

(1993) 02 MAD CK 0010
In the Madras High Court

Suraj Agencies

APPELLANT

Vs

Southern India Trading Agency (India) and Another

RESPONDENT

Date of Decision : 19-02-1993

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Section 151

Citation : (1993) 2 LW 44 : (1993) 2 MLJ 115

Hon'ble Judges : Pratap Singh, J

Bench : Division Bench

Judgement

Pratap Singh, J.—Petition u/s 151, C.P.C., praying for permission to the appellant to use the label as they have been using all along, along

with the word "Suraj" printed in size similar to the size of the word "Regal".

2. The petitioner's case is briefly as follows: The suit was filed on the basis that defendants have committed passing off with respect of their

products. The main grievance of the plaintiff is that the defendants have used the word mark "Regal" which phonetically is similar to "Regaul" the

word mark used by the plaintiffs. Excepting the two words, the rest of the label of the two parties are totally different from each other. It would be

impossible to mistake one for the other. The learned trial Court states that most of the buyers are illiterates and they are likely to be deceived into

accepting ""Regal"" products for the product named ""Regaul"". They will be entirely guided by visual impression made by the label. In the present

case, the colour scheme, the arrangement of letters, and lay out are totally different from each other. The injunction by the trial court is causing

irreparable injury to the defendants. Hence the petition.

3. The proprietor of the first respondent has filed counter affidavit. The

allegations in it are briefly as follows:

They have been using the trade name ""Regaul"" ever since 1959, by registering the trade name under Copyrights Act. Wide publicity has been given

in All India Radio, Television and by advertisements in several newspapers and magazines. He filed the suit and also obtained interim injunction in

I.A. No. 550 of 1987. It was confirmed in C.M.A. No. 154 of 1988 by this Court. The prefix of ""Suraj"" to the main trade name would not make

any difference and the unwary purchasers cannot distinguish the trade mark of the petitioner with that of the first respondent. There is a tangible

danger that a substantial number of persons whether literate or illiterate will confuse the petitioner's ""Suraj Regaul with trade name ""Regal"". When

the goods of manufacture are known in the market by particular name or device he has used, the rival trader cannot be allowed to use the same

name with different spelling which would cause great confusion in the minds of the public. It should be borne in mind, that a purchaser whether

literate or illiterate will seldom have the two products actually before him and makes the purchase after the comparison of every aspect of the two

products. When two words are confusingly similar, the addition of a prefix or suffix to one will not avoid confusion arising from imperfect

recollection of the mark, especially when the combination does not hold together as phrase or present a wholly different meaning from the separate

components. The petitioner should not be allowed to make unlawful gains by exploiting the popular trade name ""Regaul"" of the first respondent and

to spoil the reputation of the first respondent. Hence dismissal of the petition is prayed for.

4. Mr. U.N.R. Rao, the learned Senior Counsel appearing for the petitioner, would submit that suit was on the premise that there is passing off by

the defendant that the components of passing off are equivalent to the infringement of Part B which is specified in Section 29(2) of the Trade and

Merchandise Marks Act, 1958, and that the respondent has got no proprietary right or interest over the trade name ""Regaul"" and that now the

trade mark sought to be used is by giving the letters ""Suraj"" in such bold type as the words ""Regaul"" and so there would not be any confusion in the

mind of the purchaser and that what was enjoined by the court below is a mark label in the word ""Suraj"" with small letters and now during the

pendency of the appeal, the petitioner may be permitted to use the label with the word ""Suraj"" printed in size similar to the word ""Regaul"". Per

contra, Mr. K. Sarvabhuman, the learned Senior Counsel appearing for the first respondent would submit that the petitioner would virtually want a

suspension of the order of the court below and that the printing of the word ""Suraj"" with big letters would not change the situation at all and the

petitioner may not be permitted to use such a trade name.

5. I have carefully considered the submission made by the rival counsels. For better appreciation, Section 29(2) of Trade and Merchandise Marks

Act, 1958 need extraction. It reads as follows:

29(2) In an action for infringement of a trade mark registered in Part B of the register an injunction or other relief shall not be granted to the plaintiff

if the defendant establishes to the satisfaction of the court that the use of the mark of which the plaintiff complains is not likely to deceive or cause

confusion or to be taken as indicating a connection in the course of trade between the goods in respect of which the trade mark is registered and

some person having the right, either as registered proprietor or as registered user, to use the trade mark.

In Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, , the Apex Court has held as follows:

While an action for passing off is a common law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods

as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered

proprietor of a registered trade mark for the vindication of ""the exclusive right to the use of the trade mark in relation to those goods"" (Vide Section

21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the

case of an action for infringement. No doubt where the evidence in respect of passing off consists merely of the colourable use of a registered trade

mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing

off action would also be such in an action for infringement of the same trade mark....If the essential features of the trade mark of the plaintiff have

been adopted by the defendant, the fact that the get-up, packing and other

writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

6. Now, the court below has considered that the added matter, viz., ""Suraj"" is not sufficient to distinguish the goods of the defendant from that of

the plaintiff and has decreed the suit in favour of the plaintiff. Now the change sought to be made by the petitioner is by putting the letters making

the word ""Suraj"" in a bigger size and permit him to do the business in such a label, during the pendency of this appeal. Excepting that the added

matter viz. the word ""Suraj"" in bigger size, virtually there is no difference between the label of the defendant and the present one which is sought to

be used. Mr. K. Sarvabhumah, would submit that as soon as the plaintiff filed the suit, he filed petition for interim injunction till the disposal of the

suit restraining the defendant from using the label and interim injunction was granted and aggrieved by the same, the defendant took up the matter

to the High Court and this Court has confirmed the order of the trial court and the order of this Court has been reported in Shah Segalal Charanraj

and Co., by Partner, Sumermal Vs. Southern India Trading Agency (India), . Though it is a judgment over an order passed in an interlocutory

application, the principle of law enunciated in this ruling are very much relevant and germane to the present petition. In this judgment, my learned

brother Srinivasan has observed in para. 12 as follows:

Just because the manufacturer's name ""Suraaj"" is printed above the name Regal, it will not make a difference. As pointed out by learned Counsel

for the respondent, it is quite common in this country to send illiterate servants and servant-made to buy goods of this type. They will be instructed

to get Regaul Liquid Blue and they might buy actually ""Suraaj Regal Liquid Blue"" thinking that they are carrying out the instructions of their masters.

Thus, there entering a confusion in the market is more probable.

Mr. U.N.R. Rao, would submit that this ruling is irrelevant for the purpose of this case. As I have already indicated, though that judgment was

pronounced by this Court on an appeal over an order passed in an interlocutory

application, the facts considered therein, if relevant cannot be ignored in toto.

Mr.U.N.R. Rao would rely upon 1254 A. Hammond Pty. Ltd. and Ors. v. Papa Carmine Pty. Ltd. 1254 T.M.C. 880 Supreme Court of New

South Wales. In it, the plaintiffs opened the restaurant in Sydney under the name ""Giovanni's Pizza Parlour and Tavern"". The defendants carried on

a business of pizza shop and restaurant in Bondi under the name ""Papa Giovanni Pizza House and Restaurant"" The plaintiffs brought an action for

infringement and passing off. Injunction was refused. It was held that defendant's conduct did not lead to passing off. In the latter name, Giovanni

was never used alone but always as part of the name in types of the same size as the word "Papa". In those circumstances, it was so held. In the

instant case, it cannot be stated that the word "Regal" was used as part of the name of the other word "Suraj". On facts, this ruling is not

applicable to the instant case.

7. Considering the facts and circumstances of the case, inasmuch as there has been no stay of the order of the court below and inasmuch as the

label now sought to be used is substantially the same and in view of the reasons which I have stated above, I am clear that permission sought for

cannot be granted and this petition shall stand dismissed.