

(1990) 11 KAR CK 0050

In the Karnataka High Court

Case No : Miscellaneous First Appeal No. 1081/1990

Srinivas Rampt Karwa and Another

APPELLANT

Vs

M/s. R.V. Raibagi and Company and Others

RESPONDENT

Date of Decision : 21-11-1990

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 2(B)

Citation : (1990) 4 KarLJ 35

Hon'ble Judges : N. Y. Hanumanthappa, J

Judgement

1. The plaintiff a manufacturer in sarees. Its trade mark is "Biscuit" in Marathi with 999. His rights are perfected under Section 28 of the Trade and Merchandise Marks Act, 1958. The defendant entered as a competitor to the plaintiff in the market by manufacturing sarees and releasing the same for sale with trade mark as "Biscuit" (English) 9999. The defendant's trade mark is an unregistered one.

2. Aggrieved by acts of defendant, plaintiff filed a suit for permanent injunction to restrain defendant from making use of the said trade mark. The trade mark mentioned by the defendant on sarees manufactured by him are deceptive in nature, and similar to the trade mark of plaintiff printed on the sarees. By which process plaintiff that there is every likelihood of confusing the customers to the trade mark of the plaintiff. Plaintiff also filed an application for temporary injunction. This was opposed by the defendant. It was contended by the defendant before the trial Court that it is not shown how the business of the plaintiff will be affected by defendant using his trade mark as "Biscuit" 9999. According to him when both the trade marks are compared, there is lot of difference and in no way it misleads the customers to purchase the sarees manufactured by both. According to the defendant, the customers who are interested in tribble nine would purchase sarees with tribble nine as trade mark and those who were interested in saree with trade mark 9999 would purchase the said saree. Thus according to him both the trade marks are dissimilar and no scope for confusion.

3. After hearing both sides and also examining the trade mark, sarees manufactured by both the parties, after taking into consideration scope of Section 2(b) r/w Sections 28 and 29 of the Trade and Merchandise Marks Act, 1958, trial Court came to a conclusion that the trade mark used by the defendant which is an unregistered one is deceptive in nature and is almost similar to trade mark used by the plaintiff. Accordingly, if the defendant is allowed to use the said trade mark, it would definitely infringe the rights accrued to the plaintiff by virtue of his mark being registered, as required under law. Hence the trial Court felt, that since both the trade marks are similar in nature, the one which entered the market later and that too unregistered one the same deserves to be restrained. The trial Court also took into consideration the law laid down by the Supreme Court reported in; 1) AIR 1960 SC 142, wherein it is held as follows:

"In order that a trade mark may acquire reputation among the general public what is necessary is that the reputation should appear that the public associated that trade mark with certain goods. The reputation is the reputation of the trade mark and not that of the maker of the goods bearing that trade mark. A trade mark may acquire a reputation in connection with the goods in respect of which it is used though a buyer may not know who the manufacturer of the goods is."

So also another decision of the Supreme Court rendered in the case of Parle Products (P) Ltd. v J.P. and Co., Mysore, AIR 1972 SC 1359 including other decisions.

The findings of the trial Court and the reasoning adopted by it on the point are as follows:

"Hon"ble Supreme Court had an occasion to consider the words "Deceptively Similar" in the case of Corn Products Refining Co. v Shangrila Food Products, AIR 1960 SC 142, wherein the Hon"ble Supreme Court has laid down as follows:

"In order that a trade mark may acquire reputation among the general public what is necessary is that the reputation should attach to the trade mark; it should appear that the public associated that trade mark with certain goods. The reputation is the reputation of the trade mark and not that of the maker of the goods bearing that trade mark. A trade mark may acquire a reputation in connection with the goods in respect of which it is used though a buyer may not know who the manufacturer of the goods is."

The Hon"ble Supreme Court has further observed as follows:

"Again, in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is- reasonably likely to cause a confusion between them."

"The absolute identity of the two competing marks or their close resemblance is only one of the tests for determining the-question of likelihood of deception or

confusion trade connection between different goods is another such test. Ex. hypothesi, this latter test applies only when the goods are different. These tests are independent tests. There is no reason why the test of trade connection between different goods should not apply where the competing marks closely resemble each other-just as much as it applies where the competing marks are identical. Whether by applying these tests in a particular case the conclusion that there is a likelihood of deception or confusion should be arrived at would depend on all the facts of the case."

In the case of Parle Products (P)Ltd. v J.P. and Company, Mysore, AIR 1972 SC 1359, the Hon"ble Supreme Court has laid down as follows:

"To decide the question as to whether the plaintiffs's right to a trade mark has been-infringed in a particular case, the approach must not be that in an action for passing off goods of the defendant as and for those of-the plaintiff. In order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are; any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears-such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. It is of no use to note on how many points there is similarity and in how many others there is absence of it."

The same principles have been followed and reiterated in the decisions cited by the learned counsel for the plaintiffs in the case of P. Anwar Basha v M. Natarajan, AIR 1980 Madras 56; M/s. Virendra Dresses, Delhi v M/s. Varinder Garments, AIR 1982 Delhi 482; Vikas Manufacturing Company v Bharaj Manufacturing Company, AIR 1988 Punjab and Haryana 127; and M/s. Manoj Plastic India v M/s. Bhola Plastic Industries, AIR 1984 Delhi 441.

"The question is as to whether the mark-that is used by the defendants "Biscuit 9999" is deceptively similar or as to whether it nearly resembles with the registered trade mark of the plaintiffs and creates confusion in the minds of the customers has to be examined in the light of the above said principles laid down by the Hon"ble Supreme Court. It is an admitted fact that the plaintiff/firm is the owner of the registered trade mark "Biscuit 999" and in the said mark words "biscuit" has been written in English and the words that are used by the defendants in manufacturing their sarees "Biscuit" the words in English and numerical "9999". On a bare examination of the marks that are being used by the defendants on the sarees that are marketed by them, it is clear that the mark that is being used by the defendants resembles the registered trade mark of the plaintiff. There is phonetic resemblance in the mark used by the defendants and the same resembles the registered trade mark of the plaintiffs. The only dissimilarity in the mark that is being used by the defendants-in addition of the word "9" and the words "biscuit 999" is common with the

registered trade mark of the plaintiffs. In the light of the above said similarities and the principles laid down in the above cited cases by the Hon'ble Supreme Court, it is clear that the mark that is used by the defendants is prima facie deceptively similar to the registered trade mark of the plaintiffs. Therefore, I hold that the plaintiffs have made out a prima facie case. Section 28 gives exclusive right to the plaintiffs to use registered trade mark-and if there is any infringement of the trade mark, Section 29 enables the plaintiffs to obtain appropriate relief. Therefore, it must be held that the plaintiffs have made out a prima facie case and the balance of convenience is in their favour as the defendants have infringed the right of the plaintiffs in using the registered trade mark and if temporary injunction is not granted the plaintiffs would be put to irreparable and uncompensatable loss and the granting of temporary injunction would enable the plaintiffs to exercise their exclusive right of using the registered trade mark obtained by them. Hence, I hold that the plaintiffs are. entitled to the temporary injunction as prayed."

In addition to this, Section 2, sub-section (d) of Trade and Merchandise Marks Act of 1958 the word "deceptively similar" reads as follows:

"A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion."

Since, the trial Court granted temporary injunction keeping in view effect of Section 2, sub-section (b) r/w Sections 28 and 29 of Trade and Merchandise Marks Act of 1958 and the principles laid down by the Supreme Court in various decisions referred to above, I do not think that there is any infirmity in the order passed by the trial Court. Hence, this appeal is rejected. No costs.

However, trial Court is directed to dispose of the suit before End of March, 1991.

All other contentions are left open.