

(2022) 09 CAL CK 0058

In the Calcutta High Court

Case No : CS No. 107 Of 2020, IA NO: GA 1 Of 2020

Kaira District Cooperative Milk Producers Union Ltd. & Anr.

APPELLANT

Vs

Maa Tara Trading Co. & Ors.

RESPONDENT

Date of Decision : 01-09-2022

Acts Referred:

Code Of Civil Procedure, 1908 — Order 8 Rule 10

Trade Marks Act, 1999 — Section 29, 29(2), 29(4), 29(4)(a), 29(4)(b), 29(4)(c)

Citation : (2022) 09 CAL CK 0058

Hon'ble Judges : Krishna Rao, J

Bench : Single Bench

Advocate : Sayan Roy Chowdhury, Victor Dutta, Manosij Mukherjee?

Final Decision : Disposed Of

Judgement

Krishna Rao, J

The plaintiffs have filed the instant suit seeking perpetual injunction restraining the defendants for infringement of registered trademark and passing off.

The plaintiff no. 1 is the registered proprietor of the trade mark "AMUL". The plaintiff no. 1 obtained registration in the year 1958. The trade mark registration obtained by the plaintiff no. 1 have been renewed from time to time and till date the validity is subsisting. The plaintiffs have received multiple awards over the years for their work. The plaintiffs endeavour is not merely commercial but also to provide consumers with the highest level of satisfaction and quality. During the financial year 2018-2019, the plaintiff has procured on an average 33.34 lakhs kilogram milk per day from more than 1,785 milk societies, aggregating more than 121.69 crore kilogram of milk for the entire financial year.

The trade mark "AMUL" is a brand known across India and across globe. The brand symbolizes a very Indian brand that has become a household name across the length and breadth cutting across class lines. The trade mark "AMUL", irrespective of goods it is applied upon, is the sole repository and identifier of the

plaintiff and its member. The trade mark "AMUL" symbolizes a movement among Indian Rural Community towards prosperity and Indian public perceives the trade mark "AMUL" having association of connection with the plaintiffs and no other. It is a combination of all the forgoing factors that had culminated into the trade mark "AMUL" being recognized as well known trade mark and, therefore, deserves a broader scope of protection against unauthorized use on none competing goods or services.

None appears for the defendants. Written statement has not been filed, despite publication of notice of the instant case on 20.06.2022 and 22.06.2022 in the English daily newspaper "The Statesman" and in Bengali daily news paper "Bartaman". The Counsel for the plaintiff prays that the present suit may be decreed by invoking provisions of Order 8 Rule 10 of the Code of Civil Procedure. He further submits that there are sufficient documents on record and also the fact the plaint is supported by an affidavit of the plaintiff, thus, it is not necessary to lead evidence. The fact leading to filing of the present case are that the plaintiff sometimes in the month of February 2020 came to know that candles under the mark "AMUL" are being offered on a complementary basis with purchase of cake at a famous cake shop at Kolkata. The plaintiffs through its local representatives have obtained sample from the said cake shops and find that the defendant no. 1 had not only usurped the well known trade mark of the plaintiff no. 1 but also adopted a similar writing style as that of the plaintiffs registered trade mark.

The plaintiff subsequently locates the defendant's shop and had obtained larger pack of candles bearing the mark "AMUL" along with the name of the defendant no. 2. The pack contained around 30 small packs of candles. As the plaintiffs were unaware of the association between the defendant and accordingly the plaintiffs called upon the defendants to provide details with respect to their association. The plaintiffs were also unaware of the exact constitution of the defendants except what was available on the infringing packets as obtained by the plaintiffs.

The defendants are not entitled to use the mark "AMUL" or any other mark deceptively similar thereto as that of the plaintiffs. The trade mark of the plaintiff no. 1 i.e. "AMUL" has assumed a secondary meaning and as such the trade mark "AMUL" is solely and exclusively identified with the goods and services of the plaintiffs. The said trade mark cannot be utilized by any person or entity other than the plaintiffs and also cannot be used in relation to any goods in service other than those of by the plaintiffs.

The defendants have knowingly, deliberately and fraudulently adopted the well known trade mark "AMUL" including an identical and deceptively similar font/writing style only to take undue advantage of the immense reputation and goodwill acquired by the plaintiffs in respect of the trade mark "AMUL" and make undue profits there from and in doing so have infringed the statutory right of the plaintiff no. 1. AMUL is a prior used and registered well known trade mark of the

plaintiffs by which it is identified globally.

Admittedly, the plaintiff no. 1 was registered on 01.07.1958 and the said registration is extended from time to time till date. The trade mark type is "DEVICE" and the word mark "AMUL". The certificate was issued on 24.11.2016. As per the list of well known trademarks, the name of the plaintiff no. 1 is appearing at serial no. 66.

Order 8 Rule 10 had been inserted by the legislature to expedite the process of justice. The Courts can invoke its provisions to curb dilatory tactics, often resorted to by defendants by not filing the written statements by pronouncing judgments against it. At the same time, the Courts must be cautious and judged the contents of the plaint and the documents on records as being of an unimpeachable character, not requiring any evidence to be left to prove its contents. The Supreme Court in C.N. Ramappa Gowda -vs- C.C. Chandergowda reported in (2012) 5 SCC 265 at held as under :-

"25. We find sufficient assistance from the apt observations of this Court extracted hereinabove which has held that the effect [Ed: It would seem that it is the purpose of the procedure contemplated under Order 8 Rule 10 CPC upon non-filing of the written statement to expedite the trial and not penalise the defendant] of non-filing of the written statement and proceeding to try the suit is clearly to expedite the disposal of the suit and is not penal in nature wherein the defendant has to be penalised for non-filing of the written statement by trying the suit in a mechanical manner by passing a decree. We wish to reiterate that in a case where written statement has not been filed, the court should be a little more cautious in proceeding under Order 8 Rule 10 CPC and before passing a judgment, it must ensure that even if the facts set out in the plaint are treated to have been admitted, a judgment and decree could not possibly be passed without requiring him to prove the facts pleaded in the plaint.

26. It is only when the court for recorded reasons is fully satisfied that there is no fact which needs to be proved at the instance of the plaintiff in view of the deemed admission by the defendant, the court can conveniently pass a judgment and decree against the defendant who has not filed the written statement. But, if the plaint itself indicates that there are disputed questions of fact involved in the case arising from the plaint itself giving rise to two versions, it would not be safe for the court to record an ex parte judgment without directing the plaintiff to prove the facts so as to settle the factual controversy. In that event, the ex parte judgment although may appear to have decided the suit expeditiously, it ultimately gives rise to several layers of appeal after appeal which ultimately compounds the delay in finally disposing of the suit giving rise to multiplicity of proceedings which hardly promotes the cause of speedy trial.

27. However, if the court is clearly of the view that the plaintiff's case even without any evidence is prima facie unimpeachable and the defendant's approach is clearly a dilatory tactic to delay the passing of a decree, it would be justified in

appropriate cases to pass even an uncontested decree. What would be the nature of such a case ultimately will have to be left to the wisdom and just exercise of discretion by the trial court who is seized of the trial of the suit."

Accordingly, for invoking the provisions under Order 8 Rule 10 of CPC, this Court must put to test the averments in the plaint and consider their veracity. The present case has been primarily filed by the plaintiff to protect its trademark "AMUL" as well as its copy right in the original artistic work of packaging/label. At this juncture, this Court deem it appropriate to reproduced the mark and packaging/label of the parties :-

Trade of the parties : -

Plaintiff's Mark

Defendant's Mark

AMUL

Nil

Packaging/Labels of the parties :-

Plaintiff's Mark

Defendant's Mark

INFRINGEMENT OF TRADE MARK :-

Based on the documents placed on record, there is no doubt that the plaintiff is the registered proprietor of the trademark "AMUL". Section 29 (2) of the Trade Marks Act, 1999 stipulates the conditions when usage by a person amount to infringement of a registered trademark. Section 29 (4) reads as follows:-

"29 (4). A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which -

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark."

In respect of test of from adjudicating infringement, the Delhi High Court in The Royal Bank of Scotland Group PLC -vs- Sharekhan Ltd. reported in 216 (2015) DLT 197, after taking into consideration numerous judicial pronouncement, held that : -

"5. The test of comparison of the marks side by side is not a sound one since a

purchaser will seldom have the two marks actually before him when he makes his purchase. The eye is not an accurate recorder of visual detail and marks are remembered by general impression or by some significant detail rather than by any photographic recollection of the whole. While judging the question as to whether the defendants have infringed the trade mark by colourable imitation of the mark or not, the Court has to consider the overall impression of the mark in the minds of general public and not by merely comparing the dissimilarities in the two marks.

36. In order to establish infringement, the main ingredients of Section 29 of the Act are that the plaintiff's mark must be registered under the Act; the defendant's mark is identical with or deceptively similar to the registered trade mark; and the defendant's use of the mark is in the course of trade in respect of the goods covered by the registered trade mark. The rival marks are to be compared as a whole. Where two rival marks are identical, it is not necessary for the plaintiff to prove further that the use of defendant's trademark is likely to deceive and cause confusion as the registration shows the title of the registered proprietor and the things speak for themselves. In an infringement action, once a mark is used as indicating commercial origin by the defendant, no amount of added matter intended to show the true origin of the goods can effect the question. If Court finds that the defendant's mark is closely, visually and phonetically similar, even then no further proof is necessary."

Test of comparison of rival marks : -

"37 (i) In Pianotist Co. Ltd.'s application, 1906 (23) R.P.C. 774, it was observed as follows :

"You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as trade mark for the goods of the respective owners the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods-then you may refuse the registration, or rather you must refuse the registration in that case."

...

(iii) In the case of Sandow Ltd.'s Application, 31 R.P.C. 205 it was clarified that among the surrounding circumstances to be taken into account, one of considerable importance is the imperfect recollection a person is likely to have of a mark with which he is only vaguely acquainted. While approving the above tests for comparison of the two word-marks, the Supreme Court held in F. Hoffmann-La Roche & Co. Ltd. Vs. Geoffrey Manner & Co. Pvt. Ltd. MANU/

SC/0302/1969 : (1969) 2 SCC 716 that:

"It is also important that the marks must be compared as whole. It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in the other case there is no sufficient similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark."

(iv) In the case of Tokalon Ltd. v. Devidson and Co. 32 R.P.C. 133, it was observed that:

"...We are not bound to scan the words as we would in a question of compatriotic literarum. It is not a matter for microscopic inspection, but to be taken from the general and even casual point of view of a customer walking into a shop." ...

(vii) In the decision reported in MANU/MH/0063/1951 :AIR 1951 Bom 147, Bom 147, James Chadwick & Bros. Ltd. v. The National Sewing Thread Co. Ltd. Chagla C.J. and Bhagwati, J.; referring to the words "likely to deceive or cause confusion" in section 10 of the Act observed as follows:-

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

In the present case, a comparative analysis of the marks as represented in paragraph above, clearly shows a similarity in the marks of the parties. The defendants have cleverly used the trademark "Amul" in the candle packet of the defendants. It is settled law, that the mark should not be meticulously compared side by side as it is not possible for the consumer to have an opportunity to do the same.

It is clear that AMUL marks of the plaintiff have been applied are being applied

by the defendants in the candle packets of the defendants. In view of the forgoing, this Court is of the view that the defendants are infringing the registered trademark of the plaintiff under Section 29 (4) (a) (b) and (c).

Passing Off :-

Passing off action arises out of common law and is not pre-conditioned on registration. The term passing off was explained by James, L.J. in as under : -

"...I have often endeavoured to express what I am going to express now (and probably I have said it in the same words, because it is very difficult to find other words in which to express it) that is, that no man is entitled to represent his goods as being the goods of another man; and no man is permitted to use any mark, sign or symbol, device or other means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer."

Lord Diplock in *Erven Warnink Besloten Vennootschap v. J. Townend and Sons (Hull) Ltd.*, (1979) A.C. 731 had identified five essentials to establish an action of passing off the relevant excerpt is as under:-

"My Lords, *A.G Spalding and Brothers v. A. W. Gamage Ltd.*, 84 L.J.Ch 449, and the later cases make it possible to identify five characteristics which must be present in order to create a valid cause of action for passing off: (1) a misrepresentation, (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a *quia timet* action) will probably do so."

The forgoing essentials have been accepted by the Hon'ble Supreme Court in *Cadila Health Care Ltd. -vs- Cadila Pharmaceuticals Ltd.* Reported in (2001) 5 SCC 73 and *Heinz Italia -vs- Dabur India Ltd.* reported in (2007) 6 SCC 1. In *Cadila Health Care Ltd. (supra)*, the Supreme Court had further laid down the following decisive tests for checking deceptive similarity : -

"5. Broadly stated, in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors are to be considered:

(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.

(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trade marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods.

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

36. Weightage to be given to each of the aforesaid factors depending upon facts of each case and the same weightage cannot be given to each factor in every case."

In the present case, applying the aforesaid test, this Court is of the view that the defendants have tried to dupe the general public by using of an identical mark "AMUL" in respect of candles in violation of statutory rights as well as the common law rights of the plaintiffs. Such usage would inevitably lead to loss of revenue as also that of goodwill. Accordingly, the defendants have indulged into the offence of passing off. The defendants have infringed the registered trademark of the plaintiff as well as committed the torts of passing off.

The present suit is also a commercial suit within the definition of the Commercial Court, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 and it was the clear intention of the legislature that such cases should be decided expeditiously and should not be allowed to linger on. Accordingly, if the defendant fails to pursue his case or does so in a lackadaisical manner by not filing written statements, the courts should invoke the provisions of Order 8 Rule 10 to decree such cases.

Resultantly, having being satisfied with the averments made and duly supported by documents and affidavit and no written statement being on record, this Court deem it fit case to for invoking the provisions of Order 8 Rule 10 of the Code of Civil Procedure.

Accordingly, the present suit is decreed in favour of the plaintiff and against the defendants in terms of prayer (a), (b) and (c) of the plaint.

CS 107 of 2020 is disposed of. IA No: GA 1 of 2020 is accordingly disposed of. Decree be drawn accordingly as expeditious as possible.