

IN THE HIGH COURT OF DELHI AT NEW DELHI

IA No. 132 of 2005 in CS (OS) No. 19 of 2005

Reserved on: September 10, 2009

Decision on: September 24, 2009

P.P.JEWELLERS PVT. LTD. Plaintiff
Through Mr. S.K. Bansal, Advocate

versus

P.P.BUILDWELL PVT. LTD. Defendant
Through Mr. Shailen Bhatia, Advocate

and

IA No. 4048 of 2008 in CS (OS) No. 604 of 2008

P.P.JEWELLERS PVT LTD Plaintiff
Through Mr. S.K. Bansal, Advocate

versus

P.P.PRIME PROPERTIES & PROMOTERS
(P) LTD Defendant
Through Mr. Saket Sikri and
Mr. V.K.Rao, Advocates

CORAM:

HON'BLE DR. JUSTICE S. MURALIDHAR

1. Whether reporters of the local newspapers
be allowed to see the judgment? No
2. To be referred to the Reporter or not? Yes
3. Whether the judgment should be reported in the Digest? Yes

JUDGMENT

S. Muralidhar, J.

IA No. 132 of 2005 in CS (OS) No. 19/2005

IA No. 4048 of 2008 in CS (OS) No. 604/2008

1. These are applications under Order XXXIX Rules 1 and 2 CPC for

seeking interim injunction in the two suits filed by the same Plaintiff, P.P.

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Jewellers Private Limited ('PPJPL') to restrain the Defendant in each of the suits from using, offering for sale, advertising and in any manner dealing in any service using the Plaintiff's trade mark and house mark 'PP' or any other mark/name deceptively similar thereto which is likely to lead to passing off of the business and services offered by the Defendants as those of the Plaintiffs. Since both applications by the same Plaintiffs raise more or less similar questions, they are being disposed of by this common judgment.

2. In CS (OS) No. 19 of 2005 there are two Plaintiffs, i.e. PPJPL (Plaintiff No.1) and M/s. L.R. Builders Pvt. Ltd. (Plaintiff No.2). In CS (OS) No. 604 of 2008 PPJPL is the sole Plaintiff. In CS (OS) No. 19 of 2005 P.P. Buildwell Pvt. Ltd is the Defendant and in CS (OS) No. 604 of 2008, P.P. Prime Properties and Promoters (P) Limited is the Defendant.

3. In CS (OS) No. 19 of 2005 it is stated that Plaintiff No. 1 PPJPL is a well-known manufacturer of jewellery, precious metals, their alloys and precious stones etc. It is stated to be one of the largest jewellery export houses in India having won several export awards. It is further stated that the mark 'PP' has been coined by the predecessors in business of Plaintiff No.1 PPJPL in the year 1980 taking the initials from the names of the brothers Pawan and Padam. It is claimed that the marks 'PP', 'PP Jewellers' and 'PPJ' have been continuously and extensively used by the Plaintiff No.1 and its predecessors as well as sister concerns in the course of business as their house mark and trademark. It is stated that the trade mark 'PP' has come to

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be consistently and exclusively associated with the goods and business of the house of PP Jewellers.

4. It is stated that in the last decade, PP Jewellers has also diversified its business into other areas. The garment business of the group is carried on under the name and style of PP Design Estate. PPJPL diversified into the building, construction and real estate business under the flagship PP Towers promoted by L.R. Builders Pvt. Ltd, (L.R. Builders) Plaintiff No.2. which was incorporated in 1995 and has been involved in the construction of commercial complexes under the trade mark PP Towers. It is claimed that the Plaintiff No.1 is the overall controlling entity of Plaintiff No.2 and provides the funding for acquiring commercial plots from the Delhi Development Authority ('DDA'). In January 1998 LR Builders commenced construction of its commercial complex PP Towers, North Extension, in Pitampura, New Delhi. Thereafter it commenced construction of commercial complexes, one at Rohini and the two in Wazirpur under the name PP Towers and for which the logo PPT was used.

5. It is claimed that the marks PP, PP Jewellers, PPJ, PP Design Estate and PP Towers have come to be exclusively associated with Plaintiff No.1 and that the mark 'PP' has acquired a secondary meaning. The Plaintiff No.1 claims that it is the proprietor of the trademarks PP, PP Jewellers, PPJ by virtue of priority in adoption, long continuous and extensive use and advertising and the reputation consequently accruing thereto in the course of the business. On 30th September 1999 the Trade Marks Registry granted

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registration for the word mark 'PP Jewellers' and logo 'PPJ' in favour of the Plaintiff No.1. PPJPL has also applied for registration of the mark 'PP' under Class 37 relating to building construction on 27th August 2004. In the said application it has been indicated that "the mark is proposed to be used but it has been in use in Class 14 by the applicant since 1993 and by their predecessors-in-interest since 1980." The plaint sets out in paras 9 and 10 the details of the expenses on advertisement and turn over respectively of the Plaintiff No.1 from the years 1996-97 till 2004. The Plaintiffs also have registered domain names www.ppjewellers.org and www.pptowers.com.

6. The Defendant in CS (OS) No. 19 of 2005 M/s. P.P. Buildwell Pvt. Ltd ('PP Buildwell') is a company engaged in the business of constructing commercial complexes like shopping malls. It has its office at Rohini in Delhi. According to the Plaintiff, its attention was drawn to a clipping in the newspaper Navbharat Times dated 5th December 2004 in which the Defendant offered for sale commercial outlets at their proposed shopping mall being constructed at Sector 9, Rohini, Delhi. A perusal of the clipping inviting bookings for the 'North Ex Mall' shows a pictorial representation of a shopping mall in which the two towers display the letter 'P' on each of the front and side faces. It is stated that L.R. Builders started receiving letters from its clients and the public enquiring about the proposed mall. The letters by Sarwamangala Sarees and Atul Sarees both located located at Nai Sarak, Delhi and few other letters making such enquiries of the Plaintiff No.2 have been placed on record. It is claimed by the Plaintiffs that the use by PP

Buildwell of the word mark 'PP' for its shopping mall and as part of its

corporate name is likely to create confusion amongst the clients and customers of the Plaintiffs; it is not bonafide and is a misrepresentation as to the origin of the commercial complexes. It is further contended that in using the identical mark 'PP' for its malls, constructed in the same area in which the Plaintiff's commercial complexes have been constructed, PP Buildwell has exposed its dishonest and malafide intentions to encash the Plaintiff's formidable reputation and goodwill in the mark 'PP'. The loss and damage to the Plaintiff's reputation and the dishonest use would not be compensated adequately by damages. On the basis of the above averments, it is claimed that an injunction should be granted to restrain P.P. Buildwell from using the letters 'PP' either as part of corporate name or in offering any service in the form of space in commercial complexes and malls.

7. In the CS (OS) No. 604 of 2008 the averments of the sole Plaintiff PPJPL are more or less similar. It is submitted that the sole Defendant P.P. Prime Properties and Promoters Pvt. Ltd. ('PP Prime Properties') inserted an advertisement in Navbharat Times dated 26th January 2008 which showed that it was using the logo 'PP' in relation to its real estate business. It is submitted that the use of the mark 'PP' by PP Prime Properties has been incrementally dishonest as they initially started as real estate brokers under the style of M/s. PP Prime Properties and Promoters and thereafter incorporated themselves as PP Prime Properties and Promoters Pvt. Ltd. It is further submitted that the mark 'PP' adopted by PP Prime Properties is identical or deceptively similar to the letter mark PP of the Plaintiff. It is claimed that it constitutes an infringement of the registration granted to the

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Plaintiff for the letter mark 'PP' in Class 16 and amounts to passing off of PP Prime Properties as being affiliated to, associated with or endorsed by the Plaintiff and of the services offered by PP Prime Properties as that offered by PPJPL.

8. In the written statement in CS (OS) No. 19 of 2005 it is pointed out that the trade activities of PPJPL and the PP Buildwell are different in every aspect. The use of the letters PP in relation to jewellery did not confer any right on the Plaintiffs to claim exclusive right to use the mark 'PP' in respect of all descriptions of goods, businesses or services. It is pointed out that the PPJPL has been using the mark 'PP Jewellers' and not 'PP' standing alone. It is further claimed that the mark 'PP' is a combination of ordinary English alphabets which is not at all distinctive. The use of words 'PP' by PP Buildwell as part of its corporate name is not likely to be mistaken for PPJPL. The services offered by PP Buildwell by offering space in the PP Shopping Mall or PP Mall does not constitute passing off of the products and services offered by the Plaintiffs in any manner whatsoever. Also PP Buildwell is not using letters 'PP' separately but as part of a composite corporate name PP Buildwell Pvt. Ltd. Even the malls are named North Ex Mall & West Ex Mall and the single letter P is used on one side of the towers of North Ex Mall which are not even visually similar. When the marks are compared as a whole, the use by PP Buildwell of the mark PP Shopping Mall or PP Mall is neither likely to cause confusion nor is it deceptively similar to the trade mark or name of PPJPL. It is pointed out that

PP Buildwell has obtained registrations for the marks PP Mall (under CS (OS) Nos. 19/05 & 604/2008

No.1308302) and PP Shopping Mall (under No. 1308303) both in Class 37 effective 13th September 2004. It is submitted that inasmuch as PPJPL has itself in the application made by it in the Trade Marks Registry on 27th August 2004 indicated that it only “proposes to use” PP as a service mark for the services falling in Class 37, it is clear that neither PPJPL nor LR Builders is a prior user of the mark PP in respect of the business of real estate or construction.

9. It is stated by PP Buildwell that merely because PPJPL has made an investment in LR Builders through Mr. Pawan Gupta, it does not make LR Builders a “group company” of PPJPL. The interconnection between PPJPL and LR Builders has not been shown and therefore, PPJPL is not entitled to claim any protection for the mark PP Towers used by LR Builders in the business of real estate under its own trade/corporate name. Since the words ‘PP’ did not form part of the corporate name of LR Builders, the latter can have no objection to PP Buildwell using ‘PP’ as part of its corporate name. It is further pointed out that even in the commercial complexes LR Builders is using the word mark ‘PP Towers’ whereas PP Buildwell is using ‘PP’ as part of its corporate name. It is further pointed out that PP Buildwell was incorporated on 2nd August 2004 i.e. even before PPJPL applied for registration of the trademark ‘PP’ under Class 37, i.e., in the real estate business. The projects undertaken by PP Buildwell are under the trademarks ‘West End Mall’ and ‘North Ex Mall’, for the registration of which marks PP Buildwell has applied. It is submitted that there is therefore no occasion for deception or confusion.

10. In the written statement filed by PP Prime Properties the Defendant in CS (OS) No. 604 of 2008 it is submitted that the registration of the trade mark 'PP' in favour of the Plaintiff is in respect of Class 14 relating to jewellery whereas Class 37 relates to building construction and real estate. Therefore, there is no infringement of the trade mark of the Plaintiff by PP Prime Properties. It is stated that PP Prime Properties is a company incorporated under the Companies Act 1956 ('Act'). It is stated that the Plaintiff has throughout known of the existence of PP Prime Properties and therefore, on the principle of acquiescence, the Plaintiff should not been granted any injunction. It is further stated that the adoption of 'PP' as part of its corporate name by PP Prime Properties is bonafide and came from the initials of its two promoters 'Pankaj Sharma and Prince Dhingra'. It is stated that the corporate name is entitled to protection under Section 35 of the Trade Mark Act 1999 ('TM Act').

11. The submissions of Mr. S.K. Bansal, learned counsel for the Plaintiffs, Mr. Shailen Bhatia, learned counsel for PP Buildwell and Mr. Saket Sikri, learned counsel for PP Prime Properties have been heard.

12. This is essentially a passing off action by the Plaintiffs PPJPL and LR Builders claiming that the Defendants have by adopting the letter mark PP as part of their respective corporate names and for the services in the real estate and building industry passed off their services as that being offered by the Plaintiffs. The case is that the Defendants have adopted either an identical mark or a mark deceptively similar to the Plaintiffs' letter mark PP which is

the essential feature of its marks PP Jewellers and PP Towers and logos PPJ

and PPT. While PPJPL holds a registration for the marks PP Jewellers and PPJ in Class 14, its application for registration of the letter mark PP in Class 37 is yet to be granted. On the other hand PP Buildwell has registrations in respect of its marks PP Mall and PP Shopping Mall both in Class 37 relating to real estate and building construction.

13. The case of the Plaintiffs is that under Section 2 (m) TM Act 1999 a mark could include even a single letter. *McCarthy on Trademarks and Unfair Competition* states that “an individual or a group of letters, not forming a recognizable word, can function as a mark.” While it is true that an arbitrary arrangement of letters can constitute a distinctive mark, the question would be whether on the given facts of a case the letter mark in question is distinctive. This explains why while in some of the cases protection has been refused to letter marks, in some others it has been granted. The latter include *Tubes Investments of India Ltd. v. Trade Industries* (1997) 6 SCC 35, *Chemetron Corporation v. Morris Corporation v. Morris Coupling and Clamp Co* 203 USPQ 537, *B.K. Engineering Company v. U.B.H.I. Enterprises (Regd.) Ludhiana* 1985 PTC 1 (Del) (DB) and *Larsen & Toubro Ltd. v. Lachmi Narain Traders & Co.* 2008 (36) PTC 223 (Del). Some of these decisions will be discussed hereafter.

14. In the instant case, PPJPL and LR Builders claim that PP is a ‘house mark’ and has been used since 1980 for jewellery and in relation to real estate since 1998. This is what needs to be examined first. PPJPL applied for

and obtained registrations for the marks PP Jewellers and PPJ in Class 14. Those are the marks under which it conducts its jewellery business. PPJPL never used PP alone. Even for the real estate business the brochures of the commercial complexes of the Plaintiffs depict the usage of the mark 'PP' Towers and the logo PPT. Section 17 (1) of the TM Act states that “when a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to use of the **trade mark taken as a whole**.” This in effect incorporates the law explained by the Supreme Court in *Registrar of Trade Mark v. Ashok Chandra Rakhit Limited AIR 1955 SC 558* where the following observations of Lord Esher in *Pinto v. Badman 8 RPC 181* were quoted with approval: “The truth is that the label does not consist of each particular part of it, but consists of a combination of them all.”

15. The Plaintiff PPJPL has perhaps been aware that PP by itself has no distinctiveness even for the jewellery trade. PPJPL has used those letters in combination with the word “Jewellers” or the letter “J” to form the marks PP Jewellers and the logo PPJ. It used the same pattern for the real estate business when it adopted the marks PP Towers and logo PPT. Likewise, PP Buildwell cannot claim distinctiveness for the letters PP except when combined with the word “Mall” or “Shopping Mall” for which marks it holds registrations. The Plaintiffs contend that in a written statement of PP Buildwell dated 2nd August 2008 (which incidentally is not on record) it has been admitted in para 9 at page 17 that the mark PP can be appropriated as a trademark and service mark; that PP is a trade mark and service mark and that PP is an essential part of its impugned trademark. This court is unable to

agree with this submission. A perusal of para 9 of the written statement dated 4th August 2008 does not reflect any such admission. The statements therein are really a denial of the Plaintiffs' assertions in the corresponding para in the plaint. In any event, an implied admission by the Defendant in a written statement cannot lend distinctiveness to a mark which inherently lacks it.

16. The burden in the instant case for the Plaintiff to show that the letter mark PP is distinctive is indeed formidable. The counsel for the Plaintiff has correctly identified the parameters for testing the distinctiveness of a mark as extent and period of use, goodwill and association in the minds of consumers, investments on advertisements, recognition in trade circles and channels of distribution and the relevant class of customers. However, on the facts of the present case the Plaintiffs have not passed the first test which is to show that the letter mark PP is distinctive and they in fact adopted and used the mark PP per se for any of their products and services at any point in time. It is only thereafter that the other parameters come into play.

17. Letter marks which are a combination of alphabets do not admit of easy acceptance as distinctive marks. It is true that on account of long usage in a line of trade letter marks can attain a formidable reputation and considerable goodwill. That will depend on the facts of each case. While in ***Mahendra and Mahendra Paper Mills v. Mahindra and Mahindra Ltd. 2002 (24) PTC 121*** the Supreme Court enjoined a company running a paper mill from adopting the corporate name deceptively similar to Mahindra and Mahindra
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Ltd. which was in a different trade line, it was on account of the latter showing to the satisfaction of the court that the reputation and goodwill of its corporate and trade name was formidable enough to ward off deceptively similar (in that case essentially phonetic) corporate names. In ***Larsen & Toubro Ltd. v. Lachmi Narain Traders & Co.*** the mark LnT was held to be deceptively similar phonetically to L&T. That is however not the case here. The Plaintiff has not been able to prima facie show that it has built a reputation and goodwill around the letter mark PP per se either in relation to Class 14 goods or in any other class of goods and services. Its use of the letters has always been in combination with other descriptive words like “Jewellers” and “Towers” or the letters “J” and “T”.

18. A reference is made to the passage in pages 24-13 of **McCarthy on Trademarks** to urge that “the modern rule of law gives the trademark owner protection against the use of its mark on any product or service which would reasonably be thought by the buying public to come from the same source, or thought to be affiliated with, connected with, or sponsored by the trademark owner.” With reference to the Defendant PP Prime Properties it was urged that this was a case of an attempt by that Defendant at “injurious association” with the Plaintiff PPJPL. However, it should be remembered that the customer here is a person booking a commercial space in either a commercial complex or in a shopping mall, and in prominent commercial localities in New Delhi. In this context, the following observations of ***Kerly’s Law of Trade Marks and Trade Names*** by David Kitchen et al.(14th Edition, 2005, Sweet & Maxwell) pp. 589-590 are relevant:

“In passing off, **the persons to be considered in estimating**
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whether the resemblance between the marks in question is likely to deceive are all of those also are likely to become purchasers of the goods upon which the marks are used, provided that such persons use ordinary care and intelligence.

It may be, and time will tell, that these tests are not the same, and that the reference in *Lloyd* to a “reasonably well informed and reasonably observant and circumspect” average consumer will have the effect that a likelihood of confusion for the purposes of the 1994 Act will be harder to show than a likelihood of deception for the purposes of passing off, owing to **the different notional persons to be considered**. This would be unfortunate, and may seem unlikely given that the two areas in many other ways recognize similar considerations, for example the doctrine of imperfect recollection, and the notion of the “idea” of the mark. In *Reed Executive Ple v. Reed Business Information Limited* the Court of Appeal held that the tests are conceptually different but equivalent in practice.” (emphasis supplied)

19. The definition of a “well known trade mark” under Section 2 (zg) of the TM Act is also instructive. It means a mark “which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first mentioned goods or services.” Going by the above tests, the Plaintiffs have not been able to show prima facie that the letter mark ‘PP’ has been used by them as such to identify their goods and services or that because of such usage that letter mark has attained distinctiveness.

20. Then there are the Trade Mark Registry search reports which have been placed on record by the Defendants to show that an application for registration of the mark PP has been made by the Plaintiff in almost every

class of goods. There are numerous other applicants for the said letter mark. A search was also made in the office of the Registrar of Companies which showed that there are a large number of companies registered with the letters 'PP' and therefore, there is nothing distinctive about those letters. Even for the kind of services envisaged by Class 37 i.e. building and construction industry there are several companies with the letters 'PP' as part of their corporate name. While search reports in the Trade Marks Registry or in the Office of the ROC, do not by themselves prove use of the marks, they are relevant for determining whether the letter mark in question is distinctive or merely descriptive.

21. As the decisions in *Rheumaton Trademark* [1978] R.P.C. 406, *British Petroleum Company Limited v. European Petroleum Distributors Limited* [1968] R.P.C. 54, *Du Cross Trademark Application* [1913] RPC and *Polarama Trademark* [1977] R.P.C. 581 show, courts would be reluctant to accord distinctiveness to letter marks per se without anything more being shown. In *British Petroleum Company Limited v. European Petroleum Distributors Limited* 1968 RPC 54 the Court refused to grant any injunction against the European Petroleum Limited which was using the mark EP for its petrol outlets. It was held that the mark BP used by the Plaintiff British Petroleum Ltd. was non-distinctive. There was no likelihood of deception or misconception among consumers even if they were the same goods. Both were selling petrol and yet no injunction was granted. The court observed: "though an exceptionally careless motorist might make a mistake, there is no likelihood of deception or confusion on any scale worth considering."

22. Since counsel for the Plaintiffs placed considerable reliance on the decision in *B.K. Engineering Company v. U.B.H.I. Enterprises (Regd.) Ludhiana 1985 PTC 1 (Del) (DB)* it is discussed at some length hereafter. The Plaintiffs and the Defendants in the said case were both firms were engaged in the manufacture of cycle bells. The Plaintiffs started manufacturing bells as early as 1971. The Plaintiffs adopted 'B.K.' as their house mark. They manufactured cycle bells under the trade mark Crown and Venus. The house mark 'B.K.' was used, prominently and in a conspicuous manner, on the cartons as a circular logo device in the form: BK. On the stand of the bell and the carton the name of the manufacturer 'B.K. Engineering Co.' was stamped. The Defendants on the other hand were marketing cycle bells under the trade mark 'B.K. 81'. They commenced manufacturing in 1981. The mark 'B.K. 81' was embossed on the dome-shaped cover as well as on the push handle. "U.B.H.I. Enterprises Regd." was engraved on the dome-shaped cover along with words 'B.K.81'. On the stand of the bell and the carton their manufacturing name 'U.B.H.I.' appeared. The plea of the Plaintiff that the use by the Defendant of the mark 'B.K. 81' was deceptively similar to the house mark 'B.K.' of the Plaintiff and was bound to cause confusion and deception in the course of the trade was upheld. It was held that the mere fact that the Defendants were using '81' in addition to letters 'B.K.' to distinguish their product from the Plaintiffs' product, was merely 'garnishing', as the expression goes, merely altering the name by the addition of 81 and that even the altered name was likely to mislead.

23. As far as the case on hand is concerned, PPJPL has been using for its

jewellery trade the mark 'PP Jewellers' or 'PPJ' and not merely the letters PP. The brochure produced by the Plaintiff in respect of the commercial complex at Pitampura shows the use of the mark 'PP Towers' as a composite mark and the logo PPT. The word PP is not separately used even in the logo. The application forms issued by LR Builders for allotment of shops/office in PP Towers also reflects the same mark. Even the advertisements show that the mark was written as PP Towers and the logo as PPT. Therefore, what was being used by the Plaintiffs as far as the construction activities were concerned was the composite mark PP Towers. The Defendants on the other hand uses PP as part of their corporate names PP Buildwell and PP Prime Properties. PP Prime Properties have shown that they use their corporate name on the letter head by writing their full name as Prime Properties and Promoters Pvt. Limited and it is the only in the pentagonal shaped ring that the logo with the words 'PP' is used. Even this is presented very differently from the way PPJPL uses the logo PPJ or PPT. Also, PPJPL applied for registration of the mark 'PP' under Class 37 only on 27th August 2004 and it stated therein that it only "proposed to use" the mark even as of that date. It is stated by learned counsel for the Plaintiffs that since then PPJPL has filed an application for amending the date of user as from 1998. Nevertheless, the Plaintiffs have not shown that they used the letters PP per se from that date. Consequently it is not possible to agree with the contention of learned counsel for the Plaintiffs that 'PP' by itself is a distinctive letter mark and is entitled to protection against passing off.

24. Therefore it boils down to this. The comparison of the rival marks in

this case is between the Plaintiff's marks - PP Jewellers, PP Towers, the logos PPJ and PPT – and the Defendants marks – PP Buildwell, PP Mall, PP Shopping Mall and PP Prime Properties. To the question whether these marks on a comparison are deceptively or confusingly similar, the answer of this Court is prima facie in the negative. The observations in *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories AIR 1965 SC 980* to the effect that the defendant in a passing off action can escape liability if he can show that the matter added to the essential feature of the proprietor's mark would apply in the present case even if one were to accept that the letters 'PP' are an essential feature of the Plaintiff's mark. The added material in the form of "Buildwell" or "Mall" or "Shopping Mall" or "Prime Properties" are sufficient to distinguish the Defendants' marks from that of the Plaintiffs.

25. The profile of customers going in to purchase or book commercial spaces in malls has to be kept in mind while deciding whether there is likelihood of deception or confusion. In *Harrods Limited v. Harrodian School Limited [1996] R.P.C. 697* the question was whether the proposal by the Defendant to use the name "The Harrodian School" was with the deliberate intention of deceiving the public and trading on the reputation of Harrods' a world famous departmental store in London. The Court of Appeal thought not. Lord Justice Millet said (at page 718):

"I am also satisfied that, even if there is scope for some limited confusion to linger in the public mind, the plaintiffs have not discharged the heavy burden of establishing a real likelihood of more than minimal

damage to the plaintiffs' goodwill. I ask myself what would happen if the defendants' school were to go bankrupt or suffer a drug or sex scandal. The attendant publicity might temporarily tarnish Harrods' good name; but I cannot see any real danger that a material number of Harrods' customers would withdraw their custom. Anyone who was under the mistaken impression that Harrods was responsible for the school would surely say to myself: "They obviously have no idea how to run a school. I always thought they were foolish to try; a cobbler should stick to his last. But they run an excellent store. This won't stop me shopping there." Damage to goodwill is not confined to loss of custom, but damage to reputation without damage to goodwill is not sufficient to support an action for passing off."

The question of customers seeking commercial spaces in shopping malls named North ex Mall or West End Mall mistaking PP Buildwell or PP Prime Properties to be PPJPL or the spaces being offered there to be in PP Towers or by PPJPL is highly unlikely.

26. In view of the above discussion and conclusion, this Court does not consider it necessary to consider the other submissions including whether PPJPL and LR Builders are a single economic unit as claimed by them. Also, the question whether the registration in favour of PP Buildwell is liable to be cancelled on account of a misrepresentation by it as alleged by the Plaintiffs is not examined since that will be decided by the concerned authority before whom such an application is pending. As of today the registration in favor of PP Buildwell in respect of the marks PP Mall and PP

Shopping Mall subsists and is entitled to protection in terms of Section 28 read with Section 31 (1) of the TM Act. [see *P.M. Diesels Pvt. Ltd v. Thukral Mechanical Works AIR 1988 Delhi 282*]

27. Learned counsel for the Plaintiff referred to Section 29 (5) of the TM Act and submitted that although the said provision was relevant to infringement of a registered trade mark by use of such mark as part of a corporate name, the same principle should apply even in an action for passing off. This Court is unable to agree. The tests for ascertaining infringement are distinct from the tests for ascertaining passing off. This has been explained in *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories* (supra) in para 28. As far as the present case is concerned, this Court has to examine if any of the features of the Defendants' marks which are in addition to the letters 'PP' distinguish their marks and corporate name from that of the Plaintiffs. It appears prima facie to this Court that the use of the PP as part of the corporate name by either PP Buildwell Pvt. Limited or PP Prime Properties Pvt. Limited, or the marks PP Mall or PP Shopping Mall, does not amount to passing off of the Plaintiffs' mark 'PP Jewellers' or the logo 'PPJ' or the composite marks 'PP Towers' or the logo 'PPT'. This Court is also not, therefore, able to accept the submission of learned counsel for the Plaintiffs that use of the letters 'PP' by either PP Buildwell or PP Prime Properties is a case of injurious association with the Plaintiff and therefore, constitutes passing off.

28. For all the aforementioned reasons this Court does not find that the Plaintiffs have made out any prima facie for grant of an ad interim injunction

in their favour. However, the Defendants will maintain the accounts of volume of business conducted by each of them during the pendency of the suits and file half yearly statements in this Court.

29. It is clarified that this order is based on a prima facie view formed on the basis of the materials on record at this stage. It is not intended to influence the final opinion to be formed by the court at the conclusion of the trial on an independent assessment of the evidence.

30. Accordingly, both these applications are dismissed.

S. MURALIDHAR, J.

SEPTEMBER 24, 2009
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