

## **Amar Nath Chakroborty vs Dutta Bucket Industries And Ors. on 17 March, 2005**

**Equivalent citations: 2005(2)CHN278, 2005(31)PTC415(CAL)**

**Author: Bhaskar Bhattacharya**

**Bench: Bhaskar Bhattacharya**

### **JUDGMENT**

Bhaskar Bhattacharya, J.

1. This application is at the instance of a plaintiff in a suit for declaration and injunction alleging violation of registered Trade Mark and copyright and also complaining "Passing Off" and is directed against Order No. 31 dated 27th April, 2004 passed by the learned Judge, 3rd Bench, City Civil Court at Calcutta in Title Suit No. 27 of 2003 thereby rejecting an application under Order 39 Rules 1 and 2 of the Code of Civil Procedure filed by the appellant for restraining the respondents from committing breach of Trade Mark and copyright and passing off his own goods as that of the appellant.

2. The appellant filed in the City Civil Court at Calcutta, a suit being Title Suit No. 27 of 2003 thereby claiming the following relief:

"(a) Declaration that the plaintiff alone is entitled to use the trade mark and/or the artistic work and/or the name, brand TAJ appearing in the label marked 'A' and annexed to the plaint for carrying on its business in respect of Buckets, Pans, Mugs, Drums and allied goods and/or goods of the same description;

(b) Decree of perpetual injunction restraining the defendants, their proprietors, partners, directors, and every person in charge of and for the conduct of the business and each of them whether by themselves or by their servants, agents, dealers, stockists, or otherwise howsoever from infringing the plaintiffs registered trade mark TAJ, as per annexure 'A' hereto or any other mark, name, brand either same and/ or visually and/or phonetically similar to the plaintiff's original trade mark TAJ or colorable imitation thereof;

(c) Decree of perpetual injunction restraining the defendants, their proprietors, partners, directors and every person in charge of and for the conduct of the business and each of them whether by themselves or by their servants, agents, dealers, stockists, or otherwise howsoever from infringing the plaintiffs copyright in respect

of the artistic work (label) TAJ, registered under No. A-56999/99, or any label (artistic work) similar thereto;

(d) Decree of perpetual injunction restraining the defendants whether by themselves, their proprietor, partners, directors, employees, servants, agents or otherwise howsoever from in any way manufacturing, selling or offering for sale or marketing or advertising the products viz. Buckets and goods allied thereto bearing the trade mark MAJ as per annexure 'B' hereto, or any other mark which is phonetically and/or visually similar thereto;

(e) Decree of perpetual injunction restraining the defendants, their proprietors, partners, directors, and every person in charge of and for the conduct of the business and each of them whether by themselves or by their servants, agents, dealers, stockists, or otherwise howsoever from using, selling, advertising the mark/artistic work TAJ (label) or any name or mark or brand or work being identical with and/or deceptively similar to and/or a colorable imitation of the plaintiff's original trade mark/artistic work TAJ as in annexure 'A' hereto, in any form and manner whatsoever, in the course of business;

(f) Perpetual injunction restraining the defendants, their proprietors, partners, directors, and every person in charge of and for the conduct of the business and each of them whether by themselves or by their servants, agents, dealers, stockists, or otherwise howsoever from passing off or attempting to pass off or causing or enabling or assisting others to pass off Buckets, Pans, Mugs, Drums and/or goods of same description in the course of trade with the name/work/mark TAJ as in annexure 'A', and MAJ as in annexure 'B' hereto in any form, get up, manner whatsoever;

(g) Delivery up for destruction of all impugned goods, papers, labels and/ or documents, packets, wrappers, stickers, in the possession, custody or control of the defendants or any of them which bear the mark/name/ work MAJ as in annexure 'B' hereto in any form whatsoever;

(h) Leave under Order 2 Rule 2 of the Code of Civil Procedure;

(i) An inquiry into the damages suffered by the plaintiff and a decree in favour of the plaintiff of such sums as may be found due upon such inquiry;

(j) Such other injunction as should afford adequate relief to the plaintiff;

(k) Receiver;

(l) Attachment;

(m) Costs;

(n) Further or other relief."

3. The case made out by the appellant may be summarised thus:

(a) The appellant, at all material time, has been carrying on the business of manufacturing and marketing G.I. Bucket for nearly two decades under the trading style of G. N. Bucket Industries having its principal place of business at Bholanath Rudra Road, Ranaghat, District Nadia. The appellant is one of the leading and reputed manufacturers and merchants in the field of Buckets, particularly, in the Eastern Part of India.

(b) For the purpose of identifying and distinguishing his products from those of others in the course of trade, the appellant had conceived of, originated and adopted a composite mark, inter alia, comprising the name and word TAJ written in golden colour within two concentric oval shaped ellipse, with bright red coloured background for use as a label, brand, mark on his products and commenced using the said mark as its trade mark on the products of the appellant from the year 1979.

(c) The products of the appellant are manufactured and marketed under the trade mark TAJ and have demand in all parts of Eastern India and the aforesaid products are available and sold throughout the State of West Bengal.

(d) The appellant in order to promote and publicize his product with the mark TAJ has caused large scale advertisements in the newspapers, journals and in other form of sales promotion. Those advertisements have received intense attention and have boosted the popularity of the mark TAJ amongst the trading people and the customers and considerable amount of money has been spent each year towards those advertisements and sale promotions of the appellant's products with the mark TAJ.

(e) By virtue of very extensive user of the mark/brand TAJ for continuous period of over 23 years, large scale advertisements and appreciable sale of the products of the appellant, the composite mark TAJ became connotative and denotative of the appellant and no one else.

(f) The customers and trading community come to denote the petitioner's superior products with the distinctive get up, colour combination, writing arrangement, style of presentation and the name TAJ in the composite label.

(g) The appellant besides acquiring Common Law Rights to the said composite trade mark TAJ with a view to further acquire and fortify its right under statute had duly applied for registration of the said composite mark TAJ under the Trade and Merchandise Marks Act, 1958 and on completion of all procedure laid down under the said Act and the Trade and Merchandise Marks Rules, 1959 duly obtained

registration thereof.

(h) In consequence of appreciable user of the said mark TAJ on Buckets etc. and the advertisement and publicity associated therewith, the appellant has acquired valuable goodwill and reputation in regard to the said mark TAJ with the goods associated and also attached to the business of the appellant.

(i) To protect the artistic work, as defined in Section 2(c) of the Copyright Act, 1957, the appellant applied for and duly obtained the registration of the label TAJ as a piece of artistic work under the Copyright Act, 1957.

(j) The appellant, thus, by virtue of registration of the trade mark mentioned earlier had acquired exclusive right to the use of the composite trade mark TAJ and such right will be deemed to be infringed when any person uses in relation to the same or similar goods in the course of trade, such mark which is identical with and/or deceptively similar to the trade mark of the appellant.

(k) As the appellant is the owner of the artistic work including the colour combination, style of writing, get up etc. in its label/composite trade mark TAJ used in connection with its business and since the said artistic work is registered under the Copyright Act, 1957, the appellant has exclusive right to reproduce and publish the said artistic work in any form for the purpose of trade and in case, any person does anything which contravenes the exclusive right conferred upon the owner of the said copyright, the act of the said person should be treated as infringement of copyright.

(l) The use of the composite trade mark TAJ and/or any deceptively similar trade mark in relation to the appellant's goods in the course of trade by any other person should be understood by the trade and the public as that of the appellant's products and thereby such products with the falsified mark and infringed copyright would be passed off as and for those of the appellant's product causing confusion and deception in the minds of the unwary and unsuspecting member of the public and the trade.

(m) The appellant, therefore, was entitled to all the relief provided in the Trade and Merchandise Marks Act, 1958 and the Copyright Act, 1957 and also for preventing "Passing Off."

(n) In the year 1992, the appellant learnt of the use of trade mark TAJA by the respondent Nos. 1 and 2. As the said trade mark TAJA of the respondent Nos. 1 and 2 was considered to be deceptively similar to the trade mark TAJ of the appellant and as there was immense confusion and deception since the said trade mark TAJA of the respondent Nos. 1 and 2 in relation to Buckets was passed off in the markets, the appellant filed a suit being O. Suit No. 13 of 1992 in the Court of learned District Judge at Krishnagar, district-Nadia. The learned District Judge, Krishnagar, after

hearing passed an order of ad interim injunction restraining the respondents from using the trade TAJA in relation to Buckets.

(o) In the course of the said proceedings, the respondent Nos. 1 and 2 opted for a compromise and in pursuance thereof, a Solenama was filed. In the said compromise petition, the respondent Nos. 1 and 2 agreed and undertook not to use the trade mark "TAJA" or "TAZA" or any name or names visually and phonetically similar thereto and to the appellant's label and mark TAJ annexed to that petition.

(p) The respondents also undertook not to sell or offer for sale either by themselves or each of their stockists the Buckets or like products bearing appellant's trade mark or the name TAJA or TAZA or any name or names visually or phonetically similar thereto at any time in future.

(q) The said suit was decreed on the basis of said compromise and a token sum of Rs. 1001/- was awarded as compensation to the appellant.

(r) On 25th June, 2002, the appellant received complaint from the markets that inferior quality of G.I. Buckets are being sold in the different parts of Kolkata and adjoining areas with a mark or brand which is deceptively and confusingly similar to the appellant's registered and reputed trade mark TAJ. Thereafter, the appellant caused enquiries to be made and had obtained Buckets with the falsified label mark MAJ in an identical get up, design, colour combination, style of writing and arrangement as those of appellant's trade mark or label from the shop of respondent No. 3.

(s) The appellant had also got information that respondent Nos. 1 and 2 are the persons who manufactured and marketed those products with the falsified mark MAJ and were pushing insidiously their inferior quality of products with the falsified mark MAJ into the markets in order to pass off their goods with the falsified mark as and for the goods of the appellant's original mark TAJ.

4. In connection with the aforesaid suit, the appellant filed an application under Order 39 Rules 1 and 2 thereby praying for temporary injunction in terms of prayer of perpetual injunction made in the plaint.

5. The aforesaid application was opposed by the respondents by filing written objection and the objection taken by respondents may be summed up thus:

1) The respondent Nos. 1 and 2 got the trade mark "MAJ" from the Registrar of trade marks being No. 898196B dated 17th January, 2000 in terms of Section 23(2) of the Trade and Merchandise Marks Act, 1958 and Rule 65(1) of the Rules framed thereunder.

2) Sri Haripada Dutta, Sri Biswanath Dutta and Sri Parimal Dutta started a bucket industries in the name and style M/s. Dutta Bucket Industries. In the year 1992 the appellant filed a suit being O.S. No. 13 of 1992 before the learned District Judge, Krishnagar, against those respondent Nos. 1 and 2 about TAJA label trade mark. After getting notice of the said suit, the partners namely, Sri Haripada Dutta, Sri Biswanath Dutta and Sri Parimal Dutta became very anxious about the case and after prolonged discussion among the partners about the suit, the partners were compelled to compromise the suit and they also created pressure upon the defendant No. 2 i.e. Sri Haripada Dutta to compromise the suit and lastly, that suit was compromised because the partners of the partnership firm were poor and they were not in a position to conduct a suit at that time.

3) M/s. Dutta Bucket Industries was dissolved as a partnership firm from 1st April, 1993. After dissolution, Haripada Dutta is the sole proprietor of M/s. Dutta Bucket Industries. He got certificate of registration of his place of business according to West Bengal Sales Tax Act, 1994.

4) According to Section 21 of the Trade and Merchandise Marks Act, 1958, a person who has any time grievance or objection against any type of trade mark registration should have filed his objection or grievance within three months from the date of advertisement in the Trade Mark Journal. In this case, the plaintiff did not lodge any complaint or objection against the registration of "MAJ" label Trade Mark within the statutory period and as such, the defendant never violated Section 12 of the said Act.

5) The suit as well as injunction petition should be stayed according to Section 115 of the Trade and Merchandise Marks Act, 1958. Over and above, there is "RAJ" label bucket in the market and the plaintiff's mala fide intention is apparent from the wrongful adoption of the name deceptively similar to RAJ and identical artistic design as that of RAJ label.

6) There is no similarity of colour combination between TAJ label and MAJ label, there is no similarity of style of writing between TAJ label and MAJ label, there is no similarity of size between TAJ label and MAJ label, there is no similarity of design between TAJ label and MAJ label and in case of TAJ label first letter is "T" and in case of MAJ label first letter is "M". At the top of the TAJ label, the words "G. N. Bucket Industries" are written but at the top of MAJ label, the phrase "best quality" is written. Both corners of TAJ label are used by nine doted star sign but both corners of the MAJ label are used by star sign.

7) "R" sign is used in top of the letter "A" in the TAJ label but there is no such sign in the MAJ label. Registered No. 3457453 is used in the bottom of the TAJ label but the words "MADE IN INDIA" are used in the bottom of the MAJ label.

8) The plaintiff uses four labels in his TAJ label bucket whereas the defendants use two labels in his MAJ label bucket.

6. The learned Trial Judge as indicated above, on consideration of the materials on record held that in the naked eye, the difference between two levels is clear and according to him, it cannot be said that those resemble with each other. Learned Trial Judge further held that according to Section 21 of the Trade and Merchandise Marks Act, 1958 a person who has any type of grievance or objection against any registration made, should lodge such objection or grievance within three months from the date of advertisement in the trade mark journals but in the present case, the appellant had not made any complaint or objection against MAJ label and thus, the defendants did not violate the provision of Section 12 of the Trade and Merchandise Marks Act, 1958.

7. The learned Trial Judge further found that there is a RAJ labelled bucket available in the market and the defendant No. 1 has also filed a RAJ label wherefrom it appears that artistic design of label TAJ is very much similar to the artistic level marked RAJ and according to him, the plaintiff with mala fide intention wrongly adopted the name of RAJ.

8. On the basis of those findings, the learned Trial Judge held that the plaintiff failed to show prima facie case for getting an order of injunction and as such, dismissed the application.

9. Being dissatisfied, plaintiff has come up with the present appeal.

10. Mr. Bachwat, the learned Counsel appearing on behalf of the appellant, has criticized the order impugned on the ground that while disposing of the application for temporary injunction the learned Trial Judge did not follow the well accepted principles which are required to be followed while considering a case for injunction alleging violation of trade mark, copyright and also complaining an act of passing off. According to Mr. Bachwat, merely because the trade mark of the respondent was registered, that fact cannot take away the common law right of the appellant on the basis of his earlier trade mark to prevent the respondent from passing off the goods as that of plaintiff and therefore, notwithstanding the registration of the trade mark of the respondents, his client is entitled to get an order of injunction. In support of such contention Mr. Bachwat relies upon the following decisions of the Supreme Court:

1. Satyam Infoway Limited v. Sifynet Solution, .

2. Laxmi Kant V. Patel v. Chetan Bhatt Sahoo, reported in AIR 2000 SC 275.

3. Whirlpool Company and Anr. v. N.R. Dongre, .

11. Mr. Bachwat further contends that while deciding the application for temporary injunction it was no part of the business of learned Trial Judge to consider whether the trade mark of the appellant, namely, TAJ is deceptively similar to another trade mark in the field namely, RAJ, as the owner of the said mark has never come forward to support the claim of the respondents. Mr. Bachwat further contends that once it is established that the appellant is using the trade mark TAJ from 1979 and in

the past, the respondent himself gave the undertaking not to violate that trade mark or to pass off his goods as those of the plaintiff, it was the duty of the learned Trial Judge to pass an order of injunction restraining the respondents from passing off his goods as that of plaintiff.

12. Mr.. Bachwat next contends that slight differences in the writing of the trade mark of the respondent is immaterial inasmuch as, the commodity that is dealt with by the parties is bucket and is used by the public who generally has no extensive knowledge of English but they are guided by the design and colour combination of the trade mark. Mr. Bachwat contends that the word "MAJ" is deceptively similar to "TAJ" inasmuch as "A" and "Z", the last two syllables are same and the only variation is of the first syllable but the size of the trade mark, the oval shape, the combined colours of red and yellow and the corrugated design at the boundary of the label of the respondents depicts the same as deceptively similar to that of the appellant and the ordinary people are bound to be misguided by such deceptive trade mark and as such, it is a fit case where this Court should hold that the trade mark of respondents is deceptively similar to that of appellant. Mr. Bachwat contends that once such finding is arrived at, injunction is a matter of course. In support of such contention Mr. Bachwat further relies upon a decision of this Court in the case of Strassenburg Pharmaceuticals Limited v. Himalaya Drug Company and Anr., reported in 2001(3) CHN 159.

13. The aforesaid contentions of Mr. Bachwat are seriously disputed by Mr. Banerjee, the learned Counsel appearing on behalf of the respondents. Mr. Banerjee contends that the learned Trial Judge having pointed out so many differences in the trade marks of the parties and on the basis of such finding having arrived at the conclusion that there is no chance of deception of the ordinary people by taking the defendant's commodities as those of the plaintiff, this Court sitting in a first miscellaneous appeal should not interfere with the discretion exercised by the learned Trial Judge. Mr. Banerjee submits that merely because from the self-same fact a different conclusion can be arrived at, such fact is not a ground for variation of the order passed by the learned Trial Judge. Mr. Banerjee further contends that in this case as the respondents are using their trade mark from 1996 and the suit having been filed long six years thereafter, there should not be any order of injunction for the inaction on the part of appellant. In support of such contention, Mr. Banerjee relies upon the decision of the Supreme Court in the case of Power Control Appliances and Ors. v. Sumeet Machines Pvt. Ltd., .

14. Mr. Banerjee lastly contends that his client having obtained registered trade mark after complying with the provisions contained in the statute by prior publication of such mark in the trade mark journals and the appellant not having raised any objection either before or after the grant of registration, so long the trade mark of the respondent is not cancelled, the appellant is not entitled to get any relief of injunction against the use of the said trade marks. Mr. Banerjee, thus, prays for dismissal of the appeal.

15. After hearing the learned Counsel for the parties and after going through the materials on record we find that in the plaint as well as in the application for temporary injunction the plaintiff has not only alleged violation of trade mark and copyright but has also brought allegation of passing off. It is true that the respondents having obtained registered trade mark, this Court cannot hold that the respondent has violated any of the provisions of Trade and Merchandise Marks Act but it is now



well-settled that merely because the respondent has obtained trade mark under the provision of the aforesaid Act, such fact cannot extinguish the common law-right of the plaintiff to have an injunction restraining passing off if it appears that the plaintiff is the earlier user of the trade mark and that the registered trade mark of respondent is deceptively similar to that of plaintiff.

16. In the case before us, there is no dispute that the trade mark "MAJ" has been conferred upon defendant long after the registration of the trade mark "TAJ" in favour of the appellant and in the past, the respondents conceded their guilt of using a deceptively similar trade mark "TAJA" and even paid compensation of Rs. 1001/-. Therefore, even if subsequently, the respondents have obtained a trade mark in the name of "MAJ" that fact cannot stand in the way of the Court in granting injunction against respondent if it is established that the said trade mark "MAJ" is deceptively similar to that of plaintiff. Since the two marks are not identical, the onus is upon the appellant to establish that the mark used by the respondents so nearly resembles the earlier-obtained trade mark of the appellant as is likely to deceive or cause confusion in relation to the goods in respect of which his mark has been registered. This has necessarily to be ascertained by comparison to the two marks bearing in mind that the persons who would be deceived are the purchasers of the goods and it is their likelihood of being deceived that is the subject of consideration. At this stage, we can profitably refer to the decision of the Supreme Court in the case *Corn Products Refining Company v. Sangrilla Food Products Limited*, , where the Apex Court, while considering the question of deception between "gluvita" and "glucovita", observed that the question, whether the two marks are likely to give rise to confusion or not, is a question of first impression. According to the Apex Court, it cannot be overlooked that if the word is an English word, which to the mass of Indian people is a foreign word, in deciding the question of similarity between two such marks, those are to be considered as a whole. Applying that principle in the fact of that case, the Supreme Court held that apart from the syllable "co-" in the appellant's mark, the two marks were identical and that syllable was, in the opinion of Supreme Court, not such as would enable the buyers in our country to distinguish the one mark from the other. The Supreme Court further observed that, in deciding such question, the Court should approach it from the point of view of a man of average intelligence and imperfect recollection. To such a man, the Supreme Court proceeded, the overall structural and phonetic similarity and the similarity of the idea in the two marks are likely to cause reasonable confusion between them.

17. After going through two labels placed before us we find that those are of similar size and both are oval shaped. In both the trade marks, colour combination is of red and yellow and outer side of the trade marks are corrugated. It is true that in the trade mark of defendant there are some additional writings which are not in conformity with those of the plaintiff but the prominent word "MAJ" is deceptively similar to TAJ", if we take into consideration the shape, colour combination and other artistic design of the label.

18. We are of the opinion that the commodity used on the basis of such trade mark being bucket which is used by common people who are ignorant of details of the writing, there is every possibility of deception of the common people. In our view, any common people who are not efficient in English can be misled by the trade mark of defendants as that of plaintiff. If "Lakhshmandhara" is held to be deceptively similar to "Amritdhara" (see *Amritadhara Pharmacy v. Satya Deo Gupta*, ), in

our view, MAJ must be held to be deceptively similar to TAJ in the eyes of purchasers of average intelligence and imperfect recollection if we also take into consideration the colour combination, shape and other artistic design of the two labels.

19. We, thus, find that the findings of the learned Trial Judge that there are so many differences in the trade mark of defendants from that of plaintiff and those can be detected by naked eye is not the decisive factor in considering a case of injunction alleging "Passing off. It is now settled law that dissimilarities in the two labels should not be given more importance than the similarities in considering a case of passing off. (See Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., ). In the aforesaid circumstances, we are left with no other alternative but to hold that the finding of the learned Trial Judge to that effect is a perverse finding of fact.

20. Once it is established that the label of the defendant is deceptively similar to that of plaintiff and the plaintiff has been using the label from the earlier point of time, the Court has no other alternative but to grant injunction restraining the defendant from using the said trade mark unless the defendant can show positive act of the plaintiff consenting to use of the trade mark of the defendant.

21. Although, Mr. Banerjee appearing on behalf of the respondent assiduously tried to convince us that suit having been filed after a long time there should not be any injunction, we are not at all impressed by such submission. In this connection reference may be made to the decision of the Supreme Court in the case of Midas Hygiene Industries (Put) Ltd. v. Sudhir Bhatia and Ors., , where the Apex Court has held that once allegation of passing off is established, delay is immaterial for considering the case of injunction. In the case of Power Control Appliances (supra), relied upon by Mr. Banerjee, it was held that acquiescence is one of the defences available under Section 30(1)(b) of the 1958 Act. According to the Apex Court, acquiescence is sitting by, when another is invading right and spending money on it. It implies positive act; not merely silence or inaction as is involved in laches. According to the Supreme Court, the acquiescence must be such as to lead to the inference of a licence sufficient to create a new right in favour of a defendant. In this case, the defendant has not produced any material showing positive act on the part of the plaintiff consenting to grant of licence in favour of the defendant.

22. As indicated above, once the charge of passing off has been prima facie proved, in our view, the delay is immaterial unless it is shown that there is definite proof of acquiescence of the plaintiff. Such material has not been placed before the learned Trial Judge by the defendant. We, thus, find that this is a fit case where the plaintiff is entitled to get an order of temporary injunction restraining the defendant from using trade mark "MAJ" till the disposal of the suit.

23. We, therefore, set aside the order impugned and restrain the defendants from using its trade mark "MAJ" till the disposal of the suit. The appeal is, thus, allowed. In the facts and circumstances, there will be, however, no order as to costs.

Rajendra Nath Sinha, J.

I agree.