

(2014) 11 P&H CK 0200

High Court Of Punjab And Haryana At Chandigarh

Case No: FAO No. 9116 of 2014

Mahajan Tyre Company

APPELLANT

Vs

Kohinoor India Private Ltd.

RESPONDENT

Date of Decision: Nov. 27, 2014

Acts Referred:

- Civil Procedure Code, 1908 (CPC) - Order 39 Rule 1, Order 39 Rule 2
- Copyright Act, 1957 - Section 2(h), 55, 62
- Trade Marks Act, 1999 - Section 134, 135

Citation: (2014) 60 PTC 543 : (2015) 1 RCR(Civil) 194

Hon'ble Judges: Navita Singh, J

Bench: Single Bench

Advocate: Piyus Kant Jain, Advocate for the Appellant; Kamal Kishore Arora, Gaurav Arora and Himanshu Arora, Advocate for the Respondent

Judgement

Navita Singh, J.

S/Shri Kamal Kishore Arora, Gaurav Arora and Himanshu Arora, Advocates have appeared for the respondent and filed vakalatnama, which is taken on record. This appeal is filed against the order dated 26.9.2014, whereby the application filed by the respondent herein for grant of temporary injunction was allowed by the court below.

2. The backdrop of the matter is that suit under Sections 134 and 135 of the Trade Marks Act (hereinafter referred to as the Act) and Sections 55 and 62 of the Copyright Act was filed for permanent injunction by the present respondent against the appellant and in that suit, an application under Order 39 Rules 1 and 2 CPC was also filed. The prayer was that during the pendency of the suit, the defendant (now appellant) be restrained from infringing/imitating the plaintiff's trade mark, which was deceptively similar to that of the plaintiff.

3. The trial Court came to the conclusion on the application that the present appellant was infringing on the rights of the respondent by using a deceptive trade mark and, therefore, restrained the appellant from using the trade mark "DHAMAAL" and identical packing pouch as was being used by the now respondent under the trade mark "DHAMAKA".

4. Learned counsel for the appellant argued that as per the picture of the trade mark placed with the appeal as Annexure A6, the same was entirely different from the trade mark being used by the appellant, picture of which was attached as Annexure A8. He pointed out that the manner in which the word DHAMAKA was written and the insignia was printed on the either side, there was no similarity with the trade mark being used by the other side which had a completely different insignia. He contended that by granting the temporary injunction, the trial Court brought the business of the appellant to a standstill and the suit was practically decreed.

5. Learned counsel for the appellant then argued that trade mark was being used by the appellant since 2009 but the suit was filed on 8.11.2013 and such delay was fatal. He referred to the authority reported as [Consolidated Contractors International Company S.A.L. Vs. Consolidated Construction Consortium Ltd. and Others,](#) . The said reported case was decided by a Single Judge of Delhi High Court and is not binding. Even otherwise, learned counsel for the respondent rightly argued that the appellant had no registered trade mark by the name of DHAMAAL and nothing was brought on record to show that such trade mark was being used since 2009. Learned counsel for the appellant submitted that an application for registration of the trade mark has already been moved now. This would mean that there was no registered trade mark earlier and there is no document to show that it was being used since 2009. The limitation part would, therefore, be inapplicable.

6. Learned counsel for the appellant then referred to Section 2(h) of the Act where words "deceptively similar" have been defined. The definition is reproduced as under:-

"(h) "deceptively similar"-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"

7. According to the above definition, the mark being used by the offender has to resemble so nearly the other so as to be likely to cause any deception or confusion. Learned counsel for the appellant referred to the picture of the trade mark being used by the respondent and also to the picture which was being used by the appellant submitting that there was no such similarity which may even be remotely likely to cause deception or confusion.

8. Learned counsel for the respondent, however, argued that deception is not to be seen from the point of view of educated people. It has to be seen from the point of

view of ordinary consumer, who may be a layman and even an illiterate person going only by the shape and style of the mark and not by the words written. He showed to the court two packets, one bearing the trade mark of the appellant and other of the respondent. The packings are highly similar though there is a difference in the logo on the left of the word DHAMAAL in one and the word DHAMAKA in the other. The letter R is written in the circle above the trade mark in almost identical fashion and so are the words written below i.e. AN ISO 9001:2008 CERTIFIED COMPANY.

9. Learned counsel for the respondent argued that admittedly the trade mark of the appellant is not registered but the word R is written on the top which connotes to the public at large that the trade mark is registered. This argument of the respondent is convincing because the letter R if written in the manner printed on the packets, is generally taken to be an indication of registration. Also as rightly pointed out on behalf of the respondent it is nowhere shown by the respondent that their Company is also certified one as ISO 9001:2008.

10. Learned counsel for the appellant contended that the court below did not make comparison of the trade marks, pictures of which were filed by the appellant, but could not deny that the packets produced before this Court were produced by the present respondent before the trial Court as well.

11. Learned counsel for the appellant further argued that the certificate of registration placed here as Annexure A5 showed that the first application was made by the respondent on 4.8.1997 and the registration was for 10 years from the date of application. Since there was no renewal made after 2007, there was no registered trade mark of the respondent at the time of filing of the suit.

12. Learned counsel for the respondent, however, presented a document showing that another application was made before the expiry of the previous certificate and the registration was renewed from 4.8.2007 to 4.8.2017. Learned counsel for the appellant insisted that this document could not be looked into as it was not produced before the trial Court. It is felt that the respondent cannot be non-suited on this ground. The firm was holding a valid registration and merely because the renewal certificate was not produced in the court below, it would not mean that there was no registered trade mark on the date of filing of the suit. It may also be pointed out that when learned counsel for the appellant had argued on the point of limitation, learned counsel for the respondent had submitted that the point of limitation was not raised before the trial Court, to which learned counsel for the appellant replied that he could not be stopped from raising a legal argument. Similarly, respondent now cannot be stopped from showing the legal point that it had a valid registration at the time of filing of the suit and the suit is, therefore, maintainable.

13. Learned counsel for the appellant lastly argued that the trial Court did not apply its mind and granted the temporary injunction which has brought the business of the appellant to a halt. The court could have either imposed some penalty and/or directed the appellant to change the colour of the packing and the style of writing the word DHAMAAL. He submitted that the appellant was undertaking before this Court to change the colour. So far as the direction by the court is concerned, the injunction granted is to the effect that the appellant shall not use the trade mark of the appellant by using an identical trade mark under DHAMAKA and identical pouch thereof, which could pass the goods under the name of DHAMAAL as being the goods manufactured by DHAMAKA. If the appellant undertakes to use the trade mark in different style, which is not deceptively similar to that of respondent and also changes the colour of the pack, it may do so and no law stops it from the same. The appellant is at liberty to use a trade mark which is not deceptively similar to that of the respondent and the packing is also in a different colour and style. In that event, the respondent will have no grievance. At present, however, both the packings of DHAMAKA and DHAMAAL are surely deceptively similar.

14. In view of the undertaking given on behalf of the appellant before this Court, it is ordered, as observed just herein above, that the appellant may use the trade mark which is not deceptively similar to that of the respondent and must also pack the goods in different colour with different style of printing the name etc. on the packing. The appeal is disposed of in the said terms.