

**HIGH COURT OF JUDICATURE AT HYDERABAD
FOR THE STATE OF TELANGANA AND THE STATE OF ANDHRA PRADESH**

**FRIDAY, THE TWENTY NINTH DAY OF APRIL
TWO THOUSAND AND SIXTEEN**

PRÉSENT

THE HON'BLE SRI JUSTICE A.RAJASHEKER REDDY

CIVIL MISCELLANEOUS APPEAL NO.879 OF 2015

(Appeal under Order XLIII, Rule 1@ r/w Section 151 of C.P.C. against the Order dated 07-08-2015 in IA No.524/2013 in O.S.No.177 of 2013, on the file of the court of the III Additional Chief Judge, City Civil Court, Hyderabad)

Between:

Shaik Nazeemuddin,
S/o Shaik Shujauddin, Occu: Business,
Proprietor Trading as Shereen Agencies,
R/o.8-3-338/678/ 1362, Sri Ram Nagar,
Yousufguda, Hyderabad-45, Telangana.

..... Appellant/Respondent No.1/Defendant No.1

AND

1 Mohd.Aslam,
S/o.Mohd.Yousuf Ali Aged: 31 years, Occu: Proprietor
Trading as M/s.Bright Interiors Also as M/s.Bright Rock Industries,
Plot No.203, Shop No.2, Phase-I Kalyan Nagar "X" Road,
Near S.R.Nagar, Hyderabad-38

...Respondent/Petitioner/Plaintiff

2 S.K. Trading Company,
(Constitution of the Firm unknown)
Shop No.6-3-1241/193/B,
M.S.Maqtha, Opp.Raj Bhavan, Hyderabad-04
(Respondent 2 are not a necessary party)

..... Respondent/Respondent No.2/Defendant No.2

CMAMP No.1891 of 2015:

Petition under Section 151 of C.P.C., praying that in the circumstances stated in the affidavit, the High Court may be pleased to suspend the operation of the impugned order passed in I.A.No.524 of 2013 in O.S.No.177/2013, dated 07-08-2015, passed by the III Additional Chief Judge, City Civil Court, Hyderabad.

For the Appellant: Dr.D.VENKAT REDDY, Advocate

**For the Respondent No.1: SRI V.M.CHARY, Advocate for
SRI K.HEMA PRAKASHA RAO, Advocate**

The Court delivered the following Judgment:

THE HON'BLE SRI JUSTICE A. RAJASHEKER REDDY

CMA No.879 OF 2015

JUDGMENT::

1st defendant in the suit is the appellant herein. The civil miscellaneous appeal is filed against the order dated 07-08-2015 passed in IA No.524 of 2013 in OS No.177 of 2013 by the learned IX Addl. Chief Judge-FAC-III Addl. Chief Judge, City Civil Court at Hyderabad. Plaintiff-1st respondent herein filed the suit OS No.177 of 2013 under Order 7, Rule 1, Section 26 CPC, r/w. Section 27 (2) and 134 of the Trade Marks Act, 1999, (for short, "the Act") for permanent injunction against the defendants from *passing off* their goods as the goods of the plaintiff by using the mark, *Bright*, which is similar to that of the trademark, *Bright* of the plaintiff; to award damages for causing loss to the reputation and goodwill of the business of the plaintiff and for delivery up of all the goods and other material including stationery bearing the impugned trademark *Bright*. Parties hereinafter will be referred to as they were arrayed in the suit.

2. Interlocutory application being IA No.524 of 2013 was filed by the plaintiff to grant ad-interim injunction restraining the defendants and, any person claiming through them, from *passing off* their goods under the impugned trademark as the goods of the plaintiff by using

the mark, *Bright*. By the impugned order, the Court below allowed the application. Hence, this appeal by the 1st defendant in the suit.

3. Facts stated are:- The plaintiff is engaged in business of trading in goods used in making and erecting false roofing under the name and style *Bright Interiors* since 01-10-2007. That it made substantial business with trademark *Bright* and indulged in whole sale and retail business and manufacturing ceiling material including gypsum steel frames, profiles, sections and channels, metal sheets and panels and adopted *Bright* on 18-02-2011. That the plaintiff also adopted other descriptive expressions like Ultra Gypsum Steel, Ultra Gypsum Frame, Gypsum Steel with its distinctive mark by prefixing the word *Bright* Ultra Gypsum Steel, *Bright* Ultra Gypsum Frame, *Bright* Gypsum Steel and *Bright* Gypsum Frame. That the plaintiff had built up a goodwill in the business circles with the brand name *Bright* and goods are recognized as popular goods on prefixing the brand name *Bright*. That the plaintiff also diversified into other business under the name and style of *Bright* Rock Industries and manufacturing frames of metal for building sheets, plates, grids and tiles of metals, mineral fiber tiles for building gypsum boards and plaster of paris with formative mark of *Bright* Rock since 17-02-2012.

4. That the plaintiff has been using *Bright Rock* by prefixing *Bright* to all his products. That the business had shown significant improvement and *Bright Interior* is also recognized in market circles as has *Bright Rock* been recognized. In order to protect trademark *Bright*, the plaintiff sought registration of label mark containing trade mark *Bright* along with the abbreviated form of his first trading style with "BI" and has been using the goods under the Act, and necessary application was made in that behalf vide application No. 2104202 in Class 6 of the IV Schedule on 22-02-2011, which is under consideration by Trade Marks Registry at Chennai. The plaintiff sought for registration of other formative marks *Bright Rock* in Class 6 vide application Nos.2311805 and 2311807. That the plaintiff also sought registration of the work mark and label mark in Class 19 in respect of mineral fiber tiles for building, gypsum boards and plaster of paris vide application Nos.2311808 and 2311806 claiming to be user of the said trademarks from 17-02-2012 and all the applications are under consideration of the Trade Marks Registry at Chennai.

5. While the matters stood thus, the plaintiff came to know about the 1st defendant using identical mark *Bright* in conjunction with Gypsum Steel Ultra, Gypsum Frame and Gypsum Steel, as the customers were

inquiring whether the *Bright* marked products are from the plaintiff's trading concern. That after knowing about the activities of the 1st defendant in *passing off* the goods with the brand name of *Bright* which is being used by the plaintiff and use of the word *Bright* is creating confusion and deception in the minds of the customers in trade channels, the plaintiff got issued notice dated 28-12-2012. That in response to the same, the 1st defendant replied through a reply notice dated 12-02-2013 stating that the word *Bright* has no distinctive character and, therefore, the 1st defendant is not obliged to comply with the demands of the plaintiff.

6. That earlier the 1st defendant got issued a legal notice dated 02-09-2011 claiming exclusive rights to the descriptive expression *Gypsum Frame* stating that he sought registration of the word *Gypsum Frame* under the Act vide application No.2094931 in Clause 6 and plaintiff has been using the expression *Gypsum Frame* illegally, to which the plaintiff replied vide reply notice dated 22-10-2011 stating that words *Gypsum Frame* cannot be exclusively claimed and that the plaintiff has been using the words *Gypsum Frame* with prefix *Bright* right from 18-02-2011. It is further stated that when the plaintiff went through the data base made available on the official web site of Trade Mark Registry, it

was found that the 1st defendant made application No.2094931 in Clause 6 on 04-02-2011 stating that it proposes to use the words *Gypsum Frame*, but did not put to use the said words *Gypsum Frame* in business firms. That the data base search word *Gypsum* reveals that the 1st defendant applied for registration of various distinctive expressions, viz., *Gypsum Section*, *Gypsum Frame Section*, *Gypsum Frame*, *Gypsum Frame Steel*, *Gypsum Steel Ultra* and *Gypsum Frame True Steel* proposed to be used vide application No. 2198037 on 01-09-2011 and that itself indicates that the 1st defendant has not been actually using the words *Gypsum Frame* but was proposing to use it, which does not entitle him to claim exclusive rights over such proposed usage of words *Gypsum Frame*. Therefore, the word *Bright* used alone or in conjunction with any other descriptive expression should be available only to the plaintiff to sell his product. That the plaintiff has already made it clear in his reply notice dated 22-10-2011 to the legal notice dated 02-09-2011 issued by the 1st defendant, with regard to products of plaintiff and the usage of the word *Bright* alone or in conjunction with other descriptive expression, 1st defendant now cannot plead ignorance as to the usage of the word *Bright* by the plaintiff to his products. It is stated that the plaintiff had applied to the Trade Mark Registry at Chennai with proposals of *Bright Gypsum Steel Ultra*, *Bright Gypsum Frame* and *Bright Gypsum Steel* vide

application Nos.2436114, dated 03-12-2012, 2445434, dated 19-12-2012 and 2445435, dated 19-12-2013, respectively.

7. The grievance of the plaintiff is that the products of 1st defendant are inferior in quality and by using the trade name *Bright* being used by the plaintiff, the reputation and good will of plaintiff is being damaged and the plaintiff has been receiving complaints from various customers about deception and confusions created with respect to the products manufactured by the plaintiff with that of the products manufactured by the 1st defendant. That inferior quality products of the 1st defendant are being sold at a higher price deceptively as that of the products manufactured by the plaintiff. Therefore, the plaintiff is entitled to invoke the present action against the defendants in public interest and also to protect his brand image and business. That there is substantial decrease in turnover of the plaintiff by reason of sale of goods by the 1st defendant under impugned trademark with inferior quality of products. That the 2nd defendant is also using similar trademark and causing unlawful loss to the plaintiff. Therefore, the plaintiff prayed for temporary injunction, pending adjudication of the suit filed by him.

8. The 1st defendant (appellant herein), *inter alia*, in his counter affidavit contended that the plaintiff cannot bring the suit under Section

134 of Act, when it is not a registered trade mark. The plaintiff is using generic expression like gypsum steel prefixing the word *Bright* and nobody can claim exclusive right to use the generic words and such words, do not automatically evoke protection of the Court unless it is established that such marks have acquired *secondary meaning*. It is not pleaded by the plaintiff that the mark *Bright* has acquired *secondary meaning*. That there is no evidence to establish that the word *Bright* which is adopted by the plaintiff acquired distinctiveness and associated with its products. That there is no document to show about the likelihood of consumer getting confused by seeing such products using the generic words. That 1st defendant also made a search in the web portal pertaining to the word *Bright* and found that there are several people who are claiming rights and usage of word *Bright*. There was no advertisement for products *Bright Gypsum Steel* or any of the products of the plaintiff with *Bright* prefix to the other words like *Bright Gypsum Steel*, *Bright Gypsum frame* etc. That the alleged invoices filed by the plaintiff pertains to just prior to the filling of the suit. That the plaintiff cannot claim any good will or good reputation or proprietary rights on word *Bright* as plaintiff had never used the trade mark *Bright* prior to 09-04-2012. That the 1st defendant has been in the market even prior to 03-12-2012. The word *Bright* has not received

any recognition in the market and, therefore, the plaintiff cannot claim exclusive right over such word. None of the applications made by the plaintiff reached the stage of clearance from Registry of Trade Mark, Chennai. That the 1st defendant never used any single product with the name of the plaintiff and, therefore, the plaintiff is estopped from raising any grievance against 1st defendant and he has no exclusive rights over the generic word *Bright*. Hence, the suit filed by the plaintiff is not maintainable, muchless grant of temporary injunction.

9. Heard the learned counsel for the appellant-1st defendant and the learned counsel for the 1st respondent-plaintiff. Perused the impugned order passed by the Court below.

10. It is strenuously contended by learned counsel for appellant (1st defendant) that the plaintiff is not entitled to claim exclusive rights to the mark, *Bright* without registration under the Act and the Court below erred in granting injunction on the ground of prior use (*passing of*) which is nothing short of declaration of rights and granting the relief sought for by the plaintiff in the suit. It is also contended by learned counsel that the mark *Bright* being a common generic word, the plaintiff cannot claim exclusive rights or monopolize the mark *Bright*. It is further submitted that as per Section 17 of the Trademarks Act, 1999, the trade mark shall be read as a whole for comparing the similarity

between the trademarks. It is contended that the alleged confusion and deception could not be established except pleading in the averments. The following case laws are cited by the learned counsel for the appellant (1st defendant) in support of his contentions. SYKLINE EDUCATION INSTITUTE vs. S.L. VASWANI¹, ATUL RAWAL vs. S.B.EQUIPMENTS², TRINETHRA vs. MEE TRINETHRA³, THREE N-PRODUCTS vs. EMAMI LIMITED⁴, CARLSBERG vs. KHAITAN⁵, CHENNAI HOTEL SARAVANA BHAVAN vs. HOTEL SHRAVANA BHAVANA⁶ & ROHINI SEEDS vs. RESHMA CHEMCIAL LIMITED.⁷

11. On the other hand, learned counsel for the 1st respondent (plaintiff) made submissions in support of the impugned order passed by the Court below. Learned counsel submitted that inasmuch as the suit was not filed complaining infringement rights, but is based on the rights accrued on account of passing off action, and the plaintiff being a prior user of the mark *Bright*, the suit is maintainable. It is further submitted that the 1st defendant is not entitled to contend that the mark *Bright* is a generic word picked out from the dictionary when he himself as filed applications

¹ 2010 (2) SCC 142

² 2010 (43) PTC 521 DELHI

³ 2011 (4) ALT 692 DB

⁴ 2009 (41) PTC 689 CALCUTTA

⁵ 2012 PTC (49) 54 DELHI (DB)

⁶ 2005 (4) ALD 263

⁷ 2015 (64) PTC 532 AP

for registration of the word *Bright* along with other descriptive expressions. Learned counsel also submitted that the mark *Bright* being the common distinctive element present in both the rival marks, a *prima facie* case has been made out that the 1st defendant has been *passing off* his goods as the goods originating from the plaintiff and inasmuch as the relief granted by the Court below is discretionary relief, the appeal is liable to be dismissed. Learned counsel for the plaintiff-1st respondent placed reliance on the following decisions in support of his contentions.

KAVIRAJ PANDIT DURGA DUTT SHARMA vs. NAVARATNA PHARMACEUTICAL LABORATORIES⁸, N.R. DONGRE vs. WHIRLPOOL CORPORATION⁹, LAXMIKANT PATEL vs. CHETANBHAI SHAH¹⁰, & MILMET OFTHO INDUSTRIES vs. ALLERGAN INC¹¹.

12. The points that arise for consideration in this appeal are:

a) *Whether, prima facie, the plaintiff is the prior user and adopter of the mark Bright to seek restraint against its use by the defendants basing its claim on passing off ?*

b) *Whether the mark Bright is a generic word; whether it attained secondary meaning/distinctiveness in respect of goods of the plaintiff; and whether the plaintiff is entitled for injunction.*

⁸ AIR 1965 SC 980

⁹ 1996 (5) SCC 714

¹⁰ 2002 (3) SCC 65

¹¹ 2004 (12) SCC 624

13. Now it is to be considered whether the plaintiff is entitled to the relief of interim injunction in the facts and circumstances of the case.

The Supreme Court in *CADILA HEALTH CARE vs. CADILA PHARMACEUTICALS LIMITED*¹² laid down certain broad principles, while granting injunction, the relevant portion is as follows:-

34. Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered :

(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.

(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trade marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods and

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”

14. A trademark is said to be infringed when a registered trademark is used by a person who is neither the registered proprietor nor the licensee of the said trademark in relation to the goods or services for which it is registered. From the scheme of the Act, it is discernable that trademark infringement means violation of exclusive rights granted to the registered proprietor under the Act, to use the same in relation to the goods or services in respect of which the trademark is registered. Section 29 and

¹² 2001 (5) SCC 73

Section 30 of the Act, provides for protection of registered trademark in case the same is infringed upon by a person not being a registered proprietor or a licensee.

15. Action for Passing off the goods arises when an unregistered trademark is used by a person who is not the proprietor of the said trademark in relation to the goods or services of the trademark owner. Passing off is a *tort* actionable under common law and mainly used to protect the goodwill attached with the unregistered trademarks. It is founded on the basic tenant of law that one should not benefit from the labour of another. Section 27 of the Act provides that no infringement cannot lie in respect of an unregistered trademark, but recognizes the common law rights of the trademark owner to take action against the person for passing off their goods/services as the goods of another person or as services provided by another person.

16. An action for infringement for registered trademark or *tort* of *passing off* for both registered as well as unregistered trademark are essentially two ways of achieving the same objectives *i.e.* protection of goodwill attached with a mark.

17. In the case on hand, the plaintiff's case is that it has been continuously using the distinctive mark, *Bright* along with descriptive expressions such as *Ultra Gypsum Steel, Ultra Gypsum Frame, Gypsum*

— —

Steel and Gypsum Frame so as to read them as *Bright Ultra Gypsum Steel, Bright Ultra Gypsum Frame, Bright Gypsum Steel and Bright Gypsum Frame* and maintaining quality of the goods under the said mark in order to protect reputation built over his trading style consisting of the mark, *Bright* as key feature thereof. Thus, it is its case that there is a huge commercial value generated associated with the mark, *Bright*, which the plaintiff claims as an asset of immense value in its business.

18. The claim of the plaintiff in this case is based on *passing off* of goods and that it is the prior adopter and user of the mark, *Bright* and has exclusive rights thereto under the common law, that any use thereof in conjunction with any descriptive expressions by the defendants would certainly create confusion and deception in the minds of the purchasing public and the members of the trade channels as to *passing off* goods of the plaintiff as those originating from the defendants.

19. In *LAXMIKANT V. PATEL's case (10 supra)*, the Supreme Court has explained the essentials which constitute *passing off* action, by holding as under:

“12.....The three elements of passing off action are the reputation of goods, possibility of deception and likelihood of damages to the plaintiff. In our opinion, the same principle, which applies to trade mark, is applicable to trade name.

13. In an action for passing off it is usual, rather essential, to seek an injunction, temporary and ad-interim. The principles for the grant of such

injunction are the same as in the case of any other action against injury complained of. The plaintiff must prove a prima facie case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction....”

20. In *MILMET OFTHO INDUSTRIES's case (11 supra)*, the Supreme Court has applied “first in the market” test to cases based on a claim of *passing off* and held thus:

“9. In the present case, the marks are the same. They are in respect of pharmaceutical products. The mere fact that the respondents have not been using the mark in India would be irrelevant if they were first in the world market. The Division Bench had relied upon material which prima facie shows that the respondents' product was advertised before the appellants entered the field. On the basis of that material the Division Bench has concluded that the respondents were first to adopt the mark. If that be so, then no fault can be found with the conclusion drawn by the Division Bench.”

21. In *KAVIRAJ PANDIT DURGA DUTT SHARMA's case (8 supra)*, the Supreme Court with regard to the burden of proof and the essentialities of identifying the dissimilarities in action for infringement of trade mark held that when the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark, as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered. Where the question arises in an action for infringement, the onus would be on the plaintiff to establish that the trade mark used by the

defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar.

22. In *N. R.DONGRE vs. WHIRLPOOL CORPORATION's case* (9 supra) at para 10, the Supreme Court observed thus:-

“10.....There is no plausible and convincing explanation by the appellants as to how they come to adopt the mark ‘whirlpool’. In the absence of any satisfactory explanation by the appellants, the adoption of the mark by them cannot prima facie be regarded as honest and plea of delay and laches would be of no avail to them.”

23. In *NEON LABOARATORIES LIMITED vs. MEDICAL TECHNOLOGIES LIMITED*, which is yet to be reported, the Supreme Court, upheld the contention that the prior user's rights will over ride those of a subsequent user even though it had been accorded registration of its trademark.

24. In this case it is seen that both parties are competing to get word *Bright* to be registered as their trade mark. There is no document filed before this Court as to which party was granted trade mark for the word BRIGHT. In the absence of such document, it is to be presumed that both of them are passing off their goods and claiming exclusivity on the basis of *passing off* of goods. It is clear that the word *Bright* is not registered either in favour of the 1st respondent-plaintiff or in favour of the

appellant-1st defendant. Though passing off is not defined in the Act, an action for passing off depends upon the principle that nobody has a right to represent his goods as the goods of somebody in deceptively similar manner.

25. Both parties have adduced only documentary evidence. Exs.P-1 to P-19 are marked on behalf of the plaintiff. Ex.P-1, VAT Registration Certificate, registered in the name of BRIGHT INTERIORS is issued on 19.09.2007. Ex P-2 is invoice dated 20-01-2013 issued by Bright Interiors in favour of Space Concepts Interior, Banjara Hills, Hyderabad, for Rs.1,05,399/-. Ex.P-3 is the purchase order dated 13-08-2012 made by Interior Project Private Limited to Bright Rock for Rs.18,240/-. Ex P-4 is the certificate issued by Ramesh Toshniwal & Co., Chartered Accountants in favour of M/s Bright Interiors, showing the yearly turn over from the years 2008-09 to 2011-2012. Ex.P-5 is application made to Rao & Rao Company for registration of BRIGHT with logo BI for registration, dated 19-02-2011. Ex.P-6 is application for registration of BRIGHT ROCK with logo applied through Rao & Rao Company, dated 02-04-2012. Ex.P-7 and P-8 are common applications for registration of BRIGHT ROCK, dated 02.04.2012. Ex. P-9, dated 28-12-2012 is application sent through Rao & Rao Company asking the defendants to desist from use of word BRIGHT and claimed Rs.1,00,000/- towards damages. Ex.P-11 is

reply given by defendant to Rao & Rao Company from SNS Associates, Advocates, sought for particulars in the matter. Ex.P-12 is detailed reply given by SNS Associates, Advocates to Rao & Rao Company, in which they contended that the word BRIGHT is not distinctive word, it is a common word, it is *public juris* and no one can claim monopoly of generic words. Ex.P-13 is legal notice issued to the plaintiff on 02-09-2011 by defendant claiming exclusive rights over trademark Gypsum Frame and contended that plaintiff is using trademark Gypsum Frame for his products and to desist from using the same while claiming Rs.10,000/- towards legal charges. Ex.P-14 is reply notice given by plaintiff dated 20-02-2011, in which it was replied that Gypsum Frame is generic word it has no special characteristic, and the defendant cannot claim exclusive rights. The other exhibits are mostly status reports of the applications made by the parties for registration of the trademark.

26. The exhibits filed by the defendants are marked as R-1 to R-12. Ex.R-1 is application filed by the plaintiff for registration of BI Bright dated 22-02-2011. Ex.R-2 is application dated 09-04-2012 for registration of words *Bright Rock* by the plaintiff. Ex.R-3 is also another application dated 07-04-2012 by plaintiff for registration of trademark *Bright Rock*. Ex.R-4 is computer generated status report where it was mentioned that the applications filed by plaintiff were considered as

'objected'. Ex.R-5 is application by defendants dated 03-12-2012 for registration of Bright Gypsum Steel Ultra. Ex.R-6 is application dated 19-12-2012 made by defendant for trade mark of Bright Gypsum Steel. Ex.R-7 is application by defendant for registration of word 'Bright Frame' with application No. 2445434 dated 19-12-2012. Ex.R-8 is application of defendant for registration of Gypsum Frame True Steel with application No.2149872, dated 25-05-2011, Ex.R-9 is application another from defendant for registration of Gypsum Frame Steel with application No.2198037, dated 01-09-2011. Ex.R-11 is application dated 04-02-2011 applied by defendant for registration of Gypsum Frame. Ex. R-12 is application dated 30-12-2010 by defendant for registration of trade mark Gypsum Frame Section.

27. These exhibits filed into the Court goes to show that the 1st defendant (appellant) at first instance, during the years 2010-11 had applied for trade mark with his trademark *Gypsum Frame, Gypsum Ultra Steel, Gypsum True Ultra*. It is to be noted that 1st defendant initiated legal proceedings against plaintiff (1st respondent) in the year 2011. Whereas plaintiff got issued legal notice to the 1st defendant in the year 2012 with regard to usage of the trademark *Bright Rock*. It is also found that the 1st defendant applied for registration of the word Bright. It is to be noted here that both parties are vying to get word Bright to be registered

as their trade mark. There is no document filed before this court as to which party was granted trade mark for the word *Bright*. In the absence of such document, it is to be presumed that both of them were not granted trade mark in their favour. From this it is clear that the word *Bright* is not registered either in favour of the plaintiff or in favour of the defendants.

28. The plaintiff claims that he has been trading his goods in the name and style *Bright Interiors* since 1-10-2007. Ex.P-1 VAT registration certificate is dated 19-09-2007. It further claims to have adopted the trademark *Bright* from 18-02-2011 and the word *Bright* with other descriptive expressions like *Ultra Gypsum Steel*, *Ultra*, *Gypsum Frame*, *Gypsum Steel and Bright Rock* on 17-02-2012. Necessary applications for registration were made on 22-02-2011 and 17-02-2012 and it is stated that the said applications are under consideration of Trademark Registry, Chennai.

29. The 1st defendant claims that he has been using the distinctive expressions *Gypsum Section*, *Gypsum Frame Section*, *Gypsum Frame*, *Gypsum Frame Steel*, *Gypsum Steel Ultra* and *Gypsum True Steel* and made necessary applications for registration with the Trademark Registry, Chennai, on 1-09-2011. In fact, the 1st defendant earlier issued legal notice on 2-09-2011 to the plaintiff that the plaintiff is using distinctive expression *Bright Gypsum Frame* etc., and intimated it not to use the

trademark descriptive expressions, Gypsum Section, Gypsum Frame Steel, Gypsum Frame etc. The dispute is only with regard to the usage of the expression Bright by both the parties with other descriptive expressions.

30. From the above details noted, it can be, prima facie, presumed that the plaintiff is the prior user of the trademark Bright with other descriptive expressions. But it is seen that there is no evidence to indicate that the plaintiff has been passing off his goods for a considerable period. Invoices filed by the plaintiff are of local invoices and they themselves cannot constitute a cause for make an action for passing off of goods against the defendants on the ground that the goods marketed by the defendants are deceptively similar with that to the plaintiff's goods. No evidence is filed as to the popularity gained by the plaintiff's trademark *Bright* either singularly or with other descriptive expressions. When the plaintiff claims that the trademark *Bright* used by him is key note feature of his business, burden is on it to prove how it is popular among the average customers and trade channels. It is not the case of the plaintiff that it has issued advertisements in press and media with the trademark Bright to market its goods and the word Bright became popular among the general public. Except stating that some customers made enquires as to the authenticity of the goods marketed by it and the averments that on account of the defendants using deceptively similar products by using the

trademark *Bright*, it has incurred losses, no material or evidence is let, worth inspiring the confidence of the Court.

31. In *ATUL RAWAL's case* (2 supra) the Delhi High Court held that in case of same class of goods, unless the descriptive mark attains a degree of secondary meaning, it will not constitute passing off, explained the same at para 22 of the said decision:

“22. An important aspect of this case is also that the rival word marks are concededly SUPERBRIGHT, which is a combination of two common words SUPER and BRIGHT. There is some association with the product, i.e. detergents, which cleanse articles such as clothes, and other objects. The descriptive association clearly is a claimed attribute of the product, i.e. its ability to cleanse the goods thoroughly (and therefore, the "bright"). The SUPER part of the mark, apparently is reference to the attribute of superlative (SUPER) performance of the detergent. In such cases, there is a body of authority starting with *Office Cleaning Service v. Westminster Window and General Cleaners* 1946 RPC 39 which says that unless a descriptive mark has acquired a degree of secondary meaning, the use by a competitor in the trade, with some modification does not constitute passing off. These judgments include *Victory Transport Co. Pvt. Ltd v. District Judge* AIR 1981 All 421; *Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratory* AIR 1965 SC 980 -where the rival marks included "Navratna" in relation to pharmaceuticals and *Universal Winding Co v. George Hattersley & Sons* 1915 (32) RPC 479. In a similar vein, in *Sona Spices Pvt. Ltd. v. Soongachi Tea Industries* 2007 (34) PTC 91, the aspect of the plaintiff being required to establish, even prima facie, reasonable likelihood of confusion, on an overall consideration of the circumstances, based

on the acquired distinctiveness and reputation of the trademark in question, was underlined.”

32. To put it succinctly, *Bright* being generic word and descriptive in nature, prima facie, there is no evidence that the trademark *Bright* being used by the plaintiff has attained secondary meaning nor it has become popular on its own way in the trade channels to enable it to use the trademark *Bright* to the exclusion of all others.

33. To the same effect is the decision in *SYKLINE EDUCATION INSTITUTE's case* (1 supra), wherein the Supreme Court held:

“18. In our opinion, the findings recorded by the learned Single Judge and Division Bench on the crucial factors like prima facie case, balance of convenience and equity are based on a correct and balanced consideration of various facets of the case and it is not possible to find any fault with the conclusions recorded by them that it is not a fit case for restraining the respondents from using the word 'Skyline' in the name of the institute established by them. It has not been disputed on behalf of the appellant that the word 'Skyline' is being used as trade name by various companies / organizations /business concerns and also for describing different types of institute/institutions. The voluminous record produced by the respondents before this Court shows that in India as many as 117 companies including computer and software companies and institutions are operating by using word 'Skyline' as part of their name/nomenclature. In United States of America, at least 10 educational/training institutions are operating with different names using 'Skyline' as the first word. In United Kingdom also two such institutions

are operating. In view of this, it is not possible to agree with the learned counsel for the appellant that the Skyline is not a generic word but is a specific word and his client has right to use that word to the exclusion of others.”

34. There is also no evidence that the trademark Bright being used by the plaintiff and the 1st defendant is either deceptively similar or creating confusion among the average customers and trade channels. Prima facie, the plaintiff failed to make out irreparable injury that has been caused to it by the use of trademark Bright by the 1st defendant with other descriptive expressions.

35. In *TRINETHRA SUPER RETAIL PRIVATE LIMITED's case* (3 supra) a Division Bench of this Court held that when plaintiff failed to discharge his burden to prove the prima facie case that the trade mark MEE TRINETRA used by the respondent is deceptively similar to that of the appellant's trademark, causing confusion in the average customers and also failed to make out irreparable injury that has been caused to them by the use of the trade mark "MEE TRINETHRA", the plaintiff is not entitled to equitable relief of injunction.

36. It is not the case of the plaintiff that the 1st defendant is using the trademark being used by the plaintiff with that of its descriptive expressions. What is being used commonly by both the parties is only the

trademark *Bright*. The plaintiff cannot claim exclusive protection for the word *Bright* as long as it is not registered independently. To claim exclusivity on the ground of passing off of goods the trademark *Bright* is required to be shown to become popular that it has attained secondary meaning by usage and evoke protection from the Court under common law remedy.

37. In *THREE N-PRODUCTS PRIVATE LIMITED's case (4 supra)*, the Delhi High Court held that an action for using a part of the word being copied by another is not available to the registered owner. At para 37 held thus:-

“.....If a registered mark is capable of being broken in parts, the registered owner may not sue for infringement upon a part being copied by another. Section 17(2)(a) of the Act does not leave any gap. But clause (b) disclaims only such matters as are common to the trade or are otherwise not distinctive and leaves room for a registered owner to cite some unique, distinctive matter being an element of the registered mark to claim exclusivity and pursue an action for infringement. It is more than likely that clause (a) is more apposite for word marks and clause (b) the more appropriate for device or label marks. It is an entirely different matter, however, that the word "Ayur" does not appear to be strong enough to slip through the window that clause (b) provides.”

38. To the same effect is the case law in *CARLSBERG vs. KHAITAN's case (5 supra)* the Division Bench of Delhi High Court considering

Section 17 of the Trademarks Act held that a registered proprietor of a composite mark cannot seek exclusivity with respect to individual components of the trademark. Para 28 and 29 reads thus:-

“28. Section 17 of the Trademarks Act 1999 makes it ample clear that a registered proprietor of a composite mark cannot seek exclusivity with respect to individual components of the trademark. Therefore, by logical extension, it is not open to Radico, which is the registered proprietor of the composite mark „8 PM“, to seek protection for infringement of its trademark by a third party who merely uses the numeral „8“, since no exclusivity can be claimed in a single numeral.

29. Therefore, in the present case, an action for trademark infringement in respect of the composite word mark „8 PM“ against Carlsberg, which uses the mark „PALONE 8“, where the only commonality between the two is the numeral „8“, must prima facie undoubtedly fail.”

39. In CHENNAI HOTEL SARAVANA BHAVAN's case (6 supra), this Court while considering similar issue as the one involved in this case at para 20 held thus:-

“20. At the outset, it must be remembered that for claiming exclusive right over a trademark, one has to register the same under the provisions of the Trade Marks Act. In the instant case, evidently, neither the plaintiff nor the defendants have registered their trademark under the provisions of the Act and the remedy for its infringement is a statutory remedy conferred on the registered proprietor of the said trademark for vindication of his exclusive right. The infringement of trademark can be noticed if the essential features of the

trademark of the plaintiff have been adopted by the defendant. On the other hand, an action for passing off is an action for deceit i.e., a passing off by a person of his own goods as those of another and this is a common law remedy and the defendants may escape the liability, if they show that the added matter is sufficient to distinguish his goods or characteristics viz., trade-dress, get up or additions, from those of the plaintiff.”

40. In ROHINI SEEDS's case (7 supra) this Court (speaking for myself) did not agree with the proposition that a registered trademark proprietor can stop all the others, whose trademark has slightest similarity with his trademark from doing business. At para 47 it was held thus:-

“47. The courts have to take into consideration along with prima facie case, the other two factors i.e. balance of convenience and irreparable loss. The plaintiff can always be compensated by costs, if in case ultimately it is found that the defendant tried to capture the market on the basis of the good will of the plaintiff.

The decision cited by the learned counsel for the respondent in Cadila Health Care Ltd., v. Cadila Pharmaceuticals Ltd., (supra) is also considered by the Division Bench of this Court in the aforesaid decision and came to the conclusion that unless prima facie plaintiff proves that there is deceptive alleging infringement, injunction cannot be granted. A person trading with a particular mark is entitled to insist that no one else should use that mark for trading in the same and similar commodity. If there is any infringement or the mark used by the other is deceptively similar to his mark in the sense that it nearly resembles his mark that is likely to deceive or cause confusion, he undoubtedly can ask the Court to restrain the other to trade with such

deceptively similar mark. However, it does not mean that a person who has a registered trademark can stop all the others, whose trademark has slightest similarity with his trademark, from doing business. The trial Court basing on the evidence, rightly came to the conclusion that only on the ground that RS2222 is the specific trademark of the respondent/plaintiff. The trial Court merely extracted the relevant provisions of the Trade Marks Act and extracted some paragraphs of decisions, and having found that the packing and logos are different, but erroneously granted injunction restraining the appellant from using the words 2222. The court below has also not found that the customers are likely to get confused by the use of words Deepika2222 for making out strong prima facie case and it is to be made out for grant of injunction. The respondent did not produce any material to show that their business has been adversely affected by the use of the words Deepika2222 by the appellant, much less have filed any affidavit stating that by the use of the same, a confusion is caused in the minds of general public or customers that the outlets run by the appellant or that of the respondent and thereby their business was affected adversely. Since prima facie case is not established, the question of considering the balance of convenience and irreparable loss does not arise. It is open for the respondent/plaintiff to produce sufficient evidence during the course of trial for establishing his case."

41. On the above analysis, it is held that the plaintiff-1st respondent cannot dissect the composite trademark and pick up the word Bright out of the composite word and seek the remedy of injunction restraining the defendants from using the word Bright, when no evidence is led to show

that the said trademark Bright which is generic word being descriptive in nature, prima facie, has attained the secondary meaning.

42. Accordingly, the points a) & b) are answered. When the plaintiff has not established prima facie case in his favour, the question of considering whether balance of convenience is in his favour or irreparable injury is caused to him or not, need not be gone into.

43. In the result, the injunction granted by the Court below in IA No.524 of 2013 in OS No.177 of 2013 is hereby set aside and the appeal is allowed. However, it is made clear that any expression of opinion made hereinabove is only for the purpose of disposal of this appeal. The Court below to dispose of the suit uninfluenced by any of the observations made above. Miscellaneous petitions, if any pending shall stand disposed of.

There shall be no orders as to costs.

Sd/- T.VENKATESWARA RAO
JOINT REGISTRAR

// TRUE COPY //

SECTION OFFICER

To

1. The III Additional Chief Judge, City Civil Court, Hyderabad ~~_____~~.
2. One CC to Dr.D.Venkat Reddy, Advocate (opuc)
3. One CC to Sri K.Hema Prakash Rao, Advocate (opuc)
4. Two C.D. Copies.

MRC

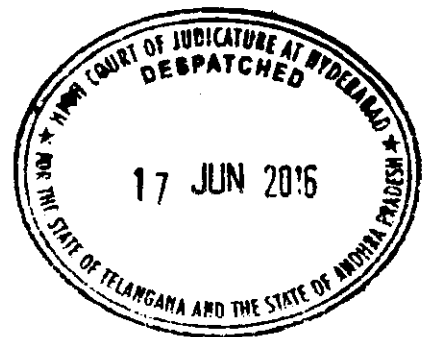
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HIGH COURT

DT: 29-04-2016

JUDGMENT

C.M.A.NO. 879 OF 2015



ALLOWING THE CMA
WITHOUT COSTS.

Handwritten signature
16/6/16