

IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON :28.01.2020

DATED :13.03.2020

CORAM

THE HONOURABLE MR.JUSTICE M.M.SUNDRESH

AND

THE HONOURABLE MR.JUSTICE KRISHNAN RAMASAMY

Original Side Appeal Nos. 4 to 12 of 2020
& CMP Nos.428 to 440, 442, 443, 445, 446, 448 & 449 of 2020

M/s Matrimony.com Limited,
No.94, TVH Beliciaa Towers, Tower II,
10th Floor, MRC Nagar, Mandaveli,
Chennai-600 028.
Rep., by its Associate Vice-President-
Legal & Regulatory S.Ravichandran ...Appellant in OSA.No.4 of
2020,5/2020,6/2020,7/2020,
8/2020,9/2020,10/2020,11/2020,12/2020

Vs.

Kalyan Jewellers India Limited,
TC32/204/2,Sitaram Mill Road,
Punkunnam, Thrissur-680 002. ...Respondent in
OSA.No.4 of 2020

Malayala Manorama Co., Ltd.,
Manorama Building, K.K.Road,
Kottayam, Kerala-686 001. ...Respondent in
OSA.Nos.5 & 6 of 2020

Ayesha Jain
#30, 18th Main Road,
17th Cross, JP Nagar,
5th Phase, Bangalore,
Karnataka-560 078, India. ...Respondent in
OSA.Nos.7 & 12 of 2020

People Interactive Pvt. Ltd.,
Old No.124/1, New No.14,
Heer Panna Complex, 2nd Floor,
GN Chetty Road, T.Nagar,
Chennai-600 034. ...Respondent in
OSA.No.8 & 11 of 2020

Tanisha Systems Pvt. Ltd.,
709-711, 7th Floor, JMD Megapolis,
Sector-48, Sohna Road, Gurgaon,
Haryana-122018.

...Respondent in
OSA.Nos.9 & 10 of 2020

Original Side Appeals filed under Order XXXVI Rule 1 of Original Side Rules read with Clause 15 of the Letters Patent against the Common order dated 20.12.20219 made in O.A.No.427 of 2019 in C.S.No.277 of 2019; O.A.Nos.531 and 530 of 2019 in C.S.No.327 of 2019; O.A.No.656.of 2019 in C.S.No.418 of 2019; O.A.No.628 of 2019 in C.S.No.395 of 2019; O.A.Nos.1114 & 1113 of 2018 in C.S.No.802 of 2018; O.A.No.627 of 2019 in C.S.No.395 of 2019 and O.A.No.655 of 2019 in C.S.No.418 of 2019.

For Appellant : Mr.Ariyamasundaram, S.C., for
in all OSAs. Mr.Arun C.Mohan

For Respondent : Mr.Harishankar
in OSA No.4/2020

For Respondent in : Mr.Sathish Parasaran, S.C., for
OSA Nos.5 & 6 of 2020 Mr.Jacob Kurian & Madhan babu

For Respondent in : Mr.Sathish Parasaran, S.C., for
OSA Nos.8 & 11 of 2020 M/s BFS Legal & Hemanth Thadhani

For Respondent in : Mr.R.Sathishkumar
OSA Nos.9 & 10 of 2020

सत्यमेव जयते
COMMON JUDGMENT

M.M.SUNDRESH, J.

PREFACE:

1.1.Internet has created a new class of literates. Anyone who uses internet sparingly, knows nothing about it, despite formal education becomes a semi illiterate or literate. World over, there is a rapid escalation of internet users with a particular reference to our country. It has indeed become inseparable in the lives of the people as one of absolute necessity.

1.2. An information has to be obtained by crawling. The web is like an exhaustive library. To get an information, a software known as 'web crawler' is used to discover the webpages.

1.3. 'Google' has earned a reputation of one of the best search engines worldwide facilitating a primary platform for the advertisement of goods and services. It has not only started its advertisement business but also 'Ad Words' programme.

1.4. The functioning of an AdWord Programme and the key words are best expressed through the words of google itself.

"(iv) The AdWords program allows an advertiser to create and run these advertisements through a simple process.. A advertiser, using the AdWords program creates a sponsored link, will specify the headline, the address of the web page to which the headline links, and the advertising text, within certain limits set by Google.

(v) "Keywords" are those words, phrases, sentences, etc., that might trigger certain sponsored results or advertisements, if they correspond to certain terms selected by the advertiser to trigger an Advertisement. The terms or expressions selected by an advertiser trigger advertisements are known as "Keywords". For example, a "search term" could be "Trains from Muymbai to New Delhi" which is typed by the user on the Google Website in the search query box. The advertiser can select the Keywords "Mumbai Delhi Trains" which is based on the search terms and for which the advertiser would like his advertisement to be shown.

It is submitted that the Plaintiff has used the expressions 'AdWords' and 'Keywords' interchangeably. To summarise, it is respectfully submitted that the term 'AdWords' is the name of the advertising program provided and managed by Defendant No.5 and that the expression 'Keywords' refers to the terms or phrases used at the backend as a trigger to display ads that meet

the specific criteria for the display of an ad in response to a search query entered by a user. These are therefore distinct terms and cannot be used interchangeably."

1.5.The following is the working mechanism.

"(ii) It is important to appreciate that when a user enters a search query (search terms) for searching particular information on the Google Website, the Google Website conducts a search of the existing material available on the third party websites as indexed by (which predominantly relate to data and content hosted by third parties on their websites) in an automated manner through its search algorithm and displays the links to the websites and other information of such search that correspond to the query entered by the user. The results that are generated are referred to as "Organic Results" or "Natural results". The order in which the natural or organic results are ranked and indexed are based on multiple factors, chief amongst them being relevance of the respective websites to the search term entered by the Internet user. The search engine operator does not claim any remuneration for displaying those results.".....

(iii)When such search results are displayed on a page, certain advertisements also appear at the top or bottom of the page (previously they also appeared on the right hand side of the search page), clearly distinguished from the search results by various indicators that included a line along with a label "Sponsored Links" or 'Ads' in a yellow or green background. Currently all advertisements are distinguished by a yellow or green coloured label with the word 'Ad' displayed in it."

1.6.Thus, "Google" has formulated its own mechanism and policy. Search Engine Optimization (SEO) and Search Engine

Marketing (SMO) are the two primary methods of running business in online business platform. Both these methods use Keywords as their tool. Using maximum number of keywords is necessary to optimise web searches and to attain maximum profit. This has been programmed accordingly by the 'Google'.

1.7. There are three primary players involved in the entire process. One is the search engine viz., 'Google'. The second is the advertisers, who bid for the "AdWords" and the third, the consumer/user. The website owners bid on the keywords/Adwords to get a strategic placement in the web results for the display of web pages, either as sponsor links or Ads.

1.8. Search platform is required not only from the point of view of the bidders of 'Google' but also the users. It is like a consumer going to a particular floor of the Mall which conveniently has a particular product though manufactured by different entities. If an intending purchaser goes to the said first floor wherein it is filled up with shoes of different brands belonging to the different manufacturers, it will be a win-win situation for everyone. A consumer can pick the best from his perspective while creating a healthy competition. He could also assess and compare the products.

2. FACTS:

2.1. The appellant is a registered trade mark Proprietor. It has not only registered the mark "BharatMatrimony" but also various other names by combining the language along with the word "Matrimony" apart from the place and religion. It has thus, combined the word 'Tamil' with 'Matrimony' and Kerala with Matrimony etc. This has been done with almost most of the well known languages and religions.

2.2. We would appositely place on record the registrations obtained by the appellant as indicated in the plaint.

S.NO.	Reg.No.	Mark	Class
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1.	1535126	ASSAMESEMATRIMONY	42
2.	1548863	BHARATMATRIMONY	35, 42
3.	2007933	BHARATMATRIMONY.COM	9, 16, 35 & 45
4.	2007942	BENGALMATRIMONY	9, 16, 35 & 45
5.	2007949	GUJARATMATRIMONY	9, 16, 35 & 45
6.	2007947	KANNADAMATRIMONY	9, 16, 35 & 45
7.	2007935	KERALAMATRIMONY	9, 16, 35 & 45
8.	2007943	MARWADIMATRIMONY	9, 16, 35 & 45
9.	2007930	CHRISTIANMATRIMONY	9, 16, 35 & 45
10.	2007946	ORIYAMATRIMONY	9, 16, 35 & 45
11.	2007940	PARSIMATRIMONY	9, 16, 35 & 45
12.	2007931	SINDIMATRIMONY	9, 16, 35 & 45
13.	2007938	TAMILMATRIMONY	9, 16, 35 & 45
14.	2007944	TELUGUMATRIMONY	9, 16, 35 & 45
15.	1535127	URDUMATRIMONY	42
16.	2007937	URDUMATRIMONY	9, 16, 35 & 45
17.	1548863	BHARATMATRIMONY	35, 42
18.	1846794	TAMILMATRIMONIAL	42
19.	1846795	KANNADAMATRIMONIAL	42
20.	1846793	SINDHIMATRIMONIAL	42
21.	1846792	PUNJABIMATRIMONIAL	42

2.3. Some of the defendants bid for the 'AdWords' which are the same as the trade marks of the appellant with the only difference being the space between the words. This made the appellant to file a suit for permanent injunction on the ground of 'infringement' and 'passing off' filed in C.S.No.832 of 2009. The learned single Judge (as he then was) through his celebrated judgment, which is one of its kind, declined the order of injunction sought for. Though the ultimate decision of the learned single Judge was confirmed, some of the findings were not agreed upon by the Division Bench in the judgment reported in Consim Info Private Limited Vs. Google India Private Limited and others (2012(5) Law Weekly 1). This paragraph is apposite.

"32. The learned Single Judge in his order, in paragraph 148, has stated that in spite of leaving a space in between the two words, it certainly provides a likelihood of confusion. However, the learned Judge found that the respondents 2 to 4, are also dealing in the same services i.e. matrimony services as that of the appellant would be left with no other choice to advertise their services, in case if the use of the combination of the above word is prohibited. The learned Judge also held that the grant of an order of injunction would lead to the consequence of reducing the choice of words

available to competitors, to a very few and resulting in the appellant's monopolising the English word 'Matrimony'. In this connection, the respondents have not pleaded with regard to alternative synonym for the words 'Tamil', 'Malayalam', 'Telugu', 'Matrimony' etc. In the absence of any pleading with regard to the same, we are not agreeing with the finding of the learned single Judge that by preventing the use of the words would leave the respondents 2 to 4 with a very limited choice of words."

2.4. The following are the ultimate finding by the Division Bench.

"59. Further, in the counter affidavit, first respondent has stated that they did not allow the registered trademark of any one from being used as adwords by any other person and that the impression "Adword" as used in the industry would mean the use of the words in the title and text of the advertisement. In paragraph 9 of the counter, the first respondent has reiterated its commitment that they would adhere to the present business policy and also indicated that its current adwords policy does not permit the use of any trademarked term in the ad text, i.e., the title and text of the advertisement. Therefore, it is clear from the order dated 07.10.2009, by recording the undertaking given by the first respondent, the injunction was vacated. The arrangement made on 07.10.2009 is continuing till date.

60. While dismissing both the applications i.e. O.A.Nos.977 and 978 of 2009, the learned Judge made it clear that dismissal of these applications shall not be construed to mean that the first respondent (Google) may henceforth deprive the plaintiff (appellant) of the benefit of their Adwords Trademark Policy, as reflected in documents filed by them. As already stated we are of the considered view that the appellant has established their case with regard to prima facie case and balance of convenience. As such, the appellants are entitled for injunction. So far as the irreparable hardship is concerned, the same can be decided only in the trial."

2.5.The Division Bench was pleased to observe that there is no pleading to the effect that there were no alternative words than the one used by the appellant and the combination of two words happened deliberately but however, this can only be examined at the time of trial through the witnesses. Ultimately, the undertaking given by Google India Private Limited has been recorded while declining an order of injunction. Not satisfied with the orders passed, the appellant filed Special Leave Petition in SLP No.30064-30065/2012, wherein the following order was passed.

"In the meantime, at the first instance, the respondents Nos.2, 3 and 4 in S.L.P.(C) Nos.30064-30065 of 2012, shall remain restrained from displaying their names in the website of the petitioner in the "Adwords" programme of the Google."

2.6.After hearing Civil Appeal Nos.908-909 of 2016 with C.A.Nos.906-907 of 2016 dated 04.08.2016, the Civil Appeals were disposed of as under.

"However, we direct that the Trial Court shall conclude the trial of the pending cases within six months from the date of communication of this order to the Trial Court. The interim order granted by this Court in these appeals on 19.10.2012 and confirmed on 02.02.2016 shall continue to operate till the trials are concluded.

The learned counsel appearing for the parties have assured this Court that their counterparts appearing before the Trial Court shall extend their full co-operation to the Court so that the matters can be finally decided within the period mentioned above.

With the above observations and directions, these appeals stand disposed of.

It is needless to mention that the Trial Court shall decide the matters on their own merits, without being influenced by any observation made by the Division Bench."

2.7.In the written statement filed by Google India Private Limited, the following stand has been taken with respect to the usage of trade marks in the AdText and as key words

(x) At the relevant time, the AdWords Trade mark Policy deals with the approach with respect to use of trademarks in the AdText and as Keywords. At the time of filing of the present suit and as on date, under the AdWords Trademarks policy as applicable to Zindia registered trade mark terms that were reported to Defendant No.5 were investigated from appearing in the AdText of the advertisement of a third party. The AdWords Trade marks policy did not restrict the appearance of trademarked terms as keywords to trigger an ad, as the mere use of a trade mark as a trigger does not violate any rights of a trademarks owner under the Trademarks Act."

Thus, Google India Private Limited has taken a specific stand that there is nothing illegal in the policy that is being adopted.

2.8. On the bidding made to the AdWords as was done earlier, few of the defendants in the first suit among others got their placements. This triggered the filing of the second suit notwithstanding the pendency of the earlier one having a specific direction to expedite the trial. To be noted, 'Google' has not been arrayed as a party defendant nor any attempt made to file another injunction application in the pending suit. In the present suit also, the same issue has been raised though the defence taken by the defendants is rather exhaustive.

2.9. The learned single Judge dismissed the interlocutory application, inter alia holding that no case of either infringement or passing off is made out. As the issue pertains to the AdWord Program of 'Google', not arraying it as a party defendant to the present suit is fatal. The words are generic and descriptive. For separating the words and using them accordingly, the appellant does not have any objection. The appellant cannot claim monopoly. Section 28 of the Trade Marks Act (hereinafter referred to as 'the Act') starts with the words 'subject to other provisions of the Act'. The first word depicts the language, the religion or the place and the second word being matrimony. The appellant is only trying to monopolise the business. This might lead to unfair trade practice and affect the provisions of the Competition Act, 2002. It is also against the constitutional mandate of right to carry on one's own trade and profession. Accordingly, by a reasoned order, the injunction applications were dismissed. To over-turn them and to allow the applications filed, these original side appeals are filed by the appellant.

3. As all these original side appeals arise out of the common order passed, the issues being one and the same though there are certain factual differences among the defendants, we pass a common judgment.

4. Heard Mr. Ariyamasundaram, learned Senior Counsel for Mr. Arun C. Mohan, learned counsel for the appellants in all these appeals and Mr. Harishankar, learned counsel appearing for the respondent in OSA No. 4 of 2020; Mr. Sathish Parasaran, learned Senior Counsel for Mr. Jacob Kurian and Mr. Madhan Babu, learned counsel for the Respondent in OSA Nos. 5 and 6 of 2020 and M/s BFS Legal & Hemanth Thadhani, learned counsel for the respondent in OSA Nos. 8 and 11 of 2020 respectively and Mr. R. Sathishkumar, learned counsel for the respondent in OSA Nos. 9 and 10 of 2020, perused the documents and written arguments filed.

5. Before venturing into the respective arguments of the learned counsel at the Bar, we would like to summarise the legal principles governing the case.

6. Trade Marks Act, 1999: (Sections 28 and 29)

6.1. Chapter IV of the Trade Marks Act, 1999, concerns with the effect of registration. Section 28 of the Act thus confers a right of protection to the registered proprietor of a trade mark. However, such a right is a qualified one, subject to the other provisions of the Act. Subject to the other provisions of the Act, a registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to its use in relation to the goods or services in respect of which it is registered and to obtain relief for infringement in the manner provided by the Act. We need to make more emphasis on the words 'if valid'. Only when a registered mark becomes valid, this protection would come into play. It is a condition precedent before exercising the right conferred by registration of a trade mark. This position has also been extended and reiterated under sub section 2 of Section 28, which makes it mandatory that such an exclusive right shall be subject to any conditions and limitations.

6.2. The literal and natural reading of Section 28, a right under it can be exercised subject to the rigour of other provisions, such as, Sections 29 and 30 of the Act. Section 29 also does not give any absolute right. We do not wish to discuss these provisions at length in view of the judgment rendered by one of us (Justice M.M. Sundresh) in Banana Brand Works Pvt. Ltd., V. Kavan Antani, Director, Bananabandy Network Private Limited (2016(4) CTC 647). We would only quote the following paragraphs.

"12.2. Section 29 of the Act deals with infringement by two sets of entities. Section 29(1) of the Act deals with a case of infringement through a mark, which is identical with, or deceptively similar to, the trade mark

in relation to goods or services in respect of which the trade mark is registered. Resultantly, such a mark of the infringer would in all manner likely to be taken as that of a registered one. Thus, Section 29(1) of the Act speaks about the mark being identical or deceptively similar in the same goods or services qua a registered mark. There is no difficulty for a Court to decide an infringement under Section 29(1) of the Act. It has to be seen as to whether the infringing mark is identical or deceptively similar to the registered trade mark in relation to the goods or services. Section 29(1) places on part the word "identical with deceptive similarity". Hence a distinction has to be made between a mere "similarity" and a deceptive one.

12.3. The Courts are faced with more number of cases applicable to Section 29(2) of the Act onwards. Section 29(2) of the Act gives importance to two words. They are, "identity" and "similarity". Though they have to be seen in the context of the provision by giving a natural and a reasonable interpretation, the word "identity" is placed at a higher pedestal than similarity. It becomes closer to the infringing mark than similarity. It denotes a mark goods or service of a same kind in appearance, character or quantity, without being identical. It is more to do with resemblance of one trade mark to another. However, both cannot be the same and hence, there would be certain independent factors attached to each of them. Thus, there involves some degree of difference between the mark, goods, services of a infringer as against the registered holder.

12.4. Section 29(2) (a) of the Act deals with "identity" with the registered trade mark and "similarity" with the goods or services. Thus, the word "identity" is attributable to the registered trade mark as against the case of goods or services covered by such registered trade mark. Therefore, a difference is shown between "identity" and the "similarity". Section 29(2) (b) of the Act speaks about similarity to the registered trade mark and identity or

similarity of the goods and services. Here, similarity is used with respect to the registered trade mark, whereas both identity and similarity are used with respect to the goods or services. Coming to Section 29(2)(c) of the Act, it deals with identity of the registered trade mark and identity of the goods and services.

12.5. In all these cases mentioned supra, infringement would occur when such acts are likely to cause confusion on the part of the public or which is an act associated with the registered trade marks. Therefore, the basis is likelihood of causing confusion from the point of view of the public in general. Hence, no actual confusion is necessary and it is relatable to an end user. Similarly, with reference to the association with the registered mark also what is sufficient is the likelihood. Therefore, if one reads all the provisions together, then intention of the legislature is very clear that is to protect the registered mark holder even in case of latter as what is sufficient is only likelihood. Coming to sub section 3 of Section 29(2) of the Act, it creates a statutory presumption in view of sub section 2(c) onwards a likelihood of causing confusion on the part of the public. Now this is because the word "identity" has been given more weightage towards infringement as against "similarity". Therefore, once there is an identity between marks of a registered holder and the other, the statutory presumption would follow the suit.

12.6. Sub Section 4 of Section 29 of the Act mandates

compliance of all the three sub clauses viz., a to c to constitute the infringement. Sub section 4 deals with a mark which is identical with or similar as the case of Section 29(1) of the Act, though the said provision deals with deceptive similarity. However, in this case, the other two conditions are also to be satisfied. However, Section 4 deals with goods or services, which are not similar to

those, for which, the trade mark is registered. This is subject to the further condition that such a mark has got a reputation in India and the usage is without due care involving undue advantage apart from detrimental to the distinctive character or reputation of the registered trade mark. Therefore, Section 29(4) of the Act can be pressed into service only when there exists a reputation of the mark holder in India. It does not stop with that, but proceeds to state that the usage of the mark is without "due cause" and by taking "undue advantage of" or "detrimental to the distinctive character or repute". Therefore, there has to be a proof of undue care followed by other facts, such as unfair advantage and being detrimental to the distinctive character or reputation as the case may be. To succeed under these provisions, a registered mark holder has to not only prove its reputation, but the distinctive character followed by undue advantage or detrimental activity without due cause. All these factors are required to be proved by the registered mark holder. This is for the reason that there is no similarity to the goods or services with the registered trade marks."

6.3. Thus, a registered trade mark holder has to prove not only the reputation but the other incidental factors. However, even this provision is subject to Section 30 of the Act.

7. SECTION 30:

The scope and ambit of Section 30 of the Act has been dealt with by one of us (Justice M.M.Sundresh) in *Orchid Chemicals & Pharmaceuticals Ltd., Vs. Wockhardt Limited* (2013 (56) PTC 558). The relationship between Sections 29 and 30 along with the scope and ambit has also been considered. We would reiterate the following passage for better appreciation.

"5.6. Sections 28 to 30 of the the Trade Marks Act, 1999, deal with the effect of registration under Chapter IV of the Act. In so far as Section 28 of the Act is concerned, it deals with the rights conferred by registration. Section 28 of the Act specifically deals with the "exclusive" right under the Act. Therefore, a registered proprietor of a trade mark can assert an exclusive right to use the trade mark under Section 28 of the Act. However, the said assertion is subject to two conditions. The first condition is that it

is "subject to other provisions of the Act". The second condition is that it is subject to its "validity".

5.7. Now coming to Section 29 of the Act, it deals with an infringement of the registered trade mark. Section 29 of the Act

specifies that an infringement would occur when an unregistered Proprietor uses a registered trade mark, which is likely to cause confusion on the part of the public or which is likely to have an association with the registered trade mark. Therefore, if one sees the object and reasons under Section 29 of the Act, it is clear that it is meant to be used against the person, who is not entitled to use the said trade mark under "law". This is required to constitute an infringement.

5.8. Now coming to Section 30 of the Act, it limits the effect of registered trade mark. A perusal of Section 30 of the Act would show that Section 29 of the Act is subjected to it. Therefore, Section 30 of the Act is an overriding provision to Section 29 of the Act. However, the parameters stipulated under Section 30 of the Act will have to be complied with. For example, in a case where a party is using a registered trade mark belonging to another one, if it is in accordance with honest practices in industrial or commercial matters or is detrimental to the distinctive character of the different trade mark, no infringement would occur as it limits the effect of registered trade mark. Similarly, when the usage is indicative of a kind, quality or a quantity, then there will not be any infringement notwithstanding the registration.

5.9. While considering the statutory provisions, the Courts will have to read them together to understand the intending purpose and object. Therefore, we are of the considered view that Sections 28 to 30 of the Trade Marks Act, 1999, are to be read in connection with each other. Such a yardstick will have to be adopted in view of the settled interpretative principle of harmonious construction.

5.10. Accordingly, let us apply the facts to the provisions. The records would show that the word "METOPROLAL" is a chemical component. It is "publici juris". There are number of registered Proprietors having the prefix "METO". The learned single Judge has also noted the said fact. Now all of them are identified with the common name, in view of the chemical component. Hence, it is not as if the respondent has infringed the said word "METO". It is already in the public domain, even much prior to the application of the appellant. Applying the said facts when we read Section 29 of the Act, we can safely come to the conclusion that the limits on effect of the registered trade mark under Section 30 of the Trade Marks Act, 1999, would apply with all force. Therefore, the exclusive right claimed by the appellant in pursuant to the registration would no longer be available, in view of the fact that the word 'METO' is already "publici juris", thereby, giving protection under Section 30 of the Act. When Section 28 of the Act is not applicable, then consequently, Section 29 of the Act also is not applicable. Even otherwise, Section 29 of the Act is subject to Section 30 of the Act. As Section 28 of the Act is also subject to other provisions, it is needless to state that it is also subject to Section 30 of the Act. Therefore, looking from any angle, we have no hesitation in holding that there is no infringement of the appellant's trade mark under Section 29 of the Trade Marks Act, 1999."

8. Section 31:

8.1. Section 31 states that in all the legal proceedings relating to the registered trade mark, the original registration shall be the prima facie evidence of its validity. This provision also will have to be read in the light of Section 30 of the Act. To put it differently, Section 31 does not exclude Section 30. The power of the Civil Court is plenary in nature. It is involved in an adjudicative process both in the interlocutory stage and the final stage. Therefore, what is applicable at the final stage has to be made applicable at the interlocutory stage. Thus, Section 31 is subject to Section 30 of the Act. It applies to the proceedings at all stages. There is a difference between a civil suit and a legal proceeding under the Act. Under the Act, the trade mark itself is questioned on its validity, whereas in a suit its evidentiary value is assessed. A right is claimed based upon a registered trade mark. Further, the presumption under Section 31 is a rebuttable presumption. It can be rebutted even in the

interlocutory stage. The word 'prima facie' mentioned under Section 31 of the Act cannot be understood to mean that at the interlocutory stage, the Civil Court is expected to hold always that a registered trade mark is valid. One cannot confuse a statutory presumption of prima facie validation with an adjudicatory process. We may note that Section 31 also comes under Chapter IV. Any interpretation other than the one we have arrived at would make Sections 28 to 30 as redundant and otiose.

8.2.As the law governing grant of injunction is well settled, it is axiomatic that once Court finds that there is an infringement of a registered trade mark, an order of injunction has to follow. We may quote with profit the following passage of the Apex Court in Midas Hygiene Industries Private Limited and another V. Sudhir Bhatia and Others (2004(2) CTC 77(SC).

"The law on the subject is well settled. In cases of infringement either of Trade Mark or of Copyright normally an injunction must follow."

9. Passing Off:-

9.1. Passing Off principle has been settled for now. Suffice it is to say that for a passing off action, one has to seek common law remedy. We do not wish to multiply the judgments except by quoting the decision rendered in Maya Appliances Pvt. Ltd., Vs. Butterfly Gandhimathi Appliances Ltd., (2017(2) CTC 742) by one of us (Justice M.M.Sundresh).

11.1. As the principle governing "passing off" is very often repeated, this Court does not want to repeat, as it has been dealt with in extenso in BANANA BRAND WORKS PVT. LTD., V. KAVAN ANTANI AND ANOTHER (2016 (4) Law Weekly 33) and in O.A.No.1102 of 2015 and A.No.6797 of 2015 in C.S.No.828 of 2015 dated 21.10.2016. Suffice it is to state that the fundamental principles popularly called as "classic trinity" as enunciated in Jif Lemon's case (1991 All England Reporter 873) still continues to rule the field. Here is a fruitful recapitulation of the given passages:

"7. PASSING OFF:-

7.1. An action for "passing off" also comes under the common law. An action for "passing off" is much wider than an infringement. The principle governing "passing off" has already been dealt with by this Court in BANANA BRAND WORKS PVT.

LTD., V. KAVAN ANTANI AND OTHERS ((2016) 4 Law Weekly 33), which reads as follows.

"6.3. Ultimately, the Courts are concerned with the damages or their likelihood. Therefore, absence of intention and the real damage cannot be the factors standing the way of getting an order of protection. Fraud is not an absolutely necessary element and thus, a mere absence of intention to deceive is not a defence. In a case of infringement qua identity and similarity with the registered mark, the requisite parameters are the same as passing off.

7. Intention is not required:-

When we speak about misrepresentation, a narrow interpretation is not required. It has to be seen and understood from the point of view of the protection, such as, act of misrepresentation, though not necessarily intentional, can be, by any one starting from the manufacturer to the retailer. The reason is that such an act is attached to the goods or services as the case may be. It is also attributable to the last of the transaction and therefore, it should also be seen from the point of view of the end seller.

10. PASSING OFF:-

The concept of "passing off" has already been dealt with by this Court in A.Nos.1554 and 1555 of 2016 and O.A.Nos.1145 and 1146 of 2015 in C.S.No.854 of 2015 dated 30.06.2016, wherein it has been held as follows.

"8.1. Passing off is a concept in the domain of common law remedy. It offers protection to a party, when the other makes an attempt to pass off his goods through a misrepresentation, as that of the former. What is required in a passing off is the existence of a goodwill, damage or injury to it and through representation. This fundamental principles called as classical trinity has been enunciated in Jif Lemon's case (1991 All England Reporter 873), which deduced

the larger requirement enunciated in the Advocate's case (ERVEN WARNINK V. TOWNEND & SONS LTD., ((1979) 2 ALL E.R. 927) (See S.SYED MOHIDEEN V. P.SULOCHANA BAI ((2016)

2 Supreme Court Cases 683).

8. A party, who comes to the Court, has to establish the three basic requirements as mentioned above, while seeking an order of protection. An actual injury is not a sine qua non and thus, likelihood of damage would suffice. A misrepresentation by the defendant to the public may or may not be intentional. What is sufficient is that an action qua a defendant, which leads or likely to lead a prospective customer to believe that the goods or services offered by it are that of the plaintiff. Such a deception can either be proved on evidence and if not by the decree of probability, of course, to the satisfaction of the Court."

7.2.The scope of passing off vis-a-vis an infringement has been dealt with by the Apex Court in a recent judgment in SYED MOHIDEEN MOHIDEEN V P.SULOCHANA BAI ((2016) 2 Supreme Court Cases 683). The following passage of the said judgment is apposite.

31.1. Traditionally, passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation caused in the course of trade and for prevention of resultant damage on account of the said misrepresentation. The three ingredients of passing off are goodwill, misrepresentation and damage. These ingredients are considered to be classical trinity under the law of passing off as per the speech of Lord Oliver laid down in the case of Reckitt & Colman Products Ltd. v. Borden Inc MANU/UKHL/0012/1990 : (1990) 1 AllE.R. 873 which is more popularly known as "Jif Lemon" case wherein the Lord Oliver reduced the five guidelines laid out by Lord Diplock in Erven Warnink v. Townend & Sons Ltd. [1979] AC 731,

742 (HL)] (the "Advocate Case") to three elements: (1) Goodwill owned by a trader, (2) Misrepresentation and (3) Damage to goodwill. Thus, the passing off action is essentially an action in deceit where the common law rule is that no person is entitled to carry on his or her business on pretext that the said business is of that of another. This Court has given its imprimatur to the above principle in the case of Laxmikant V. Patel v. Chetanbhat Shah and Anr. MANU/SC/0763/2001 : 2002 (2) R.C.R. (Civil) 357 : (2002) 3 SCC 65.

31.2. The applicability of the said principle can be seen as to which proprietor has generated the goodwill by way of use of the mark name in the business. The use of the mark/carrying on business under the name confers the rights in favour of the person and generates goodwill in the market. Accordingly, the latter user of the mark/name or in the business cannot misrepresent his business as that of business of the prior right holder. That is the reason why essentially the prior user is

considered to be superior than that of any other rights. Consequently, the examination of rights in common law which are based on goodwill, misrepresentation and damage are independent to that of registered rights. The mere fact that both prior user and subsequent user are registered proprietors are irrelevant for the purposes of examining who generated the goodwill first in the market and whether the latter user is causing misrepresentation in the course of trade and damaging the goodwill and reputation of the prior right holder/former user. That is the additional reasoning that the statutory rights must pave the way for common law rights of passing off.

32. Thirdly, it is also recognized principle in common law jurisdiction that passing off right is broader remedy than that of infringement. This is due to the reason that the passing off doctrine operates on the general principle that

no person is entitled to represent his or her business as business of other person. The said action in deceit is maintainable for diverse reasons other than that of registered rights which are allocated rights under Recent Civil Reports the Act. The authorities of other common law jurisdictions like England more specifically Kerry's Law of Trademarks and Trade Names, Fourteenth Edition, Thomson, Sweet & Maxwell South Asian Edition recognizes the principle that where trademark action fails, passing off action may still succeed on the same evidence. This has been explained by the learned Author by observing the following:--

15-033 "A claimant may fail to make out a case of infringement of a trade mark for various reasons and may yet show that by imitating the mark claimed as a trademark, or otherwise, the Defendant has done what is calculated to pass off his goods as those of the claimant. A claim in "passing off" has generally been added as a second string to actions for infringement, and has on occasion succeeded where the claim for infringement has failed"

32.1. The same author also recognizes the principle that Trade Marks Act affords no bar to the passing off action. This has been explained by the learned Author as under:--

15-034 "Subject to possibly one qualification, nothing in the Trade Marks Act 1994 affects a trader's right against another in an action for passing off. It is, therefore, no bar to an action for passing off that the trade name, get up or any other of the badges identified with the claimant's business, which are alleged to have been copied or imitated by the Defendant, might have been, but are not registered as, trade marks, even though the evidence is wholly addressed to what may be a mark capable of registration. Again, it is no defense to passing off that the Defendant's mark is registered. The Act offers advantages to those who register

their trade marks, but imposes no penalty upon those who do not. It is equally no bar to an action for passing off that the false representation relied upon is an imitation of a trade mark that is incapable of registration. A passing off action can even lie against a registered proprietor of the mark sued upon. The fact that a claimant is using a mark registered by another party (or even the Defendant) does not of itself prevent goodwill being generated by the use of the mark, or prevent such a claimant from relying on such goodwill in an action against the registered proprietor. Such unregistered marks are frequently referred to as "common law trade marks".

7.3. A person complaining of passing off has a broader remedy as against the act of infringement for the reason that it involves deceit and confusion. For the aforesaid purpose, a mere likelihood would be sufficient. Likewise, a right against passing off can be asserted even as against a registered mark holder and in the absence of a registration of a mark or a design as the case may be in favour of the applicants. The said principle has also been reiterated by the High Court of Delhi in the decision of the Full Bench in MOHAN LAL, PROPRIETOR OF MOURYA INDUSTRIES V. SONA PAINT & HARDWARES (2013(55) PTC 61).

7.4. Passing off is an action meant to protect and preserve the reputation of a party. The said concept has also got an element of public interest as it intends to protect the public against the fraudulent sale by way of imitation, which might indirectly affect the quality of the product copied. In such a case, it is not absolutely necessary for the applicants to prove long user to establish reputation and goodwill. The test for likelihood of confusion is through the eyes of a man of imperfect recollection with an ordinary memory. Incidentally, it can also be seen from the point of view of the end user. In this context, the following paragraphs of the Apex Court in SATYAM INFOWAY LTD., VS. SIFYNET SOLUTIONS PVT. LTD., ((2004) 28 PTC 566) is apposite.

12. The next question is would the principles of trade mark law and in particular those relating to passing off apply? An action for passing off, as the phrase "passing off itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff's. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its service in a manner which has deceived or would be likely to deceive the public into thinking that the defendant's goods or services are the plaintiff's. The action is normally available to the owner of a distinctive trademark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? It is not essential for the plaintiff to prove long user to establish reputation in a passing off action. It would depend upon the volume of sales and extent of advertisement.

13. The second element that must be established by a plaintiff in a passing off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any malafide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to plaintiff. What has to be established is the likelihood of confusion in the minds of the public, (the word "public" being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the "imperfect recollection of a person of ordinary memory"

29. What is also important is that the respondent admittedly adopted the mark after the appellant. The appellant is the prior user and has the right to debar the respondent from eating into the goodwill it may have built up in connection with the name.

30. Another facet of passing off is the likelihood of confusion with possible injury to the public and consequential loss to the appellant. The similarity in the name may lead an unwary user of the internet of average intelligence and imperfect recollection to assume a business connection between the two. Such user may, while trying to access the information or services provided by the appellant, put in that extra 'f' and be disappointed with the result. Documents have been filed by the respondent directed at establishing that the appellant name Sify was similar to other domain names such as Scifinet, Scifi.com etc. The exercise has been undertaken by the respondent presumably to show that the word 'Sify' is not an original word and that several marks which were phonetically similar to the appellants' trade name are already registered. We are not prepared to deny the appellant's claim merely on the aforesaid basis. For one, none of the alleged previous registrants are before us. For another, the word 'sci- fi' is an abbreviation of 'science fiction' and is phonetically dissimilar to the word Sify. (See Collins Dictionary of the English Language).

7.5. A passing off action would lie where there exists a similarity of get up between the products which in turn would satisfy the test of likelihood of confusion and deceit. A useful reference can be made to the following passage in RUSTON AND HORNBY LTD. V. ZAMINDARA ENGINEERING CO. (AIR (1970) Supreme Court 1649).

"5. It very often happens that although the defendant is not using the trade mark of the plaintiff, the get up of the defendant's goods may be so much like the plaintiff's that a clear case of passing off would be proved. It is on the contrary conceivable that although the defendant may be using the plaintiff's mark the get up of the defendant's goods may be so different from the get up. of the plaintiff's

goods and the prices also may be so different that there "would be no probability of deception of the public. Nevertheless, in an action on the trade mark, that is to say, in an infringement action, an injunction would issue as soon as it is proved that the: defendant is improperly using the plaintiff's mark.

6. The action for infringement is a statutory right. It is dependent upon the validity of the registration and subject to. other restrictions laid down in ss. 30, 34 and 35 of the Act. On the other hand the gist of a passing off action is that A is not entitled to represent his goods as the goods of B but it is not necessary for B to prove that A did this knowingly or with any intent to deceive. It is enough that the get-up of B's goods has become distinctive of them and that there is. a probability of confusion between them and the goods of A. No. case of actual deception nor any actual damage need be proved."

7.6. While deciding a case of "passing off" with reference to the similarity, the Court has to see the products of both sides as a whole. This might include the shape, get up, label, package and the colour scheme. If the combined features indicate a similarity to a naked eye, the consequence will have to flow. In such a case, the onus is on the respondent to give a plausible explanation to justify its adoption. This onus will become more pronounced when the applicants are the market leader and prior user. When we take about distinctiveness, it includes that of the products as a whole as well as a single one. In other words, the commonality governing the products along with the distinctiveness of a single product are factors for consideration against a violator. Ultimately, the Court has to sit in the arm chair of an end user and decide. So is the case with distinctiveness. The substantial volume of sale is a primary indicator of the distinctiveness of a product. However, these factors will have to be seen on the facts of each case.

7.7. The concept of initial interest confusion would certainly constitute a case of "passing off". There need not be any evidence of actual confusion and deception. In BAKER HUGHES LIMITED AND ANOTHER V. HIROO KHUSHALANI AND ANOTHER (1998 (18) PTC 580 Del.), the High Court of Delhi has held as follows:

"54.....There can be an informed class of purchasers who have a degree of knowledge and a sense of discrimination more substantial than that of an ordinary purchaser, but the mere fact that the customers are sophisticated, knowledgeable and discriminating does not rule out the element of confusion if the trade marks/trade names/corporate names of two companies are identical or if the similarity between them is profound. In several cases it has been held that initial confusion is likely to arise even amongst sophisticated and knowledgeable purchasers under a mistaken belief that the two companies using the same corporate name, trading name or style are inter-related. It is the awakened consumers who are more aware of the modern business trends such as trade mark licensing, mergers, franchising, etc. It is this class of buyers who are likely to think that there is some sort of association between the products of two different companies when they come across common or similar trade names or corporate names or trading styles used by them. The sophistication of a buyer is no guarantee against likely confusion. In some cases, however, it is also possible that such a purchaser after having been misled into an initial interest in a product manufactured by an imitator discovers his folly, but this initial interest being based on confusion and deception can give rise to a cause of action for the tort of passing off as the purchaser has been made to think that there is some connection or nexus between the products and business of two disparate companies. This view finds support from various decisions gathered in Section 20.12 of the Filing Instructions 1988, Fall Cumulative Supplement from Callmann 'Unfair Competition, Trademarks and Monopolies'. This section reads as under:

"But even apart from the doctrine of greater care, if the manner of purchasing becomes routine, the possibility of confusion can arise notwithstanding the expertise of the purchasers (Layne-Western Co. Vs. Fry, 174 F Supp 621 (CCPA 1960). The mere fact that all the customers are discriminating technicians does not by itself insure against confusion; being

skilled in the relevant art does not necessarily preclude confusion if the similarity between the marks is great (Wincharger Corpn. Vs. Rinco, Inc., 297 F2d 261 (CCPA 1962)). "The words 'sophisticated' and 'knowledgeable' are not talismans which, when invoked, act magically to dissipate a likelihood of confusion. It must also be shown how the purchasers react to trademarks, how observant and discriminating they are in practice, or that the decision to purchase involves such careful consideration over such a long period of time that even subtle differences are likely to result in a recognition that different marks are involved before an irrevocable decision is made" (Refreshment Mach., Inc. Vs. Reed Industries, Inc., 196 USPQ 840 (TTAB 1977))."

"In some cases it has been held that a different type of confusion, referred to as "initial confusion," is likely to arise even among sophisticated purchasers. As one Court has said: "by intentionally copying the trade mark of another more established company, one company attempts to attract potential customers based on the reputation and name built up by the first user, the older company. The danger here is not that the sophisticated purchaser [in the oil trading market] will actually purchase from Pegasus Petroleum believing that he has purchased from Mobil [Oil Co.]; the danger is that the purchaser will be misled into an initial interest in Pegasus Petroleum based on a mistaken belief as to the two companies' inter relationships [Mobil Oil Corp. Vs. Pegasus Petroleum Corp., 229 USPQ 890]."

It has also been suggested that sophisticated consumers, being more aware of such modern business trends as trademark licensing and conglomerate mergers, are more rather than less likely to suspect some association between disparate companies or products when they see what appears to be one company's mark on another's product [Lois Sportswear, USA, Inc. Vs.

55. In John Hayter's case (supra) the Court failed to notice the principle that even the informed, sophisticated and knowledgeable customers suffer from initial confusion where the corporate names, trade names or trade marks of two different companies are the same or similar to each other. Therefore, the view expressed in the case does not commend to me and compels me to respectfully depart from the same.

7.8. The Apex Court in MAHENDRA & MAHENDRA PAPER MILLS V. MAHINDRA & MAHINDRA LTD., (AIR 2001 Supreme Court 117) held as under.

"15. This question has been considered by different High Courts and this court in umpteen cases from time to time. On analysis of the principles laid down in the decisions, certain recognised parameters relating to the matter have emerged. Without intending to be exhaustive some of the principles which are accepted as well settled may be stated, thus, that whether there is a likelihood of deception or confusion arising is a matter for decision by the court, and no witness is entitled to say whether the mark is likely to deceive or to cause confusion; that all factors which are likely to create or allay deception or confusion must be considered in combination; that broadly speaking, factors creating confusion would be, for example, the nature of the market itself, the class of customers, the extent of the reputation, the trade channels, the existence of any connection in course of trade, and others."

7.9. Thus, while dealing with the case of passing off, the Court may not be concerned with the trade mark of the parties, but the similarity involving the get up of the goods as held by the Apex Court in RUSTON AND HORNBY LTD. V. ZAMINDARA ENGINEERING CO. (AIR (1970) Supreme Court 1649) stated supra.

7.10. There is a small difference between an act of "passing off" in general and "product passing off". In dealing with the product "passing off" apart from the factors, such as, shape, get up, let out, package and colour scheme, overall configuration/appearance are relevant factors. The

concept of novelty has to be seen in the context of each case.

11.2. There are two facets of passing off, which we are concerned with in this case. One is a "product passing off" and another is "initial interest confusion". We are concerned with the products of the applicants and the respondent. In these two cases, it is not, as if the general principles will have to be given a go-by. Therefore, it could have relevancy while dealing with the facts of this case. When we deal with "product passing off", we are required to consider the two products of the parties concerned. These two products will have to be seen with respect to the same-ness, similarity or identity, as the case may be. However, in a case of a contravention of a registration granted already, its effect, will also have to be seen through the common law as well. While dealing with the product passing off, the concept of prior user would certainly apply. However, the element of long user may not be strictly necessary in all cases. For example, a newly introduced product may attract the attention of huge customers by its quality and uniqueness. In such a case, the question of period of time loses its significance. An injunction for passing off does not lie automatically. For example, the defendant succeeds through one of its defence under Section 19 of the Act, such as a prior publication having been made by the plaintiff over a design for which a protection is sought for through the Court. To put it differently, when a design comes under the public domain, it cannot be said that any subsequent user would be violating the common law remedy by its usage. In such a case, the other factors like intention, deceit, likelihood of confusion, apart from damage to reputation, would come. There is a difference between deceit and likelihood of confusion. A "deceit" is one out of intention. But a likelihood of confusion may not be with such intention. Considering the same, it has been held by Lord Denning in PARKER KNOLL INTERNATIONAL LIMITED ((1962) RPC 265) in the following manner:

"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."

11.3. This has been quoted with approval by the Bombay High Court in M/S SELVEL INDUSTRIES AND ANOTHER VS. M/s OM PLAST (INDIA) in Notice of Motion (L) No.1434 of 2016 in Suit (L) No.439 of 2016 dated 30th June/1st July 2016.

9.2. However, when a claim of passing off is made by the plaintiff being an user on generic term, he must prove that it is beyond the mere use of a generic name by the defendant.

10. The concept of initial interest confusion has to be seen in the context of each case. It has to be assessed from the point of view of the registered mark holder/prior user, the infringing party/tortfeasor and the consumer. This concept is nothing but a facet of passing off.

11. DILUTION:--

Dilution would occur when a consumer is not in a confused state of mind, but factually the plaintiff's mark is diluted.

12. Res-judicata and Estoppel:

These two principles are well known. A party will have to plead and establish the existence of res-judicata and issue estoppel. However, there is no need for a separate suit when parties act in contravention of the issues decided. Such a plea cannot be raised in a piecemeal manner by leaving out the joint tortfeasor, who was the principal defendant in the earlier suit. However, an issue decided not on a conscious consideration of relevant materials cannot be termed as a binding one. The principles also would not act against the defendants, who were not parties to the earlier proceedings. In the subsequent proceedings, if the Court comes to the conclusion after considering the relevant materials in favour of some of the defendants, who were not parties in the earlier

one, then the other defendants, notwithstanding the fact they were parties earlier, would also get the benefit. This may be so, especially, when the ultimate relief was declined in favour of the plaintiff even in the first proceeding.

13. Generic, descriptive, suggestive, arbitrary and fanciful trade marks:

13.1. These are different categories of terms governing trade mark protection. Depending upon the category, in which the goods come, the degree of protection would follow. These categories may overlap each other because of the difference in usage over a period of time. The word generic encompasses a whole group of things. Thus, it is not specified, it is a genus, in which, a product is a specie. A generic word can also be descriptive though they are not interchangeable all the time. When a mark is generic, the chance of protection to the holder is very less compared to descriptive. However, in a case where a generic term becomes descriptive, its impact would not get diluted. Certainly, in both the cases, the onus is heavily on the plaintiff who relies upon the mark.

13.2. When a trade mark is a product of imagination, thought and perspective, it becomes suggestive. Whereas, it becomes descriptive when it conveys the idea of the ingredients, qualities and characteristics of the goods. Thus, when it becomes suggestive as against descriptive, there is no need for any proof of secondary meaning. The validity of the mark would come at naught where suggestion ends and description begins. The terms 'arbitrary' and 'fanciful' are also borne out of such imagination though there is no element of suggestion involved. It is the out and out creation of the mark holder. In this connection, we would like to quote the decision rendered by one of us (Justice M.M.Sundresh) in Hatsun Agro Product Ltd., Vs. Aroky Food Products (2016(5) CTC 382).

"10. Generic and Descriptive:-

The words generic and descriptive are not inter-changeable. "Generic" would mean general and it encompasses a whole group of things. To put it otherwise, it is not specific. Therefore, the generic name is genes, which has different species. The word "bird" is a genes and the words "eagle", "crow" are species. Once a word becomes generic, it loses its exclusivity qua a registered trade mark. This is not a general principle though there are cases in which protection would still be available. When once a word becomes generic, the burden is much higher on the plaintiff to convince the Court for a prohibitory order on the strength of his registered mark. It is much more onerous when

the defendant is in some other business. However, there is a difference between the usage of generic work, which are having direct connection with the product as against the other goods. For example, if the word "Rose" is used involving in a trade dealing with the Roses, then there is a direct connection. In such a case, it may be difficult for the plaintiff being a registered mark holder to success on that score alone de horse other factors. The reason being, the plaintiff might prevent the whole world from using the said name by a sheer act of registration. When once we understand the general principle that a registration is to protect the trade, the protection given would lead to prohibit the others to use a generic word adopting the nature or quality of goods cannot generally be accepted. It is also contrary to the intention of the enactment. On the contrary, if the word "rose" is used in a software business, then it would become a fanciful or arbitrary application. It is for the reason that though the word is generic, the protection comes for the particular business and it is the business that is identified with the name and not otherwise. Therefore, such fanciful or arbitrary words are entitled for protection as a general principle."

13.3. In *Abercrombie & Fitch Company V. Hunting World Incorporated*, 537 F.2d 4, it has been observed as under.

"It will be useful at the outset to restate some basic principles of trademark law, which, although they should be familiar, tend to become lost in a welter of adjectives.

The cases, and in some instances the Lanham Act, identify four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful. The lines of demarcation, however, are not always bright. Moreover, the difficulties are compounded because a term that is in one category for a particular product may be in quite a different one for another,⁶ because a term may shift from one category to another in light of differences in usage through time,⁷

because a term may have one meaning to one group of users and a different one to others,⁸ and because the same term may be put to different uses with respect to a single product.⁹ In various ways, all of these complications are involved in the instant case.

A generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species. At common law neither those terms which were generic nor those which were merely descriptive could become valid trademarks, see *Delaware & Hudson Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323, 20 L.Ed. 581 (1872) ("Nor can a generic name, or a name merely descriptive of an article or its qualities, ingredients, or characteristics, be employed as a trademark and the exclusive use of it be entitled to legal protection"). The same was true under the Trademark Act of 1905, *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U.S. 446, 31 S.Ct. 456, 55 L.Ed. 536 (1911), except for marks which had been the subject of exclusive use for ten years prior to its enactment, 33 Stat. 726.¹⁰ While, as we shall see, p. ---- infra, the Lanham Act makes an important exception with respect to those merely descriptive terms which have acquired secondary meaning, see § 2(f), 15 U.S.C. § 1052 (f), it offers no such exception for generic marks. The Act provides for the cancellation of a registered mark if at any time it "becomes the common descriptive name of an article or substance," § 14(c). This means that even proof of secondary meaning, by virtue of which some "merely descriptive" marks may be registered, cannot transform a generic term into a subject for trademark. As explained in *J. Kohnstam, Ltd. v. Louis Marx and Company*, 280 F.2d 437, 440, 47 CCPA 1080 (1960), no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name. See, accord, *Application of Preformed Line Products Co.*, 323 F.2d 1007, 51 CCPA 775 (1963); *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845, 48 CCPA 1004

(1961); Application of Searle & Co., 360 F.2d 650, 53 CCPA 1192 (1966). We have recently had occasion to apply this doctrine of the impossibility of achieving trademark protection for a generic term, CES Publishing Corp. v. St. Regis Publications, Inc., 531 F.2d 11 (1975). The pervasiveness of the principle is illustrated by a series of well known cases holding that when a suggestive or fanciful term has become generic as a result of a manufacturer's own advertising efforts, trademark protection will be denied save for those markets where the term still has not become generic and a secondary meaning has been shown to continue. Bayer Co. v. United Drug Co., 272 F. 505 (2 Cir. 1921) (L. Hand, D. J.); DuPont Cellophane Co. v. Waxed Products Co., 85 F.2d 75 (2 Cir.) (A. N. Hand, C. J.), cert. denied, 299 U.S. 601, 57 S.Ct. 194, 81 L.Ed. 443 (1936); King-Seeley Thermos Co. v. Aladdin Industries, 1958).

Cir. 1963). A term may thus be generic in one market and descriptive or suggestive or fanciful in another.

The term which is descriptive but not generic stands on a better basis. Although § 2(e) of the Lanham Act, 15 U.S.C. § 1052, forbids the registration of a mark which, when applied to the goods of the applicant, is "merely descriptive," § 2(f) removes a considerable part of the sting by providing that "except as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce" and that the Commissioner may accept, as prima facie evidence that the mark has become distinctive, proof of substantially exclusive and continuous use of the mark applied to the applicant's goods for five years preceding the application. As indicated in the cases cited in the discussion of the unregistrability of generic terms, "common descriptive name," as used in §§ 14(c) and 15(4), refers to generic terms applied to products and not to terms that are "merely descriptive." In the former case any claim to an exclusive right must be denied since this in effect would confer a monopoly not only of the mark but of the product by

rendering a competitor unable effectively to name what it was endeavoring to sell. In the latter case the law strikes the balance, with respect to registration, between the hardships to a competitor in hampering the use of an appropriate word and those to the owner who, having invested money and energy to endow a word with the good will adhering to his enterprise, would be deprived of the fruits of his efforts.

The category of "suggestive" marks was spawned by the felt need to accord protection to marks that were neither exactly descriptive on the one hand nor truly fanciful on the other a need that was particularly acute because of the bar in the Trademark Act of 1905, 33 Stat. 724, 726, (with an exceedingly limited exception noted above) on the registration of merely descriptive marks regardless of proof of secondary meaning. See *Orange Crush Co. v. California Crushed Fruit Co.*, 54 U.S.App.D.C. 313, 297 F. 892 (1924). Having created the category the courts have had great difficulty in defining it. Judge Learned Hand made the not very helpful statement:

It is quite impossible to get any rule out of the cases beyond this: That the validity of the mark ends where suggestion ends and description begins.

Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc., 297 F. 247, 248 (2 Cir. 1923), *aff'd per curiam*, 4 F.2d 1018 (2 Cir. 1925) a statement amply confirmed by comparing the list of terms held suggestive with those held merely descriptive in 3 Callmann, *Unfair Competition, Trademarks and Monopolies* § 71.2 (3d ed.). Another court has observed, somewhat more usefully, that:

A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.

Stix Products, Inc. v. United Merchants & Manufacturers Inc., 295 F.Supp. 479, 488 (S.D.N.Y.1968) a formulation deriving from *General Shoe Corp. v. Rosen*, 111 F.2d 95, 98 (4 Cir. 1940). Also useful is the approach taken by this court in *Aluminum Fabricating Co. of*

Pittsburgh v. Season-All Window Corp., 259 F.2d 314 (2 Cir. 1958), that the reason for restricting the protection accorded descriptive terms, namely the undesirability of preventing an entrant from using a descriptive term for his product, is much less forceful when the trademark is a suggestive word since, as Judge Lumbard wrote, 259 F.2d at 317:

The English language has a wealth of synonyms and related words with which to describe the qualities which manufacturers may wish to claim for their products and the ingenuity of the public relations profession supplies new words and slogans as they are needed.

If a term is suggestive, it is entitled to registration without proof of secondary meaning. Moreover, as held in the Season-All case, the decision of the Patent Office to register a mark without requiring proof of secondary meaning affords a rebuttable presumption that the mark is suggestive or arbitrary or fanciful rather than merely descriptive.

It need hardly be added that fanciful or arbitrary terms enjoy all the rights accorded to suggestive terms as marks without the need of debating whether the term is "merely descriptive" and with ease of establishing infringement.

In the light of these principles we must proceed to a decision of this case.

14.Scope of Interference:

14.1.When the Court of first instance considered the relevant materials and passed an order at the interlocutory stage, the appellate Court is not expected to reassess it and substitute its views unless an error is apparent. The following is the law laid down by the Apex Court in Transmission Corporation of A.P., Ltd., and others Vs. Lanco Kondapalli Power (P) Ltd., ((2006) 1 Supreme Court Cases 540).

45. In 'A Treatise on The Law Governing Injunctions' by Spelling and Lewis' it is stated :

"Sec. 8. Conflict and Loss of Jurisdiction.

Where a court having general jurisdiction and having acquired jurisdiction of the subject-matter has issued an injunction, a court of

concurrent jurisdiction will usually refuse to interfere by issuance of a second injunction. There is no established rule of exclusion which would deprive a court of jurisdiction to issue an injunction because of the issuance of an injunction between the same parties appertaining to the same subject-matter, but there is what may properly be termed a judicial comity on the subject. And even where it is a case of one court having refused to grant an injunction, while such refusal does not exclude another coordinate court or judge from jurisdiction, yet the granting of the injunction by a second judge may lead to complications and retaliatory action"

46. The High Court, therefore, while noticing the interim order passed in the writ proceedings may have the said principle in mind.

47. In *Wander Ltd. and Another v. Antox India P. Ltd.* [(1990) Supp. SCC 727], it is stated :

"The interlocutory remedy is intended to preserve in status quo, the rights of parties which may appear on a prima facie case. The court also, in restraining a defendant from exercising what he considers his legal right but what the plaintiff would like to be prevented, puts into the scales, as a relevant consideration whether the defendant has yet to commence his enterprise or whether he has already been doing so in which latter case considerations somewhat different from those that apply to a case where the defendant is yet to commence his enterprise, are attracted."

14.2. The Apex Court in *Skyline Education Institute (India) Private Ltd., V. S.L.Vaswani and another* (Civil Appeal Nos.1360-1361 of 2005 dated 05.01.2010) held as follows.

13. We have thoughtfully considered the entire matter. Before pronouncing upon the tenability or otherwise of the appellant's prayer for restraining the respondents from using the word 'Skyline' for the Institute of Engineering and Technology established by them, we consider it necessary to observe that as the suit filed by the appellant is pending trial and issues raised by the parties are yet to be decided, the High Court rightly considered and decided the appellant's

prayer for temporary injunction only on the basis of the undisputed facts and the material placed before the learned Single Judge and unless this Court comes to the conclusion that the discretion exercised by the High Court in refusing to entertain the appellant's prayer for temporary injunction is vitiated by an error apparent or perversity and manifest injustice has been done to it, there will be no warrant for exercise of power under Article 136 of the Constitution. In *Wander Ltd. v. Antox India (P) Ltd* 1990 (Supp.) SCC 727, this Court was called upon to determine the scope of appellate court's power to interfere with the discretion exercised by the court of first instance in granting or refusing the prayer for temporary injunction. The facts of that case were that in the suit filed by it, respondent-Antox India (P) Ltd. had prayed for restraining the appellant from using registered trade mark 'Cal-De-Ce'. The learned Single Judge of the High Court refused to entertain the respondent's prayer but on reconsideration of the matter the Division Bench passed an order of injunction. This Court reversed the order of the Division Bench and observed:

"... In such appeals, the appellate court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by the trial court reasonably and

in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion."

14. The proposition of law laid down in *Wander Ltd. v. Antox India (P) Ltd* (supra) was reiterated in *N.R. Dongre v. Whirlpool Corporation* (supra) in which this Court considered the correctness of an order of temporary injunction passed by the learned Single Judge of the Delhi High Court in a suit filed by the respondents to restrain defendants from manufacturing, selling, advertising or in any way using the trade mark 'Whirlpool' or any other trade mark deceptively or confusingly similar to the trade mark 'Whirlpool' in respect of their goods. The claim of the plaintiffs-respondents was based on prior user of the mark 'Whirlpool'. After considering the rival pleadings and material placed before him, the learned Single Judge granted temporary injunction. The Division Bench confirmed that order and dismissed the appeal preferred by the appellant. This Court, declined to interfere with the discretion exercised by the learned Single Judge and Division Bench of the High Court and held:

"Injunction is a relief in equity and is based on equitable principles. On the above concurrent findings, the weight of equity at this stage is in favour of the plaintiffs and against the defendants. It has also to be borne in mind that a mark in the form of a word which is not a derivative of the product, points to the source of the product. The mark/name 'WHIRLPOOL' is associated for long, much prior to the defendants' application in 1986 with the Whirlpool Corporation, Plaintiff 1. In view of the prior user of the mark by Plaintiff 1 and its trans-border reputation extending to India, the trade mark 'WHIRLPOOL' gives an indication of the origin of the goods as emanating from or relating to the Whirlpool Corporation, Plaintiff 1. The High Court has recorded its satisfaction that use of the 'WHIRLPOOL' mark by the

defendants indicates prima facie an intention to pass off the defendants' washing machines as those of the plaintiffs or at least the likelihood of the buyers being confused or misled into that belief."

15. A somewhat similar view was expressed in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals* 2001 (5) SCC 73.

16. The ratio of the above noted judgments is that once the court of first instance exercises its discretion to grant or refuse to grant relief of temporary injunction and the said exercise of discretion is based upon objective consideration of the material placed before the court and is supported by cogent reasons, the appellate court will be loath to interfere simply because on a de novo consideration of the matter it is possible for the appellate court to form a different opinion on the issues of prima facie case, balance of convenience, irreparable injury and equity.

14.3. In *Neon Laboratories Ltd., Vs. Medical Technologies Ltd and others* (Civil Appeal No.1018 of 2006 dated 05.10.2015), the Apex Court has observed as under.

"3 This Court does not normally entertain appeals against interlocutory orders. In the case of trademarks, however, keeping in perspective the endemic delay in concluding cases/suits in India because of the exponentially increasing docket explosion, temporary ad interim injunctions are of far reaching consequences, oftentimes effectively deciding the lis and the disputes themselves. Possibly for this reason 'Leave' has already been granted in the present Appeal. However, it is now well entrenched in our jurisprudence that the Appellate Court should not flimsily, whimsically or lightly interfere in the exercise of discretion by a subordinate court unless such exercise is palpably perverse. Perversity can pertain to the understanding of law or the appreciation of pleadings or evidence. We shall restrict ourselves to reference in *Wander Ltd. v. Antox India P. Ltd.*

1990 Supp SCC 727, wherein it has been adumbrated that the Appellate Court ought not to "reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion". We shall be careful not to transgress these frontiers.

14.4. In *Wockhardt Limited V. Torrent Pharmaceuticals Ltd.*, and another (Civil Appeal No.9844 of 2018 dated 12.09.2018), the Apex Court has held as follows:

"(11) We are of the view that this is not a case where *Wander Ltd.* (supra) has not been heeded. On the contrary, the Division Bench has interfered on a matter of principle, pointing out errors of law by the learned Single Judge."

15. Having considered the relevant principles of law, let us summarise the submissions at the Bar.

16. Submissions of the learned counsel for the appellant:

The learned Senior Counsel appearing for the Appellant submits that the learned single Judge has not considered the scope of Section 31 of the Trade Marks Act, 1999. The findings rendered both by the learned single Judge on the earlier occasion and the Division Bench have not been understood in the correct perspective. The aforesaid findings would operate on the principle of *res judicata* and issue of estoppel. There is no need to rearray *Google India Private Limited* as party defendant. It has stated that it has not violated the law. A contempt action has also been initiated against it. There is an element of initial interest confusion that would arise in the case. The appellant has been forced to bid and pay the higher costs for its own trademark due to the defendants bidding for the same. The appellant is the prior user having substantial reputation.

Therefore, even assuming the words are generic and descriptive, the appellant has acquired the secondary meaning. A clear case of dilution made out. The respondents cannot be allowed to ride on the reputed mark of the appellant. In view of the objections raised by the learned counsel appearing for the respondents placing reliance upon the documents filed by the appellant itself, the learned Senior Counsel has fairly submitted that the following reliefs may be considered by this court.

1.That the respondent be restrained from entering into any arrangement with Google such that when the Appellant's registered trademarks are searched by a user, the respondent's website appears?

2.That the respondent be restrained from displaying in any manner the trademarks of the appellant on the respondent's websites or advertisements?

In support of his contentions, he relied on the following decisions.

- 1.Kaviraj Pandit Durga Dutt Sharma V.Navaratna Pharmaceutical Laboratories (AIR 1965 Supreme Court 980);
- 2.Laxmikant V.Patel V. Chetanbhai Sha and another ((2002) 3 Supreme Court Cases 65);
- 3.Ruston & Hornby Ltd., V. Z.Engineering Co., (AIR 1970 Supreme Court 1649);
- 4.Kapil Wadhwa & Ors.V. Samsung Electronics Co. Ltd., (2012 (194) DLT 23);
- 5.Christian Louboutin SAS Vs. Nakul Bajaj - (2018 (253) DLT 728);
- 6.SNJ Distilleries Ltd., Vs. Imperial Spirits P. Ltd., (2010 (4) LW 304);
- 7.Reddaway V. Banham (1896 RPC 218);
- 8.Ishi Khosla V. Anil Agarwal and another (2007 (34) PTC 370 (Del);
- 9.Info Edge (India) Pvt. Ltd., & Anr. Vs. Shailesh Gupta and another (ILR 2002 (I) Del. 220);
- 10.Info Edge (India) Ltd., & another V. Sumanta Bhattacharya & Another (2017 (240) DLT 737);
- 11.Rajina V. Hogan (1974 All ER 142);
- 12.Innovation Ventures, LLC V. N.V.E., Inc., No.10-2353 (6th Cir. 2012) -763 F.3d 524;
- 13.Ruston & Hornby Ltd., Vs. Z.Engineering Co., (AIR 1970 SC 1649);
- 14.Laxmikant V. Patel Vs. Chetanbhai Shah and another (2002) 3 SCC 65);
- 15.Lupin Ltd., Vs. Johnson and Johnson (2015 (1) Mh.L.J.)

16.TV Venugopal Vs. Ushodhaya Enterprises Ltd., and another (2011 (4) SCC 85); and
17.Extract from McCarthy on Trademarks and Unfair Competition by J.Thomas McCarthy Third Edition Volume 3.

17.The Submissions of the Respondents:

The learned Senior Counsel appearing for some of the respondents submits that the trademark registered is both generic and descriptive. A mere registration per se may not give legal right. Sections 17, 28 and 29 of the Trademarks Act are subject to limitations. Section 31 of the Act cannot get over the limitations. Neither any issue of estoppel involved nor res judicata would arise. We are dealing with the case where the users are tech-savvy. Even in the typed set of papers filed by the appellant in page Nos.161 and 167, it is only its name which comes first either by using its trade mark or the generic and descriptive names. Ultimately, the consumer will have to get into the website of the defendants. What the appellant challenges is the policy of the Google and the appellant at best could have filed applications in the pending suit. The injunction applications in the earlier round of litigation were dismissed. The order of the Apex Court has not been violated. If that is the case, the remedy open to the appellant is to file contempt. One has to see the case from the view of the working mechanism of 'Google', interest of the consumer and the nature of competition leading to a situation of monopoly being exercised. The defendants' names come below the appellant's. One of the defendants does not even use all the name of the appellant's mark as alleged. The suit is not maintainable by leaving out the main tortfeasor. A mere registration per se will not give absolute monopoly to the appellant. In support of their contentions, the learned Senior Counsel has made reliance upon the following decisions.

1.Abercrombie & Fitch Company V. Hunting World Incorporated, 537 F.2d 4;

2.Nestle's Products (India) Ltd., Vs. P.Thankaraja and another (AIR 1978 Madras 336);

3.T.V.Venugopal Vs. Ushodaya Enterprises Limited and another (2011 (4) Supreme Court Cases 85);

4.Horlick's Malted Milk Company V. Summerskill (The illustrated official journal (Patents) Jan 20, 1916);

5. Transmission Corporation of A.P., Ltd., and others Vs. Lanco Kondapalli Power (P) Ltd., ((2006) 1 Supreme Court Cases 540);

6. Lupin Ltd., Vs. Johnson and Johnson (2015 (1) Mh.L.J 501);

7. S.S. Kresge Company V. United Factory Outlet, Inc., et al., 598 F.2d 694 (1979);

8. Cadila Health Care Ltd., V. Gujarat co-operative Milk Marketing Federation Ltd., & others (ILR (2010) II Delhi 85 FAO (OS));

9. The Singer Manufacturing Co. V. Loog (The University of Pennsylvania Law Review 08.07.2012);

10. Profitmakar Trade Mark ((1994) R.P.C., 713);

11. Orchid Chemicals & Pharmaceuticals Ltd., Vs. Wockhardt Limited (2013 (56) PTC 558).

18. DISCUSSION:-

18.1. As stated above, this is a second round of litigation against some of the defendants excluding the fourth defendant in the earlier suit viz., Google India Private Limited. There is no reason as to why such entity is left out deliberately, especially, when it had taken a specific plea that it is following the law correctly. If a contempt petition is stated to be filed against Google, then, it is not open to the appellant to contend to the contrary that it is not a necessary party. If some of the defendants, who were parties to the earlier suit, continue to violate the orders passed, the remedy lies elsewhere. Thus, we are in respectful agreement with the order of the learned single Judge in this regard. The consumer is Tech-

savvy. He knows the importance of 'AdWord' and the search terms. We cannot get into the mind of the consumer and expect him to use different search terms. Obviously, the consumer is expected to use such term, which he is familiar with. Such a familiarity is with respect to the language, religion, caste/community, the place and the subject. 'Google' has founded its own policy, which we have noted already. The program is such, it is bound to create more options by search engine optimization and search engine marketing. These are part and parcel of the online business platform. The key words are

nothing but tools. In creating the optimization while facilitating the marketing, the idea is to have a common platform for the identical products or service. Whether that policy is right or wrong is certainly a matter for consideration in the earlier suit. The orders passed in the earlier suit did not enure to the benefit of the appellant. Perhaps, that is exactly the reason why the present suit has been filed. It is nothing but an extension of the earlier suit with few new defendants. Perhaps, the appellant could have sought for appropriate relief in the first suit as subsequent events can also be taken note of when they happened pending the suit. Unfortunately, this has not been done so and that too, without the presence of the primary actor viz., 'Google'. This is nothing but an attempt to set at naught its policy in its absence.

18.2. In the scope and ambit of Sections 29 and 31 of the Act, we have discussed already. Even the appellant has admitted that if the words 'Tamil-Matrimony' broken into two and used separately, it would not have any objection. We are not concerned with the import of Section 17 of the Act. Rather, the concern is with respect to Sections 28 to 31 of the Act. Section 32 of the Act also will not come into play as we do not find any distinctiveness involved.

18.3. In the case on hand, the appellant has conveniently registered all similar names spanning across the entire country. This may be a business prudence. It certainly will not give a distinct advantage when the defendants seek to use them in a different way. Here is a case where the defendants did not seek to use the trade mark of the appellant per se. Rather they want to get into the platform from which the consumer can choose the respective website. The grievance of the appellant that it has been forced to make more demand by the 'Adwords' chosen by the defendants cannot be countenanced, particularly, in the business of Google Private India Limited. There is no need for it to pay the amount when there is no challenge made to the policy adopted by it. Similarly in the website of some of the defendants, the words 'Tamil Matrimony' and similar words in nature have been shown. But one has to see the content of it. They only facilitate the consumer about the nature of the service offered. Here again, it differs from case to case. After all, a consumer is expected to use consciously the website he or she wants.

18.4. We may also note that all the parties are doing the same business. In fact, one of the defendants is doing a

voluntary service either by using 'AdWord' or trade mark of the appellant. Its name alone comes first. The documents filed by the appellant would indicate the abovesaid factum. That is the reason why the learned Senior Counsel appearing for the appellant fairly modified the prayer sought for.

18.5. We do not find any 'infringement' or 'passing off' involved. Once we hold that the trade mark used by the appellant is generic and descriptive in nature, the entire scenario changes. The ingredients of

'passing off' is also not made out. Certainly, the appellant seeks to have a monopoly throughout the country by mere registration of the trade marks. Ultimately, one has to see from the perspective of the consumer as well. Granting an order of injunction would amount to set aside the very policy that is being adopted by 'Google'. There is no initial interest confusion or dilution that would arise in this case. The consumer is knowledgeable and tech-savvy. He knows what he wants and what he is doing. In fact, as a competitor, the procedure adopted would only help the appellant, if one agrees with it that it has established its reputation and thus, become the forerunner and the market leader.

18.6. We do not find any likelihood of confusion involved. A user is consciously expected to go into the website of the party either the appellant or the defendants. Therefore, at that point of time, he makes the decision consciously. If the contention of the appellant is accepted, the search results shall contain only the appellant's website alone. It is certainly contrary to the established functioning of the internet.

18.7. One cannot expect the consumer to use only the particular words as 'AdWords'. After all, the word 'Matrimony' is a most common word in the field of marriage. Even before the advent of internet, the newspapers used to carry matrimony columns. When the general public understand the words in a particular way, a different meaning must be given. The appellant has not demonstrated that it has attained the secondary meaning especially when the nature of trade and business is in tune with the natural meaning of the word. The word Tamil which depicts the language gives a certain identity. A combination of these two words is one of absolute necessity to cull out the information required. As stated, this is the very essence of search engine optimization and marketing.

18.8.The learned single Judge has considered the matter in extenso. Accordingly, he came to the correct conclusion after assessing the materials placed before him. We do not find any acceptable reason to differ with the views expressed especially in the light of the judgments referred above on the scope of the Appellate Court in reassessing the materials and findings rendered by the Court of first instance.

18.9.Though the learned counsel at the Bar made reliance upon number of judgments, we are not inclined to go into the same as there is no difficulty in appreciating the principle of law laid down therein. Neither those judgments nor that of the Division Bench which dealt with the issue on the earlier occasion would entitle the appellant to get the orders of injunction against the defendants, who were arrayed as such earlier and now. Ultimately, even on the earlier occasion, the relief sought for has been declined.

18.10.The principal of Res-judicata and issue of estoppel are not available in the case. We do not think that the appellant is entitled to succeed based upon the findings rendered by the Division Bench on the earlier occasion.

18.11.For the alleged involvement of violation by the 'Google', a fresh suit cannot be the remedy and that too, against the new defendants. Even against the earlier defendants, who were also parties to the present suit, the appellant's remedy lies in the previous suit. Even on merit, we do not find anything adverse in favour of the defendants to the extent of entitling the appellant in getting the interim order. After all, the injunctions was declined on the earlier occasion except to a very limited extent. When once the Apex Court has observed that the suit has to be expedited and the issues decided, the appellant ought not to have filed the present one. In fact, the defendants contended that there is no other way except to use the same 'AdWords'.

18.12.Thus, looking from any perspective, we do not find any error warranting interference with the order passed by the

learned single Judge. Accordingly, the Original Side Appeals stand dismissed. No costs. Consequently, connected civil miscellaneous petitions are also dismissed.

Sd/-
Assistant Registrar(CS III)

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Sub Assistant Registrar

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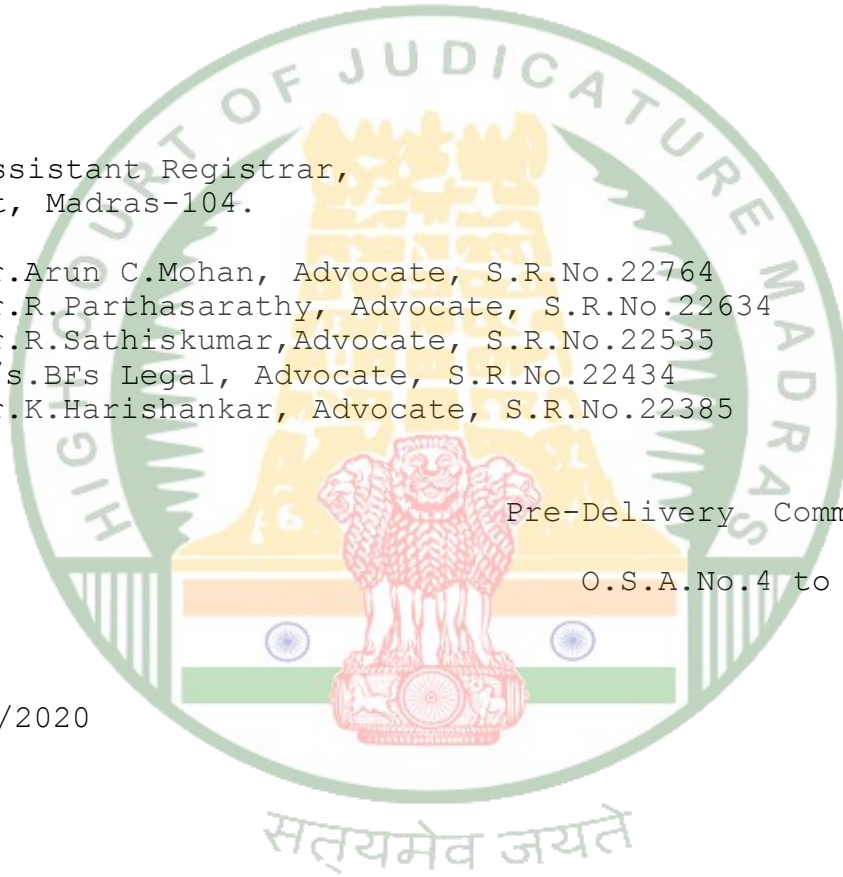
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The Sub Assistant Registrar,
High Court, Madras-104.

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