

(2006) 03 AHC CK 0075

In the Allahabad High Court

Case No : First Appeal from Order No. 2193 of 2005

Anwar Mohammad Khan

APPELLANT

Vs

Sri Taj Mohammad Khan, Mohd. Imran Khan and Sri Firasat
Husain

RESPONDENT

Date of Decision : 22-03-2006

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2, Order 41 Rule 22(1), 151

Copyright Act, 1957 — Section 63

Penal Code, 1860 (IPC) — Section 420, 485, 486, 487

Specific Relief Act, 1963 — Section 36, 37, 38, 39, 40

Trade and Merchandise Marks Act, 1958 — Section 105, 106, 11, 12, 19

Trade Marks Act, 1999 — Section 124, 124(5), 134, 134(1), 135

Trade and Merchandise Marks Act, 1958 — Section 105, 106, 11, 12, 19

Trade Marks Act, 1999 — Section 124, 124(5), 134, 134(1), 135

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2, Order 41 Rule 22(1), 151

Copyright Act, 1957 — Section 63

Penal Code, 1860 (IPC) — Section 420, 485, 486, 487

Specific Relief Act, 1963 — Section 36, 37, 38, 39, 40

Trade and Merchandise Marks Act, 1958 — Section 105, 106, 11, 12, 19

Trade Marks Act, 1999 — Section 124, 124(5), 134, 134(1), 135

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2, Order 41 Rule 22(1), 151

Copyright Act, 1957 — Section 63

Penal Code, 1860 (IPC) — Section 420, 485, 486, 487

Specific Relief Act, 1963 — Section 36, 37, 38, 39, 40

Citation : (2006) 9 ADJ 98 : (2006) 3 AWC 2166

Hon'ble Judges : V.C. Misra, J

Bench : Single Bench

Advocate : S.K. Verma, Siddhartha Varma and Pulak Ganguli, for the Appellant;
M.A. Qadeer, D.S. Misra and C.K. Misra, for the Respondent

Final Decision : Dismissed

Judgement

V.C. Misra, J.—Heard Sri S.K. Verma, Senior Advocate assisted by Sri Siddarth

Verma & Sri Pulak Ganguli, learned Counsel appearing on behalf of the appellant-defendant and Sri M.A.Qadeer & Mr. D.S. Misra, learned Counsel appearing on behalf of respondents No. 1 and 2-plaintiffs.

2. The present appeal has been filed by the appellant-defendant challenging the order dated 29.7.2005 passed by the District Judge, Bareilly in Original Suit No. 6 of 2005 allowing interim injunction application of the plaintiffs-respondents No. 1 and 2 moved under Order 39 Rule 1 & 2 of the CPC restraining the defendant-appellant from manufacturing, marketing and trading the Khaini and Tobacco with the name and style of "Bargad Fed Chhap Asali Nawab Dulha Khan".

3. The facts of the case in brief are that one Niyamat Ullaha Khan was running his business of Tobacco and Khaini under the trademark in the name and style of "Nawab Dulha Khan Khaini" and when he died in 1992 his sons started the said business adding some additional words in the said trademark. The respondent-plaintiffs started their business of Tobacco with the trademark in the name and style of "Ped Chhap Nawab Dulha Khan Khaini" w.e.f. 1993, whereas the appellant-defendant started his business with the trademark in the name and style of "Chand Khajoor Chhap Anwar Dulha Khan" with emblem of Rais Dulha Khan, Bareilly depicting Central Excise Registration Certificate No. 8/R-1 BLY/93 on the wrappers.

4. The respondents-plaintiffs filed Original Suit No. 6 of 2005 seeking injunction on the ground that the appellant-defendant changed his trademark and caption and started his business with effect from February, 2005 in the name and style of "Bargad Ped Chhap Asli Nawab Dulha Khan Khaini" on the wrappers in which the words "Bargad" and "Asli" were written in very small letters and was in very much resemblance with the trademark of respondents-plaintiffs causing deception, misleading the customers which resulted in damaging and affecting their business.

5. In the plaint it has been stated that the trade mark "Ped Chhap Nawab Dulha Khan" of the plaintiffs- respondents was registered at number 611689 (subsequently corrected as 611389) under the Trade and Merchandise Marks Act, 1958 and the Copyright Act, 1957 and the plaintiff No. 1- respondent Taj Mohammad Khan assigned the said trade mark and Copyright "Ped Chhap Nawab Dulha Khan" to plaintiff No. 2-respondent Mohd. Imran Khan by means of assignment deed dated 15th December, 2003 and since then Mohd. Imran Khan plaintiff No. 2 has been running his business as a assignee of Taj Mohammad Khan (plaintiff No. 1 -respondent). It has also been stated that the plaintiffs have a large volume of sales of their product under the registered trade mark "Ped Chhap Nawab Dulha Khan" which was carved, designed, coloured and written in a distinctive style on the wrappers for many years and their customers as well as the traders have identified and recognized the goods as such being the exclusive merchandise of the plaintiffs and none else. The plaintiffs are the creator and the author of the artistic work, design, style and colours of lettering of the said trade mark and are the legal owners, proprietors and user of the same and they have

been continuous user thereof and have thus acquired exclusive right to use its registered trade mark under the Copyright Act in respect with their goods. In the plaint it has also been alleged that the appellant-defendant by using identical and or deceptively similar mark or artistic work as referred to above started his business from February, 2005 which is bound to cause confusion and deception in the mind of unwary class of customers amounting to falsification of plaintiffs' registered trade mark and to cause heavy financial losses to the plaintiffs-respondents to which the appellant-defendant was not entitled to under law. It has also been asserted that purchasers of Khaini and tobacco are mainly illiterate public who are being confused, misled and deceived by purchasing the inferior quality of Khaini and Tobacco manufactured by appellant-defendant knowingly and willingly and without consent of the plaintiffs-respondents and thus the appellant-defendant violated the plaintiffs copyrights in the artistic work, lettering and colouring etc in the registered trade mark and has committed offences punishable u/s 78 and 79 of the Trade And Merchandise Marks Act, 1958 (hereinafter referred to as "the Act No. 43 of 1985") and Section 63 of the Copyright Act, 1957 and under Sections 420, 485, 486, 487 of the Indian Penal Code. The appellant-defendant did not accede to the request of the plaintiffs-respondents and did not refrain from manufacturing, marketing and trading their products of Khaini and Tobacco with falsified mark "Ped Chhap Nawab Dulha Khan" which was causing irreparable loss and injury whereas on the other hand it did not affect the appellant-defendant at all in any manner. The plaintiffs-respondents alongwith plaint had filed an application under Order 39 Rule 1 and 2 of the CPC supported with an affidavit seeking temporary injunction upon which an exparte interim order was granted.

6. The appellant-defendant No. 1 in rebuttal to the said injunction application filed his objections/counter affidavit before the trial court. In para 1 it is stated that the alleged trademark "Ped Chhap Dulha Khan" was not registered in the Trade Mark Office by the respondent-plaintiffs and the number mentioned as 611389 was only application number and not the registration number. It was also asserted that the appellant-defendant No. 1 had moved an application for registration before the trademark office for registration of his trademark in the name and style of "Asli Nawab Dulha Khan Ped Chhap".

7. After hearing learned Counsel for the parties and perusal of the record the trial court passed an order restraining the appellant-defendant from using the trade mark "Bargad Ped Chhap Asali Nawab Dulha Khan Khaini Tambakoo Choona Sahit" for the purpose of manufacturing marketing and trading the Khaini and Tobacco till the pendency of the suit.

8. The defendant being aggrieved filed the present appeal on the grounds, inter alia, that as the plaintiffs-respondents did not come forward with the case that they were seeking an injunction against the user of any literary or dramatically work or user of work or any artistic work or any cinematographic work and the court below passed the interim order on an assumption that the plaintiffs-

respondents had a registered trademark; that the plaintiff-respondents came forward with the allegations in their suit that their trademark was registered under the Trade Mark Act bearing number 1255208 but when the appellant-defendant controverted this assertion then the plaintiff-respondents with permission from court amended their plaint and substituted the number by another number 611389 and maintained through out that their trademark was registered under the Trade Mark Act whereas in fact it was not so, neither the Copy Right Act, 1957 applied to it and the plaintiff-respondents subsequently changed the basis of their case altogether from the original one; that the case of Dhariwal Industries Ltd. and Another Vs. M.S.S. Food Products, did not apply at all to the facts of the present case in as much as the alleged trade mark of the plaintiffs is Ted Chhap Nawab Dulha Khan Khaini" whereas the appellant-defendant is using the trademark of "Bargad Ped Chhap Asli Nawab Dulha Khan Khaini" which is a different trademark and since a different trademark was being used by the appellant-defendant no temporary injunction could be granted; that the present business being an ancestral business of Niyamatullah Khan, after his death all his sons were entitled to use the same trademark, as the ancestral business was being carried on by all his three sons; that no prima facie case was made out nor any case of balance of convenience was raised nor any findings were given by the trial court regarding irreparable loss and injury except to the extent that there was a possibility of some irreparable loss which could not be termed to be a clear finding regarding irreparable loss to the plaintiffs nor any balance of convenience lay in favour of the plaintiffs, the relief granted by the trial court was much more than that was prayed for by the plaintiff-respondents. The plaintiff-respondents had only prayed for restraining the defendants from using the trademark "Ped Chhap Nawab Dulha Khan" whereas the temporary injunction was granted in favour of the plaintiff-respondents and against the appellant-defendant to the effect that they shall not use the trademark of "Bargad Ped Chhap Asali Nawab Dulha Khan Khaini Tambakoo Choona Sahit" and that in view of Section 124 of the Trade Marks Act, 1999 the proceedings of suit itself had to be stayed and ad interim injunction could not be granted. Thus, the suit itself was barred by Section 124 of the Trade Marks Act, 1999 (hereinafter referred to as "the Act, 1999").

9. Learned Counsel for the appellant-defendant has submitted that the present original suit filed by the plaintiff-respondents was barred u/s 27(1) of the Act, 1999, since no person was entitled to institute any proceeding to prevent or to recover damages for, the infringement of an unregistered trademark. However, no such specific ground has been raised by the appellant-defendant in the present appeal. It has also been submitted by the learned Counsel for the appellant- defendant that the plaintiff-respondents had not filed the original suit on the ground of user and the plaintiff-respondents could succeed only on their own case set up by them and not upon a case not setup by them. The specific case set up in the plaint is that their trademark was registered and the appellant defendant was using the same. It has been found to be incorrect by the trial

court that the alleged trade mark had been registered. In this context learned Counsel for the appellant-defendant has relied upon the decisions given in the case of 1983 All. L.J. 509 (para 5) and in *Brahma Nand Puri Vs. Neki Puri*, It has been reiterated that no relief beyond the prayer could be granted by the court. That the effective findings regarding the three ingredients which are Sine Qua Non for issuance of an injunction viz. (i) prima facie case (ii) balance of convenience (iii) irreparable injury which could not be compensated in terms of money are lacking in the impugned order of the trial court. The trial court had merely said that there was a possibility of irreparable loss. There was no such finding that plaintiffs' loss could not be compensated in terms of money. Since the plaintiffs had also not come with clean hands for getting temporary injunction, they were not entitled to any temporary injunction. The learned Counsel for the appellant placed reliance upon the decision rendered in *Dalpat Kumar and another Vs. Prahlad Singh and others*, ; in *Hazrat Surat Shah Urdu Education Society v. Abdul Saheb* 1989 CCC 33 (Supreme Court) and in *Ajendra Prasad Ji Narendra Prasad Ji Pandey v. Swamy K. Narayan Das Ji and Ors.* 2005 (30) AIC 30 .

10. Learned Counsel for the appellant has also stressed that there is no pleading of "passing off in terms of Section 27(2) of the Act, 1999 and, therefore, it could not be the basis for awarding any relief. The trial court erred in basing its judgment and order on the fact that the plaintiffs were using the trademark from before the same was being used by the appellant-defendant. Learned Counsel for the appellant stressed that in view of the observations made by the apex Court in the case of *Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.*, (*Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.* to the extent "dissimilarity" and not "similarity" to essential feature had to be taken into consideration) as far as the user of the trademark which has been registered would be illegal but there was no infringement of an unregistered trademark and in view of the same no strict view could at all be taken by the court if the appellant-defendant had been using some portion of the unregistered trademark of the plaintiffs. It has also been submitted that in respect with "passing off three ingredients namely, "disclosure of goodwill", "demonstration of misrepresentation" and "suffering or likelihood of suffering of irreparable harm and injury in terms of reputation or money" are required to be present which are not present and established and the court below has confused with the rights under the Copy Rights Act and the Act, 1999 and proceeded as if the case was instituted under "passing off whereas the plaint is absolutely silent on this point.

11. Learned Counsel for the appellant-defendant has lastly argued that the plaintiff-respondents have not filed any cross-appeal under Order 41 Rule 22(1) of the CPC against the finding of the trial court that the trademark was not registered, the said finding has become final. (Reliance has been placed on the decision reported in *Choudhary Sahu (Dead) by Lrs Vs. State of Bihar*, and *D.M. Deshpande and Others Vs. Shri Janardhan Kashinath Kadam (Dead) by Lrs. and Others*,

12. Learned Counsel for the respondent-plaintiffs reiterating the averments made in the counter affidavit filed by it in the present appeal and the averments made in the plaint has submitted that the plaintiffs have been running its business since 1993 under its aforesaid trademark whereas the appellant-defendant has been running its business under the trademark in question admittedly only with effect from February, 2005 as per Para 20 of the appellant's affidavit filed in support of the stay application and thus, the respondent-plaintiffs are user of their trade mark much prior to the trademark in question of the defendant-appellant. An application-dated 8.11.1993 had been moved u/s 18 of the Act, 1999 for registration of the trade mark by the respondent-plaintiffs in the prescribed manner. The Registrar did not refuse the acceptance of the application rather accepted the same and entered the same in the concerned relevant Register for the purpose of granting registration. The said acceptance has not been withdrawn in terms of Section 19 which provides for conditional withdrawal of acceptance of such application before its registration, neither there has been any opposition to the said registration u/s 21. Section 23 requires the Registrar to register the trade mark, where the procedure for registration has been completed (subject to the conditions mentioned therein) and the same shall be registered as of date of making of such application which shall be deemed to be the date of registration.

13. It has been further asserted by the learned Counsel for the respondent-plaintiffs that the provisions of Sub-section (1) of Section 27 are not attracted in the present set of facts and circumstances of the case instead the suit is fully maintainable. Section 134 stipulates the forum for institution of infringement proceedings, etc., to be the District Court, which brings the trade marks law in line with the provisions contained in the Copyright Act, 1957, as very often a trade mark is also registered as an artistic work under the Copyright Act. Sub-clause (C) of Clause (1) of Section 134 lays down that no suit for passing off arising out of the use by the defendant of any trade mark which is identical with or deceptively similar to the plaintiff's trade mark, whether registered or unregistered shall be instituted in any court inferior to a District Court having jurisdiction to try the suit. Section 135 deals with the reliefs which by way of injunction also may be granted by the courts in the suits for infringement or for passing off referred to in Section 134 subject to such terms, if any, as the court thinks fit and may grant also further relief at the option of the plaintiff, either damages or an account of profits, etc., referred to therein. Sub-clause (b)(i) of Clause (3) of Section 135 further provides that notwithstanding anything contained in Sub-section (1), the court shall not grant relief by way of damages other than nominal damages or on account of profits in any case where in a suit for infringement of a trade mark the defendant satisfies the court that at the time he commenced to use the trade mark complained of in the suit, he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was on the register or that the plaintiff was a registered user being by way of permitted use. Reference is made to the provisions of Section 71 under

which the applications for registration of certification trade marks shall be moved before the Registrar in the prescribed manner by the person proposed to be registered as the proprietor thereof and Sub-clause (2) of the said Section provides that the provisions of Sections 18, 19 and 22 shall apply in relation to an application u/s 18 subject to the modification that references therein regarding acceptance of an application shall be construed as references to authorization to proceed with an application. Reference of Section 124(5) is also made under which the court is entitled to grant stay in a suit for infringement of a trademark and shall not preclude the court from making any interlocutory order including any order granting an injunction etc. Section 159 deals with repeal and savings clause by which the Trade and Merchandise Marks Act, 1958 has been repealed wherein it has been laid down that the provisions of the Act, 1999 shall apply to any application for registration of a trade mark pending at the commencement of the Act and to any proceedings consequent thereon and to any registration granted in pursuance thereof. This is for safeguarding the existing rights of the respondent-plaintiffs to the continued use of its trade mark.

14. Learned Counsel for the respondent-plaintiffs in support of his arguments has relied upon the certain decisions of the apex Court as well as of the other High Courts, In the case of Dhariwal Industries Ltd. and Anr. v. M.S.S. Food Products 2005 (1) CRC 361 in relation with Section 27 of the Act, 1999, the apex Court has held that if neither of the party has a registered trade mark as on the date of filing of the suit Section 27 of the Act, 1999 cannot stand in the way of entertaining the claim of the plaintiff and in granting the plaintiff an injunction in case he or it is in position to show prima-facie case that it was prior user of its mark. In the case of Reliance Industries Ltd. v. Anand Traders and Ors. 1998 (Suppl.) Arb. LR. 422 in relation with Sections 11, 12 and 19 of the Act, 43 of 1958, the Bombay High Court held that when similar trade marks are used in respect of the identical goods having a overall similarity which is likely to mislead a person to accept the one for the other if it is offered, the customers or purchasers of the goods can be deceived.

15. In the case of Indian Shaving Products Ltd. and Anr. v. Gift Pack and Anr. 1999(1) A. L.R. 26 in relation with Sections 9, 27 and 105 of the Act No. 43 of 1958, the Court was of the view that for granting an interim injunction the plaintiffs have to establish prima-facie case in their favour and that if the injunction is not granted they are likely to suffer irreparable loss and damages and that would be well nigh impossible to compensate them in terms of money and on the other hand the defendants are not going to suffer any irreparable loss and damages. Accordingly, finding the aforesaid things established by the plaintiffs, the Court restrained the defendants, their servants and agents from selling, offering for sale, advertising directly or indirectly dealing in goods in the said trade mark and from passing off their goods as the goods of the plaintiffs or under any other trade mark which is deceptively similar to the said trade mark, as it was the goodwill of a particular business which was built by a trader by his hard work, labour and the sweat of his brow. The law of passing off came into

being to preclude unfair trading and to protect the rights of the traders to the goodwill, which they have developed in their business over a period of time.

16. In the case of Maharashtra Rajya Sahkari Doodh Mahasangh Ltd. v. Meal Vitamin Food Products Ltd. 1999 (1) A. L.R. 369 the Bombay High Court held that no trader shall be allowed to trade upon others reputation and goodwill deceptively similar and likely to cause confusion and as the plaintiff was the prior user established passing off and prima facie case in its favour deserves protection of its right of prior user of the trade mark and by virtue of long extensive and continuous use of the said trade name acquired exclusive right to use the said trade name, therefore, the benefit of the name and reputation earned by it cannot be taken advantage by any other trader by keeping the mark and passing off its goods like goods of the said person. In the case of Yahoo !Ine v. Akash Arora and Anr. 1999 (1) A. LR 620 in relation with Sections 27 and 106 of the Act No. 43 of 1958, the Delhi High Court held that where the trade mark of a trader acquired distinctive reputation and goodwill and the other person adopted the trade mark deceptively similar and likely to cause confusion then passing off action would be taken against that person and passing off action was maintainable and no man is entitled to carry on his business in such a way as to lead to the belief that he is carrying on the business of another man.

17. In the case of Wockhardt Limited v. Aristo Pharmaceuticals Limited 1999 (2) A. L.R. 258 Madras in relation with Sections 28, 29 and 31 of the Act No. 43 of 1958, the Madras High Court observing that the infringement takes place not merely by exact imitation but by the use of a mark so nearly resembling the registered mark as to be likely to deceive, has held that the registered proprietor of a trade mark has exclusive right to the use of the trade mark in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by the Act; When once it is registered then after a lapse of 7 years, it acquires the validity and becomes a distinctive mark; Whether it is descriptive or has become publici juris is a question of fact to be established; When a number of marks all have a common element, may it be prefix, suffix or root, i.e., essential part or the core of the mark, they come to be associated in the public mind as an indication of the same source, which misleads or causes deception or confusion. ; It is the common element that has to be identified in the impugned mark and the registered trade mark and if such common element is highly distinctive and is not just a description or a commonly used word, the likelihood of deception or confusion would be very much there, despite the fact that it may differ in similarity in certain letters. In such a situation, there may be likelihood of deception or confusion coupled with anxiety of the dealer to cause confusion on the consumer.; The nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances must also be taken into consideration.; Marks must be looked at from the first impression of a person of average intelligence and imperfect recollection.; Marks must be compared as a whole microscopic examination being impermissible; The broad and salient

features must be considered, for which the marks must not be placed side by side to find out the differences in design.; Overall similarity is the touchstone.; It is not the colour of the container or the difference in the product, but it is the statutory right to the word that has to weigh, the statutory protection is absolutely necessary by way of an injunction in order to prevent confusion or deception arising from similarity of marks. Having regard to the facts and circumstances of this case, keeping in view the common element between the impugned mark and the registered mark, the Court observed that there was likelihood of deception or confusion in the minds of unwary public or from the standpoint of a common consumer.

18. In the case of Mysore Saree Udyog ep. by its Prop. Mr. Pukhraj S. Talera and Ors. v. Mysore Silk Udyog rep. by its. Prop. Mrs. Gomati Paramashivam 1999 (2) A. LR 540 the Karnataka High Court while observing that the question is not whether the trade mark used by the defendant is distinguishable but whether it is deceptively similar one found that the plaintiffs have been carrying on their business in the trading name of Mysore Saree Udyog on the other hand the defendants who are dealing in similar material as that of plaintiffs were though earlier carrying on their business under a different trading name and now have recently changed it to Mysore Saree Udyog and it is the allegation that this passing off action is only after noting the goodwill and reputation earned by the plaintiffs under the said trading style and name, therefore, it was held that there would be naturally confusion in the mind of an innocent layman customers. In the case of Laxmikant V. Patel Vs. Chetanbhat Shah and Another, in relation with Sections 105 and 106 the apex Court held that seeking an injunction, temporary or ad interim in a case of passing off the protection of goodwill attached to the name of the business will lie whenever the defendant company's name or its intended name is calculated to deceive and to so divert business from the plaintiff or to cause confusion between the two business the propensity to divert business or likelihood of injury if name adopted even innocently, inaction for passing off, actual damage need not be proved, showing of likelihood of damage is sufficient.

19. Having heard the learned Counsel for parties and after perusal of the record it is found that the appellant-defendant has yet to set up his defence to the effect that the defendant's use of the name, mark or symbol is not such as to be likely to pass off his goods or business as those of the respondent-plaintiffs. The appellant has also not come up with the case of innocent infringement or passing off satisfying the conditions laid down in Section 135(2)(b) of the Act, 1999 that he has a right of his own name mark or other sample complained of and that the same is wholly different with that of the respondent-plaintiffs.

20. In the present context an issue which also arises to be determined is, "Whether in absence of the specific words " passing off in the plaint and if the ingredients of "passing off " are present the court could proceed to decide the case as that of "passing off ?"

21. On meaningful reading of the plaint it is found that the pith and substance in the present case is that of seeking action for passing off alongwith infringement and violation of trade mark, name, symbol and get up etc. of the plaintiffs registered under Copyright Act, 1957 jointly claimed. Para 1 refers to a registration number 611389 (corrected) for the artistic work under the Copyright Act, 1957. Admittedly the registration number is under the Copyright Act, 1957, and not under the Act, 1999. There cannot be and there is no infringement of an unregistered Trade Mark under the Trade Mark Act, 1999. However all the three ingredients of passing off, i.e. disclosure of goodwill, demonstration of misrepresentation and likelihood of suffering of irreparable harm and injury in terms of reputation and money are found to be present from bare perusal of the plaint. Though the very specific word "passing off has not been used but its absence in the plaint would not disentitle the plaint from being so read if the ingredients so discloses. The averments in paras 3 to 19 of the plaint contain that the business is said to be running for pretty long time and the customers as well as traders have identified and recognized the goods bearing the said trade mark carved with a special artistic and distinctive manner having artistic work/design/style/get up and colours of lettering etc., and the plaintiffs being its creator and author are its absolute owners and are entitled to its exclusive right to put it to use. That the adoption and use of the same without their consent with a deceptively similar trade mark by the third person is bound to cause misrepresentation by way of confusion on the minds of the unwary class of customers with a view to trade upon the reputation of the plaintiffs causing heavy financial losses to him. Lastly, plea of balance of convenience has also been raised.

22. It is settled that even where the plaintiffs' mark consists of a label with a device, design or getup including colour scheme which could be the subject matter of copyright under the Copyright Act, 1957 a combined action for infringement of trade mark, infringement of copyright and passing off can be brought against the defendants. The court, where an action for infringement of a registered trade mark under the Trade Marks Act, 1999 and passing off are combined in one suit, and if the infringement action proceedings under the Trade Marks Act, 1999 could not be proceeded with, it may try the passing off proceeding in the suit alone in such a combined action for infringement and passing off. The plaintiffs may succeed on one count and may fail on other.

23. The nature of relief in a passing off action is the same as that in an infringement action provided the passing off action is based on similarity of marks. There is no specific provision as regards relief that might be granted in a passing off action not based on similarity of trade marks. Passing off is governed by common law, and the granting of reliefs is discretionary and analogous to those provided u/s 135 of the Trade Marks Act, 1999, The general rules governing the grant of injunction in trade mark cases are based on the provisions contained in Sections 36 to 42 of the Specific Relief Act 1963; and Order 39 Rules 1 & 2 read with Section 151 of the Code of Civil Procedure. Injunction is

granted where there is a threat or a probability of the infringement or passing off being committed, repeatedly or continuously. The object of the injunction is to restrain the defendant from infringing the trade mark or from passing off his goods as and for the goods of the plaintiff.

24. The object of the law of passing off as settled is to protect some form of property usually the goodwill of the plaintiff in his business or his goods or his services or in the work, which he produces. Passing off is a form of tort and contains three elements viz. goodwill, misrepresentation and damage called "classical trinity". The goodwill of the business is ordinarily represented by a mark, name, get up or other badge.

25. Though passing off is not defined in the Trade Marks Act, 1999 but is referred to in Section 27(2) which refers to the rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof are unaffected by the provisions of the Act. Section 134(1)(c) refers to jurisdiction of courts to try suits for passing off arising out of the use of any trade mark unregistered. Section 135 specifies the remedies available in respect of passing off arising from the use of a trade mark. In a passing off action the right and title to sue is to be established by evidence of reputation and goodwill of business so acquired by the plaintiff by using of a specific mark, symbol, badge or name. A settled basic underlying principle of such actionable wrong is that "a man is not to sell his own goods under the pretence that they are the goods of another man" on misrepresentation which constitute an invasion of proprietary rights vested in the plaintiffs whose goods have acquired a reputation in the market and are known by some distinguishing feature.

26. Prima facie the respondent-plaintiffs seem to have achieved certain goodwill in their business by the trade mark, name and get up in a period of 12 years (use of trade mark and registration under Copyright Act) and the chances of an invasion of their proprietary rights by the appellant defendant which create real and tangible risk resulting in damages are present and they are entitled to protection. They have also prima facie succeeded in showing that by the acts of the appellant-defendant interference caused in the conduct of their business and selling of goods in the sense and such acts of the appellant-defendant would lead the public which uses Khaini, tobacco etc. to confuse goods of the plaintiffs with the goods of the appellant-defendant and that by such misappropriation by the appellant-defendant of the goodwill and reputation of his business a wrongful invasion of his goodwill and reputation of his business is to be harmed.

27. Under present circumstances it cannot be ruled out, subject to further evidence led by the parties in the suit, that the Public using Khaini which is accustomed to rely upon the plaintiffs' particular brandname, mark and symbol may while purchasing the same could easily be misled by deception of the goods of the defendant bearing close similarity in the trade mark and the getup etc. to be the same as that of the plaintiffs. It also appears on the face of the record that the similarity in the label of the appellant-defendant to that of the plaintiff-

respondents constitutes infringement of copy right of the plaintiffs and the use of copy right, name of the trade mark in relation to the goods though not covered by registration the impugned injunction order by the court below restraining the defendants from using the same is absolutely valid.

28. The appellant-defendant has also not been able to support his case in the present appeal regarding the business being an ancestral one started by Niyamat Ullaha Khan, after whose death all his sons including the plaintiffs and the defendants were entitled to use the same trade mark under which the ancestral business was being carried out. For the purpose of granting interim injunction, it is settled law that even possibility of irreparable loss and injury would also be taken into consideration. I do not find any wrong in the injunction order granted by the court below restraining the appellant-defendant from using the said trade mark in similarity to that of the plaintiff-respondents. It is rightly found by the trial court that all the three ingredients viz. sine qua nan for issuance of an injunction were made out in the plaint. The said exercise of discretion by the court below is neither arbitrary or capricious or perverse nor has been exercised ignoring settled principles of law regulating grant or refusal of interlocutory injunction. I also find that non filing of cross-appeal by the plaintiff-respondents under Order 41 Rule 22(1) of the CPC against the findings of the trial court that the trade mark was not registered is immaterial, as the injunction order passed by the trial court would be treated to have been passed in the case of "passing off as observed hereinbefore. In view of the provisions of Section 23 in consequence to the provisions of Sections 18, 19 and 21 of the Trade Marks Act, 1999 the trade mark of the plaintiff-respondents has to be registered as of date of making of such application, i.e. 1993 which would be deemed to be the date of registration.

29. Under the above said facts and circumstances, settled law and the observations made hereinabove, I do not find any justification in interfering with the reasonable and judicious exercise of discretion of the court below based on material on record and pleadings. I consider that the respondent-plaintiffs are entitled to protect themselves by passing off action and the court below has rightly exercised its authority and jurisdiction in granting the impugned injunction order in this case.

30. In the result, the appeal fails and is dismissed accordingly. No order as to costs.