

P.M. Diesels Vs. S.M. Diesels

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Court : Delhi

Decided On : Feb-21-1994

Reported in : 1994IAD(Delhi)825; AIR1994Delhi264; 1994(1)ARBLR330(Delhi); 53(1994)DLT742; 1994(28)DRJ574

Judge : P.N. Nag, J.

Acts : [Code of Civil Procedure \(CPC\), 1908](#) - Order 39, Rule 1

Appeal No. : Interim Application No. 8027 and Suit No. 2877 of 1989

Appellant : P.M. Diesels

Respondent : S.M. Diesels

Advocate for Def. : Mr. Amarjit Singh

Advocate for Pet/Ap. : R.K. Agarwal,; Amarjit Singh and; K. Pratibha, Advs

Judgement :

P.N. Nag, J.

(1) By this application filed under Order 39 Rules 1 & 2 of the Code of Civil Procedure, the plaintiff has sought an injunction restraining the defendant, during pendency of the suit, from manufacturing, selling, offering for sale or otherwise dealing in Diesel Oil Engines and parts thereof under the trade mark

'SONAMARSHAL' and/or any other trade mark identical and/or deceptively similar to the registered trade mark and label entitled 'FIELD MARSHAL' of the plaintiff and from passing off its goods as and for those of the plaintiff's goods under the said mark/label 'SONAMARSHAL' and under the trading style of 'S.M. .h1 is 8027/89 in S.2877/89. DIESELS'.

(2) This application has been filed along with the suit for perpetual injunction restraining infringement of trade mark, trade name, copyright, passing off and for rendition of accounts etc.

(3) The relevant facts set out in the application as well as in the suit are that the plaintiff company since the year 1963 has been carrying on the business of manufacturing, marketing and exporting of Diesel Oil Engines and parts thereof (not for land vehicles), Centrifugal pumps, electric motors and parts thereof etc. and since then they have been using the trade mark Field Marshal for their aforesaid goods. The trade mark Field Marshal of the plaintiff company is duly registered under the provisions of the Trade & Merchandise Marks Act, 1958 and the particulars of which have been given in the plaint and this trade mark has been renewed from time to time. The label of the plaintiff company 'FIELD Marshal is also registered under the Copyright Act, 1957. The plaintiff has taken much pains to popularise the Field Marshal trade mark and has spent enormous sums of money on its advertisement and publicity throughout by various means of advertisement and publicity and on account of superior quality of their Field Marshal product which they have been selling for more than two decades, they have acquired unique reputation and enviable goodwill in public and trade. The plaintiff's sales are in crores and crores of rupees and publicity expenses are in lakhs and lakhs of rupees. In July 1989, it came to the notice of the plaintiff that the defendant had also started very recently manufacturing and marketing Diesel Oil Engines bearing identical and deceptively and confusingly similar trade mark Sonamarshal in respect of its products. The trade mark Sonamarshal as adopted and used by the defendant which contains the key and memorable part Marshal of the plaintiff, registered as well as long used trade mark Field Marshal was practically identical and deceptively similar to the registered trade mark Field Marshal of the plaintiff. The defendant started its business of manufacturing and

trading under the identical and confusingly similar trade name/trading style to read as S.M.DIESELS in addition to such colourable imitation of the trade mark, i.e. Sonamarshal in respect of similar goods not as the matter of co-incidence or accident but with deliberate and willful attempt to pass off its goods as and for the real goods of the plaintiff and thereby to have the illegal and wrongful gains of the plaintiff's trade reputation and business goodwill. The purchasers are normally illiterate persons - mechanics and servants from the villages - who call the engine oils by the name of Marshal and, therefore, confusion and deception is inevitable due to close identity and deceptive similarity of the trade mark and trade name of the plaintiff and of the defendant. In these facts and circumstances, according to the plaintiff, because of the unlawful activities of the defendant, the plaintiff has suffered huge losses and has caused damage to the well established reputation and, therefore, the plaintiff has been constrained to file the present suit and the present application for interim injunction.

(4) In the written statement filed by the defendant, certain objections have been taken that the suit suffers from delay, laches and acquiescence as the plaintiff has been carrying on the business of selling diesel engines continuously and extensively since 1984 at Rajkot and the plaintiff is well aware and in know of the trade mark Sonamarshal adopted by the defendant. It has further been staled that the plaintiff cannot claim monopoly in respect of the use of the word Marshal in relation to diesel oil engines. In fact there are various manufacturers in Rajkot who are using different brands with the word Marshal as suffix to their trade marks and some of the trade marks being used by . the said manufacturers are: Hindmarshal, FRIEND- Marshal, Fauzimarshal, Airmarshal, Perfect Marshal, POWER- Marshal, Supermarshal, Sunmarshal, Fermiermarshal, INDRAM- Arshal, Micomarshal, Marshal, Landmarshal, Fillmarshal, WA- Termarshal, Venusmarshal etc. The word Marshal, therefore, has become common to the trade of diesel engines and the plaintiff cannot claim the same to be distinctive of its goods or business. In view of this fact, the trade mark Field Marshal and Sonamarshal can never be deceptively similar and no customer is I likely to get confused or deceived on account of the use of the trade mark Sonamarshal by the defendant. There is simple denial by the defendants that the plaintiff has been using the Trade Mark Field Marshal since 1963.

(5) The application has been strongly opposed by the defendants. Mr. Amarjit Singh, learned counsel for the defendant, raised certain preliminary objections. The first objection raised by him was that the plaintiff is not the proprietor of the registered trade mark Field MARSHAL. He pointed out that the registration certificate of trade mark Field Marshal to be used in legal proceedings under the Trade and Merchandise Marks Act, 1958 (dated 21.5.1984, 3.11.1987 and 6.10.1987) filed and relied upon by the plaintiff only reveal that the plaintiff has been shown as the proprietor of the registered trade mark Field Marshal for a particular period, which has already expired long back and at the time of institution of suit, according to these documents, the plaintiff has not been shown as the proprietor of the registered trade mark Field Marshal and, therefore, the plaintiff has no locus standi to file the suit and pray for interim injunction.

(6) No doubt the aforementioned three registration certificates do not reveal that at the time of institution of the suit, the plaintiff was the proprietor of registered trade mark, but during the course of arguments, the plaintiff filed some additional documents in order to substantiate that the plaintiff is the proprietor of registered trade mark Field MARSHAL. Consequent upon the filing of additional documents by the plaintiff, counsel for the defendant also wanted time to file some more documents for which time was granted vide order dated 1.9.1993. However, no additional documents have been filed on behalf of the defendant. The additional documents filed by the plaintiff on 27.8.1993 which is a photo copy of pages 701 and 754 of Trade Marks Journal No.1040 dated 1.10.1992 reads under Names, Addresses And Descriptions Altered In The Register To The Form Shown Herein Italics '224879,252070,25207B- vi:-FIELD Marshal P.M. Diesels LTD.' This document clearly shows that at the time of institution of the suit in 1989, the plaintiff was the proprietor of registered trade mark Field Marshal and, therefore, the plaintiff has every locus standi to institute the present suit and pray for interim injunction. The submission of learned counsel for the defendant is devoid of any force and is rejected.

(7) Next preliminary objection raised by Mr. Amarjit Singh, counsel for the defendant, is that the plaintiff and defendant have been carrying on business of selling diesel engines since 1984 at Rajkot and in spite of the fact that the plaintiff

is aware and in know of the defendant's trade mark Sonamarshal, the plaintiff did not file the suit immediately thereafter where as it has filed this suit in 1989,withThe resultthatthissuit suffers from delay, laches and acquiescence and, thereforee, injunction as prayed for in this application, in these circumstances, may berefused. This fact has been controverted by the plaintiff. The plaintiff has reiterated that the plaintiff has been using trademark Field Marshal since 1963. Further it may be noticed that the defendant has nowhere stated that they were not aware of the use of the trade mark Field Marshal since 1963 by the plaintiff. Such a trade mark is being used by the plaintiff for two decades and is being exclusively identified and associated with the plaintiff amongst the public and trade. The plaintiff has every right to complain of the infringement and violation of statutory right of the trade mark Field Marshal and there is no question of the suit suffering from delay, laches or acquiescence. In the present case, as already stated, the plaintiff has denied any knowledge about the defendant's manufacturing or selling diesel oil engines with their trade mark Sonamarshal from 1984 at Rajkot. On the other hand, the plaintiff has stated that they have come to know of this fact in 1989 and immediately thereafter they have filed the present suit. The suit is still at preliminary stage, and such averments would be gone into at the time of trial. For the purpose of the injunction the averments in this context made by the plaintiff whatever worth it may be can be taken into consideration. Further admittedly, the plaintiff is the proprietor of registered trade mark Field Marshal and as such under Section 28 of the Trade and Merchandise Marks Act, 1958 it gives to the proprietor of registered trade mark the exclusive right to use the trade mark with relation to goods in respect of which the trade mark is registered and to obtain the relief in respect of infringement of the trade mark as provided under the Act. Such a statutory right cannot be lost merely on the question of principles of delay, laches or acquiescence. In general mere delay after knowledge of infringement does not deprive the registered proprietor of a trade mark of his statutory rights or of the appropriate remedy for the enforcement of these rights at any rate so long as the delay is not of inordinate length. In the context of this and having regard to overall circumstances in the present case, I am of the opinion that the plaintiff cannot be non-suited and injunction cannot be refused.

(8) Next contention raised by learned counsel for the defendant is that the word Marshal has become common to the trade of diesel engines in Rajkot and various other persons are using the trade mark in one form or other as inasmuch as some are using Airmarshal, Perfect Marshal, Powermarshal etc. and the defendant is not the only person who is using the trade mark Sonamarshal only. The plaintiff, therefore, cannot claim its trade mark to be distinctive of its goods or business and no customer is likely to be confused or deceived on account of this trade mark. This contention of the learned counsel for the defendant is also without force. In this connection it is sufficient to say that under the law it is the right of two parties before the court which has to be determined and the court has not to examine the right of other parties. If some other manufacturers are using or suffixing the word Marshal on their diesel engines, it is of no consequence. Furthermore, if the plaintiff has not taken any action against several other infringements, this does not mean that the plaintiff has abandoned its trade mark and cannot challenge the action of the defendant.

(9) In order to succeed in the injunction application, three factors must be kept in view, that is, the establishment of prima facie case, the balance of convenience between the parties and in case injunction is not granted this will cause irreparable injury to the plaintiff. In order to show that the plaintiff has prima facie case, the plaintiff has stated that since the year 1963 the plaintiff and/or its predecessors in title have been using the trade mark Field Marshal for their goods. In fact such an averment has not been specifically denied by the defendant. On the other hand, the defendant has neither stated nor shown that they have the prior user of their trade mark Sonamarshal and no such case has been set up by them. The registration of the plaintiff's trade mark Field Marshal in word parse is 224879 and written in style 252070 and in logo 252071, as referred to in para 3 of the plaint. This is supported by the documents placed on record by the plaintiff. The plaintiff has placed on record the documents, as already discussed, to show that even at the time of filing of the suit in 1989 the plaintiff was the proprietor of the registered trade mark Field MARSHAL.

(10) The use of the trade mark Field Marshal by the plaintiff also finds further support from the fact that the label Field Marshal of the plaintiff is also registered

under the Copyright Act and the registration No. is A-42681/83. Plaintiff, therefore, has clearly established that he is the prior user of the trade mark Field Marshal and has been selling the goods under this trade name since 1963.

(11) The next question that arises for consideration is whether the trade name Sonamarshal is likely to deceive the public or cause confusion to trade. In *Amritdhara Pharmacy v. Satya Deo Gupta* : [1963]2SCR484 , the Supreme Court considered the question whether Lakshmandhara so nearly resembles the trade mark Amritdhara - both medicinal preparation for alleviation of various ailments -is likely to deceive public and cause confusion to trade. In that case, the Supreme Court has laid down certain tests for determining whether the two trade names can be considered as similar and that in what circumstances the trade mark is likely to deceive and cause confusion by its resemblance to another amongst the persons who purchase and use such goods and has summed up as under:-

'In considering the matter, all the circumstances of the case must be considered. As was observed by Parker, J., in *Re Pianotist Co.'s Application*, (1906) 23 RPC 774, which was also a case of the comparison of two words- I You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.'

For deceptive resemblance two important questions are: (1) who are the persons whom the resemblance must be likely to deceive or confuse, and (2) what rules of comparison are to be adopted in judging whether such resemblance exists. As to confusion, it is perhaps an appropriate description of the state of mind of a customer who, on seeing a mark thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection. (See *Kerly on Trade Marks*, 8th Edition, p. 400). ' Further it has been observed:

'THE trade mark is the whole thing - the whole word has to be considered. In the case of the application to register 'Erector' (opposed by the proprietors of the trade mark 'Erector') Farwell, J., said in *William Bailey (Birmingham) Ltd.'s Application*. (1935) 52 R.P.C. 136: I do not think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole..... I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word."

Considering the above tests in the present case in respect of the disputed trade marks, viz., Field Marshal and Sonamarshal, the words Field and Sona from the word Marshal used in both the trade names should not be dissected but both the trade names as a whole should be considered and read. It is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word. If I consider both the trade names as a whole, I have no doubt in mind that both Field Marshal and Sonamarshal by their look and sound seem to resemble with each other and, therefore, the trade name Sonamarshal is likely to deceive and cause confusion to trade. Needless to say that the description of the goods, i.e. diesel oil engines and parts thereof (not for land vehicles) and cognate goods, of the plaintiff and defendant are rather identical. It is common knowledge that such goods are likely to be purchased and may be purchased by literate and illiterate persons from villages and townsfolk, mechanics, farmers etc. and I have no doubt in my mind that the use of the trade name Sonamarshal by the defendant is likely to deceive and cause confusion in the minds of such a public. In case the question is approached from the point of view of a man of average intelligence and imperfect recollection and the over all structural and phonetic similarity of the two names Field Marshal And Sonamarshal, in my opinion, the trade name Sonamarshal is likely to deceive and cause confusion. In such circumstances it can be said that the use of Sonamarshal by the defendant on diesel engines is a deliberate and willful attempt to pass off its goods as and for the real goods of the plaintiff, i.e., Field Marshal with a view to have illegal and wrongful gains affecting plaintiff's trade reputation and business.

(12) The plaintiff has, therefore, prima facie made out a case in its favor and the balance of convenience also lies in plaintiff's favor. Undoubtedly in case the defendant is not restrained from using trade mark Sonamarshal, the plaintiff will suffer huge loss in the mark and also their reputation.

(13) I would, therefore, grant an injunction restraining the defendant, during the pendency of the suit, from manufacturing, selling, offering for sale or otherwise dealing in the diesel oil engines or parts thereof (not for land vehicles) and other cognates under the impugned trade mark Sonamarshal and/or any other trade mark identical and/or deceptively similar to the registered trade mark and label entitled Field Marshal of the plaintiff and from passing off its goods as and for those of the plaintiff's goods under the said trade mark/ label SONAMARSHAL.

(14) With these directions, is 8027/89 stands disposed of. In the facts and circumstances of the case. I make no order as to costs.