

(1992) 01 DEL CK 0039

In the Delhi High Court

Case No : First Appeal No. 68 of 1991

Delhi Press Patra Prakashan Ltd.

APPELLANT

Vs

Diamond Pocket Books (P) Ltd.

RESPONDENT

Date of Decision : 28-01-1992

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 2

Citation : (1992) 1 ARBLR 508 : (1992) 46 DLT 423

Hon'ble Judges : J.K. Mehra, J

Bench : Single Bench

Advocate : A.R. Lal, M.K. Miglani and Parveen Anand, for the Appellant;

Judgement

J.K. Mehra, J.

(1) This is an appeal arising from an order passed by the Additional District Judge declining to grant injunction in favor of the plaintiff against the use or display of the title "Grahlokshmi" for a Hindi magazine being published by the defendant on the plaintiffs' plea that the plaintiff is already publishing a magazine under the title "GRAHSHOBHA" which is also registered under the Trade & Merchandise Marks Act 1958 under Registered Trade Mark No. 387789 in Class 16 in respect of printed publication. It is alleged that the plaintiff has been publishing Grahshobha since January 1988 but the registration of the trade mark was granted to the plaintiff w.e.f. 18th March 1982.

(2) The argument which is put forward on behalf of the plaintiff is that notwithstanding the lack of phonetic similarity, the adoption of the name Grahlakshmi is intended to trade upon the valuable goodwill of the plaintiff's mark Grahshobha in respect of magazines because the meaning conveyed by the two terms Grahshobha and Grahlakshmi would be the same because in the Hindi dictionaries the term "Lakshmi" has been stated to mean Goddess of wealth and it is also stated to be known by the name, inter alia, "Shobha". Therefore, the class of people who read such magazines are likely to be deceived

since the meaning and idea conveyed by the use of each of the said titles is the same. The argument put forward on behalf of the respondent is that there are other magazines in different regional languages which are being published under the title Grahlakshmi and Grahshobha. It is alleged that the said user of the title Grahlakshmi in different regional languages goes back 25 years from now and is prior in time. However, no material has been placed on record to show that the adoption of the mark Grahlakshmi by the Respondent was prior to adoption of the mark Grahshobha. u/s 2(1)(j) of the Trade & Merchandise Marks Act 1958, the term "Mark" has been defined as - "mark" includes a device, brand, heading label, ticket, name signature, word, letter or numeral or any combination thereof : and the term "Trade Mark" has also been defined in Section 2(v) of the said Act as under :-

"(V)"trade mark" means- (i) in relation to Chapter X (other than Section 81), a registered trade mark or a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark ; and (ii) in relation to the other provisions of this Act, a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right, either as proprietor or as registered user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark registered as such under the provisions of Chapter VIII;"

(3) In the cases where the trade mark has been registered, the registered proprietor of the trade mark u/s 28 of the Act enjoys exclusive right to use the trade mark in relation to the goods in respect whereof the trade mark is registered subject, however, to such conditions subject whereto the registration was granted. Section 29 of the Act provides that a registered trade mark is infringed by a person who not being the registered proprietor of the trade mark...uses or permits the use of a trade mark which is identical with or deceptively similar to the trade mark in relation to any goods in respect whereof the trade mark is registered----." In the present case, it would not be necessary to go into the question of passing off or the new development in law of passing off whereby unfair trading even though it does not give raised to deception or confusion or the case of sale of goods under lawful trade description can also be looked into and such activity can be restrained by Courts As already observed above, a mark shall be deemed to be deceptively similar only if it bears such close resemblance with the other mark which is likely to deceive or cause confusion. Such similarity could be on account of similar get up or phonetic similarity in pronouncing the mark or no account of other one or more factors which may or are likely to cause confusion.

(4) As per one of the Hindi dictionaries one of the names given to "Lakshmi" is "Shobha". However, in the same dictionary the word "Shobha" does not show "Lakshmi" as one of its name of meanings. The respondent has relied heavily on

the fact that Grahlakshmi as a magazine has been published in some regional languages. The details of such publication and the extent thereof has not been mentioned anywhere.

(5) The question of deceptive similarities has been considered by various Courts. No hard and fast rule can be laid down for all cases. Each case has to be examined and decided in the light of its own facts. Phonetic similarity plays a significant role of distinguishing one "Mark" from the other. Magazines are sold to and read by literate persons and persons who understand the language. Shobha in the same Hindi dictionary means, "Prabha, Kanti, Chamak or beauty etc." The word "Grah" in Hindi means "house" Thus when the two words are joined and read together as "Grahlakshmi or "Grahshobha", they would seem to convey the different idea. The possibility of any unwary purchaser being deceived into assuming a connection between the producers/publishers of the "Grahlakshmi" and "Grahshobha" magazines, or assuming that Grahlakshmi has also emanated from the same source wherefrom Grahshobha Is published is highly unlikely, Phonetically also the two marks are quite different from each other.

(6) Reference has been made by the appellant to the judgment in the case of J.C. Eno Limited Vs. Vishnu Chemical Co., . That was a case of a particular product and not title of a magazine. Normally if the idea and meaning conveyed by the registered trade mark and the alleged infringing mark is the same and if there is phonetic similarity and general get up of the magazines also bears close resemblance with one another, the registered proprietor would entitled to relief against the offender. No doubt in the case of registered trade mark, the very fact of registration entitles the registered proprietor thereof to the exclusive use of the said trade mark and no one has a right to infringe the said right or apply the said mark except as provided under the Trade and Merchandise Marks Act. But these considerations would not come into play if the two titles (marks) are phonetically quite different. Even about two conveying the same idea is doubtful. As such these are not likely to deceive the purchaser while buying the magazines. Prima facie I feel that the said two marks are quite distinct.

(7) I have perused the pleadings of the parties. The respondents have, inter alia, challenged the validity of the registration of the trade mark in favor of the plaintiff, but at the time of arguments no arguments were addressed on this point. So long as the mark is borne on the register and no action is initiated for its removal the suit can neither be stayed nor can any challenge the validity of the registration be entertained at this initial stage.

(8) In this case, admittedly the product in both the cases is a magazine mainly for ladies. Both deal with the same or similar topics. Their get-up and management of topics on the cover page also appears to bear similarity with one another. But in view of the discussion above, it cannot be said in the absence of evidence that use of mark Grahlakshmi would amount to infringement of the Trade Mark Grahshobha. Buyers of such magazines are not illiterate persons and are able to distinguish between the two and with phonetic dissimilarity which is

one of the most important factors to distinguish one from the other.

(9) The case of title to the magazines even though registered as a trade mark, shall have to be examined in the light of the audience and the possibility of resulting confusion besides other considerations. In the past, there have been disputes over the titles of various publication wherein the Courts had declined to grant injunction even though the same were similar phonetically. (See : The Ridgeway Company v. The Amalgamated Press (Limited) : reported as 1911 LR 28 wherein the two trade names "Everybody's Magazine" and "Everybody's Weekly" were involved. The Court held that the action failed as the two periodicals were not likely to compete with one another, and the Court could not restrain the use of a common and popular expression like "Everybody's").

(10) Therefore, at this initial stage, I think that there is no case for grant of an injunction. However, I feel that in the interest of justice the appellant should be safeguarded so that in case he succeeds in the suit finally after leading evidence, he is not left with a paper decree. Accordingly, the respondent is directed to maintain the account of sale of magazine Grahakshmi and file the same in the Court every quarter.

(11) In the light of the above discussion, the appeal is partially accepted to the extent that the respondent shall file in the Court every quarter the account of the sale of its magazine under the title Grahakshmi.

(12) Parties are left to bear their own costs. The opinion expressed in this order shall not be deemed to be an expression of opinion on the merits of the case. Appeal partly accepted.