

Balsara Hygiene Products Limited Vs Arun Chowdhury and Another

Court: Calcutta High Court

Date of Decision: Nov. 14, 2002

Citation: (2003) 3 CALLT 100 : (2005) 1 CHN 586 : (2005) 30 PTC 272

Hon'ble Judges: Kalyan Jyoti Sengupta, J

Bench: Single Bench

Advocate: Goutam Chakravarti, R.K. Khanna and S.N. Mookherjee, for the Appellant; Pratap Chatterjee and R. Bachawat, for the Respondent

Judgement

Kalyan Jyoti Sengupta, J.

The plaintiff is the owner of the registered trade marks "Odonil", "Odopic", "Odomos" both label and word

under the common Classes-5, 3, 9, 11, 21, and it has also applied for further registration between the years 1985 and 2001, for the word "Odo".

This action has been taken against infringement and passing off by the defendant who uses the name and mark "Odoja" in their products which are

under same class. With the word "Odo" the plaintiff claims that the aforesaid registrations were effected at different point of time ranging from 24th

August, 1962 to 26th February, 1990. Admittedly the defendant's mark is not a registered one and it has merely applied for registration of its

mark on or about 27th of March, 2000. The plaintiff claims, that it was the first in using of the word "Odo" in its trademarks for commercial

purpose.

2. The defendant in his affidavit in opposition has taken defence that the word "Odo" is a generic term and used by all the traders as such it has

become common to the trade. The mark used by the defendant has been made known to the public for a long time and in fact the plaintiff has also

noticed the same. The plaintiff cannot claim any monopoly over the word "Odo". The application for registration of the plaintiff of the word "Odo"

is still pending.

3. Mr. Chakraborty, senior advocate, appearing for the plaintiff submits, under the provision of the Trade and Merchandise Mark Act, 1958 his

client is entitled to get protection against the aforesaid infringement done by the defendant using the prefix of the aforesaid registered marks. The

adoption of the mark "Odoja" by the defendant is motivated and is calculated to deceive the consumer in respect of the same product, as the

product of the plaintiff.

4. Confusion in the mind of the consumer public is naturally bound to arise by reason of the fact that both the marks are used for the same product.

He contends that defence for the use of the word "Odo" put forward by the defendant is not acceptable under the law and the same appears to be

illogical and absurd. His contention is that the word "Odo" as abbreviated is a generic word and common to the trade is not correct. "Odour" is

not a generic term and according to the Oxford Dictionary, it means smell or scent. There is no proof of sale in India of West Bengal of the

defendant's product. It has merely proposed to start the use of the word "Odoja" and no concrete instances has been given that any of the

manufacturers has got registration of or has been using any mark with the word "Odo" in order to establish the case of commonness. He contends

further that although the origin of the word "Odo" may be "odour" yet the petitioner is entitled to use part of an English word as an essential feature

of its mark. Mere distinction and/or differentiation in the get up of the defendant's product and the plaintiff's product do not establish any

dissimilarity of the registered trademark. The whole point is whether the defendant is entitled to use the word "Odo" along with the suffix "ja" as its

mark. On this point he has drawn my attention to the passage of Kerly's Trade Mark, 12th Edition, Articles 14-21 and 14-22 at page 273 and

274. According to Mr. Chakraborty a mark is infringed by another trader even without using the whole of it, if he uses one or more of its essential

features. The identification of an essential feature depends on the Court's own judgment and partly on the burden of the defence placed before it.

He has further drawn my attention on this point to the passage of the Kerley's Trade Mark, 13th Edition at page 603 being Articles 16-38 and

16-39. Thus the defendant has adopted the essential feature of the trademark of the plaintiff. In support of his contention he has relied on a

decision reported in Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, .

5. His next contention is that since the year 1962 the plaintiff has been using the word "Odo" as essential feature in respect of its marks registered

and of pending applications, both in India and abroad. The respondents is well aware of this fact and has used the word "Odo" along with suffix

"ja", only to exploit illegally the goodwill and reputation of the plaintiff. He submits that undisputedly the plaintiff has huge sale of its product in India

and only a small quantity of the defendant product was sent to Nepal. He submits further that no evidence has been shown that the aforesaid word

is a common to trade and the documents, which have been annexed to the affidavit in opposition, do not prove that any other trader is using the

aforesaid word "Odo". On the contrary it will appear from the documents annexed to the affidavit in opposition that the same are proposed to be

used. So far as the question of delay in filing the suit is concerned, it is not a factor in case of passing an order of injunction as the plaintiff is the

registered owner or user of the aforesaid mark.

6. Mr. Pratap Chatterjee, learned senior counsel appearing with Mr. R. Bachawat, learned advocate submits that to the notice and knowledge of

the plaintiff the defendant No. 1 has been using its mark "Odoja" for its various products and as such applications for registration thereof have

been made and the said application are still pending. Moreover, various advertisements have been issued and hoardings have been put up and thus

public notice has been given for the defendant's use of the said mark "Odoja". In spite of such knowledge the plaintiff has not taken any action and

this action has been brought all of a sudden in the year 2001. The product of the defendant No. 1 under the aforesaid trade name "Odoja" has

become popular gradually and in short span of time the turnover of the defendant No. 1 product has reached up to Rs. 30 lacs. His contention is

that there is no deceptive similarity between the plaintiff's mark "Odonil" and defendants' mark "Odoja". In common sense either phonetically,

visually or structurally, both the marks are different from each other. The two suffixes "nil" and "ja" are different in sound, meaning and look. The

packets and the labels of the plaintiff and the defendants are wholly different. The plaintiff does not have any registration of the use of the word

"Odo". The word "Odonil" is a combination of the words "Odo" and "nil". Both the words are having common origin of English word "odo" and

over which no monopoly can be claimed. The prefix "Odo" cannot be distinctive of the plaintiff's mark as being common to the trade. The plaintiff

has in the past been refused injunction against use of "Odojanapses" by the defendant. Moreover, the plaintiff has already assessed damages of Rs.

20 lacs in lieu of order of injunction. Therefore, injunction should be vacated. In support of his contention he has relied on decisions reported in

1996 PTC 501 and 2001 PTC 601 in connection with dissimilarities of the two marks. He has relied on para 17.30 of the Law of Trade Marks

and Passing of by Narayanan. (5th Edition at page 236 and 237) which in its turn has quoted the decisions reported in 1995 PTC Rahim v. Arvind

Laboratories, On the question of different and dissimilar packets and label in case of passing of action he has relied on a decision of the Supreme

Court reported in Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co., . On the question of monopoly claim over a common English

word or generic word the following decisions have been relied on by Mr. Chatterjee (1996 PTC 124: 1998 PTC 667: 2002 PTC 141).

7. He contends further that in case of this nature it is settled position of law and the balance of convenience requires status quo be maintained

meaning thereby factually it is a running business then such business should not be disturbed. In support of his contention he has relied on the

following judgment 1990 SCC 727 Wonder v. Anotx, 1990(7) SCC page 1 paragraph 24 and 1998 PTC 667.

8. It is an admitted position that the word "Odo" is not a registered one and only application therefore has been made. Therefore, question of

infringement does not arise only passing of action may be maintained. There are distinctive features in both the products of the parties which

sufficiently distinguish one from another. As such question of deception and/or confusion does not and cannot arise. Test of similarity and

dissimilarity in case of passing of action is also the same as In that of infringement action.

9. Having heard the respective contention of the learned counsels in this matter sole question is as to whether the defendant has been able to make

out such a case for which interim order of Injunction already passed should be vacated or not.

10. Justice Bhaskar Bhattacharjee at the ad interim stage was pleased to grant an order of injunction, having satisfied with the strong prima facie

case having been made out and an appeal was taken against this order. However, the appeal Court did not interfere with the same and was

pleased to pass an order wishing that this application itself should be heard on affidavit as expeditiously as possible.

11. Having considered the material placed before me, it emerges a few admitted positions. The entire word "Odonil" or other associated words

namely "Odomos", "Odoplc" are registered one. Whereas the mark of the defendants "Odoja" Is not a registered one, only application for

registration thereof is pending. Similarly, the plaintiff's application for registration of the words "Od*" is pending. So I make it clear that any

observation and decision on this point in this Judgment will have no bearing or binding effect upon either of the two applications.

From the rival contentions the issues are as follows:

i. Whether the word "Odo" by itself Is common English word or any generic term, or not.

ii. Whether the plaintiff's mark "Odo" is an abbreviated term of the English word or not.

iii. Whether the word "Odo" has become anything common to trade or for that matter whether the plaintiff has got any distinctive in its mark

opposite to descriptive or not.

12. The contention of Mr. Chatterjee is that the word "Odo" is an abbreviated word of a generic term or abbreviated common English word. In

the Oxford Dictionary the word "Odo" is not to be found as common English word nor it is a part of a common generic term. An English word

whether in abbreviated or in full form is called common, when it is known to or used by every one. For instance expression of the word "Indo" is

understood by all over world as being abbreviated form of word "India". Unless this character of universality is assumed, one cannot call it as

common word. So it is adoption and/or coinage of the plaintiff of the word "Odo" for its mark. Nothing has been shown by Mr. Chatterjee that

this word "Odo" is a part of a common generic term.

13. Mr. Chakraborty is right in saying that it may be part of the English word "odour" but then it is not commonly used or known to public at large.

It is now part of the registered mark "Odonil" "Odomos" and "Odopic". So I hold that "Odo" may be a part of the English common word and it

has been coined and being exclusively used by the plaintiff as a part of its product. The plaintiff has been manufacturing and marketing various

products and preparations which include the products for repelling mosquito and other insects, purification and refreshing of air, electrical and

heating apparatus, traps for insects, and preparations and products for bleaching, cleaning toiletries and sanitary preparations. Therefore, the word

"Odo" is associated with the product being manufactured by the plaintiff. For several decades as it appears prima facie from the petition, the

aforesaid products are being used and marketed with the registered trademark. Admittedly, the word "Odo" is part of the registered trademark of

the combined marks of the "Odonil" and "Odopic". Now under the law whether there can be any infringement of any part of any registered mark

or not. In a fairly old decision of the Supreme Court reported in Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, in

paragraph 29, it was held amongst other by the Apex Court that:

If the essential features to the trademark of the plaintiff have been adopted by the defendant, the fact and the get up, packing and other writing or

marks on the goods or on the packets in which he offers his goods for sale so mark differences, or in fact clearly a trade origin different from that

of registered propriety of the mark would be immaterial.

14. As it has been rightly argued by Mr. Chakraborty that infringement may be as a whole or in part. It appears from a passage of Kerly's Trade

Marks and Trade Names 12th Edition as follows:

A mark is infringed by another trader if, even without using the whole of it, he uses one or more of its essential features. The identification of an

essential feature depends partly on the Court's own judgment and partly on the burden of the evidence that is placed before it. Ascertainment of an

essential feature is not to be ocular test alone; it is impossible to exclude consideration of the sound of words forming part of the whole of the

mark. Thus, if a word forming part of a mark has come in trade to be used to identify the goods of the owner of the mark, it is an infringement of

the mark itself to use that word as the mark, or part of the mark, of another trader.

15. I have no hesitation in observing that the word "Odo" as adopted by the defendants is part of the registered mark of the plaintiff as such

"Odonil", "Odopic" and "Odomos". Over the long years the word "Odo" have become associated with the product of the plaintiff and certainly

acquired goodwill in the market and that is apparent from the gross turn over of the plaintiff's product in marketing. In my view, that word "Odoja"

is likely to arise in the mind of the consumer as the associated product of the plaintiff, as the plaintiff has been using the various trade names with

the word "Odo" for its various products in same class. The actual proof of confusion in this case can possibly not to be adduced as the defendant

No. 1 has not been able to establish before this Court it has started selling product in India, only a small quantity has been sent to Nepal only.

16. I am unable to accept the contention of Mr. Chatterjee that the injunction should be vacated on the plea that in various cases injunction was

refused as the common English word was adopted by both the parties. The cases cited by Mr. Chatterjee are clearly distinguishable. The legal

principle that a party cannot have any monopoly right over a generic word is not disputed. In this case no generic word has been used by the

plaintiff, may be a part of the English word is being used but then it is a part of the registered trademark. In the case reported in 1996 PTC 501

paragraphs 14 and 15 it appears clearly therefrom the words were adopted from common English words and in that case the plaintiff's mark was

not a registered one. Similarly, in the case reported in 2001 PTC 601 it was found that the prefix in both the marks were derived from the common

generic word "Lipid". Here no such case made out nor do I find that any common generic word has been used, as I have already observed.

17. As far as the question of delay is concerned, in my view, there is no delay as such, since the defendant No. 1 has not started selling product in

India, they have expressed their willingness to sell the same using the aforesaid mark "Odoja". In case of consumer goods, opposite to medical

product, actual sale to the consumer either in its own name or otherwise the product has to be marketed and it has to be established the product

had been sold. So when there is no sale of the product of the defendant No. 1 question of delay and suffering loss and damages does not arise. As

far as claim for compensation is concerned, in my view, prima facie, at this stage the case for claim for compensation is not established, rather

prima facie case for relief for injunction has been established so relief needs to be granted accordingly, as such delay is not applicable in this case.

18. While considering the balance of convenience I am of the view that the defendant No. 1 has not started selling its product in India question of

suffering loss of business of the defendants does not and cannot arise. The decision cited by Mr. Chatterjee on the question of balance of

convenience is not disputed but on the facts and circumstances of this case as discussed above these are distinguishable, so inapplicable.

19. Hence I hold that defendants have not been able to establish any case or put up any defence for which order of injunction should be vacated.

Accordingly, interim order of injunction, which has already been passed stands confirmed and continue till the disposal of the suit. However,

hearing of the suit is expedited if the written statement is not filed the same shall be filed within 4 weeks from the date provided the writ of

summons having been served. If the writ of summons has not been served, the same may be served upon the advocate on record of the

defendants. Then written statement may be filed within four weeks thereafter.

There will be cross order for discovery within fortnight after filing of the written statement. Inspection forthwith thereafter.