

APPELLATE CRIMINAL.

Before Mr. Justice Chitty and Mr. Justice Richardson.

ANATH NATH DEY

v.

EMPEROR.*

1912

Nov. 4.

Trade-mark—Using a false trade-mark—Possession of instruments for counterfeiting a trade-mark—Selling umbrellas with counterfeit trade-mark—Trade-name, use of, by rival manufacturer—Using a false trade description—Penal Code (Act XLV of 1860), ss. 482, 485 and 486—Merchandise Marks Act (IV of 1889), ss. 6 and 7.

A trade-mark must be some visible and concrete device or design affixed to goods to indicate that they are the manufacture of the person whose property the trade-mark is. It might consist of a name impressed in some distinctive way. There is a distinction between a trade-mark and a trade-name.

Singer Manufacturing Co. v. Loog (1) referred to.

Where a tradesman alleged in his complaint to the Magistrate that his trade-mark consisted of a particular device, with the name "*Butto Kristo Pal*" or "*Sri Butto Kristo Pal*," said to be that of his son, but at the trial claimed only the name as the trade-mark, while one of the partners disclaimed the device except the name, and the former's son claimed the name as representing his own trade-mark in a separate business, and the rest of the prosecution evidence did not establish the possession or use of any specific trade-mark :—

Held, that the complainant had not proved that he had a trade-mark for the infringement of which a rival trader, using a similar device with the same name, could be convicted under ss. 482, 485 or 486 of the Penal Code, and that the case was of a civil nature.

When a manufacturer has no exclusive right to manufacture a certain article or even articles of a particular brand, all that he can claim is that no other manufacturer should so mark such articles as to pass them off as the former's when they are not.

*Criminal Appeal, No. 701 of 1912, against the order of N. Bagchi, Fourth Presidency Magistrate of Calcutta, dated Aug. 22, 1912.

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Semble : The improper use of a trade-name may fall under s. 5 of the Merchandise Marks Act (IV of 1889), and be punishable under s. 6 or s. 7 as a false trade description.

THE appellant was tried by the Fourth Presidency Magistrate, on charges under sections 482, 485 and 486 of the Penal Code and sections 6 and 7 of the Merchandise Marks Act (IV of 1889), and convicted and sentenced under the former sections, on the 22nd August 1912, to a fine of Rs. 210, and in default to simple imprisonment for three months. The instruments for counterfeiting a trade-mark found in his possession were ordered to be confiscated.

The complainant, Ashutosh Pal, had carried on a business in the manufacture and sale of umbrellas, at No. 121, Old China Bazar, for the last 10 or 12 years, in partnership with Nogendra Nath Dey and Lal Behary Ghose. His son, Butto Kristo Pal, had a similar but independent business at 120, Old China Bazar. Ashutosh Pal, in his complaint to the Chief Presidency Magistrate, alleged that his business was of long standing, that one brand of his umbrellas was known in the market as "*Butto Kristo Pal*" umbrellas, being so named after his son, that he had a trade-mark with a specific device (which he exhibited) bearing the words "*Butto Kristo Pal*" or "*Sri Butto Kristo Pal*," and that the appellant had counterfeited his trade-mark by using a similar design containing the same name, and had sold "*Butto Kristo Pal*" umbrellas as his own manufacture. At the trial, however, he stated, in cross-examination, that his trade-mark consisted only of the name. One of the partners deposed to the same effect, while the other positively repudiated the exhibited mark as a whole except the name. The complainant's son, who was also examined for the prosecution, claimed the name as being *his* own trade-mark in the separate business. A number

of other witnesses was examined, but none of them proved that the complainant had any particular device as a trade-mark, though they stated that there was a brand of umbrellas known as "*Butto Kristo Pal*," and that when they received orders for such articles they procured them from the complainant's firm.

The appellant was carrying on a similar business at No. 125-6, Old China Bazar Street, and sold umbrellas with a similar device, also containing the words "*Butto Kristo Pal*." His case was that one Tulsi Das Pal, who was in the trade for about 20 or 25 years previous to his insolvency in 1908, had manufactured and sold umbrellas called "*Butto Kristo Pal*" after his son, and that Tulsi had, shortly before becoming an insolvent, sold the business to him. It was proved that the appellant had sold such umbrellas since 1908, and the dies and plates used in imprinting his trade-mark were found on his premises and seized.

The Magistrate convicted him as stated above, whereupon he appealed to the High Court against that order and sentence.

Mr. Eardley Norton, Babu Atulya Charan Bose and *Babu Ramani Mohan Chatterji*, for the appellant.

The Advocate-General (Mr. G. H. B. Kenrick, K. C.), for the Crown.

Cur. adv. vult.

CHITTY AND RICHARDSON JJ. The appellant, Anath Nath Dey, has been convicted by the Fourth Presidency Magistrate of offences under sections 482, 485 and 486 of the Indian Penal Code, and sentenced to pay a fine of Rs. 210, or in default to undergo 3 months' simple imprisonment, the fine if realised to be paid to the complainant as compensation. The appellant was also charged in the alternative with offences under sections 6 and 7 of the Merchandise Marks Act, 1889,

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but, beyond stating the fact at the commencement of his judgment, the learned Magistrate has taken no further notice of it. He has not at all discussed those charges or come to any finding upon them. The case of the complainant Ashutosh Pal, as put forward in his petition of complaint, is that he manufactures and carries on business in umbrellas; that his business is of long standing and his umbrellas known in the markets as "*Butto Kristo Pal*" umbrellas, "*Butto Kristo Pal*" being the name of his son; that his trade-mark is the device annexed to the petition and marked A. (In Court it has been marked as Exhibit 1.) He further complained that the appellant who had recently started business in umbrellas had counterfeited the said trade-mark, using one very similar to it, (Exhibit B). (In Court that has been marked as Exhibit 2.) He accordingly charged the appellant under sections 482, 485 and 486 of the Indian Penal Code, and sections 6 and 7 of the Merchandise Marks Act, 1889. The appellant filed a written statement denying the complainant's trade-mark. He alleged that Butto Kristo Pal was the son of Tulsi Das Pal, whose umbrella business he (the appellant) had purchased. He further complained that, the parties being rival traders, this case had been brought against him falsely and maliciously in order to ruin his business.

When the case came on for hearing the complainant gave evidence. He swore that the umbrellas manufactured by him in the name of his son were known as "*Butto Kristo Pal*" umbrellas. He further swore to the design (Exhibit 1), and to the appellants alleged counterfeit of it (Exhibit 2). In cross-examination he alleged his trade-mark in umbrellas to be "*Butto Kristo Pal*" or "*Sri Butto Kristo Pal*." One of the complainant's partners, Nagendra Nath Dey, stated: "The trade-mark of the umbrellas is '*Butto Kristo*"

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Pal.” The other partner, Lal Behari Ghose, in cross-examination went further. He said: “Our trade-mark is ‘*Butto Kristo Pal.*’ This configuration (meaning Exhibit 1) is not our trade-mark. ‘*Butto Kristo Pal.*’ only is our trade-mark.” He admitted that it had not been advertised, still less registered. Butto Kristo Pal, the son of complainant, has no business connection with his father, except that Nagendra Nath Dey, one of complainant’s partners, is also his partner. They carry on a separate business at 120, Old China Bazar, the complainant’s shop being at 121. Butto Kristo Pal, in cross-examination, said: “‘*Butto Kristo Pal.*’ is my trade-mark at No. 120. The shop at No. 120 was opened 3 or 4 years ago.” The complainant called a number of other witnesses, merchants, who had bought umbrellas of his firm, and others. Not one of them speaks to any device or trade-mark of the complainant, but their evidence goes to show that there is a brand of umbrellas in the market known as “*Butto Kristo Pal.*” umbrellas, and when they are asked for such umbrellas they write to the complainant’s firm for them. It is said that the complainant has been doing this business for 10 or 12 years.

The charge against the appellant is, that he has also been selling umbrellas as “*Butto Kristo Pal.*” umbrellas, a number of which were found at his place of business, No. 125-6, Old China Bazar. A wooden block, the die of Exhibit 2, was also found and has been put in to support the charge under section 485.

The appellant called evidence to show that Tulsi Das Pal, who admittedly had dealt in umbrellas for 20 or 25 years previous to his insolvency in 1908, had used the name of “*Butto Kristo Pal.*” to denote one class of his umbrellas for 3 or 4 years prior to 1908, he also having a son Butto Kristo Pal. Tulsi Das Pal is a cousin of the complainant who learnt his business in

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Tulsi Das' shop. It was further alleged that Tulsi Das Pal, on the eve of his insolvency, sold his business to the appellant, who has since carried it on. There can be no doubt that Tulsi Das Pal before 1908, and the appellant since that date, have received orders from the mufassil for "*Butto Kristo Pal*" umbrellas.

On this evidence the learned Magistrate has convicted the appellant under sections 482, 485 and 486 of the Indian Penal Code. In our opinion that conviction cannot possibly stand.

A trade-mark must be some visible concrete device or design affixed to goods to indicate that they are the manufacture of the person whose property the trade-mark is. It might, no doubt, consist of a name impressed in some distinctive way. In this case the complainant has no exclusive right to manufacture umbrellas or even umbrellas of a particular kind. All that he could claim would be that no other manufacturer should so mark umbrellas as to pass them off as the complainant's manufacture when they were not. This the complainant alleged that the appellant had done by affixing a mark or design closely resembling his own and containing the name "*Butto Kristo Pal*." The complainant, however, has completely failed to show that he has any such trade-mark. In his complaint he put forward Exhibit 1 as his trade-mark, but in his examination he went back on this, and claimed simply the use of the name "*Butto Kristo Pal*." His partner, Lal Behari Ghose, went further and denied that Exhibit 1 was their trade-mark, while the son, Butto Kristo Pal, claimed the name as his trade-mark in a business independent of his father's. Not one of the complainant's witnesses speak to the complainant having any trade-mark, meaning any design or device, nor do they suggest that his umbrellas are known by any such trade-mark. It appears that

the case was allowed to change its character as it went on. From a case relating to the making and use of a false trade-mark, it drifted into a case of using a false trade-name. The distinction between a trade-mark and a trade-name is clear: see the remarks of Lord Blackburn in *Singer Manufacturing Co. v. Loog* (1). The improper use of a trade-name might fall within the purview of section 5 of the Merchandise Marks Act, and be punishable under section 6 or 7 as a false trade description. That, however, is not the case here. There is no proved trade-mark of the complainant for infringing which the appellant can be convicted under sections 482, 485 or 486 of the Indian Penal Code. We are not prepared to say what might have been the result had the case been confined to the charges under sections 6 and 7 of the Merchandise Marks Act. It has not been dealt with on that footing, and the appellant could not, as the evidence at present stands, be convicted under either of those sections.

We allow the appeal, set aside the conviction under sections 482, 485 and 486 of the Indian Penal Code, and direct that the fine, if paid, be refunded. The property confiscated must be returned to the appellant. We may add that we agree with the contention of the appellant that this case ought never to have been brought in the Criminal Court. The dispute between the parties is one of a civil nature, and could have been much more satisfactorily dealt with by a Civil Court.

E. H. M.

Appeal allowed.

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