
(2013) 11 MAD CK 0155

In the Madras High Court

Case No : Original Side Appeal No. 47 of 2012 and M.P. No. 1 of 2012

Mr. A.D. Padmasingh Isaac and M/s. Aachi Masala Foods (P) APPELLANT
Ltd.

Vs

Aachi Cargo Channels Private Limited RESPONDENT

Date of Decision : 12-11-2013

Acts Referred:

Citation : AIR 2014 Mad 2 : (2014) 57 PTC 102

Hon'ble Judges : Satish K. Agnihotri, J;M.M. Sundresh, J

Bench : Division Bench

Advocate : Gladys Daniel, for the Appellant; R. Ram Prakash, for the Respondent

Final Decision : Dismissed

Judgement

M.M. Sundresh, J.—This appeal has been preferred by the appellants/applicants in O.A. No. 378 of 2010 in C.S. No. 341 of 2010, questioning the order dated 10.12.2011 passed by the learned single Judge in the above application declining to grant an order of interim injunction pending suit. Facts in Brief:

The appellants are the Proprietors of the Trademark "Aachi". The first appellant secured the registration of trademark "Aachi" in the year 1999 with respect to masalas and spices. Thereafter, it secured 51 other registrations of trademark "Aachi" in various labels and cartons. The respondent, which was incorporated as "Aachi Cargo Channels Private Limited" under the Companies Act, 1956, was dealing with cargo services transporting various goods. The appellants filed a suit in C.S. No. 341 of 2010 on the file of this Court alleging infringement on the part of the respondent of their registered trade mark. The appellants also filed an application before the Regional Director of Companies, seeking to cancel and rectify the name "Aachi Cargo Channels Private Limited" u/s 20 of the Companies Act, 1956. Pending the suit filed for permanent injunction, the appellants had filed an application in O.A. No. 378 of 2010 in C.S. No. 341 of 2010 seeking temporary injunction. The learned single Judge, by a detailed order, after considering the submissions made by both sides, was pleased to dismiss the

application on 10.12.2011. Challenging the order of the learned single Judge, the appellants have preferred the present appeal.

2. Submission of the Appellants:

The learned counsel appearing for the appellants has submitted that the appellants, being the registered Proprietors of the trade mark "Aachi", the respondent cannot be permitted to use the same and therefore, the learned single Judge ought to have granted an order of interim injunction. By virtue of the statutory right conferred under Trade Marks Act, 1999, the appellants enjoyed the exclusive right over the trade mark "Aachi". The appellants continue to enjoy reputation over their registered trade mark, which can never be permitted to be used by the respondent. The mere fact that the respondent is doing business in cargo service by itself cannot be a ground to refuse an order of injunction. The learned counsel further submitted that the learned single Judge has not considered the scope and ambit of Section 29(4) of the Trade Marks Act, 1999. Therefore, the appeal will have to be allowed. In support of her contention, the learned counsel has placed reliance upon the following judgments:

(i) Caterpillar Inc., Illinois USA, V. Jorange and another (O.S.A. No. 166/1997 in C.S. No. 785 of 1996 decided on 01.10.1997);

(ii) Daimler Benz Aktiengesellschaft and another Vs. Hybo Hindustan, .

3. Submissions of the Respondent:-

Per contra, the learned counsel appearing for the respondent has submitted that admittedly the appellants and the respondent are operating in two different and distinct fields having no connection whatsoever with each other. There is no similarity of goods manufactured and the service rendered by the parties. There is no likelihood of causing any confusion in the minds of the public that the business of the respondent is that of the appellants. Therefore, it is submitted that the appeal deserves to be rejected.

4. DISCUSSION:-

4.1. The facts are not in dispute. Even though the appellants are the Proprietors of the registered Trade Mark "Aachi", the operation of the business of the parties are totally different. The appellants are primarily dealing with masalas and spices. The registrations of 51 trade mark "Aachi" in various labels and cartons would show that the appellants never dealt with the cargo services carried on by the respondent. In a suit for infringement, the Courts are primarily concerned with the label as a whole which may also contain the name. Admittedly, the label reflecting the masalas and spices of the appellants has nothing to do with the service being rendered by the respondent as cargo operators. Therefore, we are of the view that the appellants are not entitled for an order of injunction pending suit.

4.2. Even though there is no material available on records to show that the

appellants have raised the contention on the applicability of Section 29 of the Trade Marks Act, 1999, before the learned single Judge, since the learned counsel has raised the same, we decide to consider the same as well. Considering the scope and ambit of Sections 29 and 30 of the Trade Marks Act, 1999, this Court, in *Orchid Chemicals and Pharmaceuticals Ltd. Vs. Wockhardt Limited*, , has held as follows:

5.6. Sections 28 to 30 of the Trade Marks Act, 1999, deal with the effect of registration under Chapter IV of the Act. In so far as Section 28 of the Act is concerned, it deals with the rights conferred by registration. Section 28 of the Act specifically deals with the "exclusive" right under the Act. Therefore, a registered proprietor of a trade mark can assert an exclusive right to use the trade mark u/s 28 of the Act. However, the said assertion is subject to two conditions. The first condition is that it is "subject to other provisions of the Act". The second condition is that it is subject to its "validity".

5.7. Now coming to Section 29 of the Act, it deals with an infringement of the registered trade mark. Section 29 of the Act specifies that an infringement would occur when an unregistered Proprietor uses a registered trade mark, which is likely to cause confusion on the part of the public or which is likely to have an association with the registered trade mark. Therefore, if one sees the object and reasons u/s 29 of the Act, it is clear that it is meant to be used against the person, who is not entitled to use the said trade mark under "law". This is required to constitute an infringement.

5.8. Now coming to Section 30 of the Act, it limits the effect of registered trade mark. A perusal of Section 30 of the Act would show that Section 29 of the Act is subjected to it. Therefore, Section 30 of the Act is an overriding provision to Section 29 of the Act. However, the parameters stipulated u/s 30 of the Act will have to be complied with. For example, in a case where a party is using a registered trade mark belonging to another one, if it is in accordance with honest practices in industrial or commercial matters or is detrimental to the distinctive character of the different trade mark, no infringement would occur as it limits the effect of registered trade mark. Similarly, when the usage is indicative of a kind, quality or a quantity, then there will not be any infringement notwithstanding the registration.

5.9. While considering the statutory provisions, the Courts will have to read them together to understand the intending purpose and object. Therefore, we are of the considered view that Sections 28 to 30 of the Trade Marks Act, 1999, are to be read in connection with each other. Such a yardstick will have to be adopted in view of the settled interpretative principle of harmonious construction.

5.10. Accordingly, let us apply the facts to the provisions. The records would show that the word "METOPROLAL" is a chemical component. It is "publici juris". There are number of registered Proprietors having the prefix "METO". The learned single Judge has also noted the said fact. Now all of them are identified

with the common name, in view of the chemical component. Hence, it is not as if the respondent has infringed the said word "METO". It is already in the public domain, even much prior to the application of the appellant. Applying the said facts when we read Section 29 of the Act, we can safely come to the conclusion that the limits on effect of the registered trade mark u/s 30 of the Trade Marks Act, 1999, would apply with all force. Therefore, the exclusive right claimed by the appellant in pursuant to the registration would no longer be available, in view of the fact that the word "METO" is already "publici juris", thereby, giving protection u/s 30 of the Act. When Section 28 of the Act is not applicable, then consequently, Section 29 of the Act also is not applicable. Even otherwise, Section 29 of the Act is subject to Section 30 of the Act. As Section 28 of the Act is also subject to other provisions, it is needless to state that it is also subject to Section 30 of the Act. Therefore, looking from any angle, we have no hesitation in holding that there is no infringement of the appellant's trade mark u/s 29 of the Trade Marks Act, 1999.

4.3. Even on a perusal of Section 29(4) of the Trade Marks Act, 1999, it is clear that, in order to hold that a registered trade mark is infringed upon, three conditions mentioned therein will have to be satisfied. Those three conditions are,

(i) The mark of the defendant must be identical or similar to the registered trade mark;

(ii) The use in relation to goods or services, which are not similar to those for which the trade mark is registered; and

(iii) 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. All the above said three parameters are to be satisfied by the Proprietors of the registered trade mark while seeking an order of injunction. In the case on hand, it is not proved that atleast one of the conditions is satisfied. There is nothing on record to suggest that the appellants have satisfied the Court, that all these conditions are available for seeking an order of injunction. Further, as observed by the learned single Judge, the word "Aachi" in Tamil means "grandmother". Such term is in common use throughout the State of Tamil Nadu. Therefore, such a word, which is of general use, cannot be a monopoly of the appellants alone be used in any other product than the one they are doing business.

4.4. The judgments relied upon by the learned counsel appearing for the appellants are not applicable to the facts on hand. In Daimler Benz Aktiengesellschaft and another V. Hybo Hindustan cited above, the Court was concerned with the international reputation of the appellants. The Court also found that the respondent cannot be considered to be a "honest concurrent user" in view of his conduct of copying the symbol of the applicant. In that case, not only the name, but entire trade mark was sought to be adopted by the respondent. Similarly, in Caterpillar Inc., Illinois USA, V. Jorange and another

(O.S.A. No. 166/1997 in C.S. No. 785 of 1996 decided on 01.10.1997), this Court was considering the usage of registered trade marks in the very same business. It is not such a case before us. The learned single Judge has correctly held that an order of interim injunction obtained in another suit between the parties cannot be a binding precedent as each case will have to be decided on its own merit. Further more, a dismissal of an application seeking condonation of delay in preferring the appeal cannot be considered as a decision on merit. Hence, we are of the view that the decision relied upon by the learned counsel appearing for the appellants are not applicable to the present case. The learned single Judge has correctly considered the issues raised before him and passed an order, which does not require any interference. While dismissing the appeal, we make it clear that all our observations and reasoning are only meant for deciding the appeal and therefore, the same shall not have any bearing on the learned single Judge in deciding the suit.

In the result, the Original Side Appeal is dismissed. No costs. Consequently, connected miscellaneous petition is also dismissed.