

(2018) 10 CAL CK 0001
In the Calcutta High Court

Case No : Government Appeal No.1267, 1938 Of 2018, C.S. No.102 Of 2018

Shambhu Nath & Brothers & Ors

APPELLANT

Vs

Imran Khan

RESPONDENT

Date of Decision : 03-10-2018

Acts Referred:

Trade Marks Act, 1999 — Section 2(h), 2(m), 2(w), 15, 17, 17(1), 17(2), 17(2)(a), 17(2)(b), 23(2), 28, 29, 29(1), 134, 135
Copyright Act, 1957 — Section 62
Trade Marks Rules, 2002 — Rule 25(12)(d), 29(2), 62(1)
Code of Civil Procedure, 1908 — Order 2 Rule 3

Citation : (2018) 10 CAL CK 0001

Hon'ble Judges : Soumen Sen, J

Bench : Single Bench

Advocate : Pratap Chatterjee, Ranjan Bachawat, Sayantan Basu, Debnath Ghosh, Prithwiraj Sinha, Gopal Das, T.K. Jana, Sourav Jana, Shuvasis Sengupta, Susmita Ghosh, Balarko Sen, Parashar Baidya

Judgement

Soumen Sen, J.

This is an action for infringement and passing off. The petitioners are the manufacturer of electrical fans of various kinds. The petitioners in or about

1987 adopted the trade mark "TOOFAN". The said trade mark "TOOFAN" is written in a stylish manner with a gap at the top of the two

characters in the word and the letter "F" written in capital in a rectangular box with the sides curved and the word "TOOFAN" forming

only the distinctive and/or the prominent feature in the said mark taken as a whole. The said trade mark is represented as and its stylized

representations both have become distinctive of the goods of the petitioners and no one else. The word "TOOFAN" is printed on the products,

packaging materials, brochures, warranty cards, bills and invoices of the

petitioners. The said goods manufactured by the petitioners are distributed and/or sold extensively in various States including the State of West Bengal, Bihar, Orissa, Assam, Tamil Nadu, Andhra Pradesh, Uttar Pradesh, Madhya Pradesh, and Gujarat through an established network of dealers and distributors.

The petitioners have claimed superior quality of the said goods and have disclosed its turnover since 1987-1988 till 2017-2018. The turnover is quite

substantial. The petitioners claimed that the petitioners are prior adopters and users of the trade mark "TOOFAN" and have been using the said

trade mark "TOOFAN" continuously and uninterruptedly. The petitioners claimed that by reason of such prior bona fide adoption coupled with

long continuous use and wide publicity thereof, the petitioners have become the exclusive proprietor of the said trade mark "TOOFAN". The

purchasing public and the members of the trade easily identify and distinguish the goods sold under the mark "TOOFAN" to have been originated

from or connected with the business of the petitioners only and none else. The petitioners have also disclosed the expenditure entered by the

petitioners since 1998-1999 till 2016-2017 towards advertisement and publicity. The expenditures are also quite substantial. In order to prevent any

unauthorized use of the said mark "TOOFAN" and in order to make people aware of the mark "TOOFAN" for the said goods exclusively

belonging to the petitioners and none else, the petitioners published Caution Notices in various newspapers from time to time. The petitioners in this

proceeding have disclosed few of such notices and advertisements.

In order to obtain statutory protection over the said trade mark "TOOFAN" on or about August 26, 1993, the petitioners filed an application being

No.605175 in class 11 under the Trade & Merchandise Marks Act, 1958 (in short "TMM Act", 1958) before the Trade Marks Registry, which

was registered in their favour on 9th April, 2012. The registration is in respect of installation for ventilating, namely, ceiling fans, parts and fittings

thereof included in Class 11 for sale in the States of West Bengal, Bihar, Assam, Orissa, Uttar Pradesh, Madhya Pradesh, Gujarat, Andhra Pradesh

and Tamil Nadu. The certificate of registration of trade mark under Section 23(2), Rule 62(1) of the Trade Marks Rules is annexed to the Petition.

This stylized representation of the mark "TOOFAN" has also been registered

under the Copyright Act, 1957 on 30th April, 2005 for the artistic work.

Subsequently, in or about March, 2010, the petitioners filed another application being No.1931345 dated 5th March, 2010 for registration of the word

mark "TOOFAN" and obtained registration on 3rd April, 2017. The registration was, however, given for a device mark "TOOFAN". On July

18, 2018, the trade mark attorney of the petitioners has requested the Deputy Registrar of Trade Mark to amend the status of the registered trade

mark from device to word.

The petitioners alleged that in or about October, 2017, the petitioners came to know that the respondent had also applied for registration of the mark

"SNJ TOOFAN" which was published in the Trade Marks Journal No.1820 dated 23rd October, 2017. The petitioners subsequently came to

know that the respondent had filed an application being No.3338399 dated 17th August, 2016 in Class 11 under the Trade Marks Act, 1999 for

registration of the impugned mark "SNJ TOOFAN" in respect of apparatus for lighting, heating steam generating, cooking, refrigerating, drying,

ventilating, water supply and sanitary purposes claiming user thereof since 1st August, 2016. The petitioners contend that claim of user of the

impugned mark is mala fide, false, incorrect and is also subsequent to that of the petitioners.

The petitioners further alleged that from the application for registration and the advertisement published in the Trade Marks Journal, it further appears

that the respondent has adopted the identical expression "TOOFAN" and added "SNJ" as a prefix thereto. Such adoption of the impugned

trade mark "SNJ TOOFAN" consisting of the petitioners' registered trade mark "TOOFAN" by the respondent is dishonest, mala fide

and made with an intent to mislead the innocent customers as also the members of the trade and thereby pass off his inferior goods as and for the

goods of the petitioners. The said registration is being opposed by the petitioners and the said proceeding is pending final adjudication. On such facts

and circumstances, the petitioners filed a suit for infringement and passing off. In the suit, a prayer is prayed for leave under Clause 14 of the Letters

Patent. The jurisdiction of this Court is invoked under Section 134 of the Trade Marks Act, 1999 and also under Section 62 of the Copyright Act,

1957. The necessary averments for joinder of causes of action are Paragraphs 31, 32 and 33 of the Plaint which are reproduced below:-

31. The plaintiffs have ascertained that the defendant has made a false statement and given an incorrect date of user of the mark in the statement

of user in his application for registration. The plaintiffs have ascertained that the defendant has started using the mark "SNJ TOOFAN" and/or

"TOOFAN" very recently from the third week of March, 2018. The cause of action of the plaintiffs as against the defendant is for infringement

of the plaintiffs' registered trademark TOOFAN and by reasons of use of the mark "SNJ TOOFAN" and/or "TOOFAN" by the

defendant and also for passing off. Such cause of action of the plaintiffs as against the defendant is recurring in nature and every sale of goods by the

defendant under the mark "SNJ TOOFAN" and/or "TOOFAN" gives fresh cause of action to the plaintiffs to sue for infringement and

passing off. Hence, there is no delay on the part of the plaintiffs in filing the present suit.

32. The impugned trade mark "SNJ TOOFAN" and/or "TOOFAN" is both phonetically and deceptively similar to the plaintiffs

registered trade mark "TOOFAN" and has also applied for registration thereof in respect of fans falling in class 11 under the Trade Marks Act,

1999. The defendant is selling his products by using such a deceptively similar/identical trade mark and the innocent purchaser of ordinary prudence

and imperfect recollection as also the members of trade would easily be confused and deceived. They would purchase the inferior products of the

defendant under a bona fide mistake that such goods are originating from the plaintiff or connected with their business.

33. The cause of action of the instant suit arose out of infringement of the plaintiffs' registered trade mark "TOOFAN" as well as passing off

in respect thereof. Since the cause of action relating to infringement has arisen within the aforesaid jurisdiction of this Hon'ble Court and the

cause of action relating to passing off has taken place and still now taking place at the defendant's place of business at WE-508/6E, Basai

Darapur, New Delhi - 110015 outside the aforesaid jurisdiction, the plaintiffs pray for leave under Clause 14 of the Letters Patent, 1865 to join the

causes of action relating to infringement of the plaintiffs' registered trade mark "TOOFAN" and the cause of action relation to passing off in

the present suit. The plaintiffs further state that if necessary appropriate notice may be served upon the defendant directing him to show cause as to

why such leave under Clause 14 of the Letters Patent, 1865 for joinder of several causes of action in the present suit should not be granted.â??

At the time of institution of the suit, notice was issued to the defendant to show cause as to why leave under Clause 14 of the Letters Patent should

not be granted. The respondent has replied to the show cause. The respondent has also filed an application for rejection of plaint being G.A. No.1938

of 2018. In its reply to show cause and in its application for rejection of plaint the respondent has stated that the plaintiffs do not have any registration

on â??TOOFANâ? (word mark) and in view of Section 17 read with Section 29, the plaintiffs cannot maintain any suit for infringement of trade mark

before this Honâ??ble Court. However, the plaintiffs have made misleading statement on oath that the plaintiffs have obtained the registration of

word mark â??TOOFANâ? and obtained an ad interim order of injunction on 13th June, 2018 which has been subsequently recalled by this

Honâ??ble Court on 9th July, 2018.

The respondent is carrying on business from its office at WZ-508/6E, Basai, Darapur, New Delhi â?" 110 015, outside the jurisdiction of this

Honâ??ble Court. The respondent has not obtained leave under Clause 12 of the Letters Patent. The petitioners have no registration of the word

mark â??TOOFANâ? and, accordingly, cannot maintain any suit for infringement of the trade mark. In view thereof, the petitioners cannot invoke

any jurisdiction under Section 135 of the Trade Marks Act, 1999. In any event, the petitioners have not disclosed any cause of action which is arising

within the jurisdiction of this Court in connection with passing off. Filing of trade mark application by the respondent for registration of the trade mark

â??SNJ TOOFANâ? before the Trade Mark Registry would not constitute any passing off and in any event would not confer any jurisdiction on this

Court against the respondent. The petitioners have admitted that the defendant is carrying on business of manufacturing and selling fans at New Delhi

outside the jurisdiction of this Court. The act of passing off the goods of the respondent, as that of the petitioners, if any, had taken place and still now

is taking place at the respondentâ??s place of business. Hence the suit for infringement of trade mark as well as passing off is not maintainable in

this Court. On merits, it is submitted that in absence of any registration of word mark 'TOOFAN', the suit for infringement cannot lie and no

cause of action has been disclosed for infringement of the trade mark against the respondent in the plaint. On such considerations, the respondent has

opposed the leave under Clause 14 of the Letters Patent and prayed for dismissal of the suit.

Mr. Shuvasis Sengupta, the learned Counsel appearing on behalf of the respondent in respect of the affidavit filed in answer to the show cause issued

under Clause 14 of the Letters Patent has submitted that the petitioners have obtained registration of trade mark 'TOOFAN' (device) and not the

word mark 'TOOFAN'. Accordingly, the petitioners cannot maintain the suit for infringement. If the suit for infringement is not maintainable on

the basis of the said device mark 'TOOFAN' then the question of joinder of causes of action does not arise. The petitioners cannot maintain a

composite suit for infringement of trade mark and passing on the basis of such pleading. In absence of the cause of action for infringement within the

jurisdiction, cause of action for passing off cannot be allowed to be joined by granting leave under Clause 14 of the Letters Patent.

Mr. Sengupta has relied upon a Division Bench Judgement of the Bombay High Court in Harman Overseas v. Dongguan TR Bearing Company

Limited reported at 2017 SCC Online Bom 7327: 2018 (2) Bom CR 167 for the proposition that in deciding an application for leave under Clause 14 of

the Letters Patent, the Court can also consider the merits of the dispute. Mr. Sengupta has referred to Section 2(m) of the Trade Marks Act and

submits that under Section 2(m), a 'mark' is defined to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape

of goods, packaging or combination of colour or any combination thereof.

Therefore, the concept of word mark, label mark and device mark has been well recognized in the Trade Marks Act, 1999. In the Sixth Edition of

'Law of Trade Marks and Passing Off' by P. Narayanan, the 'device marks' and 'word marks' have been recognized and accepted.

In the commentary, the author says that the 'device' has various meanings. In the trade mark sense, the 'device' includes pictorial

representation of any object or thing. It also says that the definition of the marks includes words such as invented words and coin words, non-

descriptive words and descriptive words.

Mr. Sengupta submits that although an impression is sought to be given that there is no concept of any 'word mark' or 'device mark' in the

laws relating to the trade mark, the definition of Section 2(m) makes it clear that a mark could be a word mark or a device mark and such distinction

has also been illustrated in the Law of trade mark and Passing off by P. Narayanan. It is submitted that the argument that there is no distinction

between a word mark or a device mark is contrary to the definition of mark in the Trade Marks Act, 1999 and the judgement in Three-N-Products

Private Limited vs. Emami Limited reported at 2008 (4) CHN 608 which has since been affirmed by the Division Bench in Emami Ltd. Vs. Three-N-

Products Pvt. Ltd. reported at 2010 (2) CHN (Cal) 217.

Mr. Sengupta submits that the main question that has arisen is when the plaintiffs have obtained the registration of the 'device mark', whether the

plaintiffs can claim exclusive right over the word 'TOOFAN'. The issue has been decided in the judgment of Registrar of Trade Marks Vs.

Ashok Chandra Rakshit reported at AIR 1955 SC 558 where the Hon'ble Supreme Court held that where a distinctive label is registered as a

whole, such registration possibly gives an exclusive statutory right to the petitioner of the trade mark to use any particular word or name contained

therein apart from the mark as a whole.

It is undisputed that presently, the mark of the petitioners has been registered as 'device' and not 'word'. According to the provisions of

Section 2(w) of the Trade Marks Act, 1999 a Registered Trade Mark means a trade mark which is actually on the register and remain in force.

Therefore, at present, the plaintiffs have the registered trade mark in connection with device and not word. It is submitted that although the judgment

of Ashok Chandra Rakshit (supra) was rendered under the Act, 1958 the same holds good even after the introduction of Trade Marks Act, 1999

which came into force on 15th September, 2003. Mr. Sengupta refers to Section 17 of the Trade Marks Act, 1999 which reads:-

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken

as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark is

(a) contains any part of?

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any

exclusive right in the matter forming only a part of the whole of the trade mark so registered.??

Mr. Sengupta submits that Section 17 read with Sections 28 and 29 of the Trade Marks Act, 1999 has been interpreted in Three-N-Products Pvt. Ltd.

(supra) in which it is stated that the registration of the composite mark would not ipso facto confer any exclusive rights as to the parts of the

composite mark. The plaintiffs claim for infringement based on its ??Ayur? mark as a part of its device registration was found to be unacceptable

at the interlocutory stage. The learned counsel has relied upon paragraphs 5, 12, 14, 25, 26, 30, 32, 33, 36, 45 and 54 of the report.

Mr. Sengupta also referred to the judgement of the Division Bench in Emami Ltd. (supra) and submits that in affirming the judgement, the Division

Bench has held that registration of a composite mark by itself does not confer any exclusive right as to the part of the composite mark. Infringement

action is not maintainable on the basis of an unregistered part of the whole mark. In this regard, the learned Counsel has relied upon Paragraphs 15,

18-22, 25, 30, 32, 33 and 35 of the Division Bench judgment.

Per contra, Mr. Pratap Chatterjee, the learned Senior Counsel appearing with Mr. Ranjan Bachawat, learned Senior Counsel, has submitted that the

respondent is trying to confuse the issue by making a distinction between the word mark and the label mark. The learned Senior Counsel submits that

the mark has been taken and read as a whole. There may be many features in a mark and if it appears on a look at the said mark that there are no

other distinctive and/or distinguishing features other than what is prominently displayed then that forms the mark. It is submitted that, in the instant

case, the Registrar has wrongly granted registration in respect of a device which again is a mark, although, the application was filed for registration of

a word mark and advertisement has been published treating the mark as a word mark.

Mr. Chatterjee has referred to the letter issued by the Trade Mark Attorney of the plaintiffs dated July 18, 2018 where the Registry was requested to

amend the Registration Certificate. Mr. Chatterjee submits that in any event what transpires from the mark is the word 'TOOFAN' all in capital

letter and there are no other distinguishing marks apart from the said word prominently and distinctively displayed. Mr. Chatterjee submits that unlike

Three-N-Products (supra), there are no other features of trade mark which require separate registration. The silhouette of the mark is a shadow

which has mistakenly appeared while taking out a Photostat copy. The original application was produced to show that what was applied was for the

registration of the word 'TOOFAN'. The word is not surrounded by any concave design or any other designs or any associate marks to denude

the said mark 'TOOFAN' from its distinctiveness. The mark 'TOOFAN' is the stand alone mark and it is one in itself. Mr. Chatterjee

submits that if the entirety of the mark is registered as a whole then it also tantamount to registration of the essential feature or part of that mark. In

the instant case, it is argued that the essential feature of the mark is 'TOOFAN' and nothing else. In this regard, Mr. Chatterjee has relied upon

the following decisions:-

a) Ramdev Food v. Arvinbhai Rambhai reported at AIR 2006 SC 3304 (Paragraphs 78, 81 to 83);

b) Assam Roofing Vs. JSB Cement LLP & Anr. reported at AIR 2016 Cal 41: Volume 68 PTC 37 (Paragraphs 61 and 69);

c) United Biotech Vs. Orchid Chemicals reported at Volume 50 PTC 433 (Paragraphs 25, 26).

It is submitted that ascertainment of essential features in a mark is not by ocular test alone but also by consideration of sound or significance of those

words forming part of the said mark or trademark. The learned Senior Counsel, in this regard, has referred to a Single Bench decision in Khadim India

Ltd. Vs. Lifestyle reported at 2015 SCC OnLine Cal 3866 (Paragraph 22). The learned Senior Counsel has referred to Rule 25(12)(d) and Rule 29(2)

of the Trade Mark Rules, 2002 and submits that in order to claim distinctive feature in respect of the combination of colours there has to be a

statement to that effect in the trademark application. In the instant case, no such statement has been made. There are neither multiple nor several

features in the said trade mark as a whole. The only feature both prominent and distinctive in the said trade mark is 'TOOFAN'.

In dealing with the submissions made for rejection of plaint it is submitted that:-

a) Both Section 28 and Section 29 of the Trade Marks Act, 1999 make it clear that an action for infringement of a trade mark is not restricted to word

marks alone and an infringement action can be brought in relation to any trademark including a label or a device which is registered.

b) Section 28 of Trade Marks Act, 1999 provides that the registration of trade mark shall give to the registered proprietor to obtain relief in respect of

infringement of trade mark.

c) Similarly Section 29 deals with infringement by user of identical or deceptively similar trademarks. It is clear from these sections that the right to

obtain relief for infringement is not conditional upon registration of a word mark as argued.

d) It is thus clear that these sections relating to infringement do not make any distinction between word and label marks.

In response to the argument made in respect of not granting leave under Clause 14 of the Letters Patent it is submitted that if this Court has

jurisdiction to have the first cause of action then in such event, this Court will also have jurisdiction for the second or later part of the cause of action.

Only if the Court is satisfied that *ex facie*, the Court has no jurisdiction to entertain a suit based on the first cause of action, the Hon'ble Court will

be justified in exercising discretion by refusing the leave under Clause 14 of the Letters Patent but not otherwise. The primary consideration, while

deciding applications for grant of leave under Clause 14 of the Letters Patent is 'avoiding multiplicity of litigation'.

In this regard, reliance is placed on a Single Bench decision of this Court in *ITC Limited Vs. Godfrey Phillips India Ltd.* reported at 2014 (1) CHN

(Cal) 643. Mr. Chatterjee submits that the principles enumerated in the said decision also finds place in the judgment cited by Mr. Sengupta on behalf

of the defendant in *Harman Overseas v. Dongguan TR Bearing Company Limited* reported at 2017 SCC OnLine Bom 7327; 2018 (2) Bom CR 167

(Paragraphs 30 and 31).

In reply, Mr. Sengupta has submitted that *Alakananda Cement Private Limited vs. Ultratech Cement Limited* reported at 2012 (1) Bom CR 519 is

contrary to the Division Bench judgment in Emami Ltd. (supra). Furthermore, the judgment of Assam Roofing (supra), is not applicable as in that case

the mark ‘Rhino’ word per se was registered. Mr. Sengupta contended that as the coordinate bench has already decided the point and the

Hon’ble Division Bench has affirmed the view of the learned Single Judge, this Court cannot ignore the binding precedent of a coordinate bench.

Mr. Sengupta in this regard has relied on Maharashtra University of Health Sciences (represented by Dy. Registrar) Vs. Paryani Mukesh Jawaharlal

& Ors. reported at (2007) 10 SCC 201, and submits that the Hon’ble Supreme Court has stated that if the coordinate bench wants to take a

different view, judicial propriety requires that such matter be referred to a larger bench.

The issues raised are inextricably connected and accordingly taken up together. The petitioners are undoubtedly owner of the mark

‘TOOFAAN’ and are prior users. The materials produced before this court show that the petitioners have applied for the registration on March

5, 2010 of a word mark ‘TOOFAAN’ claiming user since 31st December 1987. The advertisement published in the Trade Mark Journal on

November 24, 2014 was for the word mark ‘TOOFAAN’. The mark ‘TOOFAAN’ as published is reproduced below:-

The registration certificate however was issued for a device mark on April, 2017. The trade mark image in the certificate as it appears is:

The trade mark attorney of the petitioners noticing such mistake by a letter dated July 18, 2018 requested the Deputy Registrar of Trade Mark to

amend the status of the registered trade mark from device to word. In the instant case, the main issue is whether ‘TOOFAN’ is a word mark or

a label mark and in the event that it is held to be a label mark, which apparently would seem to be so as the status of the mark has not yet been

amended from device to word, whether an infringement action would succeed merely on the basis of the word ‘TOOFAN’ displayed on the

label.

Section 2(m) of the Trade Marks Act gives an inclusive definition of ‘mark’. Mark includes a device, brand, heading, label, ticket, name,

signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. Section 2(h) defines ‘deceptively

similarâ?. It states that a mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that the other mark as to be likely to deceive or cause confusion. Under Section 29 a registered trade mark is infringed, if â?

- (a) the mark is identical and is used in respect of similar goods or services; or
- (b) the mark is similar to the registered trade mark and there is an identical or similarity of the goods or services covered by the trade mark; or
- (c) the trade mark is identical and is used in relation to identical goods or services;

and that such use is likely to cause confusion on the part of the public or is likely to be taken to have an association with the registered trade mark.

This clause further lays down that in cases falling in category (c) above, there will be a legal presumption of likelihood of confusion on the part of the

public. The ingredients of Section 29(1) are as follows:-

1. The plaintiffâ??s mark is registered.
2. The defendantâ??s mark is identical with, or deceptively similar to the plaintiffâ??s registered mark.
3. The defendantâ??s use of the mark is in the course of trade in respect of goods/services covered by the registered trade mark.
4. The use by the defendant is in such manner as to render the use of the mark likely to be taken as being use as a trade mark.
5. The defendantâ??s use of the mark is not by way of â??permitted userâ?? and accordingly unauthorized infringing use.

The function of a trade mark is to distinguish the goods of one person from others. As was said by UPJOHN, J., â??A man infringes the mark of

another if he seizes upon some essential feature of the plaintiffâ??s mark. That essential feature may be ascertained by the eye or by the ear in this

sense, that goods bearing that mark may be likely to become known by a certain nameâ?|â?|Furthermore evidence is admissible to establish what is or

has become an essential feature, but evidence is not essential if the Court feels satisfied on inspection in coming to the conclusion that some particular

feature is a distinguishing feature of the Mark allegedly infringedâ?. (Cluett Peabody & Co. Inc. Vs. McIntyre Hogg Marsh & Co. Ltd.; 1958 RPC at

351)

It has long been accepted that, if a word forming part of a mark has come in

trade to use to identify the goods of the owner of the mark, it is an infringement of the mark itself to use that word as the mark or part of the mark of another trader, for confusion is likely to result. It is sufficient to refer to the words of Lord Cranworth L.C., in *Seixo v. Provezende* (1866 LR 1 Ch. 192) "If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market, may be as much a violation of the rights of that rival as the actual copy of his device". The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole.

The function of the trade marks is to identify the source of manufacture of goods. It is an indication of origin. In the market the chief value of the trade mark is its power to stimulate sales. In law, the fundamental theory upon which the interest in the trade mark is protected is that a trade mark identifies the goods coming from a particular source, and that an infringing designation tends to divert customer from that source by falsely representing that other goods come from it. (See *Ellora Industries v. Banarasi Dass Gupta*; AIR 1980 Del 254).

A trade mark is infringed if the essential features of the registered mark of an owner have been copied. A mark is said to be infringed by another trader if, even without using the whole of it, the latter uses one or more of its essential features. If a word forming part of a mark has come in trade to be used to identify the goods of the owner of the mark, it is an infringement of the mark itself to use that word as the mark or part of the mark of another trader. (See *Balsara Hygiene Products Ltd. v. Arun Chowdhury*; 2005 (30) PTC 272 (Cal))

It is no answer to a charge of infringement "as contrasted with a passing off action - that the defendant's mark, whilst including the

plaintiff's mark, includes other marks too. Still less is it an answer that by something outside that actual mark, the defendant has distinguished his

goods from those of the plaintiff by adding his own name (Kerly's Law of Trade Mark and Trade Names, Para 14.22). However, the same

principle is not absolute as the celebrated author in the same paragraph says:-

"But the use of the defendant's name as part of the mark complained of is an element to be considered and in some cases it has turned the

scale in his favour" (Jewsbury & Brown v. Andrew & Atkinson, (1911) 28 RPC 293).

However, in the instant case, it cannot be said that the respondent is able to establish any such distinguishing feature which would distinguish its goods

from that of the plaintiffs. The trade mark is the whole thing. When a word mark or a label mark or a get up is considered, the court would be

required to consider the totality of the situation "the goods as a whole with due regard to the background provided by any other marks shown to be

in use.

The trade mark is the whole thing "the whole picture in relation to each of the marks being compared has to be considered. There may be

differences in the parts of each mark, but it is important to consider the mode in which the parts are put together and to judge whether the dissimilarity

of the part or parts is enough to make the whole dissimilar. (Kerly's Law of Trade Mark and Trade Names, 14th Edn.)

The Hon'ble Supreme Court in S.M. Dyechem case reported at (2000) 5 SCC 573 has quoted with the approval from the passages of Kerly on

Trade Mark and Halsbury's Laws of England (vol.38, 34th Edn. Para 986) to lay down the guidelines and principles to be followed by Courts to

ascertain whether essential feature has been copied resulting in infringement. Where the essential elements have been copied, the Hon'ble

Supreme Court observed that the court "would not return a finding on whether there was an intention to deceive or cause confusion in infringement

actions ... It was further opined that a suit for passing-off may fail but a suit for infringement may succeed because the additions, the get-up and trade

dress may enable a defendant to escape in a passing-off action".

The said section jealously protects a reputed mark. The Trade Mark law does not permit and protect a person who is trying to take the benefit of

someone else's reputation with references to goods which may not be similar when it is established that the said mark has acquired same reputation.

Section 17 of the Trademark Act, 1999 is a newly inserted provision dealing with the effect of registration of parts of a mark. It omits the provision relating to requirement of disclaimer as contemplated under Section 17 of the 1958 Act. A disclaimer may be necessary to preserve the essential validity of the trademark. Section 17 contemplates that if a trademark consists of several matters, the registration of that trademark confers exclusive rights to use the trademark as a whole on the proprietor. But when a trademark contains any part which is not subject of a separate application or which is not separately registered or contains any matter which is common to the trademark or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of a trademark so registered.

It states clearly that the general proposition that the registration of the trademark confers exclusive right to use the trademark taken as a whole and not separately to each constituent part if any, of the whole trademark of a registered trademark. If the proprietor of the trademark desires to the exclusive use of any part of that trademark, he would be required to apply for a registration of the whole and the part as separate trademarks. A part must also satisfy independently the requirements of registrable mark.

As a matter of law, there is no necessity for disclaimer of part of a mark since in an infringement action, unless the opposite party appropriates substantially the whole mark of the registered proprietor so that the two marks so nearly resemble each other as to be likely to cause confusion or deception, there is no infringement. (See *C.V.S Subbaih Nadar v. E.P. Kumaraval*, (1946) 63 RPC 187, 190).

In *Ashok Chandra Rakshit* (supra), a trademark consisting of superposed triangles and ornamental figures enclosed within a circle, the word 'Shree' at two places in bold letters and the words 'Shree Durga Charan Rakhit' was registered in respect of ghee. Subsequently, the registrar found that the word 'Shree' was used by Hindus as an auspicious symbol and was not adapted to distinguish and the office practice became established whereby the word 'Shree' was either refused

registration as a trade mark or disclaimer was imposed if it were made a part of the mark. The Registrar moved of his own to have the Register rectified by inserting a disclaimer of the word 'Shree'. The registered proprietors contended that they never claimed the right to the word 'Shree' simpliciter and had claimed a right to the distinctive mark as a whole of which the word 'Shree' formed only a part. The Registrar ordered a rectification of the Register by inserting a disclaimer of the word 'Shree', but an appeal was allowed.

On further appeal, the Registrar's order was restored by the Supreme Court. It was observed that 'the attention of the High Court was not drawn to an important consideration, namely, the strong possibility of the company claiming a statutory right to the word 'Shree' by virtue of the registration of its trade mark and subjecting others to infringement actions only on the strength of the registration and without proof of facts which it would have otherwise to establish in order to succeed in a passing off action or a prosecution under the Indian Penal Code' and therefore, the High Court could not be said to have properly exercised its discretion. The Supreme Court observed that where the distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole. The said decision refers to the observation made by Lord ESHER in *Pinto vs. Badman* [(1891) 8 RPC 181] where it is stated that the truth is that the label does not consist of each particular part of it, but consists of the combination of them all. As observed by the Supreme Court in *Ashok Chandra Rakhit Ltd.* (supra), the real purpose of requiring a disclaimer is to define the rights of the proprietor under the registration so as to minimise, even if it cannot wholly eliminate, the possibility of extravagant and unauthorised claims being made on the score of registration of trademarks.

The said decision was followed in *Godfrey Phillips India Ltd. v. Girnar Food & Beverages Pvt. Ltd.* reported at 1998 (9) SCC 531 where the Apex Court held that the plaintiff could pray for an injunction of passing off despite a disclaimer. To the same effect is the decision in *Charan Das & M/s. Veer Industries (India) v. M/s. Bombay Crockery House* reported at 1984 PTC 102 where the plaintiffs' mark was 'PERFECT' and

â??SWASTIC PERFECTâ?? and it had disclaimed the word â??PERFECTâ??. The new Section 17(1) enacts this general proposition.

In *Pidilite Industries Limited v. Jubilant Agri & Consumer Products Ltd.* reported at 2014 (57) PTC 617 (Bom): 2014 (2) ABR 142, Section 17(1) of

the Act came up for consideration. It is stated:-

â??It is true that the registration of a composite mark confers upon the registered proprietor a monopoly over the trademark taken as a whole. It is

not the plaintiffâ??s contention that the registration of a composite mark confers upon the registered proprietor exclusivity over each and every

constituent part thereof (no matter how minuscule or insignificant it may be in relation to the mark considered as a whole). The Court therefore has to

examine the mark as a whole. As a part of this evaluation process, the Court is required to determine what is/are the prominent and/or essential

features of the mark taken as a whole. The protection and/or exclusivity will be conferred on these features and not on insignificant trivia. This Court

has therefore at the outset after considering the relevant factors *prima facie* come to the conclusion that the word â??MARINEâ?? forms a

prominent and/or essential feature of the registered trademark (considered as a whole). If the Defendantâ??s arguments are accepted, the

consequences will be startling. Composite marks will become useless. The same will be infringed with impunity by the simple expedient of using a

trademark which has, as its essential or prominent feature(s), the essential and prominent feature of the registered mark with the addition of other

matter. The mandate of Section 17(1) will be totally frustrated.â??

â??The argument advanced by the counsel for the defendant in that as per Section 17(1) of the Act, the exclusive right of the registered proprietor is

to use the trademark â??taken as a wholeâ? and not â??in partâ? which the plaintiff is trying to claim. A recent judgment of the Division Bench of

this Court in the case of *Unitech Biotech Pvt. Ltd.* (*supra*) has very explicitly taken care of the aforesaid issue. The contention raised by the counsel

for the appellant in the said case was that the registration of respondentâ??s trademark was in respect of label mark â??ORZIDâ?? and it is only

the label which needs to be protected by virtue of Section 17 of the Act. Dismissing such contention raised by the counsel for the appellant, the Court

observed that the essential feature of the mark is also protected if the mark is

registered as a whole. After placing reliance on the judgment of

Honâ??ble Supreme Court in the case Ramdev Food v. Arvindbhai Rambhai reported at AIR 2006 SC 3304, the Division Bench of this Court

observed in Paragraphs 24 and 25 as under:-

â??The entire arguments are on the wrong premise and it proceeds on the basis of common feature of the two marks suffix â??ZIDâ? and since the

respondent has registration and trade mark â??ORZIDâ??, it cannot bare a part of it, i.e., â??ZIDâ?. What has been seen in a case like this is as to

whether the mark â??FORZIDâ? is deceptively similar to â??ORZIDâ?. That is the test which is to be applied and in a process, it is to be seen as to

whether the two marks are structurally and phonetically similar and would cause deception in the minds of consumers. When we judge the matter

from this angle, we find ourselves in agreement with the view taken by IPAB as well as the learned Single Judge. Although the mark â??ORZIDâ?? is

a label mark, the word mark â??ORZIDâ? is an essential feature which has been covered by the registration. Therefore, the learned counsel for the

respondent appears to be right in his submission on this aspect, which is predicated on the Supreme Court decision in Ramdev Food Products Ltd.

(supra).

In Ramdev Food Products Ltd. (supra), the Supreme Court has observed:-

â??The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or

services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise.

The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, 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 someone else to himself and thereby resulting in injury.â??

In Ramdev Food Products (supra), there were three elements in the said trade mark, namely, â??Ramdevâ?, â??Masalaâ? and the â??horseâ?. The

deception could be as regards the prominent features of the said trade mark. The Supreme Court did not accept the argument that only the label has

been registered and not the name â??Ramdevâ??. It was observed that the

definition of mark as contained in Section 2(j) of the 1958 Act also includes names, signatures, etc. In Ramdev Food Products (supra), the word was registered was a logo wherein the words "Ramdev" and "Masala" are prominent. It was held that the right conferred in terms of Section 28 of the 1958 Act although was required to be read with Sections 15 and 17 thereof but it is difficult to accept that each part of the logo was required to be separately registered. Section 28 of the 1958 Act confers an exclusive right of using the trade mark to a person who has got the trade mark in his name. In the instant case, as observed earlier, there was no other distinctive thing other than the word "TOOFAN" and once the said word forms essential feature or part of the mark, in my view, a case of infringement is made out.

Even if I accept that the mark "TOOFAN" is a label mark, the word "TOOFAN" is an essential feature of the label which is covered by the registration. There is no distinctive feature in it other than the prominent display and predominant presence of the word "TOOFAN". Therefore, in my view, the learned Senior Counsel for the petitioner is right in contending in his submission that when the word itself forms the essential feature of the mark, it can be a basis for an infringement action and more so when it deals with similar goods. In this context, the dicta of the Hon'ble

Supreme Court in Ramdev Food Products Ltd. (supra) is relevant:-

"82. In Ashok Chandra Rakhit Ltd. (supra), whereupon reliance has been placed by Mr. Nariman, this Court was concerned with a proprietary mark of 'Shree'. It was claimed that the mark 'Shree' was a trade mark apart from the device as a whole and it was an important feature of its device.

The respondents were carrying on business in the name and style of Shree Durga Charan Rakshit. It was in the peculiar factual background obtaining therein, this Court, referred to the decision of Lord Esher in Pinto v. Badman [8 RPC 181] to say that where a distinctive label is registered as a whole such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole. This Court in the aforementioned factual backdrop opined:

"This, as we have already stated, is not quite correct, for apart from the practice the Registrar did advert to the other important consideration,

namely, that on the evidence before him and the statement of counsel it was quite clear that the reason for resisting the disclaimer in this particular

case was that the Company thought, erroneously no doubt but quite seriously, that the registration of the trade mark as a whole would, in the

circumstances of this case, give it a right to the exclusive use of the word ""Shree"" as if separately and by itself it was also its registered trade mark

and that it would be easier for it to be successful in an infringement action than in a passing off action. It was precisely the possibility of such an

extravagant and untenable claim that called for a disclaimer for the purpose of defining the rights of the respondent company under the registration.â?

(Emphasis supplied)

83. The said decision has no application to the fact of this case.

84. Mr. Nariman is also not correct in contending that only a label has been registered and not the name 'Ramdev'. Definition of 'mark' as contained in

Section 2(j) of the 1958 Act also includes name, signature, etc.â??

In Three-N-Products Pvt. Ltd. v. Emami Ltd. reported at 2009 (41) PTC 689 (Cal), the plaintiffs have registrations of the word AYU and AYUR in

class 5 for medicinal products. The plaintiffsâ?? complaint is about the defendantsâ?? infringement and passing off by use of the mark AYUCARE,

AYURCARE, HIMANI AYURDHARA and HIMANI AYUCARE. It was the assertion of the exclusive right of the plaintiff over the wordmark

â??Ayurâ? on the strength of a black and white label registration showing the word â??Ayurâ? in an unremarkable font with an elliptical band

around it, that came up for consideration in Three-N-Products (supra). In Three-N-Products (supra), the plaintiff claimed that it is entitled to the

injunctions that it seeks on the strength of the plaintiffâ??s combined rights in â??Ayurâ?? being the most prominent feature of its device registrations,

the registration of the wordmark â??Ayuâ? and the registration of the hindi word â??Ayurâ?. The plaintiff contended that the defendant

manufactures similar products as those produced and marketed by the plaintiff and the use of the four marks by the defendant namely â??Ayucareâ??,

â??Ayurcareâ??, â??Himani Ayurdharaâ?? and â??Himani Ayucareâ?? amounts to infringement.

In Three-N-Products Pvt. Ltd. (supra), it is held that the registration of a device or label would entitle the proprietor to protection against use of such

device or label by a rival in trade if the rival's use is identical or similar to the registered trade mark and the use is in connection with identical or

similar goods or services covered by such registered trade mark and if it appears to court that the rival's mark is likely to cause confusion or is

likely to have an association with the registered mark. The identity or similarity of the marks has to be assessed on the basis of the entirety of the

mark as registered. If a device mark is pitted against another device mark or a word mark is pitted against another word mark, the tests would be simpler. It

has been held that if the owner can establish exclusivity *aliunde*, the owner can assert the exclusivity and the registered owner is entitled to protection

of its goodwill in such prominent feature as in an action for passing off unless the registered owner seeks to rely on Section 17(2)(b) of the Act in

respect of a distinctive matter not common to the trade. In such context, in Paragraph 36 of the said judgment, the plaintiff's claim of infringement

based on its 'AYUR' mark as part of its device registration was found to be unacceptable. The said Paragraph reads:-

36. But it would appear that an infringement action may not be run on the basis of an unregistered part of the registered whole of a trademark.

Alternatively, and even if it is assumed for argument's sake that Section 17(2)(a) of the 1999 Act does not altogether preclude a claim of exclusivity

over a part of a registered mark, such part has to be registrable under the Act to qualify for protection. The word 'Ayur', *prima facie*, does not appear

to be capable of distinguishing the goods or services of a person from those of another as it seems to consist exclusively of an indication which may

serve in the trade to designate the nature of the goods. The plaintiff's claim of infringement based on its 'Ayur' mark as part of its device registrations

is found to be unacceptable at the interlocutory stage.

It was further held that it is possible that a registered trade mark is made up of several components which are distinctive and notwithstanding

separate registrations in respect of such distinctive parts not having been obtained by the owner of the registered mark, such proprietor is entitled to

cite one distinctive part as being inseparable from the registered whole or such distinctive part being the most outstanding attribute and thus assert the

right over the distinctive part. But in view of Section 17(2)(a) of the 1999 Act, such assertion has to be in passing off and may not be made in aid of a

case of infringement....even if it is assumed for argument sake that Section 17(2) (a) of the 1999 Act altogether preclude a claim of exclusivity over a

part of a registered mark, such part has to be registrable under the Act to qualify for protection. The mark AYUR prima facie does not appear to be

capable of distinguishing the goods and services of a person from those of another, as it seems to consist exclusively of an indication which may serve

in trade to designate the nature of goods. The plaintiff's claim of infringement based on its AYUR mark as part of its device registration is found

to be unacceptable at the interlocutory stage.

In the instant case, nothing else other than the word "TOOFAN" has been applied for. Thus, there is no "part of the whole" that could have

been applied here. As can be seen from paragraph 1 of Three-N-Products (supra), the mark therein was registered as the word mark "AYUR"

along with an elliptical band around it " thus a composite of two. Therefore, Section 17 applied only in such a case, where there was a composite

label. In the present case, there is only the word "TOOFAN" and the question of claiming a separate registration of any of the alphabets, like the

stylized "O", does not arise, and therefore this is no composite that can be claimed for. The defendant's application for registration of

"TOOFAN" uses, practically, the same font and the same style as that of the petitioner's mark "TOOFAN" " with the addition of the

prefix "SNJ". It is crucial to note that "SNJ" also happens to represent the initials of the petitioner no. 2, Shambhu Nath Jaiswal, the owner of

the petitioner no. 1. The adoption of the said trademark with "SNJ" as prefix is not explained by the defendant, especially where there is the

very real possibility of an average consumer mistaking the product of the respondent as being that of the petitioners due to the prefix. In fact, in

Paragraphs 32 and 33 of Three-N-Products (supra), it is stated that the identity or similarity of the marks has to be assessed on the basis of the

entirety of the mark as registered and applying that test herein, both "TOOFAN" marks are similar looking.

In Alakananda Cement Private Limited vs. Ultratech Cement Limited reported at 2012 (1) Bom CR 519, the Division Bench of Bombay High Court

has considered Section 17 of the Trade Marks Act, 1999 as well as the decision of our Court in Three-N Products Private Limited (supra). In

Ultratech (supra) the plaintiff obtained registration of its trade mark with word mark "Ultratech Cement". It is a device mark since 31st

October, 2004. The word mark used by the defendant is "Ultra Tuff". The defendants admittedly did not obtain registrations under the Trade

Marks Act, 1999. The Division Bench was dealing with the action of passing off and in that context Section 17 was considered.

It is stated by the Division Bench that the said provisions have to be considered in the context of the degree of similarity. On a visual comparison of

the rival marks, similarity is absolutely striking and, hence even though the words "Ultra" or "Ultratech" are not subject matter of a

separate application in the considered opinion of the Division Bench, the case would come under Section 17(1) of the Trade Marks Act, 1999. The

trade mark of the plaintiff consists of several matters and, when on a visual comparison of the infringing mark used by the defendants with the

registered trade mark of the plaintiff, the similarity is so striking that the same is almost certainly likely to create a confusion in the minds of the user of

the product namely cement. The registered mark of the plaintiff was not capable of being broken in parts and at this interlocutory stage it was held

that it is not possible to accept the submission that the case in hand would be governed by Section 17(2). If at the interlocutory stage the plaintiff is

successful in prima facie showing that the registered mark is made up of several components which are distinctive and notwithstanding the fact that

separate registration in respect of descriptive parts have not been obtained, the plaintiff upon establishing that one descriptive part is inseparable from

the registered whole mark, the case of the plaintiff would fall under Sub-Section 1 of Section 17. The Division Bench in paragraph 17 applied the test

of deceptive similarity as it was not a case of identical marks and it is stated:

"The action for passing off is a common law remedy being in substance action for deceit where a person seeks to pass off his goods as those of

other, where, such other person has been using the mark for several years and such mark has acquired a reasonable degree of reputation and good

will in the market on account of its prolonged user and advertisement so that particular degree of reputation has been created in the minds of a

common user."

A trade mark may consist of a combination of a number of features, of which

some may possess distinctive character and others may be non-distinctive. In such cases distinctiveness has to be considered by taking the mark as a whole, all its integers being considered in combination. The true test is the totality of the impression which the mark produces in the mind of an average person with imperfect recollection. What is protected in a trademark as aptly stated by Prof. Ashwani Kumar Bansal:

“It is the imagination, effort or investment of a trade mark owner in doing everything from adopting the features of a trade mark to establishing the trade mark in the market, things which he has done in building a value for his trade mark and investments made by him into popularising the mark, the quality of goods/services which he maintains, after sales service, maintenance and warranties including interaction which he keeps with customers and everything whereby such an owner builds his repeat customers for his trade mark and so on, is what the courts protect in relation to a trade mark.”

The Supreme Court in *National Sewing Thread v. James Chadwick & Bros*, AIR 1983 SC 357 said that “in deciding whether a particular trade

mark is likely to deceive or cause confusion that duty is not discharged by arriving at the result by merely comparing it with the trade mark which is

already registered and whose proprietor is offering opposition to the registration of the mark. The real question is to decide in such cases is to see as

to how a purchaser who must be looked upon as 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 competing marks are thus to be compared as a whole. That is in fact the rule and the dissection of a mark is an exception which is generally not

permitted and can be applied only in exceptional cases. The anti-dissection rule is based upon a common sense observation of customers’

behaviour. *McCarthy on Trade Marks and Unfair Competition* (J. Thomas McCarthy, IV ed.) under the sub-heading “Anti-dissection rule”

Compare composites as a whole” has stated:-

“23.41 Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component

parts for comparison. This is the “anti-dissection” rule. The rationale for the rule is that the commercial impression of a composite trademark on

an ordinary prospective buyer is created by the mark as a whole, not by its component parts.

A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to

determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts

thereof, that is important. As the Supreme Court observed: "The commercial impression of a trademark is derived from it as a whole, not from its

elements separated and considered in detail. For this reason it should be considered in its entirety." Thus, as Judge Newman observed: "It is

incorrect to compare marks by eliminating portions thereof and then simply comparing the residue."

The anti-dissection rule is based upon a common sense observation of customer behaviour: the typical shopper does not retain all of the individual

details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall

impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of

confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in legal briefs."

As observed in *United Biotech* (supra), to the average buyer, the points of similarity are more important than minor points of difference, and the court

is not expected to engage in "technical gymnastics" in an attempt to find some minor differences between conflicting marks. The cases and

authorities cited above exhorted not to divide trade mark into bits and pieces. The two principles recognized by authorities on the subject, namely (i)

Anti-Dissection Rule, and (ii) comparing the composition as a whole, when applied in the instant case makes the mark of the defendant "SNJ

TOOFAN" vulnerable and makes out a case for protection of the mark of the plaintiff, i.e., "TOOFAN".

Mr. Sengupta submits that mere filing of an application for registration of a trade mark does not constitute a part of the cause of action in a suit for

passing off since filing of an application for registration of trade mark does not indicate any deception on the part of the respondent to injure business

or goodwill of the petitioner. In this context Mr. Sengupta has relied upon the decision of the Hon'ble Supreme Court in *K. Narayanan* and

Another vs. S. Murali reported at (2008) 10 SCC 479. However, in the instant case, it is an admitted position that the defendant is selling similar goods

under the mark 'SNJ TOOFAN'. The petitioners are entitled to maintain a suit for infringement or passing off as the case may be as there has

been actual use of the mark in relation to the goods and/or services of the respondent.

The respondent has answered to the show cause as to why leave under Clause 14 of the Letters Patent should not be granted. The learned Counsel

has also relied upon a Division Bench Judgement of the Bombay High Court in Harman Overseas v. Dongguan TR Bearing Company Limited

reported at 2017 SCC Online Bom 7327: 2018 (2) Bom CR 167 for the proposition that in deciding an application for leave under Clause 14 of the

Letters Patent, the Court can consider the merits of the dispute. The Division Bench of the Bombay High Court in Paragraph 31 has approved the

summary of law on this point in Jagdish Gopal Kamath v. Lime and Chilli Hospitality Services (P) Ltd. reported at 2013 (4) Mh.LJ 627: 2013 SCC

Online Bom 597 Paragraph 16 of Jagdish (supra) as approved reads:-

'16. From a reading of Clause XIV of the Letters Patent, the observations/findings in the aforesaid decisions of the Hon'ble Division Bench of

this Court, and from the above discussion it can safely be concluded that:

(i) the grant of leave under Clause XIV of the Letters Patent is a discretionary exercise;

(ii) the primary consideration, while deciding applications for grant of leave under clause XIV of the Letters Patent is 'avoiding multiplicity of litigation';

(iii) in the absence of proven mala fides/hardship, the argument that grant of leave will drag the Defendant from a forum where the Defendant is

situated, to the Court from which Clause XIV is sought and that this is prejudicial/inconvenient to the Defendant, is fallacious and misconceived;

(iv) leave may be declined considering undue hardship to the Defendant or such other similar ground/s;

(v) leave may be declined if the suit as filed is on the face of it not maintainable and the same is nothing but an abuse of law/Court;

(vi) the inquiry whether on facts the Plaintiff is entitled to grant of leave as sought for or not has to be minimal and not in detail, so as to ensure that

observations made do not adversely affect the parties while considering the

prayers for grant of interim relief or while deciding the suit;

(vii) it is not possible to list all the circumstances under which leave under Clause XIV should be granted or declined. The Court has to use its judicial

discretion and arrest any abuse of the process of a court without going into the merits of the case to the extent of virtually obliterating the distinction

between grant of leave and grant of interim relief.

(viii) leave petitions cannot be converted into interlocutory hearings based on the initial cause of action. This will be an anathema to the

object/legislative policy behind granting leave.â?? (emphasis supplied) Clause 14 of the Letter Patent deals with joinder of causes of action. The relief is

discretionary. Ordinarily, the Court would grant joinder of causes of action provided there is no inconvenience faced by the parties at the trial of the

suit. The inconvenience may be because of separate causes of action which would not be desirable to be clubbed together and separate trial would be

convenient. Moreover, it could be that the cause of action is not arising out of same set of transactions. Each transaction is distinct and separate. The

Division Bench of the Bombay High Court has upheld the decision of the learned Single Judge in which the learned Single Judge has laid down the

factors required to be taken into consideration in deciding an objection for granting leave under Clause 14 of the Letters Patent. The show cause to

the rule contains objections which are reflected upon by the learned Single Judge of the Bombay High Court. The nature of the objections basically is

an amalgam of the grounds available to an objector in relation to leave under Clauses 12 and 14 of the Letters Patent and Order 2 Rule 3 of the Code

of Civil Procedure.

In deciding an application for revocation of leave under Clause 12 of the Letters Patent, the averments made in the plaint are required to be taken as

true and correct. Similarly, in deciding an objection for joinder of causes of action under Clause 14 of the Letters Patent primarily the averments made

in the plaint shall be considered as true and correct. The nature of minimal interference as indicated by Justice Kathawalla of the Bombay High Court

in Jagdish (supra) and approved by the Division Bench in Harman Overseas (supra) to my mind would mean such considerations which the Court is

confronted with any statute that bars the jurisdiction of a Court or result in ouster of jurisdiction of such considerations on which the Court shall not

permit joinder of causes of action under Order 2 Rule 3 of the Code of Civil Procedure or such joinder may result in undue hardship. It may so happen

that in a plaint, one set of causes of action may be clearly barred by law, that is to say, by a statute and the Court obviously cannot decide such

disputes being expressly barred by a statute and, accordingly, the question of joinder of such causes of action would not arise. It may be a case where

the Court may not have the jurisdiction over the subject-matter of dispute. Forum inconvenience is the other ground on which such leave could be

refused if the cause of action professed to be joined is arising elsewhere and unconnected with the original cause of action. Some of these are also

considerations in deciding an application under Clause 13 of the Letters Patent by which the Court has power to transfer suits and proceedings from

the subordinate courts to the High Court.

Clause 14 only contemplates that this Court shall have original jurisdiction in respect of one of such causes of action to permit two separate and

distinct cause of action being joined and united in one suit. Like Order 2 Rule 3 of Code of Civil Procedure, the tests to be applied are if there is any

nexus between the two causes of action. In a trade mark action the use of the trade mark unauthorisedly can give rise to an action in passing off and

infringement. The "mark" is the focal point of dispute.

A similar objection was considered by Justice Sanjib Banerjee in an unreported decision in Skipper Limited vs. Akash Bansal & Ors. (G.A. No.1865

of 2016, C.S. No.7 of 2016) decided on 11th July, 2016. In the said decision it is stated:-

"However, Clause 14 of the Letters Patent confers the jurisdiction on this Court to join several causes of action unless a further cause of action

sought to be joined pertains to any land or immovable property situated outside the territorial jurisdiction of this Court. The clause provides as follows:

"14. Joinder of several causes of action. " And We do further ordain, that where Plaintiff has several causes of action against a Defendant, such

causes of action not being for land or other immovable property, and the said High Court shall have original jurisdiction in respect of one of such

causes of action, it shall be lawful for the said High Court to call on the Defendant to show cause why the several causes of action should not be

joined together in one suit, and to make such order for trial of the same as to the

said High Court shall seem fit.â??

The second limb of the clause, to the effect that it shall be lawful for the High Court to join several causes of action in one suit, is subject to two

conditions: that this Court should be competent to receive at least one of the several causes of action sought to be joined; and, that the causes of action

sought to be joined should not pertain to land beyond jurisdiction. In other words, as long as a cause of action sought to be joined does not pertain to

land or immovable property situated outside â?" like passing-off as in this case â?" this Court would have jurisdiction to join the other cause of action,

subject to whatever the defendants may cite to resist the same.

In this case, the plaintiff has sued for infringement. The plaintiffâ??s registered word mark is Bansal. An alternative or additional relief for passing-

off is carried in the plaint; possibly to detract from any defence of the bonafide use of the defendantsâ?? surname as part of the defendantsâ??

trade name. The matters complained of pertain to the same transaction or the same series of transactions. To split the two causes of action would be

artificial. In such a situation, it is incumbent on the defendants resisting the leave sought under Clause 14 of the Letters Patent to show overwhelming

inconvenience for the other cause of action not to be joined in this suit.

The defendants here show none. The defendants merely stress on the point that if this suit were to be regarded as an independent suit for passing-off,

it could not have been maintained in this Court since the necessary averments as to a part of the plaintiffâ??s cause of action regarding passing-off

having arisen within are not mentioned in the plaint. The objection is irrelevant in view of the mandate under Clause 14 as this Court is competent to

receive the infringement action.

It is also elementary that whereas leave under Clause 12 of the Letters Patent has to be obtained at the time of institution of the suit, leave under

Clause 14 thereof has, per force, to be granted subsequently; since the defendant is to be heard before leave under Clause 14 is granted. Further, the

objection under Order II Rule 3 of the Code is without merit as the clear mandate under Clause 14 is a complete answer thereto.â??

In the instant case too, the respondent is in a similar situation. The suit for infringement of the trade mark and copyright on the basis of the averments

made in the plaint are maintainable in this Court. It is not the consideration at

this stage as to whether the infringement of the mark which the plaintiff claims to be a word mark and the defendant contends to be a label mark would ultimately succeed at the trial of the suit. If the defendant has to face the trial for infringement action it is difficult to appreciate how the defendant would be prejudiced if passing off action is united and tried along with the infringement action. The necessary averments for both the actions are present. The learned Counsel for both the parties have referred to the decision of ITC Limited Vs. Godfrey Phillips India Ltd. reported at AIR 2015 Cal 19 in which I have considered Clause 14 of the Letters Patent in relation to a trade mark action. The said decision does not come to the aid of the defendant. On such considerations, the objection of the defendant for joinder of causes of action is rejected. Leave under Clause 14 of the Letters Patent is, accordingly, granted.

On comparison of the said two marks and having regard to the field of activity and the nature of the products, there cannot be any doubt that the mark 'SNJ TOOFAN' is deceptively similar to the mark 'TOOFAN' already registered in favour of the petitioners. In fact, the marks of the petitioners are infringed by user of the said infringing marks which clearly shows the dishonest intention of the said respondent to ride on the reputation of the petitioners.

That the respondent is seeking to pass off his goods as that of the petitioners is prima facie established. The balance of convenience is also in favour of passing an order of injunction in favour of the petitioner. Under such circumstances, there shall be an order in terms of prayer (a) of the petition.

The application being G.A. No.1267 of 2018 is allowed. The application being G.A. No.1938 of 2018 is dismissed. However, there shall be no order as to costs. Urgent Photostat certified copy of this judgment, if applied for, be given to the parties on usual undertaking.