

CALCUTTA HIGH COURT

(D.B.)

Before :- A.K. Banerjee and Arijit Banerjee, JJ.

G.A. No. 175 of 2014, A.P.O.T. No. 31 of 2014 and C.S. No. 452 of 2013. D/d. 30.1.2014.

B.S. Progressive Pvt. Limited - Appellant

Versus

S.G. Sales Corporation and Ors. - Respondents

Equivalent Citation: 2014(6) R.A.J. 556 : 2014(59) PTC 467

For the Appellants :- Ranjan Bachawat, Senior Advocate, Debnath Ghosh, Subhasish Sengupta and Sanjay Kr. Baid, Advocates.

For the Respondents :- **G . D . Bansal** , A.K. Gandhi, Advocates and Rudraman Bhattacharya, Piyali Sengupta, Sarosij Dasgupta, Arunima Lala and Supratim Basu, Advocates.

Civil Procedure Code, 1908, Order 39 Rules 1 and 2 - Injunction - Trademark - Infringement of - Difference in category - Appellant filed instant suit, inter alia, praying for an order of injunction as according to them, they were the registered user of mark "Austin" in plywood whereas defendant did not have any such registration in plywood - They also claim, they were prior user of mark having duly registered under class 19 - Defendant categorically asserted, they were under class 20 being manufacturer of furniture - Passing off action - Parties are in different classes in matter of registration - Present is a passing off action - Facts revealed that it would be too early to conclude finally who is in business of plywood earlier than other, let it be decided at proper time - Plaintiff should be afforded full opportunity to establish his case as to prior use - Defendant would also be entitled to defend - Appeal is disposed of without any order as to costs.

[Paras 12 and 15]

Cases Referred :

[Dhariwal Industries Ltd. v. M.S.S. food Products, 2005 \(30\) PTC 233 SC.](#)

[Glaxo India Ltd. v. Eudora Laboratories Pvt. Ltd., 1997\(17\) PTC 794.](#)

[Rotomac Pens Ltd. v. Milap Chand and Co., 1999 PTC 757.](#)

JUDGMENT

A.K. Banerjee, J. - Facts

1. The appellant is the user of the mark "Austin" in its manufacturing and business of plywood and other related products. The appellant would claim, they were having

registration under class 19 as would appear from the certificate under the Trade Mark Act, appearing at page 93-95. From the certificate it appears they are having registration under class 19. The respondent initially applied for the identical mark for plywood and other related products including furniture that was classified in class 20. The respondent got the registration in class 20 that did not include plywood. There was spate of litigation between the parties for a substantial period that we would be discussing little later. The respondents would contend, they made the application for the mark "Austin" in class 19 that would include plywood, on July 16, 2003. There was appropriate advertisement and ultimately the Authority granted certificate in furniture being class 20 on December 30, 2005. The appellant applied for the identical mark in respect of plywood on November 1, 2006 and got registration accordingly.

2. In 2008 respondent filed a suit against the appellant in the district Court at Jaipur, inter alia, praying for order of injunction restraining the appellant from using the mark "Austin", however, they were unsuccessful, both before the learned District Judge as well as in the High Court. However, they would contend, the appeal before High Court is still pending. The appellant filed a suit in the City Civil Court at Calcutta in June 2010, inter alia, praying for the similar relief against the respondent. The learned Judge refused to pass ex-parte order, the Division Bench also declined to pass any interim order, however, asked the defendant to keep accounts. The appellant did not proceed with the suit any further and withdrew the same with liberty to move afresh.

3. The appellant subsequently filed a suit in this Court alleging infringement of their mark. The appellant initially filed the suit against infringement of mark; however, the later suit was for passing off action. The learned Single Judge declined to pass an interim order. Being aggrieved, the appellant filed the instant appeal

Rival Contentions

4. Mr. Ranjan Bachawat, learned Senior Counsel would advance his argument on behalf of the appellant. According to Mr. Bachawat, the respondent was a manufacturer of furniture having been authorised to use the mark "Austin", they recently started using the said mark in plywood that would be illegal. The respondent having registered in class 20, was not entitled to use the mark for any product classified under class 19. He would refer to the advertisement published by the respondent wherein there was enough scope for a customer to be confused. The respondent in the advertisement contended through their Trade Mark Attorney, they were the authorised user of the mark in their business that would include plywood.

5. Per contra, Mr. G.D. Bansal, learned Counsel appearing for the respondent No. 1 to 4 would contend, in a passing off action, the prior user must have its say. The respondent was using the mark since 2003 whereas the appellant was using it from April, 2007, hence, there could not be any injunction. Learned Judge rightly declined.

Cases Cited

6. Mr. Bansal relied on the decision in the case of ***Dhariwal Industries Ltd. and Anr. v. M.S.S. food Products reported in, 2005 (30) P and TMC, SC 233*** and ***Glaxo India Ltd. v. Eudora Laboratories Pvt. Ltd. reported in, 1997(17) P and TMC 794***.

7. The decision in the case of ***Rotomac Pens Ltd. v. Milap Chand and Co. reported in 1999 P and TMC 757*** was also relied upon.

Discussion On The Earlier Litigations

Jaipur Suit

8. The litigation papers would appear from page 617-639 of the petition. In the plaint, the respondent claimed, they were carrying on business in the field of "furniture of all kinds" using the word marked "Austin". In paragraph 5 of the plaint the plaintiff complained of copy of their mark by the defendant in plywood and other related products. Hence, the plaintiff was entitled to injunction.

9. The suit was filed under Section 62 of the Copy Right Act. They also filed application for temporary injunction, the learned Additional District Judge dismissed the application on contest. In paragraph 13 of the said decision, the learned District Judge observed,

"The product of the respondent applicant totally different.

10. The learned Judge considered the registration of the mark, respective registration certificates and observed, the parties were registered in different classes. The defendant was classified in class 19 that would authorise them to use the mark for plywood whereas the plaintiff was having the registration in class 20 that would authorise them to use the mark for furniture. We are told, appeal is awaiting disposal.

City Civil Court

11. The City Civil Court cause papers would appear from page 648-668. The plaintiff in the City Civil Court filed suit for infringement of Trade Mark and passing off on the strength of the certificate under class 19. They would contend, the defendant in the suit was unauthorized in using the mark while selling plywood; the certificate granted to them for furniture could not be used in plywood. The Court held, the parties were having their appropriate mark duly registered and they would have exclusive right to use the mark. The Trade Mark Act did not make any provision for an action by a registered mark holder against another registered proprietor. Hence the suit for infringement was not maintainable. The application for temporary injunction was thus dismissed. The suit was allowed to be withdrawn with liberty to file a fresh suit. The plaintiff filed an appeal. The Division Bench at the initial stage asked the respondent to submit statement of accounts before the Court below and in default, they would be restrained by an order of injunction from using the mark, however, the order of the Division Bench spent its force once the City Civil Court finally dismissed the application on contest and the suit stood withdrawn.

Present Lis

12. The appellant filed the instant suit, inter alia, praying for an order of injunction according to them, they were the registered user of the mark "Austin" in plywood whereas the defendant did not have any such registration in plywood hence, it was a fit case for passing an order of injunction. They would also claim, they were the prior user of the mark having duly registered under class 19. In the earlier litigations, the defendant categorically asserted, they were under class 20 being the manufacturer of furniture. The plaintiff was thus entitled to bring passing off action as against the defendant. The learned Judge did not pass any ad interim order and directed exchange of affidavits.

Judgment And Order Impugned

13. Learned judge passed the judgment and order impugned on December, 20, 2013. His lordship put reliance on the earlier litigations and the result, the relevant observations of His lordship are as follows:-

"Although Mr. Mukherjee took me through the impressive sales figures of the plaintiff between 2007-2008 to 2012-2013 as mentioned in paragraph 6 of the petition and the advertisement expenses for the same period as stated in paragraph 7 of the petition, at least the data up to 2010 was before the learned City Civil Court and the Hon'ble Division Bench of this Court. But they refused to pass an interim order of injunction and only passed an order directing the defendant Corporation to furnish month to month sales figures to the plaintiff.

What has become most important, in the consideration of passing an interim order in this case, is that, in the affidavit filed before the Additional district and Sessions Judge, No. 4 Jaipur City, the plaintiff admitted in paragraph 9 that "Austin" was the name of the capital of Texas, USA and hence no proprietary right could be claimed over it. The said paragraph 9 is inserted herein below:

That it is pertinent to state that "Austin" is capital and surname of Texas State of U.S.A. In above facts and circumstances, plaintiff cannot hold his sole right over the word "Austin". "Austin" is surname and geographical name and it is being used generally in form of trademark for sale and buy of different merchandise goods. Many goods are sold in the name of "Austin" and "Austin" is not the sole property under the plaintiff's right.

Hence, the prayer for injunction is refused.

However, on the case made out by the plaintiff they would be entitled to the same order passed by the Division Bench of this Court i.e. a direction upon the defendant corporation to furnish statements of accounts on a month to month basis beginning from January, 2014. These accounts are to be furnished to the plaintiff's Advocate-on-Record. In default the plaintiff would be at liberty to ask for an order of injunction as provided by the said Division Bench order.

I am not closing the case of the plaintiff to ask for an interim order of injunction. But such case can be considered upon exchange of affidavits.

14. Being aggrieved the appellant filed the above appeal.

Our View

15. The parties are in different classes in the matter of registration. The present is a passing off action where the prior user would have its say. From the facts so far revealed, it would be too early to conclude finally who is in the business of plywood earlier than the other, let it be decided at the proper time. The plaintiff should be given full opportunity to prove his case as to the prior use. The defendant would also be entitled to defend. We would expedite the hearing of the suit. The defendants are represented through advocate except the defendant Nos. 5 and 6. The plaintiff must expedite the process of service of the writ of summons upon them. Service upon rest of the defendants is dispensed with.

16. The written statement by the appearing defendants must be filed within four weeks from date, discovery of additional documents by the parties, if any, within two weeks thereafter. The parties are given opportunity to approach the learned Judge taking suits, to

fix an early date of hearing once the suit becomes ready after service of summons upon the non-appearing defendants and completion of the pleadings.

17. Mr. Bansal would claim, he was regularly submitting monthly return of turnover; he produced one of such documents in Court. We feel, the same is cryptic, little more details would effectively help the learned Judge at the final hearing to arrive at the right conclusion. Henceforth, we would expect the defendants to submit accounts as directed by the learned Single Judge with little more details that would be meaningful for the purpose.

Result

18. The appeal is disposed without any order as to costs.

19. The pending injunction application is consequently disposed of by treating on the same as on day's list.

Arijit Banerjee, J.

I agree

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