

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **FAO 95/2005**

Reserved on: 06.01.2011

Date of Decision :18.01.2011

M/s HINDUSTAN SANITARYWARE & INDUSTRIES LTD.

..... Appellant

Through Mr.S.K.Bansal, Mr.Santosh Kumar,
Mr.Ajay Amitabh Suman, Advocates

Versus

M/s CHAMPION CERAMIC

.... Respondent

Through Mr.Gagan Gupta, Advocate

CORAM:

HON'BLE MR. JUSTICE MOOL CHAND GARG

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| 1. | Whether the Reporters of local papers may be allowed to see the judgment? | Yes |
| 2. | To be referred to Reporter or not? | Yes |
| 3. | Whether the judgment should be reported in the Digest? | Yes |

: **MOOL CHAND GARG,J**

1. This appeal arises out of an order dated 07.02.2005 passed by the Id. Additional District Judge in Suit No.107/2003, whereby the learned Judge has dismissed the application filed by the appellant under Order 39 Rule 1 and 2 CPC r/w Section 151 CPC seeking injunction against the respondent for injuncting them from selling their goods under the trade mark "HIMWARE" on the pretext that the appellant company is manufacturing sanitary wares and other allied products which are used in toilet and bathroom fittings since decade. The products of the appellant company were being sold under the trade name/trade mark "H-VITREOUS" since 1960. According to them, they added "HINDWARE" to their existing trademark since 1990 and got it registered.

2. It is also their case that they garnered the lion's share in the sale of sanitary wares and their products command very high reputation and goodwill amongst their consumer. It is also their case that the respondent by using deceptively similar trade mark in the same class of

goods are eating market and profits of the appellant company inasmuch as, despite the said company having come into business much later than the appellant company precisely since 1999 have attempted to eat into the market share of the appellant company by selling the goods under the trade mark "HIMWARE". It is their case that the trade mark adopted by the respondent i.e. "HIMWARE" has both colour and audible resemblance and given the fact that the appellant has a large number of people as their customer going across various sections of the society, uses their product, there is a strong possibility of deception amongst them. Moreover, the appellant company being registered trade mark holder, have a right to restrain the respondent company from using the trademark "HIMWARE" which is deceptively similar to the trademark of appellant and becomes all the more important since there is a potential for damage being caused to their goodwill and reputation which partially higher as both trademarks are used in similar type of goods. It is submitted that the respondents by having started using trademark 'HIMWARE' infringed the registered trademark of the appellant and thus a prayer was made that the respondent company be enjoined by means of injunction from selling their products under the trademark "HIMWARE" with respect to the class of goods in which they were manufacturing and selling their goods under the trademark "H-VITREOUS HINDWARE".

3. The suit/application filed by the appellant was contested by the respondents on the ground that the appellant cannot monopolize the word "HINDWARE" since 'Hind/Hindustan' is the geographical name of our country India and the word 'Ware' is taken out from the word sanitary ware, which is the common trade name, neither coined nor invented by the appellant, therefore, it was pleaded that the appellant cannot be permitted to monopolize the same. It was further stated that the trade name of the respondent's product is only "HIMWARE" whereas the trademark of the appellant is conjunction of two words i.e. HINDWARE along with VITREOUS written in between capital H. Therefore, there is no possibility of any confusion to anyone since the trade name/trademark are distinct from each other both visibly and phonetically and for that matter even Structurally.

4. The learned Additional District Judge while dismissing the application of the appellant observed that while the contentions of the appellant were correct to the extent that there is some phonetic similarity between “HINDWARE” and “HIMWARE” but when the entire trade mark of the appellant is compared with the trade mark of the respondent, the similarity goes. It has been observed:-

“15. The counsel for the plaintiff is correct to the extent that there is some phonetic similarity between Hind Ware and Him Ware but when the entire trade mark of the plaintiff is compared with the trademark name of the defendant the similarity goes. The entire trade name of the plaintiff cannot be isolated to Hind ware rather it has to go hand in hand with H-VITREOUS. According to the submission of the counsel for the plaintiff the trade mark of the plaintiff company was H-VITREOUS since 1960 to 1990 and in the year, 1990 an additional word Hind Ware was added into the trade mark. The reputation and good-will of the plaintiff was already there with the trade name H-VITREOUS which has been written in a very distinctive manner as per the plaintiff itself. In these circumstances, the possibility is that the public/user rely on the initial trade mark of H-VITREOUS and when they will be told by the seller or would be able to derive otherwise that H-VITREOUS and H-VITREOUS Hind Ware is the same then for all practical purposes they will treat the trade mark H-VITREOUS itself. In these circumstances any sanitary ware sold by the name of mere Him Ware does not seem to infringe the trade mark of the plaintiff especially when the style of writing Him Ware and Hind Ware is different and above all Hind Ware in itself is nothing unless it is read with H-VITREOUS. From the ocular comparison of the trade mark/ trade name it is apparent that the two marks are distinct inasmuch as Him Ware is encircled in Oval shaped lines circumscribing it and there is nothing which may come near to H-VITREOUS Hind Ware. The word ware in the Him Ware and Hind Ware has been taken from the words sanitary ware and neither the plaintiff nor the defendant can be permitted monopolies this. In any case the other players in the field are also using the word ware in conjunction with different words to sell their goods, which incidentally are in the same class, such as Parryware. The ratio of the judgments in the proceedings paras supports this conclusion.”

5. After making the aforesaid observations, the Additional District Judge further held that the two trade names are not similar nor there is any possibility of any deception to the consumers of this class of goods and as such, the appellant is unable to make out the prima facie case and in these circumstances declined the prayer made by the appellant

in their application under Order 39 Rule 1 and 2 and dismissed the said application.

6. It is against the aforesaid order, the appellant has come in appeal. It is the case of the appellant that the order passed by the Additional District Judge is not sustainable inasmuch as the learned Additional District Judge has erred in not appreciating the relative scope, ambit and differences between an infringement action based on a registered trademark and passing off action and thus, erred in law. It has been submitted that the impugned trade mark "HIMWARE" used by the respondent is deceptively similar to the trademark "HINDWARE". The user of the said trademark by the respondent amounts to an infringement of the appellant's registered trademark under trademark registration No.529823 B in Clause 11 which warrants issuance of the injunction.

7. It has been pleaded on behalf of the appellant that the trademark "HIMWARE" is an essential and distinguishing feature of the appellant's registered trade mark and identical and deceptively similar trade mark "HIMWARE" adopted and used by the respondent amounts to an infringement warranting issuance of injunction.

8. Reliance has been placed on the judgment of the Apex Court in the case of *M/s K.R. Chinna Krishna Chettiar Vs. Sri Ambalal & Co.*, AIR 1970 SC 146 and *M/s Ruston & Hornsby Ltd. Vs. The Zamindara Engineering Company*, 1970 (2) SCR 222.

9. It has also been submitted that the learned Additional District Judge did a grave error in not appreciating that the trade mark has to be taken in its entirety and as a whole and has failed to appreciate the various decisions of the Apex Court including those reported in *M/s Amritdhara Pharmacy Vs. Satyadeo Gupta*, 1963 (2) SCR 484; *M/s Parle Products (P) Ltd. Vs. J.P. & Company, Mysore*, AIR 1972 SCC 1359; *M/s Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.*, AIR 2001 SC 1952; and, *M/s Hitachi Ltd. Vs. Ajay Kr. Agarwal & Ors.*, 1996 PTC (16) (DB).

10. The appellant has also filed written submissions. According to the appellant,

- (i) The gist of action of infringement is that the plaintiff has to show that the defendant has copied the essential features of the registered Trade Mark.
- (ii) What is important to find out is the essential and distinguishing feature of the Trade Mark already registered. If it is found that the Trade Mark of the defendant contains the same idea of the plaintiff's registered Trade Mark, then it constitutes the infringement.
- (iii) While comparing the rival Trade Marks which mandate that while comparing marks, the two Trade Marks are not to be seen in juxtaposition.
- (iv) The confusion and deception of the Trade Marks in question has to be decided on the broad similarities and not on the dissimilarities.
- (v) The ocular comparison is not the only test. Trade Marks in question can be held to be deceptively similar even on the basis of phonetic similarity only.
- (vi) While comparing two Trade Marks, it is not permissible to split the Trade Marks. The marks have to be compared as a whole.

11. On the basis of the aforesaid points raised for the purpose of analyzing comparison between the two trade marks for coming to a conclusion as to whether the trade mark, subject matter of the dispute was infringing the registered trade mark of the appellant or nor, it has further been submitted by the appellant that The essential feature of the appellant's registered Trade mark is 'HINDWARE'. While the trademark of the respondent 'HIMWARE'. It is submitted that essential features of both the trademarks in question are not only phonetically similar but also similar ocular comparison. Goods involved in question are also same.

12. It has been submitted that the learned Trial Court ought to have considered that the trade marks can be similar even on the basis of phonetic similarity which fact has been acknowledged by the appellant.

It was submitted that the Trial Judge was wrong in splitting the trade mark while making the comparison of both the trademarks as a trademark has to be compared as a whole. Various citations have been relied upon to support the aforesaid plea by giving the following comparison in a case where the trademark of the another party has been found to be infringing the trademark of the one party as referred to in the chart given below:-

One Party	Another Party	Judgment
Navaratna & Navratna Pharmaceutical Laboratories	Navratna Kalpa & Navratna Kalpa Pharmacy	Kaviraj Pandit Durga Dutt Sharma Vs. Navratna Pharmaceutical Laboratories AIR 1965 SC 980
Eagle & Device of Eagle	Vulture Brand	M/s. James Chadwick & Brothers Ltd. V/s The National Sewing Thread Co. Ltd. AIR 1951 Bombay 147
Wrapper Containing Farm Yard, A girl, Water and Cow	Wrapper Containing a girl, cows and hens	Parle Products Vs. J.P.Co. Mysore AIR 1972 Supreme Court 1359
Falcitab	Falcogo	Cadila Health Care Ltd. Vs. Cadila Pharma AIR 2001 SC 1952
Ambal Label	Andal Labl	K.R. Krishna Chettiar Vs. Sri Ambal Co. & Anr. AIR 1970 SC 146
Gold leaf	Sona	Takkar (India) Tea Company V/s Soongachi Tea Industries Pvt. Ltd. 2010 (44) PTC 90 (Del.)
Rustam India	Ruston	Ruston & Hornsby Ltd. Vs. Zamindara Eng. Co. PTC (Suppl.) (1) 175 SC
Moonstar	Superstar	Izuk Chemicals Ltd. Vs. Babu Ram Dharam Prakash 2007 (35) PTC 28 (Del.)

13. On the other hand, learned counsel appearing for the respondent while supporting the judgment delivered by the Additional District

Judge has been pleased to observe that if one goes by Section 17 of the Trade Mark Act and read the said provisions along with Section 29 of the Act, it becomes apparently clear that the contentions of the appellant are not sustainable in law because as per Section 17, for the purpose of infringement, the entire trade mark of the appellant in toto has to be considered for the purpose of considering if there is a violation thereof or not. It is further submitted that the trademark of the appellant if read in whole, makes it clear that the user of the trade mark "HIMWARE" by the respondents in no way infringes the trade mark of the appellant and, therefore, it is submitted that the order passed by the Additional District Judge is perfectly legal and valid. The respondents have also relied upon various judgments to support their contention. Reference has been made to *Kewal Krishan Kumar Vs. Rudi Roller Flour Mills (P) Ltd. & Anr.*, 2003 (26) PTC 175 (Delhi); *S.B.L.Limited Vs. Himalaya Drug Co.*, AIR 1998 Delhi 126; and *Amar Singh Chawalwala Vs. Shree Warddhman Rice & General Mills*, 1996(36) DRJ 11. Insofar as the last judgment is concerned, it is the case of the appellant that the said judgment stand negatives by the Division Bench of this Court vide judgment dated 27.09.2007 passed in OCJA No. 1/2003

14. I have heard the learned counsel for both the parties and have also perused the record of the case as well as gone through the judgments cited at bar. I have also gone through the written submissions filed by the parties. All the judgments cited by the appellant as well as by the respondent have been referred to in a recent judgment delivered by the Division Bench of this Court in the case of *Gufic Ltd. and Anr Vs Clinique Laboratories, LLC and Anr*, MIPR 2010 (2) 411, wherein this court after referring the couple of above mentioned judgments had culled out the following principles:-

1. The test of deceptive similarity in the case of infringement is the same as in a passing off action, where the marks are not identical;
2. The question has to be approached from the point of view of a man with average intelligence and imperfect recollection;
3. In comparing the marks, it is the overall structural and phonetic similarity of the two marks that is to be seen and not by splitting them into their component

parts and to consider the etymological meaning thereof;

4. The trademark is the whole thing - the whole word has to be considered; and

5. In comparing the two marks, it is also to be seen whether they both convey the same idea - (test of commonness of the idea between the two marks).

15. In the same judgment the Division Bench has further observed that:

23. It is in this backdrop that we have to compare the marks of the appellants and those of the respondents. The respondents' registered trademark is 'CLINIQUE'. It also has other registered trademarks which all include the word 'CLINIQUE'. 'CLINIQUE' is a French word for the English word 'Clinic'. Both are pronounced differently. 'CLINIC' is pronounced as 'KLINIK' and 'CLINIQUE' is pronounced as "KLINECK". "CLINIQUE" is the most important constituent of the respondents' family of trademarks. The question is, whether the mark of the appellants - "SKINCLINIQ" is deceptively similar to 'CLINIQUE' or not? It is apparent, as already pointed out above, that "CLINIQUE" and "SKINCLINIQ" are not identical marks. The question, therefore, is to find out as to whether they are deceptively similar or not and this question has to be approached from the point of view of a man with an average intelligence and an imperfect recollection. In comparing 'CLINIQUE' with 'SKINCLINIQ', what has to be borne in mind is the overall structural and phonetic similarity of the two marks and the marks cannot be separated into their components. Consequently, we have to take the mark 'SKINCLINIQ' as a whole in comparison with the respondents' registered mark 'CLINIQUE'. When we do that, we do not find any overall structural or phonetic similarity. We cannot separate the mark 'SKINCLINIQ' into its component parts 'SKIN' and 'CLINIQ' and then compare the component 'CLINIQ' with the respondents mark 'CLINIQUE'. If such a splitting up cannot be done, then we do not see any phonetic, visual or overall structural similarity in the two marks, 'CLINIQUE' and 'SKINCLINIQ', so as to reach to the conclusion that 'SKINCLINIQ' is deceptively similar to 'CLINIQUE'. The word 'Clinic' by itself means a place where some kind of treatment is provided. So, perhaps, it could be said that the word 'CLINIQUE' conveys the idea of some kind of treatment. To a certain extent, it may be said that the mark 'CLINIQUE' and the mark 'SKINCLINIQ' do convey a common idea of treatment. However, as pointed out above, while comparing the marks, we have to examine not only the commonness of the idea between the two marks, but also the overall visual, structural and phonetic similarity of the marks. Taking an overall view of the marks, we feel that a person of average

intelligence and imperfect recollection would not be deceived by the mark 'SKINCLINIQ' into believing that it is, in fact, the mark 'CLINIQUE'. We feel that the learned single judge fell into error in splitting the appellants' mark "SKINCLINIQ" into 'SKIN' and 'CLINIQ' and in then comparing the latter component (CLINIQ) with the respondents' mark 'CLINIQUE'. Had the appellants' mark been only 'CLINIQ' then, perhaps, it could be said that it is deceptively similar to the respondents' mark 'CLINIQUE'. However, the appellants' mark is not just 'CLINIQ' but 'SKINCLINIQ', which is one word and not two separate words as in Rustam's case and Cleanzo's case.

24. Another important circumstance is that the price differential between the two products is so vast that no consumer of products of either the appellant or the respondent would confuse one for the other. We, therefore, do not agree with the conclusion arrived at by the learned single Judge that, prima facie, a case of infringement has been made out.

16. In the instant case though it is correct to the extent that there is some phonetic similarity between Hind ware and Him ware but when the entire trade mark of the appellant is compared with the trademark of the respondent the similarity goes. The entire trade name of the appellant cannot be isolated to Hind ware rather it has to go hand in hand with H-VITREOUS. More so, even from the ocular comparison of the trade mark/trade name it is apparent that the two marks are distinct in as much as Him Ware is encircled in Oval shaped lines circumscribing it and there is nothing which may come near to H-VITREOUS Hind ware. Moreover, the word ware in Hind ware and Him ware is concerned, it has been taken from the words sanitary ware and neither the appellant nor the respondent can be permitted to monopolies this. Thus in the light of the above as well as when the trademarks are put to the test of being considered from point of view of a man with average intelligence and imperfect re-collection, it does not get proved that the trademark of the respondent is deceptively similar to the trademark of the appellant. In view of the aforesaid, submissions made by the appellant are of no help to the case of the appellant.

17. Therefore having said so, I do not find any infirmity in the order passed by the Learned Additional District judge. In view of the aforesaid, I find no infirmity in the order passed by the learned

Additional District Judge in having dismissed the application filed by the appellant under Order XXXIX Rule 1 and 2 CPC. Consequently, the appeal is dismissed with no orders as to costs. It is however made clear that nothing stated herein would cause any prejudice or any aspersion on the merits of the case. The Additional District Judge is however directed to dispose of the suit itself within one year from the date of the appearance of the parties, who shall appear before the Additional District Judge on the date already fixed before the Additional District Judge.

18. A copy of this order be sent to the trial Court along with record.

C.M.5391/2005(stay)

Interim orders stand vacated.

Application is disposed of.

MOOL CHAND GARG, J

JANUARY 18, 2011

'anb'