

(1998) 07 P&H CK 0059
In the Punjab And Haryana At Chandigarh
Case No : F.A.O. No. 1756 of 1997

Century Continuous Stationery Pvt. Ltd.	APPELLANT
Vs	
Radhey Shyam Gupta	RESPONDENT

Date of Decision : 09-07-1998

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Section 151
Trade and Merchandise Marks Act, 1958 — Section 105, 106, 12, 131, 19

Citation : (1998) 07 P&H CK 0059

Hon'ble Judges : Sarojnei Saksena, J

Bench : Single Bench

Advocate : Sh. Arun Jain, for the Appellant; Sh. M.L. Mangla, Sh. Ajay Sahni and Sh. A.K. Mittal, for the Respondent

Judgement

Dr. Sarojnei Saksena, J.—Defendant No. 2 has challenged the injunction order passed by the trial Court on 26-8-1997 whereby the plaintiff-respondents' petition filed under Order 39, Rules 1 and 2 C.P.C. was allowed and the appellant's petition filed under Order 39, Rule 4 read with Section 151 of the C.P.C. was dismissed.

2. Appellant-respondent No. 1 has filed caveat.

3. Plaintiff-respondent No. 1 filed a suit for permanent injunction, passing off, rendition of Accounts etc. under Sections 105 and 106 of the Trade and Merchandise Marks Act, 1958 (for short the "Act"). The plaintiff-respondent No. 1 averred that he is sole proprietor of M/s. Delhi Stationery Mart. Plaintiff is registered proprietor of the Trade Mark "CENTURY" under the provision of the Act at Registration No. 535375-B dated 17-8-1990 in respect of "Stationery for use in Computer" for sale in the States of Delhi, Haryana, Punjab, Himachal Pradesh, Uttar Pradesh, Rajasthan Gujarat, Bihar, J. & K. and Maharashtra. The plaintiff adopted the said Trade Mark "CENTURY" in respect of the said goods on 27-6-1983 and since then it has been using the same continuously and extensively by itself and through its licensees. The sales of the plaintiff and its

licensees for its goods bearing the trade mark "CENTURY" exceed more than Rs. 5 crores annually. The plaintiff's trade mark "CENTURY" by virtue of prior adoption, long and continuous use for the last about 15 years has become distinctive and associated with the name of the plaintiff and consequently the use of the said trade mark and/or any mark which is identical and/or deceptively similar to the aforementioned trade mark "CENTURY" of the plaintiff shall amount to infringement of the rights of the plaintiff. It has already spent more than Rs. 50 lakhs on advertisement, trade promotional expenses and other publicity in respect of its said trade mark "CENTURY".

4. That in the 3rd week of July, 1997 the plaintiff purchased a packet of computer paper from defendant No. 1 bearing the trade mark "CENTURY" at Ambala which was manufactured by defendant No. 2/appellant and thus he came to know that defendant No. 2 is manufacturing and selling the aforesaid stationery bearing the infringing trade mark. "CENTURY" with the infringing trading style "Century Continuous Stationery Private Limited."

5. Being aggrieved by the said article and unlawful use of trade mark "CENTURY" and the trading style "CENTURY Continuous Stationery Private Ltd.", the plaintiff filed a suit for permanent injunction. He also filed an application under Order 39, Rules 1 and 2, C.P.C. praying that defendant be restrained from manufacturing, selling offering for sale or otherwise dealing in computer stationery including computer paper bearing the trade mark "CENTURY" or any other trade mark or trade name which may be deceptively similar to the registered trade mark "CENTURY" of the plaintiff. The additional District Judge granted ad-interim injunction on 2-8-1997 Notice was issued to the defendants for 16-9-1997 but before date, defendant No. 2 filed an application under Order 39, Rule 4 C.P.C. which was also heard along with plaintiff's injunction petition. The learned lower Court dismissed defendant Nos. 2/appellant's application filed under Order 39, Rule 4 C.P.C. and allowed the plaintiff's injunction petition vide the impugned order.

6. The appellant's main contentions are that the trial Court at Ambala has no territorial jurisdiction to try and adjudicate the said suit the goods of the appellant/defendant No. 2 are different from the plaintiffs/respondents goods in respect of which the alleged trade mark "CENTURY" has been allegedly registered in favour of plaintiff; Defendant-appellant is using the trading style "CENTURY Continuous Stationery Private Ltd." which is not likely to deceive or cause confusion in the minds of the prospective customers of the goods of the plaintiffs/respondents, that defendant No. 2 appellant is not guilty of passing off his goods as those of the plaintiff and therefore the plaintiff is not entitled to injunction; plaintiff-respondents, themselves are pirators of the Trade Mark "CENTURY" and are not entitled to the discretionary and equitable relief of injunction; that the word "CENTURY" has become Public Juris and therefore plaintiff is not entitled to its exclusive use, plaintiff has not approached the Court with clean hands; defendant-appellant is ready to give undertaking to show its trade mark Swaroop

with the device of globe more prominently on the wrapper, to reduce the size of the word "CENTURY" occurring in the Trade Name "CENTURY" Continuous Stationery Private Ltd." never to use or adopt the Trade Mark "CENTURY" on its products; it shall not manufacture "Computer Stationery" and it will furnish quarterly accounts in the Court in the event the stay is vacated.

7. Learned counsel for the appellant strongly argued that the goods of the appellant-defendant No. 2 are different from plaintiff-respondents' goods in respect of which alleged trade mark "CENTURY" has been registered in favour of the plaintiff. He referred to the plaintiff's allegation wherein the plaintiff has pleaded that its trade mark is "CENTURY" and the same is registered only in respect of "Stationery for use in Computer for sale in various states whereas the appellant-defendant No. 2 manufacturing computer printer paper" (to be referred to as Computer output paper) which is used in printers and not in computer. He also pointed out that in Clause 16 of Schedule IV of the Trade and Merchandise Marks Rules, 1959 and expressions "PAPER AND PAPER ARTICLES" and "STATIONERY" are separately mentioned. Plaintiff vide his application No. 535375 dated 17-8-1990 in form TM-1 (Annexure A/5) applied for all kinds of papers and paper products and all kinds of Computer Stationery and Accessories but the Trade Mark Registry vide its letter dated 26-10-1993 (Annexure A/6) raised objections :

"that the specifications of goods set out in the application is not precise. It may be limited to the actual goods in relation to which trade mark is used."

8. The plaintiff agreed to amend his application and prayed that it be allowed with regard to "Stationery to be used in computer". Hence, his application was allowed vide order dated 31-10-1995 (Annexure A/15).

9. On that premise, the appellant's learned counsel submitted that plaintiff respondents' trade mark is registered for the goods which fall under the category/expression "Stationery" in Class 16 of Schedule IV of the Act whereas defendant No. 2/appellant's product "computer out put paper" falls in the category of "paper and paper articles" of Class 16 of Schedule IV. He referred to State of Uttar Pradesh and Another Vs. Kores (India) Ltd., , wherein the Apex Court has held :

"The word "Paper" in the common parlance or in the commercial sense means paper which is used for printing, writing or packing purposes."

10. He also referred to Business Forms Ltd. v. Commissioner of Commercial Taxes, Karnataka ((1985) 59 STC 87 wherein the point for adjudication was whether the Computer output paper could be classified as "Paper" It was held :

"Teleprinter rolls, adding machine rolls, Computer Output papers should be classified as paper."

11. He also referred to letters sent by Trade Mark Registry Branch, Ahmedabad and Bombay, Annexures A/11, A/12 and A/13 wherein Trade Mark Registry has

clarified that Computer paper falls under the category of "paper and paper articles" mentioned in Class 16 of Schedule IV of the Trade Mark and Merchandise Rules, 1959. But in letter. Annexure A/11, Ahmedabad office has further mentioned that stationery and all kinds of papers fall in Class 16 but both are separately stated and hence are mutually excluding each other. Thus according to the learned counsel the "Computer output/Computer paper" and "Stationery for use in Computer" are separate and mutually exclude each other. This is the distinction. The learned counsel also referred to plaintiff's application No. 593441 dated 29-3-1993 Annexure A/14, vide which plaintiff applied for Trade Mark "Century Deluxe".

12. The learned counsel further submitted that even assuming though not admitting that computer output paper/computer paper is a stationery but still it cannot be termed as "stationery for use in computer" as the same is used in printer and not in computer. Printer is an accessory connected to the Computer and not an essential part of computer. Printer is required only for taking printouts whereas computer can be operated independently without the aid of printer. To support this contention, he referred to Apex Court judgment in "State of U.P. v. M/s. Kores (India)"s case (supra), wherein the Apex Court held :

"that "Ribbon" is an accessory and not part of the typewriter (unlike spools) though it may not be possible to use the latter without the former."

13. The Apex Court also approved the rule of construction of Mysore High Court wherein it held that Typewriter are being sold in the market without Typewriter Ribbon and therefore Typewriter Ribbon is not essential part of typewriter.

14. The learned counsel also argued that there is no material on record to show that plaintiff/respondents are manufacturing and selling computer papers. Appellant/defendant No. 2 is neither manufacturing nor selling "computer stationery". It is only manufacturing and selling "computer paper/ computer output paper" which is neither "stationary" nor the same is used in computer. The plaintiff/respondent's trade mark "CENTURY" is not registered in respect of "Computer paper/computer output paper".

15. Referring to Section 29(1) of the Act, the learned counsel argued that plaintiff can seek relief if his trade mark is infringed in relation to any good in respect of which the trade mark is registered in its name. Since plaintiff respondents trade mark "CENTURY" is registered only in respect of "stationery for use in computer" whereas the appellant/defendant No. 2 is using its impugned trading style "Century Continuous Stationery (P) Ltd." only in respect of "computer paper" therefore, in view of Section 29(1) of the Act as the goods are different, there is no infringement of plaintiff's trade mark by the appellant/defendant, even assuming that defendant's trading style is deceptively similar to the trade mark of the plaintiff/respondents. To support this contention the appellant's learned Counsel has relied on Nestle's Products Limited and Another Vs. Milkmaid Corporation and Another, , and Parry and Co. Ltd. Vs. Perry and

Co., .

16. The plaintiff's learned counsel refuting the above argument, simply referred to the letter of Joint Registrar of Trade Mark, Bombay dated 25-1-1998 wherein answering the query u/s 8 of the Act, the Joint Registrar Shri T. R. Subramaniam has written :

"I am to invite a reference to your letter No. As/98-99 dated 8-4-1998 on the above subject and to inform you that computer paper which is annexed to your letter as Annexure "A" is a type of paper, and hence falls under the item "paper" in Class 16 Schedule IV of the Trade and Merchandise Marks Rules, 1959. Also since stationery includes paper, it would also fall under the item stationery in Class 16. To sum up, computer paper falls under Class 16. The Assistant/Deputy Registrar of Trade Marks have also conveyed that computer paper falls under Class 16 and hence their views are not conflicting."

17. In my considered view, the above controversy is not of much relevance in this case. Class 16 of Schedule IV of 1959 Rules. Separately shows "Paper" and "paper article" and "Stationery". "Paper" positively means paper which is used for not printing/writing/packing purposes or as put by the Apex Court. The computer output paper is a paper which is used in printer to prepare the print outs. Printer is accessory of computer and is not part of computer. Computer can be operated independently of Printer. But this is not the real controversy to be adjudicated that no injury arises upon. The real controversy is whether the "Paper" falls within the Category of "Stationery". "Stationery" is defined in Chambers 20th Century Dictionary (1983) edition as :

"non-stationeries, a shopkeeper, in the Middle Ages a University bookseller distinguished from itinerant a bookseller or publisher, a dealer in writing materials and the like adj. stationery belonging to a stationer-in the goods sold by a stationer."

In Webster's New Dictionary and Thesaurus, the word "Stationery" means :

"One who deals in writing materials etc. Stationery n. his wares (orig. tradesman with a station)".

In Webster's Third New International Dictionary, Volume III. Stationery means :

"materials (as paper, pens pencils, ink, blankbooks ledgers and cards) for writing or tying 2 : Letter paper use accompanied with matching envelopes; writing paper."

Thus it is apparent that "Stationery" is a genus and paper is its specie. Paper is included in the stationery. Hence, defendant/appellant is not much benefitted by the distinction which the learned counsel is trying to draw.

18. The plaintiff's registered trade mark is "CENTURY" with regard to the "stationery for use in computer" while the appellant-defendant's registered trade mark is "Swaroop" but he has used it under the trading style of "Century

Continuous Stationery (P) Ltd." Both the plaintiffs/respondents and appellant dependent are using the word "High Quality Computer Printer Papers" on their wrappers which are produced on record. Thus it cannot be said that the product of appellant defendant No. 2 is not included in stationary for use in computer.

19. The appellant's learned counsel also argued that use of trading style "Century Continuous Stationery (P) Ltd." by the appellant defendant No. 2 is not likely to deceive or cause inconvenience in the minds of the prospective customers of the goods of the plaintiff respondent. Again, he referred to Section 29(1) of the Act and argued that in an action for infringement of a trade mark registered in Part B of the register an injunction or other relief cannot be granted to the plaintiff if the defendant establishes that the use of the mark for which plaintiff complains is not likely to deceive or cause inconvenience. He pointed out that there is no similarity between the trade marks of plaintiff and defendant. Trade mark of defendant-appellant is "Swaroop" which is of distinct style and get up and does not in any manner resemble the plaintiffs/respondents trade mark "CENTURY" either visually or phonetically. The plaintiff-respondents registered trade mark is "CENTURY" while the appellant/defendant No. 2 is using the trading style "Century Continuous Stationery (P) Ltd." wherein along with the word "Century Continuous Stationery (P) Ltd." words are also as a mark of distinction. Customers purchasing computers paper and stationery for use in computers are highly educated and literate customers, therefore, there is no possibility of any deception or confusion when such articles are purchased by them. There is clear message to the Customers that this products under the trade mark "Swaroop" is the product of the Century Continuous Stationery Pvt. Ltd. of the defendant-appellant. To support this contention, the learned counsel has placed reliance on Kellogg Company v. Pravin Kumar Bhadabhai 1996 PTC (16) 187 : 1996(1) Arb. LR 430 Delhi Press Patra Prakashan Ltd. v. Diamond Pocket Books (P) Ltd. (1992(1) Arb. LR. 508. Imperial Tobacco Co. of India Ltd. v. Registrar of Trade Marks and another AIR 1968 Cal. 682 and M/s. S.M. Enterprises v. M/s. Hyderabad Lamps Ltd. 1988 PTC 98

20. Repelling the above contentions, the learned counsel for the plaintiff-respondent simply argued that plaintiff's registered trade mark is "CENTURY" with regard to "Stationery for use in Computer and defendant appellant is manufacturing "Computer paper" adopting the trading style of "CENTURY" Continuous Stationery (P) Ltd. Thought the purchasers of Stationery/Computer paper may be highly qualified but as this is being used in offices and business establishments many a times, Class IV employees are deputed to purchase these articles and they are unable to make a distinction between the two. Thereby the customers of the plaintiff are likely to be deceived as the defendant-appellant is also using the same word "CENTURY" along with Continuous Stationery (P) Ltd. and is selling it under its said trading style. He also pointed out that the word "CENTURY" is prominently mentioned in the wrapper used by the defendant-appellant.

21. After considering the rival contentions, in my considered view, the authorities relied on by the learned counsel for the defendant appellant to not advance its cause.

In Kellogg Company's case (supra), the judgment is with regard to Kellogg's Cornflakes, wherein it is held :

"Of course, one knows that the persons who buy these articles are generally persons of some education my opinion is, having regard to the nature of the customer, the article in question and the price at which it is likely to be sold, and all the surrounding circumstances, no man of ordinary intelligence is likely to be deceived.

KELLOGG'S CORNFLAKS was a registered trade mark of the plaintiff-company when the same words were used by the defendant, the plaintiff objection and had filed a suit for passing Court observed that :

"In our prima facie view, the prominent display of the words, Kellogg's in bold red letters in white background inside the square on the left top appellant's carton cannot go unnoticed by any buyer."

If further held :

"that the trade dress or rather the whole thing must be seen in its entirety and not parts in isolation. It is not permissible, therefore, to say that the square on the left side top had a small red and green border or there was a red band horizontally and defendant's carton if examined from close quarters, showed these features. Viewed as a whole, one can see that the words Kelloggs and AIMS are prominently displayed on each and therefore there can no confusion, prima facie."

It also held that the goods in question are sold to people belonging to middle class or upper middle class who are fairly educated, therefore, likelihood of confusion or deception is ruled out.

22. In Delhi Press Patra Prakshan's case (supra), the question adjudicated was whether the names of two magazines "Grah Lakshmi" and "Grahshobha" are deceptively similar, it was held :

"Phonetic similarity plays a significant role of distinguishing one mark from the other. Magazines are sold to and read by literate persons who understand the language. When the word "GRAH" is joined with "SHOBHA" or "LAKSHMI" it would seem to convey a different idea. The possibility of any unwary purchaser being deceived into assuming a connection between the producers/publishers of these two magazines or assuming that they emanated from the same source is unlikely. Phonetically also the two marks are quite different from each other. Although both magazines are mainly for ladies, they deal with similar topics and their get up etc. appear to be similar, but they are phonetically different and there is no likelihood of deception."

Hence injunction was refused.

23. In Imperial Tobacco's case (supra), the distinction between the Registration of Trade Mark in Part A and Part B of the register is clarified. The High Court held :

"The only difference is that u/s 29(1) of the Act, in an action for infringement of a trade mark; registered in Part B an injunction or other relief shall not be granted, if the defendant establishes to the satisfaction of the Court that the use of the mark is not likely to deceive or cause confusion in the manner laid down in sub-section (2) of Section 29 of the Act. That defence apparently on the language of Section 29, is not open to the defendant when registration is in Part A of the Act."

24. To the same effect is the judgment in M/s. S.M. Enterprises's case (supra), wherein defendant's contention was noted as under :

"Mr. Anoop Singh learned counsel for the defendant urges that plaintiff's registration in respect of CHOKES for fluorescent lamps/tubes is in Part B. Defendant has been able to establish on record that use of the trade mark SOLAR in respect of Fluorescent Lamps and Tubes is not likely to deceive or cause confusion."

This High Court held :

"No doubt, there is a trade connection between fluorescent tubes and chokes and these items are sold at the same counter. But a fluorescent tube or lamp is a distinct commodity from Choke and I am of the view that there is no likelihood or probability of any deception or confusion being caused upon the mind of ordinary purchaser."

25. In this case the defendant and plaintiff both are product paper to be used in computer. Plaintiff's trade mark is registered as "CENTURY" in respect of "Stationery for use in Computer" while the defendant/appellant is producing "computer paper" adopting the trading style of "Century Continuous Stationery (P) Ltd., therefore, the customers of plaintiff's goods are likely to be deceived by the defendant/appellant's manufactured computer paper.

26. Appellant/defendant's learned counsel also argued that the plaintiff cannot get any relief as there is no possibility of passing-off of defendant's goods as those of the plaintiffs. He pointed out that there are specific tests for passing-off and requirements for granting the relief of injunction. There is clear distinction between the cause for infringement and passing off. In passing off action the plaintiff is to prove further that his trade name has by reputation and use come to acquire a secondary meaning indicating distinctiveness and quality of the business being carried by him. Learned counsel submitted that there is no prima facie evidence on record to show that plaintiff's trade mark "CENTURY" has by use and publicity acquired secondary meaning indicating distinctiveness of his goods. Plaintiff has given incorrect and misleading facts about amount spent on

advertisement and publicity of the trade mark "CENTURY". He has mentioned that he spent Rs. 50 lacs for such advertisement/publicity while in its another suit which is pending in the High Court of Delhi bearing Suit No. 718 of 1989, the plaintiff has alleged that it has spent Rs. 3 lacs of the publicity of their trade mark "CENTURY". The sale figure mentioned by the plaintiff in the plaint are not supported by the document. The sale figures given in the plaint are misleading. Sale figures of M/s. Rational Business Corporation (Plaintiff No. 2) furnished in para 9 are contradictory of the statement made by M/s. Rational Business Corporation, Plaintiff No. 2 in application No. 5 593541 dated 29-3-1993 (Annexure A/14) wherein plaintiff No. 2 has stated that it has been using the trade mark "Century Deluxe" which respect to items mentioned therein since 1-10-1989 whereas in the plaint it has been state that 100% sales of plaintiff No. 2 from the year 1993-94 onwards was under "CENTURY" label. To support his contention, learned counsel relied on Rakesh Kumar Aggarwal Vs. Locks and Locking Devices (India), which is a judgment on the point that if plaintiff has suppressed the facts and project the facts which are not true, he is not entitled to the discretionary and equitable relief of injunction.

27. The appellant's learned counsel submitted that the get up, colour scheme, letter style and other features of respective wrappers being used by plaintiff and defendant No. 2 are altogether different. The wrapper of alleged Computer paper of plaintiff-respondents is green in colour with a Scenery of Hills and Trees in a triangle printed prominently at various places and words "An environment Friendly Approach, Green World and "Century" with ten stars are also printed on the triangle which are not thereon the wrapper of defendant/appellant (Annexure A/18) which is blue in colour and the Trade Mark "Swaroop" with a Device of a Prominent GLOBE is printed all over the wrapper which are not there on the wrapper of the plaintiffs/respondents. The letter style of the word "CENTURY" occurring in the trade name of the appellant/defendant is also quite different from the Letter of the mark "CENTURY" of the plaintiff/respondent. Further, wherever the trade name of the appellant is printed on the wrapper, the words "A Quality Product of" are also printed. The wrapper of the plaintiff shows the trade origin as that of "Rational Business Corporation" whereas that of the appellant defendant shows of "Century Continuous Stationery Pvt. Ltd. Therefore, on the totality of the dissimilarities of the defendant's wrapper, there is no likelihood of deception or confusion being caused in the minds of ultimate customers, who are highly educated persons having fair knowledge of English, to take the goods of the appellant/defendant thinking that/they were the goods of plaintiff/respondents. To support his contention, the learned counsel for the appellant has relied on M/s. Johnson and Johnson and another v. Christine Hodel India (P) Ltd. and another AIR 1988 Delhi 249 and Khemraj Shrikrishandas Vs. Garg and Co. and Another, .

28. The plaintiff's learned Counsel submitted that Sections 28 and 29 of the Act grant exclusive right to registered proprietor in respect of its registered trade mark and it is settled law that so far as a registration is valid injunction ought to

be granted in favour of the plaintiff. It is also no more res-jurisdictata that there can be only one proprietor of one trade mark and that a trade mark cannot have two origins. To support this contention, he has relied on "Avis International Ltd. v. Avi Footwear Industries (1990 (2) Arb. LR 352 Power Control Appliances and others v. Sumeet Machines Pvt. Ltd. 1994(1) Arb. LR 308 and Vikas Manufacturing Company Vs. Bharaj Manufacturing Company (Regd.) and Another,

29. The plaintiff's learned counsel also contended that even assuming though not admitting that Continuous Stationery paper being manufactured and marketed by the defendant No. 2 is not covered under the specification "stationery for use in computer" the fact remains that the said item being clearly allied and cognate to the aforementioned specification of goods for which the plaintiff is admittedly registered, the defendants are liable to be enjoined on this count. Plaintiff's learned counsel has referred to Kumar Electric Works v. Anuj Electronic 1989(2) Arb.LR 133 Prakash Industries Ltd. v. Rajan Enterprise 1994 PTC 31 : 1993(2) Arb.LR 382. and Tube Investment of India Ltd. v. Trade Industries, Rajasthan (1997 PTC (17) 655 : 1997 Arb.LR 171

30. Learned counsel also submitted that even otherwise presuming that plaintiff is not the registered proprietor in respect of paper for use in computer even then when the two marks are identical, goods are identical and the trade channels are identical and admittedly plaintiff is the prior user of the said trade mark clear case of passing off is established. To support this contention, he has relied on Shanker Housing Corporation (Ext.) Vs. Mohan Devi and Others, , Dharam Pal Satya Pal v. Janta Sales Corporation 1990(2) Arb. LR 91 Delco Engineering Works v. General Motors ILR 1974 (P&H) 502. and M/s. Hindustan Pencils Pvt. Ltd. v. M/s. India Stationery Products Co. and another (1989 PTC 61 : 1989(2) ArbLR 72.).

31. The plaintiff's learned counsel argued that even the use of composite mark is not permissible under the law. Under these circumstances, the plaintiff has been rightly granted the relief of injunction as the balance of convenience lies in its favour.

32. With the help of both the learned counsel. I have thoroughly examined the wrappers of plaintiff/respondent and defendant appellant which are already on record. No doubt, there is difference in colour, scheme and letters used while the word "Century" is written in both the wrappers. But the plaintiff's wrapper reads as "Century High Quality Computer Printer Papers". It has shown a computer. The background is upper portion blue, lower portion green of the wrapper showing green land with green forests. In the long bounded by red line it is mentioned "CENTURY" as registered trade mark vide registration certificate No. 202446, a product of RATIONAL BUSINESS CORPORATION. Post Box No. 1011, Delhi 6, Fax 91-11-2915357, 7125180." It has also depicted six distinct marks. While the defendant/ appellant's wrapper (Annexure A/18) shows in a box. "This product under the trade mark SWAROOP is the product of Century Continuous Stationery Pvt. Ltd. (CCS) Post Box No. 6203, New Delhi - 110015." Below that there a Globe whereupon "SWAROOP" is written in yellow. This Globe appears on

the top of the hill having blue background. On the lower part of the hill, it is written. A quality product of Century Continuous Stationery Pvt. Ltd. In the last in bold letters "HIGH QUALITY COMPUTER PRINTER PAPER" is mentioned. The work "CENTURY" is high lighted by both the parties. In the wrapper of defendant/appellant a Globe is visible with Swaroop written on it. CENTURY is written on blue patches and identical six marks are also depicted on light blue background.

33. The authorities relied on by the learned counsel for the appellant do not help the appellant. The point whether the plaintiff has wrongly mentioned the expenditure of Rs. 5 lacks on advertisement and publicity and whether he has exaggerated the sale figures of his produce to show that plaintiff's product has earned secondary name indicating distinctiveness and the quality of the business being carried by him, are the points which can be considered only after the parties adduce their evidence. Plaintiff allegations are to be considered as they are for the decision of this injunction petition. However, it is to be kept in mind that all these details which the appellant-defendant has now adverted to and has also placed certain documents on record, were not there before the lower Court when the injunction petition was allowed by it. It is also pertinent to mention that before the impugned order was passed the defendant-appellant neither chose to submit its reply to the injunction petition filed by the plaintiff-respondent nor filed its written statement, which is now filed in the High Court. Even defendant No. 1 did not file any written statement which is also now filed by defendant No. 1. Therefore on the basis of the averments made by defendant No. 2 appellant new point are raised by the appellant during this appeal which are to be considered keeping in view the above facts.

34. In Victory Transport Co. Pvt. Ltd., Ghaziabad Vs. The District Judge, Ghaziabad and Others, , the High Court has drawn distinction between the action for infringement of trade mark and that of passing off and held that :

"In passing off actions, however, the plaintiff has to prove further that his trade name has by reputation and use, come to acquire a secondary meaning indicating distinctiveness and quality of the business being carried on by him."

35. In Gora Mal Hari Ram Vs. Bharat Soap and Oil Industries, the High Court of Delhi has considered the facts and circumstances of that case while adjudicating the question whether injunction should be granted in favour of the plaintiff or not. The High Court held :

"In order to get an interim injunction in a matter of this type, that reputation must be established in such a way as to leave little doubt that the plaintiff does enjoy such a connection with the trade mark that the public generally associated the same with him."

36. The High Court declined to grant injunction in plaintiff's favour on the ground that there was no material on record to establish that the plaintiff enjoys such a reputation in relation to the soap "Savera" as would impel the Court to grant such injunction when only and limited registration has been granted to some

other manufacturers.

37. In *M/s. Nestle's Products Ltd.'s case (supra)*, plaintiff Nestle's product filed a suit for infringement of trade mark against the defendant on the ground that the defendants which market biscuits and toffees have adopted the trade name "Milkmaid Corporation" which is both visually and phonetically quite identical with and/or deceptively similar to the trade marks and brand name "Milkmaid" of the plaintiffs. On these facts, u/s 29 of the Act. The High Court held :

"That while considering whether the trade mark has been infringed, nature and kind of goods respect of which the plaintiff's trade marks were adopted by the defendants must be considered, the registration in the plaintiff's favour of the trade mark, by itself is not sufficient to support action for infringement".

Since the goods produced by both the parties were different, the relief of injunction was declined to the plaintiff.

38. In *Parry and Company's case (supra)*, the plaintiff's have to registered trade names of making their confectionery products. The first of the marks in the name "PARRY'S" in block letter and the second of a design which contains the word Parry's written in the script form. The defendants engaged in the manufacture of biscuits registered their trade mark consisting of the words PERRY'S written in script form and also in block letters. In pursuance of an agreement arrived at between the parties the defendant was allowed to use the trade mark only in regard to biscuits. Subsequently, defendants started manufacturing confectionery and used the trade mark. The plaintiff filed a suit for infringement of his trade mark. On these facts, it was held :

"That the words used were strikingly similar when pronounced and they were also deceptive to the eye. Hence, the use of the word "Parrys" would be an infringement of the trade mark "Parrys". It was also clarified that the operation of protection given by the Trade Marks Act is confined to the goods in respect of which the Trade Mark has been registered. Section 21 of the Trade Marks Act gives an exclusive use of the right in respect of a trade mark only in relation to the goods in respect of which it has been registered. The fact that a proprietor has registered his trade mark in respect of goods in Class 30 of Schedule IV of the Rules would not entitle him to use the mark with respect to any of the goods specified therein or with respect to all goods specified in the class. The classification of the goods under Rule 13 read with Schedule IV is only for the purpose of regulating the application i.e. for the purpose of registration and Section 21 cannot be read as giving an exclusive right to a registered proprietor to use the mark not only in respect of the goods in relation to which it has been registered but also in respect of other goods, found in the same category or classification. A Trade Mark registered for biscuits falling under Class 30 of Schedule IV cannot be used in respect of confectionery also falling under the same class.

39. In *Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical*

Laboratories, the Apex Court has held that :

"In the case of passing off the defendant for escape the liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

40. In Philip Morris Belgium v. Golden Tobacco Co. Ltd. AIR 1986 Del 145 the facts were that appellant company was the proprietor of registered trade mark "VISA" in relation to cigarettes on of its registration in Indian in its favour. Defendant had been used that very trade mark without any justification whatsoever and had rather taken advantage of import restrictions on cigarettes and had thus been deceiving the public in India by inducing belief in them that they were selling the cigarettes of the manufacture of plaintiff which was a company reputed for the same. On these it was held :

"It being a clear case of infringement of plaintiff's registered trade mark the balance of convenience would not matter and plaintiff would be allowed the grant of temporary injunction."

41. In National Garments Vs. National Apparels, The Court was considering when injunction should be granted in an action for passing off and held :

"While considering an application for prohibitory injunction in an action for passing off, the principle applicable for granting interlocutory injunction is slightly different from the principle applicable in ordinary cases. For a temporary order in an action for passing off, the plaintiff need not in general show a strong prima facie case. However, the prima facie case that is required to be shown must be something more than a case that will avoid the action being struck out as frivolous or vexatious. Generally stated "even if the chance of success at the trial are only 20 per cent" the interim sought for is required to be granted. There is another reason for the grant of the interlocutory injunction under such circumstances. Such an order would stop the infringement without delay. Not only that from experience it is clear that a successful motion for interlocutory injunction "normally puts an end to the litigation and the infringement with a great saving in expenses compared with a full trial" and that is the reason why the law insists upon a hearing of such a motion in every case."

42. In Amrit Soap Company v. New Punjab Soap Factory 1989 (2) Arb. LR 242 the plaintiff was selling washing soap under trade mark "BILLY" since 1978 in artistic wrapper. Defendant started selling his washing soap under the same trade mark in similar wrappers in November, 1987. Plaintiff applied for registration of trade mark. "BILLY" in 1988 and his application was published in Trade Mark Journal. He filed a suit for permanent injunction restraining the defendant from passing off and for rendition of accounts. On these facts, it was held :

"Having regard to the colour scheme, get up layout, style and arrangement of words, the wrappers used by the defendant are deceptively similar to those of

the plaintiff and likely to cause confusion in the course particularly having regard to the class of people, ladies and domestic servants which constitute the buying public in relation to washing soap. The plaintiff has been suing the trade mark since 1978 whereas the defendant started using it in 1987. The allegation that some manufactureres are also using the same trade mark is of no consequence as the Court is concerned with parties before it only. Injunction granted."

43. In *The Tata Iron & Steel Co. Ltd. v. Mahavir Steels and others* 1992(1) Arb. LR 417. the question of imitation/similarity of the trade mark along with the question of territorial jurisdiction were considered and it was held :

"The question of territorial jurisdiction should not deter the Court from considering the application for temporary injunction and the question that the defendants are not established within the jurisdiction of this Court is not such which wholly takes away the jurisdiction of the Court to entertain the application. A mere averment that their goods were being sold by the defendants in Delhi is enough at this stage to assume territorial jurisdiction. Even if some others are using trade marks with prefix "ISCO" an imitation remains an imitation and whether it is down by one or many, it acquires no legitimacy. The trade mark "FISCO" is deceptively similar to "TISCO" and there is every likelihood of "F" being made to appear as "T". Injunction was granted."

44. In *M/s. Johnson and Johnson and another v. Christine Hoden India (P) Ltd. and another* (supra), the facts were that plaintiff were selling sanitary napkins under trade mark "STAYFREE" on packing. He failed a suit restraining the defendant from using the STAYFREE on packing of his sanitary napkins. Plaintiff also prayed for temporary injunction. The High Court held that except use of "SYAYFREE" packings of defendant having an similarity to plaintiff's packing and therefore, customers are not likely to be deceived. On these facts injunction was declined.

45. In *Khemraj Shri Krishna Dass v. M/s. Garg & Co.* (supra), a distinction was drawn between action for infringement of trade mark passing off and it was held that is essential for the plaintiff to establish are :

"(i) distinctive features; (ii) substantial user; and (iii) wide reputation.

The law casts an obligation on the defendant not to pass off his own goods (for work) as if they had been produced by the plaintiff and the Court will enforce this obligation. In such a case, the defendant can escape the liability by showing that his goods (or work), though similar, distinctly indicate that they do not originate from the plaintiff but have been produced by the defendant."

46. In *Avis International Ltd. v. Avi Footwear Industries and another* (supra), the plaintiff was registered owner of trade mark "AVIS" in respect of hosiery, wearing apparel and footwear. Defendant alleging non-user of trade mark in respect of footwear by plaintiff for five years applied for deletion of word "footwear" from the entry in register of trade mark. Defendant started marketing footwear under

the trade mark "A VIS". Plaintiff was granted temporary injunction against defendant. The defendant prayed that injunction be vacated on these facts it was held :

"Phonetically the word A VIS, which is registered mark for footwear, and the word AEVI's have to be pronounced identically. The business of the defendants is known as A VI Footwear Industries. Prima facie, if it was the intention of the defendants by affixing the label AEVI's on the footwear made by them was to indicate that the footwear carrying that label is made by the AVI Footwear Industries, then the mark they would have adopted would have been A VI but they have not done. They have tried to bring their mark/label as close as possible phonetically to the registered mark A VIS."

"In my view, the statutory monopoly which has been conferred upon the plaintiff in connection with use of the mark A VIS for footwear, has to have primary precedence over any other consideration in relation to grant or non-grant of an injunction, especially when the matter is at an interlocutory state, and is yet to be trade, and it cannot be foreseen as to whether the defendants who seek rectification of the plaintiffs mark, on account of non-user would be able to prove their case. The statutory registration establishes prima facie case in favour of the plaintiff."

47. In *Power Control Appliances and others v. Sumeet Machines Pvt. Ltd.* (supra). The appellant was marketing kitchen mixies since 1964 under trade mark "SUMEET" which was registered in 1970. Trade mark was assigned to second appellant in 1981 who started manufacturing in 1984 and copied the designs and trade mark "SUMEET". Respondents claimed acquiescence by appellant. On these facts, the Apex Court held that were silence is not acquiescence, there should be some positive act showing consent.

48. In *M/s. Vikas Manufacturing Co., Roper v. M/s. Bharaj Manufacturing Company Jullundur and another* (supra), the High Court held that mark deceptively similar includes phonetic similarity though meaning of the words are different. It is further held that Section 30 of the Act applies only when who similar marks are already registered and does not include cases where registration of one is pending.

49. In *Kumar Electric Works v. Anuj Electronics* (supra), the plaintiff was registered user of trade mark "OLYMPUS" registered in the name of its partner Raj Kumar in respect of electric goods. Plaintiff was using this trade mark since 1983 and extensively advertised it also. Defendant started using this trade mark in respect of TV sets. Defendants alleged that trade mark belongs to Japanese firm who applied for its registration in India in 1982. On these facts, the High Court held :

"Prima facie the plaintiff's electronic and electric goods were being marketed through the trade mark "OLYMPUS". Plaintiffs' right to restrain the defendant from using the trade mark prima facie extends to cognate goods. Defendant is

selling TV sets under exactly the same trade mark. There is evidence of its use and advertisement by plaintiff, while the Japanese firm had never used it in India and had only applied for registration. In an action for passing off registration of trade mark is irrelevant. Balance of convenience was also in favour of plaintiff."

Hence, injunction was granted.

50. In *Prakash Industries Ltd. v. Rajan Enterprises* (supra), the appellant was prior user of trade mark "PRAKASH" in respect of television picture tubes, video tapes and cassettes and television tuner. Respondent started using the trade mark "PRAKASH" in respect of televisions, tuners and T.V. Kits with similar description of goods. The appellant prayed for action of passing off. On these facts it was held that the goods of the appellants and those of the respondents are prima facie the goods of the same nature and they are definitely cognate and allied goods having common trading channel and class of customers are also the same. The appellant having established that they are the earlier user in point of time, the conduct of the respondent is calculated to pass off their goods as those of the appellant resulting in substantial injury to the appellant's goods will. The conduct of the respondent is such that they do not deserve any protection under the law and equity is also against them. Under these circumstances, injunction was granted in appellant's favour.

51. *Tube Investment of India Ltd. v. Trade Industries Rajasthan* (supra), is a judgment on the point of visual similarity. Plaintiff prayed for injunction and passing off trade mark under Sections 105 and 106 of the Act on the ground that respondent has started use of mark "TI" for goods in Class 12 and has thus violated appellant's right in respect of their registered trade mark "TI" in two concentric circles for goods in Class 12. On these facts it was held :

"In the above circumstances, looking to the fact that the appellants are registered holders of their mark which is specifically registered for bicycle parts, and in the circumstances set out above, this is a fit case for grant of interim injunction restraining the respondent from using his mark for any items manufactured by him for use in connection with bicycles or falling in Class 12."

It also held :

"The visual similarity between the two marks coupled with the fact that the respondent's mark is used on bicycle saddle covers, prima facie, posed a real danger that the product of the respondent can be passed off as a product of the appellants. Use of the mark by the respondent on goods falling in Class 12 is prima facie, violative of the appellants' right in respect of their registered trade mark for goods in Class 12."

52. In *Century Traders v. Roshan Lal* (supra), it is held that :

"Proof of actual damage or fraud is unnecessary in a passing off action whether the relief asked for is injunction alone or injunction, accounts and damages. If there is a likelihood of the offending trade mark invading the proprietary right, a

case for injunction is made out."

53. *Dharam Pal Satya Pal v. Janta Sales Corporation* (supra), is a judgment where the dispute was between two trade marks "RAJNI" and "RAJANI". Plaintiff was manufacturing and selling chewing tobacco under the trade mark "RAJNI" since 1980 in containers of artistic design, colour combination etc. and was also a registered holder of copyright. Defendant started marketing paan masala under a similar trade mark "RAJANI" since 1985. The plaintiff prayed for injunction. The High Court held :

"The most striking feature of this case is that the trade name adopted by the defendant is phonetically so similar to that of the plaintiff's trade mark that it becomes, on the face of it, a case of near identical trade mark, a little difference in spelling notwithstanding. The goods marketed by the plaintiff are in the category of cognate and allied goods. Both are manufactured by the same manufacturers, are sold by the same shopkeepers, and are displayed side by side." Hence injunction was granted."

54. In *Delco Engineering Works v. General Motors* (supra), the principles governing action for passing off are determined. It is held that :

"An action for passing off is founded on the desirability of preventing commercial immorality or dishonesty on the part of a trade who by using a particular mark, whether registered or unregistered, wants to falsely represent that his goods are the goods of the some one else so that he can take unfair advantage of the reputation of that other person in the market. The likelihood or probability of deception depends on a number of actors and is a question of fact in the circumstances of each case. Phonetic or visual similarities, getup, packing or other writings and marks on the goods or on parcels in which they are offered for sale and other resemblances may help in determining the probability of deception, but each case depends on its own facts. If there is no link between two traders, or in other words, the two traders are not closely co-related and the goods are not analogous, a conclusion may be reached in a particular case that the chances of deception are too remote to be taken notice of as to restrain the defendant from selling his goods under the same or similar trade mark. The whole thing has to be approached from the point of view of a man of average intelligence and of imperfect recollection. It is true that no proprietor of a trade mark acquires monopoly for the use of that mark but at the same time a trader cannot be allowed in justice and equity to let his goods pass of an those of another."

55. In *M/s. Hindustan Pencils Pvt. Ltd. v. M/s. India Stationery Products Co. and another* (supra), the plaintiff was registered proprietors of trade mark "NATRAJ" and device. Defendants obtained registration of copyright under the copyright Act, 1957. The High Court held :

"That plaintiff being registered proprietor of the trade mark holds exclusive right to use of the mark and the mark used by the defendants being deceptively

similar to the plaintiff's registered mark, the defendants are restrained by an interim injunction from using the offending mark "NATRAJ" and the device of Natraj and any other similar mark which is an infringement of the plaintiff's registered trade mark. The defendants plea about inordinate delay, laches and acquiescence and public interest did not find favour with the Court."

56. After considering the facts of the case, I am of the considered view that since appellant-defendant No. 2 is manufacturing computer paper using the trading style of Century Continuous Stationery (P) Ltd., the fact remains that the said item being clearly allied and cognate to the goods produced by the plaintiff and plaintiff being proprietor of this registered trade mark "CENTURY" the defendant No. 2/appellant has prima facie no right use to the trade mark "CENTURY" even by adding certain words with the word "CENTURY" or suing the wrapper in different colours with "SWAROOP" as its trade mark on a globe. Normally, such a stationery/computer papers are purchased by the customers on the basis of the name of the trade name which gains popularity and goodwill. It is also apparent on record that plaintiff is prior user of the trade mark "CENTURY". Hence, plaintiff is prima facie entitled to the relief of injunction.

57. I also hold that adding of word "SWAROOP" on the wrapper by the defendant will not make any difference as swaroop is not depicted so prominently as the word "CENTURY" is depicted on defendant's wrapper when articles are exposed for sale the customers do not remember the exact specification colour design or the words used on the wrapper. They only purchase such article by the trade name. When such articles are sold in the market, the products of plaintiff and defendant are never sold in juxtaposition. Even they are sold side by side, it is very difficult for a customer to remember as to which product is that of the plaintiff and which product is that of the defendant. For holding this view, I seek assistance from Kedar Nath Vs. Monga Perfumery and Flour Mills Delhi-6, K.R. Chinnikrishna Chetty Vs. K. Venkatesa Mudaliar and Another, and Jay Bharat Industries Vs. R.T. Engineering and Electronics Co., Junagadh,

58. In Kedar Nath's case (supra), it is held that if there is deceptive similarity in carton, get up and colour scheme with that of the registered trade mark it constitutes infringement u/s 29(1) of the Act. The fact of the case where that plaintiff was manufacturing and selling dhoop under the trade mark "SUDARSHAN" which is in Regular and continuous use since the year 1954. The plaintiff's trade mark "SUDARSHAN" is registered under the Trade and Merchandise Marks Act, 1958. The plaintiff also holds copyright registration relating to the artistic representation of its cartons pertaining to "SUDARSHAN DHOOP BATTI" Plaintiff alleged that by virtue of the aforesaid registration as well as by long and established use and wide publicity the plaintiff has acquired right to the exclusive use of "SUDARSHAN" trade mark in relation to DHOOP BATTI so much so that the use of any such or similar trade mark with or without any prefix or suffix by another trader is bound to cause confusion and dhoop of such manufacturer is liable to be associated with the plaintiff's goods and his

business. The defendant is also a manufacturer of dhoop and it is alleged that he has deliberately infringed the plaintiff's trade mark "SUDARSHAN" and has also copied artistic design relating to the plaintiff's cartons and wrappers. The defendant has introduced its dhoop with the trade mark "SUDARSHAN" prefixed by the word VIJAY in small. Print on its cartons and wrappers. On these facts, the plaintiff's application was allowed.

59. The Supreme Court in Parle Products (P) Ltd. Vs. J.P. and Co., Mysore, has laid down the test to determine the question when a trade mark is deceptively similar to another. Their Lordships, at page 1362 observed as under :

"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 and 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."

A little later it was observed :

"After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes."

60. The Supreme Court relied on the following passage in Karly's Law of Trade Marks and Trade Names (9th edition paragraph 838) :

"Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived if the goods were allowed to be impressed with the second mark into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in different dress and in very different positions and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade marked goods, and relying as they frequently do, upon marks, should be able to remember the exact detail of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own.

61. In K. R. Chinnikrishna Chetty's case (supra). It was held that :

"the combination of the two words "RADHA'S Sri Andal" is likely to be taken by snuff users as the snuff manufactured and marketed by the applicant originally

the as "Sri Andal". Further there is a tangible danger that a substantial number of person will confuse applicant's Radha's Sri Andal" mark applied for with the opponents legend "Sri Andal" Snuff."

62. This judgment determines that if any word is added that will not make slightest difference and on that account refusal to registered was held justified.

63. The appellant's learned counsel has also pointed out that the plaintiffs themselves are pirators of the trade mark "CENTURY". They have given a list of proprietors/traders who are using the word "CENTURY". He has pointedly argued that the mark "CENTURY" is of "CENTURY PULP AND PAPER" which is established in the year 183 and is using its said trading style and trade mark "CENTURY" Continuously and without interruption. Since the plaintiff has adopted that trade mark he is not entitled to discretionary and equitable relief of injunction. To support this contention, he has relied on Capital Plastic Industries Vs. Kappy Plastic Industries, Capital Plastic Industries v. Kapital Plastic Industries (1989 PTC 98. Ved Parkash v. Samir Kumar 1994 PTC 285 and Prem Sing v. Ceeam Auto Industries 1990(2) Arb. LR 357).

64. In Capital Plastic Industries v. Kappy Plastic Industries's case (supra), the plaintiff sought interim injunction restraining defendant from using mark "RAHBER" during the pendency of suit for perpetual injunction. Plaintiff claimed that he is owner/proprietor of trade mark "RABER" and "RAHBER". Defendant contested the suit on the ground that design was made much prior to the date as alleged by plaintiff and further plaintiff abandoned trade mark and adopted another mark. On these facts, the High Court held that so far as mark "RAHBER" is concerned plaintiff has not claimed any relief on the basis of this mark. Even otherwise, in my opinion the plaintiff is not entitled to any relief on the basis of this mark. Both the plaintiff as well as the defendant are pirators. They have copied and adopted this mark which already stands registered in the name of Plastic Rafters Ltd. Premier Insurance, Building Wallace Road, Karachi. None of them is entitled to claim and relief on the basis of this mark. The plaintiff has not been able to prima facie establish and fulfil the requirement of a passing off action. Hence, interim relief was declined.

65. In Capital Plastic Industries v. Kapital Plastic Industries (supra) appellant started using the trade mark "RAHBER" in 1985 after abandoning the trade mark "RABBER" used since 1983. Respondent also claimed use of trade mark "RAHBER" since 1985. The Court held that when both the appellant and respondents are Pirators of registered trade mark of another party. Interim injunction cannot be granted.

The same rule is enunciated in Ved Parkash's case (supra), and Prem Singh's case (supra).

66. The plaintiff's learned counsel vehemently argued that no material is placed on record to show that M/s. Century Pulp and Paper are Manufacturing and Marketing their product under the trade name "CENTURY". Further, there is no

allegation that the abovesaid company are manufacturing are marketing stationery items and, therefore, there is no conflict with the goods of the plaintiff. Further, the plaintiff is registered proprietor of the trade mark "CENTURY" and has a statutory right to the exclusive use of the said trade mark for those specifications of goods for which it is registered. Referring to Sections 12(i), 12(iii) and 30(i)(d) of the Act, the learned counsel argued that from these provisions it is evident that rights of the plaintiff are statutorily protected under the Act.

67. Appellant-defendants learned counsel also argued that the word "CENTURY" has become Public Juris (Common to trade) in the trade of paper and allied goods so as to deny the plaintiffs/respondents the exclusive use of the word "CENTURY". Appellant's learned counsel has referred to 8 Traders who are using the word "CENTURY" for manufacturing Pulp Board, Stationery Articles. Exercise book, Pen and Ball Pen. Printing Matters, ink etc. Learned Counsel referred to *Rajeev Malhotra v. Amit Home Appliances* 1996 PTC (16) 704 *M/s. Micronix India v. Mr. J. R. Kapoor* 1993 PTC 317 1993(2) Arb. LR 377. and *J. R. Kapoor v. M/s. Micronix India* 1994 PTC 260

68. In *Rajeev Malhotra*, case (supra), it is held that the word "SURYA FLAME" cannot be stated to be an invented word. The coming of two words "SURYA" and "FLAME" cannot also be stated to be an invention or discovery. These are two common words known to everybody and as it appears from the records there are number of traders in the market using the word "SUN" and other related words selling similar products. Therefore, in a passing off action the plaintiff cannot claim on the facts of this case, that it has acquired any distinctiveness and on the material placed before me, I am not able to come to the conclusion that the plaintiff has established so much market over the years that people have come to know of SURYA FLAME only emanating from the plaintiff.

69. In *M/s. Micronix India* case (supra), the Delhi High Court held that the trade name "MICRO TELEMATIX" and the trade name "MICRONIX INDIA" being different both visually as well as phonetically and the word MICRO being used by more than one person, it will not be proper to restrain the defendant from using their trade name "MICRO TELEMATIX". The defendant was restrained from manufacturing, selling, to offer for sale or otherwise dealing in electrical and electronic instruments, IV boosters under the trade mark "MICROTEL" and the logo "M" and also from using the cartons of the aforesaid articles with the aforesaid trade mark and logo during the pendency of the suit.

70. When *J. R. Kapoor*, challenged this order in the Supreme Court, the appeal was allowed *J. R. Kapoor v. M/s. Micronix India* (supra), and injunction order passed against *J. R. Kapoor* by the Delhi High Court was set aside by the Apex Court. The Apex Court held that the word being descriptive of the micro technology used for production of many electronic goods which daily come to the market, no one can claim monopoly over the case of the said word. Anyone producing any product with the use of microchip technology would be justified in

using the said word as a prefix to his trade name.

71. The plaintiffs learned counsel repelling the above contention argued that more than 75% trade mark registered under the Act are marks which are commonly used words like TATA, AMBASSADOR, ACTION, LIBERTY, CLOSE UP, USHA, BILLY etc. It cannot be said that all the above mark can be used openly by their competitors. Marks which are commonly used and form part of the dictionary are certainly registrable under the provisions of the Act. The word "CENTURY" is not at all descriptive of stationery items and is a registerable mark. The said registered mark of the plaintiff has remained on the register since last about eight years and no challenge to the said registration has been filed till date. He also submitted that there is no material placed on record by the defendant to show that the mark "CENTURY" for stationary product is being used by another trader/ manufacturer.

72. After hearing the rival contentions. I am of the considered view that defendants cannot take help of these contentions. Admittedly, plaintiff is registered trade mark proprietor of the word "CENTURY". If the word "CENTURY" is being used by other traders/manufacturers for manufacturing their other products it does not mean that the plaintiff is either pirator or since the word "Century" is commonly being used by different traders/ manufacturers for manufacturing their products, plaintiff is not entitled to the relief of injunction. The plaintiff has produced "stationery for use in computer" since 1983 and has alleged that he gained sufficient publicity and goodwill for his product. The said registered trade mark of the plaintiff has remained on the register for the last about 8 years and no challenge to the said registration has been filed till date. Therefore, on the above contentions, defendant has no ground to say that the plaintiff is not entitled to the relief of injunction.

73. The appellants learned counsel also argued that the plaintiff has not approached the Court with clean hands. Trade Mark was registered on 31-10-1995 for which he filed an application on 17-8-1990 but the copies of the notices/invitation given in newspapers prior to the said date of registration, which are annexed with the plaint, clearly reveal that the plaintiff by using "R" within a circle close to the word "CENTURY" has been falsely representing to the public that there alleged trade mark "CENTURY" is registered when actually it was registered on 31-10-1995.

74. The defendants learned counsel referred to Annexure A/24 which is a copy of "National Mail" Bhopal dated 30-9-1993. Another paper is "Dainik Jagran" dated 17-11-1993. Another papers are "Rajasthan Dainik" dated 25-11-1993. Rajasthan Patrika dated 26-11-1993, Rajasthan Patrika dated 17-8-1993. To support this contention, he has relied on Raghbir Singh Jain v. Raizuddin Gyasuddin 1996 (2) Arb. LR 87 which is again judgment on the point where the plaintiff filed a suit for passing off action on the ground that he has adopted the trade mark "LACME" since 1985. He made attempt to show that trade mark is a registered trade mark though it was not registered in plaintiff's name. On these

facts injunction was declined.

75. The above argument is misconceived. Section 23(1) of the Act read as under : "23. Registration :

(1) Subject to the provisions of Section 19. When an application for registration of a trade mark in Part A or Part B of the register has been accepted and either :

(a) the application has not been opposed and the time for notice of opposition has expired; or

(b) the application has been opposed and the opposition has been decided in favour of the applicant; the Registrar shall, unless the Central Government otherwise directs, register the said trade mark in Part A or Part B of the register, as the case may be, and the trade mark when registered shall be registered as of the date of the marking of the said application and that date shall subject to the provisions of Sections 131, be deemed to be the date of registration."

76. Hence, it is apparent that though the order of the registration of the Trade Mark was passed on 31-10-1995 but it is to be treated as if registered on 17-8-1990. Hence, if the plaintiff has shown in its advertisement/notice etc. using the word "R" it does not mean that the plaintiff is misrepresenting the facts before public.

77. The appellant defendant has chosen to give an undertaking that it will show its trade mark "Swaroop" with a device of globe more prominently on the wrapper it will reduce the size of the word "CENTURY" occurring in the trade style "Century Continuous Stationery (P) Ltd." it will not adopt the trade mark "CENTURY" with regard to its product of computer paper and it will furnish its accounts.

78. In my considered view, these points can only be considered when the plaintiff agrees to such an undertaking or when this undertaking is considered by the trial Court during trial. At this stage while deciding the appeal, the said undertaking offered by the defendant/appellant cannot be considered. However, the lower Court is required to keep his fact in mind while proceeding further with the case.

79. The last contention is with regard to the territorial jurisdiction. Both the parties have placed reliance on certain authorities to support their contentions. The appellants learned counsel strongly stressed that it is also a settled law that the cause of action partly or wholly can arise in jurisdiction only if it is the defendant who is proved to have directly made sale of goods under the impugned trade mark/trade name, within the jurisdiction of given Court, not to an individual consumer but to a distributor or a whole seller or a retailer and that such a sale should be at a commercial scale. So far, no averment has been made by the plaintiff in the plaint to the effect that answering appellant defendant has directly made a sale of goods under the impugned trade mark/trade name to the defendant No. 1 or to any other distributor/wholeseller or a retailer within the territorial jurisdiction of this Hon'ble Court or that such sale was an commercial

scale. Further it is also relevant to mention here that the said M/s. Shiv Shakti Enterprises, Delhi is neither a distributor nor an authorised dealer of the answering defendant.

80. Relying on P.L.J. & Co. v. Promilla Industries and another (1992 (1) Arb. LR 233 the appellants learned counsel prayed that in view of this proposed undertaking injunction order passed by the lower Court be vacated.

81. P.L.J. & Co.'s case (supra) is a judgment on the point when the defendant is ready to give an undertaking to change the colour scheme of cartons and also to print his trade mark prominently on the cartons, there is no need to grant injunction.

82. The defendants learned counsel also submitted that in the plaint, the plaintiff has simply mentioned that plaintiff's representative purchased two packets of computer paper from defendant No. 1 bearing the infringed trade mark "CENTURY". He has produced two cash memos which do not indicate that any product of defendant No. 2 was purchased by the plaintiff's representative from defendant No. 1 vide these cash memos. During the pendency of this appeal, plaintiff's partner Shri Ashish Gupta has submitted his affidavit wherein he has mentioned that on 27-7-1997 at Ambala he went to the shop of defendant No. 1 and asked him whether he was dealing in computer stationery. The person standing on the counter informed him that they were getting supplies of computer paper from a firm at Delhi under the name of M/s. Shiv Shakti, New Delhi who were the distributors of M/s. Century Continuous Stationery Pvt. Ltd., New Delhi. He has further deposed that when the person at the counter gave him one packet of computer paper on which trade mark "Century" was appearing prominently along with the trading style "Century Continuous Stationery Pvt. Ltd., New Delhi he purchased it. He also purchased another identical packet of computer paper from the same shop on 29-7-1997. The appellant's learned counsel argued that now defendant Nos. 1 and 2 have filled their written statement. Defendant No. 1 in its written statement has denied that he sold any computer paper of trade mark "CENTURY" but has averred that he sold that computer paper to plaintiff's representative under the trade mark "CITIZEN" vide these cash memos, which are produced by the plaintiff/respondent.

83. Thus now pleading of all the parties are on record. Defendants have disputed the territorial jurisdiction of the lower Court. Both the parties are yet to adduce evidence on this point. Since injunction order is passed against defendant No. 2 appellant which may be causing some hardship to the appellant in marketing its product, therefore, the appeal is disposed of with a direction to the trial Court to decide the issue of jurisdiction within three months from today, after giving adequate opportunity to both parties to adduce their evidence with regard to this point. Regarding all other points, in my considered view, the appeal is meritless.

84. The trial Courts record be remitted back along with a copy of this order.