
(2011) 06 DEL CK 0054

In the Delhi High Court

Case No : I.A No. 16928 of 2009 in C.S. (OS) No. 2513 of 2009

Five Star Health Care P. Ltd.

APPELLANT

Vs

Tara Chand Jadwani

RESPONDENT

Date of Decision : 03-06-2011

Acts Referred:

Trade Marks Act, 1999 — Section 10, 2, 28

Citation : (2011) 5 AD 321 : (2011) 180 DLT 573 : (2011) 6 RCR(Civil) 962

Hon'ble Judges : Manmohan Singh, J

Bench : Single Bench

Advocate : Neeraj Grover, for the Appellant; Satish Kumar, for the Respondent

Judgement

Manmohan Singh, J.—By this order, I shall dispose of the I.A No. 16928 filed by the Plaintiff in the present suit for permanent injunction, passing off, restraining infringement of trade mark, unfair competition, delivery up, and recovery of damages.

2. Plaintiff is a private limited company incorporated under the Companies Act, 1956 having its registered office at A-70, Naraina Industrial Area, Phase -I, New Delhi. The Plaintiff is engaged in the business of manufacturing and marketing/sale of cosmetics and personal care products.

3. It is averred in the plaint, that the Plaintiff has established sales network throughout the country as the goods of the Plaintiff are sold in all parts of the country. Plaintiff has continuously been using the trade name FIVE STAR as an essential part of its corporate name since 2005 and the Plaintiff has also been using trade mark 5 STAR as its inherently distinctive trade mark in relation to the sale of its goods i.e. shaving creams, soaps, lotions, face creams and shampoos etc. since the year 2006. It is also averred in the plaint that prior to the Plaintiff, its predecessor in interest and title M/s Vinkam Products, (sole proprietorship concern of Mr. Vinod Kumar Manchanda), the father Mr. Sumit Manchanda and Mr. Sachin Manchanda, directors of the Plaintiff company was using the same

trade mark since the year 1976.

4. In the year 2001, the Plaintiff's predecessor also started using STAR NATURALS which is duly registered under the Trade Marks Act, 1999 and by virtue of registration, the Plaintiff acquired statutory rights for it under the provisions of Trade & Merchandise Marks Act, 1958, the details of registrations are given as under:

Trade Mark

Registration

Class

In respect of

5 STAR

415314/ 30.12.1983

3

shaving creams, soaps & lotions included

5 STAR

495778/10.08.1988

3

shaving creams, soaps & lotions,

STAR NATURALS

1291773/22.06.2004

3

Cleaning agents, soaps, detergents,

5. It is mentioned in the plaint that the Plaintiff's request on the form TM-23 for recording of the name of the Plaintiff company as the subsequent proprietor of the aforesaid registrations on the basis of the assignment deed dated 06.02.2006 is pending with the Registrar of Trade Marks.

6. The Defendant who is engaged in the same business and is also marketing and selling similar goods had been the distributor of the Plaintiff and M/s Vikram Products between the period 1980-2008 and selling the products of the Plaintiff and its predecessor-in-interest.

7. In November, 2009 the Plaintiff came to know that a shaving cream is being sold in the whole sale market like Sadar Bazar and Paharganj, Delhi bearing mark 6 STAR. The said product shows the name of the proprietorship concern of the Defendant as the manufacturer. According to the Plaintiff, the mark used by

the Defendant is deceptively similar to the Plaintiff's mark 5 STAR. The impugned product of the Defendant is even packed in similar packaging as that of the Plaintiff with colour combination of BLUE, RED & WHITE.

8. As per the Plaintiff, the adoption of the trade mark 6 STAR was not the first or the only attempt of the Defendant to infringe the trade mark of the Plaintiff but even in the year 2006 the Defendant had filed an application for the registration of the mark identical to the trade mark VINKAM of M/s Vinkam Products, the sister concern of the Plaintiff in relation to the closely related goods. Thereafter, in 2008, the Defendant again started manufacturing its goods under the mark VILCOM, which was phonetically similar to VINKAM, thus, M/s Vinkam Products immediately filed a suit to restrain the Defendant from using the mark VILCOM and the Defendant in appeal filed by the Plaintiff offered to change the mark VILCOM to VELCOME. The time sought by the Defendant of four weeks was granted to exhaust its pending stocks.

9. The Defendant submits that it has conceived and adopted the trade mark 6 STAR having distinguished colour scheme, pattern and artistic work which is different from the trade mark, colour scheme, pattern and artistic work of the Plaintiff and there is no likelihood of any confusion among the consumers with respect to the trade marks "5 STAR" and "6 STAR".

10. Further, it is stated, that the trade mark "6 STAR" is being used by the Defendant for the last four to five years and it is the prior user of the said trade mark. The source of the product is clearly written on the packaging material and the writing style of "6 STAR" is entirely different from the trade mark of the Plaintiff.

11. The digit 6 used by the Defendant is apparently different from that digit 5 of the Plaintiff, therefore, there is no scope of any confusion either visually or phonetically or by pronunciation. The colour combination, getup of the packets, the packaging material, even the font of the trade mark of the Defendant is easily distinguishable from that of the Plaintiff. The question of infringement of trade mark under these circumstances does not arise.

12. It is submitted by the Defendant, that the court has to compare the marks as well as get up of the product as a whole to see whether the totality of the impression given both orally as well as visually is such that it is likely to cause confusion and in the present case it can be said that there is no likelihood of any mistake or confusion in the trade marks of the Plaintiff and the Defendant. The word STAR and the number 5 are common and generic and as such the Plaintiff cannot have any exclusive right over them.

13. I have heard the counsel of both the parties. In order to establish the case of infringement, the Plaintiff in such an action has to show:

(a) that his mark has been registered and he is the registered proprietor thereof, and (b) that an identical mark or a mark which is deceptively similar to the

registered mark has been used by the Defendant. The expression "deceptively similar" has been defined in Section 2(h) of the Trade Marks Act, 1999, as follows:

A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles the other mark as to be likely to deceive or cause confusion.

Therefore, in case the aforesaid requirement made out by the Plaintiff by showing that the Defendant's mark is identical with or so nearly resembles the Plaintiff's mark either visually, phonetically or otherwise that it is likely to deceive or cause confusion in relation to the goods in respect of which the Plaintiff got his mark registered. Further, if the essential features of the trade mark of the Plaintiff have been adopted by the Defendant, the fact that there are additional features in the Defendant's mark, the same is immaterial in case the essential features have been copied. Then action for infringement is made out as by virtue of registration, the party gets exclusive and statutory rights u/s 28 of the Act and the registration granted is to be taken as prima facie evidence of validity.

14. For answering the defence raised by the Defendant in the present case as to whether the mark used by the Defendant is deceptively similar. The Division Bench of this Court in the case of Atlas Cycle Industries Ltd. Vs. Hind Cycles Limited, has examined the similar question very thoroughly while dealing with the two rival trade marks Royal Star and Eastern Star of the parties and has come to the conclusion that the trade mark adopted and used by the Defendant Royal Star is similar to Plaintiff's trade mark Eastern Star.

15. Hon'ble Division Bench has discussed a catena of decisions in this regard. Some of them are as follows:

In AIR 1943 196 (Lahore) Tek Chand and Sale JJ pointed out at page 202 that "what has to be seen is not that there is a possibility of confusion, but that the resemblance is such that there is a reasonable probability of deception". The learned Judges, relying on the observation of the Privy Council in AIR 1940 86 (Privy Council) , approving the test laid down by Niamat Ullah J. in Thomas Bear and Sons (India) Vs. Prayag Narain, observed that "in the judging of the probability of deception, the test is not whether the ignorant, the thoughtless, or the incautious purchaser is likely to be misled, but we have to consider the average purchaser buying with ordinary caution.

In AIR 1951 Bombay James Chadwick & Bros. Ltd. v. The National Sewing Thread Co. Ltd; Chagla CJ and Bhagwati; referring to the words "likely to deceive or cause confusion" in Section 10 of the Trade Marks Act, 1940, observed at page 152 as follows:

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

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

In *Amritdhara Pharmacy Vs. Satyadeo Gupta*, the question was whether the trade name "Lakshmandhara" was likely to deceive the public or cause confusion to trade in view of the trade name "Amritdhara" which had already been registered, as a trade name. The Supreme Court referring to the earlier decision in *Corn Products Refining Co. Vs. Shangrila Food Products Ltd.*, held that the overall similarity of the two composite words must be considered, that the question has to be approached from the point of view of a man of average intelligence and imperfect recollection, and that to such a man the overall structural and phonetic similarity of the two names "Amritdhara" and "Lakshmandhara" was likely to deceive or cause confusion.

16. Further in the case of *Atlas Cyle Industries (supra)* it was held as under:

The principles which emerge from the above decisions may be stated as follows:

In an action for an alleged infringement of a registered trade mark, it has first to be seen whether the impugned mark of the Defendant is identical with the registered mark of the Plaintiff. If the mark is found to be identical, no further question arises, and it has to be held that there was infringement. If the mark of the Defendant is not identical, it has to be seen whether the mark of the Defendant is deceptively similar in the sense that it is likely to deceive or cause confusion in relation to goods in respect of which the Plaintiff got his mark registered. For that purpose, the two marks have to be compared, "not by placing them side by side, but by asking itself whether having due regard to relevant surrounding circumstances, the Defendant's mark as used is similar to the Plaintiff's mark as it would be remembered by persons possessed of an average memory with its usual imperfections", and it has then to be determined whether the Defendant's mark is likely to deceive or cause confusion. For such determination, the distinguishing or essential features (and not every detail) of the two marks and the main idea, if any, underlying the two marks which a purchaser of average intelligence and imperfect memory would retain in his mind

after seeing the marks, have to be noticed. It has then to be seen whether they are broadly the same or there is an overall similarity or resemblance, and whether the resemblance or similarity is such that there is a reasonable probability of deception or confusion. In doing so, the approach has to be from the point of view of purchaser of average intelligence and imperfect memory or recollection, and not an ignorant, thoughtless and incautious purchaser. In an action for passing off, the test for deceptive similarity, i.e. as to the likelihood of confusion or deception arising from similarity of the marks or the get up, packing, etc. is practically the same as in an action for infringement (vide *Edwards v. Dennis*, (1885) 30 Ch.D. 454 471 *Lambert and Butler Ltd. v. Good body*, (1902) 19 R.P.C 377, 383 *Addley Bourne v. Swan & Edgar Ltd*; (1903) 20 R.P.C 105, 117 and *Tavener Rut ledge Ltd. v. Specters Ltd.* (1959) R.P.C 355,360), except that it has also to be seen whether the Defendant's mark or the get up, packing, etc. of his goods has besides the essential features of the Plaintiff's mark or goods, any additional features which distinguish it from the Plaintiff mark or goods, and whether it is likely of reasonably probable that the Defendant can pass off his goods as those of the Plaintiff to a purchaser of average intelligence and imperfect memory or recollection.

In the present case the Appellant (Plaintiff) alleged that the trade mark "ROYAL STAR" of Respondent 1 (Defendant 1) was an infringement of his registered trade mark "EASTERN STAR", and in the alternative that Respondent 1 (Defendant 1) has been using its trade mark "ROYAL STAR" for the purpose of passing off and enabling others to pass off their cycles as the cycles of the Appellant (Plaintiff). We shall first consider the case of infringement. The registered trade marks of the Appellant (Plaintiff) are a device (monogram) registered as No-12052 and (2) the words "EASTERN STAR" registered as No. 11426.

So far as the word mark "EASTERN STAR" is concerned, the question for determination is whether the use of the words "ROYAL STAR" for the cycles of Respondent 1 (Defendant 1) constitutes an infringement of the Appellant's (Plaintiff's) trade mark "EASTERN STAR". The learned District Judge took the view that though the word "STAR" is common to both the names, the names, taken as a whole i.e. "EASTERN STAR" and "ROYAL STAR" are substantially different and there is no likelihood of deception or confusion. The learned District Judge referred to certain observations in the decisions in *Pinto v. Badman*, 8 R.P.C. 181,(13) and *The Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd.*, to the effect that a label "does not consist of each particular part of it, but consists of the combination of them all," and "where a distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole." He next referred to the observations on page 657 of *Kerlay on Trade Marks*, 7th Edition, which go to show that it was held in a case that "Night Cap" was not too near "Red Cap" or "Mother Red Cap" as to cause confusion; the decision in *Messrs Modi Sugar Mills Ltd.* (supra) that the word mark "Kotogem" did not

constitute an infringement of the word mark "Coccogem"; the observation in *Schweppes Ltd. v. Gibbons*, 22 R.P.C. 607 that a label has to be taken as a whole and too much stress cannot be laid on slight similarity in one small part of it; and the decision of the Privy Council in *Coca-Cola Company of Canada Ltd.* (supra) that the use of the name of "Pepsi Cola" was not an infringement of the trade mark "Coca Cola"; and then merely observed that he was of the view the use of the name "ROYAL STAR" by Respondent 1 (Defendant 1) for its cycles did not infringe the Appellant's (Plaintiff's) trade mark "EASTERN STAR". We find it difficult to agree with the said view. It is true that the words "EASTERN STAR" and "ROYAL STAR" have to be taken as a whole. But, the learned District Judge, in our opinion, failed to note that the view taken by a Court on the facts in any particular case cannot afford any proper guidance. As observed by the Supreme Court in *Amritdhara Pharmacy* (supra), "every case must depend on its own particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion.

17. In applying the said principles in the present case, it has to be noted that the meaning of the word "STAR" has no relation with goods in question/digit 5. Similarly, the word "STAR" has, in their meaning, no relation to the goods digit 6. They are thus not descriptive of goods to which they are applied. The essential feature of two sets of the trade mark is STAR which gives the same sound when pronounced. Thus, a person of average intelligence and imperfect memory is very likely to remember mark "STAR", and is thus likely to be deceived or confused between the two marks, therefore, in my view both marks have phonetic similarity, and consequently their use in respect of the same kind of goods is likely to cause deception or confusion.

18. As per the settled law, it appears that the use of the mark STAR by the Defendant in relation to the similar goods, amounts to the infringement of the marks of the Plaintiff bearing Nos. 415314, 495778 and 1291773 who are subsequent proprietor thereof.

19. For the aforesaid reasons, I am of the considered view that Plaintiff has been able to make out a strong prima facie case against the Defendant. Consequently, the Defendant is restrained from using the mark STAR and device of STAR in relation to similar goods. However, Defendant is free to use the number 6 with another trade mark which is not similar to the trade mark of the Plaintiff STAR.

20. It is clarified that this finding shall have no bearing on the merit of the case when the suit is finally decided.

CS(OS) No. 2513/2009

21. List on 09.09.2011 for framing of issues.