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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 29.11.2017

CORAM

THE HON'BLE MR. JUSTICE M.DURAISWAMY

C.M.A.Nos.1462 & 1463 of 2017 &
C.M.P. Nos. 7777 & 14786 in C.M.A.No.1462 of 2017 &
C.M.P.Nos.7778 & 14787 in C.M.A.No.1463 of 2017

M/s.Thiruvalluvar Modern Rice Mill
(A partnership Firm)
Represented by its Managing Partner
D.Balasubramani
Tirupur Road
Kangayam - 638 701.

... Appellant in both C.M.As/
Respondent/Defendant

VS

R.R.Chidambarasamy

... Respondent in both C.M.As/
Petitioner/Plaintiff

Civil Miscellaneous Appeal No.1462 of 2017 is filed under Order 43 Rule 1 of CPC against the Order and decreetal order dated 25.04.2017 passed in I.A.No.118 of 2016 in O.S.No.97 of 2016 on the file of Principal District Judge, Tirupur.

Civil Miscellaneous Appeal No.1463 of 2017 is filed under Order 43 Rule 1 of CPC against the Order and decreetal order dated 25.04.2017 passed in I.A.No.119 of 2016 in O.S.No.97 of 2016 on the file of Principal District Judge, Tirupur.

For Appellant : Mr.P.H.Arvind Pandian, Senior Counsel
(in both Appeals) for Mr.Rajesh Ramanathan

For Respondent : Mr.R.Sathish Kumar
(in both Appeals)

COMMON JUDGMENT

Challenging the fair and final orders passed in I.A.Nos.118 and 119 of 2016 in O.S.No.97 of 2016 on the file of Principal District Court, Tirupur, the defendant has filed the above Civil Miscellaneous Appeals.

2. The plaintiff filed the suit in O.S.No.97 of 2016 for the following reliefs:-

(i) for permanent injunction restraining the defendant from in any manner infringing the appellant's registered trademark "VALLUVAR" by using the trademark of THIRUVALUVAR"/ "VALLUVAR" or any other mark identical or deceptively similar to the plaintiff's trademark "THIRUVALUVAR" in any other manner whatsoever in relation to the rice or rice related products;

(ii) for permanent injunction restraining the defendant in any manner passing off and/or enabling others to pass off the defendant's rice/rice products as and for the plaintiff's products by using, selling or offering to sell, distributing, displaying, printing, advertising their products bearing the trademark "THIRUVALUVAR" or any other mark identical or deceptively similar to the plaintiff's trademark "VALLUVAR" per se or with any prefix or suffix or in any other manner whatsoever;

(iii) to direct the defendant to surrender to the plaintiff for destruction of all products, labels, dyes, blocks, moulds screen prints, packing materials and other materials bearing the trademark "THIRUVALUVAR" identical or deceptively similar to plaintiff's trademark "VALLUVAR"; and

(iv) to direct the defendant to pay a sum of Rs.1,00,000/- for acts of infringement of plaintiff's trademark.

3. The brief case of the respondent/plaintiff is as follows:

(i) According to the plaintiff, he is the Proprietor of the Rice Mill running under the name and style of "Thirumurugan Modern Rice Mill" and also claims that he has been involved in manufacturing and marketing variety of rice, paddy etc., for more than 14 years. The plaintiff had registered his product in

the trademark name as "VALLUVAR" in the year 2003 in respect of rice in class 30. The plaintiff has filed the Certificate of Registration and legal proceedings order issued by the Trademarks Registry, Chennai. Therefore, the plaintiff claims his right under section 31 of Trade Mark Act, 1999. The plaintiff further stated that he has been using the trademark "VALLUVAR" along with the image of Poet "THIRUVALLUVAR" in all invoices, advertisements and pamphlets as per his trademark. The plaintiff gained enormous goodwill and reputation and that his sale is growing year by year.

(ii) The plaintiff contended that the defendant was using a similar brand name "THIRUVALLUVAR" for the same product in the market, which is identical trademark as used by the plaintiff for the same category of product, i.e. rice. The defendant under the same name "THIRUVALLUVAR" and with the same design of gunny bag used by the plaintiff was selling the product in the market. Further, the plaintiff contended that the defendants had imitated the registered trademark of the plaintiff with the mala fide intention to cut the profits of the plaintiff and that the trademark applied for by the defendant is different and not actually used by them and has further stated that the registration of trademark applied by the defendant is still pending for consideration.

(iii) The plaintiff contended that since the defendant is using the identical and deceptive trademark similar to the plaintiff's registered trademark, prima facie he has established his case and prayed for grant of interim injunction restraining the defendant from infringing the plaintiff's trademark and for passing off and/or enabling others to pass off the defendant's rice/rice products by using the trade mark "THIRUVALLUVAR" or any other mark identical or deceptively similar to the plaintiff's trademark "VALLUVAR" per se or with any prefix or suffix or in any manner whatsoever till the disposal of the suit.

4. The brief case of the defendants is as follows:-

(i) According to the defendant, the brand name of their firm is special TMR brand "THIRUVALLUVAR" and the gunny bags produced by the plaintiff are all fabricated. Further, the defendant has applied for the registration of trademark and the Trademarks Authority had advised them to use TM in their brand in the right corner. The defendant has stated that "THIRUVALLUVAR" is a common name and already the same is in public domain and various persons are using the image of "THIRUVALLUVAR" and hence, the defendant states that the plaintiff cannot restrain the defendant from using the image of "THIRUVALLUVAR".

(ii) According to the defendant, there is no infringement of trademark as alleged by the plaintiff and for grant of prohibitory mandatory injunction. In these circumstances, the defendant prayed for dismissal of the applications.

5. The Trial Court, after taking into consideration the case of both the parties, allowed both the applications and granted interim injunction as prayed for.

6. Aggrieved over the orders passed in the applications in I.A. Nos. 118 and 119 of 2016, the defendant has filed the above appeal.

7. Heard Mr.P.H.Arvind Pandian, learned Senior Counsel appearing for the appellant and Mr.R.Sathish Kumar, learned counsel appearing for the respondent.

8. Mr.P.H.Arvind Pandian learned Senior Counsel appearing for the appellant-defendant submitted that the Trial Court ought not have granted an order of injunction when the appellant had applied for the registration of the trademark and the Trademarks Authority had advised them to use TM in their brand name in the right corner. Further, the learned Senior Counsel submitted that "THIRUVALLUVAR" is a common name and already the same is in public domain. In these circumstances, the learned Senior Counsel submitted that the Trial Court erred in granting an order of interim injunction against the appellant. In support of his contentions, the learned Senior Counsel for the respondent-plaintiff relied upon the following judgments:

(i) AIR 1965 (1) SC 980 [Kaviraj Pandit Durga Dutt Sharma v. Naratna Pharmaceutical Laboratories] wherein, the Apex Court, in paragraph Nos. 28 and 29 held as follows:-

" 28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under s. 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned Counsel drew our attention was based upon dissimilarity of the packing in which the goods of the

two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in their colour and other features and their general get-up together with the circumstance that the name and address of the manufacture of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy in the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods (Vide s. 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of

the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be "in the course of trade,, the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide s. 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks-the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence p./65-5 a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff. The mark of the

respondent which he claims has been infringed by the appellant is the mark 'Navaratna Pharmaceutical Laboratories', and the mark of the appellant which the respondent claimed was a colourable imitation of that mark is 'Navaratna Pharmacy. Mr. Agarwala here again stressed the fact that the 'Navaratna' which constituted an essential part or feature of the Registered Trade Mark was a descriptive word in common use and that if the use of this word in the appellant's mark were disregarded, there would not be enough material left for holding that the appellant had used a trade mark which was deceptively similar to that of the respondent. But this proceeds, in our opinion, on ignoring that the appellant is not, as we have explained earlier, entitled to insist on a disclaimer, in regard to that word by the respondent. In these circumstances, the trade mark to be compared with that used by the appellant is the entire registered mark including the word 'Navaratna'. Even otherwise, as stated in a slightly different context: (1) "Where common marks are included in the trade marks to be compared or in one of them, the proper course is to look at the marks as wholes and not to disregard the parts which are common". "

(ii) 2011 (121 DRJ 536 [Bhole Baba Milk Food Industries v. Parul Food Specialties (P) Ltd] wherein, the High Court of Delhi, in paragraph Nos 14.2 to 14.6, held as follows:-

" 14.2 A reading of paragraphs 18 and 23 of the plaint seems to suggest that the plaintiff came to court being aggrieved by the fact that the word KRISHNA forms an essential part of the defendant's trade mark and had been given greater prominence as compared to the suffix "Parul" and "Lord" and, therefore, resulted in confusion qua the plaintiff's mark. Apart from the plaintiff's grievance vis-à-vis the packaging, which in my opinion stands satisfied, the plaintiff has not set up the case of a monopolistic right to use the word KRISHNA; at least the same has not been said in so many words. But I will assume for the moment that, this is what the plaintiff intends to say in the plaint for the purposes of decision of the captioned applications.

14.3 In regard to the above, one may only notice that the plaintiff is not the only person in the business of manufacturing. A voluminous set of documents have been filed by the defendant in this

regard to show several such registrations under class 29; some of them precede the period of registration of the plaintiff, while the others succeed the date. To cite examples: KRISHNA mark in class 29 appears to have been registered vide registration No. 622772 in the name of one Subhrangshu Kumar Ghosh for ghee, butter and dairy products, the user date is given as 01.09.1989; Krishna brand label has been registered vide registration no. 82986, in favour of A.N.A. Alagirisamy Naidu Bros. in respect of ghee, the user date is 01.01.1936; Krishna ghee label has been registered vide registration no. 584939, in favour of one Gobinda Chakraborty, the user date is given as 01.10.1992. The registration seems to be restricted to sales in West Bengal and Orissa. I have deliberately not taken examples of certain registrations made post 1993 because the plaintiff claims users since 1993, but there are several registrations of the word mark KRISHNA or Krishna Label Mark even thereafter. The claim of the defendant that there is ubiquitous use of the word mark KRISHNA appears to be prima facie correct, at least at this stage.

14.4 I must here point to an argument raised by Mr Vidhani that the mere presence of such marks on the register of the Trade Mark Registry would not deprive an owner of its rights, such as the plaintiff to seek protection of the court in the event of an infringement by a competitor. In other words, Mr Vidhani sought to suggest that most of the registrations referred to by the defendant were lying dormant. In my opinion, one cannot quibble with this proposition. The use of the trade mark is important for an owner to claim rights in it. The only difficulty is, that at this stage, for me to accept the plaintiff's contention that these marks which are identical to the plaintiff's mark and which precede the date of user claimed by the plaintiff are lying dormant, without any evidence on record, would result in putting the cart before the horse. The point remains that both prior to 1993, and thereafter, there have been several manufacturers of identical goods which have, it appears been using the word mark or label mark KRISHNA. The plaintiff's claim to monopoly does not at this stage appear to be quite accurate, notwithstanding its zealous prosecution of cases against offenders, to which reference has been made in the plaint. In this regard the plaintiff had referred to the judgment of this court in the case of

DCM Sriram (supra). The DCM Sriram (supra) case is distinguishable. Briefly the facts obtaining in the case were as follows: The plaintiff, who was the respondent before the Division Bench was a registered proprietor of the trademarks "Shriram" and "Shriram Nirman". The appellant i.e., the defendant in the suit was in the business of manufacturing and selling Plaster of Paris under the name and style of "Aggarwal Shriram". The Division Bench examined the case only with respect to passing off. The plaintiff/respondent which was a Shriram Group Company had evidently adopted "Shriram" as its trademark as it was the name of its founder promoter late Lala Shriram. The plaintiff/respondent had been using the mark "Shriram" for a considerable period of time. The appellant/defendant had in defence averred that the trademark Shriram was adopted by him as one Bajrang Lal Pareek who was connected with the appellant/defendant was an ardent devotee of lord Shriram. The Court came to the conclusion that the defence taken was dishonest. In the instant case, as discussed by me above, the facts are quite different. The plaintiff in the instant case has adopted a common name which is unconnected to the plaintiff. The plaintiff has not been able to establish, at this stage, that the name has acquired secondary distinctiveness. Notwithstanding the fact that the plaintiff has adverted to the fact that its gross sales turnover between 1997-98 and 2007-08 jumped by leaps and bounds, it cannot be said at this stage that the mark has attained a reputation which brings to mind the plaintiff's product on a mere invocation of the word KRISHNA. In my opinion, the sales alone does not necessarily transcend in the mark attaining a secondary distinctiveness of a degree which ought to give the owner of a common name, in this case, a deity's name a right to monopolise its use to the exclusion of all others.

14.5 What would have to be addressed at the final stage, in this case, would be whether the mark has achieved secondary distinctiveness of the kind which brings to mind immediately the plaintiff's product. In order to come to a conclusion whether or not the mark has achieved a distinctiveness of such distinction evidence would have to be placed on record bearing in mind, amongst others, the following: (a) does the mark remind the consumer of the trade and origin. In other words does the trade origin get related to the propounder of the mark and

none other; (b) has the mark required sufficient distinctive character that the mark has become a trade mark. The use of the mark does not automatically translate into distinctiveness. [See Rich Products Corporation and Anr. vs Indo Nippon Food Ltd. 2010 (42) PTC 660 (Del)]. In this regard an argument was raised by Mr Vidhani that Rich Products case related to a descriptive mark whereas the present case deals with a common name. In my opinion, the test of secondary distinctiveness can be no different for a common name than that which is enunciated for a descriptive mark. Applying the same test, in my view, at this juncture, I cannot come to the conclusion that a name as common as KRISHNA; which in the cultural context of our country is as common as the word „John" used in West, has achieved in the plaintiff's case a secondary distinctiveness of the kind that it is inalienably related by the consumers to the plaintiff's product.

14.6 The defendant, of course, would have to show that the usage of the mark by it, of the word KRISHNA is bonafide and honest. The defendant's stand appears to be that the name KRISHNA is commonly used in the milk products industries; and thus it was included in its trade name with a specific intent to carve out a distinct identity by prefixing it with the word "Parul's" and "Lord". The defendant appears to indicate to the consumers very categorically that the origin of the goods is Parul, by using the word Parul's in its trade mark Parul's Lord Krishna. Prima facie there is nothing to show that the usage of the impugned mark is dishonest or lacks any bonafide. The case law cited by Mr Vidhani on this aspect of the matter is in my view, distinguishable on facts. In this regard I may only note that while the plaintiff has given the gross turnover, the requisite documents in the form of profit and loss accounts and balance sheets have not been filed. There is also no affidavits of consumers on record which would demonstrate, what was contended before me very vehemently, which is that, the word KRISHNA brings immediately to mind the plaintiff's product. Therefore, at this stage one cannot come to the conclusion that the trade mark KRISHNA has achieved the requisite distinctiveness which relates the origin of the product to the plaintiff. "

(iii) 2011 SCC online De 4422 [Bhole Baba Milk Food Industries v. Parul Food Specialties Pvt. Ltd. wherein, the Apex Court, in paragraph Nos. 12, 18 and 19, held as follows:-

" 12. We are in agreement with the view taken by the learned Single Judge not only for the reasons given by the learned Single Judge but the additional reason, as in the instant case, a deity may be associated with a particular kind of goods. It is common knowledge that Lord Krishna, as a child, was known for his love of milk and butter and thus Lord Krishna is closely linked with milk and butter and this would certainly dilute a proprietary claim projected by any person, in relation to Krishna with dairy products.

18. Since the stage is of forming a prima facie view, we refrain from delving deep into the matter as evidence has yet to be led, but would simply highlight that the registration obtained by the appellant is not per-se to the word "KRISHNA" but is to the word "KRISHNA" written in a distinctive form : akin to a label. The distinctiveness in which the word "KRISHNA" is written by the appellant is as noted by us in para 2 above.

19. The distinctiveness to which the appellant can lay a claim is to what it has got registered as a whole and such registration cannot possibly give an exclusive statutory right to the appellant qua a particular word of common origin. The ratio of law in the decision reported as AIR 1955 SC 558 The Registrar of Trade Marks vs. Ashok Chandra Rakhit Ltd. is squarely attracted.

9. Countering the submission made by the learned Senior Counsel appearing for the appellant, Mr.R.Sathish Kumar, learned counsel appearing for the respondent submitted that since the appellant is using "THIRUVALLUVAR" as his brand name, which is similar to the respondent's trademark "VALLUVAR", the Trial Court had rightly granted an order of interim injunction in their favour. Further, the learned counsel submitted that the brand name "VALLUVAR" and "THIRUVALLUVAR" are deceptively similar and identical, hence, the grant of interim injunction by the Trial Court is just and proper. In support of his contentions, the learned counsel for the respondent-plaintiff relied upon the following judgments: -

(i) AIR 1960(1) SC 142 [Corn Products Refining Co. v. Shangrila Food Products Ltd.] wherein, the Apex Court, in paragraph No. 15, held as follows:-

" 15. The series of marks containing the common element or elements therefore only assist the applicant when those marks are in extensive use in the market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now in the present case the applicant, the respondent before us, led no evidence as to the user of marks with the common element. What had happened was that Deputy Registrar looked into his register and found there a large number of marks which had either 'Gluco' or 'Vita' as prefix or suffix in it. Now of course the presence of a mark in the register does not prove its user all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register. If any authority on this question is considered necessary, reference may be made to Kerly p. 507 and Willesden Varnish Co. Ltd. v. Young & Marten Ltd. [39 R.P.C. 285 p. 289]. It also appears that the appellant itself stated in one of the affidavits used on its behalf that there were biscuits in the market bearing the marks 'Glucose Biscuits', 'Gluco biscuits' and 'Glucoa Lactine biscuits'. But these marks do not help the respondent in the present case. They are ordinary dictionary words in which no one has any right. They are really not marks with a common element or elements. We, therefore, think that the learned appellate Judges were in error in deciding in favour of the respondent basing themselves on the series marks, having 'Gluco' or 'Vita' as a prefix or a suffix.

(ii) AIR 2001 SC 1952 [Cardia Health Care Ltd. v. Cadila Pharmaceuticals Ltd.] wherein, the Apex Court, in paragraph Nos. 18, 19 and 20, held as follows:-

" 18. We are unable to agree with the aforesaid observations in Dyechems case (supra). As far as this Court is concerned, the decisions in the last four decades have clearly laid down that what has to be seen in the case of a passing off action is the similarity between the competing marks and to determine whether there is likelihood of deception or causing confusion. This is evident from the decisions of this Court in the cases of National Sewing Thread Co. Ltd.s case (supra), Corn Products Refining Companys case (supra), Amritdhara Pharmacys case (supra), Durga Dutt Sharmas case (supra), Hoffmann-La Roche & Co. Ltd.s case (supra). Having come to the

conclusion, in our opinion incorrectly, that the difference in essential features is relevant, this Court in Dyechems case (supra) sought to examine the difference in the two marks Piknic and Picnic. It applied three tests, they being 1) is there any special aspect of the common feature which has been copied ? 2) mode in which the parts are put together differently i.e. whether dissimilarity of the part or parts is enough to make the whole thing dissimilar and 3) whether when there are common elements, should one not pay more regard to the parts which are not common, while at the same time not disregarding the common parts ?. In examining the marks, keeping the aforesaid three tests in mind, it came to the conclusion, seeing the manner in which the two words were written and the peculiarity of the script and concluded that the above three dissimilarities have to be given more importance than the phonetic similarity or the similarity in the use of the word PICNIC for PIKNIK.

19. With respect, we are unable to agree that the principle of phonetic similarity has to be jettisoned when the manner in which the competing words are written is different and the conclusion so arrived at is clearly contrary to the binding precedent of this Court in Amritdharas case (supra) where the phonetic similarity was applied by judging the two competing marks. Similarly, in Durga Dutt Sharmas case (supra), it was observed that in an action for infringement, the plaintiff must, no doubt, make out that the use of the defendants mark is likely to deceive, but where the similarity between the plaintiffs and the defendants mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiffs rights are violated.

20. Lastly, in Dyechems case (2000 AIR SCW 2172 : AIR 2000 SC 2114 : 2000 CLC 1338 (supra)), it was observed in para 54 (of SCC) (para 53 of AIR SCW, AIR CLC) as under:

" As to scope of a buyer being deceived, in a passing-off action, the following principles have to be borne in mind. Lord Romer, L.J. has said in Payton & Co. Vs. Snelling, Lampard & Co. (1900) 17 RPC 48 that it is a misconception to refer to the confusion that can be created upon an ignorant

customer that the courts ought to think of in these cases is the customer who knows the distinguishing characteristics of the plaintiffs goods, those characteristics which distinguish his goods from other goods in the market so far as relates to general characteristics. If he does not know that, he is not a customer whose views can properly be regarded by the Court. (See the cases quoted in N.S. Thread & Co. Vs. Chadwick & Bros. AIR 1948 Mad 481 which was a passing-off action.) In Schweppes Case (1905) 22 RPC 601 (HL) Lord Halsbury said, if a person is so careless that he does not look and does not treat the label fairly but takes the bottle without sufficient consideration and without reading what is written very plainly indeed up the face of the label, you cannot say he is deceived."

These observations appear to us to be contrary to the decision of this Court in Amritdharas case (supra) where it was observed that the products will be purchased by both villagers and townfolk, literate as well as illiterate and the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. A trade may relate to goods largely sold to illiterate or badly educated persons. The purchaser in India cannot be equated with a purchaser of goods in England. While we agree that in trade mark matters, it is necessary to go into the question of comparable strength, the decision on merits in Dyechems case (supra) does not, in our opinion, lay down correct law and we hold accordingly.

(iii) 1999 (19) PTC 81 [Automatic Electric Ltd. v. R.K.Dhawan and another] wherein, the High Court of Delhi held that a person claiming exclusive right over an expression cannot change same expression as generic.

10. On a careful consideration of the materials available on record, submissions made by the learned counsel on either side and also taking into consideration the judgments relied upon by the learned counsel on either side, it could be seen that the plaintiff had filed the suit for the following reliefs:

(a) a permanent injunction restraining the defendant, by itself, its partners, men, servants, agents, representatives or any one claiming through them from in any manner

infringing the plaintiff's registered trademark "VALLUVAR" by using the trademark of THIRUVALLUVAR"/"VALLUVAR" or any other mark identical or deceptively similar to the plaintiff's trademark "THIRUVALLUVAR" in any other manner whatsoever in relation to the rice or rice related products;

(b) a permanent injunction restraining the defendant, by itself, its partners, men, servants, agents, representatives or any one claiming through them from in any manner passing off and/or enabling others to pass off the defendant's rice/rice products as and for the plaintiff's products by using, selling or offering to sell, distributing, displaying, printing, advertising their products bearing the trademark "THIRUVALLUVAR" or any other mark identical or deceptively similar to the plaintiff's trademark "VALLUVAR" per se or with any prefix or suffix or in any other manner whatsoever;

(c) the defendant be ordered to surrender to plaintiff for destruction of all products, labels, dyes, blocks, moulds screen prints, packing materials and other materials bearing the trademark "THIRUVALLUVAR" identical or deceptively similar to plaintiff's trademark "VALLUVAR";

(d) the defendant be ordered and decreed to pay to the plaintiff's a sum of Rs.1,00,000/- for acts of infringement of plaintiff's trademark and pass off their goods as that of the plaintiff;

(e) for costs of the suit.

11. In the said suit, the plaintiff took out two applications in I.A.Nos.118 and 119 of 2016 under Order 39 Rule (1) and (2) to grant an order of interim injunction restraining the defendant from infringing plaintiff's trademark "VALLUVAR" by using the trademark "THIRUVALLUVAR" or any other mark identical or deceptively similar to the plaintiff's trade mark "VALLUVAR" and for restraining the defendant from passing off and/or enabling others to pass off the defendant's rice/rice products and for the plaintiff's products by using, selling or offering to sell, distributing, displaying, printing, advertising their products bearing the trademark "THIRUVALLUVAR" or any other mark identical or deceptively similar to the plaintiff's trademark "VALLUVAR" per

se or with any prefix or suffix or in any manner whatsoever till the disposal of the suit.

12. It is not in dispute that the respondent-plaintiff is manufacturing and marketing variety of rice, paddy etc. and has registered his product in the trade mark name as "VALLUVAR" in the year 2003 under the Registration No.1220037 in respect of rice as class 30. The respondent claims his right under section 31 of the Trade Mark Act, 1999. Further, the respondent contended that he has been continuous user of the trade mark "VALLUVAR" along with the image of Poet "THIRUVALLUVAR" in all invoices, advertisements and pamphlets as per his trademark. The respondent-plaintiff further contended that appellant-defendant was using the trademark for the same product under the similar brand name "THIRUVALLUVAR", which is identical trademark as used by the respondent for the same category of product, viz., rice. The respondent also contended that the appellant is using the same identical name "THIRUVALLUVAR" and with the same design of gunny bags similar to that are used by the respondent for selling the product.

13. The Trial Court observed that appearance of the rice bag being used by the appellant-defendant seems to be identical and deceptive to that of the respondent-plaintiff and the image of "THIRUVALLUVAR" seems to be deceptive and the colour of gunny bags also identical, hence, granted an order of interim injunction in favour of the respondent-plaintiff.

14. The contention of the appellant that "THIRUVALLUVAR" is a generic name and the image of "THIRUVALLUVAR" is also common and therefore, there is no infringement or passing off. The Trial Court while granting an order of interim injunction has also observed that the merits of the matter can be decided only after the full-fledged trial.

15. In the present case, the name "VALLUVAR" is associated only with the Saint Poet of Tamil and is revered by the Tamil Diaspora in that capacity. Hence, the name of the Saint Poet is part of the Tamil culture and is common to all members of the Tamil Diaspora. Therefore, no one can claim monopoly or exclusivity over the name "VALLUVAR" or "THIRUVALLUVAR". In the case of passing off, the appellant may escape liability if he can show that added matter is sufficient to distinguish his goods from those of the respondent. The given action is not an action for infringement but only merits the consideration as in a passing off action. There are differences between the two labels used by the appellant and the respondent.

16. So far as the Registration of Trademark is concerned, it is only a prima facie evidence of its validity, which is a rebuttable presumption. In the typed set of papers, the

appellant has also produced several traders using the word "THIRUVALUVAR"/ "VALLUVAR" in respect of identical goods, viz., rice. It is also brought to the notice of this court that a third party trader had already registered the trademark "THIRUVALUVAR", which was not considered by the Trial Court.

17. So far as the similarity between the two gunny bags is concerned, the respondent does not have any exclusive right in respect of the entire gunny bags and the information contained thereto but allegedly only in respect of the device mark containing the word "VALLUVAR" brand in Tamil and the image of the Saint Poet within a circular device. The mark as registered is not being used by the respondent and the mark contained in the gunny bag is not in any manner similar to that of the appellant. When the marks are not identical, the differences between them play a vital role in coming to a conclusion respect of deceptive similarity. The grant of interim injunction by the Trial Court are not based on the prima facie case, balance of convenience and irreparable injury, which requires consideration into the facts and circumstances surrounding the case. The respondent had adopted a name which is common to all and is especially dear to the people part of the Tamil culture. The appellant contended that the gunny bags manufactured by them are completely different from that of the respondent.

18. In these circumstances, the judgments relied upon by the learned Senior Counsel appearing for the appellant squarely applies to the facts and circumstances of the present case. Since the facts and circumstances of the case on hand is different, the judgment relied upon by the learned counsel for the respondent are not applicable.

19. In these circumstances, I am of the view that the Trial Court should not have granted interim orders in both the applications. That apart, the Trial Court had allowed both the applications on 25.04.2017 whereas, this Court in C.M.P. Nos. 7777 and 7778 of 2017, filed in both the appeals, suspended the interim orders granted by the Trial Court in I.A.Nos.118 and 119 of 2016 until further orders on 28.04.2017 itself. Therefore, it is evident that the interim orders were in force in favour of the respondent only for a short time.

20. For the reasons stated above, the fair and decreetal orders passed in I.A.Nos. 118 and 119 of 2017 are set aside. The applications in I.A.Nos. 118 and 119 of 2017 are dismissed. Both the Civil Miscellaneous Appeals are allowed. The Principal District Judge, Tirupur is directed to dispose of the suit in O.S.No.97 of 2016, on merits and in accordance with law, without being influenced by any of the observations made in

this judgment, within a period of six months, from the date of receipt of a copy of this judgment. No costs. Consequently, connected miscellaneous petitions are closed.

Sd/-
Assistant Registrar(CCC)

//True Copy//

Sub Assistant Registrar

Rj

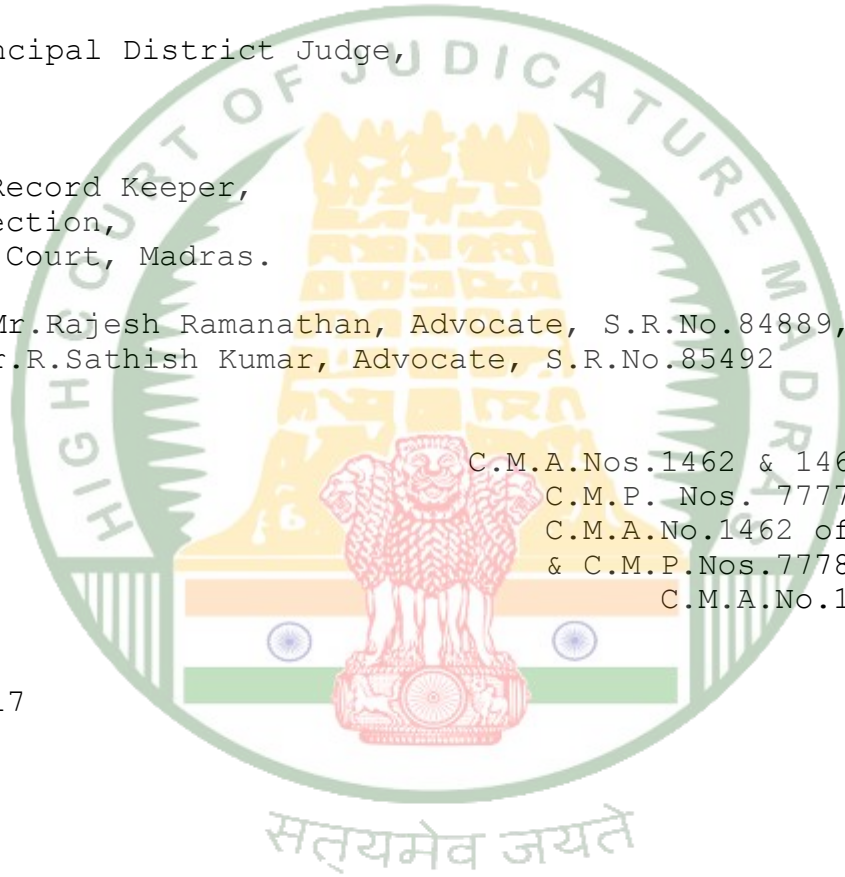
The Principal District Judge,
Tirupur.

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C.M.A.Nos.1462 & 1463 of 2017 &
C.M.P. Nos. 7777 & 14786 in
C.M.A.No.1462 of 2017
& C.M.P.Nos.7778 & 14787 in
C.M.A.No.1463 of 2017

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