* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

***Reserved on: 15th May, 2024***
***Pronounced on: 16th August, 2024***

\+ **CS(OS) 55/2006 & I.A. 784/2023**

KABUSHIKI KAISHA TOSHIBA ..... Plaintiff
Through: Mr. Pravin Anand, Ms. Vaishali R. Mittal, Ms. Madhu Rewari, Mr. Siddhant Chamola and Ms. Gitanjali Sharma, Advocates.

versus

TOSIBA APPLIANCES CO. ..... Defendant
Through: Mr. Vivek Sood, Senior Advocate with Mr. Sanjib Kumar Mohanty, Mr. Awanish Sinha, Mr. Subesh Kumar Sahoo and Ms. Anushka Jakhodia, Advocates.

**CORAM:**
**HON'BLE MR. JUSTICE SANJEEV NARULA**

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## SANJEEV NARULA, J.

1. This judgment aims to conclude a prolonged legal saga that has spanned over three decades, involving a trademark dispute between Kabushiki Kaisha Toshiba, a globally recognized conglomerate, and Tosiba Appliances Co., a domestic competitor. The dispute centres the alleged infringement of the "TOSHIBA" trademark by a nearly identical "TOSIBA" trademark utilised by the Defendant. Despite the phonetic and visual similarities between the trademarks, Tosiba Appliances Co. contends they independently created their mark before Kabushiki Kaisha Toshiba's foray

into the Indian market and have since built considerable brand recognition. This protracted battle, now drawing to its conclusion, encapsulates the intricate challenges of protecting brand identity in a fiercely competitive marketplace.

**THE CONTROVERSY**

2. The Plaintiff, through this lawsuit, has invoked the provisions of Trade and Merchandise Marks Act, 1958[1] to prevent unlawful use of their trademark "TOSHIBA" by the Defendant. They contend that this brand, now a house mark, is an invented word, meriting the highest level of protection. The Plaintiff asserts their rights in India in the mark "TOSHIBA" *w.e.f.* their first registration in 1953 on a proposed-to-be-used basis, before the introduction of their products in the Indian market. They also claim that at the time when Defendant adopted the impugned mark, their trademark's transborder reputation had spilled over into the Indian territory, thus warranting relief under the common law doctrine of passing off. Conversely, Defendant argues that their trademark "TOSIBA" was created independently and adopted in good faith, unfamiliar and unconnected with the Plaintiff's operations. They claim preferential rights of a prior user recognized under the statute, asserting that their use predates Plaintiff's entrance into the Indian market.

3. This judgment will thus analyse the elements of trademark infringement, explore the doctrine of honest and concurrent use, and consider the broader implications of maintaining established brand identities.

## PLAINTIFF'S CASE IN BRIEF

4. The facts and contentions presented by the Plaintiff are as follows:

4.1. Plaintiff-company is a manufacturer and seller of a wide range of electronic and electrical goods under the trademark "TOSHIBA." In 1939, Shibaura Engineering Works Company Limited and Tokyo Electric Company merged to form Tokyo Shibaura Electric Co. Limited. The trademark "TOSHIBA" was conceived by the Plaintiff. The letters 'TO' were lent from the word 'Tokyo' while the letters 'SHIBA' were derived from 'Shibaura,' both appearing in the name of the emergent company. Ever since their origin in 1939, the Plaintiff has been using the mark "TOSHIBA" for varied electrical goods and appliances manufactured by them. In 1978, Tokyo Shibaura Electric Co. Limited modified its name to Tokyo Shibaura Denki Kabushiki Kaisha trading as Toshiba Corporation. In 1984, the company again underwent reorganization, resulting in a change of name to Kabushiki Kaisha Toshiba trading as Toshiba.

4.2. In India, the Plaintiff is the registered proprietor of the following trademarks:

| ***Trademark and No.*** | ***Date*** | ***Class and Goods*** |
|---|---|---|
| Toshiba<br>No.: 160442 | 05.09.1953 | Class 9<br><br>scientific, nautical, survaying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, coin or counter-freed apparatus, talking |

[1] "Trade Marks Act 1958."

| | | |
|---|---|---|
| | | machines, cash registers, calculating machines, fire-extinguishing apparatus. |
| Toshiba<br><br>No.: 160443 | 05.09.1953 | Class 11<br><br>Installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes. |
| **TOSHIBA**<br><br>No.:273758 | 26.07.1971 | Class 7<br><br>Current generators, induction motors (electric), electric washing machine, etc. compressors (machinery), and electric tool set consisting of electric drills (machines), spin dryers and can openers being electrically operated tools, all being goods included in class 7. |
| **TOSHIBA**<br><br>No.:273759 | 26.07.1971 | Class 9<br><br>electric phase modifiers, rotery converters (electric), rectifiers, transformers, switch boards, electric relays, electric resistances, condensers, lightning arresters, switches (electric) of all kinds, electric connectors, fuses, electric wires and cables, drycells, diodes, integrated electric circuites, electron tubes, cathode ray tubes, x-ray tubes, x-ray image tubes, transistors, telephone receivers, telegraph apparatus and instruments, facsimile transmission and receiving apparatus (electric), radio and television transmission and receiving apparatus, sound recording and reproducing apparatus, tape recorders, electric phonographs, telecommunication apparatus, amplifier and magnetic tapes, cartridge and cassettes included in class 9, electric optical mark and character readers, vacuum cleaning apparatus (electric), measuring and magnetic measuring apparatus and instruments included in class 9, meters included in class 9, oscillographs, computors, electronic |

| | | |
|---|---|---|
| | | calculators, radar apparatus, magnetic detectors, telemeters, electric control apparatus included in class 9, cash registers, dynamometers, records included in class 9, stereophonic records, experimental glass apparatus (laboratory) and flash lamps for photographic purposes, electrically operated apparatus for killing mosquitos, hair dyers (electric), cyclotrons (electric), electric circuit brakes |
| **TOSHIBA**<br><br>No.: 273760 | 26.07.1971 | Class 11<br><br>holders for electric lamp bulbs, incandescent lamps, dazzle lamps, lamps for projectors, fluorescent lamps, glow starters, xenon lamps being lamps for projectors, iodine lamps being incandescent electric lamps, sodium vapour lamps, mercury vapour lamps, including metallic vapour lamps (not for medical or surgical use), neonglow lamps for advertisement or display purposes and not included in class 9, electric cooking ovens with microwave heating lighting fixtures (not included in other classes), refrigerators, room air conditioners, water coolers, water heaters, space heaters, warming blankets (not for surgical purposes or medical use), grilling apparatus, electric fans, ventilating fans, air purifiers, electric drivers, freezer show cases, hot plates for cooking, ovens, automatic cookers, bread toasters, pots, coffee percolators, egg cooking vessels, coffee blenders (all the foregoing electrically operated), heaters (gas and kerosene) all being goods included in class 11. |

4.3. The trademark “TOSHIBA” is a well-known mark recognized in India as well as internationally, and possesses the distinctive characteristics

of an invented word. The reputation of the trademark can be attributed to various factors, particularly its extensive and long-standing use in India. This commercial use commenced in November 1951, when Plaintiff rendered technical assistance with respect to watt-hour meters to an Indian concern. Plaintiff also exported several of their products, such as assembly kits for the use of Indian companies between 1984 to 1989. Besides their supply operations, Plaintiff also executed trademark license agreements with Toshiba Anand Batteries Ltd. and Punjab Anand Batteries Limited for commercial dealings in fluorescent lamps, batteries, and incandescent lamps. The Plaintiff's presence has permeated into trade and commerce in India. Their annual reports commencing from the year 1963 till 1989 demonstrate largescale commercial operations of electronics communication systems, heavy electrical apparatus, end-use consumer products, such as electric fans, ovens, toasters, stoves, electric irons etc. within the Indian territory. Furthermore, the Plaintiff has established authorized service centres all across India to offer repair and maintenance services to the consumers. The above trade activities and collaborations are a testament to Plaintiff's extensive business presence in India.

4.4. The trademark "TOSHIBA" has garnered immense reputation and goodwill in India through a variety of channels, such as spillover advertising and tourist travel. The unauthorized use of the "TOSHIBA" trademark by any third party without the Plaintiff's consent, permission, or license would cause significant confusion and deception among the purchasing public and within the trade. Such unauthorized use could potentially dilute the trademark's distinctive character and harm the Plaintiff's established goodwill.

4.5. In February, 1989, through a newspaper advertisement, Plaintiff discovered the Defendant's use of the trademark "TOSIBA" and the trade name Tosiba Appliances Co. in relation to electric appliances, including electric flat irons. As per the Plaintiff's investigations, the Defendant's products are not available openly in the market, and their sale is confined to the Army Canteen Stores. Plaintiff then addressed a legal notice on 24th April, 1989, informing the Defendant that the trademark "TOSHIBA" is well-known worldwide, and the use of a phonetically similar trademark "TOSIBA" by them, both as a trademark and as an essential feature of their trading style, amounts to an infringement of the Plaintiff's registered trademarks, including registrations No. 160443 and 273760. Accordingly, the Defendant was called upon to cease using the trademark "TOSIBA" in relation to electrical goods, including electric irons, and to confirm compliance within 21 days from the date of the notice. In response, by letter dated 13th May, 1989, the Defendant expressed interest in amicable discussions through their senior partner, Mr. N. K. Suri, who was in Bombay at the time. On the 30th May, 1989, Mr. N. K. Suri, after deliberations with the Plaintiff's attorney, agreed to change the trademark and trade name to "DOSIBA." However, the Plaintiff did not agree to the proposed change, which was communicated to the Defendant by letter dated 06th July, 1989. Thereafter, the Defendant failed to honour the next scheduled meeting with the Plaintiff's attorneys on 28th June, 1989, prompting the Plaintiff to inquire whether the Defendant was still interested in resolving the matter. In the meantime, the Plaintiff was served with copies of caveats filed by the Defendant, who did not respond to the Plaintiff's letter dated 06th July, 1989.

4.6. The Plaintiff has since learnt that the Defendant continues to use the

trademark "TOSIBA" for electric irons and various other electrical goods, such as, immersion rods, toasters, fans, table lamps, baking ovens, and stoves. The Defendant's adoption and use of the trademark "TOSIBA" is manifestly dishonest and in bad faith. The Plaintiff's trademark "TOSHIBA" is not only an invented mark, but a globally acknowledged trademark. Consequently, the Defendant's usage of a phonetically similar mark is inherently deceptive. Consequently, they have initiated the present proceedings, contending that the use of the trademark "TOSIBA" in relation to these goods constitutes a clear infringement of the Plaintiff's registered trademarks.

4.7. The Defendant has chosen the trademark "TOSIBA," which bears a striking resemblance to the Plaintiff's internationally celebrated trademark "TOSHIBA." This usage extends to goods that are not only encompassed within the Plaintiff's trademark registrations, but are also related and akin in nature. These goods are distributed through identical sale channels and sold at the same retail locations as the Plaintiff's products, amplifying the potential for consumer confusion and dilution of the Plaintiff's brand equity. The inclusion of "TOSIBA" in Defendant's trade name also violates the Plaintiff's trademark rights, protected under the statute.

4.8. The Plaintiff's business includes selling in India, either directly or through its joint venture companies or licensees, a range of electronic and electrical goods under the trademark "TOSHIBA." This class of goods is clearly defined, and in the minds of the public, or a section of the public in India, the Plaintiff is identified as the origin of these goods. Due to this reputation, there is significant goodwill attached to the name "TOSHIBA" of the Plaintiff. The phonetic similarity of "TOSIBA" to "TOSHIBA" attaches

the Plaintiff's goodwill to the Defendant's goods, further compounding the damage. The Plaintiff has suffered and is likely to continue suffering substantial damage to their goodwill due to the Defendant's sale of goods falsely described by the trademark or trade name "TOSIBA."

## OVERVIEW OF THE DEFENCE TO THE SUIT

5. The Defendant presented the following facts and contentions, controverting the Plaintiff's version:

5.1. The Defendant, Tosiba Appliances Co. was founded as a partnership firm of Mr. N.K. Suri and Mr. D.P. Suri in 1974 for trading in various household appliances. Gradually, the firm was transformed into a private limited company – Tosiba Appliances Co. Pvt. Ltd. The trademark "TOSIBA" was devised by Defendant's founders out of reverence for their mother, affectionately referred as "Toshi Bai" by her family members. This mark was invented independently by the Defendant, and has been extensively and openly used for various electric appliances since 1975.

5.2. The Defendant filed applications for registrations of the trademark "TOSIBA" in classes 09 and 11 claiming use since February, 1975, which stood pending on the date of institution of the instant lawsuit. The specifics of the Defendant's trademark applications are detailed below:

| ***Trademark and No.*** | ***Date*** | ***Class and Goods*** |
|---|---|---|
| "**TOSIBA**"<br><br>No.: 509862 | 04.05.1989 | Class 9<br><br>Electrical apparatus and instruments, electric iron (flat) and electronic appliances included in class 9. |
| "**TOSIBA**"<br><br>No.: 509863 | 04.05.1989 | Class 11<br><br>Installations for lighting, heating, cooking - auto non-auto ovens, |

| | | |
|---|---|---|
| | | toasters, coil stoves, table fans, electrical rods, table lamps, filters, heat convectors, room heaters and gas stoves. |

5.3. Due to the uninterrupted and widespread use of mark "TOSIBA" for over 31 years, the Defendant has amassed substantial recognition in the market, evinced by several national level accolades in their name. The Defendant has invested significantly in the promotion of the trademark "TOSIBA," spending lakhs of rupees on extensive advertising campaigns. This substantial investment has not only heightened consumer awareness, but has also firmly connected the trademark "TOSIBA" with the Defendant to the exclusion of any other entity.

5.4. In stark contrast, the Plaintiff's trademark "TOSHIBA" was registered merely on a proposed-to-be-used basis and has never been utilized in commerce since its registration in India. The Plaintiff's assertions of use of the "TOSHIBA" mark through distinct entities or licensees are unfounded. Absence of assignment deeds or registered user agreements conveying the user rights to third parties further undermines the Plaintiff's claims. The purported joint commercial ventures of the Plaintiff in India are contradicted by various extant government policies, precluding foreign entities from undertaking sale operations within India. The Defendant's established and longstanding presence of the "TOSIBA" trademark, culminating in sales running in crores of rupees, outweighs the Plaintiff's prospective entry in the Indian market. Thus, the Defendant is the established prior user in the Indian market, disentitling the Plaintiff any of the reliefs sought. In support, reliance was placed upon the judgment of this Court in ***Bolt Technology OU v. Ujoy Technology Private Limited and***

***Anr.***[2]

5.5. The suit, predicated on five registered trademarks, lacks foundational documentation, specifically, the registration and Legal Proceeding Certificates which are essential for maintaining any legal action for trademark infringement. The Plaintiff has withheld critical information from the Court – notably, all five of their registered trademarks were facing rectification proceedings at Defendant's behest when the suit was initiated. This deliberate concealment alone debars the Plaintiff from securing an injunction against the Defendant. Furthermore, the suit is untenable as the alleged registrations are held not by the Plaintiff but by another entity named Tokyo Shibaura Electrical Company Limited, Japan. Given these discrepancies, the suit should be dismissed, as the Plaintiff lacks legitimate proprietary rights to the trademarks in question.

5.6. Additionally, the Plaintiff has deliberately and intentionally provided a misleading statement of cause of action, which supposedly emerged in 1989. In reality, the Plaintiff has been fully aware of the Defendant's use of the trademark and their business activities since 1975, contradicting their presented claims. In the catalogues published by Canteen Stores, Army Headquarters, Ministry of Defence, Government of India and telephone directories published by MTNL in 1984, 1986 and 1988, the Defendant's name finds mention below Toshiba Anand Batteries Limited, an affiliate of the Plaintiff. Therefore, the suit is fundamentally flawed and procedurally barred due to the limitations of delay, laches, and acquiescence. These actions suggest an attempt by the Plaintiff to manipulate the legal process

[2] 2023 SCC OnLine Del 7565.

through omission and inaccuracies.

5.7. Critical procedural deficiencies undermine the suit. The suit has neither been signed nor verified by a duly authorized or competent person, and no power of attorney has been filed in his favor. Furthermore, the plaint fails to meet legal standards for proper verification as required under the law, rendering it susceptible to rejection. These procedural lapses highlight significant flaws in the Plaintiff's approach to initiating this legal action.

5.8. The factors outlined above underscore the Defendant's argument that their long-standing and public use of the trademark should be legally recognized and protected against the claims made by the Plaintiff.

## PROCEDURAL HISTORY OF THE SUIT

### I. *Case management proceedings*

6. Summons in the suit were issued on 21st May, 1990, whereafter the Defendant filed their written statement on 02nd June, 1990, contesting the Plaintiff's claims. A replication to the written statement was filed on 22nd October, 1990.

7. In the meantime, pending the completion of pleadings, the admission/ denial of parties' documents was conducted on 03rd and 04th December, 1990. Defendant admitted the documents marked as Ex. P1 to P4. The Plaintiff admitted six documents of the Defendant, marked as Ex. D1 to D6.

8. The Defendant initiated rectification proceedings against Plaintiff's registrations No. 273758, 272759 and 273760 in classes 07, 09 and 11, respectively before the Deputy Registrar of Trademarks, Calcutta. Likewise, the Plaintiff protested the Defendant's trademark applications No. 509862, 510312, and 509863. The decisions rendered in these proceedings were

subsequently carried in appeal before the High Court of Calcutta. Considering the pendency of these appeals, on 14th September, 1993, Plaintiff withdrew their interim applications bearing No. 11020/1990, 11641/1990, 11018/1990, 4044/1990, 9258/1992, 8654/1992, and 7824/1993, with liberty to urge the issue after disposal of the appeals.

9. The appeals filed by the Plaintiff came to be finally decided by the Division Bench of High Court of Calcutta, which shall be discussed in a subsequent segment of the judgment. Consequently, the Plaintiff filed I.A. 1012/1994 seeking an interim injunction against the Defendant from using the trademark "TOSIBA."

10. The Defendant filed I.A. 7476/1996 under Order VI Rule 17 of the Code of Civil Procedure, 1908,[3] to bring on record the change of the name of the entity from Tosiba Appliances Company to Tosiba Appliances Company Pvt. Ltd., which was permitted on 19th August, 1996.

11. On 02nd September, 1997, directions were issued for conducting admission/ denial of documents filed after 04th December, 1990 by the parties. These directions were executed on 14th January, 1998, where no document was admitted by either party.

12. Another application [I.A. 1671/1994] was filed by the Plaintiff, seeking directions to implead one Suriba Appliances Pvt. Ltd. who they believed to be an affiliate of the Defendant, Tosiba Appliances Pvt. Ltd. due to the commonality of the firms' partners. Notice was served on the proposed Defendant through publication in terms of order dated 11th November, 1999. Suriba Appliances Co. entered appearance on 08th August,

[3] "CPC."

2000 and informed that they do not trade under the trademark "TOSHIBA," and shall not undertake any other similar trademark. In view of this statement, with the consent of the Plaintiff, the application was disposed of.

## II. ***Issues***

13. On 27th September, 2000, the following issues were framed:

> *"1. Whether the Plaintiff is the registered proprietor of the trade mark TOSHIBA?*
> *2. Whether the Defendant's use of the mark 'TOSIBA' amounts to infringement of the Plaintiff's registered trade mark?*
> *3. Whether the Defendant's use of the mark TOSIBA would result in confusion and deception amounting to passing off?*
> *4. Whether the suit has been signed, verified by a duly authorised and instituted by a competent person?*
> *5. Whether the suit suffers from delay, laches and acquiescence?*
> *6. Whether the-suit is liable to be stayed under Section 111 of the Trade and Merchandise Marks Act, 1958?*
> *7. Whether the suit is likely to be dismissed on account of false statement and concealment of facts?*
> *8. What is the effect of the rectification of the Plaintiff's registrations and the appeals pending before the Calcutta High Court?*
> *9. What is the effect of the Defendant's registrations of the trade mark TOSIBA in class 5?*
> *10. Is the Defendant's trade mark TOSIBA registered under No.510314 in class 5 liable to be rectified on any of the grounds specified in Co. No.4/1999 filed by the Plaintiff?*
> *11. Relief."*

14. Issue No. 6 concerning the stay of suit proceedings till the resolution of question of invalidity of Plaintiff's registrations was not pressed by the Defendant, on the Plaintiff's assurance that they will not pursue I.A. 1012/1994 for an interim injunction. Consequently, issue No. 6 stood deleted, and I.A. 1012/1994 was dismissed on 27th September, 2000. Further, a Local Commissioner was appointed to record the evidence, with a direction to complete the exercise within three months from the date of aforesaid order.

## III. ***The conduct of trial***

15. Post framing of issues, the parties were instructed to file their list of witnesses within four weeks from 27th September, 2000. However, both parties defaulted in adhering to the stipulated timeline. When the matter was placed before the Joint Registrar on 03rd November, 2000, the parties' request for extension of time to file the list of witnesses was declined in view of Rule 3(38) of Chapter II of Delhi High Court (Original Side) Rules, 1967 and the judgment in ***Ravi Sharma v. Delhi Development Authority***,[4] which precluded the Joint Registrar from enlarging timelines fixed by the Court. Accordingly, in terms of the ruling of the Supreme Court in ***Mange Ram v. Brij Mohan*** that furnishing of a detailed list of witnesses is not mandatory, unless the party producing the witness requires court's assistance in summoning them,[5] the Joint Registrar permitted the parties to proceed with the trial by deposing their witnesses.

16. Later, the Plaintiff moved I.A. 12532/2000 requesting for permission to file a list of witnesses, as the witness intended to be produced before Court was principally based in Japan. Since there was no protest by the Defendant, the application was allowed on 11th December, 2000 and the Plaintiff was permitted to examine the Japanese witnesses. Further, as requested, they were allowed to be accompanied with an interpreter due to linguistic impediments.

17. On 30th January, 2001, given the urgency expressed by the Plaintiff regarding examination of a witness who had arrived from Japan incurring

[4] (1990) 42 DLT 361.
[5] 1983 (4) SCC 36.

substantial expenses, the Court directed recording of his statement on 31st January, 2001. Consequently, deposition of PW-1, Mr. Hideaki Togawa, was recorded on 31st January and 01st February, 2001.

18. The Plaintiff thereafter filed an application [I.A. 6366/2001] under Order XIII Rule 2 of the CPC for producing the following additional documents relevant to the controversy: (*a*) extracts from the Japanese Commercial Code, (*b*) extracts from the Commercial Register, (*c*) Ratification Resolution, (*d*) opinion of a legal expert, (*e*) certified copy of order dated 11th June, 2001 passed by the Deputy Registrar of Trademarks, Mumbai in opposition No. BOM 10198, and (*f*) legal proceedings certificates for the Plaintiff's registered trademarks. This application was allowed on 20th September, 2001, subject to payment of costs of Rs. 5,000/-. Parties were relegated to admission/ denial in respect of the documents taken on record. In the meantime, fresh directions for filing of lists of witnesses were also passed. On 12th March, 2003, the Defendant denied all the additional documents filed by the Plaintiff.

19. Endeavouring to expedite the trial, through I.A. 6933/2003, the Plaintiff sought permission to tender the remaining evidence of PW-1, Mr. Hideaki Togawa, by way of an affidavit. This application was allowed on 09th July, 2003.

20. In the midst of the trial, due to an increase in the pecuniary jurisdiction of this Court to Rs. 20 lakhs through the Delhi High Court (Amendment) Act, 2003, on 23rd January, 2004, the suit record was transferred to the concerned District Court for further proceedings.

21. Later, the Plaintiff filed an application under Order VI Rule 17 of the CPC before the District Court for reappraisal of the relief sought in the

plaint. It was argued that the suit had been filed in 1990 seeking rendition of accounts on the Plaintiff's rational assessment of the profits earned by Defendant from the impugned activities as Rs. 5,00,000/-. However, given the continued use of the impugned mark "TOSIBA" by the Defendant even during the continuance of the suit proceedings, the Plaintiff sought to recover Rs. 10,00,000/- as profits unlawfully earned and an additional Rs. 10,00,000/- for the loss of goodwill. This request faced strong opposition from the Defendant, who asserted that the amendment application was dilatory tactic, intended to oust the District Court's jurisdiction. On 21st September, 2004, Defendant's opposition was rejected in light of the judgment of the Supreme Court in ***Lakha Ram Sharma v. Balar Marketing Pvt. Ltd.,***[6] holding that an application for amendment cannot be rejected solely because it would exceed a court's pecuniary jurisdiction. Consequently, given the enhancement of suit value, exercising the authority endowed by Order VII Rule 10A of the CPC, the plaint was returned, relegating the parties to this Court for adjudication of their claims.

22. Dissatisfied with the decision, the Defendant filed a review, which was rejected on 01st November, 2004 by the District Judge. The Defendant assailed this rejection before this Court in FAO 364/2024. Parallelly, the Plaintiff moved an application before this Court for transfer of proceedings, aiming to prevent a *de novo* trial. In FAO 364/2024, this Court ordered a stay on the suit proceedings on 13th December, 2004. Subsequently, the Plaintiff's application for transfer was allowed by this Court on 29th May,

[6] 2003 (27) PTC 175 (SC).

2005, whereafter the trial commenced again before this Court.

23. Following the permission granted on 06th February, 2006, the Defendant filed an amended written statement to the amended plaint.

24. The Plaintiff's first witness, Mr. Hideaki Togawa, retired from the Plaintiff-company. Through I.A. 6930/2006, the Plaintiff then applied for the said witness to be substituted and presented an amended list of witnesses for examination. As the Defendant assented, this request was allowed on 07th August, 2006, allowing the Plaintiff eight weeks' time to file the affidavits by way of evidence (examination-in-chief). The Plaintiff thereafter presented Mr. Akio Ito as PW-1, along with affidavit of evidence filed on 13th December, 2006 and supplementary affidavit dated 14th December, 2006. The affidavit dated 13th December, 2006 was accompanied with certain documents in Japanese language. The Defendant objected to submission of new documents by the Plaintiff's without the Court's approval through necessary application. Consequently, through I.A. 1635/2007, the Plaintiff sought to produce the documents under Order VII Rule 14 of the CPC. This application met with opposition from the Defendant, who highlighted the significant delay in producing these documents that too, sans the translated versions. As these documents were judicial orders, the Plaintiff's application was allowed by this Court on 24th September, 2007, with the imposition of cost of Rs. 10,000/-. Additionally, they were directed to file the translated versions.

25. Through order dated 11th March, 2008, the affidavit of evidence and documents tendered by Plaintiff's erstwhile witness, Mr. Hideaki Togawa, were annulled. After marking of exhibits, the evidence of PW-1, Mr. Akio Ito commenced on 18th September, 2008. On 30th April, 2009, the Plaintiff

conveyed to the Court that they did not wish to examine the two witnesses mentioned at serial numbers 2 and 3 of the list of witnesses.

26. Later, to accelerate the proceedings, Plaintiff preferred I.A. 8658/2009, requesting for appointment of a Local Commissioner to record parties' evidence. The Court, through order dated 04th November, 2009, accepted the Plaintiff's request and appointed a Local Commissioner.

27. The Plaintiff then applied to the Court through I.A. 4204/2010 for authorization to present in evidence the original of a License Agreement dated 28th December, 1976 executed between the Plaintiff and Toshiba Anand Batteries, denoted by Mark X-23 due Plaintiff's inability to produce its original. On 27th January, 2011, in terms of the parties' agreement, the Plaintiff was permitted to depose one Mr. Prashant Jha as PW-2, whose testimony was to be confined to proving Mark X-23.

28. The Local Commissioner was discharged on 13th September, 2019, whereafter, the matter was placed before the Joint Registrar for completion of Defendant's evidence. In view of the constraints prevailing due to the COVID-19 pandemic, two applications were filed before the Court seeking appropriate directions for recording of evidence through video conferencing mechanism [I.A. 11833/2021 and 12554/2021]. These applications were allowed on 27th September, 2021, appointing a Remote Point Coordinator for conducting trial through online mode, in terms of the High Court of Delhi Rules of Video Conferencing for Courts, 2020. The modalities to avail this process were settled on 26th October, 2021, and examination of DW-1 was resumed. His cross-examination was concluded on 19th February, 2022.

29. The Plaintiff filed I.A. 4539/2022 requesting a direction to close the Defendant's right to lead further evidence, asserting that the Defendant is

obstructing expeditious disposal of the suit by purposely delaying presenting of evidence and recording of statements. While this application was pending consideration, the Defendant applied to the Court seeking to depose a new witness – Mr. Jayadev Samal, General Manager of Defendant. This request faced staunch opposition by the Plaintiff. Given the advanced stage of the proceedings, these applications were rejected on 04th August, 2022. The Court reprimanded the manner of prosecuting the suit by both parties, and issued directions for prompt conclusion of the trial.

30. Subsequently, the evidence of DW-2 to DW-4 was completed on 17th September, 2022. Mr. Sushil Kumar, who had to be examined as Defendant's witness, could not present himself on the said date. In view of the order dated 04th August, 2022, the request for adjournment was disallowed and the Defendant's evidence was closed, without affording an opportunity to examine Mr. Sushil Kumar.

31. The trial was concluded on 17th September, 2022, with the Plaintiff deposing PW-1, Mr. Akio Ito and PW-2, Mr. Prashant Jha, to prove Mark X-23. Defendant presented four witnesses, namely, Mr. N.K. Suri [DW-1], Mr. Ashok Kumar Dhingra [DW-2], Mr. Jasmil Singh [DW-3], and Mr. Ramesh Kumar Sarin [DW-5].

## SHIFT IN DYNAMICS OF PARTIES' TRADEMARK RIGHTS DURING THE SUIT PROCEEDINGS

32. The Plaintiff's assertions of trademark infringement against the Defendant are predicated on five registrations for the trademark "TOSHIBA" and its variants (detailed in paragraph No. 4.2. of the judgment), that precede the professed date of adoption of "TOSIBA" by the

Defendant. Before the initiation of this action, the Defendant applied to the Trademarks Registry to annul the exclusive rights derived by Plaintiff from their registrations. In contrast, Plaintiff launched oppositions to trademark applications No. 509862 and 509863 of Defendant, which had been accepted and advertised by the Registrar of Trademarks. While the proceedings in the present suit progressed, these parallel legal actions were conclusively adjudicated by the concerned fora. As these decisions directly impact the parties' standing in the current suit, it is essential to note them before embarking on a thorough analysis of the arguments and evidence presented.

## I. ***Rectification petitions filed against the Plaintiff's registrations***

### I.I. *Trademarks No. 160442 and 160443*

33. Defendant filed two petitions before the Assistant Registrar of Trademarks, Chennai seeking cancellation of Plaintiff's trademark No. 160442 in class 09, and No. 160443 in class 11 for the trademark "Toshiba." These petitions were decided through a common order on 12th January, 2005 in favour of the Plaintiff [Mark X-50]. Before the Trademarks Registrar, Defendant alleged that the afore-noted trademark had not been used for a continuous period of five years and one month preceding the date of filing of cancellation petition, and was wrongly registered without cause. They asserted that they were the prior and renowned user of the trademark "TOSIBA" in respect of domestic electrical appliances, since 1975 and filed invoices, bills, excise gate pass, application for central excise license, factory license, promotional expenses etc. to demonstrate their use. The Petitioner submitted their response along with supporting evidence to the petitions. Defendant defaulted in pursuing the matter, and failed to join

the hearing, resulting in an *ex-parte* disposal based on the presented material.

34. The Assistant Registrar noted that Defendant had failed to establish *bona fide* adoption of the trademark/ name "TOSIBA," which was deceptively similar to Plaintiff's registered trademark, first registered in 1953. In absence of evidence to the contrary, it was concluded that the Defendant's adoption was dishonest, disentitling them from claiming any relief. Further, Defendant's petitions lacked material to prove non-use by the Plaintiff for over five years. The Assistant Registrar, after scrutinizing the material placed by Plaintiff, held that Plaintiff had sufficiently demonstrated continuous use of their mark. It was observed that 'use of a trademark' is not confined to use on physical goods, and has been demonstrated through advertisements, joint ventures, technical collaborations and establishment of service centres by the registered proprietor. The intermittent use of Plaintiff's trademark on goods circulated within India was found attributable to "special circumstances," being restrictions imposed by the Indian Government on imports. Consequently, acknowledging that the trademark "TOSHIBA" is an invented word, the rectifications were dismissed for deficient proof of allegations raised, and failure of Defendant to qualify as an 'person aggrieved.'

35. The Defendant preferred review applications against the *ex-parte* order dated 12th January, 2005, alleging a breach of principles of natural justice. They explained that they did not receive the hearing notices in the rectification petitions, and therefore, could not join the proceedings. The applications for review were allowed on 01st December, 2006, with directions for fresh consideration [Mark X-51].

36. The Defendant's aforesaid rectification petitions have not been decided till date. Consequently, the status of trademark registrations No. 160442 and 160443 remains unchanged.

**I.II.** ***Trademark No. 273760***

37. Broadly, the grounds for cancellation of trademark "TOSHIBA" registered under No. 273760 in class 11 raised by the Defendant were as follows: (*a*) trademark was erroneously registered without sufficient cause, (*b*) Plaintiff committed fraud by suppressing relevant information to obtain registration, (*c*) non-use for a continuous period of five years, and (*d*) prior use. In response, the Plaintiff argued that a variety of goods, including those covered by their registration in class 11, were openly sold in the country and adduced several agreements for technology transfer, collaboration, and trademark license executed with Indian entities, in support. Any non-use of the goods in question was asserted to be caused by the "special circumstance" of governmental import limitations. The Plaintiff's submissions were rejected by the Assistant Registrar through order dated 12th May, 1992 [Mark X-47 (colly)] as the agreements filed by the Plaintiff did not pertain to manufacturing or trade of the goods falling under class 11, in respect whereof, the mark "TOSHIBA" was registered. Insofar as the question of setting up customer care centres was concerned, there was a conspicuous lack of material demonstrating that these centres conducted repairs of class 11 goods. The Registrar was also not convinced with the Plaintiff's explanation of non-use. It was observed that the Plaintiff opted to secure trademark registration for the concerned goods, conscious of the proscriptions prevalent before the date of application that precluded any sale

within India. Given the significant intervals of non-use, Plaintiff's trademark "TOSHIBA" was considered to be a "dead mark," having no association with the goods concerned for the Indian consumers. The purchase of "TOSHIBA" products by Indian consumers during their foreign travels was considered insignificant as the sale of such goods was effected outside the Indian territory and for personal use. The Registrar thus held that the trademark "TOSHIBA" was registered without *bona fide* intention of using the same in relation to the goods sold by them. The mark was found to be incorrectly registered, and had not been used for the goods in question.

38. In view of the intersection between Defendant's prior use of goods falling within class 11, the Registrar ordered removal of the overlapping goods, namely "*Holders for electric lamp bulbs, fluorescent lamps, electric cooking ovens with microwave heating, lighting fixtures (not included in other classes), water coolers, water heaters, space heaters, warming blankets (not for surgical purposes or medical use), grilling apparatus, electric fans, ventilating fans, hot plates for cooking, ovens, automatic cookers, bread toasters, coffee percolators, egg cooking vessels, heaters (gas and kerosene)*" from the ambit of goods covered by the Plaintiff's trademark registration No. 273760 in class 11.

39. Dissatisfied with the order of the Registrar, the Plaintiff filed an appeal before the High Court of Calcutta [No. 530/1992], which was decided on 15th July, 1996 [Mark X-48 (colly)]. The High Court upheld the Registrar's view of non-use of the trademark by Plaintiff. The Court disagreed with the contention that adoption of "TOSIBA" by Defendant aims to deceive the public by creating an unlawful association with the Plaintiff as there had been no use by the Plaintiff. Further, the Court

observed that any probable confusion arising from Plaintiff's international repute would be insignificant due to Plaintiff's non-use in India. As regards the Registrar's determination of Defendant as the prior user, it was held that there was insufficient evidence to demonstrate that Defendant was using their mark "TOSIBA" in respect of all the items that were rectified from Plaintiff's registration.

40. Consequently, trademark No. 27370 was rectified partially, with the omission of afore-noted goods from its scope.

**I.III. *Trademark No. 273759***

41. The Defendant's application for rectification of trademark registration No. 273759 for the mark "TOSHIBA" in class 09 was partially allowed by the Deputy Registrar of Trademarks on 12th May, 1992 on the ground of non-use for nearly 20 years [Mark X-47 (colly)]. The Registrar rejected the explanation that non-use was caused by governmental policies, which were operative even before the Plaintiff's registration. In view of the above, the goods "*electric relays, electric resistances, switches (electric) of all kinds, electric wires and cables, electrically operated apparatus for killing mosquitos, hair dryers (electric)*" were ordered to be deleted from the scope of Plaintiff's registration in class 09.

42. In appeal, in the order dated 06th May, 1994, the High Court of Calcutta opined that the intention of an applicant proposing to use the mark from a prospective date must be palpable and commercially sound [Mark X-48 (colly)]. It should not hinge on unreal or uncertain contingencies that may never materialize. In that light, given the prevailing restrictions, the Court determined that the Plaintiff did not intend to use the mark in the Indian

market. After an examination of the record presented, the Court noticed that Plaintiff had demonstrated use, as understood in trademark law, in respect of all items rectified by the Registrar, except mosquito killers and hair dryers.

43. Therefore, the Plaintiff partially succeeded in their appeal, with only the goods "*electrically operated apparatus for killing mosquitos*" and "*electric hair driers*" being omitted from their registration No. 273759 in class 09.

## I.IV. *Trademark No. 273758*

44. Asserting themselves to be the prior users for domestic electrical appliances, the Defendant sought to annul Plaintiff's trademark "TOSHIBA" registered under No. 273758 in class 07 by arguing that the registration was obtained without sufficient cause, and for lack of actual use for the statutorily prescribed timeline of more than five years. Their challenge to Plaintiff's registration was decided by the Deputy Registrar on 12th May, 1992 [Mark X-47 (colly)]. As was the case with registrations No. 273759 and 273760, the contention of import limitations preventing the use of the mark was rejected and the Trademarks Register was rectified partially with deletion of goods "*electric washing machines and spin dryers*" from Plaintiff's registration.

45. The decision of the Registrar was assailed by the Plaintiff before the High Court of Calcutta, where they principally challenged Defendant's locus to seek rectifications. According to Plaintiff, the Defendant did not qualify as a "person aggrieved" to maintain the trademark cancellation petitions, particularly since they did not trade in washing machines or spin dryers. In this regard, the Court acknowledged the similarity between the conflicting

marks – "TOSHIBA" and "TOSIBA" – whose simultaneous existence entailed the prospects of public deception. In its order dated 27th September, 1993, the Court regarded the Plaintiff's overstress on the distinction in trademark classes under which the parties operated as misconceived. Noting that the classification of goods is a creation of statute, the Court found that washing machines (covered in class 7) and electric cooking oven (class 11) are broadly considered as "goods which comprise household artefacts for modern living." Further, the existence of the mark "TOSHIBA" in respect of washing machines and spin dryers would preclude the Defendant from venturing into this arena. Accordingly, the Defendant was held to be a person aggrieved by the Plaintiff's registration of "TOSHIBA" in class 07. As regards the question of failure to use the mark, the Court agreed with the Registrar's decision to omit goods from Plaintiff's registration.

46. A challenge to the afore-discussed order of the Single Judge was initiated by Plaintiff. The Division Bench of High Court of Calcutta dismissed Plaintiff's appeal on 08th December, 2005, finding no *bona fide* use of the mark by the Plaintiff in relation to the aforesaid goods [Mark X-49]. The matter travelled to the Supreme Court, where judgment of the Division Bench was set aside as Defendant could not demonstrate any harm or injury caused by continuance of Plaintiff's registration for washing machines or spin dryers.

47. As an outcome, the purview of goods covered by trademark registration No. 273758 in class 09 remains intact.

### *I.V. Current status of Plaintiff's registrations*

48. For ease of reference and convenient reading, the outcome of the

afore-noted rectification petitions is encapsulated in the following chart:[7]

| ***Trademark and No.*** | ***Class and Goods*** |
|---|---|
| Toshiba<br><br>No.: 160442 | Class 9<br><br>scientific, nautical, survaying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, coin or counter-freed apparatus, talking machines, cash registers, calculating machines, fire-extinguishing apparatus. |
| Toshiba<br><br>No.: 160443 | Class 11<br><br>Installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes. |
| **TOSHIBA**<br><br>No.:273758 | Class 7<br><br>Current generators, induction motors (electric), electric washing machine, etc. compressors (machinery), and electric tool set consisting of electric drills (machines), spin dryers and can openers being electrically operated tools, all being goods included in class 7. |
| **TOSHIBA**<br><br>No.:273759 | Class 9<br><br>electric phase modifiers, rotery converters (electric), rectifiers, transformers, switch boards, electric relays, electric resistances, condensers, lightning arresters, switches (electric) of all kinds, electric connectors, fuses, electric wires and cables, drycells, diodes, integrated electric circuites, electron tubes, cathode ray tubes, x-ray tubes, x-ray image tubes, transistors, telephone receivers, telegraph apparatus and instruments, facsimile transmission and receiving apparatus (electric), |

[7] The description of goods that stand deleted from the Plaintiff's trademark registrations have been struck through and marked in red.

| | |
|---|---|
| | radio and television transmission and receiving apparatus, sound recording and reproducing apparatus, tape recorders, electric phonographs, telecommunication apparatus, amplifier and magnetic tapes, cartridge and cassettes included in class 9, electric optical mark and character readers, vacuum cleaning apparatus (electric), measuring and magnetic measuring apparatus and instruments included in class 9, meters included in class 9, oscillographs, computors, electronic calculators, radar apparatus, magnetic detectors, telemeters, electric control apparatus included in class 9, cash registers, dynamometers, records included in class 9, stereophonic records, experimental glass apparatus (laboratory) and flash lamps for photographic purposes, ~~electrically operated apparatus for killing mosquitos, hair dyers (electric),~~ cyclotrons (electric), electric circuit brakes |
| **TOSHIBA**<br><br>No.: 273760 | Class 11<br><br>~~holders for electric lamp bulbs,~~ incandescent lamps, dazzle lamps, lamps for projectors, ~~fluorescent lamps~~, glow starters, xenon lamps being lamps for projectors, iodine lamps being incandescent electric lamps, sodium vapour lamps, mercury vapour lamps, including metallic vapour lamps (not for medical or surgical use), neonglow lamps for advertisement or display purposes and not included in class 9, ~~electric cooking ovens with microwave heating lighting fixtures (not included in other classes),~~ refrigerators, room air conditioners, ~~water coolers, water heaters, space heaters, warming blankets (not for surgical purposes or medical use), grilling apparatus, electric fans, ventilating fans,~~ air purifiers, electric drivers, freezer show cases, ~~hot plates for cooking, ovens, automatic cookers, bread toasters,~~ pots, ~~coffee percolators, egg cooking vessels, coffee blenders (all the foregoing electrically operated), heaters (gas and kerosene) all being goods included in class 11~~ |

49. In addition to the afore-discussed registrations, the Plaintiff has presented in evidence orders delivered in proceedings concerning several other trademark applications/ registrations filed by the Plaintiff after 1975, which is the proclaimed date of adoption of the impugned mark. In view of the established principles of trademark law, the registrations subsisting on the date of conception of the mark "TOSIBA" would be germane to the present controversy. Therefore, it is deemed unnecessary to delineate the status of the subsequent registrations of the Plaintiff.

## II. ***Trademark oppositions to Defendant's applications***

### II.I. *Trademark Application No. 509863*

50. Defendant filed an application for registration of mark "TOSIBA" in class 11, which was accepted and advertised by the Trademarks Registry on 22nd August, 1994. Plaintiff filed an opposition on 19th October, 1984. However, on 21st September, 2001 this application was deemed to have been abandoned under Section 21(2) of the Trade Marks Act, 1958 owing to Defendant's failure to file a counter-statement within the statutorily prescribed timeline [Ex. DW1/P2].

### II.II. *Trademark Application No. 509862*

51. The Defendant's trademark application No. 509862 in class 09 for electrical apparatus and instruments, electric iron (flat) and electrical appliances included in class 09 was rejected by the Assistant Registrar of Trademarks, Delhi on 21st September, 2001 [Mark X-56]. The application was accepted and advertised in the trademarks journal on 16th November, 1995, whereafter the Plaintiff submitted an opposition, challenging the Defendant's proprietorship over the mark "TOSIBA." They urged that their

prior registration for “TOSHIBA” prohibits registering of any deceptively similar mark in the same class for goods of the same description. These objections were sustained by the Registrar, given the near resemblance between the contesting marks “TOSHIBA” and “TOSIBA,” which can possibly result in public confusion or deception. Further, there was an evident overlap between the goods mentioned in Defendant’s application and the Plaintiff’s registration, leading to prospects of confusion as to the trade source. In absence of cogent explanation, the Registrar was unconvinced that adoption of “TOSIBA” by Defendant was honest. Consequently, it was held that significant and continued use of “TOSIBA” could not vest proprietary rights in the Defendant.

52. The appeal preferred against the Assistant Registrar’s order before the Intellectual Property Appellate Board was declared as abandoned under Rule 17(2) of the Intellectual Property Appellate Board (Procedure) Rules, 2003, in view of Defendant’s failure to participate in the proceedings.

## ISSUE-WISE ANALYSIS AND FINDINGS

53. Pursuant to a mutual agreement reached between the parties, as documented in the court order dated 27th September, 2000, issue No. 6 concerning the stay of proceedings under Section 111 of the Trade Marks Act 1958 has been formally deleted from the case. This agreement was predicated on the condition that the Plaintiff would not proceed with the interim application for an injunction under Order XXXIX Rules 1 and 2 of the CPC, identified as I.A. 10112/1994. Consequently, this application was dismissed on the same date for lack of prosecution, effectively resolving this aspect of the dispute.

54. No further adjudication is necessary regarding issues No. 9 and 10 as the Defendant's registration of the trademark "TOSIBA" in class 05 under No. 510314 has been expunged from the Register of Trademarks. This removal follows a successful rectification petition filed by the Plaintiff in a judgment dated 01st March, 2008, as recognized by this Court in order dated 10th January, 2020 in W.P.(C) 8382/2007. Consequently, there is no need to deliberate on the effects of the Defendant's registration or the grounds for its rectification.

**ISSUE NO. 4: WHETHER THE SUIT HAS BEEN SIGNED, VERIFIED BY A DULY AUTHORISED AND INSTITUTED BY A COMPETENT PERSON?**

55. Given the foundational nature of issue No. 4 concerning the legality and propriety of the suit's initiation, it is deemed appropriate to examine this matter at the outset.

56. The Plaintiff is a corporation established under the laws of Japan, with its registered office in Kanagawa-ken, Japan. The suit was initiated on their behalf by Mr. Kensuke Norichika, General Manager of the Intellectual Property Division of the Plaintiff. The Plaintiff asserts that Mr. Kensuke Norichika was duly authorized and competent to institute the present suit. In support of this claim, they have produced the following documents to establish the legal authority and competency of Mr. Kensuke Norichika to act on behalf of Plaintiff:

(*a*) Power of Attorney executed by Mr. Joichi Aoi dated 18th April, 1989 in favour of Mr. Kensuke Norichika [Mark X-21].

(*b*) Board Resolution dated 24th January, 2001 signed by Mr. Tadashi Okamura, President and Chief Executive Officer of Plaintiff, recognizing

and ratifying Power of Attorney of 18th April, 1989, empowering Mr. Kensuke Norichika to initiate this lawsuit [Ex. PW1/40].

(*c*) Extracts from the Commercial Register of Registrar of Companies, Japan, indicating that Mr. Tadashi Okamura was nominated as the Representative Director in 2001 [Ex. PW1/41 and PW1/42].

(*d*) Board Resolution of 01st December, 2006 attested by Mr. Atsutoshi Nishida, President of Plaintiff at the time, endorsing Mr. Kensuke Norichika's authority to institute the suit [Ex. PW1/42A].

57. The Defendant raised significant challenges to the authorization and competence of Mr. Kensuke Norichika in instituting the suit, casting doubts on the procedural legitimacy of the Plaintiff's actions. These challenges are based on several key admissions and points raised during the cross-examination of Mr. Akio Ito [PW-1], which are summarised as follows:

(*a*) Mr. Akio Ito has admitted that there was no specific resolution from the Board of Directors of Plaintiff authorizing the filing of the present suit by Mr. Kensuke Norichika. This absence indicates a potential lack of formal corporate approval for the initiation of the suit.

(*b*) The copy of Power of Attorney marked as X-21, which purportedly authorized Mr. Kensuke Norichika to file and institute the suit, has not been properly authenticated as per legal requirements, and was thus, not admitted as an exhibit. Additionally, PW-1 conceded during his cross-examination on 29th April, 2004, that he did not witness the execution of the Power of Attorney, and was uncertain whether the photocopy submitted was directly copied from the original, or was a copy of a copy, casting further doubts on its legitimacy.

(*c*) The photocopy of the Power of Attorney is inadmissible in evidence

because its authenticity and direct derivation from the original cannot be verified. PW-1's vague statement during his cross-examination that he had "heard" the original Power of Attorney had been lost lacks specificity and credibility. No conclusive evidence or legally acceptable testimony confirms the loss or substantiates the claim.

(*d*) During the cross-examination conducted on 30th April, 2009, PW-1 admitted that no Board Resolutions authorized the ratifications dated 24th January, 2001 [Ex. PW1/40] and 01st December, 2006 [Ex. PW1/42A]. This lack of formal authorization questions the validity of the actions taken under this supposed ratification.

(*e*) PW-1's admissions that certain critical documents, including extracts from Commercial Register and ratifications, were not prepared in his presence, and that he had not brought original documents to verify translations or the authenticity of photocopies, weaken the Plaintiff's position.

58. Basis the points noted above, Defendant challenged the procedural foundations of the present lawsuit, particularly focusing on the authenticity and procedural correctness of the documents and authorizations relied upon by the Plaintiff to initiate legal proceedings.

59. The Court has examined the documents and oral evidence. While no specific onus of proof was assigned to this issue, the burden typically falls on the Plaintiff to demonstrate that the suit was signed, verified, and instituted by an authorized and competent individual. It cannot be disputed that a company like the Plaintiff can sue and be sued in their own name. As a juristic entity, a company necessarily acts through individuals authorized to represent its legal interests. Order XXIX Rule 1 of the CPC stipulates that

in cases involving a corporation, the Secretary, any Director, or any other Principal Officer who is knowledgeable about the facts of the case is empowered to sign and verify pleadings on behalf of the company. As per Order VI Rule 14, a pleading is required to be signed by the party and its pleader, if any. When these two provisions are read in conjunction, it becomes clear that even in the absence of a formal authorization, such as a Letter of Authority or Power of Attorney, the designated officers enumerated in Order XXIX Rule 1 possess inherent authority to act on behalf of the corporation. This provision ensures that the practical realities of a corporate's operations are accommodated within legal procedures, allowing those who hold these offices to effectively represent the corporate entity in judicial processes. In addition thereto and *de hors* Order XXIX Rule 1 of the CPC, since a company is a juristic entity, it can duly authorise any person to sign the plaint or the written statement on its behalf, and this would be regarded as sufficient compliance with the provisions of Order VI Rule 14. In the case of ***United Bank of India v. Naresh Kumar and Ors.,***[8] the Supreme Court held that beyond the stipulations of Order XXIX, a corporation may also specifically authorize any individual to sign pleadings and other legal documents. This can be achieved through explicit means such as a resolution passed by the Board of Directors or through the execution of a Power of Attorney. In situations where no explicit authorization is evident, and an officer of the corporation has signed the pleadings, the corporation has the ability to subsequently ratify these actions. Such ratification may be express, such as through formal corporate

[8] (1996) 6 SCC 660.

resolutions, or implied, discerned from the conduct and the context of the legal proceedings.

60. Before the Court, Plaintiff has relied on a series of documents to establish the authority of Mr. Kensuke Norichika to initiate legal action on behalf of Kabushiki Kaisha Toshiba. The foundational document is the Power of Attorney dated 18th April, 1989 [Mark X-21], which authorized Mr. Kensuke Norichika to sign and execute documents concerning industrial property rights, explicitly empowering him to institute legal actions for the company. However, because of the absence of the original document during the proceedings, the document could not be proved as per the Evidence Act, 1872. In response to the challenge of proving authorization, the Plaintiff produced two ratification resolutions. The first, dated 24th January, 2001 [Ex. PW1/40], which ratifies Mr. Kensuke Norichika's actions in signing, verifying, and instituting the suit. This resolution affirmed that the original Power of Attorney was deemed to confer upon Mr. Kensuke Norichika the authority necessary for handling the legal proceedings in this lawsuit. A second ratification occurred on 01st December, 2006 [Ex. PW1/42A], which also confirmed Mr. Kensuke Norichika's actions and reaffirmed the authority granted by the 1989 Power of Attorney. This was further substantiated by witness testimony of PW-1, who deposed that Mr. Kensuke Norichika, although no longer an employee, was properly authorized by then-President Mr. Tadashi Okamura, as indicated by the ratification and Power of Attorney of January 2001. Moreover, Mr. Atsutoshi Nishida, another President of the company, also ratified the institution of the suit through another document dated 01st December, 2006.

61. The legitimacy of the afore-noted authorizations is supported by

records from the Commercial Register maintained by Registrar of Companies of Japan. Extracts of these records were presented in Japanese [Ex. PW1/41] and translated into English [Ex. PW1/42], indicating that Mr. Tadashi Okamura was the Representative Director at the relevant time, further lending credence to the ratifications.

62. In his testimony, PW-1 cited specific provisions from the Japanese Commercial Code to clarify the powers of Mr. Tadashi Okamura and Mr. Atsutoshi Nishida, acting in their roles as Representative Directors in 2001 and 2006 respectively, which authorized them to institute the lawsuit. The provisions from the Japanese Commercial Code and their English translations were submitted as Ex. PW1/43 and Ex. PW1/44, respectively. This evidence supplements the legal foundation for their actions within the corporate governance structure.

63. The Court, upon reviewing the evidence and considering the totality of the circumstances, particularly the conduct of trial, is empowered to infer that the corporation has ratified the actions of its officer who signed the pleadings. This interpretative flexibility ensures that technical lapses in formal authorization do not unduly hinder the substantive pursuit of justice, reflecting a pragmatic approach to corporate legal representation. Thus, keeping the Evidence Act in view, despite rigorous cross-examination by the Defendant challenging the legality of these ratifications, the Court finds PW-1's testimony credible and sufficient to confirm that the initiation of the suit by Mr. Kensuke Norichika complied with the requirements of the CPC. Mr. Kensuke Norichika's association with the Plaintiff-company as an employee is undisputed and his authority to act on its behalf has been substantiated.

64. The longstanding engagement of the Plaintiff in the lawsuit, which

has spanned over three decades, further supports the legitimacy of Mr. Kensuke Norichika's initial actions.[9] The continuous appearance of witnesses on behalf of the Plaintiff, who have acknowledged Mr. Kensuke Norichika's role in initiating the suit, coupled with the express and implied ratifications through the ongoing prosecution of the case, reinforce the validity of his actions. This is also evidenced by the Plaintiff's payment of court fee, consistent submission of documentary and oral evidence, and active participation in the trial process throughout this period.

***Finding***

65. The Court is satisfied that the lawsuit has been instituted by a competent person on behalf of the Plaintiff. Despite technical challenges related to the original Power of Attorney in favour of Mr. Kensuke Norichika, the Plaintiff has substantiated the institution of the lawsuit through subsequent ratifications and corroborative witness testimony. Having regard to the provisions of the CPC discussed above and the judgments in ***United Bank of India*** *(Supra),* ***Mahanagar Telephone Nigam Ltd.*** *(Supra)* and ***Modern Automobiles*** *(Supra),* in the opinion of the Court, the filing of the lawsuit reflects an effort to adhere to corporate governance norms and legal requirements for authorizing litigation. Although the absence of the original Power of Attorney and certain procedural irregularities highlighted by the Defendant posed questions regarding the procedural aspects of initiation of the lawsuit, Plaintiff has successfully demonstrated that the institution was with their knowledge and sanction.

[9] *See:* ***Mahanagar Telephone Nigam Ltd. v. Smt. Suman Sharma,*** 2010 SCC OnLine Del 4290 and ***M/s Modern Automobiles and Anr. v. H.P. Vidhan Sabha and Anr.***, 2010 SCC OnLine HP 1059.

Furthermore, the sustained legal proceedings and the conduct exhibited over the years indicate ratification of the authorization of Mr. Kensuke Norichika's actions by Plaintiff. Therefore, Plaintiff has convincingly demonstrated that the lawsuit was signed, verified, and instituted by a duly authorized individual.

66. Issue No. 4 is thus decided in favour of the Plaintiff, and against the Defendant.

**ISSUE NO. 1: WHETHER THE PLAINTIFF IS THE REGISTERED PROPRIETOR OF THE TRADE MARK TOSHIBA?**

67. The above-captioned issue involves establishing the Plaintiff's ownership and registration status of the trademark "TOSHIBA." The burden of proof rests squarely with the Plaintiff.

68. The Plaintiff has asserted that "TOSHIBA" is an inventive word, created by amalgamating parts of the names of their predecessor companies –Tokyo and Shibaura. This trademark was coined in 1939 and has been actively used by the Plaintiff since its inception. The Plaintiff further substantiated their claim by providing evidence of over 2000 global registrations of the "TOSHIBA" mark, including 30 registrations in India at the time of evidence of PW-1. The trademark registrations pertinent to the instant dispute are trademarks No. 160442, 160443, 273758, 273759, and 273760, prevailing at the time of filing of the suit. Plaintiff's registrations are meticulously documented and have been introduced in evidence as Ex. PW1/7 through PW-1/27 for global registrations, and Ex. PW1/28 through PW1/30, along with Marks X-18 and X-19 for Indian registrations mentioned above, which have been proved through oral testimony.

69. Notably, the Defendants have not disputed the Plaintiff's ownership claims over the trademark "TOSHIBA." This lack of contestation, coupled with the corroborated documentary evidence presented by the Plaintiff's witness, firmly establishes the Plaintiff's ownership over the trademark. The Plaintiff has demonstrated that they have secured and maintained registrations of the "TOSHIBA" trademark in the Indian territory, confirming their status as the registered proprietor of the mark across multiple classes, including classes 07, 09, and 11, which encompass a variety of scientific, electrical, and electronic goods. The continuing validity and subsistence of these registrations on the Register, with the earliest Indian registrations dated 05th September, 1953, bearing Nos. 160442 and 160443 [Ex.PW1/28 and Ex. PW1/29], being of notable significance.

***Finding***

70. The Plaintiff's sustained use of the trademark and the enduring registrations over the past 70 years have robustly supported their claim of ownership and established their legal status as the registered proprietor of the "TOSHIBA" trademark in India.

71. Accordingly, the issue is decided in favour of the Plaintiff and against the Defendant, holding that the Plaintiff is the owner as well as registered proprietor of the mark "TOSHIBA."

**ISSUE NO. 2: WHETHER THE DEFENDANT'S USE OF THE MARK 'TOSIBA' AMOUNTS TO INFRINGEMENT OF THE PLAINTIFF'S REGISTERED TRADE MARK?**

**ISSUE NO. 8: WHAT IS THE EFFECT OF THE RECTIFICATION OF THE PLAINTIFF'S REGISTRATION AND APPEALS PENDING BEFORE THE CALCUTTA HIGH COURT?**

72. First and foremost, it is essential to recognize the distinctive nature of the Plaintiff's trademark. "TOSHIBA" was registered in Part A of the Trademarks Register, which is earmarked for trademarks that are inherently distinctive. Part A trademarks are deemed to have a unique character or to be 'invented,' readily distinguishing them from ordinary language or existing terms. Such a categorization under Part A indicates not only a higher degree of distinctiveness, but also implies that the mark "TOSHIBA" is recognized under the law as having an inherent ability to signify the source of the goods uniquely, without confusion. This inherent distinctiveness establishes a strong baseline of uniqueness against which the similarity to any other mark, such as "TOSIBA," must be measured. Therefore, when assessing whether "TOSIBA" infringes upon "TOSHIBA", the frame of reference is not just the phonetic and visual similarity, but also the distinctiveness that "TOSHIBA" commands due to its Part A registration.

## I. ***Comprehensive analysis of trademark infringement under Section 29(1) of the Trade Marks Act 1958***

73. Section 29 of the Trade Marks Act 1958 prescribes the criteria for determining trademark infringement. Sub-section (1) of Section 29 stipulates that to establish infringement, it must be shown that the Defendant's mark is either identical or deceptively similar to the Plaintiff's registered trademark, used in the course of trade, in relation to goods or services for which the trademark is registered, and used in such a manner that it is likely to be perceived as a mark indicating the origin of goods or services. The key elements of the provision can thus be broken down as follows:

(*a*) "***Identical with or deceptively similar to":*** The initial step in infringement analysis involves comparing the Defendant's mark with the Plaintiff's registered trademark. This comparison must consider both visual and phonetic elements as well as the overall impression created by the marks in the minds of the public. Under Section 2(1)(d) of the Trade Marks Act 1958, a mark is considered deceptively similar to another mark, if it so nearly resembles the other as likely to deceive or cause confusion.

(*b*) ***"Uses in the course of trade":*** This element examines whether the Defendant's use of the mark occurs within the context of commercial activity, with a view to gain economically. The usage of the mark must be part of the trading activities undertaken by the Defendant, encompassing promotion, distribution, and sale of goods under the contentious mark.

(*c*) ***"In relation to any goods for which the trademark is registered":*** Critical to the infringement analysis is whether the Defendant's use of the mark occurs in relation to goods for which the Plaintiff's trademark is registered. This requires an examination of the goods listed in registration of the Plaintiff's trademark.

(*d*) ***"In such a manner as to render the use likely to be taken as being used as a trademark":*** The final criterion focuses on the manner in which the infringing mark is used. The use of the infringing trademark must suggest to the public or consumers that it functions as a trademark – indicating the origin of the goods. In other words, the use must be in such a manner that consumers are likely to perceive it as a trademark, not merely as a decorative or non-distinctive feature. This includes consideration of how the mark is displayed on products, packaging, marketing materials, and in advertising. The usage should imply a connection in the course of trade

between the goods and the trademark owner.

74. To conclude, for the Plaintiff to succeed in their claim for trademark infringement under Section 29(1) of Trade Marks Act 1958, all these elements must coalesce: the mark used by the Defendant must be nearly identical or deceptively similar to the registered mark, used within commercial activities, linked to the registered goods, and likely to be recognized by the public as a trademark indicating the source of those goods.

75. The Court accordingly proceeds further with assessing the merits of Plaintiff's claims of infringement, examining each component in detail to determine whether these ingredients are present in the case at hand.

## I.I. *Analysis of the similarity of the marks under trademark law*

### I.I.I. *Visual or structural similarity*

76. The Plaintiff's portfolio of trademark registrations encompasses the wordmark "TOSHIBA" as well as the device "Toshiba." The device "Toshiba" principally comprises of the word "TOSHIBA" written in a striking font style, which serves as its distinctive feature intended to designate the source of their products. The overall impression created in the minds of an average buyer would thus be the wordmark "TOSHIBA," and not the manner of writing. In assessing deceptive similarity between the contesting trademarks, the Court remains cognizant of this impact rendered by the Plaintiff's use of "Toshiba."

77. On a comparative visual or structural examination of the trademarks

"TOSHIBA" and "TOSIBA," it can easily be observed that they share six out of seven letters, differing only in the sixth character ('H' in "TOSHIBA" v. 'B' in "TOSIBA"). This close similarity in visual representation enhances the likelihood of confusion or deception among the consuming public. This confusion is particularly probable given the identical sequence and majority of shared letters in the respective marks, which are likely to impress upon the consumer's memory in similar ways. Therefore, the criterion of deceptive similarity, as stipulated by law, is met on the basis of structural similarity.

### I.I.II. *Aural similarity*

78. Phonetically, the marks "TOSHIBA" and "TOSIBA" are strikingly similar, diverging only in the slight variation in pronunciation of the sixth letter. This nuanced difference is unlikely to be discerned by the average consumer, particularly during verbal communication or casual observation, heightening the risk of confusion among consumers with imperfect recollection. This risk is accentuated in environments where verbal communication predominates, such as in stores or advertisements, where precise articulation might be compromised by speech variations.

79. For considering the appropriate yardstick for assessing deceptive similarity, it would be instructive to reference a few judgments of the Supreme Court of India, rendered under the Trade Marks Act 1958. In the landmark case of ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.***,[10] the Court emphasized that the likelihood of confusion should be assessed from the perspective of an average consumer. It was held that when

the similarity between the Plaintiff's and the Defendant's mark is so close – whether visual, phonetic, or otherwise – and the Court concludes that there is an imitation, no further evidence is necessary to establish that the Plaintiff's rights have been violated. This precedent underscores that the threshold for proving deceptive similarity does not necessarily require extensive evidence if the initial comparison clearly indicates imitation, thus simplifying the process of adjudicating claims of infringement based on superficial resemblance. In ***Amritdhara Pharmacy v. Satya Deo Gupta***,[11] the Court stressed that in determining deceptive similarity, the analysis must be conducted from the perspective of a person who is likely to be deceived or confused. This judicial approach considers the state of mind of a customer possessing average intelligence and having imperfect recollection. The Court observed that minor differences between the marks might not be sufficient to distinguish them for an unwary consumer, especially if the overall impression created by the marks is one of similarity. Central to this inquiry is whether the public is likely to believe that the goods or services offered under the marks in question emanate from a common source. This perspective ensures that the focus remains not on the minutiae of the differences, but on the overall impact of the marks on the consumer's perception. Applying these well-established principles to the dispute at hand, the visual and phonetic similarities between "TOSHIBA" and "TOSIBA" become evidently significant, with only a single letter differentiating them. This minor variation does little to mitigate the visual similarity between the

[10] (2001) 5 SCC 73.
[11] 1962 SCC OnLine SC 13.

marks, which could readily lead to confusion owing to their nearly identical arrangement and appearance of letters. Moreover, the close phonetic resemblance would also easily foster confusion, particularly in environments where the marks are spoken rather than read, such as during verbal communications in stores or through auditory channels in advertisements. In such scenarios, the slight phonetic difference is likely to go unnoticed, potentially leading consumers to believe that the products originate from the same source.

Conclusion:

80. In light of the above analysis and considering the relevant judicial precedents, it is evident that the similarity between the two marks extends significantly to their phonetic expression and visual representation – factors that are crucial in assessing the potential impact on consumer perception and decision-making. These similarities are likely to lead to confusion among consumers, particularly given the almost identical visual and aural presentation of the marks. Consequently, the Court concludes that the marks "TOSHIBA" and "TOSIBA" are nearly identical, thus rendering them deceptively similar under Section 2(1)(d) of the Trade Marks Act 1958.

**I.II.** ***Use in the course of trade and in a trademark sense***

81. To fulfil the infringement criteria under Section 29(1) of the Trade Marks Act 1958, it is also imperative for the Plaintiff to establish that the Defendant's use of the mark "TOSIBA" occurs within the realm of commercial activity, characterized by efforts to derive economic benefit. The phrase "uses in the course of trade" found in the statute extends beyond mere presence of the mark in business operations; it encompasses a range of

activities that indicate the mark's use in marketing, distribution, sale, or promotion of goods under the contested trademark.

82. In the present case, there is no dispute on this aspect, there is substantial evidence that suggests that "TOSIBA" has been prominently used by the Defendant in a manner akin to a traditional trademark. This includes the application of the "TOSIBA" mark on products, packaging, promotional materials, and advertising efforts undertaken by the Defendant to reach a broad consumer base. The Defendant has engaged in selling electrical products under the "TOSIBA" mark, directly competing in the same markets where "TOSHIBA" products are sold. They also sought to secure registration of the "TOSIBA" trademark, which signifies their intention to use the mark in commerce. By filing for trademark registration and claiming actual use, the Defendant acknowledges and documents the use of "TOSIBA" in commercial activities, thereby reinforcing the mark's role in trade.

83. The use of "TOSIBA" for sale of products through stores as well as online marketing platforms, demonstrate a clear deployment of the "TOSIBA" mark in the course of trade, aimed at identifying the goods as emanating from a particular source. The manner of use of the Defendant's mark– prominently on electrical goods – further suggests that it is likely to be perceived as a trademark. Thus, the requirements of the statute on captioned criteria of Section 29(1) are also met.

### I.III. *Whether "TOSIBA" is used in relation to goods for which "TOSHIBA" is registered*

84. Having established the visual and phonetic similarity between the

trademarks "TOSHIBA" and "TOSIBA," it is now imperative to critically examine whether the Defendant is using the deceptively similar mark in relation to the goods for which the Plaintiff's trademark is registered. According to Section 29(1) of Trade Marks Act 1958, infringement occurs only when a mark that is identical or deceptively similar to a registered trademark is used on goods for which the Plaintiff's trademark is registered. Consequently, the next step of our examination will determine the extent to which the Defendant's use of "TOSIBA" intersects with the specific categories of goods for which "TOSHIBA" is registered.

85. On this issue, reference must be made to the judgments in ***Nestle's Products Limited and Ors. v. Milkmade Corporation and Ors.***,[12] and ***M/s Parry and Co. Ltd. v. M/s Perry and Co.,***[13] which elucidate the scope of infringement under Section 29(1) of the Trade Marks Act 1958. In ***Nestle's Products*** *(Supra)*, it has been categorically held that the phrase "in relation to goods and services" requires a discernible and direct connection between the goods outlined in the trademark registration and those on which the disputed mark is used. The decision in ***Parry and Co. Ltd.*** *(Supra)* delivered in a trademark infringement suit, underscores that registration of a trademark does not endow exclusive rights over all goods covered in the class, which are outside the purview of the registration. Therefore, trademark infringement claims are confined to the specific categories for which the trademark has been officially registered.

86. For illustration, consider a scenario where a trademark is registered

[12] 1972 SCC OnLine Del 132.
[13] 1962 SCC OnLine Mad 89.

for electronic appliances. If the same or a deceptively similar mark is used by another entity for apparel, the requisite direct connection to establish infringement is not present. This categorical separation often leads to distinct consumer perceptions; the recognition and association of the trademark with electronic appliances do not naturally extend to apparel. The Trade Marks Act 1958 acknowledges this segmentation, emphasizing that infringement is not merely about the use of a deceptively similar mark, but also about how the mark is used in the marketplace. The usage must suggest to consumers that it functions as a trademark, signifying the origin of the goods in a manner that aligns with the goods for which the trademark is officially registered.

87. Keeping the relevant case law and statutory framework in mind, we first examine the Plaintiff's trademark registrations. The Plaintiff has anchored their claim on several trademark registrations for trademark "TOSHIBA"/ "  " spanning classes 07, 09, and 11, as categorized by the Nice Classification. Plaintiff's class 11 registrations are particularly relevant to the controversy as they encompass electrical appliances, including a broad range of household appliances. This classification aligns directly with the Defendant's area of business, making it central to the allegations of trademark infringement. The Plaintiff's registrations pertinent to this lawsuit have been elucidated in the preceding segment. The specific details of these registrations are delineated in paragraph No. 4.2 of the judgment. In contrast, the Defendant does not hold any valid subsisting trademark registrations.

88. The Plaintiff's registration bearing No. 160443 extensively covers the

entire range of goods classified under class 11 as defined by the Nice Classification *i.e.*, "*apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, and sanitary purposes*." Based on the pleadings (paragraph No. 3 of the amended written statement**)** and evidence (cross-examination of PW-1 on 08th February, 2010 and DW1/66) and their trademark application No. 509863 which did not mature into a registration, it is evident that the Defendant's claim for "TOSIBA" trademark was intended for electrical appliances, specifically for domestic purposes. The detailed scope of the unsuccessful trademark application No. 509863 includes "*installations of heating, cooking, auto and non-auto ovens, toasters, coils, stoves, table fans, electrical rods, filters, heat convectors, room heaters, and gas stoves*." The items manufactured by the Defendant under the trademark "TOSIBA" catalogued in evidence are as follows: immersion rods, lamps, irons, toasters, milk boilers, fans, ovens, extension cords, room heaters, heat convectors, electric stoves, and stove coils.

89. Thus, the use of "TOSIBA" by Defendant clearly falls within the scope of goods protected under the Plaintiff's trademark registration No. 160443, which is broad enough to encompass the range of goods manufactured and sold by the Defendant. Such application of the mark is likely to cause confusion or deception among consumers as to the origin of the goods. Therefore, this nature of use constitutes trademark infringement under Section 29(1) of the Trade Marks Act, 1958.

## II. ***Effect of rectification of the Plaintiff's registrations***

90. The outcome of Defendant's petitions seeking cancellation of the

Plaintiff's trademark registrations submitted in evidence and marked as Mark X-47 (colly), Mark X-48 (colly), Mark X-49, Mark X-50, Mark X-51 and Ex. PW 1/74, have been comprehensively discussed in an earlier section of the judgment. The afore-noted documentary evidence was presented by PW-1 on 11th March, 2008. At the time of tendering of evidence, Defendant had contested the mode of proof of certain documents, palpably due to lack of production of certified copies of the judicial orders.

91. Be that as it may, the orders passed in trademark proceedings *inter se* the parties have not been refuted by the Defendant. Rather, during his cross-examination on 01st February, 2022, DW-1, proprietor of the Defendant, has recognized the verdicts rendered by the Trademarks Registry and the High Court of Calcutta on their rectification petitions. The relevant excerpts from his cross-examination are reproduced below:

> "*Q.61 What was the basis for your continuing to use Tosiba despite having become aware of the registrations held by the plaintiff?*
> *Ans. I continued to use the said trademark since I had learnt that the plaintiff company was not producing its goods in India. I filed rectification applications. I was told that they were blocking the register. Volunteered: I filed three rectification petitions in class 7, 9 and 11. The class 7 case was decided in my favour in trademark registry. Ld. Single Judge of Calcutta High Court also ruled in my favour. The plaintiff herein challenged the said order before the Ld. Division Bench. That case was also decided in my favour. The plaintiff then approached the Supreme Court and there the court allowed the appeal filed by the plaintiff. The rest of the two cases falling in class 9 and 11 were decided by the Registrar in favour of the defendant herein. The plaintiff herein then approached the Calcutta High Court. The Ld. Single Judge decided in favour of the defendant herein. The plaintiff herein then approached the Hon'ble Division Bench. After 20 years of filing of the case, the appeal filed by the plaintiff was dismissed.*"

92. As regards the order of the Trademarks Registry passed in proceedings arising from trademarks No. 160442 and 160443 of the Plaintiff

[Mark X-51], DW-1 did not deny the existence of the orders or contents thereof; rather, he only questioned the validity of the decisions, claiming that an appeal had been filed. In view of the explicit acknowledgment of DW-1 and lack of challenge to their authenticity, the non-production of certified copies of documentary evidence (which are public records) presented as Mark X-47 (colly), Mark X-48 (colly), Mark X-49, Mark X-50, Mark X-51 is considered inconsequential to the parties' standing with respect to their respective trademarks. These documents are thus admitted in evidence and are deemed to be exhibited with the reference numbers.

93. The spectrum of product range under Defendant's "TOSIBA" trademark coincides with the scope of registration of Plaintiff under No. 160443 operative *w.e.f.* 05th September, 1953. This registration is currently valid, not rectified, and broad enough to encompass all goods of the Defendant. Therefore, the orders omitting certain products from description of goods of Plaintiff's trademark applications do not influence the finding of infringement of the trademark "TOSHIBA."

## III. ***Appraisal of the Defendant's position of honest adoption and prior user***

94. Next, we must assess whether any defences asserted by the Defendant could render their activities as non-infringing, falling outside the purview of Section 29(1) of the Trade Marks Act 1958. This examination will particularly focus on the claims of prior use and whether the adoption of the "TOSIBA" mark was honest and in good faith. Such defences, if substantiated, could potentially mitigate or negate the findings of infringement, despite the similarities between the marks and the overlapping

goods.

**III.I.** ***Whether Defendant's adoption was honest and in good faith***

95. The Defendant asserts that their adoption of "TOSIBA" was uninfluenced by Plaintiff's presence in Japan, which had not permeated into the Indian market when Defendant's business was conceived. They explained that the trademark "TOSIBA" was devised as homage to the proprietor's mother, Ms. Sumitra, who was reverently named "Toshi Bai" by her family members. This justification, put forth only during the deposition of DW-1 (proprietor of Defendant), posits that the expression "Bai" was considered unsuitable for business related to electrical items. The term was thus modified to "Ba," connoting 'the elder one' or 'grandmother' in Gujarati language. The induction of this term in impugned tradename/ mark has been attributed to the Gujarati orientation of DW-1's daughters in law.

96. The testimony of DW-1 is relevant in this context, pertinent portions whereof are as follows:

**Cross-examination conducted on 06th September, 2019:**

"*Q1. When did you adopt the impugned Trademark Toshiba?*
*Ans. 1974-1975.*
*Q2. Did you consult a lawyer before adopting the impugned Trademark?*
*Ans. No.*
*Q3. Did you conduct any due diligence before adopting the impugned Trademark?*
*Ans. Yes.*
*Q4. What steps did you take to conduct due diligence?*
*Ans. My mother's name was Toshi.*
*Q5. Is it correct that besides your mother's name, no other step was taken by you?*
*Ans. Yes.*
*Q6. Were you aware of the plaintiff's registration of the Trade Mark Toshiba of the plaintiff since the year 1953?*
*Ans. No.*
*Q7. Is it correct that you filed two petitions bearing No. MAS-327 & MAS-*

*328 seeking rectification of the plaintiff's trademark registration for the mark Toshiba before the trademark registry, Chennai?*
*Ans. Yes. (Vol. on receiving the notice of M/s Anand & Anand, I only came to know about that his client has registered trademark and it is only after that I filed the aforesaid rectifications.)*

***xx --- xx --- xx***

*Q29. You have stated that you adopted the impugned trademark Tosiba because your mother's name was Toshi and in your affidavit dated 21.01.1991 you have stated that your late mother was given the name Toshi Bai by your late grandmother. What is the reason that you named your company "Tosiba" and not "Toshiba"?*
*(The witness is shown copy of the document from the court file @ page 413 Part -111(b).)*
*Ans. I never knew that there was a company with the name Toshiba way back in 1974.*"

**Cross-examination conducted on 01st February, 2022:**

"*Q.62 I put it to you that in your written statement you never said that the reason for the adoption of the trademark Tosiba by you was that it was your mother's name. Is that correct?*
*Ans. I did not mention this fact in the written statement because I do not want to introduce my mother's name into this case. My mother had passed away in the year 1969. It was an emotional decision. My father, however, filed an affidavit in this ease disclosing that Toshi Bai was my mother's name. Volunteered: my mother's actual name was Sumitra. She shared this name with my paternal aunt (tai). That is why the name of my mother was changed to Toshi Bai after her marriage. This was told to me by my grandfather.*

***xx --- xx --- xx***

*Q.65 Why was it that you chose not to adopt Toshi Bai and instead changed to Tosiba?*
*Ans. This was my choice. Volunteered: The expression "Toshi Bai" was not suitable for use since my business related to electrical items and the word "Bai" sounded like a misfit. In Gujarati language, the word "Ba " is used for "the elder one " or the grandmother.*

***xx --- xx --- xx***

*Q.68 During the process of adoption of the trademark Tosiba, you explained that you had based this adoption on your mother's name who had been referred to in the family as Toshi Bai. You proceeded to engineer the said words by removing the letter "h" from the word Toshi. Thereafter, you telescoped the two words together and removed the letter "i" from the word Bai in order to base the latter part of the mark on the Gujarat!*

*language source. Is this correct?*
*Ans. This is incorrect. Volunteered: In India there are 30-40 languages spoken. I have one daughter-in-law who is of Nepali origin. My two daughters-in-law are from Gujarat and my son-in-law is Bengali. So if I pick up things from here and there of the languages spoken in those regions, it cannot be compared with English words. "Ba " is one word which is very common in Gujarat.*

97. The narrative presented by Defendant lacks corroboration and is replete with inconsistencies. Defendant has been unable to sufficiently demonstrate that DW-1's mother, named Ms. Sumitra, was known as "Toshi Bai," which supposedly served as an inspiration to adopt the trademark "TOSIBA." Further, there is no convincing explanation for omitting the alphabets 'H' and 'I' from the name "Toshi Bai." DW-1 sought to rationalize the use of 'Ba' instead of 'Bai' by referring to lineage of his two daughters in law. On this aspect, the Plaintiff highlighted a significant fallacy that merits mentioning. They pointed out that DW-1, who was born in 1946, would be aged about 28 years old at the time of claimed adoption of the impugned mark "TOSIBA" in 1974. Therefore, it is implausible that DW-1 had daughters in law at the time, rendering his testimony untrue. The Court finds strength in this argument, particularly in absence of any other persuasive material underpinning the story of conception of "TOSIBA."

98. The Defendant's claim of honest adoption hinges on unfamiliarity with the Plaintiff's operations. Plaintiff's earliest trademark registrations No. 160442 and 160443 were granted on 28th November, 1955 and 27th March, 1956, respectively *w.e.f.* 05th September, 1953 [Ex. PW 1/29 and Ex. PW 1/28]. These dates considerably precede adoption of the impugned trademark "TOSIBA" by the Defendant in 1974-75. Before commencing their commercial venture under trademark "TOSIBA," it was incumbent

upon the Defendant to have inspected the trade channels, public records and Trademarks Register to prevent any potential clashes with trademarks that were filed/ obtained at an earlier time. This onus is particularly significant when the disputed trademark is sought to be utilized for the same products. Defendant's efforts have considerably fallen short in this regard. During cross-examination, DW-1 has conceded that Defendant's due diligence was restricted, and they were not aware of the Plaintiff's trademark registrations operating from 1953. Had they diligently examined the Trademarks Register, they would have surely discovered Plaintiff's prior applications/ registrations. The Defendant cannot plead ignorance of Plaintiff's statutorily recognized trademark rights when they have failed to demonstrate due diligence before commencing the impugned operations.

99. As has been established earlier, the Plaintiff's trademark "TOSHIBA" is an inventive and original creation registered in Part A of the Trademarks Register, which endows them with greater protection. The evidence put forth by Defendant fails to prove honest and diligent adoption of a deceptively similar trademark and does not aspire the Court's confidence.

**III.II.** ***Who is the prior user of the two deceptively similar trademarks?***

100. The concept of prior user is outlined in Section 33 of the Trade Marks Act 1958. This section affirms that the party who first uses a trademark in commerce, or who registers it first in a jurisdiction, is typically accorded superior rights over that mark. This legal foundation is critical for adjudicating disputes involving deceptively similar trademarks since such similarities could potentially lead to consumer confusion or deception. The precedence of use is not merely a procedural detail, but a substantive right

that plays a critical role in the protection of trademarks. It ensures that the rights of the party who pioneered the mark in a commercial context are preserved, even in the face of subsequent users who may claim rights to similar marks. In evaluating who among the parties is the senior user, the Court would have to look at the factual matrix concerning the first use of the competing marks in trade. This includes the date of first use, the nature of the goods it was used in connection with, and the geographical extent of its use.

### III.II.I. *Plaintiff's historical adoption and registration of the trademark "TOSHIBA"*

101. As previously discussed, the Plaintiff coined the trademark "TOSHIBA" in 1939 by amalgamating the first few letters of trade names of their predecessors – Tokyo Electric Company and Shibaura Engineering Works Company Limited. In a move to expand their commercial operations to India, they preferred applications for trademarks No. 160442 and 160443 in classes 09 and 11, respectively on 05th September, 1953. Later, on 26th July, 1971, they filed three other trademark applications,[14] which have been referenced hereinabove. The grant of these registrations, which are directly relevant to controversy involved herein, establishes Plaintiff's trademark precedence facilitating market penetration in subsequent years. The Plaintiff's oldest registration bearing No. 160443 [Ex. PW 1/28] in class 11 notably covers a broad spectrum of electrical appliances, including, but not limited to, household appliances. Thus, it covers virtually all the goods

[14] Trademarks No. 273758, 273759, and 273760.

being manufactured and sold by Defendant.

### III.II.II. *Date of adoption and use of "TOSIBA" by the Defendant*

102. The Defendant's claimed adoption date of 1974-75 has been proved through substantial evidence. They have presented a series of sales invoices [Ex. DW1/2 to Ex. DW1/9] substantiating their claim. Ex. DW1/2 to Ex. DW1/6 are sales bills from 1975, Ex. DW1/7 and Ex. DW1/8 from 1976, and Ex. DW1/9 from 1989. These documents collectively demonstrate the consistent use of "TOSIBA" across the relevant years. Further support of continuous use is found in the affidavit by way of evidence of DW-1, which details the Defendant's sales figures from 1974-75 to 1989-90. Additional evidence includes gate passes marked as Ex. DW1/12 to Ex. DW1/22, Ex. DW1/24 to Ex. DW 1/47, Ex. DW1/49 to Ex. DW1/54, which document the movement of electrical goods bearing the "TOSIBA" trademark out of the Defendant's factory between 1975 and 1989. These are authenticated by the Inspector of Central Excise. Registrations and certifications from relevant authorities further substantiate the ongoing business operations under the "TOSIBA" trademark. For instance, various product certifications by the Indian Standards Institute in 1976 [Ex. DW1/60 to DW1/62] confirm the use and recognition of "TOSIBA" in respect of the Defendant's products. Evidence of the Defendant's engagement with significant clients like the Army Canteen Stores [Ex. DW 1/64 to Ex. DW1/66], and various awards for product performance and entrepreneurship [Ex. DW1/79 to DW1/88] from 1984 to 1989 further prove the continuous use of "TOSIBA" trademark within relevant markets. The Defendant's ongoing business activities as evidenced by purchases of raw materials and other supplies [Ex. DW 1/99,

DW 1/101, DW 1/107, DW 1/109, DW1/111, DW1/114, DW1/117 and Ex. DW1/125] are critical indicators of the active and public use of the "TOSIBA" trademark.

103. Therefore, through the evidence discussed above, the Defendant has convincingly demonstrated continuous and sustained use of the trademark "TOSIBA" since 1975.

### III.II.III. *Determination of the senior user*

104. Against the Defendant's user date of 1975, the Plaintiff has secured several valid trademark registrations, all of which predate the Defendant's first use of the mark in 1974-75. Nonetheless, the Defendant asseverated that they are the senior user because Plaintiff had not commercially used their mark in India due to policy restrictions preventing their market entry.

105. The Defendant's argument overlooks a critical aspect of trademark law, wherein the act of registration, particularly when filed on a proposed-to-be-used basis, establishes prior use in legal terms from the date of application. Section 18 of the Trade Marks Act 1958 clarifies the eligibility for trademark registration. It states that any person who is actually using a trademark, or intends to use a trademark, can apply for registration. Crucially, this provision indicates that physical or actual use is not a prerequisite for acquiring proprietary rights in a trademark. Merely the intention to use and register the trademark is sufficient to establish these rights. This legislative framework ensures that even if a trademark is registered on a proposed-to-be-used basis, it carries the same legal weight as one already in use concerning the establishment of priority and enforcement of rights.

106. Section 33 of Trade Marks Act 1958 sets the framework for determining the priority of trademark rights. Section 33(a) articulates that the rights of a trademark user take precedence over others if their use of the mark commenced prior to another party's use of a similar mark for identical goods. Critically, Section 33(b) clarifies that if a trademark is registered, the rights of the registrant are considered to commence from the date of the application. This distinction is crucial as it does not necessitate the start of actual commercial use or the completion of the registration process for the rights to take effect. Thus, the priority hinges on the date of application rather than commencement of commercial use. This principle is underscored by the judgments in ***Drums Food International Pvt. Ltd. vs. Euro Ice Cream and Ors.***,[15] and ***Radico Khaitan Ltd. v. M/s Devans Modern Breweries Ltd.,***[16] delivered in the context of Section 34 of the Trademarks Act, 1999, which is *pari materia* to Section 33 of Trade Marks Act 1958. In these judgments, the Courts emphasized that rights established by the application for registration suffice to claim seniority, irrespective of actual use. The rationale here is that registration itself, particularly on a proposed-to-be-used basis, constructs a legal presumption of use from the date of application, thereby anchoring the registrant's prior rights.

107. Since Plaintiff's registrations demonstrably precede the Defendant's use of a similar mark, they are recognized as the senior user under Section 33(b) of the Trade Marks Act 1958. Plaintiff has thus proved that they are the prior user of "TOSHIBA" trademark for goods under classes 07, 09, and

[15] 2011 SCC OnLine Bom 817.
[16] 2019 SCC OnLine Del 7483.

11 within the established legal framework supported by judicial precedents, such as ***Drums Food International*** *(Supra)* and ***Radico Khaitan*** *(Supra)*.

***Finding on issue No. 2***

108. Keeping in view the established jurisprudence of trademark law consistently recognized by the courts in India, the deceptive similarity between the Plaintiff's trademark "TOSHIBA" and Defendant's "TOSIBA" mark, and Plaintiff's established prior use, it is held that Defendant's use of the mark "TOSIBA" amounts to infringement of the Plaintiff's registered trademark.

109. Issue No. 2 is thus decided in favour of the Plaintiff, and against the Defendant.

***Finding on issue No. 8***

110. Given that the Defendant's products sold under "TOSIBA" trademark coincide with the description of goods of Plaintiff's registration No. 160443 in class 11, which has not been rectified till date, the rectification of Plaintiff's registrations No. 273759 and 273760 in classes 09 and 11, respectively has no bearing on the finding of trademark infringement.

111. Consequently, this issue is also answered in favour of the Plaintiff.

**ISSUE NO. 3: WHETHER THE DEFENDANT'S USE OF THE MARK TOSIBA WOULD RESULT IN CONFUSION AND DECEPTION AMOUNTING TO PASSING OFF?**

112. Having established that the two marks are deceptively similar, the Court will now consider whether the Defendant's use of the mark "TOSIBA" results in confusion and deception, potentially amounting to passing off.

113. The conclusions drawn under issue No. 2 regarding the deceptive similarity of the marks are taken as a foundation for this analysis. The Court will thus directly proceed to assess whether the Plaintiff has met the classic trinity test established in the landmark case of ***Reckitt and Colman Products Ltd v. Borden Inc.***,[17] and later adopted by the Supreme Court of India in ***Laxmikant V. Patel v. Chetanbhat Shah and Anr.***[18] for demonstrating passing off. This test comprises of three essential conditions of (*a*) Reputation: the Plaintiff must demonstrate that their trademark "TOSHIBA" has an established reputation and goodwill in the market. This reputation should be significant enough that consumers exclusively associate the mark with Plaintiff's products; (*b*) Misrepresentation: there must be evidence that the Defendant's use of the mark "TOSIBA" has led, or is likely to lead, to a misrepresentation in the market. This misrepresentation occurs when the public believes, or is likely to believe, that goods or services offered under the Defendant's mark are the goods or services of the Plaintiff, or are associated with the Plaintiff; and (*c*) Damage: the Plaintiff needs to show potential or actual damage to their business or goodwill resulting from Defendant's misrepresentation. This damage could be direct, through loss of sales, or indirect, through dilution of the trademark's distinctiveness or reputation.

114. The Court thus undertakes a comprehensive examination of the arguments and evidence presented by parties to discern whether the afore-noted criteria has been fulfilled by the Plaintiff to prove their case of passing

[17] [1990] 1 WLR 491.
[18] (2002) 3 SCC 65.

off by the Defendant.

## I. ***Plaintiff's reputation in India prior to Defendant's adoption***

115. The Plaintiff's "TOSHIBA" trademark was first registered in 1953, but their formal entry in Indian market was much later due to the extant Governmental policies prevailing till 1990-91. Given the significant gap between these dates, the Plaintiff is invoking the concept of 'spilling over of reputation' to assert their trademark rights in India prior to their physical market entry. This claim rests on the premise that "TOSHIBA" had acquired a distinctive identity and significant goodwill globally, which transcended geographical boundaries and became well-known among Indian consumers, despite the lack of direct commercial presence in India until 1991.

116. In India, the doctrine of transborder reputation has been recognised through several judicial pronouncements. Notably, the judgments in ***N.R. Dongre and Ors. v. Whirlpool Corporation and Ors.***,[19] and ***Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Limited and Ors.***,[20] elucidate the criteria for establishing a foreign brand's reputation within Indian borders. The Supreme Court in these cases highlighted that a foreign entity must demonstrate that its trademark had garnered significant recognition and goodwill among the Indian public. In ***Toyota*** (*Supra*), the Supreme Court held that simply establishing a well-known reputation abroad does not automatically translate to trademark protection in India unless there is substantial evidence to show that such reputation has spilled over into the Indian market prior to the disputed use. The Court also emphasized the

[19] (1996) 5 SCC 714.

importance of the trademark being recognized by the relevant public in India at the time the allegedly infringing party began using it. In the said case, Toyota (the Plaintiff therein) had failed to provide adequate proof that the "PRIUS" name/ mark was well-recognized by the Indian public as being associated with them before the Defendant therein started using the name. The evidence of global recognition, without specific evidence of Indian recognition at the time the Indian company began using their mark/name, was found insufficient.

117. Thus, to successfully demonstrate the spilling over of reputation, Plaintiff must provide substantial evidence showcasing that "TOSHIBA" was recognized by Indian consumers as a source-identifier associated with the Plaintiff prior to 1974-75, the date of adoption of the impugned mark. This evidence might include market surveys, media reports, import data of "TOSHIBA" products, advertisements circulated in international magazines available in India, or testimonials demonstrating the brand's presence in the collective consumer consciousness of India.

118. The documentary evidence produced by Plaintiff to establish spilling over of reputation as well as use in India is enlisted below:

i. Trademark License Agreements dated 28th December, 1976 [Ex. PW 2/A/ Mark X-23], 20th February, 1984 [Mark X-25] and 12th June, 1985 [Mark X-29] between Plaintiff and Toshiba Anand Batteries Limited permitting use of trademark "Toshiba"/ "TOSHIBA" for dry batteries manufactured by Toshiba Anand Batteries.

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[20] (2018) 2 SCC 1.

ii. Technical Collaboration Agreement dated 22nd April, 1982 between Plaintiff and Punjab Anand Batteries pertaining to various forms of button-type alkaline dry cells [Mark X-24].

iii. Technical Collaboration Agreements dated 14th March, 1984 between Plaintiff and Jyoti Limited pertaining to vacuum circuit breakers [Mark X-26].

iv. Technical Collaboration Agreement dated 27th March, 1985 between Plaintiff and M.P. Uni-Magna-Tech Limited pertaining to whole body scanners and ultrasound equipment [Mark X-27].

v. Trademark License Agreement dated 12th June, 1985 between Plaintiff and Punjab Anand Batteries Limited permitting use of trademark "Toshiba" for dry batteries manufactured by Punjab Anand Batteries [Mark X-28].

vi. Trademark License Agreement dated 18th February, 1986 between Plaintiff and Toshiba Anand Batteries Limited permitting use of trademark "TOSHIBA" for fluorescent and incandescent lamps manufactured by Toshiba Anand Batteries [Mark X-30].

vii. Trademark License Agreement dated 18th August, 1987 between Plaintiff and Chaudhary International permitting use of trademark "TOSHIBA" for assembly kits [Mark X-31].

viii. Technical Collaboration Agreement dated 06th November, 1987 between Plaintiff and Kirloskar Electric Company Limited concerning production and development of uninterruptible power systems [Mark X-32].

ix. Technical Collaboration Agreement dated 26th June, 1985 between Plaintiff and NGEF Limited concerning production and development of induction rotating machines [Mark X-34].

x. Technical Collaboration Agreement dated 18th December, 1985 [Mark X-35] and 25th June,1986 [Mark X-36] between Plaintiff and Electric Construction and Equipment Co. concerning production and development of resin mold type dry transformers and elevators, respectively.

xi. Technical Collaboration Agreement dated 22nd December, 1988 between Plaintiff and ECE Industries Limited concerning elevators [Mark X-37].

xii. Technical Collaboration Agreement dated 26th June, 1985 between Plaintiff and NGEF Limited concerning production and development of induction rotating machines [Mark X-34].

xiii. Technical Collaboration Agreement dated 09th August, 1986 between Plaintiff and Instrumentation Limited concerning production and development of digital control instruments [Mark X-39].

xiv. Technical Collaboration Agreement for tuners of color television receivers dated 05th September, 1989 between Plaintiff and Videocon International [Mark X-40].

xv. Sale-Purchase Agreement of 06th March, 1985 between Plaintiff and Jupiter Radios for color television receiver [Mark X-41].

xvi. Service Agreement dated 07th February, 1985 between Plaintiff and Sonodyne Television Co., whereunder Sonodyne Television Co. agreed to provide repair and maintenance services for Plaintiff's brand consumer electronic products [Mark X-42].

xvii. License Agreement between Plaintiff and UP Electronics Corporation Ltd. dated 22nd July, 1985 for technical know-how and information pertaining to color TV picture tubes [Mark X-43].

xviii. Service Agreement dated 05th August, 1983 for repair and maintenance of Plaintiff's radios, tape recorders, radio cassette recorders and brand consumer products by Alpha Radios [Mark X-43A and Mark X-43B, respectively].

xix. Photocopies of the 1987, 1988, 1989 and 1990 editions of the Fortune-500 magazine [Mark X-12 to Mark X-15].

xx. Trademark registration certificates of the "TOSHIBA" mark worldwide [Ex. PW 1/7 to PW 1/27].

xxi. List of service centres of Plaintiff established in India [Mark X-44].

xxii. Annual Reports of the Plaintiff-company commencing from the year 1963, allegedly detailing the Plaintiff's business operations in India [Ex. PW 1/47 to PW 1/70].

xxiii. Documents concerning Plaintiff's stall displaying home and office appliances in an exhibition held in Pragati Maidan, New Delhi, India between 14th November, 1987 to 29th November, 1987 [Ex. PW 1/72].

xxiv. Letters issued by Indian consumers raising complaints regarding the Plaintiff's products purchased by them [Mark X-45].

xxv. The English translation of the Plaintiff's 85th Anniversary Report published in 1963, which mentions Toshiba Anand Batteries Limited and Toshiba Anand Lamps as Plaintiff's manufacturing subsidiaries in India [Ex. PW 1/6A].

xxvi. Advertisements published in the Indian Express in November, 1981 for radios produced by the Plaintiff [Ex. PW 1/71].

119. According to the Plaintiff, the afore-noted documentary evidence sufficiently demonstrates the consistent use of trademark "TOSHIBA" in India through collaborations and joint ventures with the Government of India and other licensed entities, even during the time period when there was a restriction on import of electrical goods in India. In addition to these documents, they contended that the Court must take judicial notice of the commercial agreements executed with Governmental authorities under Section 57 of the Indian Evidence Act, 1872. Further, referring to established trademark jurisprudence,[21] they asserted that 'use of a trademark' is not confined to actual sale of goods, and can be sufficiently proved through other commercial undertakings.

120. The Court has considered the evidence on record relating to this issue.

121. First, let us briefly discuss the concept of 'reputation' in trademark law jurisprudence. This term signifies the recognition and goodwill that a trademark holds among consumers. It embodies the association and expectations that consumers have with the mark in relation to specific goods or services provided under it. Notably, the presence of the products in the market is not a prerequisite for establishing a reputation. Rather, it can be demonstrated through consumer recognition, which may be achieved *via* advertising, media presence, or even indirect market interactions that elevate the brand's visibility and distinguishability.

122. Transborder reputation extends this concept beyond the geographic

[21] The Plaintiff placed reliance upon the judgments in ***Jolen Inc v. Doctor and Co.,*** 2002 SCC OnLine Del 518, ***Hardie Trading Ltd. v. Adissons Paint and Chemicals Ltd.***, (2003) 11 SCC 92, ***N.R. Dongre*** (*Supra*), ***Kamal Trading Co., Bombay and Ors. v. Gilette UK Ltd.,*** 1987 SCC OnLine Bom 754, and ***Kiran Jogani and Anr. v. George V. Records, Sarl,*** 2008 SCC OnLine Del 1204.

limits of where the products or services are physically available, acknowledging the global nature of commerce and communication. This principle allows a trademark known primarily in one jurisdiction to be protected in another, provided that the mark enjoys a substantial degree of recognition among consumers in the latter region. This recognition should not merely be among niche groups or specific sectors, but should permeate a significant portion of the relevant public. The acknowledgment of transborder reputation in trademark law underscores the modern reality where brands can achieve widespread reputation through digital media, international travel, and global marketing strategies, even before officially entering a local market.

123. Legal precedents have reinforced that for a successful claim of transborder reputation, the evidence must demonstrate not just the global popularity or acknowledgment of the trademark, but also its specific resonance within the market where protection is sought. The courts assess whether the average consumer in that market is likely to be influenced by the reputation of the mark, potentially leading to confusion or deception due to unauthorized use by others. This judicial approach ensures that trademark protection is realistically aligned with consumer perception and market dynamics, safeguarding both the trademark owner's interests and the consumer's expectations.

124. In the instant case, Plaintiff's witness has unequivocally acknowledged the prevalence of legislative constraints prior to 1991,[22] which impeded the export/ sale of products by foreign companies within

[22] *Refer:* Cross-examination conducted on 01st May, 2009.

India. Thus, the commercial launch of Plaintiff's products in India did not commence until 1991. Although the Plaintiff has attempted to demonstrate reputation of the trademark "TOSHIBA" before the Defendant's adoption in 1974-1975 through various documents, these efforts fall short. A detailed analysis of the afore-mentioned documentary evidence underpinning the Court's conclusion is as follows:

124.1. *Non conformity with Section 65 of the Evidence Act:*

124.1.1. Plaintiff has presented photocopies of the commercial agreements marked as Mark X-24 to Mark X-43B, publications of Fortune-500 magazine between 1987 to 1990 [Mark X-12 to Mark X-15], list of service centres established in India [Mark X-44] and letters received from consumers [Mark X-45]. Given the Plaintiff's failure to produce originals of these documents, in order to take aid of the contents of these documents, they must establish a case for leading secondary evidence in terms of Section 65 of the Evidence Act. This provision delineates the circumstances where secondary evidence as to the existence, condition or contents of a document may be submitted in trial. However, to adopt this course, a party must establish the factual foundation for leading secondary evidence on terms stipulated in Section 65 in their pleadings or evidence. Without such groundwork accounting for the absence of the originals, no party can be permitted to adduce secondary evidence in support of their case. [23]

124.1.2. On a scrutiny of the pleadings and evidence presented by the Plaintiff, the Court is unable to discern the foundational facts explaining

[23] *See:* ***Dhanpat v. Sheo Ram (Deceased) through LRs and Ors.***, (2020) 16 SCC 209, ***H. Siddiqui (Dead) by LRs v. A. Ramalingam,*** 2011) 4 SCC 240 and ***Prem Chandra Jain (Deceased) represented by LRs v. Sri Ram (Deceased) represented by LRs,*** 2009 SCC OnLine Del 3202.

non-availability of the original documents by the Plaintiff. There is no averment to this effect in the plaint or the evidence by way of affidavit of PW-1. Rather, it is only in the cross-examination held on 01st May, 2009 that PW-1 revealed that originals of agreements executed by Plaintiff are retained by them. This failure is critical as the onus to explain the basis for leading secondary evidence is on the party seeking to rely on the said evidence. The relevant segment of PW-1's cross-examination is extracted below:

> "*It is correct that I do not possess any original technical collaboration agreement today. It is correct that I do not have with me today original trademark license agreement. It is correct that when plaintiff company enters into any agreement the original is kept with the plaintiff company. It is correct that the original technical collaboration agreements are kept with the plaintiff company, however, in some cases, due to some shifting some documents may have been lost. (Vol.) All the original documents are not kept at one place and they are kept at different places by the plaintiff company. Same is my reply with regard to original trademark license agreements. It is correct that whenever we open a service centre in India we would execute a document with the Indian partners. It is correct that those original documents are also kept with the plaintiff company. It is correct that today I am not having the originals of those documents. It is correct that today I am not having any original document to show that the plaintiff company was having any service centre in India in the year 1984-85.*"

124.1.3. Plaintiff's explanation for adducing secondary evidence does not meet the threshold set by Section 65 of the Evidence Act, which outlines specific criteria under which secondary evidence can be admitted in lieu of primary evidence. As per the testimony of PW-1, the primary evidence (originals) is still in the possession of the Plaintiff, which negates the necessity of resorting to secondary evidence. The assertion of "*however, in*

*some cases, due to some shifting some documents may have been lost*" is entirely vague and unspecific and therefore, does not constitute a 'loss' or 'destruction' of documents required for the admission of secondary evidence. Such assertions must be substantiated with precise details regarding the circumstances under which the documents were purportedly lost and why they cannot be retrieved, which has not been adequately addressed in the Plaintiff's submissions. The burden is on the Plaintiff to demonstrate not only the existence of a valid reason for the unavailability of the primary documents, but also that due diligence has been exercised to recover them before secondary evidence can be considered admissible. Resultantly, the documentary evidence submitted as Mark X-12 to Mark X-15, Mark X-24 to Mark X-43B, Mark X-44 and Mark X-45 is inadmissible and cannot be considered by this Court.

124.2. *Insufficiency of the documents to establish Plaintiff's transborder reputation:*

124.2.1. Notwithstanding their inadmissibility as evidence, on a thorough review, the Court finds that the numerous commercial agreements presented by Plaintiff are subsequent to Defendant's established date of adoption (1974-1975). Therefore, these agreements are irrelevant to the determination of fact in issue – whether the Plaintiff had a recognizable presence or reputation in the Indian market at that critical juncture. Consequently, these documents fail to establish the Plaintiff's reputation in India during the relevant period when the Defendant adopted the trademark.

124.2.2. Moreover, during his cross-examination, PW-1 acknowledged the lack of precise documentation pinpointing the asserted use of "TOSHIBA" outside Japan starting in 1978. This is evident from the

following excerpts from his deposition:

**On 19th November, 2008:**

> "*We have filed documents to show when the mark "Toshiba" was first used outside the territory of Japan. I cannot exactly point out that document from the record but there certainly is a document which shows that since 1978 the mark "Toshiba" was used outside the territory of Japan. Same is my reply with regard to its first use outside Japan in relation to electric and electronic goods. (Vol. Toshiba manufactures electric and electronic goods only)…It is not in my knowledge as to whether the newspapers in Japanese language placed on record have a circulation in India or not.*"

**On 20th November, 2008:**

> "*Ex Pwl/31 at Pages- 1243 to 1256 is a catalogue meant for circulation in United Kingdom and the other catalogues from page Pages 1257 to 1299 are meant for circulation in Middle East, China, Europe, Russia, Germany, France, Asian Countries, USA and from Page 1303 to 1312 are meant for circulation in USA, and Europe. Ex Pwl/32 at Pages 1313 to 1407 were meant to be circulated in Australia, USA, Canada, Arabian countries and Japan. Ex. Pwl/33 at Pages 1408 to 1480 were meant to be circulated in Europe, Canada, Arabian countries, USA, and China However, as regards Page 1479 it pertains to some Asian country probably Malaysia or Indonesia other than China. In Ex Pwl/34 pages 1734 to 1806 are documents meant for English speaking countries.*"

124.2.3. This lack of clear evidence undermines the claim that the trademark was internationally recognized early enough to influence the Indian market by 1974-75, when the Defendant claims to have started using "TOSIBA." PW-1's admissions in his deposition regarding the lack of circulation of Japanese newspapers and other journals in India further illustrate a critical gap in proving that these publications had any substantial reach or influence within India. This point is crucial because even if "TOSHIBA" was well-known globally by 1987-1990, as suggested by Fortune-500 Magazine, there is no evidence to suggest that this recognition

extended to India during the relevant period.

124.2.4. The cross-examination on 01st May 2009 highlighted regulatory barriers that prevented Plaintiff from exporting their products to India until 1991. This directly contradicts the possibility of establishing a market presence or reputation through regular business channels prior to that year. PW-1 also admitted the absence of Plaintiff's service centres in India during the mid-1980s, further weakening claims of any significant brand interaction with Indian consumers in 1975, when the Defendant adopted the trademark. Furthermore, the Plaintiff has failed to provide concrete sales figures or marketing evidence from before 1990-91. This suggests that Plaintiff did not actively engage with the Indian market or establish a reputation under the "TOSHIBA" trademark until after the Defendant had already been using "TOSIBA."

124.2.5. The Plaintiff's claim of a transborder reputation based on consumer interactions with their products during foreign travels, and the availability of these products in duty-free shops is inadequately supported by documentary or oral evidence. While the letters submitted in evidence as Mark X-46 predominantly pertain to purchases that occurred in the 1980s, one letter dated 12th May, 1989 pertains to transaction of 1970. For ready reference, the said consumer account is extracted below:

> *"Dear Sir,*
>
> *I purchased a Toshiba 17 television in the year 1970 and since then it was giving me a very good reception without any trouble for which I must thank you.*
>
> *From the last 2 to 3 months, it has started giving some trouble with the result I have to contact the local engineers for its repairs.*
>
> *For its repairs the local engineer have requested me to provide the catalogue indicating the circuit details as well as tube No. 21JZ6.*

*For the above tube I have trid my best to procure it locally as well as from Delhi but regret to say that I am not successful in getting the same.*

*I shall be highly grateful to you if you kindly send me one number of the above tube on FREE OF CHARGE BASIS as GIFT so as to enable me to get my TV set repaired.*

*In the event, if it is not possible for you to send me the tube on FUC basis as gift, kindly advise me the formalities I have to do in getting the same.*

*In the last I may add here that my kinds are pressing me very hard for getting the TV set repaired at the earliest but I am unable to get the same repaired without the circuit details and tube No. 6GH8. As such, would request you once again to be kind enough to sand ma the above on FOC basis at the earliest.*

*Thanking you in anticipation and awaiting your early favourable reply.*

*Yours very sincerely,*

*Sd/-*
*L.R. Mendiratta"*

124.2.6. The reliance on the afore-noted letter forming a part of Mark X-46, which details a single instance of an Indian customer purchasing a television in 1970, is insufficient to prove the reputation of the Plaintiff in India to the extent that the consumers solely associated the mark "TOSHIBA" with the Plaintiff. It must be noted that the suit is at the final stage, where the Court requires concrete and comprehensive evidence to rule on the reputation of Plaintiff's trademark. Unfortunately, the Plaintiff has not met this high evidentiary standard.

124.2.7. The Annual Reports marked as Ex. PW 1/47 to PW 1/70 also fail to substantiate a significant presence or reputation of the "TOSHIBA" brand in the Indian market at the requisite time. These Reports primarily detail the establishment of "TOSHIBA" offices in India and a collaboration with Toshiba Anand Batteries Limited, which alone are insufficient to establish a market reputation of "TOSHIBA" as of the date the Defendant adopted the "TOSIBA" mark. These Reports, though documenting the

Plaintiff's international activities, do not specifically prove reputation in India in the electrical goods sector, relevant to this case. They primarily demonstrate the Plaintiff's operational presence through offices and dealings with the Indian Government concerning unspecified products, rather than establishing a solid reputation in the specific market of electrical goods.

125. *Conclusion:* In ***Toyota*** *(Supra)*, the Supreme Court of India held that to support a passing off action, entities asserting transborder reputation must produce substantial evidence of recognition within the Indian market, specifically at the time the allegedly infringing activity commenced. Plaintiff's failure to provide such evidence, as seen through the lack of documented sales, marketing activities, or consumer recognition in India prior to the Defendant's first use of "TOSIBA," is similar to the ***Toyota*** *(Supra)* case. The Plaintiff has not discharged the burden of proving transborder reputation in India by 1975.

126. The Plaintiff's documentary and oral evidence does not adequately demonstrate that the "TOSHIBA" trademark had a significant reputation that spilled over into Indian territory by the time the Defendant adopted the deceptively similar mark "TOSIBA." Without essential proof, the assertions made by the Plaintiff are untenable.

***Finding***

127. Lacking proof of their transborder reputation in India, the Plaintiff fails to meet the first crucial criterion for a passing off action – establishing a reputation of the trademark in the local market. Therefore, the Court concludes that Plaintiff's claim for passing off is not proved due to lack of evidence.

128. Accordingly, this is issue is answered in the negative and in favour of the Defendant.

**ISSUE NO. 5: WHETHER THE SUIT SUFFERS FROM DELAY, LACHES AND ACQUIESCENCE?**

129. The burden of proving delay, laches, or acquiescence lies with the Defendant, who must demonstrate that the Plaintiff unreasonably postponed initiating legal proceedings. The Defendant alleged that the Plaintiff was aware of the "TOSIBA" mark as early as 1984, based on their appearance in telephone directories alongside Toshiba Anand Batteries [Ex. DW1/91 to Ex. DW 1/93]. This, according to the Defendant, indicates a deliberate delay by the Plaintiff in filing the suit in 1990, suggesting gross negligence in enforcing their trademark rights. Contrarily, the Plaintiff contended that the suit was filed promptly in 1990, following the discovery of the Defendant's use of "TOSIBA" in February 1989, when the Plaintiff was alerted by Mitsubishi Shoji Corporation about the Defendant's advertisement. This triggered the Plaintiff to issue a cease-and-desist notice on 24th April, 1989 [Ex.PW1/1], evidencing an attempt to resolve the matter amicably without resorting to litigation. The lack of a reasonable settlement from the Defendant and subsequent service of caveats by the Defendant compelled the Plaintiff to initiate legal action at the earliest opportunity thereafter, negating any allegations of undue delay.

130. The Court notes that evidence, such as the communications within the company strategizing their next course of action *qua* Defendant's use of "TOSIBA," detailed in Mark X-46A, and the timing of the cease-and-desist notice, substantiates the Plaintiff's claim of gaining knowledge of the

Defendant's infringing activities just before taking legal action. The documents marked as X-46A have not been controverted by the Defendant, either through evidence or cross-examination of PW-1, that would invalidate Plaintiff's assertions. The Defendant's reliance on telephone directories does not conclusively prove that the Plaintiff was aware of the infringement earlier, as mere listing in a directory alongside the name of Plaintiff's business affiliate does not guarantee that the Plaintiff observed or recognized the potential infringement at that time.

131. Nonetheless, the Defendant has pointed to a short delay on Plaintiff's end, which does not undermine the Plaintiff's right to seek a permanent injunction for trademark infringement. It is crucial to recognize that the suit is not at interim, but at final stage of adjudication. Here, the short delay pointed out by the Defendant does not defeat the Plaintiff's action for a permanent injunction for infringement of a statutory right. Legal precedents have established that a mere delay, absent a significant impact on the Defendant's ability to defend itself or change in circumstances that would render the enforcement of rights unjust, does not bar the legal relief sought at the final stages of litigation. The legal precedents set in ***Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia and Ors.***,[24] and ***Hindustan Pencils Private Limited v. M/s. India Stationary Products and Co.***,[25] clearly support that mere delay does not amount to acquiescence, unless accompanied by an act that indicates acceptance or encouragement of the infringing activities. Thus, the delay, as highlighted by the Defendant, has

[24] (2004) 3 SCC 90.
[25] 1989 SCC OnLine Del 34.

no bearing on the final outcome of this case. Moreover, delay or laches, in this context, do not extinguish the statutory rights provided under trademark law unless it can be shown that the Plaintiff's inaction altered the Defendant's position to their detriment, which has not been demonstrated here.

132. Acquiescence in legal terms refers to a situation where a party knowingly stands by, without raising any objection during the infringement of their rights, particularly when such inaction leads the infringing party to believe that the conduct is acceptable and can continue without opposition. Plaintiff's actions of diligent enforcement of rights, demonstrated by issuance of a cease-and-desist notice immediately upon gaining knowledge of the infringing activities, and engaging in opposition and rectification proceedings against all infringing applications or registrations by the Defendant, clearly shows active resistance rather than acquiescence. In this case, the Defendant has not provided sufficient evidence to demonstrate any positive act of encouragement by the Plaintiff that could be construed as acquiescence. Without such evidence, the defence of acquiescence cannot prevail. The Defendant has failed to show any positive act of encouragement by the Plaintiff that would constitute acquiescence.

***Finding***

133. In conclusion, the Defendant has not satisfactorily demonstrated that the Plaintiff delayed action or acquiesced to the use of the impugned "TOSIBA" mark. Therefore, the defence of laches and acquiescence does not hold, and the Plaintiff remains entitled to enforce its trademark rights through this suit.

134. The issue is therefore decided in favour of the Plaintiff, and against the Defendant.

**ISSUE NO. 7: WHETHER THE SUIT IS LIKELY TO BE DISMISSED ON ACCOUNT OF FALSE STATEMENT AND CONCEALMENT OF FACTS?**

135. The burden to demonstrate that the Plaintiff has made any false statements or concealed relevant facts rests squarely upon the Defendant. This requires proving that the Plaintiff's disclosures in the present proceedings were not only inaccurate, but intentionally misleading. The Defendant has not met this burden. They have failed to present any substantive evidence or compelling oral arguments to substantiate the claim of false statements or concealment. The absence of concrete evidence or detailed argumentation from the Defendant's side highlights the lack of foundation for their allegations. This failure to meet the evidentiary standard required to prove such serious accusations effectively nullifies this line of defence. In view of the above, the allegations of false statements and concealment by the Plaintiff are unfounded and frivolous.

***Finding***

136. In light of the Defendant's inability to provide sufficient proof to support their claims, the Court remains unconvinced of concealment or false statements on Plaintiff's behalf. Thus, issue No. 7 is answered in favour of the Plaintiff, and against the Defendant.

**RELIEF**

137. In view of the foregoing discussion, a decree for permanent injunction is issued in favour of the Plaintiff and against the Defendant, restraining the

Defendant, or anybody acting on their behalf, from manufacturing, selling, offering for sale, advertising, or directly or indirectly dealing in electrical goods, including electric irons, immersion rods, toasters, table lamps, ovens and stoves bearing the trademark "TOSIBA" or any other mark deceptively similar to the Plaintiff's trademark "TOSHIBA" that would amount to infringement of Plaintiff's registered trademark No. 160443. Further, the Defendant is also restrained from using "TOSIBA" as part of their trade name or adopt any trade name which is deceptively similar to the Plaintiff's trademark "TOSHIBA".

138. In the instant lawsuit, the Plaintiff expressly sought a decree for an account of profits. However, post-trial, they have altered their claim and opted for award of damages quantified at Rs. 25,00,000/-. To substantiate their assessment, the Plaintiff referred to the judgments in ***Inter Ikea Systems BV and Anr. v. Sham Murari and Ors.,***[26] ***Puma SE v. Ashok Kumar,***[27] ***Koninlijke Philips NV and Anr. v. Amazestore and Ors.,***[28] and ***Meters Ltd. v. Metropolitan Gas Meters Ltd.***[29] The Court's decision on awarding damages must be predicated on a substantive examination of evidence that justifies the quantum of such compensation. The burden of proving damages rests unequivocally with the Plaintiff. To succeed, the Plaintiff must present compelling evidence substantiating the claimed damages resulting from the Defendant's alleged infringement. They must provide a reasonable estimate of the amount claimed, foundational facts, account statements, and supporting documentary and/or oral evidence. This

[26] 2018 SCC OnLine Del 11221.
[27] DHC Neutral Citation No.: 2023:DHC:7696.
[28] DHC Neutral Citation No.: 2019:DHC:2185.

entails establishing a direct link between the Defendant's actions and the claimed damages and quantifying these damages in a manner acceptable in law. They must demonstrate how the claimed figure was reached and the methodology employed, which must withstand the Court's scrutiny. Speculative or hypothetical assertions cannot form the basis for a substantial damages award.

139. The Plaintiff's late introduction of a claim for damages totalling Rs. 25,00,000/- along with punitive damages is premised on speculative assumptions rather than tangible evidence. This claim is derived from an extrapolation of the Defendant's sales data, specifically using sales bills, invoices for "TOSIBA" products, and a Chartered Accountant's certification of the Defendant's annual sales. The Plaintiff estimates the Defendant's profits from the sale of allegedly infringing products by assuming a profit margin of 10%. Such an approach to assessing damages post-trial, without evidence or proof and opportunity to the Defendant to controvert cannot be accepted. Pertinently, the parties conducted a trial on an entirely different premise and the Defendant was not confronted with this claim any time prior to filing of the written submissions. In absence of direct, tangible evidence linking the Defendant's actions to quantifiable losses incurred by the Plaintiff, this method of calculation remains conjectural and insufficient to form the basis for a credible claim for damages. Thus, due to lack of evidence put forth by the parties during the trial, the Court is not inclined to award damages as claimed. In the precedents cited by Plaintiff, persuasive material elaborating the foundation of the claimed amount of damages, such

[29] (1911) 28 RPC 157 (CA).

as the product-wise price chart, detailed account of profit earned on each sale and seizures made by a Local Commissioner, was presented to the Court. Contrastingly, in the case at hand, the Plaintiff's claim is entirely dependent on the evidence of sale of "TOSIBA" products of the Defendant, without any breakdown of amounts purportedly due to the Plaintiff. Plaintiff's claim of intangible losses manifested in the form of loss of consumer confidence and trust also fails to persuade the Court, given the Plaintiff's inability to establish their reputation in India at the relevant juncture.

140. Nonetheless, the Court is empowered to award nominal damages to the aggrieved party who is able to establish that they have suffered an injury caused by the wrongful conduct of a wrongdoer but cannot offer proof of a loss that can be compensated. This is particularly necessary when the infringement of rights is clear, as in the present case, where the Defendant has used a deceptively similar mark. The rationale behind this is to affirm the rights of the trademark holder and recognize the wrongdoing, albeit the actual damage might not be quantifiable due to the Plaintiff's lack of express evidence. Given the protracted duration of this lawsuit – spanning three decades – and the continuous use of the infringing mark by the Defendant throughout this period, it is both reasonable and just for the Court to award nominal damages. Therefore, in recognition of these factors and in line with judicial precedents that support the award of nominal damages in cases of clear infringement but insufficient proof of actual damage,[30] the Court finds

[30] *See*: ***Gujarat Ginning and Manufacturing Co. Ltd. v. Swadeshi Mills Co. Ltd.,*** 1938 SCC OnLine Bom 94.

it appropriate to award nominal damages of Rs. 15,00,000/-. This amount is intended not as a measure of actual loss suffered, but as a minimal compensatory amount reflecting the infringement's duration and the need to uphold trademark rights.

141. Additionally, the Plaintiff is entitled to actual costs recoverable from the Defendant in terms of the Commercial Courts Act, 2015. Plaintiff shall file their bill of costs on or before 16th September, 2024. As and when the same is filed, the matter will be listed before the Taxing Officer for computation of costs.

142. The suit is decreed in the above terms.

143. Decree sheet be drawn up.

144. The suit and pending application are disposed of.

**SANJEEV NARULA, J**

**AUGUST 16, 2024**
*nk*