

(2014) 07 DEL CK 0097
In the Delhi High Court
Case No : C.S. (OS) 247 of 2009

Allied Blenders and Distillers P. Ltd.

APPELLANT

Vs

Sentino Bio Products P. Ltd.

RESPONDENT

Date of Decision : 01-07-2014

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2, Order 39 Rule 3, 151
Copyright Act, 1957 — Section 10, 14(c), 2(c), 8
Trade and Merchandise Marks Act, 1958 — Section 2(j), 28, 68
Trade Marks Act, 1999 — Section 11

Citation : (2015) 213 DLT 464 : (2015) 61 PTC 149

Hon'ble Judges : G.S. Sistani, J

Bench : Single Bench

Advocate : Sudhir Chandra, Sr. Advocate, Shrawan Chopra and T. Sukshmya, Advocate for the Appellant; D.V. Reddy, Gagan Gupta and Saurabh Gupta, Advocate for the Respondent

Judgement

G.S. Sistani, J.—The plaintiff has filed the present suit for permanent injunction restraining infringement of trade mark and copyright, passing off, dilution of trade mark, unfair competition, damages and delivery up. Together with the plaint, the plaintiff has filed the present application under Order 39 Rules 1 & 2, CPC. While issuing summons in the suit, the following interim order was passed:

"6.2.2009

Present: Mr. Sudhir Chandra Aggarwal with Mr. Pravin Anand, Mr. M.S. Bharath, Mr. Sanjay Chhabra and Mr. Varun Menon for the plaintiff.

None for the defendant.

IA No. 1685/2009

Notice returnable on March 3, 2009.

This is an application under Order 39 Rules 1 & 2 read with Section 151 of the

Code of Civil Procedure by the plaintiff seeking an ex parte ad interim injunction order against the defendants restraining them, their officers, servants and agents, etc. from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in alcoholic beverages, especially "IMFL" (Indian made Foreign Liquor) or goods of any description bearing the trade mark and/or trade name "Officer's Special".

It is stated in the application that the plaintiff is in the business of manufacturing and marketing alcohol and beverages including "IMFL" (Indian Made Foreign Liquor) under various descriptive trade marks and labels, one of which is "Officer's Choice". The said trade mark "Officer's Choice" has a descriptive design, colour scheme, layout, cover and logo which has come to be exclusively associated with the plaintiff's company. The plaintiffs have acquired the registration of trade mark "Officer's Choice" from the Registrar, Trade Marks under Class 33 for alcoholic beverages since October 26, 1990.

It is alleged that the defendants have also started manufacturing and selling "whisky" since December, 2008 and they are doing so under the trade name "Officer's Special" which is deceptively similar to that of the plaintiff trade name inasmuch as it not only picks the word "Officer" from the trade name of the plaintiff but also bears substantial similarity with regard to the design, colour scheme and cover of the label.

Having regard to the aforementioned averments and also on a visual comparison of the trade mark of the plaintiff and the defendants, I am prima facie of the view that the plaintiff is entitled to an ex parte ad interim injunction. Accordingly, the defendants, its officers, servants and agents are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in alcoholic beverages, especially "IMFL" (Indian Made Foreign Liquor) or goods of any description bearing the trade mark and/or trade name "Officer's Special, till further orders of this Court.

Provisions of Order 39 Rule 3 of the Code of Civil Procedure shall be complied with, within one week.

Dasti."

Written statement as well as reply to the application have been filed.

2. The plaintiff is stated to be in the business of manufacturing and marketing alcoholic beverages, including Indian Made Foreign Liquor (IMFL). The alcoholic beverages are sold under various distinctive trade marks and labels. The subject matter of the present dispute is with regard to the plaintiff's trade mark "Officer's Choice", which was originally coined in the year 1988. It is the case of the plaintiff that the plaintiff's products under the trade mark "Officer's Choice" are sold throughout India and overseas. They have acquired an enviable reputation and goodwill, as a result of its excellent quality, distinctive packaging and characteristics namely, palatable taste, flavour, blending, etc. The plaintiff

claims that "Officer's Choice" is one of the highest selling brands of the plaintiff and is considered as one of the largest selling whiskies in India and the plaintiff has been incurring* extensive expenditure towards promotional campaigns in order to promote and publicize its product under the mark "Officer's Choice". According to the plaintiff, the plaintiff is the registered proprietor of the trade marks "Officer's Choice" in various classes as detailed below:

3. It is the case of the plaintiff that the company has been using the trade mark "Officer's Choice" in a distinctive design, colour scheme, layout, get up and the said trade mark and device have become exclusively associated with the company's product. It is also the case of the plaintiff that the colour combination, layout, get up and lettering style used on the logo i.e. white base, gold border, font style and letters in red colour constitute an original artistic work within the meaning of Section 2(c) of the Copyright Act and the same has been duly registered. It is also contended by the plaintiff that by virtue of its excellent quality, characteristics and distinctive packaging, the whisky sold under the trade marks "Officer's Choice" has become very popular amongst the trade and public. In support of his submission that the trade marks "Officer's Choice" has acquired substantial reputation and goodwill through extensive use and advertising, the plaintiff has placed on record the details of sales of the plaintiff's products bearing "Officer's Choice" trade mark from the year 1994 to 2008.

4. Plaintiff has also submitted that the plaintiff's products bearing "Officer's Choice" trade mark has extensive sales and operations within New Delhi. The details for the year 2005 to 2009 have also been produced which read as under:

5. It is also the case of the plaintiff that in order to promote the sales of its product "Officer's Choice" large amounts have been spent on advertising including through sponsorship of events such as sponsorship of advertisement in magazines, television, hoardings, posters, dangles, glow signs etc. Attention of the Court is drawn to the expenses incurred by the plaintiff on sales promotion for the "Officer's Choice" trade marks from the year 1994 to 2007-2008, which are reproduced below:

6. Mr. Sudhir Chandra, Counsel for the plaintiff contends that on account of long user, vast promotion and publicity, the trade mark of the plaintiff enjoys an unparalleled reputation and goodwill in the market and the trade mark has acquired the status of a "well known" trade mark. Mr. Sudhir Chandra further submits that a reputed and well-known trade mark is the one that embodies an aura of preminent excellence and is recognized irrespective of the class of goods or services for which it is used and the plaintiff's "Officer's Choice" trade mark wholly qualifies for this distinction.

7. In the year 2005, the plaintiff claims to have coined another trade mark for its products known as "Officer's Special" and designed a specific label containing the mark "Officer's Special". In anticipation of launching the said product, an application was filed before the Excise Commissioner of Raipur seeking the

approval for the said label. The Excise Commissioner of Chhattisgarh on 25.8.2005 had granted the approval for the "Officer's Special" Label under the Registration No. CG319/2005-06. It is contended that the said label is an original artistic work having unique combination of the colours WHITE, RED, GOLD and BLACK, with a distinct font in which the words "Officer's Special" are written in RED Colour on a white background with a golden border.

8. Mr. Sudhir Chandra, next submits that the plaintiff's were shocked to learn that the defendant No. 1 had come out with a brand of Indian made foreign liquor i.e. Officer's Special, which was being manufactured and bottled by defendant No. 2. The defendant No. 1 applied to the Excise Department to Seek approval of the label, containing the said mark in March, 2008 in the State of Andhra Pradesh and in May, 2008 in the State of Chhattisgarh. On gaining knowledge of the adoption and prospective use of the trade mark Officer's Special, the plaintiff addressed a letter dated 19.3.2008 to M/s. A.P. Beverages Corporation, Hyderabad, a copy of the said letter was marked to the Commissioner of Excise, Andhra Pradesh; legal notice was also issued objecting to the adoption of the trade mark "Officer's Special", pointing out that the said use of the mark "Officer's Special" would amount to infringement of the trade-mark of the plaintiff as the two trade-marks were identically structured (phonetically and visually). The defendants were inter alia called upon to cease and desist from misrepresenting and infringing the plaintiff's trade mark. An unsatisfactory reply to the notice has led to the filing of the present suit.

9. It is submitted that the defendants have launched and introduced its product in the city of Hyderabad and Secunderabad, within the State of Andhra Pradesh in the month of December, 2008. It is strongly urged before this Court that a visual comparison of the impugned labels of the defendants with the plaintiffs would leave no room for doubt that a clear case of infringement of trade mark, copyright and passing off is made out.

10. Learned Senior Counsel for the plaintiff has drawn the attention of the Court to the similarities between the two labels in support of his argument that the same would clearly establish the dishonest intention of the defendants, which is solely intended to confuse the unwary customers and to encash upon the goodwill and reputation enjoyed by the product of the plaintiff throughout India. Plaintiff has also filed objections before the Excise Authorities, bringing to the notice that the impugned trade mark "Officer's Choice" is a dishonest adoption by the defendants and it would cause confusion in the minds of unwary customers.

11. Mr. Sudhir Chandra, learned Senior Counsel for the plaintiff further submits that there is clear structural, phonetical and visual similarity between the two marks and the labels. It is also the case of the plaintiff that the word "Officer's" had acquired a high degree of distinctiveness that the usage of the word in relation to IMFL product refers to the plaintiff's merchandise and any use of the impugned trade mark "Officer's Special" for whiskey or for any other products

would amount to infringement of plaintiff's registered trade mark and passing off the defendants goods as those of the plaintiff's.

12. Mr. Chandra has also laboured hard to submit that the colour combination, layout, get up and the lettering style, i.e. white base, golden border, font style and lettering of the words "OFFICER'S CHOICE" in red colour within the Plaintiff's "Officers Choice" label renders the said label to be an original artistic work within the meaning of Section 2(c) of the Copyright Act. The plaintiffs' OFFICER'S CHOICE labels have been duly registered under Nos. A54982/98 dated 11.8.1998 and A-57173/99 dated 16.12.1999. It is also submitted that in addition to the aforementioned label, the plaintiff's "Officer's Special" label also contains the colour combination, layout, get up and the lettering style used on the logo, i.e. white base, golden border, font style and letters in red colour, identical to one of the Plaintiff's "Officer's Choice" label thereby constituting an original artistic work within the meaning of Section 2(c) of the Copyright Act. The plaintiff is the owner of the copyright in the aforesaid labels and is entitled to all the exclusive rights flowing from such ownership as set out in Section 14(c) of the Copyright Act, 1957.

13. Mr. Chandra, learned Senior Counsel for the plaintiff also submits that the unauthorized intended use of the deceptively similar trade mark "Officer's Special" by the defendant is an act of infringement of the plaintiff's statutory rights and also a violation of its common law rights. It is next submitted that the defendant intends to commence an unlawful act of misrepresenting their goods as those of the plaintiff's while causing incalculable loss and damage to the plaintiff's business, goodwill and reputation. It is submitted that by unauthorized adoption and use of the deceptively similar mark "Officer's Special" the defendants have infringed plaintiff's registrations Nos. 538927 in Class 33, 610451 in Class 32, 819448 in Class 34, 819449 in Class 3, 819450 in Class 21 and 819447 in Class 25. It is also submitted that the Plaintiff's "Officer's Choice" trade mark has acquired an international reputation and that the said trade marks qualify as famous and well-known trade marks as envisaged in Section 11 of the Trade Marks Act, 1999.

14. In the above circumstances the plaintiff prays that the interim order granted by this Court on 6.2.2009 be confirmed.

15. A detailed written statement has been filed by the defendants as also reply to the application. It is contended by Mr. D.V. Reddy, learned Counsel for the defendants that the defendants are licenced manufacturers of spirits from grains and they are selling several products under the different brand names. It is submitted that the defendant No. 1 is a well known and established company.

16. The first submission of Counsel for the defendants is that plaintiff has not approached this Court with clean hands and has suppressed and withheld material facts. Mr. Reddy, Counsel for the respondents submits that the plaintiff has misrepresented before this Court that Officer's Special label has been

approved in favour of the plaintiff by the Excise Commissioner, Raipur, whereas it has not been stated that the said approval was for a period of one year and further that it was not extended beyond 2005. It has also been concealed from this Court that the label of the plaintiff was never used and the grant of approval by the Excise Commissioner, Raipur has become infructuous. It is contended that the plaintiff has further concealed the fact that the plaintiff has lost its case before the Commissioner Excise in the States of Andhra Pradesh and Chhattisgarh, and has not disclosed the same to this Court.

17. Counsel for the defendants also submits that plaintiff has also suppressed the fact that the label "Officer's Special" is awarded in favour of the defendants by the Commissioner of Excise of States of Andhra Pradesh and the Chhattisgarh.

18. Counsel has further submitted that there is no similarity of any kind between both the labels of "Officer's Choice" and "Officer's Special". Counsel has laid stress on the fact that plaintiff has no exclusive rights over the said words "Choice and prestige whiskey" as a disclaimer has been issued as per the orders passed by the Registrar of Trade Marks. It has also been contended that there are several trade marks registered with the word "Officer" as part of the trade marks, as per the examination report, copy of which has been filed.

19. Mr. Reddy contends that the trade mark is to be compared as a whole and not to be dissected and then compared. Also, known monopolized general words like "Officer" have become publici juris.

20. Another submission made by Counsel for the defendants is that as long as each and every word of the trade mark is not registered separately a person cannot claim right over each and every trade mark. The trade mark is thus to be read as a whole and cannot be dissected and compared. The defendants' trade mark "Officer's Special" is clubbed with the name of the company Sentini, which is registered in different classes.

21. Counsel has also pointed out dissimilarities between two labels by pointing out in the defendant's label, its grain whisky whereas in the plaintiff's label it is prestige whisky. The defendant's label uses the prefix sentini's while there is no such prefix in plaintiff's label. Shape of the bottle is different, cap is different and category of product is also different.

22. It is also the case of the defendants that the goods sold under the brand name are different from each other as the Officer's Special is grain whiskey, and moreover there are various other dissimilarities as well between the two products.

23. Counsel for the defendants has relied upon *White Horse Distillers Ltd. v. Upper Doab Sugar Mills Ltd. & Anr.* reported at 1984 Arbitration Law Reporter page 97, in support of his plea that the plaintiff is not entitled to ex parte injunction where the trade marks are not identical and when there are differences in the marks and in the labels. Reliance is placed on paragraphs 4 and 5, which are reproduced below:

"4. It is obvious that the conflicting trade marks in question are not identical and there are substantial points of dissimilarity in the two marks. The few distinguishing features in the two marks that may be pointed out here are that only one of the two words making the trade mark of each of the parties namely "Horse" is common, whereas the other two words "White" and "Flying" are obviously dissimilar. There are great dissimilarities in the devices of the marks of the two parties. The device of the plaintiff consists of the picture of a white horse on a black background. As against that the device of the defendants consists of a horse with quite large and conspicuous wings and the horse is shown in a flying posture as against a standing horse in the device of the plaintiff. There is also a conspicuous difference in the labels of the parties as regards their colour scheme, the manner in which the marks i.e. "White Horse" of the plaintiff and "Flying Horse" of the defendants are given therein, as also of the pictures of the horses in the two labels. The other thing to note is that in the label of the plaintiff the words "Fine Old Scotch Whisky" are given in very bold letters. In the label of the defendants the words, "PRODUCE OF INDIA" are given, although not in very bold letters. In the labels of the two parties the names of the respective manufacturers are also given in detail. Further a bottle of White Horse Scotch Whisky is sold in India to a retailer for over Rs. 300/- whereas on the label of the defendants itself the price is given as Rs. 42/- per bottle.

5.Keeping in view the respective submissions of the parties, learned Counsel and the materials as placed by the parties on record the position that turns out to be is this that whereas the plaintiff may be said to have a prima facie case worth trial, it cannot be said that they have got a clear-cut case in its favour. There are contentious issues involved in the case on a final decision of which alone rests the fate of the case of the plaintiff. The grant of the temporary injunction as prayed for by the plaintiff would amount to virtually decreeing the suit of the plaintiff without its trial. Such an ad interim injunction is not ordinarily to be allowed. Further, in such a situation the question as to whether the plaintiff will suffer an irreparable loss if the injunction as prayed for by it is not allowed and the question as to in whose favour does the balance of convenience lie assume a great importance. In the event of the plaintiff's success in the suit the damages to which the plaintiff may be entitled on account of the passing of the defendants' goods can be measured and the plaintiff can be compensated by the award of such damages. On the other hand in case the temporary injunction as prayed for is granted, that is bound to destroy the entire business of the defendants which is in existence for the last about 17 years and in case the defendants succeed in non-suiting the plaintiff it would almost be impossible to assess the damage caused to the defendants by the grant of the temporary injunction against them."

24. Reliance is also placed on Radico Khaitan Limited Vs. Carlsberg India Private Limited, .

25. Objection has also been raised by the defendants with regard to the

maintainability of the suit. It is contended by Mr. Reddy that the trade mark certificates filed by the plaintiff are in the name of M/s. B.D.A. Limited and none of the certificates filed are to be used for legal purposes. It is further pointed out that the trade mark Officer's Choice, as per the assignment deed of 26.2.1991, is assigned on the name of M/s. B.D.A. Limited, which was formally known as B.D.A. Breweries Limited. It is submitted that as per the Trade Mark certificates filed by the plaintiff, the owner of the trade mark is M/s. B.D.A. Limited and as per the Assignment Deed filed by the plaintiff, M/s. B.D.A. Breweries and Distilleries Limited is the owner of the trade mark.

26. Mr. Reddy submits that there is no document filed before this Court to define the relationship/nexus between all the companies. It is submitted that as per the composite scheme of arrangements filed before this Hon'ble Court for all purposes the transferee company is M/s. Chaabriya Marketing Ltd. which is the owner of the trade mark. Hence, the suit filed by M/s. Allied Blenders and Distillers Pvt. Ltd. is not maintainable and the suit should be dismissed in limine.

27. Counsel for the plaintiff has disputed the submission made by Counsel for the defendants with regard to dismissal of the suit on the ground that the plaintiff is not the owner of the trade mark "Officer's Choice". It is submitted that the trade mark Officer's Choice was originally coined and adopted during the year 1988 by M/s. Cruickshank & Company Limited. The same was assigned to M/s. B.D.A. Breweries and Distilleries Limited by a deed of assignment dated 26.2.1991, copy of which has been placed on record. M/s. B.D.A. Breweries and Distilleries Limited recorded a change of name on 27.1.1992, copy of which has also been placed on record. This name again underwent a change to M/s. B.D.A. Limited and the change of name was recorded on 26.12.2005, a copy of which was also filed on 4.3.2009. Subsequently under the scheme of demerger of M/s. B.D.A. Pvt. Ltd., the name was taken over by the M/s. Chaabriya Marketing Ltd. and this change of name was recorded on 16.4.2007, a copy of which has also been placed on record. The name again underwent a change to M/s. Allied Blenders and Distilleries Limited, which was recorded on 25.4.2007 and thereafter on the basis of a composite scheme of arrangement to M/s. Blenders and Distilleries Pvt. Ltd. on 23.2.2007.

28. Mr. Sudhir Chandra further clarifies that the application of the plaintiff before the Trade Mark Registry (form TM 24) to bring on record the change of name of proprietor of marks has also been placed on record together with order No. PR/354 dated 15.2.2008 passed by the Trade Marks Registrar, Bombay regarding the change of name to Allied Blenders and Distillers Pvt. Ltd. in respect of the registered trade mark No. 538927, copy of which has also been placed on record.

29. Mr. Reddy has further submitted that the plaintiff has not been able to satisfy this Court about the three prime essential ingredients for grant of a temporary injunction, as the plaintiff has failed to establish a prima facie case or to show that the balance of convenience is in favour of the plaintiff and plaintiff has also not been able to establish that irreparable injury would be caused to them in

case the injunction is not granted. Counsel for the defendant has also contended that the defendants has raised triable issues in the matter and the defendants would be put to great loss if the interim order is to continue in the matter.

30. The submission of Mr. Chandra, learned Senior Counsel for the plaintiff, are summarised as under:

(i) The plaintiff is the registered proprietor of the trade mark "Officer's Choice" in various classes including for alcoholic beverages under Class 33 under the Trade Marks Act, 1999.

(ii) The use of the trade mark Officer's Special by the defendants with a deceptively similar name and label is likely to deceive and cause confusion to the purchasers, who are of ordinary intelligence and imperfect recollection as the product is sold through common outlets.

(iii) Both the labels are also deceptively similar, which are likely to cause confusion in the minds of unwary customers.

(iv) Plaintiff is also the owner of original artistic work in "Officer's Choice label", which was adopted in the year 1988, and the same is duly registered under the Copyrights Act, 1958.

(v) In the year 2005 plaintiff coined another mark for its alcoholic beverages including Indian made foreign liquor known as Officer's Special. The label was also designed. Plaintiff has acquired copyright under the art work.

(vi) Other brands of the plaintiff include Officer's Special, Officer, Officer No. 1, Officers and Gentleman and Officers Club in addition to Officer's Choice.

(vii) The plaintiff has earned immense goodwill and reputation of its products under the trade mark Officer's Choice, which are sold throughout India. Sale figures and amount spent on advertisement have been relied upon.

31. The arguments of Mr. Reddy, learned Counsel for the defendants, can be summarized as under:

(i) The suit is not maintainable as the plaintiff has no locus standi to file the present suit.

(ii) The plaintiff has suppressed and withheld material facts.

(iii) Suit and application are liable to be dismissed on account of delay and laches.

(iv) Plaintiff has not been able to make out a case for grant of temporary injunction as the plaintiff has failed to make out a prima facie case, nor has the plaintiff been able to establish balance of convenience or irreparable loss.

(v) No similarity between the two trade marks i.e. Officer's choice and Officer's Special and even with regard to design, colour scheme and layout.

(vi) Word "Officer" being of a general word plaintiff cannot claim monopoly.

32. Mr. Reddy, learned Counsel for the defendants, submits that the plaintiff has no locus standi to file the present suit as no trade mark by the name Officer's Choice stands in the name of M/s. Allied Blenders and Distillers Private Limited nor relevant documents have been filed. This submission of Counsel for the defendants is without any force for the reason that the plaintiff has averred in para 2 of the plaint that originally the trade mark "Officer's Choice" was coined and adopted in the year 1988 by M/s. Cruickshank & Company Limited and later assigned to M/s. B.D.A. Limited Company along with its goodwill by means of a registered Assignment Deed dated 26.2.1991. Subsequently as per the demerger transfer and visiting of the liquor business of M/s. B.D.A. Private Limited with Allied Blenders and Distillers Private Limited on a going concern basis vide Composite Scheme of Arrangement duly approved by the order of the High Court of Bombay dated 23.2.2007. All supporting documents have been filed by the plaintiff during the pendency of the suit, including the application filed by the plaintiff before the Trade Marks Registry (form TM 24) to bring on record the change of name of proprietor of marks has also been placed on record together with order No. PR/354 dated 15.2.2008 passed by the Trade Marks Registrar, Bombay regarding the change of name to Allied Blenders and Distillers Pvt. Ltd. in respect of the registered trade mark No. 538927. Thus, prima facie, the plaintiff has been able to establish that the plaintiff is competent to file the present suit.

33. Another objection raised by Counsel for the defendants with regard to maintainability of the present suit is with regard to suppression of material facts by the plaintiff as the plaintiff misrepresented before the Court that Officer's Special label has been accrued in favour of the plaintiff by the Excise Commissioner, Raipur, however, the plaintiff failed to point out that the said approval was for a period of one year and further that it was not extended beyond the year 2005.

34. According to the defendants, the plaintiff also concealed that the label of the plaintiff was never used for the grant of approval by the Excise Commissioner, Raipur, had become infructuous and also that the plaintiff had lost its case before the Commissioner, Excise, State of Andhra Pradesh and Chattisgarh.

35. In the case of A. Anuradha v. Canara Bank, reported at 2006-LAWS (APH)-2-107, it has been held as under:

"12. Reference also deserves to be made to some of the English decisions on this subject. In Rex v. Kensington, Cozens Hards M.R. made the following observations on the conduct of a party in an ex parte application in the following words:

"On an ex parte application uberrima fides is required, and unless that can be established if there is anything like deception practised on the Court, the Court ought not to go into the merits of the case, but simply say we will not listen to your application because of what you have done." Lord Scrutton L.J., said--

"It has for many years the rule of the Court and one which it is of the greatest importance to maintain, that when any applicant comes to the Court to obtain relief on an ex-parte statement, he should make a full and fair disclosure of all the material facts, facts not law

.....The applicant must state fully and fairly facts and the penalty by which the Court enforces that obligation is that if it finds out that the facts have been fully and fairly stated to it, the Court will set aside any action which it has taken on the faith of the imperfect statement".

36. While there is no quarrel with the proposition sought to be advocated by Counsel for the defendant No. 1 that a person, who approaches the Court with unclean hands or suppresses and withholds material facts, disentitles himself for interim relief and suppression is a ground for rejection or vacation of the stay, however, this ground is not available to the defendants in the present case, for the reason that there is no material suppression on behalf of the plaintiff which would disentitle the plaintiff for the relief which is being sought. It cannot be disputed that the plaintiff has not stated in the plaint in clear terms that the objections raised by the plaintiff before the Excise Department were rejected, as noticed in paragraphs 13 and 14 of the plaint, however, it has clearly been stated in the plaint that despite the said objection, the defendants went on to receive necessary approval from the relevant authorities in the States of Andhra Pradesh and the Chhattisgarh for the impugned label. It may also be noticed that necessary certificate issued in favour of the defendants, was also placed on record.

37. While ideally the plaintiff could have elaborated the fact that the objection made by the plaintiff before the Excise Commissioner was rejected, but such concealment itself cannot be a ground for dismissal of this application, as it has been repeatedly held that a concealment must be material in nature.

38. In the case of Arunima Baruah Vs. Union of India (UOI) and Others, , the Apex Court has held that a petitioner would be disentitled to seek discretionary relief in case of suppression of material facts. Para 12 of the judgment reads as under:

"12. It is trite law that so as to enable the Court to refuse to exercise its discretionary jurisdiction suppression must be of material fact. What would be a material fact, suppression whereof would disentitle the appellant to obtain a discretionary relief, would depend upon the facts and circumstances of each case. Material fact would mean material for the purpose of determination of the lis, the logical corollary whereof would be that whether the same was material for grant or denial of the relief. If the fact suppressed is not material for determination of the lis between the parties, the Court may not refuse to exercise its discretionary jurisdiction. It is also trite that a person invoking the discretionary jurisdiction of the Court cannot be allowed to approach it with a pair of dirty hands. But even if the said dirt is removed and the hands become

clean, whether the relief would still be denied is the question."

39. In my view there is no material concealment on the part of the plaintiff which would disentitle the plaintiff to interim relief or that the plaint or application should be dismissed on this ground alone, and, thus, the submission of Counsel for the defendants, is without any force.

40. Another objection raised by Counsel for the defendants for dismissal of the application under Order 39 Rules 1 and 2, CPC is on the ground of delay and laches.

41. It has been submitted by Counsel for the defendants that the plaintiff was aware since 19.3.2008 of the defendants' intention to use the impugned mark, which is evident from the legal notices issued to the defendants and the objection raised by them before the Excise Commissioner, Andhra Pradesh, and whereas the present suit has been filed after a gap of eleven months.

42. Reliance is placed by Counsel for the defendants in the case of Khoday Distilleries Limited (Now known as Khoday India Limited) Vs. The Scotch Whisky Association and Others, , wherein the application was dismissed on the principles of acquiescence and waiver. Reliance has also been placed by Counsel for the defendants in the case of Kanungo Media (P) Ltd. Vs. RGV Film Factory and Others, , wherein it was held that silence on the part of one party would amount to giving up its rights, if he had confusingly allowed the second party to go ahead with the production of the movie.

43. This argument of Counsel for the defendants is also without any force as it has been held that simplicitor delay is not vital to the grant of injunction. It would be useful to reproduce the observations made by the Supreme Court of India in the case of Ramdev Food Products Pvt. Ltd. Vs. Arvindbhai Rambhai Patel and Others, . Relevant portion reads as under:

"105. Acquiescence is a facet of delay. The principle of acquiescence would apply where: (i) sitting by or allow another to invade the rights and spending money on it; (ii) it is a course of conduct inconsistent with the claim for exclusive rights for trade mark, trade name, etc.

106. In Power Control Appliances and Others Vs. Sumeet Machines Pvt. Ltd., , this Court stated:

"Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name, etc. It implies positive acts; not merely silence or inaction such as is involved in laches..."

107. In an infringement of trade mark, delay by itself may not be a ground for refusing to issue injunction as has been observed by Lahoti, J. (as His Lordship then was) in Midas Hygiene Industries P. Ltd. and Another Vs. Sudhir Bhatia and Others, , in the following terms:

"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."

(Emphasis supplied)

108. The defence of acquiescence; thus, would be satisfied when the plaintiff assents to or lay by in relation to the acts of another person and in view of that assent or laying by and consequent acts it would be unjust in all the circumstances to grant the specific relief.

109. Kerr in his "Treatise on the Law and Practice of Injunction", Sixth Edition at pages 360-361 states as under:

"Mere delay after knowledge of the infringement to take proceedings, not sufficient to call the Statute of Limitations into operation, or where the infringement continues, is not, it seems, a bar to the right of an injunction at the trial. Lapse of time unaccompanied by anything else is, it seems, no more a bar to a suit for an injunction in aid of the legal right than it is to an action deceit.

But delay may cause the Court to refuse an interlocutory injunction, especially if the defendant has built up a trade in which he has notoriously used the mark..."

110. Specific knowledge on the part of the plaintiff and prejudice suffered by the defendant is also a relevant factor [See Spry on Equitable Remedies, Fourth Edition, page 433].

111. Applying the aforementioned principles in the instant case, it is evident that the time-gap between the issuance of the notice and filing of an application for grant of injunction was not a voluntary act on the part of the appellant herein. It had to wait for the outcome of various proceedings pending before different Courts. The respondents having themselves taking recourse to judicial proceedings, as noticed hereinbefore, cannot now be permitted to set up the defence of acquiescence on the part of the appellant. Indisputably, in a case of infringement of trade mark, injunction would ordinarily follow where it is established that the defendant had infringed the trade mark and had not been able to discharge its burden as regard the defence taken by it."

44. In the case of Swaran Singh Vs. Usha Industries (India) and Another, , it was held as under:

"There is then the question of delay. Learned Counsel for the respondents had urged that the delay is fatal to the grant of an injunction. We are not so satisfied. A delay in the matter of seeking an injunction may be aground for refusing an injunction in certain circumstances. In the present case, we are dealing with a statutory right based on the provisions of the Trade and Merchandise Marks Act, 1958. An exclusive right is granted by the registration to the holder of a

registered trade mark. We do not think statutory rights can be lost by delay. The effect of a registered mark is so clearly defined in the statute as to be not capable of being misunderstood. Even if there is some delay, the exclusive right cannot be lost. The registered mark cannot be reduced to a nullity."

45. In the case of Hindustan Pencils (P) Ltd. Vs. India Stationery Products Co. and Another, , it was held as under:

"29. If an action is taken by the registered owner and no interim injunction is granted, the effect is that goods bearing the infringing mark or spurious goods would continue to be sold in the market. After a number of years when the case is finally disposed of, after trial, and the plaintiff succeeds and gets a permanent injunction then, possibly, the plaintiff may also be compensated by his being awarded damages or an account of profits. In that sense the non-grant of the interim injunction would not, ultimately, prejudice the plaintiff for he may be compensated with payment of money but during this period when the defendant is allowed to continue to infringe the intellectual property it is the consumer or the purchaser who alone suffers and who ultimately cannot be compensated. Therefore, in order to curb the menace of manufacture, production and sale of spurious goods and the blatant violation of intellectual property it will be proper for the Court to take into consideration the interest of the general public. In this regard reference may usefully be made to the following observations of McCarthy at page 346, para 30.21, which deals with the protection of third parties:

"Some Courts also consider the necessity of protecting third parties. In trade mark infringement cases, "third parties" means the buying public. If the equities are closely balanced, the right of the public not to be deceived or confused may turn the scales in favor of a preliminary injunction."

30. It would appear to be difficult to accept that relief of temporary injunction should not be granted, because of the delay on, the part of the plaintiff, even though the Court feels, at that point of time, that, ultimately permanent injunction will have to be granted.

31. Even though there may be some doubt as to whether laches or acquiescence can deny the relief of a permanent injunction, judicial opinion has been consistent in holding that if the defendant acts fraudulently with the knowledge that he is violating the plaintiff's rights then in that case, even if there is an inordinate delay on the part of the plaintiff in taking action against the defendant, the relief of injunction is not denied. The defence of laches or inordinate delay is a defence in equity. In equity both the parties must come to the Court with clean hands. An equitable defense can be put up by a party who has acted fairly and honestly. A person who is guilty of violating the law or infringing or usurping somebody else's right cannot clarify the continued misuse of the usurped right. It was observed by Romer, J. in the matter of an application brought by J.R. Parkington and Co. Ltd., (1946) 63 RPC 171 at page 181 that "in my judgment, the circumstances which attend the adoption of a trade mark in

the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently". It was further noted by the learned Judge in that case that he could not regard the discreditable origin of the user as cleansed by the subsequent history. In other words, the equitable relief will be afforded only to that party who is not guilty of a fraud and whose conduct shows that, there had been, on his part, an honest concurrent user of the mark in question. If a party, for no apparent or a valid reason, adopts, with or without modifications, a mark belonging to another, whether registered or not, it will be difficult for that party to avoid an order of injunction because the Court may rightly assume that such adoption of the mark by the party was nothing honest one. The Court would be justified in concluding that the defendant, in such an action, wanted to cash in on the plaintiffs name and reputation and that was the sole, primary or the real motive of the defendant adopting such a mark. Even if, in such a case, there may be an inordinate delay on the part of the plaintiff in bringing a suit for injunction, the application of the plaintiff for an interim injunction cannot be dismissed on the ground that the defendant has been using the mark for a number of years. Dealing with this aspect Harry D. Nims in his "The Law of Unfair Competition and Trade Marks", Fourth Edition, Volume Two at page 1282 noted as follows:

"Where infringement is deliberate and willful and the defendant acts fraudulently with knowledge that he is violating plaintiff's rights, essential elements of estoppels are lacking and in such a case the protection of plaintiffs rights by injunctive relief never is properly denied. "The doctrine of estoppels can only be invoked to promote fair dealings"."

46. The arguments of Counsel for the parties are to be considered on the touchstone of the law which has been laid down by the Apex Court, as extracted in the paragraphs foregoing. According to Counsel for the defendant, the present proceedings have been initiated by the plaintiff after a delay of about 11 months and on this ground alone, the injunction should be refused. The judgments sought to be relied upon by the Counsel for the defendant are not applicable to the facts of the present case, as it cannot be said that the plaintiff allowed the defendant to invade their rights or allowed the defendant by any positive inaction on their part to establish itself and spend money for the same. The plaintiff raised objection before the Excise Commissioner which would show that the plaintiff was serious in opposing the defendant from using the impugned trade mark "Officer's Special".

47. In the present case it cannot be said that the present suit is barred by delay and laches, nor a case of acquiescence is made out and having regard to the settled position of law, the present application cannot be dismissed on the ground of delay of eleven months in filing the present suit.

48. It is the case of the plaintiff that the plaintiff is the registered proprietor of the trade mark Officer's Choice in various classes, details of which have been set

out in the plaint. It is also the case of the plaintiff that the plaintiff has been using the trade mark Officer's Choice in a distinctive design, colour scheme, lay out, get up and the said trade mark and device/logo have become to be exclusively associated with the plaintiff company. Also the colour combination, lay out, get up and the lettering style on the logo with white base, gold border, font style and letters in red colour constitute an original artistic work within the meaning of Section 2(c) of the Copyright Act, which has been registered.

49. The plaintiff has made a comparative table with respect to the similarities between two labels in support of the submission that the similarities between the two labels not only establishes the dishonest intention of the defendants but also the likelihood of confusion, which may be caused to the unwary customers.

50. While, it is the case of the defendants that there are no similarities between the two labels and the defendants product is made out of grain further there is no similarity between design, colour scheme, layout and getup, it is also the case of the defendants that the trade mark is thus to be read as a whole and cannot be dissected and compared. The defendants, trade mark "Officer's Special" is clubbed with the name of the company Sentini, which is registered in different classes.

51. Counsel has also pointed out dissimilarities between two labels by pointing out in the defendant's label, its grain whisky whereas in the plaintiff's label it is prestige whisky. The defendant's label uses the prefix Sentini's while there is no such prefix in plaintiff's label. Shape of the bottle is different, cap is different and category of product is also different. This submission of Counsel for the defendants is without any force.

52. Copy of the labels of both the products have been filed along with the plaint, which have been duly admitted by the parties.

53. In the case of Parle Products (P) Ltd. Vs. J.P. and Co., Mysore, , it has been held that in order to come to the conclusion whether one mark is deceptively similar to other the broad and essential features of the two marks are to be considered and not that they are to be placed side by side to find out any difference. Para 9 reads as under:

"9. It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not 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. In this case we find that the packets are practically of the same size, the colour scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can easily be mistaken for the other. The essential features of both are that there is a girl with

one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Gluko Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in our opinion who has a look at one of the packets to-day may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs goods, he might easily mistake the defendants' wrapper for the plaintiffs if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary to refer to the decisions referred to at the Bar as in our view each case will have to be, judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it."

54. Further in the case of Amritdhara Pharmacy Vs. Satyadeo Gupta, , the Supreme Court has laid down the tests indicated and where it has been held that the overall similarity has to be considered between the two marks. Paragraphs 7 to 9 are read as under:

"(7) It will be noticed that the words used in the sections and relevant for our purpose are "likely to deceive or cause confusion." The Act does not lay down any criteria for determining what is likely to deceive or cause confusion. Therefore, every case must depend on its own particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion. On an application to register, the Registrar or an opponent may object that the trade mark is not registerable by reason of Clause (a) of Section 8, or Sub-section (1) of Section 10, as in this case. In such a case the onus is on the applicant to satisfy the Registrar that the trade mark applied for is not likely to deceive or cause confusion. In cases in which the tribunal considers that there is doubt as to whether deception is likely, the application should be refused. 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. In considering the matter, all the circumstances of the case must be considered. As was observed by Parker, J. in Pianotist Co.'s Application (1), which was also a case of the comparison of two words--

"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."(p. 777)

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. (See Kerly on Trade Marks, 8th edition, p. 400.)

(8) Let us apply these tests to the facts of the case under our consideration. It is not disputed before use that the two names "Amritdhara" and "Lakshmandhara" are in use in respect of the same description of goods, namely, a medicinal preparation for the alleviation of various ailments. Such medicinal preparation will be purchased mostly by people who instead of going to a doctor wish to purchase a medicine for the quick alleviation of their suffering, both villagers and townfolk, literate as well as illiterate. As we said in *Corn Products Refining Co. Vs. Shangrila Food Products Ltd.*, the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity of the two names "Amritdhara" and "Lakshmandhara" is, in our, opinion likely to deceive or cause confusion. We must consider, the overall similarity of the two composite words "Amritdhara" and "Lakshmandhara". We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one "for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meanings of the composite words as "current of nectar" or current of "Lakshman". He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has other wise learnt and which he wants to purchase. Where the trade relates to goods largely sold to illiterate or badly educated persons, it is no answer to say that a person educated in the Hindi language would go by the etymological or ideological meaning and, see the difference between "current of nectar" and current of Lakshman. Current of Lakshman in a literal sense has no meaning to give it meaning one must further make the inference that the "current or stream" is as pure and strong as Lakshman of the Ramayana. An ordinary Indian villager or townsmen will perhaps know Lakshman, the story of the Ramayana being familiar to him but we doubt if he would etymologize to the extent of seeing the so called ideological difference between "Amritdhara" and "Lakshmandhara". He would go more by the similarity of the two names in the context of the widely known medicinal preparation which he wants for his ailments.

(9) We agree that the use of the word "dhara" which literally means "Current or

stream" is not by itself decisive of the matter. What we have to consider here is the overall similarity of the composite words, having regard to the circumstance that the goods bearing the two names are medicinal preparations of the same description. We are aware that the admission of a mark is not to be refused, because unusually stupid people, "fools or idiots", may be deceived. A critical comparison of the two names may disclose some points of difference, but 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. The trade mark is the whole thing the whole word has to be considered....."

55. In the case of *Heinz Italia and Another Vs. Dabur India Ltd.*, it has been held as under:

"16. Likewise, it has been repeatedly held that before the use of a particular mark can be appropriated it is for the plaintiff to prove that the product that he is representing had earned a reputation in the market and that this reputation had been sought to be violated by the opposite party. In *Corn Products case* (supra) it was observed that the principle of similarity could not to be very rigidly applied and that if it could be prima facie shown that there was a dishonest intention on the part of the defendant in passing off goods, an injunction should ordinarily follow and the mere delay in bringing the matter to Court was not a ground to defeat the case of the plaintiff. It bears reiteration that the word "Glucon D" and its packaging had been used by Glaxo since 1940 whereas the word "Glucose D" had been used for the first time in the year 1989.

17. In *Cadila Healthcare case* (supra), it has also been held that in the case of a passing off action the similarities rather than the dissimilarities have to be taken note of by the Court and the principle of phonetic "similarity" cannot be ignored and the test is as to whether a particular mark has obtained acceptability in the market so as to confuse a buyer as to the nature of product he was purchasing. We observe that the both Glucon-D and Glucose-D are items containing glucose and to us it appears that there is remarkable phonetic similarity in these two words.

18. We have also examined the packaging of the product and specifically Annexure P. 6 (colly). Item D of Annexure P-6 is the packaging in dispute. It will be seen that the colour scheme of Glucose-D and Glucon-D is almost identical with a happy family superimposed on both. Mr. Chandra has however pointed out that in Glucose-D the happy family consisted of four whereas in the case of Glucon-D the family was of three and as such the two were dissimilar. We are of the opinion however that the colour scheme and the overall effect of the packaging has to be seen. We have also examined Item D individually which is the exclusive packaging for Glucose-D; the one on the extreme left being the packaging in the year 1989, the one in the middle being the one for the year 2000 (which is impugned in the present suit) and the third on the extreme right

which is the subject matter of the suit in Calcutta which has been stayed on the application made by respondent. We are of the opinion that the packaging of Glucose-D is Glucon-D is so similar that it can easily confuse a purchaser. We also feel that mere fact that the respondents have time and again made small changes in their packaging is an attempt to continue to mislead the purchaser and to make it more difficult for the appellants to protect their mark, which the record shows has acquired an enviable reputation in the market which is sought to be exploited by the respondent."

56. In the case of Anglo-Dutch, Colour and Varnish Works Private Limited Vs. India Trading House, , relied upon by Senior Counsel for the plaintiff, it has been held as under:

"(11) As to the extent and scope of the work "mark" as defined in Section 2(j) of the Trade and Merchandise Marks Act, 1958, the observations of Graham, J. in Smith, Kline & French Laboratories Limited's Trade Mark: (1974) R.P.C. 91 (3) at page 95 may be seen--

"The upshot of all these cases is to my mind to establish that a scheme of colouring applied to goods may be a mark within the definition in Section 68. That definition, as was pointed out in contrast to other definitions in the Act, starts with the word "includes" showing that the definition is purposely not limited to the precise words which follow. The combination of colour giving a speckled effect in the present case is, in my judgment, no less a mark than the red lines in Reddaway's hose case or the "heading" in the cotton cases and in the Winter-bottom tracing cloth case. It is of course exactly parallel to the getup in the Hoffmann-La Roche (4) chlordiazepoxide case."

Again, in the later part of the judgment on page 96, learned Judge goes on to observe--

"The truth of the matter is I think as follows. In some cases the colour is an essential part of the article as an article whilst in others it is something which is not essential and has been added for some other reason. If it has been added so as to denote the origin of the goods, and the evidence shows that in practice it does so, it can properly be said that it is being used as a mark in the trade mark sense. The answer is no doubt one of degree and will depend on the evidence. It would be highly unlikely that colour in a lipstick could ever become distinctive of one manufacturer because in such a case colour is an essential element in and part of the article itself. It is for that reason that the customer buys it. Colour in a passenger motor car would normally be in a similar but not so conclusive a position, but I see no reason why a trader, as some do, should not paint his delivery vans or racing cars in specific distinct colours to indicate the origin of the car or of the goods it normally carries as emanating from him. With drugs, on the other hand, the position is the opposite of the lipstick. Colour is of no importance to the article as a drug and it may, if sufficiently distinctive, be an exceedingly effective indication of origin. It was so in the Hoffmann-La Roche

chlordiazepoxide case (1972) R.P.C. 1 (4). As has been said the less descriptive a trade mark is, the easier it is for it to be distinctive." Later on, at page 99 of the same judgment it was observed by Grahmi J. as under--

"I cannot see why other manufacturers should want to adopt the applicants' colour arrangements here except for the improper motive of trying to benefit from the latter's established goodwill."

In this judgment, Garham, J. relied on the observations of Harman Lord Justice in the Court of Appeal in the case of F. Hoffmann-La Roche & Company A.G. and Another v. D.D.S.A. Pharmaceuticals Limited, (1972) R.P.C. 1 (4). It is worthwhile to quote the words of Harman Lord Justice at page 20--

"Goods of a particular get-up just as much proclaim their origin as if they had a particular name attached to them, and it is well known that when goods are sold with a particular get-up for long enough to be recognised by the public as goods of a particular manufacturer it does not matter whether you know who the manufacturer is."

(12) As stated earlier, instead of receiving any satisfactory answer, I received no answer from the defendants to the plain question as to why they wished to mark their goods in violet grey and white. The only answer which I could suggest to myself was that they have adopted the colour-scheme in order to attract to themselves some part of plaintiff's goodwill and trade on their reputation and in fact to represent to public that their goods are the goods of the plaintiff. This is exactly a classic case of "passing off."

57. In the case of Parle Products (supra) the Supreme Court observed that to reach a conclusion whether one mark is deceptively similar to other they should not be placed side by side to ascertain whether there are any differences in the design and if yes whether they are of such a character as to prevent one design from being mistaken from the other. The Court further observed that broad and essential features are to be considered and it would be enough if the overall similarity of the two marks would like to mislead a person.

58. In the case of Amritdhara Pharmacy (supra) the Court was concerned with the marks Amritdhara and Lakshmandhara. While granting an injunction, the Court took into consideration two important questions i.e. (i) who are the persons whom the resemblance must be likely to be deceived or confused, and (ii) what rules and comparison are to be adopted in judging whether such a resemblance exists. It was also observed that the Court must take the two words, judge them by their look and their sound.

59. While in the case of Heinz Italia & Anr. (supra) the Court was concerned with Glucon-D and Glucose-D. It was found that the colour scheme of Glucose-D and Glucon-D was almost identical with a happy family superimposed on both.

60. I have also compared the original labels, which have been placed on record. The comparison of both the labels show as under:

61. Having regard to the settled position of law this Court has compared the two admitted labels, which would show, that the base colour of both the label is white. Letters on the label Officer's Choice and Officer's Special are both written in red colour and the lettering is slanting in both the labels. Border of both the labels is in gold. The product is identical and the writing in label is in block in both the labels. In view of the similarity between the two labels it leaves little room for doubt that an unwary customer is likely to get confused with regard to the two labels of the plaintiff and the defendants and, thus, it would amount to infringement of the plaintiff's copy right in their Officer's Choice and Officer's Special label. The same are identical, dangerously and confusingly similar.

62. The Court cannot lose track of the fact that both the marks are being used for Indian made foreign liquor whisky. The product is likely to be purchased by a particular strata of society and there is every likelihood that an unwary purchaser of average intelligence and imperfect recollection is likely to be deceived by the label and the mark on account of the strong similarity, colour scheme, writing style, gold border, user of the colour Red and for an identical product irrespective of the fact that the product of the defendant is made out of the grain.

63. While it is the case of the plaintiff that plaintiff is the registered proprietor and prior user of the trade mark Officer's Choice on account of his large sales throughout India and overseas they have acquired enviable reputation and goodwill and as a result of its excellent quality, distinctive packaging and characteristics, namely, palatable test, flavour, blending, etc. Further Officer's Choice is one of the highest selling brands of the plaintiff and is considered one of the largest selling whiskies in India. The plaintiff has incurred extensive expenditure towards promotional campaigns in order to promote and publicize its product. Sale figures and amounts incurred on promotions have been extracted in the plaint. Thus, it is contended that the trade mark of the plaintiff enjoys an unparallel reputation and goodwill and has also acquired the status of the well known mark and the adoption and use of the trade mark Officer's Special would amount to infringement of the registered trade mark of the plaintiff and an attempt to encash upon the tremendous reputation goodwill and sale of the product enjoyed by the plaintiff. Moreover, the trade marks are identical, structurally, phonetically and visually.

64. It has been argued by Counsel for the defendants that the goods sold under the trade mark Officer's Special by the defendants are different as to that of the goods sold by the plaintiff under the brand Officer's Choice. Mr. Reddy further submits that the whisky sold by the defendants under the brand name Officer's Special is manufactured from grains and it is called as Premium Grain Whisky and it is the only such product available in India. It has further been submitted that the trade mark Officer's Special is associated with the plaintiff's logo along with companies flagship name Sentini's and hence both the labels when compared are different.

65. The above argument of Counsel for the defendants is without any force as

both the products are Indian made foreign liquors. They are both sold from the same vend and the customer base is the same. Thus, the fine distinction, which is sought to be drawn with regard to the defendants' product being manufactured from grains, cannot be accepted.

66. It is also the case of the defendants that the plaintiff cannot claim themselves to be the owner of the trade mark Officer's Special, which was coined in the year 2005 and simply filing an application before the Excise Commissioner, Chhattisgarh and not having used the brand can be of no benefit to the defendants.

67. It has also been submitted by Counsel for the defendants that the objections raised by the plaintiff against the defendants before the Excise Commissioner stand rejected. Another submission, which has been raised by the learned Counsel for the defendants is that at the time of registration of trade mark Officer's Choice there was a disclaimer for the words "Choice Prestige and Whisky" and since the word "Officer" being a general word the plaintiff cannot monopolise rights for the words "Officer" and "Choice".

68. Mr. Sudhir Chandra, learned Senior Counsel for the plaintiff, has relied upon in the case of Vicco Laboratories, Bombay Vs. Hindustan Rimmer, Delhi, and more particularly paragraphs 13 and 14 in support of his submission that where colour scheme and the getup of the two products are similar, the plaintiff is entitled to an injunction, and even in the case where two marks are different. Paragraphs 13 and 14 read as under:

"13. The plaintiffs claim passing off by the defendants of their product as and for the product of the plaintiffs on the basis of copy of the distinctive getup and colour scheme of the collapsible tubes and the cartons by them. The defendants are not entitled to represent their goods as being the goods of the plaintiffs. The two marks "Vicco" and "Cosmo" used by the plaintiffs and defendants, respectively are no doubt different and the mark "Cosmo", by itself is not likely to deceive but, the entire getup and the colour scheme of the tube and the carton adopted by the plaintiffs and the defendants are identical in every detail and are likely to confuse and deceive the customer easily. The getup and the colour scheme of the plaintiffs adopted in every detail by the defendants for their tube and carton cannot be said to have been adopted by the defendants' unintentionally. Further the defendants allege that they started selling their product in the carton and tube in question from Nov., 1977 while the Plaintiffs have been selling their product in the said carton and the tube since April, 1975. The suit was originally filed in Feb. 1978 at Bombay and ex parte injunction was granted on 29th Aug., 1978. The plaintiffs are prior users of their product in the carton and the tube.

14. For the grant of a temporary injunction three facts are essential, namely, to Prove prima facie case, the balance of convenience between the parties and the irreparable injury likely to be caused in case the injunction is not granted. The

plaintiffs have prima facie proved the case that they have been selling their product in the carton and the tube in question with distinctive getup and colour scheme since April, 1975, while the defendants started selling their product in Nov. 1977 in the tube and the carton which prima facie appear to be copies of the entire getup and the colour scheme adopted by the plaintiffs. The tube and the carton with the get-up and colour scheme have come to be associated by the trade and members of the public as the product of the plaintiffs, the plaintiffs have also sold their product of the value of Rs. 1,77,31,377/- during the period April 1975 to Dec. 1977. The plaintiffs are the reputed "Manufacturers of the turmeric cream since 1975. The defendants have put their product in the market only from Nov. 1977 and they have not disclosed the value of their sales, meaning thereby that the sales of the defendants are negligible. It appears that it would be proper if the defendants at this stage are restrained from passing off their product in the tube and the carton which are deceptively similar to the tube and the carton--adopted by the plaintiffs since April, 1975. It would be in the interest of the defendants also to adopt their own get-up for tube and the carton for the sale of their product. The plaintiffs are likely to suffer irreparable injury if the defendants are allowed to use to similar carton and the tube identical with getup and colour scheme adopted by the plaintiffs. The injunction will not result in any hardship to the defendants if they at this stage can adopt any other carton and the tube with different getup and colour scheme. The balance of convenience is in favour of the plaintiffs."

69. In the case of Vicco Laboratories (supra) two marks Vicco and Cosmo were different based on the entire get up and colour scheme and an injunction was granted.

70. In my view, the present case is on a much better footing in favour of the plaintiff as the defendants has not only used the identical colour scheme, writing style, font, gold border for an identical product sold from the same shelf to same class of customers but has also copied the word "Officer".

71. In the case of Automatic Electric Limited Vs. R.K. Dgawan and Another, , it was held that the first syllable of a word mark is generally the most important. Para 19 reads as under:

"19. It is undoubtedly true that the first syllable of a work mark is generally the most important and thus, when the defendants are using a similar prefix with that of the plaintiff with a little variation in the suffix part of it, in my considered opinion, the trade marks are deceptively similar and cause of action for prima facie infringement is complete. The submission of the learned Counsel for the defendants that the word "DIMMER" is a generic and descriptive word also cannot be accepted for the trade mark is "DIMMERSTAT" and not "DIMMER" and the Court in a case of infringement of trade mark has to look into the whole of the trade mark as registered including the word "DIMMER". Since the plaintiff has been using the said trade mark for a long period of time, user of deceptively similar trade mark by the defendants would necessarily cause irreparable loss

and injury to the plaintiff. In my considered opinion, balance of convenience is also in favour of the plaintiff and against the defendants."

72. Further in the case of Virendra Dresses Vs. Varindra Garments, it has been held as under:

"(2) It is well known that no man is entitled to carry on his business in such a way as to represent that it is the business of another or is in any way connected with the business of another. A person has a legitimate right to carry on business under his own name but he cannot carry on the business which may have the effect of passing off his goods as the goods of other. The plaintiffs have been carrying on their business in readymade garments since August, 1978. Their sales from Rs. 50,000.00 in 1978 rose to Rs. 2,50,000.00 in 1980-81. The defendant started his business under the trade name Varindra Garments in January 1980. He does not disclose the sales since the commencement of the business. The plaintiffs and the defendant carry on business in the same street at a distance of about 50 yards only. The plaintiffs sent a notice dated 21.4.1981 to the defendant requiring him to stop using the trade name Varindra Garments in connection with the readymade goods. The defendant sent a reply through Surender Kumar proprietor wherein it was alleged that the two names did not resemble. Prima facie it is apparent that the words "VARINDRA" in plaintiffs' trade name and the words "VIRENDRA" in defendant's trade name are similar, if not identical as the spelling of the two words are different. But when the two names are pronounced there does not appear to be any difference. The words "dresses" and "garments" mean the articles of clothing. Thus the main word which is likely to cause confusion in the two businesses of the plaintiffs and the defendant is "VARINDRA". The two trade names of the plaintiffs and the defendant are similar and this similarity is sufficient to give rise to great risk of confusion. Similarity and confusion are to be determined from the point of view of a common man. A man in the street will remember the name "Varindra" he may not be able to make a distinction between the "garments" and "dresses". If a man goes in the street where the plaintiffs and defendant are carrying on business he may enter the business premises of the defendant. Thus there is every likelihood of confusion if a public man goes to the street where the plaintiffs and the defendant are carrying on business. A customer intending to go to the business premises of the plaintiffs is likely to visit the business premises of the defendant when the two trade names are so similar. I am therefore of the view that the two trade names are not distinctively different but are similar likely to cause confusion. The plaintiffs have been carrying on business since August, 1978. They have acquired reputation and the sales have risen. The defendant has not disclosed his sales or reputation in the market. The plaintiffs are therefore prima facie likely to suffer in business and reputation if the defendant is allowed to carry on business in readymade garments in the existing trade name. The defendant has recently started his business and it is desirable that he should stop using the said trade name even during the pendency of the suit. If the defendant is not restrained it may result in confusion to the business of the

plaintiffs and the defendant. In AIR 1940 39 (Lahore) the plaintiff was carrying on business under the name "Bhaion Ki Dokan". The defendants started the business under the name "Punjabee Bhaion Ki Dokan". The defendants were restrained till the decision of the suit from using the trade name "Punjabee Bhaion Ki Dokan" as the two trade names were similar which was likely to cause confusion in the minds of the intending purchasers. In *Banjit Singh v. Jaswant Singh*, the plaintiffs were carrying on business under the trade name "Ex-Soldiers Store". The defendants started the business under the name "R.J. Singh and Sons (Ex-Soldiers Store)". The defendants were restrained from trading under the said name. It is not disputed that the plaintiffs have been using the said trade name prior to the user by the defendant. The action is for passing off. In *Century Traders v. Roshan Lal Duggar Bothers*, it has been held that in an action for passing off in order to succeed in getting an interim injunction the plaintiff has to establish user of the mark prior in point of time than the impugned user by the defendants. Further it has been observed that actual damage is unnecessary in a passing off action. In *Midland Counties Dairy Ltd. v. Midland Dairies Ltd.*, 65 R.P.G. 429, the plaintiffs were carrying on business of Ice Cream under the name "Midland Counties Dairy Ltd.". The defendants started business in ice cream under the name "Midland Dairies Ltd.". The defendants were restrained as their name was liable to be confused with that of the plaintiffs.

(6) The order of the trial Court is not according to law. I, therefore, accept the appeal and set aside the judgment and order dated 21.7.1981 of the trial Court. A temporary injunction till the decision of the suit by the trial Court is issued restraining the defendant/respondent from adopting or carrying on business in the name of "VARINDERA GARMENTS" or any other name calculated to mislead the people to believe that the business of the defendant was the business of the plaintiffs so as to cause confusion between the two businesses. No order as to costs."

72A. The Privy Council in the case of *De Cordova and Others v. Vick Chemical Company*, 68 R.P.C. 103, 106 has held as under:

"It has long been accepted that, if a word forming part of a mark has come in trade to be used to identify the goods of the owner of the mark, it is an infringement of the mark itself to use that word as the mark on part of the mark of another trader, for confusion is likely to result."

The Supreme Court in the case of *Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories*, , has laid down the test of infringement, which reads as under:

"In an action for infringement the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the Court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated."

In the case of American Home Products Corporation Vs. Mac Laboratories Pvt. Ltd. and Another, it was held:

"when a person gets his trade mark registered, he acquires valuable rights by reason of such registration. Registration of his trade mark give him the exclusive right to the use of the trade mark in connection with the goods in respect of which it is registered and if there is any invasion of this right by any other person using a mark which is the same or deceptively similar to his trade mark, he can protect his trade mark by an action for infringement in which he can obtain injunction....."

In the case of National Bell Co. and Gupta Industrial Corporation Vs. Metal Goods Mfg. Co. (P) Ltd. and Another, it was held as under:

"On registration of a trade mark, the registered proprietor gets under Section 28 the exclusive right to the use of such trade marks in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of any infringement of such trade mark."

In the case of M/s. Avis International Ltd. Vs. M/s. Avi Footwear Industries and another, it was observed:

"In my view violation of the exclusive statutory rights is illegal activity, to hold otherwise will negate the statutory provisions of the Trade and Merchandise Marks Act."

72C. In the case of Automatic Electric Limited (supra) it was held that the validity of the trade mark cannot be challenged in an action of infringement:

"The validity of the registration of "DIMMERSTAT" cannot be challenged by the defendants in a proceeding like this for the defendants have a remedy to file cancellation of the registration in an appropriate forum."

72D. Identification of essential features of the trade marks has been discussed in details in the case of Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories (supra):

"In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the Court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the getup, packing and other writing or marks on the goods or on Section 10 of the Trade Marks Act, 1940, observed at page 152 as follows--

"Now in deciding whether a particular trade mark is likely to deceive or cause confusion, it is not sufficient merely to compare it with the trade mark which is already registered and whose proprietor is offering opposition to the registration

of the former trade mark. What is important is to find out what is the distinguishing or essential feature of the trade mark already registered and what is the main feature or the main idea underlying that trade mark, and if it is found that the trade mark whose registration is sought contains the same distinguishing or essential feature or conveys the same idea, then ordinarily the Registrar would be right if he came to the conclusion that the trade mark should not be registered. The real question is as to how a purchaser, who must be looked upon as an average man of ordinary intelligence, would react to a particular trade mark, what association he would form by looking at the trade mark, and in what respect he would connect the trade mark with the goods which he would be purchasing. It is impossible to accept that a man looking at a trade mark would take in every single feature of the trade mark. The question would be, what would he normally retain in his mind after looking at the trade mark? What would be the salient feature of the trade mark which in future would lead him to associate the particular goods with that trade mark?"

The decisions referred with regard to essential features were followed by the Division Bench in the decision reported as *Atlas Cycle Industries Ltd. Vs. Hind Cycles Limited*, . The Division Bench has examined the similar question very thoroughly while dealing with the two rival trade marks *Royal Star* and *Eastern Star* of the parties and has come to the conclusion that the trade mark adopted and used by the defendant *Royal Star* is similar to plaintiff's trade mark *Eastern Star*.

In the decision reported as (1945) 65 RFC 62, *Aristoc v. Rysta* decided 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;

...

"When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks identical no further question arise; for then the infringement is made out...."

72E. The Court in determining whether the defendant's mark is deceptively similar to the mark of the plaintiffs were enunciated in the judgment of Mr. Justice Parker in the decision reported as 1906 (23) RPC 774, *Pionotist* case:

"You must take the two words. You must judge of 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 & 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. If, considering all those circumstances, you come to the conclusion

that there will be confusion-that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be confusion in the mind of the public which will lead to confusion in the goods--then you may refuse the registration, or rather you must refuse the registration in that case."

72F. In the decision reported as *James Chadwick and Bros. Ltd. Vs. The National Sewing Thread Co. Ltd.*, , Chagla C.J. and Bhagwati, J.; referring to the words "likely to deceive or cause confusion" in by the House of Lords, it was held that the comparison of trade marks was a matter of first impression, but the mark "Rysta" too closely resembled mark "Aristoc" phonetically and it would be liable to lead to deception and confusion.

72G. As regard reliance of *White Horse Distillers* (supra) is concerned, the said decision of Single Judge of this Court has no bearing in the present case as the facts are materially different. In that case, the Court after having considered the material placed on record held that the part of the trade mark House is common to trade and get up was also different so also the device of two houses used by the parties, however in the present matter nothing has been placed on record by the defendant to show that the essential feature Officer is common or has actually been used by any third party prior to use of the plaintiff. Therefore, the said decision has no application in the present case.

With regard to the case of *Radico Khaitan* (supra) the facts are entirely different, it was held by the Court that the number 8 is not distinctive and is not protectable in law, therefore, injunction was not passed for various other reasons as well.

Similarly in the case of *Khoday* (supra) relied upon by the defendant, it was the case of rectification of trade mark which was filed by Scotch Whisky Association against Khoday after the lapse of many years despite of having knowledged about the existence of trade mark of Khoday. Therefore, the issues involved in the matter of rectification and consequences of delay were discussed and no relief to Scotch Whisky Association for rectification was granted. In the present case, this Court is dealing with the statutory rights granted by the registration and appropriate colour scheme and get up of the plaintiff's product. Therefore, the said decision has application to the present case.

For the reasons stated above, the Court is of the view that the plaintiff has been able to make out a strong prima facie case, balance of convenience is also in favour of the plaintiff and in case injunction order is not confirmed not only the plaintiff but the unwary customers who cannot be compensated in terms of money would also suffer in case injunction is not granted. Accordingly, the present application filed by the plaintiff under Order 39 Rules 1 and 2, CPC is allowed. Interim order is confirmed. Needless to say while deciding the present application this Court has taken a prima facie view of the matter and any observation made are only for the purpose of deciding the present application alone.