
(1995) 04 MAD CK 0081

In the Madras High Court

Case No : O.S.A. No's. 55, 56, 59 and 60 of 1995 and O.A. No's. 179 and 180 of 1995

Haw Par Bros. International Ltd.

APPELLANT

Vs

Tiger Balm Co. (P) Ltd. and Others

RESPONDENT

Date of Decision : 01-04-1995

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2
Trade and Merchandise Marks Act, 1958 — Section 27(2)

Citation : (1995) 04 MAD CK 0081

Hon'ble Judges : Srinivasan, J;S.S. Subramani, J

Bench : Division Bench

Advocate : G. Vasantha Pal and Ravi Khadam, for Mohan Associates, for the Appellant; G. Ramaswamy R. Krishnamoorthy and G. Subramaniam, for Parmabulavi Radhaki, for the Respondent

Judgement

Srinivasan, J.—With the consent of parties, all these matters are heard together. For the sake of convenience, the parties will be referred to in this judgment by their rank in O.S.A. Nos. 55 and 56 of 1995. The second appellant in O.S.A. Nos. 59 and 60 of 1995, who is also the second respondent in O.A. Nos. 179 and 180 of 1995 is not a party to O.S.A. Nos. 55 and 56 of 1995, but he will be referred to as the second appellant.

2. The first appellant has instituted C.S. No. 1464 of 1994 against the respondents praying for a perpetual injunction restraining them from using in relation to pain Balm or any other medicinal preparations, the trade mark TIGER BALM , TIGER in English and Chinese characters, the device of a leaping tiger and the cartons, labels, containers and sachets being Annexures E,F,G and H respectively and/or any other Trade Marks, device or carton, label, container and sachets which are an imitation or deceptively similar in any manner whatsoever to that of the plaintiff's trade marks TIGER BALM, TIGER in English and Chinese characters, their cartons, labels, containers and sachets being Annexures A, B, C and D respectively, so as to pass off, or enable others to pass off their goods as

and for that of the plaintiffs. The second prayer in the suit is to restrain the first respondent from using the words TIGER BALM as part of its corporate name or trading style or any other trading style containing the words TIGER BALM or others words similar thereto so as to pass off and enable others to pass off the first respondent's goods and/or business as and for the first appellant's goods and/or business. The third prayer is for directing the respondents to pay a sum of Rs. 5,00,000/- as damages for their wrongful activities. The fourth prayer is for a preliminary decree directing the respondents to render an account of the profits made by them through sale of goods under the trade marks TIGER BALM and a final decree for the amount of profits found to have been made by them after the rendition of accounts. The fifth prayer is to direct the respondents to surrender to the first appellant all goods, cartons, labels etc. bearing the trade marks TIGER BALM, TIGER in English and Chinese Characters, device of leaping tiger or any mark similar thereto and which are deceptively similar to the first appellant's cartons, labels, containers and sachets. The 6th prayer is for passing interim and ad interim orders in terms of prayers 1 and 2. The first appellant filed O.A. No. 999 of 1994 for interim injunction pending disposed of the suit in terms of the first prayer in the plaint. O.A. No. 1000 of 1994 was filed for an interim injunction pending the suit in terms of the second prayer in the plaint. The case set out by the first appellant in the plaint as well as the affidavit filed in support of the applications is as follows:- The first appellant carries on an internationally well-established business as manufacturers and merchants of herbal products including inter alia, pain balm, a medicinal ointment, It is the proprietor of various trade marks, the essential features of each pf which are, inter alia, the device of a leaping tiger, the words" TIGER BALM" and TIGER in English and Chinese characters. The history of the adoption of the said marks by the predecessor of the first appellant is briefly stated as under:-

"One Aw Chu Kin, a Chinese Herbalist in Rangoon, Burma, prepared a medical ointment in the year 1890. In or about 1900, his two sons by name Aw Boon Haw and Aw Boon Par decided to manufacture and market the medicinal ointment under the name Eng Aun long. In respect of the said balm, they adopted a trade mark consisting of the device of a tiger. The word "TIGER" is taken from the name of the elder brother Aw Boon Haw. The Chinese word Haw means the animal tiger. The Chinese word Par in the name of the Younger brother means the animal leopard. The trading name Eng Aun Tong was coined to denote the quality of the product. The trade mark TIGER and the device of a leaping tiger were being used in respect of the balm since 1900. It acquired tremendous reputation not only in Rangoon but also in other countries to which it was exported.

3. In or about 1932, a Limited Company was incorporated in Singapore, know as Haw Par Brothers (Pvt.) Ltd. It took over the business of the two brothers referred to earlier as well as the assets including the trade marks. The company continued to carry on business and export balm to various countries including India till the Japanese occupation of Burma and Singapore during the II world

war. The company devised various trade marks to be used in various countries, the essential features of each of which was the device of a leaping Tiger, the word "Tiger Balm" written in English and also in Chinese character. The trade marks were registered in different countries all over the world. In the year 1969, the first appellant took over the business of the said company. It became the subsequent proprietor of various trade marks which were used by the company earlier. The business was flourishing all over the world. In 1976 the approximate value of the world-wide sales was 5.5 million US \$. It went up to 16 Million U.S.\$ in 1992. In the interregnum, it was even higher. In 1988 it was 23.5 Million U.S.\$ and in 1990 it was 22.6 Million U.S.\$, The trade marks of the first appellant were known all over the world including India. The advertisement of the products of the first appellant sold under the said trade marks have appeared in various newspapers and magazines, Travellers from India visiting countries like Hong Kong, Singapore, Malaysia, Gulf countries, etc. purchase the first appellant's balm under the said trade marks and bring them to India, People in India have associated the said trade marks and particularly the words TIGER BALM and the device of the tiger with the products manufactured by the first appellant. The first appellant's Tiger Balm is advertised in several international newspapers, periodicals and magazines having a large circulation in India. It also advertised in STAR TV telecast in India.

4. During the second World War, the export to India was stopped on account of Japanese occupation of Burma. After Indian independence, on account of import restrictions imposed by the Government of India, the balm could not be exported to India. Notwithstanding the same, the product of the first appellant was being continuously used in India, as the goods were being carried by the tourists and available through non official channels also. A Market Survey carried out on behalf of the appellants show that the people in India associated the trade marks and particularly the words "Tiger BALM" and the device of the Tiger with the products manufactured by them.

5. In view of the liberalisation policy of the Government of India in 1990, the first appellant decided to launch its products under its trade marks in India. On learning the same, the third respondent representing the second respondent approached the first appellant showing interest in having association with it for the purpose of manufacturing and marketing its products in India under its trade marks. In the course of correspondence, respondents 2 and 3 disclosed that the fourth respondent had obtained registration of the trade mark VIJA LABS TIGER BALM under No. 204951 in class 5. The fourth respondent had authorised the third respondent to carry on negotiations with the first appellant. The negotiations did not fructify and broke down in on about 1993. In the course of the aforesaid correspondence, the third respondent gave a copy of the agreement entered by the fourth respondent with the second respondent to use the said registered trade mark of the fourth respondent. It is clear therefrom that respondents 2 and 4 were aware of the trade marks of the first appellant and the essential features thereof. After the failure of the negotiations, respondents 2

and 4 devised a scheme of trading on the reputation of the first appellant by forming Respondent No. 1 to manufacture a balm to be marketed by respondent No. 2 under the label mark and cartons and sachets of the first appellant. It is also evident from the interview given by the third respondents to the Press that the respondents have adopted the first appellants marks and slavishly imitated the same. The first appellant had applied for registration of certain trade marks in India and the applications are pending. The applications filed in July 1975 and 1976 were opposed by one Rangoon Chemical Works Private Limited of Surat and the fourth defendant. The opposition of Rangoon Chemical works was allowed and the first appellant has filed appeals in the Calcutta High Court against the orders of the Registrar of Trade Marks. The said appeals are pending. The oppositions filed by the fourth respondent were kept in abeyance. The first appellant filed rectification petition for removal of the fourth respondent's trade mark VIJA LAB'S TIGER BALM under No. 204951. The respondents have copied not only the device and the phrases in the marks but also adopted the shape of the container had the colour scheme. In short, the respondents have adopted fraudulently every aspect of the appellant's trade marks as well as the write ups. They have even adopted the Chinese character for the word "TIGER". In the write - up in each of the container of the first appellant, the photographs of the founders of the appellant company viz., Aw Boom Par and Aw Boon Haw with a device of the leopard and tiger and the names in Chinese characters at the bottom are used. The respondents have copied even that and used the Chinese language. Inch by inch the respondents have copied the appellant's marks, devices, containers, cartons, labels and literature with the dishonest intention of passing them off as the appellant's goods. By virtue of long, extensive and continues use, the trade mark Tiger Balm ", the device of leaping tiger, the carton, label and container have become distinctive of and are exclusively identified with the appellant's products all over the world including India. The manufacture and sale of an identical pain balm in identical containers etc., by the respondents would amount to passing off and enable others to pass off their goods as and for the appellants goods. The trade marks registered by the respondents under No. 204951 is completely different from what they are using. The appellants have been selling their goods under the said marks throughout the world for more than 36 years. The conduct of the respondents is dishonest and mala fide. They have also chosen to adopt the corporate name of the first appellant which is misleading. By using the said name, they are only trying to show connection with the first appellant's goods and business. On account of the respondents' wrongful activities, the appellants have suffered and are likely to suffer irreparable loss to their trade and reputation. Hence, they should be prevented by appropriate injunctions as prayed for by the appellants. The appellants became aware of the wrongful activities of the respondents in August 1994 and there has been no delay or laches in filing the suit or applications.

6. On 5-10-1994 notice and interim injunctions were ordered on Original Application No. 999 of 1994 and notice was ordered in O.A. No. 1000 of 1994.

The first respondent filed a common counter in the two applications. The affidavit was sworn to by one N.S.Kennedy, Managing Director of the first respondent. In the counter affidavit the following case is put forward:- The first appellants has no locus standi to file the suit as it is neither a citizen of India, nor a company registered under the Indian Companies Act. The plaintiff must prove the alleged history of the concern with valid records. The sales figures set out in the plaint reflecting the world-wide sales are inflated and incorrect, The suit has been filed out of business rivalry. The claim that the alleged trade marks of the first appellant has acquired tremendous reputation not only in Rangoon but also in other countries is denied. On the admission of the first appellant, export to India was stopped during the II world war and the claim of the first appellant of the reputation in India of the marks does not hold water. The first appellant has no sales of their product within India, In the absence of any manufacture, marketing or advertising of any of the plaintiff's products within the Union territory of India, the plaintiff cannot claim proprietorship to the mark in India or to establish an action for passing off the plaintiff's goods. The plaintiff approached the respondents to establish commercial relationship, obviously because of the respondent's own business reputation. The first appellant has no cause of action in India based on any alleged passing off and the same cannot arise unless and until the first appellant's products are manufactured or marketed in India. The plaintiff has not claimed any registration of his alleged trade marks in India to give them any statutory right. The pendency of the alleged applications for registration from 1975 would show that they are not prima facie registerable. They do not give any right to the plaintiff for instituting a civil action. The respondents have registered their trade marks of TIGER BALM and the device of Tiger under the Act as early as from 25-9-1961 in class V and the registration has been renewed from time to time ever since. The colour scheme, get up and label used by the respondents from 1971 is unique and presently a new improved get up and colour scheme had been adopted in respect of the label. The respondents have been using the trade mark TIGER BALM" along with the device of tiger in India ever since 1961 in respect of labels and cartons and have built valuable, good-will for the same throughout India. The fourth respondent, trading as TIGER BALM AND COMPANY is the registered proprietor of the trade marks. The first respondent of which the fourth respondent is a Director is the licensed user in respect of the registered trade marks. There is a marketing arrangement between the licensed user, the first respondent, and the second respondent so that there is a complete legal relationship between all the parties in the matter of the user of the trade marks. Having failed in their first attempt in the rectification proceedings before the Registrar in Mas/144, the plaintiff has now filed a second application for rectification before the Trade Marks Registrar at Madras and the same is liable to be dismissed just as the earlier application for rectification. The respondent request on Form TM 33 was allowed and the name of the registered proprietors has been altered from that of Vija Labs to that of Tiger Balm & Company. The trade marks, cartons and labels are used by the respondents, goods and the allegation that they are imitations of

the plaintiff's alleged cartons, labels etc., is totally baseless. None will imitate the alleged cartons/labels of the plaintiffs, who are unknown in the Indian market. The unique design of the bottle containing the Balm had been registered by the respondents under the Indian Designs Act, 1911, as early as in 1973 under registration No. 141423. The hexagonal shaped carton is complementary to the use of the said design and the respondents have been marketing their goods long prior to the plaintiff in similar carton. The colour scheme and get up of the respondents' product represent their own original artistic work. They have obtained a certificate u/s 45 of the Copyright Act for the eventual registration of their artistic work under the said Act. The first appellant's Tiger" is seemingly reddish in colour with black stripes, whereas the Tiger" device used by the respondents is yellow in colour. The plaintiff's label has the word "tiger" written in black against an orange background, whereas the respondents are using the word written in white against a dark blue background. The device of "tiger" is the essential feature of the registered trade mark of the respondents and it is in use long before the plaintiff entering into the Indian Market. The plaintiff is seeking entry into the Indian Market and is attempting to pass off its goods as that of the respondents' goods. The fourth respondent being a Doctor, has formulated the product with the Indian consumer in mind and the preparation is made purely from indigenous system of Siddha medicines.

7. The claim that the respondents are attempting to pass off their goods as that of the plaintiff's is denied, as their product is not even known or available in Indian market. The fourth respondent is an honest and bona fide user of the trade mark registered since 1961 though it was registered in 1961, it was in actual commercial use since 1958. The respondent's application in Form TM 28 for recording the licensee as the registered user under the Trade Marks Act is searched pending with the Government, The corporate name of the first respondent has been distinctly for under the Indian Companies Act and consequently been registered and it is in no way connected with the plaintiff's product. The remedy of the plaintiff in respect of the corporate name is not in the present forum under the Trade and Merchandise Marks. Act and the plaintiff being non-citizen of India would do well to approach the appropriate authority under the Indian Companies Act for any redressal thereof. The respondent being a registered proprietor, has the exclusive right without any hindrance or obstruction from any quarter to the of the trade marks in relation to the goods in respect of which the trade marks is registered and cannot be made liable to be enjoined. The respondents have also obtained drug licence under the Drugs and Cosmetic Act, 1940 for manufacture of the drugs and the respondents' product TIGER BALM is being manufactured as a Siddha Medicine. The interim order which operator in restraint of the enjoyment of the respondents' statutory rights, is causing serious and irreparable injury to the respondents' trade and business. Hence, it should be vacated. The plaintiff cannot seek to interfere with the exercise of statutory rights of the respondents and as such is not entitled to any relief. The plaintiff should be ordered to pursue the proceedings before the

Registrar of Trade Marks before when it has already filed an application for rectification of the register by cancelling the registered trademark. The proceedings brought before this Court in the same matter is veracious and is an abuse of the process of law and deserves to be dismissed.

8. The respondents filed A.No. 5985 of 1994 to vacate the order of interim injunction passed in O.A. No. 999 of 1994 and application No. 5986 of 1994 to suspend the operation of the order of ad interim injunction passed in O.A. No. 999 of 1994. Respondents 2 and 3 filed A.No. 5988 of 1994 to vacate the ad interim injunction passed in O.A.No. 999 of 1994. That application was supported by an affidavit filed by the third respondent as the Managing Director of the second respondent. The contents of the said affidavit are almost the same as on the affidavit filed by N.S.Kennedy. There is no need to summaries the contents of the said affidavit.

9. On behalf of the appellants, a common affidavit was filed by the duly constituted power agent of the first appellant as counter in the applications filed by the respondents. In addition to reiterating what was stated in the plaint and in the earlier affidavit and denying the averments contained in the affidavit filed by the respondents, it is stated therein that in spite of the ban on export of plaintiff's balm to India, the same was freely available in India as it was brought into the country regularly by travellers to and from India and sold in the duty free shops in all the international airports in India and in bonded warehouses. As regards the respondents' mark, it is said :- The trade mark under No. 204951 in class 5 is for the device of a sitting animal with the word VIJA LABs inscribed on it and bounded in a circle. The word "VIJA LAB's TIGER Balm" in English and Tamil appear in the outer circles. The mark was originally registered in the name of Dr. D.A.Nirmala, the fourth respondent. The mark now stands in the name of Tiger Balm & Co. Tiger Balm & Co. is neither the manufacturer nor the marketing agent of the impugned product manufactured, sold and dealt with by the respondents. The respondents have conveniently skirted the issue relating to proprietorship of the registration number 204951 in class 5 and the distinctive features of the said registered trade mark. It is pertinent to note that all the respondents have claimed to have registered the trade marks TIGER BALM (when in fact is not registered by them) whereas the mark is in the name of Dr. D.A.Nirmala trading as Tiger Balm & Co. Therefore, the respondents are guilty of misleading by making false and untrue statements before this Court and on this ground alone they are disentitled to seek to have the injunction vacated or any equity in their favour. As regards their wrapper and label stated to be registered in 1971, the enquiry revealed that there exists no such registration in the name of any of the respondents.

10. Reference is made to specific pages in the typed set of papers filed in Court and reliance is placed thereon in support of the first appellant's once. With reference to the rectification proceedings, it is said that it was a procedural order and not a speaking order on the merits of the case and it does not attract the

principles of res judicata within the meaning of Section 11 of the Code of Civil Procedure. With reference to the design under registration No. 141423 obtained by the fourth respondent, it is said that it had lapsed, provided it was renewed from time to time till 12th November 1988. It is stated that the first appellant had filed sufficient documentary evidence to prove the international reputation including that in India enjoyed by its trade mark Tiger Balm". The balance of convenience is in favour of the plaintiffs. The respondents are guilty of perjury and they have committed fraud on the trade and upon this Court. All of them have claimed proprietorship of the Registration No. 204951 for the trade mark in class 5, whereas it belongs only to the fourth respondent. The mark registered under No. 204951 in Class 5 is no defence to the present action. The respondents have used the Chinese character "Haw" in their cartons, labels, sachets and containers. The word "haw" in a Chinese means tiger. The Chinese character is not forming part of registration No. 204951 in Class 5. The respondents have failed to explain why they are using a Chinese character, whereas Chinese is not a language used in India. They have failed to say how they have crested the cartons, labels, containers and sachets, which are imitations of plaintiff's cartons, labels, containers and sachets in design, colour, scheme, get up and lay out.

11. The drug licence issued to the first respondent is dated 13-7-1994. It shows that the respondents were never manufacturing TIGER BALM prior to July 1994, nor they ever had drug licence to manufacture the same. The alleged claim of use made by the respondents is, therefore, illegal. Hence, the interim order should be confirmed.

12. The applications were argued at length before a learned single Judge of this Court. By a common order dated 18-1-1995, the learned single Judge vacated the interim order of injunction and dismissed O.A.Nos.999 and 1000 of 1994. He allowed application Nos.5985, 5986, and 5988 of 1994. The conclusions of the learned Judge are as follows:-

"132. The following are my conclusions;-

- i) For the foregoing reasons, I hold that the registered trade mark of the defendants/respondents is entitled to protection under the Trade and Merchandise Marks Act and the designs registered under the Designs Act.
- ii) In a passing off action, the plaintiff must establish goodwill and reputation in the geographical area where passing off is alleged and that the reputation of the plaintiff elsewhere is irrelevant. This issue is answered against the applicant and in favour of the respondents. Our Courts and the Courts in other countries have consistently taken only this view as could be seen from the 22 judgments cited by the respondents.
- iii) The applicant/plaintiff is not guilty of suppressions veri and suggestic false.
- iv) The applicant cannot gain by passing off action what he has failed to secure

by trade mark proceedings.

v) The applicant's case is hit by laches and acquiescence.

vi) Difficult questions of law raised by both sides in this case definitely call for detailed evidence, detailed arguments with reference to the evidence, oral and documentary, and mature consideration and as such, should be decided only in the suit and not on interlocutory motion.

vii) Market survey reports can be relied on by Courts after recording evidence at trial and not in a motion.

viii) The 1st respondent company represented by the 3rd respondent is entitled to use the trade mark in respect of the goods as per the terms and conditions of the users agreements dated 23-6-1994 in respect of the registered trade marks Tiger Balm" (word and device) bearing Registration No. 204951 in Class 5 in respect of medicinal balms and ointments in the name of Tiger Balm & Co., since the registered user's right under the agreement will flow immediately to the parties.

ix) Balance of convenience lies only in favour of the respondents.

x) The respondents have made out a prima facie case for the reasons recorded in the order.

xi) If the injunction granted already is not vacated, the respondents' right will be greatly jeopardised.

xii) No prejudice will be caused to the applicant by vacating the order of injunction since the applicant has not commenced their business till date.

xiii) The respondent shall maintain regular and proper accounts in regard to their sales, transactions, etc., and furnish a statement of accounts to this Court and also to the applicant once in Six months.

xiv) It is the case of the respondents in their counter that they have not adopted the applicant's cartons, containers, labels, etc. Therefore, the respondents shall use their trade mark registered under the Trade and Merchandise Marks Act and the design registered under the Designs Act and avoid using or imitating Chinese character, letters and literature in their cartons and wrappers."

13. Aggrieved thereby, the first appellant filed O.S.A. Nos. 55 and 56 of 1995 against O.A. Nos.999 and 1000 of 1994 respectively. The appeals were presented on 17-2-1995 and taken on file on 2-3-1995.

14. In the meanwhile, on 30-1-1995 respondents 4 and 1 filed CS.No. 257 of 1995 against the appellant and the second appellant for an injunction restraining the appellants from in any manner infringing their trade mark "TIGER BALM" and the device of "TIGER" for the appellants' goods or any other label, wrapper, carton, packing material, advertisements, signboard, container or sachets which are identical or deceptively similar to their trade mark, for a permanent

injunction restraining the appellants from in any manner passing off the appellants' products as their products under the registered trade mark "TIGER BALM" and using the get up, colour scheme and lay out for the appellants' goods, directing the appellants to render true and faithful accounts for the profits earned by them through the sale and manufacture of the products using the infringing name "TIGER BALM" directing them to pay the profits so earned and directing the appellants to surrender all products, cartons, labels etc., containing or consisting of the infringing name "TIGER BALM". In the plaint, the following allegations are made:- The plaintiff's are the leading manufactures of the medical preparation / balm and the first plaintiff has been carrying on business for the past several years. The first plaintiff has been doing extensive business and had adopted the words TIGER BALM in respect of the product created, manufactured and marketed by her. In the course of business, she honestly conceived and adopted the tiger mark "TIGER BALM" for the medicinal preparation / balm, manufactured and marketed by her. The medicinal balm was being produced by her with the Indian Formula, based on Indian Medicine from the year 1958. She applied for registration of the trade mark under the Trade and Merchandise Marks Act, 1958 and obtained registration on 25th September, 1961. The registration is still valid and subsisting as it has been renewed from time to time. The Consumer public have identified the product with the distinctive trade mark of the TIGER and the words TIGER BALM. There has been no other product marketed in India with the device of the TIGER and with the words TIGER BALM prior to the use, manufacture and marketing by the first plaintiff in the year 1958. She filed an application on 3-4-1963 in form TM33 and altered the trading style of the proprietor Dr.D.A.Nirmala to Dr.D.A.Nirmala trading as Vijaya Laboratories. In the year 1967, one Haw Par Brothers Limited, the predecessor of the first appellant, had filed testification proceedings in No. MAS-114 on the file of the Registrar of Trade Marks, Madras to rectify the register and to remove the registered trade mark of the first plaintiff. The first plaintiff contested the matter. The first appellant's predecessor failed to file evidence in support of the application for rectification and the application was deemed to be abandoned by the order of the Assistant Registrar of Trade Marks dated 6-5-1969. The first plaintiff would purchase the raw materials and even imported some raw materials under import licence. She was doing extensive business throughout India and had engaged agents, stockists and distributors at various places in India to market the product which had been identified as a quality product distinctive of the first plaintiff's manufacture. The agents would place orders for delivery of the TIGER BALM manufactured by the first plaintiff and they would also arrange for the advertisement of the TIGER BALM in periodicals, dailies and even through slides in the local theatres. The first plaintiff was paying excise duty from time to time and had also applied for and obtained Drug Licence under the Drugs and Cosmetics Act. She would periodically test the quality of the raw material and product TIGER BALM to maintain high level of quality. A request was made on form TM-33 dated 27-7-1971 before the Registrar of Trade Marks and by order dated 19-6-1973,

the registered proprietor's Trading Style was altered to Tiger Balm and Company. Thereafter, the first plaintiff had ceased to use the name visible and forthwith changed the trading style to TIGER BALM AND COMPANY. All the plaintiffs' advertisements, bills, invoices, complimentary items bill-boards and pamphlets, leaflets, slides and other materials were portraying the first plaintiff as TIGER BALM AND COMPANY.

15. The first plaintiff had applied for registration of the design of the hexagonal container and it was registered on 13-114973 under Design No. 141423 by the Controller General of Patents, Designs and Trade Marks. The product TIGER BALM was also marketed in the hexagonal container for the purpose of protecting the bottle container. The first appellant filed Application Nos.306622 and 316936 on the file of the Deputy Registrar of Trade Marks at Calcutta for registration of their trade marks. The first plaintiff filed opposition Nos.CAL-1698 and CAL-1758. Another individual by name M/s.Rangoon Chemical Works Pvt. Ltd. also filed opposition in CAL-1694 and CAL-1761. The applications were taken up and orders were passed rejecting the applications for registration filed by the first appellant and allowing the opposition filed by M/s. Rangoon Chemical Work (P) Ltd. were allowed vide order of the Deputy Registrar of Trade Marks dated 21-12-1988. The oppositions filed by the first plaintiff were ordered as abated and costs allowed, in view of the order passed in the oppositions filed by M/s. Rangoon Chemicals/ in favour of the first plaintiff.

16. The first appellant approached the first plaintiff for a joint venture with the first plaintiff and Dr.CK.Rajkumar, who was authorised by her to hold discussions with the first appellant. However, the demands made by the first appellant were unreasonable as the first appellant required her to surrender her trade marks to them, thereby acknowledging her rights to the said trade mark. The discussions failed and the first appellant entered into an agreement with the second appellant for a joint venture for manufacture and marketing of TIGER BALM in India.

17. The first plaintiff filed application in Form TM-28 to register the second plaintiff as registered user of Trade Mark No. 204951 and the same was acknowledged by the Registrar of Trademarks. They entered into an agreement for nation-wide marketing and distribution of their product TIGER BALM with M/s. Velvettee Pharma International Ltd., the second respondent represented by its Managing Director Dr.C.K.Rajkumar to impinge and to penetrate into the remotest corners of both the Urban and rural parts of the nation in view of the fact that the second respondent had a renowned marketing network. The hexagonal carton used by the plaintiff's in 1971 was improved and a new getup, colour scheme and layout without substantial alteration was produced to house the plaintiffs' product TIGER BALM. There has been an ever increasing demand for their product all over India and the total turnover of the product since its introduction till date would exceed several lakhs of rupees. The appellants have adopted the trade mark TIGER BALM with a view to create confusion in the

market and to enrich themselves unjustly on the reputation and goodwill earned by the respondents for over 36 years. The appellants have no manner of right, title or interest to do so. They have deliberately copied the well established registered trade mark of the respondents/ purely with the view to cut into the trade and ruin the respondents' reputation built over the years. The respondents have been put to serious loss and hardship which cannot be compensated in terms of money. The appellants cannot introduce by manufacturing and marketing their illegal product TIGER BALM in the market on account of the registration of the fourth respondent in respect of the words TIGER BALM and the device of TIGER and the carton wrapper with the improved and permitted variations, manufactured and marketed by the fourth respondent in the trading style TIGER BALM AND COMPANY. The appellants filed CS.No. 1464 of 1994 in this Court and obtained an order of ex parte ad interim injunction in O.A. No. 999 of 1994. The appellants' product is the colourable imitation of the product of the respondents and the labels, packing material and colour scheme of the appellants' preparation are identical to and deceptively similar to the product, label and packing material of the respondents' TIGER BALM. The appellants' trade marks is a slavish imitation of the respondents' trade mark. The appellants had not disclosed the entire facts on record and obtained an interim order on 5-10-1994. The respondents filed counters and applications to vacate the interim order. The applications were heard at length and this Court was pleased to vacate the ex parte order of injunction categorically holding that the first appellant has no right over the trade mark TIGER BALM and the device of TIGER among other things. The respondents gave the leave of the Court to read the order as part and parcel of the plaint.

18. Taking advantage of the ad interim order of injunction, the appellants have advertised the launching and introduction of the illegal and infringing TIGER BALM in India, in Indian Express and The Hindu. The appellants have jointly and for the first time commenced manufacturing the illegal TIGER BALM contrary to and in violation of right of the respondents under the Trade and Merchandise Marks Act, 1958. The defendants have started to market their infringing product first at Hyderabad in October, 1994 and consequently in various other places in India. The appellants have adopted the name TIGER BALM with the intention of weaning the respondents' market which had been developed after expending large sums of money, time and marketing expertise for sales promotion and maintaining quality of the product. The first appellant was allegedly selling its products in Singapore only in a paper wrapper, but never in India. The appellants are taking advantage of the good will and reputation established by the fourth respondent over the years by maintaining high standards of quality and excellence. The respondents will be put to irreparable loss and hardship and injury to the reputation and good will in their business, which cannot be compensated on terms of money. The appellants are passing off their products as that of the respondents. On the aforesaid averments, respondents 4 and 1 have prayed for the reliefs set out earlier.

19. They filed O.A. Nos. 179 and 180 of 1995 for having interim injunction during the pendency of the suit. As the appellants had entered caveat they were served with copies of the affidavits and petitions and the matter came up before a learned single Judge on 22-2-1995. The appellants prayed for time to file counter affidavit. The learned Judge granted time till 8-3-1995, to file counter affidavit and documents, if any, and adjourned the matter to that date. However, he passed an order of interim injunction till 8-3-1995 restraining the appellants from in any manner infringing the respondents' registered trade marks TIGER BALM and the device of TIGER and in any manner passing off the appellants' products as that of the respondents.

20. Against the said interim order, the appellants preferred O.S.A. Nos. 59 and 60 of 1995. When the appeals were posted for admission on 7-3-1995, the Division Bench with the consent of counsel on both sides withdrew O.A. Nos. 179 and 180 of 1995 to its file and directed the posting of O.S.A. Nos. 55 and 56 of 1995 along with said two appeals. In other words, the Division Bench directed the hearing of all the four appeals and O.A. Nos. 179 and 180 of 1995 together. The matter was posted to 14-3-1995 for hearing. Thus, all these matters have come before us.

21. The appellants have filed their common counter affidavit in O.A. Nos. 179 and 180 of 1995. The contents are almost the same as these in the plaint in C.S.No. 1464 of 1995 filed by the appellants. A detailed reference is also made in the counter affidavit to the third respondent visiting the factory and office premises of the first appellant in Singapore at least five times. It is alleged that the third respondent had first hand information on the first appellant's TIGER BALM, the packaging carton, container, label and write ups of the first appellant's products. When the negotiations for business collaboration with the first appellant failed, the respondents with deliberate and dishonest intention have copied the first appellant's scientific formula in the manufacture of the pain balm. No other company in India manufactures pain balm identical to the first appellant's pain balm. The respondents have copied the first appellant's formula by dishonest methods. By virtue of long, extensive and continuous use, the trade mark TIGER BALM, the device of leaping tiger, the carton, label and container have become distinctive of and are exclusively identified with the first appellant's products all over the world including India. The manufacture by the respondents of an identical pain balm and sale in cartons, labels and container which are almost identical to the first appellant's carton etc., are bound to cause confusion and deception amongst the trade and public. The respondents have made a false representation that the trade mark TIGER BALM is registered. The trade mark registered under No. 204951 is completely different from the respondent's Tiger Balm in English and Chinese character with the device of leaping Tiger as used in the market. The trade mark registered under No. 204951 is in respect of VIJA LABS' TIGER BALM in English and Tamil with a device of a sitting tiger. The word Tiger and the device of tiger have been disclaimed and the fourth respondent cannot claim any monopoly or exclusive right over the word Tiger and the device of tiger. The carton, label and the container used by the respondents are

not registered. The respondents are making a misrepresentation to the trade and public that their mark is registered, whereas it is not, and thereby they are committing offence u/s 81 of the Trade and Merchandise Marks Act, 1958. The respondents have minutely imitated even the literature of the appellants including the two photographs at the top solely to suggest connection with the first appellant and to mislead the traders and members of the public into believing that the respondents' products, in fact, emanate and / or originate from the first appellant. The whole conduct of the respondents is dishonest and mala fide. The first respondents has adopted the corporate name, which is misleading. The various averments contained in the plaint are specifically denied in the counter affidavit. It is also stated that the Trade Mark of the respondents is liable to be removed from the file of the Registrar.

22. In the course of hearing, the appellants filed C.M.A.No. 4433 of 1995 in O.S.A. 55 of 1995 for leave to file additional typed set of documents which could not be filed in O.A. Nos. 999 and 1000 of 1994 in spite of the exercise of due diligence and bona fide efforts. In the affidavit filed in support of the application it is stated that the respondents had filed bulky documents in support of their case after the arguments on merits had commenced in the application. The appellants having their head office at Singapore could not produce some of the material documents immediately before Court in support of their case before the Learned Single judge. By the time the documents were traced and sent to the counsel at Madras, the hearing was completed and orders were reserved. There was no deliberate intention or wanton neglect on the part of the appellants in not producing the document at the time of the filing of the suit. They could not be filed earlier due to circumstance beyond their control. The same documents had been filed in CS.No. 257 of 1995 by the appellants. They are vital for deciding the present proceedings in the proper perspective. Hence, they should be permitted to file those documents as additional evidence in the appeal.

23. The application is opposed by the respondents. According to them, no ground has been made out for filing additional evidence in the appeal. The genuineness of the documents is also disputed and, therefore, they should not be accepted in evidence.

24. Towards the close of the hearing, the respondents filed application No. 1594 of 1995 for permission to file additional documents. A counter affidavit was filed by the duly constituted Attorney of the first appellant, in which the genuineness of some of the documents filed by the respondents is disputed. It is also stated that the respondents have suppressed material and important facts with a view to mislead the Court. The deponent has referred to an inspection in the Trade Marks Registry pertaining to registered Trade mark No. 204951 and stated that the records of the Trade Marks Registry clearly falsified the contentions of the respondents as set out in paragraph 4 of the affidavit filed in support of Application No. 1594 of 1995. It is pointed out therein that the Trade Marks Registry did not accept the request of the fourth respondent to delete the

expression VJJA LABS" appearing on the registered trade mark on the ground that the same amounted to a substantial alteration of the mark. The fourth respondent was asked to show cause why the request should not be refused. It is pointed out that the additional documents sought to be produced contained an order passed by the Joint Registrar on 9-3-1995 granting the request of the fourth respondent and the conduct of the Joint Registrar is, to say the least, inexplicable in view of the earlier correspondence. We will refer to the contents of the affidavits in detail at a later stage. Suffice it for the present to refer to the rejoinder affidavit filed on behalf of the respondent by N.S.Kennedy. It is stated therein that after seeing the counter affidavit, the deponent is obliged to make further verification and for want of time at their disposal, they could not do the same. Therefore, they instructed their counsel not to press the prayer for receiving the additional documents in the application, since the same required factual investigation and verification.

In paragraph 3 it is stated as follow:-

"I submit that as we ourselves are not in a position to make immediate verification, we are not pressing our application for additional evidence. The other side is not entitled to take any document out of its context and build up an argument on the same and particularly this being an interlocutory stage. It is unnecessary to report that even assuming we have no registration still we can continue to claim the interim injunction on the basis of passing off for our plaint in C.S257 is not merely based on infringement to trade mark.

25. Both sides argued the matter at great length, as if the main suits are being tried. Each side has filed not less than 100 documents in each of the suits, though most of them are duplications. Each counsel has cited a number of authorities in support of his contention. When we pointed out that the matter is being heard only at the interlocutory stage, it was brought to our notice that almost all the important judgments on the subject have been rendered by different High Courts only at the interlocutory stage and several matter have gone to the Supreme Court also. No doubt high stakes may be involved, but yet we wish that counsel had exercised their discretion and condensed the arguments so as to enable the Court to dispose of the interlocutory applications as interlocutory matters and not prolonged the arguments unduly as if the main suits are being disposed.

26. Lest it should be said that we have omitted to consider any of the matters placed before us now we would analyse all the documents and consider the authorities cited before us. Taking the documents filed on behalf of the appellants, we find that all the documents filed earlier in CS.No. 1464 of 1994 have been filed once again in CS.No. 257 of 1995. A few more documents have been added in the later suit, but the same were sought to be filed as additional evidence in O.S.A.Nos.55 and 56 of 1995. For the sake of convenience on our request the counsel have numbered the typed sets of papers consecutively and there are as many as eight such volumes. In so far as the appellants are

concerned, we find that all the documents relied on by them find a place in Volume VII. Hence we are referring to the pages in the said volume while advertizing to those documents.

27. In pages 9 to 33 a completed list of the countries in which the appellants have registered their trade marks as well as the countries in which applications for registration are pending is given. We find that in 105 countries their marks have already been registered. In about 20 countries their applications for registration are pending, though in many of them they have already registered some marks. In India, Pakistan and a few other countries they have no registered trade mark till now and their applications are pending. Pages 34 to 88 contain copies of Certificates of Registration as well as the marks registered. It is seen that the earliest registration was in 1928 in Hongkong. Vide pages 17, 18, 76, 78 and 80. At page 77 it is stated that the trade mark found therein is to be associated with trade mark Nos. 125 of 1912, 259 of 1928, 125 and 126 of 1929. The certified copy of the original Registration Entry has been issued in 1957. In 1932 another mark was registered. Vide pages 17 and 82. Yet another mark was registered in 1961 on Hongkong.

28. In Sarawak (Borneo), Marks were registered in 1937, 1955 and 1961. (See pages 30 and 39 to 50). In Singapore marks were registered in 1940, 1948, 1958 and 1961. (See pages 30, 31 and 34 to 38). In Malawi, Marks were registered in 1948. (See page 24). In Malaya, which is now part of Malaysia, marks were registered in 1951 and 1958. (See pages 24, 25 and 52 to 58). In Japan, two marks were registered in 1995 (See pages 20). In Italy several marks were registered in 1958. (See pages 19, 20 and 61 to 75). In Jamaica (West Indies) one mark was registered in 1961. (See pages 20 and 59). In Barbados (Windward Islands) the mark was registered in 1961. (See page 10). In Brunei (Borneo) a mark was registered in 1961. (See pages 12, 87 and 88). We have not mentioned anything about the marks registered subsequent to 1961. There are several of them. We do not think it necessary to refer to all of them. We have made a reference to the above marks only for the purpose of showing that long before the respondents thought of using the trade marks with the picture of a tiger, the appellants have already registered their marks with tigers and carrying on business with those marks in several countries.

29. In all the registered marks, the essential features are same. The device of a leaping tiger, the words "TIGER BALM" and the word "TIGER" in English and Chinese characters are found. In many to them, the words "ENG AUN TONG" are also found. The appellants have been adopting different colour schemes for different countries. Two important matters have to be noted here. At page 36, the representation of the Mark registered on 2-1-1940 in Singapore is found. It is seen therefrom that in a rectangle there are as many as 64 circles, each of them containing the figure of a leaping tiger. The top two rows and the bottom two rows comprise 12 smaller circles each, whereas the middle two rows eight bigger circles each. In the bigger circles, the words "TIGER BALM" are written in each of

the rows in such a way that one letter is found below the figure of the tiger in each of the first seven circles from left to right and in the last circle, the last two letters "LM" are found. In other words, the letter "T" is found in the first circle on the left hand side, the subsequent letters are found in each of the subsequent circles and in the last circle on the right hand side the letters "LM" are found. The other matter to be noted is at page 48, the design of the bottle as well as the design of the cartons are found in the representation of the trade mark registered on 28-6-1937 in Sarawak and renewed on 28-6-1951. That shows that even as early as in 1937, the appellants had used hexagonal bottles and hexagonal cartons for their products.

30. While the appellants had registered their trade marks in so many countries in the world, the registered in China, Hong Kong, Indonesia, Japan, Malaysia, Nepal, Sarawak, Singapore and Sri Lanka assume importance. It is too well known that prior to the outbreak of the II World War, many an Indian had well established business connections in those countries and in particular had separate establishments in Burma, Rangoon, Singapore and Malaya. People from Tamil Nadu, especially Nattukottai Chettiars had vast extents of properties in Rangoon and Malaya. It will be futile for the fourth respondent to contend that the hexagonal design in the bottle and carton as well as the rectangular label containing 64 circles with the figure of leaping tiger inside each of them were born out of her own imagination and that she was the author of the said designs.

31. The next set of documents produced by the appellants are the labels and cartons with different colour schemes for different countries found in pages 109 to 123 and 263 to 270. The appellants have also produced copies of invoices, which are found in pages 90 to 108 and 258 to 262. They range between the years 1951 to 1994. In 1951 the consignment is sold to Normed Ltd., Manchester, United Kingdom and the total C.I.F. value at Southampton is 24,946.01 Singapore Dollars. (See page 92). In 1947, the sale is to a concern in Venezuela for a sum of S\$4,472.50. (See page 91). In 1971 sales are made to P.D. Maheshwari & Co. Ltd., Bombay and Calcutta for S\$66,515.60 and S\$39,960 respectively. (See pages 258 and 259) In 1980, one of the sales is to a concern in Barcelona, Spain for S\$32,900 and odd. (See page 97). In 1988, one of the sales is to a concern in Athens, Greece for U.S. \$ 26,000. (See page 90). In the same year, there are two invoices to India Tourism Development Corporation Ltd, New Delhi evidencing sales for U.S.\$ 1,359.25 and U.S. \$ 278.60 respectively. (See pages 260 and 262). No doubt, learned counsel for the respondents disputes the genuineness of the documents and contends that they should be proved by appropriate evidence. But, prima facie, there is nothing to doubt the genuineness of such old documents. At the interlocutory stage, it is the practice to accept documents filed along with affidavit. The respondents have also filed number of such documents and if regular proof is necessary, the documents filed by both sides should be completely ignored. If that procedure is adopted, it is not possible in any interlocutory application to grant relief to parties.

32. We have not referred to all the invoices in this case. We have referred to a few of them as samples to show prima facie that the appellants had world wide sales on a large scale and that the goods of the appellants were made available in this country also through an official channel apart from other private channels.

33. The next set of documents is in the shape of advertisements published by the appellants. They are found in pages 124 to 156 and 271 to 183. At pages 125 and 133, the years are mentioned as 1939 and 1934 respectively. At pages 141 and 142, we find the advertisement in "Gibraltar Chronicle" dated 8-11-1979. In pages 143 and 144, the advertisement in "The Times" dated 21-10-1988 is found. At page 145, a copy of the "Financial Times" dated 18-11-1987 containing the advertisement of the appellants is seen. Similarly, in the subsequent pages, advertisements in different magazines and newspapers published between 1979 and 1993 are found. It is stated by the appellants that many of them have large circulation in this country. At pages 157 to 164, list of International Pharmaceutical Fares at which the appellants' Tiger balm was displayed is found. At pages 158 and 160, the names of the Fares and the dates on which they were held are listed. At page 161, list of payments made for participation in Trade Fares/Exhibitions between May 1990 and November 1993 is given. At pages 163 and 164 we find monthly marketing expenditure reports for the products of the appellants.

34. The next set of documents is very important and considerable reliance is placed thereon by the appellants. It comprises the correspondence between the first appellant and respondents 3 and 4 between May 1991 and February 1993. In the pleadings, the case of the appellants is that the fourth respondent approached the first appellant through the third respondent in order to have a joint venture in this country. On the other hand, the case of the respondents is that it is the first appellant who approached the respondents in order to have such a venture. The correspondence shows that the case of the appellants is true. The first of the letters available is dated 24-5-1991 (page 288) written by George Wong, Project Manager of Tiger Balm Limited, Singapore to the fourth respondent to her address at Kuala Lumpur, Malaysia. It refers to an earlier telephonic conversation on 23-5-1991. The fourth respondent has been called upon to tender proof that she was also official owner of Tiger Balm Brand in India. She was also requested to produce audited financial statements of her factory in India including Balance Sheet and Profit and Loss statement, her proposal as to how she would like Tiger Balm Singapore (Ltd.) to co-operate with her in India and India Government's regulations regarding foreign ownership, repatriation of profits and tax regulations in India. She was also requested to visit Singapore to discuss her intentions for a mutually satisfactory business relationship in India. The next letter is against written by Tiger Balm Limited, Singapore to the fourth respondent on 13-6-1991. (page 289). It refers to a meeting on 3-6-1991 at the office of the appellant. It is stated therein that at the meeting she handed over photo copies of her trade mark in India and outlined her proposal of engaging into a joint venture business with the appellants for use

of her trade mark, inter alia as follows:-

(a) Tiger Balm Limited pay to her approximately S\$ 250,000 in consideration of goodwill for use of her trade mark and in addition,

(b) Tiger Balm Limited pay a royalty of 5% on net sales in India, for 25 years.

The letter says that notwithstanding her proposal the Company wanted to make it clear that they were the licensees of the Tiger Balm" trade marks owned or registered/pending registration throughout the world by their parent company, Haw Par Brothers International Limited, the first appellant herein. Accordingly, she was informed that her proposal was not of interest to them. The next letter is at page 290 dated 5-12-1991, written by the third respondent representing the second respondent to M/s. Tiger Balm Ltd. It refers to the earlier telephonic conversation and said that a copy of the Agreement between the second respondent and the fourth respondent was being sent along with it. An appointment was requested with the General Manager of Tiger Balm Limited, Singapore, somewhere in the second week. It refers to a previous letter dated 19-11-1991, wherein it was stated in Point No. 5, under the caption "Why we should collaborate", that Amurtanjan was losing ground very fast and the gap was filled up by other Pain Balms and it was the right opportune time. It was also said that M/s. Godrej Soaps Limited was also very keen to distribute the product nationally. It is stated that another important factor was that the profits could be repatriated to Singapore and the addresses was requested to finalise the project as a top priority. The following passage in the letter is significant:-

"I once again request you to grant me an appointment with Mr.Han and other important decision makers so that the REAL Tiger balm will be made available in India and we are very keen to start the project at any cost at the earliest." (Underlining ours).

The next letter was sent to the appellant on 11-12-1991 (page 176). Reference was made to the letter dated 19-11-1991 addressed to the Project Manager and the letter dated 5-12-1991. The following passage is found therein:-

"I request you at this stage that we join together either a participation of equity or technical collaboration with a fee, thereby we will be able to bring out REAL Tiger Balm into India or else this market is already getting invaded by spurious Tigers. "

One of the terms of the proposed agreement as suggested in the letter is that the respondents will not be exporting Tiger Balm from India and the product will be marked for Indian Consumption only. It is also stated that there are two strong brands in the country, (1) Amrutanjan restricted to South and (2) Zandu Balm of Bombay, restricted to North and that there is no All India Brand. The proposal is to start the venture by early 1992 as the respondents had already a big factory and licence and as enough damage had been caused for the Brand by spurious people emerging from different places. The appellant was requested to

treat the matter as top priority. A formal replay is sent on 16-12-1991 (page 165) that the matter will be looked into by the General Manager of Tiger Medicals Ltd., and a response will be sent in due course. The next letter is from the second respondent dated 27-12-1991 at page 166, addressed to the President and Chief Executive Officer of the first appellant. While thanking him for his quick and speedy action, the letter refers to a meeting with the General Manager, Tiger Medicals Limited, Singapore on 20th and that the details required by him were being faxed to him. On the same day another letter is addressed to the General Manager, Tiger Balm Medicals Ltd., Singapore (pages 167 and 168) stating that out of the 38 entries shown in the list found in Tiger Balm Search Report, only three names of concerns were found to be relevant for the purpose of dialogue, as others did not belong to class 5. In paragraph 2 it is stated :-

"On consultation with our Legal Experts, we understand and which you are also well aware of that you will not be a competitor in India for the product in Question. Indian Government Department for registration of Trade Mark and Copyright have not been accepting your applications for the territory of Indian Union."

In the next paragraph reference is made to another brand "Flying Tiger" and it is stated that it was in a very small way. At the end it was stated that further negotiations on both sides would be better and advantageous. On 30-12-1991, Tiger Medicals Limited wrote to the second respondent that discussion on the issue could be had in their office on 14th and 15th January, (page 291). The respondent was called upon to answer certain questions set out therein. The next letter is from Tiger Medicals Limited on 10-4-1992 to the second respondent. (page 183). On the same day, the second respondent wrote to the first appellant thanking him for giving an opportunity to meet the President (page 184). In the first paragraph, the following passage is found:-

"The meeting I had with you spelt out your Company's views clearly and I once again thank you for having an open hearted discussion with me to solve the problem, which has been existing for more than 20 years. "

In the next paragraph it is stated that the discussion of the third respondent with the fourth respondent gave rise to certain interesting points which had to be finalised with the first appellant "to start a new era in the Indian Market". Hence, he prayed for an appointment at the earliest to discuss further on the matter. An authorisation letter given by the fourth respondent to the third respondent to act on her behalf in the interest of "Tiger Balm" Brand in India was also faxed. On 16-4-1992, the second respondent writes to the first appellant (pages 181 and 182) thanking it for granting an appointment on 13-4-1992 at a short notice. The two proposals given by the appellant were mentioned therein. The first proposal is to form a Company, which will hold the Brand Name rights and manufactures of Tiger Balm" brand, in which the appellant will have 51% and Indian counter parte will have 49%. The second proposal is for the appellant to give licence to another Company with rights to manufacture "Tiger Balm" in India for a period

of 20 years, paying a licence fee, which shall be mutually agreed upon and in the manufacturing company the appellant will have 51% and the Indian Counter Part will have 49%. On the expiry of 20 years licensing period, the brand name and trade mark rights shall be relinquished to the manufacturing company. The letter proceeds to state that the fourth respondent is fully agreeable for the second proposal. The appellant was requested to take a lead from its side and see that "Tiger Balm" is manufactured and made available into the hook and corner of India in another few months. It is said:-

"As we have already lost thirty years and have to catch up against our established competitors."

35. A reply was sent on 30-4-1992 by Tiger Medicals Limited. In it, it was stated that the proposals given on 13-4-1992 were only tentative for the purpose of further exploration and discussion and that legal advice on important matters should be sought, (page 180). The second respondent faxed a letter on 27-5-1992 to the first appellant, (page .169). After stating that the fourth respondent had rejected the proposal of the appellant, it is said:-

"As I also don't see a way out of the rigid and impractical attitude of both you and Dr.Nirmala, and I having wasted my time and my Company's resources by coming to Singapore more than 7 or 8 times, it is better for me to withdraw honourably. Hence, I would like to hear from you within a weeks" time, and if I don't hear from you positively within a weeks" time, I will assume that you are not interested in the deal, and I will allow Dr. Nirmala to go on her way."

A copy of it is marked to one S.P.Khattar of M/s. Khattar Wong and Partners along with a covering letters. (page 170). A reply was sent immediately by the appellant on 29-5-1992 agreeing with the third respondent that he shall withdraw. (page 171), It was also made clear that the appellant was interested in working out a co-operative arrangement with the fourth respondent and reactivating the discussions which it had with her before the third respondent arrived on the scene. On 2-6-1992, the fourth respondent wrote to Business Development Manager of M/s.Tiger Medicals Ltd., Singapore referring to a telephonic conversation on 1-6-92. (page 173). She has mentioned that she had already entered into a "Registered Trade Mark User" agreement with the second respondent on 5-12-1991 for a period of 15 years and had given a Power of Attorney to the third respondent to handle the brand for 25 years. She also referred to the authorisation letter dated 10-4-1992. At the end she stated that all the negotiations will be handled only by the third respondent and whichever party he chooses, she will abide by it She made it clear that without him, there will be no negotiation of collaboration. 36. The third respondent thereafter forwarded two articles on the Indian Economic Liberalisation to the first appellant and informed that the product -"Tiger balm" falls under the category mentioned therein, (page 189). By a letter dated 4-12-1992, the third respondent invited the first appellant to join in its venture of starting production and marketing "Tiger Balm" in India, (page 193). The next letter is found at page 194, dated

12-2-1993. It is written to the Chairman of the first appellant by the second respondent. After referring to the earlier discussions, it is said in the second paragraph that the Brand Name will be given back to M/s.Hawpar Brothers after twenty years by the present brand owner Dr.Nirmala. The Chairman was requested to intervene to save the brand from spurious manufacturers emerging in a big way in this country and restore the negotiations. He has also informed that in the joint venture company, the day-to-day affairs will be managed by the first appellant as it is going to hold 51% of the equity. Another letter is written on the same day to the President and Chief Executive Officer of the first appellant, (page 196). The following passages are relevant :-

"I request you to once again look at our proposal, and give your positive consent so that the REAL TIGER BALM could come into India.

The existing "Flying Tiger" has almost come to the brink of the convincing the Indian Public that it is the real Tiger Balm, and also making good sales volumes, and exports too. Apart from this, many other parties are coming out with different versions of Tiger Balm. This has arisen because of the fact that the ORIGINAL TIGER BALM is not available to the Indian Public."

Again the appellant is called upon to join the second respondent so that they could give the REAL TIGER BALM to the Indian consumers. Thereafter, there appears to be no correspondence between the appellant and the respondents, what is found above shows that the respondents were fully aware of the fact that the original Tiger Balm belonged to the first appellant as well as its world-wide reputation.

37. The next set of documents relied on by the appellants comprises newspaper cuttings, which refer to the Press Interviews given by the third respondent with regard to the commencement of production of Tiger Balm. At page 223, a copy of the Report in Business standard dated 20-6-1994 is found. It is reported that the third respondent said, "the Tiger balm to be marketed in Indias will be as good as the original Singapore brand/owned by Haw Par Bros with whom Velvette held negotiations for over three years for floating a joint Venture". It is further stated that Haw Par Bros had gone to court in India, disputing the claims of the fourth respondent, but the court upheld her stand and ruled in her favour. It was after that Velvette approached Haw Par Bros for a Joint venture and even after offering to give 51% stake to the Singapore Firm, it was not offering reasonable terms. The following quotation is found therein:

"We are now going to sell the balm developed by Dr.Nirmala which is as good as the original formula. It will be sold by reviving Tiger Balm and Company which was established long ago but was not active."

At page 224, a cutting from "The Hindu" dated August 13, 1994 containing a news item that Velvette International Pharma Products has launched the internationally well-know Tiger Balm and that it will be manufactured in India by Tiger Balm Private Limited and marketed by Velvette Group. The fourth

respondent is referred to as the Indian owner of the brand since 1958. At page 225, a copy of the Indian Express dated 12-8-1994 containing the news item regarding production of Tiger Balm and the proposals to market the product in all the SAARC countries and the countries of the eastern block, is found. The third respondent is said to have claimed and the quality check carried out by the Indian Institute of Technology, Madras, had revealed that the product was as good as the one marketed by the Singapore firm. At page 226, a clipping from the Financial Express, Bombay, dated 14-8-1994 contains a similar news item referring to Tiger Balm "the popular Chinese headache cure". Referring to the first appellant, it is stated therein that Haw Par has marketing outfits in about 34 countries, while it has production bases in about four countries, Singapore, Malaysia, Philippines and Thai. Another newspaper cutting at page 227 is from Broad Equity of Economic Times dated 31-8-1994 with reference to the Madras - based Velvette International's Pharma products division launching the world renowned pain reliever, Tiger Balm, in the country. Test launched in Surat. It also refers to the tests done at IIT, Madras and the result that the product is as good as the original. Learned counsel for the respondents objects to the reference to the newspaper cuttings and contends that they have been held to be inadmissible by the Supreme Court of India. Reliance is placed on the judgment of the Supreme Court in Laxmi Raj Shetty and Another Vs. State of Tamil Nadu, and the observations found therein in paragraph 25. Learned counsel for the appellants rightly points out that the reports cannot be rejected as containing hearsay information, as they refer to the Press Interview as well as the information given by the third respondent himself to the press. It is submitted by him that the third respondent has used the newspapers as his agents for the purpose of publicity to the new product. On behalf of the appellants reliance is placed on R.S. Nayak Vs. A.R. Antulay and Another, wherein the court accepted the report in a Government publication and said that there must be an assumption that whatever is published in the Government owned paper correctly represents the actual state of affairs . relating to Governmental business until the same is successfully challenged and the real state of affairs is shown to be different from what is stated in the Government publication. In this case/the newspaper reports do not stand alone. They come soon after the negotiations between the first appellant and the respondents failed. In the light of the detailed correspondence between the parties referred to above, the truth of the contents of the newspapers is prima facie established. The learned Judge in his judgment referred in para 126 to one A. and M. Magazine and the apology said to have been tendered by it for wrong reporting. The learned Judge has said that the file copy was shown to the Court. Neither the said A. and M. Magazine nor the file copy containing the said apology has been referred to before us. There is nothing on record at present to reject the correctness of the reports found in standard newspapers which have a reputation of correct reporting particularly in view of the prior correspondence between the parties, the genuineness of which is not in dispute. We find considerable force in the arguments of learned counsel for the appellants and accept the newspaper cuttings as prima facie evidence of the

version given by the third respondent himself to the press. In the nature of things, there was no occasion for the newspapers to spread such information as contained in the cuttings on their own.

38. The next document on which reliance is placed by the appellants is the Market Survey Report on pain balms submitted by Indian Market Research Bureau, Bombay, (pages 288 to 257). According to the report, there is spontaneous awareness of Tiger Balm and more than half the people whom they contacted said that it was a foreign brand. The appellants rely on the said report to show that the product of the respondents will cause confusion in the minds of the public and they can be easily passed off as the goods of the appellants. Serious objection is taken to the Market Survey Report and it is contended that without proof, it cannot be of any use to the appellants. Learned counsel for the appellants has drawn our attention to Custom Class Boat's case 1976 RPC 589 and Lego System Aktieselskab and Anr. v. Lego N. Lemelatrigh Ltd. 1983 FSR 155 in support of his contention that the Market Survey Report is admissible in evidence and is of great evidentiary value. It is also stated that it can be taken along with other records in the case. For the purpose of these interlocutory applications, we do not think it necessary to go into that question or place any reliance on the said report as ample material is otherwise available on record.

39. Reliance is placed on the brochure found at pages 285 to 287 issued by Haw Par Brothers under the title "Har Par Villa

The Original Tiger Balm Gardens VISITORS GUIDE"

There is no dispute in this case that the original Tiger Balm is only that of the appellants. The respondents have also not disputed the fact that the appellants are having trade mark registration in several countries and a world wide market outside India.

40. The appellants have produced a book entitled "TIGER BALM KING" written by Sam king and published by Times Books International in 1992. It contains a life sketch of Aw.Boon Haw, known as the Tiger Balm King. Learned counsel for the respondents objects to the reliance on the book on the only ground that it is published only in 1992. At the same time, he places reliance on the book to contend that it shows there was no official sale in India. He has drawn our attention to a passage in page 51 that "Tiger Balm soon travelled and become famous abroad. Indian civil servants brought the ointment home for their own use as well as for profit". Learned counsel for the appellants has invited our attention to several passages in the book. Suffice it to refer to the following passages at pages 43, 137 and 138 respectively:-

At page 43: "A label identifying the product and distinguished by a springing tiger was pasted around each jar. The next stage involved rolling the jar into a folded "direction" leaflet and then wrapping it in a colourful piece of Tiger Balm wrapper. The wrapper displayed pictures of the Aw brother and carried a design finished in multicolouRs. A circular soal placed on the top and bottom of each jar

completed the packing process of each unit."

At pages 137 and 138: "After capping, the bottles were transferred to another table for labelling by another batch of forty women. This was a sticky job. The glue, prepared from rice flour, was applied with the finger, label by label and then stuck round the bottle. A "directions" leaflet, folded over six times, was then wrapped round the container. The leaflet contained indications and method of usage. It was printed in six languages Chinese, Burmese, Siamese, Malay, Tamil and English. Each jar was then completely wrapped again in colourful paper, A circular seal on each and protected the product against imitators.

Finally, the wrapped articles were packaged in packs of twelve. Aw Boon Haw sold his products only by the dozen. Each package was decorated with pictures of the two brothers, each clearly identified by his own name. With sales in the millions it was little wonder that Aw Boon Haw become the most recognized man in the Orient."

At page 138: "Within one year of its opening, the Singapore factory produced ten times as much as Rangoon ever did."

As pointed out already, the book has been published for world-wide circulation and it cannot be contended by any stretch of imagination that it has been brought out for the purpose of this case.

41. Now we shall advert to the documents produced by the respondents. Almost all of them are found in Volume V. One or two documents are found in Volume VI. Even though the respondents claim that the trade mark registered by them in 1961 was in use from 1958, no scrap of paper has been produced before us in support of the said claim. The earliest document on their side is only a Form of Contract with Imperial Chemical Industries (India) Private Ltd. by Vijaya Laboratories, (page 1-Vol.V.). The document does not contain any date, but the index to the typed set gives the date as 16-6-1961. The product is said to be Boric Acid Powder B.P. The particulars of import licence are set out therein and the contract is for a quality up to a C.L.F. value of Rs. 500/-. There is nothing on record to show that it has anything to do with Tiger Balm. Thus, the earliest document making a reference to Tiger Balm is the Registration Certificate issued by the Trade Marks Registry evidencing registration of Trade Marks No. 204951 on 25-9-1961. (page 3 of Vol. V.). The representation consists of a circle within which the figure of a tiger facing right is seen. It is quite possible to say that it is a sitting tiger or it is in a posture of readiness to leap. That does not matter very much. In the body of the tiger, the word "VIJALABS" is found. In the outer lines of the circle, the words "VIJALABS'S TIGER BALM" are found in English and Tamil. The entries representation is the registered Trade Mark. It is registered under Class 5 with the following disclaimer:-

"Registration of this Trade Mark shall give no right to the exclusive use of a device of a tiger except substantially as shown in the representation annexed hereto and of the word "Tiger".

The proprietor's name is given as Srimathi D.A.Nirmala. Pursuant to a request on Form TM33 dated 3rd April, 1963 and orders thereon dated 18th April 1963. Registered Proprietor's name is altered to D.A.Nirmala, trading as Vijaya Laboratories. The mark was removed from the Register through non-payment of renewal fees with effect from 25th September 1968. Pursuant to a request on Form T.M.18 dated 16-12-1968 and order thereon dated 17-6-1969, the mark is restored to the Register. The trading style of the registered proprietor is altered once again in 1972 to Tiger Balm and Company.

42. Some of the documents filed by the respondents are relied on to prove purchase of raw materials for making a pain balm. The earliest is the first document at page 1, which we have already referred to, being a contract to import Boric Acid Powder B.P. As pointed out already, it does not by itself prove that the material for the import of which the contract was entered was for the purpose of making tiger balm. At page 353, a list of ingredients of Tiger Balm prepared by the respondents is found. There is no mention of Boric Acid Powder in that list. The fourth respondent has purchased 120 pounds of Menthol Crystals from Madras Customs Retail Shop on 25-5-1962 for Rs. 6000/-. (Page 13). A similar purchase is made on 29-4-63 of 46 pounds of Manthol Crystals for Rs. 2,300/-. (Page 17). On 21-4-1964 76 pounds of Menthol Crystal and 50 kgs. of camphor are purchased. (Page 23). On 28-4-1964, 192 pounds of Menthol Crystal is purchased, (Page 25). All the above purchases are only in the name of the fourth respondent. There is a letter dated 28th June, 1980 from one D.V. Deo, Cochin that one case containing 3 kgs. Cinnamon leaf oil was despatched on that day and bill for Rs. 530/40 was enclosed. (Page 235). The letter is addressed to M/s. Tiger Balm and Co., The Bill is at page 237. On 27-5-1984, the fourth respondent has purchased in her individual name for Vijaya Laboratory 100 lbs. of Menthol Crystals from Madras Customs Retail Shop. (Page 275). In 1968, a licence is issued by Import Trade Control in favour of Messrs. Vijaya Laboratories for importing "natural essential oils other than banned VIDE AM 1969 RED BOOK" for approximate values of Rs. 2000/-. Licence was valid for 12 months. (Page 85). A similar Licence was issued in favour of Messrs. Tiger Balm and Company for importing permissible natural essential oils and aromatic chemicals other than banned, restricted and canalised items as per policy on 27-3-1972 for approximate value of Rs. 5000/-. (Page 135). On 31-3-1973, a licence was issued in favour of Tiger Balm and Company for importing permissible aromatic chemicals other than banned, restricted and canalised as per AM.73 Policy as well permissible natural essential oils other than banned, restricted, canalised and also excluding spearmint oil and dementholised peppermint oil for an approximate value of Rs. 5000/-. (Page 141). At page 147, a Bill of Lading issued by India Steamship Company Limited, Calcutta, is seen, but it does not bear any date. The Port of loading is shown as Liverpool and the Port of discharge is mentioned as Madras. The Company's name is mentioned as Tiger Balm and Company. The goods imported are essential oils.

43. The next set of documents relate to the agencies in different parts of the

country for the goods of the fourth respondent. They are found at pages 49, 69, 71, 77, 79, 83, 87, 91, 93, 123, 127, 137, 181, 185, 197, 207, 211, 241, 247, 251, 253, and 255. They range between 1967 and 1982. It is seen from the letters that the fourth respondent had agents in Calcutta and Tellicherry. There are some letters making enquiry regarding agency from Bombay and Mysore, but there is no record to show that agency was given to them. On the other hand, the letter at page 181 by Pragjyoti Agencies, Vijayawada addressed to M/s. Glory Agencies, Madras reads that the latter are sole selling agents for Tiger Balm throughout India. That letter is dated 4-9-1976. Probably, by that time, the fourth respondent had appointed a sole selling agent for the business. But, in 1979 the fourth respondent has written a letter to one Mr. Ganapathy, Dhruv Sales Corporation, Madras -14," terminating its agency with effect from 26-9-1979 on the ground that no transaction had been carried out by that person and the agreement dated 23-5-1977 was thereby cancelled. (Page 211). Unless further evidence is adduced on these matters, it is not possible to hold that the fourth respondent had agents throughout the country or that her produce was being sold throughout the country. The letters, however, show that the fourth respondent was doing business through some agents.

44. The next set of documents comprise orders, bills invoices and delivery notes. They range from 1966 to 1984. They are found in pages 27, 29, 31, 33, 37, 39, 41, 43, 53, 61, 63, 69, 73, 75, 77, 79, 83, 87, 91, 93, 95, 97, 99, 101, 137, 217, 219, 221, 223, 225, 227, 233, 241, 245, 247, 249, 251, 255, 261, 265, 267, 271 and 273. The quantities dealt with therein are small and there is nothing to prove the version of the respondents that the sales exceeded several lakhs of rupees.

45. The next set of documents consist of advertisements in periodicals, magazines, posters, etc., starting from 1963 and ending with 1979. It is seen that advertisements have also been made by showing slides in cinema houses for a short period. They are found at pages 15, 45, 67, 119, 121, 173, 175, 177, 179, 189, 205, and 355, to 383. From the available documents, it is not known as to what exactly was the matter advertised, excepting the documents found at pages 355 to 383. They are the advertisement materials, but they do not bear any date. In all of them, the trade mark as registered by the fourth respondent is found, which means that the product is shown as "VIJA LAB'S TIGER BALM". Some of the advertisements are in Malayalam. They also refer to "VIJA Y A LAB'S TIGER BALM".

46. The advertisements at pages 363 and 379 show Glory Agencies as the Distributors and it is stated that stockists and agents are required for all places. It is only at pages 369 and 383, one hexagonal shaped bottle and two hexagonal shaped cartons are shown, the word TIGER" being on the right side and the word "BALM" being on the right side. At the bottom, the words "REGISTERED TRADE MARK" are found, obviously giving an impression to any reader that the design found therein is a registered trade mark. That is undoubtedly a wrong representation. At page 371, one Magesh Enterprises, Pondicherry is shown as

distributors for Pondicherry State and South Arcot District. The name of the manufacturers is shown as Tiger Balm and Company. At pages 373 and 374, the manufacturer's name is mentioned as Tiger Balm and Company and the Dollor Agencies, Dindigul is shown as stockist. There is no record to prove any advertisement by the fourth respondent after 1979.

47. The next set of documents proves the opening of current account with the Excise Department by M/s. Tiger Balm and Company and payment of excise duty. The first of such documents is at page 111. It is a communication from the office of the Superintendent of Central Excise, Guindy, dated 16-9-1971 granting permission to open account current with the Collector of Central Excise. The name of the manufacturer is mentioned as M/s. Tiger Balm and Company. The name of the commodity is shown to be Tiger Balm 20 gm. The price inclusive of excise duty is Rs. 22.80 and exclusively of excise duty is Rs. 21.36. The assessable amount is shown to be Rs. 19.22. The fourth respondent is shown as the Proprietrix of the said concern. (Page 113). At page 117, a challan for payment of Rs. 250/- towards excise duty by the fourth respondent is found. It is dated 19-8-1975. At page 161, the determination of the fourth respondent in Form 5 for determination of value u/s 4 of the Central Excise Act is seen. It refers to Tiger Balm in glass bottles, in Polythene bottles and samples in tins at different prices. That bears the date 1-11-1975. At page 163, a Declaration in Form is given by the fourth respondent, which refers to Tiger Balm 1 x 1 g. tins". That bears the date 19-11-1975. At page 165, there is a communication from the Superintendent, Central Excise to M/s. Tiger Balm and Company calling upon them to explain" why Gate Pass No. 1 has not been sent to the office and also pointing out that the opening balance for the month of August 1975 was shown as 5405 bottles, whereas the closing balance for the month of July 1975 was shown as 5650 bottles. At page 167 there is an application by the fourth respondent for payment of duty in accordance with the provisions of Chapter VII of the Central Excise Rules. The installed capacity in terms of the value and the quantity of excisable goods is mentioned as 150 kg. and Rs. 25,680/- respectively. At page 195, a challan for payment of Rs. 60/- by way of excise duty bearing date 24-12-1977 is found. At page 199, a declaration for determination of value u/s 4 of the Central Excise and Salt Act, bearing date 6-4-1978, refers to Tiger Balm in Glass Bottles of 20g., Tiger Balm in Glass Bottles of 6g., and Tiger Balm sample in Tins of 1g. At page 201, a communication from the Superintendent of Central Excise dated 22-6-1978 refers to the acceptance of the declaration filed by M/s. Tiger Balm and Company with date. "At page 215, a challan payment of Rs. 130/- by way of excise duty is found. The date is not legible. At page 239, a declaration dated 15-4-1982 is given by the fourth respondent. It refers to the Tiger Balm of 20G and Tiger Balm of 6G. The value of the quantity of the goods cleared during the preceding financial years 1981-82 is shown to be Rs. 7338.35 for 4490 numbers of bottles. The estimated value of the quantity of goods for the financial year 1982-83 is stated to be Rs. 45,000/- for 27,000 numbers of bottles. There is no subsequent

document, relating to Central Excise.

48. Another set of documents relates to sales tax. They are found at pages 81, 143, 187, 229, 231, 243, 277 and 279. They range from 1968 to 1985. The documents at pages 143 and 229 evidence payment of Rs. 10/- by way of tax on 30-4-1973 and 3-5-1980 respectively. The documents at page 277 and 279 are notices of final assessment and refund orders. It is seen that a sum of Rs. 40/- paid in excess by the assessee will be adjusted towards surcharge due for the previous years and a sum of Rs. 2/- paid already in excess of the surcharges will be adjusted towards arrears. The notice clearly refers to the discontinuance of the business and the final assessment made for the year ending 31st March, 1985. It is rightly contended by learned counsel for the appellants that these two documents prove that the fourth respondent was not carrying on any business after 1984. Though it is contended that the business has been continued without stoppage till the filing of the suits, no record has been produced to show the conduct of business after 1984. All the documents refer to above stop with 1984 or prior thereto. There is no explanation for non-production of any document after 1984 to show the continuation of the business.

49. There is one other set of documents comprising Certificates of Analysis issued by Industrial Testing and Analytical Laboratories as well as the Madras Industrial Co-operative Analytical Laboratory Limited. At pages 107 and 109 the Certificates issued by the Industrial Testing and Analytical Laboratories on 29-7-1971 and 7-9-1971 are found. At page 139, an invoice for charges for issue of Methods on Tiger Balm and Raw Materials for Rs. 10/- dated 10-3-1973 issued by Industrial Testing and Analytical Laboratories is found. At page 171, 193, 203, 209 and 237, the Certificates issued by the Madras Industrial Co-operative Analytical Laboratory Ltd., bearing dates 23-4-1976, 17-11-1977, 10-7-1978, 1-8-1979 and 13-7-1982 respectively are found. The document at page 259 is only a covering letter bearing dates 29-7-1982 for the last of the certificates. Those document do not also help the respondents to prove the conduct of business after 1984.

50. Significantly, the fourth respondent, who claims that she was doing business for several lakhs of rupees, has not produced even a single account book: nor has any balance sheet or profit and loss statement been produced. Instead of filling so many documents, she could have well produced the balance sheets certified by an Auditor. No doubt, she may be producing them in the course of the trial. But, for the purpose of deciding a prima facie case at this stage, it can be stated without any fear of contradiction that there is no record to prove the conduct of business by the fourth respondent in any name after 1984. It should also be noted that in none of the pleadings filed by the fourth respondent, the sales figures are mentioned.

51. We have already referred to the long correspondence between the first appellant and respondents 2 to 4. After the negotiations between them failed, the first respondent company has been formed and the Certificate of

Incorporation found at page 337 shows that it was incorporated on 1-3-1993. It is, therefore, rightly contended that the first respondent could not have carried on any business prior to 1-3-1993. Nor could respondents 2 and 3 have done so. The affidavit filed by the fourth respondent on 23-6-1994 in support of the application to register the first respondent as a registered user of the Registered Trade Mark No. 204951 found at pages 339 and 341 refers to an agreement of even date between the fourth respondent and the first respondent for the purpose of making the latter a registered user. In paragraph 4 of the affidavit, the fourth respondent claims to have entered into the agreement as the registered proprietrix of Tiger Balm and Co. Admittedly, the matter is pending with the Central Government and the first respondent is yet to be recognised as the Registered User. The first respondent has obtained licence from the Drug Control Authorities on 13-7-1994 to be in force from 1-3-1993 to 31-12-1994 for manufacturing Ayurvedic (including Siddha) drugs in the premises mentioned therein. (Page 343).

52. One significant factor has to be taken note of at this stage, the respondents have produced the earlier licences under the Drug Control Rules. It appears that initially a claim was made by the fourth respondent or M/s. Vijaya Laboratories that Tiger Balm was being prepared in accordance with Unani System of medicines. The letters from Assistant State Drugs Controller dated 28-3-1964, 28-3-1964 and 1-4-1964 found at pages 19, 47 and 21 respectively informed M/s. Vijaya Laboratories that no licence was required under Drugs Act, 1940 for the manufacture of the product "Tiger Balm", if it was exclusively used or prepared for use in accordance with Unani Systems of Medicine and consequently their manufacturing licence in Form No. 25 bearing No. 8/62 dated 1-9-1962 surrendered along with their letter dated 27-2-1964 was treated and cancelled as requested by them. But the documents at pages 263, 281 and 335 are licence for the periods 1-1-1983 to 31-12-1984, 13-5-1986 to 31-12-1987 and 22-12-1992 to 31-12-1993, The first two are issued to the fourth respondent as the proprietrix of M/s. Tiger Balm and Company while the last one was issued to the fourth respondent and the third respondent jointly as partners of M/s. Tiger Balm and Company. Obviously, it cannot be true as the fourth respondent has stated categorically in her affidavit dated 23-6-1994 referred to already, that she is the proprietrix of Tiger Balm and Co., even on that date. Further, there is no pleading by the respondents at any stage that Tiger Balm and Company was a partnership firm in which the third respondent was a partner.

53. There is no pleading that Tiger Balm was prepared in accordance with Unani System of medicine at any time. On the other hand, the express pleading is that it is prepared in accordance with Siddha system. The document at page 353 setting out the ingredients of Tiger Balm also refers to them as Siddha medicines. Though licences would appear to have been obtained for periods subsequent to 1984 under the Drugs Rules as aforesaid, there is no other record to show that business was carried on as such. Nor is there any record to prove the use of the trade mark during that period for the purpose of business.

54. At this stage it is necessary to point out that the learned single Judge while disposing of O.A.Nos. 999 and 1000 of 1994 has not chosen to analyse the documents produced by the respondents, but taken for granted that they proved the case of the respondents to the hilt. In paragraph 128 of his order, the learned Judge refers to the documents which are made available to him from pages 1 to 367 of the second typed set of documents filed by the defendants and observes that his attention was drawn to each and every document at the time of hearing. At the end of the paragraph he observes that those documents will clearly prove that the fourth respondent's registered trade mark was already in the business line and she had been trading in the name of Tiger Balm and Company and manufacturing medicinal balm popularly known as Tiger Balm. In the next paragraph reference is made to the registered user's agreement between the fourth respondent and the first respondent dated 23-6-1994 and it is held that the first respondent represented by the third respondent is entitled to use the trade mark in respect of the said goods as per the terms and conditions of the agreement. Unfortunately, the learned Judge has failed to take note of the fact that permission has not been granted by the; authorities to the first respondent to use the registered trade mark as registered user thereof. It is rightly pointed out by learned counsel for the appellants that as on date, respondents 1 to 3 cannot claim any right whatever to the registered trade mark bearing No. 20451. The fourth respondent is the proprietrix of the said mark and according to the present entries in the register, her trading style is Tiger Balm and Company".

55. There is a peculiar feature on this aspect of the matter, which is somewhat disturbing. The learned Judge has referred to the registered user agreement dated 23-6-1994. Neither the original agreement nor a copy thereof is found among the records. Nor has it been filed before us. In paragraph 19 of the judgment the learned Judge has said that "Though at the time of argument the agreement between respondents 2 and 4 was not produced, the same was produced at the time of subsequent hearing". (Underlining ours). We do not find anything on record to show that there was a hearing subsequent to the closure of arguments. The learned Judge has not mentioned the date of such bearing, if any. According to learned counsel for the appellants, they are not aware of any hearing after the conclusion of the arguments by counsel or the filing of any document in Court after conclusion of arguments. We are at a loss to understand as to what exactly the learned Judge means by saying that the agreement was produced at the time of subsequent bearing. As stated already, the agreement is not found among the records and not made available to us. What all we find on record is only at page 339 of Volume V, the affidavit filed by the fourth respondent in the Registered of Trade Marks. We have referred to the contents of the affidavit in detail earlier. The affidavit makes a reference to registered user agreement entered on that date, i.e., 23-6-1994. But the document as such has not been produced. Learned counsel for the appellants also pointed out that the registered user agreement has not been filed in the Court. There is no demur to the said statement by learned counsel for the respondents. In the Judgement,

the learned Judge has placed strong reliance on the said registered user agreement. The conclusion of the learned Judge based on the said agreement cannot; in the circumstances, be accepted.

56. Having thus analysed the entire documentary evidence on both sides, it is relevant to mention one of the contentions repeatedly pressed into service by learned counsel for the appellants. According to him, the respondents are guilty of not only making false statements in the pleadings, but also suppressing certain relevant facts. It is submitted by him that the plaint in CS.No. 257 of 1995 proceeds as if the word "Tiger" and the words "Tiger Balm" have been registered as Trade Marks and have become distinctive as such. Our attention is drawn to the passages in paragraphs 5, 6, 13, 14, and 16 of the plaint in the said suit, wherein reference is made to the word "Tiger" and the words "Tiger Balm" as if they are registered marks. It is also pointed out by him that the respondents have not disclosed in their pleading the disclaimer entered in the register with reference to the word "Tiger" and the device of tiger. The plaint in CS.No. 257 of 1995 has not also disclosed the fact that the validity of the design registered by the fourth respondent under the Patents Act had already expired in 1988. It is further pointed out that the respondents have been making misrepresentations to the public as if the word "Tiger" and the words "Tiger Balm" "have been registered as trade marks. These contentions are well-founded. We have already referred to the fact that in the earlier years, the fourth respondent had been truthfully using the registered trade mark consisting of the device of a circle with a tiger inside and the words "VIJA LABS" on the body of the tiger with the words "VIJA LAB'S TIGER BALM " in English and Tamil in the outer rings of the circle. In course of time, she became bold to use the words "TIGER BALM" without the words "VIJA LAB'S" and represented to the public that it was a registered trade mark. We have also referred to her showing the device of hexagonal bottles and cartons as if they were registered marks. No doubt she had registered the hexagonal design under the Patents and Designs Act in 1975. But we have already indicated that she cannot claim any originality in the said design. It is quite obvious that she copied it from the products of the first appellant which was freely available till the II World War and thereafter through restricted sources. In any event, the registration of the design has ceased to be in force from 1988 as per the provisions of Section 47 of the Patents and Designs Act. The fourth respondent cannot claim any right thereto as against the appellants.

57. After the respondents joined together and pitched upon the idea of doing business jointly under the name and style of "Tiger Balm Company Private Limited", the respondents have started copying slavishly the appellants' trade marks, designs, labels, cartons and even the literature. A comparison of Annexures "A" to "D" in the plaint with Annexures "E" to "H" shows that indeed by the respondents have copied the appellants' marks labels etc. Apart from using the device of a leaping tiger, the respondents have started using the Chinese character for the word "Tiger" just above the figure of the tiger. We have already

referred to the contents of the trade mark registered in No. 204951 of the fourth respondent. There, the tiger is facing to the right. In other words, it can be said that the face of the tiger is on the right side and the tail is on the left side. The words "TIGER BALM" do not find a place inside the circle. But, in Annexure "E", "F" and "H", which the respondents have started using now, the tiger is facing to the left i.e., its face is on the left and the tail is on the right. Above the figure of the tiger, the Chinese character for the word Tiger" is found. Below the figure of the tiger, it is printed as "Trade Mark No. 204951". Below that, the words "TIGER BALM" are printed. It is in a rectangular shape and on the left border, the words "TIGER BALM" are found in Chinese characters and on the right border it is in Devnagari script. There is no explanation as to way the respondents have changed the trade mark on their own and started using a mark which is entirely different from the registered one. Further, there is no explanation as to why the fourth respondent chose the word "TIGER BALM" in 1961.

58. The position of the literature which is usually kept inside the carton, is much worse. At pages 7 and 8 of Volume VII, two literatures are found. In the literature of the appellants at the top, the photos of the two brothers Aw Boon Par and Aw Boon Haw are found. Below each photograph the figures of leopard and tiger are found as if the photograph rests on the backs of the two animals which are sitting side by side. On both sides, matters are found in Chinese characters. Below that, the Trade Mark of the appellants with the tiger inside the circle is printed, on one side in English and on the other side in four different languages including Chinese, Japanese and Tamil. The respondents, who have copied the said literature word for word, have similarly printed the photographs of a men and a women at the top, probably those of respondents 3 and 4. Below the photographs, We find a leopard on the one side and the tiger on the other side. At either side of the photographs, the word Tiger" in Chinese character is printed. Below that a design exactly similar at that of the appellants is printed as if that is the registered trade mark carrying No. 204951 of the respondents. The instructions are found in six languages, on one side in English and Chinese characters and on the other side Urdu, Devanagari, Tamil and Telugu. In order that the matter can be easily appreciated, we have annexed the Xerox copies of the literature of both parties to this judgment and marked the same as Annexures "A" and "B". There is no earthly reason as to why the respondents are adopting Chinese characters or print instructions in Chinese language. The only possible reason is that the respondents are desirous of passing off their goods as those of the appellants.

59. As is evident from the correspondence between the first appellant and respondents 3 and 4 the Tiger Balm of the appellants is the original and real one and it has acquired a world-wide reputation. After having failed in the negotiations to commence a joint venture, with the first appellant, the respondents have thought of marketing their goods as if they are of the appellants. Even an educated parson who reads the contents of the literature issued by the respondent, as well as the contents of the lables etc., will get an

impression that the product is that of the first appellant.

60. At this stage it is also relevant to take note of the attempt made by the respondents in surreptitiously getting the registered trade mark altered, while this hearing was in progress and also filed an affidavit in this Court with false averments. We have earlier referred to Application No. 1594 of 1995 filed by the plaintiff's CS. No. 257 of 1995. The application is for permission to file additional documents contained in the additional type set filed along with it. The typed set contains 11 documents. Along with it, five documents viz., carton used by the plaintiff in 1971, cinematographic slide, positive of the cinematographic slide, photograph of exhibition stall and another photograph of exhibition stall are also filed. In support of the application one N.S. Kennedy has filed an affidavit. Though it is an individual, the first paragraph states that he is the petitioner in the application. There are two petitioners in the application, one being the fourth respondent Dr. D. A. Nirmala the first plaintiff and the other being Tiger Balm Company Private Limited represented by its Managing Director N. S. Kennedy. Ignoring the said error in the first paragraph, we find that in paragraph 4 it is stated that several records of the first plaintiff were damaged during the floods and the same could not be retrieved. The year of the floods is not mentioned. It is further stated that after scrutiny of certain files, record of application pertaining to T.M. 38 were traced and the said Form TM 38 was filed by the first plaintiff as early as 1972 to alter the trade mark, but since the papers could not be traced from the Registry, order was not passed. It is then said:-

"I submit that I had confirmed with the registry, and on application under TM 38 the necessary changes were effected in the entry in the register."

This was the affidavit filed on 21-3-1995. The Constituted Attorney of the first appellant filed a counter affidavit denying the genuineness of the documents produced with application and stated that they were conducted for the purpose of the suit. With reference to the averments in paragraph 4 about the floods and the damage caused thereby are denied. It is then averred that the plaintiff's have suppressed material and important facts with a view to mislead this Court. The deponent refers to inspection in the Trade Marks Registry taken by him and his finding that the records of the Registry clearly falsified the contents of paragraph 4 of the affidavit filed in support of the application. It is stated that on 19-10-1972 the fourth respondent filed an application No. TM 38 seeking to alter the trade mark by deleting the words "Vijalabs" therefrom and paid the prescribed fee of Rs. 100/- thereon. The Examiner of Trade Marks by his letter No. "PR/349 dated 15-11-1972 informed her to forward 16 amended, printed labels of the mark at an early date. Thereafter by his letter PR/4322 dated 20th January, 1973 the Examiner of Trade Marks asked the fourth respondent whether she desired to delete the expression "TRADE MARK" appearing on the label. The fourth respondent by her reply letter dated 6th February, 1973 stated that in the amended representation sheets of the Trade Mark as sent along with her letter dated 20-11-1972, the expression "TRADE MARK" did not appear and therefore,

the question of deletion did not arise. The Examiner of Trade Marks by his letter dated 19-4-1973 reiterated that the expression "TRADE MARK" appeared in the original and did not appear in the amended mark and requested her to confirm whether she conferred that the said expression be deleted. By letter dated 4th May, 1973, the fourth respondent confirmed that the expression "TRADE MARK" had been deleted from the original mark. The Examiner by his letter No. PR/114 dated 28th June 1973 replied to the fourth respondent's letter and stated that he was directed by the Registrar of Trade Marks to inform her that the deletion of the expression "VIJALAB"S" from the mark amounts to substantial alteration and that she should show cause why the request on Form TM38 should not be refused. The fourth respondent by her letter dated 27-7-1973 which was received by the Trade marks Registry on 31-7-1973, replied that she had filed a request on Form TM-35 on 27-7-1973 for amending her trading style to Tiger Balm and Company. She said that by a letter No. PR/4269 dated 27-2-1971 it was the Registry which had directed her to file a request on Form TM-35 along with a fee of Rs. 100/- for deletion of the expression "VIJA LAB"S" appearing on the mark and that accordingly on 19-10-1972 she filed Form TM-35 with a fee of Rs. 100/-, She also stated that she was unable to comprehend" the Registrar's actions, and she did not mind the mark remaining in the Register without any alteration, but she demanded the return of the fees collected. By another letter dated 7-11-1973 the fourth respondent requested the Registrar to refund the sum of Rs. 100/- paid by her in requested in Form TM-38. The Examiner by his letter No. PR/3742 dated 20-1-1974 replied that her request has been considered and the fee could not be refunded. The fourth respondent wrote on 11-3-1974 to the Registrar and reiterated her request for refund of the fee. The Registrar by his letter dated 6-4-1974 informed her that the fee could be refunded in due course. He also cautioned her that only the mark as registered earlier should be described as Trade Mark. Eventually, on 29-4-1974 the Assistant Registrar of Trade Marks passed refund order No. MAS 2/1974-75 sanctioning the refund of Rs. 100/- paid by the fourth respondent for alteration for the trade mark. Thus, the correspondence shows that the statement contained in paragraph 4 of the affidavit filed in support of the application is false to the knowledge of the deponent and the application are guilty of making false statements with a view to mislead this Court. When the matter came up for hearing, learned counsel for the appellants expressed his desire to cross-examine the deponent viz., N.S.Kennedy on his affidavit filed in support of the application. Learned senior counsel for the respondents represented that the application was not pressed. However, learned counsel for the appellants submitted that even if the affidavit is withdrawn, the deponent cannot escape cross-examination and cited" the ruling in *In re Quartz Hill and c, Company Ex parte Young* (21 Chancery Division 642). Learned counsel for the respondents said that an affidavit will be filed by his client and accordingly, a rejoinder affidavit was filed on 31-3-1995 in which it is stated that the event happened more than 23 years back and the fourth respondent is not able to offer any comment at this point of time without further probing into the matter and as the

applicants are not in a position to make immediate verification they are not pressing the application for additional evidence. It is further stated that the other side is not entitled to take any document out of its context and build up an argument on the same and particularly this being an interlocutory stage. It is further added that it is unnecessary to repeat that even assuming that the applicants have no registration, still they can continue to claim the interim injunction on the basis of passing off as the plaint in G.S.No. 257 of 1995 is not merely based on infringement to trade mark.

61. The above facts prove that the plaintiff in CS.No. 257 of 1995 do not care to place the truth before Court. They have chosen to treat the Court with scant respect, as if they are playing a game of chance. This conduct of the respondents is sufficient to reject their prayer for the equitable relief of injunction pending suit.

62. Though the application for filing additional documents is withdrawn by the applicants, learned Counsel for the appellants has stated that the documents found in pages 84 to 86 being items 6 to 8 in the typed set of papers filed by the applicants, can be looked into by the Court, as he has no objection thereto. The first of them is a letter dated 27-12-1971 from the Examiner of Trade Marks to M/s.Tiger Balm and Company calling upon them to file a request on Form TM-35 to delete the expression "Vijalabs" appearing on the mark. The next document is a letter from the fourth respondent to the Registrar of Trade Marks dated 19-10-1972 stating that the prescribed fee of Rs. 100/- was enclosed. The third document is Form TM-35 from the fourth respondent to the Registrar of Trade Marks to delete the words "VIJALABS" appearing in Tamil and English from the circular border of trade mark and appearing in English from the stomach of the Tiger device. The additional documents sought to be filed on the footing that the trade mark has since been altered by the Registry discloses the attempt made by the respondents during the course of the hearing to get an order surreptitiously from the Registrar of Trade Marks. A perusal of the facts stated in the counter affidavit filed by the Duly Constituted Power Agent of the appellants shows that the Registrar had earlier informed the fourth respondent that the alteration would be substantial and a fresh advertisement should be made in the Journal before the same was granted.

63. The other document on which reliance is placed by the respondents comprise the proceedings before the Registry of Trade Marks initiated by the appellants for rectification of the Registered Mark of the fourth respondent and for registering the first appellant's trade mark in this country. At page 1 of Volume VIII of the Typed Papers, a copy of the application filed by Haw Par Brothers Limited under Sections 46, 47(4) and 56 of the Trade Marks Act and Rules 94 of the Trade Marks Rules, dated 28-8-1967 is found. They sought for rectification of the registered trade mark of the fourth respondent on the ground that registration was mala fide and the fourth respondent had not been continuously using the mark with any bona fide intention up to a date one month before the date of the

application. The statement of the Case is found at pages 3 to 5 of the same Volume. The application was disposed by an order of the Assistant Registrar of Trade Marks on 6-5-1969 that it was deemed to be abandoned. It is found at page 89 of Volume V. It is stated therein that the applicant failed to file evidence in support of the application for rectification and, therefore, it must be deemed to be abandoned. It is brought to our notice that a fresh application has been filed for rectification by the first appellant on 2-6-1994 before the registrar of Trade Marks. A copy of the application is found at pages 199 to 202 of Volume VII. The statement of case is found at pages 203 to 212. The application is said to be pending. Reliance is placed on the contents of the said application and the statement of the case by learned counsel for the respondents in support of his contention that the appellants are seeking to infringes the registered trade mark of the respondents. According to him, the appellants have admitted in the said proceedings that the mark registered by the fourth respondent is identical and deceptively similar with the mark of the first appellant.

64. The first appellant filed Application No. 306622 on 1-7-1975 and Application No. 316936 on 20-7-1976 for registering two trade marks. Applications are filed in 1985, 1989 and 1991. In the first two applications of 1975 and 1976, oppositions were filed by one Rangoon Chemical Works Private Limited in Opposition No. CAL 1761 and CAL 1694. The fourth respondent also filed oppositions in CAL Nos. 1698 and 1758. By order dated 21-12 1988, the Deputy Registrar of Trade Marks allowed the oppositions and dismissed the applications of the first appellant. The copies of the orders are found at pages 285, 287 and 289 to 313 of Vol. V. Consequent thereto/ the oppositions filed by the fourth respondent were declared abated by orders dated 3-4-1989. The first appellant was, however, directed to pay costs to the fourth respondent. The first appellant has preferred appeals in the Calcutta High Court against the order of the Deputy Registrar. The respondents contended that they have not received any notice will now in appeals and the claim that the appeals are pending is false. The appellants have pointed out that in the appeals before the Calcutta High Court, the respondents are not made parties as those appeals are against the orders passed in the proceedings initiated by Rangoon Chemical Works. Inasmuch as the oppositions of the fourth respondent were disposed as abated, there was no need to file any appeal against the said orderRs. It is also stated by the appellants' counsel that if the appeals of the appellants are allowed by the Calcutta High Court, necessarily the proceedings between the appellants and the respondents will to revived before the Deputy Registrar, As the pendency of the appeals in the Calcutta High Court is disputed, the Duly Constituted Attorney of the first appellant had filed an affidavit dated 31-3-1995 stating categorically that the first appellant has filed appeals in the Calcutta High Court against the orders of the Deputy Registrar of Trade Marks and they are pending as A.S.No. 194 of 1989 against CAL 1694 and A.S.No. 195 of 1989 against CAL 1761. There is no reason to reject the statement contained in the said affidavit. We will proceed in this case on the footing that the appeal is pending in the Calcutta

High Court and the orders of the Deputy Registrar rejecting the application for registration filed by the appellants have not become final. Hence, the respondent cannot place any reliance on the observations made by the Deputy Registrar in those proceedings at this stage.

65. The learned Judge in his order dated 18-1-1995 has also held that the balance of convenience is in favour of the respondents. For arriving at that conclusion, the learned Judge has said that the product of the appellants has never been available in the Indian market at any point of time and on the other hand, the respondents have been carrying on business ever since the mark was registered in 1961 till date of suit. The learned Judge has also referred to the affidavit of the Managing Director of the first respondent that the respondents are incurring a loss of Rs. 5,00,000/- every week because of the interim injunction granted in favour of the appellants. The learned Judge has also observed that the respondents were asked to alter the status qua prevailing for over 35 years and the first respondent company is small when compared to the appellants' company. He has stated that if injunction is granted, the loss cannot be compensated in terms of money, but the appellants can be compensated by keeping account.

We are unable to accept any of the aforesaid reasons. In the first place, the learned Judge has overlooked that though the appellants had not commenced their business in India, their goods were available in India market through the sources already pointed out. Respondents 1 to 3 have come on the scene only after June 1994 and in fact, their business commenced only in August 1994. The suit of the appellants has been filed on 3-10-1994. There is no question of any status qua prevailing for over 35 years with reference to all the respondents. The fourth respondent was carrying on business as sole proprietrix of Vijaya Labs in the beginning and Tiger Balm and Company later. The name Tiger Balm and Company was obviously chosen by her to create an impression that she had business connections with Tiger Balm Company at Singapore of the first appellant. We have already referred to the letter dated 24-5-1991 written by Tiger Balm Limited, Singapore, to the fourth respondent at her address in Kuala Lumpur, Malaysia. That proves that she used to stay in Malaysia or at least that she had business connections in Malaysia. She cannot plead that she was totally unaware of the existence of the Tiger Balm Company, Singapore, or the product of the first appellant bearing the name of Tiger Balm. There is good reason to hold that she had no bona fides in adopting the name "Tiger Balm Company" and changing her trading style in 1972.

66. The way in which the labels, cartons, designs and literature of the first appellant had been copied by the respondents shows that the fourth respondent as well as the third respondent were quite aware of every part of such labels, cartons etc., and practically reproduced them in the name of the first respondent, as if they have discovered them. For example, in paragraph 29 we have referred to a label containing 64 circles in each of which the figure of leaping tiger is

found and the name TIGER BALM" is written in such a way that one letter is found below the figure of Tiger in each of the first even circles and the last two letters "LM" are found in the last circle on the right extreme. The respondents have not spared that label also and copied the same to every inch of it.

67. Further, in there is no scrap of paper to show that the first respondent company is incurring loss of Rs. 5,00,000/- every week. No record has been produced before the Court to show the turnover or profits of the first respondent company. The version cannot be true as the business was commenced only in August 1994. We have already referred to the various documents filed by the respondents and found that the business carried on by the fourth respondent from 1961 to 1984 was only in a small way and all the transactions evidenced by the documents were only for small amounts. She stopped it in 1984 probably because she could not earn any profit. We are unable to accept the argument that the appellants are giants and if they are allowed to do business in this country with the trade mark "Tiger Balm", the business of the respondents will perish. We cannot permit passing off or piracy of intellectual property rights to continue just because the culprit is a small trader. In the circumstances, the finding of the learned Judge that the balance of convenience is in favour of the respondents is unsustainable.

68. We have thus surveyed the entire documentary evidence on record. Our prima facie findings on the facts at this interlocutory stage are as follows:-

(1) The first appellant has been selling its product "Tiger Balm" for several decades by now and it has acquired a world wide reputation including India.

(2). The first appellants' trade mark Tiger Balm" has already been registered in 105 countries and application for registration are pending in some countries including India.

(3). The first appellant's product has been available in this country through official and non - official sources.

(4). The fourth respondent's registered trade mark comprises the figure of a tiger facing right inside a circle with the word "VIJALABS" on its body and the words "VIJALAB'S TIGER BALM" in English and Tamil in the outer ring of the circle as found in page 9 of volume V. The expression Trade mark" is found inside the circle beneath the tiger.

(5) There is no evidence as to when exactly the fourth respondent started using trade marks other than the registered one.

(6). There is no doubt that the other trade marks used by the fourth respondent as found in pages 369 and 383 of VO1.V were copied from the mark of the first appellant.

(7). The design of hexagonal bottle was copied by the fourth respondent from that of the 1st appellant and the registration of the same expired in 1988.

(8). The fourth respondent was changing her trading style from time to time and in 1973 adopted the style Tiger Balm and Company.

(9). The fourth respondent stopped her business in 1984. There was no business between 1984 and 1994.

(10). The new business by respondents 1 to 4 is started in August 1994 only. Hence the appellants are not guilty of delay and laches.

(11). It is obvious from the designs, labels, cartons etc., used by the respondents that they have copied them slavishly from those of the appellants with a view to pass off their goods as those of the first appellant.

(12). Respondents 1 to 3 have no right whatever over the registered trade mark No. 204951 owned by the fourth respondent.

(13). The appellants are not guilty of *suppressio veri* and *sitggestic falsi* and on the other hand the respondents are not only guilty of making false representation to the public with reference to their trade mark but also making false statements in the pleadings in these cases.

(14). The appellants are not guilty of passing off or attempting to pass off their goods as those of the respondents.

(15). The balance of convenience is only in favour of the appellants.

69. We are fully aware that we are disposing of only interlocutory applications. The parties have in this case chosen to file so many documents in support of their respective contentions that we have been obliged to go through them at length. We cannot decide a *prima facie* case merely by the numerical strength of the documents. When the parties have invited us to peruse these documents and express our opinion for the purpose of granting interlocutory reliefs, necessarily we have to analyse them and say what we find therein. On the materials now placed before us, our *prima facie* findings on the merits of the case are set out above. Those findings will not prevent the Parties from adducing more evidence at the trial or stand in the way of the Court deciding the case independently on the basis of such evidence completely ignoring our present findings. We are also aware that normally the order of trial Judge in an interlocutory application will not and should not be disturbed by the appellate Bench. But, we have said enough already to show how the order of the learned single Judge dated 18-1-1995 is vitiated necessitating a different view on the facts.

70. Now we shall advert to the questions of law argued at length before us by both sides. The following are broadly the questions which arise for consideration:-

(A) Whether the registration of Trade Mark No. 204951 disentitles the appellants to any relief on the basis of passing off?

(B) Whether the appellants are entitled to get any relief without actually doing any business in India?

(C) Whether the orders passed in the proceedings for rectification of trade mark No. 204951 and for registration of first appellant's trade mark preclude the appellants from getting relief in C.S.No. 1464 of 1994 and from resisting C.S.257 of 1995?

(D) What is the effect of disclaimer of the fourth respondent at the time of registration of Trade Mark No. 204951?

71. Before taking up the aforesaid questions for consideration, we shall advert to certain well-settled general principles to be followed in an action for passing off and in an action for infringement at the interlocutory stage. In Kerly's Law of Trade Marks and Trade Names"- Supplement - pages 42 and 43, paragraph 16-02 the Law is stated thus:-

"The law of passing-off can be summarised in one short general proposition-no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number.

Firstly, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying "get-up"(whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services.

Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to belief that the goods or services offered by him are the goods or services of the plaintiff

Thirdly, he must demonstrate that he suffers or, in a Quick time action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or service is the same as the source of those offered by the plaintiff....."

72. In Parker-Knoll Ltd. v. Knoll Internationals Ltd, 1962 RFC 265, the House of Lords held that trading must not only be honest but must not even unintentionally be unfair. The Court also observe that the law of passing off is no different with respect to unintentional misrepresentation from the law in any other action based on misrepresentation and that if a true statement conveys a falsehood to the public, it is a misrepresentation.

73. In Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, , the Court said that an action for passing off is a common Law remedy going in substance an action for deceit, that is, a passing off by a person of his own goods as those of another and that it is not the gist of an action for infringement, which is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to

the use of the trade mark in relation to those goods. While the use by the defendant of the trade mark of the plaintiff is not essential in the case of passing off, it is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential feature of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark to a passing off action would also be such in an action for infringement of the same trade mark. In a passing off action, the defendant may escape liability, if he can show that the features of a mark used by him are sufficient to distinguish his case from those of the plaintiff.

74. In *Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co.*, the Supreme Court brought out the distinction between the two actions in the following words:-

"4. The distinction between an infringement action and a passing off action is important. Apart from the question as to the nature of trade mark the issue in an infringement action is quite different from the issue in a passing off action. In a passing off action the issue is as follows:-

"Is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe that they are the plaintiff's goods?"

5. But in an infringement action the issue is as follows:-

"Is the defendant using a mark which is the same as or which is a colourable imitation of the plaintiff's registered trade mark?"

It very often happens that although the defendant is not using the trade mark of the plaintiff, the get-up of the defendant's goods may be so much like the plaintiff's that a clear case of passing off would be proved. It is on the contrary conceivable that although the defendant may be using the plaintiff's mark the get-up of the defendant's goods may be so different from the get-up of the plaintiff's goods and the prices also may be so different that there would be no probability of deception of the public. Nevertheless, in an action on the trade mark, that is to say, in an infringement action, an injunction would issue as soon as it is proved that the defendant is improperly using the plaintiff's mark,

76. The action for infringement is a statutory right. It is dependent upon the validity of the registration and subject to other restrictions laid down in Sections 30, 34 and 35 of the Act. On the other hand the gist of a passing off action is that A is not entitled to represent his goods as the goods of B but it is not necessary for B to prove that A did this knowingly or with any intent to deceive. It is enough that the get-up of B's goods has become distinctive of them and that there is a probability of confusion between them and the goods of A. No case of actual deception nor any actual damage need be proved."

75. In *American Cyanamid Company v. Thicon Limited* (1975) RPC 513 Lord Diplock said that there was no rule of law that precluded the grant of an interim

injunction unless upon the evidence adduced by both parties, the appellant had satisfied the court that on the balance of probabilities the acts of the other party sought to be enjoined would if committed, violate the applicant's legal rights and unless the material available to the court at the hearing of the application for an interlocutory injunction failed to disclose that the plaintiff has any real prospect.

76. In a case under Order XXXIX, Rules 1 and 2 of the Code of Civil Procedure, the Supreme Court said that no injunction could be granted under the said rules unless the plaintiff's established that they had a prima facie case meaning thereby that there was a bona fide contention between the parties or a serious question to be tried. (See *United Commercial Bank Vs. Bank of India and Others*, . Counsel have agreed that the general principles relating to grant of an injunction under order XXXIX, Rules 1 and 2 of the CPC will apply in these cases also.

QUESTION (A)--The effect of registration of trade mark No. 204951

77. It is the contention of the respondents that the suit C.S.No. 1464 of 1994 is not maintainable in view of the registration of their trade mark bearing No. 204951. According to them, there is no limitation as to the colours and they can also use the said trade mark with certain additions and alterations which do not substantially affect its identity. Reliance is placed on the provision of Sections 28, 32, 10(2) and 54 of the Trade Merchandise Marks Act (hereinafter referred to as "the Act"). Under Sub-section (1) of Section 28, the registration of a trade mark gives to the registered proprietor the exclusive right to use the said mark in relation to the goods in respect of which it is registered and to obtain relief in respect of infringement of the same in the manner provided by the Act. Sub-section (2) of the said Section makes the exclusive right to the use of a trade mark subject to any conditions and limitations to which the registration is subject. Sub-section (3) relates to two or more persons being registered proprietors. Section 32 provides that subject to the provisions of Sections 35 and 46, in all legal proceedings relating to a trade mark, the original registration of the trade mark shall, after the expiration of seven years from the date of such registration, be taken to be valid in all respects unless it is proved that the original registration was obtained by fraud or that the trade mark was registered in contravention of the provisions of Section 11 or offends against the provision of that Section on the date of commencement of the proceedings. Section 35 relates to saving for words used as name or description of an article of substance and Section 45 relates to removal from register and imposition of limitations on ground of non-use. Section 10(2) declares that so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours. It is pointed out that the registered trade mark No. 204951 was registered without limitation of colour, Section 54 enables the Tribunal before which the use of a trade mark is registered to be proved for any purpose under the provisions of the Act, it may, if and so far as it shall think right, accept use of a registered associated trade mark or of the trade mark with additions or

alterations not substantially affecting its identity, as an equivalent for the use required to be proved. Sub-section (2) introduce a fiction that the use of the whole of a registered trade mark shall for the purpose of the Act be deemed to be also a use of any trade mark being a part thereof and registered in accordance with Sub-section (1) of Section 15 in the name of the same proprietor. Reliance is placed on this Section in order to meet the contention of the appellants that the respondents are not using the trade mark registered under No. 204591, but using an entirely different mark by slavishly copying the mark of the appellants. We have an a fact found that the respondents in their new business commenced in 1994 are attempting to use the marks of the appellants which are totally different from the mark registered under No. 204951 by the fourth respondent in 1961. We have also referred to the fact that the Registry of Trade Marks had written letter to the fourth respondent that the alteration of the trade mark sought by her in 1973 by removing the words "Vijalabs" in Tamil and English would be a substantial one requiring fresh advertisement in the journal. Hence, the respondents cannot claim the benefit of Section 54 of the Act.

78. We are unable to accept the extreme contention that the action for passing off in C.S. No. 1464 of 1994 is barred by the registration of the trade mark of the fourth respondent. Section 27(2) of the Act is a complete answer to the contention of the respondents in this regard. It reads as follows:-

"Nothing in this Act shall be deemed to affect right of action against any person for passing off goods as the goods of another person or the remedies in respect thereof;

One of the senior counsel appearing for the respondents attempted to contend that Section 27(2) would apply only where a proprietor with a registered trade mark figures as a plaintiff. There is no substance in this contention and we have stated the same only to reject it. Our attention is also drawn to Sections 105 and 106, which deal with suits for infringement of a registered trade mark as well as for passing off. The provisions in those sections do not in any way help the respondents. We do not think it necessary to dilate any further on the untenable arguments advanced on behalf of the respondents in this connection. Suffice it to point out that the position in law is too well settled to be dealt with at length in this judgment.

79. In Kerry's "Law of Trade Marks and Trade Name", 12th Edition, at page 356, in para 16-14, the following passage occurs:-

Subject to two qualifications, nothing in the Trade Marks Act affects a trader's right against another in an action for passing-off. It is, therefore, no bar to an action for passing-off that the trade name, get-up or any other of the badges identified with the Plaintiff's business, which are alleged to have been copied or imitated by the defendant, might have been, but are not registered as trade marks, even though the evidence is wholly addressed to what may be a mark

capable of registration. Again, it is no defence to passing-off that the defendant's mark is registered. The Act offers advantages to those who register their trade marks, but imposes no penalty upon those who do not. It is equally no bar to an action for passing-off that the false representation relied upon is imitation of a trade mark that is incapable of registration. A passing-off action can even lie against a registered proprietor of the mark used upon."

In Narayanan on "Trade Marks and Passing off" IV Edition, para 22.03 at pages 410 and 411 reads thus:-

"The provisions of the Act including those of registration do not affect rights of action against any person for passing off goods as the goods of another or the remedies in respect thereof. Thus in an action for passing off the defendant cannot plead that the mark he is using, which has resulted in passing off, is registered. This would appear to follow from the use of the words "subject to the other provisions of this Act" in the opening part of Section 28(1) defining the right conferred by registration. The "other provisions of the Act" would obviously include Section 27(2) dealing with rights of action for passing off. Section 27(2) overrides the provision of Section 28."

80. Our attention is also drawn to the judgments in *Century Traders Vs. Roshan Lal Duggar Co.*, and *Sushil Vasudev Vs. Kwaliti Frozen Foods Pvt. Ltd.*, which was affirmed on appeal in C.A. No. 234 of 1994 by the order of the Supreme Court dated 19-7-1994. "We do not think it necessary to quote any passage therefrom.

81. Learned counsel for the appellants has submitted that the respondents are deliberately using the appellant's trade mark "TIGER BALM" as part of their trading style in registering the first respondent company with the name "Tiger Balm and Company" and that would amount to passing off. Reliance is placed on the judgments in *Ellora Industries Vs. Banarsi Das Goela and Others*, . *K.G. Khosla Compressors Ltd. v. Khosla Extractions Ltd.* 1986 PTC 211 and *Hindustan Radiators Co. v. Hindustan Radiators Ltd* 1987 (I) PLR 21, All the three are judgments of the Delhi High Court. In view of the facts found by us that the respondents are attempting to pass off their goods as those of the appellants, it is not necessary for us to consider the propositions of law laid down in the above cases in detail.

82. With reference to user of a mark with addition and alteration, our attention is drawn to a passage in Kerly's "Law of Trade Marks and Trade Names", 12th Edition, at page 310, para 25-41, which reads as follows:-

"It is sometimes urged, on behalf of the defendant, as an objection to the plaintiff's case, that the plaintiff in actual practice uses his mark in a form different from that for which he has obtained registration. But the variation of his registered mark by the plaintiff, provided it is not an infringement of any other person's mark, or a breach of any agreement binding upon him, is perfectly lawful, although, so far as the mark actually used differs substantially from his

registered it is an unregistered mark. It is well settled that the use of a varied mark by the plaintiff does not in any way stop him from proceeding against infringes."

It is seen from that passage itself that in so far as the mark actually used differs substantially from the registered mark/it is an unregistered mark in the eye of law. Hence, the mark now used by the respondents must be considered to be only an unregistered mark in the present proceedings.

83. The appellants have drawn our attention to the rulings in *In the matter of British Hoit and Crane Coy, Ltd.,*'s Trade mark (72 R.P.C.66) and *OTRIVIN Trade Mark (Amendment B.O.T)* (1961 H.P.C. 613). In both the cases, the decision of the Registrar holding that the alterations sought to be made were substantial was upheld.

84. Strong reliance is placed by the respondents on the observations in *American Home Products Corporation Vs. Mac Laboratories Pvt. Ltd. and Another*, , *Jadayappa Mudaliar v. Venkatachalam* 1990 II MLJ 423, *Avis International Ltd. v. Avi Footwear Industries* (AIR 1991 Delhi 22), and *G.T.C. Industries Ltd., Bombay Vs. I.T.C. Limited, Madras*, . None of the aforesaid rulings will have any bearing in the present case in view of our findings on facts, particularly when the fourth respondent has not done any business from 1984 till date with her registered trade mark and the respondents have started a new business in August 1994 with a mark which is different from the registered trade mark No. 204591.

85. Placing reliance on the judgments in *Sona Ana Pana Balraj and Others Vs. S.P. Vadivel Nadar and Sons and Another*, and *State of U.P. Vs. Ram Nath, Partner, Panna Lal Durga Prasad, Kanpur*, in support of the contention that the remedy of the appellants on the ground of non-user of trade mark could only be to seek rectification of the register and removal of trade mark, learned senior counsel for the respondents contended that even if there is non-user, it will not in any way help the appellants in the present proceedings. Our findings on the facts are sufficient to negative the said contention.

86. The learned single Judge has in his order dated 18-1-1995 made in Q.A. Nos. 999 and 1000 of 1994 held that the respondents are entitled to protection under Sections 31 and 32 of the Act, Since the matter is only at the interim stage. That conclusion of the learned Judge is obviously based on his conclusion on the facts. We have differed from him on the facts. Further, in a passing off action, registration of trade mark is no defence.

87. Hence, we answer Question (A) in the negative in favour of the appellants and hold that the registration of the trade mark No. 204591 does not disentitle the appellants to rely on the basis of passing off.

QUESTION (B) - Necessity of actual business in India.

88. We have found already on facts that the appellants' goods are available in this country through official and non-official sources and that the first appellant

has acquired reputation all over the world including in India. Hence, this question of law has to be decided on the aforesaid finding which will hold goods for the present. It is evident from the various decisions cited on both sides, that the opinions on the subject had been divergent. Though at one time a view was taken consistently that unless business is carried on in a particular place, there is no question of relying on reputation or goodwill and claiming any relief on that footing. In course of time, the view has begun to change.

89. In "Intellectual Property" by N.R. Cuxnish, Second Edition, at page 418, the law is stated thus in para 16-026:-

"The same considerations apply when the plaintiff establishes a business reputation in one place and the defendant then sets up a similar business in another so as to suggest that the plaintiff has opened a new outlet. In *Brestian v. Try*, for instance, the plaintiff had hair dressers' shops in London, Wembley and Brighton, the defendant was restrained from using the same name for hairdressing in Tunbridge Wells. But Jenkins L.J. was careful to find "that damages would probably ensue" because customers might go to the defendant instead of the plaintiff, and Romer L.J. pointed to evidence that the plaintiff's credit and reputation might be endangered." More recently a business with "Chelsea Man" shops in three cities was held entitled to a country - wide injunction, because of its intention to extend business beyond these places.

This ought to be the appropriate principle for dealing with cases where a plaintiff has built up a reputation by business abroad and the defendant imitates him so as to lead Customers to believe that the plaintiff has come to Britain, If there is a tangible risk that the plaintiff's goods name will be hurt by the poor quality of what the defendant provides or adverse publicity about him, or if the plaintiff has plans to come to Britain which will be jeopardised, these should provide a sufficient basis for his claim. But it would be a new departure to give such a plaintiff relief merely because the defendant was taking advantage of his reputation."

90. In *Drysdale and Silverleaf on Passing Off Law and Practice*, 2nd Edition, at page 10 in paragraph 2.07 it is stated that the right to protect against piracy of a plaintiff's name or trade mark was not linked to the name or trade mark itself but to the "property" which the plaintiff had acquired in that name or mark by the use which he had made of it. In paragraph 2.27, at page 17, it is stated that the good-will in a plaintiff's business has been identified as the property right which the action for passing off protects. In paragraph 3.01 at page 25, the law is stated thus:-

"Whilst the title of this chapter is Reputation we have seen that the property which is protected by a passing off action is the goodwill in the business. In passing off cases the two terms are often used almost interchangeably and confusion arises as to the distinction between them. The difference is subtle and not always easy to see. Goodwill exists in the minds of a business's customers.

It is the state of mind which makes them wish to patronise its goods or services. It can exist only in relation to a business which they are able to patronise. A reputation is the means by which something is recognised. In relation to a business which has goodwill it is the manner in which the goodwill operates on the minds of the business's customers. The difference is most actually seen in two circumstances. Political parties undoubtedly possess reputations. However, they do not have goodwill because they carry on no business. Foreign traders may well have a reputation in the sense that they are known to numbers of the public in this country, even though they carry on no business in here. Such a reputation, however extensive it is, will not support a passing off action unless the business's goods or services are available in this country so that the business is able to have customers here."

91. As seen from the above passage, the learned author recognized that foreign traders may well have a reputation which can support a passing off action for the goods or services are available in this country, so that the business is able to have customers here. In paragraphs 3.11 and 3.12 in pages 32 and 33, it is stated thus:-

"However, this does not mean that a manufacture or importer of foreign made goods has to have a place of business in this country. It is sufficient that the goods are available here and that accordingly there are Customers in whom the goodwill can reside. In *Ancients Establishments Panhard at Levassor SA v. Panhard- LevasSOR* (1901) 2 Ch 513: 18 RPC 405), at the beginning of this century, the plaintiffs were French motor car manufactures. They had not themselves exported cars to this country or sold them here. Despite this it was held that the use of the name, on cars bought by other people abroad and brought by them into this country was sufficient to establish the plaintiff's reputation here on the footing that as a result of such importation "England was one of their markets". Twenty years later, in *Poirot v. Jules Puirot* Nash 1920 37 RPC 177, Lawrence J. said: "Paul Poirot is in my judgment in the circumstances of this case entitled to protect his goods and the reputation he has acquired in this country notwithstanding the fact that he has not got a place of business here." A further sixty years later *Walton J, in Athletes Foot Marketing Associates v. Cobra Sports Ltd.* 1980 RPC 343 reached virtually the same conclusion saying:

".....It would appear to me that, as a matter of principle, no trader can complain of passing off against him in any territory and it will usually be defined by national boundaries, although it is well conceivable in the modern world that it will not in which he has no customers, nobody who is in trade relation with him. This will normally shortly be expressed by saying that he does not carry on any trade in that particular country (obviously, for present purposes, England and Wales) but the inwardness of it will be that he has no customers in that country, no people who buy his goods or make use of his services (as the case may be) there."(P.350).

He expressed this view before going on to carry out a comprehensive review of

the authorities at the end of which he concluded that they led to the conclusion that:

"It does not matter that the plaintiffs are not at present actually carrying on business in this country provided that they have customers here. Equally, it is of no moment, if they have customers here, that they have a reputation in the general sense of the word in this country. It is also of no moment that reputation may have been brought about by advertising "this can be of no moment unless (as it did in the C and A case) it brings in customers, when, of course, once again there is no need to rely upon it."

The members of the Court of Appeal in the Budweiser case (*Anbeuier - Butch Inc v. Budejovicky Budvar Narayni Pudnik* (1984) FSR 413), regarded the presence of Customers in this Country as the key to the question whether the requisite goodwill had been established and Oliver L.J. in particular thought Walton J's finding helpful but pointed out that it:

".....needs, in the light of authorities, to be approached with the caveat that "customers" must not be read restrictively as confined to persons who are in a direct contractual relationship with the plaintiff, but includes the persons who buy his goods in the market."

3.12. The cases discussed in the previous paragraph were all concerned with traders in goods. In such cases the question of whether a trader has a business here is ultimately answered by determining whether his goods are available in this country."

92. In Christopher Wadlow on the Law of Passing -off, 2nd edition, at page 92, in paragraph 2.45, the development of Law is stated as follows:-

"2.45. In a series of three judgments, (*10th Cantanae Pty Ltd. v. Shoshama Pty Ltd* (1989) 10 IPR 289 *Telemak Teleproducts (Australia) Pty Ltd. v. Coles Myer Ltd* (1988) AIR 437 reserved, 1989 89 ALR 48, *Conugra Inc. v. McCain Poods (Aust) Pty. Ltd* 1992 23 IPR 193, Gummow, J. in the Federal Court of Australia has developed the proposition that there continues to exist a common law action for passing-off based on fraud, which is distinct from the equitable action of the same name based on damage to goodwill. If this is correct, it follows that as against a fraudulent defendant, in the old common law sense, a plaintiff may succeed despite having no goodwill.

"It would be an error to conclude that the consequence of treating fraud still as the basis for relief in passing-off is always to impose an additional burden to plaintiff. Rather, it may provide a remedy where none is available to protect goodwill.

The decision of Way C.J. in *Weingarton Bros. v. G and R Wills and Co.* 1960 SAIR 34 shows that where frauds has been established against the defendant, the plaintiff may succeed without showing a local goodwill arising from the conduct of a local business. In this way the "pirate", who sets out to attract to his

business local persons who know of the fame of the "international" business of the plaintiff, may be brought to account."

At page 94, reference is made to a later case in *Conagra v. McCain Foods* (1992) 23 IPR193 to which the same learned Judge was a party, in the following passage:-

"In *Conagra v. McCain Foods* itself Gummow J. appears to have reluctantly abandoned his theory in favour of the majority view that fraud is of evidential value only, and reputation per se constitutes a protectable interest. Since there was a finding of fraud against the defendants in that case, and since the plaintiffs failed for all that, *Weingarten v. Wills* seems to have been consigned back to history even in its homeland."

93. In *Ebrahim Currim v. Essa Abba Bait* ILR 24 Mad 163, a learned single Judge of this Court held that user of a mark by a person in another country did not justify the claim by such a person that the plaintiff's user of the said mark in this country was illegal or otherwise Judge than an exclusive user. The learned Judge observed :-

"The protection which the law affords to traders using a trademark in this country would be seriously diminished if immunity from action were accrued to rival traders who, having brought goods into the market with the same mark were able to prove that in some other quarter of the globe some other trader had been in the habit of using the mark for a period longer than that alleged by the plaintiff."

The proposition will have no application in this case in view of the facts found by us.

94. In *The West End Watch Company v. The Berna Watch Company* ILR 35 Bom 425, it was held that the importer, who by advertising and pushing the sale of goods under a particular mark secures a wide popularity for the mark in relation to the goods sold by him is entitled to the protection of the Court for that mark in the country of importation even against the producer of the goods. In our opinion, the proposition has been too widely stated. But it is wholly unnecessary in this case to dwell upon it any further.

95. In *S. Meera Sahib and Bros. v. Hajee M. Abdul Azees Sahib* 1938 II MLJ 651 a Division Bench of this Court held that it is essential in a passing off action to show that there has been a false representation and it is not enough for a plaintiff to claim that he has adopted a device as a trade mark and that the defendant has copied the same. The plaintiff must show that he has used the mark claimed by him on his goods or in connection with them and that the mark has become associated in the minds of the public with his goods. There must be user of the mark because without user no reputation can be acquired. On the facts it was found that there was no evidence to show any reputation on the first plaintiff therein so far as India was concerned. But, in this case, on the

facts found by us, the ruling in the above case would only help the appellants and not the respondents. In that case, the question of transborder reputation was neither raised for considered.

96. Reliance is placed by the respondents on the dictum of the Supreme Court in *S.C. Cambatta and Co. Private Ltd. Vs. Commissioner of Excess Profits Tax, Bombay*, . That was a case under the Indian Income Tax Act. While dealing with the valuation of goodwill under the provisions of the Act, the Court said that goodwill of a business depends upon a variety of circumstance or a combination of them and the location, the service, the standing of the business, the honesty of those who run it and the lack of competition and many other factors go individually or together to make up the goodwill, though locality always plays a considerable part. The Court, however, took caution to show that locality was not everything. The observations of the Supreme Court cannot be torn out of context and utilized by the respondents in this case.

97. In *Guzdar Kajora Coal Mines Ltd., Calcutta Vs. The Commissioner of Income Tax, Calcutta*, , the Court said that the expression "goodwill" has been considered and explained by the Court in *S.C. Cambatta and Co. Private Ltd. Vs. Commissioner of Excess Profits Tax, Bombay*, and nothing more need be said about it. The Court added that the principles stated by it are by no means exhaustive and are mainly illustrative.

98. In *Leahy, Kelly and Leahy v. Glover* (10 R.P.C. 141), the Chancery Division held that the party must prove that his goods have come to be known in the market by his trade name. In *Impex Electrical Ltd. v. Woinbaum* (44 R.P.C. 405), the Chancery Division held that the Court should have regard to the market in the country alone and foreign markets are wholly irrelevant unless it be shown by evidence that goods have been sold in the country with a foreign mark on them and the mark has become identified with the manufacturer of the goods. In *Hotox* case (48 R.P.C. 168), the Court held that the applicant's right to registration was not affected by the opponent's user abroad and the evidence of such user was wholly irrelevant.

99. In *T. Oertil AG v. B.J. Bowman (London) Ltd.* (74 R.P.C. 388), the Court said that in order to succeed in a passing off action the plaintiff must prove user to such an extent that the trade and the public will understand the goods to be those of the plaintiff.

100. In *Crazy Horse Saloon* case (84 RPC 581), the Court held that mere advertisements or recollection of travellers will fall very far short of constituting the sort of goodwill which could be protected by a passing off action. The Court refused to grant injunction in spite of a finding that the defendant company, had chosen the identical name "Crazy Horse Saloon" with the sole purpose of "cashing in" on the reputation, in the wider sense, of the plaintiff company and again had deliberately copied in its decoration and advertisement those of the plaintiff company's establishment.

101. In General Electric Company case (1972 All E.R. 502), it was held that goodwill was incapable of separate existence disassociated from the business.

102. In Amway Corporation and Anr. v. Burway International Limited and Ors. (91 R.P.C. 82), the Court held that the plaintiff must in order to get injunction prove business reputation in the country.

103. In Hayakawa Denki Kogya Kabushiki Kaisha (Hayakawa Electric Company Ltd). Japan v. Associated Electronic and Electrical Industries, Bangalore 1974 I MLJ 392, a Division Bench of this Court held that Section 11(a) of the Act could be invoked to oppose registration only if the objector had reputation in this country. That case related to transistor radio sets. It is worthwhile to notice that the Bench made a distinction between transistor Radio sets and medicinal and pharmaceutical goods because the Medicine and allied science have international character. On that ground the learned Judges held that the principle of Re - Application of Vitamins Limited 1955 3 All ER 827 would not apply in that case.

104. In Pazhancottai Match factory v. Siva Match Industries 1975 II MLJ 21, a learned single Judge of this Court held that the plaintiff should prove that the disputed mark or get up has become by user in this country distinctive of his goods. In Star Industrial Company Limited v. Yap Kwee Kor (trading as New Industrial Company) (1976 F.S.R. 256), the Court held that goodwill had no independent existence apart from the business to which it was attached and was incapable of subsisting by itself for being subject of a proprietary right.

105. Reliance is placed on Century Traders Vs. Roshan Lal Duggar Co., in support of the contention that the appellants have to prove prior user of the mark to get an order of injunction in a passing off action. In that case, there was no question of trans-border reputation. In Erven Warnink BY and Ors. v. J. Townend & Sons (HGLL) Ltd and Ors. 1979 2 All ER 927, the House of Lords held that the following five essential characteristics must be present in order to create a valid cause of action : (1) a misrepresentation, (2) made by a trader in course of trade, (3) to prospective customers of his or ultimate consumer, (4) which is calculated to injure the business or goodwill of another trader and (5) which causes actual damage to a business or goodwill of the trader by whom action is brought.

106. In Athetes Foot Marketing Associates Inc. v. Cobra Sports Ltd. (97 R.P.C. 343), the Court held that no trader can complain of passing off in a territory in which he has no customers or nobody in relation with him.

107. In Taco Company of Australia Inc. v. Taco Bell Ptg, Ltd. (42 ALR 177), the Federal Court of Australia held that the plaintiff must have reputation in the geographical area for which injunction is sought.

108. In the case famously known as Budweiser Case (Anhouser-Busch Inc v. Bude Jovicky Budvar-4 I.P.R. 260), the Court of Appeal in England held that substantial sales in American bases and occasional sales to the members of the

general public in U.K. did not constitute the carrying on of business to which goodwill could attach while much reliance has been placed on this case by the respondents, they have not cited any case subsequent thereto. We find that the principle in *Budweiser* (4 I.P.R. 260) has not been followed in this country in the cases recently decided.

109. In *Kamal Trading Co. v. Gillette U.K. Limited* (1988 (I) P.L.R. 135), a Division Bench of the Bombay High Court dissented from "*Budweiser*" (4 I.P.R. 260) on the following reasoning:-

"We must express our dissent with the view taken in this case. In our judgment it is not possible to conclude that the goodwill or the reputation stands extinguished merely because the goods are not available in the country for some duration. It is necessary to note that the goodwill is not limited to a particular country because in the present days, the trade is spread all over the world and the goods are transported from one country to another very rapidly and on extensive scale. The goodwill acquired by the manufacturer is not necessarily limited to the country where the goods are freely available because the goods though not available are widely advertised in newspapers, periodicals, magazines and in other medias. The "result is that though the goods are not available in the country, the goods and the mark under which they are sold acquires wide reputation, take for example, the televisions, and Video Cassettes Recorders manufactured by National, Sony or other well-known Japanese Concerns. These televisions or video cassettes are not imported in India and sold in open market because of trade restrictions, but is it possible even to suggest that the word "National" or "Sony" has not acquired reputation in this country? In our judgment, the goodwill or reputation of goods or marks does not depend upon its availability in a particular country. It is possible that the manufacturer may suspend their business activities in a country for short duration but that fact would not destroy the reputation or goodwill acquired by the manufacturers. An identical view was taken by Division Bench of Mr. Justice S.K. Desai and Mr. Justice Bharucha in a judgment dated July 24, 1968 in Appeal No. 368 of 1966. The question for consideration before the Division Bench was whether the goodwill in the trade mark "7 O'CLOCK" stood extinguished because of nonavailability of blades with the mark in India after year 1958. The Division Bench turned down the claim by pointing out various reasons and we are in entire agreement with the observations made in the judgment on this aspect. In our judgment, it is not possible to follow the view taken in the case of *Budweiser*.

With respect we agree with the view of the Division Bench.

110. In *Blue Cross & Blue Shield Association v. Blue Cross Health Clinic and Ors.* 1990 (1) PLR 92, the Delhi High Court held that the plaintiffs had produced evidence to show that they had acquired ownership of the trade marks in India as a result of business done in India and as a result of large scale advertisement made in foreign periodicals circulated in India.

111. The same High Court in *Apple Computer Inc. v. Apple Leasing & Industries* 1993 (1) PLR 63 held that it was not necessary for a plaintiff in a passing off action to carry on business in India to prove prima facie case and balance of convenience to obtain an order of interim injunction and it was enough that the plaintiff had a reputation in India, Referring to "Budweiser" (4 I.P.R. 260), the Court pointed out that the principle was not accepted in new Zealand, Australia, Canada and India. The Court said that there was a strong trend to prevent deception of the public whether it was deliberate or innocent and in India because there was greater need to catch up with the more advanced countries it was all the more necessary that the deception of the public, innocent or deliberate, be avoided by injunction.

112. The same learned Judge who decided the *Apple Computer Case* 1993 (1) PLR 63 had occasion to lay down the law in *Daimler Benz Aktiengesellschaft* and another Vs. *Hybo Hindustan*, in the following terms :-

"15. In my view, the Trade Mark law is not intended to protect "a person who deliberately sets out to take the benefit of somebody else"s reputation with reference to goods, especially so when the reputation extends world wide."

113. Once again the learned Judge dealt with the same question of law in *William Grant & Sons Ltd. v. McDowell & Co. Ltd.* (I.A.9721/93 In Suit No. 2532 OF 1993 -Judgment dated 27-5-1994). On the question of trans-border reputation, the learned Judge said :-

"Trans-border reputation of the plaintiff, has been, in my view, established sufficiently in this country by means of the fact that the sales of GLENFIDDICH takes place on duty free shops in India, by the fact that advertisement of GLENFIDDICH whisky are to be found in various magazines, like the In house magazine of Air India, and other foreign publications which are freely available in India, (some of which have been placed on record of this case), as a result which, in my view, GLENFIDDICH whisky has a live reputation in India.

After referring to judgments relating "to persons selling their goods internationally all over the world, I have already held in the case of *Apple Computer Inc.* 1991 (20) Delhi Lawyers 319, that a person whose goods have an international reputation can maintain a passing off action in India.

The learned Judge has dealt with the case law at length including his earlier judgment in *Apple Computer case* 1993 (1) PLR 63.

114. Another learned Judge of the Delhi High Court considered the question at length in *Whirlpool Corporation and Anr. v. N.R. Dongre and Ors.* 1995 (32) DRJ 317 (I.A.7657/94 in Suit No. 1705 of 1990 dated 31-10-1994). After quoting at length passages in the judgment in *Apple Computer case* 1993(1) PLR 63, the learned Judge referred to the judgment of *WWF International v. Mahavir Spinning Mills Ltd.* 1994 PTC 250:1994 31 DRJ 412 and said :-

"19. There is yet another very recent decision of this Court in *WWF International*

v. Mahavir Spinning Mills Ltd. (Suit No. 822/94 decided on 7-10-94 : 1994 PTC 250 :1994 (31) DRJ 412 by P.K. Bahri, J. referring to the law laid down in Sears Roebuck & Co. v. Happy House (TV) Mfg. Co. Ltd. 1992 PTC 59.

19.1. Therein the plaintiff running retail stores chain in America under the trade mark Sears had no physical presence in India nor had registration of trade mark SEARS in India had brought an action restraining the defendant from using the trade mark SEARS for marketing TVs. It was held that unless evidence is brought before the Court showing reputation and goodwill of the plaintiff in India as a manufacturer of television and substantial evidence of the reputation and goodwill of the plaintiff as a retail store India, the injunction cannot be granted. Bahri, J. observed that judgment dealt with totally different facts, Bahri J. has further said. :-

"Mere fact that the plaintiff has never manufactured any products in this country does not prevent it from acquiring the goodwill here in its trade mark. It is no doubt true that an action for passing off relates to the business and it must be established "that the plaintiff has a reputation or goodwill of his business in this country. The foundation for the action for passing off is the protection of goodwill and so, one must prove the existence of goodwill in this country before obtaining a relief of passing off. The principle of law of passing off has been also made applicable to non trading business or non-profit making bodies as well".

19.2. Bahri, J. has further "approved the view that trade mark law is not intended to protect a person who deliberately sets out to take benefit of somebody else"s reputation with reference to goods especially so when the reputation extends worldwide."

Again towards the end of his judgment, the learned Judge said :-

"The concept of passing off is based on good business etiquette and commercial necessity. Unfair competition has to be avoid. Nobody shall be permitted to acquire for the benefit of oneself by using false means or misleading devices the benefit of reputation and goodwill earned by someone else. This is too good as a principle and also as law applicable to any country but what about its extension trans-border? India is moving towards free economy. The drastic changes in the economic policy of the country which are in offing is sure to entail entry-fresh and afresh-of multi-nationals in the Indian market. The common law of passing off is sure to undergo a change. With the synchronization of the world, law cannot afford to remain conservative. Still the need of examining the concept of "transborder reputation" by reference to its impact on the Indian economy and Indian industries cannot be ruled out. The concept needs a thorough and in depth examination. Better if it is done by a larger bench. I have avoided the need of doing so in this case at this stage inasmuch as what is being disposed of is an interlocutory matter after all and inviting decision by a Division Bench or a Larger Bench would have merely delayed the matter further."

115. We agree with the view taken by the Bombay and Delhi High Courts in the

above cases on the question of trans-border reputation. Hence, we are not referring to the other judgments cited by the appellants in this regard. We do not accept the view expressed by the learned single Judge in O.A. Nos. 999 and 1000 of 1994 in C.S. No. 1464 of 1994 in the order dated 18-1-1995. Consequently, we answer the question (B) in favour of the appellants.

QUESTION (C) - Effect of the orders passed by the registry of trade marks.

116. According to the respondents, the order of the Assistant Registrar dated 6-5-1969 in M.A.S.114 declaring that the application for rectification shall be deemed to be abandoned prevents the appellants from filing any fresh application for rectification. They are also precluded from seeking registration of their mark in India in view of the orders in Opposition No. CAL 1698 and CAL 1758. We have already referred to the pendency of the appeals in the High Court of Calcutta and that the orders in the oppositions referred to above have not become final. The order in Rectification Proceeding declaring it to be deemed to have been abandoned will not preclude the appellants from claiming any relief on the basis of passing off. Nor would it prevent them from defending and resisting the action of the respondents which is not on the basis of the registered trade mark but a different mark. We do not want to express any opinion whether a fresh application for rectification can be filed by the appellants, as it is wholly unnecessary for the purpose of this case.

117. It is also contended by the respondents that the appellants cannot gain in these suits what the first appellant lost in the proceedings before the Registry of Trade marks referred to above. Reliance is also placed on *Sterling-Winthrop Group Limited v. Farbenfabriken Buyer A.G.* (83 R.P.C. 477). The following passage in that judgment is read out :-

"When one is asked to grant an interlocutory injunction forbidding the defendants to use some name because of a remote possibility of confusion between his goods and the plaintiff's goods one is I think entitled to pay regard to the defendant's reasons for trading under the name in question and the plaintiff's reasons for objecting to his doing so. In this case there is not the least reason to think that the first defendants are trading under the name "Bayer Germany" because they hope to pass off their goods as the goods of the plaintiffs. They want to do nothing of the kind. What they want to do is to go as far as they can, without passing off, to prevent the plaintiffs from gaining a monopoly in this country in the name BAYER in connection with the sale of drugs. The plaintiffs, on the other hand, are not I think seriously afraid that the use by the defendants of the words "Bayer Germany" will lead anyone to think that the first defendant's goods are their goods. What they are afraid of is that, if the first defendants are allowed to trade as "Bayer Germany", they will be hampered in establishing that monopoly in the name BAYER in connection with the sale of drugs which they have been striving to establish for the last 15 years; that is to say, they are trying to gain by passing off proceedings what they have no far failed to secure by trade mark proceedings."

Even the contents of the above passage show that the facts were found in favour of the defendants in that case and the proposition of law cannot be considered de hors those facts. On the findings of facts in this case, the principle will have no application particularly when the appellants have not lost anything in the proceeding before the Registry.

118. The appellants' counsel have drawn our attention to the judgments in *P. IYYa Nadar v. A.V. Rajadorai Nadar* 1973 II MLJ 7 and *Hindustan Pencils Pvt. Ltd. v. Premchand Gupta* (1985 P.T.C. 33). In the view we have expressed above, there is no need for us to advert to those judgment in detail.

119. Hence, we answer Question (C) in the negative in favour of the appellants.

QUESTION (D): Effect of disclaimer

120. In *The Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd.*, . The Supreme Court held that the avowed purpose of Section 13 of the Act requiring a disclaimer is to define the rights of the proprietor under the registration so as to minimise even if it cannot wholly eliminate the possibility of extravagant and unauthorised claims being made on the score of registration of trade marks. The Court said further :-

"(9) The last feature of the section is its proviso. That proviso preserves intact any right which the proprietor may otherwise under any other law have in relation to the mark or any part thereof. The disclaimer is only for the purposes of the Act. It does not affect the rights of the proprietor except such as arise out of registration. That is to say, the special advantages which the Act gives to the proprietor by reason of the registration of his trade mark do not extend to the parts or matters which he disclaims. In short, the disclaimed parts or matters are not within the protection of the statute."

In another part of the judgment, the Court said :-

"(14) it is true that 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. As said by Lord Eeher in--"*Pinto v. Badman*", 1891(8) RPC 181 at p. 191(J):

"The truth is that the label does not consist of each particular part of it, but consists of the combination of them all."

Observations to the same affect will be found also in--"*In re Apollinaris Company's Trade Marks*", 1891-2 Ch 186(K),--"*In re Smokeless Powder Co.*" (F) supra--"*In re Clement and Cie Trade Mark*", 1900 1 Ch 114 L and--"*In re Albert Baker and Company (B)* (supra)" and finally in the *Tudor* case (H) referred to above which was decided by Sargan, J. This circumstance, however, does not necessarily mean that in such a case disclaimer will always be unnecessary. It is significant that one of the facts which give rise to the jurisdiction of the tribunal

to impose disclaimer is that the trade mark contains parts which are not separately registered. It is, therefore, clear that the section itself contemplates that there may be a disclaimer in respect of parts contained in a trade mark registered as a whole although the registration of the mark as a whole does not confer any statutory right with respect to that part."

121. In *Lakhpur Raj Sampat Raf Sadh Vs. P. Narayana*, , the device of a bamboo had been disclaimed at the time of registration of trade mark. The trade mark gave prominence to the pictorial device of a bamboo grove. The respondent in that case adopted the device of a bamboo grove as part of his mark. When reliance was placed on the disclaimer by the respondent, the Court rejected the contention as follows :-

"The argument overlooks the real nature of the disclaimer. The device of a bamboo may have been disclaimed; but not the device of a grove. A special representation in the shape of grove, may be of bamboo, cannot, therefore, be said to have been disclaimed. This device has peculiarities of its own, which give it distinctiveness. It has come to be associated in the minds of the public and the trade, through long user, with the appellants' goods. The disclaimer, subject to which the appellants' mark was registered therefore, would not stand in their way of seeking protection for their device of a "bamboo grove".

122. In *Wippermann JR v. Wipperdrive Engineering* ILR 1977 (1) Delhi 389, the Court held that disclaimer in a registration of trade mark has of course a very material bearing because the disclaimed portion of the mark has to be ignored while considering infringement as it does not form an essential features of the mark. It was also pointed out copying of the manner of representation of the disclaimed feature especially when the representation is distinctive, will constitute infringement

123. In this case, the fourth respondent's registration was expressly subject to a disclaimer of the device of a tiger except substantially shown in the representation annexed to the certificate of registration and the word "Tiger". Hence, the respondents cannot object to the use of the word "Tiger" or the device of a tiger by the appellants, more so in this case because the same were copied by the fourth respondent from the first appellant's mark. On the facts and circumstances of the case, we have no hesitation to hold that the disclaimer at the time of registration of Trade Mark No. 204951 precludes the fourth respondent, the proprietor thereof and anybody claiming under her from questioning the use of the word "Tiger" and the device of a tiger in the trade mark or trade name of the appellants. Question (D) is answered accordingly.

124. Apart from the four questions answered by us above, some other issues were raised and argued before us. One of them is that the plaintiffs in both suits suffer from suppression veri and suggestion falsi, In other words, each side has accused the other of the same. We have found as a fact that the appellants are not guilty of it and in fact the learned single Judge has in his order dated

18-1-1995 in O.A. Nos. 999 and 1000 of 1994 rendered such a finding and we have only affirmed the same. We have also found that the respondents 4 and 1, who are the plaintiffs in CS. No. 257 of 1995, are guilty of suppression veri and suggestion falsi. Learned counsel for the appellants has referred to (1) *Greore Ltd. v. Pearman & Cor-der Ltd.* 39 R.P.C. 406, (2) *Johnson & Son (Longhborough) Ltd. v. W. Puffer & Company Ltd.* 47 R.P.C. 95 and (3) *Intercontex and Anr. v. Schmidt and Anr.* 1988 FSR 575 and argued vehemently that O.A. Nos. 179 and 180 of 1995 should be dismissed on the ground of suppression veri and suggestion falsi. Though we have given a factual finding against the respondents, we do not want to rest our orders on that finding as we have found against the respondents on the other questions which disentitle them to any relief in these proceedings.

125. Another argument is that even if the appellants can be said to be guilty of delay and laches, fraud in obtaining registration by the fourth respondent of her trade mark will exclude delay and the Court is entitled to ignore the delay and laches. Reference is also made to certain authorities and passages in text books. We have found as a fact that the appellants are not guilty of delay and laches. Hence, there is no need to consider the rulings on the subject.

126. Yet another contention is that the formation of a private company with the name Tiger Balm Company Private Limited and incorporation thereof are fraudulent with the object of defeating the rights of the first appellant, the true owner of the trade mark "Tiger Balm" and the appellants are entitled to maintain an action restraining the functioning of such company. Reliance is placed in this connection on the judgment in *La Society Anonyme Des Anciens Btablissemments Pan-hard Rt Levassor v. Panhard Levassor Motor Company, Limited* (1901 (2) Chancery Division 513). In that case, a motor car manufacturing company was registered in a name colourably resembling that of existing motor-car manufacturers with the fraudulent intention of obtaining the benefit of their reputation in that business, the company and the signatories to the memorandum who wore the only directors and shareholders were restrained from using the name in connection with that business and the signatories were further restrained from allowing the company to remain registered under that name.

127. Obviously, the second prayer in C.S. No. 1464 of 1994 and the prayer in O.A. 1000 of 1994 are based on that proposition only. But it is seen that the first respondent has secured incorporation under the Companies Act, 1956 (vide Certificate of Incorporation dated 1-3-1993 at page 337 of Vol. V). We do not want at this interlocutory stage to consider that question as it may require discussion of the relevant provisions of the Companies Act to which no reference was made by either side in these proceedings. However, the interests of the appellants can be safeguarded by appropriate directions which we intend giving to the respondents in this order.

128. While narrating the facts we have stated that O.S.A. Nos. 59 and 60 of

1995 are against the ad interim order dated 22-2-1995 by which the learned single Judge adjourned the applications to 8-3-1995 for "Counter and documents" and at the same time granted interim injunction till 8-3-1995. When the appeals were posted before us for admission we pointed out to learned counsel for the appellants that the appeals were not maintainable as they were not final orders in the applications which continued to be pending before the learned single Judge. After some argument on the question of maintainability, the learned counsel prayed for withdrawing O.A. Nos. 179 and 180 of 1995 to our file and disposing of the same. The counsel for the respondents who had entered caveat agreed to that course and accordingly we have withdrawn O.A. Nos. 179 and 180 of 1995 to our file and heard the same. Thereafter, the question of maintainability of the appeals was not argued probably because counsel thought it unnecessary. We will now dismiss the said appeals as unnecessary, but we must point out that the position in law is well settled in this Court by several decisions. Suffice it to refer to one of them, viz., The Special Tehsildar No. III, Land Acquisition v. V. Rangasamy Reddiar 1988 (1) LW 149 DB to which one of us was a party, in which it was held that such an appeal was not maintainable.

129. What remains to be considered is the grant of reliefs in these proceedings. In O.A. No. 999 of 1994 in C.S.NO.1464 of 1994, the prayer relates to Annexures "B", "F", "G" and "H" and/or other deceptively similar marks, device, carton, label, container label and sachets. On a comparison of Annexures "A", "B", "C" and "D" with Annexures "E", "F", "G" and "H", there is no doubt that the latter are almost copies of the former and deceptively similar. It is to be noted that in none of the Annexures "B", "P", "G" and "H", the trade mark 204951 of the fourth respondent as registered by her is found. The learned single Judge while dismissing the application directed the respondents to use their registered trade mark and the design registered under the Designs Act and avoid using or imitating Chinese character, letters and literature in their cartons and wrappers. In view of our factual findings which differ from those of the learned Judge, the prayer of the appellants in O.A. No. 999 of 1994 has to be granted in toto. There will be an injunction in terms of the said prayer. In O.A. No. 1000 of 1994, the relief relates to the use of the words. "Tiger Balm" in the corporate name or trading style of the respondents. For the reasons already stated, we are not inclined to grant the relief as prayed for by the appellants. However, we give a limited relief by issuing a direction to the respondents that whenever they use the words "Tiger balm" as part of their corporate name or trading style, they shall state specifically that they have nothing to do with the first appellant and its Trade Mark Tiger Balm.

130. It goes without saying that on our findings O.A. Nos. 179 and 180 of 1995 deserve to be and are hereby dismissed.

131. In the result,

(1) O.S.A.55 of 1995 is allowed and O.A. No. 999 of 1994 is ordered as prayed

for by the applicant therein.

(2) O.S.A.56 of 1995 is allowed in part and a direction is issued in O.A. No. 1000 of 1994 to the respondents that they shall whenever they use the words "Tiger Balm; in their corporate name or trading style, they shall state specifically that they have nothing to do with the plaintiff/applicant and its trade mark "Tiger Balm".

(3) O.S.A. Nos. 59 and 180 of 1995 are dismissed as unnecessary.

(4) OA. Nos.179 and 180 of 1995 are dismissed.

(5) The respondents shall pay the costs of the appellants in O.S.A. Nos. 55 of 1995. Counsel's fee Rs. 10,000/-. In other matters, the parties will bear their respective costs.