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

Reserved on: 08.11.2016

%   **Decided on: 17.07.2017**

+   **<u>CS(OS) 2247/2015</u>**

MEX SWITCHGEARS PVT. LTD   ..... Plaintiff

Through: Mr. Shailen Bhatia, Mr. Amit Jain, Ms. Ekta Nayyar Saini and Ms. Jubli Momalia and Mr. Neeraj Mishra, Advocates.

versus

OMEX CABLES INDUSTRIES & ANR.   ..... Defendants

Through: Mr. Umesh Mishra, Advocate.

CORAM:
HON'BLE MS. JUSTICE DEEPA SHARMA

JUDGMENT

I.A 15312/2015 (by plaintiff under Order XXXIX Rules 1 & 2 CPC read with Section 151 CPC)

1. The present suit has been filed by the plaintiff for permanent injunction restraining the defendants from infringing its trademark, corporate name, copyright, passing off and has also claimed damages etc.

2. The case of the plaintiff in brief is that it is the registered owner of the trademark MEX which it is using for electric switchgears, switches, ignition switches, electric capacitators, electric meters, starting devices for electric

motors etc and various other electrical goods. The Plaintiff is also using the trade mark MEX on CFL bulbs, kitkats, fuses, wires and cables and many other cognate and allied goods and the said mark is being used by its predecessor since the year 1960 continuously, extensively and exclusively.

3. It has been stated by the plaintiff that the word MEX is an integral part of the corporate name of the plaintiff which was incorporated in the year 1979. The registered trademark is owned by the plaintiff company M/s Mex Switchgears Pvt. Ltd. on its incorporation and the word MEX is also used in the corporate name of the company. The said trademark is registered under Classes 7, 9 and Class 11 for various goods. Besides this, the plaintiff is also the owner of various registered trademarks wherein the word MEX has been used and thus plaintiff is the owner of the word MEX which is distinctive and identified exclusively with the goods of the plaintiff. The plaintiff produces high quality of products and enjoys the enviable reputation and the public associates the trademark MEX with the plaintiff and none else. Any goods bearing the trademark MEX or a similar trademark causes an impression that the same belongs to the plaintiff. The plaintiff had good market and it has also shown in para 12 of its plaint, the

sale figures for the various years and it has also given the details of the expenses spend on the advertisement of its product in para 13 of the plaint.

4. It is submitted that the products of the plaintiff are tested and approved by various Government Departments. The plaintiff had also filed several oppositions from time to time whenever any deceptively similar trademark was advertised and has also won those proceedings. It had opposed an application for registration of trademark MAX in Class 9 in respect of similar goods.

5. The plaintiff had preferred a similar suit against one Mr. Gopal Krishan who was using the trademark MAX Standard as well as the corporate name MAX STANDARD SWITCHCGEARS PVT. LTD. in which an injunction was granted in its favour restraining the defendant from using the trademark MAX (TNR 14). However, later the suit was compromised and permanent injunction order was passed in favour of the plaintiff. The plaintiff had also filed one case against one M/s Max Switchgears Pvt. Ltd. before this Court and in that case also an order was passed in favour of the plaintiff whereby the defendants were restrained from using the trademark MAX.

6. It is further submitted that the defendant no. 1 i.e. M/s Omex Cables Industries has adopted the trade name with the word "OMEX" which is identical to that of plaintiff's trade mark MEX. The defendant no. 2 is the authorised dealer of the defendant no. 1. The trademark OMEX GOLD was advertised in Trade Marks Journal No. 1338-1 under Application No. 1251498 and the plaintiff has filed its opposition and the same is pending under No.DEL-228156.

7. The case of the plaintiff is that the use of the expression OMEX either as a trade mark or a trade name by the defendant no. 1 is bound to cause confusion and deception amongst the purchasing public and the public would be misled into thinking that the defendant's goods bearing the word OMEX originated from the plaintiff. It is submitted that it is identical/deceptively similar to the registered trademark of the plaintiff i.e. MEX. It is also submitted that the defendant's trade mark OMEX is visually, phonetically as well as structurally similar to the well known trademark MEX of the plaintiff. It is also submitted that the addition of the word GOLD as a suffix makes no difference. It is stated that the trade mark and the trade name has been adopted by the defendant no. 1 with a dishonest motive. The use of trade mark OMEX therefore is an infringement and

passing off of the plaintiff's trademark. On these facts, it is submitted that plaintiff has a good *prima facie* case in its favour and the balance of convenience also lies in its favour and it shall suffer an irreparable loss and injury if the stay is not granted to it and it is prayed that by way of *ad interim* injunction, the defendants be restrained from using the said trade mark OMEX.

8. The application under Order 39 Rule 1 & 2 of CPC is contested by the defendants. While all the contents of the application are denied as incorrect, it is submitted that defendant no. 1 is using the trade mark OMEXGOLD since the year 1995 and defendant no. 2 is dealer/ distributor of the defendant no.1. It is submitted that the plaintiff was very well aware of this fact but still it has concealed this fact from the knowledge of this Court and thus it has not come to the Court with the clean hands and the application is liable to be dismissed on this ground alone.

9. It is submitted that the trademark used by the defendants i.e. OMEXGOLD has no resemblance either visually, phonetically or structurally with the trade mark of the plaintiff. Also the trade name of the defendant no. 1 has no resemblance with the trade name of the plaintiff. It is submitted that defendant no. 1 is using the trade mark legally, honestly and

bonafidely and had no intention to deceive the public into believing that they were buying the goods of the plaintiff. It is also submitted that the other people are also using the word MEX as trademark with prefix or suffix in relation to their business in class 9 of the Trade Mark Act and has submitted the details of such users as mentioned in para 6 of its written statement. It is submitted that MEX is a common word and cannot be said to have been coined by the plaintiff, and therefore, cannot be exclusively associated with the plaintiff's trade mark. The suit as well as the application is also liable to be dismissed on the ground of delay and laches. The plaintiff was very well aware of the use of trade mark OMEXGOLD by the defendant no. 1 since the year 1995 and it had also opposed the application of the defendant no. 1 for registration of the trade mark of the defendant in the year 2006, yet it had chosen not to approach the Court and thus it he has accepted the use of OMEXGOLD by defendant no. 1.

10. It is further submitted that defendant's products bearing trade mark OMEXGOLD had acquired goodwill and reputation amongst customers on account of its quality. The defendant no. 1 has also filed the defects of its yearly turnover in para 8 of the written statement. On these facts, it is submitted that the plaintiff has no *prima facie* case in its favour and not

entitled for any interim injunction and the application is liable to be dismissed.

11. It is argued by learned counsel for the plaintiff that the plaintiff is the owner of the registered trade mark and plaintiff's logo is MEX which is evident at the registration certificate placed at page 41 along with the list of the documents. It is also argued that the said registration is with regard to class 9 of the products. The trade mark description of defendants which is at page 232 is clearly deceptively similar with that of the plaintiff. It is further argued that MEX and OMEX phonetically sound similar and it is likely to deceive the general public. Learned counsel for the plaintiff has relied on the findings in the case of ***IZUK Chemical Works vs. Babu Ram Dharam Prakash,* 2007 (35) PTC 28 (Del)** and it is argued that the test in judging the probability of deception rests on the average purchaser buying with ordinary caution. The Court in *Izuk Chemical Works (supra)* had relied on ***Thomas Bear and Sons (India) Ltd. vs. Pravag Narain,* AIR 1935 Allahabad 7** in para 14 of the judgement and learned counsel for the plaintiff has laid emphasis on the said paragraph. The relevant paragraph is reproduced as under:-

> "*14. It is equally well settled that what has to be seen is not that there is not a possibility of confusion but that the resemblance is*

such that there is a reasonable probability of deception. So far as the judgment on this test is concerned, in AIR 1943 Lahore 196 Modi Sugar Mills Limited v. Tata Oil Mills Ltd., the Privy Council approving the test laid down by Niamat Ullah J. in Thomas Bear and Sons (India) Ltd. v. Pravag Narain observed that "in the judging of the probability of deception, the test is not whether the ignorant the thoughtless, or the incautious purchaser is likely to be misled, but we have to consider the average purchaser buying with ordinary caution."

12. Learned counsel for the plaintiff has also relied on the findings in para 15 of the *Izuk Chemical Works (supra),* wherein this Court has relied on the findings in the case of ***Atlas Cycle Industries Ltd. vs. Hind Cycles Limited, ILR 1973 1 Delhi 393***. The relevant paragraph is reproduced hereunder:-

"15. The principle in this behalf was further elucidated by the Division Bench of this Court in the Atlas Cycle Industries case (supra). Placing reliance on James Chadwick and Bros. Ltd. v. The National Sewing Thread Co. Ltd. , Chagla CJ and Bhagwati; referring to the words "likely to deceive or cause confusion" in Section 10 of the Trade Marks Act, 1940, observed at page 152 as follows:

Now in deciding whether a particular trade mark is likely to deceive or cause confusion, it is not sufficient merely to compare it with the trade mark which is already registered and whose proprietor is offering opposition to the registration of the former trade mark. What is important is to find out what is the distinguishing or essential feature of the trade mark already registered and what is the main feature of the main idea underlying that trade mark, and if it is found that the trade mark whose registration is sought contains the same distinguishing or essential feature or conveys the same idea, then ordinarily the Registrar would be right if he came to the conclusion that the trade mark should not be registered. The real question is as to

how a purchaser who must be looked upon as an average man of ordinary intelligence, would react to a particular trademark, what association he would form by looking at the trademark, and in what respect he would connect the trade mark with the goods which he would be purchasing. It is impossible to accept that a man looking at a trade mark would take in every single feature of the trademark. The question would be, what would he normally retain in his mind after looking at the trade mark? What would be the salient feature of the trade mark which in future would lead him to associate the particular goods with that trademark.

The court had thereafter culled out the principles which would apply as hereunder:

In an action for an alleged infringement of a registered trade mark, it has first to be seen whether the impugned mark of the defendant is identical with the registered mark of the plaintiff. If the mark is found to be identical, no further question arises, and it has to be held that there was infringement. If the mark of the defendant is not identical, it has to be seen whether the mark of the defendant is deceptively similar in the sense that it is likely to deceive or cause confusion in relation to goods in respect of which the plaintiff got his mark registered. For that purpose, the two marks have to be compared, "not by placing them side by side, but by asking itself whether having due regard to relevant surrounding circumstances, the defendant's mark as used is similar to the plaintiff's mark as it would be remembered by persons possessed of an average memory with its usual imperfections", and it has then to be determined whether the defendant's mark is likely to deceive or cause confusion. for such determination, the distinguishing or essential features (and not every detail) of the two marks and the main idea, if any, underlying the two marks which a purchaser of average intelligence and imperfect memory would retain in his mind after seeing the marks, have to be noticed. It has then to be seen whether they are broadly the same or there is an overall similarity or resemblance, and whether the resemblance or similarity is such that there is a reasonable probability of deception or confusion. In doing so, the approach has to be from

the point of view of purchaser of average intelligence and imperfect memory or recollection, and not an ignorant, thoughtless and incautious purchaser. In an action for passing off, the test for deceptive similarity, i.e. as to the likelihood of confusion or deception arising from similarity of the marks of the get up, packing etc. is practically the same as in an action for infringement (vide Edwards v. Dennis (1885) 30 Ch.D 454 471(9) Lambert and Butler Ltd. v. Goodbody (1902) 19 R.P.C. 377, 383(10) Addley Bourne v. Swan and Edgar Ltd; (1903) R.P.C.105, 117(11) and Tavener Rut Ledge Ltd. v. Specters Ltd. (1959) R.P.C. 355, 360(12), except that it has also to be seen whether the defendant's mark or the get up, packing, etc. of his goods has besides the essential features of the plaintiff's mark or goods, any additional features which distinguish it from the plaintiff mark or goods, and whether it is likely of reasonably probable that the defendant can pass off his goods as those of the plaintiff to a purchaser of average intelligence and imperfect memory or recollection."

13. It is further argued that in *Izuk Chemical Works (supra)* case, the Court took note of the Madras High Court Judgment in ***Devi Pesticides Pvt. Ltd vs. Shiv Agro, 2006 (32) PTC 434 (Madras) (DB)***, wherein the Court held that BOOM being the essential part of the registered trademark of the plaintiff, was incorporated in defendant's trademark SUPERBOOM which was an unregistered mark. The Court noticed that there was a phonetic similarity as well. Para 18 of the said judgment on which the plaintiff has placed reliance is reproduced as under:-

"18. In a Division Bench pronouncement of the Madras High Court reported at 2006 (32) PTC 434 (Madras) (DB) Devi Pesticides Pvt. Ltd. v. Shiv Agro Chemicals Industries, claiming exclusive proprietorship over the trademark BOOMPLUS and

BOOM FLOWER, an injunction was prayed for by the plaintiff against the defendant who was selling its goods by use of the trademark SUPERBOOM. The defendant's trademark SUPERBOOM was an unregistered mark. It was also noticed that phonetic similarity would constitute trademark infringement and that the users of the products of the parties being illiterate farmers and the common man, it was held that an ordinary average person would not be able to make out the difference between the plaintiff's goods and the defendant's goods. Placing reliance on Section 29(5) of the Trademark Act, it was held that the statutory provisions make it clear that even if a part of the registered trademark is used by the defendant, it would amount to infringement. In this case, BOOM was an essential part of the registered trademark of the plaintiff which was incorporated in the defendant's trademark."'

14. It is submitted that the Courts have always protected the rights of a trader who claims proprietary rights over numeral trademarks. This Court in *Izuk Chemical Works (supra)* case, has taken note of its earlier judgment in the case of ***Shaw,Wallace and Co. Ltd. and Anr. vs. Superior Industries Ltd, 2003 (27) PTC 63 (Delhi*** and held in paragraph 19 of the said judgment that defendant's trademark 'HAYWARDS 5000' was an illegal infringement of the registered trademark of the plaintiff i.e. 'HAYWARDS 5000 SUPER STRONG BEER' on the ground that numeral 5000 was used by the defendant with the intention of cashing in on the reputation of the plaintiff acquired in the business which it was conducting under its registered trademark of which 5000, was an essential part. It is submitted

that in the said case, the Court has clearly held that the test for determining whether the mark is similar or not, it is the imperfect memory of an average consumer which is important. The Court had laid emphasis that while assessing whether the trade mark is deceptively similar or not, it would be remembered by persons possessed of an average memory with its usual, imperfection. It is further argued that the Courts are not required to compare both the trademarks by putting them together but has to judge it from the impression it leaves on the minds of the general public who go to the market to buy the goods. If the Court finds that the defendant has used a trademark with an intention to create an impression in the mind of the public that they were buying the product of the plaintiff while actually what was sold to them was the product of the defendant. It is argued that the use of the word MEX by the defendants in the trade mark OMEXGOLD has been done with the said intention alone and it is likely to deceive the public. It is submitted that in *Izuk Chemical Works (supra)* also, after applying the principles, it was held that the use of the trademark SUPERSTAR by the defendant was likely to create confusion and deception in the mind of the public as both the parties were trading the same goods and what amounts to an infringement of

the registered trademark MOONSTAR of the plaintiff as the Court found that the STAR is an integral part of the trademark of the plaintiff.

15. Learned counsel for the plaintiff has also relied on the order dated 25.02.2014 of this Court passed in its favour against the defendant M/s Max Switchgears Pvt. Ltd in a separate suit filed by plaintiffs against M/s Max in order to show that the plaintiff is vigilant in taking step whenever there was violation of its trademark. It is also argued that the plaintiff had contested various applications for registration of trademarks which are similar to that of plaintiff's and thus it has never concise any detailed action against the defendants as well. As soon as it is learnt that the defendant no. 1 has applied for registration of the trademark, it opposed the said application and the opposition is still pending. It was further argued that where there is likelihood of deception with an existing trademark and there is a striking phonetic resemblance between the distinctive words of an existing trade mark and the proposed trademark, the proposed trademark cannot be registered. It is argued in the case of ***K.R. Chinna Krishna Chettiar, vs. Sri. Ambal & Co,* AIR 1970 SC 146** wherein the dispute was whether the expression 'Sri Ambal' is phonetically similar to the word 'Sri Andal' and

the Court found that the expression 'Andal' and 'Ambal' are deceptively and phonetically similar and the registration of 'Andal' was refused.

16. The plaintiff has also relied on the findings of Bombay High Court in the case ***Encore Electronics Ltd. vs Anchor Electronics and Electricals Pvt. Ltd,*** ***2007 (35) PTC 714 (Bom.)*** wherein the Court had judged whether there was phonetic similarity between 'Encore' and 'Anchor' and the Court had concluded that both were phonetically similar and granted injunction in favour of the respondent. It is further argued that this Court in the case of ***Pankaj Goel vs. Dabur India Ltd,*** ***2008 (38) PTC 49 (Del.) (DB)*** also found that due to the phonetic similarity between the plaintiff's mark HAJMOLA and defendant's mark RASMOLA, the general public is likely to be deceived into thinking that the product RASMOLA which they were buying actually belonged to the plaintiff since MOLA had the distinctiveness in the trademark HAJMOLA. On these facts, it is submitted that since the plaintiff is the user of the trademark since long and there is nothing on record to show that the defendants are using its mark OMEX since 1995 and since the word MEX has distinctive characteristics to the trademark of the plaintiff, the adoption of the mark OMEXGOLD by the defendants are likely to

deceive the public and has been done with the intention to pass off its goods as that of the plaintiff.

17. It is further argued that the suit of the plaintiff does not suffer with any delay or laches or acquiescence since the plaintiff has clearly stated that defendants were not in market till recently. It is further submitted that, even otherwise, passing off is the recurring cause of action and has relied on the findings of this Court in the case of *Pankaj Goel (supra),* wherein this Court has held as under:-

> *"24. In the present case we also do not find that Respondent/Plaintiff's suit is either barred by delay or laches or acquiescence. In fact, from the documents on record, specially at pages 217, 352 and 361 in Paper Book, we find that the Appellant's sales under the mark RASMOLA till the year 2004 were rather insignificant. Even in the cause of action paragraph the Respondent/Plaintiff has averred that though it had filed a notice of opposition dated 25th July, 2007, yet it did not find the Appellant's goods in the market till the first week of December 2007. Consequently, at this stage we cannot draw the inference that the present suit is barred by delay or laches. In any event, passing off is a recurring cause of action and delay being a defence in equity would not be available if the Defendant's conduct is fraudulent - as is in the present case. Consequently in the present facts, delay and so called concurrent use, if any, cannot be a ground for refusing interim injunction."*

18. On the other hand, learned counsel for the defendants has argued that the plaintiff had the knowledge that defendants are using the trademark OMEXGOLD in 2006 when it filed its opposition to the registration of

trademark of OMEXGOLD of the defendants. It is argued that the stand of the plaintiff that it came to know only in 2015 that the defendants were using the mark OMEXGOLD, is therefore wrong.

19. It is argued that simply because one word which is of common nature has been used in the mark OMEXGOLD, does not make it phonetically similar to that of MEX. It is submitted that in the case of ***Kewal Krishan Kumar vs. Kaushal Roller Flour Mills Pvt. Ltd,*** ***PTC (Suppl) (1) 217 (Del),*** this Court has clearly held that the two marks 'SHAKTI BHOG' and 'MAHA SHAKTI BRAND', both have a common word SHAKTI but they do not sound to be similar when the two words are separately pronounced. The emphasis is placed on para 14 which is reproduced as under:-

> *"(14) I have given my analytical consideration to the submissions made by the counsel for the parties. The certificate of registration in respect of the articles in question having trade mark "SHAKTI BHOG" has not been produced by the plaintiff. The question that arises for my consideration is whether the words 'MAHA SHAKTI' and 'SHAKTI BHOG'canbe said to be descriptive and common in the business parlance and/or whether these two words are phonetically similar to each other. The words 'MAHA SHAKTI' and 'SHAKTI BHOG' although have a common word 'SHAKTI' but they do not sound to be similar when the two words are separately pronounced. The average or ordinary purchaser would be able to know the difference between the two when he goes to the market to buy the said product. It cannot be said that the said two words have a striking phonetic similarity so as to cause close resemblance to the ear. From the*

visual point of view also as shown to me by the learned counsel for the defendants during the course of arguments to two trade marks as used by them in their respective goods appear to-be also visually dissimilar and therefore, the decision of the Supreme Court relied upon by the learned counsel for the plaintiff in K.R. Chinna Krishna Chettiar Vs. Sri Ambal & Co. & another, ; Ruston & Hornby Ltd. Vs. Zamindara Engineering Co., ; K.R.Chinnikrishna Chetty Vs. K.Venkatesa Mudaliar & another, (Supra) are not applicable to the present case.

20. It is further submitted that the documents placed on record by the plaintiff itself show that the defendants are in the market since long. It is submitted that there is no document on record to show that the public is being misled by use of mark OMEXGOLD of the defendants.

21. I have heard the arguments and have perused the relevant record.

22. The matter in dispute before this Court is whether the trademark of the plaintiff i.e. MEX which is registered is phonetically, visually or structurally similar to the mark OMEXGOLD of the defendants depicted on pages 225-227 along with the list of documents of the defendants. Also, the trade name of the defendants is M/s OMEX Cable Industries which is clear from the bill etc placed on record by the defendants. The question is whether these marks can be said to be either phonetically or visually or structurally similar in order to constitute infringement of the plaintiff's trademark.

23. Section 28 and Section 29 of the Trade Marks Act, 1999 grants an exclusive right to the registered owner of a trademark which reads as under:-

"28. Rights conferred by registration.—

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

29. Infringement of registered trade marks.—

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark

is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(d) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

24. Therefore, if an unregistered proprietor uses, in a course of its trade, a mark which is identical or deceptively similar to the registered trademark without the permission of the trademark owner, then the mark of the registered owner can be stated to have been infringed.

25. It is essential for the plaintiff to show that the defendant has taken out essential part of its registered trademark. The plaintiff states that the essential part of its trademark is MEX and by mere use of the MEX in the mark, the defendants have violated its registered trademark. The mere use of part of a registered trademark does not amount to violating registered trademark unless it is shown that it is identical or deceptively similar. The mark can be said to be deceptively similar when it is either structurally or phonetically or visually similar to that of the registered trademark. For that reason, the Court is not required to place both the marks side by side and see its similarity and dissimilarity. It is the general impression which is created in the mind of the general public who is going to buy the goods under those trademarks which is important. If the impression created in the mind of the

general public who is buying the goods is that they are buying the goods belonging to the plaintiffs while actually they would be buying the goods of defendant, then it can be said that the mark used by the defendants is deceptively similar to the registered mark and thus infringes the rights of the registered trademark owner. The plaintiff has relied on various judgments wherein the Court has held that certain marks like 'Andal'and 'Ambal', 'Boomstar' and 'Superstar', 'Rasmola' and 'Hajmola' and 'Encore' and 'Anchor' are deceptively similar and likely to cause deception in the mind of the general public who when go to buy the goods of defendants in the market and would think that they are buying the goods of the plaintiffs. In those cases, the Court found that the words 'Andal'and 'Ambal'are phonetically similar, while in the case of 'Rasmola', Mola is the distinctive part of the registered trademark 'Hajmola'and 'Star' was the distinctive characteristic of the trademark 'Moonstar'. While, on the other hand in the case, *Kewal Krishan Kumar (supra),* the Court did not found any deceptive, phonetic or structural similarity between the trademarks 'Shakti Bhog'and 'Maha Shakti Brand' and the Court held that expression 'Shakti' although is common in both the trademarks but do not sound to be similar when they are separately pronounced and the average and ordinary purchaser would be

able to know the difference when he goes to market to buy the said product. It sounds that both did not had striking phonetic similarity with each other. The relevant paragraphs of the judgment are reproduced hereunder:-

> *"(15) In my opinion it could be said that there is an innocent or accidental resemblance between the two trade marks but it cannot be said that the defendants have deceptively copied the trade mark in its letter and its essential features namely - "SHAKTI BHOG". 'SHAKTI' as we all know is strength and "MAHA SHAKTI" is super strength, whereas "SHAKTI BHOG" denotes food that gives strength. In their meanings also, therefore, the two words are dissimilar and it cannot be said that there is an imitation by the defendant of the plaintiff's trade mark and that the defendant is using the same with the sole object of diverting the business of plaintiff.*
>
> *(16) In this connection I may appropriately refer to the decision in the case of Coca Cola Company of Canada Ld. Vs. Pepsi Cola; 1942 (59) Rpc 127. In that case the question was whether the word 'COLA' was descriptive and commonly adopted in naming of beverages. It was held that 'Cola' was descriptive and commonly used by the manufacturers of non-alcoholic drinks. It was held that: "THE distinguishing feature of the mark coca cola was coca and not cola. For the same reason the distinguishing feature of the mark Pepsi Cola was Pepsi and not cola. It was not likely that any one would confuse the word Pepsi with coca."*
>
> *(17) In the present case also prima facie it appears to me that the term 'Shakti' is commonly used in the business parlance as would appear from the few pages of the telephone directory produced in the present case and the word 'MAHA SHAKTI' is descriptive in nature. Even the word "SHAKTI BHOG", in my prima facie opinion, is a descriptive word. We may also appropriately refer to the decision in F. Hoffman Lr. case (Supra) wherein the Supreme Court has held that where two words have a common suffix, uncommon prefix of the words is a natural mark of*

distinction. Therefore, in my opinion the decision rendered by the Supreme Court in the aforesaid case is squarely applicable to the facts of the present case."

26. In the present case, as is apparent, there is no visual similarity between two trademarks. Also, the style of advertisement of its mark by the defendants is different with that of plaintiff's. The trade name of the defendants i.e. OMEX Cable Industries is also entirely different from the trade name of the plaintiff i.e. MEX Switchgears Pvt. Ltd.

27. The Supreme Court in the case of ***Wander Limited vs. Antox India (P) Ltd, 1991 PTC-1,*** while dealing with the grant of interim injunction has noted as under:-

"5. Usually, the prayer for grant of an interlocutory injunction is at a stage when the existence of the legal right asserted by the plaintiff and its alleged violation are both contested and uncertain and remain uncertain till they are established at the trial on evidence. The court, at this stage, acts on certain well settled principles of administration of this form of interlocutory remedy which is both temporary and discretionary. The object of the interlocutory injunction, it is stated is to protect the plaintiff against injury by violation of his rights for which he could not adequately be compensated in damages recoverable in the action if the uncertainty were resolved in his favour at the trial. The need for such protection must be weighed against the corresponding need of the defendant to be protected against injury resulting from his having been prevented from exercising his own legal rights for which he could not be adequately compensated. The court must weigh one need against another and determine where the "balance of convenience lies".

28. This Court in ***Shri Gopal Engineering & Chemical Works vs. M/s POMX Laboratory,*** ***AIR 1992 Delhi 302***, has clearly held that where there is a delay in moving the Court, the plaintiffs would not be entitled for interim relief. In that case, the plaintiff had learnt about the infringement action in a case of passing off in June 1990 and again in July 1990 but he waited up to September, 1991 to file a suit and the Court held that he was not entitled to any interim relief. This Court again in the case of ***Warner Bros Entertainment Inc. and Anr vs. Harinder Kohli and Ors,*** ***2008 (38) PTC 185 (Del),*** while dealing with the application under Order 39 Rule 1 & 2 has clearly held that the delay in approaching the Court is fatal and the application seeking interim relief on this ground is liable to rejected.

29. From the plaint itself, it is clear that the defendant had filed an application for registration of its trademark in the year 2006 and was opposed by the plaintiff and this shows that the plaintiff was aware that the defendants were using the mark OMEXGOLD, yet the plaintiff has come up before this Court only in the year 2015. The plaintiff tried to explain the delay by stating that it did not find any goods of the defendants in the market and so was unaware. The plaintiff, in its replication averred that it had genuine hope to succeed before the Registrar when he had filed opposition

application to the Registrar of the Trademarks against the defendants and had stated that defendants never disclosed that it has been using the trademark since long and was also not aware that the defendants were in the market and selling the goods under the mark OMEXGOLD and, therefore, it did not file the suit earlier. Even if we presume that plaintiff was not aware that the defendants were in market in the year 1995 it however became aware of this fact in the year 2006 when the defendants applied for the registration of its mark and when it moved an application opposing the said registration. The defendants, on the other hand, has placed on record the document showing its sales since the year 2003 and 2004 and the various other documents filed on record by the defendants shows that it has been using the said trade mark in the year 2006 when it had applied for the registration of the said mark. The delay in filing the present suit as well as the application, in the circumstances of this case, also disentitles the plaintiff for discretionary relief more so, when the plaintiff has concealed in his plaint the fact that the defendants had applied for the registration of the mark and it had filed the opposition application.

In view of the above, the application with I.A 15312/2015 stands dismissed.

CS(OS) 2247/2015

Let the matter be placed before the Roster Bench on 20.07.2017.

DEEPA SHARMA
(JUDGE)

JULY 17, 2017/*ss*