

A FRUIT OF THE LOOM, INC.
v.
CHONG KONG MAN AND OTHERS

[HIGH COURT OF TRINIDAD AND TOBAGO (McMillan, J.), January 31, 1972]

B *Trade Mark—Infringement of registered trade mark—Passing off—Whether similar mark used by defendants likely to deceive or cause confusion—Whether proof of actual confusion necessary—Whether label part of mark—Whether differences in colour and size material—Injunction—Enquiry as to damages—Trade Marks Ordinance 1955 [T.], s. 5 (1), 18.*

C The plaintiffs, a foreign company, manufacturers and dealers in cotton goods, were registered proprietors of a trade mark under the Trade Marks Ordinance 1955. The mark consisted of a bunch of mixed temperate fruits with the words “Fruit of the Loom” printed below. Since 1961 the plaintiff’s goods marketed in Trinidad were packaged and sold locally in plastic bags bearing a distinctive label in substantially the form of the trade marks. In about the year 1967 the plaintiffs became aware that the defendants were manufacturers and dealers in goods similar to the type manufactured by them and that they were being packaged and sold in plastic bags bearing a label with a bunch of mixed tropical fruit and the words “Tropical Fruits” at the top. The plaintiffs brought an action for infringement of their registered trade mark, for “passing off” and sought an enquiry as to damages.

E **Held:** (i) that registration of a valid Trade Mark gives to the registered proprietor the exclusive right to the use thereof;

(ii) that a trade mark is infringed if a person other than a registered proprietor or a permitted user, in the course of trade, uses in relation to goods covered by the registration one or more of the trade mark’s essential features so as to be likely to deceive or cause confusion;

F (iii) that for there to be “passing off” of goods it must be shown that the defendants’ mark or “get up” is similar to the plaintiffs’ and thus likely to cause confusion or to deceive;

(iv) that the defendants’ use of a mark similar in essential features to that of the plaintiffs’ mark was an infringement of the plaintiffs’ registered mark and that the defendants were passing off their goods as those of the plaintiffs’.

G *Injunction granted. Order for delivery of all offending labels. Nominal damages. Defendant’s taxed costs.*

Cases referred to:

H (1) *Spalding v. Gamage (A. W.), Ltd.*, [1914] 2 Ch. 405; 83 L.J.Ch. 855; 111 L.T. 829; 58 Sol. Jo. 722.

(2) *Jay v. Ladler* (1888), 40 Ch. D. 649; 60 L.T. 27; 37 W.R. 505; 5 T.L.R. 57; 6 R.P.C. 136.

Action for damages and an injunction to restrain the defendants from passing off goods.

I *M. de la Bashde* for the plaintiffs.
H. Rameser for the defendants.

McMILLAN, J.: The plaintiffs, a foreign company incorporated in the State of New York are manufacturers and dealers in clothing including men’s underwear, cotton piece goods and goods made of synthetic fibres and synthetic fibrous materials and prior to 1957 and, subsequently, have been exporting the said goods

to Trinidad and Tobago where there has been, I find, since at least 1957 a good market therefor. Indeed since 1970 the goods are manufactured for the plaintiffs by E. P. Gibbes, Ltd., a local company, under licence granted by the plaintiffs. Certificates from the Registrar General's office in evidence show that the plaintiff company first became in 1953 the registered proprietors of a trade mark under the Trade Marks Ordinance, Cap. 31 (since repealed and replaced by the Trade Marks Ordinance 1955) valid for 14 years to June 8, 1967. That trade mark comprised a bunch of mixed temperate fruit with the words "Fruit of the Loom" inscribed above them and was registered in Class 38 in respect of clothing, including men's underwear. In February, 1967, before the expiration of that trade mark the plaintiffs applied separately for and subsequently obtained registration of a similar mark in respect of:

- (a) cotton piece goods, including sheets and pillow cases (class 24);
- (b) cotton goods not included in other classes (class 25) and;
- (c) synthetic fibres and fibrous materials including sheets and pillowcases included in class 50 (class 50).

That mark differed from the first mark in so far as the words "Fruit of the Loom" appeared below the identical mixed bunch of temperate fruit and not above, and though there are now subsisting three separate registrations it is convenient to deal with them as one mark.

Since 1961, the plaintiffs' goods in respect of which their trade mark subsisted were packaged and sold in plastic bags bearing a distinctive label in substantially the form of the said trade marks. It comprised as a prominent feature of its distinctive get up and general lay out the combination of an ellipse broken at the top by a similar bunch of mixed fruit as in their trade mark and enclosing the words "Fruit of the Loom" inscribed under the fruit as in the later registration and within the ellipse. Within the ellipse and under the words "Fruit of the Loom" are the words "unconditionally guaranteed" and, it would appear from the exhibits in evidence before me, with a declaration of the contents of the package.

In or about the year 1967 the plaintiffs became aware that the defendants, who as partners in business under the name of Victory Knitting Factory, are manufacturers of and dealers in some or all of the goods of the types manufactured and dealt in by the plaintiffs, have since the registration of the plaintiffs' trade mark been putting upon the market and selling various types of goods similar to those of, but not manufactured or sold by the plaintiffs, in plastic bags bearing a label which it is alleged is a colourful and deceptive imitation of the plaintiffs'. The defendants' label also comprised an ellipse broken at the top by a branch of mixed fruit (which appear to be, and were described as tropical by counsel on either side and by the plaintiffs' witness) and enclosing the words "Tropical Fruits" printed, I find, in the same or similar type of print as that used by the plaintiffs and placed in a similar position to the bunch of fruit as are the words "Fruit of the Loom" in relation to the fruit in the plaintiffs' trade mark registered in 1967, and on the packages now used by the plaintiffs since 1961. Within the ellipse and under the words "Tropical Fruits" are the words "Guaranteed to Fit" and thereunder "For Quality and Lasting Wear". The plaintiffs accordingly, through their solicitors, wrote the defendants on June 15, 1967, notifying them of this registration of their trade mark and complaining that the mark used by the defendants on their label was so similar to theirs as to amount to an infringement of the plaintiffs' trade mark and warning them that legal proceedings would be instituted if the defendants did not cease using the trade mark immediately. The defendants replied by letter dated June 23, 1967, enclosing a specimen copy of their package and therein observed:

A “We think you will agree beyond any doubt that there is no infringement of the trade mark. However, we would like you to understand that if in your opinion there is doubt we will be prepared to discontinue this brand if you will allow us to utilise the 20,000 bags presently in stock as these were purchased prior to us (*sic.*) obtaining full control of this factory as it was our partner’s idea of designing a bag of this nature and as he is no longer associated with the company, we trust that
B you will understand the situation in the event of your findings (*sic.*) that the bag enclosed, represents an infringement of trade marks. We wish like all other manufacturers to co-operate and we hope this affair can be settled to our mutual satisfaction.”

C From the bundle of correspondence put in evidence (which clearly does not include all the correspondence between the parties) it appears the plaintiffs agreed to allow the defendants to continue using their existing stock of bags to which objection was taken up to December 31, 1967, but on October 11, 1967, the defendants again wrote the plaintiffs’ solicitors indicating that owing to shortages in raw materials and other financial difficulties they were forced to suspend operations for a time and asked for a further extension of the period of indulgence granted them for utilisation
D of their existing stock of bags. This was by letter dated November 23, 1967, extended to February 9, 1968, on condition that the defendants would give an undertaking in writing that they would pay damages should they use the “offending” trade mark after that date. The letter concluded:

E “Failing your agreement, our instructions are to proceed against you as soon as possible after December 31 this year.”

F On December 7, 1967, however, the defendants again wrote the plaintiffs’ solicitors explaining that they were again embarrassed by a tremendous drop in sales, the non-receipt of raw materials and the devaluation of currency necessitating correspondence with their “importers in London and Hong Kong” but were happy to report that they had that day received notification of a further shipment of raw materials due to arrive in January, 1968, and, anticipating a step up in sales in February and March, 1968, sought a further extension of indulgence to May 31, 1968. The plaintiffs, however, were prepared to grant an extension to March 31 only, and so informed them by letter dated January 4, 1968, through their solicitors who clearly indicated:

G “this is the last extension they (plaintiffs) will agree to and should they find that you are still using these plastic bags after that date legal proceedings will be commenced to enforce their legal rights.”

H That is the last piece of correspondence in evidence and on July 1, 1969, the plaintiffs issued their writ in this action seeking injunctions to restrain defendants from infringing their trade marks registered as 88 of 1953 and Nos. 4058, 4059 and 4060, and from passing off their goods as those of the plaintiffs, obliteration upon oath of all marks upon all material the use of which would be a breach of the injunction, an enquiry as to damages, costs and further or other relief.

I These are the facts as disclosed by the pleadings and the evidence which, apart from the documentary evidence, consisted of the evidence of Mervyn Troja who was called by the plaintiffs, and as a result I conclude that no undertaking in writing was given as requested, and that since the defendants have admitted that they have put upon the market and sold goods in plastic bags as alleged and merely denied any infringement of the plaintiffs’ trade marks or passing off of their goods as those of the plaintiffs, I must conclude that they use, and are prepared still to use their labels despite their apparent initial offer of co-operation.

I have therefore to determine as a question of fact whether the use by the

defendants of their label constitutes (a) an infringement of the plaintiffs' registered mark or design and/or (b) a passing off or risk of passing off their goods as those of the plaintiffs. A

Registration of a trade mark in respect of any goods, if valid, gives to the registered proprietor the exclusive right to the use thereof in relation to those goods and that right is infringed if any person, not being the proprietor of the mark or a registered user thereof by way of permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of their mark likely to be taken either: B

(a) as being used as a trade mark ; or C

(b) in a case in which the use is upon the goods or in physical relation thereto . . . , as importing a reference to some person having the right to use the trade mark or to the goods with which such person is connected in the course of trade: s. 5 (1) of the Trade Marks Ordinance 1955. D

Accordingly, a trade mark is infringed if a person other than a registered proprietor or permitted user, uses in relation to goods covered by the registration one or more of the trade mark's essential features or particulars: KERLY ON TRADE MARKS (8th edn.), p. 269. But in order to succeed in an action of infringement use of the offending or spurious mark must be used in the course of the trade. Here, there is no question as to the validity of plaintiffs' trade mark or that the defendants' use of their mark is in the course of the same trade as the plaintiffs' or that their goods are on sale in business places in Trinidad as are the plaintiffs'. There is equally no question of permitted user since any acquiescence by the plaintiffs in the defendants' user was limited to December 31, 1967. Indeed, it is not pleaded as a defence. Thus, the only question for me on the pleadings and on the evidence as regards infringement or non-infringement is whether the defendants' use of their mark falls within s. 5 (1) of the Trade Marks Ordinance, *i.e.*, whether the defendants' mark is likely to cause confusion or deception. E F

As regards the claim for passing off, the plaintiffs must prove also that the defendants' conduct in using the mark or similar mark or "get up" is likely to deceive or cause confusion and/or damage to the plaintiffs' trade by passing off other goods as his or by leading his customers to suppose that there is a connection between the defendants' goods and plaintiffs' business which does not in fact exist. As stated by LORD PARKER in *A. G. Spalding v. A. W. Gamage, Ltd.* (1) (referred to in KERLY, *op. cit.*): G

"The basis of a passing off action being a false representation by the defendant, it must be proved in each case as a fact that the false representation was made. It may, of course, have been made in express words but cases of express misrepresentation are rare. The more common case is implied in the use or imitation of a mark, trade name, or get up with which the goods of another are associated in the minds of the public, or of a particular class of the public. In such cases, the point to be decided is whether having regard to all the circumstances of the case, the use by the defendant in connection with the goods of the mark, name or get up in question impliedly represents such goods to be goods of the plaintiff or goods of the plaintiff of a particular class or quality, or, as it is sometimes put, whether the defendants' use of such mark or get up is calculated to deceive." H I

Thus the plaintiffs must prove their mark or get up has become by user distinctive of their goods and none other, so that the use in relation to any goods similar to those dealt in by the plaintiffs of that mark or get up will be understood by the trade and public in this country as meaning that the goods are the plaintiffs'. It is admitted on

A the pleadings that the label has become distinctive of the plaintiffs' goods and none other, so that again the issue left is whether the defendants' mark or get up is likely to deceive or cause confusion. I have no evidence of actual confusion or of anyone being deceived, counsel for plaintiff being content to rely on what he asserts is the similarity in appearance of the two labels and the likelihood therefore of the public being deceived. Counsel for the defendants, however, submitted that in the absence
B of such evidence proof of a fraudulent intention to deceive is necessary. He referred to no authorities. The authorities which I have been able to discover are to the contrary and their effect is summarised in *KERLY, op. cit.*, at p. 334 thus:

C "Passing off cases are often cases of deliberate and intentional misrepresentation, but it is well settled that fraud is not a necessary element of the right of action, and the absence of an intention to deceive is no defence."

Indeed, proof that someone has actually been deceived by the defendants' get up is not necessary and an injunction will be granted if the "similarity is so great that any person acquainted with the one might readily consider the other to be only a temporary or occasional variation of it . . .": *KEKEWICH, J.*, in *Jay v. Ladler* (2) ((1888), 40 Ch.D. at p. 653). In that case there was evidence by one witness
D experienced in the particular trade that the defendant's mark or get up might have deceived him. I have no such evidence here. However, it seems to me that that question is one purely of fact to be decided on a comparison by this court of all the similarities and dissimilarities of the two marks or labels, and such other inferences as may be drawn from the evidence including the absence of evidence of actual confusion, and on that comparison I have come to the conclusion that the
E defendants' label is a colourable imitation of the plaintiffs' labels.

Like *KEKEWICH, J.*, in *Jay v. Ladler* (2) it would require some charity for me to suppose the defendants' mark or get up was not suggested to one of them, or to the person who designed it by his having seen the plaintiffs' mark or get up. A display of fruit on the goods dealt in by the plaintiffs, and indeed the words "Fruit of the Loom" for that matter, have significance only in the context of the plaintiffs' name and in so far as the word "Fruit" in that name indicates "produce" of the loom. The same cannot be said of the defendants' use of fruit in their label. When we consider the use as well of the broken ellipse it would require even greater charity. In this case I cannot exercise that charity with respect to these two defendants even though their letter of June 23, 1967, to plaintiffs' solicitors suggested that it was a former partner who copied the plaintiffs' design or mark for, apart from imputing knowledge to them of their former partner's copying, it is sufficient for me to hold, because of their persistence in using the offending label after knowledge of the plaintiffs' complaint, that that use no longer remains innocent and I find that continued use of it now in the circumstances is with the specific intent of misleading or confusing the ultimate purchaser of leading them to believe that their goods are those of the plaintiffs'.

H Counsel for the defendants sought to distinguish the defendants' mark, for example, by the use of tropical fruit and the words "Tropical Fruit", and the differences in colour and sizes in the labels. I have no doubt that on very close examination these differences may well be apparent but I am equally satisfied that to the average purchaser who buys over the counter the defendants' mark or get up will be mistaken for the plaintiffs'. The arrangement is so similar that the colour tones and differences in the nature of the fruit become insignificant and the whole representation is, as I have already said, a colourable imitation of the plaintiffs' get up or package in which they sell their goods.

I Accordingly, the plaintiffs must be entitled to an injunction restraining the defendants from passing off their goods as those of the plaintiffs and I will grant the injunction as prayed in that behalf.

I have so far dealt with the plaintiffs' label as if it were something different from his registered mark. In fact, however, I can see no difference. The salient feature of the plaintiffs' mark is the display of fruit. That is copied by the defendants in circumstances, as I have already indicated, where it can have no significance in relation to their goods except as "fruit of the loom" and the substitution of the words "Tropical Fruit" therefor, only enhances its deceptive value. Comparing the plaintiffs' mark as registered and the defendants' as it appears on their label, and bearing in mind that by virtue of s. 18 of the Ordinance the plaintiffs' mark is deemed to be registered for all colours, I have come to the firm conclusion that the defendants' use of a collection of fruit largely similar in shape and arrangement with the plaintiffs' mark is a copy of the essential features thereof and the added words do not in my view sufficiently distinguish it therefrom, and I hold that the continued use by the defendants of the offending labels is an infringement of the plaintiffs' registered mark. Accordingly, the plaintiffs are entitled to an injunction restraining the defendants and each of them from infringing their registered trade mark and I will grant them the injunction as prayed in that behalf as well as an order for the delivery of all offending labels under the defendants' possession or control.

No actual damage having been established and counsel informing me that he was not pursuing his claim for an inquiry and an account of profits, I give only nominal damages in the sum of \$50 and costs to be taxed.

*Injunction granted. Order for delivery of all offending labels.
Nominal damages. Defendants' taxed costs.*

Solicitors: Messrs. J. D. Sellier & Co (for the plaintiffs); A. Tsoi-a-Sue (for the defendants).

BHARATH v. CAMBRIDGE

[COURT OF APPEAL OF TRINIDAD AND TOBAGO (de la Bastide and Georges, J.J.A.),
February 7, 1972]

Criminal Procedure—Complaint—Ex parte hearing of summons—Conditions to be satisfied before proceeding to hearing—Discretion for absent defendant to appear by legal representative—No notice of adjourned hearing—Whether accused represented at all—Evidence of notations in magistrate's Proceedings Book—Whether legal representative at granting of adjournment unauthorised—Principles for setting aside conviction ex parte—Culpable neglect—Summary Courts Ordinance [T.], ss. 11, 12, 41, 57 (1), 63 (1), 119—Summary Offences Ordinance, Cap. 14, No. 17 [T.], s. 54.

The appellant was convicted in his absence of using obscene language to the annoyance of persons contrary to s. 54 of the Summary Offences Ordinance. He filed a notice of appeal against conviction and sentence on two grounds—that he had been denied natural justice and that he was not guilty. By his amended notice of appeal he pointed out that he had been served no notice of the adjourned date of the hearing (*i.e.* September 21, 1971) and therefore there had been a breach of natural justice.

Two main points arose for consideration:

(a) whether the magistrate's decision to hear and determine the complaint *ex*