

Bikanervala vs New Bikanerwala on 31 January, 2005

Equivalent citations: 2005(30)PTC113(DEL)

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Bench: R.C. Jain

JUDGMENT

R.C. Jain, J.

1. This order will govern the disposal of IA 1138/2004, an application moved on behalf of the plaintiff under Section 135(2) of the Trade Marks Act, 1999 (in short "The Act") and Order 39 Rule 1 and 2 read with Section 151 CPC seeking an ad interim injunction against the defendant in a suit filed by the plaintiff under Section 27(2) of the Act read with Section 134(1) and 135 of the Act and Sections 51 and 55 of the Copyright Act, 1957 for permanent injunction restraining infringement of copyright, passing of and rendition of accounts. The suit has been filed with the averments and allegations that it is a partnership firm; the forefathers of the plaintiff's were in the business of manufacturing and marketing ethnic foods including sweets and namkeens for the last about 100 years and have inherited a vast treasure of recipes of traditional Indian sweets and namkeens developed and perfected down the generations. In the year 1981 the plaintiff established a major outlet in the capital at Karol Bagh, under a coined trade name / trade mark 'BIKANERVALA' which, as a whole, is inherently distinctive and was not being used by any competitor of the plaintiff firm before it was coined. The Hinglish expression 'BIKANERVALA' of the plaintiff due to its unique combination of English and Vernacular language and because of the goodwill and reputation generated by the plaintiff by its untiring efforts for more than two decades has been a runaway success amongst the trade and public and has succeeded in achieving an extremely high recall value in the minds of the intending purchasers and the consuming public at large and since then the plaintiff has grown by leaps and bounds and at present is one of the major traders in traditional sweets and namkeens in India along with its associate firms / companies and a number of retail outlets spread far and wide so much so that the said trade mark/trade name 'BIKANERVALA' has assumed a secondary significance and qualifies to be a well known and famous trade mark. It is further alleged that due to the extensive and wide user of the said coined trade mark / trade name 'BIKANERVALA', the same has become a household name which is recognized and hailed by one and all as a source of superior and impeccable quality of the sweets, namkeens and other cognate products originating from the plaintiff firm exclusively.

2. It is also stated that in the year 1992 the plaintiff adopted a distinctive and eye-catching artistic label titled 'BIKANERVALA' which artistic label in its essential features consists of alternate parallel strips of red and yellow in a rectangle, below which the trade mark/trade name / artistic work

'BIKANERVALA' of the plaintiff firm is written in a white script on a red background and further below which appears the device of 'Jhalar' having a distinctive alternate red and yellow colour combination thereto and such colour combination in itself also constitutes a separate trade mark of the plaintiff. It is alleged that the said artistic work of the plaintiff, which is fully depicted in Annexure-A, is duly registered under the provisions of the Copyright Act, 1957. Plaintiff in association with its sister concerns and franchisees/licensees has conducted sales in respect of its various products bearing the aforesaid trade mark for an amount of more than Rs. 300 crores and the combined turnover for the year 2002-03 alone exceeded more than Rs. 100 crores. The plaintiff further claims that such sales figures establishes the popularity, vast goodwill and reputation which the plaintiff's products have acquired amongst the trade and public and is indication of the tremendous amount of confidence which the trade and public has in respect of the products originating from the plaintiff firm, which in turn indicates that the said trade mark and the distinctive label/packageing thereto of the plaintiff have achieved the status of being well known trade marks.

3. The plaintiff has alleged that in the third week of February, 2004 it learnt that the defendant is running a sweet shop and restaurant at Janakpuri under an identical trademark / trade name/artistic work 'BIKANERVALA' as that of the plaintiff prefixing it with a small word 'NEW' and, therefore, the defendant is guilty of using a deceptively similar font as that of the plaintiff with a view to cause confusion and deception in the trade and public and to make unlawful and illegal gains. In view of the two competing names and of a deceptive similar font adopted by the defendant would show that the defendant has used the trade mark/trade name of the plaintiff as a model / guide while conceiving its trade name/trade mark 'NEW BIKANERVALA' and, therefore, is guilty of dilution of the trade mark of the plaintiff. It is claimed that the use of the trade mark by trade name/label 'BIKANERVALA' with prefix 'NEW' is visually, structurally and phonetically identical to the reputed trade mark/trade name/artistic label of the plaintiff in respect of its business and is bound to lead to confusion and deception amongst the purchasing public and trade. The mis-representation of the defendant is not only relatable to the origin of the goods but also to the quality as the defendant's products are of much inferior quality. It is alleged that the defendant has no justification for the adoption of the impugned trade mark/trade name/label of 'BIKANERVALA' with the prefix 'NEW'. It has done so to encash upon the tremendous goodwill and reputation of the renowned reputation and prior used trade mark/trade name/artistic label of the plaintiff. It is alleged that by using a deceptively similar mark and adopting a similar label, the defendant has also made itself liable for criminal offence(s) under the provisions of the Copyright Act and the Indian Penal Code. Further, the defendant is also obliged to provide the details of its various movable and immovable assets to this Court to ensure that the plaintiff is able to recover the cost and other pecuniary remedy, if and when granted, are not rendered infructuous. On the above averments and allegations, the plaintiff has sought the relief of perpetual injunction for restraining the defendant, its servants, retailers, stock its, distributors, representatives and agents from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in food articles for human consumption under the impugned trade mark/infringing artistic work 'NEW BIKANERVALA', as appeared in Annexure-B to the plaint or any other artistic work which is identically and/or deceptively similar to the artistic work of the plaintiff and also from using the said trade mark with the prefix 'NEW'. Plaintiff has also sought an order for rendition of accounts of profits illegally earned by the

defendant; for an order of delivery for the purposes of destruction of all the impugned polybags, labels, dies, boxes, cartons, paper bags, menu cards, wrappers, banners, hoardings etc and also for perpetual injunction for restraining the defendant from using the trade mark 'BIKANERVALA'.

4. Along with the suit, the plaintiff filed an application for grant of ad interim injunction to the same effect as in the suit during the dependency of the suit.

5. The defendant being noticed, has contested the suit and the application for grant of ad interim injunction and has filed its written statement and reply raising preliminary objections about the maintainability of the present suit on the ground that the plaintiff has falsely claimed the expression 'BIKANERVALA' to be a trade mark in respect of food articles for human consumption; the expression 'BIKANER' is a well known geographical city of Rajasthan, which is known and recognized for a particular type kind of food articles for human consumption and, therefore, in reference to the city of Bikaner in respect of food articles for human consumption is indicative and serve in trade to designate geographical origin, character, quality, variety, type and kin of the product, originating there from or having connection thereof. It is also stated that the expression 'BIKANER', whether used independently or in conjunction with any prefix or suffix and particularly the suffix 'VALA' does not make any difference to the generic character of the name of city of BIKANER in respect of such goods. The expression 'BIKANERVALA' conveys definite and specific meaning in ordinary language so as to indicate the origin of the person of the product from Bikaner and the expression BIKANER and/or BIKANERVALA are thus generic, laudatory and descriptive which are used openly and extensively not only in the city of Bikaner but also in various other parts of the country with reference to the food articles for human consumption. It is also pleaded that these names have become customary in the current language in relation to the business of articles of human consumption. The plaintiff, therefore, cannot claim monopoly of such expression to the exclusion of the entire trade and the same cannot be claimed to be a trademark or capable of being used as a trade mark. The defendant has also stated that the expression(s) BIKANER or any other expression derived there from, including 'BIKANERVALA' when used in respect of food articles for human consumption does not indicate that the said goods are originating from a particular manufacturer but the same indicates that the said goods or the manufacturers are either originating from the city of BIKANER or are of BIKANER style/taste or are connected with the city of BIKANER in one or the other manner. Yet another objection of the defendant is that the expression 'BIKANERVALA' cannot be said to be innovative or original or coined expression developed by the plaintiff in respect of food article for human consumption and, therefore, the suit of the plaintiff for the relief of passing off is not maintainable. It is also stated that the suit of the plaintiff for the relief of infringement of copyright is also not maintainable on the ground that the plaintiff has made vague claims in the plaint and has failed to show the subsistence of any valid copyright or ownership therein in its favor and further that the plaintiff does not have any copyright in the packaging material or script of alphabets and is not entitled to claim any relief in respect thereof. It is also stated that the suit has not been signed, verified and instituted by a duly authorised person on behalf of the plaintiff. The allegations in regard to the plaintiff being in the business of sweets since the time of his forefathers and having acquired a tremendous reputation and goodwill and had a turnover of more than Rs. 300 crores till date or that the combined turnover for the year 2002-03 was more than Rs. 100 crores are denied. Each and every allegation made in the plaint in regard to

the defendant having adopted a deceptively similar mark with a view to cause confusion in the mind of the trade and general public as also the defendant having tried attempted to encash upon the tremendous goodwill of the plaintiff are denied. It is denied that the plaintiff is entitled to any of the relief claimed by it or a temporary or an ad interim injunction.

6. In the replication, the plaintiff has controverted the objections and pleas raised by the defendant in the written statement and has reiterated the averments made in the plaint and the application.

7. I have heard Mr. Ajay Sahni, learned counsel for the plaintiff and Mr. Amarjeet Singh, learned counsel representing the defendant at length and have given my thoughtful consideration to their rival submissions. This Court at the moment is concerned with the application for grant of ad interim injunction and therefore, this Court is required to take only a prima facie view of the matter so as to see if the plaintiff has been able to make out a good case in its favor for grant of such an injunction. In view of the rival contentions put forth on behalf of the parties, the foremost question which this Court is called upon to consider and determine is as to whether the expression 'BIKANERVALA' constitutes a valid trade mark/trade name and is capable of projection under the provisions of the Trade Mark Act or under the common law. It may be stated at the very outset that Mr. Ajay Sahni, learned counsel appearing for the plaintiff has fairly stated that the plaintiff has no objection to the defendant or any other person using the word/mark 'BIKANER' or 'BIKANERI' etc. either as a part of their trade name, but his submission is that once 'BIKANER' is suffixed with the word 'VALA', the combined word 'BIKANERVALA' becomes a coined and innovative word and the plaintiff had exclusive right to use the same even if the same contains the name of a city. This contention is based on the submission that under the common law of passing off, there are no exceptions by way of any geographical and or descriptive names which may constitute a disqualification for statutory registration. According to him, the primary duty of the Court would be to examine as to who is the prior user of the said trademark and whether there is any likelihood of confusion and deception among the trade and public. He has supported his submissions by giving illustrations of various manufacturers of automobile lubricants/oils in India who have legitimately used the trade mark/trade name such as 'BHARAT PETROLEUM', 'INDIAN OIL' etc.; in relation to the textile 'GWALIOR', 'BHILWARA', 'BOMBAY DYEING', 'DELHI CLOTH MILLS (DCM)' and in relation to publications of local reports such as 'DELHI LAW TIMES', 'ALL INDIA REPORTER', 'MADRAS LAW JOURNAL' etc. According to him, use of these marks by these persons would show that despite the inclusion of the geographical name, they could be used as trade names / trade marks. He has also invited the attention of the Court to a similar trademark like 'KABULIWALA', 'DERAWALA', 'CHURIWALA', 'ROHTAKWALA' etc. published in the Trade Mark journals and which have also been granted registration.

8. In order to show that the plaintiff has been using the trademark/tradename 'BIKANERVALA' for a long period i.e. ever since 1981 and that the said mark along with the artistic work of carton has been registered under the Copyright Act ever since 2000, he has invited the attention of this Court to various documents. Plaintiffs have filed copies of registration certificate issued under Central Sales Tax and the Delhi Sales Tax Rules in the name of the plaintiff firm 'BIKANERVALA' issued by the concerned authorities for the period 1981; copies of plaintiff's registration certificate of its establishment; assessment order of the Income Tax for the year 1982-83; sample invoices issued by

the plaintiff from the year 1997 onwards; copies of the bills and invoice in respect of various advertisements issued by the plaintiff firm from time to time; sample copies of the advertisements issued by the plaintiff in the print media from time to time in order to show that the firm is in existence and is registered with the concerned authorities with the name of 'BIKANERVALA'. A copy of the certificate dated 13.12.2000 issued by the Copyright Office, Govt. of India along with the artistic work has also been filed on behalf of the plaintiff. Mr. Amarjeet Singh, learned counsel representing the defendants has not seriously disputed these documents and, therefore, even in absence of the same having been formally proved on record and they being the copies of public documents can be safely relied and acted upon, at least, at this stage of the proceedings. A perusal of these documents would prima facie establish that the plaintiff firm is registered under the name of 'M/s Bikanervala' and has been in existence since 1981 and is carrying on the business of sweets etc. under that name and style and had also been using the name/mark 'BIKANERVALA' on the cartons, wrappers and advertisements used for the sale and publicity of their goods. The artistic work containing the said word 'BIKANERVALA' in a particular style/font appearing in an artistic work with red and yellow strips and a jhallar is registered with the Registrar of Copyright.

9. So far as the defendant is concerned, it is not disputed by Mr. Amarjeet Singh, learned counsel for the defendant that the defendant has started using the trademark 'NEW BIKANERVALA' since 2004 only. Therefore, in that view of the matter, it can be safely held that the plaintiff is the long, prior and extensive user of the mark 'BIKANERVALA' in relation to its goods. Since it has not been shown on record that this mark 'BIKANERVALA' in the above form of the artistic work had been used by the defendant or by any other manufacturer or seller of sweet meats either as such or with a prefix or suffix word, therefore, it can also be presumed that the plaintiff had coined and adopted the said mark/trade name 'BIKANERVALA' in respect of its business of manufacturing and marketing of food products for human consumption. There is also prima facie sufficient material on record to hold that by extensive user of the trademark/trade name 'BIKANERVALA' the plaintiff's has a large turnover running into hundreds of crores of rupees during preceding few years.

10. In support of his contention that the plaintiff has an exclusive right to use the trademark 'BIKANERVALA' even if the same contains a geographical name/name of a city, Mr. Shane has emphatically urged that under the common law of passing off there are no exceptions by way of any geographical and/or descriptive names, which may constitute disqualification for statutory registration and the primary duty of the Court would be to examine as to who is the prior user of the said trademark and whether there is any likelihood of confusion and deception being caused among the trade and public. To support his contention, Mr. Shane has placed reliance on a number of decisions of the Apex Court and various High Courts.

11. The first in the series is a Karnataka High Court decision in the case of *The Nilgiri Dairy Farm v. A.Rathnasabhapathy*, 1975 (2) Kar.L.J. 505. The said case related to the trademark 'Nilgiri Dairy Farm'. One of the contentions raised on behalf of the defendant was that since Nilgiri was a geographical name and 'Dairy Farm' was descriptive of the business, the same could not form a valid trademark. The Court on a consideration of the matter held that though the word 'Nilgiri' was a geographical name and 'Dairy Farm' was descriptive of the business, the name 'Nilgiri Dairy Farm' had become a trade name to the extent necessary to maintain an action of passing off and as the

plaintiff had acquired a valuable reputation, the Court would restrain the unauthorised use of that name and mark in a manner calculated to deceive the public and cause damage to the plaintiff. In para-22 of the judgment, the Court had held as under:

"It cannot be forgotten that what is important is that rights are limited to particular goods or business associated with the name or mark. The plaintiff cannot be permitted to complain against the use of the name 'Nilgiri' or 'Nilgiris' by other trader manufacturing some other goods with which he is not concerned. The learned II Addl. District Judge has totally ignored all these aspects and has been simply carried away by the fact that 'Nilgiri' is a geographical name of District and 'Dairy Farm' is description of a business. He ought to have borne in mind as to in relation to what products the trade name and the trade mark have been used."

12. The next case relied upon is a Gujarat decision in the case of Bharat Tiles and Marble Private Ltd. v. Bharat Tiles Manufacturing Company, 1978 Gujarat Law Reporter 518 which lays down a principle of law that mere fact that geographical descriptive name adopted is not always a defense in a 'passing off' action. The Court has also reiterated the settled position that name of the business can also be a trade name. The following observations are relevant:

"The relevant principles which the Court should bear in mind in passing off action are well known and settled by the authorities. The name under which a business trades will almost always be a trade mark and it is also considered difficult, if not impossible to distinguish between the trading business and a trade name. It is no doubt true that where the trade name of an individual businessman is geographically descriptive, the mere fact of adoption of the same or similar geographically descriptive trade name would not by itself establish a cause for the relief in a passing off action. The aggrieved party has to prove that the use by the rival party of his trading style is calculated to lead to the belief that the business of the rival party is the business of the aggrieved party. Merely because a trade name is geographically descriptive, it cannot be urged successfully that the proprietor of that trade is not entitled to succeed in a passing-off action, provided he is able to establish the requisite grounds of deceit by the use of similar name, though it may be a relevant consideration when an application for registration is made under Section 9 of the Trade and Merchandise Marks Act, 1958. It is equally significant to note that the name of a business will acquire a goodwill in course of time and the Courts always protect them. The passing off action would certainly lie at the instance of a business man, if his rival carries on his business in the name which is calculated to deceive or which may divert the business from the plaintiff to the defendant or it may occasion a confusion between the two businesses."

13. Heavy reliance has been placed on a decision of this Court in the case of Sunder Nagar Association Regd. And Anr. v. Welfare Cultural Club (Regd.) and Anr., 1995-PTC-270. In that case the Court considered the question if the name 'SUNDER NAGAR DEWALI MELA' has come to be associated with the plaintiffs on account of the event under this banner having been held year after

year on Saturdays/Sundays preceding Dewali festival acquiring enough goodwill and commercial significance and the defendants by using the name 'SUNDER NAGAR DIWALI MELA' wanted to make use to their advantage of the plaintiff's goodwill. The Court took note of the observations made in para 169 of Vol.48 (Fourth Edition of the Halsbury's Law of England), which is to the following effect:

"Even though it might be possible for a geographical name to be used with adequate distinction in a way which is not deceptive, a name originally purely geographical in its significance may become so associated with the plaintiff's goods or services that its use on its own as a trade mark or name without adequate distinction will amount to passing off, especially if it is used in conjunction with get-up or other indic similar to that used by the plaintiff."

14. Again, reliance is placed on a decision of a learned Single Judge of this Court in the case of Geepee Ceval Proteins and Investment Pvt. Ltd. v. Saroj Oil Industry, 2003 (27) PTC 190 (DL) where in para-4 the Court referring to several earlier decisions and contentions of the parties concluded as under in para 7 and 8 of the judgment:

"7. The suit is for passing off the goods manufactured by the defendant in the name of 'Chambal Deep' s that of the goods manufactured and sold by the plaintiff under the trademark 'Chambal'. It is not a case of the infringement of a registered trademrk. The applications of the plaintiff and the defendant for registration of their respective trademark 'Chambal' and 'Chambal Deep' are pending. According to plaintiffs allegation it is using trademark 'Chambal' for selling its edible oil products since 1997. It has also referred to the figures of sale turn over since 1997 which showed that its sale turn-over had tremendously increased over the years from Rs. 113 crores in 1997-98 to Rs. 240 crores in the years 2001-02. The plaintiff also mentioned the amount incurred on the advertisement of its product under the trade name 'Chambal' in print and electronic media, which is substantial."

"8. The word 'Chambal' is a geographical name and a geographical name can be registered as a trade mark if its distinctiveness is proved. Therefore, Section 9 of the Act does not put a blanket ban on the registration of a geographical name as a trademark. Moreover, the present case is based on passing off the goods of the defendant as that of the plaintiff's goods, therefore, Section 27 of the Act would save the action of the plaintiff."

15. Mr. Sahni has also referred to an earlier decision of this Court in the case of M/s Hindustan Radiators Co. v. M/s Hindustan Radiators, 1987-PTC-73 wherein the Court having regard to the facts and circumstances of that case, more particularly, the enormous sales made and advertisement expenses incurred by the plaintiff, held that:

"Keeping in view the enormous sales and advertisement expenses by the plaintiff, it is held that the trade name 'Hindustan Radiator Co. and the trade mark Hindustan

Radiators H.R." have become distinctive of the plaintiff and consequently the user of the trade name 'Hindustan Radiators' Limited, by the defendant was likely or calculated to deceive or cause confusion and injury to the business reputation of the plaintiff. The plaintiff having established a prima facie case, balance of convenience would follow even otherwise the question of balance of convenience would arise only when the parties are practically on the same level where the plaintiff's position is superior there is no difficulty to hold that balance of convenience lies in the grant of ad interim injunction and accordingly the defendants, their agents, stockists and all other persons on their behalf are restrained during the pendency of the suit to use the trading style 'HINDUSTAN RADIATOR H.R.' in respect of their radiators in any manner whatsoever or to pass off their business and goods as the business and goods of the plaintiff".

16. Mr. Sahni, learned counsel for the plaintiff has then urged that the plaintiff can succeed in a passing off action even if the plaintiff uses a descriptive trade mark and in support of his contention, he has placed reliance upon the following decisions:

- 1) In Info Edge (India) Pvt.Ltd.and Anr v. Shailesh Gupta and Another, 2002 (24) PTC 355(Del);
- 2) In Prakash Metal Works v. M/s Square Automation (P) Ltd., (1992-PTC-29);
- 3) In Charan Dass and M/s Veer Industries (India) v. M/s Bombay Crockery House, 1984-PTC-102; and
- 4) In Ziff-Davis Inc. v. Dr.D.K.Jain and Ors., 1998 PTC 739.

In the first case the domain name 'NAUKRI.COM', which was developed and adopted by the plaintiff in 1997 was in question though the Court found that the said name was generic or descriptive, still it was capable of protection against passing off. The adoption of such a name by the defendant with a minor mis-spelling of the plaintiff's mark indicated dishonest intention and action on the part of the defendant which appeared to have been done with bad faith in order to gain advantage of spelling error made by the internet user while attempting to enter into the plaintiff's internet address on their web browser. In the case of Charan Dass and M/s Veer Industries (India)'s case (supra) it was the word 'PERFECT' which was the subject matter of the trade mark In that case the Court rejected the defendant's contention that whenever there was a disclaimer with respect to a particular word, no right to exclusive user with respect to that word can be acquired and no action on the basis of principle of 'passing off' can be brought. The Court held that disclaimer does not, in any manner, debar acquiring of a right to exclusive use of a word in the trade mark, otherwise than by registration and the defendant should be restrained from passing off his goods with that of the plaintiff. The Court reiterated the well established principle that the right against 'passing off' does not arise out of registration of a trade mark but is independent.

17. Mr. Sahni has also urged that the trade mark 'BIKANERVALA' of the plaintiff has to be considered as a whole and it is not permissible to split up the trade marks into its constituent parts and, therefore, the use of the said trade mark / trade name 'NEW BIKANERWALA' constitutes passing off. In this connection he has heavily relied upon a decision of this Court in the case of *Globe Super Parts v. Blue Super Flame Industries and Another*, 1986 PTC 235. The Court considered the mark 'SUPERFLAME' in respect of gas appliances and held that sufficient skill and labour had been expended upon the creation of said word, the word has to be considered as a whole and it is not permissible to dissect it into component parts. The Court, therefore, held that the use of the word 'Blue Superflame' by the defendant in their trading style was with a view to trade upon the name and reputation of the plaintiff and, therefore, the plaintiff was entitled to permanent injunction restraining the defendant from using the word 'SUPERFLAME' in the name of their business.

18. In the case of *Parle Products (P) Ltd. v. J.P. And Co., Mysore*, PTC (Suppl) (1) 346 (SC) the Apex Court held that in order to come to the conclusion whether one mark is deceptively similar to another, they should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. In another case *Laxmikant V. Patel v. Chetanbhat Shah and Anr.*, 2002 (4) PTC 1 (SC), the Hon'ble Supreme Court reiterated the general principle that refusal to grant an injunction in spite of the availability of facts, which are prima facie established by overwhelming evidence and material available on record justifying the grant thereof, occasion a failure of justice and such injury to the plaintiff would not be capable of being undone at a latter stage. It is also equally well settled that the use of a similar trade mark/trade name by third parties is not of much relevance in deciding the issue between the plaintiff and the defendant.

19. Mr. Amarjit Singh, learned counsel for the defendant has not seriously disputed the above legal propositions which emerge from the catena of decisions rendered by the Supreme court and various High Courts but his main contention is that the defendant is not entitled to claim an exclusive right to the use of the expression 'BIKANERVALA' in a combined form on the basis of a claim of priority in adoption and user under the common law. His contention is based on the submissions that Bikaner is a well known geographical name and the city of Bikaner is known for its food articles for human consumption and the expression 'WALA' or 'VALA' has no trade mark value as the said expression is purely laudatory and it refers to the person or the product from the city of Bikaner. According to him, no person is entitled to claim an exclusive right to the use of the word either 'BIKANER' or 'WALA' either independently or in conjunction. In this connection he has referred to the provisions of Section 9 of the Trade marks Act, 1999 which prescribes registration of the trade mark in the nature of geographical names or which have direct reference to the character and quality of the goods. He also submitted that geographical names which have no reference to the character or quality of the goods or geographical indication may qualify to be a trade mark subject to the proof of the said mark having acquired a secondary significance on account of long and exclusive use. In this connection he tried to prove his point by giving the examples of Kullu for Shawls, Kohlapuri for Chapples, Kanjipuram for Silk, Darjeeling for Tea, Agra for Petha etc. He further submitted that it may be permissible to use Kullu for Perfume, Kohlapuri for Tea, Darjeeling for

Motor Parts etc. In their words, his contention is that no monopolistic right can be claimed to the use of the geographical name like Bikaner and, therefore, the use of the word 'WALA' in conjunction with Bikaner would not alter the position.

20. In support of his above contention he has heavily relied upon a Calcutta High Court (Division Bench) decision in the case of I.T.C. Ltd. v. Registrar of Trade Marks and another, PTC (Suppl)(2) 533 (Cal)(DB). In that case the Registrar of Trade Marks had rejected the application of the petitioner for registration of the mark 'SIMLA' in Part A of the Register in relation to the cigarettes manufactured by the petitioner. The decision was challenged in the High Court and the Court reiterated the genera position that in determining whether the mark is distinctive or capable of distinguishing, the Tribunal shall be regard if the mark is inherently distinctive or his inherently capable of distinguishing. The Court held that 'SIMLA' is too prominent a city, the capita of Himachal Pradesh, well known in the country and abroad and in its ordinary or geographical significance it is inherently neither distinctive nor adapted to distinguish also nor capable of distinguishing the goods of the appellant as a particular trader from those of others, and was also hit by the provisions of Section 9 of the Trade and Merchandise Marks Act, 1958.

21. The next case relied upon is a Madras High Court decision in the case of R.S.K.V.Raghavan as R.S.Krishna and Co., Mayuram v. G.R.Gopal and Co. and others, where the Court was considering the mark 'THENNAMARAKKUDI' in relation to the medicinal oil preparations called Thennamarakkudi Oil and the Court held that the applicant could not claim any exclusive right to use the word 'THENNAMARAKKUDI'. Reliance is also placed on the famous English cases of Liverpool Electric Cable Company, 4 RPC 99; Yorkshire Copper Works Limited, 71 RPC 150 and A.Bailey and Co. Ltd. v. Clark, Son and Morland, Ltd, 55 RPC 253. In Liverpool's case the Court held that the word 'LIVERPOOL' was not prima facie capable of distinguishing those cables or of becoming istinctive of them and further that Liverpool was one of a class of geographical names which were of such importance that the name ought not to be registered to any one trader. It further held that the word 'LIVERPOOL' and the phrase 'LIVERPOOL CABLES' eant not the cables of the appellant alone, but the cables manufactured or dealt in at Liverpool.

22. The next submission of Mr. Amarjeet Singh is that the word 'BIKANERVALA' for Bikaneri sweets, namkeens and bhujia etc. is common in trade/generic expression/publicie jurice etc. which, irrespective of the length of use, cannot acquire any degree of distinctiveness in the market. In this connection he has referred to the following cases:

- 1) In Sant Kumar Mehra v. Ram Lakhan, 1999 PTC (19) 307;
- 2) In Aviat Chemicals Pvt. Ltd. and Anr. v. Magna Laboratories (Gujarat) P.Ltd. And Anr., 2002 (24) PTC 231 (Del);
- 3) In M/s Uttam Chemical Udyog, Ballabgarh v. Shri Rishi Lal Gupta, trading as Rishi Soap Works, Ballabgargh, 1981 PTC 137;
- 4) In Manish Vij and Ors. v. Indra Chugh and Others, 2002(24) PTC 561 (Del); and

5) In SBL Ltd. v. Himalaya Drug Co., 1997 PTC (17) 540 (DB).

In all these cases the Courts were considering the question as to whether a generic or descriptive name which indicate the origin of the product could receive the protection against passing off and the Court answered in the negative.

23. Heavy reliance is also placed by the learned counsel for the defendant on the judgment of the Division Bench of this Court in the case of Girnar Food and Beverages Pvt. Ltd. v. Godfery Phillips India Ltd., 2001 PTC 360. In that case the learned single Judge of this Court had granted an ad interim injunction by recording the following findings:

"(a) That the legal position is that when the trade mark consists of words or device descriptive or laudatory of the goods prima facie not distinctive in relation to the goods to which it are applied no right of property can be said to have been acquired in the trademark so as to entitle the holder to seek restraint on others from the use of it on similar goods. The words which are descriptive of goods are not prima facie considered distinctive. It is required to be established by evidence that the mark as a result of sufficient use has become distinctive and come to denote the goods of the trader using it and none else. Consequently the length of the user is a determinative factor for the mark to become distinctive. Once it is established that the defendant's action will lead to passing of his goods as that of the plaintiffs, it can be assumed that the natural consequences of the defendant's action would cause damage to the plaintiff's business;

(b) That the mark SUPER CUP is prominently displayed in the plaintiff's product marketed under the umbrella mark 'TEA CITY' in capital letters over a circle which contains a cup and saucer on a triangular board and 'TEA CITY' does not occupy such a prominent position. Affidavits averring the purchase of SUPER CUP by the dealers have been filed by the plaintiff ordering the tea as SUPER CUP brand tea;

(c) That the plaintiff's trade mark is SUPER CUP and SUPER is a laudatory word and does not have a secondary meaning;

(d) That however when the mark Super is used in conjunction with the word 'cup' both the words have to be considered as a whole and not separately. Words like SUPER TASTE, SUPER FLAVOUR, SUPER TEA, SUPER FINE TEA, SUPER QUALITY TEA may have direct reference to the character or quality of tea but these words cannot have a secondary meaning even by long user. However, the words SUPER CUP have no such direct reference to the character or quality of tea and any indirect reference will not make it a laudatory word or incapable of having a secondary meaning and this mark cannot be said to be a purely laudatory or descriptive one.

(e) That even if there is an indirect reference to the quality or character of the goods the mark is capable of acquiring a secondary meaning by its use by traders as well as

customers/public.

(f) That material on record prima facie shows that the plaintiff has been selling tea under the brand name of SUPER CUP with the device of cup and saucer under a umbrella mark 'TEA CITY' since 1988 and there have been substantial sales and substantial amount spent on advertising by the plaintiff;

(g) that the trademark SUPER CUP identifies the goods of the plaintiff.

(h) That the defendant's own case was that from 1975 till July, 1995 goods were sold by them under the trade name of Girnar when the word 'Super Cup Tea' and the device of cup and saucer was added alongside the trade mark Girnar.

(i) That no plausible explanation was given from the defendant's side for adopting SUPER CUP with the device of cup and saucer;

(j) That the basic features of the two marks have deceptive similarities or likely to cause confusion among the unwary consumers/customers and the trade;

(k) That the defendant cannot be said to have acted honestly in the absence of a plausible explanation;

(l) That it is a reasonable inference that the sole object of the defendants is either actually misleading the public or taking undue advantage of the good-will in the trade of the plaintiff;

(m) That the defendant's action are calculated to lead persons to believe that the goods of the defendant are the goods of the plaintiffs;

(n) A strong prima facie case has been made out by the plaintiff and the balance of convenience is also in favor of the plaintiff. Simultaneous use by Godfrey Phillips and M/s Girnar Food of the mark SUPER CUP is bound to lead to confusion in the trade cause irreparable loss to the business and goodwill of the plaintiff. Plaintiff was using the trade mark since 1989 and defendant started using it since July, 1995;

(o) That the defendant had been using Girnar for the last 20 years and no irreparable injury is going to be caused to them by the injunction and restraining them from using SUPER CUP accordingly."

24. On the basis of the contentions raised on behalf of the parties in appeal, the Division bench framed the following two questions:

(i) Whether the words 'Super Cup' adopted by the plaintiff / respondent are descriptive in nature and the word 'Super' is laudatory of the Cup and not of tea? And

(ii) Whether the defendant has given a plausible explanation for adoption of 'Super Cup' by it as a part of its mark."

The same were answered by the Court in para 15 and 16, relevant portion of which may be extracted below:

"15. On the other hand there is no objection by the respondent /plaintiff to the user of the word 'Super' by the defendant. It is only the conjunction or the word 'Super' and 'Cup' which has been found objectionable by the respondent/plaintiff as according to the plaintiff/respondent this is an attempt to derive unfair benefit of the reputation earned by them in the market place by the sustained quality of their product. The plaintiff/respondent has contended that the adoption of the combination of the words 'Super Cup' is inspired by a desire to derive unfair benefit from the reputation and goodwill of the plaintiff's products which had been successful in the market for about 7 years before its success persuaded the defendant/appellant to pick it up. The plaintiff/respondent has contended with great emphasis that the word 'Super' was descriptive of the word 'Cup' and not of 'tea'.

16. In so far as plaintiff's claim for secondary meaning is concerned, there is substance in the defendant's plea that the plaintiff's plea regarding acquisition of secondary meaning by the term 'Super Cup' was not averred either in the "Cease and Desist". Notice given to the defendant or in the plaint and no sufficient documentary evidence barring few invoices has been filed by the plaintiff/respondent. However, we have considered the case on the basis of the plaintiff's plea that Tea City is an umbrella brand of its various tea products and the mark of the plaintiff said to be violated is 'Super-Cup'. In fact the perusal of the various brands of tea marketed under the common name 'Tea City' by the plaintiff such as Symphony, Madhuban, Swan Lake and Samovar justifies the plea of the plaintiff that Tea City is the umbrella brand and the product whose trade mark has been said to be infringed bears the relevant mark 'Super Cup' which is required to be considered by us."

25. In para-17 of the aforesaid judgment the Division Bench considered the contention if the use of the word 'SUPER' with 'CUP' can acquire a secondary meaning. The Court held the view that whenever a reference is made to tea, invariably it is referred to as a cup of tea and that the common usage of cup is qua tea and not any other beverage. The Court held that if the word 'CUP' is a synonym for the words 'CUP OF TEA' in the English language, then it was obvious that the combination of the words 'SUPER' and 'CUP' cannot acquire a secondary meaning. The Court accordingly concluded that the terms 'SUPER CUP' is descriptive and laudatory of the goods of the plaintiff, therefore, the plaintiff was not entitled to an injunction.

26. The said decision of the Division Bench was the subject matter of appeal before the Apex Court in Civil Appeal No. 5611/2001 and has been disposed of by the Supreme Court vide an order dated 20.4.2004 whereby the Hon'ble Supreme Court remanded back the matter to the Division Bench with the following observations:

"Without going into the question whether the conclusion arrived at by the Division Bench that the trademark is descriptive is correct or not, it appears to us, and as is conceded by both parties before us, that the enunciation of principle of law with regard to the protection available even in respect of the descriptive trademark was wrong. A descriptive trademark may be entitled to protection if it has assumed a secondary meaning which identified it with a particular product or as being from a particular source. We, therefore, remand the matter back to the Division Bench of the High Court so that it may address its mind to this question without disturbing the other conclusions arrived at at this stage. In the event, the Division Bench answers the additional issue formulated by us against the appellant, it will be open to the appellant to raise all the issues which have already been concluded and which are the subject matter of this appeal in any further appeal as it may be entitled to prefer from the final decision of the Division Bench. The Division Bench is directed to dispose of the appeal as expeditiously as is conveniently possible. It is made clear that the trial of the suit may also be proceeded with and concluded expeditiously without being inhibited either by the pendency of the appeal or by any observation in the orders of the High Court on the interlocutory application. The appeal is disposed of but without any order as to costs."

27. Mr. Ajay Sahni, learned counsel for the plaintiff has strenuously urged that the findings of the Division Bench as noted above cannot be taken as precedent because the order passed by the Division Bench has been set aside and the matter remanded back for further consideration. On the other hand, Mr. Amarjeet Singh, learned counsel for the defendant states that so far as the above findings contained in paras 15, 16 and 17 are concerned, they have not been upset by the Hon'ble Supreme Court and the matter has been remanded back to the Division Bench for consideration of a limited aspect in regard to the enunciation of the principle of law with regard to the protection available even in respect of the descriptive trademark being not correct. In the opinion of this Court, the judgment rendered by the Division Bench of this Court cannot be relied and acted upon by this Court as laying down a principle of law because the same has not yet attained finality and the appellant before the Division Bench has been given liberty to raise all the issues which have already been concluded and which were the subject matter of the appeal in case the Division Bench answered the additional issue formulated by the Hon'ble Supreme Court against the appellant. Even otherwise, it would be seen that the facts of the present case are not identical or similar to that of the case which received consideration of the Division Bench.

28. The legal proposition which flows from the above decisions is that:

a) A trade mark/trade name, even if it contains or refers to a geographical name, but if it conveys a distinct and specific meaning in common parlance as to indicate the origin of the person or the product and the said mark has assumed a secondary significance, the same can constitute valid trade mark/trade name and is capable of protection under the Trade Mark Act as well as under the common law against passing off by a defendant.

29. Bearing in mind the legal proposition emerging from the above referred authorities, I may now proceed to examine the ultimate question as to whether the mark of the plaintiff 'BIKANERVALA' is entitled to protection because of its exclusive adoption and long user by the plaintiff and whether the plaintiff is entitled to an interim injunction. In the opinion of this Court once the plaintiff has been able to show prima facie that the plaintiff has coined and adopted his trademark 'BIKANERVALA' since 1911 i.e. for more than 20 years and has been manufacturing and selling its edible goods for human consumption and its turnover being quite large during past few years, he has made out a prima facie case in its favor. The defendant has started using an identical trademark/tradename since 2004 only with a prefix 'NEW' which is visually, structurally and phonetically similar to the mark/tradename of the plaintiff. It has also been established that the trademarks/tradenames like 'Kabuliwala', 'Rohtakwala' etc. despite being referable to geographical terms are good trademarks and have, in fact, been registered with the Registrar of Trademarks. On that analogy and otherwise also, therefore, it can be safely held that the plaintiff's trademark/tradename 'BIKANERVALA' is a good mark and entitled to protection. The defendant could not render any possible explanation as to why it has adopted and started using the word 'NEW BIKANERVALA' and in the absence of any plausible explanation forthcoming, it may be presumed that the defendant has done so with a mala fide and deceitful intention and with a view to tread upon the goodwill and reputation of the plaintiff relating to the said trademark and with the sole intention of passing off its own goods as that of the plaintiff's goods. The balance of convenience also lies in favor of the plaintiff rather than in favor of the defendant and in case interim injunction is not granted in favor of the plaintiff, the defendant may continue to pass on its goods as the good of the plaintiff which is bound to occasion irreparable loss and injury to the plaintiff.

30. The net result of the above discussion is that plaintiff's application deserves to be allowed and the defendant is required to be restrained by means of an ad interim injunction and the plaintiff is entitled to interim injunction till the disposal of the suit. Accordingly, the application of the plaintiff is allowed and till the disposal of the suit the defendant, its servants, stockists, distributors, agents and retailers are hereby restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in food articles for human consumption under the impugned trademark and infringing artistic work 'NEW BIKANERVALA' as appearing in annexure-B to the plaint or under any other deceitful similar trademark or artistic work as that of the plaintiff's mark 'BIKANERVALA'. Needless to say that observation made herein above are only for the purpose of disposal of the application and may not be taken as an expression of opinion on the merits of the suit. Application stands disposed of.