

(2006) 08 CAL CK 0041

Calcutta High Court

Case No: G.A. No. 2257 of 2005 and C.S. No. 177 of 2005

Revlon Manufacturing Limited

APPELLANT

Vs

K.V. International and Others

RESPONDENT

Date of Decision: Aug. 11, 2006

Acts Referred:

- Civil Procedure Code, 1908 (CPC) - Order 11 Rule 15
- Stamp Act, 1899 - Article 62, 17, 18
- Trade Marks Act, 1999 - Section 29, 44

Citation: (2007) 1 CALLT 236

Hon'ble Judges: Kalyan Jyoti Sengupta, J

Bench: Single Bench

Judgement

Kalyan Jyoti Sengupta, J.

The suit above relates to action for infringement and Passing Off of the mark "Charlie" proprietorship of which is claimed by the plaintiff against the defendants. The aforesaid interlocutory application has been taken out by the plaintiff. At the ad interim stage this Court on prima facie satisfaction passed an order in terms of prayers (a) to (c) of the Notice of Motion. Upon hearing both the parties on 27th July, 2005 the Receiver has been appointed with direction to visit the office of the respondent No. 1 and also any other place, shops and godowns where the finished products were available and to submit a report to this Court. Since the said interim order is continuing, now question of vacation of the same has arisen upon reading of the affidavit of the respondent No. 1. The short fact of the case as made out in the petition on which the aforesaid interim order was passed is briefly set out hereunder:

The petitioner/plaintiff is a world leader in cosmetics, fragrance, skin care and personal care products. The petitioner's trade mark Revlon and Charlie have global brand recognition. In 1972 the petitioner introduced the Charlie fragrance. The

petitioner is the registered proprietor of the trade mark "Charlie" and its variations and has registrations throughout the world. The petitioner's trade mark Charlie has acquired transborder reputation, goodwill and commands immense international sales. Pursuant to a deed of assignment dated 29th December, 1993 between the Revlon(Suisee) S.A., the predecessor-in interest of the petitioner and the petitioner several registered trade marks including the trade mark "Charlie" were assigned to the petitioner. By reason of the aforesaid the petitioner is the present proprietor of the trade mark Charlie and its variants. In fact registration certificates for the mark Charlie after 1993 {hereinafter referred to as the assignment) are in the name of the petitioner. The proprietary interest of the petitioner in the said mark has in fact been recognized by the Delhi High Court when the petitioner had filed a suit being No. 2090 of 1997 an order dated 13th October, 1997 was passed by the said Court thereby the respondents were restrained from using the trade mark Revlon and Charlie or any other deceptively similar mark in respect of cosmetics and other goods. The respondent subsequently approached the petitioner to settle the matter on 19th April, 2001 the matter was decreed in terms of the settlement executed by the petitioner and the respondent.

2. From a survey conducted by the petitioner in Calcutta in January 2005 it was revealed that despite the decree passed in the suit filed in Delhi Court the respondents are continuing to infringe and/or pass off the petitioner's registered trade mark "Charlie" under a different name.

3. The defendant No. 1 has filed affidavit-in-opposition affirmed by one Mrs. Rachna Virmani who is the proprietress of the defendant No. 1 is no way connected with the product of the defendant No. 1. The respondent No. 1 basically disputed all the material allegations made in the petition. It is stated in the affidavit in opposition that no copy of the deed of assignment has been produced though the respondent No. 1 through her learned Advocate demanded for supply of a copy of the deed of assignment has been shown on October 14, 2005. In spite of request neither the deed of assignment nor any copy thereof has been furnished to the respondent No. 1 or her Advocate. As such the plaintiff/petitioner has failed to prove that it is the registered proprietor of the mark "Charlie".

4. Mr. Sudipta Sarkar, Senior Advocate, appearing on behalf of the plaintiff/petitioner, while highlighting the facts stated in the petition and also affidavit in reply and placing the annexure thereof submits that the petitioner is admittedly registered proprietor of the mark "Charlie" as well as prior user of the mark both in the world market and in India. The petitioner also enjoys substantial transborder reputation, the respondents are admittedly using the main mark "Charlie" which is deceptively similar to the trade mark of the petitioner and have given no reason why the main mark which visually, phonetically and structurally similar to the petitioner's mark was adopted/used by them. In view of the aforesaid admitted factual position protection u/s 29 of the Trade Marks Act 1999 is available

to the plaintiff/petitioner.

5. He contends further that plea of limitation taken by the respondent No. 1 is not tenable and also the other lacuna which is in the nature of procedural law is inapplicable. In the affidavit in reply the deed of assignment has been annexed. According to him no stamping is required for such deed of assignment under the provision of Section 44 of the Trade Mark Act. Moreover the alleged plea of non production and non supply of the document taken by the respondent No. 1 is not required to be looked into by the Court at the interlocutory stage and this maybe necessary at the time of the trial. In support of his submission he has relied on the decision of the Privy Council reported in AIR 1916 PC 217 and [P. Balakrishna Reddy Vs. The Accommodation Controller, Madras](#),

6. He therefore, concludes that the plaintiff has been able to make out strong prima facie case to maintain interim order already passed and the same may be made absolute and allowed to continue till the disposal of the suit.

7. Mr. P.K. Ghosh learned Senior Advocate while placing his client's affidavit* in opposition contends that the plaintiff has not been able to establish and/or substantiate with documentary evidence its claim of registered ownership of the mark. Documents issued by trade mark registry annexed to the petition and plaint, do not show the Trade Mark No. 369145 has been registered in the name of the plaintiff/petitioner, no registration of other mark has been annexed. In the affidavit in reply the petitioner has annexed number of documents issued by trade mark registry. Save and except one document there is no mention of the name of the plaintiff/petitioner in other document. The document at page 66 relates to Trade Mark No. 667245 in the name of the petitioner but the mark registered is "Charlie Red". The said registration was from 26th May, 1995 and this has expired on 26th May 2002. In the premises there is no document to show that the petitioner's mark is registered one or the trade Mark "Charlie" has been duly registered in India.

8. Then he contends that the case of the plaintiff is absolutely self-contradictory as on the one hand it is claimed that plaintiff is the registered owner of the mark, on the other hand it is claimed by deed of assignment dated 29th December 1993 the plaintiff has become registered proprietor of the mark. Therefore, it is not clear as to why a deed of assignment was at all required, particularly when the petitioner claims to be registered proprietor of the mark "Charlie" In India since beginning. The deed of assignment of the petitioner is not registered in the Trade Mark Registry. He further contends that the petitioner should not be permitted to rely on the deed of assignment as under the provisions of Order 11 Rule 15 of the CPC when in spite of request documents referred to in the pleadings or affidavits were not produced for inspection. Pleading means and includes plaint and written statement. This legal provision applies not only at the time of hearing of the suit but also at the interim stage. He seeks reliance for this proposition of law on three authorities namely [A. Giridharilal Vs. State of Tamil Nadu and Others](#), , [Ravindra Bal](#)

9. He says that the deed of assignment is also invalid because of non compliance of the provision of Stamp Act 1899. u/s 17 of this Act all instruments chargeable with duty must be stamped before or at the time of execution. The petitioner has to establish that the deed of assignment comes within Section 18 of the said Act in order to rely on the same. The schedule to the deed of assignment having contained particulars of mark has not been signed. An assignment of a trade mark is made always for consideration and it therefore, attracts the provisions of Stamp Act. He relies on the Article 62 of the Stamp Act in this respect.

10. He urges even assuming assignment of trade mark is otherwise valid, it can not be looked into as evidence by reason of the fact that assignment has not been registered with the Registrar of Trade Marks. Even the deed of assignment has not been included in the list of documents relied on by the plaintiff as annexed to the plaint. At no stage the plaintiff can rely on the deed of assignment. In this context he refers to a decision of Privy Council reported in AIR 1916 PC 217 .

11. I have heard a lot of argument made by both the sides on the question of law substantially and also fact partially. I find the argument advanced by Mr. Ghosh on fact do not find place in the affidavit. No affidavit-in-opposition has been filed by any of the defendants except the first defendant, the sole proprietor, Smt. Rachna Virmani. This lady has disclosed that she is the wife of respondent No. 3. Therefore, the statements and submissions made on the factual aspect by the petitioner are deemed to have been admitted by the other defendants. Accordingly, I think order of injunction already passed as against them shall be and is hereby confirmed unhesitatingly. The respondent No. 1 in the affidavit-in-opposition has taken specific stand in paragraph 18 that she had or has not indulged in using the trademark "Charlie". There was or is or will be no question of exploitation of the reputation and goodwill of the petitioner. It is further specifically stated in paragraph 18 of the affidavit "I assert that since I have not or had not used the trademark "Charlie" or any deceptive mark there is no question of exploitation of the goodwill and reputation of the petitioner". In paragraph 21 of the affidavit-in-opposition it has been further stated by the said deponent that she did and does not operate any business bearing the trademark "Charlie".

12. When on fact this stand has been taken I do not think interim order of injunction granted by this Court will affect or harm the defendant No. 1.

13. Therefore, the interim order of injunction granted earlier stands confirmed.

14. However, when an argument has been advanced by the learned Counsel taking note of the statements and averrments of the documents annexed to the petition as well as in affidavit-in-reply which has got the implication on law, I think this should be dealt with accordingly. It is alleged in the plaint that the defendants and respondents have been using the mark "Cherlie" in connection with the same

product which is phonetically similar and colourably imitative of the plaintiff's registered mark "Charlie". Prima facie, I think that these two marks are phonetically similar and confusing. Though the spelling of the two words are different but any customer of this product hardly takes note of this difference in the spelling. Mr. Ghosh, appearing for the defendant No. 1, in his argument, questioned and further raised doubt as to whether the plaintiff is the owner or user of the mark "Charlie". In this context I have carefully examined all the documents annexed both to the petition and affidavit-in-reply, I have found that the petitioner is having registration in relation to the said mark not only in India but also in a number of other countries in the world. The petitioner has been able to establish prima facie that it has considerably good market in India.

15. The respondents have no registration at all. From the document filed and submitted, I have no doubt in my mind prima facie that the plaintiff/petitioner is the registered owner by virtue of assignment. A great deal of question has been raised regarding legality and validity of assignment, but these are matter of trial. For the time being if question of assignment as raised by Mr. Ghosh is assumed to be correct, still on the strength of the registration granted by the Trade mark Registry, the plaintiff/petitioner has protectable right and interest. Some confusion is sought to be raised regarding registration of assignment but I do not think this does in any way help the cause of the respondents at this stage.

16. The decisions cited by Mr. Ghosh in support of this case and legal submission made by him do not have any factual foundation in view of the stand taken in the affidavit-in-opposition.

17. But Court must be satisfied prima facie that the plaintiff has been able to make out a case for continuation of interim order of injunction which has already been passed.

18. I am satisfied prima facie that the plaintiff has been able to make out a case and prove user of the cosmetic product with the trademark "Charlie", whereas use by the defendants of the mark does not and cannot arise in view of the categorical statement made by her. Accordingly, the plaintiff has been able successfully to retain order of injunction already passed. Therefore, it is confirmed, however, the Receiver appointed by this Court is discharged.