

(1995) 07 DEL CK 0096

In the Delhi High Court

Case No : Interim Application No. 11909 of 1994 and Suit No. 2883 of 1994

Kuldip Singh trading as Saini Spares

APPELLANT

Vs

S.K. Auto Industries and Another

RESPONDENT

Date of Decision : 01-07-1995

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 21, 34

Citation : (1995) 59 DLT 725 : (1995) 34 DRJ 355

Hon'ble Judges : N.G. Nandi, J

Bench : Single Bench

Advocate : K.L. Aggarwal, S.K. Aggarwal, M.R. Bhalerao and Pankaj Luthra, for the Appellant;

Judgement

N.G. Nandi, J.

(1) In the suit, challenging the infringement by the defendants, of the plaintiffs registered trade mark "SAINI" in relation to the manufacturing and marketing of hydraulic Brake Parts for motor land vehicles, all spare parts for motor land vehicles, oil seals and filters of all kinds, helmet, switches, lighting signals, electric starters, headlights, parts and fittings thereof, for motor land vehicles and the artistic carton/ label with the said trade mark, the plaintiff, by this is seeks to restrain the defendants from manufacturing, selling, offering for sale or otherwise dealing in the clutch system containing clutch plates, cover assemblies and lever kit minor for use in the motor land vehicle under the impugned trade mark/carton/label entitled "SAINI" or any other identical with and/or deceptively similar trade mark/carton/label, pending the hearing and disposal of the suit.

(2) The say of the plaintiff is that the plaintiff has been using his fanciful trade mark "SAINI" for the business of manufacturing and marketing of hydraulic brake Parts for motor land vehicles, all spare parts for motor land vehicles, oil seals and filters of all kinds, helmet, switches, lighting signals, electric starters, headlights, parts and fittings thereof, for motor land vehicles since 1964; that the plaintiffs trade mark "SAINI" has been registered with the Registrar of Trade

Marks in Classes 12, 7, 9 and 11 of the Trade & Merchandise Marks Act, 1958 and that the said mark has been registered on 26.2.1990, 5.6.1990 and 12.6.1990 for all spare parts and fittings respectively; that the plaintiffs application for registration has been accepted for advertisement by the Registrar of Trade & Merchandise Marks and that the plaintiffs trade mark has been advertised in Trade Mark Journal at pages 312 and 412 on 1.6.1994 and 1.7.1994 respectively. It is alleged that defendants have been using the mark "SAINI" with carton, labels and get-up, lay-out and colour scheme, identical and/or deceptively similar to the registered trade mark "SAINI" of the plaintiff; that the adoption and use of the said trade mark and artistic work on the carton/label on the part of the defendants amounts to infringement of the plaintiffs aforesaid trade mark and reputed trade mark "SAINI" and the artistic work on the carton/label "SAINI", duly registered under the Copy Right Act, 1957. The manner, in which the defendants are using the said trade mark on its cartons/labels apparently indicates the intention of defendants to give impression that their goods are coming from the plaintiff or their goods are connected with plaintiff in some or the other manner and that the defendants are passing off their inferior and substandard goods as and for the quality goods as manufactured by the plaintiff.

(3) As against this,, the say of the defendants is that the trade mark "SAINI" being a common name is not distinctive of the plaintiffs goods which they were not manufacturing; that the plaintiff can not claim exclusive right for the use of the word "Saini" in respect of all goods; that the plaintiff had thorough knowledge about the adoption and user of mark "SAINI" in the year 1990. The suit of plaintiff is bad for the reason of delay, laches and acquiescence; that the colour scheme, get up, lay out and writing style and arrangement of words of the defendants' label are altogether different; that the plaintiffs trade mark has been registered for different goods; that the defendants have been manufacturing, selling clutch plates; that there is no question of infringing plaintiffs trade mark because the use by the defendants, of the mark "SAINI" is for different goods and the action of the defendants is not in violation of the rights of the plaintiff.

(4) It is submitted by Mr. Aggarwal, counsel for the plaintiff, that the plaintiffs mark "SAINI" is registered since 1966 and the same is also registered under the Copy Right Act. plaintiff has sale all through-out India and the(r) defendants have been passing off their goods as that of the plaintiff and that the confusion is likely to mislead the customer whose interest needs to be protected; that the mark "SAINI" can not be used by the defendant. As against this, it is submitted by Mr. Bhalerao, counsel for the defendant, that the plaintiffs product is hydraulic brake parts and the defendants have been dealing" in manufacturing of clutch plates. There is no question of passing off and the defendants' goods are different; that the defendant's sir-name is Saini and u/s 34 of the Trade & Merchandise Marks Act, the plaintiff can not claim exclusive use of mark Saini; that there is no likelihood of deception or confusion.

(5) It is not in dispute that the plaintiff as well as the defendants have been manufacturing and selling the automobile parts relating to motor land vehicles in the name and style "SAINI". The mark of plaintiff as well as the defendants has been placed on record by the plaintiff. The plaintiffs mark is to be found at "A", where, on the carton or the box, plaintiffs mark "SAINI" is shown having "I" highlighted therein. In the plaintiffs label, out of five letters, first, two i.e. "S" and "A" and the last two words "N" and "I" have been written in same size whereas the letter "I" in between, is about three times bigger in length as compared to other letters S, and N. At the top of this very letter "I" it has been intersected with word "GENUINE" (all the letters in black colour with yellow base) whereas the label of defendants' mark is shown at "B" with "SAINI" in red letters. Both the marks are in yellow base/back ground. Defendants' mark having a green line around with thick green colour on two sides, left and right. It is suggested that defendants have been using mark "SAINI" since 1990 whereas the plaintiff has been using the mark since 1966.

(6) The defendants filed objections u/s 21 of the Trade & Merchandise Marks Act with the Registrar of Trade Marks opposing/objecting to the registration of plaintiffs mark "SAINI". At page 33, true copy of the said objections has been produced by the plaintiff, wherein the defendant has stated that "the mark in respect of which the applicants (plaintiffs) are seeking registration, consist of word "SAINI" which is similar to the said trade mark. The registration and use of the impugned mark is bound to cause confusion "and deception among the trade and public". It is further stated in para 2 that "mark in respect of which the applicants are seeking registration, is confusingly and deceptively similar to the said trade mark". In para 9, it is stated that the over-all impression of the mark in respect of which the applicants are seeking registration is such that it can be easily mistaken and confused with the said trade mark". In para 10, it is stated that "the goods, for which applicants are seeking registration, are identical to our (defendants) goods; that the channels of trade of both applicants goods and our goods under the said trade mark are the same in that the applicants goods as well as our goods would be sold in the same shops, over the same counters and to the same class of purchasers". In para 14, it is contended that "inevitable confusion will result from the use of the trade mark consisting of the word "SAINI" in respect of which the applicants are seeking registration and is calculated to facilitate and lead to passing-off of the applicants goods as and for our goods or as goods associated with our company".

(7) It may be seen from the above that what the plaintiff has been alleging in this suit against the defendants, the defendants have alleged against this plaintiff in their objections u/s 21 of the Trade & Merchandise Marks Act before the Registrar, Trade & Merchandise Marks as regards the registration of mark "SAINI" applied for by the plaintiffs. Thus, on defendants' own say, both the marks are similar to each other and registration and use of impugned mark is bound to cause confusion and deception amongst the trade and the public and that the mark is confusingly and deceptively similar to each other and the mark can be

easily mistaken and confused with the mark applied for by the plaintiff and that the goods are also identical to the defendants' goods and the channels of trade of both the plaintiffs and defendants' goods under the said trade mark are the same and that the goods of both would be sold at the same shops over the same counter and to the same class of purchasers and that the mark would lead to passing off the goods of each other for each other or as the goods associated with each other.

(8) An answer to the defense u/s 34 of Trade & Merchandise Marks Act by the defendants is to be found in the decision in the case of Bajaj Electricals Ltd., Bombay versus Metals & Allied Products, Bombay and another (reported in Air 1988 Bom 16). In the case before the Bombay High Court, the plaintiffs were carrying on the business as manufacturers of electric lamps, lighting fittings, accessories, kitchen appliances such as stoves, heaters, toasters, mixers, grinders, pressure cookers and kitchen wares. Plaintiffs were incorporated in 1938 under the name "Radio Lamp Works Limited" which name was changed to "Bajaj Electricals Limited" in the year 1960. Defendant No.1 was a partnership firm and defendant No.2 was a firm marketing the products manufactured by defendant No.1 firm and that the defendants were not using any trade mark in respect of products manufactured by them and the plaintiffs complained that with a view to trade upon the reputation acquired by the plaintiffs' trade mark consisting of the word "Bajaj", defendant No.1 adopted an identical mark "Bajaj" and the only dissimilarity between the mark of the plaintiff and the mark of defendant No.1 is that the first letter "B" is in capital and the mode of writing letter "B" is slightly different and all the words are joined. In light of these facts, the Division Bench of the Bombay High Court observed that "the trade name of the plaintiff was widely advertised and gained wide reputation for a number of years. The partners of the defendant firm were carrying on their business with 'the mark consisting of their family name and it was identical and deceptively similar to the trade mark of the plaintiffs. There was identity of goods, identity of mark and identity of consumers in respect of the goods manufactured by the plaintiff and that of the defendants. The articles of the plaintiff and the defendants were available in the same shops. The defendants were attempting to pass off their goods with the same mark with the intention to secure advantage of the reputation earned by the plaintiffs." It has been held that "the defendants were using the family name not" as a trading style but as a trade mark or trade sign. Such use is not permissible. The fact that the damages would be suffered by the plaintiffs, can not be ignored and the actual sufferance of the damages can not be established on the date of the institution of the suit." At page 170, the observations, which read as under, have been extracted from the decision reported in 1962 Rpc 265 in the case of Parker-Knoll Limited versus Knoll International Limited by the House of Lords :-

"IN the interests of fair trading and in the interest of all who may wish to buy or to sell goods the law recognises that certain limitations upon freedom of action are necessary and desirable. In some situations the law has had to resolve what

might at first appear to be conflicts between competing rights. In solving the problems which have arisen there has been no need to resort to any abstruse principles but rather, I think, to the straightforward principle that trading must not only be honest but must not be unintentionally be unfair."

(9) There is no dispute that the plaintiffs' user and the registration of the mark are much prior. The objections to the advertisement of the registration of the plaintiff's mark in class 12 in Trade Mark Journal 1090 dated 1.11.1994 at page 1099, relevant portion whereof has been referred to above, clearly establishes the ingredients necessary for the grant of injunction on defendants' own say. Since the objections in para 7,8,9,10 and 14 at page 34 have been reproduced above, I do not propose to repeat the same over again and on defendants' own objections, the plaintiff would be entitled to the injunction following the principle laid down in the Division Bench judgment of the Bombay High Court, referred to above and on the principle that there can be one mark, one source and one proprietor.

(10) In the result, the plaintiff would be entitled to the injunction as to allied, and cognate products as the purchaser may be led to believe the goods of the defendants to be that of the plaintiff or plaintiff's association/connection with the defendants goods. It may also be appreciated that the plaintiff as well as the defendants are the manufacturers of parts of motor land vehicles and sold by the same shops and at the same counters and the class of purchasers being drivers, motor mechanics or the persons working with the motor mechanics, the possibility of deception and confusion would be very much there and the plaintiff's right prima-facie to restrain the defendants from using the trade mark, would extend to the cognate goods, namely, clutch system, i.e. clutch plates, cover assemblies and lever kit minor etc. when the plaintiff is the manufacturer of hydraulic brake parts and other parts for motor land vehicles, oil seals, filter, helmets, switches, lighting signals and electric starters, headlights and parts and fittings thereof. The defendants have been using their family name not as a trading style but as for trade mark or trade sign, and such user even for cognate/allied goods would not be permissible, and Therefore, the defendants have to be restrained by ad interim injunction.

(11) In the result, this I.A. is allowed and the defendants are restrained in terms of Para 19 of the I.A, pending the hearing and disposal of the suit.

(12) I.A. stands disposed of accordingly.