

(2001) 05 DEL CK 0110

In the Delhi High Court

Case No : IA. No. 8718 of 2000, in Suit No. 1897 of 2000

Shri Bhagwan Dass Gupta (alias Agarwal)

APPELLANT

Vs

Shri Shiv Shankar Tirath Yatra Company Private Limited

RESPONDENT

Date of Decision : 29-05-2001

Acts Referred:

Citation : (2001) 93 DLT 406 : (2001) 59 DRJ 609

Hon'ble Judges : Jiwan Dass Kapoor, J

Bench : Single Bench

Advocate : Mr. K.R. Gupta, Mr. O.P. Bansal and Nitin Gupta, for the Appellant;
Mr. S.K. Bansal and Mr. R.K. Yadav, for the Respondent

Judgement

J.D. Kapoor, J.—The applicant/plaintiff has been carrying on his business of arranging tour programmes to various religious places all over Indian under the name the name and style of "Shri Shiv Shankar Tirath Yatra Company" since 1981. It also got the declaration and registration of the said trade name on 26th February, 1990 under the provisions of Indian Registration Act and also git it registered as an artistic work under the provisions of Indian Copyright Act on 20th June, 1990.

2. Through this application the applicant/plaintiff seeks injunction against the defendants as the latter has given an advertisement in the newspaper that "Shri Shiv Shankar Tirath Yatra Company Private Limited" has arranged a tour programme for Char Dham Yatra. The plaintiff was shocked to come across the said advertisement and after inspecting the records of the Registrar of Companies came to know that the company under the name and style of Shri Shiv Shankar Tirath Yatra Company Private Limited was also registered on 16th June, 2000 and its Directors are Ami Chand Bhardwaj, defendant no. 2 and his son Shri Shyam Sunder Bhardwaj. Shri Ami Chand Bhardwaj is the same person who had worked as a Halwai for cooking food under the plaintiff for 10 long years on the various tour programmes arranged by the plaintiff.

3. It is alleged that the defendant have deliberately adopted the same trade name as that of the plaintiff/applicant and got it registered dishonestly and fraudulently and has now started passing off their own business as that of the plaintiff, resulting in unjust enrichment to the defendant and causing irreparable loss and injury to the plaintiff/applicant. The customers and the public are likely to suffer on account of want of proper and efficient services as they are bound to be confused that the tours are being arranged by the plaintiff.

4. The defendant has admitted that it has registered its trade name under the name and style of Shri Shiv Shankar Tirath Yatra Company Private Limited but at the same time has defended its action on the ground that every person has a right to use the same either by itself or in combination with other words as these words are religious and are, Therefore, publici juris. He has taken refuge under several such deceptively similar or near similar names being used by various other persons some of which are "Jai Shiv Shankar Tirath Yatra Company"; "Om Shiv Shankar Tirath Company" and "Om Shiv Shankar Char Dham Yatra Company Private Limited".

5. According to the defendants the adoption and user of the same name as the plaintiff has been using for its business and trade is honest, bonafide and is in his own rights. However so far claim of the applicant/plaintiff as to its reputation and the goodwill of the plaintiff's trade name since 1981 and its continuous, extensive, open and exclusive business under the aforementioned trade name is concerned, there is only a bald denial and not specific one. According to the defendants the registration under the Indian Registration Act has no legal consequences as the same does not confer any legal right.

6. The circumstance that the defendant had been employed with the plaintiff/applicant for 10 long years when the tour programmes were being conducted by the plaintiff/applicant under the trade name of "Shri Shiv Shankar Tirath Yatra Company" shows that the defendant has conscious knowledge about its continuous, long and extensive use of the trade name.

7. To support his contention that the impugned trade name is a generic term and publici juris, the learned counsel for the defendant has relied upon (i) Rupee Gains Tele-Times Private Limited Vs. Rupee Times 1995 (15)PTC 384 and (ii) Competition Review (P) Limited Vs. N.N. Ojha 1996(16) PTC 124. In Rupee Gain's case the question for determination was whether the word RUPEE is a distinctive word or a generic word. The action for passing off was preferred for restraining the respondents from publishing its paper as Rupee Times which was allegedly similar to the paper of the petitioner as Rupee Gains. It was held that the word RUPEE is not a distinctive word but a generic term because everything connected with trade and business is described by money, finances and rupees. It was also held that the use of the word "RUPEE" is not likely to create a confusion in the market or to deceive the intending readers.

8. In Competition Review's case the controversy was with regard to the word

"Competition". It was held that the word "competition" is a word of English language and Therefore the plaintiff cannot claim exclusive right on the basis of registration of this word under the Copy right Act.

9. On the same analogy the learned counsel for the defendants tried to project that the name of the plaintiff company is such over which nobody has monopoly as it is publici Jurisdiction being common to the trade in which the parties are engaged.

10. The basic test to find out whether a particular mark is publici Jurisdiction or not is that if the mark has come to be so public because of its universal use that it does not confuse or deceive by the use of this the purchasers of the goods of the original trader. The object to protect a trade mark is merely to prevent the trader for being deceived or confused by the other persons goods as his goods.

11. There was a rule under the TMM Act of the United Kingdom that an identical mark could be registered by different person up to no. 3 and not more. Where more than three persons had acquired any right by using under the same mark it was treated as a publici Jurisdiction or common of the trade.

12. Merely because a person gets a trade mark registered first does not mean that he has an unfettered right to protect it. In a celebrated case Ford Vs. Foster (1872) 7 ChA 611 a person has been trading under a particular mark for forty long years but without getting it registered but the same mark was got registered by another person only four years before. It was held:-

"Monstrous injustice would have been done if a man who has had a trade mark for perhaps forty years should lose it because another man who had it for four years had happened to register it first".

13. Almost a similar proposition of law arose in The Andhra Perfumery Works joint family Concerns Vs. Karupakula Suryanarayaniah and Others, where the plea taken by the respondent was that the mark bearing the device of Lord Ganesh and the word Ganesh had been adopted by him from the year 1953 and was honestly and continuously used up to the date of the application in respect of the goods namely Agarbathis. The mark became very popular in the market and achieved public repute and patronage as distinctive of those goods. The defendant firm also adopted the same name and took the plea that the plaintiff has acquiesced in the use of Ganesh by many other manufactures and even otherwise this mark is publici juris. Several cases were referred and relied upon including the case relating to English law on the subject and also as to the proposition "under what circumstances even a distinctive name becomes publici juris". It was held that whether a word or mark is a publici Jurisdiction is a question of fact. If the word has attained distinctiveness as mark of a particular person this distinctiveness may be lost. Unless and until the distinctiveness is lost it is entitled to recognition.

14. According to the learned counsel for the defendants the distinctiveness of

Shri Shiv Shankar Tirath Yatra Company has lost because of near similar name s by various companies and organisations in the same trade. The question whether the distinctiveness has lost or not is not to be decided at this stage and has to be kept open. At this stage three elements are to be considered. Firstly whether there exists a prima facie case in favor of the applicant and secondly whether balance of convenience is in its favor and thirdly whether the applicant shall suffer irreparable loss of injury if the defendants are not injuncted.

15. Admittedly the part of trade name does not have any Dictionary meaning namely Shiv Shankar which is the name of a Hindu deity. However if other words are used in conjunction with the name of the deities these words also attain the status of trade name and, Therefore, the person having prior, long and continuous use of such name has a preferential right to protect it. One cannot be oblivious of the fact that the defendant was in the employment of the applicant/plaintiff when it had been conducting tour programmes for religious places. The very fact that the defendants adopted not only a deceptively similar name but exactly the same name without any iota of variation prima facie projects that the defendants had no other intention in adopting this name than to trade in and thrive upon the goodwill and the reputation of the plaintiff/applicant earned through industry, hard work and expense on advertisement.

16. Admittedly the trade name in question has not been registered under the Trade Merchandise marks Act and it has been registered only under the Indian Registration Act and Copyright Act. Even if it is assumed for the sake of arguments that registration under any of these Acts does not confer any right still the protection against action for passing off is available to the applicant/plaintiff.

17. In the words of Clerk and Lindsell on torts, 15th Edition it is immaterial whether the false representation, as to good or business, involved in passing off, is made expressly by words, or impliedly, by the use of imitation of a mark, trade name or get-up with which the goods of another are associated in the minds of the public. But although this is the most common form of passing off it is only a special instance of a more general rule that any misrepresentation calculated to give one trade the benefit of another's goodwill is actionable.

18. Balance of convenience also is in favor of the applicant. There is no credible Explanation as to why did the defendants chose to adopt the name whereas the instances given by him show that there are variations in the name of the company run by various other persons. Prima facie it appears to be a practical attempt. The plaintiff/applicant is bound of suffer irreparable loss, injury if the defendants are not injuncted upon form using the same name which was invoked much prior and has been in long and continuous use. This is bound to create confusion as to its origin and source and Therefore prima facie amounts to passing off.

19. The foregoing reasons persuade me to allow the application and grant an ad

interim injunction restraining the defendants from using the plaintiff's trade name Shri Shiv Shankar Tirath Yatra Company as a part of the defendants' trading style like Shri Shiv Shankar Tirath Yatra Company Private Limited or any other trade name that may be deceptively similar to the plaintiff's trade name. Interim order is made absolute.

S.No. 1897/2000 20. List on 12th September, 2001.