

(2000) 03 MAD CK 0020

In the Madras High Court

Case No : O.S.A. No's. 199 to 204 of 1999 and C.M.P. No's. 17181 to 17189 of 1999

Kaalai Malar Publications Pvt. Ltd. and 3 others

APPELLANT

Vs

Dinamalar and Others

RESPONDENT

Date of Decision : 06-03-2000

Acts Referred:

Citation : (2000) 03 MAD CK 0020

Hon'ble Judges : B. Akbar Basha Khadiri, J;A.S. Venkatachalamoorthy, J

Bench : Division Bench

Advocate : J. Rebello and S. Elambharathi, for the Appellant; Perumbulavil Radhakrishnan, S.M. Panickar and N. Ramesh, for the Respondent

Judgement

B. Akbar Basha Khadiri, J.—All these appeals have arisen in this ways:

One T.V. Ramasubbier originally started a Tamil daily under the name and style of "Dinamalar" at Trivandrum, Kerala State. Thereafter, he

shifted his business to Tirunelveli, wherefrom the Tamil daily ""Dinamalar" was published. The words "Dina" and "Malar" have been registered with

the Registrar of Trade Marks in Class 16 in registration No. 302070 on 13.01.1975. Ramasubbier had left behind five sons by name, R.

Venkitapathy, R. Krishnamurthy, R. Lakshmipathy, R. Raghavan and R. Sathyamurthy. The proprietary concern "Dinamalar" was converted into a

firm consisting of Ramasubbier and his five sons. K. Ramasubbu and K. Venkataraman are the sons of Krishnamurthy and L. Ramasubbu and L.

Adhimoolam are the sons of Lakshmipathi. Hema, Bhuvaneswari, Sudha, Kalpagam are the wives of K. Ramasubbu, L. Ramasubbu, Adhimoolam

and Venkataraman respectively. K. Ramasubbu, Venkataraman, L. Ramasubbu and Adhimoolam are working as Executives in Dinamalar. The

above facts are not in dispute. The case of the respondents/ plaintiffs is that the above said four persons know the business secrets of running a

daily newspaper successfully and they tried to float a company under the name and style of Kaalaimalar Publications (P) Ltd. to bring out a Tamil

daily under the name and style of "Kaalaimalar". Finding some difficulties in their starting the company, at their instance their wives have formed the

company under the name and style of "Kaalaimalar Publication Limited. They are trying to bring out a daily Tamil Newspaper under the name and

style of "Kaalaimalar". According to the plaintiffs, by forming the company, the defendants are trying to pass off their company as a unit of the

plaintiffs i.e., as a sister concern of Dinamalar. The plaintiffs have filed a suit in C.S. No. 524 of 1999 seeking the relief of injunction to restrain the

defendants namely the appellants herein, from infringing their trademark, from passing off their newspaper and also for infringement of copyright.

The plaintiffs have also filed a suit in C.S. No. 593 of 1999 against K. Ramasubbu, L. Ramasubbu who are said to be the executives of Dinamalar

and against M/s. Kaalaimalar Publications represented by its owner Adhimoolam and then against defendants 5 to 10 who are said to be the

proprietors of certain press, who have undertaken to do the printing work for the same reliefs which are sought for against the defendants in C.S.

No. 524 of 1999. The plaintiffs have filed O.A. Nos. 425/99, 426/99 and 427/99 in which they seek the following reliefs.-

(i) In O.A. No. 425 of 1999, the plaintiffs seek for an order of interim injunction restraining the respondents/defendants and others from using the

trade mark "Dinamalar" or any part thereof with the device of the Lotus bud Blooming and/or any other Trademark, device or symbol which are

an imitation of and deceptively similar in any manner whatsoever to that of the plaintiff's Trade Mark "'Dina Malar'" in English or any other language,

and in particular in Tamil so as to infringe the plaintiffs Trade Mark in Tamil publications by using the same or any other trade mark which is

identical or deceptively similar in respect of the respondent/defendant's publications, Dailies, Supplements, magazines, Diwali Annual, Weekly

editions, fortnightly editions, Calenders, Yearbooks, Stationery, Blocks, Boards and Advertisement material.

(ii) In O.A. No. 426 of 1999, the plaintiffs seek for an order of interim injunction restraining the respondents"/defendants and others from using the

trade mark "Dinamalar" in the three dimensional stylistic lettering or any part thereof with the device of the Lotus bud Blooming and/or any other

Trade Mark, device or symbol which are an imitation of and deceptively similar in any manner whatsoever to that of the plaintiff's Trade Mark

Dina Malar"" in English or any other language, and in to that of the plaintiff's Trade Mark ""Dina Malar"" in English or any other language, and in

particular in Tamil so as to infringe the plaintiffs Trade Mark in Tamil publications by using the same or any other trade mark which is identical or

deceptively similar in respect of the respondent/defendant's publications, Dailies, Supplements, magazines, Diwali Annual, Weekly editions,

fortnightly editions, Calenders, yearbooks, Stationery, Blocks, Boards and Advertisement material.

(ii) In O.A. No. 426 of 1999, the plaintiffs seek for an order of interim injunction restraining the respondents/defendants and others from using the

trade mark "Dinamalar" in the three dimensional stylistic lettering or any part thereof with the device of the Lotus bud Blooming and/or any other

Trade Mark, device or symbol which are an imitation of and deceptively similar in any manner whatsoever to that of the plaintiff's Trade Mark

Dina Malar"" in English or any other language, and in particular in Tamil so as to pass off the respondents/defendant's Corporate name or trading

style Kaalai Malar Publications (P)Ltd. as and for the Applicant /plaintiffs Business or as a unit or division thereof.

(iii) In O.A. No. 427 of 1999, the plaintiffs seek for an order of interim injunction restraining the respondent/defendant and others from using the

trade mark "Kaalai Malar" or any part thereof with the device of the Lotus bud Blooming and /or any other Trade Mark, device or symbol which

are an imitation of and deceptively similar in any manner whatsoever to that of the plaintiff's Trade Mark ""Dinamalar"" in English or any other

language, and in particular in Tamil so as to infringe the plaintiffs copyright in the stylistic three dimensional lettering and placement of the words in

relation to the device which is identical or deceptively similar in respect of the respondent/defendant's publications, Dailies, Supplements,

magazines, Weekly editions, fortnightly editions, Calenders, Yearbooks, Stationery, Blocks, Boards, Advertisement material, trading style or

name.

The plaintiffs have also filed the similar applications in O.A. Nos. 478 of 1999, 479 of 1999 and 480 of 1999 in C.S. No. 593 of 1999. Ex parte

ad interim injunction was granted. The respondents therein, namely the appellants herein filed Application Nos. 2531, 2532 and 2533 of 1999 in

C.S. No. 524 of 1999 to vacate the interim injunction. The learned single Judge before whom the matter came up for consideration took the view

that the respondents' use of the name of Ramasubbier, the founder of Dina Malar, his picture or photo and also the logo of a Blooming Lotus,

which is similar to the logo used by the applicants therein and thereby cause confusion in the minds of the public that the respondents company is a

sister concern of the applicants company and that the words "Kaalai Malar" are deceptively similar, to "Dina Malar" and accordingly, by common

order, allowed the applications filed by the applicants therein i.e., respondents herein and dismissed the applications filed by the respondents/

appellants herein. As against the common order passed by the learned single Judge, the respondents/defendants in both the suits, have come

forward with these Original Side Appeals.

We have heard the learned Counsel on both the sides. We have examined the trade marks and logos. We have also examined the relevant

authorities on the subject cited by the learned Counsel. In Shanmugavel v Associated Publishers (Madras) Ltd., etc. & 2 others (1995-2-L.W.458

(D.B.) a Division Bench of this Court consisting of M. Srinivasan. J. as His Lordship then was, and AR. Lakshmanan, J. has pointed out that in

matter of this sort, the plaintiff has to prove the following:-

- (1) that he has a prima facie case;
- (2) that the court's interference is necessary to protect him from irreparable or at least serious injuries;
- (3) that the balance of convenience is in his favour;
- (4) that there is no other sufficient remedy to protect his interest.

It is the case of the plaintiffs/ respondents herein that the defendants in C.S. No. 524 of 1999 have floated a company under the name and style of

Kaalaimalar Publication (P) Limited, and that by their words and deeds, they tried to pass off a sister concern of the plaintiffs. The defendants in

C.S. No. 524 of 1999 are all the daughters-in-law of the house. They are not the strangers. As rightly pointed out by the learned single Judge in

paragraph No. 8 of his order, there is no bar for some of the members of the family to form a company. Of course, it should not be in violation of the rights of the plaintiffs. It is settled law that if there is a right under the law, there must be a remedy for the violation. The remedy will be available, though the injury does not cause actual or pecuniary damage. If the plaintiffs/respondents cannot show a violation of any legal right, they cannot succeed merely on the ground of damage. In other words, violation of the legal right without sustaining damage i.e., *injura sine damnum*, which is actionable, whereas damage without violation of legal right *damnum sine injura* is not actionable.

2. In the instant case, the defendants in C.S. No. 524 of 1999 starting a new company does not violate any rights of the plaintiffs. In fact, there is nothing to indicate that the Articles of Association of the plaintiffs' firm contain any covenant that neither the Directors nor the descendants' or their spouses should start a company and also it is not the case of the plaintiffs. It is urged by the plaintiffs/respondents herein that the husbands of the defendants/appellants herein are the executives of the plaintiffs' firm and they may pass on certain secrecy of operation to the defendants. If that be case, the remedy lies elsewhere and not in a case for infringement of trade mark or for passing off. But the case of the plaintiffs/ respondents herein are that the defendants/ appellants herein are trying to create an impression that Kaalaimalar Publication (P) Limited is a sister concern of Dina Malar and thus they are trying to pass off their company as a unit of the plaintiffs. According to them, the defendants/appellants herein have intended to use a similar logo used by the plaintiffs/respondents herein. The plaintiffs' logo is a fully blossomed lotus, whereas the logo proposed to be used by the defendants/ appellants here is a blooming lotus. According to the plaintiffs/ respondents herein, the defendants/ appellants are using the picture or photo of T.V. Ramasubbier, the founder of Dina Malar and also his name in their letter-pad and other materials. In the course of the arguments, the learned Counsel for the defendants/appellants herein has stated that till the completion of trial in the suit, the defendants/appellants herein are not going to use the logo of lotus whether fully blossomed or blooming, the name of T.V. Ramasubbier, and his picture or photo. In view of the submission of the learned counsel, the apprehension of the plaintiffs/respondents is alleviated. Now without using the name Dina Malar and

the logo of Lotus and the picture or photo of T.V. Ramasubbier and his name, if the defendants/appellants are to run a company in the name of

Kaalai Malar Publications (P) Limited, it cannot be said that such act of the defendants amounts to passing off.

3. The next contention of the plaintiffs/ respondents are that (i) the defendants/appellants are trying to infringe the trade mark of the plaintiffs, (ii)

they are trying to pass off their goods as that of the plaintiffs/respondents and (iii) they are infringing the copy right of the plaintiffs/respondents.

4. There is distinction between the infringement action and passing off action. In *Ruston & Hornby Ltd. v. Z. Engineering Co.* (AIR 1970

S.C.1649), the Apex Court has pointed out that in a passing off action, the issue that would arise is, ""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"". The Apex Court has also pointed out that in an

infringement action, the issue is, "" Is the defendant using a mark which is the same as or which is a colourable imitation of the plaintiffs registered

trade mark"". A distinction has to be drawn between the same mark and similar mark. When the same mark is used in a sense, the public is

deceived into purchasing the defendants' goods in the belief that they are the plaintiffs goods. So a registered trade mark is a casualty. It is the duty

of the court to protect the trade mark. In such case, no further question would arise. In case of similar mark, a duty is cast upon the Court to

compare both the marks to find out if the offending mark is deceptively similar to the applicant's mark and to ask the question whether there is

likelihood of deception or confusion. In deciding the question, the judge is the final authority. The judge must approach the question from the point

of view of a man of average intelligence and imperfect recollection.

5. According to the plaintiffs/respondents, the plaintiffs/respondents have registered Dina Malar as a trade mark. If the defendants/ appellants are

to use the same mark, i.e., Dina Malar with any suffix or prefix like "Dina Malar India" or "Dina Malar Madras" or "Chennai Dina Malar" etc., the

suffixes and prefixes will be of no avail and such act would amount to infringement of trade mark. The case of the plaintiffs/ respondents is that the

defendants/appellants are using the word "Malar" in their proposed publication "Kaalaimalar". Of course, "Malar" is a part of the registered trade

mark. "Malar" is a generic word. But, only in case where the whole trade mark is adopted as it is by the defendants/appellants herein, the

plaintiffs/respondents can complain of infringement. If a part of generic term is used on a stand-by alone basis, then it can be said that the same

trademark yardstick may be applied. But, in case when part of the mark is used with a prefix, then the yardstick for similar trade mark has to be

applied, because neither the plaintiffs/ respondents nor the defendants/ appellants are using the word "Malar" alone. The plaintiffs/ respondents use

the mark with a prefix "Dina", i.e., Dina Malar, and the defendants/ appellants have a prefix "Kaalai" to make it "Kaalaimalar". Therefore, we have

to adopt the yardstick for similar mark. In Shanmugavel v. Associated Publishers (Madras) Ltd. etc. & 2 others cited supra, the Division Bench of

this Court have pointed out that so far as deceptive similarity is concerned, the test in both passing-off action and infringement action is the same, if

the two marks are not identical. Their Lordships have also pointed out that deceptive similarity has not to be decided by keeping the two marks

side by side and comparing them but to find out whether ordinary purchasers with a normally imperfect recollection or average memory would

mistake the goods of the defendant as that of the plaintiff. Both the Counsel have cited catena of decisions to point out what were all to be

considered as phonetically deceptive and what were all to be considered as visually deceptive. But so far as newspapers are concerned, in the

decision Shanmugavel v. Associated Publishers (Madras) Ltd.. etc., & 2 others cited supra, the Division Bench of this Court have pointed out as

under:-

But newspapers are not like articles such as tea, soap etc. or any other article bought by public, who take one particular word of a distinctive

name and are caught by the similarity in the type, size of colour of the packages. As pointed out in Both Wick v. The Evening Post (37 Ch.D.449),

the newspapers were bought only by those who will read the same and not merely take a hasty look at it. They will be in a position to form an

opinion upon the politics contained in the newspapers. They are persons of more intelligence and are not likely to be misled by the colour or

imitation of name as purchasers of house-hold articles etc.

It is thus clear that a purchaser of a newspaper who would be watchful, gets

what he wants and he cannot be equated with a person of imperfect recollection or weak memory.

6. The learned Counsel for the Plaintiffs/ respondents submitted that law relating to trade marks applied to the intellectual properties also and cited

the decision reported in Rediff Communication Ltd., v. Cyberbooth (AIR 2000 Bombay 27). In that case the similarity in internet domain name

"Rediff and "Radiff came into question whether the defendant's usage of " Rediff for its net work amounts to passing off of the plaintiff's net work

"Rediff". In that case, the learned single Judge referred to an earlier decision reported in Yahoo, Inc., v. Akash Arora (1999 PTC (19) 201)

where the plaintiff's domain name "Yahoo" is almost similar to "Yahooindia" and amounts to passing off. The learned single Judge is of the view

that considering the nature of the goods dealt with, the calibre of persons who deal with the goods has to be considered and not the calibre of an

ordinary individual. In other words, the learned judge has held that because of similarity in the domain name, even a sophisticated user may be

visiting a different internet from what he intended to visit. We are prepared to follow the decision of the Division Bench of this Court reported in

Shanmugavel v Associated" Publishers (Madras) Ltd.. etc. 2 others cited supra, because the case reported in Yahoo, Inc. v. Akash Arora cited

supra can be differentiated in this way. That is a case where a person may visit the internet site through the common media, i.e., through his

computer. The media is the same. He can reach out net site. But in case of newspaper, the media is entirely different. It is for the purchaser to

choose the media, i.e., the newspaper. It cannot be said that he would accept a wrong media in the place of what he wanted.

7. The similarity and deceptiveness pointed out by the plaintiffs/respondents are (1) the logo; and (2) the usage of the name, picture or photo of

T.V. Ramasubbier. Now, that the learned counsel for the defendants/appellants herein has stated that the defendants/appellants are not going to

use these materials in their publication till the disposal of the suit, the question of deceptive similarity need not be considered and there cannot be

any deceptive similarity at all.

8. The further argument of the learned Counsel for the plaintiffs/respondents herein is that the word "Malar" though a generic term has acquired a

secondary meaning referring only to Dina Malar Daily, because of its long use and reputation. The word "Malar" in Tamil would mean flower. It is

admittedly a generic term. But, it cannot be said that if a person goes to a newspaper vendor, and asks for a "Malar", the newspaper vendor

would give Dina Malar. As pointed out by the defendants/appellants herein in their submission, there are several publications which carry the word

"Malar" with a different prefixes. Further, the test whether the generic term has acquired a secondary meaning because of its long use or reputation

is an objective test and not a subjective test. In other words to establish this, the plaintiffs/respondents have to let in evidence to show that Dina

Malar has assumed such name and fame among the newspapers reading public that "Malar" would refer only to "Dina Malar". In fact, the learned

single Judge has also pointed out that another publication in the name of "Maalai Malar" is also available in the market. We do not think that at this

initial stage of seeking an ad-interim relief, such a question can be gone into whether generic term "Malar has acquired a secondary meaning.

In that regard, we disagree with the findings of the learned single Judge which is to the effect that "Malar" has acquired secondary meaning. To

summarise, the defendants have come forward with an assurance that they would not use the logo of a blossomed or blooming lotus, the name,

picture, or photo of T.V. Ramasubbier till the disposal of the suit. It is yet to be proved that the word "Malar" has assumed a secondary meaning

to indicate "Dina Malar" only which is a matter of evidence. In that view of the matter, we are inclined to set aside the orders passed by the

learned single Judge.

9. Lastly coming to the question of balance of convenience, balance of convenience would become relevant for consideration in case where the

scales are even. If the balance is already tilted the question of consideration of balance of convenience would not arise for consideration. In the

instant case, we have held that in the light of the submission of the learned Counsel that the defendants/ appellants herein are not using the logo,

name, picture or photo of T.V. Ramasubbier till the disposal of the suit, there is no similarity between the marks, which would tilt the balance of

convenience in favour of the defendants/ appellants herein. Even considering the balance of convenience, it should be stated that the balance of

convenience does not lie in favour of the plaintiffs/ respondents. Due to the injunction order, the defendants/ appellants had not been able to carry on their publications. Had there be no injunction, the defendants/ appellants would have carried on business and the loss suffered by the plaintiffs/ respondents can be ascertained and the plaintiffs/respondents can be adequately compensated. But, grant of injunction would throttle the business of the defendants/ appellants herein at the threshold and the loss suffered by them cannot at all be ascertained to maintain equity. We direct the defendants /appellants herein to maintain the accounts for the business and submit the same once in two months till the disposal of the suit in the trial Court. The learned single Judge is requested to consider taking all the suits for trial at an early date. In the result, all the O.S.As. are allowed. The common order passed by the learned single Judge is set aside. Consequently connected C.M.Ps. in the O.S.A. are closed as no orders are necessary.