

THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment Pronounced on: 21.12.2011

+ CS(OS) 1284/2006

GENERAL ELECTRIC COMPANY **Plaintiff**

Through: Mr Pravin Anand, Ms Kruttika
Vijay and Mr Shrawan Chopra, Advs.

versus

MR. J.SINGH AND ORS. **Defendants**

Through: None

CORAM:-

HON'BLE MR JUSTICE V.K. JAIN

V.K. JAIN, J (ORAL)

1. The plaintiff is a large corporation incorporated in United State of America and also has a subsidiary in India by the name GE International Operations Company, Inc. The plaintiff, which is a 122 years old company, claims to be the world's largest diversified services company, providing high quality, high technology industrial and consumer products, has 250 manufacturing plants in 25 countries and employs 3,40,000 personnel. The plaintiff was recognized as the 'world's most valuable company' by Time

magazine. It is alleged that plaintiffs Six Sigma quality, which is aimed at complete customer satisfaction, translates into high degree of efficiency and uniformity in products and services, and a hard-to-match record of minimal rate of defects per million products, giving it a distinct edge over competitors. The businesses of the plaintiff include (i) GE Appliances, which is one of the largest manufacturers of major appliances such as dehumidifiers, refrigerators and freezers, electric and gas ranges, microwave ovens, washers and dryers, dish washers, disposals and compactors, room air-conditioners, water purifying systems etc. being sold under various well-known trademarks under GENERAL ELECTRIC and GE (Monogram); (ii) GE Lighting, leading supplier of lighting products such as incandescent, fluorescent, high intensity discharge, halogen and holiday lamps along with portable lighting fixtures, lamp components and quartz products; (iii) GE Medical Systems, a world leader in medical diagnostic imaging technology with products including computed tomography (CT Scanners), X-Ray equipment, nuclear medicines cameras, ultra sound systems, mammography and radiation therapy equipment, etc.; (iv) GE Aircraft Engines, world's largest

producer of large and small jet engines for commercial and military aircrafts; (v) GE Industrial Systems, industrial leaders in design and motivate or products such as industrial motors and drives, circuit breakers, switches, transformers, switch boards, switchgears, meters, relays, programmable logic controllers, and power management solutions; (vi) GE Plastics, a world leader in versatile high performance engineered plastics used in business equipment, automotives, building and construction of other industries; (vii) GE Information Services, a global leader in business-to-business electrical solutions; (viii) NBC which is a leading US television network with outstanding news, sports and entertainment programming.; (ix) GE Capital Services a diversified financial services organization that provides services globally including Europe and Asia through a network of several highly-focused businesses in five core niches; Equipment Management, Consumer Services, Specialized Financing, Mid-Market Financing and Specialty Insurance; (x) GE Power Systems a world leader in the design, manufacture and service of gas, steam and hydro electrical turbines and generators for power production, pipeline and industrial applications; (ix) GE

Transportation Systems, which manufactures more than half of diesel freight locomotives in North America and has operations in 74 countries.

2. The trademarks GE and GENERAL ELECTRIC being used by the plaintiff as its trade name, trademark and is mark are stated to be well-known marks. The plaintiff-company holds the following registrations in India in respect of the trademark GE and GENERAL ELECTRIC and their variations:

Trademark	Class	Description of Goods	Regn. No.
GE Monogram	1	Chemical products used in industry science, photography, agriculture, horticulture; forestry, artificial and synthetic resins; plastics in the form of powders; liquids of pastes for industrial use; manures (natural and artificial); fire extinguishing compositions; tempering substances and chemical preparations for soldering; chemical substances for preserving foodstuffs, tanning substances, adhesive substances used in industry	399688
GENERAL ELECTRIC GE	2	Paints, varnishes (other than insulating varnish), shellacs, lacquers and resins	10091
GE Monogram	3	Bleaching preparations and other substances for laundry use; cleaning; scouring and abrasive preparations; soaps,	399956

		perfumery, essential oils; cosmetics; hair lotions; dentifrices.	
GE Monogram	6	Metal alloys not included in other classes	10085
GE Monogram	7	Compressors (Machinery); pump, condensers and gearing (not included in other classes), machine tools and parts thereof, electric alternators, electric generators, electric motors, electric ignition devices for engines, electric hoists, magnetos, mining machinery, elastic fluid turbines, internal combustion engines not included in class 12, and marine engines.,	10086
GE Monogram	9	Magnets	304290
GENERAL ELECTRIC GE	9	Cinematograph apparatus, radio receiving and transmitting apparatus, television apparatus, thermionic valves, cathode ray tubes, conductors, phonographs, insulated wire, loudspeakers, electric welding apparatus, electric circuit breakers, circuit closers, electric fuses, electric control apparatus, electric protective devices, electric converters, rectifiers, transformers, amplifiers, discharge tubes and parts thereof, electric relays, electric resistances, electric measuring apparatus and instruments, switches and switchboards, induction apparatus, collectors,	10094

		contact devices, smoothing irons, flat irons, vacuum cleaners.	
GE Monogram	9	Cinematograph apparatus, radio receiving and transmitting apparatus, television apparatus, thermionic valves, cathode ray tubes, conductors, phonographs, insulated wire, loudspeakers, electric welding apparatus, electric circuit breakers, circuit closers, electric fuses, electric control apparatus, electric protective devices, electric converters, rectifiers, transformers, amplifiers, discharge tubes and parts thereof, electric relays, electric resistances, electric measuring apparatus and instruments, switches and switchboards, induction apparatus, collectors, contact devices, smoothing irons, flat irons, vacuum cleaners.	10087
GENERAL ELECTRIC GE	10	Diagnostic apparatus, accessories and parts thereof using X-ray, Gamma Rays or other radiation, such as spot film devices, X-Ray image intensifier systems, X-ray fluoroscopes, mobile X-ray units, dental X-ray units, X-ray tables, radiographic film viewers, computerized tomography scanner systems, nuclear camera systems and ultra sound scanner systems, devices used to monitor physiological activities, such as cardiac activity, temperature and blood pressure and parts	107920

		and accessories thereof, prosthetic devices such as defibrillators and parts and accessories thereof.	
GE Monogram	10	X-ray apparatus for locomotion by land, air and water.	107919
GE Monogram	11	Gas and oil-burning furnaces, electric fans, electric air conditioning apparatus, electric heating apparatus, electric cooking apparatus, electric furnaces, electric incandescent lamps, electric gaseous discharge lamps, electric photographic flash lamps, electric refrigerating apparatus, electric washing apparatus (clothes and dishes), electric lighting fittings and accessories not included in other classes.	10088
GENERAL ELECTRIC GE	11	Gas and oil-burning furnaces, electric fans, electric air conditioning apparatus, electric heating apparatus, electric cooking apparatus, electric furnaces, electric incandescent lamps, electric gaseous discharge lamps, electric photographic flash lamps, electric refrigerating apparatus, electric washing apparatus (clothes and dishes), electric lighting fittings and accessories (not included in other classes).	10095
GE in block letters	12	Vehicles, apparatus for locomotion by land, air or water	583550
GE Monogram	17	Gutta percha; indiarubber; balata and substitutes; articles made from these	399689

		substances and not included in other classes, plastics in the form of sheets; blocks and rods; being for use in manufacture; materials for packing; stopping or insulating; asbestos; mica and their products; hose pipes (not metallic)	
GENERAL ELECTRIC GE	17	Dielectric or insulating oils and compounds	10090

3. The plaintiff has wide presence in India through the following subsidiaries/Joint Venture Companies:

- i. GE India Technology Centre Pvt. Ltd.
- ii. GE Plastics India Limited
- iii. Wipro GE Medical Systems Limited
- iv. GE Power Control India Pvt. Ltd.
- v. GE Lighting (India) Ltd.
- vi. GE Bayer Silicones (India) Pvt. Ltd.
- vii. GE Fanuc Systems Pvt. Ltd.
- viii. GE BE Limited
- ix. GE Motors (India) Ltd.
- x. GE Power Services (India) Ltd.
- xi. GE Capital International Services
- xii. GE Capital Services India Limited

- xiii. GE Countrywide Consumer Financial Services Ltd.
- xiv. GE Capital Transportation Financial Services Ltd.
- xv. GE Capital Business Process Management Services Pvt. Ltd.
- xvi. BHEL GE Gas Turbine Services Ltd.
- xvii. Satyam GE Software Services Pvt. Ltd.
- xviii. Godrej GE Appliances Ltd.
- xix. GE Medical Systems X-Ray (South Asia) Ltd.
- xx. **IGE** (India) Limited.

4. It is alleged that during last more than 100 years, the plaintiff has built up an unparalleled reputation and goodwill in its trade name/trademark GENERAL ELECTRIC and GE and it was rated as 'The World's Most Respected Company' by the Financial Times from 1998 to 2003, 'The Company of the Century' by Time Magazine, 'Most Admired Company in America' by Fortune Magazine from 1999 to 2002 and ranks 05th in overall ranking in the Fortune 500 companies. It is claimed that by virtue of long and continuous usage of the trade name and trade mark GENERAL ELECTRIC and trademark GE by the plaintiff in practically all parts of the world, including India in respect of enormous variety of goods and services, the aforesaid

trade name and trademark have come to be identified exclusively with the plaintiff and use of the aforesaid mark in relation to any goods would automatically be considered to be as use by the plaintiff.

5. The plaintiff had revenue of US\$ 132226 million, US\$ 134641 million and US\$ 152866 million in the years 2002, 2003 and 2004 respectively. It is also claimed that the plaintiff-company extensively advertises and promoting its goods and services under the trademark GE and GENERAL ELECTRIC on a regular basis in newspapers and magazines having international reach and circulation. The actual promotional expenditure of the plaintiff is alleged to be US\$ 406.3 million, US\$ 439.5 million and US\$ 471.6 million in the years 1997, 1998 and 1999 respectively. It is also alleged that the plaintiff has been zealously protecting its rights in the aforesaid mark and has obtained injunctions from this Court alone in a number of cases mentioned in para 20 of the plaint.

6. Defendant No. 1 Mr J. Singh and defendant No. 2 Mr Sukhwinder Singh are carrying business under the name and style of Galaxy Enterprises (Defendant No.3) and they appear to be manufacturing nuts, bolts, suts, washers,

rivets. In April, 2005, the plaintiff came across an advertisement in Trademarks Journal of 14th February, 2005, whereby it came to know that the defendant had applied for registration of the Trademark GE in class 6 in respect of all kinds of nuts, bolts, suts, etc. The plaintiff filed an Opposition to the aforesaid registration, which is stated to be pending. It is alleged that use of the impugned mark by the defendants is bound to mislead the consumer and members of the trade, who being familiar with the reputation of the mark GE, are likely to be deceived on account of use of the aforesaid marks by the defendant. It is also alleged that adoption of the trademark GE by the defendants is mala fide and dishonest, aimed at earning illegal profits by encashing upon the tremendous reputation and goodwill which the brand of the plaintiff enjoys throughout the world.

7. The plaintiff has sought an injunction, restraining the defendants from selling, advertising or promoting any product or service under the trademark GE or any other mark deceptively similar to plaintiff's registered trademark. The plaintiff has also sought damages, amounting to Rs 20 lakh, besides delivery up of the infringing material.

8. The defendant was proceeded ex parte vide order dated 14th March, 2007. The plaintiff has examined its constituted attorney Mr Mrigank Sharma by way of ex parte evidence. In his affidavits by way of evidence, Mr Sharma has supported on oath the case set out in the plaint and has proved various document relied upon by the plaintiff.

9. In **Tata Sons Ltd. vs. Manoj Dodia & Ors** 2011 (46) PTC 244 (Delhi), I had an opportunity to examine as to what in India would constitute a well-known mark within the meaning of Section 2(ZG) of Trademarks Act, 1999. This Court, inter alia, observed as under:

“The doctrine of dilution, which has recently gained momentum, particularly in respect of well known trademarks emphasises that use of a well known mark even in respect of goods or services, which are not similar to those provided by the trademark owner, though it may not cause confusion amongst the consumer as to the source of goods or services, may cause damage to the reputation which the well known trademark enjoys by reducing or diluting the trademark’s power to indicate the source of goods or services.

Another reason for growing acceptance of trans-border reputation is that a person using a well known trademark even in respect of goods or services which are not similar tries to take unfair advantage of the trans-border reputation which that

brand enjoys in the market and thereby tries to exploit and capitalize on the attraction and reputation which it enjoys amongst the consumers. When a person uses another person's well known trademark, he tries to take advantage of the goodwill that well known trademark enjoys and such an act constitutes an unfair competition.

The concept of confusion in the mind of consumer is critical in actions for trademark infringement and passing off, as well as in determining the registrability of the trademark but, not all use of identical/similar mark result in consumer confusion and, therefore, the traditionally principles of likelihood of confusion has been found to be inadequate to protect famous and well known marks. The world is steadily moving towards stronger recognition and protection of well known marks. By doing away with the requirement of showing likelihood of confusion to the consumer, by implementing anti-dilution laws and recognizing trans-border or spill over reputation wherever the use of a mark likely to be detrimental to the distinctive character or reputation of an earlier well known mark. Dilution of a well known trademark occurs when a well known trademark loses its ability to be uniquely and distinctively identify and distinguish as one source and consequent change in perception which reduces the market value or selling power of the product bearing the well known mark. Dilution may also occur when the well known trademark is used in respect of goods or services of inferior quality. If a brand which is well known for the quality of the products sold or services

rendered under that name or a mark similar to that mark is used in respect of the products which are not of the quality which the consumer expects in respect of the products sold and/or services provided using that mark, that may evoke uncharitable thoughts in the mind of the consumer about the trademark owner's product and he can no more be confident that the product being sold or the service being rendered under that well known brand will prove to be of expected standard or quality.

The owner of a well known trademark may (i) seek cancellation or (ii) prevent registration of a trademark which is same or similar to the well known mark irrespective of whether the impugned mark is in relation to identical or similar goods or services or in relation to other categories of goods or services. He may also prevent others from incorporating the well known trademark as a part of their corporate name/business name. Even if a well known trademark is not registered in India, its owner may avail these rights in respect of the trademark registered/used or sought to be registered/used in India, provided that the well known mark is otherwise known to or recognized by the relevant section of public in India.

The existence of actual confusion or a risk of confusion is, however, necessary for the protection of a well known trademark, as a result of infringement.

Trademarks Act, 1999 does not specify the factors which the Court needs to consider while determining whether a mark is a well known mark or not,

though it does contain factors which the Registrar has to consider whether a trademark is a well known mark or not. In determining whether a trademark is a well known mark or not, the Court needs to consider a number of factors including (i) the extent of knowledge of the mark to, and its recognition by the relevant public; (ii) the duration of the use of the mark; (iii) the extent of the products and services in relation to which the mark is being used; (iv) the method, frequency, extent and duration of advertising and promotion of the mark; (v) the geographical extent of the trading area in which the mark is used; (vi) the state of registration of the mark; (vii) the volume of business of the goods or services sold under that mark; (viii) the nature and extent of the use of same or similar mark by other parties; (ix) the extent to which the rights claimed in the mark have been successfully enforced, particularly before the Courts of law and trademark registry and (x) actual or potential number of persons consuming goods or availing services being sold under that brand. A trademark being well known in one country is not necessarily determinative of its being well known and famous in other countries, the controlling requirement being the reputation in the local jurisdiction.”

10. The deposition of Mr Mrigank Sharma, coupled with the documents filed by the plaintiff-company would show that the mark GE and GENERAL ELECTRIC are known almost throughout the world, including India and,

therefore, are widely recognized as the trademarks belonging to the plaintiff-company. These trademarks have been in use in a large number of countries for more than 100 years, in respect of a large number of diversified products and services. The plaintiff-company has been regularly advertising its brand names and incurring huge expenditure on such advertisement and promotion on a regular basis, almost throughout the world, including India. The plaintiff-company holds registrations in the aforesaid trademarks in a large number of countries. It has about 250 manufacturing capacities in various countries and employs more than 3 lakh personnel. The sale turnover of the plaintiff-company, using the aforesaid trademarks, was US\$ 147955 million, US\$ 163391 million and US\$ 172738 million in the years 2005, 2006 and 2007 respectively, which is a strong indicator of the worldwide presence, the plaintiff has in a large number of products and services. The promotional expenditure of the plaintiff-company was US\$ 406.3 million, US\$ 439.5 million and US\$ 471.6 million in the years 1997, 1998 and 1999 respectively. The plaintiff-company carries on business in India through as many as 19 subsidiaries/joint venture companies.

The plaintiff-company holds a number of trademark registrations in India in class 1, 3, 6, 7, 9, 10, 11, 12, 17, 41 and 42. The registrations in class 1, 3, 6, 7, 9, 10, 11 & 17 are GE (Monogram - the letter GE in a circle, in a stylized form). The registrations in class 2, 9, 10, 11 & 17 are trademark registrations of GENERAL ELECTRIC GE, whereas, the registration in class 12 is of the GE trademark. The plaintiff-company has been zealously protecting its aforesaid trademarks and filed CS(OS) No. 1880 of 2000, CS(OS) No. 1180 of 2001, CS(OS) No. 1634 of 2003, CS(OS) No. 239 of 2005, CS(OS) No. 241 of 2005, CS(OS) No. 242 of 2005, CS(OS) No.404 of 2005 and 1 CS(OS) No. 1119 of 2006 in this Court and obtained injunction against infringement of its trademark. The plaintiff-company has applied for a number of other registrations in India in different classes. The plaintiff-company has consistently been ranked amongst world's largest corporations. It was accorded first and second rank in the Forbes Super 500 list of companies from 1997 to 2004 and ranked 5th in the year 2005. It was recognized as 'world most respected company' by Financial Time Magazine in the years 1999 to 2004 and 'globally most admired company' by Fortune magazine in

the years 1999 to 2007. It has also come in evidence that the trademarks of the plaintiff-company were valued at US\$ 39 billion, US\$ 42 billion, US\$ 44 billion and US\$ 49 billion in value, in the year 2000, 2001, 2004, 2005 and 2006 respectively. It was voted as the third most admired company by the Fortune magazine in the year 2005 and Fourth most “Innovative Company” by Business Week for the year 2008.

Considering the overwhelming presence of the plaintiff-company almost throughout the world, the diversified range of the products and services offered by it throughout the world, widespread presence of the company in India through a number of subsidiaries/joint venture companies, various registrations of the trademark GE/GENERAL ELECTRIC, leading position accorded to it by highly reputed business magazines such as Time, Fortune and Business Week, the variety of the trademarks being used by the plaintiff-company and the orders passed by this Court from time to time against infringement of the trademarks of the plaintiff-company, the sale turnover of the plaintiff, promotional expenditure being incurred by it throughout the world in building its brands and promoting

its business, there being no evidence of any other persons holding registration or using the trademark GE and the reputation which the plaintiff-company enjoys throughout the world, including India, it can hardly be disputed that GENERAL ELECTRIC as well as GE, whether written in plain letters or in a stylized form such as a Monogram are well-known marks of the plaintiff, within the meaning of Section 2(ZG) of Trademarks Act.

11. The mark which the defendant used or proposed to be used is a word mark consisting of two letters of English alphabet 'G' & 'E'. The plaintiff has only one registration of the word mark GE which is in Category 12, whereas rest of its registrations are of the word mark GENERAL ELECTRIC and GE (monogram). The question which comes up for consideration is as to whether use/proposed use of the word mark GE by the defendant constitutes infringement of a well known mark of the plaintiff. In my view, not only GE (monogram) and GENERAL ELECTRIC but also the word mark GE, are the well known marks of the plaintiff. Assuming, however, that the word mark GE is not the well known mark of the plaintiff and only GENERAL ELECTRIC and GE (monogram) are its well known marks, use of the

word mark GE by the defendant, in my view, would still constitute infringement of the well known mark GE (monogram) of the plaintiff. It is by now settled proposition of law that in order to constitute infringement of a registered trademark, the impugned mark need not be its absolute replica and it is sufficient to constitute infringement if the impugned mark is visually, phonetically or otherwise so close to the registered trademark of the plaintiff that it would be considered to be a imitation of the registered trademark. In fact, the infringer is not likely to use a mark which is absolutely identical of a registered trademark, but would like to make some changes here and there so that in the event the mark used by him is challenged, he can take a plea that since his mark was not identical to the mark of the plaintiff, no case of infringement was made out.

Section 29(4) of Trademarks Act 1999 which deals with infringement of a well known mark, to the extent it is relevant, provides that such a mark is infringed by use of a mark which is identical with or similar to the registered trademark, is used in relation to goods or services which are not similar to those for which the trademark is registered and use of the impugned mark, without due cause takes

unfair advantage or of is detrimental to the distinctive character or repute of the registered trademark. The mark GE, though not identical to the registered trademark GE (monogram) of the plaintiff, it is difficult to dispute that it is similar to the plaintiff's trademark GE (monogram). If there is a deceptive resemblance between registered trademark and the impugned trademark, that would be sufficient to constitute infringement within the meaning of Section 29 of the Trademarks Act, 1999. It was observed by Supreme Court in **Ruston & Hornsby Ltd. v. The Zamindara Engineering Co.** 1969(2) SCC 727, where the alleged infringement consists of using not the exact mark on the register, but something similar to it, the test of infringement is the same as in an action for passing off, which would mean the test as to likelihood of confusion or deception arising from similarity of marks. The question as to whether the two competing marks are so similar as to be likely to deceive or to cause confusion has to be considered from the point of view of a man of average intelligence and imperfect collection, who is not likely to notice and retain in his mind, all the details of the registered trademark. What such a person notices and keeps in mind is what is called

essential or distinguishing features of the mark which he has earlier seen on the goods purchased or services availed by him or which on account of quality of products sold or the services rendered under that mark has built such a reputation that he wants to buy the goods being sold or services being offered under that particular mark without having purchased such goods or availed such services in the past. The Courts need to ensure that there is no confusion in the mind of such a customer as regards source of the product or service he is buying and he needs to be assured that he is buying the same product or the same services which he intends to buy and identifies on account of the mark under which it is sold.

In **Saville Perfumery Ltd. vs. June Perfect Ltd.**, *LVIII, reports of Patent, Design and Trademark cases – 6*, the plaintiff was using the trademark “June”, printed in a particular way over a bar and a word “Saville” was used in connection with that trademark. The mark was not merely the word “June”, but the word “June” represented in a particular way. Underneath, the word “June” was a garland of flowers and roses and the plaintiff had no right to the exclusive use of the flower devices. The defendants were

selling goods which had upon them the word “June”. The case of the plaintiff, both as regards, infringement as well as passing off, rested upon the use of the word “June” on lotion, lipstick and the shampoo powder. The case of the plaintiff was that the word “June” had become so identified with the toilet preparations manufactured by it that use of the word “June” inevitably led to the goods being sold as the goods of the plaintiff. On the case of the plaintiff having been dismissed, the matter was taken to Court of Appeal, which allowed the appeal, holding it to be the case of infringement as well as passing off. The Court of Appeal noted that infringement takes place not merely by exact imitation but also by use of a mark so nearly resembling the registered mark as is likely to deceive. The Court noted that, in the case of certain goods, traders and perhaps the public too, may be expected to receive so strong an impression of the actual mark as to lead to the conclusion that nothing short of a degree of resemblance apparent to the eye will cause the necessary likelihood of deception, but many articles do not fall within this category. It was observed that the traders who deal with a large number of marks used in the trade in which they are interested, do

not, in practice, and indeed cannot be expected to, carry in their heads the details of any particular mark, while the class of customer among the public which buys the goods does not interest itself in such details. In such cases, the mark comes to be remembered by some feature in it which strikes the eye and fixed itself in the recollection. Such a feature is referred to sometimes as the distinguishing feature and sometimes as the essential feature of the mark. The Court held, on evidence that the word “June” being the distinguishing or essential feature of the Appellants’ mark, the traders and members of the public who see the mark on the goods which they purchase describe the Appellants’ goods. The proposition of Law Court of Appeal approved was that the question of resemblance and the likelihood of deception is to be considered by reference not only to the whole mark, but also to its distinguishing or essential features, if any. The Court observed that if the retailer ordering the goods from the wholesaler asks for the goods under the word “June”, and in answer to that order, an article marked “June”, which, in fact, emanates from the defendant is supplied, there will probably be deception of the customer and possibly of the retailer and therefore user

of the word “June” was a case of infringement. The matter was taken by the defendants to House of Lords by way of appeal, which was dismissed. The Appellants before the House of Lords contended that the conflicting marks were different since the word “June” used by them, if compared with the plaintiff’s registered trademark, was not calculated to deceive. Rejecting the contention, the House of Lords held that distinguishing feature of the plaintiff’s registered mark, was the word “June” and hardly any evidence was required to enable the Court to come to this conclusion and since the Appellants had used an essential feature of the plaintiff’s mark, which was registered mark, a case of infringement was made out. The House of Lords came to the conclusion that the use of the word “June” as a mark on the goods so nearly resembled the Respondents’ mark as was to be likely to deceive or cause confusion in the minds of the purchasers with a normally imperfect recollection of the precise picture representing or containing the registered mark.

A person who has seen or come across the mark GE or GE (monogram) of the plaintiff is likely to notice the letters G & E and neither the stylized form, in which these

letters are written nor the circle in which these letters enclosed. What he is likely to notice and retain in his mind are the letters GE and if he comes across any goods bearing the mark GE, whether it is a word mark, or the letters GE written in a stylized form or it is the letters G & E written in some form other than the form in which it is being used by the plaintiff, he is likely to presume it to be a mark of the plaintiff company. The core, and I would say only distinctive or essential feature of the trademark GE(monogram) of the plaintiff are the letters G & E and, therefore, if anyone uses these two letters together, irrespective of the form in which they are used, this, to my mind, would constitute infringement of the registered trademark GE(monogram) of the plaintiff.

I am in agreement with the learned Counsel for the plaintiff that in order to decide whether the impugned mark infringes the registered trademark of the plaintiff or not, the Court has to compare not only the whole of the marks but also their essential or distinguishing features and if the Court comes to the conclusion that the defendant has used the core or distinguishing part of the registered trademark of the plaintiff that would be the case of infringement since

such a use is likely to cause deception and confusion in the mind of the customer, particularly with respect to source of the goods. If the facts of this case are compared with the facts in the case of **Saville Perfumery** (supra) the case of the plaintiff stands on a much stronger footing.

In **Naturelle Trade Mark case**, the plaintiff was registered proprietor of the trademark NATREL in respect of a range of cosmetics and toiletries. The application for registration of NATURELLE in the device mark and device in respect of skin and hair care preparation etc. was opposed by the proprietor of the trademark NATREL. The Registrar refused the application for registration which was challenged. It was held in appeal that the word NATURELLE was confusingly similar to the word NATREL and the mark NATURELLE was apt to capture the distinctiveness of the earlier trademark NATREL which was likely to cause confusion.

In the case before this Court, the mark of the plaintiff GE (monogram) irrespective of the form in which it is written and the circle in which the letters are enclosed, will be pronounced as GE. The mark used/proposed to be used by the defendant being GE, there is absolute

phonetically similarity between the two marks. It can therefore hardly be disputed that the mark GE used/proposed to be used by the defendants is similar to the mark GE (monogram) of the plaintiff. If a person goes to the mark seeking to buy a product of the plaintiff company he would ask for the product of GE and if a product bearing the trademark GE, in plain letters of English alphabets is offered to him, he is likely to take it as a product of the plaintiff company irrespective of the fact that neither the letters GE are written in a stylized form in which the letters in the trademark GE (monogram) of the plaintiff nor are they enclosed in a circle. To him what matters are the letters GE.

In **K. R. Chinna Krishna Chettiar vs Sri Ambal & Co., Madras & Anr** *AIR 1970 SC 146*, the respondents were proprietors of two trademarks, one consisting of a label containing a device of goddess Sri Ambal in the centre with the legend 'Sri Ambal parimala snuff' at the top of the label and the name 'Sri Ambal & Co. Madras' at the bottom and the other consisting of the expression 'Sri Ambal'. The appellants were seeking registration of a label containing three panels. The first and the third panels contained in

Tamil, Devanagari, Telugu and Kannada the equivalents of the words "Sri Andal Madras Snuff". The centre panel contained the picture of goddess Sri Andal and the legend "Sri Andal". Sri Andal and Sri Ambal are separate divinities. Sri Andal is a vaishnavite woman saint of, Srivilliputtur village and was deified because of her union with Lord Ranganatha. Sri Ambal is the consort of Siva or Maheshwara. The question before Supreme Court was whether the proposed mark was deceptively similar to the respondents' mark. The Registrar was of the view that the appellants' mark was not deceptively similar to the respondents' trademark. The High Court, however, held otherwise and felt that there was great phonetic similarity between the word AMBAL and ANDAL and therefore there was danger of confusion between the two phonetically allied names. Rejecting their plea Supreme Court inter alia held as under:

"It is for the Court to decide the question on a comparison of the competing marks as a whole and their distinctive and essential features. We have no doubt in our mind that if the proposed mark is used in a normal and fair manner the mark would come to be known by its distinguishing feature "Andal". There is a striking similarity and affinity of sound

between the words “Andal” and “Ambal”.

There is 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 the eye. There is a close affinity of sound between Ambal and Andal.

The name Andal does not cease to be deceptively similar because it is used in conjunction with a pictorial device.

The customers who use the respondent's goods will have a recollection that they are known by the word Ambal. They may also have a vague recollection of the portrait of a benign Goddess used in connection with the mark. They are not likely to remember the fine distinctions between a Vaishnavite Goddess and a Shivaite deity.”

In **James Chadwick & Bros. Ltd. vs. The National Sewing Thread Co. Ltd.** *AIR 1951 (Bom) 147*, the appellants were using the two trademarks which they had also got registered. One of the trademarks was bearing the legend ‘Eagley Sewing Machine Thread’, whereas the other trademark was merely a representation of an eagle, without any writing. The respondents were using the picture of a bird of prey and the mark also bore a legend ‘Peerless Quality Vulture Brand Reel Thread’. Initially, they were

using the name of the brand as eagle which at the time of registration they changed to a vulture. The marks of the appellants were known as eagle. Holding that the mark of the respondent was likely to deceive or cause confusion, the High Court *inter alia* observed as under:

“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 mark which is already registered & 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 & what is the main feature or the main idea underlying that trademark, & 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 re-act to a particular trade mark, what association he would form by looking at the trade mark & 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 trade mark. 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?

What the learned Judge should have done was not to keep these two trade marks before him & to find out how they differ & how little they resemble; what he should have done was to decide for himself what was the distinguishing or essential feature of the appellants' trade mark, & then, looking at the trade mark of the respondents, to ask himself whether there was any resemblance in the trade mark of the respondents to that distinguishing or essential feature. It is true, as pointed out by the learned Judge, that the bird appearing in the respondents' trade mark is different in its posture, in its poise, in the position of its head, & in the spreading of its wings from the bird that appears in the trade mark of the appellants. But that is hardly the question. The question is whether the bird in the respondents' trade mark is likely to be mistaken by an average man of ordinary intelligence as an Eagle.

Therefore, if there is a possibility of a mistake, if there is a likelihood of this bird being mistaken or accepted as an Eagle, that possibility itself is sufficient to entitle the Registrar to say that this trade mark is likely to deceive or cause confusion.

11. The use of the trademark GE in relation to goods or services, irrespective of whether the plaintiff deals in those goods and services or not, is likely to be taken as a

connection between the plaintiff-company and the goods or services which are sold under the trademark GE. Use of the trademark GE by the defendant is likely to give an impression to the customer that the product has been manufactured or is being sold in association with the plaintiff-company or its subsidiary/associated company and an unwary customer is likely to purchase the product of the defendant, only on account of the use of the mark GE on it, in the belief that the product in some manner or the other connected with the plaintiff-company. A customer, while purchasing goods of the defendant, is likely to attach considerable importance to use of the mark GE on the product and since the aforesaid mark has come to be identified exclusively with the plaintiff-company, he may also believe that the product was likely to be of superior quality which he expects in respect of the products being sold and services being offered by the plaintiff-company. If the customer later finds that the quality of the goods purchased by him is not as he expected from a GE product, this may considerably damage the goodwill and brand equity which the mark GE enjoys throughout the world, besides adversely affecting the interest of the purchaser who

may be paying a higher price in the belief that he was purchasing a product of high quality but may end up getting a product of inferior quality.

Since the trademark GE is a well-known trademark, use of the aforesaid mark by the defendant on the product sold/proposed to be sold by them constitutes infringement within the meaning of Section 29(4) of Trademarks Act since by using the trademark GE, they are trying to take an unfair advantage by encashing upon brand equity and goodwill which the mark GE enjoys in the market. Since the defendant has not come forward to contest the suit, the presumption is that the use of the mark GE by them is not bona fide, but, is a deliberate attempt intended to encash upon the goodwill and reputation which the trademark of the plaintiff-company enjoys in the market. Such use is bound to be detrimental to the reputation and distinctive character of the trademark GE because if this mark is allowed to be use on the products which have no connection with the plaintiff-company, that may diminish the ability of the trademark GE to identify the source of the goods in respect of which this trademark is used, besides lowering its reputation in case

the quality of the goods is not of expected standard.

13. In their application for registration of the trademark GE in their favour, the defendants claimed user from a past date, but, no evidence has been led by the plaintiff to prove actual user of the aforesaid trademark by the defendants. But, in my view, mere application for registration of the trademark gave sufficient cause of action to the plaintiff-company to file the suit. In **Jawahar Engineers Private Limited**, (1983) PTC 207, a Division Bench of this Court was of the view that when injunction is sought, it is not necessary that the threat could have become the reality before the injunction and it can even be sought for a threat, which is yet to materialize. It was further held that since the plaintiffs had learnt that the defendants had applied for registration of trademark in Delhi, they could claim for injunction to prevent any sale of the infringing products.

In **Mars Incorporated vs. Kumar Krishna Mukerjee & Ors.** 2003 (26) PTC 60 (Del), the defendant sought to incorporate a company named MARS FOODS PVT LTD, though mark was the registered trademark of the plaintiff company. The question which came up for

consideration before this Court was as to whether a person who has not suffered any damage in respect of trade either due to competition or due to deceptive or confusing similarities of the trademark adopted by the defendant has any right to challenge the act of the defendant in seeking to incorporate a company under a name which included the name of the registered trademark of the plaintiff company. The defendant in that case had been incorporated as a company but had not commenced operations by manufacture or sale of goods. Upholding the right of the plaintiff to maintain cause of action on account of apprehension of infringement of its trademark, this Court inter alia observed as under:-

To expect the aggrieved party to wait and watch for the opening of business or manufacturing or sale of goods under the apprehended infringement of trade mark is too much. A stitch in time always saves nine and that is what is the essence of *Quia Timet* Action...

...Let us assume that infringer has no past history of either squatting or hoarding the domain name, trade name and comes out with advertisement for the first time for registering its Corporate name by adopting the similar name or deceptively or confusingly similar name without immediate intention to start its business. Whether or not the plaintiff whose name is

sought to be infringed has a remedy to forestall the defendant from adopting its name or from opening up of the business under the plaintiff's trade name. the answer in any eventuality is in affirmative.

The plaintiff has the same degree of right to protect its trade name from infringement as it has against infringement of registered name or in an action of passing off in respect of manufacturing or selling or offering to sell the goods by the defendants under the plaintiff's trade name. The genesis is the underneath intention which is not difficult to fathom. Why one should choose or pick up the name or mark which has already become famous and well known and whose reputation and goodwill is all pervading and is obviously hard earned. The only intention or object is to thrive upon the goodwill and reputation and confuse the purchasers of his goods into believing that the defendants' goods or business in one way or other is connected with the plaintiff. Obvious object is to cash on exploit the goodwill, reputation, name and trade mark of the plaintiff...

...It is immaterial whether or not there is a real or tangible possibility of starting a business. Such a threat will even loom large over the head of the plaintiff and therefore entitle him to resort to *Quia Timet* Action as the intentions are bad, designs are dubious. There is no other object of such a defendant than to hoard the trade mark and black mail the plaintiff in order to use it in future. Thus, in both the cases, the action and proposed activities are manifestly *mala fide* and calculated to deceive the public or would be purchasers as to the connection of the defendants with the plaintiff.

As the saying goes, the evil should be nipped in the bud so is the nature of *Quia Timet* Action where the injury or damage has been caused.

In **KRBL Limited vs. Ramesh Bansal & Anr.** 2009

(41) PTC 114 (Del), the plaintiff was registered proprietor of the trademark/label “India Gate”, which it was using for selling rice. The defendant applied for registration of the same mark in respect of salt. The right of the plaintiff to maintain a *quia timet* action was upheld by this Court.

I, therefore, hold that even if there has been no use of the trademark GE by the defendants, the plaintiff, on account of the defendants having applied for registration of the aforesaid trademark, is very much entitled to seek injunction against infringement of its trademark by them.

CONCLUSION

For the reasons given in the preceding paragraphs, a decree for injunction with proportionate costs is passed restraining the defendants from using the mark GE or any other mark which is identical or similar to the registered trademarks GENERAL ELECTRIC, GE (monogram) and GE of the plaintiff.

In the facts and circumstances of the case

particular considering the fact that there is no evidence of actual user of the mark GE by the defendants, I do not deem it appropriate to grant any other relief to the plaintiff.

Decree sheet be drawn accordingly.

(V.K. JAIN)
JUDGE

DECEMBER 21, 2011
bg /vn