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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

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Judgment delivered on: 05.01.2018

+ RFA 796/2005 & CM APPL. 16272/2005, CM APPL. 3162/2007

ORIENTAL LONGMAN LTD.

..... Appellant

Through: Mr. Pravin Anand, Mr. Raunaq
Kamath and Ms. Prakriti Sharma,
Advocates.

versus

GULMOHAR PRESS P. LTD.

..... Respondent

Through: None.

CORAM:

HON'BLE MR. JUSTICE NAJMI WAZIRI

NAJMI WAZIRI, J (Oral)

1. This appeal seeks setting aside of the impugned order dated 16.07.2005 dismissing the appellant's suit (No. 150/03) seeking permanent injunction against the respondent/ defendant restraining it from infringement of its registered trademark "GUL MOHAR", passing off, rendition of accounts of profits, delivery up etc. The appellant is a publisher of books and had claimed that it has published a series of books under the Gulmohar series which is widely sold to and used by school children. It has shown a sales turnover of Rs. 56,89,000/- in the year 1983-84 which has grown in successive years to Rs. 4,91,42,000/- till 1991-92. The appellant has claimed to have spent large sums of money on publicity of the books published under the "GULMOHAR" series. Additionally, it claims that the "GULMOHAR"

brand/trademark has attained valuable goodwill over the years, ever since it came into the public domain. According to the appellant, the amount expended towards publicity started from Rs. 87,000/- in 1983-84 and increased progressively to Rs. 12,50,000/- in 1992-93. This trademark “GUL MOHAR” was registered on 13.05.1986 bearing no. 453981 in Class 16 for *inter alia* printed matter, newspapers and periodicals, books, etc. and the same having been registered under Part A of the Register of Trade Marks is valid under the provisions of section 32 of the Trade & Merchandise Marks Act, 1958. According to the appellant, their trademark was more than seven years old, had been renewed, therefore, it had acquired conclusive validity.

2. The defendant under the name and style of “GulMohur Press Pvt. Ltd.”, situated at 101-4, Kaushalya Park, Hauz Khas, New Delhi used the word “GULMOHUR” as part of its trade name. It published a book titled ‘Mother Teresa’ authored by Navin Chawla. It is the appellant’s case that the defendant’s use of the word “GULMOHUR” infringed their registered trade mark “GULMOHAR”; and the aforesaid publication could easily be passed off as a book having been published by the appellant. A permanent injunction against the respondent was sought from using the appellant’s trademark “GULMOHAR”. Their suit was dismissed on the ground that respondent/defendant had no intention to deceive. However, this conclusion is untenable because the law does not require an intention to deceive. All that needs to be considered is whether an ordinary unsuspecting person could be deceived.

3. Mr. Pravin Anand, the learned counsel for the appellant, refers to the judgment of the Hon’ble Supreme Court in **Laxmikant V. Patel v.**

Chetanbhai Shah (2002) 3 SCC 65 which held: -

“13. In an action for passing off it is usual, rather essential, to seek an injunction temporary or ad-interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. The plaintiff must prove a prima facie case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction. According to Kerly (ibid, para 16.16) passing off cases are often cases of deliberate and intentional misrepresentation, but it is well-settled that fraud is not a necessary element of the right of action, and the absence of an intention to deceive is not a defence though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception. Christopher Wadlow in *Law of Passing Off* (1995 Edition, at p.3.06) states that the plaintiff does not have to prove actual damage in order to succeed in an action for passing off. Likelihood of damage is sufficient. The same learned author states that the defendants state of mind is wholly irrelevant to the existence of the cause of action for passing off (ibid, paras 4.20 and 7.15). As to how the injunction granted by the Court would shape depends on the facts and circumstances of each case. Where a defendant has imitated or adopted the plaintiffs distinctive trade mark or business name, the order may be an absolute injunction that he would not use or carry on business under that name. (Kerly, ibid, para 16.97).

14. In the present case the plaintiff claims to have been running his business in the name and style of Mukтажivan Colour Lab and Studio since 1982. He has produced material enabling a finding being arrived at in that regard. However, the trial court has found him using Mukтажivan as part of his business name at least since 1995. The plaintiff is expanding his business and exploiting the reputation and goodwill associated with Mukтажivan in the business of Colour Lab and Photo by expanding the business through his wife and brother-in-law. On or about the date of the institution of the suit the defendant was about to commence or had just commenced an

identical business by adopting word Muktajivan as a part of his business name although till then his business was being run in the name and style of Gokul Studio. The intention of the defendant to make use of business name of the plaintiff so as to divert his business or customers to himself is apparent. It is not the case of the defendant that he was not aware of the word Muktajivan being the property of the plaintiff or the plaintiff running his business in that name though such a plea could only have indicated the innocence of the defendant and yet no difference would have resulted in the matter of grant of relief to the plaintiff because the likelihood of injury to the plaintiff was writ large. It is difficult to subscribe to the logic adopted by the Trial Court, as also the High Court, behind reasoning that the defendants business was situated at a distance of 4 or 5 Kms. from the plaintiffs business and therefore the plaintiff could not have sought for an injunction. In a city a difference of 4 or 5 Kms. does not matter much. In the event of the plaintiff having acquired a goodwill as to the quality of services being rendered by him a resident of Ahmedabad city would not mind travelling a distance of a few kilometers for the purpose of availing a better quality of services. Once a case of passing off is made out the practice is generally to grant a prompt ex-parte injunction followed by appointment of local Commissioner, if necessary. In our opinion the trial court was fully justified in granting the ex-parte injunction to the plaintiff based on the material made available by him to the court. The Trial Court fell in error in vacating the injunction and similar error has crept in the order of the High Court. The reasons assigned by the Trial Court as also by the High Court for refusing the relief of injunction to the plaintiff are wholly unsustainable.

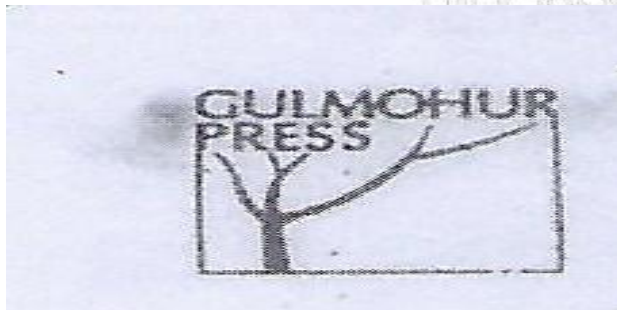
4. The other reason for dismissal of the suit was that the defendant had used the logo “Gulmohur Press” which is different from the logo of the plaintiff i.e. “GULMOHAR” which is the logo used by the defendant incorporating the word-mark is distinct from the word used by the plaintiff.

5. For an ocular appreciation of the two logos, they are reproduced hereunder:-

Appellant's logo:



Respondent's logo:



6. The impugned order has reasoned that the word “GULMOHAR” is used at the bottom of an internal page of the book with a different logo from the plaintiff’s whereas the latter had been using the word as the name of series published by it. Further the defendant has not made any attempt to adopt the use of the word “GULMOHAR” in its book so as to give an impression that it is connected with the books published by the plaintiff. On the comparison of the two logos, the Trial Court came to the conclusion that

it is very unlikely for an ordinary person to get an impression that the book published by the defendant is connected with the series of the books published by the plaintiff and since there was no intention on the part of the defendant to make a dishonest misrepresentation to the public in general so as to pass off his book as that of the plaintiff, it concluded that the use of the word “Gulmohur Press” by the defendant is bonafide and honest. However, this is against the statutory provision as laid down in section 21 of the Trade Marks Act, 1999.

7. The appellant contends that in the world of publishing, when a word mark gains goodwill or publicity, it is used ordinarily and those buying the book will not look at the logo which goes along with it. Therefore, if a book is asked for or referred to, the logo would be over-looked and even if the logo is noticed, it may be assumed by the unsuspecting public that the variation is bona fide. The argument assailing the impugned order dismissing the suit is that the presumption in law under section 29 (2) (c) and sub section 3 of the Act has been overlooked. This Court is persuaded by the aforesaid argument and therefore is of the view that the impugned order erred in this regard. The respondent has used the appellant’s registered trade mark which is phonetically identical, and a mere change of a letter in the spelling of the trade name/ trade mark is not likely to be noticed by an unsuspecting buyer of the book. It is likely to confuse and deceive the public, prime users and target group being school children.

8. Furthermore, the intention to deceive is immaterial in the case of infringement of trademark and passing off. The appellant relies upon the Judgment in *Millington v. Fox* (1838) 3 Mylne & Craig 338, in support of this proposition i.e. the intention to deceive is immaterial. The appellant

argues that there has been a continuous injunction against the defendant from using the trademark GULMOHAR from the year 1993, that is, immediately after the publication of the aforesaid book under the name and logo of “GulMohur Press” till the dismissal of the suit on 16.07.2005. However, this injunction was continued by this Court by order dated 21.11.2005. In the suit, although a representation was entered on behalf of the respondent/defendant for some time but since they stopped appearing after a while, they were subsequently proceeded ex-parte in the appeal.

9. In view of the aforesaid discussion and for the reasons mentioned, the interim order is made absolute. The respondent is restrained from using the trademark or trade name GULMOHUR in relation to books or other printed publications as part of the corporate name Gulmohur Press Pvt. Ltd. or any other identical or similar mark to the plaintiff’s trademark “GULMOHAR”.

10. The learned counsel for the appellant does not press for any orders for costs. Considering that the case has been pending since the year 1993 and the respondent was proceeded ex-parte, a cost of Rs. 1 lakh is imposed on the respondent/defendant, which shall be paid to the Delhi High Court Mediation and Conciliation Centre within four weeks from the receipt of this order.

11. In view of the above, the appeal, alongwith pending applications, stand disposed off.

NAJMI WAZIRI, J

JANUARY 05, 2018

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