

Neutral Citation No. - 2024:AHC:7630

Reserved on: 22.11.2023

Delivered on: 17.01.2024

Court No. - 6

Case :- FIRST APPEAL FROM ORDER No. - 1623 of 2023

Appellant :- M/S Sai Chemicals

Respondent :- M/S Jai Chemical Works

Counsel for Appellant :- Devansh Misra, Arun Kumar Misra, Raghuvansh Misra

Counsel for Respondent :- Utkarsh Singh, Brijesh Kumar Singh

Hon'ble Rohit Ranjan Agarwal, J.

1. This is defendant's appeal filed under Order 43 Rule 1 (r) C.P.C. read with Section 13 of the Commercial Courts Act, 2015 against the judgment and order dated 01.09.2023 passed by the Presiding Officer, Commercial Court, Kanpur Nagar in Original Suit No.03 of 2020 (titled as "Jai Chemical Works Vs. M/s Sai Chemicals") granting temporary injunction to the plaintiff-respondent allowing application 6-C filed by the plaintiff and rejecting objections 22-C filed by the defendant.

2. Plaintiff-respondent filed suit under Sections 134 and 135 of the Trade Marks Act, 1999 (*hereinafter called as "Act of 1999"*) and the Copyright Act, 1957 seeking permanent injunction against the defendant-appellant for restraining infringement of Trade Mark, Copyright and passing off rendition of account etc. before the Commercial Court, Kanpur Nagar, which was registered as Original Suit No.3 of 2020.

3. According to the plaintiff, he is in the business of manufacturing and selling of detergent powder in India under the trade mark 'HARA PATTA'. The plaintiff is a proprietorship firm and one Jay Kumar is the Proprietor. He adopted the trade mark 'HARA PATTA' along with copyright label under licence from one Jitendra Kumar, who was carrying on business of manufacturing and sale of detergent powder under trade mark 'HARA PATTA' along with its unique design, colour scheme and get up since 1996. Jitendra Kumar, on 07.01.1996, had appointed as licence user to Jai Kumar, the proprietor of plaintiff under licence agreement dated 07.01.1996. The trade mark was assigned to the plaintiff by Jitendra Kumar through assignment deed dated 02.01.2004. The artistic feature of label of 'HARA PATTA' is registered under the Copyright Act on 27.07.2009, while under the Trade Mark Act, label was registered in Class 3 on 07.08.2022.

4. The label of 'HARA PATTA' comprises a unique colour scheme combination of red, green and yellow. The entire label has green background upon which a circular dense appears as a distinctive logo spreading sun rays and in the centre, a green leaf printed device is appearing, under this the trade mark 'HARA PATTA' is written in Hindi and English version is written as green leaf in red colour below the Hindi version.

5. The label was designed by one Kaushal, R/o Kanpur Nagar in the year 1996, for which, valuable consideration was paid by the plaintiff. Earlier, on 29.01.2003, an *ex-parte* injunction was granted against another unscrupulous infringers in relation to use of similar trade mark/label, in Suit No.3 of 2003.

6. In another Suit No.70 of 2008, an injunction was granted on 05.10.2009 against the defendant of that suit, which was later decreed in favour of the plaintiff. It was on 01st June, 2020 that plaintiff learnt that defendant had launched similar goods under the trade mark 'TAZZA

PATTA' bearing deceptively similar label, having similar font with similar placement of word, logo and also with red, yellow and green colours combination and other artistic features. Along with the aforesaid suit, an application under Order 39 Rule 1 and 2 read with Section 151 C.P.C. was also filed.

7. The defendant-appellant contested the suit and filed a written statement denying the facts of the plaint. In the additional plea, it has been stated that both the firms are different and the trade mark 'TAZZA PATTA' has been registered under the Act of 1999 on 10.04.2019 and under the Copyright Act on 29.08.2017. There is no similarity between the two *i.e.* 'HARA PATTA' and 'TAZZA PATTA'.

8. Moreover, the trade mark 'TAZZA PATTA' is visually and phonetically different. There is no deceptive similarity as the striking feature in the logo and leaf surrounding it make the trade mark of appellant easily distinguishable. The tag line written on the packet of defendant's goods is also distinct and bears no co-relation to the trade mark of the plaintiff. A rectification application filed by the defendant is pending before the Registrar under Section 124 of the Act of 1999. Against the application 6-C, objection through application 22-C has been preferred by the defendant.

9. The Court below, after considering the application moved under Order 39 Rule 1 and 2 and the objections preferred by the defendant, granted temporary injunction on 01.09.2023 and allowed the application 6-C of the plaintiff and rejected the objection 22-C filed by the defendant, hence the present appeal.

10. Sri Devansh Misra, learned counsel appearing for the defendant-appellant has submitted that application under Order 7 Rule 11 C.P.C. has been filed by the defendant as the suit filed is under-valued, but the trial Court had not returned any finding, nor decided the said application. He

then contended that while granting temporary injunction, the trial Court was to consider three factors *i.e.* prima facie case, balance of convenience and irreparable loss to the plaintiff. According to him, the trial Court failed to appreciate that registration of defendant-appellant's trade mark is a prima facie proof in terms of Section 31 of the Act of 1999. The trial Court had wrongly returned the finding in favour of the plaintiff as to prima facie case as the trade mark of the defendant had acquired a distinctive character in terms of Section 9 as a result of its use since 2013.

11. Learned counsel then contended that the finding of deceptive similarity between trade mark of the appellant and that of plaintiff-respondent, composite mark is to be seen and there can be no trade mark for exclusive right to use a commonly used trade name like 'PATTA'.

12. Reliance has been placed upon a decision of the Delhi High Court in case of **Carlsberg India Pvt. Ltd. Vs. Radico Khaitan Ltd., 2011 SCC Online Del 5756**. Reliance has also been placed upon a decision in the case of **Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73**.

13. Sri Misra, learned counsel then contended that the finding returned by the trial Court in respect of balance of convenience is perverse to the extent that it fails to take note into account the fact that business enterprise of the appellant has been in existence since 2013, and grant of an interim injunction at an interlocutory stage will cause greater inconvenience to appellant as compared to plaintiff, who can otherwise be adequately compensated by damages, if the suit succeeds. Reliance has been placed upon a decision in case of **American Cyanamid Co. Vs. Ethicon Ltd., 1975 AC 396 HL**.

14. Learned counsel then contended that the trial Court failed to take notice of the fact that plaintiff was well aware of the existence of appellant's firm in business of washing powder and detergent and action

for infringement of trade mark has been instituted after substantial delay, when appellant's firm had been able to create its own independent identity and goodwill in the market. There has been failure on the part of Court below to consider the import of Section 33 of the Act of 1999. Acquiescence on the part of the plaintiff, acts as a mitigating factor for tilting the balance of convenience in favour of the appellant. Reliance has been placed upon a decision of **Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries Limited and Others, (2018) 2 SCC 1.**

15. On the question of irreparable loss, he submitted that it would be fall upon the defendant-appellant as he would be made to shut down its business enterprise, rather the plaintiff's claim of irreparable injury is only with respect to loss of profit and goodwill, which will not be impossible to compute in monetary terms. Reliance has been placed upon the decision in case of **M/s Power Control Appliance and Others Vs. Sumeet Machines Pvt. Ltd., (1994) 2 SCC 448** and **S.M. Dyechem Ltd. Vs. Cadbury (India) Ltd., (2000) 5 SCC 573.**

16. Sri G.K. Singh, learned Senior Counsel appearing for the plaintiff-respondent submitted that trade mark 'HARA PATTA' has been registered since 07.08.2002 and the plaintiff, under the assignment deed executed on 07.01.1996, had been in the business of selling detergent powder under the trade mark 'HARA PATTA' with its unique design, colours scheme and get up. The defendant-appellant had entered in the business in the year 2019, after its registration of the trade mark and the label of the product of the appellant clearly resembles the label of 'HARA PATTA' as the only distinction is the word 'TAZZA' in place of 'HARA', while the colours scheme combination of red, green and yellow is the same. The logo of green leaf printed as appearing is also the same. Moreover, the photo of a boy on the label of 'HARA PATTA' is there, while that of a girl is on the label of 'TAZZA PATTA'. Looking from the label of both the products, it is deceptively similar.

17. According to Sri Singh, learned Senior Counsel, there is visually and phonetically deceptive similarity between the two trade marks. According to him, the trial Court while granting temporary injunction had held that plaintiff was in the business since 1996 and has been registered under the Trade Marks Act, 1999 in the year 2002, while the defendant-appellant was registered in the year 2019 and thus, plaintiff had made out a prima facie case for grant of injunction.

18. On the question of balance of convenience, he submitted that as there is an infringement of registered trade mark of the plaintiff by the defendant, there being violation of Section 29 (3) of the Act of 1999. The balance of convenience tilts in favour of the plaintiff, and the Court below has rightly proceeded to pass the order impugned.

19. On the question of irreparable loss, learned Senior Counsel relied upon the decision of the Apex Court in case of **Satyam Infoway Ltd. Vs. Siffynet Solutions (P) Ltd., (2004) 6 SCC 145**. According to him, there will be no irreparable loss merely on account of disruption in appellant's business as it can very well carry on its business after change of name.

20. Reliance has also been placed upon the decision in the case of **Midas Hygiene Industries (P) Ltd. And another Vs. Sudhir Bhatia and Others, (2004) 3 SCC 90** and **Parle Products (P) Ltd. Vs. J.P. and Co. Mysore, (1972) 1 SCC 618**.

21. I have heard respective counsel for the parties and perused the material on record.

22. It is a case where both plaintiff and defendant are in the same business of manufacturing and selling detergent washing powder. The plaintiff had got his trade mark registered in the year 2002 though, he claimed to be in the business since 1996, on the basis of the licence agreement dated 07.01.1996 between the proprietor of the plaintiff firm

and one Jitendra Kumar, who was carrying on business under trade mark 'HARA PATTA'.

23. On the Contrary, defendant got his trade mark registered in the name of 'TAZZA PATTA' in the year 2019, and under the Copyright Act in the year 2017.

24. Before delving into the question in regard to the effect of registration of trade mark, a glimpse of Section 17 is necessary, which spells out the effect of registration of part of a mark, which is as under:-

"17. Effect of registration of parts of a mark.- (1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark--

(a) contains any part--

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered."

25. An effort has been made by learned counsel for the appellant that Court below while returning the finding of deceptive similarity had failed to appreciate the effect that a composite trade mark has to be seen and no exclusivity can be given to a commonly used trade mark like 'PATTA'. In this backdrop, Section 17 (1) of the Act confers on the proprietor exclusive right to use of the trade mark taken as a whole.

26. In Pernod Ricard India Private Limited Vs. A B Sugars Limited & Anr., Delhi High Court in its judgment dated 31.10.2023 had the occasion to consider the said provisions and relied upon the judgment of the Apex Court as well as the Division Bench of Delhi High Court. Relevant paragraphs 44, 45, 46, 47, 48, 49, 50, 52, 53, 55, 56, 57, 58, 59, 60 and 61 are extracted here as under:-

“44. An inroad of sorts was made, in this statutory dispensation, by the judgment of the Division Bench of this Court in South India Beverages. The Court was, in that case, concerned with a challenge of infringement laid against South India Beverages Pvt Ltd ("SIB", hereinafter) by General Mills Marketing ("GMM", hereinafter). GMM was the proprietor of the registered trade mark 'HAAGEN DAZS', for processed food and ice cream, since 2007. SIB was also manufacturing ice creams and frozen desserts under the name 'D'DAAZ', since 2009. While reiterating the principle that the rival marks were to be considered in their entirety, the Court held that, in the case of a composite mark, it was permissible to accord more or less importance or dominance to a particular portion or element of the mark. The dominant part of a composite mark was referred to, by the Court, as the "dominant mark". It was held that the "anti-dissection rule" did not "impose an absolute embargo upon the consideration of the constituent elements of a composite mark", and that such consideration could "be viewed as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole". Thus, held the Court, the identification of the dominant mark did not conflict, in any manner, with the anti-dissection principle. Rather, these principles were complementary to each other. Reliance was placed, in this regard, on various foreign decisions. The Court also relied on the principle that arbitrarily chosen marks were entitled to greater protection, for which purpose it cited Kirorimal Kashiram Marketing. Interestingly, having thus enunciated the "dominant mark" principle, the Court proceeded to hold that no part of GMM's mark HAAGEN-

DAZS could be regarded as predominant, but that both parts, 'HAAGEN' and 'DAZS' were equally dominant.

45. That said, the question of whether the defendants' INDIAN STAG mark, in the present case, is deceptively similar to the plaintiff's ROYAL STAG mark, is easily answered by reference to at least five authoritative pronouncements, two by the Supreme Court and three by Division Benches of this Court.

46. Each of the rival marks, in the present case, is a composite mark consisting of two parts; in the plaintiff's case, 'ROYAL' and 'STAG' and, in the defendants', 'INDIAN' and 'STAG'. The second part of each of these marks is the same - 'STAG'. Amritdhara Pharmacy ('Amritdhara' and 'Lakshmandhara'), Ruston & Hornsby ('Ruston' and 'Rustam'), Amar Singh Chawal Wala ('Golden Quilla'/'Lal Quilla'/'Neel Quilla' and 'Hara Quilla'), Kirorimal Kashiram Marketing ('Double Deer' and 'Golden Deer') and South India Beverages ('Haagen Dazs' and 'D'Daaz') are all cases in which the common second part of the rival marks constituted the basis for the Court returning a finding of deceptive similarity and, resultantly, infringement.

47. In Amritdhara Pharmacy, the respondent Satya Deo Gupta ("Gupta" hereinafter) sought to register the trademark 'Lakshmandhara' in Class 5, for medicinal preparations. Amritdhara Pharmacy ("AP", hereinafter) opposed the application on the ground that 'Lakshmandhara' was deceptively similar to the mark 'Amritdhara' which already stood registered in favour of AP in Class 5, also for medical preparations. Among other arguments, Gupta contended that no deceptive similarity could be said to exist between the marks merely because of the common 'dhara' suffix. Besides, it was submitted that the packing and appearance of the products were distinct and different. The Division Bench of the High Court rejected AP's claim, holding that, as it had registered the entire mark "Amritdhara", it could claim monopoly only for the whole word, and not for its individual parts "Amrit" and "dhara". The Supreme Court held, in appeal, that, where the comparison was between whole words, the test

which would apply was that laid down by Parker, J., in *Pianotist Co. Application 40* as follows:

"You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks"

The Supreme Court crystallized the definitive test to be applied thus:

"A trade mark is likely to deceive or cause confusion by the resemblance to another already on the Register if it is likely to do so in the course of its legitimate use in a market where the two marks are assumed to be in use by traders in that market.....For deceptive resemblance two important questions are: (1) who are the persons whom the resemblance must be likely to deceive or confuse, and (2) what rules of comparison are to be adopted in judging whether such resemblance exists. As to confusion, it is perhaps an appropriate description of the state of mind of a customer who, on seeing a mark thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection."

*48. Having thus laid down the applicable tests, the Supreme Court proceeded to apply them. It reiterated, at the outset, the principle, earlier enunciated in *Corn Products*, that "the question has to be approached from the point of view of the mythical gentleman of average intelligence and imperfect recollection". To such a gentleman, found the Supreme Court, "the overall structural and phonetic similarity of the two names "Amritdhara" and "Lakshmandhara" islikely to deceive or cause confusion". In arriving at this finding, the Supreme Court emphasized that the overall similarity of the two composite words have to be taken into account. An unwary purchaser of average intelligence and imperfect recollection would not split the names into their component parts and consider the etymological meaning of each part or even the meaning of the words as wholes.*

"He would go more by overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which he has otherwise learnt and which he wants to purchase". The common "dhara" suffix was held not to be decisive of the matter, as the court had to consider the overall similarity of the composite words, keeping in mind the fact that they both applied to medicinal preparations of the same description. Though a critical comparison of the two names may disclose some point of difference, the Supreme Court reiterated that "an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name".

49. Thus the Supreme Court also enunciated, though not expressly, the principle that, in deciding the question of infringement, the Court was not required to compare the rivals side by side, but was to proceed from the point of view of a purchaser of average intelligence and imperfect recollection who had earlier seen the plaintiff's mark, or purchased the product bearing the plaintiff's mark, and who chanced upon the defendant's mark at a later point of time.

50. This aspect, I may note, was carried forward, to some degree, by the judgment of the Division Bench of this Court in Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blender & Distillers Pvt. Ltd. 41, in which the Division Bench of this Court expostulated, at some length, on the difference between "confusion" and "deception" apropos infringement. The Division Bench held that the test to be applied was one of initial interest confusion. If, at an initial glance at the defendant's mark, or the product bearing the defendant's mark, the consumer of average intelligence and imperfect recollection is placed in a state of wonderment as to whether the plaintiff's mark, which had seen at an earlier point of time, was the same as, or associated with, the defendant's mark, the requirement of "likelihood of confusion" within the meaning of Section 29

of the Trade Marks Act, was met. In *Amritdhara Pharmacy*, the Supreme Court clarified that the degree of confusion which would be necessary for infringement could not be fixed, and would depend on facts of each case. The judgment concluded, however, in para 12, that the overall similarity between the names "Amritdhara" and "Lakshmandhara", in respect of the same description of goods, was likely to cause deception or confusion within the meaning of the Trade Marks Act.

52. The judgment in *Amar Singh Chawal Wala* adjudicated an appeal filed by Amar Singh Chawal Wala ("ASCW"), as the proprietor of the marks Golden Qilla, Lal Qilla Chapp, Lal Qilla and Neel Qilla with the device of a fort (Qilla) in respect of rice. ASCW sought a restraint against the respondent Vardhman Rice & Genl. Mills ("Vardhman" hereinafter) using the Qilla device or the trade mark HARA QILLA. Priority of use by ASCW, over Vardhman, was admitted. The learned Single Judge of this Court rejected ASCW's prayers for interim injunction, reasoning thus:

"The device-used by the plaintiff along with GOLDEN QILLA is so materially different from the device used by the defendant along with Hara Qilla that there is no likelihood of the customer inclined to purchase Lal Qilla Rice being deceived into purchasing Hara Qilla rice. There is no visual or phonetic similarity between the defendant's name and mark- and the plaintiff's name and mark- either of the three Golden or Golden Qilla cannot be confused with Hara Qilla. So is the case with Lal Qilla and Neela Qilla..... It is not suggested, nor is it borne out from the record that the defendants have tried to present their device of Qilla in such a manner as look similar or deceptively similar with any of the device adopted by plaintiff. It is not the case of the plaintiff that any of the defendants has at any time attempted at it passing off the defendants goods as those of the plaintiff".

ASCW appealed to the Division Bench.

53. The Division Bench held that the essential feature of ASCW's mark was the word QILLA, whether it was spelt as "Qilla" or "Killa" or written in a different style or colour combination. The phonetic similarity between the registered trade mark of the plaintiff and the HARA QILLA

mark of the defendant would not stand eviscerated merely because the picture of the QILLA used by the defendant was different from that used by the plaintiff. The phonetic similarity between the two marks was held to be sufficient to confuse the consumer. The use, by Vardhman, of the device of a fort was also found to indicate the intent of Vardhman that the word "QILLA", as used by it, was to be assigned its normal etymological meaning, of a fort. These factors, in conjunction with the fact that both marks were used for rice, were held to be sufficient to give rise to confusion in the mind of the consumer regarding identity or association between them.

55. In Kirorimal Kashiram Marketing ("Kirorimal" hereinafter), Kirorimal, who produced and sold rice under the registered trade mark "Double Deer", sought an injunction against the respondent Shree Sita Chawal Udyog Mill ("SSCUM" hereinafter) using the mark "Golden Deer" also in respect of rice. The Single Judge rejected the application for interim injunction on the following reasoning:

"4. A perusal of the documents filed by the plaintiff would show that the trademark of the plaintiff consists of a figure of two deers facing each other with a flag in between. The figures and flag are enclosed in a white colour semi circle. The base of the packing is yellow and prominent colour of the trademark is red with cooked/uncooked rice shown on the pack. The trademark being used by the defendant is one single deer enclosed in a standing oval shape ring. There is peripheral rim in the ring which is having holes at regular intervals. On both sides of the ring are spikelets. The word "Golden deer" is written on the top. Neither the artistic design nor the words nor the colour combination has anything common with the design of the plaintiff's trademark. The figure of deer is also altogether different from that of the plaintiff. While the two deers in the plaintiff's trademark are males with antlers, the deer of defendant is a female only having ears and no antlers. The deers in the plaintiff's trademark are running deers with both front feet bent and rear feet stretched in running condition, the deer in the defendant's trademark is a standing deer with one front feet a little raised and bent. The contention of the plaintiff that the defendant's trademark is deceptively similar to that of the plaintiff is on the face of it a false and wrong contention. Neither the trademark of the plaintiff was being infringed by

defendant. The plaintiff has no prima facie case to contend that the defendant was passing off the goods as that of the plaintiff. There is no similarity between the label of plaintiff and that of the defendant. The learned counsel for plaintiff vehemently argued that the defendant had no right to use the word "golden deer" since the plaintiff was using the word "double deer". He submitted that the rice may be purchased by the illiterate persons and they purchase the same only looking at the figure of deer and they would not go into the nicety of the fact whether there were two deers or one deer and, therefore, use of the word "deer" by the defendant amounted to infringement of the plaintiff's trademark.

5. The test to be applied as if the defendant was passing off his goods as those of the plaintiff. It is not the case of the plaintiff that goods of the plaintiff were known by the name of "deer" or by the mark deer alone. It is the plaintiff's own case that its goods are known by mark of "double deer" and two stags with antlers were shown on the mark facing each other, across a flag. The goods bearing the mark of two deers with antlers cannot be confused by the goods having mark of one deer, which is altogether different from that mark of plaintiff. The devise used by the plaintiff along with double deer is materially different from one used by the defendant along with golden deer. There is no likelihood or customers confusing one deer with two deers and golden deer with double deers, even if the customer is illiterate. There is no similarity between the defendant's label and that of plaintiff's name. Neither there is visual similarity between defendant's name and the plaintiff's name. Any customer of plaintiff's rice would certainly ask for double deer and would not ask for golden deer. Even an illiterate person who can see if there are two deers on the label or there is only one deer on the label. It is not the case of the plaintiff that defendant has tried to present its device in such a manner so as to look similar or deceptively similar with the devise of the plaintiff. Neither the plaintiff has placed on record any material to show that the defendant has attempted to pass off its goods as those of the plaintiff's. Even the areas of business of plaintiff and defendant are different."

56. The Division Bench, in appeal, disapproved, at the very outset, the manner in which the learned Single Judge had proceeded. The Division Bench held that "the overriding aspect....is that deer is a prominent part of the trade mark of the appellant". Once such a prominent part of Kirorimal's trade mark had been copied, a finding of

deceptive similarity was bound to follow especially when both marks were used for the same product. "Deer" it was noted, was an arbitrary mark when used in respect of rice, as a deer has no connection or correlation with rice. Such an arbitrary mark was found to be entitled to a very high degree of protection, especially as it was registered, and the use of the "Double Deer" mark, by Kirorimal, was anterior in point of time to the mark "Golden Deer" by SSCUM. The Division Bench held that copying of a prominent part of a mark was impermissible and relied, for this purpose, on the decision of an earlier Division Bench of this Court in Goenka Institute of Education and Research v. Anjani Kumar Goenka. In this regard, the Division Bench also relied on the observation of the Supreme Court in Kavirat Pandit Durga Dutt Sharma that "if the essential features of a trade mark of the plaintiff have been adopted by the defendant, the fact that the get up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the Plaintiff". Thus, copying of the essential features of the plaintiff's mark by the defendant was found, ipso facto, to result in infringement. The Court also found that the issue in controversy mirrored the dispute which had earlier come up before this Court in Amar Singh Chawal Wala, the similarity between the two cases being thus noted:

"8. The aforesaid ratio of the Division Bench in the case of Amar Singh Chawal Wala (supra) squarely applies to the facts of the present case because the expression "Deer" is arbitrarily adopted with respect to the product rice and "deer" is a prominent part of the trademark "Double Deer" of the appellant, similar to the prominent word mark Qilla in the case of Amar Singh Chawal Wala (supra). The respondent has also failed to give any satisfactory explanation as to why it adopted the expression "Deer" when there already existed a registered trademark "Double Deer" of the appellant."

57. Holding, therefore, that the mark "Golden Deer" was deceptively similar to the mark "Double Deer" the Division Bench AIR 2009 Del 139 reversed the decision of the Single Judge and granted injunction. A plea of delay, which was raised by SSCUM was also negated, holding that delay would be relevant only if it resulted in acquiescence.

58. On this aspect of the matter, the last decision that needs to be noted is South India Beverages with which I have already dealt earlier in this judgment. In that case, on the ground of phonetic similarity result as a use, by the appellant SIB, of the suffix "DAAZS", in its mark "D-DAAZS" vis-à-vis GMM's mark "HAAGEN-DAZS", confusion was likely to result, injunction was granted by the Division Bench.

59. When one applies these decisions to the facts of the present case, it is apparent that the mark INDIAN STAG has to be held to be deceptively similar to the mark ROYAL STAG. Though a faint submission was sought to be raised, by the defendant, to the effect that STAG is descriptive of the product in respect of which it is used and is, therefore, not eligible for registration, it is obvious that the submission is meritless. A stag is an animal. Though liquor, consumed in excess, may evoke animalistic tendencies in the imbiber, the word STAG cannot, in any manner of speaking, be regarded as descriptive of alcoholic beverages. Once that is so, applying the reasoning contained in the afore-noted decisions, the marks INDIAN ROYAL STAG and INDIAN STAG, have necessarily to be regarded as deceptively similar. Both are used for IMFL. The defendant has not been able to cite a single other mark, used for IMFL, which contains the word STAG or even uses the Stag device. The use of the Stag device, by the defendant, would exacerbate the confusion. No doubt, visually the plaintiff's stag may not look like the defendant's. That, however, cannot make a difference, applying the principle laid down in Kirorimal Kashiram Marketing. In that case, too, the Single Judge of this Court had held that the two deer, in the plaintiff's and defendant's labels were completely different from each other. A detailed description of the differences between the

two deer was also provided by the Single Judge. The Division Bench of this Court, however, held that these differences were inconsequential so long as both were deer. De hors the sheer coincidence that Kirorimal Kashiram Marketing was concerned with deer and we are concerned with stags, the principle squarely applies. Similarly, the fact that the depiction of the fort by Vardhman was different from the manner in which ASCW depicted the fort was also found to be inconsequential by the Division Bench of this court in Amar Singh Chawal Wala. The fact was that both emblems depicted a fort and, by use of the word QILLA, which was the Urdu equivalent of fort, Vardhman was found to be specifically drawing attention to the fort motif. These findings apply, mutatis mutandis, and on all fours, to the facts in this case. The defendants have also used a Stag device. The second half of the defendants' mark is also STAG. The use of STAG by the defendants renders the INDIAN STAG mark phonetically and structurally similar to the mark ROYAL STAG.

60. Insofar as infringement is concerned, additional added features make no difference. The case has to be decided on a mark to mark comparison. The moment the essential features of the plaintiff's marks are replicated by the defendant, infringement has necessarily to be found to have taken place. In view of the pictorial depiction of a stag, the "STAG" part of the plaintiff's mark has necessarily to be held to be its essential and dominating feature. The use, by the defendant, of the word STAG along with the pictorial depiction of a stag, clearly indicates imitation, by the defendant, of the essential features of the plaintiff's mark.

61. Applying the law laid down in a long line of decisions starting from Kaviraj Pt Durga Dutt Sharma, once the essential features of the plaintiff's mark are replicated in the defendant's mark, infringement, within the meaning of Section 24(2)(b) of the Trade Marks Act, has necessarily to be found to have taken place. All criteria envisaged by the provision are met. The marks are similar; they are used for the same product, and, owing to these factors, there is a likelihood of confusion, or at the least association, in the

mind of a consumer of average intelligence and imperfect recollection.”

27. Reliance placed upon the decision rendered in **Carlsberg India Pvt. Ltd. (supra)** stands distinguished in light of the judgment rendered by the Apex Court as well as the Division Bench rendered to above.

28. Argument raised by the appellant as to statutory presumption of validity of a mark registered under Section 31 (1) of the Act cannot be dislodged at the *prima facie* stage easily. However, if the material is brought before the Court, which is indicative of the fact that the trade mark was an *ex-facie* not registrable at all, the Court cannot shut its eye.

29. Submission that ‘PATTA’ being commonly used trade name, no exclusive right could be granted, cannot be accepted as the registration of trade mark which does not suffer from any of the handicaps envisaged by Section 9, or Section 11 cannot therefore be recorded as ‘*publici juris*’, and at the *prima facie* stage at least its validity would be entitled to be presumed in view of Section 31(1). The defendant-appellant is not seeking that ‘HARA PATTA’ mark which the plaintiff is ascertaining in the present case, is ‘*publici juris*’. The ‘*publici juris*’ character is being attributed only to the latter ‘PATTA’, part of plaintiff’s mark. In view of the said fact, the defendant’s ‘TAZZA PATTA’ mark is deceptively similar to the plaintiff’s ‘HARA PATTA’ mark.

30. In **Pernod Ricard India Private Limited (supra)**, Delhi High Court while dealing with the mark of ‘ROYAL STAG’ and ‘INDIAN STAG’ held as under:-

“95. Publici juris literally translates to "of public right" or "belonging to the public". A mark which is publici juris and which, therefore, is legitimately available to the public for enjoyment and exploitation, cannot be monopolised by a private individual. The publici juris principle is actually conceptually circular in nature. Registration, and

registration alone, confers the right to monopolise a trademark and to proceed against those who use it, or something deceptively similar to it, without authority. Every mark which is neither registered nor deceptively similar to a registered mark is, therefore, publici juris. Equally, a mark which is not entitled to registration under Section 9 or Section 11 of the Trade Marks Act is, ipso facto publici juris.

96. The publici juris doctrine cannot, therefore, be invoked in vacuo. A defendant who claims that the plaintiff's registered mark is publici juris has, on him, therefore, the onus to demonstrate why it is so.

100. Even so, I may observe that there is really no convincing argument, advanced by the defendants, to support the assertion that the mark STAG is publici juris. All that is contended, in this regard, is that "stag", being the name of an animal, is a word used in common parlance and is not, therefore, entitled to registration. Again, this issue is not of any significance, as the plaintiff does not hold any registration for the mark STAG per se, and is not asserting, even in the present plaint, the mark STAG. The plaintiff asserts ROYAL STAG."

31. Coming to the argument that appellant is in the trade since 2013, cannot be accepted as the registration under the Act of 1999 was done in the year 2019, and no material was brought on record to demonstrate that it was in the said business since 2013 and so as to accord benefit of Section 33. It is a specific case of the plaintiff that on coming to know about the registration of trade mark 'TAZZA PATTA', the suit was filed in the year 2020.

32. Next coming to the question of balance of convenience, the reliance placed upon a decision in the case of **American Cyanamid Co. (supra)**, does not help the case of the appellant much as Section 29 (2) (c) provides that in case a registered trade mark is infringed by a person who, not being registered proprietor or a person using by way of permitted use,

uses in the course of trade, a mark which because of its identity with the registered trade mark and the identity of goods or services covered by such registered trade mark is likely to cause confusion on the part of public, or it is likely to have an associate with the registered trade mark.

33. Sub-section 3 of Section 29 provides that in any case falling under clause (c) of sub-section 2, the Court shall presume that it is likely to cause confusion on the part of the public.

34. In the instant case, trial Court had recorded clear finding that the logo used by the appellant is the same, which has same shape of leaf of green colour inside the yellow circle having similar font with similar placement of words with red, yellow and green colours combination and other artistic features.

35. Comparing the two labels, it is clear that except the photo of a boy being there on the label of 'HARA PATTA', the photo of a girl child is on the label of 'TAZZA PATTA'. The fonts used in both the labels appear to be deceptively similar with similar placement. Further, comparing two labels and the marks, there appears deceptive similarity both visually and phonetically, which can easily create confusion in the mind of a common man.

36. Lastly, on the question of irreparable loss, reliance has been placed upon the judgment rendered in case of **M/s Power Control Appliances (supra)** which takes note of the case of **American Cyanamid (supra)**. However, in judgment of **Satyam Infoway Ltd. (supra)**, the Supreme Court held that the defendant can carry on its business and inform its members of the change of name. Relevant para 34 is extracted here as under:-

“34. The last question is - where does the balance of convenience lie? Given the nature of the business, it is

necessary to maintain the exclusive identity which a domain name requires. In other words, either 'Sify' or 'Siffy' must go. Apart from being the prior user, the appellant has adduced sufficient evidence to show that the public associates the trade name SIFY with the appellant. The respondent on the other hand has produced little proof to establish the averments in support of its case that it had a membership of 50,000. We are unable to hold, while not commenting on the authenticity of the bills relied on by the respondents, as the High Court has done, that the bills by themselves show that the respondent "has been carrying on conferences at different places and enrolling members who would be transacting with them in the business and like that they have enrolled about 50,000 members already". Similarly, several Bills raised in the name of the respondent in respect of different items do not by themselves establish that the members of the public have come to associate the word "Siffy" only with the respondent. Weighed in the balance of comparative hardship, it is difficult to hold that the respondent would suffer any such loss as the appellant would unless an injunction is granted. The respondent can carry on its business and inform its members of the change of name. We are conscious of the fact that the grant of an interlocutory order may disrupt the respondent's business. But that cannot be seen as an argument which should deter us from granting relief to the appellant to which we are otherwise satisfied it is entitled."

37. Thus, looking from this angle, I find that the balance of convenience and irreparable loss tilts in favour of the plaintiff as the plaintiff-respondent is the prior user and has right to debar the defendant-appellant from eating into the goodwill it has built up.

38. Earlier also, in the year 2003 and 2009, the injunction was granted in favour of the plaintiff against different infringements of the trade mark who had stepped into the same business of manufacturing and selling detergent washing powder.

39. In **Midas Hygiene Industries (P) Ltd. (supra)**, the Apex Court held that the law on the subject is well settled. In cases of infringement, either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary, if it prima facie appears that the adoption of the mark was itself dishonest.

40. In **Parle Products (P) Ltd. (supra)**, the Apex Court had laid down two broad principles to be considered for arriving at conclusion whether one mark is deceptively similar to another. According to Apex Court, both the marks should be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him.

41. In this case, I find that the label placed before the Court are of the same size, colours scheme of both the labels are almost the same, the design of the leaf of both resembles each other and resemblance is such that one can easily be mistaken from other.

42. In the label of 'HARA PATTA', photo of a boy is there, while in the 'TAZZA PATTA', a girl child appears on the label. Apart from this, there is no difference and both the labels are almost the same including the fonts on the label. Anyone in my opinion, who has a look at one of the two labels may easily mistake the other if shown on another date as being the same article which he has seen before.

43. Thus, I find that the finding recorded by the Court below on 01.09.2023 regarding deceptive similarity between the label 'HARA PATTA' and 'TAZZA PATTA' needs no interference by this Court.

44. The appeal fails and is, hereby, **dismissed**.

45. However, looking to the fact of the case as both the parties are in the same business, the pendency of the suit for long will effect the business of the appellant, thus, this Court directs the Commercial Court, Kanpur Nagar to expedite the Original Suit No.3 of 2020 and make every endeavour to decide the same within a period of six months from the date of production of certified copy of this order.

46. It is made clear that no adjournment shall be granted to either of the parties, and the Court below shall make endeavour to proceed with the matter on day to day basis.

Order Date :- 17.1.2024
SK Goswami

[Rohit Ranjan Agarwal, J.]