

(2004) 08 MAD CK 0023

In the Madras High Court

Case No : O.A. No's. 487 and 488 of 2004 and A. No. 2158 of 2004 in C.S. No. 460 of 2004

Maya Appliances Private Limited

APPELLANT

Vs

Pigeon Appliances Private Limited and Others

RESPONDENT

Date of Decision : 18-08-2004

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Section 148A
Copyright Act, 1957 — Section 62
Limitation Act, 1963 — Section 4
Specific Relief Act, 1963 — Section 38

Citation : (2004) 4 CTC 334

Hon'ble Judges : S. Ashok Kumar, J

Bench : Single Bench

Advocate : T.R. Rajagopalan, for T. Poonkuzhali, G. Vimal and Rajinikanth Madhavan, for the Appellant; T.L. Ram Mohan, for A.R. Sampath, Suresh Gulecha and S. Selvakumari, for the Respondent

Final Decision : Dismissed

Judgement

S. Ashok Kumar, J.—The applicant/plaintiff has filed the suit (i) for a judgment and decree against the respondents/defendants for a

declaration that the plaintiff is the owner of the trade mark CHEFPRO and CHEFPRO PLUS, (ii) for a declaration that the plaintiff is the absolute

owner of the copyright in the lay out, colour scheme, get up, design, artistic work, etc., of the CHEFPRO and CHEFPROPLUS series of mixer

grinders and its accessories, (iii) for permanent injunction to restrain the defendants, their servants, agents, employees from in any manner passing

off the defendant's goods as that of the plaintiff's by selling, advertising or offering to sell or using the plaintiffs Trade Marks or any mark or

product which is identical with confusingly similar or deceptively similar to the

plaintiffs Trade Marks and/or lay out, colour scheme, get up, design, artistic work, etc., of the products, and (iv) for permanent, injunction restraining the defendants, their servants, agents, employees from in any manner infringing the copyright in the design,, configuration and technical specifications, layout, colour scheme, get up, contents of the instruction manual, artistic work and/or literary work comprised in/reproduced on the plaintiff's products.

2. The contentions of the applicant/plaintiff are as follows:

The applicant, a partnership firm, was established in 1978 as MAYA APPLIANCES & CONTROL EQUIPMENTS. The applicant spent

considerable time and resources in Research and Development and within two years of establishment, the applicant introduced mixer grinders into

the market in May 1980. In 1981 the applicant formed a new partnership firm MIXIES AND APPLIANCES. In 1985 the applicant introduced

new mixie range under the Trade Mark PREETHI, which was subsequently registered as a trade mark. The applicant through its product range

has acquired a distinct reputation and goodwill both in India and several countries abroad for their superior quality and technical excellence. The

applicant's brand PREETHI owing to its superior quality is a popular household name and in the last 25 years of its existence, is an undisputed

market leader in a whole range of kitchen appliances. The applicant is engaged in the business of manufacturing, marketing and after sales services

in the range of kitchen appliances viz., mixer grinders, coffee makers, micro oven and electric cookers under popular brand PREETHI among

various other trade marks. The products of the applicant meet international quality and safety standards certified by various international certifying

bodies. The applicant has over sixteen lakh customer base both in India and several countries abroad. The applicant has more than 22 branches,

2000 dealers and more than 300 authorised service centers across India.

3. The applicant earns an average of Rs.75 lakhs per year through the sale of the products and has incurred a considerable sum towards

marketing, promoting and advertising its products in both print and visual media. The applicant, incurs an average of Rs. 90 lakhs per year towards

marketing, promoting and advertising expenses.

4. The applicant introduced a premium and improved series of heavy duty mixer

grinder bearing the Trade Mark PREETHI CHEFPRO in

September 1995 and PREETHI CHEFPRO PLUS in February, 1997. The applicant engaged M/s.Icarus Design Consultants, a professional

consultancy firm in Bangalore to improve upon its existing products and to launch a new range of products bearing the trade marks CHEFPRO and

CHEFPROPLUS. M/s.Icarus carried out the design development of the applicant's CHEFPRO & CHEFPROPLUS series for the body,

switches, jars and jar lids, jar handles and Graphics and branding. The distinctive and striking features including colour scheme, shape of the jar

and handle, overall get up and layout of the applicant's CHEFPRO and CHEFPROPLUS series have helped the applicant in attaining immense

reputation and goodwill. The applicant has also made an application for registration of Trade Mark PREETHI CHEFPRO PLUS in India.

5. The products of the applicant has a unique user friendly handle for its jars. The look and feel of the applicant's handle has become distinctive

and exclusive of all the applicant's products so much so that the consumer and traders immediately recognise and associate the exclusive shape,

colour scheme, get up and design of the hand with the applicant. The applicant has introduced a distinct blade well known in the trade circles,

especially by the dealers as ""S"" blade that has been developed following extensive Research & Development and expenditure by the applicant. The

applicant has introduced the 750 watts motor in the Chefpro & Chefproplus series to give the consumers the benefit of faster, efficient and user

friendly mixer grinder.

6. During August-September, 2003, the applicant commemorating the silver Jubilee celebrations organised a launch event for new and improved

series of CHEFPRO at Kodaikannal and incurred a huge promotional expenditure and 600 dealers at a stretch of 11 days had taken part in the

launch. The applicant hired the services of the event management company EVENTFUL of Chennai and through them engaged a performer to

introduce the product in an innovative and captivating manner. For a period of 11 days the performer introduced the improved series of

CHEFPRO and CHEFPROPLUS to the dealers explaining the unique advantages, feature and functioning of the products.

7. In August 2002, one Mr.Rajendra J.Gandhi representing the 2nd and 3rd

respondent approached the applicant to do business with the applicant. The said Rajendra J. Gandhi during the visit of the applicant's factory was explained the requirement and handed over a sample of the applicant's CHEFPRO and CHEFPROPLUS jars and drawings and the applicant gave clearance for production of jars for his products. The 2nd and 3rd respondents supplied a total number of 3550 jars to the applicant out of which 1104 jars were rejected due to nonconformity on the basis of quality Control Inward Inspection carried out by the applicant. The said Rajendra J. Gandhi had assured the applicant to deliver jars in compliance with the quality specifications of the applicant. The applicant was thoroughly misled by the false assurance from the said Rajendra J. Gandhi of the respondents and in July 2003 sent fresh technical drawings with quality specifications for development of jars, simultaneously asking for the price quotation from the respondents for manufacturing the same. The respondents neither responded to the communication, nor sent their quotation for production of the specified jars.

8. Around October, 2003 to the shock and surprise of the applicant it came to their knowledge that the respondent organised a dealer's meet at Chennai launching PIGEON CHEFMATE AND CHEFMATEPLUS mixer grinders. The respondent with ulterior motives employed the services of the same performer who launched the applicant's CHEFPRO and CHEFPROPLUS products. The respondent thus tried to mislead the traders and dealers that there is a trade connection between the applicant and the respondent. The 2nd and 3rd respondents who were engaged in the business of manufacture and sale of Pressure Cooker and Gas Stoves under the brand PIGEON through the 1st respondent unscrupulously and with ulterior motives entered in the field of mixer grinder for the first time by launching an infringing and identical product viz., colour scheme, get up layout of the applicant's mixer grinders adopting deceptively, visually and phonetically similar trade marks viz., CHEFMATE AND CHEFMATE PLUS. The respondent's act of engaging the same artist/performer who had the first hand knowledge of the applicant's mixer grinders only shows

- the mala fide intention of the first respondent to misrepresent and cause confusion regarding the source of the first respondent's mixer grinder amongst the traders and public. The first respondent has erected huge hoardings

at various locations throughout the city of Chennai and other places displaying the deceptively similar mixer grinder with prominent and striking features including the colour scheme, get up, layout of the applicants series of CHEFPRO and CHEFPROPLUS mixer grinders. The respondent also advertised their products in the newspapers.

9. The applicant, to counter the criminal breach of trust, initiated criminal complaint in C.C.No.295 of 2004 in the Metropolitan Magistrate Court, Chennai. The substandard goods supplied by the respondents and passed off under the goodwill of the applicant has severely damaged the goodwill and reputation of the applicant's products. The applicant has also compiled an original customer friendly Instruction Manual containing figurative arrangement of the mixer grinder, user instructions such as DO's and DON'Ts, grinding instructions, cleaning instructions and operational instructions. The applicant therefore has a copyright over the Literary and artistic work of the instruction manual. The 1st, 2nd and 3rd respondents conveniently with ulterior motives infringed the copyright in the applicant's instruction manual by copying verbatim substantial portion/passages,

10. The first respondent's CHEFMATE series comprises of identical dimension, colour scheme, lay out, get up, etc., of all the jars and handle popularly and exclusively associated with applicant's CHEFPRO and CHEFPROPLUS series of mixer grinder. The applicant's CHEFPRO and CHEFPROPLUS mixer grinder series and the first respondent's CHEFMATE and CHEFMATE PLUS fall under the same sphere of goods and consumers. The products of the applicant and the first respondent are displayed at the same stores, occupy the same shelves attracting the same class of consumers. The consumers are deceptively led to believe similar product displayed in the promotional hoarding of the first respondent, comes from the house of the market leader and the most trusted company, viz., the applicant. Taking advantage of the reputation and goodwill of the applicant's product, the respondents are falsely claiming and misleading the dealers, traders, distributors and consumers that respondents are the suppliers and manufacturers of applicant products as if both the products are from the same source. The misrepresentation and deceptive marketing carried on by the first respondent is causing confusion to gullible

consumers, members of the trade and such false claim will definitely prejudice the hard earned customer loyalty and long standing reputation and goodwill of the applicants.

11. The resemblance and striking features of the respondent's product and trade mark with that of the applicant's product and trade mark is a

clear evidence of the dishonest and fraudulent intentions of the respondent to deceive and confuse the public, consumer and traders. The injury

caused by the act of passing off by the first respondent is irreparable and money compensation would not be sufficient to redress the continuing

harm resulting from the tort of passing off committed by the respondents. The respondents have violated the applicant's rights. The applicant prays

to grant an ad interim injunction restraining the respondents, their men, agents from in any manner infringing the copyright in the design,

configuration and technical specifications, layout, colour scheme, get up, contents of the instruction manual, artistic work or literary work

comprised in/reproduced on the applicant's CHEFPRO and CHEFROPLUS mixer grinder series and to restrain the respondents, their servants,

agents, from in any manner passing off the defendant's goods as that of the applicant's by selling, advertising or uttering to sell or using the

applicant's trade marks or any mark or product which is identical with, confusingly similar or deceptively similar to the applicant's trade marks

CHEFPRO and CHEFPROPLUS mixer grinders and to appoint an Advocate Commissioner to go to the place of the defendants and take an

inventory and seize the infringing goods, dies, articles, packets, cartons, packaging materials, advertising materials etc.,

12. The respondents have filed a common counter affidavit, wherein they have contended as follows:

The suit which has been filed without obtaining leave to sue the defendants who are residing outside the jurisdiction of this Court is not

maintainable. The provision of Clause 12 of the Letters of Patent is mandatory and the suit filed without complying with the terms of the said clause

is liable to be dismissed in limine. Clause 14 of the Letters Patent contains mandatory provisions which cannot be dispensed with without leave of

the Court and at the fancy, of the plaintiff. The applicant/plaintiff is not the registered owner of the designs alleged to have been perfected by him

and hence cannot complaint infringement of design. According to the applicant, the designs for the mixer grinder was created by M/s.Icarus Design

Consultants, Bangalore, who are not parties to the suit and the applicant has not produced any document from the said designer assigning his

design and copyright to the applicant. The applicant cannot maintain an action for infringement of design or copyright not owned by it. The

applicant is marketing its product of mixer grinder under the trade name of PREETHI. Likewise, the respondents are marketing the mixer grinder

under the trade name of PIGEON. The applicant has deliberately misrepresented the facts as there was no similarity phonetically or literally

between the brand name PREETHI and PIGEON marketed by the applicant and the respondents. Apprehending filing of such a suit the

respondents filed Caveat Petition No.277 of 2004 on 18.2.2004. The applicant has suppressed the fact of filing of Caveat and has secured ex

parte orders during the vacation Court. The applicant has filed C.C.No.295 of 2004 on the file of the VIII Metropolitan Magistrate Court, George

Town, Chennai against all the three respondents and other Directors who are not connected with the daily business affairs of the company with the

sole object of harassing the persons who are all residing in Bangalore. One of the accused in the above case has filed Criminal Original Petition

No.15159 of 2004 before this Court to quash the CC.No.295 of 2004. This Court while admitting the CrI.O.P., ordered stay of all further

proceeding in the said C.C.No.295 of 2004 which was filed on the same set of facts on which the present suit has been filed and the applicant has

not issued any notice to the respondents complaining of violation of its rights and calling for remedial actions. The respondent has been marketing

products such as Stoves, and Cookers and kitchen utensils under the trade name PIGEON for over a decade and the mixer grinders are also

under the brand name PIGEON. Chef is a well known word conveying the meaning of cook and the same is not the copyright or trade mark of

any one. The above said words are descriptive of the product. Further the mixer grinder is not marketed under the descriptive name. Without

prejudice to the rights and contentions, the respondents are ready and willing to suspend the use of descriptive words namely CHEFMATE AND

CHEFMATE PLUS. The respondents have already stopped using the said descriptive words ever since they have received the orders of this

Court.

13. The mixer grinder along with attachments are sold throughout the world with similar model and designs and the plaintiff who is a later entrant

cannot claim any proprietary right on the basis of alleged Research and Development of a product which comes from a common source. The

applicant has not disclosed how if at all it has acquired the rights and privileges from its alleged predecessor. Neither the applicant nor Icarus

Design Consultants have invented or discovered the original designer of mixer grinders. Mixer Grinder of similar designs are available throughout

the world including this part of the world, where more than 10 old reputed brands of mixer grinder using similar design and having similar functions

are sold. As a matter of fact a mixer grinder inclusive of the motor contains about 127 parts and every one of the parts is available from different

OEM sources in the market. Most of the companies marketing the products are assembling majority of parts purchased from several sources. It

was the applicant who approached the respondents for business as they were already supplying stainless steel utensils to M/s.TTK Prestige Ltd.,

which is a sister concern of applicant. Further the respondents were also supplying Stainless Steel products as an OEM supplier to BPL, Kanchan,

Marlex, Inalsa, Ganga and Jaipan group of companies and have established reputation as an quality OEM supplier of stainless steel products. The

averment that Rajendra J.Gandhi visited the applicant's factory is denied. On the other hand it was the applicant's representative visited the

respondent's factory at Bangalore and took samples from them. The averment that Jars supplied by the respondents were rejected due to non-

conformity on the basis of quality is denied. For some reasons the applicant has not disclosed the reasons for rejecting the supplies and failed to

honour the contract leading to strained relationship between them. In fact the applicant is bound to compensate the respondents for the cost

incurred and the respondents reserve the right to make a claim in this regard in the written statement.

14. The respondents are not marketing the product under the name CHEFMATE and CHEFMATE PLUS. The respondents' trade name is only

PIGEON. The applicant has referred to some performer vaguely without disclosing the name and without impleading him as a party in the suit. In

fact the respondents are in the market for kitchen appliances long before the applicant came into existence. The mixer grinders are available

throughout the world in similar design, colour scheme, get up and other common features and attachments and no one can claim any exclusive right

to any part or parts without a proper accredited registration of ownership of design and patents.

15. The respondents' mixer grinders are advertised and marketed only in the brand name of PIGEON and on the Strength of reputation

established by them over the years marketing kitchen appliances such as Gas Stoves, Pressure Cookers, Stainless Steel Utensils, etc. The Stainless

Steel Jars, Handle, motor and more than other 120 parts of a mixer grinder are all common and they do not exclusively belong to the applicant.

The applicant has no copyright over the colour scheme, get up, lay out and he is put to strict proof to the same. Similarly, the applicant has no

copyright on any instruction manual and instructions contained in the manual are from the common source and the same is given free of cost to the

purchaser of mixer grinder which contains information on the proper usage of the product and also well known recipes. Similarly the Instruction

Manuals are supplied free of cost by the manufacturers of various mixer grinders and other kitchen appliances to keep the customers well informed

about the proper usage of the products and dangers in the misuse of the products. These instructions and recipes are drawn from common source.

Therefore the applicant cannot claim to have invented or discovered the instructions contained in the instruction manual. As the applicant had

requested M/s.Icarus Design Consultant to copy the Forbus Jar Design, they must have similarly copied, the instruction manual from other common

source available in the market. The applicant is put to strict proof of the claim that he compiled an original instruction manual and therefore has

copyright over the same. It is significant to note that in his instructions manual the applicant has not claimed any copyright stating that it is an original

material disclosing the name of the author/owner,

16. The Trade Marks Act only protect the brand name and the applicant cannot claim any exclusive right to market mixer grinders as against every

other manufacturer of similar products. The consumers are not confused by large number of brands which is proved by the increase in turnover of

applicant business. The respondents never claimed that their products are originating from the same source as that of the applicant for the simple

reason that we are not marketing our product as CHEFMATE and CHEFMATE PLUS. More than 127 parts constitute a mixer grinder and no

manufacturer can claim exclusive right over part or parts. The respondents are not passing off their products as that of the applicant and their

products are distinct and the performance is superior to that of the applicant and bears a consumer friendly price tag.

17. The respondents never misrepresented that their goods have any connection with applicant's goods. The respondents have not traded on good

will and trade mark of the applicant. The applicant is trying to avoid competition and want to monopolise the trade and exploit the consumers. The

applicant in the guise of injunction seeking to freeze the respondents entire business and bring financial loss and loss of reputation. The appointment

of Advocate Commissioner is a misconceived one and beyond the scope of the suit. Both the applications for injunction are misconceived,

oppressive and untenable. The applicant is attempting to ruin the defendants' business and stamp out all competition. The applicant has suppressed

filing of Caveat Petition. The respondents pray to dismiss the applications.

18. The point for consideration is:

Whether injunction as prayed for by the applicant/plaintiff should be granted ?

19. The plaintiff has filed C.S.No. 460 of 2004 to restrain the defendants from infringing the copyright and passing off the trade mark and has

prayed for interim orders by filing Applications under Order XXXIX, Rules 1 and 2, C.P.C. The contention of the applicant/plaintiff is that the

products of the respondent/defendant in the name of PIGEON CHEFMATE & CHEFMATE PLUS are similar to that of the applicant's products

and the respondent/defendant has been passing off the goods as that of the applicant's goods utilising the reputation and goodwill earned by the

applicant. The contention of the respondent is that the suit is not maintainable since (i) no leave was obtained to sue the defendant who is carrying

on business outside the jurisdiction of this Court (ii) that no permission was obtained for the joinder of causes of action, (iii) the plaintiff has

obtained ex pane interim injunction against the defendant without giving them notice when the defendant has already filed a Caveat Petition against

the plaintiff, that the applicant himself is a pirator of a design and a pirator cannot ask for any injunction against another pirator and that there is no passing off of the goods of the defendant.

20. As regards the first contention that the suit itself is not maintainable since the same was filed without obtaining leave, it is the admitted case of the applicant/plaintiff also that no leave was obtained for filing of this suit. Clause 12 of Letters Patent Act reads as follows:

12. Original Jurisdiction as to Suits -- And we do further ordain that the said High Court of Judicature at Madras, in exercise of its ordinary

original civil jurisdiction, shall be empowered to receive, try, and determine suits of every description if, in the case of suits for land or other

immovable property, such land or property shall be situated, or in all other cases, if the cause of action shall have arisen, either wholly, or in case

the leave of the Court shall have been first obtained, in part, within the local limits of the ordinary original jurisdiction of the said High Court: or if

the defendant at the time of the commencement of the suit shall dwell or carry on business or personally work for gain, within such limits except

that the said High Court, shall not have such original jurisdiction in cases falling within the jurisdiction of the Small Causes at Madras, in which the

debt or damage, or value of the property sued for does not exceed hundred rupees.

21. It is the admitted case of the plaintiff also that the defendant is residing at Bangalore and manufacturing all the goods and other activities are at

Bangalore. Therefore, in the normal course, leave to sue the defendant ought to have been obtained by the plaintiff. The plaintiff at paragraph 40 of

the Plaint has stated that the plaintiff carries on business and its Registered Head Office is located within the jurisdiction of this Court and the

plaintiffs products having copyright in the artistic and literary work in the product and product literature are sold extensively within the jurisdiction

of this Court. Therefore, u/s 62 of the Copyright Act, 1957, this Court has jurisdiction to try this suit for the cause of action arising out of the

defendant's passing off the plaintiffs trade mark and infringing the plaintiff's Copyright. Though the defendant is carrying on the business outside the

jurisdiction of this Court, the suit is in respect of a combined action for copyright infringement and trade mark passing off and therefore leave to sue

the defendant is not necessary.

22. In *The Clan Line Steamers Ltd. Vs. Gordon Woodroffe and Co. and Others*, this Court held as follows:-

8.... As far as the first defendant is concerned, undoubtedly, if leave to sue was required under Clause 12 of the Letters Patent and if it had not

been obtained at the time of the instituting of the suit, that defect cannot be cured by subsequently granting leave to sue under Clause 12 of the

Letters Patent. That is a well settled proposition of law which cannot be disputed.

9. Where leave under Clause 12 is necessary, the granting of such leave is a condition precedent to the Court having jurisdiction to entertain the

suit, and therefore such leave has to be obtained at the time of the institution of the suit.

20. Mr.Chellaswamy on behalf of the first respondent/plaintiff raises also the question of waiver and submission to the jurisdiction of this Court; but

we do not think that there is any submission to the jurisdiction of this Court or any waiver, for at the earliest opportunity the objection had been

taken.

20. It should be noted that the application or impleading the proposed fourth defendant had to be filed because of the contention raised by the

other defendants that the proposed fourth defendant is a necessary party to the suit and the suit is bad for non-joinder of necessary parties. It

should also be noted that on behalf of the plaintiff company it is contended that when the suit was originally filed there was no necessity to obtain

leave of Court, because according to the assertions made in the plaint, the first defendant is carrying on business through its agent in Madras. But

since the proposed fourth defendant is carrying on business in London leave has to be necessarily obtained before he is added as a party. Such

being the case, the fact that the suit as originally was instituted without obtaining leave under Clause 12, would not be a bar to the Court granting

leave under Clause 12 would not be a bar to the Court granting leave under Clause 12 when a now defendant is ought to be added and when the

suit in respect of that defendant can only be instituted after obtaining leave under Clause 12 in view of the fact that the defendant is not residing or

currying on business within the jurisdiction of this Court.

23. Even in the Plaint itself, it is admitted that the defendant is carrying on

business outside the jurisdiction of this Court and therefore leave ought to have been obtained at the time of filing of this suit and the suit filed without obtaining leave is not maintainable. The learned counsel for the applicant/plaintiff would contend that as there is a joinder of cause of actions of the cognizable infringement and passing off trademark, leave to sue the defendant is not necessary. At Paragraph 40 of the plaint, the plaintiff has claimed that u/s 62 of the Copyright Act, this Court has jurisdiction to try the suit for the cause of action arising out of the defendant's passing off the plaintiffs trade mark and infringing the plaintiffs copyright, and has further added that this suit is in respect of a combined action for copyright infringement and trade mark passing off and therefore leave to sue the defendant is not necessary. At the end of Paragraph 41 the plaintiff has added in writing that "though the reliefs asked are under the Trade Marks Act and the Copyright Act, they arise out of a single cause of action.

24. In *Brook Bond India Ltd. v. Balaji Tea (India) Pvt. Ltd.*, 1993 (1) MLJ 132 when a question arose with regard to the choice of the forum by

the plaintiff and whether leave can be granted under Clause 14 of Letters Patent (Madras) Act, a Division Bench of this Court held as follows:

11....No Judge can afford to deny a relief, if in law and in equity such relief is available to a party, evidently not for the reason that he does not like

the choice of the forum and the action in Court by a litigant. Since we have taken the view that the copyright action emerges from the same bundle

of facts from which the trade mark and passing off actions emerge and the copyright action is maintainable in this Court (learned Single Judge has

also so found), we are of opinion that it will not serve the ends of justice if leave is refused for joinder of causes of action falling under the

Copyright Act and the Trade and Merchandise Marks Act.

25. The above mentioned case was with regard to the granting of leave under Clause 14 of the Letters Patent, where the bundle of facts revealed

joinder of causes of action under the Copyright Act and the Trade Marks Act for infringement and passing off actions. In this case also, there is

joinder of infringement and passing off actions as pleaded by the plaintiff. If so, leave of this Court is mandatory for joinder of causes of action

falling under the Copyright Act for infringement and Trade and Merchandise Marks Act for passing off. But the plaintiff has not applied for leave to

sue the defendant at the time of filing the suit and for joinder of causes of action and on these grounds, the applications are liable to be dismissed.

26. The next contention of the learned counsel for the respondent/defendant is that the respondent has filed a Caveat Petition against the

applicant/plaintiff on 18.2.2004. But the applicant/plaintiff has not given notice of filing of the suit and the applications for injunctions against the

respondent/defendant, before moving the same before this Court and according to the respondent, the suppressing of filing of the Caveat disentitles

the applicant from seeking any assistance of this Court and that the applicant has come to Court without clean hands and therefore he is not entitled

for an order under equity. u/s 41(i) of the Specific Relief Act, an injunction cannot be granted when the conduct of the plaintiff or his agent has

been such as to disentitle him to the assistance of the Court.

27. In C. Seethaiah Vs. Government of Andhra Pradesh and Others, a Division Bench of the Andhra Pradesh High Court held as follows:

6....In G.C. Siddalingappa Vs. G.C. Veeranna, , a single Judge of the Karnataka High Court held:

When once a caveat is filed, it is a condition precedent for passing an interim order to serve notice of the applicant on the caveator who is going to

be affected by the interim order. Unless that condition precedent is satisfied, it is impossible for the Court to pass an interim order affecting the

caveator""

7. In the instant case, the writ petitioner did not serve the copies of the petition on the caveator and he was not at all heard before the interim order

of suspension was granted. Consequently the ex parte order of suspension deserves to be set aside on this simple ground

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11. The matter came up for hearing before the Court when the third respondent caveator was not present and he could not be present because the

third respondent's name or the name of his counsel was not printed in the cause list. When the petitioner was served with a notice of caveat having

been lodged it was the duty of the petitioner and his counsel to bring that fact to the notice of the Court before the matter was heard and any

interim order was passed adverse to the caveator. In our view, when a caveat is lodged it becomes not only the duty of the Court but also of the

appellant petitioner and his counsel to bring to the notice of the Court that caveat has been lodged and the matter may not* be heard ex parte.

Though no such obligation is imposed expressly by Section 148-A, such an obligation must necessarily be implied having regard to what is

contained in Sub-sections (3) and (4) thereof and also the overall intendment of the provision. If the name of the third respondent-caveator or his

counsel were printed in the cause list that in our opinion would have constituted sufficient notice to the third respondent. But that should have been

preceded by furnishing of copies of petitions and documents on the third respondent-caveator by the appellant-petitioner or his counsel. We,

therefore, agree with our learned brother Ramanujulu Naidu.J., that the ex parte interim order of suspension deserves to be set aside on this very

ground.

28. In K. Anbazhagan Vs. M. Kannappan and Others, it has been held as follows:-

26. Learned counsel appearing for the defendants 1 and 2 would argue that injunction being an equitable remedy the plaintiff should come to

Court with clean hands and that it is not so in this case since the plaint has not referred to the two suits filed by the first defendant before the DMC,

Coimbatore and another suit filed by one of the parties before the DMC Karur and the interim orders passed in those suits. The affidavit filed for

getting interim order; in those suits are available in the typed set of papers. From it we are able to see that the subject matter of those suits and the

subject matter in this suit are different. Therefore, failure to mention about the other suits pending in the other Courts in the plaint cannot be a

ground to vacate the interim relief granted to the plaintiff in this application on the ground of suppression if only suppression is committed on vital

materials, equitable remedy cannot be granted. But when the materials not placed before this Court have nothing to do with the subject matter of

this suit, it cannot be said that there is a suppression on the part of the plaintiff to vacate the injunction already granted.

29. As far as this case is concerned, the respondent has filed Caveat u/s 148-A, CPC on 18.2.2004 and notice has been served on the applicant

and copy of the acknowledgment Card also have been produced.. The Ninety days period u/s 148-A expires on 19.5.2004 as admitted by the

applicant. The suit was filed on 25.4.2004. Both 19.5.2004, the date on which

the caveat period expired and 24.5.2004, the suit was filed, fall

when the Court was closed for summer vacation and the suit was filed on 24.5.2004 in the Vacation Court, five days after the expiry of the caveat.

The contention of the respondent is that the caveat will continue to be valid during the vacation till the reopening of the Court and therefore the

plaintiff ought to have served copy before moving the injunction applications. But the contention of the applicant/plaintiff is that Section 4 of the

Limitation Act will not have any application to the caveat filed u/s 148-A, CPC and caveats are also filed even during the Court vacation on all the

Court working days. According to the applicant, a Caveat not being a lis or a cause, the principles of Section 4 of Limitation Act has no

application. Only in cases where a right of a litigant is lost by reason of limitation, the time gets extended till the reopening of the Court. Section 4 of

Limitation Act reads as follows: -

Section 4: Expiry of prescribed period when Court is closed:-- Where the prescribed period for any suit, appeal or application expires on a date

when the Court is closed, the suit, appeal or application may be instituted, preferred or made on the date when the Court reopens.

30. It is the admitted case of the applicant/plaintiff that a caveat was lodged on 18.2.2004 and has expired on 19.5.2004. According to the

applicant/plaintiff he got knowledge around October 2003 that the defendant had organised a Dealers' Meet at Chennai by launching PIGEON

CHEFMATE and CHEFMATE PLUS Mixer Grinders (para 23 of the Plaint). Having come to know about the launch of respondent's products

with similar name, get up, design, etc., the plaintiff kept quiet till the Court was closed for summer vacation and awaited till the expiry of the caveat

and filed the suit five days thereafter and got an ex parte injunction. Even in the Plaint, the plaintiff has not mentioned that already a Caveat was filed

and the same expired on 19.5.2004 and that there was no renewal of the caveat during the vacation period. On the other hand, the plaintiff has

totally suppressed the filing of the caveat. Normally a caveat which expires during the vacation will be operative till the reopening of the Court after

such vacation. Therefore, it is a case where the plaintiff has come to Court suppressing the material facts and pendency of the caveat and obtained

ex parte orders against the respondent. Not even a notice was issued to the

defendants before filing of the suit that the defendants are infringing the copyrights of the plaintiff and passing off their goods.

31. The next contention of the plaintiff is that the product of the defendant, particularly the Jar and the names CHEFPRO and CHEFPRO PLUS

are also used by the defendant for passing off the goods as that of the plaintiff. As far as the Jar is concerned, the same has been designed by the

plaintiff by engaging M/s.Icarus Designs and consultants. There is no denial on the part of the defendant also that the designs and drawings for the

Jar were given to the defendant for manufacturing and supply of the jars to the plaintiff and in fact the defendant has supplied 3500 jars to the

plaintiff out of which about 1104 jars were rejected by the plaintiff. Therefore, the fact remains that the defendant was in possession of the

drawings for the manufacture of the jars. A perusal of the comparison of the jars would reveal that the jars used by the defendant are almost similar

in colour, get up and size, except that in the jars of the defendant, there is an inside locking system and in the handle of the jars, there are curves on

the inner side of the handle for the purpose of grip and it is also a fact that the defendant has not produced his own source of drawing/design for

the manufacture of the jars. The Blade used inside the Jar is almost similar for both the plaintiff and the defendant. According to the defendant,

M/s.Icarus Design Consultant, Bangalore is not a party to the suit and the plaintiff has not produced any document from the said Designer assigning

their copyright in the design in favour of the plaintiff and therefore, the plaintiff cannot maintain an action for infringement of design or copyright not

owned by him.

32. The contention of the defendant is that the plaintiffs product is not the original, but has only copied design from the mixer grinder manufactured

by other companies. In fact the plaintiff has instructed M/s.Icarus Design Consultants to have scrips on dome like ""Forbes"" and jar should have Rim

like ""Forbes"". According to the defendant the plaintiff is a pirator of the design of the jar of other manufacturers. Therefore, one pirator cannot

claim an injunction against another pirator and for such a proposition relies upon the judgment in Baldev Singh v. Godran Rubber Plastic Industries,

1999 (19) PTC 375, where the Delhi High Court held as follows:

14. Learned counsel for the defendant Mr.Ajay Sahni placed reliance on Capital

Plastic Industries v. Kapital Plastic Industries, 1989 Patents and

Trademarks Cases 98. In this case a Division Bench of this Court held that the user of the trade mark Rabber/Ranber by the plaintiff and the trade

mark Rahber by the defendant is being tainted with piracy from the very beginning and no law having been brought to notice providing protection

to the pirates of a trade mark, the undertaking given by the respondent that he will not manufacture, sell or offer or sale jugs under the trade mark

Ranber or Rabber is hereby released with direction that the defendant will maintain true and proper account of such sales, meaning thereby a

pirator cannot injunct another pirate. The originator of the trade mark or design is entitled to protection of law, but not a pirate.

15. Mr.Sahni also placed reliance on a Division Bench Judgement of this Court reported as M/s.Niky Tasha India Pvt. Ltd. v. M/s.Faridabad Gas

Gadgets P. Ltd., AIR 1985 Delhi. 136, wherein the Court observed that interlocutory injunctions are granted in exceptional cases where damages

will not provide an adequate remedy to the plaintiff. The Court also observed that an interlocutory injunction should not be granted unless there is a

real probability of the plaintiff succeeding on the trial of the suit. It is also mentioned that when there is a serious question as to the validity of the

design to be tried in the suit and an application for cancellation has been made, no injunction should be granted.

16. The Court in the said judgment also observed that the design is a conception, suggestion or idea of a shape and not an article. If it has been

already anticipated, it is not ""new or original"". If it has been pre-published, it cannot claim protection. Publication before registration defeats the

proprietor's right to protection under the Act.

17. Both those judgments have been followed in a later judgment of this Court In Baldev Singh v. Shriram Footwear, 1997 (17) PTC 268. The

Court while following the ratio of these judgments dismissed the plaintiff's application under Order 39, Rules 1 & 2, CPC and allowed the

defendants-application under Order 39, Rule 4, CPC.

18. On consideration of relevant law, documents and photography on record, prima facie I am on the considered opinion that one pirate cannot

seek injunction against another pirate and consequently, the plaintiff is not entitled to any interim protection and accordingly, the ad interim ex

parts injunction granted, to the plaintiff is liable to be vacated.'".

33. There is no denial on the part of the defendant that the industrial drawings were supplied by the plaintiff to the defendant for the manufacture of

jars to be supplied to the plaintiff. With regard to colour, get up and size, except the inside locking system, and the curves in the handle, the jars of

the plaintiff and the defendant are almost similar. But the jar is only one part among the 127 parts which are required for the manufacture of a

mixie. A perusal of the photographs of various other mixies manufactured by other companies would reveal that the concept, get up, mechanism,

etc., are almost similar.

34. More over the plaintiff has not registered his design or artistic work under the Designs Act. According to the learned counsel for the defendant,

if an artistic work or design is used for more than 50 times, then there is no copyright for the said product.

35. According to the learned counsel for the applicant/plaintiff, the respondent/defendant has been using the words ""CHEF"" MATE and ""CHEF

MATE ""PLUS"" in his products using the same type of Instruction Manual for the purpose of passing off the goods as that of the applicant/plaintiff.

The plaintiff is using the word CHEFPRO and CHEFPROPLUS, whereas the defendant is using the words CHEFMATE and CHEFMATE

PLUS. As far as the words CHEFMATE OR CHEFMATE PLUS are concerned, the word ""CHEF"" is a prefix to the unregistered trade mark of

both the applicant and the respondent and it is a well known common generic word meaning ""cook"" and the same word is being used in several

kitchen appliances in the field and therefore the word ""CHEF"" is concerned, one cannot claim exclusive copyright over the said word to the

exclusion of others. In this context, it is useful to refer to some of the judgments of various High Courts on this aspect.

36. In Indo-Pharma Pharmaceutical Works Ltd. Vs. Citadel Fine Pharmaceuticals Ltd., , a Division Bench of this Court held as follows:-

56.(c) The word "ENERJ" is an abbreviation of a generic name ""energy". The word "energy is a commonly used word and would be the

description of energising product. A generic name of a product cannot be treated as a trademark to indicate the origin. The prefix for both the

marks viz., "ENERJ" is common to the trade and cannot be a proprietary name.

Nobody can claim exclusive right to use such an abbreviation.

(d) As per the suffix, phonetically, the words ""JEX"" and ""JASE"" are totally dissimilar and are not going to create any confusion in the mind of the

users, especially, in this case, when the visual impression of the said two trade names is completely different.

(e) In fact, we have compared the two words as a whole with the eyes of the public. We think prima facie that the total sound effect of these two

words lacks any similarity. So also, when these words are written down and compared, they do not have any similarity which can deceive the eye

of the layman.

57. In view of the above findings, we hold that a case for grant of injunctions sought for by the appellant is not made out and the orders under

appeals have to be confirmed, as the balance of convenience is only in favour of the defendant.

37. In McDonald's Corporation v. Mac Gilz Fast Food, 2003 (26) PTC 547, the Punjab and Haryana High Court held as follows:

It shall be absolutely premature to form an opinion that the two words ""McDonalds and MacGilz"" are deceptively similar to each other.

Admittedly, the applications have been filed by the plaintiff for seeking registration of the trade mark as alleged in the Plaint, which are still pending

for final orders before the Registrar of Trade Marks. By granting a interim injunction at this stage would bring the business of the defendant at a

grinding halt and that the damage and irreparable loss which may be suffered by the defendant respondent shall not be quantifiable in terms of

money. The plaintiff has also been able to establish as to what kind of fiscal profit has been made or earned by the defendant-respondent rather the

plaintiff has asked for the production of accounts i.e., profits which may have been earned by the defendant-respondent. The defendant-

respondent has categorically averred that they have suffered business losses and the said statement has not been controverted by the plaintiff. In

this view of the matter, it cannot be accepted prima facie that the defendant-respondent has encashed or has earned profits by usage of the word

MacGilz"" allegedly deceptively to be similar to ""McDonalds"". The dicta of the Apex Court and various other High Courts which have been relied

upon by the learned counsel for the plaintiff cannot be relied upon at this stage.

The description and projection of the circumstances as have been spelt out in the plaint and the application, which have been controverted by the defendant-respondent, make out a triable case which needs to be decided on the basis of cogent piece of evidence which may be brought on record by the respective parties.

16. In view of the above, I am not at all inclined to grant ad interim injunction to the plaintiff.

38. In SBL Ltd. v. Himalaya Drug Co., AIR Delhi 126, speaking for the Bench, R.C.Lahoti, J., (as his lordship then was) held as follows:

The test for judging a case of infringement and/or passing off remains the same when applied to medicines and pharmaceuticals. However, a few

additional considerations arise when dealing with cases of such drug, which cannot be sold except on prescription of a doctor and which are sold

only by such persons who have special knowledge or expertise in the field. The manner in which trade in such medicines is carried on that is they

can be sold only on prescription and at authorised outlets only the class of persons who would purchase that is, the patients advised by the

doctors, chemists and druggists these two facts assume significance and shall have to be kept in view by the Courts. There are about 100 drugs in

the market using the abbreviation "Liv" made out of the word Liver-an organ of the human body, as a constituent of names of

medicinal/pharmaceutical preparations with some prefix or suffix-mostly suffixes-meant for treatment of ailments or diseases associated with liver.

Liv has thus become a generic term and publici juris. It is descriptive in nature and common in usage. Nobody can claim an exclusive right to the

use of Liv as a constituent of any trade mark. The class of customers dealing with medicines would distinguish the names of the medicines by

ignoring Liv and by assigning weight to the prefix or suffix so as to associate the name with the manufacturer. The possibility of deception or

confusion is reduced practically to nil in view of the view that the fact that the medicine will be sold on medical, prescription and by licensed dealers

well versed in the field and having knowledge of medicines. In the instance case the two rival marks Liv.52 and Liv.T contain a common feature

LIV which is not only descriptive but also publici juris; a customer will tend to ignore the common feature and will pay more attention to

uncommon features i.e., 52 and T. The two do not have such phonemic similarity as to make it objectionable. The cartons of the two products

respectively of the plaintiff and of the defendant shows that there is no possibility of one being accused of deceptively similar with the other and the

likely customer mistaking one with the other, even by recollecting faint impressions. Therefore the proprietor of Liv.52 was not entitled to the grant

of an injunction restraining the use of LIV-T.

39. In *Micronix India v. J.R.Kapoor*, 2002 (26) PTC 593 (Delhi), it has been held as follows:

That neither visually nor phonetically MICRONIX and MICROTEL have any similarity though name of both the trademarks starts with the word

MICRO. Micro is a generic term as it refers to state of art technology and cannot be monopolised by any person as both the parties are in same

trade using micro technology as in every electronic and electrical items, micro chips are used and that is why both the articles cannot be confused

as to their source or origin by use of word MICRO as a prefix to the mark or trade name. Thus use of the word "MICRO" in MICROTEL and

MICRONIX as prefix does not involve the element of deceptive similarities in respect of electronic goods and goods with microchip technology.

The word or prefix Micro cannot be monopolised as there are international and national trade names in respect of technology where microchips

are used. The prominent instance is Microsoft.

40. The judgments referred to above clearly show that a generic name or word of a product can never function as a trade mark. Even otherwise,

according to the defendant, he has been using the word "CHEF" denoting the different models of the defendant's kitchen grinders in the user

manual and he is also prepared to remove these words.

41. As far as the user manual is concerned, almost exact words are used by the defendant like that of the applicant, a comparison of User Manual

of Various mixer grinders of various companies, the similar DO's and DONT's are found. It may be that the wordings are different. The user or

Instruction Manual is not registered under the Press and Registration of Books Act. Further the Instruction Manual are given free and not sold.

Therefore, it cannot be alleged that there is copyright or trade mark violation of the plaintiff's Instruction Manual by the defendant. After all,

Instruction Manual is to instruct how the apparatus is to be used.

42. As far as passing off is concerned, the get up of various mixies of about ten varieties manufactured by, different companies, the concept, and

get up are nearly similar. The size of the jar and the bottom may be different in size. But the mechanism used in all the mixer grinders are almost

similar. Mixer Grinders are not like other products like foodstuffs or condiments which are purchased by all common people. Mixer grinders are

used mostly in Towns and Cities and not in remote villages. Mixer grinders are used by middle class and upper class people who are fairly

educated. Before purchasing a product, like the mixer grinder, the customers make up their mind as to which brand they must purchase. The public

are not carried away by mere get up. The public know the manufacturers' credentials and also the performance of each product. Even if several

manufacturers' products of the same apparatus are kept side by side, the buyer knows which company's product he must buy. Therefore, the

passing off a material like that of another person's product is almost negligible in costly products, like Mixer Grinders. Though the shape of the

product is also included in the trade mark, the mixer grinders of various companies, have almost similar shapes. There may be difference in size.

Therefore the products like mixer grinders, which are used by fairly educated people belonging to upper class and middle class, the chance for

passing off the goods is very little.

43. The plaintiff has given particulars of turn over for the years 1986 to 2003 and has not given the figures of turn over for the year 2003-2004 in

the plaint. If really the plaintiff has sustained any loss due to passing off the goods by the defendant, the plaintiff would have mentioned the same in

the plaint. However, it is a fact to be proved by the plaintiff whether he sustained any loss by the alleged passing off of the goods by the defendant

by violating or infringing the rights of the plaintiff.

44. Granting of injunction against the respondent before letting in evidence may cause great harm and result in irreparable injury which cannot be

compensated in terms of money. If by an order of injunction the respondent is prevented, it may result in injury from his having been prevented

from exercising his own legal rights for which he could not be adequately compensated. The Court must weigh one need against another and

determine where the balance of convenience lies.

45. In *Power Control Appliances and others v. Sumeet Machines Pvt. Ltd., etc.*, 1994 (2) SCC 248, the Supreme Court held as follows:

35. Again in *Wander Ltd. v. Antox India P. Ltd.*, to which decision one of us (M.N.Venkatachalaiah, J., as he then was) was a party it was

stated thus:-

Usually, the prayer for grant of an interlocutory injunction is at a stage when the existence of the legal right asserted by the plaintiff and its alleged

violation are both contested and uncertain and remain uncertain till they are established at the trial on evidence. The Court, at this stage, acts on

certain well settled principles of administration of this form of interlocutory remedy which is both temporary and discretionary. The object of the

interlocutory injunction, it is stated:

.....is to protect the plaintiff against injury by violation of his rights for which he could not adequately be compensated in damages recoverable in

the action if the uncertainty were resolved in his favour at trial. The need for such protection must be weighed against the corresponding need of the

defendant to be protected against injury resulting from his having been prevented from exercising his own legal rights for which he could not be

adequately compensated. The Court must weigh one need against another and determine where the balance of convenience lies....The interlocutory

remedy, is intended to preserve in status quo the rights of parties which may appear on a prima facie case. The Court also, in restraining a

defendant from exercising what he considers his legal right but what the plaintiff would like to be prevented, puts into the scales, as a relevant

consideration whether the defendant has yet to commence his enterprise or whether he has already been doing so in which latter case

considerations somewhat different from those that apply to a case where the defendant is yet to commence his enterprise, are attracted"".

46. In the result, for non-obtaining of leave to sue the defendant before filing of the suit under Clause 12 of the Letters Patent Act and failure to get

permission for joinder of cause of actions as required under Clause 14 of the Letters Patent Act and for suppression of materials like filing of

caveat in spite of notice and also for various other reasons mentioned above, the interim injunctions granted earlier in Original Application No.488

of 2004 is liable to be vacated and the same is vacated.

47. Consequently, Application No. 487 of 2004 for injunction and Application No. 2158 of 2004 to appoint an Advocate Commissioner are also dismissed.