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AIR 1988 Delhi 249

**M/s. Johnson and Johnson & Ors. VERSUS Christine Hoden India (P) Ltd.**

**Trade & Merchandise Marks Act, 1958 S.29**— trade marks under order 39 Rule 1 & 2 Civil Procedure Code 1908 **“Stayfree”** on packing—Suit to restrain defendant from using words **“Stayfree”** on packing of his sanitary napkins—Temporary injunction prayed for—Except use of **“Stayfree”** packing of defendant having no similarity to plaintiff’s packing—Customers not likely to be deceived—injunction refused.

2

2003 (27) PTC 18 (Delhi)

**East African (I) Remedies (P) Ltd. VERSUS Wallace Pharmaceuticals Ltd.**

**Trade and Merchandise Marks Act, 1958**—Section 28, 29—Interim injunction—Deceptively similar trade mark—Plaintiff’s mark **RIVOX** and that of defendant, **REVOX**—Both parties engaged in pharmaceutical preparations Both marks pending registration—Though plaintiff is prior user yet not continuous or regular—Adoption of **EEVEX** by defendant honest and bona fide—Trade names prominently depicted on cartons having distinct get up and layout and products manufactured and marketed by rival parties not be sold without prescription—Defendant’s drug in market for cores during previous year—Balance of convenience in favour of defendant—Injunction not be granted—Civil Procedure Code, 1908, Order 39 Rule 1 & 2.

3

2002 (25) PTC 721 (DB) (All)

**Vinayak Tea Co VERSUS Kothari Products Ltd**

**Trade Marks infringement** —Permanent injunction —Plaintiff manufacturing and selling pan masala chewing tobacco, etc. under registered trade mark **PARAG**—Defendant dealing in tea prefixing the word of the goods manufactured and sold by it—Said word **PARAG** already in use in the market before plaintiff got registered the trade mark **PAN PARAG**, and not an invented one— Goods sold by defendant entirely different and the packets used also entirely different—No prima facie evidence to show confusion or deception—Injunction vacated—Trade and Merchandise Marks Act, 1958, Section 2 (1) (d), 27. 105- Civil Procedure Code, 1908, Order 39, Rule 1 & 2,

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2002(25) PTC 763 (Cal)

**Honda Motor Company Limited VERSUS Kewal Brothers & Other**

**Trade Mark Infringement** – Interim injunction-Plaintiff, engaged in manufacture and sale of automobiles under registered trade name **HONDA** having transporter reputation-Defendant also getting the same name registered in respect of auto lamps and auto bulbs-NO protest from plaintiff for 28 years – Balance of convenience in favour of defendant –Ad interim injunction vacated-Trade and Merchandise Marks Act, 1958, Sections 28 & 30 Civil Procedure code, 1908, O.39, Rr. 1 & 2

**HELD :** The plaintiff/petitioner is the manufacturer of amongst other automobiles and auto generators. The plaintiff does not manufacture neither bulb nor auto lamp or auto lamp or lamp. The defendants are the manufacturer of auto lamp and bulbs Admitted the mark which is used by both the parties is “Honda”. Both the plaintiff and defendants have got registration in India under the Trade and Merchandise Marks Act, 1958. Their registrations are subsisting till today though the plaintiff has applied for cancellation of the defendants’ mark in the year 1998. The defendants got the aforesaid trademark registered in about 24th November, 1970 in class 11 in respect of lamp and bulbs In 1998 the plaintiff for the first time protested the defendants against their use of mark ‘Honda’ through its attorney. The plaintiff got its registration of the aforesaid mark ‘Honda’ in India in 1961 in class 12 ( for motor cycles /motor scooters etc. including parts and fitting thereof) This registration is also valid and subsisting. So the defendants are entitled to get statutory protection under Sections 28 and 30 As long as the registration of the defendants is not cancelled and it remains valid the question of infringement does not arise because of Sections 28 and 30 The plaintiff/ petitioner does not manufacture auto lamp or auto bulb. Therefore, in the circumstances as above question of infringement does not arise. It would be suffice for the time being to refuse injunction on the plea of infringement. In this case the defendants have been, upon registration bona fide concurrently using the said mark ‘Honda’ since 1970

**PASSING off** – Interim injunction-Reputation and goodwill-Defendant senior user of impugned trade mark-Failure of plaintiff to show that it enjoyed wide reputation and goodwill in India when the defendant adopted the mark-Injunction would not have been granted since the relevant date for determining question of passing is the date of commencement of adoption of the mark by defendant-Trade and Merchandise Marks Act, 1958, Sections 28 & 30- Civil Procedure Code, 1908, Order 39, Rules 1 & 2.

**HELD:** In order to succeed in passing off action plaintiff is to establish goodwill and reputation of its ‘mark’. The real test is as to whether by using the mark there would be any confusion and/or deception in the mind of the public buyer or not. In this case there is hardly any scope for deception and/or confusion as the plaintiff’s product is motor car and motor cycle and other automobile machines. It does not appear to me that the plaintiff at any point of time either manufactured or used or advertised their mark ‘Honda’ for trading auto lamp or auto bulb. So there cannot be any idea in the mind of the public buyer the plaintiff has the product of auto lamp or auto bulb so much so it can create confusion. The defendant has adopted

the mark 'Honda' in or about 24th November, 1970 when the defendant applied for registration and since then defendants openly, and to the notice and knowledge of all persons concerned has been using the said mark. **APART** from a solitary document, viz, an advertisement in National Geographic 1971 April issue there is no material that the plaintiff had established its wide reputation and goodwill in India. In true sense the defendant is the senior user of the said mark '**Honda**' in respect of auto lamp and auto bulb in India as the mark was adopted in 1970. The date for determining whether the plaintiff has established the necessary goodwill and reputation of its product is the date of commencement of the conduct complained of. THE trademark 'Honda' was adopted by the defendants in any event honestly and bona fide. **WHEN** the defendants adopted the mark '**Honda**' the plaintiff was not known in India as far as their product under the mark '**Honda**' is concerned. It has been established prima facie is that the defendant is senior user of the mark 'Honda' in respect of auto lamp and auto bulb. They cannot be prevented from using this mark.

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1998 PTC (18)

**Relaxo Rubber Industries VERSUS Aman Cable Industries**

**Trade and Merchandise Marks Act, 1958 Section 30 (1)-** Infringement of trade mark-Use of mark for a different class of goods does not constitute infringement.

**HELD:** It is admitted case of the parties that the trade mark '**RELAXO**' in respect of only footwear's as is apparent from the registration certificate placed on record. In that view of the matter provisions of section 30 (1) becomes applicable which provides that the use of the registered mark by any person in any manner in any place or in any circumstance not covered by the scope of registration, does not constitute infringement.

**TRADE MARK** Passing off-Different class of goods-Registration of trade mark in respect of footwear-Use of trade mark-for the purpose of wires and cables-Use of descriptive words as trade mark-Interim injunction refused.

**HELD:** The word '**RELAXO**' is being used by the plaintiff for its various types of footwear's. Admittedly, the word '**Relaxo**' is derived from the word '**Relax**' and to the said word '**Relax**' a suitable vowel '**O**' has been added to constitute a pronounceable word. Otherwise it could also be that to the word '**Relax**' another word namely '**On**' is used deleting '**N**' from the word '**On**'. Since the word '**RELAXO**' is being used as a trade mark for the footwear's marketed by the plaintiffs the intention of having the said mark could be to denote or make the customers aware that a person wearing the footwear's of marketed by the plaintiffs In the latter case the plaintiffs intended to take two dictionary words, join them together and then drop the letter '**N**' so as to make it one single word, and also to make it distinct from the originating word. In the earlier case it is a case of using a word, adding thereto a suitable vowel to constitute a pronounceable word the word

'Relax' is a dictionary word and is descriptive in nature. "RELAXON" or "RELAXO" are also descriptive words both 'Relax' and 'On' signifying the nature and character of the article. The mark is indicative and descriptive of the thing intended. Examined thus I am of the opinion that the word 'RELAXO' is prime facie purely descriptive when a mark is used consisting of a purely descriptive word or words it cannot be said that a case of passing off has been made out. Words 'Relax On' or 'Relax' adding thereto a vowel 'O' are dictionary words and more or less purely descriptive word or words it cannot be said that a case of passing off has been made out. Words 'Relaxn' Or Relax' adding thereto a vowel 'O' are dictionary words and more or less purely descriptive in nature Thus the said words cannot be said to be invented by the plaintiffs. Since the nature of trading and the goods dealt with by the plaintiffs and the defendants are distinct and separate having no connection with each other at all and since the trade mark of the plaintiffs is held to be not an invented word it cannot be said that a case of passing off has been made out by the plaintiffs on the user of the defendants of the same trade mark in relation to its goods of wires, cables and PVC pipes. Even otherwise the defendants have placed on record the documents indicating the defendants dealing with the mark "RELAXO " for last about 8 years, the bills and the receipts placed on record indicate that the aforesaid mark is being used at least from 25/12/1993 and the suit was filed in the year 1997. Thus there was also delay on the part of the plaintiffs in approaching this court The plaintiff has to bring an action of passing off immediately after the user of the same trade mark by the defendants. Thus on consideration of the entire facts and circumstances the prayer of the plaintiffs restrained from using the trade mark "RELAXO" in respect of its goods in the nature of wires, cable and PVC pipes. The ad interim injunction granted by this court stands vacated to the aforesaid extent.

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1984 PTC 102

**Charan Das & M/S Veer Industries VERSUS M/s Bombay Crockery House**

Plaintiff registered proprietor of trade **Perfect** and **Swastik Perfect** also owners of copyright and registered design in respect of stove--- Defendants using the trade mark **Trishul Perfect** and **Vijay Perfect**--- infringement and passing off disclaimer effect of interim injunction consolidating proceedings **section 9(1)(d) 17 & 27 of the Trade and Merchandise Marks Act, 1958:**

**Held:-**that under section 9(1)(d) of the act, the word '**perfect**' being an adjective or a laudatory epithet cannot be registered and actually there being a disclaimer of the word '**perfect**' in terms of section 17 of the Act the registration does not confer any right of exclusive use of a word in the trade mark otherwise than by registration. The right against passing off is independent and does not arise out of registration which is clear from section 27 of the Act. In order to succeed in an action for passing off, the plaintiff has to establish user of the mark prior to point. That being so, the

plaintiffs having using the mark since 1964 which fact being not controverted and the defendants being stockiest and seller of the product of the plaintiff can easily pass off his own goods as those of the plaintiffs. The balance of convenience being clearly in favour of the plaintiffs as the suit may take lot of time being disposed of and in the meantime the defendants may go on selling stoves under the trade mark 'PERFECT' which may finish the market of the plaintiffs. In the circumstances the use of the trade mark 'PERFECT' by the defendant is stopped so as to avert irreparable injury happening to the plaintiffs. As regards the infringement of copyright, there being no similarity as to the shape and colour scheme etc. of the cartons used for packing the stoves of the plaintiffs, the contention fails. Similarly there is no necessity of issuing injunction in respect of design because as soon as the word 'Perfect' is not used by the defendants on his products, the stoves manufactured by the plaintiffs is clearly distinguishable.

Relating to consolidating the proceedings as to cancellation of the design, it is held that consolidation will cause confusion as that application is confined to one aspect of the present case i.e. validity of registration of design and that application has nothing to do with the trade marks and copyrights however that application listed on the same day and before the same Bench when the present suit is listed.

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AIR 2000 SUPREME COURT 2114

**M/s. S.M Dyechem Ltd., Versus M/s. Cadbury (India) Ltd.**

**Trade and Merchandise Marks Act (43 of 1958), S. 106** – Trade mark – Infringement – Injunction – Power of Court – In trade mark matters, it is now necessary to go into the question of 'comparable strangling' of the cases of either party, apart from balance of convenience. Trade and Merchandise Marks Act (43 of 1958), S. 106 – Trade mark – Infringement – Proof – Peculiar aspects of common features of disputed word namely peculiar script and curve not copied by defendant – Dissimilarities appearing to be more striking to naked eye than similarity between two marks – Plaintiff not entitled to temporary injunction

8.

1999 PTC (19) 598 P& H Court

**M/s. Bharat Enterprises Versus M/s. C. Lall Gopi Industrial Enterprises**

**Trade Mark Passing off- Generic word**-Use of words 'Heat pillar' which is a generic word for room heaters-No similarity between marks-No prima facie Passing Off made out-Interim injunction can not be granted-Civil Procedure Code, 1908-Order 39 Rule 1 & 2- Trade & Merchandise Marks Act, 1958 – Section 29.

**Held:** An exclusive trade-mark must consist of some arbitrary or fanciful term, figure, or device, and words or phrases, in order to constitute a trade-mark, must be used in a purely arbitrary or fanciful when they do not, by their usual and ordinary

meaning, denote or describe products to which they are applied, but rather come to indicate their purposes by application and association."

The principle or settled rule would be that either in the case of goods or business the plaintiff has to show that his mark has become so distinctive that the public regard the same as belonging to a particular source. The plaintiff has to further prove that the offending mark or name is likely or calculated to deceive and cause confusion among the public thereby injuring the plaintiff's business. The test in this regard necessarily would be of a normal prudent person as to whether the appellant is selling the goods so marked as by design or calculated the public to believe that they are the goods of the respondent.

The expression "HEAT PILLAR" must be taken to be a generic word. All those room heaters which are so designed like a pillar are using the word Heat Pillar. It cannot be confined to the respondents. They cannot have the exclusive right to use the word Heat Pillar. It is the other words of the company concerned which are the tilting factors. In the case of appellants, they are using the word "Belco". Between the word 'Belco' and "Gopi" there is a clear phonetic distinction.

The attention of the Court even had drawn to the advertisement of the Himachal Government wherein it is also using the word Heat Pillar. The same is not being confined to only the respondents. It shows that the Himachal Government even wanted Heat Pillar from different companies having different names, may be that they will use the name Heat Pillar. Different logos have been used and slight similarity in packets by itself cannot be a factor to prompt the Court to hold that an ordinary person would be deceived.

## 9. 2002 (25) PTC 189 (Guj)

**M/s. Lark Laboratories (India) Ltd. Versus M/s. Medico Interpharma Ltd**

**Civil Procedure Code 1908, Section 104, Order 39, Rules 1 & 2** – Interference in appeal – Interim injunction- Appellate Court is within the power to interfere with the exercise of discretion of the trial court in granting or refusing interlocutory relief if the discretion is shown to have been exercised arbitrarily or capriciously ignoring the settled principles of law regarding grant or refusal of injunction.

**Trade Mark Interim injunction** – Interference in appeal- where the trial court has come to a conclusion that balance of convenience was in favour of the plaintiff without assigning any reason, and also not dealt with material on record to come to the conclusion that balance of convenience was in favour of the plaintiff without assigning any reason, and also not dealt with material on record to come to the conclusion that irreparable injury would be caused to the plaintiff if injunction not been granted, the order is liable to be set aside and matter remanded to the trial court to be decided afresh.

**Held:** Satisfaction that there is a prima facie case by itself is not sufficient to grant injunction. The Court further has to satisfy that non-interference by the Court

would result in “irreparable injury” to the party seeking relief and that there is no other remedy available to the party except one to grant injunction and he needs protection from the consequences of apprehend injury or dispossession. Though the trial Court has come to a conclusion stating in a single line that balance of convenience is in favour of plaintiff, he has not discussed any material or affidavit to come to such conclusion in his order and that the reason should be plausible reasons. The absence of any reason to arrive at a particular decision will be unjustifiable in eye of law, because when a judicial discretion is to be exercised, the same is to be exercised with due care, caution and circumspection. **Hence**, in absence of reason, it is very difficult to justify the conclusion reached to by trial Court with regard to balance of convenience in favour of the plaintiff.

Impugned order suffers from following two most material irregularities which go to the root of the impugned order: **(1)** Though the learned Judge of the trial Court has come to a one line conclusion that balance of convenience is in favour of plaintiff, he has not assigned any reason for such conclusion ; **(2)** The learned Judge of the trial Court has not at all discussed and dealt with material on record to come to a conclusion that irreparable injury would be caused to plaintiff, if injunction is not granted. He has not reached to any conclusion for injury much less irreparable injury. Injunction can be granted only if three important material ingredients are satisfied by the plaintiff at a time. It is not sufficient that if only one ingredient is satisfied, other two ingredients are presumed to have been satisfied by the plaintiff automatically. Under the circumstances, the impugned order is contrary to settled principles of law relating to grant or refusal of interim injunction, and therefore, this is a fit case in which the Appellate Court should interfere with the impugned order. The impugned order suffers from serious infirmity because of the lapses committed by the trial Court. Had he discussed material on record to a conclusion with regard to balance of convenience, the decision of this Court would be otherwise. Similarly, the learned Judge has completely failed to discuss the material on record for coming to a conclusion on the point of irreparable injury. Because of the lapses committed by the learned Judge, the impugned order is found to be contrary to well settled principles of law regulating to grant or refusal of interlocutory injunction. This Court is of the view that the party should not suffer for lapse committed by the learned Judge, and therefore, to do a complete justice, impugned order is required to be set aside and application is required to be remanded for hearing afresh by the trial Court.

## 10. 2001 PTC 300

**M/s. Cadila Health Care Ltd Versus M/s. Cadila Pharmaceuticals Ltd.**

**Trade Marks –Passing off-** unregistered trademark – factors to be considered for deciding the questions of deceptive similarity enumerated.

**Held:** In an action for passing off on the basis of unregistered trade mark, generally for deciding the question of deceptive similarity, the following factors are to be considered: -

- a) The nature of the marks i.e., whether the marks are word marks or label marks or composite marks i.e., both words and label marks.
- b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.
- c) The nature of goods in respect of which they are used as trademarks.
- d) The similarity in the nature, character and performance of the goods of the rival traders.
- e) The class of purchasers who are likely to buy the goods bearing the mark they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and or using the goods.
- f) The mode of purchasing the goods or placing orders for the goods and;
- g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.
- h) Weightage to be given to each of the aforesaid factors depends upon facts of each case and the same weightage cannot be given to each factor in every case.

The “**passing off**” action depends upon the principle that nobody has a right to represent his goods as the goods of somebody. In other words, a man is not to sell his goods or services under the pretence that, they are those of another person.

“**Passing off**” have five elements: -

- i) A misrepresentation;
- ii) Made by the trader in the course of trade;
- iii) To prospective customers’ of his or ultimate consumer of goods or services supplied by him;

Which is calculated to injure the business or goodwill of another trader and Which causes actual damage to a business or goodwill of the trader by whom the action is brought or will probably do so?”

The real question to decide in such cases is to see as to how a purchaser, who must be looked upon as an average man of ordinary intelligence’s, would react to a particular trademark, what association he would form by looking at the trademark and in what respect he would connect the trademark with the goods which he would be purchasing”

“It is well known that the question whether the two marks are likely to give rise to confusion or not is a question of first impression It is for the court to decide the question-----It is well recognized that in deciding a question of similarity between two marks, the marks have to be considered as a whole.

“You must take the two words You must judge then, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those

goods In fact, you must consider all the surrounding circumstances and you must further consider what is likely to happen, if each of these trademarks is used in a normal way as a trademark for the goods of the respective owners of the marks”.

Judgements