

## CALCUTTA HIGH COURT

Rustom Ali Molla

Vs.

Bata Shoe Co. Ltd

A.F.O.O. No. 159 of 1955

(Mitter and Guha, JJ.)

12.09.1956

### JUDGMENT

#### **Mitter, J.**

1. This appeal is from an order of the District Judge of 24 Parganas, granting an interlocutory injunction against the defendants in a suit for infringement of a Trade Mark and for passing off.
2. The plaintiffs are well-known manufacturers of footwear and other leather and rubber goods. It is said that they also manufacture socks and hosiery. They are the owners of the Trade Mark "Bata" in respect of "canvas rubber leather shoes, rubber monolith (footwear), rubber heels, rubber soles, rubber plates (for shoes), leather soles, half-soles, heels, wooden heels, socks and hosiery." This Trade Mark was registered on July 8, 1946.
3. Defendant No. 5 (one of the appellants herein) claims to have been using the said mark or name "Bata" in respect of lungis. It is said that in August, 1953, he applied before the Registrar of Trade Marks, Bombay, for registering a Trade Mark under the name "Bata Lungis".
4. It is common case that the plaintiffs have not so far manufactured lungis or handkerchiefs. According to them, they first learnt in November, 1953, that defendant No. 5 was using the said mark "Bata" in respect of lungis by inscribing the said mark on a label which was attached to each piece of lungi and that the word "Bata" was printed in the identical way as that used in their said Trade Mark.
5. According to the plaintiffs, the user of the said Trade Mark in respect of lungis or handkerchiefs constituted an infringement of the plaintiffs' Trade Mark and/or passing off the goods concerned as those of the plaintiffs.
6. Upon the said discovery, the plaintiffs launched criminal proceedings against defendant No. 6 under Sections 482, 483 and 486 of the I. P. C. By an order dated 19-2-1954, the Presidency Magistrate of Calcutta discharged the said defendant, whereupon the plaintiffs moved this Court in revision. Chunder, J., set aside the said order of discharge and directed that the said

proceedings should be kept pending till the disposal of defendant No. 5's application for registration of the mark "Bata Lungis". Thereafter, on or about 19-4-1955, the plaintiffs instituted the present suit, claiming, inter alia, a temporary injunction restraining the defendants and each of them, their servants and agents, from infringing the plaintiffs' said Trade Mark and from passing off, amongst others, lungis and other articles not of the manufacture of the plaintiffs as those of the plaintiffs and from selling or offering for sale any article associated with the name "Bata" in any manner or form.

7. The learned District Judge held that the user of the mark or name "Bata" in respect of lungis or handkerchiefs did not constitute any infringement of the plaintiffs' Trade Mark which was in respect of specific goods which did not include lungis or handkerchiefs. The learned District Judge, however, found that the plaintiffs had made out a strong prima facie case as to passing off. The reason for this finding was the obvious imitation of the mark "Bata" on the labels or cartons used for the lungis or handkerchiefs and that this similarity was likely to deceive the customers of these goods into believing that they were of the plaintiffs. The learned Judge also imputed dishonesty in the user of the mark.

8. Mr. Atul Gupta on behalf of the appellants has contended that no one can have a monopoly in the use of a name or a mark, unless the same has become associated in the market with his goods. Such a monopoly, according to Mr. Gupta, must, however, be limited to the goods with which the mark has become associated in the public mind and may even extend to similar goods. This is conceded by Mr. Sanyal appearing on behalf of the respondents. Mr. Gupta further contended that the respondents not having manufactured lungis or handkerchiefs, the name or mark "Bata" cannot be said to have been associated with lungis or handkerchiefs. In support of these contentions, Mr. Gupta has referred us to the case of *Thomas Bear and Sons (India) Ltd. v. Prayag Narain*<sup>1</sup>, Delivering the judgment of the Board, Viscount Maugham observed :

"There can obviously be no monopoly in the use of the trade mark. A manufacturer of cigarettes under an undoubted trade mark such as an animal, or any other device, cannot legally object to the use of the identical mark on, say, hats, or soap, for the simple reason that purchasers of any of the latter kinds of goods could not reasonably suppose, even if they were well acquainted with the mark as used on cigarettes, that its use on hats or soap denoted that these goods were manufactured or marked by the cigarette manufacturer. See *Somerville v. Schembri*<sup>2</sup>".

9. In our view, the mark "Bata" not having been associated in the public mind with lungis or handkerchiefs, these goods being of a totally different character from those of the respondents' goods, the appellants' user of the said mark or name in respect of lungis or handkerchiefs of their manufacture cannot constitute any passing off of their goods as those of the respondents.

10. Mr. Sanyal has contended that by reason of the association of the mark with certain goods of the manufacture of the respondents, the use of the same mark in connection with other goods of the manufacture of the appellants is calculated to deceive customers into

<sup>1</sup>67 Ind App 212

<sup>2</sup>(1887) 12 A C 453

thinking that the goods are the products of the respondents and that it is sufficient to

sustain an action of passing off if there is a probability of deception. Mr. Sanyal's argument comes to this that the mark or name "Bata" having been associated with certain goods of the manufacture of the respondents, the same mark or name cannot be applied to any other goods of someone else's manufacture. This, in our view, is too wide a proposition, and if it were correct, no one should be permitted to use the mark or name "Bata" in connection with, say, sweets.

11. The only case which appears to lend support to Mr. Sanyal's contention is *Warwick Tyre Co. Ltd. v. New Motor and General Rubber Co. Ltd.*<sup>3</sup>. This case is, however, distinguishable from the present, in which the articles, namely, lungis, have no connection with the articles, in respect of which the respondents have acquired a reputation to the name or mark. In the Warwick case, the articles were tyres, although, in the one case, they were cycle and motor cycle tyres and, in the other, motor car tyres. The observation of Neville, J., at the bottom of page 254 has to be read with the following observation at pp. 255 and 256 :

"That there is a universal property in a trade name certainly is not true, because if the plaintiff has a trade name in the tyre trade he cannot stop anybody else using the same name for the sale of some articles which has no connection with the articles in respect of which the plaintiff has acquired a reputation to the name."

12. The case of *Walter v. Ashton*<sup>4</sup>, was not concerned with any passing off of goods and must be left out of consideration in deciding the question before us.

13. The next case cited by Mr. Sanyal was *Lloyd's v. Lloyd's (Southampton) Ltd.*<sup>5</sup>. The defendants in that case were held to pass off as being Lloyds of Southampton, which they were not. The injunction granted was to restrain them from carrying on business under the name of Lloyds (Southampton) Ltd., and they were given time to change their name.

14. The case of *Kodak Cycle Co. Ltd.*, (1898) 15 RPC 105 cited by Mr. Sanyal, was also a case for an injunction to restrain the user of a business name, particularly because the evidence disclosed a close connection between the two trades concerned.

15. Similarly, the *Dunlop Pneumatic Tyre Co. Ltd. v. The Dunlop Lubricant Co.*<sup>6</sup> also cited by Mr. Sanyal, was another case of passing off of a business name. In this case, it was held that the word "Dunlop" suggested the plaintiff company. Mr. Sanyal has argued that although the respondents have not so far manufactured lungis, they may do so, and that, therefore, the appellants should be restrained from selling lungis under the name "Bata Lungis." This argument is founded upon the following observation of Romer, J., at p. 15 :

"They themselves are sellers of cycle accessories, though as a matter of fact up to the present time they have not sold burning oil or lubricants. But they may do so, and in the meantime it appears to me that they are entitled to come into Court and say that a name substantially identical with theirs ought not to be allowed to be

<sup>3</sup>(1910) 1 Ch 248

<sup>5</sup>(1912) 29 RPC 433

<sup>4</sup>(1902) 2 Ch. 282

<sup>6</sup>(1898) 16 RPC 12

used by the defendant in the way in which he is using it. I, therefore, think that the plaintiffs are entitled to some relief."

We would dissent from this view if Romer, J., meant that even if the two sets of articles concerned had no connection with each other, there would still be a case of passing off by reason of the same mark or name being used.

16. This is an action of passing off goods and not any business or business name. Indeed, Mr. Sanyal conceded that in this action the plaintiffs were not objecting to any business being carried on under the name "Bata". This being the position, no one doubts the force of the following observation, relied on by Mr. Sanyal, of Romer, L.J., in the case of. *The Clock Ltd. v. The Clock House Hotel Ltd*<sup>7</sup>. at p. 275 .

"There is really no dispute and can be no dispute as to the principle of law involved in this case. The principle is this, that no man is entitled to carry on his business in such a way or by such a name as to lead to the belief that he is carrying on the business of another man or to lead to the belief that the business which he is carrying on has any connection with the business carried on by another man."

17. In the facts of this case, the correct legal position appears to us to be what was laid down in the following observation of Lord Watson delivering the judgment of the Board in the case of (1887) 12 AC 453, at p. 457 .

"The acquisition of an exclusive right to a mark or name in connection with a particular article of commerce cannot entitle the owner of that right to prohibit the use of others of such mark or name in connection with goods of a totally different character; and that such use by others can as little interfere with his acquisition of the right." We would also observe in passing that a similar view was expressed by Cotton, L. J., in the case of *Edwards v. Dennis*<sup>8</sup>, at p. 471 .

18. Mr. Sanyal has argued that the merits of the case will be determined in the suit and that we must not, therefore, express any views on the topic as to whether the user of the word "Bata" in connection with the appellants' sale of lungis constituted passing off their goods as those of the respondents. It is obvious that we cannot dispose of this appeal without a finding on the point, however provisional or embarrassing it may be.

19. For the foregoing reasons, we must hold that the respondents failed to make out a case for an interlocutory injunction. The question of a permanent injunction falls to be determined in the suit upon such further evidence as the parties may choose to adduce.

20. In the result, we would set aside the order of the learned District Judge and allow this appeal with costs.

**Guha, J.**

<sup>7</sup>(1936) 53 RPC 269  
<sup>8</sup>(1885) 30 Ch D 454  
21. I agree.

Appeal allowed.