. 311.

(3) (1904) I. L. R. 31 Calc. 411.

(2) (1887) L. R. 35 Ch. D. 9.

(4) [1894] A. C. 275.

(5) (1878) L. R. 9 Ch. D. 176.

bearing on the weight of evidence ; clearer proof of fraudulent intent and of actual injury will be required : *Rodgers v. Rodgers* (1), Seton's Judgments and Orders, 6th edition, Volume I, page 633. Promptitude is the life of a trade-mark : see Kerly on Trade-Marks, 3rd edition, page 425. To obtain an injunction, the plaintiff must show that at the date of the hearing of the suit in January 1908, repute still existed : *Ford v. Foster* (2). An injunction is in the nature of preventive relief. [WOODROFFE J. Ordinarily relief would be granted on the basis of the circumstances existing at the date of suit.] In a "passing-off" action, relief by injunction must go on the basis of the circumstances existing at the hearing of the suit, the object of an injunction being to prevent repetition. It would be otherwise in the case of relief by way of damages. The antiquity of a trade-mark has no importance : the important feature is repute. The enquiry as to damages is not justified.

Mr. A. Chaudhuri (with him *Mr. Sircar*), for the respondents. I concede that if infringements had taken place since the date of suit in 1903, to the plaintiff's knowledge and without opposition, it would affect plaintiff's remedy. But there is no evidence of this. [WOODROFFE J. It is not your knowledge that is material : it is the loss of your repute in the mind of the public.] [JENKINS C.J. The mark would lose its denotation : where then would there be any "passing-off" ?] Fletcher J. was correct in coming to the conclusion that the defendants had deliberately adopted the plaintiff's mark. The addition of the defendants' initials and name did not avoid the infringement. The authorities are collected in Kerly on Trade-marks, 3rd edition, page 407. The infringement complained of is not with reference to the term "*phul-marka*" as a generic term, but to the closeness of the resemblance of the defendants' mark to the plaintiff's. It is not necessary for the plaintiff to establish that he was the manufacturer or even selector : it would be enough if the mark is identified with the plaintiff's dealing with the goods : *Major Brothers v. Franklin & Son* (3),

(1) (1874) 31 L. T. 285.

(2) (1872) L. R. 7 Ch. App. 611, 628.

(3) [1908] I. K. B. 712.

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Knott v. Marshall (1); Kerly on Trade-Marks, 3rd edition, page 54. [JENKINS C.J. What do you say to the terms of the injunction?] The injunction is unhappily worded: but the intention was to protect the plaintiff and the terms may be varied. On the question of damages, allegation of special damage is no part of the cause of action: there is, however, evidence of damage.

Mr. Mitter, in reply. Before the principle—that where the defendant has effected an imitation, the Court will not be astute to balance the evidence as to the closeness of the imitation—is applied, the plaintiff must establish the preliminary point of repute: see Kerly on Trade-Marks, 3rd edition, page 507, citing *Hershell L. C.* Now, what is the plaintiff's trade-mark? The plaintiff's evidence went to establish that he had a trade-name (*phul-marka*). There is no evidence that his trade mark was the particular design of a flower, as distinguished from a flower itself. [JENKINS C.J. That is, he makes too big a claim. Can we not deal with the fact that this particular form of flower has been used by the plaintiff since 1894?] By placing his claim too high, the plaintiff may prevent the Court from defining the limits of his trade-mark. The foundation of a plaintiff's right is the distinctive feature of his trade-mark.

Cur. adv. vult.

JENKINS C.J. This appeal arises out of a suit brought by the plaintiff to establish his exclusive right to a mark, with consequential relief. The plaintiff is one Munna Lal Serowjee, who carries on business in Calcutta as a *ghee* merchant in the name, style and firm of Munna Lal Dwarkadas. The defendants are Jawala Prasad, Mawaram and Gopal Das, who carry on business as dealers in *ghee* under the name and style of Jawala Prasad Mawaram and Buktear Mal Mody, who carries on business in Calcutta as a dealer and commission agent in *ghee*. Since the institution of this appeal one of the defendants

has died, and Mr. Mitter, who appeared on his behalf, has dropped the appeal so far as he is concerned.

It is alleged in the plaint, and established by the evidence, that for a considerable time, that is to say for twelve years, the plaintiff's *ghee* has been sold in Calcutta and foreign markets, tinned in canisters bearing his embossed mark, which consists of a flower on a stem with leaves, the flower being of the shape of an ellipse with an indented circumference, having within its circumference the initials of the plaintiff's firm M. D. S. The infringement is said to consist in the fact that the defendants used on their canisters of *ghee*, intended for sale and export in the same markets, a colourable imitation of the plaintiff's mark: and it is alleged that the use by the defendants of this mark is calculated to deceive, as it has deceived, by inducing purchasers to buy the defendants' goods in the belief that they are buying those of the plaintiff. Though the plaintiff's mark has been described as a registered trade-mark, there is no system of registration here which gives a plaintiff a statutory title, and therefore it is necessary for the plaintiff to establish that the mark, in respect of which he makes this claim, has acquired a reputation in connection with the goods that he sells. A trade-mark means a mark used to denote that goods are of the manufacture or merchandise of a particular individual. That is the office of a trade-mark, and much of the difficulty in this case has arisen from the fact that evidence has not been directed to establishing that particular point. However, Mr. Justice Fletcher has come to a clear and distinct finding on the evidence before him in these terms: "I have come," he says, "to the conclusion on the evidence that canisters containing *ghee* marked with the plaintiff's trade-mark have come to be recognised in the market as *ghee* prepared by the plaintiff," and so an injunction was granted by him "restraining the defendant from selling, or offering for sale, *ghee* not prepared or manufactured by the plaintiff in canisters having embossed thereon a flower on a stem with leaves, the flower being in the shape of an ellipse with an indented circumference, without clearly distinguishing such *ghee*

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from the plaintiff's *ghee*." In this finding, and in the consequent injunction, there is this error, that it assumed that the *ghee* was prepared by the plaintiff. This, admittedly, is not so. But it is contended on behalf of the plaintiff that though not prepared or manufactured by him, it is in fact selected and sold by him, and that contention is, I think, made good. The first question then that we have to determine is whether there is anything which supports the view that this particular mark used by the plaintiff on the canisters in which his *ghee* is tinned has come to denote in the market his *ghee*. We have the significant fact that from 1894 this mark has been claimed by the plaintiff as his own, and he has used that mark for the purposes of his trade in *ghee*. During the greater part of that time there has been no other mark of that character, and that naturally leads to the conclusion that the plaintiff's *ghee* did become associated with the mark which he throughout used; and though the evidence is, as I have said, not carefully directed to the real point in issue, I think there is sufficient in the evidence to justify the distinct finding of the learned Judge that the trade-mark has come to be recognized in the market as indicating the *ghee* of the plaintiff. In this connection, too, one cannot but be impressed by the fact that the plaintiff's mark was known to the defendants, and also by the very significant circumstance that with the whole world of flowers to choose from, for some reason or other, the defendants have selected this particular form of conventional flower, and they have not come forward to explain how it was that this came about. In the circumstances, I hold with the learned Judge that not only did this mark denote in the market the *ghee* of the plaintiff, but that the defendants did deliberately adopt the plaintiff's trade-mark for their own purposes. Having come to that conclusion, it necessarily follows that the plaintiff is entitled to succeed in this suit. The remedy that has been awarded to him by the Court of first instance has been first of all an injunction; and, secondly, an enquiry as to damages. No special ground of appeal has been directed against this enquiry as to damages, and it was not suggested to us, in the opening of the

appellants' case before us, that this enquiry was erroneous, except so far as the whole of the plaintiff's claim was misconceived. Mr. Mitter, however, proposed, in reply, to raise then, for the first time, a question as to the propriety of this enquiry as to damages. But we could not allow that question to be raised at that stage of this appeal, bearing in mind the grounds of appeal formulated for the consideration of the Court.

Though no specific objection was taken to the form of the injunction, I think it requires modification, because, as I have pointed out, it proceeds upon an assumption which cannot be sustained, that is, upon the assumption that the *ghee* sold by the plaintiff was prepared or manufactured by him. That is not so; and accordingly there must be a variation introduced into the terms of the injunction so as to fit in with the facts as they actually are established, by substituting the words "being *ghee* of" for the words "prepared or manufactured by." Then, again, the words "*ghee* from the plaintiff's *ghee*" (after the words "without clearly distinguishing such") are not correct, and the words "canisters from those in which the plaintiff's *ghee* is contained" should be substituted for them.

The result then is that, with this variation, the decree must be confirmed with costs, the costs of the two abandoned applications will be costs in the appeal.

WOODROFFE J. I agree that the appeal should be dismissed with costs. I think the action is maintainable, even though the plaintiff be not the manufacturer or selector of the goods, but is merely a vendor of them. The main point, however, which has been urged before us is this, that the claim is at variance with the evidence: what, it is said, the plaintiff claims is not the right to exclusive user of a flower, but to the exclusive user of the flower of a particular design which he registered in 1894. This, however, I may observe, was the claim that was made in the plaint, and it is in fact the right which has been protected by the decree.

It is further urged that the evidence, if believed, shows that the plaintiff's goods were recognised by the design of a flower

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alone (which was called *phul-marka*), and not by the particular design of a flower which the goods bear embossed on them, indicating the plaintiff's trade-mark, exhibit A. I agree with the learned Chief Justice in thinking that the evidence has not been on this point very happily directed. But this particular design has been used since the year 1894, and I am satisfied that for the greater part of this period no other design of flower has been used by any one selling *ghee*. Therefore, if the plaintiff's goods were associated with the mark of a flower, as there was only one flower, the association must have been with the flower of the particular design which the plaintiff has adopted. I think it is sufficient to show, in the circumstances of this case, that an association has been established between the plaintiff's particular design of a flower and the goods sold thereunder.

There is further evidence, it has been noted, that the plaintiff's goods are known by this mark—evidence which, in my opinion, is none the less acceptable because reference is made merely to the design of a flower, and not to the particular distinctive marks of the plaintiff's design. It must be remembered in this connection that, when that evidence was given, the witnesses had before them the particular exhibit, and I think it is reasonable to suppose that that evidence was given with reference to, and must be read in connection with, that exhibit. As to the similarity of the marks, this is transparent to the eye, and the doctrine of chances is all against coincidence and in favour of the conclusion that there has been, as the learned Judge has found, deliberate imitation. I do not consider, in the circumstances, that any direct evidence was necessary to establish that fact. It appears to me to be a legitimate conclusion from the evidence that is before us. Moreover, there is evidence that unless the names are read, the marks are not distinguishable. It may be, as the learned counsel for the appellants has pointed out, that some persons can read the Devnagri characters under the mark, which, he claims, distinguish his mark from that of the plaintiff. But it must be remembered that others cannot do so. The case

cited, *Blackwell v. Crabb* (1), must be taken in relation to the circumstances of that case and the country in which that judgment was pronounced. There it was an English name; and the mark was current in England, and naturally the name could be read and understood by everybody. But here the name is in Devnagri character, which is not readable by the greater portion of the public.

Apart from this, we have this outstanding fact that the actual design of the defendants' flower is almost exactly the same as the plaintiff's mark. Why is this similarity if it serves no purpose? The adoption of an almost exactly similar mark indicates cogently, in my opinion, that the defendants believed that it was the design which sold the goods: if they did not, they would not have adopted it.

The only other point which I wish to add to what the learned Chief Justice has said is this: I am not satisfied, as regards the evidence of the plaintiff's witness, Nanda Lal, that he did not make any mistake as to the mark which he says he saw in the plaintiff's firm. I think it is very important in this connection to remember that the reply which he gave was in answer to a question put by one of the plaintiff's counsel in examination-in-chief.

Appeal dismissed.

Attorney for the appellants: *N. C. Bose.*

Attorney for the respondents: *Manuel and Agarwalla.*

J. C.

(1) (1867) 36 L. J. Ch. 504.

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