

(2005) 08 CAL CK 0044

Calcutta High Court

Case No: G.A. No. 839 of 2005, A.P.O.T. No. 158 of 2005, A.P.O. No. 147 of 2005 and C.S.
No. 138 of 2004

Prakash Glass and Rubber Works
and Another

APPELLANT

Vs

Hindustan Safety Glass Works
Private Limited and AnotherRESPONDENT

Date of Decision: Aug. 5, 2005**Acts Referred:**

- Civil Procedure Code, 1908 (CPC) - Order 39 Rule 1, Order 39 Rule 2
- Trade and Merchandise Marks Act, 1958 - Section 27(2), 28(1), 31, 33, 34

Citation: (2006) 2 CHN 555 : (2007) 34 PTC 267**Hon'ble Judges:** Pravendu Narayan Sinha, J; Pinaki Chandra Ghose, J**Bench:** Division Bench**Final Decision:** Dismissed

Judgement

Pinaki Chandra Ghose, J.

This appeal directs against an order of the Hon'ble First Court dated December 23, 2004 whereby on an application of the respondent under Order 39 Rules 1 & 2 of the CPC (hereinafter referred to as the CPC) the Hon'ble First Court was pleased to grant, an order of injunction in favour of the respondent. The prayers made in the said application of the respondent are as follows:

(a) An order of injunction restraining the respondent by themselves or through their agents, servants and/or assigns from in any way manufacturing marketing or selling any glass products or laminated or toughened glass under the impugned trade mark or trade name "SAFEX FLOAT or using the mark "SAFEX" or any other mark which is deceptively similar to the registered trade mark of the petitioner or suing the essential and/or salient feature of the petitioner's mark namely "SAFEX" in respect of toughened and/or laminated glass.

(b) An order of injunction restraining the respondent by themselves or through their agents or servants and/or assigns from in any way passing off goods bearing the impugned mark or trade name "SAFEX" or "SAFEX FLOAT" or using any other deceptively similar mark or trade name resembling the registered trade mark of the petitioner in respect of glass including toughened and laminated glass which is calculated to deceive or likely to deceive and confuse members of the trade and consuming public to believe that the impugned product of the respondent is a product of the petitioner or that the petitioner is connected to and/or associated or related therewith.

(c) An order of injunction restraining the respondent, their servants, agents and/or assigns from in any manner infringing the petitioner's registered trade Mark No. 463502 or using any mark deceptively similar thereto in respect of any glass product.

2. Facts revealed in this application that respondent is a Private Limited Company and one of the oldest glass manufacturers in India and is engaged in the business of manufacturing and sale of Laminated Safety Glass Sheet, Toughened Safety Glass, Penguin Pane Insulated Glass, Twin Bird and Golden Fish Mirrors, Safety Bullet Resistant Glass and also other types of glass used in vehicles, petrol pumps and offices. The said laminated and toughened glass is sold by the respondent both within and outside the jurisdiction of this Hon'ble Court and under the mark "SAFEX". The respondent enjoys goodwill and reputation all over India.

3. Since 1954 one Mr. D.N. Agarwal along with his family members formed a partnership firm in the name and style of D.N. Agarwal & Sons and started selling the aforesaid variety of glass in different parties of India using the said mark "SAFEX". The said partnership business was converted into a company on or about 27th May, 1958 and was duly incorporated in the name of Hindusthan Safety Glass Works (Pvt.) Limited under the Companies Act, 1956 and was duly took over all the rights and liabilities including the said trade mark "SAFEX" which was sold all over India by the said partnership firm.

4. In or about 1959 respondent appointed one Agency as its sole selling agent for promoting the sale of its glass including the glass bearing the mark "SAFEX". Thereafter, respondent applied before the Indian Standard Institute for the use of "Standard Mark" and licence was issued. Respondents applied on or about 24th November, 1986 under the Trade & Merchandise Marks Act, 1958 (hereinafter referred to as the said Act) for registration of its mark "Safex Laminated Safety Sheet" and "Safex Toughened Safety Sheet" which was duly registered in Class 19 under registration No. 463502.

5. Respondent had been extensively and continuously using the said trade mark "SAFEX" in respect of its goods prior to 1958 and since 1958 respondent had been and still is using and selling the said glass under the aforesaid trade mark "SAFEX".

Respondent appointed the appellant/petitioner herein in or about March, 2000 as its dealer to sell laminated and toughened glass bearing the registered trade mark "SAFEX" in the State of Andhra Pradesh. In or about June, 2003 respondent for the first time came to learn that the appellant/petitioner was wrongfully and illegally selling similar laminated and toughened glass under the purported mark "SAFEX FLOAT". The wrongful use of the word "SAFEX" in association with the word "float" by the appellant/petitioner amounts to an infringement of the respondent's registered mark "safex" in relation to laminated and toughened glass. The glass sold by the petitioner/appellant bearing the essential feature of the petitioner's mark namely the word "SAFEX".

6. Case of the respondent before the Hon"ble First Court that the petitioner/appellant herein had wrongfully and illegally used the said trade mark "SAFEX" with an intention of trading upon and utilizing the goodwill and reputation of the respondent and further to convey to the public at large that the petitioner/appellant was connected and/or associated with the goods of the respondent and further the sole intention of the petitioner/appellant deceive the public into believing that the same are the products of the respondent. Respondent through its Advocate called upon the petitioner to cease and desist from using the impugned mark "SAFEX FLOAT" and the appellant/petitioner challenged the said right of the respondent to use the said trade mark.

7. Further case of the respondent that the appellant/petitioner using the mark "SAFEX" is a colorable and wrongful imitation of the well-known mark "SAFEX" of the respondent. The said word "SAFEX" is the essential feature and/or character of the respondent's laminated and toughened glass. The appellant/petitioner is using the said mark "SAFEX" with an intention to deceive the public and is deceiving the public and the trade, both within and outside the aforesaid jurisdiction of this Hon"ble Court.

8. The appellant/petitioner tried to make out a case before the Hon"ble First Court as well as before us that the respondent's trade mark is confined to Class 19 of the Fourth Schedule of the Trade and Merchandise Marks Rules, 1959 (hereinafter referred to as the said rules) whereas the petitioner/appellant applied for registration of the mark "SAFEX FLOAT" and "SAFEX TUF" in Class 12 of the said Schedule. Further case of the petitioner/appellant that the petitioner deals with the windscreen (both front and rear) and door glass of the automobiles and sells the same in a finished form in the replacement market and not to the automobile manufacturers. Furthermore, the said mark of the appellant/petitioner "SAFEX FLOAT" and "SAFEX TUF" is in conjunction with an emblem.

9. Mr. Ajoy Kumar Gupta, learned Senior Advocate appearing on behalf of the petitioner/appellant contended that the Hon"ble First Court has failed to appreciate that the registration of the respondent's mark was in Class 19 of the Fourth Schedule which is confined and limited to building and construction materials only

and further appellant/petitioner was selling its products under the mark "SAFEX FLOAT" in conjunction with an emblem of the appellant/petitioner, which was distinctive in character and further the appellant/petitioner deals with the replacement mark whereas the respondent deals with the automobile industries. Hence, there cannot be any chance of deceiving the public at large. He further submitted that the appellant/petitioner manufactures windscreen glasses and door glasses in a finished form and not in sheet form and further the appellant/petitioner applied for registration of its marks "SAFETY FLOAT" and "SAFETY TUF" in Class 12 of the said rules. Hence, he submitted that in the facts and circumstances of this case there was and could be no question of deception or confusion or passing off as alleged by the respondent. He further submitted that the marks of the respondent and as of the appellant/petitioner were dissimilar and distinctive which escaped the notice of the Hon"ble first Court. In these circumstances, he submitted that there was and could no deception or damage or injury to the respondent in any manner whatsoever. He further relied upon the decisions reported in [Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co.,](#) and [Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.,](#) in support of his such contention.

10. He further relied upon a decision reported in 1996 (16) PTC 476, N.R. Dongre v. Whirlpool Corporation and submitted that according to Section 28(1) of the said Act registration of a trade mark gives a right to the registered proprietor thereof to use the same exclusively in relation to goods in respect of which it has been registered. Therefore, according to him, right created in favour of the registered proprietor of a trade mark is not an absolute right and is subservient to other provisions of the said Act and it would be evident clearly from the said section of the said Act.

11. Mr. Gautam Chakraborty, learned Senior Advocate appearing on behalf of the respondent submitted that u/s 34 of the said Trade Marks Act, 1999, the respondent is a prior user of the said mark "SAFEX". He further contended that the appellant/petitioner adopted the mark "SAFEX FLOAT" and "SAFEX TUF" with a mala fide intention to offend the mark created by the respondent. In support of such contention be relied upon the decisions reported in [Corn Products Refining Co. Vs. Shangrila Food Products Ltd.,](#) . [Amritdhara Pharmacy Vs. Satyadeo Gupta, F. Hoffmann-la Roche and Co. Ltd. Vs. Geoffrey Manner and Co. Pvt. Ltd.,](#) . [Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co.,](#) ; 1996 (16) PTC 476 (supra); [Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories,](#) ; 2003 (26) PTC 1(Delhi), [Honda Motors Co. Ltd. v. Charanjit Singh and Ors.;](#) [Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.,](#) and submitted that registration of a trade mark of an application therefore does not provide a defence for the proceedings for passing off. u/s 27(2) of the Act a prior user of a trade mark can maintain an action for passing off against any subsequent user of an identical trade mark including a registered user thereof and such right is not attached by Section 31 of the Act, under which the only presumption that follows from the registration of a mark is its prima facie evidentiary value about its validity and nothing more. Mr. Chakraborty

further submitted that prior to codification of trade mark law there was no provision in India for registration of a trade mark and such right has not been affected by the Act and rather is preserved and recognized by Sections 27(2) and 33 of the said Act.

12. He further contended that the Trade Mark Law is not intended to protect a person who deliberately sets out to take the benefit of somebody else's reputation and he submitted that only question to be found out that, in case of passing off action, is the similarity between the competing marks and to determine whether there is likelihood of deception or causing confusion. He further submitted that the mark of the petitioner/appellant would show that there is every possibility of the passing of the goods of the respondent and further the mark in question of the appellant/petitioner would show that the appellant/petitioner using the word "SAFEX" on their goods and the degree of resemblances between the marks, phonetically similar and hence similar in idea. Further, it would be evident that goods are similar in nature, character and performance. Therefore, he submitted that the test of the passing off has specifically fulfilled which would be revealed from the facts of this case and therefore, according to him, the Hon'ble First Court correctly made the said order and the injunction in favour of the respondent restraining the petitioner/appellant from using the said mark.

13. After hearing the learned Counsel for the parties and after analyzing the facts of this case admittedly it appears to us that the respondent enjoys goodwill and reputation all over India in respect of its product and the prior user of its trade mark "SAFEX" since 1958. It is also admitted that the trade mark of the respondent was registered in Class 19 under Fourth Schedule and having a registration No. 463502. Respondent had been extensively and continuously using the said trade mark "SAFEX" in respect of its goods prior to 1958 and still is using and selling its products in the aforesaid trade mark "SAFEX".

14. It is also a fact that the appellant/petitioner was appointed as a dealer of the respondent to sell the laminated and toughened glass bearing the registered trade mark "SAFEX" in the State of Andhra Pradesh. In or about June, 2003 appellant/petitioner came to the market and sold similar laminated and toughened glass under the mark "SAFEX FLOAT" and "SAFEX TUF".

15. However, it was contended before us that the trade mark of the appellant/petitioner is under Class 12 of Fourth Schedule. It is also to be noted that the appellant/petitioner and the respondent -- both are dealing in the automobile industries. The appellant/petitioner deals with their products in the replacement market whereas the respondent deals with the automobile manufacturing companies which has been pointed out by the learned Senior Advocate appearing on behalf of the appellant/petitioner and according to him that would show that the petitioner would not suffer any damages.

16. It is no doubt that the respondent is the prior user of the said trade mark "SAFEX". Mr. Chakraborty also pointed out before us that the appellant has no case and/or defence for the proceedings for passing off. u/s 27(2) of the said Act a prior user of a trade mark can maintain an action for passing off against and subsequent user of an identical trade mark including a registered user thereof.

17. We have also considered the decisions cited before us and it appears to us after analyzing those decisions particularly in "Honda Motors Co. Ltd. v. Charanjit Singh and Ors." (supra) where the Hon"ble Delhi High Court observed that in an action for infringement of a trade mark, title of the plaintiff is established by evidence of registration, whereas in a passing off action, title is established by the evidence of reputation and goodwill of the business acquired by the use of a mark, symbol or other badge.

18. It is also well-settled that the plaintiff in passing off action does not have to prove that he has actually suffered damage by loss of business or in any other way. A probability of damage is enough but the actual or probable damage must be damage to him in his trade or business i.e., damage to his goodwill in respect of that trade or business. What is required to be established is the likelihood of deception or confusion in the minds of the public at large. Such likelihood or probability of deception depends on a number of factors, which varies from one case to the other depending upon the facts.

19. At the time granting an injunction it is only to be seen that whether the plaintiff has a prima facie case. It has to be seen that whether the mark of the plaintiff has acquired substantial reputation and goodwill.

20. In the instant case, it appears to us that the plaintiff is dealing with such business with the said mark "SAFEX" for a long time i.e. prior to 1958 and in fact has already built up its reputation for its quality products.

21. It has also been settled by a catena of decisions that now-a-days with the changed concept of passing off action, it is now not material for a passing off action that the plaintiff and the defendant should trade in the same field.

22. On this ground we are of the opinion that the plaintiff/respondent herein made out a case in their favour.

23. In "Corn Products Refining Co. v. Shangrila Food Products Ltd." (supra), the Hon"ble Supreme Court came to the conclusion which are as follows:

The absolute identity of the two competing marks or their close resemblance is only one of the tests for determining the question of likelihood of deception or confusion. Trade connection between different goods is another such test. Ex hypothesi, this latter test applies only when the goods are different. These tests are independent tests. There is no reason why the test of trade connection between different goods should not apply where the competing marks closely resemble each

other just as much as it applies, as held in the "Black Magic" and "Panda" cases, where the competing marks were identical. Whether by applying these tests in a particular case the conclusion that there is likelihood of deception or confusion should be arrived at would depend on all the facts of the case.

24. In "Amritdhara Pharmacy v. Satya Deo Gupta" (supra), the Hon"ble Supreme Court held that for deceptive resemblance two important questions are: (a) who are the persons whom the resemblance must be likely to deceive or confuse, and (b) what rules of comparison are to be adopted in judging whether such resemblance exists. As to confusion, it is perhaps an appropriate description of the state of mind of a customer who on seeing a mark thinks that it differs from the mark on goods, which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection.

25. If such tests are applied and found that the customers are not in a position to distinguish the goods, in that case there is a chance of confusion and then it has to be held that there is a chance of being deceived of customer.

26. In "Rustom & Hornby Ltd. v. Zamindara Engineering Company" (supra) where the Hon"ble Supreme Court granted a decree restraining the respondent by a permanent injunction from infringing the plaintiffs trade mark "RUSTON" and from using it in connection with the engines, machinery or accessories under the name of "RUSTAM" or "RUSTAM INDIA" on the ground that there is a deceptive resemblance between the word "RUSTON" and "RUSTAM" and therefore, the use of the bare word "RUSTAM" constituted infringement of the plaintiffs trade mark "RUSTON" and the word "INDIA" is added to the respondent's trade mark is of no consequence.

27. In the instant case, it appears to us that the respondent's product with the mark "SAFEX" is a well-known glass material in automobile market. The appellant/petitioner was appointed as the dealer of the respondent's product in the market and to sell laminated and toughened glass bearing the registered trade mark "SAFEX" in the State of Andhra Pradesh and thereafter came into the market with the mark "SAFEX TUF" and "SAFEX FLOAT". In our opinion, there is a deceptive resemblance between the words "SAFEX" and "SAFEX TUF" and "SAFEX FLOAT" and therefore the use of the bare word "SAFEX" constituted infringement of the respondent's trade mark and the word "TUF" or "FLOAT" are of no consequence.

28. In "Cadila Health Care Limited v. Cadila Pharmaceuticals Ltd." (supra) the Hon"ble Supreme Court held that in the case of passing off action, it is only a duty to see the similarity between the competing marks and to determine whether there is likelihood of deception or causing confusion in the mind of the public.

29. In the instant case, it appears to us that applying the said test we have to hold in favour of the respondent and in our opinion, the respondent made out a prima facie case before the Hon"ble First Court to have an injunction in their favour.

30. In "N.R. Dongre v. Whirlpool Corporation" (supra), it was observed that the goodwill is not limited to a particular country as in the present days the trade is spread all over the world and the goods are transported from one country to another very rapidly and on extensive scale. It was also observed that the goodwill acquired by the manufacturer is not necessarily limited to the country where the goods are easily available because the goods though not available are widely advertised in newspapers, periodicals, magazines and in other media. It also observed that the trade name transcends the physical boundaries of a geographical region and acquires a trans-border or overseas or extra-territorial reputation not only through import of goods but also by its advertisement.

31. In "Kaviraj Pandit Durga Dutt Sharma (In both the Appeals) v. Navaratna Pharmaceutical Laboratories (in both the Appeals)" (supra) the Hon"ble Supreme Court came to the conclusion that in an action for the 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 plaintiffs 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 plaintiffs 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.

32. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff.

33. In our opinion, such fact at this prima facie stage cannot be gone into excepting it is clear to us that the plaintiff/respondent has been able to make out a case before the Hon"ble First Court.

34. In [Daimler Benz Aktiengesellschaft and another Vs. Hybo Hindustan](#), , the Hon"ble Delhi High Court held that the plaintiff was using the trade mark "Mercedes Benz" in relation to vehicle. The defendants started using the trade mark "Benz" in respect of undergarments. The Court granted an injunction restraining the defendants from the using the said trade mark "Benz" as well as the words "Three Pointed Human Being in a Ring". The said judgment was also upheld by the Hon"ble Supreme Court. The observations made in the said decision are as follows:

There are marks which are different from other marks. There are names which are different from other names. There are names and marks which have become household words. "Benz" as name of a Car would be known to every family that has ever used a quality car. The name "Benz" as applied to a car, has a unique place in the world. There is hardly one who is conscious of existence of the cars automobiles, who would not recognize the name "Benz" used in connection with cars. Nobody can plead in India, where "Mercedes Benz" cars are seen on roads, where "Mercedes" have collaborated with TATAs, where there are Mercedes Benz. Tata trucks have been on roads in very large number, (known as Mercedes Benz Trucks, so long as the collaboration was there), who can plead that he is unaware of the word "Benz" as used with reference to car or trucks.

35. In our opinion, the Trade Mark Law is not to protect a person who deliberately tries to take the benefit of one's reputation with regard to its goods.

36. In the year 2003, the appellant/petitioner tried to imitate the said word "SAFEX" on its product using the said word "SAFEX" and tried to confuse and/or deceive the public which is arising from similarity of marks and in our opinion, such action on the part of the appellant/petitioner is nothing but can be called to be fulfilled the ingredients of passing off.

37. In the instant case, in our opinion "SAFEX TUF" and "SAFEX FLOAT" would show a deception resemblance between the products of the appellant/petitioner and that of the respondent and in our opinion, the Hon'ble First Court correctly granted an injunction in favour of the respondent.

38. Accordingly, we dismiss this application.

39. By consent of the parties the appeal is also treated as on day's list and the same is also dismissed.

Pravendu Narayan Sinha, J.

40. I agree.