

(2012) 08 DEL CK 0205

Delhi High Court

Case No: CS (OS) 2392 of 2006

Subhash Chand Bansal

APPELLANT

Vs

Khadim"s and Another

RESPONDENT

Date of Decision: Aug. 22, 2012**Acts Referred:**

- Trade Marks Act, 1999 - Section 124(2), 17, 17(1), 17(2), 17(2)(a)

Citation: (2012) 9 AD 448**Hon'ble Judges:** V.K. Jain, J**Bench:** Single Bench**Advocate:** Mohan Vidhani, Mr. Mahir Malhotra and Mr. Rahul Vidhani, for the Appellant;
Sayantan Basu and Mr. Atish Ghosh, for the Respondent

Judgement

V.K. Jain, J.

The plaintiff before this Court is engaged in the business of manufacturing and sale of boots, shoes and slippers, which he is selling under the trademark "KHAZANA". The plaintiff claimed to be using the aforesaid mark since 1.1.1990 and also claims that his products are well known for their intrinsic quality and enjoy tremendous goodwill and reputation in the market. The plaintiff is also the proprietor of the registered trademark KHAZANA, registered vide registration number 1070231 in Class: 25 in respect of boots, shoes and slippers.

The defendants applied for trademarks "Khadim"s Sriman KHAZANA (label), "Khadim"s Girls KHAZANA" (label), "Khadim"s Srimati KHAZANA" (label) and "Khadim"s Boy KHAZANA" (label) under applications numbers 1312611, 1312619, 1312623 and 1312621 respectively in class 25 for clothing, footwear and headgear which were opposed by the plaintiff. The defendants, while seeking registration of the above referred marks, claimed user since 18.09.2004, whereas the plaintiff has been using the mark KHAZANA since 1.1.1990. The defendants filed two other applications bearing number 1365971 and 1365977 for registration of the

trademark Khadim's Baby KHAZANA and Khadims Boy KHAZANA for clothing including boots, shoes, hawai chappals and slippers and headgear included in class 25. In these applications also the defendants claimed user since 18.9.2004. The plaintiff had filed opposition to these applications as well. The plaintiff has accordingly sought an injunction restraining the defendants from using the trademark KHAZANA or any other mark which is identical or deceptively similar to that of the plaintiff's mark. The plaintiff has also claimed damages to the extent of Rs. 20 lac, besides delivery up of the infringing material and rendition of accounts.

The defendants have contested the suit. It has been stated in their counter affidavit/written statement that defendant No. 1 has no independent juristic existence, it being only an outlet owned by defendant No. 2 and even that outlet is not functioning any more. It is further alleged that plaintiff did not apply for registration of the word mark KHAZANA and sought registration only in a stylized manner in which the word KHAZANA has been represented in the Trademark Journal and the application for registration. It was also alleged that defendant No. 2 was in the process of applying for rectification of the registration obtained by the plaintiff. It is also alleged that defendants have at all material times representing the mark KHAZANA with the prefix KHADIM'S so as to distinguish their mark from other marks. It is also claimed that use of prefix KHADIM'S is sufficient to distinguish the goods of the defendants from the goods of the plaintiff. It is also stated in the written statement/ counter affidavit that the defendant No. 2 intend to sell the goods with KHAZANA suffix from its own departmental stores and, therefore, there is no possibility of any confusion amongst public. It is further alleged that the sale of the defendants from KHAZANA product was Rs. 121,251,927/- as against the plaintiff's sale of Rs. 11,87,830/- in the year 2005- 06 and the defendants incurred publicity expenses amounting to Rs. 32,49,666/-, in respect of the mark KHAZANA for the year 2005-06.

The defendants have placed on record attested photocopies of as many as five registrations in class 25 in respect of boots, shoes, hawai chappals, slippers and headgears. In three of them, the word KHAZANA in conjunction with other word(s) has been used on the labels which have been registered by Trademark Registry. The remaining two are word mark registration of the words "KHADIM'S KHAZANA" and "KHADIM KA KHAZANA". The defendants were directed to file legal proceedings certificates in respect of the aforesaid registrations. On 21.04.2011, the learned counsel for the plaintiff stated that the plaintiff proposed to challenge registration/ application Nos.1365976, 1341765, 1281371, 1276320 and 1339523, all in Class 25, before the Intellectual Property Appellate Board. The plaintiff was accordingly given three months" time to apply to the Intellectual Property Appellate Board, for rectification of the registration of the aforesaid trademarks. An additional issue was also framed on that date. Vide subsequent order dated 10.10.2001, the trial of the suit was stayed by this Court in terms of Section 124(2) of the Trademarks Act till final disposal of the rectification proceedings which the plaintiff had filed on

21.07.2011, in respect of the said registrations in favour of defendant No. 2. However, during the course of hearing in FAO(OS) No. 289 of 2012, the learned counsel for the defendants stated that the defendants were not relying on those registration certificates and the controversy in the present suit was limited to the issue as to whether there was an infringement/ passing off qua the mark of the plaintiff KHAZANA by reason of the defendants using the trademark KHADIM'S KHAZANA and other prefixes. Therefore, the aforesaid registration in favour of the defendants has to be excluded from consideration, while deciding this suit.

2. On 17.01.2011, the following issues were framed in this case:

1. Whether the defendants are infringing the registered trade mark "KHAZANA" of the plaintiff and/or are passing off their goods as those of the plaintiff's by using the impugned trademarks/labels Khadim's sriman Khazana, Khadim's Girls Khazana, Khadim's srimati Khazana and Khadim's Boy Khazana and/or other marks khazia including the name "KHAZANA" therein ?

2. Whether the plaintiff is entitled to the injunctions sought by him?

3. Whether the plaintiff is entitled to damages and if so, to what amount?

4. Whether the plaintiff is entitled to rendition of accounts?

5. Whether the plaintiff is entitled to delivery up of the infringing materials?

6. Relief.

The parties stated that since there was no dispute on facts, they do not propose to lead evidence. As regards additional issue framed on 21.04.2011, the same is liable to be struck off in view of the statement made by the learned counsel for the defendants in FAO(OS) 289/2012.

ISSUE No. 1 to 3

3. A perusal of the registration certificate number 01070231 dated 31.12.2001 issued by Trademark Registry would show that the trademark registered in favour of the plaintiff is the word KHAZANA inside a rectangular box. The contention of the defendants is that the word "KHAZANA" for which registration has been obtained by the plaintiff has been written in a stylized manner, whereas the contention of the plaintiff is that the word KHAZANA has been written in a particular font and not in a stylized manner. However, the fact remains that there is neither any additional word nor any logo/monogram etc in the rectangular box in which the word KHAZANA has been written in the registration of the plaintiff. In the certificate issued by Trademark Registry the trademark of the plaintiff has been described as a label/ device and not as a word or mark.

4. Relying upon Section 17 of the Trademarks Act, 1999, the learned counsel for the defendants has contended that since the plaintiff did not seek separate registration

in respect of the word KHAZANA, he is not entitled to injunction against user of the word KHAZANA and the right available to him is confined to the word KHAZANA written in a particular stylized form, in a box. The contention of learned counsel for the plaintiff on the other hand is that the plaintiff is entitled to exclusive use of the word KHAZANA irrespective of the fact whether it is written in a stylized form or in a designer font or using ordinary letters of the language in which the word is written.

5. Section 17 of the Trademarks Act, 1991 reads as under:

17. Effect of registration of parts of a mark.-

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub- section (1), when a trade mark-

(a) contains any part-

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

A careful analysis of the abovereferred provision would show that subsection (2) would apply only to a mark which contains more than one parts, which are capable of being separately registered as a trademark. If a trademark does not constitute more than one part capable of separate registration, sub section (2) of section 17 would not apply to such a mark. To take an example, if a registered trademark constitutes of a wordmark as well as a logo, the proprietor of the trademark would be entitled to exclusive right to use the trademark taken as a whole, but would not be entitled to protection of the logo and the wordmark when they are used separately from each other. To demonstrate it by way of an example, if a registered trademark comprises of the word "Lotus" and picture of a flower inside a box, he would be entitled to injunction if another person uses the mark as a whole but would not be entitled to an injunction against the use of the word "Lotus" or the picture of the flower unless he has submitted separate applications for registration of the word "Lotus" and the picture of the flower. This is so because the flower as also the word "Lotus" are capable of separate registrations. To take another example, if there is a mark comprising of the word "Delhi Khata Mitha" inside a box or otherwise, the registered proprietor of the trademark would be entitled to use of the trademark "Delhi Khata Mitha" as a whole. He would be entitled to protection against use of the trademark "Delhi Khata Mitha" as a whole and not if the word "Delhi" is used without the word "Khatha Mitha" or "Khatha Mitha" is used without

the word "Delhi", unless the proprietor of the trademark has separately sought registration of the words "Delhi" and "Khatha Mitha". This is for the reason that the word "Delhi" as well as the word "Khatha Mitha" are capable of separate registration.

6. However, in the case before this Court, there is absolutely nothing except the word KHAZANA inside a box/ on the label registered in favour of the plaintiff. There would be nothing left in the box/ on the label if the word KHAZANA is taken out of the box /label. Therefore, it cannot be said that the registered trademark of the plaintiff comprised two distinct parts which were capable of separate registrations. Therefore, sub-section (2) of Section 17 does not apply to the registration obtained by the plaintiff. During the course of the arguments, the learned counsel for the plaintiff gave yet another apt example. He contended that if the registration trademark comprises of a picture of an apple, can it be said that use of the word "apple" would not constitute infringement of the trademark merely because no separate registration for the word "apple" was sought. The answer, according to the learned counsel, has necessarily to be in the negative since the very purpose of obtaining registration of the picture of apple would be frustrated, if others are also allowed to use the word "apple" in respect of the same product which are the subject matter of the registered trademark i.e. picture of an apple.

7. The learned counsel for the defendants placed heavy reliance upon the judgment of Madras High Court in *Three-N-Products Private Limited v Emami Limited* [GA No. 2951 of 2007; GA No. 3976 of 2007 in CS No. 204 of 2007)] decided on 26.08.2008 as well as the judgment of Division Bench of Madras High Court in an appeal filed against the order of learned Single Judge in that case. In the case before the Madras High Court, the plaintiff before the High Court asserted its exclusive rights over a word mark "Ayur", on the strength of a black and white label registration, showing the word "Ayur" in an unremarkable font with an elliptical band around it. The defendant before the High Court had applied for registration of the word "Ayucare" in class 5 and class 3 of the word mark "Ayucare" in class 3 and class 42. The plaintiff before the Madras High Court was also the registered proprietor of the word mark "Ayu" in class 5, covering medicinal and like products. On the strength of the word "Ayur" being the most prominent part of plaintiff's label registration and its proprietary rights to the word "Ayu" plaintiff sought injunction against the defendants before the Madras High Court. Rejecting the case of the plaintiff, the learned Single Judge, inter alia, held as under:-

32. The registration of a device or label would entitle the proprietor to protection against the use of such device or label by a rival in trade if the rival's use is identical or similar to the registered trademark and the use is in connection with identical or similar goods or service covered by such registered trademark and it appears to the Court that the rival's mark is likely to cause confusion or is likely to have an association with the registered mark.

34. The right that the owner of a device or label mark obtains is, loosely speaking, somewhat similar to copyright. It is as much the writing or etching in a device or label, and the design and colour combination thereof, over which the registered proprietor gains rights as the manner of depiction thereof. It is possible that a registered mark is made up of several components which are distinctive and notwithstanding separate registrations in respect of such distinctive parts not having been obtained by the owner of the registered mark, such proprietor is entitled to cite one distinctive part as being inseparable from the registered whole or such distinctive part being the most outstanding attribute of the mark and thus assert a right over the distinctive part. But in view of Section 17(2)(a) of the 1999 Act, such assertion has to be as in passing off and may not be made in aid of a case of infringement. Section 17(2) and the world beyond the statute that is recognized in Section 27 of the 1999 Act has a combined effect of permitting the registered owner to claim exclusivity of a part of the whole of the registered mark, but only on a cause of action of passing off.

35. The words "the registration thereof shall not confer any exclusive right" towards the end of Section 17(2) have to be understood in the context. The import of such words is that the registration of the composite mark will not ipso facto confer any exclusive right as to the parts of the composite mark. But if the owner can establish exclusivity aliunde, the owner can assert the exclusivity. The registered owner is entitled to protection of its goodwill in such prominent feature as in an action for passing off unless the registered owner seeks to rely of Section 17(2) (b) of the Act in respect of a distinctive matter not common to the trade.

The Division Bench of Madras High Court rejecting the plea of the plaintiff held as under:

18. So far infringement of the registered trademark is concerned, it appears that the plaintiff is the registered proprietor of the trademark "Ayu" and "Ayur" in Class 5 for medicinal and pharmaceutical preparations and is the proprietor of registration of a "device" or "label" "Ayu" and "Ayur" written in a "particular design". It is settled law that the registration of a device or label would entitle the proprietor to protection against the use of such device or label by a competitor in trade if the rival's use is identical or similar to the registered trademark and the use is in connection with identical or similar goods or service covered by such registered trademark and at the same time, if it appears to the Court that the rival's mark is likely to cause confusion or is likely to have an association with the registered mark. In other words, if the two marks are identical and the goods and services covered by either mark are also identical, there is a presumption that there is violation of the registered mark and the Court in such circumstances is entitled to grant a temporary injunction. The identity or the similarity of the marks has to be assessed on the basis of entirety of the marks as registered.

19. The identity of the defendant's mark with 17 the plaintiffs as referred to in Clauses (a) and (b) of sub-section (2) of Section 29 of the Act is to be understood in the context of Section 17(1) of the Act.

20. We cannot lose sight of the fact that the right which the owner of the device or label marks obtained is somewhat similar to copyright and it is as much the writing in a device or label and the design and colour combination thereof, over which the registered proprietor gains rights as the manner of depiction thereof. In a given case, it may be that a registered mark is made up of several components which are distinct and in spite of separate registration in respect of such distinguishing part not having been obtained by the owner of registered mark, such proprietor is entitled to cite one distinctive part as being inseparable from the whole registered or such distinctive part and thus, can assert a right over the distinctive part. But as pointed out in Section 17 (2) (a) of the Act, such assertion has to be in conformity with the law of passing off and may not be made in aid of infringement.

8. With due deference to the decision of Madras High Court, I find myself unable to take the view that registration of a word on a label/ in a box without there being anything else on the label/ inside the box would not entitle the plaintiff to seek injunction against use of that word in a suit based on infringement. In my view, sub section (2) of Section 17 of the Act cannot be applied unless the trademark constitute of more than one parts which are capable of independent registrations and this is made abundantly clear by use of the word "contains any part which is not the subject of a separate registration" in clause (a) of sub section.

9. The learned counsel for the defendants has also relied upon a decision of this Court in S.B.L Ltd. v Himalaya Drug Co. [AIR 1998 (Delhi) 126]. In that case, the plaintiff before this Court was selling and manufacturing Ayurvedic medical preparations under the trademark "Liv.52", which is a liver tonic prescribed for liver disorder and to protect the liver against various dysfunction, damage and hepato-toxins. The trademark "Liv.52" was registered in class 5 as a medical preparation. The "Liv.52" label was also registered in class 5 as medical, pharmaceutical and Ayurvedic preparation and substances. The defendants were found to be using the mark "Liv.52" for similar products, which were Homoeopathic preparations. This Court, while refusing the injunction to the plaintiff, noted that there were about 100 registrations in the market using the preparation Liv made out of the word "Liver", an organ of human body, as a constituent of the name of medicinal and pharmaceutical preparations with some prefix or suffix and thus the word "LIV" is, therefore, a generic and common to the trade name, describing the medicines associated with the treatment of liver. It has become public juris. It was held that the word being descriptive in nature and common in usage, nobody can claim" an exclusive right to the use of "Liv" as a constituent of any trade mark. It was held that the class of customers dealing with medicines would distinguish the name of the medicines by ignoring "Liv" and by assigning weight to the prefix or suffix, so

as to associate the name with the manufacturer and the possibility of deception or confusion is reduced practically to nil, in view of the fact that the medicine will be sold on medical prescription and by licensed dealers well versed in the field and having knowledge of medicines. This Court further held that there was no phonetic similarity between Liv-52 and Liv-T. This judgment does not help the defendants before this Court for the simple reason that there is no evidence or even averment that the word KHAZANA was being used as a trade name for shoes, boots, etc. nor can it be said to be a generic term as far as boots, slippers etc are concerned. Also, there is no evidence or even allegations that this word was being used by others in the market, along with some prefix or suffix.

10. It was next contended by the learned counsel for the defendants that since they are using the word KHAZANA in conjunction with the word "KHADIM'S and that at the time of filing of this suit, the size of the word "KHADIM'S on their packaging was smaller than the word KHAZANA, they are ready to reduce the size of the word KHAZANA so as to make it smaller than KHADIM'S and, therefore, the plaintiff is not entitled to any injunction against use of the mark "KHADIM'S KHAZANA". The learned counsel for the plaintiff, on the other hand, maintained that the defendants cannot use the word KHAZANA either alone or in conjunction with any other word by way of suffix or prefix since any such use would clearly constitute infringement of the registered trademark of the plaintiff.

11. In Ruston & Hornsby Ltd. versus Zamindara Engineering Co. PTC (Suppl) (1) 175 (SC), the plaintiff was the proprietor of the trademark "RUSTON". The defendant was found using the mark "RUSTAM". Holding that the plaintiff should be granted a decree restraining the defendant by way of a permanent injunction from infringing its trademark "RUSTON", the Supreme Court, held as under:

4. It very often happens that although the defendant is not using the trade mark of the plaintiff, the get up of the defendant's goods may be so much like the plaintiff's that a clear case of passing off would be proved. It is on the contrary conceivable that although the defendant may be using the plaintiff's mark the get up of the defendant's goods may be so different from the get up. of the plaintiff's goods and the prices also may be so different that there "would be no probability of deception of the public. Nevertheless, in an action on the trade mark, that is to say, in an infringement action, an injunction would issue as soon as it is proved that the defendant is improperly using the plaintiff's mark.

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7. 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.

12. In *Metro Tyres Limited v. M/s A.S. Traders and others* [2011(6) R.A.J. 184 (Del.)], the plaintiff was using the trademark "VELO" represented in a special and artistic manner in respect of cycle/ rickshaw tyres. The defendants in that case had adopted a mark which was identical to plaintiff's trademark "VELO". It was held by this Court that the plaintiff was entitled to injunction restraining the defendants from using the impugned trademark. Thus, this Court granted injunction despite the fact that the trademark of the plaintiff was the word "VELO" written in a specialized and stylized manner whereas, the trademark being used by the defendants was simple wordmark "VELO".

13. I had the occasion to consider somewhat similar issue in *Greaves Cotton Ltd. v Mohamamd Rafi & Ors.* [2011(46) PTC 468(Del.)]. In that case, the plaintiff was the registered proprietor of the trademark "GREAVES" which was also being used by it as a part of its corporate name. Defendant No. 1 before this Court had applied for registration of the trademark "GREAVES INDIA". Holding that the plaintiff was entitled to permanent injunction against use of the impugned mark, this Court, inter alia, held as under:

12. It is not necessary that in order to constitute infringement, the impugned trademark should be an absolute replica of the registered trademark of the plaintiff. When the mark of the defendant is not identical to the mark of the plaintiff, it would be necessary for the plaintiff to establish that the mark being used by the defendant resembles his mark to such an extent that it is likely to deceive or cause confusion and that the user of the impugned trademark is in relation to the goods in respect of which the plaintiff has obtained registration in his favour. It will be sufficient if the plaintiff is able to show that the trademark adopted by the defendant resembles its trademark in a substantial degree, on account of extensive use of the main features found in his trademark. In fact, any intelligent person, seeking to encash upon the goodwill and reputation of a well-established trademark, would make some minor changes here and there so as to claim in the event of a suit or other proceeding, being initiated against him that the trademark being used by him, does not constitute infringement of the trademark, ownership of which vests in some other person. But, such rather minor variations or distinguishing features would not deprive the plaintiff of injunction in case resemblance in the two trademarks is found to be substantial, to the extent that the impugned trademark is found to be similar to the registered trademark of the plaintiff. But, such malpractices are not acceptable and such a use cannot be permitted since this is actuated by a dishonest intention to take pecuniary advantage of the goodwill and brand image which the registered mark enjoys, it is also likely to create at least initial confusion in the mind of a consumer with average intelligence and imperfect recollection. It may also result in giving an unfair advantage to the infringer by creating an initial interest in

the customer, who on account of such deceptive use of the registered trademark may end up buying the product of the infringer, though after knowing, either on account of difference in packaging etc. or on account of use of prefixes or suffixes that the product which he is buying is not the product of the plaintiff, but is the product of the defendant.

13. As held by the Supreme Court in [Amritdhara Pharmacy Vs. Satyadeo Gupta](#), whether a trade name is likely to deceive or cause confusion by its resemblance to another mark already registered is a matter of first impression and the standard of comparison to be adopted in judging the resemblance is from the point of view of a man of average intelligence and imperfect recollection. What is important to keep in mind that the purchaser does not have both the marks lying side by side for comparison and, therefore, chances of deception are rather strong.

14. In a case based on infringement of a registered trademark, the plaintiff need not prove anything more than the use of its registered trademark by the defendant. In such a case, even if the defendant is able to show that on account of use of other words by him in conjunction with the registered word/mark of the plaintiff, there would be no confusion in the mind of the customer when he comes across the product of the defendant and/or that on account of the packaging, get up and the manner of writing trademark on the packaging, it is possible for the consumer to distinguish his product from that of the plaintiff, he would still be liable for infringement of the registered trademark.

In [KSB Aktiengesellschaft and Ors Vs. KSB Global Limited](#), the plaintiff company was using "KSB" as part of its corporate name. Plaintiff No. 2 in that case was also exporting goods under the trademark "KSB" and/or under the trade name "KSB" & Logo. The defendant was using "KSB" as a part of its trade name. It was contended on behalf of the defendant that no infringement was made out on its part as it was using the words "Global Limited" as suffix to the word "KSB". The contention was however, rejected by this court noticing that the parties were in similar line of business and holding the rival marks were deceptively similar. The Court felt that a lay consumer could by association relate the origin of defendant's goods to that of the plaintiff.

In *Ruston & Hornsby Ltd. v. Zamindara Engineering Co.* (supra) where the appellant was registered proprietor of trade mark "RUSTON" in Class 7 in respect of the diesel internal combustion engines. The respondent was found using the trademarks "RUSTAM" and "RUSTAM INDIA". The High Court held that use of the word "RUSTAM INDIA" by the respondent did not constitute infringement of the mark "RUSTON" on the ground that the plaintiff's products were manufactured in England whereas the defendant was manufacturing them in India and the suffix "INDIA" would be a sufficient warning that the engines sold was not a "RUSTON" engine manufactured in England. Setting aside the decision of the High Court, Supreme Court held that if the respondent trade mark "RUSTOM" was deceptively similar to that of the

appellant's trade mark "RUSTON", the mere addition of word "INDIA" to the respondent's trade mark was of no consequence and the appellant was entitled to succeed in its action for infringement of trade mark.

Similar issue came to be considered by me in [Procter and Gamble Co. Vs. Joy Creators and Others](#), . The plaintiff in that case was holding registration in respect of trademark "Olay total effects" in Class 3 of Schedule 4 of Trademarks Act, 1999 in respect of Foundation, Make-up Base, Skin Moisturizing Cream, Lotions and Gels, Skin Whitening Preparations etc. It was also holding registration in respect of the trademark OLAY in Class 3 of the same Schedule. The defendants in that case, applied for registration of the label which contains the mark JOY ULTRA LOOK TOTAL EFFECTS in respect of soap, perfumery essential oils, hair lotions and creams, dentifrices etc. Holding that the plaintiff was entitled to injunction against use of the impugned trademark, this Court, inter alia, held as under:

11. In [Corn Products Refining Co. Vs. Shangrila Food Products Ltd.](#), , the Supreme Court observed that the question whether two competing marks are so similar as to be likely to deceive or cause confusion is one of first impression and it is for the court to decide it. The question has to be approached from the point of view of a man of average intelligence and imperfect recollection.

12. In [Parle Products \(P\) Ltd. Vs. J.P. and Co., Mysore](#), , Supreme Court inter alia observed as under:-

According to Karlyus Law of Trade Marks and Trade Names (9th Edition Paragraph 838) "Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with the one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. It would be too much to expect that persons dealing with trademarked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own. It is therefore clear that 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.

18. In [K.R. Chinna Krishna Chettiar Vs. Shri Ambal and Co., Madras and Another](#), the respondents were the two registered trademarks. The first mark consisted of a label containing a device of a goddess Sri Ambal seated on a globe floating on water enclosed in a circular frame with the legend "Sri Ambal parimala snuff" at the top of the label, whereas the other mark consisted of expression "Sri Ambal". The appellant before Supreme Court was seeking registration of a label containing three panels. The first and the third panels contained equivalents of the words "Sri Andal Madras Snuff", whereas the central panel contained the picture of goddess Sri Andal and the legend "Sri Andal". Sri Andal and Sri Ambal are separate divinities. The question before the Court was whether the proposed mark of the appellant was deceptively similar to the respondents' mark. Noticing that the word Ambal was an essential feature of the registered trademarks, the Court was of the view that the name Andal proposed to be used by the appellant did not cease to be deceptively similar because it was used in conjunction with a pictorial device. Supreme Court referred to the case of *De Cordova and Ors. v. Vick Chemical Coy.* (1951) 68 R.P.C.103 where Vick Chemical Coy were the proprietors of the registered trade mark consisting of the word "Vaporub" and another registered trade mark consisting of a design of which the words "Vicks Vaporub Salve" formed a part. The defendants advertised their ointment as "Karsote vapour Rub" and the Court held that the defendants had infringed the registered marks. The view taken by Lord Radcliffe that "a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features" was affirmed by the Supreme Court. The appeal was accordingly dismissed by Supreme Court, despite the fact that the words Ambal and Andal had distinct meanings. In the case before this Court, the defendants have used the words "TOTAL EFFECTS" without even attempting any change in those words, as an essential component of their trademark "JOY ULTRA LOOK TOTAL EFFECTS". The infringement by the defendants, therefore, is more serious than the infringement in the case of K.R. Chinna Krishna Chettiar (supra)

In *Atlas Cycle Industries Ltd. vs. Hind Cycles Limited*: ILR 1973, Del 393, the plaintiff was the registered proprietor of the trademark "EASTERN STAR" in respect of bicycles. The defendant was found selling cycles under the trademark "ROYAL STAR". The stand taken by the defendant was that the word trademark ROYAL STAR was not likely to cause confusion or deception or was not any infringement of appellants trademark EASTERN STAR since the word STAR was common to the trade and was being used by several cycle manufacturers. It was observed by this Court that when the words EASTERN STAR and ROYAL STAR are uttered, a person of average intelligence and imperfect memory was likely to remember only the sound and word STAR and those likely to be deceived or confused between the two names or mark and, therefore the two marks had an overall structural and phonetic similarity and consequently, their use in respect of the same kind of goods viz. cycles will cause confusion or deception within the meaning of Section 29 of the Trade and

Merchandise Marks Act, 1958.

In *Ansul Industries vs. Shiva Tobacco Company*: 2007(34) PTC 392, the appellant was marketing tobacco under the name "Udta Panchhi", whereas the respondent was manufacturing/selling chewing tobacco under the trade name "Panchhi Chaap". Noticing that the word "Panchhi" in the mark "Udta Panchhi" and "Panchhi Chaap" enjoys prominence and is the focal point of two marks, it was held by this Court that despite the getup and colour of packing being different, there was likelihood of deception and confusion on account of phonetic similarity of the word "Panchhi" in both the marks

14. In the case before this Court, the trademark KHADIM'S KHAZANA being used by the defendants incorporates whole of the trademark KHAZANA of the plaintiff. Thus, virtually the whole of the trademark of the plaintiff is subsumed in the trademark being used by the defendants. Admittedly, the defendants are using the mark KHADIM'S KHAZANA in respect of the shoes, boots, slippers, etc., for which registration has been obtained by the plaintiff. It is not the case of the defendants that they have been using the impugned trademark prior to use of the trademark KHAZANA by the plaintiff. Hence, the provisions of Section 34 of Trade Marks Act do not apply to this case.

15. In *Simla Chemicals Pvt. Ltd. v. Sun Soap Industries & Ors.* [CS(OS) No. 85/2008, decided on 20.07.2012], I had the occasion to analyze Section 29 of the Trade Marks Act, 1999 to the extent it is relevant for our purpose, and, inter alia, held as under:

7.....It would thus be seen that before a registered trade mark can be said to have been infringed u/s 29(1) of the Act:

(a) The person using the impugned mark should not be either its registered proprietor or a permitted user;

(b) The impugned mark should be either identical with or deceptively similar to the registered trade mark; (c) The impugned trade mark should be used in relation to the goods or services covered by the registered trade mark; and (d) The impugned mark should be used in such a manner that it is likely to be taken as if it is being used as trade mark.

8. The following are the pre-requisite conditions to constitute infringement under sub Sec.2 of Sec.29 of the Act:

a. The person using the impugned mark should not be either its registered proprietor or a permitted user

b. The impugned trade mark should be identical to the registered trade mark and should be used in respect of goods or services which are similar to the goods or services in respect of which the registered trade mark has been obtained/OR, the impugned trade mark should be similar to the registered trade mark and should be

used in respect of goods or services which are identical or similar to the goods or services covered by the registered trade mark/OR the impugned trade mark should be identical to the registered trade mark and should be used in respect of goods or services which are identical to the goods and services covered by the registered trade mark.

c. the user should be such as is likely to cause confusion on the part of the public or should be such that the impugned trade mark is perceived to be associated with the registered trade mark.

16. In [Bajaj Electricals Limited Vs. Metals and Allied Products and Another](#), the plaintiff before the Bombay High Court was engaged in the business of manufacturing electric lamps, lighting, fittings, accessories, kitchen appliances etc which were being used under the trademark "Bajaj". The defendants before the High Court adopted identical mark, the only dissimilarity being that the first letter in the trademark of the defendants was "B" is in capital letter as against the word "b" in the trademark of the plaintiff and the mode of writing letter "B" was slightly different and all the words were joined, which was not the case in the trademark of the plaintiff. It was held by the Bombay High Court that the plaintiff was entitled to injunction against the use of the impugned trademark by the defendants.

In *Kuldip Singh v S.K. Auto Industries* [1995(59) DLT 725], the plaintiff was using the trademark "SAINI" in which letter "I" was highlighted in the plaintiff label and out of the five letters, first two i.e. "S" and "A" and the last two words "N" and "I" were written in same size whereas the letter "I" in between, was about three times bigger in length as compared to other letters S, and I. At the top of this very letter "I" it had been intersected with word "Genuine" (all the letters in black colour with yellow base) whereas in the label of defendants "SAINI" was written in red letters. Both the marks were in yellow base/back ground, the defendants' mark having a green line around with thick green colour on two sides, left and right. It was held that the plaintiff was entitled to injunction against use of the impugned mark by the defendants.

17. Mere use of the prefix KHADIM'S, would not take the case out of the purview of Section 29 of the Trade Marks Act irrespective of whether the word KHADIM'S is bigger, equal or smaller than the word KHAZANA. There is a strong possibility of customers findings the shoes and boots etc. being sold under the trademark KHADIM'S KHAZANA in the stores of defendant No. 2 and confusing the same with the trademark of the plaintiff on account of use of the word KHAZANA in the trademark of the defendants. Moreover, a customer of average intelligence may presume that it is the product of the plaintiff which is being sold in the stores of the defendants and that is why the word KHAZANA is written on the product and/or its packaging or the customers may presume that there is some kind of trade connection between the plaintiff and defendant No. 2 and that is why the word KHAZANA is being used as a part of the trademark of the defendants, in respect of

identical products.

18. The impugned trademark, to my mind, is at least deceptively similar to the registered trademark of the plaintiff and since the trademark in question is being used in relation to the goods which are covered by registered trademark of the plaintiff, a case of infringement u/s 29(1) of the Trade Marks Act is clearly made out. Even if I proceed on the assumption that impugned trademark is similar though not deceptively similar to the registered trademark of the plaintiff, it still constitutes infringement within the meaning of Section 29(2) of the said Act since it is being used in respect of the same products which are covered by the plaintiff's registered trademark and as such is likely to cause confusion in the minds of the consumers or they may perceive the impugned trademark to be associated with the registered trademark of the plaintiff.

19. For the reasons stated hereinabove, the issue No. 1 and 2 is decided against the defendants and in favour of the plaintiff.

Issues No. 3 to 6:

20. No arguments were advanced on these issues, by the learned counsel for the plaintiffs. I, therefore, held that the plaintiff is not to any relief other than the injunction sought by him.

Conclusion

In view of my finding on the issues, defendant No. 2 is restrained from using the impugned trademark "KHADIM'S KHAZANA" or any other mark which is identical or deceptively similar to the registered trademark of the plaintiff in respect of shoes, boots and slippers. Defendant No. 2 is also restrained from selling, advertising or storing for sale any boots, slippers, shoes, etc bearing impugned trademark or any other mark which is identical or deceptively similar to the mark of the plaintiff either on the product or on its packaging. Since defendant No. 1 is not a legal entity, its name is deleted from the array of defendants. In the facts and circumstances of the case, there shall be no orders as to costs. Decree sheet be drawn accordingly.