



C.S.No.888 of 2006

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 14.12.2023

Pronounced on : 21.12.2023

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

C.S.No.888 of 2006

M/s.KAS Zainulabdin & Company
A partnership firm represented by its Partner,
No.88, Angappan street,
Chennai – 600 001.

... Plaintiff

Vs.

M/s.KAS Bukhari & Company,
Represented by its partner
Mr.K.Mohideen Abdul Kader,
No.191(93), Angappan Street,
Chennai – 600 001.

... Defendant

Prayer: Civil Suit is filed under Order IV Rule 1 of O.S. Rules read with
Order VII Rule 1 CPC and Sections 134 and 135 of the Trade Marks Act,
1999, and Sections 55 and 62 of the Copyright Act, 1957, praying:-



C.S.No.888 of 2006

(a) for permanent injunction restraining the Defendant above named by themselves, their servants or agents or anyone claiming through them from in any manner infringing the plaintiff's registered trademarks label "CHAND" by using the offending trademark label "CHAND" or any other trade mark or trade mark label which is in any way identical or deceptively similar or colourable imitation of the plaintiff's registered trademark label CHAND.

b) for permanent injunction restraining the defendant by themselves, their servants or agents or anyone claiming through them from in any manner passing off their textile goods, kerchief, lungies etc. by using the offending trade mark label CHAND as and for the plaintiff's registered trade marks label CHAND or any other label which is similar or deceptively similar to that of the plaintiff's trademarks label "CHAND" either by manufacturing or selling or offering for sale or in any manner advertising the same;

c) for permanent injunction restraining the defendant by themselves, their servants or agents or anyone claiming through them



C.S.No.888 of 2006

from in any manner infringing the plaintiff's copyright in the artistic work over trademark label CHAND by using the offending trademark label CHAND or any other label or labels which are in any way deceptively similar to or a colourable imitation of the plaintiff's copyrighted label CHAND;

d) for a direction to the defendant to surrender to the plaintiff's the entire stock of unused offending label CHAND together with the blocks and dyes, name boards, signboards etc. for destruction;

e) for a direction to the defendant to render a true and faithful account of the profits earned by them through the sale of the offending textile products, lungies bearing the offending trade mark label CHAND and directing payment of such profits to the plaintiff; and

f) for a direction to the defendant to pay to the plaintiff the costs of the suit.



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C.S.No.888 of 2006

For Plaintiff : Mr.A.Prabhakara Redd
for M/s.APR Associates

For Defendant : Ms.B.Maheswari
Jeevika K.A.

JUDGMENT

The suit has been filed for the alleged infringement of the registered trademark “CHAND” (label mark) and for passing off. The suit has also been filed for the alleged infringement of copyright and for other consequential reliefs.

2. The plaintiff is in the business of manufacturing and marketing textile goods under various trademarks. They claim that they were established in the year 1910 and ever since their establishment, they are carrying on the business in the same filed.

3. According to the plaintiff, they enjoy a huge reputation and goodwill in respect of the products manufactured by them under various trademarks. One such trademark is “CHAND”, which is the subject matter of the dispute in this suit. According to the plaintiff, the



C.S.No.888 of 2006

registered trademark “CHAND” has been designed artistically consisting of special features, which is unique. After coming to know that the defendant has blatantly copied the plaintiff's trademark “CHAND” and has also copied the artistic design of the plaintiff's label for the very same business, as that of the plaintiff, namely, for manufacturing of Lungis, the plaintiff has filed this suit seeking for the reliefs sought for in the plaint.

4. However, according to the defendant, as seen from the written statement, they have not committed any infringement of the plaintiff's trademark and copyright as claimed in the plaint. According to the defendant, certain partners of the plaintiff's firm retired and formed another partnership under the name and style of M/s.Amin & Company, which carried on the business until 1980. According to the defendant, M/s.Amin & Company was permitted by the plaintiff's firm to use the trademark “CHAND” with letter 'A' added to it. According to them, the trademark “CHAND” was bifurcated with the consent of the plaintiff in the year 1952 by permitting M/s.Amin & Company to use the trademark “CHAND-A”. According to the defendant, ever since the bifurcation, the



C.S.No.888 of 2006

plaintiff has been using the mark “CHAND-Z” in order to be distinctive when compared with the trademark used by M/s.Amin & Company, which is “CHAND-A”. According to the defendant, they are engaged in the business of manufacturing and trading of Lungis under the trademark “CHAND-A”, taking over from their predecessor-in-title, namely, M/s.Amin & Company, who was earlier using the trademark “CHAND-A” since 1952.

5. Originally, the partnership firm M/s.KAS Zainulabdin & Company/plaintiff herein was started in the year 1910 by three brothers, namely, (a) Kulam M.A.K.Zainulabdin; (b) Kulam M.A.K.Ahmed Lebbai; and (c) Kulam M.A.K.Syed Mohamed Bukhari. According to the defendant, the said three brothers had conceived the label as well as the caption in a unique and stylish manner. According to the defendant, in the plaintiff's firm, namely, M/s.KAS Zainulabdin & Company, the letters KAS denote the family name “Kulam”; letter 'A' denotes the second brother 'Kulam Ahamed Lebbai', letter 'S' denotes the third brother 'Kulam Syed Mohamed Bukhari'; and 'Zainulabdin' denotes the eldest brother 'Kulam Zainulabdin'. Kulam Syed Mohamed Bukhari is



C.S.No.888 of 2006

the father of K.Mohideen Abdul Kader, partner of the defendant's firm.

According to the defendant, the plaintiff has no exclusive right over the letters 'KAS', as also coined caption 'special quality', printed in a unique and stylish manner, and the mark “CHAND”, co-authored by all three brothers.

6. According to the defendant, in their adoption of the trading style “KAS BUKHARI & Company”, K denotes their family name 'Kulam', 'A' denotes Abdur Rahman and Aboobacker, who are the sons of partner WAB.HajaraBeevi; and 'S' denotes Syed Mohamed Bukhari and Sadakathullah, who are the sons of partner K.Mohideen Abdul Kadar, and 'Bukhari' represents one of the founder partners of KAS Zainulabdin & Company. Therefore, according to the defendant, they have every right to use the letters 'KAS' and also as a descendant of Syed Mohamed Bukhari, the co-founder of the parent company KAS Zainulabdin & Company, established in the year 1910. According to the defendant, with regard to the usage of the mark “CHAND”, all the co-founders were using the mark till the separation of two brothers from the partnership firm in the year 1952. It is also their case that subsequently, based on the



C.S.No.888 of 2006

understanding among the brothers and based on the consensus reached as part of an internal arrangement, the plaintiff has been using the mark “CHAND” with a letter 'Z' in the circle and the defendant's predecessors with a letter 'A' in a circle.

7. It is also contended by the defendant that even though the plaintiff is the registered proprietor of the trademark “CHAND”, in view of the provisions of the Trademarks Act, particularly, Sections 30(2)(c)(i)&(e) as well as the Section 33, the plaintiff cannot claim exclusive right.

8. Based on the pleadings of both the plaintiff and the defendant , the following issues were framed by the court on 09.08.2021:-

- 1. Whether the plaintiff is the exclusive owner of the mark “CHAND” ?*
- 2. Whether the plaintiff has the right to use mark “CHAND” alone or comprising the letter 'Z' as a whole?*
- 3. Whether the prior user claimed by the plaintiff is true?*
- 4. Whether the use of mark “CHAND” by the*



C.S.No.888 of 2006

defendant would cause deception and confusion among the consumers?

5. Whether the plaintiff is entitled to the relief on the basis of the infringement of trademark with respect to the label “CHAND” ?

6. Whether the plaintiff is entitled to the relief of infringement of copy right in respect of the artistic work “CHAND” ?

7. Whether the plaintiff is entitled to surrender of the entire stock of unused offending goods with trademark “CHAND” together with cartons, labels, brochures, printing blocks, containers, boxes, etc., bearing the offending trademark for destruction?

8. Whether the plaintiff is entitled to accounts?

9. Whether the defendant is attempting passing off its goods as that of the plaintiff?

10. To what other relief is the plaintiff entitled?

9. Before the learned Additional Master-III, High Court, Madras Mr.K.M.Mahmood Sulaiman, one of the partners of the plaintiff's firm, was examined as a witness(PW1) on behalf of the plaintiff. He has also filed a proof affidavit reiterating the contents of the plaint. Through PW1, the following documents were marked as exhibits.



C.S.No.888 of 2006

Dated	Exhibits	Nature of document
05.08.1999	Ex.P1	The photocopy of copyright registration certificate for “CHAND” brand label
	Ex.P2	The photocopy of the certificate of renewal of trademark No.365019.
	Ex.P3	The photocopy of certificate for legal use in respect of registered trademark under No.365019 in class 24 (with objection)
01.01.2006	Ex.P4	The photocopy of partnership firm registration certificate
17.07.2006	Ex.P5	The photocopy of the legal notice
01.08.2006	Ex.P6	The photocopy of the reply notice
16.08.2006	Ex.P7	The photocopy of the rejoinder notice
29.09.2006	Ex.P8	The photocopy of the reply to rejoinder notice
	Ex.P9	The photocopy of the Plaintiff's Label
	Ex.P10	The photocopy of the Defendant's Label
	M.O.1	Specimen of the Plaintiff's product bearing the trade mark label “CHAND”
	M.O.2	Specimen of the Defendant's product bearing the trade mark label “CHAND”

PW1 was also cross-examined by the defendant's counsel before the learned Additional Master-III.

10. On the other hand, Mr.K.Mohideen Abdul Kader, one of the defendant's partners, was examined as a witness(DW1) . He has also filed his proof affidavit reiterating the contents of the written statement.



C.S.No.888 of 2006

Through DW1, the following documents were marked as exhibits:-

Dated	Exhibits	Nature of document
21.06.2022	Ex.D1	The original authorization letter (marked with the consent of the other side)
	Ex.D2	The original Holy Qoran (marked with subject to objection that it is irrelevant to this suit)
	Ex.D3	The original marriage Invitation of Defendant's family members.(marked with subject to objection that it is irrelevant to this suit)
	Ex.D4	The original page no.4,5,6,7,64,78 and 79 of the original school Magazine (marked with subject to objection that it is irrelevant to this suit)
	Ex.D5	The original Haj Guide (marked with subject to objection that it is irrelevant to this suit)
	Ex.D6	The original calender pad of the year 2004
	Ex.D7	The original calender pad of the year 2005
19.09.2005	Ex.D8	The original mediation agreement
03.06.2005	Ex.D9	The original memorandum of understanding(marked with subject to objection that it is irrelevant to this suit)
30.05.1996	Ex.D10	The certified copy of entry in the trademark register relating to trademark No.706702 in Class 24
	Ex.D11	The original marriage invitation of defendant's family members (marked with subject to the objection that it is irrelevant to this suit)
17.07.2006	Ex.D12	The photocopy(marked with consent) of the legal notice issued by the plaintiff to the defendant
01.08.2006	Ex.D13	The office copy of the reply notice
12.09.2006	Ex.D14	The photocopy of the rejoinder issued by the plaintiff counsel
29.09.2006	Ex.D15	The office copy of the reply to rejoinder sent by defendant's counsel to plaintiff's counsel
	Ex.D16	The photograph of shops of plaintiff and KSM Bukhari & Co at Kolkata.



C.S.No.888 of 2006

Dated	Exhibits	Nature of document
	Ex.D17	Photograph of Shops of plaintiff and KSM Bukhari & Company at Chennai

DW1 was also cross-examined by the plaintiff's counsel.

11. Heard Mr.A.Prabhakara Reddy, for M/s.APR Associates, learned counsel for the plaintiff, and Ms.B.Maheswari, learned counsel for the defendant.

12. The learned counsel for the plaintiff in support of his contentions submitted the following:-

(a) The plaintiff agreed to permit M/s. Amin & Company in the year 1952 to use the trademark “CHAND” with respect to different class of goods.

(b) M/s. Amin & Company, which was found in the year 1952 by some of the retiring partners of the plaintiff's firm, carried on business only upto 1980. M/s.Amin & Company was granted only permissive license to use the plaintiff's trademarks “CHAND” and since M/s. Amin & Company ceased to exist from the year 1980, registered trademark of the plaintiff “CHAND” is exclusively vested only with the plaintiff.



C.S.No.888 of 2006

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(c) The plaintiff always, in order to indicate and assure the guarantee of the goods marketed by the plaintiff under different trademark label, used a distinctive label with 'Z' in circle as a symbol of guarantee. As an internal arrangement to identify the goods of the plaintiff, M/s. Amin & Company was using the similar seal of the assurance with letter 'A'. The use of the trademark of the plaintiff by the said firm M/s. Amin & Company was only permissive and the plaintiff maintained the control with respect to the standards and quality of the goods sold by M/s. Amin & Company by using the plaintiff's trademark.

(d) M/s. Amin & Company knowing their limited right over the trademark of the plaintiff did not also apply for registration of the trademark in their name .

13. The learned counsel for the plaintiff would further submit that in the year 1978, M/s. Amin & Company was dissolved and two new firms were started by the partners of the firm M/s. Amin & Company under the name and style of “M/s. KSM Bukhari & Co and M/s Ahamad Hasan & Co.” The partners of M/s. KSM Bukhari & Company



C.S.No.888 of 2006

approached the plaintiff and requested them to continue to use the trademark label “CHAND” with letter 'A' in their newly constituted firm M/s. KSM Bukhari & Company. The plaintiff also permitted the said firm M/s. KSM Bukhari & Company to use the said trademark. The use of the said trademark by M/s.KSM Bukhari & Company formed by some of the partners of the dissolved firm M/s.Amin & Company was also only by permissive use and not to dilute the plaintiff's trademark “CHAND”. No permission was also granted to the other firm M/s.Ahmed Hasan & Company formed by other partners of M/s.Amin & Company to use the plaintiff's trademark “CHAND”. The defendant's firm, which was promoted by the retired partners of M/s.KSM Bukhari & Company in the year 2005, illegally commenced using the trademark “CHAND”, which is identical in every aspect to that of the plaintiff's trademark label.

14. Despite the cease and desist notice issued by the plaintiff, the defendant is continuing to use registered trademark of the plaintiff “CHAND” and therefore has committed an act of infringement and passing off. The label of the plaintiff is artistically designed and is unique, and copyright over the same is exclusively vested only with



C.S.No.888 of 2006

plaintiff. The defendant has also blatantly copied the artistic design and special features of the plaintiff's label and therefore they have committed infringement of copyright as well.

15. On the other hand, apart from reiterating the contents of the written statement, the learned counsel for the defendant also drew the attention of this Court to the deposition of PW1 and would submit as follows:-

(a) It is deposed by PW1 in the cross-examination that the plaintiff has not produced any document to prove that permissive license was granted to M/s.Amin & Company by the plaintiff in the year 1952 to use the trademark "CHAND".

(b) PW1 has also admitted that the plaintiff has never objected to M/s.Amin & Company for doing business with the very same trademark "CHAND".

16. The learned counsel for the defendant, after drawing the attention of this Court to Exs.D2 to D11, documents marked as exhibits on the side of the defendant, would submit that it is clear that the



C.S.No.888 of 2006

defendant and its predecessors have been using the mark “CHAND-A” for a long period of time without any opposition from the plaintiff.

17. After drawing the attention of this Court to the exhibits marked on the side of the defendant, the learned counsel of the defendant would further submit that the partners of the plaintiff are aware of the developments as they are close family members and relatives of the defendant. The arbitration award signed by all the partners of M/s.KSM Bukhari & Company as well as retirement-cum-reconstitution of partnership deed, which have been marked as Exs.D8 & D9 respectively also prove that the plaintiff's firm is aware of the usage of the trademark “CHAND-A” by the defendant as well as its predecessors.

18. The learned counsel for the defendant would submit that the defendant has not mislead the general public as alleged in the plaint. He would further reiterate that the public is fully aware of the trademark, the distinction being 'Z' adopted by the plaintiff and 'A' adopted by others for several decades; and their names and addresses apart from the words and style to distinguish their own goods from those of the plaintiff.



C.S.No.888 of 2006

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19. The learned counsel for the defendant would also finally conclude that whatever the trademark that has been used by M/s.KSM Bukhari & Company is now being used by the defendant and the same has never been objected by the plaintiff for over 4 decades. He would therefore submit that it is now not open to the plaintiff to raise any objection for the usage of the trademark by the defendant. According to him, the plaintiff and the defendant have been co-existing in the market for over 2 decades.

20. While summarizing her conclusions, the learned counsel for the defendant would submit as follows:-

(a) There is no infringement of trademark committed by the defendant as claimed by the plaintiff.

(b) There is no cause of action to file this suit against the defendant.

(c) The plaintiff is not the exclusive owner of the trademark “CHAND”.

(d) The plaintiff has not satisfied the legal requirements for



C.S.No.888 of 2006

proving passing off.

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(e) The defendant, being an honest and concurrent user of the trademark “CHAND-A”, the relief sought for in the plaint cannot be granted.

DISCUSSION

21. As per Section 101 of the Indian Evidence Act, 1872, whoever desires any Court to give judgment as to any legal right or liability depending on the existence of facts, which he asserts, must prove that those facts exist. When a person is bound to prove the existence of any fact, it is said that the burden of proof lies on that person.

22. The burden of proof can define the duty placed upon a party to prove or disprove a disputed fact, or it can define which party bears this burden. Burden of proof and onus of proof are used interchangeably and there is a difference between burden of proof and onus of proof. The well settled rules regarding the burden and onus of proof can be summarized as below:-

(a) The burden of proof lies upon a person who has to prove a fact



C.S.No.888 of 2006

and it never shifts, but, the onus of proof shifts.

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(b) The burden of proof would be on a party whose suit would fail if no evidence was let in.

(c) The burden of proof on the pleadings of a party never shifts to other party.

(d) Onus of proof by a party would cease the moment opposite party admits the transaction.

(e) When a party produces evidence in support of his statement, onus would shift on the opposite party to adduce rebutting evidence to meet the case made out by the other party.

(f) In civil cases, onus of proof is never fixed permanently, but, it would fluctuate very frequently.

23. The Indian Constitutional Courts on numerous occasions dealt with the question of burden and onus of proof and shifting of the same during the proceeding. Dealing with the question of burden of proof in an action for infringement of trademark, the Hon'ble Supreme Court in ***Kaviraj Pandit Durga Dutt Sharma Vs. Navratna Pharmaceutical***



C.S.No.888 of 2006

Laboratories [1965 1 SCR 737] held that in an action for infringement, the onus (burden of proof) would be on the plaintiff to establish that the trademark used by the defendant in the course of trade in the goods in respect of which his mark is registered are identical or deceptively similar. The Hon'ble Supreme Court further held that once the fact that the defendant is infringing his trademark is established by the plaintiff, the onus shifts on the defendant to negate the claim. The burden to prove his case remains with the plaintiff but it is the onus that does keep on shifting during the infringement proceeding.

24. In the case on hand, it has been pleaded by the plaintiff in the plaint as follows:-

(a) In and around 1952, some of the partners of the plaintiff firm retired from the partnership and started their own firm under the name and style of M/s.Amin & Company.

(b) The said M/s.Amin & Company was dissolved in the year 1980 and the partners of M/s.Amin & Company started the business in manufacturing of Lungis under the name and style of M/s.KSM Bukhari & Co.



C.S.No.888 of 2006

(c) M/s.Amin & Company requested the plaintiff to permit them to use the trademark label “CHAND” and purely on compassionate ground and magnanimity, the plaintiff permitted M/s.Amin & Company to use the trademark label “CHAND” in respect of certain specific products. However, the plaintiff was having full control over the quality of the products sold under the trademark “CHAND”.

(d) M/s.Amin & Company had no manner of right over the trademark “CHAND” as they never attempted to apply for registration of the trademark “CHAND” in their name.

(e) M/s.Amin & Company got split in the year 1980 and the partners of M/s.Amin & Company started two independent firms under the name and style of M/s.KSM Bukhari & Co. and M/s.Ahamed Hassan & Co.

(f) As requested by M/s.KSM Bukhari & Co., the plaintiff permitted them to use the said trademark in respect of certain specific products. After some period, M/s.Ahamed Hassan & co. was dissolved and ceased to carry on business.

(g) The use of the trademark of M/s.KSM Bukhari & Co. is only by way of permissive license granted by the plaintiff with suffix 'A'



C.S.No.888 of 2006

(h) In spite of permitting the same to M/s.KSM Bukhari & Co., the plaintiff again exercised control over the quality and standard of the product, on which, the trademark “CHAND” was used.

(i) The plaintiff used the letter 'Z' in their label and others were using the letter 'A'. This arrangement is purely an internal arrangement, but, for the customers, trademark “CHAND” indicated common source and same quality and standards in the products.

25. However, in the written statement, the defendant has categorically denied that only based on the permissive license granted by the plaintiff, M/s.Amin & Company started using the trademark “CHAND” in the year 1952. It is their categorical assertion that the trademark “CHAND” got bifurcated with “CHAND-A” being used by M/s.Amin & Company and “CHAND-Z” being used by the plaintiff ever since 1952. The defendant has also categorically denied that M/s.KSM Bukhari & Company did not have any right over the trademark “CHAND” as alleged in the plaint. The defendant has also pleaded in the written statement as to how they are entitled to use the trademark



C.S.No.888 of 2006

“CHAND-A” and they have traced their rights from 1952 onwards.

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26. As observed earlier, as per Section 101 of the Evidence Act, the burden of proof with regard to the pleadings of a party never shifts to the other party. When the defendant has categorically denied the grant of permissive license in its written statement, the burden of proof with regard to the pleadings made in the plaint continues to vest only with the plaintiff. It is also settled proposition of law that burden of proof would be on a party whose suit would fail even if no evidence was let in.

27. In the case on hand, pleadings contained in the plaint with regard to permissive license granted by the plaintiff for the usage of the trademark “CHAND” to M/s.Amin & Company in the year 1952 and thereafter to M/s.KSM Bukhari & Company, are not supported by any independent oral and documentary evidence. Any neutral partner of M/s.Amin & Company or M/s.KSM Bukhari & Company, who are unconnected with the subject dispute, have not been examined as a witness on the side of the plaintiff to prove the plaintiff's case. The alleged permissive license granted to M/s.Amin & Company by the



C.S.No.888 of 2006

plaintiff is of the year 1952. Even, according to the plaintiff, M/s.Amin & Company got dissolved in the year 1980 and thereafter, after a gap of 10 years, M/s.KSM Bukhari & Company was permitted to use the trademark “CHAND” by the plaintiff.

28. The plaintiff has also not filed any documentary evidence before this Court to prove their contention that even though permissive license was granted for the usage of the trademark “CHAND” to M/s.Amin & Company as well as to M/s.KSM Bukhari & Company, the plaintiff was having control over their usage. The pleadings contained in the plaint being disputed by the defendant with believable facts, necessarily the burden of proof to prove the plaintiff's contention is vested only with the plaintiff as the onus has not shifted to the defendant.

29. None of the documents which have been marked as exhibits on the side of the plaintiff is in respect of the alleged permissive license granted by the plaintiff for the usage of the trademark “CHAND” by M/s.Amin & Company in the year 1952 and by M/s.KSM Bukhari & Company thereafter. When the defendant has categorically denied that



C.S.No.888 of 2006

such a permissive license was granted by the plaintiff in its written statement as well as in its oral and documentary evidence, it is clear that the plaintiff has failed to discharge its burden of proof that such a permissive license was infact granted to M/s.Amin & Company and thereafter to M/s.KSM Bukhari & Company for the usage of the trademark “CHAND”. The defendant has also categorically pleaded that the trademark “CHAND” was bifurcated into “CHAND-A” to be used by M/s.Amin & Company and “CHAND-Z” to be used by the plaintiff in the year 1952. The defendant has also categorically contended that bifurcation was done to make the plaintiff's Lungis and the Lungis manufactured by M/s.Amin & Company distinctive. The plaintiff has not let in any independent oral and documentary evidence to disprove the contention of the defendant.

30. On the other hand, the defendant has filed documentary evidence in the form of Exs.D2 to D11 with regard to its contentions that the trademark “CHAND” was bifurcated into “CHAND-A” and “CHAND-Z”. Since no documentary evidence has been produced by the plaintiff to prove that permissive license was granted for the usage of the



C.S.No.888 of 2006

trademark “CHAND” to M/s.Amin & Company in the year 1952 and thereafter to M/s.KSM Bukhari & Company, it can be inferred that the pleadings of permissive license is only an afterthought and has been taken by the plaintiff only to prevent the defendant from using the trademark “CHAND-A”. The conduct and acquiescence on the part of the plaintiff for the usage of the trademark “CHAND” with the letter 'A' by the defendant and its predecessors from the year 1952 will also disentitle the plaintiff from seeking the relief as sought for in the plaint.

31. In the Retirement-cum-Reconstitution of Partnership dated 30.09.2005 executed between continuing partners as well as retiring partners of M/s.KSM Bukhari & Company, marked as Ex.D19, it is clearly mentioned that the trademark “CHAND-A” shall remain with both the parties of continuing partners as well as retiring partners, and both the partners shall be at liberty to use the trademark “CHAND-A” for marketing their products without any limits and bounds. Admittedly, in the Retirement-cum-Reconstitution of Partnership dated 30.09.2005/Ex.D19, the retiring partners are Mr.K.Mohideen Abdul Kader, one of the partners of defendant firm, and Mrs.W.A.B.Hajara



C.S.No.888 of 2006

Beevi, mother of Mr.Abdur Rahman and Aboobacker, who are also partners of defendant firm. Mr.K.Abdur Rahim and Mr.K.Kader Sulaiman, sons of Late Syed Mohamed Bukhari, co-founder of the plaintiff's firm, also appended their signature in Ex.D19. While that be so, the allegation of the plaintiff that the defendant has no right whatsoever to use the trademark “CHAND-A” cannot be sustained.

32. In addition to the mark “CHAND”, the alphabet 'A' adopted by the defendant and the alphabet 'Z' adopted by the plaintiff make the marks distinctive. Therefore, the general public will not be misled by the usage of the mark “CHAND-A” by the defendant, as “CHAND-A” has been admittedly in existence ever since 1952, when M/s.Amin & Company has been using the said mark for its Lungis. Since the mark “CHAND-A” is admittedly in existence ever since 1952 till the year 2006, when the present suit came to be filed, without interruption whatsoever, the question of granting the reliefs as prayed for by the plaintiff in the plaint will not arise, that too, when no documentary evidence has been produced by the plaintiff for the alleged permissive license granted to M/s.Amin & Company in the year 1952 and thereafter



C.S.No.888 of 2006

to M/s.KSM Bukhari & Company, from whom, the defendant claims to have inherited the trademark “CHAND-A”.

33. Even as seen from the cross-examination of DW1, though DW1 has deposed that his father and his father's elder brother retired from the plaintiff's firm in the year 1952 by receiving money settlement, he has deposed that the trademark was not separated and that all three brothers were continuously using it. Infact, DW1 has deposed that both the plaintiff as well as his father have used the word “CHAND”. Further, DW1 will not be in a position to comment upon the events, which lead to the retiring of partners in the plaintiff's firm in the year 1952, which lead to the formation of M/s.Amin & Company in the year 1952, as he was not a party to the said transaction. Further, as seen from the evidence available on record, PW1 would have been a minor in the year 1952. The plaintiff has also not examined any independent witness, who was a witness to the alleged transaction in the year 1952 for the purpose of proving the plaintiff's claim. The plaintiff has miserably failed to prove infringement of trademark as well as passing off against the defendant



C.S.No.888 of 2006

and they have also not proved the infringement of copyright, as the artistic features in the defendant's label are being put to use by the defendant and its predecessors-in-title ever since 1952.

34. The learned counsel for the plaintiff during the course of submissions had relied upon the following authorities:-

- (a) Addanki Narayanappa Vs. Bhaskara Krishtappa [AIR 1966 SC 1300];
- (b) S.V. Chandra Pandian Vs. S.V. Sivalinga Nadar [1993 1 SCC 589];
- (c) M/s.Power Control Appliances Vs. Sumeet Machines Private Limited [1994 2 SCC 448]; and
- (d) Ramdev Food Products (P) ltd. Vs. Arvindhbai Rambhai Patel [2006 8 SCC 726]

35. None of the authorities referred to supra will aid the plaintiff. When the plaintiff has not been able to prove that permissive license was granted to M/s.Amin & Company in the year 1952 and thereafter to M/s.KSM Bukhar & Company, through any independent oral and



C.S.No.888 of 2006

documentary evidence, and admittedly when the mark “CHAND-A” was being used ever since 1952 and “CHAND-A” being distinctive from the registered trademark “CHAND-Z” of the plaintiff, it is immaterial whether the DW1's father who was a partner in the plaintiff's firm, had received consideration on account of his retirement from the plaintiff's firm in the year 1952 or not. By virtue of the continuous, honest, concurrent and extensive use of the mark “CHAND-A” since 1952 by M/s.Amin & Company, from whom, the defendant claims to have traced its right, it cannot be said that the defendant has committed an act of infringement of the trademark and passing off and has also infringed the copyright.

36. There is a statutory protection available to the defendant under Section 12 of the Trademarks Act, 1999, when the mark is being honestly and bonafidely adopted by the defendant. When the plaintiff has not proved through any oral and documentary evidence that the defendant has dishonestly with malafide intention adopted the plaintiff's trademark “CHAND”, they cannot claim passing off against the defendant after a period of 40 years of continuous use as per Sections 12 and 33 of the



C.S.No.888 of 2006

Trademarks Act, 1999. Sections 12 and 33 of the Trademarks Act, 1999,

are extracted hereunder:-

“12. Registration in the case of honest concurrent use, etc.— *In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.*

33. Effect of acquiescence. -- *(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark--*

(a) to apply for a declaration that the registration of the later trade mark is invalid,
or

(b) to oppose the use of the later trade



C.S.No.888 of 2006

mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark was not applied in good faith.

(2) Where sub-section (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark, or as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark may no longer be invoked against his later trade mark.

37. In the instant case, the plaintiff has remained silent ever since M/s.Amin & Company started using the trademark “CHAND-A” in the year 1952. They have also remained silent when M/s.KSM Bukhari & Company started using the trademark “CHAND-A” subsequent to the dissolution of the partnership firm M/s.Amin & Company in the year 1980. Eventhough the plaintiff may contend that they had granted permissive license to both M/s.Amin & Company as well as M/s.KSM Bukhari & Company for using the trademark “CHAND-A”, non-production of any documentary evidence by the plaintiff to prove the permissive license will draw inference that the suit filed by the plaintiff



C.S.No.888 of 2006

in the year 2006 against the defendant for the alleged infringement and passing off is unbelievable and is only an afterthought. After allowing the usage of the trademark “CHAND-A” by third parties ever since 1952, the suit may have been instituted only due to the personal rivalry of the plaintiff's firm with the defendant and may also be only to harass them due to the said reason. On the acquiescence also, the suit filed by the plaintiff is hit by Section 33 of the Trademarks Act, 1999.

38. To determine whether there is an honest and concurrent use by the defendant of the trademark “CHAND” with letter 'A' in the circle, this Court will have to consider the following before arriving at a decision:-

- (a) The genuineness of the concurrent use.
- (b) The quantum of concurrent use of the trademark shown by the defendant having regard to the duration, area and volume of the trade to the case concerned.
- (c) The probability of confusion resulting from the similarity of the applicant's and opponent's trademarks as a measure of the public interest or public inconvenience.



C.S.No.888 of 2006

(d) Whether any instances of confusion have on record been proved.

(e) The relative inconvenience that may be caused to the parties concerned.

39. In the case on hand, being the plaintiff, they must prove that there was a dishonest intention on the part of the defendant to use the same trademark and they should also prove that the usage of the trademark “CHAND-A” by the defendant will cause confusion in the minds of the public. But, the plaintiff has miserably not proved the same through their oral and documentary evidence.

40. It is also to be noted that the instant suit was filed in the year 2006. Admittedly, no interim injunction was granted in favour of the plaintiff by this Court till date. Though that cannot be a legal ground for refusal of the main reliefs sought for by the plaintiff in the suit, but, it is an added reason for this Court to dismiss the suit considering the fact that the mark “CHAND-A” has been in continuous and extensive use since 1952 through M/s.Amin & Company, which has been formed by the retired partners of the plaintiff's firm in the year 1952, and even after the



C.S.No.888 of 2006

filing of this suit in the year 2006, the defendant has been using said mark for more than 17 years.

41. With regard to the plaintiff's claim for infringement of copyright, it is to be noted that the defendant has been using the label under the trademark "CHAND-A" for the past several years and their predecessors, from whom they have got the right, have been using the label with the same artistic features as that of the plaintiff's label for a long number years ever since 1952 when M/s.Amin & Company started using the trademark "CHAND-A". In view of the long usage, the same reasons given by this Court for rejecting the plaintiff's suit for infringement of trademark also hold good for infringement of copyright as well and therefore, the relief for infringement of copyright sought for in the plaint has also got to be rejected. The label of the plaintiff, which contains the letter 'Z' in circle and the label of the defendant, which contains the letter 'A' in circle will not confuse the general public with average intelligence and imperfect recollection. In view of the long usage, the plaintiff cannot now contend that the defendant has blatantly



C.S.No.888 of 2006

copied the plaintiff's copyright over its registered label. Hence, the suit for infringement of copyright has also got to be rejected by this Court.

42. Passing off happens when someone deliberately or unintentionally passes off their goods or services as those belonging to another party. When the mark “CHAND-A” is admittedly in continuous and extensive use since 1952, the question of passing off by the defendant by the adoption of the mark “CHAND-A” will not arise, as the mark is in existence for almost 70 years. The plaintiff has also not proved through independent oral and documentary evidence that permissive license was granted to M/s.Amin & Company for the usage of the trademark “CHAND” in the year 1952.

43. For the foregoing reasons, the issues framed by this Court have to be answered against the plaintiff. Accordingly, issues framed by this Court are answered in the following manner:-

Issue (1):-

Whether the plaintiff is the exclusive owner of the



C.S.No.888 of 2006

mark “CHAND”?

In view of permitting the usage of the mark “CHAND-A” by M/s.Amin & Company and its successors in interest and in view of the fact that the plaintiff has not proved the grant of permissive license to M/s.Amin & Company and M/s.KSM Bukhari & Company, the plaintiff's claim to be the exclusive owner of the mark “CHAND” has to be rejected by this Court.

Issue (2):-

Whether the plaintiff has the right to use mark “CHAND” alone or comprising the letter 'Z' as a whole?

44. From the oral and documentary evidence available on record, both the plaintiff as well as M/s.Amin & Company and its successors in interest had the right to use the mark “CHAND”. The plaintiff has exclusive right to use only the mark “CHAND-Z”.

Issue (3):-

Whether the prior user claimed by the plaintiff is true?



C.S.No.888 of 2006

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45. The mark “CHAND-A” used by the defendant is distinctive from the mark “CHAND-Z” used by the plaintiff. When M/s.Amin & Company and its successors in interest have used the trademark “CHAND-A” ever since 1952 and there was no objection raised till 2006 when the present came to be filed, the need for this Court to adjudicate as to who is the prior user does not arise. “CHAND-A” and “CHAND-Z” are being two distinctive marks, the prior user doctrine has no applicability for adjudicating the subject matter of the dispute between the plaintiff and the defendant.

Issue (4):-

Whether the use of the mark “CHAND” by the defendant would cause deception and confusion among the consumers?

46. Since the mark “CHAND-A” and “CHAND-Z” are being extensively used for almost 70 years, the question of deception and confusion among the consumers will not arise. Due to the conscious and



C.S.No.888 of 2006

uninterrupted usage for almost 70 years, certainly the use of mark “CHAND” by adding a letter 'A' by the defendant would not cause deception and confusion among the consumers.

Issues (5) & (6):-

47. The mark used by the defendant is “CHAND-A” and not “CHAND” alone. As observed earlier, by the long usage of the mark “CHAND-A” ever since 1952, it cannot be said that the usage of “CHAND-A” amounts to infringement of trademark. Hence, the plaintiff is not entitled to the relief as prayed for in the plaint as the defendant has not infringed the plaintiff's trademark or copyright.

Issues (7) to (9):-

48. Since the defendant has not committed an act of infringement or passing off and has also not committed infringement of copyright, issues (7) to (9) are also answered against the plaintiff.

49. In the result, there is no merit in this suit. However, considering the facts and circumstances of the case, the suit is dismissed



C.S.No.888 of 2006

with no costs.

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21.12.2023

Index: Yes/no
Speaking order/non-speaking
Neutral citation : Yes/no
rkm

Plaintiff's witness:

Mr.K.M.Mahmood Sulaiman - PW1

Documents exhibited by the Plaintiff:

Dated	Exhibits	Nature of document
05.08.1999	Ex.P1	The photocopy of copyright registration certificate for "CHAND" brand label
	Ex.P2	The photocopy of the certificate of renewal of trademark No.365019.
	Ex.P3	The photocopy of certificate for legal use in respect of registered trademark under No.365019 in class 24 (with objection)
01.01.2006	Ex.P4	The photocopy of partnership firm registration certificate
17.07.2006	Ex.P5	The photocopy of the legal notice
01.08.2006	Ex.P6	The photocopy of the reply notice
16.08.2006	Ex.P7	The photocopy of the rejoinder notice
29.09.2006	Ex.P8	The photocopy of the reply to rejoinder notice



C.S.No.888 of 2006

Dated	Exhibits	Nature of document
	Ex.P9	The photocopy of the Plaintiff's Label
	Ex.P10	The photocopy of the Defendant's Label
	M.O.1	Specimen of the Plaintiff's product bearing the trade mark label "CHAND"
	M.O.2	Specimen of the Defendant's product bearing the trade mark label "CHAND"

Defendant's witness:

Mr.K.Mohideen Abdul Kader - DW1

Documents exhibited by the defendant:-

Dated	Exhibits	Nature of document
21.06.2022	Ex.D1	The original authorization letter (marked with the consent of the other side)
	Ex.D2	The original Holy Qoran (marked with subject to objection that it is irrelevant to this suit)
	Ex.D3	The original marriage Invitation of Defendant's family members.(marked with subject to objection that it is irrelevant to this suit)
	Ex.D4	The original page no.4,5,6,7,64,78 and 79 of the original school Magazine (marked with subject to objection that it is irrelevant to this suit)
	Ex.D5	The original Haj Guide (marked with subject to objection that it is irrelevant to this suit)
	Ex.D6	The original calender pad of the year 2004
	Ex.D7	The original calender pad of the year 2005
19.09.2005	Ex.D8	The original mediation agreement
03.06.2005	Ex.D9	The original memorandum of understanding(marked with subject to objection that it is irrelevant to this suit)



C.S.No.888 of 2006

Dated	Exhibits	Nature of document
30.05.1996	Ex.D10	The certified copy of entry in the trademark register relating to trademark No.706702 in Class 24
	Ex.D11	The original marriage invitation of defendant's family members (marked with subject to the objection that it is irrelevant to this suit)
17.07.2006	Ex.D12	The photocopy(marked with consent) of the legal notice issued by the plaintiff to the defendant
01.08.2006	Ex.D13	The office copy of the reply notice
12.09.2006	Ex.D14	The photocopy of the rejoinder issued by the plaintiff counsel
29.09.2006	Ex.D15	The office copy of the reply to rejoinder sent by defendant's counsel to plaintiff's counsel
	Ex.D16	The photograph of shops of plaintiff and KSM Bukhari & Co at Kolkata.
	Ex.D17	Photograph of Shops of plaintiff and KSM Bukhari & Company at Chennai

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C.S.No.888 of 2006

ABDUL QUDDHOSE, J.

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C.S.No.888 of 2006

21.12.2023