

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)

BEFORE:

The Hon'ble Justice Ravi Krishan Kapur

In IP-COM/34/2024
IA NO. GA-COM/3/2025

SHANKAR ENGINEERING WORKS AND ORS.
Versus
SANKAR IRON ENGINEERING WORKS PVT. LTD. AND ORS.

For the plaintiff : Mr. Shuvasish Sengupta, Adv.
Mr. T. K. jana, Adv.
Mr. Gopal Das, Adv.
Mr. Sourav Jana, Adv.

Judgment on : 25.08.2025

RAVI KRISHAN KAPUR, J.:

1. This is an application under Order XIII A of the Code of Civil Procedure, 1908. The suit has been filed for passing off and damages. It is submitted on behalf of the plaintiffs that they are not pursuing their claim for damages.
2. Briefly, the plaintiffs are engaged in the business of manufacturing and selling various types of cast iron suction hand pumps which are used for domestic and irrigation purposes. In the course of business, the plaintiffs had filed an application bearing no. 487545 dated 18 March, 1988 before the Trade Marks Registry for registration of the mark "ASHA MAYA" in class 7. Subsequently, the said mark had been duly registered and continues to be valid and subsisting.

3. In or about 2016, the plaintiffs had also adopted and coined an associate or similar mark “ASHU MAYA” in the same category of goods. Ever since the above change, the plaintiffs have been selling their goods under the name “ASHU MAYA”. The above goods are sold in State of West Bengal as well as other parts of the country. With the passage of time, the said mark has acquired tremendous goodwill and reputation and also has impressive sale figures. As such, in view of the uninterrupted, continuous and extensive use of the said mark “ASHU MAYA”, the goods of the plaintiffs have acquired immense goodwill and reputation.
4. In or about July, 2024 upon searches being made in the official website of the Trade Marks Registry, the plaintiffs came to learn that the defendant no. 1 had filed an application being No.6207137 dated 4 December, 2023 in class 8 under the Trade Marks Act, 1999 for registration of an identical trade mark “ASHU MAYA” as “proposed to be used”. Later, the defendant no. 1 filed another application being no.6470304 in class 8 for registration of the trade mark “ASHU MAYA” (word) *per se* which is still pending claiming user since 4th December, 2023.
5. In such circumstances, the plaintiffs have filed the instant suit claiming reliefs against the defendants from using the impugned mark. Despite repeated directions, the defendants have failed to appear. The matter has been taken up in the third call, the defendants remain unrepresented. Affidavit of Service filed by the plaintiffs be kept with the records. There is also no prayer for adjournment made on behalf of the

defendants. Service report relied upon by the plaintiffs demonstrates that the time to file the Written Statement has long expired. In such circumstances, it is evident that the respondents are not interested in defending the instant suit and have no defence to the same.

For convenience, both the marks are set out hereinbelow:-

Plaintiff's Mark



Impugned mark



6. On a comparison of two marks, it appears that the impugned mark is phonetically and structurally deceptively identical to that of the plaintiffs' mark. Admittedly, the plaintiffs are prior bona fide adopters and users of the mark. The plaintiffs have also openly, continuously and uninterruptedly been using their mark. By a notice dated 17th August, 2024, the plaintiff had called upon the defendants to take necessary steps to stop using the impugned mark. The respondent refused to accept such cease and desist notice and the same was returned with the postal endorsement "Refused".
7. In *Laxmikant V. Patel vs. Chetanbhai Shah & Anr.* (2002) 3 SCC 65 it has been held as follows:

8. *It is common in trade and business for a trader or a businessman to adopt a name and/or mark under which he would carry on his trade or business. According to Kerly (Law of Trade Marks and Trade Names, 12th Edn., para 16.49), the name under which a business trades will almost always be a trade mark (or if the business provides services, a service mark, or both). Independently of questions of trade or service mark, however, the name of a business (a trading business or any other) will normally have attached to it a goodwill that the courts will protect. An action for passing-off will then lie wherever the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff, or to occasion a confusion between the two businesses. If this is not made out there is no case. The ground is not to be limited to the date of the proceedings; the court will have regard to the way in which the business may be carried on in the future, and to its not being carried on precisely as carried on at the date of the proceedings. Where there is probability of confusion in business, an injunction will be granted even though the defendants adopted the name innocently.*

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

8. In *Satyam Infoway Ltd. vs. Sifynet Solutions (P) Ltd* (2004) 6SCC 146 it has been held as follows.

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

14. *The second element that must be established by a plaintiff in a passing-off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant’s while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [Cadbury Schweppes v. Pub Squash, 1981 RPC 429 : (1981) 1 All ER 213 : (1981) 1 WLR 193 (PC); Erven Warnink v. Townend, 1980 RPC 31 : (1979) 2 All ER 927 : 1979 AC 731 (HL)] . What has to be established is the likelihood of confusion in the minds of the public (the word “public” being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the “imperfect recollection of a person of ordinary memory” [Aristoc v. Rysta, 1945 AC 68 : (1945) 1 All ER 34 (HL)] .*

15. *The third element of a passing-off action is loss or the likelihood of it.*

9. The impugned mark is deceptively similar and strikingly identical to the mark of the plaintiffs. Misrepresentation is an essential ingredient for any action of passing off. There is every likelihood of confusion and deception. The use of the impugned mark is also certain to dilute the

goodwill and reputation being enjoyed by the plaintiffs. Upon filing of the suit by an order dated 3 October, 2024, a Co-ordinate Bench had granted an order of restraint, *inter alia*, restraining the respondents from dealing with the impugned mark. Thereafter, by an order dated 14 January, 2025, this Court had confirmed the *ad interim* order of injunction.

10. In the above circumstances, the plaintiffs have been able to make out a strong case of passing off. The ingredients for maintaining an action of passing off are admitted and incontrovertible. In view of the deceptive similarity of the impugned mark there is every chance of confusion and deception. The defendants are obviously trying to ride on the goodwill of the petitioners with *mala fide* intent.
11. In view of the above, there shall be an order in terms of prayers (a) and (b) of the Notice of Motion.
12. With the above directions, GA-COM/3/2025 stands allowed. As a consequence, IP-COM/34/2024 stands decreed, in terms of the above.
13. The Department is directed to draw up the decree expeditiously.

(RAVI KRISHAN KAPUR, J.)