

**IN THE HIGH COURT AT CALCUTTA
CIVIL APPELLATE JURISDICTION
ORIGINAL SIDE**

Present:

THE HON'BLE JUSTICE HARISH TANDON

&

THE HON'BLE JUSTICE SHAMPA DUTT (PAUL)

**APO No. 23 OF 2020
GA No.1801 OF 2018
CS No. 132 OF 2018**

**Sk. Akram Ali
Vs.
Kumardipta Das**

Appearance:

For the Appellant : **Mr. Soumya Roy Chowdhury, Adv.**
Mr. Sarosij Das Gupta, Adv.
Mr. Chanchal Kumar Dutta, Adv.
Ms. Krishna Mullick, Adv.

For the Respondent : **Mr. Ranjan Bachawat, Sr. Adv.**
Ms. Sayantan Basu, Adv.
Mr. Debnath Ghosh, Adv.
Mr. Prithwiraj Ghosh, Adv.
Mr. Tin Kari Jana, Adv.
Mr. Gopal Das, Adv.
Mr. Sourav Jana, Adv.

Judgment On : **25.11.2022**

Harish Tandon, J.

In a suit for infringement of trademark and passing off, the Single Bench passed an order of injunction, restraining the appellant from manufacturing and/or selling tracksuit and readymade garments and hosiery goods under the trade name “**CARLTRON**” or any other mark which is either identical or deceptively similar to the respondent’s trademark “**CARLTRON**”, and/or passing off goods under the said trademark. The respondent claimed exclusive ownership over the trademark “**CARLTRON**” being used since 1993 written in a stylised manner within a rectangle preceded by a circle half of which is black and the other half is white. The respondent claimed to have used the said label with the distinctive mark “**CARLTRON**” affixed to the sportswear forming the distinctive part of it. The respondent claimed to have sold the said product in different parts of the country and acclaimed the good reputation both to the quality as well as the fabric used in manufacturing. The said sportswear had acclaimed a reputation in the players, athletes, morning walkers and the ordinary users which would be evident from the turnover between the period from 1993 to 2018.

The respondent filed an application on 24th February, 2018 for registration of the said trademark “**CARLTRON**” before the Trademark registry in respect of the tracksuits and the sports clothing under Clause 25

of the Trademarks Act, 1999 which is a pending registration. Subsequently, another application was filed on 26.06.2018 for registration of the trademark "**CARLTRON**" per se, before the trademark registry under the aforesaid clause which was also pending.

It is claimed by the respondent that the representation of the label mark "**CARLTRON**" is an artistic work within the meaning of the Copyright Act of which he acquired an ownership under No. A-83022/2008 dated 7th July, 2008 under the Copyright Act, 1957. It is alleged that the appellant is using the artistic getup of the trademark "**CARLTRON**" and the other visual getup on the packets containing the said sportswear goods of identical nature in a more deceptively manner creating the confusion in the mind of the bona fide consumer that the said goods are high quality manufactured goods by the respondent.

The suit being CS 132 of 2018 was filed for a decree for permanent injunction restraining the appellant from selling the tracksuits, readymade garments and hosiery goods under the trademark "**CARLTRON**" or any other mark which is either identical or deceptively similar to the respondent's trademark "**CARLTRON**" and also from passing off his goods under the said trademark and/or using the label or selling the said goods with the identical or deceptively similar visual getup in the packaging. An injunction was sought in the same fashion but an ad interim order was initially refused and the appellant was invited to file the opposition to the said application which, in fact, was done and by the impugned order the

Single Bench restrained the appellant from using the said trademark “**CARLTRON**” and/or passing off his goods with such trademark, including the packaging used which is deceptively similar to the visual getup of the respondent. The Single Bench held that the respondent being the registered copyright holder as prior user of the mark “**CARLTRON**” and the packaging being deceptively similar to the one used by the respondent it would be appropriate to pass an order of injunction.

The appellant filed an application under Order 41 Rule 27 of the Code of Civil Procedure in the instant appeal seeking leave to produce additional evidence which are necessary for the purpose of pronouncing the judgment by the Appellate Court.

The learned Advocate appearing for the appellant submits that although the aforesaid documents were available before the Single Bench, they could not be produced because of the lack of advice, although those are relevant for the purpose of adjudication of the points involved in the instant appeal. In support of his contention that there is no fetter on the part of the appellate Court to allow the additional evidence to be adduced at the appellate stage, if required for pronouncing a satisfactory judgment, the reliance is placed upon a judgment of the Supreme Court in case of **Wadi vs. Amilal & Ors. reported in (2015) 1 SCC 677**. It is further submitted that the registration was applied for the label “**CARLTRON**” and not anything prefix and suffix thereto and, therefore, it would not be available to the respondent to seek any reliefs on the ground of infringement of the

trademark and placed reliance upon a Division Bench judgment of the Supreme Court in case of ***M/s. Sudarshan Seeds Pvt. Ltd. Vs. Vishal Krishi Products Pvt. Ltd. reported in 2017 SCC Online Cal 16310.***

It is arduously submitted that the trademark was allowed to be used with the disclaimer that it shall not give an exclusive use of the word “**CARLTRON**” and, therefore, no exclusive right over the aforesaid word “**CARLTRON**” can be asserted by the respondent as held in case of ***Parakh Vanijya Pvt. Ltd. vs. Baroma Agro Product & Ors. reported in (2018) 16 SCC 632.*** It is further submitted that under the copyright, the complainant cannot seek a relief on the title of the literary work if the title is comprised of common words and placed reliance upon a judgment of the Supreme Court in case of ***Krishika Lulla & Ors. Vs. Shyam Vithalrao Devkatta & Anr. reported in (2016) 2 SCC 521.*** Lastly, it is submitted that the Trial Court has not recorded any reasons while passing an order of injunction, which is *sine qua non* to the administration of the judicial delivery system and placed reliance upon a judgment of the Supreme Court in a case of ***Secretary and Curator, Victoria Memorial Hall vs. Howrah Ganatantrik Nagrik Samity & Ors. reported in (2010) 3 SCC 732.***

On the other hand, the learned Advocate appearing for the respondent submits that even the registration has been granted with disclaimer that itself cannot be a ground for denial of reliefs on the ground of passing off action and placed reliance upon a judgment of the Supreme Court in case of ***Godfrey Philips India Ltd. Vs. Girnar Food & Beverages Pvt. Ltd.***

reported in (1998) 9 SCC 531. It is further submitted that the packaging containing the artistic work has not only been adopted *in toto* but the use of the word “**CARLTRON**” in a similar fashion attracts the passing off action and, there is no infirmity in granting injunction. It is vehemently submitted that in a passing off action the Court should ascertain the essential feature of the respondent’s trademark and then to find out the resemblances as well as the similarity. To buttress the aforesaid submission the reliance is placed upon a Division Bench judgment of the Bombay High Court in case of **Procter and Gamble (India) Ltd., Mumbai & Anr. vs. Endolabs Ltd., Indore & Anr. reported in (2000) 3 Mah LJ 637.** It is, thus, submitted that Section 17 of the Trademark Act forbids any exclusive right in the matter forming only a part of the whole of the trademark was registered if granted with the disclaimer yet it does not take away the right for passing off action under Section 27 (2) of the said Act.

By drawing the attention to the respective packagings containing the visual description and the getup, it is submitted that the appellant has adopted the identical and similar getup to that of the appellant’s packaging and, therefore, it not only infringes the registered artistic work under the Copyright Act but also passing off his goods that of the respondent and, therefore, there is no illegality and/or infirmity in the impugned order. It is, thus, submitted that the appeal should be dismissed.

Although, the trademark legislation was made for the first time in India in the year 1940 but even prior thereto right to prevent the other

person from knowingly and deceptively selling the goods as that of the plaintiff was recognized under the common law in United Kingdom albeit the nature of the reliefs were granted in varied form but later on the court of equity was vested with the power upon promulgation of the statute to protect and prevent such action. Initially, it was conceived to be an action of deceit, yet by a judicial pronouncement it encompasses an action on misrepresentation or deception by invading the right accrued on a person over the said mark or label.

The Trademark is defined in Section 2 (1) (zb) to mean **a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include the shape of goods, there packaging and combinations of colours.**

The intellectual property law, more particularly, the trademark law is basically founded on the premise that it encourages the fair trade in every sphere of the commercial activities and does not put any brindle or hamper to the competition. However, it aimed to put an obstacle against a person intended to damage or jeopardise the business and the reputation of another person by using a fraud, deceit, trickery or the unfair means in order to tarnish the name and reputation built up by another commercial entity from his skill and labour which he had put into it. Sub-Section (2) of Section 27 of the Act starting with the non-obstante clause does not prohibit the right to maintain an action against any person for passing off goods;

even two registered holders of the trademark can sue or be sued by the other in a passing off action which is seemingly protected under sub-Section (2) of Section 27 of the said Act. It is primarily based on a common notion that no one can pass off his goods as those of another.

Even, if the Section 17 puts a fetter on the exclusivity over the mark or the label because of the disclaimer yet Section 27 (2) of the Act creates an exception to it by the use of the non-obstante clause. The aforesaid principles can be forfeited from a judgment of the Supreme Court in case of **Godfrey Philips India Ltd. (Supra)** in these words:

“5. The order made by the Division Bench is based on its view indicated as under:-

In view of the mark which is now registered, the word ‘Super Cup’ having been disclaimed, the only effective part of the registered mark of the plaintiff is ‘Tea City’. The plaintiff/respondent therefore, prima facie, cannot claim exclusive right to use the words ‘Super Cup’ by virtue of any alleged user.

6. The proposition in the above extract is clearly in conflict with the decision of this Court in Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd. There is no dispute before us that even on disclaimer, a passing off action lies and that is the reason why Shri Jaitley did not support the above reason given by the Division Bench in its order.”

The ratio laid down in ***Parakh Vanijya Pvt. Ltd. (Supra)*** as relied upon by the appellant does not appear to be of any assistance on the aforesaid proposition although it has been held that no exclusive right over the word can be claimed because of the disclaimer to the exclusive use of the said word yet it does not rule out the right to a passing off action. In the said report, the Apex Court held that the comparison of the two label marks are substantially different and no similarity can be attached thereto in the following words:

5. The appellant is the registered owner of the label mark in Class 30 in respect of rice, flour and preparations made from cereals, bread, cakes, biscuits, pastry and spices. The appellant sells biriyani rice and the most prominent feature of its label mark is the word “MALABAR”. The appellant-plaintiff is granted registration in Class 30 for its products. Class 30 of the classification of goods and services under the statute covers diverse spices and other edible materials as wheat, rice, coffee, tea, etc. In the registration under Class 30, there is a disclaimer for the word ‘MALABAR’. The disclaimer is worded thus:

“Condition & Limitation: Registration of the trade mark shall give no right to the exclusive use of word ‘MALABAR’ and all other descriptive matters.”

6. The appellant though claims exclusive right over the word “MALABAR” since there is a disclaimer to the exclusive use

of the word “MALABAR”, the appellant has no right over the exclusive use of the word “MALABAR”. The respondents have also inter alia brought on record the materials to show the registration of other goods under Class 30 with the word “MALABAR MONSOON” granted in favour of Amalgamated Bean Coffee Trading Co. Ltd. for coffee cream, coffee included in Class 30. The registration of the mark “MALABAR MONSOON” under Class 30 also contains similar disclaimer of the word “MALABAR”. Likewise, the label “MALABAR COAST” has been registered Class 30 for coffee, tea, cocoa, sugar, etc. in favour of Tropical Retreats (P) Ltd. which again contains a similar disclaimer for the exclusive use of the word “MALABAR COAST”. Having regard to the materials placed on record, we are of the view that the High Court rightly held that the appellant cannot claim exclusive right over the use of the word “MALABAR”.

7. Insofar as the label mark used by the parties is concerned, we have perused the label mark of the appellant selling biriyani rice with word “MALABAR” and also the modified label mark of the respondents. The label of the respondents containing the words “BAROMA”, “MALABAR”, “GOLD” are circled having different get-up from that of the appellant. By comparison of the two label marks, in our view, both appear to be substantially different. There appears to be no similarity between both the labels, more so, deceptive similarity. Keeping

in view the interest of the respective parties who are said to be having substantial turnover in their respective business, the High Court rightly held that the respondents would be entitled to use the word “MALABAR” in conjunction with “BAROMA” with the different get-up as approved by the High Court. We do not find any serious infirmity warranting interference with the impugned order.”

The Division Bench of this Court in case of **M/s. Sudarshan Seeds Pvt. Ltd. (Supra)** declined to pass an order of injunction solely on the ground of suppression of the material facts. In the said report both the parties to the suit were manufacturing and selling the paddy seeds. Appellant therein was the registered holder of the mark “**TIGER BRAND**” and also sells the paddy seeds under the mark “**SWARNA GANGA**” in conjunction with the said mark “**TIGER BRAND**”. It was claimed by the appellant that “**SWARNA GANGA**” was previously used by a proprietary concern since 2002 and was assigned to the appellant company incorporated and formed in the year 2006. Subsequently, an application was made for registration of the trademark “**TIGER BRAND SWARNA GANGA**” in relation to the seeds in the year 2006 but it was contended that they are the registered proprietors of the said mark and entitled to injunction. In course of hearing the Division Bench found that the appellant therein enjoys the trademark in respect of the “**TIGER BRAND**” and not “**SWARNA GANGA**” suffix thereto and such being the suppression the Division Bench declined to pass an order of injunction.

The aforesaid judgment does not appear to have any application in the instant case for the simple reason that there is no case of suppression of material facts made out by the appellant nor anything has been produced at the behest of the appellant which may even remotely suggest such suppression. It is no doubt true that even in a passing off action the injunctions are decided on well-known parameters attributable to the consideration of an application for injunction. It is both the statutory and the discretionary right and the court may refuse to exercise discretion, if a person does not approach the Court with clean hands. The suppression of material fact is the integral part of exercise of such discretion which in fact, has been held in the above noted report.

In ***Krishika Lulla & Ors. (Supra)*** the claim relates to an infringement of copyright over the synopsis of a story written by the Respondent no. 1 therein with the title “**Desi Boys**”. Subsequently, the appellants therein released the film with the title “**Desi Boys**” and the point was raised before the Supreme Court as to whether the said Respondent no. 1 has a copyright in the title “**Desi Boys**” which he gave a synopsis of a story and the action under Section 63 of the Copyright Act is tenable. The Apex Court held that on the backdrop of the above facts that no copyright can be claimed in the title of the literary work under the aforesaid provisions in the following:

“20. In the present case, we find that there is no copyright in the title ‘Desi Boys’ and thus, no question of its infringement

arises. The prosecution based on allegations of infringement of copyright in such a title is untenable.”

In a passing off action, the ordinary test to be applied is not keeping the two marks side by side and comparing them but the proper test would be of an imperfect re-collection of the full details of the mark which an ordinary man of imperfect mental alertness would perceive, over the similarities in the marks in the eyes of the ordinary man and the confusion being created on the proprietary of the said goods i.e. it is of the plaintiff. The Court must embark a journey on the distinguishing and essential feature of the trademark of the plaintiff and then to apply a test whether the trademark of the defendant resembles the trademark of the plaintiff in relation to such distinguishing or such essential features.

It is beyond cavil of doubt that both the parties are using the mark **“CARLTRON”** and deals with sportswear, the packet which contains the sportswear are similar and identical not only the colours used therein but even the artistic work showing a same man kicking a football wearing the same jersey of the same colour and the folds on the said jersey. Even the spikes in the soccer boot are identical and similar in the packaging of the appellant. The flags displayed in the said packaging of the different nations in the packaging of the plaintiff are identical and similar to the flags shown in the packaging of the defendant. The goalpost is identically and similarly placed and, therefore, there is no confusion in our mind as to the getup, colour combination and the visuals printed on the said packaging. The only

difference one can see is the mark “**DS**” written in a small font prior to “**CARLTRON**” which is very different to be noticed on a bare look of it by an ordinary person.

Before we proceed to conclude, it is found that an application for production of the additional evidence was taken out in the instant appeal mostly relying upon the certain documents pertaining to the said trademark which, according to the appellant, could not be produced before the Trial Court. It is averred therein that the aforesaid documents though available at the time of passing of the impugned order by the Trial Court were in custody of the appellant but could not be produced because of the lack of advice. The aforesaid application has basically found on the premise that those documents shall be required by the Appellate Court in pronouncing a judgment. The appellant relied upon a judgment of the Supreme Court in **Wadi (Supra)** for the proposition if the Appellate Court feels that the aforesaid documents are necessary for pronouncing a judgment, there is no fetter on the part of the Appellate Court to permit the appellant to produce the additional evidence. In the said judgment, the Apex Court has held that it is the requirement of the Appellate Court, if the judgment so pronounced would result in a defective decision and ensure the effective judgment.

Under Order 41 Rule 27 of the Code no unbridled right is created with the appellant to produce the additional evidence before the Appellate Court but the Appellate Court may permit the additional evidence, provided the conditions mentioned therein are fulfilled. The additional evidence can

be produced if the Trial Court refused to admit evidence which ought to have been admitted or such evidence which was not within the knowledge of the appellant despite the exercise of due diligence and could not be produced at the time when the decree was passed or if any document was required to pronounce judgments. The aforesaid provision is never intended to fill up the lacunae nor the omission but to render the real justice or substantial justice and for the just decision in the appeal. It is thus the requirement of the Court and not of the party. The true and real test is whether the Appellate Court is otherwise able to pronounce the judgment on the materials before it without taking into consideration the additional evidence. The purpose of inserting the aforesaid provision is not envisioned to patch up the weak parts of the case but to fill up the omission at the appellate stage. It is, therefore, a discretion of the Appellate Court whether to permit the appellant to produce the additional evidence on the contour of the above stated principles.

The document sought to be relied on by the way of additional evidence does not appear to have any impact on the core issues involved in the instant appeal even if the trademark was allowed to be registered with the disclaimer.

As indicated above, the Apex Court in Godfrey ***Philips India Ltd. (Supra)*** had categorically held that even if the registration was done with the disclaimer, it does not confer an exclusive right upon the proprietor of the trademark yet it does not debar him from pursuing a passing off an action.

We thus do not find that it is a fit case where the said application deserves to be allowed. The same is hereby dismissed.

In view of the findings made hereinabove, we do not find that it is a fit case where the interference to the impugned order is called for. The appeal is thus dismissed.

No order as to costs.

Urgent Photostat certified copies of this judgment, if applied for, be made available to the parties subject to compliance with requisite formalities.

I agree.

(Harish Tandon, J.)

(Shampa Dutt (Paul), J.)