

INDIA

Trade Marks Act

**Selected decisions
1986-1990**

**Supreme Court, Allahabad, Bomaby, Calcutta,
Delhi, Gujarat, Kerala, M.P. & Madras.**

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Case No. 1

**Removal from register
Trade and Merchandise Marks Act, 1958, sections 18, 46, 48
Trade Marks Act, 1940, sections 14(1), 39(2).**

In an application for removal of a trade mark under section 46(1) (a), registered by an American company under section 14 of the 1940 Act, it was found that only when it was decided to introduce a product in the Indian market through the Indian company, the American company, proprietor of the trade mark, made its application to register the trade mark under which the product in question was to be marketed. There was a close connection in the course of trade between the American company and the Indian company. The former owned 40 per cent of the shareholding in the Indian company. It had entered into a technical collaboration agreement with the Indian company, which provided for strict quality control and for formulae and services to be provided by the American company. The manufacture, marketing and advertising of all products under the said agreement were to be under the control of the American company. There was no royalty payable by the Indian company to the American company in respect of the use of the trade mark. In the event of the collaboration agreement being terminated by reason of the happening of any of the events mentioned in the said agreement, (amongst which events was the shareholding of the American company becoming less than 40 per cent,) the Indian company was to cease to be entitled to manufacture the product or to use its formula or to use the trade mark. It was held that there was no question of any "trafficking" in trade mark. The intention of the American company to use the trade mark through the Indian company, which was subsequently to get itself registered as the registered user of the said trade mark, could not but be characterised as bonafide. In this view, the application filed under section 46(1) (a) to have the trade mark in question removed on the ground that the American company had not at any relevant time made use of the trade mark itself and that permitting the use of the trade mark amounted to permitting trafficking in the trade mark, was liable to be set aside.¹

1. **American Home Products Corporation v. Mac Laboratories Pvt. Ltd., A.I.R. 1986 S.C. 137.**

Case No. 2

Refusal of registration Trade and Merchandise Marks Act, 1958, Section 49(3)

The refusal of an application for registered user has a civil consequences of considerable effect. It is, therefore, that the hearing is contemplated. An order which speaks of the reasons why the application is refused, is a corollary to the hearing. The applicant is entitled to know that the facts of his case and his contentions have been duly considered by the authority. He is entitled to know the grounds upon which his application is rejected and that these are germane. If the applicant is dissatisfied by the refusal, he may bring the matter to court, in which event the court would become entitled to know that the order was passed after due consideration of all relevant facts and upon germane grounds. An order passed under section 49(3), refusing an application to be registered as a registered user, must be a speaking order.

It is not sufficient simply to state in the show cause notice that registration is not in the interest of the general public and the development of indigenous industry in India. It is no more than a repetition of the phraseology used in section 49(3), with only the addition of the word "indigenous".¹

1. **The Singer Company v. Union of India.** A.I.R. 1986 Bom. 286 (Bharucha, J.).

Case No. 3

**Passing off
Trade and Merchandise Marks Act, 1958
Section 29**

It was held that the plaintiff was entitled to the interim injunction sought for. The defendants were using their family name, not as a trading style but as a trade mark or trade sign. Such user is not permissible. The fact that damage would be suffered by the plaintiff cannot be ignored and the actual sufferance of damage need not be established on the date of the institution of the suit.¹

1. **Bajaj Electricals Ltd., Bomaby v. Metals & Allied Products, Bomaby A.I.R. 1988 Bom 167 (P.S.Shah and M.L.Pendse, JJ).**

Case No. 4

**Resemblance
Trade and Merchandise Marks Act, 1958
Section 56**

Petitioner had been manufacturing rice hullers and spare parts under trade mark "Raja", for 20 years or more. Respondents started manufacture of same products under name "Maharaja". It was held that the mark of respondents was not deceptively similar to that of the petitioner.¹

1. **S.M.Chopra & Sons v. Rajendra Prasad Shrivastava** A.I.R. 1988 Cal. 326 (BB).

Case No. 5

**Exclusive Appropriation
Trade and Merchandise Marks Act, 1958
Sections 2(v), 2(j), 2(k), 27(2)**

A name or a word is capable of exclusive appropriation as a trade mark. Word "superflame" was in respect of gas cookers/appliances and was exclusively appropriated by plaintiffs. It was held that plaintiffs were owners of the mark.

In view of the provisions of sections 2(v), 2(j) and 2(k), a name or a word is capable of exclusive appropriation as a trade mark. Even at common law, a mark or a name can be exclusively appropriated by the person who was, as between parties to the suit, the prior user of it. The words which are of common usage; and the words which are uncommon, "coined" or "Fancy words", are treated differently, as coined words or fancy words are not part of language. There can be a property in a name, the nature of the property being such that others could be restrained from using it in connection with their goods.¹

1. **Globe Super Parts v. Blue Super Flame Industries**, A.I.R. 1986 Delhi 245 (Mahinder Narain, J.).

Case No. 6

Infringement
Trade and Merchandise Marks Act, 1958
Section 27 (2)

The word "superflame", in respect of gas cookers appliances was found to be distinctive qua plaintiff. There was deliberate incorporation of the said word in trading style/trading nature of defendant No. 1. Defendant No. 2 already had trading connection with plaintiff for 10 to 12 years. Defendant No. 2 was father of owner of defendant No. 1 firm. Mentioning the aforesaid word in a trading style by defendant was only with a view to filching the business of plaintiff. It was held that plaintiffs were entitled to permanent injunction, restraining the defendants from using the word "Superflame".¹

1. **Globe Super Parts v. Blue Super Flame Industries**, A.I.R. 1986 Delhi 245 (Mahinder Narain, J.)

Case No. 7

**Passing off
Trade and Merchandise Marks Act, 1958
Section 27**

Use of unregistered trade mark "Goodmans" by plaintiffs existed for long, in respect of medicines. Permanent injunction restraining the defendant from using the same mark in respect of disinfectants was issued.

A trader acquires a right in a distinctive mark merely by using it upon or in connection with his goods, irrespective of the length of such user and the extent of his trade, and this is independent of its registration which merely affords further protection under the statute. Priority in adoption and use of trade mark is superior to priority in registration. Common law rights are left wholly unaffected by registration.

The suit of the plaintiffs must be decreed for permanent injunction, restraining the defendant from manufacturing and marketing disinfectants under the trade mark "Goodmans".¹

1. **Swaran Singh Trading & Appliances Emporium v. Usha Industries (India), New Delhi**, A.I.R. 1986 Delhi 343 (D.K.Kapur and N.N.Goswamy, JJ.).

Infringement : Injunction
Trade and Merchandise Marks Act, 1958
Sections 28 and 33

The effect of registration is to give an exclusive right of user to the proprietor of the registered trade mark. However, under section 33, if there is user prior to the registration, it may continue.

Where the interim injunction, in effect, permitted the defendant to use the impugned mark during the pendency of the suit in respect of all items which the defendant was dealing in, irrespective of whether the user thereof was from before the date of registration of the mark in favour of the plaintiff or not, the same was modified, restricting such permission to those items which the defendant showed he was using from before. Further, considering that the user in respect of other items had been concurrent for some time, the defendant was allowed to use the impugned trade name in conjunction with another word (Golden' in this case), as the defendant was found using in respect of some of its items. The effect of an interim order of injunction in a case of infringement of registered trade mark should not be such as to create a difficult situation for the person holding exclusive right of user thereof as its proprietor, under section 28 of the Act.¹

1. **Dr. Ganga Prasad Gupta & Sons v. S.C.Gudimani.** A.I.R. 1986 Delhi 329
(D.R.Khanna, J.).

Case No. 9

**Registration - right
Trade and Merchandise Marks Act, 1958
Sections 28, 29 & 30**

The registration of a trade marke **per se**, if valid, whether in part A and B of the Register, confers on the proprietor of the mark the right under section 28(1) to the exclusive use of the mark in relation to the goods in respect of which it is registered, that is to say, the right to exclude others from the use of the trade mark, to restrain infringement of his mark and to obtain relief in respect of any infringement. This is in addition to his right under section 12(1), to object to another person registering a trade mark which is the same as, or deceptively similar to, the mark already registered by him in respect of the same goods or description of goods. The rights conferred by section 28(1) are subject to the conditions and limitations contained in sections 28(2) and (3), 30(2) and 33 and 34 of the Act.¹

1. **Tata Oil Mills Co. Ltd. v. Wipro Ltd.** A.I.R. 1986 Delhi 345 (M.K.Chawla, J.)

Case No. 10

**Delay
Trade and Merchandise Marks Act, 1958
Sections 28 & 29**

Plaintiff was proprietor of registered trade mark 'Bubbles' for his soaps. Suit by plaintiff was for permanent injunction, restraining the defendant from infringing his mark. Suit was filed after 3 months of plaintiff coming to know of use of defendant's mark.

It was held that the delay of about 3 months in filing the suit after the plaintiff came to know of the use of the trade mark 'Bubbles', cannot be held to be fatal to the suit. The plaintiff had a statutory exclusive right (under section 28) to the use of his trade mark and to prevent its infringement and a statutory right could not be lost by delay. To refuse the injunction on the ground of delay, would tantamount to permit a fraud being practiced on unwary customers. Moreover, mere delay is not a defence, even in equity.¹

1. **Tata Oil Mills Co. Ltd. v. Wipro Ltd.** A.I.R. 1986 Delhi 345 (M.K. Chawla, J.)

Case No. 11

**Infringement
Trade and Merchandise Marks Act, 1958
Section 106**

Defendant adopted **in toto**, registered trade mark of a foreign company on his cigarettes. Plaintiff was a company reputed for its cigarettes. Temporary injunction can be granted, casting away considerations of balance of convenience.

The foreign company was the proprietor of registered trade mark 'VISA' in relation to cigarettes on account of its registration in that very trade mark. The Indian company, without any justification whatsoever, had taken advantage of import restrictions on cigarettes and had thus been deceiving the public in India by inducing a belief in them, that they were selling the cigarettes of the manufacture of plaintiff which was a company reputed for the same. It being a clear case of infringement of plaintiff's registered trade mark, the balance of convenience would not matter, and plaintiff would be allowed the grant of temporary injunction.¹

1. **Philip Morris Belgium S.A. v. Golden Tobacco Co. Ltd.** A.I.R. 1986 Delhi 145 (Jagdish Chandra, J.)

Case No. 12

**Identical Marks
Trade and Merchandise Marks Act, 1958
Section 11(a)**

The word "YERA" was being copied by the petitioner, in order to take advantage of the reputation acquired by the trade mark. Perfumery and cosmetics manufactured by the petitioner were sold in bottles and glass containers, and if the trade mark "YERA" appeared on the bottles and glass containers, there was likelihood that a common man, who would go to buy these perfumery and cosmetics, would be led to believe that these goods were manufactured by the opponent company. The petitioner was, therefore, not entitled to registration under section 11(a) of the Act.¹

1. **Surjit Singh v. Alembis Glass Industries Ltd.** A.I.R. 1987 Delhi 319 (Ms. Sunanda Bhandare, J.)

Case No. 13

**Resemblance
Trade and Merchandise Marks Act, 1958
Section 29.**

Plaintiff sold 'bidis' with figure '22' as trade mark of the label, for a number of years. Defendant used '12' as his mark in respect of similar goods and label. Colour scheme, get up, layout of both the labels, were identical. Infringement of trade mark was held to have been established. The resemblance between the two labels was extremely close. In view of the fact that the bidis are consumed and used by illiterate and unwary purchasers, it would be impossible for them to decipher an imperceptible difference which would not have been even found by a reasonably intelligent buyer.²

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1. "Bidis" are Indian-made substances containing Tobacco similar to cigarettes
 2. **Vrajlal Manilal and Co, v. N.S.Bidi Co.,** AIR 1987 Delhi 312 (C.L.Choudhary, J.).

Case No. 14

**Injunction : Common property
Trade and Merchandise Marks Act, 1958,
Section 29**

For an ad interim injunction, the plaintiff must establish that he has a prima facie case in his favour and the balance of convenience lies in the grant of ad interim injunction so as to protect him and, that otherwise, irreparable injury would be caused to him. It is incumbent upon the plaintiff to show that he has been using the trading style and trade mark for quite a long period and continuously.

Unless plaintiff's trading style or trade mark has become common property, it would be no defence for the defendant that there were some other concerns who were also using similar trading style or similar trade mark. As to whether it has become common property it is a question of fact in each case. The mere fact that the defendant has got its name approved from the Registrar of Companies, would not go against the claim of the plaintiff in any manner whatsoever.¹

1. **Hindustan Radiators Co. v. Hindustan Radiators Ltd.**, AIR 1987 Delhi 353 (Mahesh Chandra, J.).

Case No. 15

**Rectification
Trade and Merchandise Marks Act, 1958
Sections 46, 56 and 108**

There is no provision in the Trade Marks Act (or the Rules) requiring the original entry or certified copy of the entry in the register to be filed along with the application to the High Court for rectification of the register. Certified copy of the relevant entry of the register may be relevant as evidence of contents of the entry (in case of dispute on it between the parties on merits of the case). But want of certified copy of the relevant entry cannot be a bar, at the threshold, to the maintainability of an application for rectification of the register, it is, therefore, unnecessary for the applicant to produce the original register or a certified copy of the register for invoking jurisdiction of the High Court.¹

1. **Plaza Trading Co. v. R.K.Cables Co.** A.I.R. 1987 Delhi 214 (T.P.S.Chawla and A.B.Saharya, JJ.)

Case No. 16

**Resemblance
Trade and Merchandise Marks Act, 1958
Section 78**

Medicinal and pharmaceutical preparations falling under Schedule A were at issue. No visual or phonetical similarity existed between the two marks. Mark was adopted by the defendant after following common practice. There was no proof of dishonesty. No possibility of confusion existed. Passing off could not be said to have been established.

A suit for perpetual injunction restraining the defendant company from selling its drugs under the brand name 'Curechlor' was filed by the plaintiff, a drug company selling its product under the brand name 'Rector'. Both the trade marks related to the medicinal preparations falling under Schedule A of Drugs and Cosmetics Rules, 1945 and therefore could not be sold without physicians, prescription and without following the prescribed safeguards.¹

1. E.R.Squibb & Sons Inc. v. Curewel India Ltd. A.I.R. 1987 Delhi 197 (H.C.Goel, J.).

Infringement
Trade and Merchandise Marks Act, 1958
Sections 2(d) and 160

Marks "Camlin Flora" and "Tiger Flora" on pencils and cartons relating thereto of plaintiff and defendant respectively, were not similar. However, in view of similarity in appearance of both the pencils and the pencils being purchased by small children and their becoming confused, interim injunction was granted.

There was no similarity or resemblance, (phonetically or visually) between the two marks. No similarity of ideas was also to be seen in the two marks. No confusion was likely to be caused. The first word of the plaintiff's mark was CAMLIN, while that of the defendant was TIGER and buyer who has to purchase the plaintiff's pencil with CAMLIN mark cannot be confused or deceived to purchased defendant's pencil with TIGER mark.

However, the plaintiff had been able to establish a prima facie case for the grant of an interm injunction. The resemblance between the two pencils was extremely close, - so close that it can hardly occur, except by deliberate imitation. Frime facie, the act of the defendant was not an honest one. Small children are not likely to make a distinction between the two. Hence interim injunction was granted.¹

1. **Camlin Private Ltd. v. National Pencil Industries**, A.I.R. 1988 Delhi 393 (C.L.Choudhary, J.).

Case No. 18

**Passing off
Trade and Merchandise Marks Act, 1958
Section 29**

There was common field of activities in respect of similar goods of parties. Trading style adopted by the defendant was deceptively similar to that of the plaintiff. There was infringement of trade mark. Defendant was also guilty of tort of passing off.

The adoption of trading style "Sara Exports International" by the defendant and offering for sale, export and advertising the goods under the aforesaid trading style, (that is, Sara Exports International) was calculated to deceive and create confusion amongst the doctors, chemists and the general public in India and the importers and general public abroad. In the circumstances, use by the defendant of the word/mark 'Sara' in their trading style was an infringement of plaintiff's registered trade mark. Further, on account of deceptive trading style "Sara Exports International" which includes the main portion of registered trade mark of the plaintiff, the defendant was passing off, enabling others or causing and assisting others to pass off their goods and/or business as goods and/or business of the plaintiff. The defendant was thus also guilty of tort of passing off.¹

1. **Sarabhai International Ltd. v. Sara Exports International, A.I.R. 1988 Delhi 134**
(S.N.Sapra, J.)

Case No. 19

RESEMBLANCE
Trade and Merchandise Marks Act, 1958
Section 29

Plaintiff was selling sanitary napkins under the trade mark 'Stayfree' on the packing. Suit was to restrain the defendant from using the words 'Stayfree' on the packings of his sanitary napkins. It was held that the main question was not the intention of the defendant in using certain words, but the probable effect of such use on the minds of the customers. Actual deception was not required to be proved. It is the tendency to confuse that forms the gist of the passing off action. The plaintiff need not establish fraud. On the totality of the defendant's trade mark, there was no likelihood of causing deception or confusion or mistake in the minds of the ultimate customers who were literate or semi-literate and not illiterate ladies. Accordingly, the temporary injunction prayed for, was refused.¹

1. **Johnson and Johnson v. Christine Hoden India (P) LTD**, AIR 1988 Delhi 249 (S.S.Chadha and Y.K.Sabharwal, JJ.).

**Identical Trade Marks
Trade and Merchandise Marks Act, 1958
Sections 28(3), 31(1)**

There were registered proprietors of identical trade marks in different goods. Infringement of the mark, by one of them, was alleged. Application was made by him for deleting the name of one who infringed the trade mark from the register, during the pendency of suit for perpetual injunction.

By virtue of the provisions of section 28(3) of the Trade Marks Act, the exclusive right to use the trade mark 'Field Marshal' shall not be deemed to have been acquired, either by the plaintiff or by the defendant, as against each other, but both the plaintiff and the defendant had otherwise the same rights as against other persons as they would have, if they were the sole proprietors. Therefore, even though the plaintiff had filed an application in High Court for rectification of the Trade Mark Register for deletion of the name of the defendant therefrom, the registration of the trade mark in the name of the defendant was prima facie evidence of the validity thereof, because of the provisions of section 31(1).

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1. **P.M.Dissels Pvt, Ltd. v. Thukral Mechanical Works**, AIR 1988 Delhi 282 (B.N.Kirpal, J.).

Case No. 21

**Threats
Trade and Merchandise Marks Act, 1958
Section 120**

The word 'otherwise in section 10, Trade Marks Act is not to be construed **ejusdem generia** with the words "circulars, advertisements" in section 120(1). Cause of action envisaged by the section is not similar to libel and therefore threats, in order to be actionable under that provision, need not be published.¹

1. **Siddarth Wheels Pvt. Ltd. v. Bedrock Ltd.** AIR 1988 Delhi 228 (Arun B. Saharya, J.)

Case No. 22

**Registration
Trade and Merchandise Marks Act, 1958
Sections 21(2) and 101(1)**

When the application for registration of trade mark is opposed by the other party and notice of the opposition is served on the applicant, requiring him to file his counter-statement to the opposition within two months from the date of receipt of the notice of opposition as provided under section 21(2), the registrar has the power under section 101(1) to extend the time for sending the counter-statement, if sufficient cause is shown.¹

1. **Progro Pharmaceuticals Pvt. Ltd. Madras v. Deputy Registrar of Trade Marks, Madras AIR 1986 Mad. 282 (Sathiadev, J.)**

Case No. 23

**Registration
Trade and Merchandise Marks Act, 1958
Sections 28, 29 and 32**

In a suit for damages for infringement of registered trade mark, it was established that the plaintiff was registered proprietor of the trade mark for more than seven years and the defendant did not take any step for rectification. It was not open to the defendant to raise the plea in the suit that the registration of the plaintiff's trade mark was invalid. The plaintiff was entitled to the exclusive use of the trade mark and was entitled to market his product in the registered trade mark as long as he continued to be the registered proprietor of the said trade mark.¹

1. **Aravind Laboratories v. V.A.Samy Chemical Works**, AIR 1987 Madras 265
(Sengottuvelan, J.)

