

IN THE HIGH COURT OF KERALA AT ERNAKULAM

PRESENT:

THE HONOURABLE MR. JUSTICE P.B.SURESH KUMAR

THURSDAY, THE 19TH DAY OF MARCH 2015/28TH PHALGUNA, 1936

FAO.No. 292 of 2014 ()

(I.A.NO.1319/2014 IN OS.NO.3/2014 OF DISTRICT COURT, KOLLAM
DATED 20-08-2014)

APPELLANT/RESPONDENT/ DEFENDANT:

SHOUKKATH.J, AGED 59 YEARS,
S/O ISMAIL KUNJU, SHAHNAZ PANIKKASSERY JEWELLERS,
MUKKADA, KUNDARA, KOLLAM,
RESIDING AT SHAHNAZ COTTAGE, ELAMALLOOR,
KUNDARA.

BY ADV. SRI.B.RENJITHKUMAR

RESPONDENT/PETITIONER/ PLAINTIFF:

M.MUHAMMED NOUSHAD,
S/O. HANEEFA, AGED 47 YEARS,
PANIKKASSERY JEWELLERS, MUKKADA,
KUNDARA, KOLLAM, RESIDING AT PANIKKASSERY HOUSE,
ELAMPALLOOR, KUNDARA P.O, KOLLAM -691 501

BY ADVS. SRI.B.ASHOK SHENOY
SMT.C.G.PREETHA
SRI.THOMAS P.MAKIL
SRI.K.V.GEORGE
SRI.P.N.RAJAGOPALAN NAIR
SRI.P.S.GIREESH

THIS FIRST APPEAL FROM ORDERS HAVING BEEN FINALLY HEARD
ON 19-03-2015, THE COURT ON THE SAME DAY DELIVERED THE
FOLLOWING:

sts

FAO.NO.292/2014

APPENDIX

PETITIONER'S ANNEXURES:

- ANNEX 1 COPY OF THE ELECTORAL IDENTITY CARD OF ADBUL NIZAR.**
- ANNEX II COPY OF THE RATION CARD OF THE FATHER OF THE RESPONDENT.**
- ANNEX III COPY OF THE SALE DEED NO.3234/2009 DATED 1/8/2009**
- ANNEX IV COPY OF THE SALE DEED NO.3222/2010 DATED 3/06/2010**

RESPONDENT'S ANNEXURES: NIL

/TRUE COPY/

P.A.TO JUDGE

sts

C.R.

P.B.SURESH KUMAR, J.

FA.O.No.292 OF 2014

Dated this the 19th day of March, 2015

JUDGMENT

The defendant in an action for infringement of a trade mark has come up in this appeal challenging the order of temporary injunction passed against him in the suit.

2. The case of the plaintiff is that he is engaged in the manufacture and sale of jewellery and related goods in the name 'Panikkassery Jewellers' from the year 1996; that the name 'Panikkassery' has been registered by him as his trade mark under the Trade Marks Act; that during the year 2002, the defendant who is the brother-in-law of the plaintiff has opened a jewellery under the name 'Shehanaz Panikkassery Jewellers' in the vicinity of the jewellery of the plaintiff and that the use of the name 'Panikkassery' by the defendant amounts to infringement of the trade mark of the plaintiff. The relief sought in the suit is a prohibitory injunction restraining the defendant from infringing the registered trade mark of the plaintiff.

3. Along with the suit, I.A.No.1319 of 2014 was filed by the plaintiff seeking an order of temporary injunction restraining the defendant and others acting under him from infringing the trade mark of the plaintiff by using the name 'Panikkassery'. The defendant contested the application for temporary injunction contending inter alia that 'Panikkassery' is the family name of his wife; that it was he who started 'Panikkassery Jewellers' in the year 1996 with the plaintiff; that under a family arrangement, he has given up his rights in the business carried on in the name 'Panikkassery Jewellers'; that at the time of parting, there was no agreement that the defendant shall not use the name 'Panikkassery' and that therefore, the use of the name 'Panikkassery' by the defendant will not amount to infringement.

4. The documents produced by the plaintiff in support of I.A.No.1319 of 2014 were marked as Exts.A1 to A38 and the documents produced by the defendant in support of the contentions raised in the said application were marked as Exts.B1 and B2. The court below, on an appraisal of the materials on record, granted the interim order of temporary injunction sought by the plaintiff. The defendant is aggrieved by the said order.

5. Heard the learned counsel for the appellant and the respondent.

6. The learned counsel for the appellant contended that 'Panikkassery' being the family name of the wife of the defendant, the use of the said name by the defendant for his jewellery will not amount to infringement. He relied on section 35 of the the Trade Marks Act in support of the said contention. The learned counsel for the appellant has also contended that the materials on record would establish that the defendant had been doing business jointly with the plaintiff in the name 'Panikkassery Jewellers' and in the absence of any agreement to the effect that the defendant shall not use the said name, it has to be presumed that the defendant has been permitted to use the trade name 'Panikkassery'. He relied on section 53 of the the Trade Marks Act, in support of the said contention. The learned counsel for the appellant has further contended that the names 'Panikkassery Jewellers' and 'Shehanaz Panikkassery Jewellers' have no similarity and therefore, at any rate, it cannot be contended that the defendant has infringed the trade mark of the plaintiff.

7. Section 29 of the Trade Marks Act deals with infringement of

registered trade marks. Sub-sections (1) to (3) of Section 29 read thus:

“29. Infringement of registered trade marks:- (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.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.”

It is evident from Section 29 of the Trade Marks Act that if the use of a mark in the course of trade, which because of its similarity to the registered trade mark and the identity to the product or service covered by the registered trade mark, is likely to cause confusion to the public as

to the source of the product or service, such use would amount to infringement. It is settled that the question whether the use of a mark is likely to cause confusion among the public as to the source of the product or service is to be determined in the context of an unwary person of average intelligence with imperfect recollection. [See ***Amritdhara Pharmacy v. Satya Deo Gupta*** (AIR 1963 SC 449)].

8. The fact that the plaintiff has obtained registration of the trade mark 'Panikkassery' under classes 14 and 35 of the fourth schedule to the Trade Marks Rules, 2002 is not in dispute. Likewise, the fact that the plaintiff and the defendant are engaged in identical business is not in dispute. Again, the fact that the registered trade mark of the plaintiff is part of the name of the jewellery of the defendant is not in dispute. The issue to be considered, therefore, is whether the trade name 'Shehanaz Panikkassery Jewellers' is likely to cause confusion among the public as to the source of the products and services of the defendant. Ext.A1 is the licence obtained by the plaintiff from Kottankara Grama Panchayat on 9.4.1996 to run a jewellery in the name 'Panikkassery Jewellers'. Ext.A2 is the registration obtained by the plaintiff under the Kerala General Sales Tax Act on 18.10.1996 in the

name 'Panikkassery Jewellers'. Ext.A3 is the copy of the counterfoil of the return of income tax submitted by the plaintiff on 27.2.1998 in connection with the business carried on by him in the name 'Panikkassery Jewellers'. Ext.A5 is a copy of the proceedings initiated against the plaintiff under the Kerala General Sales Tax Act on 11.2.1998 in connection with the business carried on by him in the name 'Panikkassery Jewellers'. Ext.A9 is the registration obtained by the plaintiff under the Shops and Commercial Establishments Act in connection with the business 'Panikkassery Jewellers'. Ext.A9 indicates that the plaintiff has been doing business in the name 'Panikkassery Jewellers' from 31.3.1996. Exts.A8, A12, A14, A15, A17 and A18 are the advertisements of 'Panikkassery Jewellers'. Among them, Ext.A8 is an advertisement published on 30.8.2003. Ext.A16 is the copy of a proceedings initiated against the plaintiff under the Kerala Value Added Tax Act on 20.5.2008. Exts.A30 and A31 are the photographs of the jewellery of the plaintiff. Exts.A32 and 33 are the photographs of the jewellery of the defendant. Ext.A34 is an advertisement of the jewellery of the defendant. The documents referred to above would indicate beyond doubt that the plaintiff has been doing business in the name

'Panikkassery Jewellers' from 1996 onwards. The various advertisements of the jewellery of the plaintiff also would indicate the reputation and goodwill acquired by the plaintiff in the name 'Panikkassery Jewellers'. In ***Parle Products (P) Ltd. v. J.P. and Co., Mysore*** (1972)1 SCC 618, the Apex Court has held that in an action for infringement, in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two alone need be considered. It was also held that 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. A comparison of the photographs of the shop of the plaintiff and the photographs of the shop of the defendant, in the light of the principles aforesaid, would indicate beyond doubt that the use of the name 'Shehanaz Panikkassery Jewellers' by the defendant is likely to cause confusion among the public as to the source of the products and services of the defendant. It is thus evident that the plaintiff has made out a prima facie case for an order of temporary injunction.

9. The main contention advanced by the learned counsel for

the appellant is that 'Panikkassery' being the family name of the wife of the defendant, the use of the said name by the defendant will not amount to infringement. Section 35 of the Trade Marks Act relied on by the defendant in support of his contention reads thus :

“Section 35. Saving for use of name, address or description of goods or services--Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services.”

Section 35 protects bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business. It is evident from Section 35 that the said Section permits only bona fide use of the name referred to in the Section. Bona fide use means honest use by a person without any intention to deceive anybody or without any intention to make use the good will of another. In the instant case, 'Panikkassery' is the family name of the wife of the defendant. The said name is not a name contemplated under Section 35 of the Trade Marks Act and at any rate, the said name being the family name of the wife of the defendant, it

is difficult to hold that the use of the said name by the defendant is bona fide and without any intention to make use the good will of the plaintiff. The defendant is, therefore, not entitled to the protection under Section 35 of the Trade Marks Act.

10. The next contention advanced by the learned counsel for the appellant is that the defendant has been doing business jointly with the plaintiff in the name 'Panikkassery Jewellers' and in the absence of any agreement to the effect that the defendant shall not use the said name, it has to be presumed that the defendant has been permitted to use the name 'Panikkassery'. The said contention is advanced based on Section 53 of the Trade Marks Act. Section 53 of the Act reads thus:

“Section 53. No right of permitted user to take proceeding against infringement--A person referred to in sub-clause (ii) of clause (r) of sub-section (1) of section 2 shall have no right to institute any proceeding for any infringement.”

Exts.B1 and B2 are the two documents produced by the defendant to substantiate his contention that he was conducting the business 'Panikkassery Jewellers' jointly with the plaintiff. Among them, Ext.B1 is a copy of the lease deed executed by the defendant in respect of two shop rooms. Ext.A19 licence produced by the plaintiff would indicate

that the jewellery of the plaintiff was housed in the premises covered by Ext.B1 lease deed. The plaintiff has not produced any document to show as to how he got possession of the shop rooms covered by Ext.B1 lease deed. The defendant has no case that the plaintiff is running his establishment in the very same premises even now. In the light of the said documents, it has to be inferred that the plaintiff had been conducting the business in a premises taken on lease by the defendant for some time. Ext.B2 is a newspaper report in which it is stated that 'Panikkassery Jewellers' is an establishment run by the plaintiff and the defendant together.

11. The documents produced by the plaintiff as referred to above rule out the possibility of the joint business by the plaintiff and defendant beyond any shadow of doubt. As such, merely for the reason that the plaintiff had conducted business in a premises taken on lease by the defendant for some time, it cannot be held that the plaintiff and the defendant were doing business jointly. As noticed above, Ext.B2 is only a news paper item and the same cannot be accepted as evidence of the facts reported in the news item. The materials on record are not sufficient to hold that the plaintiff and defendant were doing business

together. As such, the contention of the defendant that there is an implied permission to use the trade mark 'Panikkassery Jewellers' cannot be accepted.

12. I have found that the use of the name 'Shehanaz Panikkassery Jewellers' by the defendant is likely to cause confusion among the public as to the source of the products and services of the defendant. As such, the contention advanced by the learned counsel for the appellant that the names 'Panikkassery Jewellers' and 'Shehanaz Panikkassery Jewellers' have no similarity and therefore, there is no question of any infringement is only to be rejected.

In the aforesaid facts and circumstances, the decision of the court below is perfectly in order. There is no merit in the appeal. The appeal is, accordingly, dismissed.

P.B.SURESH KUMAR, JUDGE

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