

(2015) 03 MAD CK 0514

In the Madras High Court

Case No : Original Application Nos. 243 and 244 of 2014 in Civil Suit No. 182 of 2014

Sivanesan and Co.

APPELLANT

Vs

Kanchan Home Appliances and Others

RESPONDENT

Date of Decision : 17-03-2015

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2
Trade Marks Act, 1999 — Section 29, 48, 49

Citation : (2015) 03 MAD CK 0514

Hon'ble Judges : R. Subbiah, J

Bench : Single Bench

Advocate : R. Rajesh, for the Appellant; Ashok Kumar, Advocates for the Respondent

Final Decision : Allowed

Judgement

R. Subbiah, J.—Original Application No. 243 of 2014 has been filed by the applicant/plaintiff under Order XIV Rule 8 of Original Side rules read with Order XXXIX Rules 1 and 2 of Code of Civil Procedure, praying to grant ad-interim injunction restraining the respondents/defendants, their men, agents, servants or any one claiming through them from in any manner infringing the applicant/plaintiff's registered trade mark "Premier" by using the offending trade mark "Premier Dezire" or any other trade mark or device which is identical or deceptively similar to or a colourable imitation to that of the applicant/plaintiff's registered trade mark and trade mark label "Premier", pending disposal of the suit.

2. Original Application No. 244 of 2014 has been filed by the applicant/plaintiff under Order XIV Rule 8 of Original Side rules read with Order XXXIX Rules 1 and 2 of Code of Civil Procedure, praying to grant ad-interim injunction restraining the respondents/defendants, their men, agents, servants or any one claiming through them from in any manner passing off of the goods of the respondents/

defendants as those of the applicant/plaintiff by using the offending trade mark "Premier Dezire" or any other trade mark label/device which is similar/deceptively similar to that of the applicant/plaintiff's trade mark "Premier", pending disposal of the suit.

3. The applicant herein is the plaintiff and the respondents herein are the defendants in the suit. For the sake of convenience, the parties are referred to as per their rankings in the suit.

4. The case of the plaintiff, in brief, is as follows:-

4(1) The plaintiff viz., M/s. S. Sivanesan and Co, is a partnership firm and ever since the formation of the plaintiff-firm on 1st April, 1974, the plaintiff is carrying on business in manufacturing and marketing inter alia Mixies, Grinders, Non-stick Cookware, Household Utensils including Kitchen Utensils, Containers, Domestic Appliances and Pressure Cookers under the trade mark "Premier".

4(2) The plaintiff is a family concern and there are other related/associated partnership firms of the same family group, carrying on same or similar business in the market and the list of all the firms of the group of the plaintiff are as follows-

- (a) M/s. Sivanesan and Co. (plaintiff)
- (b) M/s. Sivanesan Company
- (c) M/s. Premier Home Appliances
- (d) M/s. Houseware Industries
- (e) M/s. Premier Aluminium Company
- (f) M/s. Sivanesan Company (Unit II)
- (g) M/s. SS Packaging
- (h) M/s. Sivanesan Company (Ind)
- (i) M/s. Premier Marketing
- (j) M/s. Veena Marketing and Distribution
- (k) M/s. Ketana Home Collections

M/s. Sivanesan Company, M/s. Premier Home Appliance and M/s. Houseware Industries are the direct product manufacturing firms. M/s. Premier Aluminium Company and M/s. SS Packaging are firms offering service/assistance to the product manufacturing firms stated above. M/s. Sivanesan Company (Ind) deals entirely on the export side of the group. M/s. Premier Marketing, M/s. Veena Marketing and Distribution and M/s. Ketana Home Collections are purely domestic marketing set up to sell the products manufactured by the product manufacturing firms stated above.

4(3) The plaintiff have done extensive business continuously ever since 1975 using the trade mark "Premier" without any interruption. By virtue of such continuous use and tireless promotion of the said products under the trade mark "Premier", the said mark has become highly distinctive of the goods of the plaintiff and it denotes and connotes the goods of the plaintiff alone. In fact, in respect of Mixies, Grinders, Non-stick Cookware and Pressure Cookers, the trade mark "Premier" enjoys high popularity and there is an ever increasing demand for such goods under the trade mark "Premier". Due to high standards maintained by the plaintiff in their products, extensive sale promotions and tireless efforts, their products enjoy high demand in the market.

4(4) The trade mark "Premier" has received high acceptance among the trade and public and enjoys very good market. The plaintiff has also taken adequate steps to protect their trade mark by applying and obtaining registration in respect of various products. The details of the plaintiff's trade mark registrations in India are tabulated herein below:

4(5) The plaintiff's application for registration of the mark "Premier" under No. 2337289 in classes 7, 11 and 21 is pending for registration before the Trade Marks Registry. As far as the Trade Mark issues are concerned, the plaintiff holds the Registered Trade Marks in its name and through agreements the other three product manufacturing firms, as mentioned above, are permitted to use the registered Trade Mark by the plaintiff. Further, not only a reasonable royalty charges are levied and collected by the plaintiff for the usage for the trade mark, but, also the products with the registered trade marks are sold only through the marketing firms of the plaintiff's group of companies.

4(6) Apart from registering the said trade mark "Premier" in India, the plaintiff has also obtained trade mark registrations from countries such as Australia, Qatar, Bahrain, UAE and Community Trade Mark (CTM) registration for European Union.

4(7) The plaintiff by virtue of the use of the trade mark "Premier" in respect of Pressure Cookers and other Kitchen utensils and also by virtue of the registration obtained, the plaintiff is an exclusive and absolute owner of the trade mark "Premier" and therefore, the plaintiff is entitled to use the said trade mark "Premier" in respect of the said goods to the exclusion of others.

4(8) While so, the plaintiff came across in the market that the 1st defendant is selling products such as Tawa (non-stick cookware), Mixes etc under the mark "Premier Dezire", in which the trade mark "Premier" is represented in a prominent manner and the word "Dezire" has been printed in an insignificant manner. The 1st defendant is selling identical goods with a deceptively similar mark "Premier Dezire" only with an unethical and criminal intention to cash upon the reputation and goodwill built by the plaintiff over the years in respect of the trade mark "Premier". The plaintiff conducted a detailed probe in the market and identified that the products being sold with a similar mark "Premier" by the 1st

defendant. The plaintiff in order to make a comparison of the products, mark etc., even purchased the product from the 1st defendant under a bill dated 21.08.2013. In a detailed investigation carried out by the plaintiff, it was found from the carton of the product sold by the 1st defendant that the 2nd defendant is shown as the manufacturer of the infringing product. During the inspection of the infringing goods, which were bought from the 1st defendant, the plaintiff noticed the "TM" symbol printed on the top right side corner of the mark. To ascertain whether the 2nd defendant has filed any application for registration of the trade mark "Premier Dezire" before the Trade Marks Registry, the plaintiff conducted a search in the electronic records of the Registry. However, the plaintiff was shocked to see the search report that it was the 1st defendant who has applied for registration of the trade mark "Premier Dezire" and the same is pending for registration with the Trade Marks Registry. The said trade mark which has been applied for registration by the 1st defendant is being used by the 2nd defendant with the "TM" symbol. The 2nd defendant with the knowledge, consent and connivance of the 1st defendant is misusing the trade mark "Premier Dezire". In the infringing product sold by the 1st defendant and also the carton exhibits an ISI mark carrying S. No. "IS 4250 and License No. CM/L No. 7966296" and upon verification of the official records of Bureau of Indian Standards (BIS), it was found that the said license Number is in the name of the 3rd defendant. The licence indicates that the 3rd defendant is dealing with the Domestic Electric Food-Mixers. Both the defendants 2 and 3 are carrying on business in Mumbai with respect to same goods. Therefore, according to the plaintiff, it is very clear that all the three defendants, have nexus and close business relationship with each other.

4(9) The plaintiff alone is manufacturing and marketing through its sister concerns products like Mixies, Grinders, Non-stick Cookware Household Utensils including Kitchen Utensils, Containers, Domestic Appliances and Pressure Cookers under the Trade Mark "Premier" and the reputation, goodwill earned in respect of the Pressure Cookers and other items under the Trade mark "Premier" by tireless efforts of the plaintiff and high standards maintained by the plaintiff, apart from the huge sales promotion and advertisements made by the plaintiff running to several lakhs of rupees, at high expenditure and cost, exclusively belong to the plaintiff alone. Therefore, the defendants have no manner of any right to use the trade mark "Premier" in any of the products produced or manufactured by them. If the defendants continue to carry on business with the trade mark "Premier Dezire" dealing with the same and related products dealt with by the plaintiff, there will be a great confusion and deception among the trade and the general public would get an impression that the products of the defendants are emanating from the plaintiff and would as well associate and think that there is some kind of trade connection between the plaintiff and the defendants. If the defendants are allowed to use the celebrated trade mark of the plaintiff and the products under the offending trade mark, being not up to the quality and high standards meticulously maintained by the plaintiff, there is

every threat of the hard earned reputation of the plaintiff getting ruined. Hence, the plaintiff has filed the present suit for the following reliefs as follows-

(a) permanent injunction restraining the defendants, their men, agents, servants or any one claiming through them from in any manner infringing the plaintiff's registered Trade Mark "Premier" by using the offending Trade Mark "Premier Dezire" or any other trade mark or device which is identical or deceptively similar to or a colourable imitation to that of the plaintiff's registered trademark and trademark label "Premier";

(b) Permanent injunction restraining the defendants, their men, agents, servants, or any one claiming through them from in any manner passing off the goods of the defendants as that of the plaintiff by using the offending trade mark "Premier Dezire" as and for the trade mark of the plaintiff "Premier" or any other trademark label/device which is similar/deceptively similar to that of the plaintiff's trademark "Premier";

c) Directing the defendants to surrender to the plaintiff the entire stocks, cartons with the infringing artistic work "Premier" and unused infringing trademark labels "Premier Dezire" together with blocks and dies for destruction;

d) Directing the defendants to render a true and faithful accounts of the profits earned by them through the sale of their products bearing the infringing labels "Premier Dezire" which are similar or deceptively similar to the plaintiff's trademark and directing the payment of such profits to the plaintiff;

e) Direct the defendants to pay the costs of the suit to the plaintiff;

5. Pending the suit, the plaintiff has filed the above Original Applications for interim injunctions as stated supra.

6. When the Original Applications came up on 26.03.2014, this Court ordered notice to the respondents. Subsequently, after completion of service of notice to the respondents, on 06.06.2014 this Court has granted interim injunction in O.A. No. 243 of 2014 and similarly, on 08.07.2014, this court has granted interim injunction in O.A. No. 244 of 2014.

7. Thereafter, on appearance, the defendants have filed Application No. 5770 of 2014 seeking to vacate the interim injunction order dated 06.06.2014 granted O.A. No. 243 of 2014. Similarly, the defendants have filed Application No. 5771 of 2014 seeking to vacate the interim injunction order dated 08.07.2014 granted in O.A. No. 244 of 2014.

8. The sum and substance of the contentions made in the affidavits filed in support of the vacate interim injunction applications filed by the defendants are as follows-

8(1) The applications filed by the plaintiff are neither maintainable in law nor on the facts of the case. The plaintiff suppressed material facts and failed to approach this Court with clean hands. Hence, the applications filed by the

plaintiffs are liable to be dismissed in limine.

8(2) The plaintiff themselves have admitted that the plaintiff are carrying on business under trade mark Premier for the firms, viz., a) M/s. Premier Home Appliances, b) M/s. Premier Aluminium Company and c) M/s. Premier Marketing. It is well settled principle of law that there can be only one proprietor for single Trade Mark. In the present case, it is admitted by the plaintiff that three different firms adopted trademark Premier. Hence, the plaintiff themselves are not clear about correct title and ownership of trademark Premier vested under which firm. On this ground, the main suit itself is liable to be dismissed.

8(3) The plaintiff have not produced any document to prove and establish that the plaintiff firm has link and connection with other firms like M/s. S.S. Packaging, M/s. Veena Marketing and Distribution, M/s. Ketna House Collections etc. The plaintiff have failed to prove title and ownership over the trade mark Premier. It is important to point out that the plaintiff are not clear and crystal about the business relationship with other firms. Hence, the plaintiff have failed to prove and establish their case regarding status of trade mark Premier. It is strongly denied by the defendants that by virtue of such continuous use and tireless promotion of the said products under the trademark Premier, the mark has become highly distinctive of the goods of the plaintiff and it denotes and connotes the goods of the plaintiff alone. The trademark Premier is neither distinctive trademark of plaintiff nor adopted and capable of distinguishing plaintiffs products. The trademark Premier has lost its originalities, uniqueness and distinctiveness. The dictionary meaning of the word Premier is high standard product. Premier is a laudatory word and it describes nature and quality of product. No one including plaintiff can claim monopoly of trademark Premier. On the mere registration, the plaintiff cannot have any monopoly because registration is granted subject to other provisions of the Trademark Act. It is important to point out that as per online status, other than the plaintiff, many traders/manufacturers have applied for registration of trade mark Premier. More than 150 different applicants have applied for registration of trademark Premier. While the facts being so, the plaintiff has no right or authority to claim monopoly in respect of the trademark Premier. The name of the applicant in respect of Trade Mark No. 4016757, 476637, 333108, 401658 and 590160 does not match, tally and resemble with the name of the plaintiff in the present suit. As per the online status, the plaintiff failed to renew trademark No. 401657, 590160, 476837. Likewise, applications in No. 478836, 476838, 590154, 503256 and 503257 filed by the plaintiff for registration of trademark Premier are abandoned,. The plaintiff wantonly and deliberately suppressed and hid the fact about abandonment of the plaintiff's applications. As per online search report, prior to the plaintiff's applications for registration of trademark Premier, many others have applied prior to the applicant's applications. Therefore, it is improper on the part of the plaintiff to claim proprietorship over the trademark Premier since application filed by the plaintiff is subsequent and later. It is important to point out that the plaintiff is claiming a right over the trademark

Premier, whereas mark adopted by the 1st defendant is Premier Dezure. Therefore, suffix Dezure is sufficient for distinguishing the 1st defendant's products. In other words, added matter Dezure is sufficient to distinguish the 1st defendant's product. By including suffix Dezure the 1st defendant can escape from the liability of passing off of the goods of the 1st defendant as that of the plaintiff. In fact, the 1st defendant has filed applications for registration of trademark Premier Dezure before the Trademark Registry, in Application Nos. 2289126, 2639338 and 2639337, and the same are pending. The above injunction applications filed by the plaintiff are devoid of any merit and lack bone fide. Thus, the defendants sought for vacating the interim injunction orders.

Submissions made by the learned counsel for the plaintiff

9.1. The learned counsel appearing for the plaintiff submitted that the plaintiff is using the trademark Premier since 1975. The plaintiff has also permitted their sister concerns to use the said trademark. The plaintiff has registered their trademark under Classes 7, 11 and 21. By virtue of the use of the trademark Premier in respect of Pressure Cookers and other Kitchen Utensils and also by virtue of the registration obtained, the plaintiff is an exclusive and absolute owner of the trademark Premier. Now, the respondents, just by adding the word Dezure along with the word Premier, are selling the identical goods, deceptively similar to that of the plaintiff. The respondents' trademark was not registered. They have filed applications for registration of their trademark Premier Dezure for the same goods only in the year 2012, for which the plaintiff has already got registration as early as in the year 1995 itself. The learned counsel appearing for the plaintiff would further submit that if the defendants' trademark is published in the trademark journal, the plaintiff will file objection for the same. In this regard, the learned counsel appearing for the plaintiff, by inviting the attention of this Court to Section 29 of the Trademarks Act, submitted that since the trademark of the defendants is identical to the trademark of the plaintiff and the goods of the defendants are also similar to that of the plaintiff, the plaintiff is entitled for injunction as against the defendants, restraining the defendants from infringement and passing off, by using the offending trademark Premier Dezure and other deceptively similar trade label.

9.2. In this regard, the learned counsel appearing for the plaintiff relied upon the decision of the Hon'ble Supreme Court reported in T.V. Venugopal Vs. Ushodaya Enterprises Ltd. and Another, (2011) 3 JT 225 : (2011) 45 PTC 433 : (2011) 3 SCALE 182 : (2011) 4 SCC 85 : (2011) 4 SCR 1000 : (2011) 2 UJ 871 and submitted that the factual aspects of that case would show that the appellant therein was the sole proprietor of a firm carrying on business inter alia as manufacturers of and dealers in incense sticks (agarbattis) in the name and style of Ashika Incense Inc, at Bangalore; the appellant therein adopted the mark "Ashika's Eenadu"; according to the appellant therein, the word "Eenadu" in Kannada language means "this land" and in Talugu language it means "today"; it was the case of the appellant therein that in the year 1993, they honestly and

bone fide adopted the trademark "Eenadu" meaning "this land" in Kannada. In that case, the respondent therein, who was the plaintiff in the suit, was engaged in the business of publishing a newspaper in Telugu entitled as Eenadu. Before the Hon"ble Supreme Court, it was contended by the appellant therein that the respondent therein had been in the business of publishing newspaper, whereas the appellant therein was dealing with incense sticks (agarbattis), and the businesses of the appellant and the respondent are different; therefore, the use of the mark Eenadu by the appellant therein would not amount to infringement or passing off of the goods of the respondent therein. But, in that case, the Hon"ble Supreme Court has come to the conclusion that permitting the appellant to carry on his business in the name of Eenadu in the State of Andhra Pradesh would lead to eroding extraordinary reputation and goodwill acquired by the respondent Company over a passage of time.

9.3. Thus, by relying upon the above said judgment of the Hon"ble Supreme Court, the learned counsel appearing for the plaintiff has submitted that the present case stands on a better footing and in the present case, the goods of the plaintiff and the defendants are similar and the defendants are using the word Premier in the trademark, which has already been adopted by the plaintiff; therefore, the plaintiff is entitled for grant of injunction against the defendants. For the same proposition, the learned counsel for the plaintiff has also relied upon the following decisions-

i) N.R. Dongre and Others Vs. Whirlpool Corpn. and Another, (1996) 6 AD 710 : (1996) 2 ARBLR 488 : (1996) 7 JT 555 : (1996) 16 PTC 583 : (1996) 6 SCALE 276 : (1996) 5 SCC 714 : (1996) 5 SCR 369 Supp

ii) Vivekananda English Academy and Others Vs. Amoha Education Pvt. Ltd. and Another, (2005) 5 CTC 393 : (2006) 66 SCL 309

iii) Midas Hygiene Industries P. Ltd. and Another Vs. Sudhir Bhatia and Others, (2004) 28 PTC 121 : (2004) 2 SCALE 231 : (2004) 3 SCC 90 .

9.4. That part, the learned counsel for the plaintiff would also submit that by adding suffix Dezire along with the mark Premier, the defendants can not escape from the liability of passing off. In support of this contention, the learned counsel for the plaintiff relied upon the decision reported in Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co., AIR 1970 SC 1649 : (1969) 2 SCC 727 : (1970) 2 SCR 222 . Thus, the learned counsel for the plaintiff prayed for making the interim injunction absolute.

Counter submissions made by the learned counsel for defendants

10.1. Countering the submissions made by the learned counsel appearing for the plaintiff, the learned counsel appearing for the defendants submitted that the 1st defendant is only a trader and not a manufacturer and that the 2nd defendant alone is the manufacturer. Now, the 1st defendant has filed applications under Classes 7, 11 and 21 for registration of the trademark Premier Dezire with the

Registrar of Trademarks at Chennai and the same is pending. Before filing the application for registration, the 1st defendant verified with the registry in the office of the Registrar of Trademark to find out as to whether there is any prior users of the said trademark. More than 150 different applicants have applied for registration of the mark Premier. Further, as per the online search report, prior to the plaintiff's application for registration, many others have also applied for registration of the mark Premier. Therefore, the plaintiff cannot claim proprietorship over the mark Premier. Furthermore, the word Premier has dictionary meaning and the dictionary meaning of the word Premier is "first in position". Premier is a laudatory word and it describes nature and quality of product. No one including plaintiff can claim monopoly of trademark Premier. The 1st defendant has adopted the trademark Premier Dezire. Therefore, suffix Dezire is sufficient to distinguish the 1st defendant's products. In other words, added matter Dezire is sufficient to distinguish the 1st defendant's product. By including suffix Dezire the 1st defendant can escape from the liability of passing off of the goods by the 1st defendant as that of the plaintiff. Since Premier is a laudatory word, the plaintiff cannot claim monopoly over the same, because others can use the same by adding suffix or prefix to distinguish their products. Further, the defendants are using the mark Premier Dezire since 01.04.2002, long prior to filing of the present suit. In support of his contentions, the learned counsel appearing for the defendants relied upon the following decisions-

(i) Indo-Pharma Pharmaceutical Works Ltd. Vs. Citadel Fine Pharmaceuticals Ltd., AIR 1998 Mad 347 : (1998) 2 LW 646 : (1998) 3 MLJ 214 ,

(ii) Kewal Krishan Kumar Vs. Rudi Roller Flour Mills (P) Ltd. and Another, (2003) 26 PTC 175

(iii) M/s Girnar Food and Beverages Vs. M/s Godfrey Phillips India Ltd., (2001) 90 DLT 839 : (2001) 2 RAJ 289

(iv) J.R. Kapoor Vs. Micronix India, (1994) 2 ARBLR 274 : (1994) 5 JT 37 : (1994) 3 SCALE 732 : (1994) 3 SCC 215 Supp : (1994) 2 SCR 567 Supp : (1994) 2 UJ 717

(v) S.B.L. Ltd. Vs. Himalaya Drug Co., (1997) 4 AD 757 : AIR 1998 Delhi 126 : (1997) 2 ARBLR 650 : (1997) 67 DLT 803 : (1997) 2 ILR Delhi 168

(vi) Sant Kumar Mehra Vs. Ram Lakhan, (1999) 2 AD 804 : (1999) 79 DLT 221 : (1999) 122 PLR 23

(vii) 1981 PTC 137 [M/s. Uttam Chemical Udyog, Ballabgharh Vs. Shri Rishi Lal Gupta, Trading as Rishi Soap Works, Ballabgharh and another]

(viii) Bharat Hotels Limited Vs. Unison Hotels Limited, (2004) 28 PTC 404

(ix) Novelty Emporium Vs. Novelty Creation Private Limited, (2002) 96 DLT 68

(x) Standard Electricals Limited Vs. Rocket Electricals and Another, (2004) 72 DRJ 794 : (2004) 28 PTC 26

10.2. That apart, the learned counsel for the defendants, by inviting the attention of this Court to search report obtained from online, submitted that the status of the applications filed by the plaintiff for registration of the trademark Premier covered under Application Nos. 478836, 476838, 590154, 503256 and 503257, is shown as "abandoned". But, this fact was suppressed by the plaintiff in the plaint; therefore, the plaintiff is not entitled for injunction on the ground of suppression of material facts.

10.3. Further, it is submitted by the learned counsel for the defendants that according to the case of the plaintiff that they have given permission to their sister concerns to use the word/mark Premier. But, the permission to the sister concerns to use the mark Premier was not given in accordance with the provisions of the Trade Marks Act. In this regard, the learned counsel for the defendants invited the attention of this Court to Sections 48 and 49 of the Trade Marks Act and made an elaborate argument, contending that since the permission given by the plaintiff in favour of its sister concerns is not in accordance with the provisions of the Trade Marks Act, the plaintiff cannot claim monopoly over the mark Premier.

Reply by the learned counsel for the plaintiff

11.1. By way of reply, the learned counsel appearing for the plaintiff, by inviting the attention of this Court to the online search report produced by the defendants, submitted that though the defendants have stated that 150 persons have applied for registration of the mark Premier, out of 150 applications, 50 applications were opposed, 48 applications were abandoned, 18 applications were withdrawn, 22 applications were objected, 5 applications were removed, one application was refused; and 44 application alone were shown to be registered, out of which five belongs to the plaintiff and remaining 39 applications are concerned, they are using the word Premier by adding suffix or prefix in totally different products, not for the products similar to that of the plaintiff; therefore, the submissions made by the learned counsel for the defendants that other persons are also using the trademark Premier, has no significance. In this regard, the learned counsel appearing for the plaintiff has also relied upon the judgment reported in Prakash Roadline Ltd. Vs. Prakash Parcel Service (P) Ltd., (1992) 2 ARBLR 274 : (1992) 48 DLT 390 : (1992) 22 DRJ 489 .

11.2. The learned counsel for the plaintiff further replied that the issue as to whether the permission given by the plaintiff to use the mark Premier to enable their sister concerns is in accordance with the provisions of the Trade Mark Act or not, has no relevance to decide the issue involved in the preset suit. The defendants can raise such objections only before the Registrar of Trademarks and not in the present suit.

12. I have carefully heard submissions made on either side and perused materials available on record.

13. Now, the points which fall for consideration are as follows-

(1) Whether the defendants are entitled to use the mark Premier Dezire since the Premier is already registered as trademark in favour of the plaintiff?

(2) Whether any prima facie case has been made out by the plaintiff to make the interim injunction absolute?

Point No. 1:-

14. The plaintiff is carrying on business since 1975 by using the trademark Premier and the said trademark has been registered under Classes 7, 11 and 21. For registration under Class 7, the plaintiff has filed application on 18.02.1983; for registration under Class 11, the plaintiff has filed application on 13.08.1987; for registration under Class 21, the plaintiff has filed application on 03.02.1978; and another application under Class 21 for registration was filed by the plaintiff on 18.02.1983; the plaintiff is claiming that they are using the mark from the year 1975. Further under Class 11, the plaintiff has also filed application for registration of the label on 05.02.1993 claiming user claim from 01.01.1993. The said trademark and the label were registered in favour of the plaintiff. That apart, the plaintiff has also made some other applications for registration of the trademark Premier, which are pending before the Registrar of Trademarks. These material facts would show that the plaintiff is the registered proprietor of the mark Premier. While so, in respect of the same products, the defendants are using the mark Premier, by adding suffix Dezire.

15. But, it is the case of the defendants that the word Premier is common in trade and public juries and it is a laudatory word and dictionary meaning is "first in position"; therefore, added matter Dezire is sufficient to distinguish the 1st defendant's product; by including suffix Dezire, the 1st defendant can escape from the liability of passing off of the goods by the 1st defendant as that of the plaintiff. Apart from that, it is the submission of the learned counsel appearing for the defendants that 150 persons have registered the mark Premier, therefore, the plaintiff cannot claim monopoly over the word Premier.

16. In fact, the learned counsel for the defendant has relied upon number of judgments in support of his contentions that if it is a common word, by adding suffix or prefix, the defendant is entitled to use the trademark. In the regard, a reference could be placed in the decision reported Indo-Pharma Pharmaceutical Works Ltd. Vs. Citadel Fine Pharmaceuticals Ltd., AIR 1998 Mad 347 : (1998) 2 LW 646 : (1998) 3 MLJ 214 , wherein the Division Bench of this Court has held that prefix for the marks viz., "Enerj" is common and it is abbreviation of generic name "energy" and suffix to the said words viz., "Jex" and "Jase" are totally dissimilar and it does not create confusion in the mind of the users especially and that when visual impression of the said two trade names is completely different and total sound effect of these two words lacks any similarity, there is no infringement of trade mark of plaintiff.

17. It is the submission of the learned counsel for the defendants that if the impugned mark has been held to be descriptive and laudatory of the goods of the plaintiff, then the plaintiff will not be entitled to an injunction. In support of his contention, the learned counsel for the defendants relied upon the judgment reported in *M/s Girnar Food and Beverages Vs. M/s Godfrey Phillips India Ltd.*, (2001) 90 DLT 839 : (2001) 2 RAJ 289 . For the same proposition, the learned counsel for the defendant has also relied upon number of judgments.

18. No doubt, it is well settled legal principle that if the word/mark is a common word, then by adding suffix or prefix, the defendant can always use such trademark. But, at the same time, even if the word is a laudatory word, the Court must see as to whether the trademark of the defendants is identical to the plaintiff's trademark and as to whether the goods are similar; if it is so, the Court must see whether the added matter, as suffix or prefix, would be sufficient to distinguish the products of the plaintiff and the defendants. But, in the instant case, I find that the plaintiff has registered their trademark Premier under Classes 7, 11 and 21. Under the same classes, the 1st defendant has also applied for registration of the trademark Premier Dezire. The products of both the plaintiff and the defendants are similar and they would be sold by keeping them side-by-side. Further, I am of the opinion that though the word Premier is a laudatory word, by continuous long usage of the mark Premier by the plaintiff since 1975, the said word would have obtained secondary meaning by this time. Therefore, if the word Premier is used with any suffix or prefix for the same products, definitely it would create confusion and deception in the minds of the traders and general public, who buy the said products, and they would get an impression that the products of the defendants are emanating from the plaintiff and there is some connection between the plaintiff and the defendants. Though the defendants have stated that they have been using the mark Premier Dezire, since the year 2002, not even single document has been produced to show that they are using the mark Premier Dezire since 2002. In this regard, a reference could be placed in the judgment relied upon by the learned counsel for the plaintiff reported in *Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co.*, AIR 1970 SC 1649 : (1969) 2 SCC 727 : (1970) 2 SCR 222 , wherein it has been observed as follows-

"7. The two actions, however, are closely similar in some respects. As was observed by the Master of the Rolls in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at 161.

"The Statute-law relating to infringement of trade marks is based on the same fundamental idea as the law relating to passing-off. But it differs from that law in two particulars, namely (1) it is concerned" only with one method of passing-off, namely, the use of a trade mark, and (2) the statutory protection is absolute in the sense that once a mark is shown to offend, the user of it cannot escape by showing that by something outside the actual mark itself he has distinguished his goods from those of the registered proprietor. Accordingly, in considering the

question of infringement the Courts have held, and it is now expressly provided by the Trade Marks Act, 1938, section 4, that infringement takes place not merely by exact imitation but by the use of a mark so nearly resembling the registered mark as to be likely to deceive."

In an action for infringement where the defendant's trade mark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. But where the alleged infringement consists of using not the exact mark on the Register, but something similar to it, the test of infringement is the same as in an action for passing off in other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions.

8. In the present case the High Court has found that there is a deceptive resemblance between the word "RUSTON" and the word "RUSTAM" and therefore the use of the bare word "RUSTAM" constituted infringement of the plaintiff's trade mark "RUSTON". The respondent has not brought an appeal against the judgment of the High Court on this point and it is, therefore, not open to him to challenge that finding. If the respondent's trade mark is deceptively similar to that of the appellant the fact that the word "INDIA" is added to the respondent's trade mark is of no consequence and the appellant is entitled to succeed in its action for infringement of its trade mark.

9. We are accordingly of the opinion that this appeal should be allowed and the appellant should be granted a decree restraining the respondents by a permanent injunction from infringing the plaintiff's trade mark "RUSTON" and from using it in connection with the engines machinery and accessories manufactured and sold by it under the trade mark of "RUSTAM INDIA". The appellant is also entitled to an injunction restraining the respondent and its agents from selling or advertising for sale of engines, machinery or accessories under the name of "RUSTAM" or "RUSTAM INDIA". The appellant is also granted a decree for nominal damages to the extent of Rs. 100/-. The appellant is further entitled to an order calling upon the respondent to deliver the appellant price-lists, bills, invoices and other advertising material bearing the mark "RUSTAM" or "RUSTAM INDIA". The appeal is allowed with costs to the above extent."

The principle laid down in the said judgment squarely applicable to the facts of the present case. If the defendants' trademark is deceptively similar and the products are also identical to that of the plaintiff, even if the suffix is added to the defendants' trademark, it has no significance. Further, from the above Judgment, it could be seen that any infringement or passing off should not be tested in the light of minute similarities. Hence, the defendants are not entitled to use the mark Premier Dezire.

19. But, it is another submission of the learned counsel for the defendants that more than 150 persons have applied for registration of the mark Premier. But, as

pointed out by the learned counsel for the plaintiff, out of 150 applications, 50 applications were opposed, 48 applications were abandoned, 18 applications were withdrawn, 22 applications were objected, 5 applications were removed, one application was refused and 44 application alone were shown to be registered, out of which five belongs to the plaintiff and remaining 39 applications are concerned, they are using the word Premier by adding suffix or prefix in totally different products, not for the products similar to that of the plaintiff. Since other persons are using the word Premier the same cannot be a defence for the defendant, as the usage of the mark by the other persons may not affect the business of the plaintiff. If the court come to the conclusion that the usage of the mark of the plaintiff by other person by adding suffix or prefix would affect the business of the plaintiff, definitely the plaintiff is entitled for injunction. In this regard, a references could be placed in the judgment reported in Prakash Roadline Ltd. Vs. Prakash Parcel Service (P) Ltd., (1992) 2 ARBLR 274 : (1992) 48 DLT 390 : (1992) 22 DRJ 489 , wherein it has been held as follows:-

"Merely because no action is taken against certain other parties, it does not mean that the plaintiff is not entitled to take action against the defendant. The other parties may not be affecting the business of the plaintiff. They may be small-time operators who really do not matter to the plaintiff. Therefore, the plaintiff may not choose to take any action against them. On the contrary, the plaintiff feels danger from defendant in view of the fact that the defendant's promoters are the ex Directors/employees of the plaintiff who are fully in the know of the business secrets of the plaintiff. Therefore, the mere fact that the plaintiff has not chosen to take any action against such other parties cannot disentitle the plaintiff from taking the present action. This contention is, therefore, prima-facie without any merit and is rejected."

In the light of the above said judgment, I am of the opinion, the submission made by the learned counsel for the defendants that since the other persons are also using the trademark of the plaintiff, the plaintiff is not entitled for injunction against the defendants, cannot be accepted.

Point No. 2.

20. It has been established by the plaintiff that the plaintiff is using the trademark Premier since 1975 and because of the continuous and long usage of the word Premier by the plaintiff, the said word has assumed a secondary meaning and the said word would be identified with the products of the plaintiff. Therefore, if the defendants are allowed to use the said word, by adding suffix Dezire for the same products, certainly it would cause irreparable loss to the plaintiff. Further, the plaintiff has also produced documents to show that there is increase in the turnover of the plaintiff. The usage of the offending trademark by the defendants is only enriching the defendants unjustly at the cost of the plaintiff's hard earned reputation. In this regard, a reference could be placed in the decision reported in Godfrey Philips India Ltd. Vs. Girnar Food and Beverages

Pvt. Ltd., (2005) 123 CompCas 334 : (2005) 30 PTC 1 : (2004) 5 SCC 257 , wherein it has been held as follows-

"A descriptive trade mark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source."

Though, as observed earlier, the mark of the plaintiff is a descriptive in nature, by continuous and long usage of the mark Premier by the plaintiff since 1975, by this time, it could have assumed secondary meaning. That part, the materials produced by the plaintiff would show that all the three defendants have nexus and close business relationship with each other.

21. In view of the above discussions, I find a prima facie case in favour of the plaintiffs. If the defendants are allowed to use the mark Premier by adding suffix Desire, certainly it will cause irreparable loss to the plaintiff. Hence, the plaintiff is entitled for grant of interim injunctions against the defendants.

For the foregoing reasons, the Original Application Nos. 243 and 244 of 2014 filed by the plaintiff are allowed as prayed for and the interim injunctions granted by this Court are made absolute. Consequently, Application Nos. No. 5770 and 5771 of 2014 are dismissed.