

Mr. Jagdish Prasad Sharma Vs. Mastermind Publishing House

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Court : Delhi

Decided On : Jul-28-2005

Reported in : 2005(31)PTC243(Del)

Judge : Swatanter Kumar, J.

Acts : [Trade Marks Act, 1999](#); [Copyright Act, 1957](#); Trade Mark Act, 1995 - Sections 9; Specific Relief Act - Sections 41; Code of Civil Procedure (CPC) - Order 7 Rule 11

Appeal No. : CS(OS) 2093/2003

Appellant : Mr. Jagdish Prasad Sharma

Respondent : Mastermind Publishing House

Advocate for Def. : Sunil Tomar and ; Garima Prasad, Adv.

Advocate for Pet/Ap. : Sunil Aggarwal, Adv

Judgement :

Swatanter Kumar, J.

1. The plaintiff has filed the present suit for a decree of permanent injunction against the defendant, its employees, agents, servants, restraining them from threatening the plaintiff of groundless and illegal threats of civil and criminal

proceedings including search and seizure etc. by the police and to serve upon them notices, circulars etc. Further the plaintiff had prayed for a decree of declaration praying that the word 'Mastermind' in respect of books or publications or guides or help books or printed material, is laudatory, descriptive and non-distinctive in nature and the same is incapable of any monopoly in favor of one person or the other for the purposes of registration or otherwise.

2. The above relief is prayed for by the plaintiff on the premise and as is evident from the averments made in the plaint that the plaintiff is carrying on his business of publication of books, help books, guide books and question banks on the basis of curriculum of various classes as prescribed by the State and Central Government including Central Board of Secondary Education. While dealing with its books, plaintiff has been using the word 'Master Mind Guide for Junior High School' in a descriptive and laudatory manner, which also refer to the character and quality of goods which are being published and sold by the plaintiff. According to the plaintiff, the expression 'Mastermind' is a generic term and is incapable of being registered as a trade mark. It is further the case of the plaintiff that this expression means and implies and is a synonym of the words, brilliant, genius, greatmind, authority, excellent understanding and all these expressions are laudatory and descriptive in nature which just refers to the quality of the goods. The word is incapable of protection under the [Trade Marks Act, 1999](#) and also cannot be protected under the [Copyright Act, 1957](#), but only the writing style i.e. the script can be protected under the provisions of the said Act. Not only the plaintiff, many other publishers are using the same expression which is in wide circulation. The defendant had sent a notice on 5.9.2003, illegally and unjustifiably threatening the plaintiff and called upon him to discontinue the use of the word 'Mastermind' in respect of the books published by the plaintiff and also threatening to take action under both the afore-stated legislations. In the plaint, there is a specific averment made by the plaintiff that the defendant neither has registration under the Trade Marks Act nor is exclusively using the same and it also has no protection over the copyright. As the threats issued by the defendant are unjustified, groundless and illegal, as such it may be restrained by taking criminal or civil action against the plaintiff in addition thereto. The plaintiff was using the said expression for a considerable time amongst others and the cause of action is

stated to have been arisen on 6/9/2003 when the legal notice dated 5.9.2003 was received by the plaintiff and thereafter on various dates when oral threats were given by the defendant to the plaintiff.

3. This suit was contested by the defendant by filing a detailed written statement. In the written statement, defendant has taken preliminary objections stating that the plaintiff had concealed the material facts from the Court and has not come with clean hands. The suit was not valued properly for purposes of court fee and jurisdiction and there was no cause of action in favor of the plaintiff and against the defendant for filing the present suit. It prays for dismissal of the suit even under the provisions of Order 7 Rule 11 of the Code of Civil Procedure (for short 'the CPC'). While vaguely denied the averments made in the plaint, defendant had stated that defendant is the exclusive user of the word 'Master Mind' in the publication business of various books and that the word 'Master Mind' is its copyright. According to the defendant, this expression is capable of being a trade mark, particularly in the matter of publication of books which are being published by the defendants. The word 'Master Mind' is a distinctive word and capable of being used by the defendant. The defendant is using the said word for a considerable time. On these averments, the defendant is praying that the suit of the plaintiff be dismissed with costs. Replication on behalf of the plaintiff was filed denying the allegations made in the written statement and elaborating his case as stated in the plaint. On the basis of these pleadings, Court vide its order dated 9th November, 2004 framed the following issues :-

1. Whether the defendant is the exclusive owner of the word 'MASTER MIND' in the publication business of the books? OPD
2. Whether the word 'Master Mind' has acquired distinctive name and goodwill in the business of publication of books by the defendant? OPD
3. Whether the plaintiff has passed on his goods, as that of the defendant? OPD
4. Whether the plaintiff is entitled to the decree of injunction & declaration as prayed for? OPP

5. Relief.

4. The parties led their evidence in support of their issues, documentary or oral before the Local Commissioner. PW-1 plaintiff filed his affidavit by way of evidence and was cross-examined as PW-1. Various documents were executed including search report exhibited as Ex.PW.1/4 to PW.1/8. Shri Laxman Singh, proprietor of M/s. Master Mind Publishing House has filed his affidavit on behalf of the defendant, by way of evidence and was cross-examined by counsel appearing on behalf of the plaintiff. Learned counsel for the plaintiff has closed his evidence in the affirmative on 16.2.2005. However, the plaintiff led no evidence in rebuttal, after the defendant also closed its evidence on 16.2.2005.

5. As is evident from the above narrated facts and the records, the parties have led very limited evidence in support of their respective claims. As issues No. 1 to 3 are based upon common evidence, these can be determined on the basis of the evidence led by the parties and they being, to some extent, inter-dependent, it would be appropriate to have the common discussion on these issues and determine them accordingly.

ISSUES 1 to 3

6. The plaintiff in his plaint has specifically stated that he has been publishing and selling the books under the expression 'Master Mind Guide for Junior High School' for a considerable time. The said expression is stated to be laudatory in nature. It is a generic term and cannot be registered under the Trade Mark Act or the Copyright Act. The notice served by the defendant upon the plaintiff is unjust and illegal and they cannot take civil and/or criminal action against the plaintiff. According to the plaintiff, not only that the title 'Master Mind' cannot be protected under the two statutes, but also is a name of common trade which is used by various publishers in the trade. In the written statement, defendant has stated that the word 'Master Mind' is copyright of the defendant and also stated that it has been dealing with it exclusively in the business of publishing books and as such they have every right to take action against the plaintiff. PW-1, Jagdish Prasad Sharma, in his affidavit, clearly stated that the word 'Master Mind' is being used in a descriptive and laudatory manner, it refers to the character and quality of the

books and meant for the benefit of the students so that they could develop a mastery over the subject matter with the help and assistance with this book. The cover of these books have been exhibited as Exs.PW.1/1 to PW 1/3.

7. According to this witness, the plaintiff and defendant both are in same trade of printing, publishing and selling of books under the non-distinctive word 'Master Mind' and besides both of them, there are several other publishers, who are using the non-distinctive/descriptive word Master Mind. He applied for search reports with the Registrar's of Copyright which were placed on record as PW 1/4 to PW 1/8. In paragraph 13 of the affidavit, the plaintiff stated as under :-

'I say that the defendant has neither any registration under [Trade Marks Act, 1999](#) nor is exclusively using it. The defendant has no evidence of any use and has sent a photo state copy of the extract of Registrar of Copyright, which has been surreptitiously registered in the defendant's name.'

8. From the cross-examination, PW-1 was not even given a suggestion that the defendant has a trade mark or copyright over the word 'Master Mind'. In his cross-examination, he stated that for the last 10 years, he was using the word 'Master Mind' and when he started the business, he had got the search conducted at the office of the Registrar and no such trade mark or copyright was registered at that time. Nothing material came in the cross-examination of this witness. The defendant filed his affidavit in which except making a balled averment that the defendant is protected under the copyright and trade mark, no document or particulars thereof was given in the affidavit. However, it was reiterated by the said defendant that it was exclusively using the word 'Master Mind' and it is not a word of common trade. In his cross-examination, he admitted that 5-6 years back, the defendant had come to know that the plaintiff is using the word 'Master Mind'. He also admitted in complete contradiction to his written statement and affidavit that many other persons are also using the word 'Master Mind' on such type of books/course. As is evident from the record of the file, the defendant did not file any document and no document has been exhibited even in his affidavit. In the event, defendant was claiming protection under the Copyright Act being a registered copyright owner of the design or expression 'Master Mind'. It was on the

part of the defendant to prove this averment in the written statement by leading proper cogent documentary evidence and submitting the requisite certificate on the record of the file. Particularly, all the onus of these issues have been placed upon the defendant. It may be noted and during the course of hearing, learned counsel appearing for the plaintiff had brought to the notice of the Court copy of the letter dated 24th June, 2005 wherein the application of the defendant being No. 1225593 for registration of the mark 'Master Mind' (styles) was rejected under section 9 of the Trade mark Act, 1995 for detailed ground stated therein and the order passed by the Assistant Registrar of Trade Marks. This document has not been exhibited, but learned counsel appearing for the defendant fairly admitted the correctness of this document and stated that the application of the defendant for registration of the said trade mark had already been rejected. Of course, he stated that they have a right to challenge the said order in accordance with law. Plaintiff had filed some documents, but both the plaintiff and defendant have miserably failed to discharge their respective onus for proving the issues. The defendant, except a balled statement, by way of affidavit had led no documentary or oral evidence to substantiate the claim of either of prior user or to be a registered owner of the trade mark or copyright under the respective laws. In the cross-examination, the said defendant has conceded that number of other people are using such trade expressions for number of years and the plaintiff was also using the same for more than 5 to 6 years. The plaintiff has also not brought any evidence on record to establish its prior user or preferential right vis-a-vis the defendant. The case of the plaintiff to some extent is that all can use the said trade expression including the plaintiff and the said expression is incapable of being registered under the Trade Mark Act or the Copyright Act. Reliance was also placed by learned counsel for the plaintiff upon the judgment of this in the case of Competition Review (P) Ltd. v. N.N. Ojha 1996 (16) PTC 124 where the Court held that word 'competition' is a word of a English language and is a generic term. No one can claim exclusive use of the word 'competition' and thus had declined the interim injunction application filed by the plaintiff in that case. The plaintiff has also relied upon other judgments of the Court relating to the term `Multilight', `Ruppee' and `Safemix' where registration has been refused. (see Ruppee Gains Tele-Times Pvt. Ltd. v. Ruppee Times 1995 (15) PTC 384, Multilight Trade Mark (1978) RPC

601 and Safemix Trade Mark (1978) RPC 397).

9. The expression 'Master Mind' has been given dictionary meaning in the new Laxicon Webster Dictionary, 1988 Edition, as 'the intellect behind some impressive piece of planning, organisation, a person of outstanding intellect'. In the Cambridge International Dictionary of English, 1996 Edition, this term is explained as 'to make certain that it happens successfully'. The principle enunciated in these judgments and in light of the meaning given to the term 'Master Mind', it has to be held that term is of generic nature and to claim a monopoly over such expression would hardly be possible and permissible. I would refrain from discussing this aspect of the issues in greater detail so as to avoid prejudice to the rights of any parties to the suit if they propose to challenge the order dated 24.6.2005 passed against the defendant in appropriate proceedings. I am primarily concerned with the decision of the lis between the parties to this suit. The onus even of issue No. 3 was on defendant, but he failed to lead any evidence or establish on record that the plaintiff had passed off his goods as goods that of the defendant. In fact, there is hardly any evidence led by the parties. The onus of the issue was never questioned by any of the parties to the suit.

ISSUE NO. 4

10. As far as the first prayer of the plaintiff for passing of a decree of injunction restraining the defendant, his agents etc, to take any civil and/or criminal proceedings against the plaintiff is concerned, the same cannot be granted. The plaintiff was served with the notice by the defendant dated 5.9.2003 which was exhibited as Ex.P-2. No injunction can be issued against a party restraining the other from taking recourse to the remedies available to it under law. In fact, under section 41(a) of the Specific Relief Act, no such injunction can be granted by the Court. There is no evidence on record to show that the intended litigation was a multiplicity of proceedings or that it was any way vexatious so as to compel the Court to exercise any discretion in favor of the plaintiff and against the defendant and as such the suit of the plaintiff in regard to that prayer is dismissed. However, in regard to second prayer of the plaintiff, keeping in mind the findings recorded on issues No. 1 to 3, I would hold and pass a decree for declaration that plaintiff has

not passed off any of his goods as the goods of the defendant and on the evidence led before this Court, the defendant is not the exclusive owner of the word `Master Mind' in publication business of books. In view of this discussion, I would answer all the issues against the defendant and in favor of the plaintiff.

11. In view of the above discussion, the suit of the plaintiff is partially decreed to the limited extent afore-stated. A decree in terms of the judgment be drawn leaving the parties to bear their own costs.

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