

MANU/DE/1236/2003

**Equivalent Citation:** 2004(72)DRJ794, 2004(28)PTC26(Del)

**IN THE HIGH COURT OF DELHI**

IA Nos. 3314/03 and 3843/03 in S. 662/03

Decided On: 12.12.2003

Appellants: **Standard Electricals Limited**  
**Vs.**

Respondent: **Rocket Electricals and Anr.**

**Hon'ble Judges/Coram:**

Mahmood Ali Khan, J.

**Counsels:**

For Appellant/Petitioner/plaintiff: Rajiv Nayar, Sr. Adv. and Pratibha M. Singh, Adv

For Respondents/Defendant: A.K. Goel, adv. for Defendant No. 1 and Mohan Vidhani, Adv. for Defendant No. 2

**Subject: Intellectual Property Rights**

**Acts/Rules/Orders:**

Trade and Merchandise Marks Act, 1958 - Section 28, Trade and Merchandise Marks Act, 1958 - Section 29; Code of Civil Procedure, 1908 (CPC) - Order 39 Rules 1, Code of Civil Procedure, 1908 (CPC) - Order 39 Rules 2

**Cases Referred:**

Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories, AIR 1965 SC 980; Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., 2001 PTC 541 (SC); Parle Products (P) Ltd. v. J.P. & Co. Mysore, PTC (Suppl. 1) 346 (SC); Corn Products Refining Co. v. Shangrila Food Products Ltd., (1960) 1 SCR 968; Anglo Dutch PC & v. Works Pvt. Ltd., AIR 1977 Delhi 41; Amritdhara Pharmacy v. Satya Deo Gupta, AIR 1963 SC 449; Century Traders v. Rushan Lal Duggar & Co. and Ors., AIR 1978 Delhi 250; American Home Products Corporation v. Mac Laboratories Pvt. Ltd. and Anr., AIR 1986 SC 137; Kaviraj Pandit Durga Dutt Sharma v. Navrathan Pharmaceutical Laboratories, PTC (Suppl.) (2) 680 (SC); Info Edge (India) Pvt. Ltd. and Anr. v. Shailesh Gupta and Anr., 2002 (24) PTC 355 (Delhi); Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd., 2002(24) PTC 121 (SC); Indian Shaving Products Ltd. and Anr. v. Gift Pack and Anr., 1998 PTC(18) 698; Kochar Oil Mills Ltd. v. Chhatar, Extractions Ltd. and Ors., PTC (Suppl.) (1)171 (Delhi); Rob Mathys India Pvt. Ltd. v. Synthes Ag Chur, 1997 PTC 669; Amir Chand Om Prakash v. Monga Perfumery, 1996 PTC 385; Essel Packaging Limited v. Sridhar Nara and Anr., 2002 PTC 233; J.R. Kapoor v. Micronic India, 1994 PTC 260; Viyay Kumar Ahuja v. Lalita Ahuja, 2002(1) CTMR 105 (Delhi), 2002 (24) PTC 141(Del); SBL Limited v. Himalaya Drug Co., 1997 PTC (17); Aviat Chemicals Pvt. Limited v. Intas Pharmaceutical Ltd., 2001 PTC 601 (Del); Relaxo Rubber Limited and Ors. v. Aman Cable Industries and Ors., 1998 PTC (18); Rochem Separation Systems (I) Pvt. Ltd. v. Tas Engineering Co. Pvt. Ltd., 2001 (1) CTMR 477 (Bombay), PTC (Suppl)(2) 120(Bom); Ginar Food & Beverages Pvt. Ltd. v. Godfrey Phillips India Ltd., 2001 PTC 360 (Del.); Rupee Gains Tele-Times Pvt. Ltd. v. Rupee Times, 1995 PTC (15); Indo Pharam Pharmaceuticals Works Ltd. v. Citadel Fne Pharmaceuticals Ltd., AIR 1998 Madras 347; Competition Review (P) Ltd. v. N.N. Ojha, 1996 PTC(16); Novelty Emporium v. Novelty Creation Pvt. Ltd., 2002 (24) PTC 285 (Del.); K.M. Associates Pvt. Ltd., v. Good Times Pvt. Ltd., 2003 (26) PTC 428 (Suit No. 1985/02); Peshawar Soap & Chemicals Ltd. v. Godrej Soap Ltd., 2001 PTC (21) 1; Hindustan Development Corporation v. The Deputy Registrar of Trade Mark and Anr., AIR 1995 Calcutta 519; Sant Kumar Mehra v. Ram Lakhan, 1999 PTC (19) 307; Panacea Biotec Ltd. v. Recon Ltd., 1996 PTC (16); Universal Industries v. Universal Agency, 1985 ALR 263; The Proctor and Gamble Co. v. Satish Patel, 1996 PTC (16) 646; B.L. and Co. and Ors. v. Pfizer Products Incl., 2001 PTC 797 (Del); Bravingtons Ltd. v. Barrington Tennant, 1987 RPC 183; Jolen Inc v. Shoban Lal Jain and Ors., 2001 PTC 216 (Madras); Swaran Singh Trading as Appliances Emporium v. Usha Industries (India) New Delhi and Anr., AIR 1986 Delhi 343; Shri Gopal Engg. & Chemical Works v. POMX Laboratory, AIR 1992 Delhi 302; Gopal Hossierey v. The Dy. Registrar of Trade Marks and Ors., AIR 1981 Calcutta 53; Hindustan Pencils Private Limited and Anr. v. Universal Trading Company, 2000 PTC 561 ; The Fairdeal Corporation (Pvt.) Ltd. v. Vijay Pharmaceuticals, 1985 PTC 80; Synthetic Moulders v. Samperit Aktiergeselshaf, 1980 RLR 263; Century Electronics Limited v. C.V.S. Enterprises Limited, 1983 FSR 1; Paresh Chandra Saha v. Prakash Chandra Das and Anr., 2000 PTC 269 ; Paras Traders v. Rajasthan Copy Manufacturers Association (Regd.), 1996 PTC (16) 229; Bengal Waterproof Ltd. v. Bombay Waterproof Mnfg. Co., 1997 PTC (17) 98; Hindustan Pencils Pvt. Ltd. v. India Stationery Products Co. and Anr., AIR 1990 Delhi

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### **Case Note:**

**Trade mark--Interim injunction--Infringement and passing off action--Deceptive similarity--Balance of convenience--Ex parte ad interim injunction--Both plaintiff and defendant dealing in electrical goods--Trade mark of plaintiff STANDARD and that of defendant MS STANDARD--Defendant earlier selling its goods under the trade mark MAX STANDARD since 1979 as instructed by court in judicial proceedings--Several parties other than the defendant using the word STANDARD, though not a defense in passing off action, there was no question of any confusion or deception--Both the parties advertising their products under the respective trade marks in the same journals, diaries, yellow pages, print and visual media since long and their advertisements published in same newspapers--Defendant not using the trade mark STANDARD simpliciter--Though it may be said that there is prima facie case in favor of plaintiff in view of its prior user, balance of convenience not in its favor--Ex parte interim injunction order vacated--Trade and Merchandise Marks Act, 1958, Sections 28, 29--Civil Procedure Code, 1908, Order 39, Rules 1 & 2.**

## **JUDGMENT**

### **Mahmood Ali Khan, J.**

1. This order will dispose of is 3314/03 filed by the plaintiff under Order 39 Rules 1 and 2 CPC for grant of ad-interim injunction for restraining the defendants from manufacturing, selling, offering for sale or in any manner using the trade mark MS STANDARD or any other mark identical/deceptively similar to the plaintiffs trade mark STANDARD, in relation to the electrical switchgear including MCBs, isolators, RCCBs, distribution boards, FR PVC wires, MCCBs, switch disconnecter fuses, changeover-rewirable-double break switches, HBC fuses and plugs and sockets etc. and/or cognate and allied goods and further from doing any other thing as may constitute passing off and acts of unfair competition and from doing any act as may result in dilution of the plaintiffs trade mark and trade name and is 3843/03 filed by defendant No. 2 under Order 39 Rules 3 & 4, CPC for vacating the ex-parte ad-interim injunction order dated 21.3.2003 whereby the defendants were restrained, as requested by the plaintiff in is 3314/03 above-mentioned.

2. In the passing off action suit, the plaintiff has sought permanent injunction in the same term in which interlocutory injunction was prayed for in is 3314/03. In addition, a prayer was also made for decree of damages for a sum of Rs. 5,50,000/-in favor of the plaintiff against the defendants and further a decree for rendition of accounts of the profit earned by the defendants and further a decree directing the defendants to deliver all the products bearing the infringed trade mark MS STANDARD etc. The allegations made in the plaint, in brief, are that a Company in the name of Indo Asian Traders (P) Limited was incorporated in 1958. Its name was changed thrice and lastly, it was changed to Standard Electricals Limited, the plaintiff herein. The plaintiff is a leading manufacturer of wide range electrical equipments, i.e., electrical switchgear including MCBs, isolators, RCCBs, distribution boards, FR PVC wires, MCCBs, switch disconnecter fuses, changeover-rewirable-double break switches, HBC fuses and plugs and sockets etc. The products of the plaintiff are sold under the trade name STANDARD and they have acquired unparallel reputation on account of wide publicity and extensive advertisements. The plaintiff is proprietor of registered trade mark STANDARD in relation to its goods since 1958. It has six trade mark registrations in its favor, as detailed in para-5, which are 'IAT Standard'. 'Standard S in triangle India', 'Standard Kopp', 'Standard Switchgears'. 'Standard (in logo form)' and 'Standard Switchgear life guards in power'. Except the first mark, others have been renewed from time to time. They are more than seven years old and are exclusive and valid. Recently, the Company has been taken over by Havell's group. Initially 60% of the Company's equity was purchased in April, 2000 and on 1.1.2002, the remaining 40% was taken over. Now the plaintiff is a part of Havell's group, which is extremely well known in the field of electrical equipments. Apart from the trade mark right in the word 'STANDARD', the plaintiff is also the owner of the copyright in the packaging of various products. The plaintiff is also the owner of the copyright in various logos/devices used by it and its products. The figure of sale of the plaintiffs products under the trade mark STANDARD have risen from 17.23 crores in 1992-93 to 39.47 crores in the year 2001-02. The products of the plaintiff are being sold in India and also in many other countries, as detailed in para-10 of the plaint. The plaintiff has been spending huge sums of money on advertisements and publicity. The plaintiff spent Rs. 3.7 crores in the last ten years on publicity and advertisements. The trade industry and the public identify the word STANDARD with the plaintiff and the plaintiff alone, especially in relation to electrical equipment, the plaintiff is so well known under the trade mark STANDARD that mere mention of the word STANDARD means the plaintiff. The word STANDARD though a dictionary word, due to prior adoption and continuous use and due to excellent quality products is now distinctive of the plaintiff and has acquired a secondary meaning to connote and denote goods originating from the plaintiff.

3. The defendant No. 1 is apparently the distributor of the products of defendant No. 2. Defendant No. 2 is a

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manufacture of electrical switchgears, comprising of switch fuse units, changeover switches, direct on line starters, MCB boxes and distribution boards, R/F switches and rotary switches under the trade mark MS STANDARD. The plaintiff is the prior adopter and user of the trade mark STANDARD and the earliest trade mark user of the plaintiff is of 1961 though the trade mark was adopted in 1958. As against this, the user of the defendant is comparatively very recent. The plaintiff has found one price list which claims to be from 1.6.2002. The defendant, as such, was guilty of passing off an act of unfair competition. Therefore, it is not only infringing the common law and proprietary right in which the trade mark STANDARD was acquired by the plaintiff for a long use and any infringement of this trade mark by the defendant by later adoption of the trade mark MS STANDARD for manufacturing and sale of the similar products is likely to create confusion and deceive the consumer and the sub-standard goods of the defendant may tarnish the image and reputation of the plaintiff.

4. Defendant No. 2 has contested the suit. It was alleged that the defendant was registered proprietor of the trade mark MS STANDARD, which was registered in April, 1992 and has been renewed and is valid. The registration is subsisting. The defendant was earlier selling its goods under the trade mark MAX STANDARD since 1979 and from 1.3.1992 under the trade mark MS STANDARD. The trade mark STANDARD, as such, has been continuously used by it since 1979. The trademark MS STANDARD was changed in terms of the order of this Court in FAO 99/92 dated 14.11.1995. The defendant's trade mark had become so popular that the defendant even formed a private limited company by the name of MAX STANDARD SWITCHGEAR (P) LTD., which is still in existence.

5. Both the plaintiff and defendant are advertising their products under the respective trade marks in the same journals, diaries, yellow pages, print and visual media since long. Their advertisements are published in the same newspapers. The defendant is also publishing the caution notices in the leading newspapers from time to time. The defendant has also registered the copyright in the label MAX STANDARD. The defendant is not using the trade mark STANDARD simpliciter, but it uses MS STANDARD, which is sufficient even otherwise to distinguish the products of the defendant from those of the plaintiff and could not cause confusion or deception or pass off the goods of the defendant as that of the plaintiff. The word STANDARD is a common English language word and is highly laudatory and is incapable of being appropriated by any single person/company. The word STANDARD cannot acquire any secondary meaning. The basic meaning of the word STANDARD cannot be lost even if a person uses it for centuries. The word STANDARD is being used by several persons/companies in respect of the electrical and electronic goods, some of whom are prior to the plaintiff. Some have even registered the same though with disclaimer like the defendant. Thus, the same is common to trade and public juris. The word STANDARD has not acquired exclusivity in favor of the plaintiff nor it is claimed by the plaintiff. The plaintiff had the knowledge about the use of the mark earlier as MAX STANDARD and later as MS STANDARD by defendant No. 2. The plaintiff has filed the suit with inordinate delay and it suffers from laches and acquiescence and as such, the suit of the plaintiff is liable to be dismissed.

6. In the replication, the plaintiff has reiterated its own case and denied the allegations made by the defendants.

7. The plaintiff filed is 3314/03 for grant of ad-interim order on which, as noted above, as ex-parte ad-interim injunction order was granted. On being noticed, defendant No. 2 has applied for its vacation by filing is 3843/03.

8. I have heard learned counsel for the parties and gone through the records. The plaintiff's suit is filed on account of unfair competition by the defendant by adopting the trade mark MS STANDARD, which is deceptively similar to the plaintiff's trade mark, STANDARD, for sale of its products in relation to electrical equipments including switchgear, MCBs, isolators, RCCBs, distribution board, FR PVC wires, MCCBs, switch disconnector fuses, changeover-rewirable-double break switches, HBC fuses and plugs and sockets etc. The plaintiff and the defendant both have used the trade mark STANDARD with some prefix. The plaintiff has got six registration of trade mark STANDARD with prefix or suffix, as detailed in para-5 of the application. The trade mark of IAT STANDARD was being used from 1961, which has not been renewed. It is claimed that other registrations have been renewed and are valid and subsisting. The defendant, on the other hand, also claims to be the proprietor of registered trade mark MAX STANDARD since 1979, which trade mark was changed to MS STANDARD in the year 1992 pursuant to an order passed in a judicial proceedings. There is no controversy that registration of the trade mark is not a defense to a passing off action.

9. It is also not in dispute that both the plaintiff and the defendant are engaged in the business of manufacturing and sale of electrical equipments, some of which are similar in nature and further that the other products are cognate and allied products to the goods manufactured by the parties respectively under the trade mark STANDARD by the plaintiff and MS STANDARD by the defendant. Moreover, it has also not been denied that consumer of the goods of the plaintiff and defendant are the same. In other words, the goods of the parties are used, purchased and consumed in identical field.

10. An action for passing off is a common law remedy being in substance an action for deceit, i.e., a passing off by a person of his own goods as those of another. The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off. But 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

manupatra 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. Passing off one's own goods as that of another in a unfair competition and injures the goodwill and business of the person who had acquired propriety right in the exclusive use of a particular trademark. In a passing off action if the defendant shows that the getup, packing or other writing or marks on the goods or on the packets in which the goods are offered for sale are different or indicate clearly a trade origin different from the opponent, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff (Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories, MANU/SC/0197/1964 : [1965]1SCR737 ).

11. The Supreme Court in Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., 2001 PTC 541 (SC) laid down as follows:-

"As far as this Court is concerned, the decisions in the last four decades have clearly laid down that what has to be seen in the case of a passing off action is the similarity between the competing marks and to determine whether there is likelihood of deception or causing confusion."

12. It is further observed:

"The passing off action depends upon the principle that nobody has a right of represent his goods as the goods of somebody. In other words a man is not to sell his goods or services under the pretence that they are those of another person."

13. In paragraph-35, in relation to the passing off on the basis of unregistered trademark, it is observed that generally for deciding the question of deceptive similarity, the following factors are to be considered;-

- (a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.
- (b) The degree of resembleness between the marks, phonetically similar and hence similar in idea.
- (c) The nature of the goods in respect of which they are used as trade marks.
- (d) The similarity in the nature, character and performance of the goods of the rival traders.
- (e) The class of purchaser who are likely to buy the goods bearing the marks they require, on their education and intelligence and a decree of care they are likely to exercise in purchasing and/or using the goods.
- (f) The mode of purchasing the goods or placing orders for the goods.
- (g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

14. It was further held that:-

"For deceptive resemblance two important questions to be decided are: (1) who are the persons whom the resemblance must be likely to deceive or con fuse, and (2) what rules of comparison are to be adopted in judging whether such resemblance exists".

15. It was further held that:-

"As to the 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."

16. In Parle Products (P) Ltd. v. J.P. & Co. Mysore, PTC (Supp. 1) 346 (SC), it was held that 'in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him.'

17. In Corn Products Refining Co. v. Shangrila Food Products Ltd., MANU/SC/0115/1959 : [1960]1SCR968 , the Supreme Court held that "the question whether the two marks are likely to give rise to confusion or not in a question of first impression and that it was well recognised that in deciding a question of similarity between

18. In *Anglo Dutch PC & v. Works Pvt. Ltd.*, MANU/DE/0158/1976 : AIR1977Delhi41, this Court had observed that "the Supreme Court in *Com Products Refining Co.*, (supra) and *Amritdhara Pharmacy v. Satya Deo Gupta*, MANU/SC/0256/1962 : [1963]2SCR484, has laid down the test for comparing the two marks as under:-

(i) The question whether the two marks are so similar as likely to cause confusion or deceive is one of the first impression. It is for the Court to decide this question.

(ii) The question has to be approached by applying the doctrine of fading memory, i.e., from the point of view of a man of average intelligence having imperfect recollection.

(iii) Whether the overall visual and phonetic similarity of the two marks is likely to deceive such a man or cause confusion that he may make mistake the goods of the defendant for those of the plaintiff,

(iv) The other questions which are:-

(i) Who are the persons who are likely to be deceived, and

(ii) What rules of comparison are to be adopted in judging whether such resemblance exists.

19. The facts of the present case may not be considered on the touchstone of the principles laid down in the above cited judgments. In an action for passing off, the prior in use of the trade mark is important. Referring to the trade mark journal at p-44, copy of the letter of the meetings of the Board of Directors in the year 1961-62 at p-1 of the documents filed on 9.7.2003, letter dated 1.1.1968 sent to the Chartered Accountant at p-2 of the above documents, copy of the letter showing interest paid on export packaging credit to State Bank of India in the year 1969-70 at p-3 of the document, copy of export invoice dated 16.12.1972 and 22.1.1975 at p-4 and 5 of the documents, letter sent to Income Tax Officer on 27.2.1973 at p-6, export invoices dated 3.2.1973, 8.2.1973, 6.2.1973, 10.2.1973, 1.2.1973 at p-7 to 11 of the documents, registered letter dated 25.9.1973 at p-12 of the document file, letter sent to Income Tax Officer dated 12.12.1973 at p-13, copy of the letter to Ghaziabad Plant dated 25.5.1976 at p-14 of the documents, copy of the certificate of marriage awarded to Mr. K.K. Mehrotra dated 9.8.1981 at p-19, copy of the letter sent to Assistant Commissioner of Excise & Taxation at p-15 and the others sent on 22.12.1987 at p-16 and other documents, which are at p-17 to 157. Counsel for the plaintiff has argued that they clearly establish that the plaintiff was using the trade mark STANDARD continuously since 1961. It is urged that defendant No. 2 as per its own admission has adopted the user of the word MAX STANDARD in 1979 and MS STANDARD in 1992. It is also argued that the defendant had filed the printed invoices of the year 1997 and prior to that there are certain hand-written invoices, which bear no authenticity. Counsel for the plaintiff has cited *Century Traders v. Rushan Lal Duggar & Co. and Ors.*, MANU/DE/0153/1977 : AIR1978Delhi250 ; *N.R. Dongre v. Whirlpool Corporation*, 1996 (16) PTC 583 (SC) and *Sandeep Mani Proprietor of Capital Radio Company, New Delhi and Anr. v. Capital Sound Equipment, Delhi*, 1984 PTC 23 in support of his arguments. Learned counsel for the defendants, on the other hand, pointed out that invoices of the goods filed by the plaintiff prior to 1979 are only in respect of its export business and not selling of the goods in the Indian market. Anyway, he also argued that passing off action is an inconvenient remedy as compared to infringement action. He has referred to *American Home Products Corporation v. Mac Laboratories Pvt. Ltd. and Anr.*, MANU/SC/0204/1985 : AIR1986SC137. On the basis of the averments made in the pleadings and the documents, which have been relied upon by the parties, there is no gain saying that the plaintiff has adopted STANDARD as the trade mark for his products prior in time to the use of the trade mark MAX STANDARD for MS STANDARD by the defendant in terms of the pleadings. The plaintiff claims the user of the trade mark STANDARD since 1961, as compared to the defendant, who asserts that it is using MAX STANDARD since 1979 and MS STANDARD since 1992. But the material, which has been placed on record, prima facie shows that both the plaintiff and the defendant are marketing their electrical equipments under their respective trade marks since very long and the defendant is at least selling its products under the present trade mark MS STANDARD since 1992. Anyhow, the plaintiff will not become entitled to grant of ad-interim injunction demanded in the application merely on its prior in use of the trade mark STANDARD in the peculiarity of the present case, which cannot be ignored at this stage.

20. The plaintiff also claims that extensive use of the trade mark STANDARD and wide publicity given by it, has resulted in the consumers, traders of the electrical equipments in question to associate the products sold under the trade mark STANDARD with the plaintiff. Counsel for the plaintiff also referred to certain suits, which were filed by the plaintiff for protecting the trade mark STANDARD by some other parties. In one case, ex-parte ad-interim injunction was granted and the other matter was compromised. In the third, a decree for permanent injunction was granted against the trade mark STANDARD for electrical products and in the fourth, the defendant gave an undertaking that they will stop using the word STANDARD on their electrical goods. The suit is still pending. According to the plaintiff, the figure of sale of its goods under the trade mark STANDARD, runs into crores. So, is the position with regard to expenses incurred on advertisements and publicity by the plaintiff, which is many times more than what has been spent by the defendant.

manupatra 21. Be as that it may. The defendant's goods were being sold in the market since 1979 under the trade mark MAX STANDARD and under the trade mark MS STANDARD since 1992. The defendant is also expending substantial sums on the publicity of its goods and the trade mark. Figure of sale of goods of the defendant is also substantial, The plaintiff would not succeed merely because its sale exceeds many times more than the sale of the products of the defendant nor would it claim superior proprietary rights in the registered trade mark on account of expenditure in excess of the expenditure which is incurred by the defendant on publicity and advertisements of the products.

22. One of the contentions of the defendant is that the word STANDARD is a common word of English language and it is highly laudatory and is incapable of being appropriated by any single person/company and also does not acquire any secondary meaning so as to be associated with a particular person. The plaintiff, on the other hand, claims that even the common rational generic personal name and geographic name can also be protected by the Court as the trade mark for marketing a product. Reference was made to the judgment in Kaviraj Pandit Durga Dutt Sharma v. Navrathan Pharmaceutical Laboratories, (2) PTC (Supp.) 680 (SC) wherein the word Navrathan used for Ayurvedic medicines was protected and it was observed that if the two marks were identical, the infringement is made out, but if they are different, the plaintiff would have to establish that the mark used by the defendant was nearly resembling the plaintiff's registered trade mark and is likely to deceive or raise confusion to the goods in respect of which it is registered. This observation was made by the Court in a case of infringement of the trade mark. In Info Edge (India) Pvt. Ltd. and Anr. v. Shailesh Gupta and Anr., 2002 (24) PTC 355 (Del), with regard to the infringed trade mark 'Naukri', a contention was raised that it was an ordinary any generic word and as such, cannot be appropriated by one party. However, the Court held that use of similar word by a party coupled with dishonest intention and bad faith would empower the Court to restrain such user misuse to do equitable justice to the aggrieved party. In Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd., 2002 (24) PTC 121 (SC), the Supreme Court restrained the use of the word Mahendra observing that the trade mark had acquired a distinctiveness and a secondary meaning in the business or trade circles and that people have come to associate the name Mahindra with a certain standard of goods and services rendered by the plaintiff. Similar was the view taken in Indian Shaving Products Ltd. and Anr. v. Gift Pack and Anr., 1998 (18) PTC 698 and Kochar Oil Mills Ltd. v. Chhatar, Extractions Ltd. and Ors., 1 PTC (Supp.) 171 (Del). Prima facie there does not appear much force in the argument of the defendant that the word STANDARD is continuously used for a long time as a trade mark for selling its goods and the trade mark cannot be protected only because it is a common English language word, a generic, descriptive or laudatory word. An ordinary generic or descriptive word or even name of a person, geographical place, or surname may come to acquire distinctiveness and secondary meaning in the business and trade circle so as to associate a product sold under that trade name with a particular person. If another person is using the same word or a deceptively similar mark for marketing its products with dishonest intention to cash upon the reputation, popularity and goodwill of the products of the plaintiff, the plaintiff's trade mark is entitled to be given due protection by the Court.

23. The question arises whether the two trade marks cause or likely to cause confusion or deception in the mind of unwary and not so vigilant consumer and traders that they are likely to associate the product of the defendant with that of the plaintiff. As noticed, the plaintiff is using the trade mark STANDARD for selling its goods whereas the defendant's trade mark is MS STANDARD. Indeed, the test in arriving to the conclusion that the two marks are or not identical is not by putting the two marks side-by-side, but of a customer or a trader with weak memory, who had seen the goods manufactured under a particular trade mark holder and remembers the broad features and trade mark while buying the goods and mistook the goods manufactured by others under the same or similar brand name to be the one which he intended to buy. In the instant case indeed both the parties are using the word STANDARD, but the plaintiff is using the word STANDARD implicate as trade mark and the defendant is using the word MS STANDARD. Looking at the two trade marks, the samples of which have been placed on record, it would be clear that the word MS is pre-dominant and prominent in the trade mark of the defendant. If a person, who sees the trade mark of STANDARD and comes across another product with the trade mark MS STANDARD, he is unlikely to identify that product with that of the plaintiff. It is so because the documents have been placed on record by the plaintiff which disclosed that the word STANDARD in relation to the electrical goods is being used by different manufacturers and products of goods even from prior to adoption of this trade mark by the plaintiff. Though in a passing off action, the defense that a number of other parties are using same trade mark is untenable. But the fact remains that the plaintiff has not denied that quite a number of other persons are using the same trade mark. STANDARD with suffix and prefix in relation to the electrical or allied and cognate goods and some other goods. All these goods have not caused confusion and deception in the mind of consumers and traders, who wanted to buy the goods of the plaintiff only. Even in the contest of the present suit, counsel for the defendant has stated that the trade marks MS STANDARD and MAX STANDARD are in the market for the past about 24 years and it has not caused any confusion or deception in the minds of consumers and traders so as to harm the financial interests or reputation of the plaintiff. A glance at the infringed and infringing trade marks would show that the way in which the trade marks are used, prima facie cannot be said to be similar or identical so as to cause confusion and deception in the mind of the consumers of these products.

24. It is equally true that in passing off action, consumer's attention is paramount consideration and if there are chances of deception or confusion, right of the persons, who had acquired proprietary rights in the trade marks is to be given due protection. It will be advantageous to refer to Rob Mathys India Pvt. Ltd. v. Synthes Ag Chur, 1997 PTC 669; Amir Chand Om Prakash v. Monga Perfumery, 1996 PTC 385. Similarity it will be

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futile to plead on the part of the defendant that a number of other parties are using the same trade mark. It will not be a proper defense of a passing off action and in this regard, judgments in Indian Shaving Products Limited and Anr. v. Gift Pack and Anr., 1998 PTC 698; Essel Packaging Limited v. Sridhar Nara and Anr., 2002 PTC 233 and Info Edge (India) Pvt. Ltd. and Anr. v. Shailash Gupta and Anr., 2002 (24) PTC 355 (Del) may be referred.

25. Learned counsel for the defendant has contended that the word STANDARD being a deceptive word, could not be protected as a trade mark and cited certain foreign judgment where the word 'STANDARD'. 'HEAVENLY'. 'MUST, 'ALWAYS'. 'MERIT' were held to be descriptive and, Therefore, could not be given protection. He also cited certain Indian judgments in J.R. Kapoor v. Micronic India, 1994 PTC 260 (infringed trade mark -MICRONIX); Vijay Kumar Ahuja v. Lalita Ahuja. 2002 (1) CTMR 105: 2002 (24) PTC 141(Del) (infringed trade mark -MISTER, defense, ARUN AND ML); SBL Limited v. Himalaya Drug Co., 1997 (17) PTC (infringed trade mark -LIV.52); Aviat Chemicals Pvt. Limited v. Intas Pharmaceutical Ltd., 2001 PTC 601 (Del) (infringed trade mark -LIPICARD); Relaxo Rubber Limited and Ors. v. Aman Cable Industries and Ors., 1998 (18) PTC (infringed trade mark -RELAXO); Rochem Separation Systems (I) Pvt. Ltd. v. Tas Engineering Co. Pvt. Ltd., 2001 (1) CTMR 477 : 2 PTC (Supp) 120(Bom) (infringed trade mark -DISK TUBE); Girnar Food & Beverages Pvt. Ltd. v. Godfrey Phillips India Ltd., 2001 PTC 360 (Del.) (infringed trade mark -SUPER CUP); Rupee Gains Tele-Times Pvt. Ltd., v. Rupee Times, 1995 15 PTC (infringed trade mark -RUPEE TIME); Indo Pharam Pharmaceuticals Works Ltd. v. Citadel Fne Pharmaceuticals Ltd., MANU/TN/1178/1998 : AIR 1998 Mad 347 (infringed trade mark -ENERJEX); Competition Review (P) Ltd., v. N.N. Ojha, 1996 (16) PTC (infringed trade mark -COMPETITION); Novelty Emporium v. Novelty Creation Pvt. Ltd., 2002 (24) PTC 285 (Del.) (infringed trade mark -NOVELTY); K.M. Associates Pvt. Ltd., v. Good Times Pvt. Ltd., 2003 (26) PTC 428 (Suit No. 1985/02) (infringed trade mark -OXYGEN); Peshawar Soap & Chemicals Ltd. v. Godrej Soap Ltd., 2001 21 PTC 1 (infringed trade mark -NIKHAR); Hindustan Development Corporation v. The Deputy Registrar of Trade Mark and Anr., AIR 1995 Cal 519 (infringed trade mark -RASOI); Sant Kumar Mehra v. Ram Lakhan, 1999 19 PTC 307 (infringed trade mark -MATKEWALA); Panacea Biotec Ltd. v. Recon Ltd., 1996 16 PTC (infringed trade mark -NIMULID); Universal Industries v. Universal Agency, 1985 ALR 263 (infringed trade mark UNIVERSAL) and The Proctor and Gamble Co. v. Satish Patel, 1996 16 PTC 646 (infringed trade mark -SAFEGUARD). Recent judgment of Supreme Court in Mahendra & Mahendra Paper Mills Ltd, v. Mahindra & Mahindra Ltd. (supra) has also been cited in which it has been held that the word Mahindra & Mahindra was being used by the plaintiff for a long span of time extending over five decades and the name had acquire a distinctiveness and a secondary meaning in the business or trade circles and the people have come to associate the name 'Mahindra' with a certain standard of goods and services. Any attempt by another person to use the name in business and trade circles is likely to and in probability will create an impression of a connection with the plaintiffs' group companies. Therefore, the judgments, which have been cited above by the defendant would turn on their won peculiar facts and there cannot be generalization of the principle that a generic and ordinary dictionary, descriptive laudatory word would not be protected by the Court if it acquired exclusivity and association with the product of the plaintiff that the consumer of the goods would immediately recognise the goods sold under that mark as that of the plaintiff.

26. Learned counsel for the defendant argued that there is delay of about ten years, rather more than 20 years for the plaintiff in bringing up passing off action against infringement of trade mark. It is submitted that the defendant was marketing its products under the trade mark MAX STANDARD since 1979 and under the trade mark MS STANDARD since 1992. The advertisement in newspapers, trade journals, magazines and other filed and visual media were being published of the trade mark of the products and the trade mark of both the parties simultaneously. Attention has been drawn to a number of documents, which have been placed on record in this connection. It is argued that there is inordinate delay in filing of the present action by the plaintiff, which disentitles it from injuncting the defendant from using the trade marks MS STANDARD in relation to its goods. He has referred to B.L. and Co. and Ors. v. Pfizer Products Incl., 2001 PTC 797 (Del); Bravingtons Ltd. v. Barrington Tennant, 1987 RPC 183; Jolen Inc v. Shoban Lal Jain and Ors., 2001 PTC 216 (Mad); Swaran Singh Trading as Appliances Emporium v. Usha Industries (India) New Delhi and Anr., MANU/DE/0366/1985 : AIR1986Delhi343 ; Shri Gopal Engg. & Chemical Works v. POMX Laboratory, AIR 1992 Del 302; Gopal Hossier v. The Dy. Registrar of Trade Marks and Ors., MANU/WB/0015/1981 : AIR1981Cal53 ; Hindustan Pencils Private Limited and Anr. v. Universal Trading Company, 2000 PTC 561; The Fairdeal Corporation (Pvt.) Ltd. v. Vijay Pharmaceuticals, 1985 PTC 80; Synthetic Moulders v. Samperit Aktiergeselshaf, 1980 RLR 263; Century Electronics Limited v. C.V.S. Enterprises Limited, 1983 FSR 1; Paresh Chandra Saha v. Prakash Chandra Das and Anr., 2000 PTC 269; The Proctor and Gamble Co. v. Satish Patel, 1996 16 PTC 646; Paras Traders v. Rajasthan Copy Manufacturers Association (Regd.), 1996 16 PTC 229 where on account of delay for few months to 12-13 years, injunction was refused. But a perusal of these judgments will disclose that delay alone was not the reason in these cases to refuse ad interim injunction.

27. It is now well settled that in an action for passing off, a common law remedy would not be defeated merely because there is a delay on the part of the plaintiff in coming to the Court for protection of its propriety right over a trade mark. If the defendant had taken the infringed trade mark of the plaintiff fraudulently and deceptively, the plaintiff would not lose its right to file an action for passing off the goods owned by the defendant for its own goods as that of the plaintiff. In this regard, counsel for the plaintiff has cited the cases of Bengal Waterproof Ltd. v. Bombay Waterproof Mnfg. Co., 1997 17 PTC 98; Hindustan Pencils Pvt. Ltd. v. India Stationery Products Co. and Anr., MANU/DE/0383/1989 : AIR1990Delhi19 ; Rupa & Co. Ltd. v. Dawn

manupatra Mills Co. Ltd., 1999 19 PTC 334; Lupin Laboratories Ltd. v. Jain Products, 1999 19 PTC 118; Automatic Electric Limited v. R.K. Dhawan and Anr., 1999 PTC 81, Conopco Inc. v. Banwari Lal Trading as Cosmic Chemicals (India) and Ors., 1998 18 PTC 38 and Power Control Appliances v. Sumeet Machines Pvt. Ltd., 1995 PTC 165 (SC).

28. The principles governing grant of ad-interim injunction are now well settled. They are (i) whether the applicant has made out a prima facie case meaning thereby that there is a bona fide dispute and serious contentions which require interrogation and trial; (ii) whether balance of convenience is in favor of the applicant, that is to say, whether it would cause greater inconvenience to the applicant if interlocutory injunction is not granted than the inconvenience to which the affected party will be subjected if it is granted, and (iii) whether the applicant would suffer irreparable loss and injury if the prayer for grant of the interlocutory injunction is refused. All these considerations must be conjointly satisfied before the order of ad interim injunction is passed by the court.

29. In the present case, the plaintiff is using the word STANDARD as its trade mark in relation to electrical equipments, allegedly since 1958/1961. The defendant, on the other hand, is selling its own products under the mark MAX STANDARD since 1979 and presently under the trade mark MS STANDARD since 1992. Except the word STANDARD, which is common in the two trade marks, there is no constructive and visual resemblance between the two trade marks, MS STANDARD and STANDARD simpliciter in the way they are used on the product and their package. For the past 20 years, the defendant's goods sold under MAX STANDARD/MS STANDARD have not caused any monetary loss or injury to the reputation of the plaintiff. The trade mark of the defendant is registered since 1979/1992 and that of the plaintiff is registered since 1958 or so. Even the plaintiff in fact came to know of the presence of defendant's goods in the market even though the goods of both the parties were published sometimes in the same journals, newspapers and telephone directories, other print and visual media etc. Prima facie both have carved out a niche in the market for their goods identified by their peculiarly printed trade mark and they have not caused any confusion or deception in the trade circle so as to pass off the goods of the defendant as that of the plaintiff. Therefore, even if it is assumed, though not held that there is prima facie a case in favor of the plaintiff for grant of ad-interim injunction or the plaintiff has bona fide dispute and serious contentions, which required investigation, the balance of convenience is not in favor of grant of ad-interim injunction in the peculiarity of the facts of the present case. In this regard, principles laid down in the judgments in Colgate Palmolive (India) Ltd. v. Hindustan Lever Ltd., MANU/SC/0494/1999 : AIR1999SC3105 ; Wander Ltd. and Anr. v. Antox India (P) Ltd., 1991 PTC 1; Ciba Geigy Ltd. v. Sun Pharmaceutical Industries, 1997 17 PTC 364; Sanjeev Kumar Co. v. Bishnu Prasad and Brothers, 1999 19 PTC 440; Jitender V. Jain and Anr. v. Living Media India Ltd. MANU/DE/2062/2002 may be perused. In order to protect the plaintiff's monetary interests, it would suffice if certain conditions are imposed on the defendant at this stage instead of restraining the defendant, after being for 24 years long standing in the market selling its product under the trade mark MS STANDARD, by an interlocutory injunction. (See Sanjeev Kumar & Co. v. Bishnu Prasad and Brothers, 1999 19 PTC 440).

30. In the facts and circumstances of the present case, it is not a fit case where ad-interim order as prayed for may be granted. However, in order to protect monetary and other interests of the plaintiff during the pendency of these proceedings, the defendant may be directed to keep proper accounts of its products sold under the trade mark MS STANDARD or any other mark, which is an obvious imitation or deceptively similar to the trade mark used by the plaintiff for marketing its products and produce the same in Court as and when it is required to do so. Accordingly, it is directed that the defendant shall maintain proper audited accounts of electrical equipments manufactured and sold by it under the trade mark MS STANDARD to be produced in the Court, as and when it is so directed. The ex-parte ad-interim injunction order granted in favor of the plaintiff on 21.3.2003 is vacated. Both the applications stand disposed of.