

# Izuk Chemical Works vs Babu Ram Dharam Prakash on 11 May, 2007

**Equivalent citations:** MIPR2007(3)8, 2007(35)PTC28(DEL)

**Author:** Gita Mittal

**Bench:** Gita Mittal

## JUDGMENT

Gita Mittal, J.

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1. By this judgment, I propose to decide I.A. No. 2516/2006 filed by the plaintiff under Order 39 Rule 1 and 2 of the Code of Civil Procedure in the suit filed by it against the defendant seeking the relief of permanent injunction to restrain the defendant from infringement of its registered trademark and copyright and also from passing off its goods as those having an association with the goods of the plaintiff and delivery up of offending material as well as rendition of accounts.
2. The suit is premised on the averments that the plaintiff is engaged in the business of manufacturing and trading bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparation as well as soap, perfumary, essential oil, cosmetics, hair dyes and dentifrices since the year 1917. The plaintiff is since conducting its business under the trademark 'MOONSTAR' and has adopted a device of a star in the lap of the moon. The plaintiff has been using the trademark by itself and also in an artistic label.
3. The plaintiff had applied for the registration of the trademark as well as the device and the label under the provisions of the Trademarks Act and it has obtained several registrations of the same which have been detailed in the Annexure to the plaint and copies whereof have been filed on record:

S. No.	Trademark Class No.		Date of Registration and status
1	Moon and Star device	82128	Hair dyes associated with 82129 and 82130
2	Word Mark Moon and Star	82129	Hair dyes class-3
3	Label containing device moon and star, the word mark moonstar, and all	1300553	Cosmetics including henna for export only under class-3 (the
			5th July, 1943
			registered on 25th July, 1943 which stands renewed even till date
			4th August, 2004 which stands renewed even on date

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other essential features  
of the label

plaintiff's application  
for registration of the  
moonstar label under  
No. 1300551 and moonstar  
under No. 673897 in  
class-3 are stated to be  
pending)

4 The moon and star label 521932 Bleaching preparations 28th December, 1989 etc., perfumary soaps, cosmetics, hair lotions etc. in class-3

4. The plaintiff has placed before this Court documents showing that it had engaged the services of M/s Chauhan Graphics, South Market, Kidwai Nagar East, New Delhi-110023 to create and author the art work in the label. The bills of payment which were made to this concern as well as its processing by M/s International Print-O-Pac Limited, B-204, Okhla Industrial Area, Phase-I, New Delhi have been placed before this Court. It is thus claimed that the label and trademark constitute an original artistic work within the meaning of the same under the Copyright Act and the plaintiff is the only owner and proprietor thereof. The application for registration of such art work and copyright is pending.

5. By virtue of long, continuous, extensive and exclusive use of the trademark since 1917 and of the label since 1998, the trademark and label have become distinctive and are associated with the goods and business of the plaintiff. The plaintiff has acquired tremendous goodwill and reputation in the market and it has voluminous trade under this trademark and label. The annual export turnover of the plaintiff under these trademarks in the year 1998-99 was to the tune of Rs. 15,07,637/- which decreased to Rs. 5,44,047/- in 1999-2000 but has thereafter gone up to Rs. 8,77,712/- in the year 2003-2004. The annual turnover in the domestic market of the plaintiff's business under these trademarks and label has gone up from Rs. 5,41,200/- in the year 1998-99 to Rs. 16,37,250/- in the year 2003-2004.

The plaintiff has also placed before this Court the copies of the advertisements printed by it in newspapers and also the expenditure incurred on advertising of its products under this trademark and label. Invoices of the supplies of its products including henna under the 'MOONSTAR' label have been placed before this Court in support of the figures of the sales which have been tabulated. The plaintiff has thus claimed that the trademarks and the label of the plaintiff are well known trademarks within the meaning of this expression in Section 2(1)(zg) of the Trademarks Act, 1999.

6. It has also been pointed out that the partnership firm as constituted in 1943 saw changes in the constitution due to partners leaving the firm on account of demise etc. and others joining. The sequence of these changes has been duly recorded in the certificates issued by the Trademark registry upon appropriate requests being made as per law. At present, the partnership consists of

two partners namely Aftab Ahmed and Anwar Ahmed.

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7. The plaintiff has complained of dishonest, mala fide and fraudulent acts on the part of the defendant who is stated to be engaged in the manufacture and trade of hair dyes. Thus, the defendant is also engaged in the same business and trade as that of the plaintiff. It has been contended that the defendant has dishonestly and fraudulently copied all essential and striking features of the plaintiff's trademark and label and is trading henna under the trademark 'SUPERSTAR'.

8. When the suit was filed, the plaintiff was aggrieved by the similarity between the cartons in which the plaintiff was marketing its products and those adopted by the defendant. The same colour scheme, device of a woman and the expression 'herbal henna' were displayed in an identical position on the front of the carton as they appeared on the plaintiff's cartons. The defendant had also copied the device of the star and displayed the same in a similar manner as displayed by the plaintiff with the mark of registration of the trademark and had printed the word 'SUPERSTAR' in the same colour and style as the plaintiff's 'MOONSTAR' on its carton. The back of the defendant's carton was almost identical to that of the plaintiff with same identical changes in the language in which the printed material was displayed and the contents of the information which was given. The plaintiff has claimed that it has gained knowledge of the defendant upon a search conducted of the Trademark Registry whereupon it was revealed that the defendant has applied for registration of the trademark 'SUPERSTAR' with label against application No. 1403177 for goods in class-3.

9. The suit has been filed urging that the defendant has dishonestly and illegally infringed the trademark of the plaintiff and also the copyright in the trademark and label by substantially reproducing the marks and label of the plaintiff and thereby also passing off its goods and business as that of the plaintiff, thereby violating both the statutory and proprietary rights of the plaintiff in the trademark, label and copyright and also the common law rights of the plaintiff in the same.

10. Pending adjudication in the suit, the plaintiff has filed this application seeking interim relief of an injunction against the defendant from persisting with its offending acts on the plea that the plaintiff shall suffer irreparable loss and damage if the interim injunction against the defendant from persisting with its offending acts is not granted.

11. So far as consideration of such application is concerned, the judicial parameters within which the same has to be considered are well settled. In the instant case, the trademark adopted by the defendant is not identical to that of the plaintiff. Even the label which has been adopted and the device which is being utilised by the defendant is not identical. The plaintiff has therefore urged not only infringement of its proprietary rights based on its registration in the trademark that is the word mark as well as device but also in its label and has also urged that the defendant is dishonestly passing off its goods as those having an association with those of the plaintiff.

12. In the instant case, the defendant has however changed the label and its packaging. A copy of the changed label has been placed on record along with an affidavit dated 3rd October, 2006 wherein it has given an undertaking Page 2018 that it would not use the packaging produced as Annexure 'A' to the written statement filed with the list of documents dated 24th April, 2006. In this view of the matter, this Court has recorded the following order on the 13th February, 2007:

+IA No. 2516/2006 in CS (OS) No. 390/2006 The defendant has filed an affidavit dated 3rd October, 2006 placing an amended label as annexure B Along with. This affidavit has been sworn by Mr. Dharam Prakash as sole proprietor of the defendant wherein he has stated that so far as the label which was complained of by the plaintiff is concerned, the defendant has stopped user of the alphabet "R" in a circle which was appearing on its lable and the pouches and packages. It has further been deposed that the pictures and the words which would appear on the pouches and packages of the defendant would be in the form and style as described in the amended lable which has been placed Along with affidavit as annesxure B. The defendant has also altered the print of the word "Herbal Henna" and its colour has been changed from the colour black in place of the colour white which was earlier being used. It is clearly stated in the affidavit that the defendant is using the label as amended and has discontinued the label which was enclosed as annexure A to the written statement. In this view of the matter, Mr. Bansal, learned Counsel for the plaintiff submits that so far as the complaint of the plaintiff against the label and packaging of the defendant was concerned, the same does not survive for adjudication and the relief in this behalf stands satisfied. He submits that the plaintiff however is entitled to press its relief based on the complaint that the user by the defendant of the word and device "Star" is illegal and violates the rights of the plaintiff is concerned, the same survives for adjudication.

Mr. Singla, learned senior counsel for the defendant submits that this objection is contrary to the pleadings. In the light of this statement, the consideration in the present case stands confines to the contention of the plaintiff that the use of the trademark, superstar and star is violative of the plaintiff's rights for its trademark Moonstar and device of moonstar and star.

For these reasons, the prayer of the plaintiff so far as the label is concerned, stands satisfied. However, the plaintiff's grievance with regard to use of the word 'star' as part of the defendant's trademark and display of the device 'star' remains and has to be adjudicated in the light of the law.

13. In a case of infringement of trademark, the plaintiff may establish that the plaintiff's trademark is identical with or so nearly resembles the plaintiff's work either visually or phonetically or otherwise, that it is likely to deceive or cause confusion in relation to the case in respect of which the plaintiff got his mark registered. The requirement that the plaintiff has to satisfy in order to make out a case of infringement of its mark by the defendant and in a passing of action have been succinctly laid down by the Division Bench of this Court in its pronouncement reported at 2nd 1973

1 Page 2019 Delhi 393 Atlas Cycle Industries Ltd. v. Hind Cycles Limited wherein the court held thus:

Therefore, the aforesaid requirement in (b) may be made out by the plaintiff by showing that the defendant's mark is identical with or so nearly resembles the plaintiff's mark either visually, phonetically or otherwise that it is likely to deceive or cause confusion in relation to the goods in respect of which the plaintiff got his mark registered. In other words, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that there are some additional features in the defendant's mark which show marked differences is immaterial in an action for infringement. An action for passing off, on the other hand, is in substance an action in common law for actual or probable passing off by the defendant of his own goods as those of the plaintiff. In such an action, the use by the defendant of the trade mark of the plaintiff as such is not essential. The plaintiff has only to show that the similarity of the defendant's mark or goods is such that the defendant can pass off his goods as those of the plaintiff. The defendant may escape liability in an action for passing off if he can show that his mark or goods, besides the essential features which are sufficient to distinguish the same from that of the plaintiff. Thus, while in an action for infringement of a registered trade mark the plaintiff has to establish either an use of his registered trade mark as such or of an identical mark or of a deceptively similar mark by the defendant, he has to establish in an action for passing off that the defendant's mark or goods are such that the defendant can pass off his goods as those of the plaintiff.

14. It is equally well settled that what has to be seen is not that there is not a possibility of confusion but that the resemblance is such that there is a reasonable probability of deception. So far as the judgment on this test is concerned, in AIR 1943 Lahore 196 Modi Sugar Mills Limited v. Tata Oil Mills Ltd., the Privy Council approving the test laid down by Niamat Ullah J. in Thomas Bear and Sons (India) Ltd. v. Pravag Narain observed that "in the judging of the probability of deception, the test is not whether the ignorant the thoughtless, or the incautious purchaser is likely to be misled, but we have to consider the average purchaser buying with ordinary caution."

15. The principle in this behalf was further elucidated by the Division Bench of this Court in the Atlas Cycle Industries case (supra). Placing reliance on James Chadwick and Bros. Ltd. v. The National Sewing Thread Co. Ltd. , Chagla CJ and Bhagwati; referring to the words "likely to deceive or cause confusion" in Section 10 of the Trade Marks Act, 1940, observed at page 152 as follows:

Now in deciding whether a particular trade mark is likely to deceive or cause confusion, it is not sufficient merely to compare it with the trade Page 2020 mark which is already registered and whose proprietor is offering opposition to the registration of the former trade mark. What is important is to find out what is the distinguishing or essential feature of the trade mark already registered and what is the main feature of the main idea underlying that trade mark, and if it is found that the trade mark whose registration is sought contains the same distinguishing or

essential feature or conveys the same idea, then ordinarily the Registrar would be right if he came to the conclusion that the trade mark should not be registered. The real question is as to how a purchaser who must be looked upon as an average man of ordinary intelligence, would react to a particular trademark, what association he would form by looking at the trademark, and in what respect he would connect the trade mark with the goods which he would be purchasing. It is impossible to accept that a man looking at a trade mark would take in every single feature of the trademark. The question would be, what would he normally retain in his mind after looking at the trade mark? What would be the salient feature of the trade mark which in future would lead him to associate the particular goods with that trademark?

The court had thereafter culled out the principles which would apply as hereunder:

In an action for an alleged infringement of a registered trade mark, it has first to be seen whether the impugned mark of the defendant is identical with the registered mark of the plaintiff. If the mark is found to be identical, no further question arises, and it has to be held that there was infringement. If the mark of the defendant is not identical, it has to be seen whether the mark of the defendant is deceptively similar in the sense that it is likely to deceive or cause confusion in relation to goods in respect of which the plaintiff got his mark registered. For that purpose, the two marks have to be compared, "not by placing them side by side, but by asking itself whether having due regard to relevant surrounding circumstances, the defendant's mark as used is similar to the plaintiff's mark as it would be remembered by persons possessed of an average memory with its usual imperfections", and it has then to be determined whether the defendant's mark is likely to deceive or cause confusion. for such determination, the distinguishing or essential features (and not every detail) of the two marks and the main idea, if any, underlying the two marks which a purchaser of average intelligence and imperfect memory would retain in his mind after seeing the marks, have to be noticed. It has then to be seen whether they are broadly the same or there is an overall similarity or resemblance, and whether the resemblance or similarity is such that there is a reasonable probability of deception or confusion. In doing so, the approach has to be from the point of view of purchaser of average intelligence and imperfect memory or recollection, and not an ignorant, thoughtless and incautious purchaser. In an action for passing off, the test for deceptive similarity, i.e. as to the likelihood of confusion or deception arising from similarity of the marks of the get up, packing Page 2021 etc. is practically the same as in an action for infringement (vide *Edwards v. Dennis* (1885) 30 Ch.D 454 471(9) *Lambert and Butler Ltd. v. Goodbody* (1902) 19 R.P.C. 377, 383(10) *Addley Bourne v. Swan and Edgar Ltd*; (1903) R.P.C.105, 117(11) and *Tavener Rut Ledge Ltd. v. Specters Ltd.* (1959) R.P.C. 355, 360(12), except that it has also to be seen whether the defendant's mark or the get up, packing, etc. of his goods has besides the essential features of the plaintiff's mark or goods, any additional features which distinguish it from the plaintiff mark or goods, and whether it is likely of reasonably probable that the defendant can pass off his goods as those of the plaintiff to a purchaser of average

intelligence and imperfect memory or recollection.

16. Yet another pronouncement which would have bearing on the issues raised was reported at *Amritdhara Pharmacy v. Satya Deo Gupta*. In this case, the question raised was whether the trade name "Lakshmandhara" was likely to deceive the public or cause confusion to trade in view of the trade name "Amritdhara" which had already been registered as a trade name. The Supreme Court referring to the earlier decision in *Corn Products Refining Co. v. Shangrila Food Products Ltd.*, held that the overall similarity of the two composite words must be considered, that the question has to be approached from the point of view of a man of average intelligence and imperfect recollection, and that to such a man the overall structural and phonetic similarity of the two names "Amritdhara" and "Lakshmandhara" was likely to deceive or cause confusion. In the *Amritdhara* case supra, the court has held thus:

As we said in *Corn Products Refining Co. v. Shangrila Food Products Ltd.* the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity of the two names "Amritdhara" and "Lakshmandhara" is, in our opinion, likely to deceive or cause confusion. We must consider the overall similarity of the two composite words "Amritdhara" and "Lakshmandhara". We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, slot the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite words as 'current of nectar' or 'current of Lakshman'. He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has otherwise learnt and which he wants to purchase.... We are aware that the admission of a mark is not to be refused, because usually stupid people, "fools or idiots", may be deceived. A critical comparison of the two names may disclose some points of the two names may disclose some points of difference but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names Page 2022 having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name.

17. The principles laid down by the Division Bench in *K.R. Chinna Krishna Chettiar v. Sri Ambal and Co.* and *Anr.* are also topical and instructive in this behalf. The plaintiff had urged that the trademark 'Sri Andal' being adopted by the defendant was deceptively similar to the trademark 'Sri Ambal' of the plaintiff and an injunction was prayed for. It was held by the court that there was striking similarity and affinity of sound between the words 'Andal' and 'Ambal'. The court held that though there was no visual resemblance between the two marks but ocular comparison is not always the decisive test. The resemblance between the two marks must be considered with reference to the ear as well as eye. The name Andal does not cease to be deceptively similar because it is used in conjunction with a pictorial device. The court placed reliance on the observations of the court in *De*

Cordova v. Vick Chemical Coy 68 RPC 103, in which M/s Vick Chemical Coy were the proprietors of the registered trademark consisting of the word 'Vaporub' and another registered trademark consisting of a design of which the words 'Vick Vaporub Salve' formed a part. The defendants had advertised their ointment as 'Karsote Vapour Rub'. It was held that the defendants had infringed the registered marks. In this case, Lord Radcliffe said "...a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features.

The court considered the realities of the fact that even though 'Sri Andal' and 'Sri Ambal' were two divinities and that the pictorial devices on the goods of the respondent were different, however, the fact that the customers of the plaintiff were persons of religious denominations other than Hindus whose business was not confined to South of India where the people may know the difference between the two divinities could not be lost track of. The trademarks had no direct reference to the character and quality of snuff and consequently, the customers would have a recollection of only the essential features. The court was therefore persuaded to grant an injunction in favor of the plaintiff against the use of the trademark by the defendant.

18. In a Division Bench pronouncement of the Madras High Court reported at 2006 (32) PTC 434 (Madras) (DB) Devi Pesticides Pvt. Ltd. v. Shiv Agro Chemicals Industries, claiming exclusive proprietorship over the trademark BOOMPLUS and BOOM FLOWER, an injunction was prayed for by the plaintiff against the defendant who was selling its goods by use of the trademark SUPERBOOM. The defendant's trademark SUPERBOOM was an unregistered mark. It was also noticed that phonetic similarity would constitute trademark infringement and that the users of the products of the parties being illiterate farmers and the common man, it was held that an ordinary average person would not be able to make out the difference Page 2023 between the plaintiff's goods and the defendant's goods. Placing reliance on Section 29(5) of the Trademark Act, it was held that the statutory provisions make it clear that even if a part of the registered trademark is used by the defendant, it would amount to infringement. In this case, BOOM was an essential part of the registered trademark of the plaintiff which was incorporated in the defendant's trademark.

19. The courts have also protected rights of a trader who is claiming proprietary rights over numeral trademarks. In 2003 (27) PTC 63 (Delhi) Shaw Wallace & Co. Ltd. and Anr. v. Superior Industries Ltd., the plaintiff had urged that the defendant's trademark 'HAYWARDS 5000' was an illegal infringement of its registered trademark 'HAYWARDS 5000 SUPER STRONG BEER'. It was primarily urged that the use of the numeral 5000 by the defendant was with the intention of cashing in on the reputation of the plaintiff acquired in the business which it was conducting under its registered trademark of which 5000 was an essential part. Reiterating the test laid down in the judicial pronouncements afore-noticed, apart from regard being had to the relevant surroundings, the consensus in order to assess as to whether the defendant's mark is similar to the plaintiff, the court had emphasised the imperfect memory of an average consumer. In this behalf, it was urged that in an action for infringement, for the success by the plaintiff, he need not prove that the whole of his registered trademark has been copied. He can also succeed, if, he shows that the mark used by the defendant is similar to the mark of the plaintiff as it would be remembered by persons possessed of an average memory with its usual imperfection or that its essential particulars or the



distinguishing or essential feature has been copied. Placing reliance on the earlier pronouncement of this Court reported at 2nd 197 (II) Delhi 225 Jagan Nath Prem Nath v. Bhartiya Dhoop Karvalaya, it was held that a person may have right of trademark in a numeral as well.

20. To the same effect was the pronouncement rendered by the learned single Judge in AIR 1987 Delhi 312 Vrajilal Manilal and Co. v. N.S. Bidi Co. and Anr. In this behalf, I may also usefully advert to the provisions of Section 2(1)(J) wherein the word 'Mark' has been defined to include numeral or any combination thereof.

21. Learned Counsel for the plaintiff has placed strong reliance on the judicial pronouncement in 1997 PTC 17 134 William Grant and Sons Ltd. v. Mc. Dowell and Co. Ltd.; Parle Products P. Ltd. v. J.P. and Co., Mysore in support of the submission that the label of the defendant had incorporated all essential features of the plaintiff's label deliberately and dishonestly with the intention of bringing similarity between the products of the plaintiff and defendant so as to confuse the purchasers and the consumers.

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22. Learned Counsel for the plaintiff has also placed reliance on the pronouncement of the learned single Judge in Glaxo Operations UK Ltd. v. Samrat Pharmaceuticals, wherein the plaintiff had claimed copyright over its cartons and proprietary rights in the registered trademark Glucose-D and urged that the action of the defendant has infringed the rights of the plaintiff therein.

Objection to the grant of interim protection was inter alia urged on ground of delay and that the carton of the defendant was also registered as an artistic work under the Copyright Act. It is well settled that copyright exists whether registration is done or not and that registration is merely a piece of evidence as to when the author started copyright in some artistic work or some other work. Further, the court negated the objection of the defendant on the ground that the plaintiff was not entitled to injunction against the defendant on grounds of delay.

23. Mr. S.K. Bansal, learned Counsel for the plaintiff has placed reliance on the pronouncement of the Apex Court reported at 2004 (28) PTC 121 (SC) Midas Hygiene Industries P. Ltd. and Anr. v. Sudhir Bhatia and Ors., wherein the court has held that delay in bringing the suit shall not defeat an action for infringement of a registered trademark.

24. So far as the plea of the defendant based on bonafide concurrent user is concerned, in Metro Playing Card Co. v. Wazir Chand Kapoor, it was held by the court that even in a case where the defendant was able to get a registration for a concurrent user but till the date of registration of the trademark, there can be no doubt that the plaintiff's trademark is infringed by the defendant and thereby the plaintiff's statutory rights under Section 28 of the Act are violated. Consequently, so long as the registration of the plaintiff's trademark subsists, it is not open to the defendant to violate the same.

25. Again in 1996 PTC (16) DB (Delhi) Hitachi Ltd. v. Ajay Kr. Agarwal and Ors., the Division Bench of this Court has held that the courts cannot allow a trader to use a trademark which bears a close or deceptive similarity, affinity and proximity in sound/looks with the trademarks belonging to others, whether by prior use or prior registration, in order to maintain purity and morality in trade and to protect the unaware customers from being misled in buying the product which he did not intend to buy. An infringer or plagiarist of a trademark cannot be allowed to thrive on somebody else's reputation and goodwill.

26. Before this Court also, an objection has been taken by the defendant that the defendant has been bona fide using the trademark 'SUPERSTAR' since 1st April, 1988. I find that the defendant has not disclosed the date on which it adopted the trademark 'SUPERSTAR' or commenced its use. The Page 2025 defendant gives no reason as to why the defendant found it necessary to adopt this trademark or device. It has also not disclosed the date on which the label which has been complained of by the plaintiff was created. Not a single document is on record in th is behalf. There is no evidence of any publicity having been undertaken and no advertisements are also forthcoming on record. The few bills and invoices placed by the defendant on record do not disclose the trade of any goods under the offending trademark. Some of the documents do advert to the product 'henna' but there is nothing to inducate that this henna was being traded under the trademark 'SUPERSTAR'. There is no evidence of concurrent use even let alone the prior use of the trademark adopted by the defendant.

27. In the facts which have been placed before this Court, I find that there is no evidence of such use as is claimed by the defendant of the trademark complained of. For this reason, the pronouncement reported at Uniply Industries Ltd. v. Unicon Plywood Pvt. Ltd. and Ors. has no bearing on this matter.

28. This plank of the defendant's objection is based on the statutory provisions of Sections 12 and 127 of the Trademarks Act, placing reliance on Rubber Co. Ltd. v. Durex Products (Incorporated) and Anr. and Gopal Hossierey v. The Dy. Registrar of Trademarks and Ors., it is urged that the Registrar is empowered to register more than one trademark if the same are being concurrently used.

29. Concurrent use has to be established by documents which may include bills, invoices, transportation and sales proofs etc. Use includes physical and non-physical use. Advertisements and other promotional activities and materials relating to a trade mark are covered under non-physical use. (Ref: Hardie Trading Ltd. v. Addisons Paint and Chemicals Ltd. ).

30. The defendant has placed reliance on an application made for registration of its trademark. Copy of this document which has been placed on record shows that the application has been filed only on 2nd December, 2005. As discussed hereinabove, there is no evidence placed before this Court of concurrent use, let alone prior use of trademark, in any form by the defendant. In any case, the trademark of the defendant has not been registered till date. The pendency of the application for registration would thus have no bearing on the infringement of the plaintiff's trademark by the defendant.

This contention of the defendant thus deserves to be rejected.

31. Mr. A.K. Singla, learned senior counsel for the defendant has also urged that the application of the defendant seeking registration of the trademark Page 2026 is pending before the Registrar and for this reason, this adjudication has to await and abide consideration of such application by the prescribed forum under the competent statute. Placing reliance on the pronouncement of the court reported at Maddada Chayanna v. Karnam Narayana; State Electricity Board and Anr. v. Ashwani Kumar; and 1999 (1) SCC 156 State of Mizoram v. Biakchhawna, it has been urged that the present suit ought not to be proceeded with, and the Registrar of Trademarks is the appropriate and competent authority to deal with the matter. In my view, this objection is wholly misconceived.

32. So long as the plaintiff has registered trademarks, it is legally entitled to seek interim relief against the defendant for infringement thereof under the statute. The plaintiff has placed copies of its trademark registration which prima facie established its legal right to protection of the infringement on the part of the defendant. This issue has in any case been considered in the judicial pronouncements reported at 1996 (16) PTC 262 (DB) (Del) Hitachi Ltd. v. Ajay Kr. Agarwal and Ors. The defendant has no legal right whatsoever in the trademark which may be identical or deceptively similar to a registered trademark till such time it gets registration in accordance with law.

33. In the instant case, there can be no doubt that the trademark 'MOONSTAR' adopted by the defendant is not descriptive of the goods for which it is being used. Both the words 'Moon' or 'Star' have also no association with the products. They also do not describe the nature or character of the products of the plaintiff in any manner. The plaintiff's registration of this trademark and its device of a star in the lap of the moon remains valid and binding and has not been objected to or revoked by the Registrar of Trademarks. The plaintiff has also prima facie established its extensive trade and reputation in its business under such trademark. The trademark and the device as also the plaintiff's label stands registered thereby conferring enforceable rights on the plaintiff by the present action urging infringement. The word and device of star are certainly essential and distinctive part of the trademark and of the label of the plaintiff.

34. Even in the Atlas Cycle Industries Ltd. case (supra), the plaintiff had alleged that the trademark 'ROYAL STAR' of the defendant No. 1 was an infringement of his registered trademark 'EASTERN STAR'. It was submitted by the defendant in this case, that the plaintiff having admitted the words 'EASTERN STAR' as its trademark, he should not be allowed to make a contrary allegation that it was entitled to the use of the word 'STAR' which was only a part of the registered name, and the name did not consist of any Page 2027 particular part but consisted of the combination of two words 'EASTERN' and 'STAR'. The court stated that the proper approach in deciding the question is to consider the overall and phonetic similarity of the two names 'EASTERN STAR' and 'ROYAL STAR'. The court further stated that the meaning of neither word, whether 'EASTERN' or 'STAR' has any relation at all to cycles, and are thus not descriptive or suggestive of the goods i.e. cycles and therefore, the most important thing that has to be noticed is that both names, when uttered end in the same sound. Therefore, a person of average intelligence and imperfect memory would logically remember only the sound of the ending word 'STAR' and is therefore likely to be deceived or confused between the two names or marks. Therefore, the court held that since the two marks have

an overall structural and phonetic similarity and considering their use in respect of the same kinds of goods i.e. cycles, the use of the defendant's trademark is likely to cause deception or confusion as discussed under Section 29 of the Trade and Merchandise Act, 1958.

35. In the instant case, there is no dispute that the trademark adopted by the defendant is not registered. Therefore, the use of the mark (r) i.e. placing R on its label has been urged to be tainted with dishonesty.

There is force in this submission inasmuch as by printing this device as part of its trademark, the defendant has attempted to dishonestly create an impression that its trademark was registered. The device is placed at a place identical to where it is placed in the label of the plaintiff which has been urged as infringement of its registered trademark by the defendant.

Certainly, there is strength to the contention of the plaintiff that these acts of the defendant are tainted with dishonesty and mala fide and intended to cause deception and confusion in the minds of the purchasing public.

36. The pronouncement reported at *Novartis AG v. Wanbury Ltd. and Anr.* therefore would have no application to the instant case.

37. In the light of the principles laid down in *Atlas Cycle Industries Ltd. v. Hind Cycles Industries Ltd.* 2nd (1973) I Delhi 393; *K.R. Chinna Krishna Chettiar v. Sri Ambal And Co. and Anr.* *Devi Pesticides Pvt. Ltd. v. Shiv Agro Chemicals Industries*; and the statutory provisions of Section 29(5) of the Trademarks Act, 1999, the plaintiff has a legal right to object to the infringement of even a part of its trademark which is undoubtedly distinctive.

38. Prima facie, it would appear that the defendant has fraudulently copied an essential part of trademark of the plaintiff when it has used 'STAR' as part of its trademark. It has also dishonestly copied an essential and integral part of the device of the plaintiff when it uses the device of star for Page 2028 its products. From the documents placed on record and the averments made, it is evident that the plaintiff has proprietary rights over the same by virtue of prior user of the trademark since 1917 and registration of its trademark since 1943 and the defendant has not been able to establish any such use. The registration of the plaintiff effected on 5th July, 1943 relates to the product hair dyes and even the device of moon and star also stands registered in its name. There is no force in the defendant's objection that the plaintiff does not hold registration of the trademark or copyright with regard to the label which is the subject matter of the suit.

39. Placing reliance on the pronouncement reported at AIR 1998 Delhi 114 *Mahant Purshottam Dass v. Harnarayan and Sarjiwan Singh v. Delhi Vidyut Board*, it has been urged that the plaintiff has not sought any declaration for labels which are similar to that of the plaintiff and consequently, no injunction could be granted.

40. The arguments deserve to be noticed only for the sake of rejection. The plaintiff in the instant case is basing its rights on its registered trademark and has urged that the defendant has infringed

the same. The plaintiff has based its entitlement to injunction on detailed averments to this effect in its pleadings. In such a case, the findings relating to the acts of the infringement on the part of the defendant in so trading are inherent in the very nature of the lis and consequently, no separate declaration is required to be sought.

In any case, the legal rights of the plaintiff are based on its registered trademark and are statutorily recognised thereby. There is no declaration of status or title as envisaged under the Specific Relief Act, 1963 is required to be sought. For these reasons, this objection is devoid of substance.

41. In the light of the well settled principles of law and the above discussion, I find that the plaintiff has prima facie established a case of infringement of its registered trademark by the defendant. The trademark adopted by the defendant contains an essential part of the plaintiff's trademark as also of the device by which the plaintiff is trading.

42. I also find that the defendant is trading in the same goods as that of the plaintiff and the infringing trademark is being used for the sale of the very goods which are being sold by the plaintiff. The plaintiff has prima facie also established reputation and goodwill in its business under such trademark which would undoubtedly suffer irreparable loss and damage if the defendant is not restrained from continuing with its offending acts. The balance of convenience, interest of justice and equity lie in favor of the plaintiff and against the defendant. The purchasing public would consist of literate, semi-literate and even illiterate people who by virtue of the adoption of the word 'Star' as apt of its trademark by the defendant as also the device star would be persuaded to believe that the product of the defendant is associated with that of the plaintiff.

For all the foregoing reasons, I am of the view that the present application deserved to be allowed.

Page 2029 Accordingly, the defendants, proprietors, promoters, retailers, their agents, partners, servants, assigns, representatives, successors, distributors and all others acting for and on their behalf are hereby restrained from using the plaintiff's trademark 'MOONSTAR' or any part thereof for manufacturing, selling, offering for sale, advertising or displaying directly or indirectly or dealing in any other manner for its products or business. The defendants, proprietors, promoters, retailers, their agents, partners, servants, assigns, representatives, successors, distributors and all others acting for and on their behalf are also hereby restrained from using the device of star in the lap of the moon or any portion thereof for its products or business. The defendants are also restrained from using any other trademark or device identical or deceptively similar to that of the plaintiff amounting to infringement of plaintiff's registered trademark; or violating the plaintiff's common law rights in the trademark.

This application is allowed in the above terms.