
(1871) 06 CAL CK 0011

Calcutta High Court

Case No: No. 1426 of 1871

Baker and Others

APPELLANT

Vs

Sutherland and Others

RESPONDENT

Date of Decision: June 22, 1871

Judgement

Norman, Offg. C.J.

1. The question turns upon the construction of the two Statutes 5 & 6 Vict., c. 100 and 24 & 25 Vict., c. 73. By 5 & 6 Vict., c. 100.--An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture, it is enacted (by section 3) that "With regard to any new and original design, whether such design be applicable to the ornamenting of any article of manufacture, or of any substance, artificial or natural, or partly artificial and partly natural, and that whether such design be so applicable for the pattern, or for the shape and configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means such design may be so applicable, whether by printing, or by painting, or by embroidery, or by weaving, or by sewing, or by modeling, or by casting, or by embossing, or by engraving, or by staining, or by any other means whatsoever, manual, mechanical, or chemical, separate or combined, the proprietor of every such design, not previously published either within the United Kingdom of Great Britain and Ireland, or elsewhere, shall have the sole right to apply the same to any articles of manufacture, or to any such substances as aforesaid, provided the same be done within the United Kingdom of Great Britain and Ireland" And by section 4 it is provided that "No person shall be entitled the benefit of this Act, with regard to any design in respect of the application thereof to ornamenting any article of manufacture, or any such substance, unless such design have, before publication thereof, been registered according to this Act."

2. The 24 & 25 Vict., c. 73, after reciting the 5 & 6 Vict., c. 100, and that it is expedient that the provisions of the recited Act should apply to designs, and to the application of such designs, within the meaning of the said Act, whether such application be effected within the United Kingdom, or elsewhere," enacts (by section 1):-- "That the said recited

Act, and all Acts extending or amending the same, shall be construed as if the words "provided the same be done within the United Kingdom of Great Britain and Ireland" had not been contained in the said recited Act; and the said recited Act, and all Acts extending or amending the same, shall apply to every such design as therein referred to whether the application thereof be done within the United Kingdom or elsewhere, and whether the inventor or proprietor of such design be or be not a subject of Her Majesty."

3. The 7th section of 5 & 6 Vict., c. 100, for preventing the piracy of registered designs, enacts, that "during the existence of any such right to the entire or partial use of any such design, no person shall either do, or cause to be done, any of the following acts with regard to any articles of manufacture, or substances, in respect of which the copyright of such design shall be in force, without the license or consent in writing of the registered proprietor thereof (that is to say),

No person shall apply any such design, or any fraudulent imitation thereof for the purpose of sale, to the ornamenting of any article of manufacture, or any substance, artificial or natural, or partly artificial and partly natural.

No person shall publish, sell or expose for sale any article of manufacture, or any substance, to which such design, or any fraudulent imitation thereof, shall have been so applied, after having received, either verbally, or in writing, or otherwise, from any source other than the proprietor of such design, knowledge that his consent has not been given to such application, or after having been served with or had left at his premises a written notice signed by such proprietor or his agent to the same effect.

4. The 8th section provides for the recovery of penalties for piracy of the design, and the 9th section empowers "the proprietor in respect of whose right such penalty shall have been incurred (if he shall elect to do so) to bring such action as he may be entitled to for the recovery of any damages which he shall have sustained, either by the application of any such design or of a fraudulent imitation thereof, for the purpose of sale, to any articles of manufacture."

5. The effect of 5 & 6 Vict., c. 100, appears to me to have been this, that the owner or proprietor of any design registering the same under the Acts, if such design was applied to the ornamenting of any article of manufacture in England, acquired a right to prevent any person from applying the design, or any fraudulent imitation of it, to any article of manufacture, or from selling any article to which the design is applied. But the extent of such prohibition must have been, and was, measured by the extent to which the provisions of 5 & 6 Vict., c. 100, applied. Now 5 & 6 Vict., c. 100, did not extend to India, and therefore there is nothing in that Act which would have prevented any person from applying any registered design, or selling any article to which such design had been applied in India.

6. 24 & 25 Vict., c. 73, was passed immediately prior to the Exhibition of 1862, and it extended the privileges conferred by 5 & 6 Vict., c. 100, to the case of designs registered in England, whether the application of such designs to articles of manufacture was effected within the United Kingdom or elsewhere. But there is nothing in 24 & 25 Vict., c. 73, which extended the prohibition of the application of such design, or the sale of articles to which such design had been applied, to India or the Colonies, or to any other place to which 24 & 25 Vict., c. 73, did not extend.

7. I am therefore of opinion that the decision of the Recorder is correct, and that a registered proprietor of a design within the United Kingdom could not sustain an action against a person who applied such design, or who sold any articles to which such design had been applied, in British Burmah.

8. The learned Advocate General has attempted to rest the case on another ground, namely, that the plaintiff had a right in this design analogous to the right which a merchant may have in his trade mark. I think that there is no foundation for such a contention. A design for ornamenting an article of manufacture is not an indication that such article is manufactured by a particular house, and there are no allegations in the plaint that the defendants used the design in question, the same being the property of the plaintiffs, for the purpose of fraudulently pretending, or causing it to be believed, that the articles so sold by the defendants were articles manufactured, selected, or printed by the plaintiffs. The two subjects, the property in a trade mark, and the property in a registered design, are two rights totally distinct in their nature, The right put forward in the present case is simply a right in a design for ornamenting an article of manufacture, and such right is not infringed by the sale in British India of articles to which the design has been applied.

9. We are of opinion, therefore, that the decision of the Recorder is correct, and that it must be affirmed. The unsuccessful party, the plaintiffs, will pay the defendants costs of this reference.