

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Date of reserve : 11.09.2015

Date of delivery: 16.09.2015

CORAM

THE HONOURABLE MR.JUSTICE K.RAVICHANDRABAABU

O.A.Nos.356 and 357 of 2014 and Application No. 2980 of 2014
in
C.S.Nos.299 of 2014

1. Noor Mohamed
Proprietor,
Olympia Paper & Stationery Stores,
22, Anderson Street,
Chennai - 600 001.

2. Olympic Cards Ltd.,
No.195, N.S.C. Bose Road,
Parrys, Chennai - 600 001
rep. By its M.D.,
Mr.Noor Mohamed

.. Applicants in all the Applications.

vs.

1. Olympic Prints,
20-22, Sunnambukkara Street,
Dhanamani Complex,
Madurai - 625 001.

2. Olympic Traders,
3/86, Indian Bank Colony,
2nd Street, Narayanapuram,
Madurai - 625 014.

3. Olympic Xerox,
3/86, Indian Bank Colony,
2nd Street, Narayanapuram,
Madurai - 625 014.

..Respondents in all the Applications.

O.A.No.356 of 2014

Application filed under Order XIV Rule 8 of O.S. Rules read with Order XXXIX Rule 1 & 2 of C.P.C. to grant an order of interim injunction restraining the respondents 1 to 3, by themselves, their servants or agents or any one claiming through them or under them, from in any manner, infringing the applicants' registered trade mark "OLYMPIC " (Label) under No.423133 in Class 16, "OLYMPIC " (Word mark) under No.423134 in Class 16 and DEVICE OF A TORCH under No.423135 in Class 16 or any other deceptively similar variation thereon, in any form or manner whatsoever.

O.A.No.357 of 2014

Application filed under Order XIV Rule 8 of O.S. Rules read with Order XXXIX Rule 1 & 2 of C.P.C. to grant an order of interim injunction restraining the respondents 1 to 3, by themselves, their servants or agents or any one claiming through them or under them, from passing off of their products in any manner, as and for the products of the applicants by using the well reputed and registered trade mark "OLYMPIC", "OLYMPIC LABEL", "DEVICE OF A TORCH" or any other identical or similar trademark which are deceptively similar to or imitation of the words of the applicants registered trademark.

A.No.2980 of 2014

Application filed under Order XIV Rule 8 of O.S. Rules read with Order XXXIX Rule 1 & 2 of C.P.C. to direct the respondents 1 to 3 to surrender to the applicants the entire stock of unused offending trade mark labels/ blocks and dyes for destruction.

For Applicants in all the applications : Mr.T.K.Ramkumar
for M/s. Ram & Rajan Association

For Respondents in all the applications : Mr.A.Thiagarajan,
Senior Counsel for
Mr.M.Veeranthiran.

COMMON ORDER

The applicants in all these applications are the plaintiffs in the above suit. They filed the above suit seeking for the following reliefs.

a) To grant permanent injunction restraining the defendants 1 to 3, by themselves, their servants or agents or any one claiming through them or under them, from in any manner, infringing the plaintiffs' registered trade mark "OLYMPIC " (Label) under No.423133 in Class 16, "OLYMPIC " (Word mark) under No.423134 in Class 16 and DEVICE OF A TORCH under No.423135 in Class 16 or any other deceptively similar variation thereon, in any form or manner whatsoever.

b) To grant permanent injunction restraining the defendants 1 to 3, by themselves, their servants or agents or any one claiming through them or under them, from passing off of their products in any manner, as and for the products of the plaintiffs by using the well reputed and registered trade mark "OLYMPIC", "OLYMPIC LABEL", "DEVICE OF A TORCH" or any other identical or similar trademark which are deceptively similar to or imitation of the words of the plaintiffs' registered trademark.

c) To direct the defendants 1 to 3 to surrender to the plaintiffs the entire stock of unused offending trade mark labels/ blocks and dyes for destruction.

d) To direct the defendants 1 to 3 to render true and faithful account of the profits earned by them through the sale of products bearing the offending OLYMPIC trade mark, Device of Torch and directing payment of such profits to the plaintiffs for the infringement and/or passing off committed by the Defendants 1 to 3.

e) To direct the defendants 1 to 3 to pay to the plaintiffs the costs of the suit.

2. Pending disposal of the suit, they seek the interim reliefs in the above applications as stated hereunder.

O.A.No.356 of 2014 is filed to grant an order of interim injunction restraining the respondents 1 to 3, by themselves, their servants or agents or any one claiming through them or under them, from in any manner, infringing the applicants' registered trade mark "OLYMPIC " (Label) under No.423133 in Class 16, "OLYMPIC " (Word mark) under No.423134 in Class 16 and DEVICE OF A TORCH under No.423135 in Class 16 or any other deceptively similar variation thereon, in any form or manner whatsoever.

O.A.No.357 of 2014 is filed to grant an order of interim injunction restraining the respondents 1 to 3, by themselves, their servants or agents or any

one claiming through them or under them, from passing off of their products in any manner, as and for the products of the applicants by using the well reputed and registered trade mark “OLYMPIC”, “OLYMPIC LABEL”, “DEVICE OF A TORCH” or any other identical or similar trademark which are deceptively similar to or imitation of the words of the applicants registered trademark.

A.No.2980 of 2014 is filed to direct the respondents 1 to 3 to surrender to the applicants the entire stock of unused offending trade mark labels/ blocks and dyes for destruction.

3. The case of the applicants/ plaintiffs is as follows:

i) The first applicant is carrying on business as the sole proprietor under the name and style of Olympia Paper & Stationery Stores and as such, he is the registered Proprietor of the trade marks “OLYMPIC” (word perse), “OLYMPIC” (Device) and Device of a Torch. The second applicant is the public limited company and licensee of the 1st applicant. The 1st applicant is the Chairman and Managing Director of the 2nd applicant Company.

ii) The applicants are engaged in the manufacture and marketing of various products like Stationary including wedding cards, visiting cards, invitation cards, greeting cards, inland letters, envelopes, paper and paper articles, cardboard and cardboard articles, books, diaries etc. One

N.M.Habibullah adopted the unique trade marks “OLYMPIC” (device), “OLYMPIC” (word mark) and Device of a Torch in the year 1962 and was carrying on business under the name and style of “Olympic Stores” as a sole proprietor. Since 1962, the above referred trade marks have been used by the said person. Later, the said Proprietary concern was taken over by his two sons namely, the 1st applicant herein and one H.Salahudeen. On 10.11.2005, the said H.Salahudeen passed away and the partnership firm was dissolved and the 1st applicant herein has become the sole proprietor of the concern under the name and style of Olympia Paper and Stationery Stores.

iii) The 1st applicant has obtained statutory protection by registering the marks under the Trade Marks Act, 1999. The particulars of registered trademarks of the 1st applicant are as follows:

<i>Trademark</i>	<i>Trademark No.</i>	<i>Date of Registration</i>	<i>Class</i>	<i>Specification of goods</i>
Olympic Trade Mark (Device)	423133	12.06.1984	16	Stationery including Wedding cards, visiting cards, invitation cards, Greeting cards, Inland letters, envelopes, Paper and Paper Articles, cardboard and cardboard Articles, Printed matter, Books Book Binding Materials, Writing Instruments Inks, Adhesive Materials, Artists Materials (including Paint Brushes), Instructional and

Trademark	Trademark No.	Date of Registration	Class	Specification of goods
				Teaching Material Playing cards and Office Requisites Including Inc. Class 16.
OLYMPIC (word mark)	423134	12.06.1984	16	Stationery including Wedding cards, Visiting cards, Invitation cards, Greeting cards, Inland Letters, Envelopes, Paper and Paper Articles, cardboard and Cardboard Articles, Printed matter, Books Book Binding Materials, Writing Instruments Inks, Adhesive Materials, Artists Materials (including Paint Brushes), Instructional and Teaching Material Playing cards and Office Requisites.
DE OF MARSHAL (Device)	423135	02.06.1984	16	Stationery including Paper and Paper Articles, Cardboard and Cardboard Articles, Printed matter, Books Book Binding Materials, Writing Instruments Inks, Adhesive Materials, Artists Materials (including Paint Brushes), Instructional and Teaching Material Playing cards and Office Requisites.
OLYMPIC TRADE	973270	22.11.2000	16	Paper and Paper Articles, Cardboard and

Trademark	Trademark No.	Date of Registration	Class	Specification of goods
MARK (Device)				Cardboard Articles, Printed matter, Stationery including Wedding cards, Visiting cards, Invitation cards, Greeting cards, Inland Letters, Envelopes Books, Book Binding Materials, Writing Instruments Inks, Adhesive Materials, Artists Materials (including Paint Brushes), Instructional and Teaching Materials, Periodicals and Publications, Office Requisites, Playing Cards, Photographs and Transparencies (All the Foregoing Goods Including Those for Use With Computers Recorded Computer Software, Recorded Computer Software Packages, Apparatus and Instruments for Use in Creating, Operating, Accessing and Managing web sites On The Internet); Parts And Fittings For All The Aforementioned Goods

iv) The above trade marks under Serial Nos. 1 to 3 have been renewed from time to time and they are valid till **2025**. However, the mark under

No.973270, i.e., “Olympic” Trade Mark (Device) was not renewed in time even though, the said registration lapsed in the year 2007. However, the applicant has applied once again and the same is pending before Registrar of Trade Marks. In fact, the requirement for the 1st applicant to make a fresh application in respect of the “Olympic” trade Mark (device) is due to the expansion of the scope of Class 16 under the Trade Marks Act, thereby, some more goods were added in the specification.

iv) There has been an ever increasing demand for the product of the applicants in domestic market and the total turn over of the said products under the above Trade Marks has been steadily increasing. The year wise sales turn over of the goods under the above said Trade Marks are as follows:

<i>Year</i>	<i>Turnover</i>
2007-2008	200,835,929.00
2008-2009	264,197,238.00
2009-2010	313,250,873.00
2010-2011	384,504,527.00
2011-2012	431,676,292.00
2012-2013	474,787,361.00
2013-2014	523,860,612.00

vi) The applicants have acquired the status of a well known trade mark under the provisions of Trade Marks Act, 1999. Recently, the applicant noticed that the 1st respondent has commenced its operation under the name of

“Olympic Prints” and is using the identical trademarks of the applicants in respect of digital and print media. The applicants came to know about such infringement through the advertisements made in the magazine named “Print Week” in the issue dated 10.03.2014. The applicant carried out a work search in respect of the “Olympic” and to their utter shock, they came across a website of the 1st respondent calling themselves to be a part of the “Olympic Groups” wherein the Device of the Torch as registered by the applicants has been used by the 1st respondent. The 1st respondent group carries on business in the name and style of “Olympic Xerox”, “Olympic Traders” and “Olympic Prints”. Thus, the registered Trade Marks of the applicants are being exploited by the 1st respondent and its group which amounts to infringement of the trademarks of the applicants.

vii) The applicants came to know that the respondents have only applied for the registration of the mark “Olympic Prints ” in Classes 16 and 35. The details of the applications filed by the respondents are as follows:

<i>Trade mark</i>	<i>Appln. No.</i>	<i>Appln. Date</i>	<i>Class</i>	<i>Date of user</i>	<i>Applicant</i>	<i>Specifica- tion of goods</i>	<i>Status</i>
Olympic xerox (Device)	2356077	26.06.2012	35	26.06.2009	S.Mohamed Rafeek Raja Trading As Olympic Xerox	Photo copying, Binding, Lamination Printing, Plan Printing,	Send Back to EDP

<i>Trade mark</i>	<i>Appln. No.</i>	<i>Appln. Date</i>	<i>Class</i>	<i>Date of user</i>	<i>Applicant</i>	<i>Specification of goods</i>	<i>Status</i>
						DTP Etc. and All Other Item	
Olympic Prints (Device)	2548891	14.06.2013	16	13.12.2010	S.Mohamed Rafeek Raja Trading As Olympic Prints	Digital Printing, Offset Printing (Block Printing) computer to Plates (Ctp), Binding, Lamination and Deisgning	Formalities Check Pass
Olympic Prints (Device)	2356078	29.06.2012	35	13.12.2010	S.Mohamed Rafeek Raja Trading As Olympic Prints	Printing, Printing Materials, (Ctp), Plate Making, Binding, designing, Lamination etc. (Pre-Press, Press and Post-Press) and all other items	Objected

viii) The 1st and 2nd respondents filed the above applications only in the year 2012 and 2013 respectively claiming user rights also only from 2009 and

2010 respectively. The applicants mark “Olympic” device carries the word “Olympic” with a device of a torch in the said label. The respondents and their group have infringed the registered trade mark of the applicant “Olympic” as well as the registered device of the torch and have incorporated both in the name of so called “Olympic Group”. The respondents have made contradictory claims before the Trade Mark Registering Authority. The applications of the respondents are now in the initial stage of scrutiny before the Registrar of Trade Mark and the applicants herein intends to oppose the registration of the above mark, once, it is advertised in the Trade mark Journal. The 1st respondent has dishonestly and fraudulently adopted the impugned mark “Olympic Prints” knowingly and being fully aware of the applicants existence. The mark “Olympic Prints” is identical to the well known and registered Trade mark of the applicants. The applicants have been in the business of printing and digital media since 1962 whereas the 1st respondent has claimed to have started its business only in January, 2014. Therefore, the applicants are entitled to restrain the respondent from using the word “Olympic” and the device of a torch in any manner either by themselves or anybody claiming through them. Thus, the above said suit with the application for interim reliefs were filed before this Court.

4. This Court ordered notice to the respondents in those applications and

thereafter, the matter is now taken up for final disposal of the applications.

5. A common counter is filed on behalf of the respondents wherein it is stated as follows:

i) The first respondent is carrying on business under the name and style of “Olympic Prints” and is in the business of digital printing, offset printing (block printing), computer of plates (ctp), binding, lamination and designing. The trademark “Olympic Prints” was bonafidely conceived and adopted by the first respondent in the year 2010. The mark “Olympic Prints” is represented in a distinctive lettering style and artwork capable of distinguishing the services rendered by the first respondent. The above trade mark has no reference whatsoever to the kind, quality or the intended purpose of services and does not consist of marks or indication in the trade which is capable of distinguishing the services of the first respondent from those that of the others. The respondents were engaged in making plates for the printing shops and the printers from Madurai, Karur, Trichy, Nagercoil, Theni, Salem and Virudhunagar markets, alone would place orders with the company. Around 300 plates are supplied to the printers on their orders. This respondents produced printed tags and supply around 20,000 to 25,000 tags per day for the Textile customers. The mark "Olympic Prints" of the respondent became very popular.

ii) The respondents have applied for trade mark registration for “Olympic

Prints” on 18.08.2014 before the Trade Mark Registry. The applicants, except making a bald allegation against the adoption, have not substantiated the same with any documentary proof. The very claim of adoption as early as in the year 1962 is false. Both the marks are not visually, phonetically and structurally similar. There are several added features in the respondents' mark and there is no chance of deception and confusion in the minds of the trade and public. The applicants have not made out a *prima facie* case or established balance of convenience in their favour.

6. Learned counsel appearing for the applicants submitted as follows.

a) All the usage of the respondents in respect of the trade mark under dispute are clearly and admittedly after the date of user by the applicants. The applicants can oppose the applications of the respondents before the competent authority only after an advertisement is made as required under the law. The applicants registration regarding the marks in Serial Nos.1 to 3 are renewed upto 2025. The essential features of Trade Mark is “Olympic”. The respondents are well aware of the existence of the mark and together made as mark of the applicants/ Plaintiffs. The marks in Serial Nos. 2 & 3 are individual marks and together made as mark in Serial No.1. Thus, the “Olympic” is a key word. Admittedly, the respondents started their business and using the impugned trade mark only from 2009 and 2011. However, the applicants came

to know about the existence of the respondents/defendants trade mark only on 10.03.2014 and immediately filed the present suit. Therefore, the applicants have made out a *prima facie* case for grant of interim injunction. The balance of convenience is also in their favour.

b) In support of his contention, the learned counsel relied on the following decision.

i) **2005(30) PTC 233 (Dhariwal Industries Ltd. & Anr. vs. M.S.S.Food Products)**; (ii) **2002(24) PTC 1 (SC) (Laxmikant V.Patel vs. Chetanbhat Shah & Anr.)**; (iii) **PTC (Suppl.)(2) 680 (Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories) (SC)**; (iv) **1997 (17) PTC 655 (Tube Investments of India Ltd. vs. Trade Industries, Rajasthan)** and (v) **PTC (Suppl.)(1) 346 Parle Products (P) Ltd. vs. J.P. And Co., Mysore)(SC)**.

7. Learned senior counsel appearing for the respondents submits as follows:

a) The suit is premature since the applications filed by the respondents are pending before the competent authority and the applicants can make their objection before the said authority. The mark used by the respondents/defendants is totally different and has not deceptively similar to that of the plaintiffs.

b) The goods which are manufactured by the respondents are different

and not one and the same as that of the applicants. The goods manufactured by the respondents are not for selling to common man, on the other hand, it is meant for selling to the class of customers, namely, Printers. Therefore, there is no possibility for any confusion in the minds of the public. The applicants have knowledge from 2009 about the usage of the trade mark by these respondents. The respondents are not doing the business in Chennai. The mark “Olympic” cannot be claimed exclusively by the applicants.

8. Heard the learned counsel appearing for the applicants and the learned senior counsel appearing for the respondents and perused the materials placed before this Court.

9. The point for consideration is as to whether the applicants have made out a case for grant of interim reliefs as sought for in these applications.

10. The applicants as the plaintiffs filed the the present suit seeking for permanent injunction against the defendants from in any manner infringing the plaintiffs registered trade mark and also for permanent injunction restraining the defendants from passing off their products in any manner as and for the products of the plaintiffs by using the above registered trade mark or any other identical or similar trade mark which are deceptively similar to or imitation of

the words of the plaintiffs registered trademark. Whether the plaintiffs are entitled to the relief sought for in the main suit is the question that has to be considered and decided only after conducting the trial. However, for considering these interim applications, this Court has to see as to whether the plaintiffs have made out a prima facie case for grant of interim relief as sought for in these applications. It is also to be seen as to whether the balance of convenience is in favour of the plaintiffs and whether irreparable injury would be caused to them, if injunction is refused.

11. While extracting the respective case of the parties in the earlier paragraphs, the particulars of the registered trademarks of the plaintiffs have been shown in tabular column. Therefore, I am not reproducing the same once again herein. From a perusal of the particulars of the registered trademarks of the applicants, it is evident that the first applicant is using the trade mark namely “Olympic” (device), “Olympic” (word mark) and Device of a Torch under trademarks Nos. 423133, 423134, 423135 from the month of June, 1984. The date of registration of the above marks was on 12.6.1984, 12.6.1984 and 2.6.1984 respectively. Insofar as the 4th trade mark namely “Olympic” trade mark (Device) is concerned, though the same was registered on 22.11.2000 under Trademark No.973270, it is stated that the said registration lapsed in the year 2007 and instead of renewing the registration in time, the 1st applicant has

applied once again afresh for issuing fresh registration in view of the fact that the specification of goods referred to under Class 16 was expanded. However, the fact remains that the applicants are continuously using the trade mark all these years. In fact, it is claimed by the applicants that their trade marks were adopted by one N.M.Habibullah, father of the applicant in the year 1962 while he was carrying on the business under the name and style of “Olympia Stores”. It is also claimed by the applicants that the sole proprietorship became a partnership between the sons of the said Habibullah, thereby continuously using the above trade marks ever since 1962. It is further claimed by the applicants that the said partnership firm was dissolved subsequently, after the death of one of the partner and thus, it has become the proprietary concern in the year 2005 and the 1st applicant has become the sole proprietor of the same. All these facts are not disputed or denied by the respondents. Therefore, the claim of the applicants that the usage of the trademarks from the year 1962 is found to be factually correct.

12. On the other hand, while considering the usage of the trademark by the respondents, it is evident that the respondents themselves have claimed in their application before the Registering Authority that the date of user of their trademark is only from 26.06.2007 and 13.12.2010 respectively. It is also seen that the respondents have made their application only on 26.06.2012,

14.6.2013 and 29.06.2012. It is also an admitted fact that these applications of the respondents are still pending and not advertised in the Trademark Journal. What is to be seen in the present case under the above stated facts and circumstances, is as to whether the applicants have come before this court immediately on knowing the infringement of their trademark and the impugned passing off action by the respondents. It is specifically contended by the applicants that they came to know about the infringing action of the respondents through the advertisement made in the magazine named 'Print Week' in the issue dated 10.03.2014. This contention of the applicants are not specifically denied by the respondents and on the other hand, except making a vague statement as though the applicants are aware of the trademarks of the respondents from 2009, the respondents have not filed any material proof in support of such contention. Therefore, this Court has to accept the contention of the applicants, insofar as their date of knowledge of the impugned action of the respondents, as stated in their application.

13. Now, let me consider as to whether the trademark of the plaintiffs and defendants are deceptively, phonetically or visually similar with each other.

14. First of all, it is seen that the word "Olympic" is a registered

trademark of the applicants under trademark No.423134 with date of registration, 12.06.1984 under Class 16. Therefore, in my considered view the word, “Olympic” registered as the word mark by the applicants, cannot be used by any other person and if there is any such use, certainly, it would amount to infringement of the said registered word mark.

15. While considering the trademark of the respondents, it is evident that they are also using the very same word mark, namely, “Olympic” as their trademark. No doubt, their trademarks are referred to as “Olympic Xerox” and “Olympic Prints”. However, it is an admitted fact that the word “Olympic” is used by the respondents in their trade mark. A perusal of the style of the letters of the word “Olympic” in both the marks shows similarity which a common man can definitely be given to understand as though the trademark of the respondents is that of the applicants, in view of the fact that the applicants are in the trade with the above registered trademarks from the year 1962. Even though, an attempt is made by the respondents to claim that their customers are specific group of persons, namely, Printers and therefore, there is no possibility for confusion in the minds of the public, I am not able to accept the said contention, in view of the fact that what is to be seen is, as to whether any infringement has taken place in respect of the usage of the trademarks or not. In this case, the above stated facts and circumstances would disclose that

the respondents have infringed the trademark of the applicants insofar as the trademarks under Serial Nos.1 to 3 'Olympic' trademark are concerned. Insofar as the other trademark namely "Olympic" Trademark (device) is concerned, certainly, the passing off action of the respondents are against the interest of the applicants as there is every possibility to consider the trademarks of the respondents/defendants as that of the applicants/plaintiffs. It is also to be noted at this juncture that the respondents have not denied the knowledge of the existence of the plaintiffs business and their trademark ever since 1962. On the other hand, what they contend is that the claim of the plaintiffs and their usage of the registered trade mark are false. I do not think that the respondents are justified in contending so, in view of the statutory registration certificate issued by the competent authority in respect of the disputed trade marks in favour of the plaintiffs.

16. Learned counsel appearing for the applicants relied on the decision of the Honourable Supreme Court reported in **2005(30) PTC 233 (Dhariwal Industries Ltd. & Anr. vs. M.S.S.Food Products)** wherein the Honourable Supreme Court has observed that the earlier user of the trademark is entitled to an injunction. Paragraph No. 11 reads as follows

11. Prima facie, it appears to us that the mark "Malikchand" was being used, though not

much publicized by the original user, leading to the alleged acquisition of the right to use the mark by the plaintiff. The defendants appear to have started the use of the mark "Malikchand" in a large scale at a subsequent point of time. As noticed by the High Court, both sides had used their respective marks for some time. The litigation arose when the defendants herein approached the High Court of Bombay seeking to prevent the use of the mark "Malikchand" by suing what they thought was the proprietor of the business. It was then that the present plaintiff came forward with the suit seeking an injunction against the user of the mark "Malikchand" by the defendants. To some extent it may be possible to conceive that the present suit by the plaintiff was a counter blast to the suit filed by the defendants in the High Court of Bombay, but at the same time, the point made by the High Court that the plaintiff probably was apprehensive of its mark being annihilated, had approached the trial court for relief based on its prior user of the mark. It was in this context that the High Court took the view that the application for interim injunction could not be rejected on the ground of delay and laches. We also feel, that we cannot completely brush aside the argument of counsel for the plaintiff, that the

case of delay and latches has not been properly projected on behalf of the defendants in their pleadings either in the trial court or in the appellate court, though no doubt that aspect has been projected seriously before us by learned counsel for the defendants and to some extent is covered by the pleadings in the written statement.

17. He further relied on the decision of the Honourable Apex Court reported in **2002(24) PTC 1 (Laxmikant V.Patel vs. Chetanbhat Shah & Anr.)**, to contend that the Court has to disallow the same name usage. paragraph No.12 reads as follows:

“12. In Oertli v. Bowman, (1957) RPC 388 (at page 397) the gist of passing off action was defined by stating that it was essential to the success of any claim to passing off based on the use of given mark or get-up that the plaintiff should be able to show that the disputed mark or get-up has become by user in the country distinctive of the plaintiff's goods so that the use in relation to any goods of the kind dealt in by the plaintiff of that mark or get up will be understood by the trade and the public in that country as meaning that the goods are the plaintiff's goods. It is in the nature of acquisition of a quasi-proprietary right to the exclusive use of the mark or get-up in relation to goods of that kind

because of the plaintiff having used or made it known that the mark or get-up has relation to his goods. Such right is invaded by anyone using the same or some deceptively similar mark, get-up or name in relation to goods not of plaintiff. The three elements of passing off action are the reputation of goods, possibility of deception and likelihood of damages to the plaintiff. In our opinion, the same principle, which applies to trade mark, is applicable to trade name.”

18. *PTC (Suppl.)(2) 680(Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories)*, a decision of the Honourable Supreme Court is also referred to by the learned counsel for the plaintiffs to contend that lengthy of user is a material factor. Paragraph No.15 of the said decision reads as follows:

“15. That, however, is not the position here. The learned District Judge has, on the basis of evidence recorded a finding that the mark or trade name “Navaratna Pharmaceutical Laboratories” had by user acquired distinctiveness in the sense of indicating the respondent and the respondent alone as the manufacturer of goods bearing that mark and that finding has been affirmed by the learned Judges

of the High Court. The learned District Judge has further held that the respondent has been using that mark or a permissible variant of that mark from long before the 25th February 1937, and that in consequence, notwithstanding that the mark might not satisfy the requirements of Section 6(1) as explained by sub-sections (2) & (3) of that section, still it was registrable as a trade Mark by virtue of the proviso to Section 6(3) of the act. We do not find any error in the approach of the learned District Judge to this question. In the first place, there was the intention on the part of the proprietor of the mark to indicate by its use the origin of the goods on which it was used. There was also indubitable evidence regarding the recognition of that mark as indicating origin on the part of that section of the public who buy these goods in the course of trade or for consumption. Thus, the finding was that by reputation the mark had come to denote the goods of the respondent. Besides, the words were not a merely laudatory expression in relation to the goods. But descriptive though as such they would prima facie not be distinctive. Length of user would, of course, be a material factor for the mark to become distinctive and the learned District Judge found that by such a long user the mark had become exclusively associated with the goods of the respondent in the

market.”

19. Learned counsel for the Plaintiffs also relied on the decision of the Honourable Supreme Court reported in **1997 (17) PTC 655 (Tube Investments of India Ltd. vs. Trade Industries, Rajasthan)**, in support of his contention that visual similarity between the applicants' trademark and the respondents' trademark is sufficient to grant injunction. Paragraph No.2 of the said decision reads as follows:

“2. The respondent is a small manufacturer. He set up his business in the year 1976 in Jodhpur and his sales for the year 1995-96 were amounting to Rs.12,50,717 and his expenditure on advertisements for that year was Rs.71,000. The respondent uses a mark TI in a circle in all his goods. The respondent manufactures saddle covers on which he uses this mark. An examination of the mark used by the respondent with the registered mark of the appellants shows that the mark used by the respondent is prima facie similar to the mark used by the appellants. In the respondent's mark also, 'T' is a capital. 'T' and 'I' is a capital 'I' and is shorter and placed below 'T'. The respondent contends that he uses only one circle around his mark instead of two concentric circles. However, this small difference does not make much impact on

the obvious similarity between the two marks. The visual similarity between the two marks coupled with the fact that the respondent's mark is used on bicycle saddle covers, prima facie, posed a real danger that the product of the respondent can be passed off as a product of the appellants. Use of the mark by the respondent on goods falling in Class 12 is, prima facie, violative of the appellants' rights in respect of their registered trade mark for goods in Class 12."

20. Learned counsel also relied on ***PTC (Suppl.)(1) 346 Parle Products (P) Ltd. vs. J.P. And Co., Mysore***), a decision of the Honourable Supreme Court, to contend as to how the assessment has to be made by the Court while considering these applications. In paragraph No.9, it has been observed as follows:

"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. In this case we find that the packets are practically of the same size, the colour scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can easily be mistaken for the other. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word “Glucose Biscuits” is one and “Glucose Biscuits” on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in our opinion who has a look at one of the packets today may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs' if shown to him some time after he had seen the plaintiffs. 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."

(emphasis supplied)

21. In this case, the plaintiffs have established a strong *prima facie* case in their favour by showing that they are in the trade using the trade mark for more than 50 years and are doing good business running to several crores every year. It is also seen that this trade mark of the plaintiffs is commonly known by the public all these years as that of the plaintiffs only. Therefore, all these factors would show that the plaintiffs have made out a *prima facie* case in their favour for grant of interim orders against the infringement. No doubt, in this case, the defendants claim that they are using the trade mark from 2009. At the same time, it is seen that the knowledge of the plaintiffs has commenced about the infringement only from 2014 and they filed the present suit immediately. Therefore, I am of the view that injunction should follow once this Court finds such *prima facie* case in favour of the plaintiffs and that there is no delay or laches on their part in approaching the Court, even though

the defendants are using the trade mark for quite some time. Even otherwise, once it is established that there is an infringement, the Court should protect the interest of the parties who is holding and using such registered trade mark much prior in point of time, that too, for long number of years.

22. Considering the above stated facts and circumstances and considering the above case laws relied on by the learned counsel appearing for the applicants, I am of the view that the applicants have made out a prima facie case for grant of interim injunction, I am also of the view that if no injunction is granted, it would certainly cause irreparable injury to the applicants as their registered trademarks are being used by the respondents which would be construed as though the respondents' trademark is that of the applicants. I also find that the balance of convenience in favour of the applicants, in view of the fact that immediately after knowing the infringement action of the respondents, they have come before this Court and filed the present suit with the interim applications as stated supra. Further, as the applications of the respondents were filed only in the year 2012 and 2013 and they themselves claim the usage of the said Trademark only from 2009, I am of the view that the persons having the usage much prior to them, namely the applicants, that too, from the year 1962, are entitled to be protected by way of interim orders. Accordingly, O.A.Nos.356 and 357 of 2014 are allowed.

Application No.2980 of 2014 is directed to be posted along with the main suit.

16.09.2015

Index:Yes

Internet:Yes

vsi

K.RAVICHANDRABAABU.,J.

vsi

Pre-delivery order made in
O.A.Nos.356 and 357 of 2014 and
Application No.2980 of 2014
in
C.S.Nos.299 of 2014

16.09.2015