

RAJASTHAN HIGH COURT

(Jaipur Bench)

Before :- Mohammad Rafiq, J.

S.B. Civil Miscellaneous Appeal No. 2972 of 2015 with Stay Application No. 2039 of 2015.
D/d. 30.01.2016.

M/s. International Dog Bazar - (Plaintiff-Appellant)

Versus

International Dog World - (Defendant-Respondent)

Equivalent Citation: 2016 (2) R.C.R. (Civil) 160 : 2016 (1) DNJ 422 : 2016 (66) PTC 30 (RAJ.)

For the Plaintiff-Appellant :- **G . D . Bansal** , Advocate.

For the Defendant-Respondent :- Y.S. Choudhary, Advocate.

Trade Marks Act, 1999 Sections 28, 29, 31 and 32 Passing off action-prior user- Plaintiff is using firm name "International dog Bazar" and its abbreviation - "IDB" and website -"www.internationaldogbazar.com" for trading of live animals and pet dogs-defendant/respondent subsequently adopted deceptively similar firm name "International Dog World" and its abbreviation - "IDW" and website "www.internationaldogworld.com" for the similar business - Trial court was wholly unjustified in holding that the trademark of the both parties are different due to difference in last words "bazar" and "world" - Plaintiff submitted many authorities/judgements - But trial court has simply brushed aside and refuse to look into them by cryptic observation that they are not helpful to the plaintiff - Trial court did not discuss true and correct perspective and passed impugned order - Trial court failed to appreciate that substantial part of the trademark are similar - Trial court failed to correctly appreciate provisions of section 28, 29, 31 and 32 of the trademark act, 1999 - Defendant/respondent had applied for trademark "International Dog World" and was registered by the authority concerned-objections of the plaintiff was not accepted by the Registrar of trademark - Held :-

(1) Substantial similarity between two names-mere reason of difference in the suffix "Bazar"/"world" does not create difference - General impression - Layman-average intelligence or common man with an ordinary imperfect recollection of memory could not be able to distinguished both trademarks/Trade name - Substantial similarity would cause confusion in the mind of public - Therefore, action of defendant brings within the purview of passing off action.

(2) Passing off action "A" is not entitle to represent his goods as the goods of "B" in the mind of customers side by side comparison may habit many and various differences but due to substantial similarity ordinary man might or particulars are taken in case of device Mark consider what are the essential features and particulars of the device

(3) In an action for passing off, it is usual, rather essential to seek an injunction, temporary or ad-interim-passing off cases are often cases of deliberate and intentional misrepresentation.

(4) It is well settled that fraud is not necessary element of the right of action absence of intention to deceive is not a defence probability of deception is sufficient.

(5) Plaintiff does not have to prove actual damage in order to succeed in action for passing off likelihood of damages is sufficient.

(6) Passing off action similarities rather than the dissimilarities, have to be taken note of by the court principle of phonetic "similarity" cannot be ignored.

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

(8) It is well settled that in case of infringement either of trademark or of copyright, normally an injunction in such cases.

(9) Passing off action test of similarity to be applied whether a man of average intelligence and of imperfect recollection would be confused an unwary purchaser is not keep the goods of two manufacturer for side by side comparison to compare similarities and dissimilarities thereon meticulously to decide whether he is purchasing the same goods which he had intended to buy.

(10) Deception can be cause by user of one or more essential features of a Mark-likely to be confused on the first impression-duty of the court.

(11) Passing off action plaintiff has to established prior user to secure an injunction the registration of Mark or similar Mark prior in point of time is irrelevant.

(12) The principle of similarity cannot be very rigidly applied if dishonest intention on the part of the defendant an injunction should ordinarily follow mere delay in bringing the matter to court is not a ground to defeat the case of plaintiff.

(13) Application for temporary injunction allowed the defendant restrained from using the Trade name "international dog world", logo"IDW" and website www.internationaldogworld.com pending the disposal of the suit.

[Paras 2 to 13 and 15 to 21]

Cases Referred :

A.G. Spalding & Bros. v. A.W. Gamage Ltd., (1915) 32 R.P.C. 273.

Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., 2005(1) R.C.R.(Civil) 769 : (2001) 5 SCC 73.

Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142.

Heinz Italia v. Dabur India Limited, 2007(3) R.C.R.(Criminal) 290 : 2007(3) R.C.R.(Civil) 365 : (2007) 6 SCC 1.

Laxmikant V. Patel v. Chetanbhai Shah, 2002(2) R.C.R.(Civil) 357 : (2002) 3 SCC 65.

Erven Warnink BV v. J. Townend & Sons, (1979) 3 WLR 68.

Midas Hygiene Industries Pvt. Ltd. v. Sudhir Bhatia, (2004) 3 SCC 90.

Mind Gym Ltd. v. Mindaym Kids Library Pvt. Ltd., 2014 (58) PTC 270 (Del).

MRF Ltd. v. NR Faridabad Rubbers, 1998 PTC (18) Delhi.

Ruston and Hornby Limited v. Zamindara Engineering Company, AIR 1970 SC 1649.

Star industrial Co. Ltd. v. Yap Kwee Kor, (1976) Fleet Street Patent Law Reports 256.

JUDGMENT

Mohammad Rafiq, J. - Plaintiff-appellant herein has approached this court challenging order dated 02.07.2015 passed by Additional District Judge No.17, Jaipur Metropolitan, who thereby dismissed its application under Order 39 Rules 1 and 2 read with Section 151 of the Code of Civil Procedure, praying for order of temporary injunction against defendant-respondent.

2. Appellant, M/s. International Dog Bazar through its Proprietor Virendra Sharma, filed a suit against respondent M/s. International Dog World under Section, 27(1) and 134 of the Trade Marks Act, 1999, inter alia, pleading therein that appellant has been trading in live animals and pet dogs from the year 1990 since the time of its earlier proprietor Hukam chand, father of its present proprietor Virendra Sharma. Its registration number is 1819277, which has been renewed up to 18.05.2019. Its trade name is "international Dog Bazar". Appellant firm is renowned by its logo name "IDB". Appellant also runs a website in the name of www.internationaldogbazar.com. Appellant has spent a huge money in advertisement through various media of its registered trade mark "International Dog Bazar", so as to promote services and business, on account of long user and ample advertisement, appellant's trade mark became well-known trade mark and also got secondary meaning in the market in respect of trading of live animals and pet dogs. Appellant was the first such firm to start business of this kind in the country, therefore, it is pioneer and founder of the business of live animals and pet dogs and its abbreviated name "IDB" is printed on all its promotional materials and hoardings and display boards, and also became a trade mark. This trade mark is well known amongst its customers, users and related persons. Appellant has therefore right to use the aforesaid registered trade mark and no one else can be permitted to use such trade mark separately or independently or in a manner, which is identical and deceptive to the appellant's trade mark.

3. It was pleaded that respondent has recently started similar business under the trade mark "International Dog World" with its abbreviation "IDW, is deceptive and similar to the

appellant's trade mark. Respondent is fully aware about goodwill, reputation and well-known identity of appellant's trade mark "International Dog Bazar" in the market. Despite that, respondent has cleverly adopted appellant's trade mark "international Dog Bazar". According to settled proposition of law related to similarity of trade marks, respondent's trade mark "international Dog World" is deceptively similar to appellant's registered trade mark "International Dog Bazar". Similarly, respondent intentionally and knowingly also adopted abbreviated form "IDW", which is identical to that abbreviated form of appellant's firm "IDB". Moreover, respondent also opened a website in the name www.internationaldogworld.com, which is also deceptively identical to the website of appellant, referred to above. This only shows dishonest intention on the part of defendant. The defendant has no explanation whatsoever why he so adopted similar and deceptive trade mark in respect of same business. It clearly establishes that defendant had mala-fide intention to take advantage of goodwill and reputation of the plaintiff's registered trade mark "international Dog Bazar" and also abbreviated word "IDB". Plaintiff's trade mark is composite mark and broad and essential feature of plaintiff's trade mark is "International" and therefore defendant-respondent has with mala fide intention adopted deceptive similar composite name consisting two similar words of trade mark, namely, "international" and "Dog", as part of its trade mark. Defendant-respondent has no legal right to use such deceptive trade mark in respect of similar nature of work.

4. Defendant-respondent contested the suit as also application for temporary injunction, filed by plaintiff-appellant and in reply thereto, defendant-respondent maintained that its trade mark "International Dog World" is entirely different than plaintiff's registered trade mark. Though two suffix words, namely, "International" and "Dog" are similar, but there is difference in last word, while plaintiff has "Bazar" in the last of its trade mark, defendant has "world" as the last word of its trade mark. Thus both the trade marks are totally different and creates no confusion in the mind of customers. Defendant-respondent also submitted that abbreviated name of trade mark of plaintiff-appellant is "IDB", whereas that of defendant-respondent is "IDW", therefore both do not carry any similarity. Plaintiff-appellant does not have any right over the words "international" and "Dog", and both these words do not come in the definition of trade mark. No one can claim exclusive right over the said words under the Trade Marks Act, 1999 (for short, 'the Act of 1999'), especially over the word "Dog" which is a generic word. Learned trial court, by the impugned order, has rightly disallowed application for temporary injunction.

5. Shri G.D. Bansal, learned counsel for plaintiff-appellant, has argued that learned trial court has erred in law in rejecting the application filed by plaintiff-appellant for grant of temporary injunction. Order passed by learned trial court runs contrary to settled proposition of law relating to infringement of trade mark. Learned trial court was wholly unjustified in holding that trade marks of two parties are different due to difference in last words of both, as one party has "Bazar" as last word of its trade mark, whereas another party has "World" as the last word of its trade mark. It has further wrongly held that there was no similarity in trade marks of two. Learned trial court failed to appreciate that abbreviation of trade marks of two parties, namely, "IDB" and "IDW" bears striking similarity and can mislead the customers. Defendant-respondent thereby tried to take undue advantage of the goodwill and business reputation of plaintiff-appellant. Learned trial court failed to appreciate that defendant-respondent has, by his conduct, not only infringed restricted trade mark of plaintiff-appellant but also caused loss to his goodwill and reputation of plaintiff-appellant in an action for passing off. Learned trial court has taken note of as many as sixteen judgments, relied on by plaintiff-appellant but has simply brushed aside them by observing that cited judgments are distinguishable on facts. In doing so, learned trial court has not considered and dealt with ratio of any of the judgments. It refused to look into them by cryptic observation that they are not helpful to plaintiff.

Learned court below has not discussed prima facie case in its true and correct perspective and passed the impugned order on the basis of surmises and conjectures. It has not discussed ingredients of balance of convenience and irreparable loss properly. Learned trial court failed to appreciate the basic principle that broad essential features of rival trade marks have to be taken into consideration to decide the question of infringement. It failed to appreciate that substantial part of trade mark i.e. "international Dog ..." preceding "Bazar" and "World", of plaintiff-appellant and defendant-respondent, not just similar but exactly same. Plaintiff's registered trade mark has since long, acquired identity and acceptability amongst customers, users and trade channels. Both the trade marks are not only similar but also phonetically identical. There is clear imitation of the trade mark of plaintiff-appellant by defendant-respondent. Learned trial court failed to correctly appreciate provisions of Sections 28, 29, 31 and 32 of the Act of 1999. Learned counsel for plaintiff-appellant has produced for perusal of the court photographs of the logos used by plaintiff-appellant, which were obtained from the justdial.com as also the photographs showing the shop of defendant. He argued that there are multiple number of shops run by defendant in Jaipur city, one of which is in the vicinity of the main shop of plaintiff.

6. Learned counsel for plaintiff-appellant, in support of his arguments, has relied on judgments in **Heinz Italia and Another v. Dabur India Limited - 2007(3) R.C.R.(Criminal) 290 : 2007(3) R.C.R.(Civil) 365 : (2007) 6 SCC 1. MRF Ltd. v. NR Faridabad Rubbers and another - 1998 PTC (18) Delhi. Laxmikant V. Patel v. Chetanbhai Shah - 2002(2) R.C.R.(Civil) 357 : (2002) 3 SCC 65 and Midas Hygiene Industries Pvt. Ltd. v. Sudhir Bhatia and others - (2004) 3 SCC 90.**

7. Per contra, Shri. Y.S. Choudhary, learned for respondent, opposed the appeal and argued that learned trial court was perfectly justified in rejecting application for temporary injunction because plaintiff-appellant has miserably failed to establish prima facie case inasmuch as balance of convenience was also not favour plaintiff-appellant and that there was no irreparable loss caused to plaintiff-appellant by non grant of interim injunction. Defendant-respondent had applied for trade mark and trade mark "international Dog world" was registered in the name of defendant-respondent by the authority concerned. Learned counsel in this connection has produced before this court a letter dated 16.09.2015, and argued that objection of plaintiff-appellant was not accepted by the Assistant Registrar of Trade Marks. The trial court found that last words, namely, "Bazar" and "World" of name the trade marks of both the parties i.e. "International Dog Bazar" and "international Dog world" are completely different and there was no similarity between two. They are not only visually different but also phonetically distinguishable. They cannot be considered as similar names. Plaintiff-appellant will have to prove that logo "IDW" was being misused by defendant-respondent, inasmuch as he also failed to prove whether such logo was put by defendant-respondent on his shop or elsewhere. The trial court therefore rightly held that loss of business goodwill or reputation was not established, and that there was no prima facie case in favour of plaintiff-appellant, plaintiff-appellant also failed to prove that defendant/respondent was deriving any undue benefit or alleges similarity in the names of websites of the two, whereas names of the websites of the two are entirely different.

8. I have considered the rival submissions, perused the material on record and studied the cited precedents.

9. Indisputably, plaintiff-appellant has been having trade mark "international Dog Bazar" in the name of Hukam Chand, father of present proprietor of plaintiff-appellant, since 1990. The logo of plaintiff-appellant "IDB" is also being used since then. Besides, the website address of plaintiff-appellant is www.internationaldogbazar.com. use of trade mark "international Dog world" by defendant-respondent is of recent origin. Not only the name

and logo but also the website address of the two bears striking similarity. Learned trial court, while deciding application for temporary injunction, has although held that plaintiff-appellant failed to prove prima facie case but did not make any discussion whatsoever either on facts or law. It was singularly guided by fact that trade name "International Dog World" was also registered with the Trade Marks Registry' of the Government of India, and that last word "World" of the trade mark of defendant-respondent was different not only visually but also phonetically than the last word "Bazar" of the trade mark of plaintiff-appellant. Though, the trial court took notice of as many as sixteen judgments cited on behalf of plaintiff-appellant but did not deal any one of them in this respect.

10. In Order to decide claim of defendant that the trade name used by them is distinguishable than that of plaintiff and is also non-deceptive, we have to find out whether substantial similarity between two names by mere reason of difference in the suffix "Bazar"/"world", carry leading and essential characteristics and what general impression a layman gathers on seeing/receiving the trade name used by defendant-respondent. The court in doing so, will have to examine the trade mark of defendant to identify its essential features and characteristics. It should then visualize, putting itself in the place of an average common man with an ordinary and imperfect memory, whether the essential features and characteristics of plaintiff's mark are reproduced and highlighted in defendant's mark. Are they such which may cause confusion in the mind of public? Whether the action of defendant-respondent to adopt such trade name, was intended to take benefit of the reputation and goodwill of plaintiff's trade mark? whether action of defendant * brings this matter within the purview of passing off action under the Trade and Merchandise Marks Act, 1958?

11. The Supreme Court in ***Ruston and Hornby Limited v. Zamindara Engineering Company - AIR 1970 SC 1649***, has observed that gist of a passing off action is that 'A' is not entitled to represent his goods as the goods 'B' in the minds of customers. In Kerly's "Law of Trade Marks and Trade Names", Twelfth Edition, the test determining the rules of comparison to determine deceptive similarity are stated thus -

Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they, frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with they are in the habit of dealing. Marks or names are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole, when the question arises whether a mark applied for bears such resemblance to another marks as to be likely to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only, impressions left on the mind might be very different. On the other hand, a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same. Thus it is clear that a mark is infringed if the essential features, or essential particulars of it, are taken. In cases of device marks, especially, it is helpful before comparing the marks to consider what are the essentials of plaintiff's device."

12. In **Laxmikant V. Patel** (supra), the Supreme Court held that in an action for passing off, it is usual, rather essential, to seek an injunction, temporary or ad-interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. Passing off often cases of deliberate and intentional misrepresentation, but it is well-settled that fraud is not a necessary element of the right of action, and the absence of an intention to deceive is not a defence, though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception. Therein, the Supreme Court, while referring to authority of Christopher Wadlow in Law of Passing off (1995 Edition, at P. 3.06), observed that plaintiff does not have to prove actual damage in order to succeed in an action for passing off. Likelihood of damage is sufficient. It further observed that defendant's state of mind is wholly irrelevant to the existence of the cause of action for passing off.

13. The Supreme Court in **Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd. - 2005(1) R.C.R.(Civil) 769 : (2001) 5 SCC 73**, has held that in the case of a passing-off action, the similarities rather than the dissimilarities, have to be taken note of by the court and the principle of phonetic "similarity" cannot be ignored and the test is as to whether a particular mark has obtained acceptability in the market so as to confuse a buyer as to the nature of product he was purchasing. The Supreme court in para 10 of the report has laid down the following tests in the case of passing off,

"In other words in the case of unregistered trade marks, a passing-off action is maintainable. The passing-off action depends upon the principle that nobody has a right to 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. As per Lord Diplock in **Erven Warnink BV v. J. Townend & Sons, (1979) 3 WLR 68** the modern tort of passing off has five elements i.e. (1) a mis-representation, (2) made by a trader in course of trade, (3) to prospective customers of his or ultimate consumers of s or services supplied by him, (4) which calculated to injure the business or goodwill of another trader (in the sense that is a reasonably foreseeable consequence), and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quatiimet action) will probably do so."

14. Section 17 of the Act of 1999 provides that when a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole. Sub-section (2) however provides that notwithstanding anything contained in sub-section (1), when a trade mark (a) contains any part (i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or (ii) which is not separately registered by the proprietor as a trade mark; or (b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered. Sub-section (2) of Section 17 of the Act of 1999, thus operates in a distinctively defined arena. *Where a person has registered a mark of multiple parts, he enjoys a monopoly of the entirety of that mark with all its parts taken as a whole. The registration of a mark with components does not give him rights over the individual Integers in that mark unless those individual integers are separately registered or applied for, where such individual integers are non-distinctive and common to the trade, no rights accrue in the individual thereabout, but when a trade mark consist of several matters, its registration shall confer on the proprietor exclusive right to use of the trade mark as a whole* (emphasis mine). Here, in the present case, there does not appear to be any application of sub-Section (2) of Section 17 of the Act of 1999 because Section 17(1) alone

attach full exclusivity to the trade mark "international Dog Bazar", which is being used by plaintiff-appellant for a pretty long time.

15. Section 28 of the Act of 1999 inter-alia provides that registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by the Act. Sub-section (2) thereof provides that exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject. Sub-section (3), with which we are concerned in the present case, provides that where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

Section 29 of the Act of 1999 provides for infringement of registered trade marks. Its sub-section (1) provides that a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark. Sub-section (2) provides that a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of - (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark. Sub-section (4) inter alia provides that where a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which - (a) is identical with or similar to the registered trade mark; and (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark. Sub-section (5) provides that a registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

16. The Supreme Court in, Midas Hygiene industries Pvt. Ltd. (supra), held that the law on the subject is well settled that in cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest.

17. The Delhi High court in **Mind Gym Ltd. v. Mindaym Kids Library Pvt. Ltd., 2014 (58) PTC 270 (Del)**, while dealing with the question of goodwill and reputation by plaintiff in an action for passing off, made the following observations:-

"Goodwill and reputation in India by the plaintiff in an action for passing off 13. infringement of a registered trademark is caused by the use of the mark which is identical or nearly resembling to that of registered trademark in respect of the same, similar or different goods in terms of `provisions, of the Act. In that sense, the remedy of infringement is statutorily referred upon the registered proprietor. On the other hand, passing off action is an action in common law which is essentially the protection of goodwill and reputation which the person has created by virtue of carrying out of business activities under a particular name and style or under a brand name for that matter and the said action is an action in deceive which is to prevent any misrepresentation caused amongst public. The said misrepresentation may be in the form of representation or deliberate representation which is immaterial in the case passing off.

14. The fundamental difference that passing off is an action which essentially protects goodwill, and not the unregistered trademark has been explained in the case of **Star Industrial Co. Ltd. v. Yap Kwee Kor, [1976] Fleet Street Patent Law Reports 256** decided by Privy Council comprising Lord Diplock in his speech wherein it has been observed that passing off is an action which is to preserve the goodwill of a person and not aimed at to protect an unregistered trademark. In the words of Lord Diplock, it has been observed as under:-

"whatever doubts there may have previously been as to the legal nature of the rights which were entitled to protection by an action for "passing off" in courts of law or equity, these were laid to rest more than 60 years ago by the speech of Lord Parker of the waddington in **A.G. Spalding & Bros. v. A.W. Gamage Ltd., (1915) 32 R.P.C. 273** ("the Gamage Case") with which the other members of the House of Lords agreed. A passing off action is a remedy for the invasion of a right of property not in the mark, name or get up improperly used, but in the business or goodwill likely to be injured by the misrepresentation made by passing-off one person's goods as the goods of another. Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached. It is local in character and divisible; if the business is carried on in several countries a separate goodwill attaches to it in each. So when the business is carried abandoned in one country in which it is acquired a goodwill the goodwill in that country perishes with it although the business may continue to be carried on in other countries. Once the Hong Kong Company had abandoned that part of its former business that consisted in manufacturing toothbrushes for export to and sale in Singapore it ceased to have any proprietary rights in Singapore which was entitled to protection in any action for passing-off brought in the courts of that country."

15. From the reading of the said observation of Lord Diplock's is speech, it is clear that the gist of passing action is goodwill and reputation which is sought to be protected and thereby misrepresentation is prevented in the course of trace. It is altogether different matter that misrepresentation may include the use of mark in the course of trade and ultimate effect of passing off action in most the cases is protection of the trademark anyway, but the heart and soul of the passing off action has always been protection of goodwill and reputation aimed at to prevent misrepresentation."

18. The Delhi High Court in MRF Limited (supra), was dealing with the case where a suit was filed by plaintiff for perpetual injunction, restraining defendants from passing off their goods and business as and for the goods and business of plaintiff by using the offending trade mark "NRF or any other trade mark deceptively similar thereto, in relation to tubes used in tyres or any other product and further restraining defendants from infringing plaintiff's registered trade mark "MRF" by using the impugned mark "NRF" and also for rendition of accounts. Plaintiff, engaged in the manufacture and sale of automobile tyres/tubes, filed an application under order 39 Rules 1 and 2 read with section 151 of the CPC, seeking temporary injunction to the same effect till the disposal of the suit, which was declined by the trial court. The Delhi High Court held that the test to be applied in such matters is as to whether a man of average intelligence and of imperfect recollection would be confused. An unwary purchaser is not expected to keep the goods of two manufacturers or the labels side by side and compare the similarities and dis-similarities thereon meticulously to decide whether he is purchasing the same goods which he had intended to buy. Deception can be caused by user of one or more essential features of a mark and degree of resemblance necessary to deceive or cause confusion could not be defined and the question to be asked by the Court to itself is as to whether the customers of average intelligence and imperfect recollection are likely to be confused on the first impression.

19. The Supreme Court in Heinz Italia (supra), was dealing with a case where plaintiff was the proprietor of the trade mark "Glucon-D", which had been registered in India under the Trade and Merchandise Marks Act', 1958. That trade mark had earlier been registered in the name of Glaxo on 21.05.1975, but subsequently vide deed of assignment dated 30.09.1994, that had been assigned to the first petitioner along-with the goodwill, etc. Glaxo Laboratories had also assigned their rights in the artistic work used on the packaging. Plaintiff thereupon used the trade mark "Glucon-D" and the "packaging" from the year 1994 to 2002. Plaintiff came to learn in July 2002 that defendant, Dabur India, had launched a similar product under the name "Glucose-D" by using packaging which was deceptively similar to the packaging used for "Glucon-D". Plaintiff then filed a suit for permanent injunction and accounts of profits for infringement of the trade mark and infringement of copyright. Along-with the suit, plaintiff also filed an application under Order 39 Rules 1 and 2 CPC for grant of an ad interim injunction to restrain defendant from using the trade mark "Glucose-D" or any other trade mark and lively similar packaging as well. The trial court held that word "Glucose" was a generic word and, as such plaintiff could not claim that the use of the word "Glucose-D" violated their registered trade mark "Glucon"-D". The trial court also rejected the plea that the packaging used by defendant was deceptively similar. The first appeal filed there against was dismissed by the Punjab and Haryana High Court. In those facts, when the matter reached the Supreme Court, their Lordships held that in an action for passing off, plaintiff has to establish prior user to secure an injunction and the registration of the mark or similar mark in point of time is irrelevant. Before use of a particular mark can be appropriated, it is for plaintiff to prove that the product, that he is representing, had earned a reputation in the market and that this reputation had been sought to be violated by the opposite party. The principle of similarity cannot be very rigidly applied and if it can be prima facie shown that there was a dishonest intention on the part of defendant in passing off goods, an injunction should ordinarily follow and mere delay in bringing the matter to court is not a ground to defeat the case of plaintiff, in the case of passing-off action, the similarities rather than the dissimilarities, have to be taken note of by the court and the principle of phonetic "similarity" cannot be ignored and the test is as to whether a particular mark has obtained acceptability in the market so as to confuse a buyer as to the nature of product he was purchasing. The Supreme Court, in that case, while reversing the judgment of the courts below, granted temporary injunction in favour of plaintiff.

20. In ***Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142*** the Supreme Court observed that the principle of similarity could nature very rigidly applied and that if it could be prima facie shown that there was a dishonest intention on the part of defendant in passing off goods, an injunction should ordinarily follow and mere delay in bringing the matter to court was not a ground to defeat the case of plaintiff.

21. In view of the above, the present appeal deserves to succeed and is hereby allowed. The impugned order is quashed and set aside. The application filed by plaintiff for grant of temporary injunction under Order 39 Rules 1 and 2 read with Section 151 of the CPC, stands allowed in terms of the prayer made therein and defendant-respondent, by means of temporary injunction, is restrained from using trade mark/trade name "international Dog world", logo - "IDW" and website "www.internationaldogworld.com", pending disposal of the suit for perpetual injunction.

22. As this order is confined to interim injunction order, any observation made in this order would not bind learned trial court in final adjudication of the suit.

Stay application also stands disposed of.

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