

**IN THE HIGH COURT AT CALCUTTA  
(Ordinary Original Civil Jurisdiction)  
COMMERCIAL DIVISION**

**Present:**

**The Hon'ble Justice Krishna Rao**

**CS 1 of 2020**

**Shyam Sel and Power Limited  
Versus  
Atibir Industries Company Limited**

Mr. Shuvasish Sengupta

Mr. Balarko Sen

Ms. Sharfaa Ahmed

Ms. Sakshi Mandelia

... for the plaintiff.

Hearing Concluded On : 10.10.2023

Judgment on : 18.10.2023

**Krishna Rao, J.:**

1. The plaintiff has filed the suit praying for a decree of permanent injunction and allied prayers.
2. The plaintiff is a company incorporated under the provisions of the Companies Act, 1956 and is engaged in the business of manufacturing,

trading and selling of TMT bars, Billets, Angels, Channels and other building materials made of iron and steel.

3. In the month of June' 1998, the predecessors of the plaintiff coined or adopted the mark "SEL" and started using and embossing the same on the TMT bars and other allied goods, products and also on different stationeries like letter heads, advertisement materials and etc. The mark "SEL" is an abbreviation or short form of "Shyam Engineering Limited". The predecessor of the plaintiff started using the mark "SEL" and "SHYAM" continuously and without any interruption.
4. On 1<sup>st</sup> April, 2000, Shyam Engineering Co. Pvt. Ltd. along with Shyam Polysel Ltd. and Pioneer Equites Pvt. Ltd. were merged with Shyam Sel Ltd. pursuant to the order dated 28<sup>th</sup> August, 2001 whereby Scheme of amalgamation was sanctioned by the High Court at Calcutta as per Section 391 and 394 of the Companies Act, 1956 in C.P. No. 365 of 2001 connected with CA No. 254 of 2001. Pursuant to the said scheme, the intellectual property rights including goodwill and reputation attached to the mark "SEL" transferred to the plaintiff. On 22<sup>nd</sup> April, 2008, the name of Shyam Sel Ltd. was changed to Shyam Sel and Power Ltd.
5. The mark "SEL" has been used extensively, uninterruptedly and continuously by the plaintiff since adoption of the mark by its predecessor in interest since the year 1998. In order to protect the statutory rights under the provisions of the Trade Marks Act, 1999, the

plaintiff has obtained registration of the trade mark “SEL STEEL” (Device) under Clause-6 being Registered Trade Mark No. 805376. The said registration was valid till 9<sup>th</sup> June, 2008 but thereafter the same was not renewed due to oversight and the said registered trade mark was removed by the Trade Mark Registry. The plaintiff had again applied for registration of the mark “SEL” (Word) “SEL” (Device) both under Clause 6 being Trade Mark Application Nos. 4315323 and 3878360 respectively. The Trade Mark applied by the plaintiff was pending before the Authority when the plaintiff had filed the present suit. During the pendency of the suit, the Registrar of Trade Mark has allowed the Mark “SEL” as Device on 30<sup>th</sup> January, 2021 under Clause 6 with effect from 4<sup>th</sup> July, 2018 and the Mark “SEL” as Word on 24<sup>th</sup> March, 2021 under Clause 6 with effect from 9<sup>th</sup> October, 2019.

6. In the month of August’ 2019, the plaintiff came to know that the defendant has launched an identical goods and product under an identical and deceptive similar mark “ISEL” in the market.
7. Mr. Shuvasish Sengupta, Leraned Advocate representing the plaintiff submitted that the defendant has adopted the trade mark “ISEL” farudently and with an intention to deceive and confuse the consumers and dealers in the market. He submits that though the defendant claims to have adopted a deceptively similar mark “ISEL” but in fact the defendant is using the mark “SEL” on the products. He further submits that the defendant has adopted and using the trade mark “ISEL” in relation to TMT bars and other allied products to trade upon the

goodwill and reputation of the plaintiff seeking to passing off its inferior goods as that of the plaintiff's well known established trade mark "SEL".

8. Mr. Sengupta submitted that the plaintiff has sent a desist notice to the defendant on 20<sup>th</sup> August, 2019, requested the defendant to refrain from using the identical and deceptively similar mark "ISEL" and on receipt of the notice, the defendant had sent a reply on 29<sup>th</sup> August, 2019 and claimed the mark is not identical and deceptively similar with the mark "SEL" as that of the plaintiff.
9. Mr. Sengupta submitted that the plaintiff had made a public search in the official website of the Trade Mark Registry and found that the defendant had suppressed that on 5<sup>th</sup> August, 2019, the defendant has purportedly applied for the registration of the mark "ISEL" (Device) before the Trade Mark Registry claiming to be the user since 5<sup>th</sup> October, 2000 but the defendant has not disclosed any documents evidencing the purported use of mark "ISEL" since 5<sup>th</sup> October, 2000.
10. Mr. Sengupta submitted that the defendant is the subsequent user and adopter of the trade mark and the plaintiff is the prior user and adopter. He submits that the defendant is using a domain name i.e [www.iselsteel.com](http://www.iselsteel.com) and has started using the mark of the plaintiff "SEL" as part of its own domain name. He submits that the defendant has fraudulently and intentionally used the mark of the plaintiff as a part of its domain name with the intention to deceive the customers and there

exists a likelihood of confusion and it is necessary to preserve the goodwill and reputation of the plaintiff as well as the interest of the customers of the plaintiff.

11. Mr. Sengupta, Learned Advocate appearing for the plaintiff has obtained service report issued by the Deputy Sheriff of this Court dated 12<sup>th</sup> September, 2023, wherein it was certified that the writ of summons of this case were served upon the defendant on 24<sup>th</sup> January, 2020. Mr. Sengupta had also obtained report from the Deputy Registrar (Ct.&J) dated 13<sup>th</sup> September, 2023 wherein it is certified that the defendant had neither appeared nor has filed written statement. On the basis of the reports, this Court had fixed the matter in the list of undefended suit.
12. Mr. Sengupta submitted that the defendant inspite of receipt of writ of summons of the present suit has chosen not to appear in the matter and had also not filed written statement and this Court has fixed the suit in the list of undefended suit, this Court by invoking the provisions of Order VIII, Rule 10 of the Code of Civil Procedure, 1908 pronounced judgment and decree to be drawn.
13. Mr. Sengupta relied upon the judgment passed by this Court reported in **2022 SCC OnLine Cal 2516 (Kaira District Cooperative Milk Producers Union Ltd. and Another -vs- Maa Tara Trading Co. and Others)**, this Court held that :

*“9. Order 8 Rule 10 had been inserted by the legislature to expedite the process of justice. The Courts can invoke its provisions to curb dilatory tactics, often resorted to by defendants by not filling the written statements by pronouncing judgments against it. At the same time, the Courts must be cautious and judged the contents of the plaint and the documents on records as being of an unimpeachable character, not requiring any evidence to be left to prove its contents. The Supreme Court in C.N. Ramappa Gowda v. C.C. Chandergowda reported in (2012) 5 SCC 265 at held as under:—*

*“25. We find sufficient assistance from the apt observations of this Court extracted hereinabove which has held that the effect [Ed : It would seem that it is the purpose of the procedure contemplated under Order 8 Rule 10 CPC upon non-filing of the written statement to expedite the trial and not penalise the defendant] of non-filing of the written statement and proceeding to try the suit is clearly to expedite the disposal of the suit and is not penal in nature wherein the defendant has to be penalised for non-filing of the written statement by trying the suit in a mechanical manner by passing a decree. We wish to reiterate that in a case where written statement has not been filed, the court should be a little more cautious in proceeding under Order 8 Rule 10 CPC and before passing a judgment, it must ensure that even if the facts set out in the plaint are treated to have been admitted, a judgment and decree could not possibly be passed without requiring him to prove the facts pleaded in the plaint.*

*26. It is only when the court for recorded reasons is fully satisfied that there is no fact*

which needs to be proved at the instance of the plaintiff in view of the deemed admission by the defendant, the court can conveniently pass a judgment and decree against the defendant who has not filed the written statement. But, if the plaint itself indicates that there are disputed questions of fact involved in the case arising from the plaint itself giving rise to two versions, it would not be safe for the court to record an ex parte judgment without directing the plaintiff to prove the facts so as to settle the factual controversy. In that event, the ex parte judgment although may appear to have decided the suit expeditiously, it ultimately gives rise to several layers of appeal after appeal which ultimately compounds the delay in finally disposing of the suit giving rise to multiplicity of proceedings which hardly promotes the cause of speedy trial.

27. However, if the court is clearly of the view that the plaintiff's case even without any evidence is prima facie unimpeachable and the defendant's approach is clearly a dilatory tactic to delay the passing of a decree, it would be justified in appropriate cases to pass even an uncontested decree. What would be the nature of such a case ultimately will have to be left to the wisdom and just exercise of discretion by the trial court who is seized of the trial of the suit.”

- 14.** Considered the submissions and the judgments relied by the plaintiff, this Court invoked the provisions of Order VIII, Rule 10 of the CPC, 1908.

15. In the case reported in **(2001) 5 SCC 73 (Cadila Health Care Ltd. -vs- Cadila Pharmaceuticals Ltd.)**, the Hon'ble Supreme Court fixed some factors which are to be taken into consideration which reads as follows:

**“10.** Under Section 28 of the Trade and Merchandise Marks Act on the registration of a trade mark in Part A or B of the register, a registered proprietor gets an exclusive right to use the trade mark in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by the Act. In the case of an unregistered trade mark, Section 27(1) provides that no person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark. Sub-section (2) of Section 27 provides that the Act shall not be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof. In other words in the case of unregistered trademarks, a passing-off action is maintainable. The passing-off action depends upon the principle that nobody has a right to represent his goods as the goods of somebody. In other words a man is not to sell his goods or services under the pretence that they are those of another person. As per Lord Diplock in *Erven Warnink BV v. J. Townend & Sons* [(1979) 2 All ER 927] the modern tort of passing off has five elements i.e. (1) a misrepresentation, (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence), and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

**35.** *Broadly stated, in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors are to be considered:*

*(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.*

*(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.*

*(c) The nature of the goods in respect of which they are used as trademarks.*

*(d) The similarity in the nature, character and performance of the goods of the rival traders.*

*(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.*

*(f) The mode of purchasing the goods or placing orders for the goods.*

*(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”*

- 16.** As per the case of the plaintiff, the plaintiff had adopted the mark “SEL” and started using and embossing the same on the TMT bars and allied products including letter heads and advertisement materials. The plaintiff is claiming the mark “SEL” but the plaintiff by an application No. 805376, under Class-6 dated 09/06/1998 had applied for the mark “SEL STEEL” as Device and the same was valid till 9<sup>th</sup> June, 2008. The plaintiff has not applied for renewal and the said registration mark was

removed. Subsequently the plaintiff has applied for registration of the mark “SEL” as DEVICE on 4<sup>th</sup> July, 2018 being Application No. 3878360 under Class-6 and on 9<sup>th</sup> October, 2019 as WORD being Application No. 4315323 under Class-6. The document relied by the plaintiff are annexed with the plaint as Annexure-B, Page-48, i.e the advertisements.

17. The plaintiff to prove the case with regard to sale of its products has enclosed audit report and copies of invoices from 1998-1999 to 2018-2019. The audit report is dated 2<sup>nd</sup> December, 2019, proves that the sale of the products of the plaintiff have been increased sufficiently.
18. The plaintiff has issued desist notice to the defendant on 20<sup>th</sup> August, 2019 (but in the plaint, it is mentioned as 22<sup>nd</sup> August, 2019). The defendant had sent a reply to the plaintiff on 29<sup>th</sup> August, 2019 which reads as follows :

“To  
Mr. Shwetaank Nigam (Advocate),  
M/s. Choudhury’s Law Offices,  
Nikko House, 3<sup>rd</sup> Floor,  
2, Hare street,  
Kolkata – 700 001, W.B. India.

Re : Illegal, Groundless and Malicious Threat to  
our Client for the use of the Trade Mark/Artistic  
Work “I S E L (Label)”.

Your Letter/Legal Notice -22/08/2019

Our Client : Mr. Sandeep Kumar Saraugi, Trading As,  
M/s Atibir Industries Co. Ltd of Registered Office at-  
20B, Abdul Hamid Street, 7<sup>th</sup> Floor, Block-7B, Kolkata –

700 069, West Bengal, Works At-Bhorandiha, P.O.-  
Udnabad, Dist- Giridh – 815301, Jharkhand, India,

Sir,

Under instructions from our Client, Mr. Sandeep Kumar Sarawgi being a Director of the Indian Incorporated Company M/s Atibir Industries Co. Ltd. of Registered Office at -20B, Abdul Hamid Street, 7<sup>th</sup> Floor, Block-7B, Kolkata – 700 069, West Bengal, Works At-Bhorandiha, P.o.- Udnabad, Dist-Giridh – 815301, Jharkhand, India, we address this communication to you in response to your Letter/Legal Notice of 22/08/2019, and we state as follows:-

1. Our Client has been shocked, surprised and perplexed when your said Letter containing such vexatious allegations, contentions and uncalled for requisitions was received. Suffice it for the purpose of this correspondence to state that the allegations made in your Letter/Notice are false, baseless having no factual support.
2. Without prejudice to the aforesaid, we state that the contents of your Letter/Notice are misconceived and without basis and we deny and dispute the contents thereof. We also state that the content of the said Letter/Notice is vague and without particulars. Your Client has misguided you and suppressed the material facts. You have (on behalf of your Client) intentionally issued such illegal and groundless threaten Letter to our Client, which is untenable in the eye of law.
3. Reply to Paragraphs 1 to 5

The statements of allegations made in these Paragraphs are denied and disputed. The allegations made in these paragraphs are completely false, factitious and fabricated. It is denied that your Client is engaged in the well known and well established business of manufacturing and trading the goods in relation to “Supplier and seller of M.S. Round, TMT

Bars and Billets, Angles, Channels and other building materials made of iron and steel included in class 6 under the Mark “SEL”. It is denied that the Mark “SEL” is the House Mark/Trading Style of your Client. As per the records the Name of Trading Style of your Client is M/s Shyam Sel and Power Limited and it has no relevance with our client’s marks “I S E L”. It is denied that the Artistic Work under the Mark “SEL” as developed by your Client is original. It is denied that the Mark “SEL” is the Intellectual Property of your Client. The questions of confusion and deception as alleged by you on behalf of your Client are false, fictitious and fabricated and having no factual support.

- As per your client they demands their right on the Trade Mark “SEL” under class-06 but when we go through the search report of the mark ‘SEL’ in class-06 there are some other marks are available and here an important point to be noted that in the search report there is no brand of your client has been yet Registered and your client’s 1<sup>st</sup> Trade Mark which was filed on 13/01/2010 under Application number 1908612 which was ABANDONED due to Not Replying of the Notice of Opposition which was filed by the one of the Registered Trade Mark proprietor of the Brand ‘SEL’ M/s. SEL Manufacturing Co. Ltd. but your client have no valid evidences to proof their existence hence they didn’t replied A Copy of the said Search Report with the Order Letter of the Abandoned is Annexed here as Annexure-A.
- Again your client filed a Trade Mark under Application No. 1958993 in class-06 on 30/04/2010 and after your clients reply during the date of Hearing which was held on 26/09/2016 at Kolkata, Trade Marks Registry and after the hearing the Honorable Deputy Registrar Of Trade Mark **REFUSED** the above said Trade Mark on dated 05/10/2016 Under Rule 40(1)- “The decision of the Registrar

under rule 38 or rule 42 after a hearing or without a hearing if the applicant has duly communicated his observations in writing and has stated that he does not desire to be heard". A Copy of the Refusal Order letter is Annexed here as Annexure-B.

- Than at last again 04/07/2018 your client again filed a new Trade Mark Application 3878360 which is also **Objected till date.** Hence it is crystal clear that your client have no right on the Brand 'SEL" he is doing and earn from the others goodwill and they have a bad intention to copy other brand and doing infringement. Hence they have no right to put allegation against our client whose Brand name is 'ISEL' which is a whole single pronouncing word. Your client only creates wrong allegation on our client with bad intension of spoiling their business. **A Copy of the Trade Mark Status is Annexed here as Annexure-C.**

4. Reply to Paragraphs 6 to 11

The statements of allegations made in these paragraphs are denied and disputed, except of those which are the matter of records only. The allegations made in these Paragraphs are completely false, fictitious and fabricated. The said Mark 'I S E L (Label)' of our Client is innovative, unique, novel Mark in respect of their said goods. The Device of 'I S E L' is pronounce as whole in a one word. Our Client does not wish to produce the said documents before you/your Client and reserves their right to produce the Evidential Documents in time before the appropriate Forum (If required for).

5. We regret to mention that these paragraphs narrate baseless and unfounded allegation against our client. Each and every statements made by you on behalf of your client are denied as these are lacking in any cogent reasoning and also are devoid of any

*merit. It appears that such a Letter/Notice to our client has been an outcome of sheer business rivalry and trade jealousy.*

6. *Your Client is also advised to withdraw the aforesaid Letter/Notice which appears to be misconceived. Our Client reserves their right to recover their damages apart from other relief(s) entirely which has been occurred by your Client through wrong allegation that destroy my client's mental and business peace/costs and consequences, which please note.*

*For SKYLINE CORPORATE  
LAW HOUSE LLP*

*Advocate  
(Attorney for the Client)."*

- 19.** The defendant in the aforesaid reply sated that the Mark "ISEL (Label)" of the defendant is innovative, unique, novel Mark in respect of their goods. The Device of "ISEL" is pronounce as a whole in one word. The plaintiff has annexed the application filed by the defendant for registration of Mark "ISEL" as Device on 5<sup>th</sup> August, 2019 and claiming to be user of the said mark since 5<sup>th</sup> October, 2000. The application shows that as on 26<sup>th</sup> December, 2019, the status was objected. In the reply, the defendant has specifically denied to produce any document to the plaintiff and in the reply, the defendant has not stated that the Mark of the defendant is registered one.

- 20.** At the time of hearing of the suit, the plaintiff has produced documents wherein it reveals that the application filed by the plaintiff dated 4<sup>th</sup> July, 2018 being Application No. 3878360, under Class-6 for

registration of Trade Mark of “SEL” as DEVICE was registered. In the said application, it is mentioned that the plaintiff is the user of the said Mark since 1<sup>st</sup> June, 1998 which corroborate the contention of the plaintiff. The other document is also application for registration being No. 4315323 dated 9<sup>th</sup> October, 2019, under Class-6 for Trade Mark “SEL” as WORD which is also registered and in the said application it is also mentioned that the plaintiff is user of the said Mark since 1<sup>st</sup> June, 1998. The documents produced by the plaintiff proves the contention of the plaintiff that the plaintiff is the user of Mark “SEL” since 1<sup>st</sup> June, 1998.

- 21.** The defendant in his application dated 5<sup>th</sup> August, 2019, being Application No. 4256698 under Clause 6 applied for registration of the Mark “ISEL” with Artistic DEVICE and claimed that the defendant is the user of the said Mark since 5<sup>th</sup> October, 2000 but the defendant has not entered appearance in the suit to prove the contention and to established that the defendant is the user of the said mark since 5<sup>th</sup> October, 2000.
- 22.** Passing off action arises out of common law and is not preconditioned on registration. The term passing off was explained by James, L.J. in as under:—

*“...I have often endeavoured to express what I am going to express now (and probably I have said it in the same words, because it is very difficult to find other words in which to express it) that is, that no man is entitled to represent his goods as being the goods of another man; and no man is permitted to use any*

mark, sign or symbol, device or other means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer.”

**23. Lord Diplock in Erven Warnink Besloten Vennootschap v. J.**

**Townend and Sons (Hull) Ltd., [1979] A.C. 731** had identified five essentials to establish an action of passing of the relevant excerpt is as under:—

*“My Lords, A.G Spalding and Brothers v. A.W. Gamage Ltd., 84 L.J.Ch 449, and the later cases make it possible to identify five characteristics which must be present in order to create a valid cause of action for passing off : (1) a misrepresentation, (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.”*

- 24.** The foregoing essentials have been accepted by the Hon’ble Supreme Court in the case of **Cadila Health Care Limited (Supra)**. At the time of hearing of the case, the Counsel for the plaintiff has produced the samples of the iron/steel rods of both the parties and on comparing the marks appearing in the said products of the parties this Court finds that the Mark of the defendant is similar to the mark of the plaintiff. Applying the tests as mentioned in the case of **Cadila Health Care Ltd. (Supra)**, this Court is of the view that defendant had tried to dupe

the general public by using the identical mark “ISEL” with respect of the TMT bars and other materials in violation of the statutory rights as well as common law rights of the plaintiff. Such usage would be would inevitably lead to loss of revenue as also that of goodwill. Accordingly, the defendant has indulged into the offence of passing off.

- 25.** The present suit is also a commercial suit within the definition of the Commercial Court, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 and it was the clear intention of the legislature that such cases should be decided expeditiously and should not be allowed to linger on. Accordingly, if the defendant fails to pursue his case or does so in a lackadaisical manner by not filing written statements, the courts should invoked the provisions of Order VIII, Rule 10 of the Code of Civil Procedure, 1908 to decree such cases.
- 26.** Resultantly, having being satisfied with the averments made and duly supported by documents and affidavit and no written statement being on record, this Court deem it fit case to for invoking the provisions of Order VIII, Rule 10 of the Code of Civil Procedure, 1908.
- 27.** The Counsel for the plaintiff during his argument has not pressed the other prayers.
- 28.** Accordingly, the present suit is decreed in favour of the plaintiff and against the defendants in terms of prayer (a), (b) and (c) of the plaint.

**29. C.S No. 1 of 2020** is thus **disposed of**. Decree be drawn accordingly.

**(Krishna Rao, J.)**