SooperKanoon - India's Premier Online Legal Search - sooperkanoon.com

Kewal Krishan Kumar and anr Vs. Rudi Roller Flour Mills

Kewal Krishan Kumar and anr Vs. Rudi Roller Flour Mills

SooperKanoon Citation : sooperkanoon.com/1171037

Court : Delhi

Decided On : Aug-13-2014

Judge : G.P. Mittal

Appellant : Kewal Krishan Kumar and anr

Respondent : Rudi Roller Flour Mills

Judgement :

* IN THE HIGH COURT OF DELHI AT NEW DELHI Pronounced on:

13. h August, 2014 + CS (OS) No.393/ 2003 KEWAL KRISHAN KUMAR AND ANR. Through: ..... Plaintiff Mr. M.K. Miylani, Advocate Versus RUDI ROLLER FLOUR MILLS Through ..... Defendant Ex-parte CORAM: HON'BLE MR. JUSTICE G.P. MITTAL1 This suit for perpetual injunction restraining infringement of trade mark, passing off, damages and rendition of accounts has been filed by the Plaintiffs against the Defendant alleging that the trade mark SHAKTI BHOG was adopted by M/s Kumar Dal Mills in the year 1975. M/s Kumar Dal Mills was a partnership firm of Plaintiff No.1 and his two brothers Jagmohan Kumar and Shri Harbans Lal Kumar. The two brothers retired from the firm and Plaintiff No.1 became the sole proprietor in respect of the trade mark SHAKTI BHOG. Plaintiff No.2 was incorporated as a company whereof Plaintiff No.1 is the Managing Director since its inception till the filing of this suit and even till recording his evidence as PW-1.

2. It is stated that the trade mark SHAKTI BHOG has been in continuous and extensive use in respect of goods, namely, flour (atta), gram flour (besan), dal, maida, sooji, rawa, bran and other preparations made therefrom and other cereals etc.

3. The trade mark SHAKTI BHOG is duly registered under No.391844 in Class 30 from 16th June, 1980 in respect of flour, dal (broken grains), besan and other preparations made from cereals under the provisions of the Trade and Merchandise Marks Act, 1958 (the Act). The said trade mark is valid, subsisting and effective throughout India. Trade mark SHAKTI BHOG was registered under No.472286 in Class 30 in respect of goods including coffee, tea, salt, spices, condiments, baking powder, yeast, mustard, vinegar, pepper, sauces, spices, honey, bread, biscuits, cakes, pastry and confectionery etc. from 15.05.1987.

4. It is averred that Plaintiff No.1 has given wide publicity to the trade mark SHAKTI BHOG and its sale had risen from over Rs. 10 lacs in the year 1975-76 to over Rs. 19 crores in the year 1993-94. After Plaintiff No.2 company was incorporated, its sales increased from over Rs. 38 crores in the year 1996-97 to Rs. 697 crores in the year 2005-06. The advertisement expenditure had also risen from over Rs. 86 lacs in the year 1996-97 to over Rs. 1 crore 64 lacs in the year 2005-06.

5. It is pleaded that the trade mark SHAKTI BHOG is exclusively identified and associated with Plaintiff No.2 and adoption of the trade mark SHIV SHAKTI by the Defendant is only to trade upon and benefit from the Plaintiffs hard earned goodwill and reputation to which the Defendant is not entitled.

6. It is the case of the Plaintiffs that on 18.11.1995, trade mark SHIV SHAKTI was advertised in the trade mark journal for registration in the name of Defendant in respect of the same goods for which the trade mark SHAKTI BHOG of the Plaintiffs was registered. The Plaintiffs filed notice of opposition which was contested by the Defendant. The Assistant Registrar of Trade Marks, however, dismissed the opposition and proceeded to register the trade mark SHIV SHAKTI in the name of the Defendant. The Plaintiffs were unsuccessful in an appeal decided in CM (M) No.550/ 2002 by a learned Single Judge of this Court by an

order dated 21.11.2002. The second appeal being OCJA No.1/ 2003 was also dismissed by the Division Bench by an order dated 27.09.2007.

7. The Defendant has contested the suit by way of filing a written statement and it denied that the trade mark SHIV SHAKTI registered in the name of the Defendant was deceptively or confusingly similar to the trade mark SHAKTI BHOG of the Plaintiffs. It has been stated that the Defendant being the adopter of composite label SHIV SHAKTI with the device of Trishool and Damroo since the year 1990 has honestly adopted the trade mark which was not only allowed to be registered by the Registrar of Trade Marks, but also the first and second appeals preferred by the Plaintiffs were also dismissed. It has also been stated that not only his trade mark is distinguished from that of the Plaintiffs, the customers of the Plaintiffs and the Defendant are also different as the Defendant was mainly selling the goods in gunny bags of 20 kgs. whereas the Plaintiffs line of activities was restricted to kirana products and food products in gunny bags of 5 and 10 kgs. The Defendant thus, prayed for dismissal of the suit.

8. In the replication, the Plaintiffs have denied the averments made in the written statement and have reiterated the averments made in the Plaint.

9. On the basis of the pleadings of the parties, following issues were framed by an order dated 28.10.2005:-

1. Whether the suit has been properly valued for the purpose of Court fees and jurisdiction and appropriate Court fees has been paid?. OPP2 Whether the plaintiff is the owner and proprietor of mark Shakti Bhog, if so to what effect?. OPP3 Whether the plaintiff is entitled for perpetual injunction as prayed for?. OPP4 Whether the plaintiff is entitled for rendition of accounts?. If so, for what period?.

5) Whether the plaintiff is entitled for damages?. If so, how much?. OPP6 Whether the suit of the plaintiff is not maintainable without assignment of the said mark in favour of plaintiff?. OPD7 Whether the suit is barred on account of delay, laches and acquiescence?. OPD8 Whether there is any likelihood of deception and confusion in respect of the trademarks of the plaintiff and the defendant, if so to what effect?. OPD (sic. OPP)

9) Whether the defendant is an honest concurrent user of his mark for a long period of time?. If so to what effect?. OPD10 Whether the goods of the defendant can be passed or likely to be passed as that of plaintiff?. If so to what effect?. OPP11 Relief.

10. Subsequently, Plaintiff No.1 was permitted to amend the plaint to take the plea that Plaintiff No.1 as proprietor of the trade mark SHAKTI BHOG has assigned the trade mark in favour of Plaintiff No.2 by Deed of Assignment dated 28.02.2007.

11. There was an attempt to settle the dispute through mediation. However, the mediation failed.

12. By an order dated 21.02.2012, the Defendant was ordered to be proceeded ex-parte.

13. In ex-parte evidence, Plaintiff No.1 filed his Affidavit Ex. PW-1/A. He proved the assignment of the trade mark SHAKTI BHOG in favour of Plaintiff No.2 Ex. P-3 and the copies of the registration and renewal certificates of trade mark SHAKTI BHOG in respect of Class 30 as Ex. P-4 to P-10. He proved various invoices indicating sales of goods bearing trade mark SHAKTI BHOG as Ex. P-13 to P42 and some advertisement and bills as Ex. P-43 to P-70. He testified that the trade mark SHIV SHAKTI was advertised in the trade mark journal for registration on 18.11.1995. A copy of the advertisement was proved as Ex. P-71. In the Affidavit, PW-1 claimed token damages/ compensation of Rs. 5 lacs.

14. Since the Defendant was ordered to be proceeded ex-parte, its defence is not on record.

15. My issue wise findings are as under:- ISSUE No.1 16. The Plaintiffs have valued the suit for the relief of three injunctions at Rs. 200/- each and for the purpose of jurisdiction at Rs. 15 lacs and have claimed damages of Rs. 5 lacs. The Plaintiffs have paid a total court fee of Rs. 7,324/-. I am unable to see any defect in valuing the suit for the purpose of court fee and jurisdiction. The issue is accordingly decided in affirmative. ISSUE No.2 17. The Plaintiffs evidence that the trade mark SHAKTI BHOG was being used by the partnership firm Kumar Dal

Mills of Plaintiff No.1 since 1975 has remained unchallenged and unrebutted. It has also not been challenged that Plaintiff No.1 became the proprietor of the firm Kumar Dal Mills in the year 1990 and that the trade mark SHAKTI BHOG was assigned by Plaintiff No.1 in favour of Plaintiff No.2 company by a Deed of Assignment Ex. P-3. This evidence has also remained unchallenged and unrebutted. Thus, it is established that initially Kumar Dal Mills, then Plaintiff No.1 and since the year 2007, Plaintiff No.2 company is the owner and proprietor of trade mark SHAKTI BHOG. The issue is accordingly decided in affirmative. ISSUE No.6 18. In view of my findings on issue No.2 and subsequent assigning of the trade mark in favour of Plaintiff No.2, this issue has become redundant. ISSUE No.7 19. No evidence was produced by the Defendant to prove that the Plaintiffs were aware of the use of the trade mark SHIV SHAKTI by the Defendant for a very long time. The case set up by the Defendant itself was that the trade mark SHIV SHAKTI was adopted by the Defendant since the year 1970. It applied for registration of the trade mark in the year 1995. Immediately on publication of the mark, opposition was filed by the Plaintiffs. Thus, it cannot be said that the Plaintiffs suit is barred on account of delay, laches and acquiescence. The issue is decided in negative. ISSUE No.9 20. The onus to prove this issue was on the Defendant. The Defendant has not adduced any evidence to prove the onus and being the concurrent user of the trade mark for a long time. However, I refrain from giving any finding on this issue as the suit is going to be decided on other issues. ISSUES No.3, 4, 5, 8 and 10 21. It is admitted case of the parties that the Defendant applied for registration of the trade mark SHIV SHAKTI in the year 1995. On 18.11.1995, trade mark SHIV SHAKTI was advertised in the trade mark journal for registration in the name of Defendant in respect of same goods for which trade mark SHAKTI BHOG of Plaintiffs was registered. The advertisement was proved by PW-1 as Ex. P-71. The Plaintiffs issued a notice of opposition which was dismissed by the Assistant Registrar of Trade Marks and ultimately the Defendants trade mark SHIV SHAKTI was registered. The Plaintiffs filed an appeal being CM (M) No.540/ 2002 which came to be dismissed by the learned Single Judge of this Court. The second appeal being OCJA No.1/2003 was also dismissed by the Division Bench of this Court by an order dated 27.09.2007. While dismissing the appeal by an order dated 21.11.2002, the learned Single Judge

noticed various distinguishing features in the two registered marks. The learned Single Judge opined that there was a lot of phonetic and visual difference. Distinguishing the judgment in K.R. Chinna Krishna Chettiar v. Sri Ambal & Co., AIR 1970 SC146 the learned Single Judge held as under:- 22.

9. ....It may be mentioned that the customers who would be using the goods of the two parties here would no doubt find the word Shakti same. But Shiv Shakti alongwith the device would certainly make a difference, for there would be phonetic as well as ocular difference in the case in hand. Besides, the word Bhog is not being used and further it is very much apparent that the appellant is not using any device at all in Shakti Bhog for the registered trademark is only Shakti Bhog without any device. In this case of the respondents are using device of Trishul and Damru alongwith the words Shiv Shakti which would be phonetically as well as visually different.

The Division Bench also held that the trade marks SHAKTI BHOG and SHIV SHAKTI with the device of Trishul and Damroo were distinct and different and there was no similarity at all. The observations of the Division Bench in Kewal Krishan Kumar v. Rudi Roller Flour Mills (P) Ltd. & Anr., 2007 (35) PTC848(Del.) are extracted hereunder:

8. .... The issue that arises for our consideration is whether the impugned trade mark and label 'Shiv Shakti' by the respondent is deceptively similar to the registered trade mark 'Shakti Bhog' of the appellant. In the aforesaid two competing trade marks the word/ expression 'Shakti' is common. The said word is otherwise a descriptive word denoting 'strength' and 'power'. What is registered in favor of the appellant is not 'Shakti' but 'Shakti Bhog' whereas what is registered in favor of the respondent No.1 is the word 'Shiv Shakti' with the device of 'Trishul' and 'Damru'. A comparative look of the labels of the appellant and the respondent No.1 would make it crystal clear that the aforesaid two competing labels are distinctly different and that there is no identity at all. Therefore, there is no visual similarity of the two labels as are being used by the appellant and the respondent No.1 in their products.

9. The next question which needs consideration is whether there is any phonetical similarity phonetic between the two trademarks. In our considered opinion the two competing marks cannot be said to be phonetically similar also for there is a vast difference between the two marks namely, 'Shiv Shakti' and 'Shakti Bhog Atta'. The prefix used by the respondent No.1 before the word 'Shakti' with the device of 'Trishul' and 'Damru' is descriptive of Lord Shiva, the Hindu God. The said words have no connection or relevance with the word 'Shakti Bhog Atta' which is the trade mark of the appellant. In various decisions the Supreme Court and the different High Courts held that it is the syllable of a trade mark which is generally considered as the most important part, especially in case of short words. It was also held that it is on the letters which precede the termination of the letters upon which an intending purchaser must always rely and on which he must direct his attention. In American Home Products Corporation v. Mac Laboratories Pvt. Ltd., AIR 1986 SC137 the Supreme Court held that the marks are different and not similar considering the prefix. In Fox & Company reported in 1920 37 RPC37trade marks "Motrate" and "Filtrate" were held to be not similar. 'Rece Master' was not held to be similar to 'Master' although both the trade marks related to the same goods namely, diesel oil engines, as held by the Bombay High Court in M/s R.T. Engineering and Electronics Company reported AIR1972 Bom 157. In Coca Cola Company of Canada Ltd. v. Pepsi Cola Company of Canada Ltd. reported in AIR (29) 1942 Privy Council 40, the Privy Council held that Pepsi Cola is not similar to Coca Cola for beverages as the distinctive feature in both the words was the first part i.e. "Coca" and "Pepsi" and that cola was the word only used as a part of the marks for beverages. In that case in respect of the stand as to whether the word 'cola' is descriptive and only adopted in naming of beverages, it was held that actually the word was descriptive.

10. In our considered opinion the same is the position and situation in the present case, for 'Shakti' which is common in both the trade marks is only descriptive whereas 'Shiv' and 'Bhog' are completely distinctive features of the two marks and therefore there is no likelihood that anyone would confuse with the word 'Shiv' with 'Bhog'. 'Shiv Shakti' is phonetically miles away from the word 'Shakti Bhog Atta'..........

23. It is also admitted that an SLP preferred by the Plaintiffs was dismissed by the Supreme Court and the registration of the trade mark has attained finality.

24. There is no dispute about the proposition of law that in spite of the Defendants mark being registered, the Plaintiffs could have shown that there was similarity between the two marks and that the Defendant was guilty of passing off of its goods as those of the Plaintiffs. However, no evidence in this regard was led by the Plaintiffs.

25. I am conscious of the fact that registration of a trade mark and a suit for infringement of the trade mark are two different things and the Plaintiffs in civil action can show that the trade mark of the Defendant was deceptively or confusingly similar to that of the Plaintiffs. That however, was not done.

26. In view of distinguishing features noticed by the learned Single Judge in Kewal Krishan Kumar v. Rudi Roller Flour Mills (P) Ltd. & Anr., CM (M) No.549/ 2002, decided on 21.11.2002 and reported as 2003 (26) PTC175(Delhi) and by the Division Bench in Kewal Krishan Kumar v. Rudi Roller Flour Mills (P) Ltd. & Anr., OCJA No.1/ 2003 decided on 27.09.2007 and reported as 2007 (35) PTC848(Delhi), the Plaintiffs are disentitled to the relief of perpetual injunction as claimed by them.

27. Since, it cannot be said that the Plaintiffs trade mark has been infringed by the Defendant, they are not entitled to grant of perpetual injunction as claimed. Consequently, they are not entitled to any rendition of accounts or damages. It also cannot be said that the Defendant has passed or is likely to pass its goods as that of the Plaintiffs. Issues No.3, 4, 5, 8 and 10 are accordingly decided in negative.

28. In view of my findings on issues above, the suit of the Plaintiffs is hereby dismissed. In peculiar facts of this case, the parties are left to bear their own costs.

29. Pending applications also stand disposed of. (G.P. MITTAL) JUDGE AUGUST13 2014 vk

SooperKanoon - India's Premier Online Legal Search - sooperkanoon.com