

Jayanti Kumar Jain and Another Vs R.R. Electricals and Others

Court: Calcutta High Court

Date of Decision: Oct. 28, 2009

Acts Referred: Trade Marks Act, 1999 & Section 28, 29

Citation: (2009) 2 ILR (Cal) 430

Hon'ble Judges: Sankar Prasad Mitra, J; Pinaki Chandra Ghose, J

Bench: Division Bench

Advocate: Pratap Kr. Chatterjee, Ranjan Kumar Bachawat and Tanmoy Roy, for the Appellant; Goutam Chakraborty, Goutam Roy, Goutam Brahma and T.K. Jana, for the Respondent

Final Decision: Dismissed

Judgement

Pinaki Chandra Ghose, J.

This appeal is directed against an order and/or judgment passed by the Hon'ble First Court on April 24, 2008

when the Hon'ble First Court was pleased to dismiss the application filed by the Appellants praying for injunction against the Respondents from

using the Convex shaped switches in respect of their registered Trademark ""PRITAM"".

2. The Appellants filed a suit before this Hon'ble Court against the Defendant Respondents alleging infringement of their Trademark ""PRITAM"

and also infringement of the registered design of switches manufactured by the Appellants and sold under the marks ""WINNER"" and ""PRITAM"".

3. The case made out by the Appellants that the Appellant Nos. 1 and 2 are the cousins. The Appellant No. 2 is the proprietor of J.K. Electrical

Industries. The Appellants are manufacturing and marketing electrical switches and other related goods. In 1986, Jayanti Kumar Jain (Appellant

No. 1) adopted the Trademark ""PRITAM"" in respect of electrical switches manufactured and sold by him. According to him, the Mark

PRITAM"" and the letter ""P"" are written in a stylized manner and distinctive of his business and goods. On July 4, 1989 the Plaintiff/Appellant No.

1 made an application before the authority for registration of the Trademark ""PPRITAM"" which was duly registered on November 15, 1996. On

February 16, 2001 J.K. Electrical Industries applied for registration of the design No. 184691 in respect of the switches manufactured and

marketed by him and got the same registered.

4. By a Deed of Assignment, the Appellant No. 1 on March 10, 2004 assigned his rights in favour of Appellant No. 2 and the rights in respect of

registered Trademark ""PRITAM"" was transferred together with the goodwill of the business in favour of the Appellant No. 2 herein. The Appellant

No. 1 transferred his business to the Appellant No. 2 on April, 1, 2004. The Appellants have alleged that the Respondent Nos. 3 and 4 have

adopted a Trademark ""PRETTY"" which is deceptively similar to the Trademark ""PRITAM"" of the Plaintiffs/Appellants. It is further alleged that the

packaging used by the Respondent Nos. 3 and 4 is a colourable imitation of the Plaintiffs/Appellants having the same colour scheme, get-up and

design. It is further alleged that the packaging of the Respondent is the same yellow and green colour in the same lay-out and design with the

identical shades as that of the packaging used by the Plaintiffs/Appellants and the packaging of the Respondents is deliberately designed in a

manner which is deceptively similar to that of the packaging of the Plaintiff/Appellant No. 2. It is further alleged that the Respondents' Trademark

PRETTY"" is represented in the same fashion and identical background as that of the Plaintiffs/Appellants.

5. It has further alleged that the Respondent Nos. 3 and 4 are infringing the registered design of the switches of the Plaintiffs by manufacturing and

selling switches under the same design as that of the Plaintiffs/Appellants i.e., the switches of the Respondent Nos. 3 and 4 have convex button like

the ""WINNER"" switches of the Plaintiff No. 2. It is further alleged that Respondent Nos. 1 and 2 are the dealers and distributors of the

Respondent No. 3, who have sold the infringing switches within the jurisdiction of this Hon"ble Court.

6. The Hon"ble Single Judge dismissed the application for injunction filed by the Appellants, inter alia, holding that the switches of the Appellants

are convex whereas the switches of the Respondents are concave and as such, held that the Respondents' switches are completely different to the

Appellants' switches. The Hon"ble First Court also held that the Respondents' mark ""PRETTY"" with the device ""P"" is written in a different font

and style and colour combination and does not constitute an act of infringement of the Appellants' registered Trademark ""PRITAM"" with the

device ""P"". The Hon"ble First Court also did not accept the contention of the Appellants that the labels of the boxes are identical. On the contrary,

it has been held that those labels are so dissimilar that there is no question arises of passing off.

7. In these circumstances, injunction was prayed before this Court.

8. Mr. Pratap Kumar Chatterjee, learned Senior counsel appearing on behalf of the Appellants contended that the said order is liable to be set

aside on the ground that if a comparison is made between the Appellants' registered design and the products manufactured and sold by the

Respondents, it would appear that the Respondents are also selling Convex switches which is identical to the registered design of the switches of

the Appellants. He further contended that the Appellants' Trademark ""PRITAM"" with the device ""P"" is registered under the provisions of the

Trademarks Act, 1999 in Class 9. According to him, the said mark of the Appellants is represented in an artistic and stylized manner with a unique

and distinctive representation of the letter ""P"". The Respondents are using deceptively similar mark ""PRETTY"" represented in an identical &

stylized manner with a device ""P"". According to him, the Respondents constitute an act of infringement under Sections 28 & 29 of the Trademarks

Act, 1999.

9. He further contended that the Respondents are also selling their products in boxes bearing the identical colour scheme combination as that of the

Appellants which is deceptively similar. From a bare perusal of the trade dress of the Appellants and Respondents, it would appear that they are

identical and/or deceptively similar with each other. The Respondents have deliberately adopted such identical trade dress only in an attempt to

pass off Respondents' switches in the said impugned boxes as that of the Appellants.

10. On the contrary, Mr. Goutam Chakraborty, learned Senior counsel appearing on behalf of the Respondents submitted that the registration of

the design of the switches so obtained by the Appellants does not bear any new shape, configuration, pattern, ornamentation or composition of line

nor there is any new innovation or originality in the said design. It is further contended that the said design had been disclosed prior to its

registration and, as such, the same is liable to be cancelled.

11. It is further contended by Mr. Chakraborty that the packaging of ""PRETTY"" bears a combination of red and a stripe of green at the top. The

word ""PRETTY"" with letter ""P"" is written in white on Blue background and, as such, there is no question of any confusion or deception between

the Trademark ""PPRITAM"" and ""PRETTY"" and further the get-up and trade dress of the two marks are entirely different. It is further contended

by Mr. Chakraborty that the label bearing the mark ""WINNER"" is the subject matter of the suit pending in the Delhi High Court filed by the

Respondents. As such, no order can be passed thereon. He further contended that the issue regarding the trade dress of the boxes of the

Appellants and the Respondents is not the subject matter of the instant appeal.

12. Mr. Chakraborty further contended that it is well settled that priority in adoption and use of a mark is superior to prior of registration in the

instant case. The Respondent No. 3, since 2000 started exporting its products to Bangladesh under the Trademarks ""WINNER"" & ""PRETTY""

and since 1980, it has been used by the Respondent No. 3 continuously. He further drew our attention to the bills/invoices evidencing the sale of

the said products by the Respondent No. 3 under the aforesaid Trademarks which is annexed to the Affidavit-in-Opposition in support of his

contention. He also relied on the decisions in the cases of:

1. Consolidated Foods Corporation Vs. Brandon and Company Private Ltd.,

2. Century Traders v. Roshan Lal Dugar, AIR 1978 Del 251

3. N.R. Dongre v. Whirlpool Corporation 1996 (16) P.T.C. 476

4. N.R. Dongre v. Whirlpool Corporation 1996 (16) P.T.C. 583

13. He also submitted that the said suit is pending before the Delhi High Court and the Appellants have also filed written statement in the said suit.

He further pointed out that since the matter is pending before the Delhi High Court this Court should not pass any order since the subject matter of

the present suit is covered under the said suit.

14. Mr. Chakraborty drew our attention to the suits which are pending before the Delhi High Court being C.S. (O.S.) No. 1530 of 2006

(Sancheti Appliances Pvt. Ltd. v. J.K. Electrical Industries) and C.S. (O.S.) No. 2362 of 2007 (Sancheti Appliances Pvt. Ltd. v. D.K. Industries)

and submitted that the Appellant has duly entered appearance in the said suit and also made counterclaim therein for ownership of the Trademark

WINNER". The said suit is pending before the Delhi High Court.

15. In these circumstances, he submitted that no order should be passed on this application.

16. He further contended that the validity of the design is under challenge by the rectification application on the ground of prior publication and not

noble but purely functional. He further submitted that the Appellants have not come before this Court with clean hands and have deliberately

suppressed the material facts. Hence, he submitted that the appeal should be dismissed.

17. After considering the facts and circumstances of this case and after analyzing the decisions cited before us, we find that the switches which

have been handed over to us cannot be said to be is noble or, in our opinion, can be said to be having any distinctive feature as claimed by the

Appellants. In the facts and circumstances of this case, we do not find that there is any reason to interfere with the order so passed by the Hon"ble

First Court.

18. In our considered opinion, the Appellant has failed to make out a case. Hence, there is no merit in this appeal and we dismiss this appeal

affirming the order so passed by the Hon"ble First Court.

19. Urgent Xerox certified copy of this order, if applied for, be supplied to the parties subject to compliance with all requisite formalities.

Sankar Prasad Mitra, J: I agree.