

Vidya Amin

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
CIVIL APPELLATE JURISDICTION

**APPEAL FROM ORDER NO. 52 OF 2016
WITH
CIVIL APPLICATION NO. 63 OF 2016 IN A.O. NO. 52 OF 2016**

Zensar Technologies Ltd. ... Appellant
Vs.
Zensar Suppliers Pvt. Ltd. ... Respondent

Mr. Venkatesh Dhond a/w. Mr. Ramesh Gajria, Mr. Ameet Deshpande i/b.
Mr. R.K. Diwan & Co., Advocate for the appellant.
Mr. Abhijeet A. Desai a/w. Mr. Vrushali Maindad, Advocate for the
respondent.

CORAM: MRS.MRIDULA BHATKAR, J.
DATE: 22nd February, 2016.

P.C.:

Admit. The learned counsel for the respondent waives service. By consent, the Appeal is heard finally and decided at the stage of admission.

2. This Appeal from Order is directed against the order dated 5th August, 2015 passed by the learned District Judge, Pune in Regular Civil Suit No. 6 of 2014 thereby rejecting the Application Exhibit 5. The appellant/original plaintiff has filed the suit under Trade Mark Act of 1999 for permanent injunction and other reliefs. By way of interim relief, the Application under Order XXXIX Rules 1 and 2 of Code of Civil Procedure was preferred stating that the defendants or through their agents or representatives, be restrained from using the plaintiff's well-known

registered mark “Zensar” or any other mark deceptively similarly in respect of any goods or services, in the course of business. After hearing the said application on merit, the learned District Judge held that the defendant does not deal in the goods in respect of which the plaintiff is registered and no prima facie case is made out to show that the public in general is getting confused due to use of trade mark by the defendant and therefore, it refused to grant interim relief in favour of the plaintiff.

3. The appellant/original plaintiff is a company having registered office at Zensar Knowledge Park, Plot No. 4, MIDC, Kharadi, Off. Nagar Road, Pune and it is in the business of software services provider. The plaintiff company has registered its mark as “ZENSAR” and got its trade mark registered under all the classes except class nos. 11, 39 and 40 in the year 2000 as per the Fourth Schedule of Trade Mark Rules, 2002. The registration was renewed from time to time. However, in the month of January 2014, the plaintiff company came across the same trade mark used by the defendant, which is “Zensar Suppliers Pvt. Ltd”. Upon investigation through internet, the appellant found that the respondent/defendant is a private company incorporated on 29th August, 2008 and is selling its products and services under well-known registered trade mark 'Zensar'. As the plaintiff/appellant has registered trade mark 'Zensar' and defendant has

not registered its trade mark, the appellant/plaintiff filed a suit under the Trade Mark Act, 1999 for permanent injunction and other reliefs against the respondent/defendant.

4. The learned counsel for the appellant has submitted that the appellant has registration for trade mark for all the classes 1 to 42 except classes 39 and 40. The respondent company is incorporated in 2008, however, there is no delay in filing the suit in 2014 because the appellant/plaintiff had no knowledge about the use of trade mark "Zensar" by the defendant and there cannot be a case of acquiescence because the appellant/plaintiff had no knowledge about the same. He submitted that admittedly the appellant is in the business of software and not at all dealing with any goods as classified from 1 to 42 in the Fourth Schedule of the Trade mark Rules. However, once there is a registration, then whether the appellant/plaintiff dealing with goods or services as per the registration is immaterial and once it is noticed that defendant is selling the goods or services under the same trade mark, then it is a case of infringement. He submitted that 'Zensar' is not a descriptive name but it is inherently distinctive. He further submitted that the defendant has dishonest intention to use his registered trade mark. He submitted that the respondent/defendant has not registered his name under the Trade Mark

Act and therefore, there was no way for the appellant/plaintiff to know about such use of trade mark earlier. If the respondent/defendant would have taken search in the office of trade mark, then they would have come to know about the registration of trade mark “Zensar” by the appellant. He submitted that the adoption is basely dishonest and no explanation is given by the respondent/defendant as to how they adopted the name of Zensar. He submitted that this Appeal is directly under Section 29(5) of the Trade Marks Act, 1999 and he is not pressing this Appeal for passing off. In support of his submission, he relied on the following judgments:

- (i) Ruston and Hornby Ltd. vs. Zamindara Engineering Co., reported in AIR 1970 SC 1649 on the point of infringement.
- (ii) Power Control Appliances & Ors. vs. Sumeet Machines Pvt. Ltd. & Ors., reported in 1995 (15) PTC 165 (SC) on the point of acquiescence.
- (iii) Judgment of Division Bench of Bombay High Court in Bal Pharma Ltd. vs. Centaur Laboratories Pvt. Ltd. & Anr., reported in 2002 (24) PTC 226.

5. In reply, the learned counsel Mr. Desai for the respondent submitted that there is no registration under classes 39 and 40 by the appellant. The respondent is a supplier of the raw material of non-processed goods. The

appellant is not in the business of any goods or services wherein the respondent is dealing with. He argued that nothing is brought on record pointing out the conflicting interest of the respondent and the appellant. As the interest of the appellant is not jeopardized due to use of the word “Zensar” by the respondent, the order passed by the learned District Judge is correct and it is to be upheld. He further argued that the appellant has registered trade mark “Zensar”, however, he is seeking a blanket injunction on the goods and services under the classes mentioned in the Fourth schedule and trying to monopolize the business. He further submitted that the burden is on the appellant/plaintiff to prove its prima facie case however, no documents are produced by the appellant/plaintiff to show that there was conflicting business interest. He further submitted that it was necessary for the appellant/plaintiff to bring on record as to how the use of trade mark has affected on the public and they got confused between the goods and services of the appellant and respondent and the case is falling under the passing off or infringement. He heavily relied on the judgment of Single Judge of Bombay High Court in **Raymond Ltd. vs. Raymond Pharmaceuticals Private Ltd.** in Notice of Motion No. 661 of 2006 in Suit No. 437 of 2006 dated 15th February, 2007. The learned counsel argued that as per the ratio laid down in the said ruling, it is necessary for the appellant to show that the mark is identical with or

similar to the registered trade mark and its use is without due cause and takes unfair advantage of or is detrimental to the distinctive character or repute of the registered trade mark. The learned counsel also relied on the judgment of Division Bench of this Court thereby confirming the order passed by the Single Judge of this Court in the case of **Raymond Ltd. vs. Raymond Pharmaceuticals Pvt. Ltd. dated 13th July, 2010 in Appeal No. 438 of 2007 in Notice of Motion No. 661 of 2006 in Suit No. 437 of 2006**. He submitted that to prove the case under sub-sections 1 to 4 of Section 29, it is necessary for the appellant to show how the use of trade mark has led to public confusion and loss of business. No documentary evidence or even prima facie case is proved by the appellant for grant of interim relief. He submitted that the respondent is not dealing with the same goods in relation to which the trade mark of the appellant is registered. The interim relief is rightly rejected to the appellant. He further submitted that the appellant did not produce any documents to show that the appellant has registered the trade mark under the Fourth Schedule. They have not produced proper certificate to show the registration. Merely mentioning the Articles of Association is not a conclusive proof to show that there is infringement of trade mark. The learned counsel also submitted that the respondent is dealing with the business of lead or lead ingots and it has nothing to do with the business of

the appellant.

6. Perused the record and the order of the trial court. The definition of mark is defined under section 2(1)(m) of the Act which includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. In the present case, the word 'Zensar' is the name and hence it is covered under the definition of “mark” under section 2(1)(m) of the Act. The effect of registration are stated under Chapter IV of the Trade Marks Act, 1999. Once the trade mark is registered with the office. Some rights are conferred by registration and then there can be action for infringement against user of same unregistered trade mark. Section 29 states about the infringement of registered trade mark. As per the case of the appellant, they are claiming infringement under section 29(5) of the Act. Section 29(5) reads as follows:

“5. A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.”

7. The appellant has registered the name 'Zensar' for classes 1 to 42 except classes 39 and 40 in the Fourth Schedule. The appellant has prayed for interim relief. So at this stage, conclusive establishment of the fact is

not expected. The appellant/plaintiff has produced the certificates of registration under classes 9, 16 and 35 as specimen and claims that under other classes except classes 39 and 40, trade mark is registered. The relief is prayed specifically under infringement, i.e., under section 29(5) of Trade Marks Act. At this stage, it is not required for the appellant to show what is the effect of the use of the same or similar trade mark on the public at large. The registration gives protection to the trade mark against its use by any person for the goods and services of the classes in the Fourth Schedule. It is true that the appellant is entirely in the software business and is not in the business of goods and services, i.e., classes 1 to 42 except 39 and 40. It is immaterial whether the appellant is dealing with the same goods which the respondent is also manufacturing and dealing with. The appellant may not have any business in respect of goods for which he is registered.

8. In the case of **Ruston and Hornby Ltd.** (*supra*), the Hon'ble Supreme Court held that the words "Ruston" and "Rustam" are phonetically similar though there may be difference in their spelling and hence there is encroachment.

9. In the case of **Raymond Ltd. vs. Raymond Pharmaceuticals Private Ltd.** (*supra*), the learned Single Judge of the Bombay High Court has

rejected the injunction to the plaintiff for infringement. The plaintiff-Raymond Ltd. was in the business of textile piece goods and had obtained registration for the word “Raymond”. Defendant is a Raymond Pharmaceuticals Pvt. Ltd. and has nothing to do with the wearing apparels. It uses the word “Raymond” as part of their trade name and corporate name and not as a trade mark. The learned Single Judge held that the word “Raymond” is a common word which means “mighty protection” in the English language. The plaintiff Raymond Ltd. have not registered for pharmaceuticals products and have registered their trade mark only for textile and, therefore, the injunction was rightly rejected.

10. The word 'Zensar' is not a generic term. I did not find meaning of “Zensar” in Oxford dictionary. The learned counsel for the appellant has submitted that Zensar is a imaginary word, i.e., combination of Japanese word “Zen” and other alphabets. So, it is a special word, which is registered as a trade mark of the appellant company. The learned counsel for the respondent could not tell the meaning of word “Zensar”, as no explanation has come forward from the respondent for the use of this word. As the word “Zensar” is registered by the appellant, *prima facie* it is a case of infringement. Once it is registered, then the infringement follows and thus, the appellant has made out a *prima facie* case and balance of

convenience lies in appellant's favour.

11. In the present case, the appellant has demonstrated that they have registered their trade mark for the products in classes 1 to 42 and though today they are dealing only with software, they want to protect their name for these classes.

12. Thus, I am of the view that the order passed by the learned District Judge is illegal and hence set aside. The relief of interim injunction as prayed in prayer clause (a) in the plaint/application is granted in favour of the appellant. Appeal from Order is allowed.

13. In view of this, Civil Application does not survive and the same is accordingly disposed of.

(MRIDULA BHATKAR, J.)