

Mex Switchgears Pvt. Ltd. Vs. Max Switchgears Pvt. Ltd.

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Court : Delhi

Decided On : Feb-25-2014

Judge : Manmohan Singh

Appellant : Mex Switchgears Pvt. Ltd.

Respondent : Max Switchgears Pvt. Ltd.

Judgement :

* IN THE HIGH COURT OF DELHI AT NEW DELHI % + Judgment pronounced on: February 25, 2014 I.A. No.10442/2013 in CS(OS) No.1299/2013 MEX SWITCHGEARS PVT LTD Plaintiff Through Mr. Shailen Bhatia, Mr. Amit Jain, Ms. Ekta Nayar and Mr. Vaibhav Kashyap, Advs. versus MAX SWITCHGEARS PVT LTD Defendant Through Mr. Vikas Chhabra, Adv. CORAM: HON'BLE MR. JUSTICE MANMOHAN SINGH MANMOHAN SINGH, J.

1. By this order, I propose to decide the pending interim application being I.A. No.10442/2013 filed by the plaintiff under Order XXXIX, Rules 1 and 2 of Code Of Civil Procedure 1908 (hereinafter referred to as CPC) in a suit for permanent injunction restraining infringement of trade mark, corporate name, copyright, passing off, rendition of accounts, delivery up etc.

2. The case of the plaintiff is that plaintiff i.e. Mex Switchgears Private Limited through its predecessor is the first adopter and user of the trade mark MEX since the year 1960 for electric switchgears, switches, ignition switches, electric

capacitors, electric meters, starting devices for electric motors etc. and various other electric goods. The plaintiff is also stated to be using the trade mark MEX on CFL bulbs, kitkats, fuses, distribution boxes, circuit breakers wires and cable miniature circuit breaker (MCBS), Control Panels for Meters and submersible pumps etc.

3. It has been stated by the plaintiff that the word MEX is an integral part of the corporate name of the Plaintiff Company since its incorporation in the year 1979 and that earlier to this, the Managing Director of the plaintiff i.e. Mr. Jai Krishan Saini had a partnership firm consisting of the name Mex Electro Corporation and the firm had adopted the trademark MEX in 1960. The plaintiff claims that it has an exclusive right over the word MEX both by virtue of trademark registration and presence of the word MEX in its corporate name.

4. The plaintiff has stated that it is a registered proprietor of various trademarks relating MEX under classes 7, 9 and 11 for various goods, details of which are given in Para 5 of the plaint and some of which are: trademark MEX (label) registered for electric switchgears and switches under class 9 as on 31st August 1962 bearing registration No.211055; trademark MEX registered for ignition switches, electric capacitors, electric plugs, electric distribution boards, electric meters and electric circuit breakers included in class 9 as on 28th July 1979 bearing registration No.351897; trademark MEX registered for electric motor (not for land vehicles) and parts thereof included in class 7 as on 4th August 1988, used since 1st April 1960, bearing registration No.495452; trademark MEX registered for gas stoves and parts thereof under class 11 as on 20th June 1983 bearing registration No.406916.

5. The plaintiff is also stated to have obtained registrations of its trade mark MEX in Nepal under classes 7 and 11. The plaintiff also holds a copyright registration of the artistic work titled MEX. The plaintiff has a huge sales turnover details of which are given in Para 12 of the plaint and the sales turnover for the year 2011-12 is stated to be ` 20,81,50,303/-. The plaintiff has widely advertised the trade mark MEX and the details of the advertisement and publicity expenses have been given in Para 13 of the plaint and the said expenses for the year 2011-2012 have been

stated to be `42,46,105/-.

6. It has been stated that the plaintiff has attained enviable reputation and goodwill for its trademark MEX and has successfully contested several oppositions in the trade mark registry from time to time on the basis of its prior adoption and use. Also in a suit preferred by the plaintiff against one Mr.Gopal Krishan using the trademark MAX standard as well as the corporate name MAX STANDARD SWITCHGEARS PVT. LTD., the plaintiff vide an order dated 22nd February, 1992 had got an injunction against the said defendant. The plaintiff states to have been always vigilant about protection of its trademark MEX.

7. It is the case of the plaintiff that its attention was drawn to the defendant company which has been incorporated only in the year 2011. The defendant had, according to the plaintiff, adopted an identical trade mark and also an identical corporate name. On the receipt of the said information the plaintiff addressed two notices dated 31st October, 2012 and 27th November, 2012 to the defendant, out of which though the first notice dated 31 st October, 2012 was served on the defendant, second returned as unserved.

8. It is the case of the plaintiff that the use of expression MAX, which is identical/deceptively similar to the registered trademark MEX of the plaintiff, either as a trademark or trade name by the defendant is bound to cause confusion and deception amongst the purchasing public and trade which leading to think that the defendants goods bearing the trademark MAX originate from the same source i.e. the Plaintiff. The presence of the word MAX in the corporate name of the defendant would also create deception and confusion and create an impression as if the defendant has some connection with the plaintiff.

9. The plaintiff contends that the trade mark MAX is visually, phonetically as well as structurally similar to the well known trade mark MEX of the plaintiff. The adoption of the trademark/trade name MAX by the defendant is with a dishonest motive to create mischief and to deceive the purchasing public by seeking to create an impression that its products are somehow connected with the plaintiff.

10. On the other hand, it is the case of the defendant that its directors are in the business of Heavy Electrical for the last many years and in the year 2011 the defendant took over the running business of its predecessor M/s MAX ELECTRICS which was one of the proprietary concerns of one of its directors who conceived the idea of starting the present business in the year 2000.

11. It has been stated that the product sold by the defendant bears only a device mark/logo which has been conceived and adopted by the defendant itself and that the aforesaid device mark/logo of the defendant is entirely different and has no visual or any kind of other similarity with any trademark(s) of the plaintiff.

12. It has also been stated that the defendant is a seller of well known prestigious heavy electrical goods and is the business of electrical and consulting engineers, electrical contractors, manufactures and supplier of electrical items used in medium to high transmission lines like vacuum circuit breaker (VCBs), load break switches and panels, unitised sub-stations and equipments etc. the said electrical products are heavy engineering products which are customised as per the requirements of the client which varies in each and every case depending upon industry to industry. So as per the defendant, the question of trademark infringement does not arise. Further, the products of the defendant are purely manufactured and sold on prior quotations and verifications and then orders are placed. It was stated that the products of petitioner do not bear any trademark identical or similar to MEX or any other similar or identical mark of the plaintiff.

13. It has been submitted that the defendant is in the business of switchgear items and the word switchgears is common to the entire industry dealing in such items and that the word MAX has been adopted from the common dictionary word MAXIMUM and there are number of business houses in the electrical line in the country that use the trade name MAX as a part of their business name. So the plaintiff could not be permitted to claim exclusive rights over such common names which are common in the industry. It is also stated that the defendant started the business in the year 2000 through its predecessor and later in the year 2011 the defendant was renamed and that since 2007, the website of the predecessor of the defendant is available. The plaintiff never raised an objection on the trade

name of the defendant and thus by conduct allowed the defendant to continue with the name MAX.

14. It has been averred that the defendant has a reputation of its own and has nothing to do with the business reputation/goodwill of the plaintiff. The details of the sales turnover of the defendant has been given in Para 23 of the written statement filed by the defendant and the sales turnover for the period 2012-13 is stated to be ` 6,40,99,240/-. It has been stated that the defendant has never adopted the trademark MAX for any of its goods and the product of the defendant are known for their quality and identified by its unique logo/device mark which has been invented by the defendant.

15. The following defences are raised by the defendant: i. The trade mark MAX is adopted by the defendant from the common dictionary. It was bonafide adoption as the same was adopted from the word MAXIMUM. ii. The trade mark MAX is not similar with the trade mark of the plaintiff i.e. MEX. iii. The mark MAX is common to the trade in the industry of Switch Gears. iv. The defendant started the business in 2000 through its predecessor and later in the year 2011 the defendant was renamed and since 2007 the website of the predecessor is available bearing the name MAX. v. There is delay of acquiescence on the part of the plaintiff to file the action. vi. This Court has no territorial jurisdiction to entertain and try the suit. vii. The defendant is selling heavy electrical goods and is in the business of electrical and consulting engineers, electrical contractors, manufacturers and supplier of electrical items used in medium to high transmission lines etc. Thus, the question of confusion and deception does not arise.

16. However arguments were addressed by the learned counsel for the defendant on points No.(i) to (iii) and (vii) only.

17. Before dealing with the defences raised by the defendant, it appears from the record that the plaintiff company through its predecessor has been using the trade mark MEX since the year 1960 in respect of electrical switchgears of various kinds, electrical meters, starting devices for electric motors and various other electrical goods. The plaintiff is also using the trade mark MEX in respect of CFL bulbs, fuses, distribution boxes, circuit breakers wires and cables miniature circuit

breaker etc.

18. The plaintiff is a registered proprietor of trade mark MEX in various trade marks, the details of which are mentioned in para 5 of the plaint in classes 7, 9 and 11 in respect of the registered goods mentioned above as well as other large number of specification of goods mentioned in the said para. The plaintiff has also given the details of expenses on advertisement and sale figures of the goods under the trade mark MEX in pars 12 and 13 of the plaint from the year 1960 to 2011-2012.

19. The trade mark of the plaintiff has been protected from time to by various courts including the Bombay High Court as well as District Court, Delhi. The details of the said protections are given in paras 15 and 16 of the plaint.

20. Before filing of the suit, the plaintiff also issued notices to the defendant not to use the trade mark MAX as well as part of corporate name, otherwise it would amount to infringement and passing off of the trade mark of the plaintiff. The case of the plaintiff is that the present case is a triple identity whereby two set of trade marks i.e. MEX and MAX are almost identical. The goods are also same goods and trade channel is also the same.

21. The goods of the plaintiff are admittedly sold in every nook and corner of India. The said fact has not been denied by the defendant during the course of hearing. The plaintiff states that the defendants predecessor or the defendant ought not to have used the trade mark MAX in relation to same goods as well as part of their corporate name as on the date of adoption they were fully aware about the goodwill and reputation of the plaintiff.

22. It is also argued by the plaintiff that the defendant has never used the trade mark MAX from the year 2000 as alleged by the defendant. They have been using the trade mark and corporate name Max Switchgears Pvt. Ltd. In any case, since the plaintiff is holding the registration of the trade mark MEX and corporate name Mex Switchgears Pvt. Ltd., the delay, if any, is not fatal to the case of the infringement of trade mark. Therefore, the plaintiff is pressing for injunction against the defendant.

23. The rival submissions of the defendant have been dealt with by the learned counsel for the plaintiff during the course of the arguments denying all the statements made in the written statement. It is argued by the learned counsel for the plaintiff that all the pleas raised by the defendant are false and frivolous and the same are not sustainable in law. The present case is a case of infringement also where the plaintiff has been able to establish a strong prima facie case against the defendant for using the identical trade mark and trade name in relation to the same goods and they are selling their goods in the same market. Counsel further states that it is immaterial if the goods of the defendant are heavy engineering products. Infringement of Trade Mark 24. It is the admitted position that the plaintiff is a registered proprietor of the trade MEX in respect of large number of goods i.e. electric switchgears, switches, ignition switches, electric capacitors, electric meters, starting devices for electric motors etc. and various other electric goods. The trade mark MEX is registered in various classifications of goods falling in classes 7, 9 and 11 including electric distribution boards, electric meters and electric circuit breakers. The registration of the plaintiff is not denied by the defendant. The defendant has not stated that the defendant has challenged the validity of the trade mark of the plaintiff. It is also the admitted position that the plaintiff and its predecessor have been using the trade mark MEX since 1960. The mark MEX is also dominant part of their corporate name. Under Section 31 of the Act, the registration is a prima facie evidence of its validity.

25. The law relating to infringement of a registered trademark has been envisaged under Section 29 of the Trade Marks Act, 1999 and exclusive rights granted by virtue of registration under Section 28 which reads as under:

29. Infringement of registered trademarks -

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which (a) is identical with or similar to the registered trade mark; and (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he (a) affixes it to goods or the packaging thereof; (b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark; (c) imports or exports goods under the mark; or (d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a

business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising- (a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or (b) is detrimental to its distinctive character; or (c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

28. Rights conferred by registration - (1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act. (2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject. (3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those person as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

26. By mere reading of these provisions, it is clear that a registered trademark is infringed by a person who not being a registered proprietor, uses in the course of trade a mark which is identical or deceptively similar in relation to the goods or services which are identical or similar to that in respect of which the trademark is

registered without the permission of the trademark owner.

27. So far as infringement qua different goods is concerned, separate enactment of Section 29(4) makes it clear that the strict rigors are prescribed as against the ordinary case of similar goods wherein a registered proprietor has to establish that the registered trademark has reputation in India and is of such a nature wherein the use of the mark by the other side without due cause would tantamount to taking unfair advantage or detrimental to the distinctive character or repute of a trademark.

28. A reading of Section 29(4) of the Act would reveal that the said protection qua different goods is earmarked by the Legislature for the trademarks which are either highly reputed or well known or famous trademarks and enjoy either high level of distinctiveness or the marks which are inherently distinctive in nature or has become distinctive due to their repute; the use of which will cause detrimental to the distinctive character and repute of the trademark only when the ingredients of Section 29(4) are satisfied conjunctively which is sub sections (a), (b) and (c) the infringement qua Section 29(4) in relation to different goods is attracted. In the present case, no doubt, in view of the goodwill, reputation, huge sale and advertisement, prime facie, it establishes that the trade mark MEX has acquired a unique name in the market and by virtue of that it is satisfied that it comes within the meanings of Section 29 (4) of the Act.

29. Section 29(5) of the Act, it is seen that it relates to a situation where (i) the infringer uses the registered trademark "as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern" and (ii) the business concern or trade is in the same goods or services in respect of which the trade mark is registered. If the owner/proprietor of the registered trade mark is able to show that both the above requirements exist then an injunction restraining order the infringer should be passed.

30. Recently in the case of Bloomberg Finance LP vs. Prafull Saklecha & Ors. 2013 (56) PTC243(Del), in para 51, after a long discussion on Section 29 of the Act, it was held as under:

51. The legal position emerging as a result of the above discussion may be summarised as under: (a) Section 29(5) of the TM Act 1999 relates to a situation where (i) the infringer uses the registered trademark "as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern" and (ii) the business concern or trade is in the same goods or services in respect of which the trade mark is registered. (b) This is in the nature of a per se or a 'no-fault' provision which offers a higher degree of protection where both the above elements are shown to exist. If the owner/proprietor of the registered trade mark is able to show that both the above elements exist then an injunction order restraining order the infringer should straightway follow. For the purpose of Section 29(5) of the TM Act 1999 there is no requirement to show that the mark has a distinctive character or that any confusion is likely to result from the use by the infringer of the registered mark as part of its trade name or name of the business concern. (c) However, in a situation where the first element is present and not the second then obviously the requirement of Section 29(5) is not fulfilled. Where the registered trade mark is used as part of the corporate name but the business of the infringer is in goods or services other than those for which the mark is registered, the owner or proprietor of the registered trade mark is not precluded from seeking a remedy under Section 29(4) of TM Act 1999 if the conditions attached to Section 29(4) are fulfilled. (d) Given the object and purpose of Section 29(1) to (4), Section 29(5) cannot be intended to be exhaustive of all situations of uses of the registered mark as part of the corporate name. Section 29(5) cannot be said to render Section 29(4) otiose. The purpose of Section 29(5) was to offer a better protection and not to shut the door of Section 29(4) to a registered proprietor who is able to show that the registered mark enjoying a reputation in India has been used by the infringer as part of his corporate name but his business is in goods and services other than that for which the mark has been registered.

31. It is settled law that in order to prove the case for infringement of trade mark, the plaintiff has to show that the essential features of the registered trade mark which has been adopted by the defendant has been taken out from the plaintiffs registration. Only the marks are to be compared by the Court and in case the registration is granted in favour of the plaintiff, he acquires valuable right by reason

of the said registration.

32. The test of comparison of the marks side by side is not a sound one since a purchaser will seldom have the two marks actually before him when he makes his purchase. The eye is not an accurate recorder of visual detail and that marks are remembered rather by general impression or by some significant detail than by any photographic recollection of the whole. While judging the question as to whether the defendant has infringed the trade mark by colourable imitation of the mark or not, the Court has to consider the overall impression of the mark in the minds of general public and not by merely comparing the dissimilarities in the two marks.

33. In *K.R. Chinna Krishna Chettiar v. Sri Ambal & Co.*, AIR 1970 SC146 the Supreme Court held that ocular comparison is not always the decisive test. Resemblance between the two marks must be considered with reference to the ear as well as to the eye. In this case, the Registrar held that the sound of AMBAL does not so nearly resemble the sound of ANDAL in spite of certain letters being common to both the marks, as to be likely to cause confusion or deception. The Registrar thus found that the marks were not deceptively similar. But on appeal both the Single Judge and Division Bench found deceptive similarity. The Supreme Court, dismissed the appeal, and held that there was a striking similarity and affinity of sound between the word Andal and Ambal and held that there was a real danger of confusion between the two marks.

34. The following are the judgments are relevant to be referred to for the purpose of grant of relief in the cases of infringement of the trade marks: i. *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories* AIR 1965 SC980 it was held in Para 28 that:

28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a

statutory right under s. 21 in respect of a registered trade mark and also of a passing off by the use of the same make. The finding in favour of the appellant to which the learned Counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in their colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy in the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods (Vide s. 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the *sine qua non* in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's 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 plaintiff's 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 make 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 ii. In the case of *American Home Products v. Mac Laboratories* AIR 1986 SC137 in Para 36 it was held as under:

When a person gets his trade mark registered, he acquires valuable rights by reason of such registration. Registration of his trade mark give him the exclusive right to the use of the trade mark in connection with the goods in respect of which it is registered and if there is any invasion of this right by any other person using a mark which is the same or deceptively similar to his trade mark, he can protect his trade mark by an action for infringement in which he can obtain injunction....

iii. In the case of *National Bell Co. v. Metal Goods Mfg. Co.* AIR 1971 SC898 at page 903 it was held as under:

On registration of a trade mark the registered proprietor gets under Section 28 the exclusive right to the use of such trade marks in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of any infringement of such trade mark.

iv. *M/s Avis International Ltd. vs. M/s Avi Footwear Industries and another*, reported in AIR1991 Delhi 22, the relevant paras of which read as under:

14. At this stage of the case, we have no affidavit against another affidavit, and in view of the statutory provisions of Ss. 28 and 31 of the Trade and Merchandise Marks Act, it would be appropriate to rely upon contentions of the plaintiffs.

15. It is apparent that the word AEVI is not a commonly used word. The word is not in a dictionary. Its adoption by the defendants, therefore, needed to be explained, which the defendants have not explained in the pleadings before the Court.

16. Phonetically the word AVIS, which is registered mark for footwear, and the word AEVI'S have to be pronounced identically. The business name of the defendants is known as AVI Footwear Industries. Prima facie, if it was the intention of the defendants by affixing the label AEVI'S on the footwear made by them was to indicate that the footwear carrying that label is made by the AVI Footwear Industries, then the mark they would have adopted would have been AVI, but that they have not done. They have tried to bring their mark/ label as close as possible phonetically to the registered mark AVIS.

17. In my view, the statutory monopoly which has been conferred upon the plaintiffs in connection with use of the mark AVIS for any other consideration in relation to grant or non-grant of an injunction, especially when the matter is at an interlocutory state, and is yet to be tried, and it cannot be foreseen as to whether the defendants who seek rectification of the plaintiffs mark, on account of nonuser would be able to prove their case. The statutory registration establishes prima facie case in favour of the plaintiffs.

18. In this view of the matter, I think that the balance of convenience would be in favour of the plaintiffs, to ensure that by concurrent user, during the period of the trial, no other rights come into existence. In my view, it is very convenient, if the defendants are so minded, to adopt any other label that establishes a connection in the course of trade with respect to the footwear manufactured by them.

In view of the above said facts and circumstances, it is held that two marks MEX and MAX visually, phonetically and structurally are deceptively similar. The use of the trade mark MAX by the defendant in relation to same/similar goods as well as dominant part of its corporate name amounts to infringement of trade mark of the plaintiff. In case the defendant is allowed to use the deceptively similar trade mark, there would be confusion and deception. **PASSING OFF**³⁵ The following are the essential characteristics of an action of passing off:(A) In *Erven Warnink B.V. v. J.*

Townend & Sons (Hull) Ltd., 1980 RPC³¹ Lord Diplock stated the essential characteristics of a passing off action as under:

"1. misrepresentation, (2) made by a person in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so."

(B) The essentials of passing off action in Halsbury's Laws of England Vol. 38 (3rd Edition) para 998 as given below are worth noting:

998. Essentials of the cause of action The plaintiff must prove that the disputed name, mark, sign or get up has become distinctive of his goods in the sense that by the use of his name or mark, etc in relation to goods they are regarded, by a substantial number of members of the public or in the trade, as coming from a particular source, known or unknown; it is not necessary that the name of the plaintiff's firm should be known.....The plaintiff must further prove that the defendant's use of name or mark was likely or calculated to deceive, and thus cause confusion and injury, actual or probable, to the goodwill and the plaintiff's business, as for example, by depriving him of the profit that he might have had by selling the goods which ex hypothesi, the purchaser intended to buy. Thus, the cause of action involves a combination of distinctiveness of the plaintiff's name or mark and an injurious use by the defendant of the name or mark or a similar name or mark, sign, picture or get-up does or does not amount to passing off is in substance a question of evidence; the question whether the matter complained of is likely to deceive is a question for the Court.

36. The test of confusion and deception in order to prove the case of passing off has been very well discussed in the case of Laxmikant V. Patel vs. Chetanbhai Shah And Another, a judgment delivered by the Supreme Court, reported in (2002) 3 SCC65 wherein the Apex Court while considering a plea of passing off and grant of ad interim injunction held in no uncertain terms that a person may sell his goods or deliver his services under a trading name or style which, with the passage of time, may acquire a reputation or goodwill and may become a property to be protected by the Courts. It was held that a competitor initiating sale of goods or

services in the same name or by imitating that name causes injury to the business of one who has the property in that name. It was held that honesty and fair play are and ought to be the basic policy in the world of business and when a person adopts or intends to adopt a name which already belongs to someone else, it results in confusion, has the propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury. It was held that the principles which apply to trade mark are applicable to trade name also. Relevant para 10 of the aforesaid judgment reads as under:- The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that his goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.

In this case, the Apex Court further observed that:

Where there is probability of confusion in business, an injunction will be granted even though the defendants adopted the name innocently.

In another case of passing off, a Division Bench of this Court in the case of B.K.Engineering Co. vs. Ubhi Enterprises and Anr., reported in 1985 PTC1 in para-57 inter alia it is held that trading must not only be honest but must not even unintentionally be unfair.

37. In the case of Essel Packaging Ltd. v. Essel Tea Exports Ltd., 1999 PTC (19) 521, the High Court of Bombay after considering Kirloskar Diesel Recon Pvt. Ltd. vs. Kirlosker Proprietary Ltd. and Bajaj Electricals Pvt. Ltd. vs. Metals and Allied Projects, held, that common field of activity is not conclusive for deciding whether there can be passing off action, although at one point of time the said test was treated as conclusive. It was held that with the passage of time the law of requirement of common field of activity in a passing off action has undergone a

radical change and as such there was no requirement for a common field of activity to found a claim on passing off action, because the real question in each of such cases is, whether there is, as a result of mis-representation, a real likelihood of confusion or deception of the public and consequent damage to the plaintiff is likely to be caused and if that is taken to be the test then the focus is shifted from the external objective test of making comparison of activities of the parties, to the state of mind of public, in deciding whether it will be confused. Applying these principles the injunction in favour of the plaintiff was granted.

38. As already held that the defendant is guilty of infringement of trade mark, it is also clear that the defendant is passing its goods as that of the plaintiff who has been able to make out a strong prima facie case for passing off against the defendant. The fact remains that the descriptions of goods of both the parties are almost same. Therefore, even the defendants are using the deceptively similar trade mark MAX. Being heavy engineering products is also immaterial as there would be confusion and deception if the defendant is allowed to use the trade mark in relation to electrical contractors, circuit breaker (VCBs), load break switches, panels and unitised sub-stations. The justification given by the defendant that it has bonafide adopted the trade mark MAX from the common word MAXIMUM is also without any substance because of the reason that the defendant has been using the trade mark MAX in relation to similar goods and not the mark MAXIMUM. The defendant is also using the trade mark MAX as dominant part of its corporate name which amounts to infringement under Section 29(5) of the Act. Therefore, the adoption and use of the name MAX is not bonafide. It is also pertinent to mention that on the date of adoption of the trade mark MAX either by the defendants predecessor or by the defendant in the year 2011, they were fully aware about the trade mark and trading style of the plaintiff as the said name was extensively advertised in the area of Tamil Nadu. Thus, prima facie the plaintiff has been able to establish strong case for passing off.

Trade Name 39. The defendants contention has no force that since the name was registered under the Companies Act and under various provisions the defendant is entitled to use the name of the company, therefore, this Court should not pass the injunction order in view of settled law laid down by various High Courts in India. It is not denied by the defendant that the mark MAX is used by the defendant as

dominant and essential part of its corporate name. Few judgments in this regard are as under:1. In K.G. Khosla Compressors Ltd. vs. Khosla Extraktion Ltd., reported in AIR1986 Delhi 181, D.P. Wadhwa, J., of this Court restrained the use of the KHOSLA as part of the corporate name of the defendant despite the fact that the fields of activity of both parties were entirely different (compressors v extraction business).

2. In Montari Overseas Ltd. vs. Montari Industries Ltd., reported in 1996 PTC (16) 142, a Division Bench of this Court restrained the defendant from using Montari as part of its corporate name. The Court held that remedies under Section 22 of the Companies Act and common law of passing off operate in different fields. The Court relied upon the decision of K.G. Khosla Compressors Ltd. vs. Khosla Extraktion Ltd. (supra). The areas of operation of the two concerns were also different.

3. In Kirloskar Diesel Recon P. Ltd. vs. Kirloskar Proprietary Ltd., reported in 1997 PTC (17) 469, S.M. Jhunjhunwala held that under the Trade & Merchandise Marks Act, 1958 the term trade mark in Section 105(c) would include the trade name also. The Court accordingly restrained the defendant from using KIRLOSKAR as part of its corporate name in an action for passing off and infringement. This decision was cited with approval by the Supreme Court in Mahendra & Mahendra Paper Mills Ltd. vs. Mahindra & Mahindra Ltd.

40. Section 20 of the Companies Act, 1956 reads as under:

20. Companies not to be registered with undesirable names.-(1) No company shall be registered by a name which, in the opinion of the Central Government, is undesirable. (2) Without prejudice to the generality of the foregoing power, a name which is identical with, or too resembles, - (i) the name by which a company in existence has been previously registered; or (ii) a registered trade mark, or a trade mark which is subject of an application for registration, of any other person under the Trade Marks Act, 1999, may be deemed to be undesirable by the Central Government within the meaning of sub-section (1). (3) The Central Government may, before deeming a name as undesirable under clause (ii) of sub-section (2), consult the Registrar of Trade Marks.

Sub-section (2) (ii) of the said provision was incorporated with effect from September 15, 2003 when the Trade Mark Act, 1999 came also into operation from the said date. The said provision mandates that the companies not to be registered if a name is identical with or too nearly resembles the name which has been previously registered or a registered trade mark or a trade mark which is a subject of an application for registration under the Trade Marks Act, 1999.

41. It appears that the said provision of sub-section (2) of Section 20 was incorporated in order to avoid the civil litigation before the Court and duty was cast upon the Registrar of Companies to apply its mind at the time of granting the registration of the name of the company. In the present case, it is undisputed fact that when the defendant company was incorporated in the year 2007, the plaintiff was registered proprietor of two trade marks. The trade marks and trade names used by both the parties are almost identical, thus, it is evident that the Registrar of Companies granted the registration contrary to Section 20 of the Indian Companies Act. The Registrar of Company by complying the provisions of Section 20(2) (ii) obtained the search report from the office was Trade Marks Registration, the registration of the name of the company of defendant No.1 would not have been issued under the mandatory provision and litigation could have been avoided however, it did not happened despite of direction issued by the Apex Court and in various other cases and mandatory provisions of various Acts. Thus it appears to the Court that use of corporate name which formed part of a similar registered trademark of the plaintiff amounts to infringement and passing off of the registered trademark of the plaintiff. Territorial Jurisdiction 42. Sub-section (2) of Section 134 enacts that for the purposes of clauses (a) and (b), the term District Court having jurisdiction would include a District Court within the local limits of whose jurisdiction, the person or one of the persons instituting the suit or proceeding actually and voluntarily resides or carries on business or personally works for gain. The law in this respect, which is similar to Section 62 of the Copyright Act, makes a departure from the general law contained in the Code of Civil Procedure 1908 regarding jurisdiction. See *Gharkul Utadane v. Kharpe Gruh Udyog*, (1997) IPLR13 where the Bombay High Court held that it had no jurisdiction under Section 62 of the Copyright Act, revoking the leave granted.

43. In terms of Section 134, it would appear that the plaintiff has an option of the forum for institution of suit. In respect of the suit for infringement of a registered trade mark or relating to any right in a registered trade mark, at the option of the plaintiff, the suit may be filed in any court not inferior to the district court having jurisdiction, within the local limits of whose jurisdiction, the plaintiff resides or carries on business. On the other hand, in respect of matters specified in clause (c) of sub-section (1) namely a passing of action based on a registered or unregistered trade mark, the suit will have to be filed only in the appropriate district court having jurisdiction in terms of the CPC. Under Section 20 of CPC, the suit is to be instituted in the court within the local limits of whose jurisdiction the defendant at the time of the commencement of the suit actually or voluntarily resides or carries on business.

44. In *Exphar SA v. Eupharma Laboratories Ltd.*, (2004) 3 SCC688 the Supreme Court has held that when an objection to jurisdiction is raised, the Court can proceed on the basis that the facts as pleaded by the initiator of the impugned proceedings are correct.

45. In *Shri Rajmoti Industries v. Rajmoti Oil Mill Pvt. Ltd.*, 2005 (3) PTC38(Del.), where the plaintiff had averred in its plaint that it carried on business in Delhi and had referred to its two distributors for the purpose, it was taken as a sufficient compliance of the provisions of Section 134(2) of the Trade Marks Act, 1999.

46. Sub-section (2) of Section 134 has thus been construed to be much wider than normal grounds as laid down under Section 20 the CPC. The permissive provision allowing the person to file the suit or other proceedings where he carries on business or works for gain would not be limited to the carrying on of business in respect of the goods involved. After all, no such limitation is attached to these words.

47. It is not denied by the defendant during the course of hearing that the plaintiffs goods are available in every nook and corner of India including in the State of Tamil Nadu from where the defendant is carrying on its business. Thus, the plaintiff is entitled to invoke the territorial jurisdiction of this Court under Sub-Section (2) of Section 134 of the Act. The plaintiff has invoked the jurisdiction of

this Court by alleging that the plaintiff has its branch office in Delhi and its goods are also being sold in Delhi. The plaintiff has also many dealers in Delhi. The defendant is selling its goods in clandestine manner in Delhi. It is further stated that the name of the defendant company is available on the internet site of Registry of companies which accessible in Delhi. Though the issue of territorial jurisdiction is not argued by the counsel for the defendant, however since it was one of the pleas was taken in the written statement, thus the same is dealt with. In view of the settled law, prima facie this Court finds that this Court has got the territorial jurisdiction. However, issue of jurisdiction has to be decided after framing of issues when the matter is taken for final disposal of the suit. The said issue as raised by the defendant is thus kept open. Common to the Trade 48. The case of the defendant in the written statement is that the mark MAX is common to the trade and there are many companies who have been using the mark MAX as part of their corporate names or the firm names. The defendant has also filed list of companies taken from the internet in order to show that there are many companies who have been using their trading style/trade name/corporate name in which MAX forms part of it. However, during the course of arguments, no document was pointed out by the learned counsel for the defendant as to whether the said firm/trading style/corporate name are still carrying on their business or not. No documentary proof about their user has been produced by the defendant along with list of documents.

49. Learned counsel for the plaintiff states that the plaintiff is very much vigilant about their trade mark/trade name MEX and plaintiff has been taking actions from time to time as and when the plaintiff comes to know about the offending activities of any trader who is either using the trade mark MEX or deceptively similar mark.

50. Law of publici juris has been discussed in various cases and the Courts have given their respective findings to the effect that a party who has taken the defence of publici juris has to prove his case. The same has been dealt with by the Supreme Court and various High Courts in the following cases: a) In Corn Products Refining Co. v. Shangrila Food Products Ltd., 1960 SC142 it has been held as under:

15. The series of marks containing the common element or elements therefore only assist the applicant when those marks are in extensive use in the market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now in the present case the applicant, the respondent before us, led no evidence as to the user of marks with the common element. What had happened was that Deputy Registrar looked into his register and found there a large number of marks which had either 'Gluco' or 'Vita' as prefix or suffix in it. Now of course the presence of a mark in the register does not prove its user all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register. If any authority on this question is considered necessary, reference may be made of Kerly p. 507 & Willesden Varnish Co. Ltd. v. Young & Marten Ltd., (1922) 39 RPC285at p.

389. It also appears that the appellant itself stated in one of the affidavits used on its behalf that there were biscuits in the market bearing the marks Glucose Biscuits, Gluco biscuits and Glucoa Lactine biscuits. But these marks do not help the respondent in the present case. They are ordinary dictionary words in which no one has any right. They are really not marks with a common element or elements. We, therefore, think that the learned appellate Judges were in error in deciding in favour of the respondent basing themselves on the series marks, having Gluco or Vita as a prefix or a suffix. b) The Supreme Court set aside the judgment of the Division Bench of this Court and restored the order of the Learned Single Judge. The Supreme Court dealt with the finding of the Division Bench that trademarks with the prefix or suffix 'Gluco' and 'Vita' were common features of the trade and could not be associated only with the appellant's product, and observed thus:

The second point on which the learned appellate Judges based themselves in arriving at the conclusion that there was no reasonable apprehension of confusion or deception was, as we have earlier stated, that there were various trademarks with a prefix or suffix 'Gluco' or 'Vita' and that made it impossible to say that the common features 'Glu' and 'Vita' were only associated with the appellant's products. This view was founded on a passage which the learned appellate Judges quoted from Kerly on Trade Marks, 7th Edn., p.624. That passage may be

summarized thus: Where there are a "series of marks, registered or unregistered, having a common feature or a common syllable, if the marks in the series are owned by different persons, this tends to assist the applicant for a mark containing the common feature. This statement of the law in Kerly's book is based on *In re: an Application by Beck, Koller and Co. (England) Ltd.* (1947) 64 R.P. C.

76. It is clear however, from that case, as we shall presently show, that before the applicant can seek to derive assistance for the success of his application from the presence of a number of marks having one or more common features which occur in his mark also, he has to prove that these marks had acquired a reputation by user in the market.

(emphasis supplied) c) *In Express Bottlers Services Pvt. Ltd. v. Pepsi Inc. and Ors.*, 1989 (9) PTC14it has been held as under.

50. .To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks. The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This court is inclined to accept the submissions of the respondent No.1 on this pointThe respondent No.1 did not lose its mark by not proceeding against insignificant infringers d) *Rolex Sa v. Alex Jewellery Pvt. Ltd. and Ors.*, 2009 (41) PTC284(Del).

22. The next aspect to be considered is the effect/impact, if any, of a large number of other persons using the word ROLEX as claimed by the defendant. At this stage, this plea will be examined believing the same to be true. In my view, the

same would be immaterial. Firstly, nothing has been shown that any of the said users has any significant presence. Secondly, it is now well settled in Honda (supra) in turn relying upon Indian Shaving Products Ltd Vs Gift Pack that merely because the plaintiff who is otherwise found entitled to the interim injunction is shown to have not taken any step against other infringers is no ground to deny relief to the plaintiff. It cannot also be said that the plaintiff's trademark has lost its distinctiveness for the said reason. The reply affidavit of the plaintiff lists the orders of the Trade Mark Registry from 1964 to 2000, where plaintiff's mark has been protected inter alia for reason of having great reputation. It also shows that the plaintiff has been enforcing its rights. Though the list filed by defendant No.1 in this regard is long but a perusal thereof shows a number of applicants to have abandoned or withdrawn their applications. This is a vast country. Mere long list of applicants/registrants of mark, without any extensive use of the mark, cannot dent the distinctive character or repute of the mark.

Similar view was taken by this court in various cases reported in 2009 (41) PTC57 Novartis AG v. Crest Pharma Pvt. Ltd. and Anr., 93 (2001) DLT406 Bhagwan Dass Gupta v. Shri Shiv Shankar Tirath Yatra Company Pvt. Ltd., 1998 PTC18 Indian Shaving Products Ltd. & Anr. v. Gift Pack & Anr., and 2008 (38) PTC49(Del.) (DB) Pankaj Goel v. Dabur India Ltd.

51. As the defendant has failed to produce any evidence of the actual use of the mark MAX by third parties, the mark MAX is common to the trade in an action for passing off is not available. Further the present suit is also for infringement of trade mark which is filed on the basis of exclusive and statutory rights granted in favour of the plaintiff under Section 28 of the Act. Thus, there is no force in the submission of the defendant that the mark MAX is common to the trade and the defendant is entitled to use the same. Delay and Acquiescence 52. In the written statement, the defendant has made the statement that the defendant started business in 2000 through its predecessor and later in the year 2011 the defendant was renamed as Max Switchgears Pvt. Ltd. It is also alleged that since 2007 the website of the predecessor is available bearing the name MAX. In support of his submissions, the defendant has filed certain documents by list of dates dated 23rd September, 2013. First document is certificate dated 21st May, 2013 issued by

the Chartered Accountant in which the statement of sales turnover and net profit is shown from the year 2007-2008. The defendant has also filed few invoices from the year 2007 to 2013 with regard to the sale of Transformer Switch Board and other related material. No other document has been filed by the defendant to show the user of the predecessor earlier to the year 2007. Even the defendant has also not filed the advertisement figures or any newspaper or cogent and clear evidence in order to show that the defendant and its predecessor have been using the trade mark/trade name MAX since the year 2000 as alleged by the defendant in the written statement. Even if the face value of the documents is taken as correct, the said documents about the use of the mark MAX by the predecessor are from the year 2007 to 2010 and about the use of mark MAX by the defendant are from the year 2011 to 2013.

53. On the other hand, the plaintiff has filed large number of newspapers and evidence in order to show that the plaintiff's mark MEX was being advertised in the same are from where the defendant is carrying on its business. The said advertisements are advertised in the well-known newspaper bearing the mark MEX and in its corporate name Mex Switchgears Pvt. Ltd.

54. From the said evidence filed by the defendant, one can easily get the impression that on the date of adoption of the trade mark by the defendant's predecessor or the defendant from the year 2011, they must be aware about the user of trade mark MEX by the plaintiff. Even otherwise, the delay, if any, as per settled law in a case of infringement is not fatal because of the reason that in trade mark cases, the cause of action is a recurring cause of action. Few decisions on this aspect of delay and acquiescence are referred to as under: a) In the case of Midas Hygiene Industries Pvt. Ltd. vs. Sudhir Bhatia and others, 2004 (Vol.28) PTC121 relevant para-5 of the said judgment is as under:

5. The law on the subject is well settled. In cases of infringement either of Trade Mark or of Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the Mark was itself dishonest.

b) In the case of Swarn Singh vs. Usha Industries (India) and Anr., AIR1986 Delhi Page No.343 (DB) it was held as under :

There is then the question of delay. Learned counsel for the respondents had urged that the delay is fatal to the grant of an injunction. We are not so satisfied. A delay in the matter of seeking an injunction may be a ground for refusing an injunction in certain circumstances. In the present case, we are dealing with a statutory right based on the provisions of the Trade and Merchandise Marks Act, 1958. An exclusive right is granted by the registration to the holder of a registered trade mark. We do not think statutory rights can be lost by delay. The effect of a registered mark is so clearly defined in the statute as to be not capable of being misunderstood. Even if there is some delay, the exclusive right cannot be lost. The registered mark cannot be reduced to a nullity..

c) In the case of Hindustan Pencils Pvt. Ltd. Vs. M/s India Stationery Products Co., AIR 1990 DELHI19 it was held as under :

.. It was observed by Romer, J.

in the matter of an application brought by J.R. Parkinson and Co. Ltd., (1946) 63 RPC171 at page 181 that in my judgment, the circumstances which attend the adoption of a trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently. It was further noted by the learned Judge in that case that he could not regard the discreditable origin of the user as cleansed by the subsequent history.

d) In the case of M/s. Bengal Waterproof Lim. Vs. M/s. Bombay Waterproof Manufacturing Co. AIR 1997 SC1398 it was held as under :

20...It is now well settled that an action for passing off is a common law remedy being an action in substance of deceit under the Law of Torts. Wherever and whenever fresh deceitful act is committed the person deceived would naturally have a fresh cause of action in his favour. Thus every time when a person passes

off his goods as those of another he commits the act of such deceit. Similarly whenever and wherever a person commits breach of a registered trade mark of another he commits a recurring act of breach or infringement of such trade mark giving a recurring and fresh cause of action at each time of such infringement to the party aggrieved. It is difficult to agree how in such a case when in historical past earlier suit was disposed of as technically not maintainable in absence of proper relief, for all times to come in future defendant of such a suit should be armed with a license to go on committing fresh acts of infringement and passing off with impunity without being subjected to any legal action against such future acts.

55. In the absence of any cogent and clear evidence for the user claimed by the defendant since 2000 by its predecessor, the benefit of the same cannot be granted to the defendant. It appears from the record that the some invoices and sale figures certified by the chartered accountant are available from the year 2007 only. The said user even taken as correct from the 2007 is not fatal in an action for infringement in view of the above mentioned settled law. It is also pertinent to mention that no evidence is placed on record by the defendant to show that the plaintiff was aware about the defendants user from the year 2007. Thus, the plea of delay and acquiescence is also rejected.

56. In an action for infringement, the plaintiff must no doubt make out that the use of the defendants mark is likely to deceive, but where the similarity between the plaintiffs and the defendants mark is so close either visually, phonetically or otherwise that 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 on the registered proprietor of the mark, would be immaterial.

57. In view of the above said facts and circumstances of the matter, it appears that the plaintiff has been able to make a strong prima facie case in its favour and

against the defendant being the registered proprietor of the trade mark MEX in relation to same goods as well as allied and cognate goods falling in class 7, 9 and 11. The balance of convenience also lies in favour of the plaintiff and against the defendant. If the interim order is not passed, the plaintiff will suffer irreparable loss and injury. On the other hand, the defendant will continue to use the said trade mark/trade name MAX in relation to the same goods as well as a dominant part of its corporate name. Therefore, prima facie a strong case for passing an adinterim order has been made out by the plaintiff. Accordingly, till the disposal of the suit, the defendant, its servants, agents, dealers, distributors and all others persons acting for and on its behalf from manufacturing, selling, offering for sale and directly or indirectly dealing with electrical goods i.e. switchgear, switches and other allied and cognate goods under the trade mark MAX as well as from using the same as dominant part of its corporate name. The defendant is also restrained from using any deceptively similar trade mark which may amount to infringement of plaintiffs registered trade mark No.211055 in class 9 as well as passing of its goods as that of the plaintiff and from doing any other thing which is likely to create confusion and deception.

58. In the interest of justice, six months time is granted to the defendant to dispose of the existing stock and to change the trade mark and trade name of the defendant.

59. The application is disposed of. The findings arrived by this Court are tentative and shall have no bearing when the matter shall be considered at the final stage after trial in the matter 60. No costs. I.A. No.16626/2013 Exemption allowed, subject to all just exceptions. The application is disposed of. CS(OS) No.1299/2013 List the matter before the roster Bench for framing of issues on 14th July, 2014. (MANMOHAN SINGH) JUDGE FEBRUARY25 2014

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