

Present : Pereira J.

1914.

STEWART v. SILVA.

77—P. C. Colombo, 44,049.

Person registering trade mark under "The Trade Marks Ordinance, 1888," is proprietor of mark—Rights of person registering same trade mark under "The Patents, Designs, and Trade Marks Act, 1883"—Priority—If no step taken to obtain priority in Ceylon, local registration remains unaffected.

When a trade mark is duly registered in Ceylon under "The Trade Marks Registration Ordinance, 1888," its proprietor, so far as Ceylon is concerned, is the person who has so registered it, and its use by anybody else without his sanction is obnoxious to the Ordinance.

If the same trade mark has been registered in England under "The Patents, Designs, and Trade Marks Act, 1883," inasmuch as the provisions of section 103 of that Act have been extended to Ceylon, it is open to the person in whose favour it is so registered to obtain priority by registration of the same mark in Ceylon under our Ordinance; but so long as no steps have been taken to obtain such priority, and no proprietorship *aliunde* is established by anybody, the rights accruing from local registration remain unaffected.

THE facts are set out in the judgment.

Bawa. K.C., and Morgan de Saram, for complainant, appellant.

H. J. C. Pereira, for accused, respondent.

Cur. adv. vult.

February 17, 1914. PEREIRA J.—

This is an appeal from an acquittal with the sanction of the Attorney-General. The accused was charged with offences under section 3. sub-section (1) (b) and sub-section (2), of "The Merchandise Marks Ordinance, 1888." In view of the evidence, I think that the only charge that need be considered is that under section 3 (2), that is to say, the charge of selling goods to which a trade mark was falsely applied without proof of the exculpatory circumstances mentioned in sub-sections (a), (b), and (c). I think that, assuming that the accused did sell goods to which a trade mark was falsely applied, it is clear that he has failed to establish the exculpatory circumstances mentioned above. So that the only question for decision is whether to the goods sold by the accused a trade mark was falsely applied. The accused has been proved to have sold certain boots to which the trade mark of a kangaroo was applied after that trade mark had been duly registered by the complainant

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under "The Trade Marks Registration Ordinance, 1888." It has been argued for the defence that the trade mark in question is one that has been registered in England under "The Patents, Designs, and Trade Marks Act, 1883," as a trade mark for the boots imported by the accused, and that therefore the accused has a right to sell the boots under that trade mark, in spite of the registration of the same trade mark in Ceylon, as a mark for the boots imported from the same manufacturer. There is no evidence that the trade mark in question has been registered in England under "The Patents, Designs, and Trade Marks Act, 1883"; but, assuming that to be so, what is the effect of the registration of the same trade mark under our Ordinance in Ceylon? Under section 19 of "The Trade Marks Ordinance, 1888," the registration of a trade mark is *prima facie* evidence of the right of the person who has registered it to the exclusive use of the mark, and such registration becomes conclusive evidence after five years from the date of the registration. The meaning of this, of course, is that for five years from the date of registration any person who can show that he is the proprietor of the trade mark may establish by proof the fact of such proprietorship as against the person who has registered the mark in Ceylon. Now, the section of Ordinance No. 13 of 1888 under which the accused is charged speaks of trade marks as defined in section 4 of the Ordinance, and the expression "trade mark" is there defined (to put it briefly) as a trade mark registered under the local Ordinance or under the Patents, Designs, and Trade Marks Act, or a trade mark which, whether with or without registration, is protected by law in a British Possession to which the provisions of the 103rd section of "The Patents, Designs, and Trade Marks Act, 1883," are, under His Majesty's Order in Council, for the time being, applicable. The provisions of section 103 of "The Patents, Designs, and Trade Marks Act, 1883," have been duly extended to Ceylon (see *Gazette* No. 6,075 of September 15, 1905). That being so, under section 41A of Ordinance No. 14 of 1888, if the trade mark in question in this case was registered in England, the person in whose favour it was so registered was entitled to obtain priority by registration here under our Ordinance in the manner laid down in section 41A; but no such registration has been proved to exist, nor has any proprietorship been established *aliunde*, if that were permissible in the circumstances of the case. The only local registration proved is that by the complainant. It may be open to any person to have the registration of a trade mark expunged on proper cause shown; and in a case like the present it is, I think, the practice in England to suspend proceedings when a proper application is made for that purpose, pending proceedings in the proper quarter to have the registration of the trade mark involved in the case expunged. But so long as the registration remains it has effect, and in view of the provision of section 6 (3) of Ordinance

No. 13 of 1888, the proprietor, so far as Ceylon is concerned, of the trade mark in question in the case is the complainant, and its use without his sanction is obnoxious to the Ordinance. I set aside the acquittal, and convict the accused of the offence mentioned above under section 3(2) of Ordinance No. 13 of 1888. I think that in the circumstances the punishment need be nominal, to serve merely as a warning against a continuance of the offence. I sentence the accused to pay a fine of Rs. 5, in default, to one week's simple imprisonment.

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Set aside.
