

Sen and Pundit Vs. E.S. Oakes

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Court : Kolkata

Decided On : Jun-18-1919

Reported in : 55Ind.Cas.560

Judge : Lancelot Sanderson, C.J., ;John Woodroffe and ;Asutosh Chaudhuri, JJ.

Appellant : Sen and Pundit

Respondent : E.S. Oakes

Judgement :

Sanderson, C. J.

1. This is an appeal by the defendants from the judgment of Greaves, J., whereby he granted an injunction against the defendants restraining them and their servants and agents from passing off or attempting to pass off or in any manner representing any bicycles not imported by the plaintiff as and for bicycles imported by the plaintiff and as and for Warrior Bicycles and in particular from selling, offering for sale or causing, procuring or enabling to be sold any bicycles not imported by the plaintiff with or bearing the stamp or device of Warrior in the plaint in this suit mentioned or any other device resembling or colourably resembling the plaintiff's said stamp or device or under the name of Warrior Cycles and from fixing to any bicycles or otherwise employing or using in connection therewith any such stamp or device or any such name or any equivalent thereof in any manner whatsoever.' And it was further ordered that the defendants should furnish to the

plaintiff on oath a list of all bicycles in their possession or under their control with the Warrior Transfer attached.

2. There was a further direction as to the taking of an account of all bicycles sold by the defendant with the Warrior Transfer attached thereto.

3. The injunction restrains the defendants not only from selling bicycles, not imported by the plaintiff, with or bearing the stamps or device of Warrior referred to in the plaint, but also from selling such bicycles under the name of Warrior Bicycles.

4. The claim of the plaintiff mainly was with regard to the above-mentioned device, or transfer' as it has been called.

5. This appears from paragraph 5 and prayers (b) and (d) of the plaint. Paragraph 5 is as follows:

The stamping of bicycles with the said transfer indicates to dealers and purchasers that bicycles so stamped are bicycles imported and sold by one particular merchant, namely, the plaintiff, and purchasers when buying bicycles so stamped expect to obtain bicycles imported and sold by one particular merchant, namely, the plaintiff, and bicycles so stamped are known in the Indian market as the Warrior Cycles.

6. And prayer (b) is:

For an account and payment of the profits made by the defendant firm in selling or disposing of any bicycles not of the plaintiff's importation sold or disposed of under the device, stamp or name aforesaid.

7. And prayer (d) is:

For the delivering up by the defendant firm upon oath to the plaintiff of all bicycles stamped or marked with the device or stamp aforesaid and for destruction and cancellation thereof,' 6. The evidence of the plaintiff also shows this. The plaintiff was asked the following question:

8. Q, Whenever you have put forward any claim, your claim has been the use of the Warrior Transfer ?

9. A, Yes, that is all--we are claiming the sole right to the use of the Wairior Transfer on cycles.

10. Messrs. Morgan's letter of the 24 th July 1914 to the defendant in the 2ad paragraph makes it clear that this was what the plaintiff was claiming and the learned Counsel in cross examining the defendant San, after referring to this letter, put it to the witness that the letter implied that it was the transfer which the plaintiff was after, to which the witness agreed.

11. I think, therefore, it maybe taken that the plaintiff's main claim was to, have his alleged right to the exclusive user of the Warrior Transfer protected. Such claim was based upon notoriety and long user, it being alleged that the Warrior Transfer stamped on bicycles indicated to dealers and purchasers that bicycles so stamped were bicycles imported and sold by one purticular merchant, viz., the plaintiff, and the bicycles so stamped were known as the Warrior Cycles.

12. The first issue was:

Whether the stamping of bicycle? with the Warrior Transfer indicated to dealers and purchasers that bicycles so stamped are imported and sold by the plaintiff only.

13. And the learned Judge's finding was as follows:

For the reasons already stated I think that the plaintiff acquired a reputation in the market by the import of bicycles of the Warrior specification with Warrior Transfers, and I think that the word Warrior bad become associated in the market with the plaintiff firm, so that it indicated to dealers generally that bicycles bearing the word Warrior were imported by the plaintiff only.

I find on the evidence that this repute existed generally in Calcutta, but I am not able to say on the evidence how far it extended outside Calcutta.

14. It was argued by the learned Counsel on behalf of the defendants that the evidence. did not establish the plaintiff's contention that the stamping of bicycles with the Warrior Transfer indicated to dealers and purchasers in India that bicycles so stamped were imported and sold by the plaintiff only.

15. It appears that in May 1909 a Company, called Veloce Ltd., carrying on business at Birmingham and manufacturing, Veloce Cycles, made arrangements with S. Oakes & Co. of Calcutta, which is the name of the plaintiff's firm to act as agents for the sale of Veloce Cycles. This agency came to an end on or about the 27th September 1911, when Veloce Ltd. placed the sole agency for the Veloce Cycles in the hands of a firm called Levetus and Co. Levetus took up the sale and export of cheap cycles, lists were prepared with respect to the Warrior Cycles upon which the name Levetus & Co. appeared as 'sole exporters' and the defendants 'Sen & Pandit' as import agents. The learned Judge has found. that these were not circulated in India until September or October 1912, It may here be mentioned that on October 18th 1911, after the agency of the plaintiff with regard to the Veloce Cycles had come to an end, Veloce Limited registered in England the word 'Warrior' as a trade mark in connection with cycles.

16. It further appears that in 1910, while the above agency of S. Oakes & Co. still existed, a question arose as to whether Veloce Limited, whose managing Director was Mr John Taylor, could supply Stanley Oakes & Co. with cheap cycles for sale to them, and by them in India

17. Correspondence ensued between Stanley Oakes & Sons of London and Veloce Limited as to the specification, and on the 15th March 1910 Veloce Limited sent the specification upon which they were prepared to make the cheaper cycle.

18. In October 1910 Mr. Darnell, who was connected with the plaintiff's firm in Calcutta in some capacity, was in Birmingham and representing the plaintiff.

19. Discussions took place between Mr. Taylor and Mr. Darnell as to the cheap cycles and as to the so called 'nondescript' transfer which should be put upon them, and on the 10th November 1910 there is a letter from Mr. Taylor to Mr. Darnell:

I am in receipt of yours and note you now suggest the Challenge Cycle Co., Birmingham. I regret this name is impossible as there already exist a Challenge Cycle Co. in Birmingham run by the new Hudson Cycle Co., and another well-known in this country run by O'Brien, so we shall have to drop this. I see no objection to the 'Centurion,' specially as it is now pretty certain that the Centurion Cycle Co. will go into liquidation. It is of course possible that this company will be resurrected, but nevertheless I see no objection to the word 'Centurion' and enclose herewith a rough sketch partly in colours of the suggested transfer which please return. I know it is very difficult to find a suitable name without treading on some one's toes. I can suggest 'The Marvel' or 'The Warrior' but am not sure whether even these names are not already in use; however, as the machine is for India, I do not think it matters much. I note your remarks re accessories but have not had time to look through Lowman's list.

Certainly I shall make the cheap cycles, but I am determined to do these in another place altogether in order to keep the two qualities quite separate, I have already arranged for a small place which is not very far away, and I hope in course of a week or two shall be in working order there. I shall be in London on the 21st instant and shall probably stay at the Bedford Hotel but will advise you, at any rate. I could meet you by appointment at the Olympic Show any time from Monday till Thursday. Perhaps it may be as well for you to make an appointment by some well known stand.

20. It, therefore, appears that the Veloce Limited were going to manufacture the cheap cycles; but not under the name of Veloce Limited. Mr. Darnell suggested the Challenge Cycle Co., Birmingham; this, however, could not be adopted as there was already a Challenge Cycle Co, in Birmingham run by the new Hudson Company.

21. Mr. Taylor suggested the name 'Warrior,' which was subsequently adopted. This according to the evidence was the first time the word 'Warrior' had been mentioned in connection with the cheap cycles.

22. Mr. Taylor decided to make the cheap Warrior Cycles in another place altogether and under the name of the Warrior Cycle Co., in order to keep the two

qualities quite separate: he had at that time apparently arranged for a small place not far away, which he hoped would be in working order in a week or two. This place was No. 5, Fleet Street, Birmingham.

23. According to Mr. Taylor's evidence in this case there was no name attached to the premises, although in an affidavit sworn in October 1914, he had said that business was carried on at 5 Fleet Street under the name or style of the 'Warrior Cycle Company,' and Mr. Sen said he had seen a brass plate on the premises showing the 'Warrior Cycle Co.'

24. This was the origin of the name 'Warrior Cycle Co.' There was no registered Company of that name. It was a name to be used by the Veloce Limited in connection with the manufacture of the cheap Warrior Cycles, one of the reasons being that the Veloce Limited were unwilling to produce such cheap bicycles under the name of Veloce Limited, it being alleged that the Veloce Cycles were high grade cycles.

25. Prior to November 1910, cheap cycles had been made by Veloce Limited for the plaintiff under the name of 'Royal London' and other names.

26. In November 1910 lists were prepared by Veloce Limited and were forwarded by Oakes and Son to the plaintiff in Calcutta in December 1910. According to Mr. Oakes' evidence the original lists which were sent out were like Exhibit C produced at the trial in Calcutta. (This Exhibit was called during the hearing of the appeal 'Calcutta C,' to distinguish it from another Exhibit marked C which was referred to in Mr. Taylor's evidence taken on commission).

27. A copy of a specimen of the original lists circulated by the plaintiff and marked C is set out at page 335 of the paper book, Volume II. It is headed 'Warrior Cycles.' There is an illustration of the cycle with the text 'British materials and British labour are advertised.'

28. The specification is then set out.

29. There is a note, that the cycles can be had with Warrior or customer's own transfer.

30. Then come the words in large letters:

The Warrior Cycle Company, Birmingham.

Then in smaller print: 'Sole Export Agents Oakes and Son, 80-81, Woof Exchange, London, E.C. Stanley Oakes & Co., 6, Mangoe Lane, Dalbousie Square, Calcutta.

31. The original circulars like this, Exhibit C, were circulated in India by the plaintiff. According to his evidence about 2 000 of these circulars were circulated. The plaintiff's business was entirely wholesale and the circulars were sent to the trade only. As the result of these first circulars, the plaintiff, according to his evidence, obtained a number of enquiries about Warrior Cycles, and in addition to the circulars the plaintiff sent out his travellers, Other circulars, of which Exhibit D. is a specimen, were issued by the plaintiff; the date of the issue is not clear, but it was after he had severed his connection with Veloce Limited. In this circular, i.e., Exhibit D, there is no reference to the Warrior Cycles.

32. The first invoice received by the plaintiff in Calcutta in respect of cycles with the Warrior Transfer on them was in September 1911, and it seems that it was about that time that cycles bearing the Warrior Cycles were first put on the market in Calcutta by the plaintiff. The Warrior Transfer attached to the cycles is the one exhibited in the plaint, It consisted of a picture of the head and shoulders of a man supposed to be a warrior, above the picture were the words 'The Warrior' and below the picture the words 'Cycle Company,' Birmingham. This transfer in the first instance was made by Veloce Limited. It was alleged that the special transfer mentioned in the letter of the 25th September 1911 from Mr. Taylor to S. Oakes and Sons which the Veloce Limited had made and reserved for S. Oakes and Sons was the 'Warrior Transfer.' Mr. Taylor, however, denied this and said that the sentence was not clear, but that they had made several thousand transfer under the name of Veloce with the initials S.O.C. (representing S. Oakes and Company), and that it must have been these transfers to which they referred in that letter.

33. This explanation was not challenged in cross-examination.

34. There is no doubt, however, that as between Veloce Limited and S. Oakes and Co. the words 'Warrior Cycle' represented the cheap machine which Veloce Limited had under taken to make for the plaintiff. This mark or transfer upon the face of it represents it as the mark of the manufacturers, viz., the Warrior Cycle Co. of Birmingham, and the transfer together with the circulars like Exhibit Calcutta C, issued by the plaintiff, in my judgment, represented to the trade that there was a company called the Warrior Cycle Co. which manufactured the Warrior Cycles, that such manufacture was carried on at Birmingham, and that the transfer, above mentioned, was the manufacturing company's mark, that S. Oakes and Sons of London were the sole export agents and that S. Oakes and Co. of Calcutta were the representatives of the sole export agents in Calcutta.

35. The evidence in my judgment shows that the dealers and purchasers so understood the matter.

36. Some of the indents which have been produced referred to 'Makers' usual Transfers,' 'Usual Warrior Transfer,' 'Makers own Transfer' and K. Bhattacharjee, the plaintiff's broker, said in his evidence that 'Makers' own Transfer' indicated the 'Warrior Transfer.'

37. I think it is clear, therefore, that the 'Warrior Transfer' was looked upon by the dealers and purchasers in India as the transfer or mark of the manufacturers, viz , the Warrior Cycle Co.

38. I think the evidence also shows that S. Oakes and Co. were regarded by the trade as the representatives of the Warrior Cycle Co. It is only natural that this should be so, having regard to the terms of the circulars already referred to which the plaintiff issued to the dealers in the trade. The letter of 24th October 1912, exhibited at page 195 of the paper-book, Volume II, from a company called the Provincial Cycle Company to S. Oakes and Co. is an instance of the reputation which S. Oakes and Co. had established and which existed in October 1912.

39. In that letter the writers say:

We have received a leaflet direct from the Warrior Cycle Co., Birmingham, offering cycle at 2 C.I.F. Indian ports.

As you are their representatives, we request the favour of being informed of the rates for large contracts about this cycle as early as possible.

40. There is evidence of considerable number of enquiries addressed to S.C. and Co. for Warrior Cycles, among other cycles. There is also evidence that up to the time when Sen & Pandit, the defendants, advertised their intention of importing the Warrior Cycles, the traders, if they wanted Warrior Bicycles, used to communicate with the plaintiff who was known as the sole importer. This was only to be expected in view of the circulars which the plaintiff had issued holding out S. Oakes and Sons of London and S. Oakes and Company of Calcutta as the sole export agents.

41. But that is not decision of the question whether the mark stamped on the bicycles indicated to the dealers and purchasers that the bicycles so stamped were imported and sold by the plaintiff only or, in other words, whether the Warrior Transfer was regarded as a symbol or guarantee of the plaintiff's importation and selling.

42. There is nothing on the Warrior Transfer itself to indicate that the plaintiff is the importer or seller of the cycles; on the contrary the transfer on the face of it purports to be solely the manufacturers' mark.

43. In my judgment the evidence falls far short of proving that the mark had come to be understood and regarded by the dealers and purchasers as indicating importation or sale by the plaintiff.

44. On the contrary I think the evidence shows that the Warrior Transfer was regarded by the trade and the dealers as the manufacturers' mark, and that the plaintiff's connection with the cycles stamped with the Warrior Transfer was solely that of the representative of the Warrior Cycle Co.

45. The plaintiff, however, in this suit asks the Court to give him protection for an alleged right of exclusive user of the 'Warrior Transfer,' as being one employed by

him and understood by the dealers and purchasers as indicating importation and sale by him only irrespective and independent of any connection between him and the Warrior Cycle Co.

46. In my judgment the plaintiff has not made out a case for such protection.

47. The learned Counsel for the defendant relied upon a further ground, viz., that in any event the Court should not have granted an injunction or any relief in favour of the plaintiff on the ground that the plaintiff in selling bicycles with the Warrior Transfer, which included the word 'Birmingham,' was guilty of misrepresentation as to the place of origin of the bicycles.

48. It was urged by the learned Counsel for the plaintiff that the consideration of this point must be confined, having regard to the pleadings, to the use of the word 'Birmingham.' In my judgment this is not so. The form of the issue is wide enough to allow the Court to consider the whole of the misrepresentation, if any, involved in the use of the Warrior Transfer by the plaintiff. The learned Judge evidently so understood it, for he said in his judgment: 'I think the plaintiff is entitled to relief unless the description on the transfer 'Warrior Cycles Co., Birmingham' is so misleading as to disentitle him to relief.'

49. He then proceeded to discuss the above mentioned description in two parts, first the 'Warrior Cycle Company' and then the word 'Birmingham.'

50. The learned Judge held that upon the evidence there was no Warrior Cycle Co. and that being so, he did not think the words 'Warrior Cycle Co.' were calculated to deceive.

51. With great respect to the learned Judge I do not agree; it seems to me that when the plaintiff placed the cycles stamped with the Warrior Transfer containing the words 'Warrior Cycle Co.' before the dealers in the trade, he thereby represented to them that there was a company in existence called 'The Warrior Cycle Co.' which was in fact manufacturing the 'Warrior Cycle,' and if it is to be assumed that there was no such company in existence, as is now contended on behalf of the plaintiff, this was a misrepresentation of a material fact and it certainly

was calculated to deceive.

52. As regards the use of the transfer, the learned Judge has found that with the exception of a small number of bicycles, said to be 18, imported by the plaintiff with Warrior Transfers, the other 'Warrior Transfer' bicycles all came from Glasgow and had no connection with Birmingham, although this appeared on the transfers. This finding is not disputed: and indeed it was admitted by the learned Counsel for the plaintiff that the plaintiff began almost at once ordering Warrior Cycles in Glasgow.

53. It appears that the Warrior Cycles were made for the plaintiff by the Victoria Motor Cycle Company, Limited, Glasgow: From the plaintiff's evidence it appears that there was an invoice, dated the 31st July 1911, for Warrior Cycles with Warrior Transfers supplied by Victoria Motor and Cycle Company, Limited and on reference to pages 68 and 70 of Volume II of the paper book the order for these cycles seems to have been given on the 4th May 1911.

54. The plaintiff in his evidence speaking from memory said that in December 1910 orders were sent to the Victoria Motor and Cycle Company, Glasgow, for cycles to be made with Warrior Transfers.

55. The arrangement between the plaintiff's representative and Mr. Taylor as to the manufacture of the Warrior Cycles with the Warrior Transfers was completed about November 1910, and yet in December 1910, or at any rate in May 1911, the plaintiff was ordering these Warrior Cycles with Warrior Transfers from the Victoria Company in Glasgow.

56. These facts are material: because the plaintiff or his London firm must have given instructions for the making of the Warrior Transfer,' so that it could be affixed to the 'Warrior Cycles' which were made by the Victoria Motor and Cycle Company, Limited, Glasgow, and when the plaintiff was asked why he went on putting on the same transfer (i.e , the Warrior Transfer) when he got the bicycles manufactured by the Victoria Cycle Company Glasgow, he said it did not occur to him to alter the transfer. ' The transfer was already established in the market, '

57. I think this was an incorrect answer.

58. The invoice for the first consignment of Warrior Cycles, bearing the Warrior Transfer, imported into Calcutta by the plaintiff was not received by the plaintiff until September 1911. It may be that the plaintiff was mistaken in saying that orders to the Victoria Company in Glasgow were given in December 1910, but in any event orders were certainly given in May 1911. This was some considerable time before any bicycle, bearing Warrior Transfers, had arrived in Calcutta. The Warrior Transfer did not appear on the circulars issued by the plaintiff and it is obvious, therefore, that the Warrior' transfer could not have been established in the market when the plaintiff in his London firm first gave orders to the Victoria Cycles Company at Glasgow; his reason, therefore, for putting the Warrior Transfer on cycles made by the Victoria Company in Glasgow cannot be accepted.

59. I think the reason for his continuing to use the Warrior Transfer is obvious. He had issued the circulars, Exhibit C (Calcutta), which he received from the Veloce Limited advertising the Warrior Cycle, as being made by the Warrior Cycle Co., Birmingham. If he had changed the name of the manufacturers and had substituted the name of the Victoria Cycle Co, Glasgow, for that of the Warrior Cycle Co., Birmingham, it would not have been in accordance with the representation which he had made in the circulars and it would have broken the continuity of his dealings.

60. The learned Judge has come to the conclusion that it was immaterial to the purchasers whether the word 'Glasgow' or 'Birmingham' was used on the transfer, and he has relied on the evidence given in that respect on behalf of the plaintiff.

61. With much respect to the learned Judge, this is a conclusion with which I cannot agree.

62. There was evidence on behalf of the defendants by persons in the trade that Birmingham and Coventry are two places famous for bicycles, that importance is attached to the place of manufacture, that manufacturers never omit 'Birmingham' and 'Coventry' if cycles are manufactured there, that at first preference was given

to Coventry cycles and subsequently Birmingham cycles received preference.

63. One witness, representing the Standard Cycle Company, said he had not heard of any cycle manufactured at Glasgow. Mr. Walton, one of the plaintiff's witnesses, said he had never sold a cycle with Glasgow on it to his knowledge.

64. In view of this I find it very difficult to accept the evidence that it would make no difference to buyers, whether 'Glasgow' or 'Birmingham' were upon the cycle so long as the bicycle bore a British name.

65. If that were really so, why did the plaintiff continue to use the word 'Warrior Cycle Co., Birmingham' when the cycles were in fact made by the Victoria Motor and Cycle Company, Glasgow. But even if I were satisfied that in general it would make no difference to the trade whether 'Glasgow' or 'Birmingham' was on the cycle (which I am not), I think that in this particular case the matter was of importance, because the plaintiff had already, by issuing the circulars, represented to the dealers and the trade that the cycles were made by the Warrior Cycle Co. in Birmingham.

66. I think it must have been the object of the plaintiff to make the dealers and the trade believe that he was continuing to have the Warrior Cycles made by the same company and at the same place, as he had represented to the dealers and the trade in the first instance when he distributed the circulars, otherwise I do not understand why he did not state the true facts to those who were dealing with him.

67. In my judgment the plaintiff acquired his reputation, of whatever nature it was, in connection with the Warrior Cycles, by misrepresentation. He represented to the trade and dealers that there was a company in existence called the 'Warrior Cycle Co.,' this, according to his case as now presented, was untrue: he represented that this company were the manufacturers of the Warrior Cycles, imported by him. This admittedly was untrue, for all the Warrior Cycles imported by the plaintiff were made by the Victoria Motor and Cycle Company, Glasgow, except a small number of bicycles said to be 18, which were made by Veloce Limited under the name of the Warrior Cycle Company: he represented that the bicycles imported by him were made at Birmingham, whereas in fact, with the exception of 18, they were

made in Glasgow.

68. A party seeking the protection of the Court in such a case as this must come to the Court, as it has been said with clean hands' and even if the plaintiff had established his case to the effect that the stamping of the bicycles with the Warrior Transfer indicated to dealers and purchasers that bicycles so stamped were imported and sold by him only or that the word 'Warrior' had become associated in the market with the plaintiff so that it indicated to dealers generally that bicycles bearing the word 'Warrior' were imported by the plaintiff only (which I do not think he has), in my judgment it would not be right for the Court to grant him the injunction or other relief claimed for the purpose of protecting his alleged right by reason of the misrepresentation of which, in my judgment, he was guilty.

69. There is one other matter, to which it is necessary to refer: the claim in this case was based mainly upon an allegation that the defendants had been importing into Calcutta bicycles, stamped with a transfer similar to that used by the plaintiff, and were offering the same under the name of 'The Warrior Cycles' with the fraudulent intention of passing off such bicycles as and for bicycles imported and sold by the plaintiff. See paragraph 6 of the plaint which runs as follows:

The plaintiff on or about 21st July 1914 came to know that the defendant firm has been importing into Calcutta bicycles stamped with the same transfer and has been advertising and offering the same for sale under the name of 'The Warrior Cycle' with the fraudulent intention of passing off such bicycles as and for the bicycles imported and sold by the plaintiff as aforesaid.

The learned Judge on this point has found as follows: 'Except that the defendant firm under what they considered a genuine claim of right have sold Warrior Bicycles with Warrior Transfers, I find no evidence that the defendants have passed off any bicycles sold by them as and for bicycles imported by the plaintiff.

70. I can see no basis for the charge of fraudulent passing off: the evidence showed that it was known in October 1912 that the defendants were going to import the Warrior Cycles, and the learned Judge has found that the defendants' circulars were distributed in September or October 1912. These circulars showed

that the defendants were acting as import agents for the Warrior Cycles. Under these circumstances there was no ground for saying that the defendants were attempting fraudulently to pass off the Warrior Cycles imported by them as bicycles imported by the plaintiff.

71. In my judgment this appeal should be allowed and the plaintiff's suit should be dismissed.

72. We think that the plaintiff must pay the defendants' costs of the proceedings in the first Court and of the proceedings in the Appeal Court, and those costs will include the costs of the reference and all reserved costs and the costs of the commission. The sum of rupees one hundred and fifty, which we understand has been paid by the defendants as damages, must be refunded to them.

Woodroffe, J.

73. As developed, the argument of the plaintiff in appeal seems to resolve itself into this. The plaintiff says that he wanted some cheap bicycles for sale in the Indian market with a special transfer. He approached the Veloce Company, Limited, who were willing to make bicycles according to specification and suggested the distinguishing name of 'Warrior, which is on the transfer. As the making of such bicycles might affect the sale of Veloce Company's own cycles, they were sent out as the product of a non-existent company called the Warrior Cycles Company, Birmingham, at which city Veloce Company manufacture. The plaintiff company first placed such bicycles on the Calcutta market.

74. Now the first question the plaintiff argued is that the title in the name Warrior and its mark is in him. Apparently the claim to this is made by Veloce Company, Limited. The point then taken is that the Veloce Company did not make these bicycles under this name and mark for themselves at the suggestion of the plaintiff in order to sell to the latter and that the name and the mark are thus not the property of the Veloce Company, but that this company made the bicycles with this name and mark for the plaintiff and, therefore, they were his property and the defendant company cannot infringe his right. It is next said that even if the plaintiff fail to establish that the name and mark were his property and they were in fact

that of the makers, an importer can yet set a reputation on the maker's mark and thus may get a right against the manufacturers themselves. The third paragraph of the plaint alleges that bicycles were specially manufactured for the plaintiff by Veloce Company, Limited, but it is not said that the name and mark were made for and were the property of the plaintiff. In Section 4 the pleading states that to distinguish such bicycles the plaintiff caused the bicycles to be stamped with a Warrior Transfer which has the design of a Warrior with the words 'The Warrior' above and 'Cycle Company, Birmingham' underneath. Then it is said (Section 5). that the stamp indicates that bicycles so stamped are imported and sold by the plaintiff and the bicycles so stamped are called 'Warrior Cycles.' On the facts the learned Judge seems to have found in favour of the plaintiff, his finding being supported before us by reference to the facts that the transfers were made and specially reserved for the plaintiff and that the Veloce Company did not stock the goods but waited until they got orders to put them in hand. I am disposed to think that the question raised by the first part of this argument is not open on the pleadings and issues. But even if it were, it is to be observed that only a small number of bicycles were manufactured and sent to the plaintiff by Veloce Company and afterwards the bicycles were made by a Glasgow firm. As regards the alleged reputation and passing off I am disposed to agree with what the Chief Justice has said. But in my view of the case it is not necessary to finally decide these matters, because I am of opinion that the appeal must be decreed and the Suit must be dismissed on the ground that the mark of which protection is sought contains a misrepresentation. I need not consider whether it is necessary that the misrepresentation should be material. It seems to me to be right that in a case of this kind where the Court's protection is asked that it should demand the strictest accuracy and that any misstatement should disqualify for relief, For the Court should not have to enter into such enquiries in the case of those who wilfully state what is not the fact. I need not, however, enquire whether the law warrants this view, because in the present case I am satisfied that the misrepresentation was material for reasons I give later. It has been further held that if a statement is calculated to deceive, it is for those who made it to show that it has not in fact deceived: *Newman v. Pinto* (1887) 4 Pat. Cas. 508 : 57 L.T. 31 In *Leather Cloth Co. v. American Leather Cloth Co.* (1863) 33 L.J. Ch. 99 : 4 De G.J, & S. 137 : 10

Jur. (N.S.) 81 : 3 N.R. 364 : 9 L.T. 658 : 12 W.R. 289 : 48 E.R. 868 : 146 R.R. 248
Lord Westbury held that if a trade mark contain a material misrepresentation as to the character of the goods to which it is applied, the Court will not interfere to protect the use of it; even though the misrepresentation should be so obvious that no purchaser would be deceived.

75. When the plaintiff got his cycles from the Victoria Company at Glasgow, the obvious question is why he did not so state but continued the words 'Warrior Cycle Co., Birmingham,' which were a misstatement. Mr. James suggests as an answer that the plaintiff had started business with cycles described as those of Warrior Cycle Co., Birmingham, and that in giving the order to the Victoria Cycle Company he has overlooked the statement on the transfer as though it was a matter of no importance. I am unable to accept this explanation, which is not that which Mr. Oakes has himself given.

76. In his evidence Mr. Oakes says that when the agency of Veloce Company, Limited, of Birmingham ceased, he got the Victoria, Cycle Company and Motor Company, Glasgow, to manufacture them, He says, he, went on putting on the same transfer and was asked: Q. 'Did it occur to you to alter the transfers? and the answer was 'No. The transfer was already established in the market.' Later after stating that 'Birmingham' simply means 'British manufacture,' he was asked; 'Q. If that is so, Why did you not put in Glasgow ?' and the answer was 'We could easily, that would make no difference.' All this evidence does not suggest and is opposed to the suggestion that it was an oversight. He does not say that it did not occur to him that the the transfer should be changed, but that it did not occur to him to alter the transfer because the transfer was already established in the market (the accuracy of which answer I need not here discuss), and further I suppose from his answer he would have us believe that he considered the matter one in itself of indifference. I myself think that the transfer was deliberately retained so that the continuity of the sale of these bicycles might not be affected. The cycle had been sold with the 'Warrior Cycle Company, Birmingham' on the transfer; it was probably thought that if the words were Victoria Cycle Company, Glasgow, on them (the word Victoria replacing the word Warrior in big letters at the top of the transfer) purchasers might have some doubt whether they were buying the same

article as they had hitherto done. Then was the statement material? I think it was in two respects, both as to the suggestion that the cycle was the make of the Warrior Cycle Company which it was not, whether we regard the title 'Warrior Cycle Company' as having no real company behind it or referring to Veloce Company working at Birmingham under that name. In fact the cycle was made by the Victoria Cycle Company.

77. Next the statement suggests that the cycles were made at Birmingham, whereas in fact they were made at Glasgow. This is a misrepresentation as to place of origin. Mr. James has contended that the issue is limited to the use of the word 'Birmingham.' The actual issue (the second) framed was wider, as is shown by the judgment which holds that the description 'Warrior Cycle Co., Birmingham' is not so misleading as to disentitle the plaintiff to relief. The learned Judge has held the misdescription to be immaterial. The plaintiff's case is that it does not matter if the goods come from Glasgow or Birmingham; that the word 'Birmingham' does not represent that the cycle is made at Birmingham but that it is British manufacture. If this last were so, then the name of any place would do and preferably the place where it was in fact manufactured.

78. There is some evidence both ways as to the respective merits of Birmingham and Glasgow as centres of cycle industry. I should have thought that it was a matter of common knowledge that Birmingham was, as some of the evidence states, a famous seat of manufacture of bicycles. On the other hand Mr. Walton says that he has never, to his knowledge, sold a bicycle having Glasgow on it and that there is only one firm of cycle manufacturers in Glasgow which he knows of.

79. The place of origin seems to me of some importance. And in fact we find that the word is retained by the plaintiff even after he was getting cycles from Glasgow. But even if it were the fact that abstractedly considered it was indifferent to the buyer (particularly to those ignorant of the seats of manufacture) whether a cycle bore the words 'Glasgow' or 'Birmingham,' the case here is not to be so regarded. I must look at the other facts, viz., that 'Birmingham' was retained because the alleged reputation had been gained on a mark bearing that word and not 'Glasgow.' We have to remember that in this instance there was, in my opinion, a

deliberate statement which was incorrect with a view to keeping the trade. For, I cannot, for the reason stated, accept the explanation of a mere oversight. As regard the words, 'Warrior Cycle Company,' we find from the indents the name of persons who were asking for cycles so described, doubtless in the belief that there was a company of this name which made them. Either, however, there was no such company or if we regard it as an alias of Veloce Limited, then bicycles were not manufactured by them after the plaintiff purchased them from Glasgow. For these reasons I think that the appeal should be decreed and the suit dismissed with costs in terms of the Chief Justice's judgment.

Chaudhuri, J.

80. As I take a view different from that of the trial Court, I think I should shortly state the grounds for my decision. The plaintiff is an importer and seller of bicycles of various kinds. In the early part of 1910 he approached Veloce Limited, a firm of manufacturers at Birmingham, whose agent he was for the sale of Veloce Cycles, for the manufacture of a cheap quality which he thought would have a good market in India. A specification was settled in consultation, but the company said that they would have to use a nondescript transfer or stamp for the new make so as not to spoil their market for Veloce Cycles. The plaintiff has a firm in London known as Oakes & Son. That firm wrote on the 27th September 1910 leaving the question of transfer or stamp on the cycle in the hands of the company. A representative of the plaintiff went to Birmingham at the end of October and on the 10th November 1910. The Managing Director of Veloce Limited suggested the 'Warrior Transfer' and sent a sketch partly in colours for approval. He said in his letter that in order to make the cheap cycles they would engage a separate place. At the same time they prepared a large number of lists, Exhibit C, for circulation in India and the plaintiff's London firm sent them out to Calcutta in the beginning of December 1910. These circulars were apparently printed at the cost of Veloce Limited. They contained a specification with a note that the bicycles could be bad with Warrior or customers' own transfers, and were issued in the name of the Warrior Cycle, Co., Birmingham, and described Oakes & Son as their sole export agents and Stanley Oakes & Company, agents in Calcutta. These circulars were issued by the plaintiff firm in India. Shortly thereafter the plaintiff gave orders for

some of these bicycles from Veloce Limited. Taylor, their Managing Director, said in his examination that as between them and the plaintiff the words 'Warrior Cycle' represented the cheap machine which they had undertaken to make for him. They used the name Warrior Cycle Company to keep the manufacture of the cheap article separate. There is no reason for not accepting his statement that they engaged a separate place for its manufacture at Birmingham. The following portion of the plaintiff's evidence in this connection is important:

Q.--The Warrior Cycle Company, Birmingham, do they exist?

A.--No.

Q.--What is the point of putting Warrior Cycle Co?

A.--It is a sort of trade name. You have to give trade description to show that they are of English manufacture, that is all, and that there is some firm behind it.

Q.--What do you mean by that there is some firm behind it?

A.--Because it is necessary for trade out here for a native buyer to have a name behind. He wants an English name to show it is English manufacture.

81. The plaintiff appears to have ordered only a very few of such cycles from Veloce Limited. He says that the first consignment with the Warrior Transfer was received in Calcutta on the 11th September 1911. The plaintiff's agency for Veloce Cycles terminated on the 25th September 1911. There is a letter on that date from Veloce Limited, in which they say that they had made and reserved for the plaintiff a special transfer of which they had several thousands in stock and that they would be pleased to supply the plaintiff under any other transfer excepting the Veloce. The plaintiff, however, had begun employing another firm at Glasgow known as the Victoria Cycle Company to manufacture cheap bicycles for him and he got them also to stamp them with the same transfers. This firm supplied the bulk of these goods to the plaintiff. In addition to the list, Exhibit C, another list, Exhibit D, was issued by the plaintiff sometime later, the precise date of which cannot be obtained. The plaintiff, however, said that it was issued after his connection with Veloce Limited was severed. It was headed 'Warrior Cycle' and

contained the following note: 'can be bad with Warrior, various stock or customers' own transfers: charge will be made for the cost of latter. Sole Importers Stanley Oakes & Company, Calcutta.' The plaintiff says that a large number of such cycles came out, some of them with the Warrior Transfer and some with his customers' own transfer or other non-descript transfers, and that he got a reputation as the importer and seller of such bicycles. He said that up to the end of 1911 he got out 72 bicycles of Warrior specifications with Warrior Transfer; that he bought out Warrior Cycles with other transfers which were about 50 per cent. He said he got bicycles on his Warrior specification in 1912, 1913, 1914 and 1915 numbering 522, 636, 504 and 228 respectively. The correctness of these figures has been challenged. Exhibit E, which is relied upon by the plaintiff, has not been rightly accepted by the trial Court as correct, but it can be safely assumed that he imported a fairly large number. He said that when he went to the Glasgow manufacturer, he did not change the transfer 'as it was already established in the market'. It contained the name 'Warrior Cycle Company, Birmingham, as it did not matter at all to the buyers whether the bicycles came from Birmingham or Glasgow,' It has been suggested that he kept the name of the company as it was a fictitious name, and as such a company did not exist he had a right to use that name. No one had a greater right to it. In 1912 a list came out from England (Exhibit F on commission) describing the defendant firm as agents for Warrior Cycles. It purported to have been issued by the Warrior Cycle Company of 7, Fleet Street, Birmingham, the exporting agent being Levetus & Co., London, and the Calcutta agents Sen and Pundit. The plaintiff thereupon went to the customs office in Calcutta and wrote to them on the 23rd October 1912 that the Warrior Transfer had been used by him for some years past on cycles imported by him, but that a circular had come out bearing the name of the defendant firm as importing agents for the Warrior Cycle Company, which he said had been mailed direct to Indian dealers from London during the past fortnight. He alleged that for some years past he had been doing considerable business in Calcutta and throughout India 'on his Warrior Brand Cycles,' and asked the customs to stop importation of cycles bearing the Warrior Transfer other than those shipped and invoiced out by his London firm, and he said that he would take necessary legal action. He continued to apply to the customs from time to time and then this suit was instituted in

September 1914. 80. It appears that after the termination of the agency of the plaintiff with Veloce Limited, Levetus and Company were appointed their agents and they employed Sen and Pundit, the defendants, as their sub-agents in India. Circulars were issued, as I have said, in the name of the Warrior Cycle Company mentioning the new agencies, and orders were obtained by Sen and Pundit, but they had great difficulty in getting the cycles out owing to the interference of the customs. Veloce Limited registered the Warrior mark in England on the 18th October 1911. The plaintiff claimed in the correspondence that he was the owner of the transfer in India, but it is very difficult to make out from the way in which the plaintiff had been drawn and the case conducted on his behalf as to the precise nature of his claim. His Counsel has claimed that he is entitled to protect the mark as seller of these bicycles in India, and that nobody else can use it in India and he has also claimed title to the mark. The point has been left vague and ambiguous in the plaintiff's claim, a characteristic not unfrequent in pleadings which our Courts find it very difficult to cure.

82. From the orders received by the plaintiff 'himself' this mark appears to have been frequently referred to as 'the maker's own mark'. The plaintiff has been described in some of the orders as the representee of the manufacturers. He himself was a party to issuing the circulars which described him as the agent of the Warrior Cycle Company, Birmingham. The reputation he obtained was clearly reputation as agent of the makers, the Warrior Cycle Company. Orders were obtained by him in the name of that company; several of such orders are on the record. The plaintiff does not claim any right in respect of the specification. As to this the following portion of his evidence is important:

83. Q.--Whenever you have put forward any claim your claim has been to the use of the Warrior Transfer? Yes, that is all, We are claiming the sole right to use of the Warrior Transfer on cycles.

84. Q.--Have you anywhere put forward any claim to the Warrior specification? We originated the warrior specification.

85. Q.--You cannot claim it? It is impossible for any body to put forward any claim for specification.

* * * * *

86. Q.--What do you say the Warrior Bicycle and Transfer indicate to people in the market? That the machine is reliable in every respect which they can buy without taking the risk of getting hold of shoddy stuff.

87. Q.--Do persons know who deal with these bicycles, who the importer is? Yes, absolutely, they know us as importers.

88. He admitted that the Warrior specification had nothing peculiar about it.

89. The plaintiff said that 'he was entitled to the mark by priority of importation: one who got the market first was entitled to it.' The evidence of the dealers is that they came to know that those cycles were to be had from the plaintiff: that Oakes was bringing out these articles which were manufactured in England. That he used to import them was known in the market and that they could be had with any transfer. They stated that they got their own transfers or the Warrior Transfer in combination with other transfers. I am not satisfied upon the evidence that the word Warrior or Warrior Transfer had come to be identified with the plaintiff alone. The specification was changed: other transfers were used and it was known in the market from about the middle of September 1911 that such cycles could be had from the plaintiff and dealers came and ordered them from him, but I do not think that he has established that the mark or transfer was identified with him. He received orders for the Warrior Cycle Company's Warrior Cycles and brought them out with a transfer bearing that name, which was taken by the buyers to have come from that company. The evidence about his identity with the mark is very meagre and indefinite. I am unable to hold that (he plaintiff is the owner of the mark or transfer or the name, or that, he has a right to use them alone in India. I do not think he is entitled to the relief he seeks.

90. I am also strongly of opinion that he is not entitled to any relief having regard to the misrepresentations made by him in respect of these cycles. The transfer contains the name Warrior Cycle Company, Birmingham. That the Warrior Cycles Company was the name adopted by Veloce Limited cannot be doubted. It was done to keep the manufacture of these cycles separate from their manufacture of

Veloce Cycles: that that firm had a separate place of manufacture for them at Birmingham, I hold established. The plaintiff had no right to use that name. Veloce Limited registered the disputed name and mark. When the plaintiff got the cycles actually made at Glasgow by the Victoria Cycle Company, it was a false representation to the public that these articles were made by the Warrior Cycles Company, Birmingham, which was the transfer on them. Birmingham is a well-known place of manufacture of bicycles. The plaintiff said that he did not change the transfer as it was already established in the market, which means that it was established as an article manufactured by the Warrior Cycle Company at Birmingham, and the plaintiff had no business to use that name or the transfer in respect of articles manufactured at Glasgow, which has apparently no reputation for bicycles. No one has imported a single bicycle from Glasgow and although one witness said that he had heard that there was a cycle manufactory at Glasgow, he had never seen one cycle from that place. It is no use saying that the buyers in India did not care about the name so long as the article was manufactured in Great Britain. The conduct of the defendants' firm cannot be said to be dishonest or deceitful. They were appointed agents by the Veloce Limited and they openly obtained orders as such agents. Having regard to the plaintiff's own statement that he went to the Glasgow firm some months before the termination of his agency with Veloce Limited, even as early as December 1910, I think his idea was to get better terms from the Glasgow firm and he utilised the specification settled with Veloce Limited and the name suggested by them without notice to them and without their knowledge. The fact that he had gone or was going to another firm was suppressed from the Veloce Limited, but he deliberately used the name of the Warrior Cycle Company in obtaining orders. He represented himself, as their agent and obtained orders upon that basis. I do not think that he can claim any relief having regard to these misrepresentations. I am of opinion that the misrepresentation was material. The name was adopted by him, according to his own statement, to induce the belief that there was a firm behind the name. Not much reputation for the articles could have been established if it was known that the article was being manufactured by different people at different places. It was certainly to create an impression that one particular firm in Birmingham were the manufacturers that the plaintiff kept on the original name, which he knew was the

name adopted by Veloce Limited. I think he also knew that Veloce Limited had registered the mark. He never disputed reference to the mark by his customers as the 'maker's own mark.' When Veloce protested against its use, he claimed to be 'the proprietor of the Warrior Cycle Company Transfer' as far as India was concerned. He also claimed that by notoriety and long user he had acquired the exclusive right to the Warrior Transfer. In his letter to the customs dated the 23rd October 1912, he untruly stated that he had for some years past had the Warrior Transfer on cycles imported by him. The name Warrior and the transfer were for the first time proposed in November 1910, and had not been used before June 1911. We have no evidence about the terms between him and the Victoria Cycle Company, or how he went to them, Taking all the facts and circumstances together I agree that the appeal should succeed.

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