(1926) 28 BOMLR 243 : (1926) ILR (Bom) 402

Bombay High Court

Case No: O.C.J. Suit No. 5165 of 1923

A.J. Von Wulfing — APPELLANT

Vs

D.H. Jivandas and Co. — RESPONDENT

Date of Decision: Dec. 19, 1924

Acts Referred:
Trade Marks Act, 1905 â€" Section 45

Citation: (1926) 28 BOMLR 243 : (1926) ILR (Bom) 402

Hon'ble Judges: Taraporewala, J

Bench: Single Bench

Judgement

Tarapoerwala, J.
In this case the plaintiffs allege that for several years prior to 1914, they had manufactured and sold under the names of

Sanatogen "" and "" Formamint "" certain chemical compounds for use in medicine and pharmacy, that within a short time the said compounds sold

under the name of Sanatogen and Formamint acquired a very high reputation throughout India and the sales thereof were large and profitable and

the names of Sanatogen and Formamint had come to mean chemical compounds of the plaintiffs" manufacture. They further allege that on the

outbreak of the War the said compounds were imported into India by the plaintiffs" London firm until the property and assets of the plaintiffs"

London firm were sold in June 1917 by the controller appointed under the Trading with the Enemy (Amendment) Act 1916 to Genatosan Limited,

that from and after June 1917, the said Genatosan Limited imported the said compounds under the names of Sanatogen and Formamint, that on

the termination of the War the plaintiffs started importing Sanatogen and Formamint from Berlin, and that their original exclusive right to the use of

the said names was by the terms of Treaty of Peace of Versailles restored to the plaintiffs, The plaintiffs further allege that at the end of October

1923, the defendants imported into Bombay two consignments of some substances under the names of Sanatogen and Formamint and were selling

the same at a much lower rate than the plaintiffs'' goods. The plaintiffs charge that the object of the defendants in importing and selling the said

goods was to deceive the public and lead them to believe that in purchasing the inferior compounds offered for sale they were buying the genuine

articles of the plaintiffs'' manufacture, and further say that the general make up, marking and appearance of the defendants'' packages, apart from

the use of the names Sanatogen and Formamint, was made to closely resemble the plaintiffs'' packages. The plaintiffs pray for an injunction

restraining the defendants from passing off or attempting to pass off or from enabling others to pass off chemical compounds not of the plaintiffs''

manufacture as the goods of the plaintiffs by use of the names Sanatogen or Formamint and other consequential reliefs.

2. By their written statement the defendants deny that the names Sanatogen and Formamint came to mean chemical compounds of the plaintiffs''

manufacture as alleged by the plaintiffs. They further contend that the trade marks of Sanatogen and Formamint were avoided and removed from

Register of Trade Marks in October 1916, by and under the Order made by the Board of Trade and under rules made under the Patents, Designs

and Trade Marks Temporary Rules Act 1914 Amendment Act and that thereupon the said marks and names became public property both in

England and India. They further contend that Sunatogen and Formamint were, from 1917 to 1923, imported into India by Genatosan Limited and

also by various other persons and that the said names and marks have become public property by reason of common user. The defendants further

deny that the plaintiffs had the original exclusive right to the use of the said names or that such right is restored to the plaintiffs by the Treaty of

Peace. The defendants admit that they had imported twenty-two cases of Sanatogen and a consignment of Formamint but deny that it was inferior

to the plaintiffs'' compounds or that their object in importing the said goods was to deceive the public as alleged. They further deny that the general

make up, marking and appearance of the packages closely resemble the plaintiffs'' packages, and allege that the make up of their packages was of

a description common to the trade. The defendants further allege that the plaintiffs have no right to the exclusive use of either the names Sanatogen

and Formamint or to the use of the said get-up.

3. Eighteen issues were raised and at the beginning of the hearing Mr. Binning for the plaintiffs asked for issue of commission to England, America

and Germany, to prove various allegations in the plaint on which the defendants have raised issues Nos. 1 3, 4, 8 and 11, I refused the application

for commission and the trial went on chiefly on issues Nos. 2, 5, 7, 12 and 15. In my opinion, the issues on which Mr. Binning asked for a

commission were not at all necessary for the decision of the case, and, at the end of the hearing, I was confirmed in my opinion that on the

evidence as led before me the said issues were not at all necessary for coming to a decision in this case, The issue of a commission would have

caused a very heavy expenditure of money and a good deal of delay in the decision of the suit, and after fully considering all the facts I came to the

conclusion that neither the said expenditure nor the said delay was at all necessary.

4. Although the defendants have in their written statement denied that the plaintiffs had acquired any exclusive right to the use of the names

Sanatogen or Formamint, in the course of his evidence, Harkisondas, a partner in the defendant firm, who is managing the defendants'' business in

Bombay, admitted that prior to 1914, the names Sanatogen and Formamint had come to mean the chemical compounds of the plaintiffs''

manufacture in the Indian market, and that the plaintiffs had acquired an exclusive right to the use of the names Sanatogen and Formamint in

respect of the said compounds, The denial of the exclusive right of the plaintiffs to the use of the said names was put forward in the written

statement of the defendants and also put forward at the hearing, both in the argument on the question of the issue of a commission and in the

opening of the defendants'' case, on the grounds which, on examination, appear to be unfounded, namely, that Sanatogen and Formamint were the

names under which the said two compounds had been patented and that they were the only names by which the said compounds could be

designated in the market, that the said patent rights had expired in 1911, and that thereupon the said names had become common names of the

compounds and that any person manufacturing the said compounds was entitled to use the same in respect thereof. The said compounds were

patented in England by the plaintiffs, but it was proved in the case that the names given to the compounds in patenting them were Latin names

indicating the nature of the compounds, About the same time the plaintiffs gave the names of Sanatogen and Formamint to these compounds as

fancy names to indicate their manufacture of the said compounds and got the said names registered as trade marks in England. It was conceded by

Mr. Munshi for the defendants, when these facts were proved in the case, that the said names having been registered as trade marks after the

compounds had been patented, the said two names could not be treated as names descriptive of the compounds or the only names which could be

used in respect thereof. Thereafter the defendant Harkisondas admitted in his evidence, as stated before, that so far as India was concerned the

plaintiffs had acquired, an exclusive right to the user of the said two names in respect of the compounds which they sold under the said names.

Even if there was any substance in the argument that the names Sanatogen and Formamint, being the names under which the said compounds were

patented, became common names of the articles on the expiry of the patent, the argument could not apply in India as the said compounds were not

patented in India; and the only question, therefore, for the Court to consider, so far us India is concerned, is whether by the sale of the said

compounds in India under those names the plaintiffs acquired a reputation in the Indian market that the said names denoted the manufacture of the

plaintiffs and whether by reason of such user and such reputation they became solely entitled to the exclusive right of user of these names, In

respect of rights in trade marks and trade names any rights acquired by the parties in England have no effect on the rights of the parties in India.

The rights of industrial property in India are governed by the laws of India and are in no way affected by the laws of England or by the action of

parties in England. There is not yet any Registration Act in India for the protection of rights in trade marks. The trader or manufacturer in India has

still to depend upon his common law right for the protection of his trade mark. It was tried to be argued on behalf of the defendants that the

common law right to a trade mark is not a right to industrial property in the same sense as a right in a registered trade mark is .in countries where

registration of trade marks gives right of property in the trade mark. But if the evolution of the law in England as to the rights in trade marks and

protection of such rights is considered, one finds that before the Registration Acts the Equity Courts had by their decisions created a right of

property in trade marks in a trader who had acquired a reputation in respect of goods on which he had used the trade mark. This point is well

brought out by Kerly in his Law of Trade Marks and Trade Names, 5th Edition, page 4, as follows:-

An important step was taken in 1838, by the decision of Lord Cottenham in Mulington v. Fox, that an injunction could be obtained to restrain

infringment of a trade mark, even though the infringment was due to ignorance, and was without fraudulent intent. This decision led, by an obvious

deduction, to the establishment of a right of property in trade marks; and, although the nature of this right gave rise to much discussion, and was

defined in different terms by Chancery judges in subsequent cases, .it soon became firmly established, and the protection of trademarks in equity

was expressly based upon it.

5. Mr. Kerly further goes on to say on the same page :-

The trade mark cases, however, were so much the more numerous and important, that, as already stated, a definite property-right in the use of a

trade mark was set up, and the action for infringement became a specialised and distinct form of the more general action to restrain, or to obtain

damages for "passing off." The litigation of trade mark cases was, however, found to be extremely costly, and otherwise unsatisfactory. The

essence of a trade mark right being the reputed association in the market of the symbol in question with the goods of the plaintiff, it was often

necessary to call a large number of witnesses to give evidence of the reputation, especially if the defendant alleged that the pretended trade mark

was either mere descriptive matter, or was, on any other grounds, a mark common to the trade; and, as infringers were usually persons of no

substance, it was often impossible to recover the costs after the plaintiff had conducted his action to a successful issue. Moreover, success against

one infringer did not relieve the owner of a trade mark from the necessity of proving his title afresh if, in any action against another infring. or, the

defendant chose to dispute it.

6. With a view to mitigate these evils, the Trade Mark Registration Act, 1875, was enacted in England and the object of the Act, as stated by

Kerly at page 6, was twofold :-

It was directed, on the one hand, to diminish the difficulty and costs of, or to remove altogether the necessity for, the proof of title by use and

reputation, which had cast so great a burden upon the owners of trade marks in proceedings to restrain infringement; and, on the other, to secure

the publication of marks which had been appropriated as trade marks, and to define the rights of their proprietors, for the information of traders,

and, farther, to limit the classes of marks which should be capable of being so appropriated.

7. Further amending Acts were passed, and the Act now in force is the Trade Marks Act, 1909, as amended by the Trade Marks Act of 1919.

There were prohibitory sections in the said Acts which purported to make registration a condition precedent to a right of action to restrain or to

obtain damaged for infringement of trade marks. Unregistered trade marks, notwithstanding the prohibitory sections of the Acts, are in many cases

protected by the Courts in England in the ""passing-off"" actions, Section 45 of the Trade Marks Act, 1905, expressly provides that nothing in the

Act shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect

thereof.

8. In India there being no Registration Act giving a right of property in trade marks by registration, the only right of action a trader or manufacturer

has is the common law right of action which entitles him to an injunction restraining the use of a trade mark belonging to him if such use is calculated

to pass off the defendant''s goods as the goods of the plaintiff.

8. Various witnesses were called by both the parties in this suit. Unfortunately, they were all persons dealing in chemicals, either wholesale or retail

or both. No evidence of the purchasers in the market was called. The evidence of witnesses of both the plaintiffs and the defendants clearly proves

that prior to the outbreak of War in 1914, the plaintiffs had acquired a reputation in respect of these compounds under the name of Sanatogen and

Formamint, and the said names were identified in the minds of the public with the manufacture of the plaintiffs. As rightly pointed out by Mr.

Binning, it was not necessary for him to prove that the public in India knew the plaintiffs'' name as the name of that manufacturers, There is no

doubt that they knew and believed that the compounds sold under the names of Sanatogen and Formamint were the manufacture of one particular

manufacturer and when they bought the said compounds under the said names they expected to get the compounds manufactured by the said

manufacturer, and there is no doubt the said manufacturers were the plaintiffs. I shall deal with the evidence in detail later on.

9. The sole ground on which, therefore, the defendants could claim to sell their compounds under the names of Sanatogen and Formamint would

be the determination of the said trade mark rights of the plaintiffs.

The right of the proprietor of a mark (subject to the rights of other proprietors, if any, of the same mark) to the exclusive use of it upon the goods

of the kind in respect of which the right existed is determined :-

(1) When the mark so used ceases to be distinctive;

(2) When, the proprietor is no longer able to use it in the business in connection with which the right was acquired;

(3) When he has abandoned it;

(4) When he has forfeited his claim to protection of his right by using the mark deceptively or in a fraudulent trade; and

(5) In the case of the name of an article or substance manufactured under any patent, when the patent expires or determines,"" (See Kerly on Trade

Marks, page 430.)

10. The defendants in this case contend that the said trade marks ceased to be distinctive by reason of the sale of these compounds under the said

names by persons other than the plaintiffs between the years 1917 and 1923. The evidence in this case, no doubt, proves that on the outbreak of

the War the plaintiffs could not import the said compounds from Germany where they were up to that date manufacturing the same. In order to

carry on the lucrative trade in the said articles the plaintiffs began to manufacture the said compounds in England and to import the same into India

till their business was sold by the Controller, in the year 1916, to an English Company called Genatosan Limited. About the same time as the sale

of the plaintiffs'' business in England by the Controller, the British Government avoided the plaintiffs'' trade marks in respect of these compounds

under the special powers given to the Government by the War Emergency Legislation. The avoidance of the trade marks thus enabled various

other manufacturers in England not only to manufacture the said compounds, but to use the names Sanatogen and Formamint in respect thereof. I

may mention here that the patent rights in respect of both these compounds came to an end in the year 1911. The formula of these compounds

were public and any one could have manufactured or sold the compounds in England after the patent rights had expired, but as the name

Sanatogen and Formamint were registered trade marks of the plaintiffs no other manufacturers could use those names in respect of the said

compounds and sell the same under those names in Great; Britain. On the avoidance of the trade marks, the Said names became common names

and ceased to be distinctive of the manufacture of the plaintiffs. Thereupon in England any manufacturer could use the names in respect of the

compounds which prior thereto they had acquired the right of manufacturing. Thus, after the year 1916, the compounds were manufactured

according to the original formula by various manufacturers and sold by them under the names Sanatogen and Formamint.

11. After the outbreak of the War the original German compounds ceased to be imported into India, and the plaintiffs themselves imported the

compound under the name Sanatogen as manufactured in England and, after their English business was sold by the Controller, the compound was

manufactured in the United States of America and imported under the name Sanatogen into India. The name of the American Company was Bauer

Chemical Company. There is no doubt that it was the plaintiffs who manufactured the compound in America under that name. At the same time,

Genatosan Limited, who had purchased the plaintiffs" English business, manufactured the compound in England and imported and sold the same in

India. Only other Sanatogen imported into India is that of the defendants, excepting a very small consignment sent by John Lorimer and Company,

Similarly, Formamint was, during the pendency of the War, manufactured by plaintiffs, at first, in England, and after 1917 in America, under the

name of Bauer Chemical Co,, and sold in India up to the end of 1920, After 1917 and up to 1922, Genatosan Limited also sold their Formamint in

India. The plaintiffs recommenced Selling their German Formamint from 1921. The only other Formamint sold in India was that of Burgoyne

Burbidges & Co., Ltd., and that was in 1923. For the last year and more Burngoyne Burbidges & Co. Ltd. are selling their Formamint under the

name Formalin, and Genatosan Limited have ceased to sell their Formamint in India.

12. The plaintiffs called the evidence of Mr. Fraser of Kemp & Co. and Mr. Welch of Thompson and Taylor, and Ahmed Haji Haroon, a

wholesale dealer in patent medicines, and Jehangir Sorabji Patel. These witnesses admitted that during the War there were throe kinds of

Sanatogen in the market: English, American and German. All these witnesses were, however, emphatic in saying that German Sanatogen only was

considered by them to be genuine, that the English and American Sanatogen was considered by them as merely a substitute and a bad substitute

for the original Sanatogen, and that, immediately they could get the German stuff again, they would not buy or import and sell to the customers any

Sanatogen other than the Sanatogen of the plaintiffs" manufacture.

13. This evidence means, and can only mean this, that in the view of these witnesses the compound which is sold under the name Sanatogen is not

Sanatogen unless it is manufactured by the original German manufacturers, namely, the plaintiffs, and that by the word Sanatogen they understood

the compound manufactured by the plaintiffs. If Mr. Welch, who is a dealer on a very large scale in chemicals and has long experience of Indian

markets, is of that opinion, one can well understand what the opinion of the ordinary Indian customer would be. His opinion would be much

stronger than that of his English salesman, that when he buys the compound Sanatogen, he buys the genuine article only if it is the manufacture of

the plaintiffs, and if he is given anything which is not the manufacture of the plaintiffs under that name, he is not really given the article which he has

asked for, Mr. Munshi admitted, on behalf of the defendants, that Sanatogen was consumed by persons knowing English as well as by persons

who do not know English. Mr. Welch said that the customers complained of the inferiority of Sanatogen other than the German Sanatogen of the

plaintiffs" manufacture. The stock of original Sanatogen which remained in Bomby at the commencement of the War fetched a very high price,

which fact also shows that the people believed the real Sanatogen to be the Sanatogen of the plaintiffs" manufacture.

14. Ahmed Haji Haroon stated that he bought the Sanatogen of the American manufacture seeing the name Bauer Chemical Co. on it under the

belief that that was also manufactured by the plaintiffs.

15. A significant fact may here be noted that Genatosen Limited sold their compound in the market with the following representation on their label:-

This product is now absolutely British.

The English assets of A. Wolfing & Co., including all stocks of Sanataogan, etc., have been purchased from the Board of Trade by a syndictate of

British businessmen. In the future, therefore, this business will be entirely British and free from enemy capital or influence.

This is the genuine original Sanatogen, and its manufacture will be continued at the Penzance Factory. It will subsequently be re named to avoid

confusion with worthless substitutes.

16. It shows that Genotosan Limited themselves felt that the compounds had acquired a reputation in India as the manufacture of the plaintiffs, and

they tried to sell their goods in the Indian market on the faith of the representation that they were the assignees of the business and good-will of the

plaintiff firm and were the only manufacturers of the genuine compound called Sanatogen. This, to my mind, strengthens,the case of the plaintiffs

that, even where the public bought the stuff manufactured by Genatosan Limited, they bought it under the impression that they were baying the

genuine articles as originally manufactured by the plaintiffs.

17. The evidence of the plaintiffs'' witnesses inclines me to hold that even where the Sanatogen of English and American make was sold, it was

sold to the public under a representation that either it was made by the original manufacturers or that it was made by the assignees and successors

of the original manufacturers. To my mind, the general public and those who do not know English could not have known from the fact of the sale of

American Sanatogen. and English Sanatogen of Genatosan Limited, that Sanatogen was a common name of a compound which was manufactured

by various manufacturers, and denoted merely the compound and not the manufacture of a particular manufacturer, namely, the plaintiffs.

18. The defendants made an attempt to show that John Lorimer & Co., the manufacturing chemists of England, tried to sell their Sanatogen in the

Indian market. The evidence on the point shows that a small consignment of this Sanatogen was received and, as the people did not like the form in

which it was packed, no farther consignment was imported into India. The only other Sanatogen proved to have been sold in India, during the

War, was the English Sanatogen manufactured by the plaintiffs themselves and sold under their own name A. J. Von Wulfing, and the American

Sanatogen sold by the plaintiffs under the name of Bauer Chemical Co,, and the English Sanatogen manufactured by Genatosan Limited, as the

successors and assignees of the plaintiffs'' London business,

19. The fact, that in England, after the avoidance of the trade mark in 1916, a large number of manufacturers are manufacturing Sanatogen, does

not affect the question in India at all. So far as the Indian market is concerned, no Sanatogen of any manufacturers, other than those mentioned by

me, was sold. Immediately after the Peace Treaty the plaintiff"s began to import their stuff into India, and Genatosan Ltd. thereupon disputed their

right to do so, and a suit was filed by them in the Calcutta High Court. That suit was settled, and Genatosan Limited withdrew from the Indian

market. It is admitted by all the witnesses, both on behalf of the plaintiffs and the defendants, that for the last year or so there has been a very small

quantity of Sanatogen other than the Sanatogen of the plaintiffs in the Indian market.

20. The defendants" witnesses were also wholesale and retail chemists. They did not call evidence of a single customer. Those witnesses deposed

that they had sold, between 1917 and 1923, Sanatogen of English and American manufacture, and produced entries from their books showing that

they had so sold Sanatogen of English and American manufacture and a few letters of demand from chemists upcountry for American or English

Sanatogen. Here, again, the utmost this evidence proves is, that the dealers in chemicals, knowing very well that during the War the German stuff

could not be imported into India, made inquiries, seeing that there was demand for the compound, as to whether they could get the stuff, and

coming to know that Sanatogen manufactured in America and England was imported, naturally they made inquiries for it and bought it. Chiefly, it

was the American Sanatogen which was sold as it was the cheapest and, as I had pointed out, it bore on the face of it the name of Bauer Chemical

Co., which would naturally be identified by the public with the original German manufacturers. No doubt, the price paid for the original stuff was

higher than the price paid for the American stuff, but that merely shows that the people put a very high value on the original German stuff and they

bought the other stuff as a substitute for want of the German stuff. By reason of competition with Genatosen Co, Ltd., also, possibly the American

Co. sold their stuff cheaper. The various catalogues of chemists in India were put in to show that Sanatogen was advertised in the catalogues,

under different manufactures, namely, American, English, and German. The catalogues do not afford any indication as to the ideas held by the

public and particularly the public who do not know English, The onus is on the defendants to show that the names Sanatogen and Formamint

ceased to be distinctive and became publici juris as alleged by them. The evidence that they have led is, in my opinion, quite insufficient to show

that. For the last year or So, the only attempt made to sell Sanatogen of any other manufacture is by the defendants.

21. After a very careful consideration of the evidence, I have come to the conclusion that the name Sanatogen is still identified in the mind of the

public with the manufacture of the plaintiffs and has not become a common name of the compound.

22. In respect of Formamint, the evidence of sale of Formamint of other manufacture in India, between 1017 and 1923, is equally insufficient.

There is the evidence of the dealers; no customers are called. For the last year or so, there is no other Formamint in the Indian market excepting

the plaintiffs," That chemical has also acquired a great reputation in the Indian market as admitted by the defendants, and up to 1914 the name

Formamint was identified with the manufacture of the plaintiffs, The plaintiffs are as much entitled to the use of that name as their trade mark as in

the case of Sanatogen. In my opinion the defendants have failed to prove that the word Formamint became a common name of the compound in

the mind of the Indian public.

23. The question, as to when a trade mark or a name, which is distinctive, becomes publicijuris, is considered in Ford v. Foster (1872) L.R. 7 Ch.

App. 611 The test is laid clown very clearly by Hellish L. J,, at page 628, as follows:-

For the reasons given by the Lord Justice James, which I do not repeat I am clearly of opinion that originilly, at any rate, the plaintiff was entitled

Co be protected against the use of the word "Eureka" by the shirt makers as a violation of his trade mark, Then the question is, has it become

publici juris? and there is no doubt, I think, that a word which was originally a trade mark be exclusive use of which a particular trader, or his

successors in trade, may been entitled, may subsequently become publici juris, as in the case which have cited of Harvey"s Sauce. It was admitted

6hat, although that originally had been the name of a sauce made by a particular individual, it had become, publici juris, and that all the world were

entitled to call the sauce they made Harvey"s Sauce if they pleased. Then what is the test by which a decision i8 to be arrived at whether a word

which was originally a trade mark has become publici juris ? I think the test must be, whether the use of it by other persons is still calculated to

deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if

they were his goods. If the mark has come to be so public and in such universal use that) nobody can be deceived by the use of it, and can be

induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear

on the trader, yet practically, as the right to a trade mark is simply a right to prevent the trader from being cheated by other persons" goods being

sold as his goods through the fraudulent use of the trade mark, the right to the trade mark must be gone.

24. It appears from these observations of Lord Justice Mellish that the Court would require very strong evidence, which would show conclusively

that the mark had come to be so public that no body could be deceived by the use of it and could be induced from the use of it to believe that he

was buying the goods of the original trader, for refusing protection to the trader who was entitled to the use of the trade mark.

25. Another case on the point, to which I would refer, is the judgment of the Privy Council in National Starch Manufacturing Company v. Munn"s

Patent Maizena and Starch Company [1894] A. C. 275 Lord Ashbourne observes as follows:-

Other firms besides the appellants and respondents used the word "Maizena" in Australia between 1864 and 1889, From 1867 until shortly before

the commencement of this suit no claim was ever made by the appellants to the exclusive use of the word ""Maizena"" in New South Wales. The

present question could not have arisen if the appellants had more promptly availed themselves of the Act of 1865. They did not do so until the year

1889, and the first substantial question in this case is, whether during the twenty-four years which elapsed between 1865 and 1889 the word had

been so used in the colony as to make it no longer registerable as the appellants'' trade-mark. If during the period in question the word was only

used in the colony for the fraudulent purpose of counterfeiting their goods, the right of the appellants to register it as their trade-mark would not be

impaired, If, on the contrary, it was used and Understood before 1889 as a term descriptive of the article, as a product of maize, and did not

denote such product to be of the manufacture or the merchandize of a particular person, that it must be regarded as having become, in the sense of

law, publici juris, and was no longer registerable by the appellants as their trade-mark.

26. Then further on he says (p. 280):--

No full or exhaustive definition can be given of the circumstances which Will make a word or name publici juris, and each case must depend upon

its own facts. In considering the question, it is important to bear in mind that the appellants do not claim any special right to the manufacture of

''Maizena'', or any exceptional method in making their ''Maizena'', and that the respondents and all other people have just as much right as the

appellants have to manufacture the thing-no matter whether it is called ''Maizena'', corn flower, or any other name. Having regard be all the facts

and evidence in the case it is impossible to resist the conclusion that in December, 1889, the date of registration, and for many years previously, the

word ''Maizena'' had become publici juris, and their Lordships are therefore clearly of opinion that it was at the date specified not registerable by

the appellants as their trade mark.

27. In this case the user by others was extended over a very long time and the Court came to the conclusion that the word "" Maizena "" in New

South Wales was the common name of an article and not a name distinctive of the manufacture of the appellants in that case.

28. In all cases of trade mark no doubt, the Court has to judge on the facts before it and the decision in another case, based on the facts of that

case, can be of little value in arriving at a conclusion on the facts of the particular case before the Court. But the principles laid down as to the

appreciation of the facts are of the same importance and of the same value in all these cases, and applying the principles as laid down in Ford v.

Foster to the facts of the case, and considering that the onus of proving that the trade mark Sanaf ogen, in which the plaintiffs had admittedly

acquired a reputation up to the outbreak of War in 1914, had ceased to be distictive of the plaintiffs'' manufacture and had become publici juris, is

on the defendants, I cannot hold on the evidence before me that the defendants have proved to the satisfaction of the Court that the name

Sanatogen has come to be ao public and in such universal use that no body aan be deceived by the use of it, and can be induced from the use of it

to believe that he is buying the goods of the plaintiffs. To my mind the evidence, as it ""shows that notwithstanding the sales of Sanatogen which, on

the face of the packets, was shown to have been manufactured not in Germany but in England and America either by the plaintiffs or by the

Genarosan Limited, the public bought it merely as a substitute for the genuine article even where they knew that it was not the German stuff they

were buying, and that in the mind of the public the word "" Sanatogen "" did not indicate the name of a compound which might be manufactured by

any manufacturer but indicated the distinctive manufacture of the plaintiffs.

29. On the evidence there is no doubt, in my mind, that the defendants, seeing that a very large and lucrative business was carried on by the

plaintiffs in Sanatogen, and that there was no other competitor in the field, and finding that in England various other manufacturers did manufacture

and sell the compound in that name, sought to tike advantage of the reputation acquired by the plaintiffs and that got it manufactured in England for

sale in, India. The whole conduct of the defendants, as disclosed in the evidence, shows the dishonesty of their intention.

30. Mr. Binning, for the plaintiffs, did not press the point of get-up as, in his opinion, the use of the words "" Sanatogen"" and ""Formamint"" was the

most important factor in the case and what the plaintiffs are seeking in this suit is to prevent the use of those names, and therefore the question of

the get-up, although taken in their plaint, has not been pressed before the Court at the hearing. To my mind, however, the question of the get-up is

important from this point of view that whatever be the belief of the defendants as to the name Sanatogen being a common name and not distinctive

of the plaintiffs'' manufacture, the defendants did, by the get-up of their stuff, try to sell their stuff as the stuff of the plaintiffs. The differences are

childish. The name Sanatogen is printed on the packets and on the bottle of the plaintiffs in a different style. The defendants have merely changed

the position of these names. The style of the words used on the packets of the plaintiffs is the style of the words on the bottle of the defendants,

and the style of the words used on the plaintifis'' bottle is the style of the words on the packet of the defendants. No doubt, the name of the

supposed manufacturer in England, which, the defendant had to admit in his evidence, was an imaginary name, is printed on the bottle and packet,

but, as observed in so many cases, the public are not therefore less likely to be deceived in buying the defendants'' goods as the goods of the

plaintiffs.

31. Even if the word "" Sanatogen"" had ceased to be distinctive, there is no doubt in my mind that the way the defendants have tried to sell the

goods is indicative of their intention to pass off their goods as the goods of the plaintiffs, and, in any event, the plaintiffs would be entitled to an

injunction restraining the defendants from passing-off the goods as the goods of the plaintiffs.

32. Assuming that the defendants are right in their contention that the names have ceased to be distinctive of plaintiffs manufacture by reason of the

sales of the compounds manufactured by other manufacturers under those names between 1917 and 1923, the next question arises, namely,

whether under the Peace Treaty the fact of the user of the names by others should be eliminated from consideration and the case considered as if

the right of the plaintiffs, as it was at the outbreak of the War, was restored to them on the conclusion of the Peace Treaty. This question has been

the main question argued before me by counsel on both sides. I have given a very careful consideration to this point, more particularly, as there are

no reported cases thereon. The point has arisen in South Africa before and been decided by the Registrar of Trade Marks where rights to trade

marks are protected by registration under law similar to Registration Acts in England. Mr. Binning has used that judgment as part of his arguments

on my invitation to him to do so, and I must say that I have derived some assistance from it,

33. Coming to the relevant articles of the Peace Treaty of " Versailles, Article 806 provides as follows :-

Subject to the stipulations of the present Treaty, rights of industrial, literary and artistic property, as such property is defined by the International

Conventions of Paris and Berne, mentioned in Article 286, shall be re-established or restored, as from the coming info) force of the present Treaty,

in the territories of the High Contracting Parties, in favour of the persons entitled to the benefit of them at the moment when the state of war

commenced or their legal representatives.

34. Then there is a proviso that :-

Nevertheless, all acts done by virtue of the special measures taken during the war under legislative, executive or administrative authority of any

Allied or Associated Powers in regard to the rights of German nationals in industrial, literary or artistio property shall remain in force and shall

continue to maintain their full effect.

35. Under Article 307 it is provided as follows :-

A minimum of one year after to be coming into force of the present Treaty shall be accorded to the nationals of the High Contracting parties,

without extension fees or other penalty, in order to enable such persons to accomplish any act, fufil any formality s pay any fees, and generally

satisfy any obligation prescribed by the laws or regulations of the respective States relating to the obtaining, preserving, or opposing fights to, or in

respect of, industrial property either acquired before August 1, 1914, or which, except for the war, might have been acquired since that date as a

result of an application made before the war or during its continuance...

All rights in, or in respect of, such property which may have lapsed by reason of any failure to accomplish any act, fulfil any formality, or make any

payment, shall revive...

The period from August 1, 1914, until the coming into force of the present Treaty shall be excluded in considering the time within which a patent

should be worked or a trade mark or design used, and it is further agreed that no patent, registered trade mark or design in force on August 1,

1914, shall be subject to revocation or cancellation by reason only of the failure to work such patent or use such trademark or design for two

years after the coming into force of the present Treaty.

36. Article 309 provides:-

No action shall be brought and no claim made by persons residing or carrying on business within the territories of Germany on the one part and of

the Allied or Associated Powers on the other, or persons who are nationals of such Powers respectively, or by any one deriving title during the

war from such persons, by reason of any action which has taken place within the territory of the other party between the date of the declaration of

war and that of the coming into force of the present Treaty, which might constitute an infringement of the rights of industrial property or rights of

literary and artistic property, either existing at any time during the war or revived under the provisions of Articles 307 and 303.

37. These articles of the Peace Treaty, no doubt, purport to reestablish and restore, as from coming into force of the Treaty, the rights of industrial

property as such property is defined by the International Conventions of Paris and Berne.

38. Article 286 provides that the International Convention of Paris of March 20, 1883, for the protection of industrial property revised at

Washington on June 2, 1911, will again come into effect as from the coming into force of the present Treaty in so far as they are not affected or

modified by the exceptions and restrictions resulting therefrom.

Industrial property"" is defined in the International Convention of Paris, as revised at Washington, in the final Protocol to Article 1 of the

Convention, as follows:-

The words "industrial property" are to be taken in their broadest sense; they extend to all productions of the agricultural industries (wines, corn,

fruits, cattle, etc) and of the mining industries (minerals, mineral waters, etc).

39. Article 2 of the Convention provides as follows :-

The subjects or citizens of each of the contracting countries shall in all the other countries of the Union, as regards patents, utility models, industrial

designs or models, trademarks, and trade names, indications of origin, and the suppression of unfair competition, enjoy the advantages that their

respective laws now grant, or may hereafter grant, to their own subjects or citizens. Consequently, they shall have the same protection as the latter,

and the same legal remedy against any infringement of their rights, provided they observe the conditions and formalities imposed on native subjects

or citizens. No obligation as to the possession of a domicile or establishment in the country where protection is claimed shall be imposed on those

who enjoy the benefits of the Union.

40. Article 6 provides specifically for trade marks :

Every trade mark duly registered in the country of origin shall be admitted for registration and protected in the form originally registered in the other

countries of the Union.

41. Articles 7 and 8 further provide for registration of the trade marks. Article 8 provides:-

A tradename shall be protected in all the countries of the Union without necessity of registration, whether it form part or not of a trade-mark.

42. Article 10 his provides as follows :-

All the contracting countries undertake to assure to those who enjoy the benefits of the Union effective protection against unfair trade competition

43. The explanation to Article 1 as given by the Protocol and Article 2 indicate that industrial rights, in their broadest sense, are sought to be

protected by the Convention. The Articles, however, which deal in, detail with the protection of these rights, show that so far as trademarks are

concerned only rights acquired by registration are considered, and in the case of trade names, it is specifically provided that registration shall not be

necessary for the protection of trade names. The question then arises as to whether by reason of the specific provision for protection of registered

trademarks, the definition as given in the explanation to Article 1 and the rights which are sought to be protected by Article 2 can be construed as

circumscribed by the said specific provision. At one time I thought that that would be a reasonable construction. Probably, the registration of trade

marks being in force in most of the civilized countries, the Signatories of the Convention did not contemplate or provide for rights in trade marks

which are not acquired by registration. But, on a fall consideration, I am inclined to the opinion that the. object of the Signatories being the

protection of industrial rights in trade marks as are recognised by a 2ountry, the Court by putting a restrictive meaning on the provisions of the

article, would be frustrating the very object with which the Convention was made, and, in a country like India, would deny to a foreigner the right

to acquire in India rights in respect of trade mark by user which a citizen of the British Empire could acquire therein. It would mean that where the

law of registration of trade marks does not prevail, a foreign national cannot acquire the rights in trade marks as the national of that country can

acquire. It may be that where the law of registration prevails, every one would be cognizant of the rights of property in the trade marks which are

registered. But the fact that a common law right to a trade mark may not be so well-known unless and until it is contested in a Court of law, ought

not, to my mind, to preclude a foreign national from acquring and maintaining such a right in a country, which is a party to the said Covention, just

as a national of that country would be entitled to do. Moreover, the right to a trade mark is, to my mind, not affected by the method by which it is

acquired. The right of industrial property consists in the right to the user of a particular trade mark. In India there being no Registration Acts, the

right to a trade mark can be acquired only by user. There is no doubt, in my mind, that the right so acquired in India is a right to industrial property,

and it is for that reason that I have cited the observations of Kerly in the beginning of my judgment as to the nature of the right acquired in England

before the passing of the Registration Acts. The right, to a trade mark, in whatever way acquired in a British country, is a right of industrial

property coming under the Coventions of Paris and Berne. If that is so, the rights which the plaintiffs admittedly had to these trade marks, at the

out-break of the War, must be restored to them under the Peace Treaty, unless there is an Act of Government which deprives them of the right, In

England there has been such, an Act of Government. In India no such action has been taken by Government. So the only thing in the way of the

plaintiffs, in the exercise of their rights of trade marks, is the sale of Sanatogen and Formamint, manufactured by others and sold under those names

in infringement of the right of the plaintiffs from the year 1917 to 1923, during the time when the plaintiffs, by reason of the War, could not possibly

prevent such infringement. The Peace Treaty expressly provides that any such infringement during the War shall not be taken into consideration and

the parties shall be restored to their original position as it existed at the outbreak of the War.

44. At one time I was very much oppressed by the argument that the common law right to a trade mark is originally based on the deception of the

public, and that, if in fact, the public are not deceived, the owner of the mark should not be entitled to a restoration of a right where the very basis

of the right is gone. In the case of registration the right is acquired independently of any reputation of the article by the mere fact other registration

of the trade mark. Such a right, if infringed during the War, may very well be restored by the action of the Government who are parties to the

Peace Treaty, but in the case of a common law right, where the article has come to be publici juris, by reason of its sale by other manufacturers,

how could the original position be restored ? But, on a careful consideration of the Peace Treaty and of the Convention of Paris as revised at

Washington, the object of the Peace Treaty appears to me to be clear, namely, to restore the traders to the same position as they occupied, at the

outbreak of the War, in respect of the rights acquired by them. On further consideration, I think, the same arguments can be advanced in respect

of the restoration of a right to a registered trade mark. For instance, a trade mark cannot be registered unless the word is a fancy word. If all

manufacturers use it, it remains no longer a fancy word. But by the Peace Treaty the owner of the trade mark is restored to his rights, that is to say,

the word is to be considered to be a fancy word in spite of the infringement which makes it a common name. To my mind it appears that I would

not be giving full effect to the clauses of the Peace Treaty if I construed the definition of '' industrial property"" in the narrow sense in which I am

asked to do by the defendants in this case.

45. I hold that the plaintiffs are entitled to the rights in the said trade marks as possessed by them at the outbreak of the War, and that sale by the

defendants of their compounds, under the names Sanatogen and Formamint, is an infringement of the plaintiffs'' said rights.

46. I have already pointed out how the get-up of the defendants'' Sanatogem and Formamint is very similar to the get-up of the plaintiffs''

Sanatogen and Formamint, and how it is likely to deceive the public into buying the defendants" goods as the plaintiffs" goods. In any event, I am

of opinion, that the defendants cannot be allowed to sell their goods under that get-up and that they should be restrained by an injunction from

doing so, The mere publication of the name of Gibbon Sons & Co,, as manufacturers, on the defendants" goods is not sufficient to distinguish them

from the plaintiffs" goods Even if the defendants are entitled to use the words ""Sanatogen" and ""Forinamint" on the goods sold by them, they must

change the get-up of the goods in a manner as not to deceive the public into believing that they are the goods of the plaintiffs.

47. Decree for the plaintiffs in terms of prayers A and B of the plaint.

48. The defendants to submit accounts of importation and sale of goods, as per prayer C, to the plaintiffs" solicitors on or before January 31,

1925.

49. Plaintiffs to be at liberty to make an application to refer accounts to the Commissioner.

50. Defendants to pay the costs of the plaintiffs.