
(1927) 08 BOM CK 0012

In the Bombay High Court

Case No : Civil Reference No. 17 of 1926

Herbert Whitworth Ltd.

APPELLANT

Vs

Jamnadas Nemchand Mehta

RESPONDENT

Date of Decision : 16-08-1927

Acts Referred:

Citation : AIR 1928 Bom 227 : (1928) 30 BOMLR 514 : (1928) ILR (Bom) 228 : 110 Ind. Cas. 312

Hon'ble Judges : Crump, J; Amberson Marten, J

Bench : Division Bench

Judgement

Amberson Marten, Kt., C.J.—This is a passing-off case brought in the Aden Court. The trial Judge thought that the defendant's goods would not deceive the public into thinking they were the goods of the plaintiffs, and he dismissed the suit. The learned Resident on appeal has taken the opposite view, and referred the matter to us under the Aden Act.

2. We are not dealing here with a case of registered trade marks. What the plaintiff alleges in paragraph 3 of his amended plaint is that?

the plaintiff company has for a number of years imported and sold in Aden white shirtings which are designated to the public by a ticket bearing a mark being a Somali on horseback; that the goods are known in Aden, Somali Coast, and Red Sea Port markets as " Abu Kheyl, and that a sample of the said White Shirtings and mark is hereto annexed and marked " A." And white shirtings which are designated to the public by a ticket bearing a mark being a Somali girl. The goods are known in Aden, Somali Coast, and Red Sea Port markets as " Abu Sherifa". A sample of the said white shirtings and mark is hereto annexed and marked "C".

3. Then paragraph 4 runs :?

The aforesaid marks are well known to the public and to the trade as designating the goods of the plaintiff company. The plaintiff company is the owner of the said

marks.

4. Then in paragraph 5 they allege that?

On or about the first day of April 1924 the defendant imported into Aden white shirtings bearing marks made up to resemble the plaintiff company marks aforesaid, and is endeavouring to deceive the public by passing off white shirtings of the defendant as representing those sold by the plaintiff company.

5. Then they ask in effect for an injunction and damages.

6. Now the written statement of the defendant is extremely careful not to deny that the marks in question as pleaded by the plaintiff are the marks of the plaintiff company, and that their goods are known under those marks. What the defendant says is that the tickets on his goods differ in form and appearance from those on the plaintiffs' goods to such an extent that this fact alone is sufficient to distinguish the defendant's goods from those of the plaintiffs, he denies that he ever endeavoured to deceive the public by passing off white shirtings of his as representing those sold by the plaintiffs, and points out that his goods bear the numbers 663 and 2120 whereas the plaintiffs' bear the numbers 4444 and 3333. He, accordingly, asks that the plaintiffs may be put to strict proof that these tickets of the defendant resemble plaintiffs' and that they deceive the public or are likely to cause confusion in the trade.

7. As far as the evidence in the case goes, one has to remember that lawyers up to now have not been admitted in the Aden Court, and therefore the learned Judge has not had the advantage which an ordinary law Court possesses; that, however, will soon be remedied by the recent amending Act. But substantially the evidence seems to point to this, that the two classes of goods sold by the plaintiffs are known as "Abu Kheyl" as regards the picture of the horseman and as "Abu Sherifa" as regards the picture of the woman. The manager of Kempton and Company for the defendant himself says in cross-examination, "I have heard of Abu Kheyl and Abu Sherifa. Abu Kheyl refers to 4444 of Herbert Whitworth and Company and Abu Sherifa to 3333 of Herbert Whitworth and Company." Another witness of his says, "People would ask for Sherifa Herbert or Abu Kheyl Herbert.?"

8. There is clearly no evidence that any actual buyer was deceived into buying the defendant's goods when he intended to buy the plaintiffs'. It is also, I think, clear on the evidence that trade buyers, by which I mean persons experienced in this particular trade, would not be deceived by the similarity in marks or pictures. We, therefore, have to consider whether the uneducated retail buyer is likely to be deceived. In this connection it must be remembered that the average buyer is presumably illiterate, seeing that at any rate in India over ninety per cent, of the population are illiterate, and I see no reason to think that they are any better educated in Aden. We have also to bear in mind that it is extremely improbable, even if he were literate, that he would have any knowledge of English; therefore, names, on the goods would probably mean little or nothing to him I may refer,

for instance, to the more educated though small minority in India that have recently been given votes; even there there is so large a percentage of illiteracy that the names of candidates have to be designated by pictures of lions, elephants, and the like, so that the intelligent voter may vote for the right candidate. I have, therefore, no doubt, considering the substantial number of Indians in Aden, that buyers would be largely influenced by the pictures on the goods before them.

9. Taking, first, the picture of the horseman, what are the essential points in the two pictures? I should say they are a Somali man, a horse, and the colouring and general get up. So, too, in the picture of the lady, they are the Somali girl and the general get up. Now, it is quite true that there are differences in the pictures. If one takes the pictures of the two horsemen, the horse in the plaintiffs' picture is rather good-looking and is standing still; the other is more of the artist's variety, and is walking, and looks more highly spirited. The horsemen, too, are looking in different directions, or rather the horses are facing in different directions; the plaintiffs' faces towards the right, while the defendant's faces towards the left. But there is a striking similarity in the colouring, and in particular in the gold edging. I do not say that the gold edgings are identical; they are not. The plaintiffs' is wider than the defendant's, and is all gold except for a straight line; whereas the defendant's has a little variegated pattern on But the labels are very nearly of the same size, and certainly very nearly of the same colouring.

10. Under these circumstances, seeing that the plaintiffs' goods have been imported with this mark, and have been known by this description for very many years, what is the explanation of how the defendant also came to hit upon a Somali horseman and a horse, and, strange to say, the same colour? So far as the defendant himself is concerned, most unfortunately he did not go into the box, and, therefore, we have no explanation from him, Counsel suggests that in Aden it is not considered quite necessary for the party himself to go into the box. However that may be, the Court will draw inferences in the ordinary way in the absence of any explanation from the person principally concerned as to how, if he is an honest man, he came to adopt or use these particular marks. There is, I think, one most important circumstance that arises, not so much with the horseman as with the Somali girl. It was stated in evidence by one of the defendant's witnesses that there had previously been on the market goods bearing the picture of the Somali girl, and that picture we have in evidence. Curiously enough, so far as the girl is concerned, the defendant's label is an exact copy. But when we come to the colouring, there is a very marked and striking difference. In the older mark (I am referring to Exhibit D-5-1) the girl is standing on a back-ground which has most of the colours of the rainbow. Nobody can say that, as far as the general colouring is concerned, it in any way resembles the plaintiffs' Somali girl. Why then was it that the defendant, when he proceeded to copy this Somali girl in Exhibit D, changed the background of the colouring and adopted instead a colouring closely resembling that used by

plaintiffs? In fact, so far as the edging is concerned, he has here come nearer to an imitation of the plaintiffs' picture than he has in the case of the horseman. There is here a full gold edge, and the other differences in the edging, though they do exist, are very slight. Speaking for myself, I have no doubt that this was done deliberately and with the intention of catching for the defendant's goods the trade which legitimately belonged to the plaintiffs.

11. How then do the authorities on the point stand? In *Johnston v. Orr Ewing* (1882) 7 App. Cas. 219, we have a case where the plaintiffs had been exporting to Bombay and other oriental markets goods having the device of two elephants on a green and gold ticket, and in the centre a crown. The defendants there adopted a somewhat similar ticket so far as the colouring is concerned, and they put a Ganpati in the middle in the place of the crown, and also inserted two elephants as support. There were minor differences between their elephants and the plaintiffs' elephants, that is to say, the trunks were turned down in the one case and up in the other, and so on. In the plaintiffs' case there were no riders; in the defendant's there were, and howdahs along with them. Notwithstanding that, the House of Lords came to the conclusion that the defendants' goods were intended to resemble the plaintiffs' goods, and Lord Blackburn says (p. 230) :?

Why then did they come so near the plaintiffs' ticket? why use the two elephants at all, unless in the hope that incautious purchasers might mistake one ticket for the other? The defendants were both called as witnesses and had every opportunity given them to explain this, and neither could give any answer.

12. In the present case the defendant has not even gone into the box. So far as the exact legal point is concerned the headnote to that case runs:?

No trader has a right to use a trade-mark so nearly resembling that of another trader as to be calculated to mislead incautious purchasers, The use of such a trademark may be restrained by injunction, although no purchaser has actually been misled; for the very life of a trade-mark depends upon the promptitude with which it is vindicated.

13. Then in *Anglo-Swiss Condensed Milk Co. v. Metcalf*: In *re Metcalf's Trade-mark* (1886) 31 Ch. D. 454, the case before Mr. Justice Kay was one where the defendant called the company the Anglo-Danish Condensed Milk Company, and put on his tins a milk maid or dairy-maid closely resembling that on the plaintiffs' tins, and sold his goods in tins of practically the same size, shape, and form as the plaintiffs'. The plaintiff's proved that their goods were known as "milkmaid" or "dairy" brand, and on the facts of that case the learned Judge had no doubt that what the defendant had done was done with the direct intention of committing a fraud upon the plaintiffs so as to enable him to acquire some of their custom and to pass off his goods as and for those of the plaintiffs.

14. Then other cases were referred to. In *Boord & Son v. Thorn and Cameron Ltd.*: *Thorn and Cameron Ltd. v. Board & Sons* (1907) 24 R.P.C. 697 there were goods sold known as Cat and Barrel and Old Tom gin, the main portion of the

label being a cat and a barrel and the name, Old Tom. There, although the actual labels when seen together were quite different, the main features, viz., the cat, the barrel, and the description "Old Tom", were there in both cases. Then in *Wilkinson v. Griffith Bros, and Co.* (1891) 8 R.P.C. 370a decision of Mr. Justice Romer, there was a polish known under the name of Lal Mohur or Lal Chap, and though very different labels were used, still there were in the defendants' goods two red medals which were distinctive features of the goods in both cases, and, accordingly, an injunction was granted. So, too, in *Taylor v. Virasami* ILR (1882) Mad. 108, Mr. Justice Kernan held that a plaintiff who owned shirting known as "Talwar" shirting and had a certain descriptive mark in which swords were distinctive features was entitled to restrain the defendant from selling shirting with a label bearing swords closely resembling the plaintiffs."

15. The defendant cited to us *Payton & Co. v. Snelling, Lampard & Co.* [1901] A.C. 308; but there the plaintiffs' goods were known as Royal Coffee and the defendants' goods were known as Flag Coffee, and, as pointed out by Lord Davey at p. 312, so far as the colours were concerned, there could not be the slightest ground for saying that the defendants had in any way imitated the colours of the plaintiffs. There the Court held that as the goods were known under two distinctive names, and as there was no similarity in the get up, it could not be said that the public would be deceived into buying the defendants' goods in the place of the plaintiffs".

16. The observations of Lord Macnaghten in that case, which have been referred to by my brother Crump, may here be cited as to the relevance of witnesses who come forward and say that they think that the marks are so similar that people would be deceived. Lord Macnaghten says (p. 311):?

One word with regard to the evidence I should like to say. I think, as I have said before, that a great deal of the evidence is absolutely irrelevant, and I do not myself altogether approve of the way in which the questions were put to the witnesses. They were put in the form of leading questions, and the witnesses were asked whether a person going into a shop as a customer would be likely to be deceived, and they said they thought he would. But that is not a matter for the witness; it is for the judge. The judge, looking at the exhibits before him and also paying due attention to the evidence adduced, must not surrender his own independent judgment to any witness.

17. Therefore, so far as the case as presented to us is concerned, we have to make up our minds as to whether on the facts before us we think it probable that purchasers would be deceived by the similarity of the marks and general get up of the two sets of goods. In our judgment there is a distinct likelihood that they would be deceived, and, speaking for myself. I would go further and would hold that that was the intention of the defendant in adopting the marks and pictures which he in fact did. Under those circumstances it follows that an injunction has to be granted against him.

18. The next question is to what extent it should apply. The plaintiffs put before us a claim that they were entitled to the exclusive right in Aden to any mark as regards piece goods bearing the picture of a Somali horseman and horse or of a Somali girl. As I read their plaint, that claim is not pleaded there. And having regard to the evidence that there had already, in years past been some sales in Aden of other goods with the picture of a Somali horseman or a Somali girl, I do not think it would be right for us to grant the extended form of injunction. We were asked to apply *Seixo v. Provezende* (1865) L.R. 1 Ch. 192 the headnote of which runs ;?

No trader can adopt a trade mark so resembling that of another trader, that persona purchasing with ordinary caution are likely to be misled, though they would not be misled if they saw the two trade marks side by side. Nor can a trader, even with some claim to the mark or name, adopt a trade mark which will cause his goods to bear the same name in the market as those of a rival trader.

19. There Lord Cranworth points out that the correct course is not merely to look at the two marks side by side, but to consider what would be the effect on the mind of the ordinary purchaser coming to purchase the same goods some little time after he had purchased similar goods on the market before. And it is also pointed out that there may be cases where persons may be entitled absolutely to the use of a particular name in the trade that nobody else is entitled to use. That also is dealt with in the case I have already cited of *Johnston v. Orr Ewing*, where it will be noticed at pp. 233 and 234 that the House of Lords expressly declined to frame an injunction in the wider form in which it is now asked for here, viz., "from employing any mark or words which would be calculated to cause any Turkey red yarn not dyed by the plaintiffs to be known in Bombay as Bhe hathi or Do hathi yarn," and, accordingly, they omitted those words from the injunction asked for by the plaintiffs. In the present case we are asked to grant an injunction in the terms framed by the House of Lords, but adding the very words which the House of Lords on the evidence before them refused to insert. In our opinion the proper (I) form of order in the present case, having regard to the evidence as to there having been some user in the past as regards a Somali horseman and Somali girl, would be an injunction as framed by the House of Lords. Consequently, the injunction will run in that form. Then there must be an order for the delivery up of the infringing articles, and for an inquiry as to the damages suffered by the plaintiffs.

20. We will, accordingly, report to the learned Resident that the appeal from the trial Judge ought to be allowed and his order set aside, and that an order should be passed to the effect I have already mentioned; and we would direct the respondent to pay the costs of the reference to us. The proper order would be that the defendant pay the costs of the suit throughout including the costs of this appeal up to date, Further directions and further costs will be reserved to be dealt with by the Aden Court.

21. It should be made clear in the order that the expression "infringing articles"

applies only to so much of each piece as bears the mark or picture complained of. This would involve, I gather, cutting about a yard at each end. It does not apply to the intervening thirty-eight yards or thereabouts of each piece, which has no mark on it.