

Fleming and anr. Vs. Ralli and anr.

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Court : Kolkata

Decided On : Mar-12-1878

Judge : Richard Garth, C.J. and ;Markby, J.

Appellant : Fleming and anr.

Respondent : Ralli and anr.

Judgement :

Richard Garth, C.J.

1. I am of opinion that this injunction was properly granted; but in order to make its meaning more clear, I think the form of it should be slightly modified.
2. There is no doubt, I conceive, as to the law of the case; and there is but little difference between the parties as to the actual facts. The difficulty, if there be any, is to ascertain the fair and reasonable inference which we ought to draw from those facts. I propose dealing with the matter at this stage as shortly as I can, in order to avoid prejudicing the defendants' case at the hearing of the cause, when the Court may probably be supplied with fuller materials than it has at present for ascertaining the truth.
3. For the present purpose it appears to me sufficiently established that the plaintiffs, Messrs. Nicol, Fleming, & Co. have, for several years past, been selling a particular cloth in the market, which has obtained celebrity there, and become readily saleable; that this cloth is known to the public by certain marks which are

described conspicuously upon it, and especially by the number '2008,' which is printed upon each piece in largo figures, and in a particular position and combination; and that the defendants, Messrs. Ralli and Mavrojani, having imported similar cloth obtained from the same manufactory, have had marks impressed upon their cloth in a combination generally resembling that used by the plaintiffs, and especially introducing in a similar position and in figures of the same size and character the number '2008,' avowedly for the purpose of giving their cloth a saleable quality in the market, which it would not otherwise possess. Thus far there is no difference between the parties as to the facts.

4. The defendants say that the plaintiffs are entitled to no monopoly of the sale of cloth in question; that they are not manufacturers of it; and that they, the defendants, have as much right to obtain it from the manufacturers, and sell any quantity of it in the market as the plaintiff's have. This is, of course, perfectly true. But the question is, whether, for the purpose of giving the cloth a saleable quality, the defendants have a right to use these marks which undoubtedly are in some essential particulars an imitation of marks which have hitherto been used exclusively by the plaintiff's? The defendants say that they have not adopted either the plaintiffs' name or their trade-mark proper, which is a turtle; that they describe on the cloth their own name and trademark, which is a rose. They admit that they use the number '39' in the same configuration, and for the same purpose as the plaintiffs use it, viz., to denote that each piece of cloth is 39 yards in length; and they claim a right to use the number '2008' as merely conveying to the public that the cloth which they sell is of the same quality as the plaintiffs'.

5. The plaintiff's, on the other hand, say, that this combination of marks, although differing from theirs in some respects, is undoubtedly a close imitation of it; and that by using this combination, and more especially by the use of the number '2008,' which is admitted to be the main descriptive feature which renders the cloth saleable, the defendants would lead the public to believe that the goods which they are selling are goods imported or sold by the plaintiffs' house. This is the real pith of the case; and here it is that the Court is called upon to draw a fair and reasonable inference from the facts. If the defendants' combination is so different from the plaintiffs, that the public could not reasonably be deceived by the use of

it, or if the number '2008' was merely a manufacturer's number, or was used generally by the trade to designate a particular kind or quality of cloth, no doubt the defendants would have as much right to use either the combination or the number as the plaintiffs.

6. But, on the other hand, if the object of the defendants in using this number and in imitating the plaintiffs' combination is, or if the natural consequence of their doing so would be, to induce the public to believe that the goods which they sell were imported by, or came from the plaintiffs' house, then I consider that, in point of law, the defendants would not be justified in thus deceiving the public to the plaintiffs' prejudice.

7. Now, in determining this question, I think we ought to consider in the first place, how it was that the defendants came to use these marks at all; and in the next place, who and what the buyers of those goods are, and how and by what considerations they are likely to be influenced.

8. First, then, the evidence in the case explains very clearly to my mind how it was that the defendants came to use these marks. From the 7th paragraph of the affidavit of Mr. Westerhout, the plaintiffs' assistant, and the affidavit of Bholanath Khettry, the broker, which he made on behalf of the defendants, it appears that, in the years 1875 and 1876, Bholanath was employed by the plaintiffs to sell this cloth for their house. He well knew the estimation in which it was held in the market; he knew that it was saleable only by marks used by the plaintiff's; and when he left the plaintiff's, and began to act as broker to the defendants, he was asked in the market for these same goods which he had been selling previously for the plaintiffs and as their goods; and he then advised the defendants to buy similar cloth from the manufacturers, and to have it marked in their own way. It is clear to me that it was through this man's advice, though he does not actually say so, that the defendants had the number '2008' printed on their goods and that their combination of symbols was made in such a form as to imitate that of the plaintiffs'.

9. It must here be borne in mind, and it is, in my opinion, a most material feature in the case, that the number '2008' was a symbol used exclusively by the plaintiffs

and impressed, only upon goods which came from their home. He was not a manufacturer's number: it was a symbol, the use and meaning of which was not known to the defendants, and is not now known to the Court. It was known to the plaintiffs only. The defendants chose to say that they understood it to notify the quality of the cloth, and they say this because other cloths of different qualities sold by the plaintiffs are marked '2006' and '2007': but this is a mere conjecture on their part; and they do not profess to understand, nor can they in fact know, the true origin or meaning of that symbol. If they had used the words,--'1st quality' or '2nd quality', or such an expression as 'superior' or 'superfine' or 'super-durable,' they would have used terms which are intelligible to all the world, and the use of which could not be calculated to deceive. But the number '2008' is a peculiar symbol which, like a 'lion' or a 'tree' or a 'flower,' would convey a particular meaning to the plaintiffs themselves, but to no one else, and which could only have been used by the defendants, because it had been used, by the plaintiffs in the sale of this cloth. Now then, let us see, secondly, who were the buyers of these goods in the market, and what considerations influenced, or were likely to influence, them in making their purchases? The buyers and consumers of this class of goods would be, for the most part, the native public people who, as a rule, cannot read or write English; who would scarcely distinguish the name of 'Nicol, Fleming & Co.' from that of 'Ralli and Mavrojani,' and who certainly could not understand, even if they could read the word 'trade-mark.' They might possibly, if they examined the print carefully, distinguish between a rose and turtle; but what they would naturally most be guided by is the general appearance of the combination described on the cloth; and it is admitted, according to the evidence on both sides, that the most distinctive mark in that combination was the conspicuous number 2008 by which name 'do hazar at,' the cloth itself was known in the market.

10. From these considerations it appears to me that the fair and almost necessary inference to be drawn is this: that as the plaintiffs, for a period of five years, had been the only persons selling this cloth in the market by these distinctive marks, and as, during that time, the cloth had obtained peculiar value and celebrity in the eyes of the public, who had learnt to place faith in the goods so marked and sold by the plaintiffs, the use of these marks upon similar cloth by the defendants would

be calculated to deceive the public into the belief that the goods which they were buying were the goods which they had bought for years before imported and sold by the plaintiffs; or, in other words, would naturally lead them to suppose that they were buying goods which came from the plaintiff's house.

11. In coming to this conclusion I do not think it necessary in this particular case to go narrowly into the question, whether the whole, or any, and if so what, particular part of the plaintiff's combination is to be considered as their 'trade-mark proper,' I think that, considering who and what the buyers of these goods are, they would understand very little of what was a 'trade mark proper.' I only say that if the imitation of the plaintiffs' marks generally, or of the use of the number '2008' in particular, would be calculated to deceive or mislead the public, the defendants ought to be restrained from such use or imitation.

12. It was urged upon us in argument by the defendants' counsel, that, by confirming the judgment of the Court below, we should be imputing direct fraud to a firm of respectable merchants, and exposing them to obloquy and odium in the commercial world, before the cause itself had been finally determined; and we were, therefore, much pressed to dissolve the injunction, and merely to require the defendants to keep an account of their sales until the hearing. But I confess it seems to me that, in using this argument, the learned Counsel have done their clients an injustice. I have no reason to suppose that, in using those marks, the defendants knew that they were committing a fraud, or doing the plaintiff's any actionable wrong. I dare say these gentlemen may have carefully considered,--nay, I think it not impossible that they may have taken advice,--as to how far they might use those marks without infringing in any way upon the rights of other people. But they have done what many honest and good men have, under similar circumstances, done before them,--they have, made a mistake without any evil intention; and this Court is bound to prevent them until the rights of the parties have been finally ascertained at the hearing from repeating it.

13. In this particular case I do not think that their keeping an account of sales would be a sufficient protection to the plaintiffs, because if the defendants were allowed to use those marks in the market for several months in order to sell their

cloth, they would become as well known in the market as importers and sellers of the cloth as the plaintiff's; and so the very mischief which the injunction is intended to guard against would have been effected.

14. I think, therefore, that this appeal should be dismissed, and with costs on scale 2; but that the form of the injunction should be varied thus:

Order, that the defendants be restrained from selling any cloth impressed with the combination of marks described in exhibit D, annexed to the affidavit of Alexander Westerhout, or any other combination resembling that used by the plaintiff's, and especially from using the number '2008' in any such combination.

Mapkby, J.

15. In this case I have had some doubt whether it is desirable to express my views at length, but upon the whole I have come to the conclusion that I ought to do so.

16. The plaintiffs and defendants are both merchants in Calcutta, and both are in the habit of importing largely goods known by the name of grey shirtings from Manchester, which they sell chiefly to native dealers in the bazar. These grey shirtings are delivered by the manufacturers to the correspondents of the parties at Manchester unmarked, and the outside fold of each piece is there marked by the correspondents of the firms here. There has been for some time a general similarity between the marks in use by the plaintiff's and those in use by the defendants. The general character of the marks in use by both the firms is as follows: at the top is a green paper ticket pasted on the cloth with a device thereon, and the name of the Manchester firm in English, and two or three native languages, well-known in the bazar; beneath this is a device similar to the device on the ticket impressed by a stamp upon the cloth itself; beneath this again the name of the Manchester firm in large English letters (which, in the case of the defendants, is the same as the name of their firm here); lower down the figures 39, being the number of yards in each piece, and lowest of all a number which generally signifies the quality of the cloth. About five years ago the plaintiffs began to sell grey shirtings, each piece of which was marked at the bottom with the number 2008. Sometimes in the year 1876 the defendants commenced selling

grey shirtings bearing the same number. The plaintiffs thereupon complained that the defendants were infringing their trade-mark, and required them to desist. The defendants signified their willingness to make some alterations in the marking of their cloth, but insisted on retaining the number '2008.' The plaintiffs were not satisfied with this, and the present suit was accordingly brought. When the plaint was filed, the plaintiffs applied for, and obtained an interlocutory injunction, restraining the defendants from using their trade-mark, and it is against the order granting this injunction that the present appeal is brought.

17. I am not aware of any previous case relating to trade-marks as used by the traders who are importers only; but I see no reason why there should not be such a trade-mark. If the law declares, as it clearly does, that no man has a right to put off his goods as the goods of a rival manufacturer, it seems to me to follow, that no man has a right to put off his goods as the goods of a rival importer. The confidence reposed in the skill, care, and honesty of a particular firm may give a special value to goods imported by them. The question is, did the defendants put off goods imported by themselves as goods imported by the plaintiff a?

18. There is no question here as to the quality of the goods sold by the defendants under this number, being the same in quality as the goods sold by the plaintiff's under that number. Nor is there any question of the right of the defendants to sell goods of this particular quality, which may be bought at Manchester by any one who chooses to pay for them.

19. The plaintiffs claim the whole of that which is impressed upon the outside of each piece of cloth as their trade-mark. How far they can do this I shall have to consider in dealing with another part of the case. Conceding for a moment that it would be possible for the plaintiff's to make out this claim, it seems to me to be clear upon the evidence that the only infringement of which they can complain is the use of the number '2008.' They have themselves produced a piece of cloth, with respect to which one of their own witnesses makes the following statement: 'That I am informed, and verily believe, that, up to a very recent date, the defendants have been selling similar cloth, but with a different number, namely '177' instead of the number '2008' now adopted by them, the character of the

figures being in themselves dissimilar; and that the words 'Ralli and Mavrojani' were then printed in a different style of lettering to what they have now adopted. A piece of cloth bearing the above-mentioned number '177' and sold by the defendants before they imitated the plaintiffs' trade-mark an hereinbefore mentioned, is Hereunto annexed and marked with the letter B. (see p. 10 of Mr. Westerhout's affidavit). If the piece of cloth here referred to be looked at, and the mark on it compared with that now in use by the plaintiffs, it will be seen that this statement really reduces this infringement to the substitution of the '2008' for No. 177.

20. The meaning which the plaintiff's attach to the figures '2008' has not been disclosed by them, but it is clear to me from these affidavits that, whatever meaning the plaintiff's may attach to these figures, they are treated by the public as a quality mark--whether as a quality mark of importation, or as a quality mark of manufacture only, I shall consider hereafter. It is also clear that considerable value is attached to this mark as a mark of quality by buyers of this description of cloth. It is, moreover, not shown that any other firm in Calcutta imports cloth bearing this number except the plaintiffs, and (recently) the defendants; but the plaintiffs themselves import grey shirtings of a slightly different description bearing the Nos. 2007 and 2009.

21. As I understand the law upon this subject, no trader can complain against a rival trader in regard to any announcement he makes concerning the goods which he sells, so long as no statement is made which is untrue, or calculated to mislead. But besides making use of ordinary language and their own names, in order to announce to the public what they wish to make known with respect to their goods, traders are in the habit of resorting to a variety of devices in order to catch the eye of the public, and to represent to them in a striking manner what they wish to announce. Sometimes they wrap their goods in a fanciful cover, sometimes they impress upon their goods a fanciful name, at other times a fanciful plant or animal; and when a trader specially selects and appropriates to himself for the purpose of distinguishing his goods a device of this kind, that device becomes his trade-mark proper, and no one else is allowed to use it. But if, without any such special selection and appropriation, the goods of the trader do in fact happen to bear

some particular mark, and this mark has come to be associated by the public with this trader's name, so that all goods bearing that mark are supposed to come from him, then also the law will not allow any person to use a mark of this latter description any more than it will allow him to use a rival trader's trade-mark proper, and for this reason, because in either case there is made, or there is assumed to be made, a representation to the public which is false, namely, that the goods which are the goods of one trader are the goods of another. But this distinction has been drawn between these two cases. If it be shown that a trader has infringed a rival trader's trade-mark proper,--that is to say, the mark which another trader has specially selected and appropriated for the purpose of distinguishing his goods,--the Court will, without further evidence, at once interfere, taking it for granted that such a proceeding is calculated to deceive the public; whereas, if the mark be one which has not been specially selected and appropriated by the trader for this purpose, evidence must be given to show that the mark was so understood by the public as to make it clear that the proceeding had either deceived, or was at least calculated to deceive, the public. Marks of both these kinds are usually called trade-marks, and the distinction between the two cases is not one of principle, but it is one which is convenient when examining the evidence by which it is sought to prove the infringement.

22. Now dealing with the question whether the figures '2008' were part of the plaintiffs' trade-mark proper, I think upon this evidence it appears that they were not. The plaintiff's themselves have, as I consider, told the public with sufficient accuracy what their trade-mark is, to enable us to say with certainty that these figures were no part of that device, which they themselves had specially selected and appropriated for the purpose of distinguishing their own goods from those of other traders.

24. It is, as is well known, a very common custom amongst traders, when they adopt a particular device in order to distinguish their goods, to announce to the world that they have done so by attaching to the impression of this device upon their goods the word 'trade-mark.' This is a notice to the public of what their trade-mark proper consists, and to other traders not to use it. Such a notice greatly assists the trader, who has adopted the device in the appropriation of it to himself.

But a trader who gives such a notice must, I think, he understood to confine his trade-mark proper to what is reasonably covered by the words. Now it appears that the plaintiffs have, in conformity with this custom, made an announcement to the world of what their trade-mark consists. Upon the piece of cloth produced by thorn and marked according to their present fashion, the word 'trade-mark' appears twice--once upon the stamp impressed upon the green paper pasted on to the cloth, and once upon the stamp impressed upon the cloth itself. In both cases the words are attached to the figure of a turtle in the centre of a star. I think it is quite clear, therefore, that what the plaintiffs have represented to the world as the device by which they designate their goods is this turtle in a star. What I think is the reasonable construction of the plaintiffs' own announcement, at any rate, I cannot, by any construction of these words, extend so as to cover the figures '2008'.

25. The figures '2008' therefore not being any part of the plaintiffs' trade-mark proper, we have then to consider whether these figures have been so associated with the plaintiffs' name as to indicate, in the understanding of the public, that goods of this description bearing this number came from their firm, and whether the use of those figures by the defendants is calculated to deceive buyers of ordinary intelligence. This is the most favourable way of putting the question for the plaintiffs. I am not sure that it is not a little too favourable; but let that pass. Now, if I had to decide this case finally upon the evidence now before me, I feel bound to say that I can see no evidence that these figures have been so associated with the plaintiffs' name. It may perhaps be known in the bazar that the plaintiffs are in the habit of importing and selling this particular kind of grey shirtings. There is also ample evidence that they have preference for this particular kind of grey shirtings, but there is, as far as I can see, no evidence that they like them any the better because the plaintiffs import them, or that the figures '2008' are understood by any one to signify that the plaintiffs had in fact imported them. It seems to me that all the evidence in the case, particularly that of the plaintiffs' own native witnesses, goes to show that these figures are understood by buyers to indicate the quality of the manufacture, and that only, and that they are not supposed to have anything whatever to do with the importation. As to any deception of the public, of course, no one acquainted with all that is marked upon

these goods by the defendants could ever suppose that the cloth sold by the defendants was imported by the plaintiffs. The name of the defendants' firm is stamped upon the goods several times over in a variety of languages, European and oriental; and all the native brokers, who have given evidence in the case, state themselves to be acquainted with the whole of the marks. They could not, therefore, have been deceived as to who were the importers, and they do not pretend to say that they were so. But it is said that these goods are sold by the brokers to persons of less intelligence who would not read or would not understand the whole of the marks, and whose eyes would be caught by the figures '2008' only. This is quite reasonable, and may be assumed; still what do the witnesses say; they say that native purchasers buy the cloth by the number '2008', and not from any examination of the nature or quality of the cloth. That, however, as I understand the law, is not sufficient. The plaintiffs, I will assume, first adopted the combination of figures '2008', and attached to them some meaning, which is a secret. The public have attached to these words the same or another meaning, namely, that they indicate that the cloth so marked is of a particular quality. Where is the false representation, which is an essential element of the plaintiffs' case, in the defendants' use of these figures? If the meaning to the public of these figures, when expressed in full, is no more than this, it is hereby represented to the public that this piece of cloth is of a certain quality,' then every trader in Calcutta has a right to make this representation, and make it by any words or symbols that he likes. There can be no exclusive right to make such a representation, or to make it in any particular manner. If, indeed, the meaning of the figures as understood by the public is this--' it is hereby represented that these goods were imported by Messrs. Nicol, Fleming, & Co.' that would be quite another matter. But that is what I do not see anywhere stated in the evidence.

26. If, therefore, this suit were now before me for final determination, I should feel compelled to say that, in my opinion, the plaintiffs had not made out even a prima facie case. But it will be a manifest inconvenience if, upon this interlocutory application, there should be a difference of opinion, giving the parties a right to a second appeal before the suit is heard. That is clearly not desirable. I think, therefore, that, upon this interlocutory application, I am justified in yielding my opinion to that of the Chief Justice and Mr. Justice Macpherson, and not

expressing any formal dissent from the judgment of the Chief Justice, which substantially dismisses the appeal.

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