

International Association Of Lions ... vs National Association Of Indian Lions ... on 29 March, 2006

Equivalent citations: 2006(33)PTC79(BOM)

JUDGMENT

S.U. Kamdar, J.

1. The present application has been initiated by the plaintiff inter alia for an injunction restraining the defendants from in any manner using the word 'Lion' or 'Lions' or 'Lioness' or 'Leo' or Leos or any other registered trade mark or service mark or association name of the plaintiffs or any other word mark identical with or deceptively similar to the character of the plaintiffs herein. Thus, by prayer (a) a passing off action has been initiated by the plaintiffs restraining the defendants from using the trade mark or trade name by using the aforesaid mark. By prayer (b) of the motion the plaintiffs are seeking in injunction restraining the defendants from using the said mark "Lion" or "Lions" or "Leo" or "Leos" or any other registered mark either as domain name or and/or e-mail address or any part of their domain name or part of their e-mail address so as to pass off or likely to pass off and/or enable others to pass off the association of the defendants and/or their associate clubs for the defendants and/or the activities, services and business of the defendants as if the same are the activities and business of the plaintiffs. By prayer Clauses (c) and (d) once again injunction is sought from using the word "Lion" and/or "Lions", "Leo" and/or "Leos" or from using the domain name "www.Indianlions.org". Some of the material facts in the present case, briefly sated, are as under:

2. The plaintiffs are known as Lions Club International having their principal office at Oak Brook, Illinois 60323 in the United States of America and also having their office at Arcadia Building, 10th floor, 195 Nariman Point, Mumbai 400 021, The plaintiffs are inter alia carrying on activities as a Lions Club of International and/or International Association of Lions Club. The plaintiffs are an international association established for the purpose of organising, chartering and supervising various service clubs known as "Lions Clubs" and to co-ordinate the activities and to standardize the administration of "Lions Clubs" members. Various activities of the plaintiffs are in the nature of charitable activities and the various functions are organised for charity. It is the case of the plaintiffs that there are about 44,450 Lions Clubs all over the world including the Lions Clubs in India. It is the case of the plaintiffs that in India the plaintiffs have over 1,55,000 members in over 4,300 Chartered Clubs and thus the plaintiffs are well known International Club having large deep rooted activities in India. The plaintiffs are thus well known organisation in India. It is the case of the plaintiffs that the children of the members of the Lions Clubs are treated as Leos and wives as Lioness. Some of the activities which are organised by the plaintiffs in India is to eliminate curable blindness. The plaintiffs also organise free operations of cataract. The plaintiffs have constructed hospitals for poor and needy as well as are running schools and colleges for underprivileged

students. The plaintiffs have also established vocational training centres and in the event of national disasters the plaintiffs gear up their organisations for relief operation work on behalf of various members. It is the case of the plaintiffs that the plaintiffs are using the mark Lion, Lions and Leo in relation to their services and their club and the emblem mark with picture of lion. The said mark was registered and adopted by the plaintiffs in the year 1921 and has been continuously used by the plaintiffs upto date. The plaintiffs have explained the mark when they accepted the said emblem. It is the case of the plaintiffs that the emblem as well as the mark Lion is recognised throughout the world and is associated exclusively with the plaintiffs.

3. It is the case of the plaintiffs that recently the plaintiffs found on obtaining a pamphlet in Hindi that a club of Ajmer is depicting the words INDIAN LIONS with the emblem and the picture thereof as set out in Exhibits J and J-1 to the plaint. They also found that the defendants have adopted the word LIONS and have adopted the emblem similar to that of the plaintiffs fraudulently and dishonestly. It is the case of the plaintiffs that the act of the defendants to use the word "LION" or emblem or trade mark or service mark of the plaintiffs and the user of the domain name www.indianlions.org, bizli.com and/or using their email address is totally dishonest and must be prevented because the defendants are seeking to pass off the activities of their Club as that belonging to the plaintiffs. On the aforesaid basis, the present suit is filed for injunction against the defendants.

4. On the present notice of motion being initiated, an issue of jurisdiction was raised by the defendants inter alia contending that this Court has no jurisdiction to entertain and try the present suit. By an order the matter was referred to the Commissioner for recording evidence. After the Commissioner recorded the evidence the matter was placed back before me and by my order and Judgment dated 25.1.2006¹ have held that this Court has jurisdiction to entertain and try the present suit. In the light of the decision which is delivered by me holding that this Court has jurisdiction, I have proceeded to decide the motion on merits.

5. The learned Counsel for the plaintiffs has contended that the adoption of the mark by the defendants is totally fraudulent and dishonest. The learned Counsel for the plaintiffs has relied upon the oral evidence led before the Commissioner which was even on merits though the issue of jurisdiction only was referred to him and has contended that the adoption of the mark or trade name or logo namely "Lions" as the part of their operations is illegal. The association is floated with the name the National Association of Indian Lions and the defendants are calling themselves as Bharatiya Lions. The defendant No. 1 describing itself as a national society of Indian Lions which is totally illegal and unlawful. It was been further contended that the words "Indian Lions" which are used by the defendants as a domain name is also totally illegal and unlawful. It has been contended that there is no dispute that the defendants are using the said words and thus user thereof is totally fraudulent. It has been contended that the plaintiffs are associated with the word "Lions" and "Leos" and "Lioness" for a very long time and having international reputation and thus the defendants are not entitled to use the said word other as trade name or trade mark or as any part of their domain name for organisation. The learned Counsel for the plaintiffs has also pointed out to me that the plaintiffs are using the said mark not only in respect of their name of association but they are also using the mark on the various articles which are distributed to the people such as books, stationery,

office requisites, diaries, calendars. He had further drawn my attention to the various paras and pages of the plaint Indicating that they are distributing the said diaries, booklets, calendars, etc., to the various people. Thus, it is contended by the learned Counsel for the plaintiffs that they are using the word "Lion", "Lioness", "Leos" not merely as the trade name but even exclusively using the same as a trade mark on various articles. It was also pointed out that even the persons who are members also call themselves Lions and thus the mark "Lion" is exclusively used by the Plaintiffs in relation to their activities and in relation to their articles which are distributed. The learned Counsel for the plaintiffs has further pointed out that certain activities described hereinabove are also conducted by the plaintiffs in the name of Lions Club and Lions activities and thus the plaintiffs mark "Lion", "Leos", "Lioness" in relation to the various emblem has acquired a huge reputation and thus, the defendants are not entitled to use those words in relation to the emblem and picture of the defendants in relation to their activities and/or their charity organisation. It has also been pointed out that the defendants have not given any explanation why they are using the mark Lion in relation to any activities. It has been thus contended that the defendants should be prevented by an order and injunction from using the said mark and the said domain name. In support of the aforesaid contention, the learned Counsel for the plaintiffs has relied upon the Judgment of the Delhi High Court in the case of Apple Computer Inc. v. Apple Leasing & Industries Vol. 18, No. 2, 1993 IPLR 63 : PTC (Suppl)(2) 45(Del) and the relevant portion is as under:

Passing off-- In order to prove prima facie case and balance of convenience it was not necessary for a plaintiff in a passing off action to carry on business in India; it was enough that the plaintiff had a reputation in India. It is not possible to accept the view that the defendant did not know of the existence of the "Apple Computers."

He has also relied upon the Judgment of the Supreme Court in the case of N.K. Dongre and Ors. v. Whirlpool Corporation and Anr. , particularly para 17 thereof.

He has also relied upon a Judgment of the Division Bench of this Court in the case of Kamal Trading Co. and Ors. v. Gillette U.K. Ltd. 1988 Vol. 12 IPLR 135 : 1988 (8) PTC 1 (Bom) (DB) at page 144 which reads as under:

Defendants unable to explain how the mark was invented by them. Entire conduct of the defendants is totally dishonest and fraudulent in using the mark "7 O' clock".

The "7 O'CLOCK' mark was used for tooth brushes by Defendants.

He has then relied upon the Judgment of the Delhi High Court in the case of Acqua Minerals Ltd. v. Pramod Borse and Anr. in which it has been held as under:

36. It is obvious and self-axiomatic that the domain name 'Bisleri' was chosen by the defendants with mala fide and dishonest intention and as a blocking or squatting tactic. The reply sent by the defendant that they are ready to forego with the domain name if they are compensated with the cost incurred by them for developing the site demonstrates that their sole object in getting the domain name registered was to seek

unjust enrichment and thrive upon the goodwill and reputation of the plaintiff. There is no doubt that not only unwary persons but even experienced persons are bound to believe that the domain mark BISLERI.com is certainly associated with the plaintiff.

The learned Counsel has thereafter relied upon the Judgment of the Apex Court in the case of Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd. 2004 (28) PTC 566 in which the Supreme Court has held that the domain name and email address are equal to trade mark and no person can use the same domain name and email address to as to pass off the business of the plaintiff as that of the defendant. He has relied upon paras 28, 29 and 33 of the said Judgment which reads as under.-

28. According to the respondent the word "Siffynet" which features both as its corporate name and in its domain names was derived from a combination of the first letter of the five promoters of the respondent, namely, Saleem, Ibrahim, Fazal, Fareed and Yusuf, and the word "net" implies the business of the respondent. The stand taken by the respondent is that it was not aware of the appellant's trade name and trading style 'Sify'. This is not credible for several reasons. In answer to the legal notice issued by the appellant no such case was made. The refusal of the respondent to comply with the demand notice issued by the appellant was based only on an alleged difference between the trade name, 'Sify' and 'Siffynet' and a claimed difference in the field of operation. The High Court has not also found that the respondent-company was unaware or ignorant, of the use of the trade name 'Sify' by the appellant. The reason put forward by the respondent for the choice of the word 'Siffy' as part of its corporate and domain names appears from the second written statement filed by the respondent before the trial Court where it has been said that the respondent company was the brain child of its founder Director, Mr. Bawa Salim and that the word 'Siffy' was invented from the first letteres of the five persons involved in the setting up of the respondent company. But only four names were given. The fifth name was given in the counter-affidavit filed in this Court. In the first written statement and the first answer to the interlocutory application of the appellant verified by Bawa Salim as Managing Director of the respondent, no such case as has been put forward now regarding the choice of the name "Siffy" was made out. In fact in the original written statement, the respondent had stated that though its domain name "was got registered in the name of one Mr. C.V. Kukar, now the said person does not have any connection with this defendant since the second defendant is no longer in existence as a partner (sic)". Thus, it appears that the respondent may originally have been a firm because C.V. Kumar, in whose name 'Siffynet' was registered has been described as a partner. Even if this inference is incorrect and the respondent was always a company, we are still not convinced as to the reason why the name "Siffy" was chosen by the respondent. If the originators of the company were the five persons, viz., Salim, Ibrahim, Fazal, Fareed and Yousuf why was the domain name of the respondent already registered as 'Siffynet' in the name of Mr. C.V. Kumar? Furthermore, the list of names provided by the respondent to support its case that 'Siffy' as an original acronym was based on the initial letters of the respondent; company's promoters seems unsupported by any evidence whatsoever. No document apart from a bare assertion that the five named individuals had any special collective role in the origination or promotion of the business has been filed. The appellant's interest based business was, from 1999, high profile. The evident media prominence to 'SIFT' and large subscriber base could have left the respondent in no doubt as to its successful existence prior to the adoption of Siffy as part of its corporate name and registration of Siffynet and Siffy.com as its domain names. It

would therefore, appear that the justification followed the choice and that the respondent's choice of the word "Siffy" was not original but inspired by the appellant's business name and that the respondent's explanation for its choice of the word "Siffy" as a corporate and domain name is an invented post-rationalisation.

29. What is also important is that the respondent admittedly adopted the mark after the appellant. The appellant is the prior user and has the right to debar the respondent from eating into the goodwill it may have built up in connection with the name.

33. The high Courts' finding that no prejudice would be caused to the appellant because it had another domain name was a consideration which might have been relevant if there was a case of bona fide concurrent use and where the right to use was co-equal. The doubtful explanation given by the respondent for the choice of the word "Siffy" coupled with the reputation of the appellant can rationally lead us to the conclusion that the respondent was seeking to cash in on the appellant's reputation as a provider of service on the internet. In view of our findings albeit prima facie on the dishonest adoption of the appellant's trade name by the respondent, the investments made by the appellant in connection with the trade name, and the public association of the trade name "Siffy" with the appellant, the appellant is entitled to the relief it claims. A different conclusion may be arrived at if evidence to the contrary is adduced at the trial. But at this stage and on the material before the Court, we are of the view that the conclusion of the High Court to the contrary was unwarranted.

He has also thereafter relied upon the Judgment of the Chancery Division in the case of *The British Diabetic Association v. The Diabetic Society and Ors.* 1996 Fleet Street Report page 1; *Ruston & Horn by Ltd. v. The Zamindara Engineering Co. , Marks & Spencer pic. v. One in a Million Ltd. and Ors.* 1998 FSR 265 and the Judgment of the Court of Appeal in the case of *British Telecommunications plc. v. One in a Million Ltd. and Ors.* 1999 FSR page 1. He has also relied upon the Judgment of the learned Single Judge of this Court in the case of *Rediff Communication Ltd. v. Cyberbooth and Anr.* AIR 2000 Bom 27 : 2000 PTC (20) 209(Bom). He has also relied upon the Judgment of the Delhi High Court in the case of *WWF International v. Mahavir Spinning Mills Ltd.* 1994 (14) PTC 250 (Del) to point out that even in case of social activities or charitable activities the principle of trade mark and trade name applies and no person is entitled to utilise the mark of another person even if such person is not doing business activities but only doing activities in charity. He has also relied upon the Judgment of the Delhi High Court in the case of *Aqua Minerals Ltd. v. Parmod Borse and Anr. .* He has relied upon the Judgment of this Court in the case of *The International Association of Lions v. Indian Lions* IPLR 2002 July page 337. Apart from relying upon the aforesaid Judgments, the learned Counsel for the plaintiffs has pointed out that in the course of evidence there are certain admissions which have been made by the defendants particularly as to the use of the word "Lion" and "Leos" in respect of the activities of the defendants. On the aforesaid basis the learned Counsel for the plaintiffs has contended that the plaintiffs are entitled to the action of passing of as well as infringement of trade mark because the mark of the plaintiffs is registered in respect of emblem. The learned Counsel for the plaintiffs has also relied upon the provisions and guidelines and particularly Sections 28 and 29 of the Trade & Merchandise Marks Act, 1958 to contend that the plaintiffs are entitled to the injunction even in respect of

emblem with the picture of Lion and the artistic work associated therewith it was contended that the plaintiffs invented the said artistic work in the form of emblem as far back as 1921 and the plaintiffs are therefore proprietor of the said emblem and said design and thus the defendants are not entitled to use the said emblem and the said logo though the word Lion, Lioness or Leo associated with the picture of Lion. He has in fact sought an injunction in respect of the domain name "Indian Lions" and prevent the defendants from using the word "Lion" in their domain name.

6. On the other hand, the learned Counsel for the defendants has contended that under Section 27(2) of the Trade Marks Act the plaintiffs are entitled to injunction in respect of passing off only in respect of those goods which are supposed to have been passed off by the defendants and sold in the market. He has submitted that in view of the fact that the plaintiffs are not selling any goods in the market, the question of passing off does not arise and thus the plaintiffs are not entitled to any injunction of passing off in relation to the said name Lion or Lioness. He has submitted that the passing off action is maintainable only in respect of the sale of the goods in the trade and the market and not in respect of activities of charitable kind or in the nature of the club. He has further relief upon the provisions of Sections 28 and 29 of the Trade Marks Act inter alia pointing out that the trade mark is in relation to goods and not services. He has further submitted that the plaintiffs are not entitled to any injunction in respect of passing off because the plaintiffs do not fall under any of the guidelines mentioned by the Apex Court in the case of Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd. 2001 PTC 300 (SO in which the broad guide-lines are get out for granting an injunction in the case of passing off of an unregistered trade mark. He submitted that since the case of the plaintiffs does not fall under any of the guidelines, the plaintiffs are not entitled to the action of passing off.

7. Insofar as the copyright is concerned, the learned Counsel for the defendants has submitted that under Section 29 of the Copyright Act the copyright registration is valid only for the period of 60 years. In the present case the plaintiffs have registered its copyright in the year 1921. The said copyright has in the meantime expired at the expiry of 60 years. In the case of international copyright the person is not entitled to any protection of the said copyright because the same is only valid for 60 years under the aforesaid section. In view thereof, it is submitted that the injunction sought by the plaintiffs cannot be granted and the notice of motion is liable to be dismissed.

8. I have considered the rival contentions between the parties. Insofar as the question of establishment of the reputation of the plaintiffs is concerned, the same is established beyond any doubt. The plaintiffs are the internationally well known organisation and are conducting activities on a very large scale. The plaintiffs have got large number of clubs in India and large number of people are their members and the club is closely associated with the plaintiffs and plaintiffs activities in India including the City of Bombay carried on a very large extent. The plaintiffs have thus acquired a huge reputation in the word Lion, Lioness and Leos in association with their names namely Lions Club of International. The plaintiffs have equally acquired a huge reputation in the emblem with picture of Lions on both sides. The Lion emblem is also well known in India. By virtue of the fact that the plaintiffs are carrying out its activities in social sector and even in charity sector the plaintiffs name and the emblem is associated with the plaintiffs and its activities. Thus, in my opinion, the question that whether the plaintiffs have acquired a reputation or not in the word Lion,

Lioness and Leo must be answered in favour of the plaintiffs. The plaintiffs also advertised the said word Lion, Lioness and Leos in relation to their activities in various newspapers and in pamphlets and posters. It is thus without any doubt clear that the reputation of the plaintiffs in the word Lion, Lioness and Leo and Leos has been the very huge reputation and, therefore, the plaintiffs are entitled to protect the same. Insofar as the contention of the defendants is concerned that the plaintiffs are not entitled to protection of a service mark because it is not in relation to any trade or well of goods and it is in relation to only the charity and services, in my opinion, the said submission must be rejected. In the case of *The British Diabetic Association v. The Diabetic Society and Ors.* (supra), Justice Walker of Chancery Division has held as under:

In the end the second issue comes down to a short, though not simple question of fact. The following are the main background matters that I bear in mind in approaching it.

(1) The business activities of the two charities are such that members of the public are most likely to come into contact with them by recommendation. Such recommendation will often be by word of mouth, whether in a hospital outpatients' department or a doctor's surgery, or in the course of a telephone call. Any half-recollection of a name may lead to a mistake, or may lead to reference to the telephone book or some other directory (which may or may not lead to a mistake). On any view the name is not of particular importance.

(2) The Association is a large and long-established charity with a loyal membership and a genuinely nationwide coverage. None of these factors gives it any right to a monopoly, but together they do mean that its reputation and goodwill are substantial. There is a likelihood of confusion with any other charity which aims to carry out similar activities on a nationwide basis, unless the two "charities' names are adequately differentiated. In determining whether the differentiation is adequate, I am entitled to take the Association's size, age and reputation into account.

(3) There is a limited range of descriptive names for a charity providing advice and help to diabetics in the United Kingdom (though Charity, Council, Federation, Fellowship, Institution and Trust are all possibilities). I have to take that into account, and accept that some risk of confusion may be inevitable (as it will be with the Foundation). But the defendants are not entitled (in the words of Oliver, L.J.) to make confusion worse confounded and Mr. Bennett indicated in cross-examination that he would have no qualms or objections about continuing, if he lawfully could, to ask for the Society to be considered for legacies whose destination was in any doubt.

Approaching the question in the way, I note that Mr. Pumfrey accepts that the Association still has a reputation and goodwill in its name as it was until 1954 ("Diabetic Association") as well as in its present name. The prefix "British" can therefore be put on one side, and the crucial issue is whether the single word "Society" is sufficiently differentiated from "Association", Unlike the words ("Services" and "Association") considered in the Office Cleaning case, the two crucial words in this

case are very similar in derivation and meaning, and not wholly dissimilar in form. There may be background circumstances in which the small difference between the two words might be sufficient-it is, as the authorities emphasise, a question of fact to be decided in all the circumstances of the particular case - but in the end I have reached the clear conclusion that it is not a sufficient differentiation in this case. For the Society to continue to use its existing name would in my judgment be deception, even if unintended, calculated to damage the Association's reputation and goodwill.

The Delhi High Court has taken a similar view in the case of WWF International v. Mahavir Spinning Mills Ltd. 1994 (14) PTC 250 (Del) in para 22 which reads as under:

22. So even if the plaintiff itself is not manufacturing and marketing the goods by itself even then the plaintiff as a licensor of trade mark is not debarred from bringing an action of passing off against the defendant when, prima facie, the plaintiff has shown that its licensee has been marketing the goods in trade mark PANDA in India. Mere fact that the plaintiff has never manufactured any products in this country does not prevent it from acquiring the goodwill here in its trade mark. It is no doubt true that an action for passing off relates to the business and it must be established that the plaintiff has a reputation or goodwill of his business in this country. The foundation for the action for passing off is to protect goodwill and so, one must prove the existence of goodwill in this country before obtaining a relief of passing off. The principle of law of passing off has been also made applicable to non-trading business or non-profit making bodies as well.

And in the case of The International Association of Lions Club v. Indian Lions Club and Ors., (supra) this Court has held as under:

It appears from the affidavit filed on behalf of the defendants that the members of the defendants were members of the plaintiff Club previously, they were dissatisfied with the work of the plaintiff Club in Mumbai and they therefore left their membership and they have formed their own club. It goes without saying that there is definite similarity in the name of the plaintiffs and the name of the defendants. If the defendants' organisation has come into existence because of the dissatisfaction with the working of the plaintiffs and if it was not the intention of the defendants to pass off their organisation as an associate of the plaintiffs, then there was no justification for the defendants to use 'Lion' in the name of their club. If their Club came into existence because of the dissatisfaction with the plaintiffs, then they would have tried to distance themselves from the plaintiffs and they would have adopted a name which cannot even remotely be connected to the plaintiffs. There was at all justification for using word 'Lion' in the name of their Club when everybody knows that the Lions Club is an international organisation in existence for last several decades. In my opinion, therefore, the use of the word 'Lion' in the name of the organisation of the defendants shows their intention to pass off their organisation as that of the plaintiffs. In this view of the matter therefore, in my opinion, the plaintiffs are

entitled to ad-interim order in terms of prayer Clauses (a) and (b). It is accordingly granted. At this stage, the learned Counsel for the defendants requested that the operation of this order should be stayed. It is however to be seen that by order dated 16th March 2001, ad-interim order in terms of prayer Clause (a) has already been granted because a statement was made by the defendants that the defendants will not take any steps to get renewal of their domain name. As the ad-interim order in terms of prayer Clause (a) is operating for nearly a month now, I see no justification for grant of this request. Notice of Motion is therefore disposed of.

9. In the light of the aforesaid judgments, it is not possible to accept the contention of the learned Counsel for the defendants that the plaintiffs are entitled to an injunction on the basis of a passing off only if they are carrying on business in relation to goods and not in relation to services. In my opinion, the plaintiffs are entitled to the injunction of passing off even if the plaintiffs are not trading in the goods in the market and are merely rendering services. I am also of the further opinion that the plaintiffs are distributing the goods such as calendars, diaries, booklets, etc. and while doing so they are using the mark Lion, Lioness, Leo or Leos and emblem. Merely because they are not doing so for profit does not mean that the plaintiffs are not entitled to protect their mark and this emblem. In that light of the matter, the contention of the learned Counsel for the defendants that the plaintiffs are not entitled to injunction by virtue of the fact that the plaintiffs are not trading in the goods cannot be accepted and accordingly the same is rejected.

10. The next contention advanced by the learned Counsel for the defendants relying upon the Judgment of the Apex Court in the case of Cadila Health Care Ltd., (supra) is clearly without substance. In my opinion, in the present case the factors which are prescribed in the said Judgment are duly complied with both in relation to Clauses (b), (c) and (g) of the said para. The said para of the Apex Court judgement in Cadila Health Care Ltd., (supra) reads as under:

Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered

(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.

(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trade marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to

exercise in purchasing and/or using the goods.

It is clear that the mark which is being used by the plaintiffs having acquired reputation the defendants are trading upon the reputation of the plaintiffs as an international club and, therefore, the plaintiffs are entitled to injunction. The contention of the learned Counsel for the defendants based on the Judgment of the Supreme Court in the case of Cadila Health Care Ltd. (supra) is without any merit and without any substance and the same therefore requires to be rejected.

11. The next contention of the learned Counsel for the defendants that the plaintiffs are not entitled to any action on the basis of copyright under the Copyright Act because the plaintiffs mark has expired because it was registered in 1921 and 60 years have expired and that the plaintiffs mark being international mark is not entitled to protection after the period of 60 years. In my opinion, the said submission is devoid of any merit. In my judgment, which I delivered while determining the issue of jurisdiction I have dealt with the aforesaid argument and I have rejected the very same contention which was advanced by the learned Counsel for the defendants and while doing so I have held as under:

14. The next contention which has been advanced by the learned Counsel for the defendant is based on Section 29 of the Copy Right Act which inter alia prescribes that the registration is valid only for a period of 60 years from the date of the next calender year after the date of registration in case of international trade marks or brand names and in the present case the copy right registration having expired a suit on infringement and/or passing thereof is not maintainable. I am of the opinion that the said contention is without any substance. Firstly there is no foundation in support of the factual data that infact registration has expired in 1982 i.e. 60 years from 1922. The only reliance placed is in respect of one question which was asked to P.W. No. 1 during his cross examination in which he has deposed that their copy right registration is of the year 1922. There is no foundation or further cross examination inter alia in respect of expiry of registration of the said copy right or non-renewal thereto so as to non-suit the plaintiff. Mere oblique question raised in an examination in chief without any foundation being laid in support of the arguments to be advanced before the Court cannot be treated as an evidence to hold that infact the registration has expired in 1982. Mr. Shah learned Counsel for the defendant has contended that the witness has not deposed further that the said registration is subsisting and valid and the same is renewed and, therefore, this Court must infer that the registration has expired in 1982 and thus the suit for passing off of copy right is not maintainable. The submission in my opinion is without any merits. Once the question is asked about the year of registration of the copy right mark by the defendant to the P.W. No. 1 then it was the duty of the defendant No. 1 to proceed further and cross examine the witness and ought to have questioned whether the said copy right registration is subsisting or expired. Apart therefrom I am of the opinion that registration of a design for copy right is not a sine-qua-non. Insofar as the suit for passing off for the copy right design is concerned. The proprietor or owner of the copy right is entitled to maintain the suit without its design is registered for copy rights under the said Act.

The registration thereof is only a prima facie evidence of a ownership of such a copy right design. In a Book 'Law of Copyright and Industrial Designs', Third Edition, P. Marihuana on the Copy Right Act the learned author has opined as under:

24.25 Registration not compulsory: Although the Copyright Act under Section 44 provides for registration of a work in which copyright subsists, registration is not necessary to claim copyright. Copyright sunbursts as soon as the work is created and given a material form.

15. Under Section 54 an 'owner' is defined by an inclusive definition and includes an exclusive licensee or in the case of antonymous or pseudonymous literary, dramatics, musical or artistic work an author, publisher anchor author's legal representatives. Thus, an owner can always maintain a suit for infringement or passing off his copy right irrespective of the fact whether he has registered his design under the Copy Right Act or not. Thus, in my view the contention of the learned Counsel for the defendant that the suit as far as copy right is concerned is not maintainable because of expiry of registration in 1982 has no merits and thus the same is required to be rejected.

12. Thereafter, the learned Counsel for the defendants had contended that the defendant is a registered society and under the Memorandum of Articles and Association they are entitled to carry on the aforesaid activities. Once the defendant is a registered society and the memorandum and articles permit to use the word Lion, Lioness and Leo in relation to their activities it is contended that it is not open for the plaintiffs to file a suit for injunction either on the ground of passing off or on the ground of copyright and restrain the defendants from using the said words as a name of the society which is permitted by the Rajasthan Cooperative Societies Act. Insofar as the aforesaid submission is concerned, the said submission is also without any merit. Similar contention was advanced by the learned Counsel for the defendants also at the stage of the jurisdictional issue and I have rejected the same. Apart from the same, I am also of the view that by mere registration by a person under either the Companies Act or under the Cooperative Societies Act there is no right conferred on them to use the name of such a nature which is also a trade name or organisation name of some other person and trade upon the reputation of the other party. In the present case the defendants were well aware of the fact that the plaintiffs are well known international club with the name Lion. In fact some of the members of the defendants were also the members of the plaintiffs club and thus were well aware of the use of the word "Lion" by the plaintiffs. In spite of the same the adoption of the said name Lion and Lioness is totally dishonest on the part of the defendants and thus it is necessary that an injunction must be granted in favour of the plaintiffs and against the defendants herein.

13. This leads me to the last contention of the plaintiffs pertaining to the domain name and the email address which is being used by the defendants with the word Lion. Insofar as the domain name and email address is concerned, there is no dispute that the defendants are using the word in its domain name and also in its email address. There is also no dispute that the defendants are also using the word Lion in the email address. Insofar as the domain name and email address is

concerned, the law is consistent and settled by the Apex Court in the case of Satyam Infoway Ltd., (supra). Thus, it is necessary that the defendants have to be injuncted from using the domain name and email address with the word 'Lion' 'Leos' or 'Lioness' therein.

14. For the reasons aforesaid I am of the view that the plaintiffs motion must succeed. Accordingly, I make the Notice of Motion absolute in terms of prayer Clauses (a) to (e). The defendants shall also pay the cost to the plaintiff of the present Notice of Motion.

15. The learned Counsel appearing for the Defendants seeks stay of the present order. Stay granted upto 25.4.2006.