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**IN THE HIGH COURT OF JUDICATURE AT BOMBAY  
ORDINARY ORIGINAL CIVIL JURISDICTION  
NOTICE OF MOTION NO. 644 OF 2016  
IN  
SUIT NO. 145 OF 2016**

|                |              |
|----------------|--------------|
| Jayshree Vasan | ...Plaintiff |
| <i>Versus</i>  |              |
| Vimla Shah     | ...Defendant |

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**Mr. Rashmin Khandekar, with Mrs. Bhagwati Trivedi, & Ms. Sana  
Khan, i/b Bhagwati & Co., for the Plaintiff.  
Ms. Kalpita Ghosh, i/b Intralegal, for the Defendant.**

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**CORAM: G.S. PATEL, J  
DATED: 19th October 2016**

**PC:-**

1. This order will dispose of the Plaintiff's Notice of Motion for injunction in a passing off action. The Plaintiff's mark is ***Violett***. She claims that the Defendant is passing off her mark by using a rival mark ***Violet***.
  
2. I will state straight away that I do not believe that there is any merit at all in the submission made by Ms. Ghosh for the Defendant that the two marks are visually, phonetically and structurally sufficiently distinct from each other. I do not think that this is at all true. The pronunciation of the two words is the same and the fact

that the Defendant uses a stylized label with a flower device over the letter “I” makes very little difference. Both marks are used in relation to ladies’ garments. The Plaintiff says that she uses her mark *Violett* for fashion wear, and this, the Defendant says is another point of distinction, for the Defendant uses her mark only for what is described as ladies’ intimate wear. Mr. Khandekar for the Plaintiff says that this makes no difference at all; for, as according to him, it is the Defendant’s own case on Affidavit that there is existing confusion between the two marks. Mr. Khandekar submits that this confusion speaks to the essence of an action in passing off.

3. The only question, therefore, according to him, is which of these two marks is prior in point of time, that is to say, which of the two marks shows prior user. Both marks are unregistered. Both parties have sought registration. The Plaintiff’s application is opposed by the Defendant. Both applications are pending.

4. Mr. Khandekar points out that there was a Partnership Deed dated 20th June 2007 between the Plaintiff and one Mr. Vishwanath Shetty.<sup>1</sup> In this, the two parties agreed to carry on the business in partnership in the name and style of M/s. V.J. Inc. They agreed to do so using the trade mark *Violett*. The business proposed was to deal in garments and clothing accessories. It is the Plaintiff’s case that it was she who conceived and adopted this mark in relation to this business.

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1. Plaintiff, Exhibit “A”, pp. 20–24.

5. Mr. Khandekar relies first on a set of four invoices,<sup>2</sup> all of August 2007 in the name of the partnership firm. These do not, however, refer to the mark at all. From October 2007, however, the Plaintiff has done business using this mark *Violett* and there are invoices showing this.<sup>3</sup> These invoices are all of October 2007. There is also the fact that the Plaintiff has a certified statement of sales from 2007-2008 for the goods under this mark. By 2013-2014, these sales were nearly Rs. 23.5 lakhs.<sup>4</sup>

6. Mr. Khandekar says that the Plaintiff had her shop premises at Chembur redesigned and invoices in the name of *Violett* were issued by the Interior Designer Firm, Ethique.<sup>5</sup> These invoices are dated 7th and 27th September 2007. I will straightaway deal with a dispute raised by the Defendant that the address on these invoices is shown as being above D'Mart, Kanjur Marg, an establishment that did not open till 9th December 2013.<sup>6</sup> The answer to this in Rejoinder is that the Plaintiff obtained this invoice on request only for the purposes of this Suit by which time D'Mart had been established.<sup>7</sup>

7. There is also annexed to the Plaintiff material in the form of advertising which shows that the mark *Violett* used by the Plaintiff

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2. Plaintiff, Exhibit "B", pp. 25-27.

3. Plaintiff, Exhibit "D", pp. 29-36.

4. Plaintiff, Exhibit "C", p. 28.

5. Plaintiff, Exhibits "E" and "F", pp. 37-38.

6. Notice of Motion Paper book, p. 636.

7. Notice of Motion Paper book, p. 653.

since November 2007.<sup>8</sup> There is additional material of this period as well.<sup>9</sup>

8. When the Plaintiff applied for registration in 2012,<sup>10</sup> this was opposed by the Defendant.<sup>11</sup> The grounds of opposition are interesting. Here, the Defendant admits having adopted the mark in November 2010, but while saying on the one hand that the Plaintiff's mark is not distinctive nor capable of registration, the Defendant admits that it is deceptively similar to the Defendant's own mark *Violet*. The Defendant claims that the Plaintiff's mark is identical with the Defendant's mark. Mr. Khandekar would have it that this ends any prospect the Defendant might have had of contending that the two marks are dissimilar. He points out that the Defendant does not, however, stop at that, for she goes on to say that the confusion is inevitable. The Plaintiff has also listed a large number of material well prior to October 2010 evidencing her use of her mark *Violett*.<sup>12</sup>

9. The Defendant filed an Affidavit in Reply with a very large two-volume compilation as also a Written Statement.

10. While the Defendant claims to be more popular and to have made several attempts to popularize her mark, she has stated in

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8. Plaintiff, Exhibit "G", pp. 39.

9. Plaintiff, Exhibit "I", pp. 48-49.

10. Plaintiff, Exhibits "J" and "K", pp. 50-51.

11. Plaintiff, Exhibit "L", pp. 52-56.

12. Notice of Motion Paper book, pp. 641-642.

paragraph 35 of her Affidavit in Reply<sup>13</sup> that in 2012 one of her patrons asked her whether she had opened a branch in Chembur. The Defendant's own outlet is at Ghatkopar. The Defendant assured her client that she has no franchise anywhere in Mumbai. Over time, other customers made the same enquiry and the Defendant says that she then realized "that there was another outlet using a deceptively similar name trying to usurp the said trade marks reputation and goodwill". The Defendant asked her son to visit the Plaintiff and to cease and desist.

11. This is confirmed in the Plaintiff's first cease and desist notice of 26th August 2015.<sup>14</sup> In this, the Plaintiff confirms that she had told the Defendant's son, when he asked the Plaintiff to stop using her own trade mark, that it was the Defendant who should stop. A formal cease and desist notice was actually sent to the Plaintiff by the Defendant on 3rd September 2015.<sup>15</sup> In this again, the Defendant says in paragraph 5 that confusion is being caused by the Plaintiff's use of her mark *Violett*.

12. I believe Mr. Khandekar's submission that the only test is of prior user and that once confusion is demonstrated, an injunction must follow is only partly accurate. This is, after all, an action in passing off; i.e., a tortious action in *deceit*. The essence of this must be, as the expression suggests, that knowing the Plaintiff's mark to be in existence, the Defendant adopted a rival, confusing mark; and that the attempt by the Defendant is to 'pass off' her goods as those

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13. Notice of Motion Paper book, *pp.* 14–15.

14. Plaintiff, Exhibit "Q", *p.* 104.

15. Plaintiff, Exhibit "R", *pp.* 105–106.

of the Plaintiff. As Denning LJ said in *Parker Knoll v Knoll International Limited*:<sup>16</sup>

“Secondly, ‘to deceive’ is one thing. To ‘cause confusion’ is another. The difference in this: When you deceive a man, you tell him a lie. You make a false representation to him and thereby cause him to believe a thing to be true which is false. You may not do it knowingly, or intentionally, but still you do it, and so you deceive him. But you may cause confusion without telling him a lie at all, and without making any false representation to him. You may indeed tell him the truth, the whole truth and nothing but the truth, but still you may cause confusion in his mind, not by any fault of yours, but because he has not the knowledge or ability to distinguish it from the other pieces of truth known to him or because he may not even take the trouble to do so.”

13. It is difficult to see how, from the materials before me, the Defendant could possibly be said to be ‘telling a lie’, even unintentionally. To say that a Plaintiff need not prove deceit is one thing. It is quite another thing to say that the element of deceit is wholly alien and unnecessary to a course of action in passing off. Confusion may result from a multitude of causes, not one of them deceitful. I cannot possibly overlook the fact that the confusion in this case was in reverse: there is material to show that persons mistook the *Plaintiff’s* goods for the Defendant’s, not *vice versa*. In fact, that is the whole of the evidence before me at this stage. It was

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16. [1962] RPC 265.

the Defendant who first asserted the rights to exclusivity and sent her son off to parley with the Plaintiff and to demand that she, the Plaintiff, cease use of her mark. There is no evidence that anyone took the Defendant's goods to be those of the Plaintiff, and that is the confusion that the Plaintiff must show. She does not. This, therefore, leaves only the question of prior use, and that is, therefore, the sole foundation of the Plaintiff's case. It is, in my view, an entirely unstable and unsure foundation for an injunction in passing off.

14. In any case, both parties use marks that sound very much like an ordinary word depicting a colour or a shade, one that is also the name of a flower, and used a female name. This use carries an attendant risk of close imitators.

15. I am not convinced that on these materials a sufficient *prima facie* case is made out for the grant of an injunction. The Notice of Motion is dismissed, with costs.

16. I must record my appreciation for the admirable restraint and compactness of arguments on both sides. Ms. Ghosh in particular had a very great material at hand but accurately focussed her attention to only the relevant portions of it.

**(G. S. PATEL, J.)**