



A.S.(MD).No.149 of 2013

BEFORE THE MADURAI BENCH OF MADRAS HIGH COURT

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JUDGMENT RESERVED ON : 23.06.2023

JUDGMENT PRONOUNCED ON: 22.09.2023

CORAM

THE HONOURABLE MRS.JUSTICE N.MALA

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and

CMP.(MD).No.2514 of 2023

Sri Rajeswari Fireworks,
Rep. By its Partners G.Kathiresan (Died)
1.P.Tharun Viswanath
2.K.Prithiviraj
3.P.Sumathi
[Memo dated 09.08.2022 filed
on 10.08.2022 in U.S.R.No.
22121 is recorded as the
partner G.Kathiresan died and
the other partners of Sri
Rajeswari Fireworks are
substituted vide Court order
dated 16.02.2023 made in
AS(MD).No.149 of 2013 by
NMJ]

... Appellants

Vs.

1.M/s.Sri Kaliswari Fireworks,
Rep. By its Partner A.P.Selvarajan,
No.5-A, Chairman A.shanmuga Nadar Road,
Sivakasi,



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Virudhunagar District.

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2.M/s.Dinesh Fire Works,
E-34, Milap Nagar,
Utham Nagar,
New Delhi - 110 059.

3.Sri Amir Chand,
M/s.A.C.Fire Works,
561, Jheel Kuranja,
Patpar Road,
Delhi - 110051.

4.Jai Mata Traders,
Sir Subash Kataria,
M/s.Kataria Fire Works,
A2A/114, Janakpuri,
New Delhi - 110 058.

5.Sahu Gun House,
Mahavir Chowk,
Ranchi,
Jharkand State.

6.Surya Sales,
Mahavir Chowk,
Ranchi
Jharkand State

... Respondents

First Appeal filed under Section 96 read with Order XLI Rule I of CPC, to set aside the Judgment and Decree dated 19.08.2013 passed by the Principal District Court of Virudhunagar at Srivilliputhur made in Trade Mark O.S.No.35 of 2010.



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For Appellants	: Mr.P.Valliappan Sr.Advocate for Mr.P.Thiagarajan
For R1	: Mr.Michael Bharathi
For R2 to R5	: No appearance
For R6	: No appearance

J U D G M E N T

The 1st defendant in the suit has filed the above appeal. The appeal is filed challenging the Judgment and Decree dated 19.08.2013 passed in O.S.No. 35 of 2010 on the file of the Principal District Court of Virudhunagar at Srivilliputhur.

2. The parties will be referred to as per their ranking in the suit.

3. The brief facts of the case leading to the above appeal are as follows:

The plaintiff is a registered partnership firm having its principal place of business at Sivakasi, Virudhunagar District, Tamil Nadu. The plaintiff is a manufacturer of fireworks, crackers, sparklers and other allied products in India since 1923. The products of the plaintiff are represented by a unique trademark COCK with a device of multi colour rooster inside the two circles in the background of yellow shade which



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was devised by the founders of the plaintiff's firm in 1923 and registered in Class 13 of the Register of Trade marks on 17.08.1954 under Registration No.165412. The Trade mark of the plaintiff was renewed from time to time. The plaintiff earned a reputation for itself among the users of the fire works. The plaintiff spent huge amount to popularise its COCK brand products across the country by incurring considerable expenditure for the same. The plaintiff had issued Trade mark Caution Notice in all leading newspapers on 09.03.2010 to protect its Trade mark COCK. According to the plaintiff, it registered its distinctive artistic work of the trade mark COCK under the Copyright Act also in Copyright Registration No.A-95119/2009 with its name "KALISWARI".

4. It was the plaintiff's further case that the defendants conspired together to spoil the name of the plaintiff's fireworks products and in order to gain unlawfully indulged in manufacturing and marketing inferior quality fireworks under a deceptively similar 'DUCK' as shown in the "B" Schedule in the market areas of the plaintiff. The plaintiff stated that the first defendant had devised its trade mark with the pictogram of DUCK which is very similar to the pictogram of COCK of



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the plaintiff. The plaintiff stated that the first defendant purposely and maliciously in order to pass off its products as that of the plaintiff, devised the colour scheme, get up, artistic work, placement and layout of its DUCK as that of the plaintiff's COCK trade mark. According to the plaintiff, phonetically also the word 'DUCK' is similar to the word 'COCK' and the two circles around the rooster and yellow colour background of the plaintiff's pictogram were imitated by the 1st defendant to make its mark appear deceptively similar to that of the plaintiff. The plaintiff came to know about the use of trade mark 'DUCK' of the 1st defendant, which is deceptively similar to that of the plaintiff during Diwali i.e. in the month of October, 2009. The plaintiff orally advised the first defendant and though the 1st defendant agreed to desist from infringing and passing off the offending trade mark 'DUCK', nevertheless continued to market its products with the offending trade mark with the aid of the other defendants. The plaintiff issued a legal notice to the first defendant, but the first defendant failed to reply to the same or stop the usage of the offending trade mark. The plaintiff was therefore constrained to file the suit for infringement and passing off under the Trade marks Act and for infringement of Copy Right under



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the Copy Rights Act for the following reliefs.

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a. Permanent injunction restraining the Appellant from in any manner infringing its trademark COCK with the very same colour scheme and the appearance;

b. Appellant Permanent from in injunction any manner restraining infringing its registered copyright in the artistic work of pictogram of COCK with the very same colour scheme and appearance;

c. Permanent injunction restraining the Appellant from in any manner passing off and enabling others to pass off their fireworks crackers with a similar colour scheme;

d. Mandatory injunction directing the Appellant to deliver up for destruction all fireworks, crackers, sparklers and other allied products &

e. Rendition of accounts.

THE 1st DEFENDANT's CASE:

5. The first defendant's fire works was established in the year 1980 in Maraneri Village, Sivakasi Taluk. The first defendant adopted the 'DUCK' brand for manufacturing the fire works. The first defendant registered the Trade mark 'DUCK' on 28.02.1983 vide Registration No.



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357776 in Class 13 relating to fireworks, crackers and sparklers. The registered trade mark was renewed on 23.01.1987 for a period of seven years and subsequently on 23.01.1994 and thereafter till 2008. In the year 2008 due to inadvertence, the registered trade mark 'DUCK' was not renewed and on the advise of the Trade mark Registry, the first defendant made a fresh application for registration of his trade mark 'DUCK' in the year 2009 vide Application No.1866419 in Class 13. According to the 1st defendant it was using the Trade mark 'DUCK' continuously from 1980 without any objection from any one. The first defendant had also applied for copy right protection, for which the Trade Marks Registry gave its clearance in Form TM60. Therefore, according to the first defendant as per the standards of the Trade Marks Registry, there was no similarity between the mark of the plaintiff and the first defendant.

6. It was the defendants further case that it had a good market for it's fireworks and it had created a distinct identity in the market. The 1st defendant was able to sell it's products due to the superior quality of the fireworks manufactured by it and the good will that it had developed



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7. The written statement of the defendants further referred to various features of the plaintiff's 'COCK' mark and the defendants' 'DUCK' mark to show that there was absolutely no imitation or similarity of the plaintiff's Trade mark and the defendants Trade mark. As far as the colour scheme, design and lay out of the defendants' Trade mark was concerned, it was the defendants contention that the yellow colour back ground was common to the trade and the plaintiff could not claim exclusive right over the same.

8. The defendant further stated that various registered trade mark owners had adopted the yellow colour background with either a bird or an animal inside a circle and the plaintiff had not chosen to initiate action against all those manufacturers. As the plaintiff was envious of the defendants growth, the plaintiff chose to file the suit against the defendant alone.

9. The defendant raising the plea of acquiescence stated that in view of the Section 33 of the Trade Marks Act, the plaintiff had lost its right, if any, to oppose the use of the 'DUCK' Trade mark by the



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defendant. The defendant further stated that the plaintiff had no right to oppose the application of the first defendant for the registration of the 'DUCK' Trade mark, as the plaintiff had acquiesced for a period of 27 years to the use of the 'DUCK' Trade mark by the defendant. According to the defendant, the Trade Mark 'DUCK' had been in continuous, extensive and uninterrupted use for nearly 30 years and it had acquired immense goodwill and reputation. The defendant claimed to have invested huge amounts on advertisements for popularizing its trade mark 'DUCK'. The defendant stated that there was absolutely no similarity between the 'DUCK' mark and the 'COCK' mark. It was further stated that the plaintiff was estopped from questioning the defendant's trade mark as it had not opposed the registration of the same in 1980. The defendant further stated that there was no cause of action for the suit. On the above facts, the defendant prayed for dismissal of the suit.

10. The plaintiff filed rejoinder denying all the allegations raised in the written statement apart from stating that, when the plaintiff's firm was registered, all the properties of the erstwhile firm were transferred



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by operation of law and hence no special instrument of transfer was necessary. According to the plaintiff as the 'DUCK' trade mark was registered in the names of the partners belonging to the partnership firm of 'KALISWARI Fireworks in the category of partnership firm the plaintiff was the registered proprietor and so assignment or transfer of trade mark was necessary. The plaintiff referred to the special features of the 'DUCK' brand used by the defendant and stated that it was designed to appear deceptively similar to plaintiff's 'COCK' trademark. The plaintiff further pointed out that the 'DUCK' Trade mark presently used by the defendant was entirely different from the one advertised in the Trade Marks Journal of the year 1980. The plaintiff further stated that the colour combinations adopted by the defendant were made with a view to make it look more like the plaintiff's 'COCK' mark, thereby causing confusion and deception in the minds of the trading public and for passing off their sub-standard goods as and that of the plaintiff. The plaintiff further submitted that the plea of acquiescence under Section 33 of the Trade Marks Act was not available to the defendants as the adoption of the 'DUCK' brand by the defendants was fraudulent and malicious. The plaintiff had no objection to the use of the Trade mark



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'DUCK' originally registered by the defendant in the year 1980, as the same did not infringe the 'COCK' mark of the plaintiff. The plaintiff was aggrieved by the recent changes made by the first defendant to the originally registered 'DUCK' mark to make it look deceptively similar to its 'COCK' mark. The plaintiff therefore prayed that the suit may be decreed as prayed for.

11. Before the Trial Court, the plaintiff was examined as PW1 and Ex.A1 to Ex.A70 were marked. On the side of the defendants, two witnesses were examined and Ex.B1 to Ex.B172 were marked.

12. On the basis of the pleadings of the parties and the evidence on record, the Trial Court framed the following issues.

1. Whether the 1st defendant's trade mark 'Duck brand' as shown in the 'B' schedule of plaint is deceptively similar to that of 'A' schedule 'Cock Brand' of the plaintiff's firm as shown in the plaint?

10. 2. Whether there is any infringement of registered trade mark and copy of right of plaintiff's firm as alleged by the plaintiff?

3. Whether "DUCK" pictogram as registered by 1st defendant in the year



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1980 has undergone distinctive changes in the year 2009 so as to look deceptively similar to that of “Cock Brand” of plaintiff?

4. Whether the plaintiff is entitled to the relief of permanent injunction restraining the defendant from in any manner infringing the plaintiff's registered trade a pictogram of cock by deceptive and imitative use of a pictogram of “Duck ” with the very same colour scheme as prayed for?

5. Whether the plaintiff is entitled to the relief of permanent injunction restraining the defendant firm in any manner infringing the plaintiff's registered copy right in the artistic work of a pictogram of “Cock” by deceptive and imitative use of a pictogram of “Duck” with the substantial reproduction of the plaintiff's artistic work with the very same colour scheme as prayed for?

6. Whether the plaintiff is entitled for permanent injunction as against the defendants restraining them from in any manner passing off their fire works, crackers and allied products by the use of imitative pictogram of “Duck” brand which is identical to and deceptively similar to plaintiff's registered pictogram of cock brand?

7. Whether the plaintiff is entitled to the relief of mandatory



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injunction directing the defendants to deliver up for destruction all the fire works, crackers and other allied products carrying on the offending “Duck” labels which are identical to the trade mark and artistic work of plaintiff’s “Cock” brand?

8. Whether the plaintiff is entitled for the rendition of accounts directing the defendants to render true and faithful accounts of profits earned by the sale of “Duck” branded products using the imitative trade mark of plaintiff’s “Cock” brand?

9. Whether the plaintiff has got exclusive right over yellow colour background which is used by many of the fire works manufacturers in Sivakasi in view of the nature of the product?

10. Whether the defendant has acquired a good market for his product due to infringement of plaintiff’s trade mark or by it's distinct quality as stated by the defendant?

11. Whether the suit is filed in time?

12. To what other relief, if any, is the plaintiff entitled to?

13. The Trial Court partly decreed the suit by granting the relief's 'A' to 'C' and rejecting the relief's 'D' and 'E'. Aggrieved by the



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Judgment and Decree of the Trial Court, the 1st defendant in the suit has filed the above appeal.

14. The learned counsel for the first defendant/appellant put forth the following objections to the Judgment and the Decree of the Trial Court.

1.The Trial Court failed to note that there was absolutely no cause of action for the suit and that even the cause of action pleaded by the plaintiff was not established.

2.The Trial Court failed to note that the suit for infringement of the Trade mark at the instance of the plaintiff was not maintainable as the plaintiff was not a registered proprietor of the 'COCK' Trade mark.

3.The Trial Court failed to note that the failure of the plaintiff to register the 'COCK' Trade mark to particular combination of colours did not entitle it to claim monopoly over the colour combinations.

4.That the suit was barred by acquiescence under Section 33 of the Trade Marks Act.

5.That the Trial Court failed to note that there was no infringement of Trade mark, copy right and passing off.



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6. That the Trial Court erred in decreeing the suit for permanent injunction restraining the appellant from in any manner infringing the Trade mark COCK with the very same colour scheme and appearance, for Permanent injunction restraining the appellant from in any manner infringing its registered copy right in the artistic work of pictogram of COCK with the very same colour scheme and appearance and also restraining the appellant from in any manner passing off and enabling others to pass off their fireworks crackers with a similar colour scheme. The learned counsel therefore stated that the appeal be allowed and the Judgment and the Decree of the Trial Court be set aside.

15. The learned counsel for the plaintiff on the other hand submitted that the suit was filed for infringement of its Trade mark under Section 29(2) of the Trade Marks Act by the 1st defendant by adopting identical and deceptively similar 'DUCK' mark for its goods. The learned counsel for the plaintiff/respondent further submitted that the objection as to the plaintiff not being the registered proprietor was untenable as the plaintiff's trade mark was registered in the name of the firm and therefore the firm as a registered proprietor could file the suit.



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As far as the monopoly over the colour combinations in the label of the plaintiff's COCK brand was concerned, the learned counsel submitted that the label was registered under Section 10(2) of the Trade Marks Act, and so even if the Label was registered for Black and White it is deemed to have been registered for all colours.

16.The learned counsel submitted that the first defendant/appellant could not invoke Section 33 of the Trade Marks Act against the plaintiff as the 1st defendant was not a registered proprietor of the Trade Mark DUCK and also because the defendant had failed to prove that he adopted the colours in the mark bona fide.

17. The learned counsel for the plaintiff/respondent further submitted that as the Trial Court on the basis of the entire evidence on record gave a factual finding that the defendants 'DUCK' mark was deceptively similar to that of the plaintiff's registered 'COCK' trade mark and that there was infringement of the plaintiff's copy right in the pictogram 'COCK', the said finding could not be interfered with in appeal unless and until it was proved to be perverse. The learned



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counsel further submitted that as the finding of the trial Court was that the defendant adopted the identical trade mark of the plaintiff with a view to deceive and confuse the customers, it was totally justified in concluding that the defendant was guilty of Passing off his goods as that of the plaintiff. The learned counsel therefore submitted that there were absolutely no merits in the appeal and the same deserved to be dismissed.

18. I have heard both the learned counsels and have perused the materials on record.

19. The points that arise for consideration in the appeal are as follows:

1. Whether the suit is bad for want of cause of action?
2. Whether the plaintiff is a registered proprietor in terms of Section 2(V) of the Trade marks Act?
3. Whether the 1st defendant has infringed the plaintiff's registered trade mark and copy right of the plaintiff in the artistic work of pictogram 'COCK'?



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4. Whether the 1st defendant by adopting a deceptively similar mark to that of the plaintiff's trade mark is passing off his goods as that of the plaintiff.

5. Whether the defendant is entitled to invoke the provisions of Section 33 of the Trade Marks Act relating to acquiescence.

POINT NO.1:

20. The learned counsel for the first defendant submitted that there was no cause of action for the suit and the suit was liable to be dismissed on the short ground. According to the first defendant, the plaintiff had taken inconsistent stand as regards the accrual of cause of action. Whereas in the legal notice, the plaintiff stated that it came to know about the DUCK mark only in the month of October, 2009, in the legal notice, it was stated that the plaintiff came to know about the DUCK mark recently.

21. The learned counsel for the plaintiff on the other hand submitted that the suit was laid among others for infringement of Trade Mark under Section 29(2) of the Trade Marks Act, that both the plaintiff



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and the first defendant were in the same trade and that the defendant had designed his DUCK mark so as to appear deceptively similar to that of the plaintiff's COCK mark and with a view to pass off his products as that of the plaintiff. The learned counsel therefore submitted that the contentions of the learned counsel for the 1st defendant were untenable.

22. The term cause of action is not defined in the civil procedure code but the same has been interpreted by the Courts in several cases. One such interpretation of the term cause of action is that it is a bundle of facts which forms the basis for the reliefs claimed in the suit.

23. The first defendant claims that the basis for the suit are two letters i.e. Ex.A7 and Ex.A8. According to the 1st defendant the said letters were obtained subsequent to the legal notice and for the purpose of the case. According to the 1st defendant the fact that the dealers continued to purchase the products of the first defendant subsequent to the said letters also supports the said contention. On the other hand the plaintiff states that the suit is filed not only on the basis of the aforesaid letters, but also under Section 29(2) of the Trade Marks Act for



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infringement of Trade Mark.

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24. It is seen that the suit is laid for permanent injunction for infringement of the Trade mark of the plaintiff, for passing off and for infringement of Copy Right in the artistic pictogram of the “COCK” mark of the plaintiff. It is well settled that to find out if the cause of action for the suit is made out or not only the contents of the plaint have to be looked into as a whole and the defence put forth by the defendant is not material. It is trite that the cause of action for a suit is an act or a transaction. The act or transaction may give rise to two or more causes of actions. But the plaintiff is bound to claim the entire relief in the suit which arises out of the cause of action. In the present case, the dispute is whether the first defendant has infringed the plaintiff's trade mark, copy right and also if the defendant is guilty of passing off his goods as that of the plaintiff. The plaintiff's case is that the defendant has deceptively imitated the plaintiff's registered trade mark and is passing off his goods as that of the plaintiff. The plaintiff also claims that the artistic work of the pictogram COCK of the plaintiff with it's colour, lay out and scheme is copied by the defendants, so as to appear deceptively



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similar to that of the plaintiff. The letters form a part of the cause of action and not the sole basis for the relief's claimed in the suit. On a reading of the entire plaint it cannot be said that there is no cause of action at all for the suit. Therefore, I am of the view that the objection that the suit is not maintainable for want of cause of action cannot be sustained and the same is rejected. Point No.1 is decided against the 1st defendant.

POINT NO.2:

25. The second objection of the first defendant is that the plaintiff is not a registered proprietor in terms of Section 2(V) of the Trade Marks Act and as such the plaintiff has no right to file the suit for infringement. According to the first defendant, it was admitted by the plaintiff that in the year 1938 when the business was started there were three members as partners i.e. A.Shanmugam Nadar, A.Arunachala Nadar and A.Nataraja Nadar. In 1954, the COCK Mark was registered. In 1971, the partnership firm was reconstituted with the partners consisting of A.A.Rajappan, Chinna Nadar, Purnachandran, Palaniswamy etc., and the same was registered. According to the first defendant in the absence



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of any evidence to show that the said mark registered in the name of the individual partners was transferred in the name of the registered partnership firm on 1971, the plaintiff could not be considered to be a registered proprietor in terms of Section 2(V) of the Trade Marks Act. In contra, the plaintiff's case is that there was no need for an assignment of the Trade Mark from the partners of the firm, as the Trade mark was registered in the name of the partnership firm and therefore, the firm was entitled to file the suit. According to the plaintiff the question of assignment will arise only if the Trade mark was transferred from one entity to other. In the instant case, the Trade mark was registered in the name of the firm and as it remained the property of the firm, there was no question of assignment of trade mark.

26. Section 2(V) of the Trade Marks Act defines registered proprietor.

2(V)“registered proprietor”, in relation to a trade mark, means the person for the time being entered in the register as proprietor of the trade mark”



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27. From the said definition it is clear that the registered proprietor means the person whose name is entered in the register as a proprietor of the Trade mark. A perusal of Ex.A13 would show that the Trade mark was originally registered on 17.08.1954 in Registration No.165412 under Clause 13 in the name of A.Shanmugam Nadar, A.Nataraja Nadar, A.M.A.Arunachala Nadar in the category of partnership firm. When a trade mark is registered by a firm, it is always registered in the name of the firm, whether the firm was registered or unregistered and hence the trade mark belongs to the firm and not to any individual partner. In the instance case, the original partnership firm was unregistered but the trade mark was registered in the category of partnership firm. The question of assignment would arise only if the trade mark was transferred from one entity to other. In the instant case as the trade mark was registered in the category of partnership firm, though unregistered, there is no question of any assignment because the trade mark belonged to the firm and not to any individual partner. It is further pertinent to note that even otherwise the COCK trade mark has been used by the plaintiff firm since 1954 without any objection from any partner. Therefore the contention of the first defendant that the



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plaintiff is not a registered proprietor of the trade mark COCK brand is untenable and the same is rejected. Point No.2 is decided against the 1st defendant.

POINT Nos'.3 and 4:

28. The undisputed facts of the case are that the plaintiff and defendant are both manufacturers of fireworks like sparklers, crackers etc. and are based in Sivakasi, that the plaintiff entered the trade much before the defendant and registered his trade mark 'COCK' in black and white on 17.08.1954 in Reg.no. 165412 under Ex.A13, that the defendant entered the trade in 1981 and registered his trade mark 'DUCK' in black and white on 28.02.1983 vide Reg.No. 357776, that both the plaintiff and the defendant registered their trade mark in Class 13 of the Register of Trade Marks, that the defendant periodically renewed his trademark till 2008 and thereafter failed to renew the same, that the defendant applied for Registration of the trade mark 'DUCK' afresh in 2009 vide Application no.1866419 in Class 13, that the plaintiff obtained the copyright for its artistic work of the 'COCK' mark under the Copy Rights Act in Regn.No.A-95119/2009 and that the defendant applied for



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copyright protection for its artistic work of 'DUCK' mark and the trade marks registry gave clearance in Form 60.

29. The entire controversy in the appeal is whether the defendant has infringed the plaintiff's Registered trade mark 'COCK'.

30. Before delving into the factual examination of the marks to find out if there is any infringement of the plaintiff's registered mark by the defendant, the legal position with respect to the provisions of the Act and also the legal principles enunciated by catena of Judgments is scrutinized. I have refrained from discussing all the Judgments relied on by the counsels as ultimately the finding of fact on similarity of the marks is left to the Court and the citations can only guide the Court in undertaking the said exercise.

31. Section 29(1) of the Trade Marks Act, 1999 deals with the infringement of Trade marks and the various acts constituting infringement.



Section 29

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(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark."

32. The term deceptively similar used in Section 29(1) is defined under 2(h) of the Act. Section 2(h) defines "deceptively similar" as follows:



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(h) *“deceptively similar”*. – A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion.

33. In 1960 (1) SCR 968 : AIR 1960 SC 142 in the case of *Corn Products Refining Co.Ltd. vs. Shangrila Food Products Ltd.* It was held as follows:

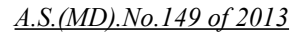
“18. It is well known that the question whether the two marks are likely to give rise to confusion or not is a question of first impression. It is for the court to decide that question. English cases proceeding on the English way of pronouncing an English word by Englishmen, which it may be stated is not always the same, may not be of much assistance in our country in deciding questions of phonetic similarity. It cannot be overlooked that the word is an English word which to the mass of the Indian people is a foreign word. It is well recognised that in deciding a question of similarity between two marks, the marks have to be considered as a whole.....”

34. The Hon'ble Supreme Court in the case of *Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories* reported in AIR 1965 SC 980 held as follows:



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“Para 28. When once the use by the defendant of mark, which is claimed to infringe the plaintiff's mark is shown to be “in the course of trade” the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trademark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered. A point has sometimes been raised as to whether the words “likely to deceive” or “likely to cause confusion” introduce any element which is not already covered by the words “likely to deceive” and it has sometimes been answered by saying that is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words “likely to deceive”. But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trademark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks – the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject consideration. The



“Para 5... The issue is, “is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe they are the plaintiffs goods. The Apex Court has also pointed out that in an infringement action the issue is, “is the defendant using a mark which is the same as or which is a colourable imitation of the plaintiffs registered trademark. When same mark is used, the public is deceived into purchasing the defendants goods in the belief that they are the plaintiff's goods. So a registered trademark is a casualty. It is the duty of the Court to protect the trademark. In such a case, no further question would arise. In case of similar



mark, a duty is cast upon the Court to compare both the marks to find out if the offending marks are deceptively similar to the appellant's mark and to ask the question whether there is likelihood of deception or confusion. In deciding the question, the Judge is the final authority. The Judge must approach the question from the point of view of a man of average intelligence and imperfect recollection."

36. In yet another Judgment in the case of *F. Hoffmann-La Roche & Co. Ltd vs Geoffrey Manners & Co. Pvt. Ltd* reported in 1970 SCR (2) 213, it was held as follows:

"You must take the two words. You must judge of them, 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 those trademarks is used in a normal way as a trademark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion, that is to say, not necessarily, that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods than you may refuse the registration, or rather you



must refuse the registration in that case.”

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37. In the case of *Parle Products (p) Ltd. v. J.P.& Co Mysore* reported in 1972 (1) SCC 618 the following is stated.

“9. It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him.....

After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary to refer to the decisions referred to at the Bar as in our view each case will have to be judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it.”

38. The expansive but not exhaustive legal principles that can be



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culted out from the above citations in my view are:

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1. The Burden of proof in establishing the infringement of the registered trade mark and passing off is on the plaintiff.

2. Deception or confusion is to be determined from the point of view of a purchaser of Average intelligence and imperfect recollection.

3. Identification of the essential features of the marks is a question of fact left to the Judgment of the court which enquiry is based on the evidence on record and the usage of the trade.

4. The offending mark as a whole has to be considered to find out if it is deceptively similar to that of the plaintiff's registered mark.

5. The question whether the two marks are deceptively similar so as to cause confusion or not is a question of first impression, which means that a mechanical dissection of the marks feature by feature should not be undertaken to find out the similarities and dissimilarities by keeping the two marks side by side.

39. It is not the plaintiff's case that the defendant's mark is identical to that of the plaintiff's registered mark. Both the plaintiff as well as the defendant are manufacturers of fire crackers etc. As manufacturers of



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fire crackers both the plaintiff and defendant sell their products to whole sale dealers, who in turn supply to retailers and through the retailers the products reach the customers finally. Hence in the present case the marks are not identical but the goods are identical and the trade channel is also the same. The plaintiff's case therefore falls under Clause (b) of Subsection (2) of Section 29. Therefore when two marks are not identical the burden to establish deceptive similarity and confusion lies on the plaintiff. The plaintiff has to prove that the mark adopted by the defendant bears so near a resemblance to his mark that it is likely to cause confusion in the minds of the purchasers of average intelligence and imperfect recollection. In other words the yard stick for determining deception and confusion is the impression of the "Consumer who is not gifted with the powers of observation of a Sherlock Holmes". In order to determine deceptive similarity and confusion the essential features of the Mark are to be examined. The two marks need not be kept side by side to find out the similarities and dissimilarities. In my view the first impression that is created by a bare look at the two marks is very important. A mere look at the marks should leave an impression of imitation and similarity, an impression that one could be easily



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mistaken for the other.

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40. It is trite that similarity can be either of an idea, phonetic or visual. As far as phonetic similarity is concerned, I find that the word's 'DUCK' and 'COCK' are not phonetically similar. So also the Tamil names “வாத்து” and “சேவல்” are also phonetically dissimilar.

As far as visual similarity goes it is seen from Ex.B3 that in the plaintiff's registered mark, the Bird 'COCK' is placed in the centre of two concentric circles in the middle of which the words “Registered Trade Mark” are printed. The multicoloured 'COCK' is placed in the centre of the two concentric circles in yellow colour background. The feathers of the 'COCK' are spread, its beak is open and the crown of the 'COCK' is coloured red. The spread feathers of the 'COCK' are multicoloured without prominence of any one colour. In the defendant's mark, the bird 'DUCK' is placed in the centre of two concentric circles, in the middle of which the words “Registered Trade Mark” are printed. The multicoloured 'DUCK' with its open bill is placed in the centre of the concentric circles in Yellow colour back ground. The 'DUCK' obviously has no crown and the feathers of the 'DUCK' are also not spread. In my



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view the essential feature of both the marks are the birds placed in the centre. Whereas the plaintiff has adopted the bird "COCK" the defendant has adopted the bird "DUCK". By no stretch of imagination can it be said that the bird 'DUCK' can be confused with the bird 'COCK', as anatomically the two are different.

41. I would for a moment digress here to refer to certain peculiar facts of the case as borne out by the evidence placed before the Court.

A bare look at Ex.B3, which contains various marks adopted by the manufacturers of fireworks brings out the following facts. In almost all the marks the Yellow colour background is found, an animal or bird forms the essential feature of the marks and concentric circles with words printed in the middle are adopted by all the manufacturers.

42. Perhaps to overcome the above facts, the plaintiff when examined as PW1 in his cross examination deposed as follows:

"1981ம் வருடம் 1ம்பிரதிவாதியின் வாத்து வணிகச் சின்னம் எவ்வாறு இருந்ததோ அவ்வாறே இருக்க எனக்கு ஆட்சேபனை இல்லை."

"வாத்து வணிக சின்னத்தில் பின்னணியில் உள்ள



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வட்ட வடிவில் அமைந்துள்ள பகுதியில் உள்ள மஞ்சள் வண்ணத்தை பொருத்து எனக்கு ஆட்சேபனை இல்லை."

"பி.வா.சா.ஆ.3ல் இடம் பெற்றுள்ள வணிக

சின்னங்களில் மஞ்சள் வண்ணம் இடம் பெற்றுள்ளதற்கு காரணம் பட்டாசு தொழிலில் நெருப்பு சம்பந்தப்பட்டது என்று சொன்னால் சரியாக இருக்கலாம். தாவா "எ" அட்டவணையில் இடம் பெற்றள்ள சேவல் சின்னத்தை 1981க்கு பிறகு பதிவு செய்ததாக நினைக்கிறேன். சரியாக தெரியவில்லை."

From the above evidence of the plaintiff it is seen that he has no objection to the defendant using the Yellow colour background and to the use of the bird 'DUCK' in its mark as originally registered. In the light of the said evidence the controversy gets tapered to the use of the colour combination, layout and scheme adopted by the plaintiff in its artistic pictogram of 'COCK' by the defendant. The defendant protests the objection of the plaintiff to the colour combination adopted by it, stating that the plaintiff has no monopoly to the colour combination adopted by it. The plaintiff is admittedly in the trade much before the defendant's entrance. The plaintiff originally registered its trademark in black and white in the year 1954 and only in the year 2009 obtained the copy right for the artistic design of the 'COCK' with the colour



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combinations, layout and scheme. The defendant states that as the plaintiff registered its trademark under Section 10(2) of the Trade Marks Act, the plaintiff cannot claim monopoly over the colour combination.

43. Section 10 of the Trade Marks Act reads as follows:

“(1)A trade mark may be limited wholly or in part to any combination of colours and any such limitation shall be taken into consideration by the tribunal having to decide on the distinctive character of the trade mark.

(2) So far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.”

44. The plaintiff has registered its trademark under Subsection (2) of Section 10 in black and white. When the mark is registered under Subsection (2), the same is registered without any limitation as to colour and is further deemed to be registered for all colours. Useful reference is made to the Judgments of this Hon'ble Court in the case of *ITC limited Vs. Ganesh Flour Mills and Another* reported in 2015 SCC Online Mad 14273 and *R.Gopalakrishnan vs. M/s.Venkateshwara Camphor Works* reported in 2000 (4) CTC 222. The relevant paragraph in 2015 SCC



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Online Mad. 14273 with regard to the effect of registration under Section

10(2) of the Act is extracted here under.

“63. It is an admitted fact that the respondent/plaintiff registered the trade dress for their products and the trademark Registration No. is 1106809 and it is in black and white colour. As per Section 10 of the Trademarks Act, when the trademark is registered without limitation of colour, it shall be deemed to be registered for all colours. Therefore, the arguments of the learned Senior Counsel for the applicants/defendants that the respondent/plaintiff cannot claim any monopoly over the colour red or orange, as they have not registered the trademark with colours, is untenable.”

45. In the case of *R.Gopalakrishnan Vs. M/s. Venkateshwara Camphor Works* No.14, Panneer Selvam Street, Puliampatti, Coimbatore – 688 459 reported in 2000 (4) CTC 222 this Court held as follows:

“8.....The Trial Court had observed that the colour scheme is not registered by the plaintiff and importance should be given to the name of the brand and not the colour scheme. The colour scheme is very nearly identical, both as regards the front of the carton and the rear of the carton. There are blue and yellow bands identically designed on the



sides of the carton, in both the figure of the God set-against a orange circle, with a similar yellow circle super-imposed and the letterings in white with red border set-against dark blue background is very nearly similar. In any event when a trade-mark is registered, it is registered for all colours.

Section 10 of the Act is as follows:

“.... . If and so far as a trade-mark is registered without limitation of colour, it shall be deemed to be registered for all colours.”

The registration certificate given to the appellant has no limitation regarding colour and therefore, it should be deemed to be for all colours.”

I am therefore of the view that the objection of the 1st defendant that the plaintiff cannot claim monopoly over the colour combination is not tenable.

46. As already referred above, the burden is on the plaintiff to establish that the defendant's mark is deceptively similar to its mark and the same causes confusion in the minds of the purchasers. It is pertinent to reiterate here that the objection of the plaintiff is only to the colour combination, layout and scheme adopted by the defendant in its pictogram. According to the plaintiff, it has registered copy right over



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the artistic design of the 'COCK' with its colour combination, layout and

scheme and therefore the defendant by adopting the same has infringed

his copy right also. The Trial Court in support of its finding that the

defendant had adopted a deceptively similar mark, that the defendant

infringed the plaintiff's copy right and that the defendant was passing

off his goods as that of the plaintiff found that the defendant changed

the pictogram of 'DUCK' so as to make it appear deceptively similar to

that of the plaintiff's 'COCK' mark. According to the Trial Court the

defendant had deliberately shortened the neck of the 'DUCK, opened its

bill and distended its feathers to make it appear deceptively similar to

the plaintiff's mark and with a view to cause confusion in the minds of

the purchasers. In my view, the said finding of the Trial Court cannot be

sustained in the face of Ex.B33. A bare glance at Ex.B33 (Registration

copy of the defendant's trade mark) will show that no changes, least of

all the changes referred to by the Trial court were made in the

defendant's mark. In my further view even a purchaser of average

intelligence and imperfect recollection, however illiterate he/she may be

cannot mistake a 'DUCK' for a 'COCK'. The two birds are visually and

anatomically so dissimilar that one cannot be mistaken for the other. In



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my considered opinion, the layout, scheme and the colour combination of the plaintiff's mark is not unique to the plaintiff so as to cause confusion in the minds of the purchasers. As discussed supra, it is evident from Ex.B3 that use of a bird or animal is common to the trade, use of yellow background is also common and even the concentric circles with writing in the middle is also common to the trade. Further the colours used by the plaintiff in its artistic pictogram of 'COCK' is adopted by other manufacturers like Nightingale brand, Roller brand and Annam brand against whom the plaintiff seems to have no grievance at all. As rightly pointed out by the defendant the plaintiff has not chosen to object to the use of those marks by its owners only because the plaintiff is jealous of the defendant's growth in the trade.

47. It is to be noted that the defendant has been in the same business right from the year 1980 and had first registered its mark in the year 1983. The defendant renewed it's trade mark periodically till 2008. According to the defendant due to inadvertent lapse on its part the trade mark could not be renewed in 2008 and therefore the defendant filed fresh application for registration of trade mark in 2009. It was during



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this period when the first defendant's trade mark lapsed that the plaintiff filed the suit for infringement of trade mark. The defendant filed its annual turn over statement from 1996 to 2009 to show its steady growth in the business. The evidence of the plaintiff is noteworthy, in this regard. The relevant paragraph is extracted as under:

"1ம் பிரதிவாதி அவருடைய வாத்து சின்னத்தை 5 வருடத்திற்கு ஒருமுறை புதுப்பித்து வருகிறாரா என எனக்குத் தெரியாது. 1ம் பிரதிவாதி வாத்து சின்னத்தை அதே வண்ணத்துடன் அதே பின்னணியில் பயன்படுத்தக் கூடாது என்று நான் சமீபத்தில்தான் ஆட்வேபனை செய்தேன். 1ம் பிரதிவாதி இதே வண்ணத்துடன் இதே பின்னணியில் அவருடைய வியாபார பொருட்களை விற்பனை செய்து வந்ததால் தான் நான் இந்த தாவாயை போட்டேன்".

"1ம் பிரதிவாதி அவருடைய வாத்து சின்னத்தை இதே வண்ணத்துடன் புதுப்பிக்காதது தான் நான் வழக்கு தாக்கல் செய்தேன்."

48. The next question would be whether the defendant is guilty of passing off of his goods as that of the plaintiff. The defendant can escape the plea of passing off, if the defendant establishes that the getup, packaging and other written marks on its packages are different leaving



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no room for confusion. The defendant can also succeed in countering the plea of passing off, if the defendant can show that the plaintiff has not suffered any monetary damage. The packaging is one of the important components of fireworks industries. The manufacturers of fireworks have their own packaging styles for different items of fireworks. The trademark is usually a fixed in one part of the package. It is also common knowledge that crackers are purchased majorly during festival season and other occasions. The purchase of crackers is not confined to the trademark, but is also related to the packaging and rates offered. In my view, the customers give more importance to the rates more than anything else. In this case in the front cover of the plaintiff's package golden, white and blue burning sparklers in red background with procession of elephants, horse driven chariots with men playing musical instruments is printed with the trademark 'COCK' at the center. The words 'COCK' brand the leader in fireworks and Sri Kaliswari Fire Works, Sivakasi are printed below the 'COCK' brand in pink background. Whereas in the defendant's package in the front cover crackers in multi colour background with photograph of a leading actress in the fore-front is seen, the chain crackers are on one side of the



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pictogram of the 'DUCK' mark. In the right end corner of the package, the words Sri Rajeswari Fire Works, Sivakasi is printed in blue background. It is therefore seen that the packaging of the plaintiff's goods is completely different from that of the defendant's goods and therefore there is no possibility of the defendant's goods being passed off as that of the plaintiff.

49. One aspect on which passing off can be sustained is the likelihood damage to the plaintiff's business. In the instant case, it is pertinent to note that the plaintiff has categorically admitted that he had not suffered any monetary damage due to the use of 'DUCK' mark by the 1st defendant. The crucial admission of the plaintiff in this regard is as follows:

"1ம் பிரதிவாதி வாத்து வணிக சின்னத்தை பயன்படுத்தி வருவதால் எனக்கு நஷ்டம் ஏற்படவில்லை. 1ம் பிரதிவாதி வாத்து வணிக சின்னத்தை பயன்படுத்தி வருவதால் விற்பனை ரீதியாக எங்களுக்கு பாதிப்பு ஏற்படவில்லை."

The aforesaid admission of the plaintiff clearly proves that the plaintiff's has not suffered any financial damage. I am therefore of the



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view that the plaintiff has failed to prove that the defendant is guilty of passing off his goods as that of the plaintiff.

50. As far as infringement of copy right is concerned, the test would be whether the defendant has imitated the plaintiff's label so as to infringe the plaintiff's copy right. As already discussed above the artistic design, layout and scheme of the plaintiff is not similar to that of the defendant and further as I have found no imitation of the plaintiff's artistic design of the pictogram of 'COCK' by the defendant find that there is no infringement of copy right. For all the above reasons issues 3 and 4 are decided against the plaintiff.

In view of my finding on issues 3 and 4, decision on point no.5 is not necessary but for the sake of completion, the point is taken up.

POINT No.5:

51. According to the 1st defendant, the suit is barred by acquiescence under Section 33 of the Trade Marks Act. According to the 1st defendant, the defendant has been trading with the 'DUCK' brand for almost 43 years and the said mark has developed distinct identity of its



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own. The 1st defendant further stated that the annual turn over statement filed by it from 1996 – 2009 would reveal the steady growth of the business of the 1st defendant. It was the 1st defendants further case that the plaintiff having kept silent for 30 years, filed the suit only in the year 2010 after the defendants registered trademark was not renewed due to inadvertence.

52. The plaintiff on the other hand stated that, as the defendant has failed to satisfy two important requisites for applying Section 33 of the Act, the plea of acquiescence should be rejected. According to the plaintiff, the two requisites which the defendant has to satisfy for invoking Section 33 of the Trade Marks Act are i) Registered proprietor and ii) Use of Colour mark was bonafide. According to the plaintiff, both requisites are not satisfied, hence the plea has to be rejected. Section 33 of the Trade Marks Act reads as follows:

“33. Effect of acquiescence

(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trademark-



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a) to apply for a declaration that the registration of the later trademark is invalid, or

b) to oppose the use of the later trademark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was not applied in good faith."

Section 33 of the Trade Marks Act makes it clear that to invoke the provisions of Section 33, the defendant should be a proprietor of the registered trademark. Admittedly in the present case, the trademark registration of the defendant had lapsed in the year 2008 itself and therefore on the date of the suit, the defendant was not a registered proprietor of the trademark and therefore as rightly contended by the learned counsel for the plaintiff the plea of acquiescence under Section 33 of the Trade Marks Act is not available to the 1st defendant. Even though the statutory plea is not available to the 1st defendant, the common law principle of acquiescence can be invoked by the 1st defendant, if he is able to establish that he was a bonafide user of the trademark and that the plaintiff having knowledge of his user had acquiesced to the same.



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53. According to the 1st defendant, as far as colour label goes, the 1st defendant was a prior user having used the colour combination from the year 1995 under Ex.B72 and Ex.B73. According to the defendant, the plaintiff's first user of the colour logo is only from the year 1997, as evidenced by Ex.A40 dated 26.10.1997. Whereas Ex.B72 and Ex.B73 is of the year 1995.

54. It is pertinent to note here that even the copy right for the colour logo was obtained by the plaintiff in the year 2009. Except Ex.A31 and Ex.A40, there is no other document to prove the user of the colour trademark by the plaintiff. The defendant has filed Ex.B72 and Ex.B73 to show that the defendant has been using the colour mark from 1995. One important aspect to be noted here is that the plaintiff and defendant belong to the same trade and admittedly the partners of the plaintiff firm as well as the partners of the defendant firm have been the members of the Tamil Nadu Fireworks & Amorses Manufacturers Association and they had also been a part of the books in which the advertisements relating to their trade was published. In this regard, the



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evidence of P.W1 is as follows:

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"தமிழ்நாடு பட்டாசு சரக்குகள் உற்பத்தியாளர்கள் சங்கத்தில் நான் உறுப்பினராக ஆரம்பம் முதலே இருக்கிறேன். நான் 20 வருடத்திற்கு மேலாக நான் உறுப்பினராக இருக்கிறேன். பட்டாசு சரக்குகள் உற்பத்தியாளர்கள் சங்கத்தின் 1996 2004ம் வருடமும் நான் சங்க தலைவராக இருந்தேன். 2006-2007 வருடம் நான் சங்க தலைவராக இருந்தேன் என்றால் இருக்கலாம். 2006-2007 வருடம் சங்க இணை செயலாளராக யார் இருந்தார் என்று எனக்கு ஞாபகம் இல்லை. 2006-2007ம் வருடம் சங்கத்தின் துணை செயலாளராக 1ம்பிரதிவாதி மகன் திரு.பிரதிவாரஜ் தான் இருந்தார் என்றால் அதை நான் மறுக்கவில்லை."

"நாடார் ஜார் தொடக்கப்ள்ளி புதிய கட்டிடத்தின் விழா மலரில் எங்கள் வணிக சின்னம் சேவலானது இடம் பெற்றுள்ளார். அது பி.வா.சா.ஆ 5 ஆகும் அதேம விழா மலரின் 1ம் பிரதிவாதியுடைய வாத்து வணிக சின்னமானது இடம் பெற்றுள்ளது அது பி.வா.சா.ஆ 6 ஆகும். பி.வா.சா.ஆ 5.6 இடம் பெற்றுள்ள விழா மலரானது 31.10.01ம் வருடம் வெளியிடப்பட்டுள்ளது என்றால் சரிதான். சிவகாசி டாக்டர்.தி.சந்திரகிரகம் மலரின் பக்கம் 45ல் என்னுடைய அனுமதியும் கட்டுரையானது எனது பெயரில் இடம் பெற்றுள்ளது. மேற்படி கட்டுரை பி.வா.சா.ஆ 7 பி.வா.சா.ஆ 7 சம்மந்தப்பட்ட மலரானது 29.07.07 அன்று வெளியிடப்பட்டுள்ளது. பி.வா.சா.ஆ 8 ஆகும்.



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மேற்படி மலரின் 1ம் பிரதிவாதியின் வாத்து வணிக சின்னமானது இடம் பெற்றுள்ளது. அது பி.வா.சா.ஆ 9 ஆகும். எஸ்.எ.வி சாலா பள்ளியில் 65வது ஆண்டு நிறைவுவிழா மலரில் உள்ள எங்களுடைய சேவல் சின்னமானது இடம் பெற்றுள்ளது என்றால் சரிதான். மேற்படி மலர் வெளியிடப்பட்டுள்ள வருடம் 2004ம் வருடம் ஆகும். மேற்படி மலர் பி.வா.சா.ஆ 10. மேற்படி அதே பாட விழா மலரின் 1ம் பிரதிவாதியின் வாத்து சின்னமானது இடம் பெற்றுள்ளது என்றால் சரிதான் அது பி.வா.சா.ஆ 11. குழந்தை வேலன் பாமாலை என்ற புத்தகத்தில் அன்னதான நன்கொடை நிர்வாகர் என்ற பகுதியில் 19வது பெயராக திரு.ஜி. செல்வ சண்முகம் என்ற பெயர் இடம் பெற்றுள்ளது என்றால் சரிதான். மேற்படி பெயர் பி.வா.சா.ஆ 12. மேற்படி குழந்தை வேலன் பாமாலை என்பது 2001ம் வருடம் வெளியிடப்பட்டது என்றால் சரிதான். மேற்படி குழந்தை வேலன் பாமாலை கடைசி அட்டை பகுதியில் 1ம் பிரதிவாதியின் வண்ணத்துடன் கூடிய வாத்து சின்னம் இடம் பெற்றுள்ளது என்றால் சரிதான். மேற்படி சின்னம் பி.வா.சா.ஆ 13. என்னிடம் காட்டப்படும் குழந்தைவேல் பாமாலை என்பது 2003ம் வருடம் வெளியிடப்பட்டது. என்றால் சரிதான் மேற்படி பாமாலையில் 14வது நபராக ஜி.செல்வ சண்முகம் பங்குதாரர்களின் ஒருவராகும். மேற்படி உபயத்தினை தனியாக கொடுத்துள்ளார். மேற்படி பெயர் குழந்தை வேல் பாமாலையில் கடைசி அட்டையில் 1ம் பிரதிவாதியின் வணிக சின்னம் வண்ணத்துடன் இடம் பெற்றுள்ளது சரிதான் பி.வா.சா.ஆ குழந்தை வேல் பாமாலை என்பது



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2004ம் வெளியிடப்பட்டது. அதில் பொருள் உதவி செய்த நபரில் 7வதாக ஜி.செல்வசண்முகம் என்பவர் இடம் பெற்றுள்ளார். மேற்படி நபர் செல்வசண்முகம் என்பவர் இடம் பெற்றுள்ளார். மேற்படி நபர் செல்வசண்முகம் எங்கள் பங்குதார்களின் ஒருவராகும். பி.வா.சா.ஆ 1 6 ஆகும். அதே குழந்தைவேல் பாமாலையின் கடைசி அட்டை பகுதியில் 1ம் பிரதிவாதியின் வணிக சின்னம் வண்ணத்துடன் இடம் பெற்றுள்ளது. அது பி.வா.சா.ஆ 17. குழந்தைவேல் பாமாலை என்னிடம் காட்டப்படுவது 2005ம் வருடம் வெளியிடப்பட்டது என்றால் சரிதான். அதில் பொருள் உதவி செய்தவர்களின் என்ற பகுதியில் 12 வதாக செல்வசண்முகம் எங்கள் நிறுவனத்தின் பங்குதாரர் ஆகும் அது பி.வா.சா.ஆ 18 அதே பாமாலையில் 1ம் பிரதிவாதியின் வணிக சின்னம் வண்ணத்துடன் இடம் பெற்றுள்ளது. கடைசி அட்டையில் உள்ளது. பி.வா.சா.ஆ 19. என்னிடம் காட்டப்படும் குழந்தை வேலன் பாமாலை என்பது 2006ம் வருடம் வெளியிடப்பட்டதாகும். அதில் பொருள் உதவி செய்தார்கள் என்ற பகுதியில் 194தாக இடம் பெற்றுள்ள திரு.செல்வசண்முகம் எங்கள் நிறுவனத்தின் பங்குதாரர் ஆகும் அது பி.வா.சா.ஆ 20 அதே பாமாலையில் கடைசி பக்கம் 1ம் பிரதிவாதியின் வணிக சின்னம் வண்ணத்துடன் இடம் பெற்றுள்ளது அது பி.வா.சா.ஆ 21 என்னிடம் காட்டப்படுவது குழந்தை வேலனின் பாமாலை என்பது ஆகும். அது 2007ம் ஆண்டு தை பூச விழாவின் போது வெளியிடப்பட்டது என்றால் சரிதான் அதே பாமாலையில் பொருள் உதவி செய்தவர்கள் என்ற பகுதியில் 16 வது நபரான இடம் பெற்றுள்ள



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செல்வசண்முகம் எங்கள் நிறுவனத்தில் பங்குதாரர் ஆகும். அது பி.வா.சா.ஆ 22 மேற்படி அதே பாமாலையில் 1ம் பிரதிவாதியின் வணிக சின்னமான வாத்து வண்ணத்துடன் இடம் பெற்றுள்ளது. அது பி.வா.சா.23 65வது நாடார் மகாஜன சங்க 65வது மாநாடு மலரின் இடம் சேவல் சின்னம் வண்ணம் இல்லாததது எங்கள் நிறுவனத்தின் வணிக சின்னம்தான் இது பி.வா.சா.ஆ 24 அதே மலரில் பக்கம் 260ல் இடம் பெற்றுள்ளது 1ம் பிரதிவாதியின் வணிக சின்னம் தான் அது பி.வா.சா.ஆ 25 சிக்னல் ராக்கெட் என்ற அட்டை பெட்டியில் இடம் பெற்றுள்ள சேவல் சின்னம் எங்கள் நிறுவனத்தை சேர்ந்தது தான் அது பி.வா.சா.ஆ 26 சிவகாசி காளீஸ்வரி டிரேடர்ஸ் பெயரில் எங்கள் சில்லரை விற்பனை கடையால் வழங்கப்பட்டது அதில் எங்கள் வணிக சின்னம் இடம் பெற்றுள்ளது அது பி.வா.சா.ஆ 27 (பி.வா.சா.ஆ 26இ 27 ஆட்சேபனையுடன் குறியிடப்பட்டது). என்னிடம் காட்டப்படுகின்ற பிளாஸ்டிக் பையில் இடம் பெற்றுள்ள வணிக சின்னம் எங்கள் நிறுவனத்தை சேர்ந்தது தான் அது பி.வா.தா.ஆ.28 என்னிடம் காட்டப்படுகின்ற சேவல் சின்னம் இடங்கிய வண்ணங்களுடன் கூடிய படம் எங்கள் நிறுவனத்தால் செய்யப்பட்டது தான் அது பி.வா.சா.ஆ.29".

From the aforesaid evidence of the plaintiff, it is clear that the plaintiff was aware of the use of 'DUCK' mark by the defendant and some of the documents also show that the plaintiff as well as the defendants marks



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in colour were advertised side by side. Further the plaintiff has not produced documents prior to 1995 to show that he was the first user of the colour trademark.

55. Be that as it may, the plaintiff having allowed the defendant to build his trade for a period of 28 years cannot be permitted, to feign ignorance of the defendant's user of the trademark 'COCK' and the use of the colour mark from 1995. The defendant has produced documents to show its growth in the trade right from 1996-1997 to 2010-2011. Ex.B121 dated 09.03.2011 is the turn over certificate of the 1st defendant. In this regard, the Judgment of the Hon'ble Supreme Court in the case of *Power Control Appliances and Ors v. Sumeet Machines Pvt. Ltd.* reported in 1994 (2) SCC 448 is usefully referred to. In para 29 it is stated as follows:

"29. Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name etc. It implies positive acts; not merely silence or inaction such as is involved in laches.

In Harcourt v. White 28 Beav 303 Sr. John Romilly said: "It is important to distinguish mere negligence and acquiescence." Therefore, acquiescence is one facet of delay. If the plaintiff stood



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by knowingly and let the defendants build up an important trade until it had become necessary to crush it, then the plaintiffs would be stopped by their acquiescence"....."

In the case on hand, it is seen that the plaintiff and the defendant were belong to the same trade and therefore it cannot be said that the plaintiff was not aware of the defendant's infringement of its trademark. The documents filed by the defendant clearly show that the defendant has grown in the industry right under nose of the plaintiff and the plaintiff has allowed the defendant to grow with full knowledge.

56. It is the defendant's specific case that the suit is motivated by jealousy and trade rivalry. From the facts of the case, it is seen that the defendant has been in the trade right from the year 1980 and had registered its mark in the year 1983. Till 2008, the defendant renewed its trademark periodically and due to inadvertent lapse, the trademark was not renewed in 2008. The defendant therefore applied afresh for trademark in 2008. It was during this period, when the defendants trademark had lapsed, the plaintiff filed the suit for infringement of



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trademark. The annual turn over statement of the defendant for the years 1996-2009 shows that there has been steady growth in the defendants trade. The fact that the plaintiff filed the suit in the year 2008, during which time, the defendants trademark had lapsed clearly shows that the plaintiff filed the suit out of envy and to crush the defendant after he had grown in the industry. Hence point no.5 is also answered against the plaintiff.

For all the above reasons, I find merit in the appeal and the same is allowed. The Judgment and Decree dated 19.08.2013 passed by the Principal District Court of Virudhunagar at Srivilliputhur made in Trade Mark O.S.No.35 of 2010 is set aside. There shall be no order as to costs. Consequently, connected Miscellaneous Petition is closed.

22.09.2023

Index : Yes/No
Speaking Order: Yes/No
Neutral Citation: Yes/No
dsn



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To

1.The Principal District Court of Virudhunagar,
Srivilliputhur.

2.M/s.Sri Kaliswari Fireworks,
Rep. By its Partner A.P.Selvarajan,
No.5-A, Chairman A.shanmuga Nadar Road,
Sivakasi, Virudhunagar District.

3.M/s.Dinesh Fire Works,
E-34, Milap Nagar, Utham Nagar,
New Delhi - 110 059.

4.Sri Amir Chand,
M/s.A.C.Fire Works,
561, Jheel Kuranja,
Patpar Road,
Delhi - 110051.

5.Jai Mata Traders,
Sir Subash Kataria,
M/s.Kataria Fire Works,
A2A/114, Janakpuri,
New Delhi - 110 058.

6.Sahu Gun House,
Mahavir Chowk,
Ranchi, Jharkand State.

7.Surya Sales,
Mahavir Chowk, Ranchi



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8.The Section Officer,
V.R. Section,
High Court, Madras.

N.MALA, J.

ah/dsn

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