
(1900) 09 MAD CK 0008
In the Madras High Court

Ebrahim Currim

APPELLANT

Vs

Essa Abba Sait

RESPONDENT

Date of Decision : 18-09-1900

Acts Referred:

Citation : (1901) ILR (Mad) 163

Hon'ble Judges : Shephard, J

Bench : Single Bench

Judgement

Shephard, J.—The question I have to determine is whether the allegation made by the defendant that the stag trade-mark used on umbrellas

is the trade-mark of McIntosh Ferguson & Co., who carry on business in Glasgow, is relevant by way of defence to this suit. For the purpose of

the argument it must be taken that the stag mark was used by the Glasgow firm before it was used by the plaintiff in India and that it was never

used by that firm in this country before the plaintiff had begun to use it in his trade, and on this assumption it is contended that since the trade-mark

originally belonged to McIntosh and Ferguson it cannot be lawfully used or claimed by the plaintiff notwithstanding that the Scotch firm have never

used the mark in India, or imported umbrellas bearing it into this country. In my opinion this contention is not sound and the prior use in Scotland

would not justify the Scotch firm and the defendant in saying that the plaintiff's user of the trade mark is illegal or otherwise than an exclusive user.

The principle which underlies the law relating to trade-marks is that no man has a right to put off his goods for sale as the goods of a rival trader.

No man,"" says James, L.J., ""is entitled to represent his goods as being the goods of another man ; and no man is permitted to use any mark, sign

or symbol, device or other means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he

enables such purchaser to take a lie or to make a false representation to somebody else who is the ultimate customer." Singer Manufacturing

Company v. Long L.R. 18 Ch.D. 395. A man whose goods, associated with a certain trade-mark, have a reputation in the market is not for that

person entitled to prevent other traders from imitating his goods and selling them, but he is entitled to prevent other persons from attaching to such

goods his trademark in such a way as to deceive customers. Fraud on the defendant's part need not be proved, but no wrongful act has been

committed by the defendant unless it is shown that his conduct has been calculated to deceive the public into buying his goods as the goods of the

plaintiff. These considerations show in how qualified a sense a man can be said to have property in a trade-mark see particularly Mellish, L.J., in

Singer Manufacturing Company v. Wilson L.R. 2 Ch.D. 434 et seq. It is only in a peculiar sense that a man's right of property can be said to be

infringed when in order to establish the infringement he must prove the possibility of other persons being deceived. Yet it was mainly on the strength of

the theory that trade-mark is property that it was contended before me that prior ownership of a trade-mark in Scotland excluded the possibility of

ownership of the same symbol in India. The proposition seems to me to go a great deal beyond what is required for the protection of traders. It

assumes that two or more persons in England cannot lawfully use the same trade-mark, and that the Scotch firm could, if they come to Madras,

maintain an action against the plaintiff. The books show that the co-existence of identical marks in different parts of the country has not been

uncommon in England, and under the Statute there may be as many as three registered owners. No case was cited in support of the proposition

that the Scotch firm could maintain an action here against the plaintiff.

2. The case chiefly relied on was *Lavergne v. Hooper* ILR 8 Mad. 149. The point actually decided in that case was that the plaintiffs, whatever

right they may otherwise have had, had led the defendant to believe that his firm was to adopt the trade-mark in dispute; and that was the ground

on which the suit had been dismissed in the Court of First Instance. The question whether exclusive use of a trademark in one market gives an

exclusive right to use it in another market, though the person using it may not have employed it in such other market, was propounded and the

conclusion arrived at was that "the remedies which are conceded for the protection of trade-marks adopted in the home market are also extended

to trade-marks which have been originally adopted in foreign markets, and it is immaterial that goods bearing such marks are not sold in the home

market" The Collins Company cases *The Collins Co. v. Waiker* 7 W.R. 222 *The Collins Co. v. Brown* 3 K. & J. 428 and *The Collins Co. v.*

Cowen 3 K. & J. 423 are cited by way of authority. I do not think this statement can be treated as more than a dictum. Not only was the case

decided on the distinct ground already mentioned, but as a matter of fact the plaintiff had been trading in the Madras market in so far as he had

been supplying the defendant with the brandies bearing the Maltese Cross mark. In point of law the authorities cited do not support the proposition

which I am asked to affirm. In *The Collins Co. v. Brown* 3 K. & J. 428 the point taken on demurrer was that the plaintiffs were a foreign company

and therefore not entitled in England to any rights in respect of their trade-mark, and the demurrer was overruled. Nothing was or could be

decided as to the circumstance that the trade-mark was not used in England, because the bill alleges that articles bearing it had been sold to

persons in England. I can hardly believe that the learned Judges of this Court intended to hold on the authority of these cases that a man can

maintain an action for infringement of this trade-mark without proof that his goods have ever been brought into the market. In *re Riviere's Trade-*

mark L.R. 26 Ch. D. 43 relates to the same trade-mark. There the Madras firm, alleging that they had formerly been supplied by *Riviere & Co.*

with brandy bearing the Maltese Cross and had requested them to get it registered in England and in France, objected to the registration of *Riviere*

& Co. as owners of the Maltese Cross in connection with brandy, and because the former had never used the mark in England it was held on

demurrer by Pearson, J., that they were not persons "aggrieved" within the meaning of the Act. On appeal, it was held that the Madras firm might

possibly be "aggrieved," although they were not themselves entitled to register in respect of the mark. This case, so far from supporting the

defendant's position is like several others which were cited as authority for the proposition that "user," as understood by the Act, means user in

England. This is put most clearly by Starling, J., in Jackson & Co. v. Nappar L.R. 35 Ch.D. 2 where registration was refused in the case of

particular articles in respect of which user in England had not been proved and allowed as to others in respect of which there was proof although

there was a similar mark already on the register. As regards articles of the former class, as the justertii set up by the defendants failed the plaintiffs

obtained an injunction, and it does not appear to have been suggested that the use of the trade mark in connection with these articles in Germany

was any answer to the claim for an injunction. The circumstance that the industry of counsel was unable to find any English case directly supporting

this contention is in my opinion a strong argument against it, for it is inconceivable that cases similar to the present should not have occurred in

England or cases in which the foreign owner of a trade-mark used abroad complained of another person using the same mark in England. The

protection which the law affords to traders using a trade-mark in this country would be seriously diminished if immunity from action were secured

to rival traders who, having brought goods into the market with the same mark, were able to prove that in some other quarter of the globe some

other trader had been in the habit of using the mark for a period longer than that alleged by the plaintiff.

3. For these reasons I think the second issue must be struck out.

4. The third issue is for other reasons unnecessary since the question is sufficiently raised by the first issue.

5. The third issue is also struck out.

6. The defendants must pay the costs of the issue.