

**(2001) 09 DEL CK 0124**  
**In the Delhi High Court**  
**Case No : Suit No. 1436 of 2000**

Jolen International Limited

APPELLANT

Vs

Diwan Industrial Chemicals

RESPONDENT

**Date of Decision :** 24-09-2001

**Acts Referred:**

Copyright Act, 1957 — Section 2

Trade and Merchandise Marks Act, 1958 — Section 28, 29, 30, 34, 35

**Citation :** (2002) 1 AD 594 : (2002) 25 PTC 24

**Hon'ble Judges :** A.K. Sikri, J

**Bench :** Single Bench

**Advocate :** Manmohan Singh, for the Appellant; Nemo, for the Respondent

## **Judgement**

A.K. Sikri, J.—Jolen International Limited, who is the plaintiff in the instant case, claims itself to be the proprietor of trade mark COSMO which is registered under No. 317797 in class 3 of 17th August, 1976 in respect of toothpaste. The plaintiff is the assignee of this trade mark which was originally registered in the name of Ms/ Hindustan Rimmer and assigned to M/s Gavs Laboratories Pvt. Ltd. who assigned the same in favor of the plaintiff. It is in fact claimed that all these companies are owned by the same family.

2. The present suit has been filed against the defendant for permanent injunction and infringement of trade mark and copy right, passing off, rendition of account and delivery up etc. as the case of the plaintiff is that the defendant started using of the trade mark COSCO in respect of toothpaste which amounts to infringement of the plaintiff's trade mark and copyright etc. The averments relating to the aforesaid infringement ,as made out in the plaint, are as under:

3. The plaintiff is the owner of the artistic logo on the packing of COSMO toothpaste having red colour background with the device of toothbrush. The trade mark COSMO is written in a particular manner. The plaintiff has been using the trade mark COSMO in a particular style which is a distinctive script in respect of toothpaste. The trade mark used in the said logo script constitutes and original

artistic work within the meaning of Section 2(c) of the Copyright Act .It is also stated that the approximate sale figures of colour concentrates under the trade mark COSMO lacks of Rupees per annum. There has been extensive advertising in newspaper and direct marketing expenses involved in the efforts by the plaintiff to promote its products under the trade mark COSMO .It is further stated that as a result of intrinsic good quality of the products marketed, sold and dealt with by the plaintiff, the products of the plaintiff under the trade mark COSMO as well as packaging materials like Annexure "A" have acquired a unique and enviable reputation and exclusive goodwill. The plaintiff has also acquired a valuable common law right in the trade mark COSMO. The reputation and goodwill of the trade mark COSMO extends throughout India .The said product has gained wide acceptance. the said mark COSMO has become distinctive of and exclusively identified with the plaintiff. By virtue of the registration under the Trade and Merchandise Markets Act, 1958, the plaintiff is entitled to the exclusive use of the mark and name COSMO, inter alia, in respect of toothpaste and cosmetic goods. It is further alleged that the defendant has started manufacturing and marketing its toothpaste under the trade name COSCO in a similar type of packing i.e. carton like having almost same get up, lay out and colour combination. It is also alleged that the defendant had copied all the features from the plaintiff's packing material of COSMO toothpaste and the adoption of the defendant's trade mark is deliberate and dishonest to introduce a deceptively similar mark by infringing the plaintiff's trade mark and also passing off its inferior goods as that of the superior goods of the plaintiff.

4. Summons in the suit were served upon the defendant who appeared through counsel and sought time to file the written statement on 23rd January, 2001. However, no written statement was filed. The defendant also stopped appearing. By order dated 13th July, 2001 the defendant was proceeded against ex-parte and the plaintiff was allowed to file the evidence by way of affidavit .Affidavit of Mr. Vikas Jain, one of the Directors of the plaintiff company, has been filed. He has deposed consistently with the averments made in the Plaint .He has also proved registration of the trademark COSMO in favor of the plaintiff as Ex.P-1. Sample of the plaintiff's carton is proved as Ex.P-2 and that of the defendant's carton as Ex.P-3.

5. From the aforesaid unrebutted testimony of the plaintiff and the documents on record, it stands proved that the plaintiff is the subsequent proprietor of the trade mark. The trade mark was originally registered in the name of Sobhan Lal trading M/s Hindustan Rimmer. Subsequently, it was transferred to M/s Gabs Laboratories by virtue of assignment deed dated 1st August, 1993. Thereafter it was further assigned in favor of the plaintiff with effect from 7th April, 1997 by virtue of Agreement dated 7th April, 1997 and an application for registration of the said Agreement is pending in the Trade Mark Office. Therefore, the suit filed by the plaintiff is maintainable as held in the case M/s. Modi Threads Limited Vs. M/s. Som Soot Gola Factory and another, .

6. By virtue of the said trade mark exclusive rights are conferred in favor of the plaintiff u/s 28 of the Trade and Merchandise Marks Act. Any other person who is using the trade mark in respect of goods either identical with or deceptively similar trade mark is guilty of infringement u/s 29 of the Trade and Merchandise Marks Act. This is so held in the case reported in AIR 1965 SC 910 and the relevant observations made therein read as under:

"In an action for infringement, the plaintiff must, no doubt make out that the use of the defendant's mark is likely to deceive, but where similarity between the plaintiff's and defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required, to establish that the plaintiff's right are violated "

7. The comparison of the two cartons, namely, that of the plaintiff as well as of the defendant, show marked similarities in packing, get up, lay out and colour combination. In fact, the defendant has tried to copy all the features of the plaintiff's packing material of COSMO toothpaste. The adoption of the trade mark COSCO is almost identical to the plaintiff's trade mark COSMO and when this product is sold by the defendant imitating similar features of packing, getup, lay out and colour combination, there is bound to be a confusion in the minds of the consumers that the product being sold by the defendant is that of the plaintiff's. The adoption of such features with almost identical mark and name by the defendant is clearly fraudulent with sole motive to cause confusion and pass off its goods as that of the plaintiff's. In fact when the violation of registered trade mark stands proved, motive is not even relevant. In such cases, the plaintiff shall be entitled to the relief, as (SIC). It would be apposite to quote here the judgment of the Apex Court in the case of Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co., holding as under:

"The action for infringement is a statutory right. It is dependent upon the validity of the registration laid down in Section 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. At common law the action was not maintainable unless there had been fraud on A's part. In equity, however, Lord Cottenham L.C. in *Millington v. Fox* held that it was immaterial whether the defendant had been fraudulent or not in using the plaintiff's trade mark and granted an injunction accordingly. The common law courts, however, adhered to their view that fraud was necessary until the Judicature Acts, by fusing law and equity, gave the equitable rule the victory over the common law rule."

8. Further, in the case of *Parle Products (P) Ltd. Vs. J.P. and Co., Mysore*, the Apex Court quoted following observations with approval *Karley's Law of Trade Marks and TradeNames*:

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

9. The suit filed by the plaintiff accordingly stands decreed. There shall be decree for permanent injunction restraining the defendant, its servants, agents, distributors, stockist or any one acting under or through it from in any manner manufacturing, marketing, distributing or selling any products by the use of the mark COSCO or any other mark or name deceptively similar thereto or otherwise infringing the plaintiff's aforesaid trade mark COSMO. There shall also be decree for permanent injunction restraining the defendant, its servants, agents, distributors, stockist or any one acting under or through it from in any manner manufacturing, marketing, distributing or selling any products with a pack design/carton and tube in the colour scheme like Annexure "X" which is reproduction of the plaintiff's product like Annexure" A. There shall also be decree for permanent injunction restraining the defendant, its servants, agents, distributors, stockist or any one acting under or through it from in any manner manufacturing, marketing, distributing or selling any products with a pack design/carton and tube in the colour scheme as that of the plaintiff's product and passing off their goods as the goods of the plaintiff. There shall also be an order for delivery upon affidavit by the defendant to the plaintiff for the purposes of destruction and/or obliteration as the case may be of all the offending goods, cartons, tubes, blocks, dies, labels, wrappers etc., price list, leaflets, literature and any other infringing material bearing the offending trade mark COSCO.

10. The plaintiff shall be entitled to cost. Decree be drawn accordingly.

11. Suit stands disposed of.