

(2010) 03 MAD CK 0235

In the Madras High Court

Case No : Original Side Appeal No. 449 of 2009 and M.P. No. 1 of 2009

N. Ranga Rao and Sons

APPELLANT

Vs

Koya's Perfumery Works

RESPONDENT

Date of Decision : 12-03-2010

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 7 Rule 1
Copyright Act, 1957 — Section 55, 56, 60, 62
Trade Marks Act, 1999 — Section 134, 135, 27(2), 28, 28(1)

Citation : (2011) 45 PTC 140

Hon'ble Judges : M. Sathyanarayanan, J;D. Murugesan, J

Bench : Division Bench

Advocate : P.V. Rajeswari, for the Appellant; R. Sathishkumar, for the Respondent

Final Decision : Dismissed

Judgement

M. Sathyanarayanan, J.—The Appellant is the applicant in O.A. No. 854 of 2009 in C.S. No. 694 of 2009 and aggrieved by the order of disposal under which, certain direction was given, has preferred this appeal.

2. The facts necessary for the disposal of this appeal are as follows:

The Appellant filed a suit in C.S. No. 694 of 2009 against the Respondent herein under Order VII Rule 1 of Code of Code of CPC read with Sections 134 and 135 of the Trade Marks Act, 1999 and under Sections 55, 56, 60 and 62 of the Copyright Act, 1957, praying for the relief of permanent injunction restraining the Respondent herein from in any manner infringing the Appellant/Plaintiff's registered trade mark "WOODS" by using the offending trade mark "HEAVEN WOOD" or any other mark or marks which are identical and similar to the registered trade mark "WOODS"; permanent injunction restraining the Respondent herein from in any manner infringing the Appellant/Plaintiff's copyrighted artistic work "WOODS" by using the offending artistic work "HEAVEN WOOD" or any other work or works which are identical and similar to the

registered Copyright over the artistic work "WOODS"; permanent injunction restraining the Respondent herein from in any manner passing off its agarbathi products bearing the offending trade mark and the artistic work "HEAVEN WOOD" as and for the celebrated agarbathi products of the Appellant/Plaintiff bearing the registered trade mark and the copyrighted artistic work "WOODS", either by manufacturing, selling or offering for sale or in any manner advertising the same; directing the Respondent/Defendant to surrender to the Appellant/Plaintiff the entire stock of unused offending cartons bearing the offending trade mark "HEAVEN WOOD" together with blocks and dyes for destruction; directing the Respondent/Defendant to render a true and faithful account of the profits earned by the Respondent/Defendant through the sale of their products sold under the offending trade mark "HEAVEN WOOD" and directing payment of such profits to the Appellant/Plaintiff for the passing off committed by the Respondent/Defendant; and for costs of the suit.

3. Pending disposal of the suit, the Appellant herein took out three applications for the following reliefs:

(i) O.A. No. 852 of 2009 is for the relief of ad-interim injunction restraining the Respondent herein/Defendant from in any manner infringing the applicant's copyrighted artistic work "WOODS" by using the offending artistic work "HEAVEN WOOD" or any other work or works which are identical and similar to the applicant's registered Copyright over the artistic work "WOODS", pending disposal of the above suit.

(ii) O.A. No. 853 of 2009 is for the relief of ad-interim injunction restraining the Respondent herein from in any manner infringing the applicant's registered trade mark "WOODS" by using the offending trade mark "HEAVEN WOOD" or any other mark or marks which are in any way identical with and similar to the applicant's registered trade mark "WOODS", pending disposal of the above suit.

(iii) O.A. No. 854 of 2009 is for the relief of ad-interim restraining the Respondent herein from in any manner passing off its agarbathies using the offending trade mark and the artistic work "HEAVEN WOOD" as and for the applicant's well established agarbathies bearing the registered trade mark and copyright over the artistic work "WOODS", either by manufacturing, selling or offering for sale or in any manner advertising the same, pending disposal of the above suit.

4. The learned Judge vide a common order dated 16.11.2009, on taking into account of the fact that at the time of filing the suit, the Respondent herein/Defendant violated the Appellant/Plaintiff's trade mark rights as well as the copyright and the Respondent/Defendant had the intention to pass off the goods but during the pendency of the suit, the Respondent/Defendant changed the trade mark as well as the combination and pattern of printing, has directed the Respondent/Defendant to further change its trade mark by printing the word "Koya"s" in commensurate with the size of the words "HEAVEN WOOD" and

granted three weeks time for complying the above said direction. The learned Judge by the above said common order, had closed O.A. Nos. 852 to 854 of 2009.

5. The Plaintiff/applicant, aggrieved by the orders passed in O.A. No. 854 of 2009, had preferred this appeal.

6. It is the case of the Applicant/Plaintiff/Appellant that they are the leading manufacturers of the agarpathies and their names are very well established in the public. The Appellant had only conceived and adopted the "WOODS" in respect of agarpathies and applied registration of the same on 24.1.1985 and subsequently obtained registration of the trade mark "WOODS" under No. 432777 in class 3 in respect of agarpathies and dhoop (incense sticks) under the Trade Marks Act, 1958 and the said registration is also periodically renewed. The Appellant had also designed the agarpathi carton bearing the trade mark "WOODS" in an artistic manner with a peculiar colour scheme and get up during the year 1996 and also registered the same under the Copyright Act, 1958 under No. A-54025/97.

7. It is further contended by the Appellant/Plaintiff that due to the spending of considerable amounts and efforts in promoting the sale and due to the quality of their products, they had done business to the tune of several crores of rupees since its inception under the trade mark and the artistic work "WOODS".

8. The Appellant/applicant became aware that during the end of July 2009, the Respondent herein has started manufacturing and selling agarbathies under the identical carton bearing the offending artistic work and the trade mark "HEAVEN WOOD" and it amounts to mala fide act.

9. It is further contended that since the Respondent herein had started using the Appellant/applicant's registered trade mark "THREE IN ONE" in respect of agarpathies during the year 2005 and the Appellant/applicant had filed a suit against the Respondent herein in C.S. No. 517 of 2005 and pending disposal of the said suit, had also obtained interim orders restraining the Respondent herein from using the said trade mark. Thereafter, the said suit has ended in compromise and decreed in favour of the Appellant herein in terms of the memo of compromise dated 20.10.2008.

10. However, the Respondent herein had now copied the registered trade mark and the copyrighted artistic work "WOODS" in respect of agarpathies and also started marketing the same in the name and style of "HEAVEN WOOD". According to the Appellant/applicant, the above acts on the part of the Respondent herein including the passing off of the agarpathies is unsustainable and that the Appellant/applicant is also started suffering grave hardship and loss and hence prayed for interim orders restraining the Respondent herein from doing so.

11. The Respondent herein filed a counter affidavit contending that they are the registered proprietors of the trade mark "KOYA'S HEAVEN WOOD" by virtue of

their registration under No. 1467210 in class 3 dated 3.7.2006 and they are using the said trade mark ever since in the year 2006. It is further contended by the Respondent that the products viz., agarpathies are generally wood based which makes the trade mark "WOODS" descriptive and that there are hundreds of manufacturers all over India using the trade mark "WOODS" either as a whole or as part of their trade mark. Thus, the trade mark "WOODS" has also become publici juris i.e. common to the public. However, the Respondent had changed the entire colour-scheme, get up and layout of the entire carton/packaging for their "KOYA'S HEAVEN WOODS" and in view of the same, there is no visual similarity between the two products its packaging and therefore, the claim of the Appellant is liable to be rejected.

12. It is further contended that there is no misrepresentation on the part of the Respondent and therefore, the relief sought for by the Appellant/applicant regarding passing off cannot be granted. It is also contended by the Respondent that they are using their trade mark "KOYA'S HEAVEN WOOD" which includes their trade name "KOYA'S" which is prefixed to the "HEAVEN WOOD" which concerns of three different words, whereas the Appellant/applicant's trade mark is only "WOODS" which has become publici juris and that in the event of the Respondent have to discontinue the registered use of their trade mark, they will suffer irreparable damage and loss of reputation and monetary loss. Hence, the Respondent prayed for the dismissal of the applications.

13. The learned Judge, on taking into consideration the rival submissions and the decisions cited by the respective counsel, has held that the modified trade mark of the Respondent herein would disclose that the colour combination as well as printing method got changed and he could not see much of the muchness between the Appellant's trade mark and the Respondent's on the other side. The learned Judge further held that there is much difference in the present trade mark of the Respondent and the method of printing with colour combination with that of the Appellant's trade mark. Therefore, the learned Judge directed the Respondent herein to further change its trade mark by printing the word "KOYA'S" in commensurate with the size of the words "HEAVEN WOOD" and accordingly closed all the applications.

14. Heard Mrs. P.V. Rajeswari, learned Counsel appearing for the Appellant and Mr. R. Sathishkumar, learned Counsel appearing for the Respondent.

15. The learned Counsel appearing for the Appellant would submit that mere addition of the words "KOYA'S" prefixing the "HEAVEN WOOD" will not make any difference since no buyer would go to the shop and ask for the Respondent's products. On the other hand, the buyer would ask for only "WOODS" agarpathies and there is every chance that the shopkeeper would offer the Respondent's products instead of the Appellant's products. It is further contended by the learned Counsel appearing for the Appellant that once the trade mark is registered, the registered proprietor is entitled to protection in terms of Sections 28 and 29 of the Trade Marks Act, 1999. It is further submitted by the learned

Counsel appearing for the Appellant that mere addition of the words "KOYA"S" prefixing the words "HEAVEN WOOD" will not make any difference between the products of the Appellant and the Respondent as the essential feature to both trade marks is "WOOD". Therefore, the learned Counsel appearing for the Appellant prays for the setting aside of the orders passed in O.A. No. 854 of 2009 and consequential order of ad-interim injunction against the Respondent.

16. Per contra, the learned Counsel appearing for the Respondent apart from reiterating the stand taken by them in their counter affidavit as extracted above, would further submit that after the orders passed by the learned Judge, they have complied with the order by further changing its trade mark by printing the word "KOYA"S" in commensurate with the size of the words "HEAVEN WOOD" in the same font size and the colour structure has also been changed to Brown colour as against the Green colour of the Appellant's products.

17. The Court has carefully considered the submissions made by the learned Counsel appearing on either side and also perused the impugned order and the typed set of documents.

18. The question that arises for consideration is:

Whether the Respondent is to be restrained from using the offending trade mark and artistic work "HEAVEN WOOD" in respect of their products agarpathies and passing off the same?

19. The learned Counsel appearing for the Appellant in support of her submissions, placed reliance upon the following decisions:

(i) AIR 1974 Mad 7 - K.R. Chinnakrishna Chetty v. K. Venkatesa Mudaliar and Anr.

(ii) G.T.C. Industries Ltd., Bombay Vs. I.T.C. Limited, Madras, .

(iii) FAO (OS) 262 of 1994: 1996 (16) PTC 476 (Del) (DB) - N.R. Dongre and Ors. v. Whirlpool Corporation and Anr., Judgment dated 21.4.1995 rendered by the High Court of Delhi.

20. In AIR 1974 Mad 7 - K.R. Chinnakrishna Chetty v. K. Venkatesa Mudaliar and Anr., the Appellant therein has registered its trade mark as "Radha's Sri Andal" and whether it infringes or deceptively similar to the product manufactured and marketed by the Respondent as "Sri Ambal", a Division Bench of this Court in the said decision had considered various decisions cited before it including the judgment reported in K.R. Chinna Krishna Chettiar Vs. Shri Ambal and Co., Madras and Another, between the same parties and arrived at a finding that the combination of the words "Radha's Sri Andal" is likely to be taken by snuff users as the snuff manufactured and marketed by the Appellant originally as "Sri Andal". It has been further held in the said decision that there is a tangible danger that a substantial number of persons will confuse the Appellant's "Radha's Sri Andal" mark applied for with the Respondents' legend "Sri Ambal snuff".

21. In AIR 1992 Mad 253 - G.T.C. Industries Ltd., Bombay v. I.T.C. Limited, Madras (DB), the parties were two manufacturers of cigarettes and the subject matter of dispute with regard to the infringement and passing off the product namely Gold Flake Cigarettes. The learned single Judge in that decision found that there is a deceptive similarity between the two sets of marks and consequently restrained the G.T.C. Industries Limited, Bombay from infringing and passing off the Cigarettes under the said trade mark. As G.T.C. Industries Limited aggrieved by the same, had preferred appeal which came to be dismissed under the above cited decision.

22. In a decision rendered by the High Court of Delhi in FAO (OS) 262 of 1994: 1996 (16) PTC 476 (Del) (DB) - N.R. Dongre and Ors. v. Whirlpool Corporation and Anr., an issue arose for consideration with regard to the using of trade mark "WHIRLPOOL" by the Appellant therein N.R. Dongre and others, a Division Bench of the Delhi High Court has considered the scope of Section 28(1) of the Trade Marks Act and held as follows:

Neither Section 28 nor any other provisions of the Act bars an action for passing off by an anterior user of a trade mark against a registered user of the same. In other words registration of a trade mark does not provide a defence to the proceedings for passing off as u/s 27(2) of the Act a prior user of a trade mark can maintain an action for passing off against any subsequent user of an identical trade mark including a registered user thereof. Again this right is not affected by Section 31 of the Act, under which the only presumption that follows from registration of a mark is its prima facie evidentiary value about its validity and nothing more. This presumption is not an un rebuttable one & can be displaced. Besides Section 31 is not immune to the over-riding effect of Section 27(2). Placing reliance on Section 28(3) of the Act the learned Counsel for the Appellant contended that when two registered proprietors of identical or near similar trade marks cannot be deemed to have acquired exclusive right to the use of any of those trade marks against each other, how can an unregistered user of the trade mark maintain an action for passing off against a registered user of the same mark and seek an injunction restraining him from using it. This argument of the learned Counsel seems to stem from a misconception about the real purpose and intent of Section 28(3). Actually Section 28(3) protects registered proprietor of a trade mark from an infringement action by another registered proprietor of an identical or near similar trade mark.

It has been further held in the above cited decision that registration of trade mark would be irrelevant in an action for passing off and that in order to succeed at the stage of interlocutory application, the party had to establish user of the aforesaid mark prior in point of time than the impugned user i.e. the Respondents.

23. Per contra, the learned Counsel appearing for the Respondent has relied upon the following decisions:

(i) Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, ;

(ii) AIR 1998 Mad 347 (DB): 1998 PTC (18) 775(Mad)(DB) -Indo-Pharma Pharmaceuticals Ltd. v. Citadel Fine Pharmaceuticals Ltd.,

(iii) S.B.L. Ltd. Vs. Himalaya Drug Co., ,

(iv) Nutrine Confectionery Co. Ltd. Vs. Icon Household Products Pvt. Ltd. and ITC Ltd., .

24. In Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, , the issue pertains to trade mark "Navaratna Pharmaceutical Laboratories" and it has been held as follows:

The use by the Defendant of the trade mark of the Plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the Plaintiff must, no doubt, make out that the use of the Defendants mark is likely to deceive, but where the similarity between the Plaintiffs and the Defendants mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the Plaintiffs rights are violated. Expressed in another way, if the essential features of the trade mark of the Plaintiff have been adopted by the Defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the Defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the Plaintiff.

When once the use by the Defendant of the mark which is claimed to infringe the Plaintiffs mark is shown to be in the course of trade, the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the Plaintiff would have to establish that the mark used by the Defendant so nearly resembles the Plaintiffs registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide Section 21). A point has sometimes been raised as to whether the words or cause confusion introduce any element which is not already covered by the words likely to deceive and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the

concept indicated by the earlier words likely to deceive. But this apart, as the question arises in an action for infringement the onus would be on the Plaintiff to establish that the trade mark used by the Defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the Plaintiffs mark. The purpose of the comparison is for determining whether the essential features of the Plaintiffs trade mark are to be found in that used by the Defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the Defendant as a whole is deceptively similar to that of the registered mark of the Plaintiff.

25. In Indo-Pharma Pharmaceutical Works Ltd. Vs. Citadel Fine Pharmaceuticals Ltd., , the question arose for consideration was as to whether the word "ENERJASE" would be deceptively similar to the word "ENERJE". In the said decision, the decision rendered by the Hon'ble Supreme Court of India in Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, has been considered and also other decisions and the opinion of the authors relating to the trade marks and trade names. In the said decision the issue with regard to the publici juris has also been considered and it has been held that a generic name of a product can never function as a trade mark to indicate origin, as it has become a publici juris of which, no one can claim proprietary right for the exclusive use.

26. In S.B.L. Ltd. Vs. Himalaya Drug Co., viz., "LIV.52" as well as the trade mark used by the opposite party viz., "LIV-T" came up for consideration. A Division Bench of Delhi High Court, has once again taken into consideration the decision reported in Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, Parle Products case Parle Products (P) Ltd. Vs. J.P. and Co., Mysore, and other decisions and held as follows:

To sum up:

(1) The crucial tests to be applied for judging an infringement action or a passing off action in the field of medicinal and pharmaceutical preparations remain the same as are applicable to other goods. However, in the case of preparations trading whereof is governed by statutory rules or regulations, additional considerations become relevant. They are: (i) the manner in which the trade is carried on, such as sales being made only by authorised or licensed vendors who will be educated, also having special knowledge of medicines and pharmacy (ii)

the class of persons who would be the purchasers, whether they would be accompanied by doctors" prescription and would in all probability remain in touch with doctor while consuming the medicine purchased. The court would ask--Is there such a similarity between the two trade marks that a doctor or a chemist or the both by some carelessness in expression, some obscurity in handwriting, some slip of recollection or some careless mistake not expected of a trained professional like doctor or chemist might lead to the one being confused for the other? Regard shall be had not to the hypothetical possibilities but to ordinary practical business probabilities as applied to the circumstances of an individual case.

(2) The decision on the question of likelihood of deception is to be left to the Court.

(3) Nobody can claim exclusive right to use any word, abbreviation, or acronym which has become publici juris. In the trade of drugs it is common practice to name a drug by the name of the organ or ailment which it treats or the main ingredient of the drug. Such organ, ailment or ingredient being publici juris or generic cannot be owned by anyone for use as trade mark.

(4) Whether such feature is publici juris or generic is a question of fact.

(5) If the two trade marks by two competing traders use a generic word or an expression publici juris common to both the trade marks it has to be seen if the customers who purchase the goods would be guided by the use of such word of expression or would ignore it and give emphasis to prefixes or suffixes or words used in association therewith. The primary question to be asked is what would remain in the memory of customer? The surrounding circumstances such as the presentation of goods, colour scheme and lettering style etc. used on the packing also assume significance.

27. In *Nutrine Confectionery Co. Ltd. Vs. Icon Household Products Pvt. Ltd. and ITC Ltd.*, ., the use of the word "Lacto" came up for consideration and the Division Bench of this Court has considered various decisions of the Hon'ble Supreme Court of India and held that use of the word "Lacto" by the Respondents cannot be construed as infringement of trade mark "Lacto" as there are humpty number of traders are using the word "Lacto". It has been further held that the word "Lacto bon bon" is a common generic expression used in relation to milk candies.

28. This Court has taken into consideration the above cited decisions and the ratio laid down in those decisions. The facts of the case would disclose that the Appellant has registered its trade mark in the year 1996 and the carton colour-scheme and the artistic work would indicate that the carton used by the Appellant for the sale of agarpathies in the name and style of "WORDS" would disclose that it has been printed in green colour and they have also obtained copyright for that colour-scheme and artistic work.

29. The Respondent had registered its trade mark "Koya's HEAVEN WOOD" in Registration No. 1467210 in class 3 on 3.7.2006. Originally the Respondent herein was marketing their products under the name and style of " Koya's HEAVEN WOOD" and on an earlier occasion there was a suit filed against them which ended in a compromise and thereafter the Respondent herein started using a new carton with a changed colour-scheme, get up and layout and according to them there is no visual similarity between the two products manufactured by them and the Appellant.

30. The case of the Appellant was mainly projected on the footing that the Respondent is still retaining the essential feature of the Appellant's trade mark namely "WOODS" and in the event of their products being asked by the consumer the shopkeeper may get confused and would offer Respondent's products instead of the Appellant's products. It is the further case of the Appellant that their registered trade mark "WOODS" is entitled to protection in terms of Sections 28 and 29 of the Trade Marks Act. It is also the case of the Appellant that mere addition of the words "KOYA'S" as a prefix before the word "HEAVEN WOOD" by the Respondent will not make any difference since the essential feature of both trade mark is "WOOD".

31. However, the said claim was opposed by the Respondent by contending that they have entirely changed the colour-scheme, artistic work and font and there is no deceptive similarity between the products manufactured and sold by them and that of the Appellant. It is further contended by the Respondent that the word "WOOD" is a publici juris and consequently the Appellant cannot claim exclusive right to use the said word for the purpose of marketing their product.

32. The word publici juris is a Latin word and it deals with public right. The word "public" in this sense means pertaining to the people, or affecting the community at large; that concerns a multitude of people; and the word "right," as so used, means a well-founded claim; an interest; concern; advantage; benefit. This term, as applied to a thing or right, means that it is open to or exercisable by all persons. It designates things which are owned by "the public," that is, the entire state or community, and not by any private person. When a thing is common property, so that any one can make use of it who likes, it is said to be publici juris; as in the case of light, air, and public water (vide Black's Law Dictionary -5th Edn.).

33. Kerley in his book "Law of Trade Marks and Trade Names" (13th Edn.) states that names, which once carried a distinctive reference to a particular trader may, in consequence of successful piracies, or of their use by the trader himself for goods which are the goods of others, or are put forward as such, or for other reasons, lose it and fall into common use and become publici juris, in the same way as trade marks may be lost or abandoned. The proper test whether an exclusive right has become publici juris is whether the use of the trade mark by the other persons has ceased to deceive the public as to the maker of the article and that piracy, which exceeds in volume the genuine goods may fail to destroy

the reputation of a mark, if it remains surreptitious, so that the ultimate consumer never appreciates the true position.

34. Dr. Venkateswaran in the book "The Law of Trade Marks and Passing Off" (4th Edn.), has stated that marks, which are common to the trade cannot be distinctive to the goods of any particular manufacturer and will not be registered. A mark may be common to the trade when it is in common use in the trade in the goods concerned or is open to the trade to use. A word to the exclusive use of which as a trade mark a particular trader has been entitled, may subsequently become publici juris and if this happens no monopoly can thereafter be claimed by any person in that word. Every trader has a right to use for his trade purposes the terminology common in his trade, provided always that he does this in a fair, distinct and unequivocal way. The author is also of the opinion that the phrase "common to the trade" is capable of two meanings:"i) in common use in the trade;ii) open to the trade to use" and that it is a question of fact in each case whether a mark is common to the trade.

35. In Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd., , it was held by the Supreme Court that the real question to decide in cases is to see 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. The Supreme Court further held that in deciding a question of similarity between two marks, marks have to be considered as a whole and that the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. It further held that to decide the question, it must be seen as to how an unwary purchaser of average intelligence and imperfect recollection split the name into its component parts and consider its etymological meaning thereof or ever consider the meaning of the composite words.

36. In Laxmikant V. Patel Vs. Chetanbhat Shah and Another, , the Supreme Court held that an action for passing off will lie whenever the Defendant company's name or its intended name is calculated to deceive, and so to divert business from the Plaintiff, or to occasion a confusion between the two businesses and if this is not made out there is no case. It further stated that where there is probability of confusion in business, an injunction will be granted even though the Defendants adopted the name innocently. The Supreme Court was of the further view that honesty and fair play are, and ought to be, the basic policies in the world of business and that when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of some one else to himself and thereby resulting in injury. The Supreme Court referred to the judgment in Oertil v. Bowman, 1957 RPC 388 and held that gist of passing off action was defined by stating that it was essential to the success of any claim of passing off based on the use of given mark or get-up that

the Plaintiff should be able to show that the disputed mark or get-up has become by user in the country distinctive of the Plaintiffs goods so that the use in relation to any goods of the kind dealt in by the Plaintiff of that mark or get-up will be understood by the trade and the public in that country as meaning that the goods are the Plaintiff's goods."

37. The ratio laid down in the above cited decision would make it clear that it is for this Court to approach the question from the point of view of a man of average intelligence and imperfect recollection to find out whether in a given case the words are deceptively similar and whether an unwary purchaser of average intelligence and imperfect recollection deceived. It should be borne in mind that the object of the enquiry in deciding the question in the ultimate analysis is, whether the mark used by the Respondent as a whole is deceptively similar to that of the registered trade mark of the Appellant and that whether the word "WOOD" is a *publici juris* and whether the Appellant herein is entitled for an order of ad-interim injunction.

38. In the considered opinion of the Court, the word "WOOD" is a *publici juris*. The Respondent in this connection, has drawn the attention of this Court to various products including agarpathies manufactured and marketed by different firms. The documentary evidence of the same is available from page No. 79 to 89 of the typed set of papers. A perusal of those documents would disclose that the word "WOOD" is a necessary ingredient for manufacture of agarpathies and consequently most of the manufacturers are using it for the manufacture of agarpathies except for the manufacture of "Dhooth" sticks. Any one can make use of the wood as he likes and if it is so, it will be *publici juris*. Therefore, the claim of the Appellant that since they got the registration of the trade mark under the name and style of "WOODS", they alone have exclusively got right to use the same, in our considered opinion lacks merit.

39. In so far as passing off is concerned, the use by the Respondent herein with regard to the word "WOOD" in their products is not essential in an action for passing off. u/s 27(2) of the Trade Marks Act, Registration of the trade mark does not proper defense to the proceedings to the passing off as still a prior user of a trade mark can maintain an action for passing off against any subsequent user of an identical trade mark including a registered user thereof. The said right is not affected by Section 31 of the Act, under which the only presumption that follows from registration of a mark is its *prima facie* evidentiary value about its validity and nothing more. This presumption is not an un rebuttable one and can be displaced.

40. It is to be pointed out at this juncture that subsequent to the impugned order which is the subject matter of challenge in this appeal, the Respondent has changed the size of the font and brought alteration in compliance of the order. This Court has also compared the carton of the agarpathies manufactured by the Appellant and the Respondent and found that the carton of the Respondent contains entirely different colour-scheme, font and the words appearing on the

font are also of different context and conveys different meaning. Therefore, it cannot be said that the shopkeeper as well as the intending purchaser will be mislead or confused with regard to the product namely agarpathi being sold by the Appellant and the Respondent.

41. We, on a careful consideration and appreciation of the entire materials available on record, are of the considered opinion that there is no error apparent on the face of the record in the order passed by the learned Judge and we find no merits in this appeal. Therefore, the appeal is dismissed. However, in the circumstances of the case, there will be no order as to costs. Consequently, M.P. No. 1 of 2009 is closed.