

(2010) 08 CAL CK 0022

Calcutta High Court

Case No: G.A. No"s. 2662 of 2008 and 263 of 2010 and C.S. No. 155 of 2008

R.R. Proteins and Agro Limited

APPELLANT

Vs

Hari Shankar Singhania and
AnotherRESPONDENT

Date of Decision: Aug. 20, 2010**Acts Referred:**

- Trade Marks Act, 1999 - Section 17, 17(2), 2, 21, 29
- Trade Marks Rules, 2002 - Rule 68

Citation: (2010) 44 PTC 448**Hon'ble Judges:** Sanjib Banerjee, J**Bench:** Single Bench**Advocate:** S.K. Kapur and Pratap Chatterjee, Ranjan Bachawat, Sayantan Bose, Prithiraj Sinha, A. Chandra and Atish Ghosh, for the Appellant; Bhaskar Sen and Goutam Ray, for the Respondent**Final Decision:** Allowed

Judgement

Sanjib Banerjee, J.

In this rolled up action for infringement and passing-off, the plaintiff asserts its exclusivity over the trade mark "Arati" in respect of edible oil on the strength of the plaintiff's word mark registration in "Arati" and divers label registrations where the plaintiff claims that "Arati" is the dominant feature.

2. On the cause of action of infringement, the plaintiff insists that all it is required to demonstrate is that the defendants have used the plaintiff's mark as a part of their mark in relation to similar goods as those covered by the plaintiff's mark. The plaintiff says that the use of an additional word by the defendants would be of no relevance since in the defendants' "Sandhya Arati" mark it is the "Arati" word that stands out and the word "Sandhya" is an embellishment or a distraction. On the additional cause of action of passing-off, the plaintiff suggests that the defendants'

coinage of their mark was with notice of the plaintiff's rights in respect of "Arati" and was calculated to cause confusion with intent to trade upon the goodwill and reputation of the plaintiff's mark and the established quality of its product.

3. By an agreement of October 1, 2003, the erstwhile owner of ten word and device marks agreed to assign such marks for valuable consideration to the plaintiff. The plaintiff claims that the assignment was completed upon the execution of a document in March, 2007. A copy of the relevant document of March, 2007 was made over to the defendants at the ad-interim stage. The plaintiff shows from the documents on record that the second defendant is an erstwhile director of the plaintiff and that both the defendants continue to be shareholders of the plaintiff company.

4. On the plaintiff's application, GA No. 2662 of 2008, an ad-interim order was made on August 21, 2008. At such stage the defendants were permitted to rely on documents that they had produced to suggest that their use of the mark "Sandhya Arati" in connection with edible oil had been continuous from or about the year 2004. The ad-interim order noticed the defendants' submission that the first defendant ran the business and the fact that the second defendant father of the first defendant was once a director of the plaintiff should not be counted against the first defendant's use of the "Sandhya Arati" mark. The said order, prima facie, disbelieved the documents produced by the defendants that their use of the "Sandhya Arati" mark dated back to 2004.

5. After recording the defendants' submission on the basis of Section 17 of the Trade Marks Act, 1999 and their argument as to the anomaly in the plaintiff's case that though the assignment of the marks was effected in favour of the plaintiff in March, 2007 the plaintiff had obtained or applied for recording the plaintiff's name as the registered owner in respect of some of them on the basis of the agreement to assign executed on October 1, 2003, the order dated August 21, 2008 recorded as follows:

The word "Arati" may be part of the composite label but the word is neither common to the trade nor otherwise of a non-distinctive character. Implicit in the subsequent registration of the word "Arati" is the recognition of it being distinctive. Section 17 of the 1999 Act does not imply that a prominent feature of a label mark has to be altogether disregarded even if it appears that such prominent part has developed a secondary meaning or association with a product. Section 17(2) contains a non-obstante clause which qualifies the right conferred by Sub-section (1). If the registered owner of a mark that consists of several matters is exclusively entitled to the use of the mark taken as a whole, there is some element of exclusivity conferred on the registered owner in respect of the prominent part of the composite mark. If such prominent part is per se not registrable or can be said to be generic to the associated product so as to rob such prominent part of the element of distinctiveness, the registered owner may not assert such prominent part to stop

another trader's use of it.

The words "the registration thereof shall not confer any exclusive right" towards the end of Sub-section (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 plaintiff's application for the word mark "Arati" shows proposed use at the time of the application. The defendant has relied on the plaintiff's representation to such effect. But since it appears that the registration of the labels prominently bearing the word "Arati" predates the defendant's use of the word "Arati" as part of its "Sandhya Arati" mark, the plaintiff is entitled to protection of its goodwill in such prominent feature as in an action for passing off.

Considering that the first defendant is the son of an erstwhile director of the company who was and/or ought to have been aware of the plaintiff's rights in respect of the marks and further considering that the word "Arati" formed a prominent part of the plaintiff's label marks and even disregarding the word-mark registration in favour of the plaintiff which dates back to the year 2006, the plaintiff is entitled to an order of injunction restraining the defendant from using the mark "Arati" as part of the composite mark in relation to edible oils sold by the defendants.

6. The defendants waited their turn for the plaintiff's application to ripen for final hearing and did not assail the ad-interim order. Not that such fact can be held against the defendants, but it has been nearly two years that the defendants have sold their edible oil product under the "Sandhya Arati" mark. The defendants express their helplessness at the plaintiff's application not having been taken up earlier and say that in their attempt to expedite the matter they were constrained to apply for vacating the subsisting order in February of this year. The first defendant's vacating application, GA No. 263 of 2010, is now meaningless since the plaintiff's application has been taken up.

7. The plaintiff submits that it is for the defendants to dislodge the ad-interim order since their affidavit and the vacating application do not bring any new material which would require the prima facie view already formed to be revisited. The plaintiff contends that it is the same set of documents that the defendants had relied upon at the ad-interim stage that have now been included in their affidavit to suggest that the defendants' use of the "Sandhya Arati" mark commenced in 2004. The plaintiff says that nothing in the defendants' documents on such aspect should prompt the court to alter the prima facie view already taken that the bills and other material relied upon by the defendants to demonstrate sale of their product under the "Sandhya Arati" mark prior to 2007 are questionable. The plaintiff argues that to the extent the defendants have sought to question the plaintiff's rights as the

registered owner of various marks, the court should disregard the defendants' assertion till such time that the plaintiff's name remains on the register in respect of such marks.

8. In its opening submission, the plaintiff has relied on a Supreme Court judgment to establish the distinction between infringement and passing-off, another to demonstrate that the use of a name as part of a label may be distinctive enough to entitle the plaintiff to exclusivity in respect of such name and a third to show that if the defendants' adoption of their mark is shown to be dishonest and with prior knowledge of the plaintiff's mark, an interlocutory injunction would almost invariably follow. In addition, the plaintiff has, in its opening, relied on a Madras decision where the use of one or more words in conjunction with the plaintiff's word mark was found to be no impediment to the plaintiff's claim therein of infringement.

9. The defence is three-fold. The defendants say that the recording of the plaintiff's name in respect of the registered marks has come about in suspicious circumstances. They say that as a forum of equity, the court will not turn a Nelson's eye to such matters merely because the plaintiff is now the registered owner of the marks or that the defendants' applications for rectification are pending. The defendants confine their submission to the plaintiff's rights under class 29 of the classifications since the defendants claim to use their "Sandhya Arati" mark only in relation to edible oil which is covered in such class. The defendants refer to paragraph 7 of the plaintiff's petition and say that, contrary to the impression given by the plaintiff, trade mark Nos. 495042, 495043, 495044, 556138, 630165 and 715376 do not stand in the name of the plaintiff in the Trade Marks Registry. In support of such contention, the defendants refer to copies of the documents downloaded from the Trade Marks Registry website that have been appended to the vacating application. It is apparent from such copy documents that as at January 5, 2010, the proprietor of such marks continued to be shown as the plaintiff's assignor, according to the status reports relating to these marks on the Trade Marks Registry website. The first defendant has categorically averred the same at paragraph 7 of his vacating application.

10. The defendants question the plaintiff's rights in respect of registered trade mark Nos. 715372, 715374 and 715375 which the plaintiff has claimed at paragraph 9 of its petition. The defendants say that the document at page 53 of the plaintiff's petition in support of the plaintiff's rights in respect of such three device marks would reveal that only a request in Form TM-16 had been made to the Registrar of Trade Marks. The defendants refer to Rule 68 of the Trade Mark Rules, 2002 and to Forms TM-16, TM-23 and TM-24 which are appended to such Rules. The defendants submit that a request in TM-16 is made for the correction of a clerical error or for an amendment. The defendants say that an application to the Registrar for registration of the transfer of a trade mark has to be made either by way of TM-23 or of TM-24.

The defendants urge that the plaintiff's claim in respect of the six marks referred to at paragraph 7 of its petition and the three marks referred to at paragraph 9 of its petition should be disregarded.

11. In respect of the marks bearing Nos. 1265443, 1265444, 1265445 and 1265446, which have been referred to at paragraph 11 of the plaintiff's petition, the defendants say that the claims in respect thereof as published in the trade marks journal in January, 2006 are, *ex facie*, false. The defendants refer to excerpts from such journal appearing at pages 72 and 73 of the vacating application where the use of such marks has been claimed by the plaintiff to be from March 1, 1989. The defendants suggest that since the plaintiff's right to the marks could only be asserted from March, 2007, the recording of the plaintiff's name in respect of marks, which was on the basis of a false representation, should be given no credence. The final contention of the defendants is that their mark "Sandhya Arati" is quite distinct from the plaintiff's "Arati" and no credible case of confusion or of any damage suffered has been brought by the plaintiff. The defendants submit that notwithstanding the ad-interim order of August 21, 2008 the balance of convenience would demand that the defendants' business under the "Sandhya Arati" mark not be stopped altogether. The defendants have offered to use their "Sandhya Arati" mark in such other form as would make it obvious that the defendants' products under such mark do not come from the plaintiff's stable.

12. The defendants have also sought to distinguish their labels, get-up and the form of expression of their mark from the plaintiff's. Since the matter does not turn on the resemblance of the labels or on the get-up of the packaging material of the rival products or on the stylised depiction of either mark, such line of defence is found to be irrelevant.

13. In fairness to the parties, the unusual course of the hearing must be accurately recorded. The plaintiff's opening submission was adequate but brief as the plaintiff was justifiably confident that it was for the defendants to dislodge the ad-interim order that has continued for nearly two years, particularly when such order was made after protracted hearing and upon the defendants' best documents being noticed. In the reply, the defendants sought more to justify their adoption and the use of the mark and to discredit the plaintiff's claim than to urge that the ad-interim view may not have been legally sound. But the defendants are not to blame for emphasising on the facts and law in their support rather than directly question, before the same Judge, the legal premise on which the ad-interim order was founded.

14. For reasons that will be found later in this order, the defendants' submission in their reply on facts and in law does not merit that the subsisting order of injunction be vacated. The plaintiff was put on notice by court, at the beginning of the plaintiff's rejoinder, that it was possible to perceive that the use of the word "Sandhya" by the defendants as part of their mark sufficiently distinguished it from

the plaintiff's as "Sandhya" was more substantial than the usual ornamental additions like, say, "new" that would seek to bring about a distinction in the copied mark without a meaningful difference. It is thence that the matter began afresh with the plaintiff being permitted to rely on authorities that would bear on the applicable principles.

15. The plaintiff insists that it has, and it is permissible to maintain, independent causes of action of infringement and passing-off in respect of its mark "Arati." The first, the plaintiff says, is a statutory right where the incorporation of such mark by another would entitle the registered proprietor to obtain protection. The other, according to the plaintiff, may be established, to the extent necessary at this stage of the proceedings, by demonstrating the improper motive of the defendants in the adoption of their mark and the confusion likely to be caused thereby. The plaintiff has referred to several authorities covering more than a century of legal thought in such branch of law. Some of the judgments that the plaintiff has carried were rendered at the final stage of the action and though the underlying principles may be the same, the tests to be applied at the interlocutory stage would be quite different. The plaintiff first gives a taste of the law that has been recognised in this country by referring to the celebrated judgment reported at [Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories](#). The two appeals that were considered in the judgment arose from an application for removing the mark "Navaratna" from the Trade Marks Register and from an appeal from a decree in an action for infringement and passing-off. The Supreme Court observed that all the matters which are of the essence in an infringement action may not be of relevance in a cause of action for passing-off. The following passage from paragraph 28 of the report encapsulates the legal position:

(28) ...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. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish

that the plaintiff's rights are violated. Expressed in another way, 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.

16. In the judgment reported at [K.R. Chinna Krishna Chettiar Vs. Shri Ambal and Co., Madras and Another](#), that is next placed by the plaintiff, the Supreme Court considered the likelihood of deception with an existing trade mark in the context of the subsequent application for the registration of a mark. There was already a "Sri Ambal" mark that was in the register in respect of snuff. A subsequent application was made for registration of the mark "Sri Andal" to which the owner of the registered mark "Sri Ambal" filed a notice of opposition on the ground that the mark proposed to be registered was deceptively similar to the registered mark "Sri Ambal." The Court held that the resemblance between two marks must be considered with reference to the ear as well as the eye and ocular comparison may not always be decisive. The subsequent applicant's plea stood rejected on the court's perception that the phonetic resemblance of its mark would lead to confusion and it was likely that the majority of the customers would not be capable of understanding the fine distinction between the meanings of the two goddesses embodied in the rival words.

17. As to the tests to be applied if one or more words are added to the word forming the subject-matter of a previous registered word mark, the plaintiff has brought a judgment reported at [Kali Aerated Water Works, Tiruchirapalli Vs. Rashid and Others](#). The plaintiff in that case was the registered owner of the mark "Kali" in respect of the class covering aerated water. Erstwhile employees of the plaintiff started a business of manufacturing aerated water and selling the product under the mark "Sri New Kali." In addition to the claim based on the word mark, the plaintiff also contended that the defendant's label was a colourable imitation of the plaintiff's. The trial court decreed the suit in the plaintiff's favour but fixed a nominal damage and declined the other reliefs for the defendants to produce in court the dice and other material used for printing their labels. The defendant's appeal succeeded and a Letters Patent appeal therefrom was carried to a Division Bench of the Madras High Court which found that the plaintiff had established the essential ingredients of a passing-off action and was entitled to a decree.

18. The next judgment cited by the plaintiff, reported at [Midas Hygiene Industries P. Ltd. and Another Vs. Sudhir Bhatia and Others](#), is for the proposition that if the adoption of the defendant's mark is found to be dishonest, an interlocutory injunction would follow. The plaintiff in that case complained of passing-off and

infringement of copyright. The original mark in that case was "Laxman Rekha" and the offending mark was "Magic Laxman Rekha." After briefly noticing the facts, the court held that in cases of infringement, either of trade mark or of copyright, normally an injunction must follow and the mere delay in bringing the action would not be sufficient to decline the injunction. The court also noticed that it was the admitted position that the defendants used to work with the plaintiff and held that the grant of injunction would be necessary if it prima facie appeared that the adoption of the mark was itself dishonest.

19. In the judgment reported at (1951) 68 RPC 103 (PC) (*De Cordova v. Vick Chemical Coy.*) the matter reached the Privy Council from the decree passed in the suit. The defendant in that case had added the word "Karsote" in place of "Vicks" but the rest of the mark was identical to the plaintiff's. The Court found that a case of both infringement and of passing-off had been made out. In the judgment reported at 1958 RPC 226 (*Baume & Coy., Ltd. v. Moore (A.H.) Ltd.*), the plaintiff complained of the defendant's "Baume & Mercier" mark in respect of watches infringing the plaintiff's registered mark "Baume." The court opined that the additional words "& Mercier, Geneva" did not avoid the prohibited resemblance to the plaintiff's mark since the defendant had used "Baume" which was the essential feature of the plaintiff's mark. The plaintiff has relied on another decision about a 100 pages down in the same volume by referring to the judgment reported at 1958 RPC 335 (*Cluett Peabody & Coy. Inc. v. McIntyre Hogg Marsh & Coy. Ltd.*). The matter concerned two device marks with the words "Arrow Brand" featuring in one and the word "Arrow" featuring in the other. The defendant used a device with a horizontal arrow above the written word "Arrow" and another device with an inclined Arrow above the written words "Arrow Brand." The court found at the trial that in either device mark of the plaintiff the words formed an essential feature thereof. It was in such context that the defendant was found to have infringed the plaintiff's marks since shirts of the plaintiff's manufacture bearing the two devices, according to the court, must have come to be known as "Arrow" and "Arrow Brand" shirts. The judgment is not central to the principal cause espoused by the plaintiff in the present case but would be material to the lesser cause of action as noticed later herein.

20. The plaintiff has also relied on a judgment reported at 1958 RPC 317 (*Parker-Knoll Ltd. and Parker-Knoll (Textiles) Ltd. v. Knoll International Britain (Furniture and Textiles) Ltd.*) where an interlocutory injunction was granted restraining the defendant from trading under the word "Knoll" since the plaintiff had traded under the name "Parker-Knoll" for several years. This judgment is one of the *Parker-Knoll v. Knoll* series that practitioners in this branch of law frequently cite. In the judgment reported at 1958 RPC 387 (*Harry Reynolds v. Laffeaty's Ltd., Dodwell & Coy. Ltd., and S. Guiterman & Coy. Ltd.*), the plaintiff complained of infringement of its mark "Aquamatic" for toy water pistols by the defendant's use of the mark "Watermatic" for a similar product. The decision is instructive in that it brings to the fore that the tests to be applied to different cases in this branch of law

would, despite the established underlying principles, depend on the perception as to the extent of resemblance or likely confusion. The court found in that case that the suffix "-matic" was common to the trade relating to toy pistols. The court, however, perceived "Watermatic" to be substantially similar to "Aquamatic" for the defendant's mark to be prohibited upon the plaintiff's registration of the "Aquamatic" mark. It is true that the sense that "Aqua" conveys the same sense that "Water" carries. Yet, if one mark had been "Aqua" and the mark complained of had been "Water", the second may not have been found to be offensive of the registered mark; it was upon "Aqua" carrying the "matic" suffix which was common to the trade and "Water" also carrying the same non-exclusive suffix that rendered the defendant's mark susceptible to the challenge.

21. Closer to the present times, the plaintiff relies on a judgment reported at 1995 FSR 713 (*Wagamama Ltd. v. City Centre Restaurants plc*). The plaintiff ran a none-too-exclusive eatery in London by the name of "Wagamama" that dished out Japanese fare. The claim was against the defendant's use of the mark "Rajamama" for their restaurant serving Indian cuisine in a comparable class of eating outlets. The defendant altered its name to "Raja's Mama." The court found that the causes of action of both infringement and passing-off had been established. The judgment leads to the other point that is of extreme importance in such matters. The geography of a place, the court's perception and the court's projection of the situation are key factors in such an action. "Rajamama" or "Raja's Mama" would scarcely excite an Indian court to injunct their use upon a complaint of the registered proprietor of "Wagamama." But that may be because of an Indian court's perception that a restaurant serving Japanese food and another servicing local Indian cuisine with such names would hardly deceive a prospective customer or cause any confusion. In a land to which both sets of cuisine are alien (never mind that chicken tikka masalla is now one of the most sought after dishes in England), the common suffix in both marks weighed with the court as it projected that the class of patrons likely to frequent the plaintiff's restaurant might associate the defendant's eating house with the plaintiff's.

22. The plaintiff has also carried a judgment reported at (1937) 54 RPC 341 (*Ravenhead Brick Co., Ltd. v. Ruabon Brick & Terra Cotta Co., Ltd.*) where the plaintiff's mark "Rus" in the business of manufacture of bricks entitled it to restrain the defendant from using the mark "Sanrus" in relation to the same product on the ground that it was likely to cause confusion in the building industry. In the judgment reported at reported at 1887 (4) RPC 530 (*The Sanitas Company, Limited, v. Condy*), the plaintiff coined the mark "Sanitas" in respect of deodorants, disinfectants and antiseptics. The registered mark consisted of a device of a eucalyptus tea surmounting the word "Sanitas." The word mark was registered in the same class and also for cattle medicine and other articles in another class. The defendant first used a word mark "Omnia Condisanitas" and later introduced a new disinfectant under the mark "Condisanitas." The trial court questioned the defendant's adoption

of the Latin word which had a nexus with the class of products and wondered why the defendant could not hit upon another word when the defendant had "not only the English language before him, but every language, living or dead, to choose" from.

23. The defendants refer to a recent decision reported at [Ramdev Food Products Pvt. Ltd. Vs. Arvindbhai Rambhai Patel and Others](#), and rely on paragraphs 92 and 93 where the Supreme Court acknowledged that the fundamental basis of the cause of action for passing-off is that the plaintiff must establish goodwill or reputation in the goods or services that it supplies such that it is recognised to be distinctive; that there is misrepresentation by the defendant that would lead the public to believe that the goods or services offered by the defendant are those of the plaintiff; and, the plaintiff has suffered damage or is likely to suffer damage by the erroneous belief engendered by the defendant's misrepresentation.

24. The defendants have relied on a judgment reported at (1990) 1 All ER 873 (Reckitt & Colman Products Ltd. v. Borden Inc) to show that no case of passing-off is made out by this plaintiff. The defendant says that for a valid cause of action for passing-off it is necessary that there is a misrepresentation; that such misrepresentation is made by a trader in course of trade; that it is made to prospective or ultimate consumers of goods or services supplied by such trader; that such misrepresentation is calculated to injure the business or goodwill of another trader; and, such action causes actual damage to the business or goodwill of a trader by whom the action is brought or, in a quia timet action, will probably do so. The ingredients of an action for passing-off are well recognised. It is an entirely different matter that the defendants fail by the tests that they cite.

25. The defendants finally remind of the salutary principles that are to be kept in mind at the interlocutory stage of such an action to assess a prima facie case and to balance the convenience of the parties. The following passage from paragraph 9 of the judgment reported at [Wander Ltd. and Another Vs. Antox India P. Ltd.](#), is placed:

9. Usually, the prayer for grant of an interlocutory injunction is at a stage when the existence of the legal right asserted by the plaintiff and its alleged violation are both contested and uncertain and remain uncertain till they are established at the trial on evidence. The court, at this stage acts on certain well settled principles of administration of this form of interlocutory remedy which is both temporary and discretionary. The object of the interlocutory injunction, it is stated

...is to protect the plaintiff against injury by violation of his rights for which he could not adequately be compensated in damages recoverable in the action if the uncertainty were resolved in his favour at the trial. The need for such protection must be weighed against the corresponding need of the defendant to be protected against injury resulting from his having been prevented from exercising his legal rights for which he could not be adequately compensated. The court must weigh

one need against another and determine where the "balance of convenience lies."

The interlocutory remedy is intended to preserve in status quo, the rights of parties which may appear on a prima facie. The court also, in restraining a defendant from exercising what he considers his legal right but what the plaintiff would like to be prevented, puts into the scales, as a relevant consideration whether the defendant has yet to commence his enterprise or whether he has already been doing so in which latter case considerations somewhat different from those that apply to case where the defendant is yet to commence his enterprise, are attracted.

26. The first two lines of defence canvassed by the defendants do not warrant any protracted engagement. It is not for a third party to question the right of an assignee of a registered mark where no apparent dispute between the assignor and assignee exists. Again, it is possible that at the trial of an infringement action the defendant may question the plaintiff's mark being on the register in the first place. There is serious doubt, of course, as to whether even that would be permissible; but it is not necessary to delve on such aspect at the interlocutory stage. For the moment, it is enough that the plaintiff's marks are on the register and that, by itself, is more than a prima facie acknowledgement of the plaintiff's exclusive rights in respect thereof. The defendants have, on their admission, applied for rectification of the register; in effect, for the plaintiff's name in respect of the subject marks to be erased therefrom. They have to await the result of such endeavour. At the interlocutory stage in an action for infringement, the fact that the plaintiff's mark is on the register would be sufficient for the plaintiff to claim exclusivity in respect thereof and insist on the benefits conferred by the statute therefore. The two grounds urged by the defendants, that there is a serious doubt whether the assignment in favour of the plaintiff was completed before the plaintiff clambered on to the register and that the plaintiff's approach to having its name recorded in the registry in respect of such marks was questionable, are of no relevance at the interlocutory stage of an infringement action. The further doubt that the defendants have attempted to cast on the plaintiff's statutory rights in respect of some of the marks, is of equal irrelevance. The documents that the defendants downloaded from the Trade Mark Registry on January 5, 2010 carry a disclaimer at the foot of each page. While dealing with such matter in its affidavit, the plaintiff has averred that it holds the relevant certificates in its name and is not responsible for the erroneous information available on the Registry's website. At the hearing the plaintiff has produced the original certificate in respect of each of the disputed marks. There is little merit in this argument of desperation put forth by the defendants.

27. The plaintiff is, indeed, entitled to the order of injunction that it seeks but on grounds that are somewhat more substantial than had been recognised at the ad-interim stage.

28. First, there needs to be a bit more clarity on the issues involved. In the plaintiff's excitement of pushing its case on the basis of several marks, the distinct features of four simultaneous causes of action appear to have been blurred. The plaintiff is the registered proprietor of a word mark. It has pleaded a cause of action for infringement and another for passing-off in respect of the registered word mark. The plaintiff is also the registered proprietor of several device or label marks. It has made out a cause of action for infringement and another for passing-off in respect of its registered device or label marks.

29. The get-up, packaging and label of the defendants do not imitate or resemble the plaintiff's, other than the word "Arati" being a part thereof. Apart from the depiction by the defendants of an earthen lamp (diya in Hindi) which is quite dissimilar in shape and form to the earthen lamps forming part of the plaintiff's labels, the get-up and packaging material of the defendants would not prompt an association with the plaintiff's label marks if the word "Arati" did not form a part thereof.

30. Since protection against infringement is a statutory right, however it may be understood in other jurisdictions, it is the statutory connotation of infringement that is of relevance. Section 29 of the present Trade Marks Act, in its general description of infringement, records that a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark. The identity or similarity of the registered mark with the mark complained against and the identity or similarity of the goods or services covered by the two marks are the essential keys to ascertain whether there is infringement. Where the marks are identical there is scarcely any difficulty in entering judgment for the plaintiff if the identity or similarity of the goods or services is established. If the two marks are not identical but the mark complained of is deceptively similar to the registered mark and the identity or similarity of the goods or services is established, there is infringement. A mark is deceptively similar to another, according to the statutory definition in Section 2(h) of the Act, if the mark so resembles the other as to be likely to deceive or cause confusion.

31. The expression "likely to deceive or cause confusion" does not imply that there has to be deceit attempted by the owner of the mark complained of; in other words, mens rea is not an essential ingredient in the adoption of the mark complained of. That is not to say that if there is dishonest intent that would be utterly irrelevant in an action for infringement. The assessment of the likelihood of deceit or confusion has to be made from the demand side perspective and not necessarily from the supply side; if the owner of the mark is regarded to be on the supply side and clients or prospective clients are considered to be on the demand side. The expression

"likely to deceive or cause confusion" has more to do with whether a prospective purchaser of goods or services would be deceived or confused in opting for the goods or services offered by a trader on the mistaken impression that are of, or are associated with, another trader.

32. An honest adoption of a mark by a trader may also result in it being deceptively similar to a registered mark and susceptible to an injunction without there being the remotest intent on the part of the trader to deceive or to trade upon the goodwill or reputation of another or another's product or services.

33. The word "Sandhya" is the longer word in the defendants' mark "Sandhya Arati", yet it is "Arati" which is the essential part thereof. There cannot be any uniform rule that the first word or the middle word or the last word of a multiple- word mark would always be its most prominent attribute. Some of the authorities that the plaintiff has brought would support this view. It is essentially a test by perception and a projection as to whether the mark complained of is likely to deceive or cause confusion. It has to be assessed through the eyes and ears of the prospective user of the goods or services; where the Judge has to place himself in the position of a prospective customer and assess whether he would then be likely to be deceived or confused. If, in addition, there is dishonest intent on the part of the owner of the mark complained of, it makes it easier for the claimant in the action to get his protection; but it is not necessary that must be so established.

34. "Arati" to the Indian psyche is the performance of a ritual in obeisance, generally to a god or goddess. "Sandhya", in a number of Indian languages, implies dusk or early evening. Though the ritual of "Arati" may be said to be more commonly performed in the evening, thus implying that "Sandhya Arati" is not much different from "Arati," but that may not be attributed as the principal similarity between the two word marks. But "Sandhya" is, in the mark "Sandhya Arati", a form of an adjective describing "Arati" and the focus of the "Sandhya Arati" mark is on "Arati." When a part of the plaintiff's exclusive word mark in the same class of goods is incorporated in the defendants' mark it is for the defendants to establish that their use of one or more words in addition to the plaintiff's word mark would remove the defendants' mark from the prohibited umbra of what is deceptively similar. These defendants, prima facie, have not been able to discharge such onus. In any event, given that these defendants were obviously aware of the plaintiff's mark it would have been even more difficult for these defendants get away with the "Sandhya Arati" mark. Prima facie, the defendants' use of "Sandhya Arati" infringes the plaintiff's mark "Arati" and also amounts to passing-off and an injunction should follow.

35. The defendants have not been able to establish, on the basis of the material relied on, that their use of the "Sandhya Arati" mark was prior to the plaintiff's adoption of the "Arati" mark. The nature of goods covered by the offending mark is the same as the plaintiff's. The defendants have not been able to detract from the

plaintiff's claim that its products sold under its "Arati" mark have wide acceptability. The sales figures relied upon by the plaintiff are impressive.

36. In view of it being found that the defendants' use of the word mark "Sandhya Arati" infringes the plaintiff's rights in respect of its "Arati" mark, it is not necessary to consider the lesser case, whether of infringement or of passing off, that has been brought by the plaintiff on the basis of its registered device or label marks. Though "Arati" appears to be the prominent feature of all of the plaintiff's label marks, the registration in the word mark itself confers a statutory right to the plaintiff which has, prima facie, been accepted. The order of injunction that the plaintiff ought to obtain against the defendants "Sandhya Arati" mark would not permit the defendants use of "Arati" as part of their marks and, consequently, it is irrelevant to consider the case of infringement and passing-off on the basis of the plaintiff's label marks.

37. There will be an order of injunction restraining the defendants whether by themselves or by their servants or agents or assigns or otherwise howsoever from using the "Sandhya Arati" mark or any other mark incorporating the word "Arati" in relation to edible oil in any manner whatsoever.

38. GA No. 2662 of 2008 is allowed as above. In view of such order in favour of the plaintiff, the defendants' vacating application, GA No. 263 of 2010, fails and is dismissed. The defendants will pay costs assessed at 1000 GM to the plaintiff.

39. Urgent certified photocopies of this judgment, if applied for, be supplied to the parties subject to compliance with all requisite formalities.

Later:

40. The defendants seek a stay of the operation of the order which is declined.