



2024 : DHC : 1883



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **CS(COMM) 679/2023**

JINDAL INDUSTRIES PRIVATE LIMITED Plaintiff
Through: Mr. Chander M. Lall, Sr.
Advocate with Mr. Sarad Kumar Sunny, Mr.
Rohan Dua, Mr. Keshav Mann and Ms.
Yashi Dubey, Advs.

versus

**SUNCITY SHEETS PRIVATE
LIMITED AND ANR.** Defendants
Through: Mr. Vaibhav Agnihotri and Mr.
Harshit Kiran, Advs. for D-1
Mr. J. Sai Deepak, Mr. Kishore Kunal, Mr.
Abhishek Avadhani and Ms. Runjhun Pare,
Advs. for D-2

**CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR**

JUDGMENT
07.03.2024

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IA 18962/2023 [under Order XXXIX Rules 1 and 2 CPC]

1. “What’s in a name?” queried Juliet, of her Romeo¹. Much indeed, as this litigation would disclose.

2. This judgment decides IA 18962/2023, preferred by the plaintiff Jindal Industries Pvt. Ltd. The plaintiff seeks an order of interim injunction, pending disposal of CS (Comm) 679/2023, restraining the

¹ In Act II Scene II of Shakespeare’s immortal play, Romeo and Juliet



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defendants from using the mark , or JINDAL *per se*, in any manner as would infringe the plaintiff's registered trade marks.

3. Defendant 1 is Suncity Sheets Pvt. Ltd. ("SSPL") and Defendant 2 is Rachna Jindal, the wife of Nitin Kumar Jindal, the Manager of SSPL.

Rival Contentions

4. I have heard Mr. Chander M. Lall, learned Senior Counsel for the plaintiff-applicant, Mr. Vaibhav Agnihotri, learned Counsel for Defendant 1 and Mr. J Sai Deepak, learned Counsel for Defendant 2, at exhaustive length.

Submissions of Mr. Lall

5. Mr. Lall submits thus:

(i) The plaintiff is the registered proprietor, in terms of Section 18 of the Trade Marks Act, 1999, of

(a) the word mark JINDAL, *vide* registration No. 3022745, w.e.f.² 12 March 2014, in Class 17, covering "PPR Pipes, Pex Pipes, PVC Pipes & Fittings, PVC Flexible Pipes, Acrylic Sheet, Agricultural Rigid PVC Pipes, Hope Pipes & Coils, PVC & UPVC Rigid Pipes &

² With effect from




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Pipes Fittings, Hope SWR Pipes & Fittings, Polythene Pipes, Pre-Al-Pe (Polyethylene-Aluminium-Poly Ethylene) Composite Pipes, Pex-Al-Pe Composite Pipes, Pex-Al-Pex Composite Pipes, Pex Pipes (Cross Linked Polyethylene Pipes), Poly Propylene Random Pipes & Fittings in Class 17”,

(b) the word mark JINDAL, *vide* Registration No. 894786 w.e.f. 8 January 2007, in Class 6, covering “Steel Tubular Poles, Steel Poles, Poles of Metal, for electric Lines”, and



(c) the word mark JINDAL COR, *vide* Registration No. 899510 w.e.f. 8 January 2007, in Class 6, covering “C.I. Soil Pipes, Cast Iron Pipes, M.S. Pipes, C.I. Pipe and Fittings, Galvanized Corrugated Steel Sheet, Galvanised Iron Pipes, Galvanised Plain Steel Sheet, Steel Strips, Steel Pipes and Tubes and Fitting and Parts thereof, Mild Steel Pipes and Tubes both Black and Galvanized and parts and fitting thereof and other articles, Pipes Fittings (Galvanized Iron and Metal), Steel Tubular Poles, Steel Poles, Back and Galvanized Pipes Seamless Steel Pipes and Tubes”.

(ii) The defendants use the composite mark . By combining the initials of the wife of the Manager of SSPL with “JINDAL”, the defendants have ingeniously infringed the plaintiff’s registered trade marks.



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(iii) Defendant 2 applied for registration of the impugned  mark as a sole proprietor of RN Jindal SS Tubes. The address provided in the application, E-422, Basni IInd Phase, Industrial Area, Jodhpur (Rajasthan), India was the same as the address of Defendant 1, SSPL. Mr. Lall has referred me, in this context, to a Signboard outside the premises of SSPL reflecting the said address. Along with the application for registration of the  mark, Defendant 2 filed Invoice No. STJTI/10078/2021, dated 21 July 2020, from SSPL to RN Jindal SS Tubes (“RNJSST”), showing RNJSST as consignee as well as buyer. He has referred me to the said invoice, filed with the plaint.



(iv) Apropos this invoice, it is also pointed out that the local truck, with registered number RJ 14 GJ 8429, through which SS Pipes and Tubes were shown to have been transported from SSPL to RNJSST on 21 July 2020 was also shown to have transported SS Pipe Tube from RNJSST to Prateek Steels & Metals on the same day under another Invoice No. GST3/20-21.

(v) The same phenomenon, of one truck having transported SS pipe tubes on the same day in two different consignments, is also to be seen in Invoice No. STJTI/10094/2021 and Invoice No. GST4/20-21, both dated 28 July 2020, reflecting transport of SS Pipe Tubes, in the one case from SSPL in Jodhpur to



RNJSST in Basni and, in the other, from RNJSST to Savitri Metal Group in Ghaziabad. The invoices, therefore, were fabricated and unreliable.

(vi) Defendant 2, Rachna Jindal, in her statement dated 24 May 2022, recorded in CS (Comm) 604/2021, disclaimed knowledge of the year when SSPL started, and claimed to be unable to name any known person in SSPL. She further stated that the defendants had approached SSPL for manufacturing stainless steel (SS) pipes and tubes under the brand name RNJ, which were sold by her in her personal name. On the packing of the products, the name of SSPL found no place. This, submits Mr. Lall, is a violation of the Legal Metrology (Packaged Commodity) Rules, 2011.

(vii) The defendants'  mark is clearly similar, if not identical, to the plaintiff's registered JINDAL word mark. The plaintiff's registered word mark has entirely been subsumed in the impugned  mark of the defendants. "JINDAL" is clearly the most prominent part of the impugned mark. A *prima facie* case of infringement, within the meaning of Section 29(2)(b)³ of the Trade Marks Act, 1999, therefore, exists.

³ 29. **Infringement of registered trade marks.** –

(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—

(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



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(viii) The defendants have not pleaded that the registration of the plaintiff's JINDAL mark is invalid. Once the mark is valid, and infringement is proved, the plaintiff is entitled to injunction.

Submissions of Mr. J Sai Deepak for Defendant 2

6. Countering the submissions of Mr. Lall, Mr. J. Sai Deepak, learned Counsel for Defendant 2, contends thus:

(i) The issue in controversy is largely covered by the judgment of this Court in *Jindal Stainless (Hisar) Ltd v. Suncity Sheets Pvt Ltd*⁴, in which interlocutory injunction was denied.


(ii) The defendants could not be enjoined from using the impugned  mark as JINDAL is a common surname. It may, therefore, be registerable, but is certainly not enforceable, in view of Section 35⁵ of the Trade Marks Act. The plaintiff's attempt is to entirely monopolize use of the common surname JINDAL, either by itself or with any other words or images. This is clearly impermissible. Inasmuch as the name of

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

⁴ 298 (2023) DLT 163


⁵ 35. **Saving for use of name, address or description of goods or services.**—Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any *bona fide* use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any *bona fide* description of the character or quality of his goods or services.



Defendant 2, who markets the product, is Rachna Nitin Jindal, the use of the impugned  mark, by her, is perfectly legitimate. The use of one's own surname as a trade mark is *prima facie bona fide*. Mr. Sai Deepak cites, in this context,

- (a) paras 8 to 10 of *Precious Jewels v. Varun Gems*⁶,
- (b) paras 3 and 5 to 6 of *Manish M. Turakhia v. Neerav N. Turakhia*⁷,
- (c) paras 9 to 11 of *Somashekar P. Patil v. D.V.G. Patil*⁸,
- (d) para 9 of *Jindal Stainless (Hisar) Ltd.*,
- (e) para 15 of *Prathiba M. Singh v. Singh & Associates*⁹ and
- (f) para 26 of *S.M. Dyechem Ltd. v. Cadbury (India) Ltd*¹⁰.

(iii) The defendants' mark is distinctive. It combines "RNJ" with the image of the sun and the complete name of the defendant-concern "R N Jindal SS Tubes". It is, therefore, entitled to the protection of Section 35 of the Trade Marks Act. That which is permitted by the law cannot, quite obviously, be dishonest.

(iv) The distinctive nature and appearance of the impugned  mark of the defendants clearly distinguishes it from

⁶ (2015) 1 SCC 160

⁷ 2016 SCC OnLine Bom 15576 (DB)

⁸ AIR 2018 Kar 135


⁹ (2014) 145 DRJ 572



¹⁰ (2000) 5 SCC 573



the JINDAL word mark of the plaintiff. There is no chance of confusion between the two.

(v) As was confirmed by Defendant 2 in her statement dated 24 May 2022 *supra*, Defendant 2 entered into a Memorandum of Understanding (MoU) dated 3 July 2020 for manufacturing SS pipes and tubes under the brand name RNJ. The plaintiff was trying to characterize the MoU as a sham transaction only to avoid the rigour of Section 35 of the Trade Marks Act.

(vi) As the plaintiff’s word mark JINDAL and the defendants’ device mark are completely dissimilar when viewed as whole marks, no case of passing off can be said to exist either. The “added matter” in the impugned  of the defendants was sufficient to obviate any possibility of confusion between the said mark and the plaintiff’s JINDAL mark. The dissimilarity between the plaintiff’s and defendants’ device marks was even more stark:

Plaintiff’s mark	Defendants’ mark
	

(vii) The plaintiff had never sold, and was not selling, SS tubes. The plaintiff could not be permitted to squat over the JINDAL mark preventing its use by others even for goods



which formed no part of the plaintiff's portfolio. In this context, reliance is placed on

- (a) paras 32 and 33 of *Nandhini Deluxe v. Karnataka Cooperative Milk Producers Federation Ltd*¹¹,
- (b) *Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd*¹² and
- (c) *Mittal Electronics v. Sujata Home Appliances (P) Ltd*¹³, which extended the decision in *Nandhini Deluxe* to infringement proceedings.

(viii) The fact that two invoices issued on the same day showed transportation of goods by the same vehicle to different destinations is irrelevant. GST had been paid separately on the trips.

(ix) SSPL was the contract manufacturer for Defendant 2.

Submissions of Mr. Lall in rejoinder

7. In rejoinder, Mr. Lall submits thus:

(i) The acts of the defendants are completely orchestrated and lacking in *bona fides*. Defendant 1 was an ex-licensee of the plaintiff. The day the plaintiff cancelled the licence of Defendant 1, he started infringing the plaintiff's registered trade

¹¹ (2018) 9 SCC 183

¹² (1997) 4 SCC 201

¹³ (2020) 83 PTC 358




marks by picking up, for the said purpose, Defendant 2, who is the wife of Nitin Jindal, a former employee of the plaintiff.

(ii) Defendant 2 has no prior knowledge or experience whatsoever in manufacture or sale of steel pipes. She was a housewife.

(iii) The benefit of Section 35 of the Trade Marks Act, by way of a “personal name defence”, was not available to Defendant 1, which was a corporate entity.

(iv) Section 35 prohibited injuncting of the use, by a “person, of his own name”. It did not, therefore, apply here.

(v) Section 35 would not apply where the defendant was using the impugned mark as a trade mark. The use would not, then, be *bona fide*. Reliance is placed, on this context, on paras 203 and 210 of *Zydus Wellness Products Ltd v. Cipla Health*

*Ltd*¹⁴. The defendants were clearly using the  mark as a trade mark, and not merely as source identifiers. Section 35 protects only honest user of one’s name as a mark. Reliance is placed on the decision of the House of Lords in *Parker Knoll Ltd v. Knoll International Ltd*¹⁵, which was followed by the Division Bench of this Court in *B.K. Engineering Co. v. UBHI*

¹⁴ 2023 SCC OnLine Del 3785

¹⁵ (1962) 10 RPC 265 (278)



*Enterprises*¹⁶ (from which Mr. Lall cites para 22) and, specifically in the context of surname usage, by a Division Bench of the High Court of Bombay in *Bajaj Electricals Ltd v. Metals & Allied Products*¹⁷ (from which Mr. Lall cites para 7). Reliance is further placed on the decision of the Chancery Division of the UK High Court in *Joseph Rodgers & Sons Ld v W.N. Rodgers & Co.*¹⁸ and on *M. Melachrino & Co. v. The Melachrino Egyptian Cigarette Co. & U. Melachrino*¹⁹.

(vi) What, therefore, the defendants were seeking to contend, was that, because the surname of Defendant 2 happens to be “JINDAL”, the Court should overlook the aspects of infringement, deception, confusion, and the like.

(vii) Defendant 1 cannot seek to do, indirectly through Defendant 2, that which Section 35 does not permit it to do directly.

(viii) Section 29(1)²⁰ covers, within the sphere of infringement, use of an identical trade mark by the defendant “as a trade mark”. Surnames are not excepted. A surname is also a “mark”

¹⁶ AIR 1985 Del 210: 27 (1985) DLT 120 (DB)

¹⁷ AIR 1988 Bom 167

¹⁸ (1924) 41 RPC 277

¹⁹ (1887) 4 RPC 215 (Ch D)

²⁰ 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.



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within the meaning of Section 2(m)²¹. Ergo, the *bona fide* use of the name of the defendant, as envisaged by Section 35(1), cannot include use of the name as a trade mark.

(ix) The transactions between SSPL and Defendant 2 are sham. SSPL sold the goods to Defendant 2, who sold it further to the final supplier, on the same truck on the same day. Defendant 2 is, therefore, only a *via media*, with no experience in selling SS sheets or pipes. It is further emphasized that SSPL and RNJSST are situated in the same premises, and that the mobile number given in the trade mark application filed by RNJSST is that of Nitin Jindal, who was the marketing manager of SSPL.

(x) Allowing usage, by the defendants, of the impugned mark, would wipe out, altogether, the statutory right created in the plaintiff's favour by virtue of the registrations obtained by it.

(xi) The judgments cited by Mr. Sai Deepak are distinguishable, as they relate to cases where all family members are in one business, and there are, therefore, concurrent rights of all over the common surname. Reference has been made to para 9 of *Precious Jewels*, para 5 of *Manish M. Turakhia* and para 9 of *Somashekar P. Patil, Prathiba M.*

²¹ (m) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;



Singh, it is submitted, was passed in order to avoid litigation amongst law firms.

(xii) The plea of lack of confusion, or of difference between the rival marks, is devoid of merit. The JINDAL word mark stands registered in favour of the plaintiff in Class 6 for steel poles etc., and the JINDAL COR word mark stands registered for steel pipes and tubes. The goods are, therefore, identical to those made and sold by the defendants.

Submissions of Mr. Sai Deepak in surrejoinder

8. Mr. Sai Deepak was permitted a surrejoinder, especially as Mr. Lall had, in rejoinder, advanced fresh submissions and cited new judicial pronouncements. In surrejoinder, Mr. Sai Deepak submits as under:

(i) Section 35 starts with a *non obstante* clause. The right to use the name of the predecessor in business, therefore, also encompasses its use as a trade mark.

(ii) The protection under Section 35 can be lost only if the use of the impugned mark results in actual confusion, not merely likelihood of confusion.

(iii) The protection under Section 35 is, moreover, not contingent on the existence of a family relationship.



(iv) In any case, the defendants’ and plaintiff’s marks were totally different, and there was no likelihood of confusion between the two. Attention is invited to the words “without distinguishing its goods” in para 22 of the judgment of the Division Bench of this Court in ***B.K. Engineering***, cited by Mr. Lall. ***Melachrino***, it is pointed out, was a case in which the defendant was emphasizing, in the impugned mark, the word “Melachrino”, unlike the present case.

Submission of Mr. Vaibhav Agnihotri, for SSPL

9. Mr. Vaibhav Agnihotri pitches in to contend, on behalf of Defendant 1, SSPL, that his client was never a licensee of the plaintiff, but was merely the purchaser of the plaintiff’s raw material.

Analysis

Section 35 of the Trade Marks Act

10. Section 35 operates, in my *prima facie* view, as a statutory fetter to grant of the relief that Mr. Lall seeks.

11. Section 35 starts with a *non obstante* clause, which gives it overarching applicability over every other provision “in this Act”. Mr. Lall’s reliance on Section 29(1) of the Trade Marks Act cannot, therefore, dilute the effect of Section 35. Besides, Section 29(1)




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would, even otherwise, not be applicable, as I venture to point out subsequently.

12. If Section 35 applies, therefore, no occasion arises, in law, to refer to any other provision of the Act. There is an absolute statutory proscription against the plaintiff interfering with the use, by the defendants, of the impugned mark.


13. Of course, the use of the impugned mark, by the defendants, has to be *bona fide*. I would advert to this aspect presently, as Mr. Lall has also sought to contend that the defendants' use of JINDAL, as part of the impugned  mark, is not *bona fide*.


14. Mr. Lall does not dispute that R N Jindal is indeed the name of Defendant 2. In view of Section 35, therefore, the plaintiff cannot interfere with the use, by Defendant 2, of her own name, provided, of course, the use is *bona fide*.

15. "Use", per se, is neither defined in Section 35, nor elsewhere in the Trade Marks Act. Section 2(2)(b), however, ordains that, unless the context otherwise requires, any reference, in the Trade Marks Act, "to the use of the mark shall be construed as a reference to the use of the printed or other visual representation of the mark". I see no reason, moreover, not to extend the benefit of Section 35 to the use of the name in the form of initials either. In other words, Defendant 2 would be entitled to the benefit of Section 35, in respect of the use, by



her, of “Rachna Nitin Jindal” or, for that matter, “R N Jindal” or even “RNJ”. In each case, what is clearly been referenced is her name.

16. In the impugned  mark, the most prominent feature is, undoubtedly “RNJ” with the sun symbol alongside. The name below it is the name of Defendant 2 herself, viz. R.N. Jindal. The mark does not highlight, or emphasize, in any manner, “JINDAL”, over “RN”. It is not possible, therefore, to read the mark as “JINDAL”, ignoring the “RNJ” or the “RN” which precedes “Jindal” in the small print.

17. To tear out of the impugned composite  mark the word “JINDAL”, and allege, on that basis, that the mark infringes the plaintiff’s registered JINDAL marks is, in my considered opinion, not justified by any provision of the Trade Marks Act.

18. The marks, it is well settled, have to be compared as whole marks. In *Amritdhara Pharmacy v. Satya Deo Gupta*²², the Supreme Court held:


“8. We agree that the use of the word “dhara” which literally means “current or stream” is not by itself decisive of the matter. *What we have to consider here is the overall similarity of the composite words*, having regard to the circumstance that the goods bearing the two names are medicinal preparations of the same description. We are aware that the admission of a mark is not to be refused, because unusually stupid people, “fools or idiots”, may be deceived. A critical comparison of the two names may disclose some points of difference, but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name.


²² AIR 1963 SC 449



The trade mark is the whole thing-the whole word has to be considered. In the case of the application to register “Erectiks” (opposed by the proprietors of the trade mark “Erector”) Farwell, J., said in *William Bailey (Birmingham) Ltd. Application*²³:

“I do not think it is right to take a part of the word and compare it with a part of the other word; *one word must be considered as a whole and compared with the other word as a whole....* I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word.”

19. Thus compared, the plaintiff’s mark is JINDAL, whereas the defendants’ is . They are as alike as chalk and cheese.


20. Defendant 2 applied for registration of the impugned  mark. She, therefore, is the avowed proprietress thereof, through the firm RNJSST.


21. Whether Defendant 2 is a housewife, or has a prior knowledge of marketing and selling SS tubes cannot be a concern for this Court especially at this *prima facie* stage. There is no known principle that the proprietress of a manufacturing concern must have prior experience in manufacturing or trading that item.

22. The plaintiff has not produced any tangible material on the basis of which the *bona fides* of the MoU dated 3 July 2020, whereunder Defendant 2 contracted with Defendant 1 to manufacture the SS pipes and tubes, can be doubted.

²³ (1935) 52 RPC 137




23. The submission that the address of Defendant 2, as entered in the application dated 12 June 2020 seeking registration of the impugned  mark, is the same as the address of SSPL, again, is not clinching enough to entitle the plaintiff to an injunction, even if it is suggestive to an extent. The submission is premised on a signboard on a wall. The date of taking of the photograph is unknown and undisclosed. No document has been cited, by Mr Lall, to support the contention of identity of addresses.

24. Assuming, *arguendo*, that this were the case, there is nothing illegal in the wife of Nitin Jindal being the proprietor of RNJSST and, therefore, of adopting the impugned mark and seeking its registration. At the highest, therefore, this is an issue which would require evidence and trial, and cannot constitute a basis to injunct the defendants from using the  mark, where other factors, even seen cumulatively, do not make out a case for grant of injunction.

25. The submission that goods were transported in the same truck from SSPL to RNJSST and, thereafter, from RNJSST to the ultimate destination, too, does not carry the plaintiff's case any further. There is nothing inherently impossible in the same truck carrying the goods further to the final destination.

26. The submission that the benefit of Section 35 would not be applicable to Defendant 1 is also without merit. The defendants contend that Defendant 1 is only a contract manufacturer for



Defendant 2. The MoU in that regard is also on record. There is no reason why, at this *prima facie* stage, this Court should not accept the submission. The benefit of Section 35 is certainly available to Defendant 1. It was Defendant 1 who had applied for registration of the impugned  mark as its proprietor.

Re. the submission that the benefit of Section 35 is not available for use of the mark in a “trade mark sense” or “as a trade mark”

27. Mr. Lall sought to contend that the benefit of Section 35 would be available only if the name were used as a source identifier, and not if it was used “in the trade mark sense” or “as a trade mark”.

28. I do not find any such caveat, or condition, in Section 35.

29. Mr. Lall sought to place reliance, for this purpose, on paras 204 and 210 of my decision in *Zydus Wellness Products*. The said paragraphs read thus:

“204. Section 30(2)(a) of the Trade Marks Act, to the extent it is relevant, applies where the impugned trade mark is used by the defendant to indicate the kind, quality, quantity, intended purpose or other characteristics of the goods or services of the defendant. Applying this provision, the Division Bench of this Court held, in *Marico*²⁴, that where the expression “LOW ABSORB” was used by the defendant, in that case, as part of the phrase “WITH LOW ABSORBING TECHNOLOGY”, the use of the expression was purely descriptive and could not, therefore, be enjoined by plaintiff. Section 30(2)(a) is a complete exception to Section 29. Even if a registered trade mark is copied by the defendants or used by the defendants as it is, such use cannot be enjoined by the proprietor of the registered trade mark, if the use of the mark by the defendants is purely descriptive in nature.

²⁴ (2010) 174 DLT 279 (DB)



210. *Mutatis mutandis*, this position would also obtain in respect of Section 35 of the Trade Marks Act. Section 35, to the extent it is relevant, proscribes interference with bonafide use, by a person, of “any bonafide description of the character or quality of his goods or services”. The discussion afore-noted clearly indicate that the marks “Prolyte Gluco-C ++” and “Prolyte Gluco-D ++” cannot be regarded as descriptions of the character or quality of the goods of the defendants. The defendants cannot, therefore, seek the benefit of Section 35 of the Trade Marks Act either.”

Zydus Wellness Products dealt with the concluding part of Section 35, which envisages “*bona fide* description of character or quality of ... goods or services”. It is in that context that I had held that where the mark was not used in a descriptive sense, the benefit of Section 35 would not be available. That principle has no applicability to the opening part of Section 35, which deals with *bona fide* use of one’s own name. *Zydus Wellness Products*, therefore, does not apply.

30. From *Parker Knoll*, Mr. Lall cited passages both from the majority opinion of Lord Morris as well as the dissenting opinion of Lord Denning. As it is the majority opinion which prevails, I reproduce, here, the passages cited, from the majority opinion, by Mr. Lall:

“Lord Morris of Borth-y-Gest: My Lords, in the interests of fair trading and in the interests of all who may wish to buy or to sell goods the law recognises that certain limitations upon freedom of action are necessary and desirable. In some situations the law has had to resolve what might at first appear to be conflicts between competing right. In solving the problems which have arisen there has been no need to resort to any abstruse principles but rather. I think, to the straightforward principle that trading must not only be honest but must not even unintentionally be unfair.



The present case is concerned with the selling of goods under a mark or name. The respondents fear that if the appellants, whose honesty is not in any way impugned, are allowed to sell furniture in the way that they desire to do, a great many people would buy furniture in the belief that they were buying the respondents' furniture whereas they would in reality be buying the appellants' furniture.

In approaching the facts of the case. I propose to state a few propositions, which, though they are by no means exhaustive, seem to me to apply to such a case as the present.

1. No one has any right to represent his goods as being the goods of someone else (*Reddaway v. Banham*²⁵, *Joseph Rodgers & Sons, Limited v. W. N. Rodgers & Company*²⁶).

2. The court will restrain the making of any such representation even though it is not made fraudulently (see *John Brinsmead & Sons Ltd. v. Brinsmead & Sons Ltd*²⁷). If A represents his goods as being the goods of B, then B is likely to suffer and is entitled to be protected whether A makes the representation innocently or fraudulently. If there is room for doubt as to whether A has represented his goods as the goods of B, then if there is evidence that A deliberately intended to and set out to make such a representation that evidence will in some cases assist to prove that there was in fact such a representation.

3. A name may be used as a mark under which a person's goods are sold so that the name comes to denote goods made by that person and not the goods made by anyone else or even made by anyone else who has the same name. So also a mark under which a person's goods are sold may come to denote goods made by that person. The name or the mark will have acquired a secondary meaning (see *Chivers v. Chivers*²⁸).

4. It follows that someone may, even by using his own name and using it innocently, make a representation that is untrue, that is a representation that goods which in fact are his are the goods of someone else (see *Reddaway*).

In *Joseph Rodgers & Sons, Limited*. Romer, J., at p. 291 said that no man is entitled so to describe or mark his goods as to represent that the goods are the goods of another, and further said at p. 292

²⁵ [1896] A.C. 199

²⁶ (1924) 41 R.P.C. 277)

²⁷ (1913) 30 R.P.C. 493

²⁸ (1900) 17 R.P.C. 420)



that to the rule as so stated there is no exception at all (see also *Baume v. Moore*²⁹. In *Marengo v. Daily Sketch and Sunday Graphic Limited*³⁰. Lord Simonds said at p. 251: “It is an unassailable general proposition that the interests alike of honest traders and of the public require that the goods of A should not be confused with the goods of B. But that proposition is subject to the qualification that a man must be allowed to trade in his own name and, if some confusion results, that is a lesser evil than that a man should be deprived of what would appear to be a natural and inherent right. But ... it is a fantastic gloss upon this well-established qualification to say that it justifies a trader in placing upon his goods a mark which, however much he may intend it to signify his name, is yet liable to suggest to reasonable men the name of another.” Having regard to this passage, I think that some observations made by Lord Greene, M.R., in *Wright. Layman & Umney Ltd. v. Wright*³¹ at 152, must be regarded as incomplete.

5. It is a question of fact, to be decided on the evidence, whether it is proved that a name or a mark has acquired a secondary meaning so that it denotes or has come to mean goods made by a particular person and not goods made by any other person even though such other person may have the same name.

In the circumstances to which I have referred, which are fully set out in the careful judgment of the learned judge, the issue in the case is whether the respondents clearly established that if furniture is sold under the mark KNOLL or KNOLL INTERNATIONAL there will be serious risk that substantial numbers of members of the purchasing public will be led to believe that they are buying Parker-Knoll furniture or in other words furniture of Parker-Knoll Limited. If the marks KNOLL and KNOLL INTERNATIONAL are used when furniture is sold is it proved that such furniture would as a result of the use of such marks be represented albeit innocently as being the furniture of Parker-Knoll Limited? Would members of the trade and members of the public be likely to be deceived? My Lords, the learned judge at the trial and all three judges in the Court of Appeal considered that by the use of the word KNOLL there was a real likelihood of passing-off with the exception of the Master of the Rolls the judges reached a similar conclusion in regard to the use of KNOLL INTERNATIONAL. My Lords, I am not persuaded that the conclusions of the majority were erroneous. The failure of the respondents to show that the word KNOLL, used as a trade mark, had come to denote solely the

²⁹ [1958] Ch 137.

³⁰ (1948) 65 R.P.C. 242

³¹ (1949) 66 R.P.C. 149



respondents' goods is not, in my view, fatal to the respondents. The question still remains whether it was clearly proved that passing-off will result if Knoll International Limited use the marks KNOLL or KNOLL INTERNATIONAL. The fact that the word KNOLL was not shown to be solely distinctive of the respondents does not of itself negative the likelihood that deception would result from the use of the word by the appellants.

There was much evidence which satisfied the learned judge that purchasers who wished to buy PARKER-KNOLL chairs often, by way of an abbreviation, asked for a KNOLL chair. The evidence tended to support the view that members of the purchasing public are likely to regard KNOLL as the striking and significant feature of the doublet PARKER-KNOLL I think that the learned judge was warranted in taking the view that many purchasers would regard KNOLL as the major name or the memorable part of PARKER-KNOLL. Consequently, if they saw furniture which was being sold with the mark KNOLL they would, I think, consider that they were buying PARKER-KNOLL. If knowing the style of PARKER-KNOLL furniture they saw furniture of rather different design but bearing the mark KNOLL, I think that it is more likely that they would conclude that they were seeing PARKER-KNOLL furniture which was of new design than that they would conclude that the furniture was not PARKER-KNOLL furniture at all. On an approach to the case without regard to any evidence as to the habits of purchasers it would seem to me that the word KNOLL being rather unusual would lead a searcher for PARKER-KNOLL furniture to conclude that furniture marked KNOLL was what he was looking for. The mark KNOLL INTERNATIONAL would, I think, lead a searcher to conclude that he was seeing Parker-Knoll furniture but that the manufacturers of it had an extended organisation which would enable them to sell in many countries. I think that there is force in the observation of

It is upon the second question that a point of law has been raised in this House which depends on the fact that the appellants when they use the name KNOLL INTERNATIONAL are honestly using their own name. They agree that a false representation may be made innocently and that absence of fraud is no defence to an action for passing-off, but in their printed case they urge that nevertheless the honest user of their own name in connection with their goods makes the onus on the plaintiff to satisfy the court that such use by the defendant amounts to a false representation a heavy one. In this House counsel on their behalf has gone further and, while saying that the proposition stated above is sufficient for him on the facts of this case, has argued that the honest user by the appellants of their own name is a complete answer in law to the respondents'



claim. This argument is supported by some observations of Lord Greene, M.R., in *Wright, Layman & Umney Limited*, a case of passing-off. He said: “If a man carries on his business in his own name and so describes his goods, it appears to me that he is perfectly safe.” Lord Greene had already referred to the decision of Romer, J., in *Joseph Rodgers and Sons. Limited*, which puts the position very differently where passing-off is concerned. He said at page 291: “It is the law of this land that no man is entitled to carry on his business in such a way as to represent that it is the business of another, or is in any way connected with the business of another; that is the first proposition. The second proposition is that no man is entitled so to describe or mark his goods as to represent that the goods are the goods of another. To the first proposition there is, I myself think, an exception a man, in my opinion, is entitled to carry on his business in his own name so long as he does not do anything more than to cause confusion with the business of another, and so long as he does it honestly. It is an exception to the rule which has of necessity been established... To the second rule, to which I have referred, I think there is no exception at all, that is, that a man is not entitled so to describe his goods as to lead to the belief that they are the goods of somebody else. It is not necessary that there should be an exception to that.” Lord Greene gave no indication that he dissented from what Romer, J., had said and I think his observations must have been unguarded, for he gave no effect to them in the decision which he gave.

The statement of Romer, J., in Rodgers’ case notes the distinction which is drawn between trading under a name and passing-off of goods by the use of a name. The distinction noticed by Romer, J., was accepted as correct by Viscount Simonds in *Marengo*. The exception to the rule in the case of trading under a name is exemplified by authorities such as *Turton v. Turton*³², which was a case of trading, not passing-off, in which strong and unqualified language was used upholding the right of persons to use their own names provided they did so honestly. Other cases in the books contain similar language, but with the exception of Lord Greene’s observations in Wright’s case there is no trace of this exception being applied to cases of passing-off of goods in this country. As Viscount Simonds pointed out in *Marengo*, the *Turton* case had been qualified in *Brinsmead v. Brinsmead*³³, by Buckley, L.J., who gave his opinion upon that case in no uncertain terms showing that since the decision in *Reddaway v. Banham*³⁴, the doctrine had

³² (1889) 42 Ch. 128

³³ (1913) 30 R.P.C. 493

³⁴ (1896) 13 R.P.C. 218



been clearly established that a man may use even his own name in connection with a sale of goods so as to make a false representation.

The extreme argument on behalf of the appellants must, in my opinion, be rejected without hesitation, and it seems to me that this rejection carries with it rejection of the argument that honest user of the defendant's own name puts a special burden upon the plaintiff to discharge the burden of proof in a passing-off action.

When one asks whether the appellants so describe their goods as to be likely to mislead purchasers into believing that their goods are the goods of the respondents, I do not see that the answer to this enquiry goods is assisted by knowledge of the fact that the defendant is using his own name. The presence of honesty does not assist in answering the question. It is true that the presence of fraud is treated as relevant on the basis, no doubt a wholesome one, that if the defendant thinks it advantageous to make fraudulent use of the fact that his own name is the same as that of the plaintiff the court will be slow to assume that he has failed in his purpose. No such consideration applies here, and the enquiry must be answered bearing in mind that the purchasing public are unlikely to have any knowledge whether a trader is in truth using his own name or not without imposing any special burden on the party who seeks to prove passing-off.

The majority of the Court of Appeal, Upjohn, L.J., and Pearson, L.J., upheld the decision of the trial judge in that they decided that KNOLL INTERNATIONAL as well as the word KNOLL by itself must be included in the injunction. The Master of the Rolls, Lord Evershed, and some of your Lordships take a different view as to KNOLL INTERNATIONAL. I am bound to say that once the word KNOLL is found to be objectionable it appears to me to follow that KNOLL INTERNATIONAL should suffer the same fate.

Now, it is obvious that a court is less likely to find fraud if the name which a man uses is genuine than if it is assumed. As Buckley, L.J., said, if a trader takes the name of a rival trader, that is strong evidence that he intends to deceive, and the court would fasten upon that in any case in which it occurred. In this way, the use of a man's own name can be indirectly relevant. But no fraud is alleged here.

Where there is no question of fraud, where the question is whether the statement is literally true but whether it carries with it a false representation, I cannot see how it can matter whether or not the name whose use is capable of being misunderstood is an actual



name or a fictitious one. Buckley, L.J., said categorically in his third proposition: “There is, in my opinion, no difference whatever where the true statement consists in an accurate statement of the defendant's name as distinguished from any other true statement of fact if of course you have evidence that from the use of his own name deception results.

The same considerations apply to the alternative submission that the genuineness of the name places an onus on the plaintiff to satisfy the court that its use amounts to a false representation. The genuineness of the name is, in my opinion, irrelevant either to prove or disprove the falsity of the representation. The fact that there was once a real Hans Knoll from whom the company takes its name is not a fact that is known to the prospective purchaser and is not, therefore, a factor to be given any weight at all in the estimate of the effect on his mind of the name KNOLL.

It may be that there is a distinction in this respect between the name that is attached to a business and one that is attached to goods. In *Rodgers v. Rodgers*³⁵, Romer, J., at p. 291, differentiated between the two, dealing with the name in which a man carried on his business in one proposition, and the name by which he described or marked his goods in another. To the second proposition he said that there was no exception, but to the first he said that there was. “A man, in my opinion, is entitled to carry on his business in his own name so long as he does not do anything more than that to cause confusion with the business of another, and so long as he does it honestly.

The present case comes under the second proposition. The respondents are not seeking to restrain the appellants from carrying on business as “Knoil International.” Thus *Rodgers*, standing by itself, is only another authority contrary to the appellants’ contention. But they submit it is to be read in conjunction with what Lord Greene, M.R., said about it in *Wright v. Wright*³⁶. They submit that no real distinction can be drawn between a name attached to a business and one attached to goods or to services, such as transport or office cleaning, to take an example from one of the cases. In all these cases the effect of misrepresentation is the same, namely, the diversion of trade. So Lord Greene, M.R., said: “If he carries on business in his own name and so describes his goods, it appears to me that he is perfectly safe.

³⁵ (1924) 41 R.P.C. 277


³⁶ (1949) 66 R.P.C. 149



My Lords, I cannot think that this language was well considered. Lord Greene, M.R., referred to **Rodgers** without disapproval, and I am sure that if he were taking a contrary view-which must certainly have been the case if he meant the exception to operate on both propositions instead of on one – he would have said so explicitly. At any rate, I am satisfied that Romer, J.’s second proposition is sound and that is all that in this case I need to decide. As at present advised, I am not persuaded that the genuineness of a name in which a man carries on his business would in all cases be a sufficient justification for its use, but that question does not now arise.”

(Emphasis Supplied)

What **Parker Knoll** proscribes, quite clearly, is the use of one’s name, even innocently, in such a manner as is liable to suggest, to “reasonable men” – who, in the Indian context, following **Amritdhara Pharmacy**, has to be the man of average intelligence and imperfect recollection – the name of another. If, therefore, the manner in which the name is used is likely to lead such a person to believe that the goods are of another’s, then such use, even if innocent, will not be permissible. As the decision says, “a man is not entitled so to describe his goods *as to lead to the belief that they are the goods of somebody else*”. At the same time, significantly, the decision notes that “a court is less likely to find fraud if the name which a man uses is genuine than if it is assumed”. It has also to be borne in mind that **Parker Knoll** was rendered in the context of passing off.

31. It would be stretching the limits of credulity, in my opinion, to hold that the use of JINDAL, by the defendants, as a mere part of the total composite impugned mark  **RN JINDAL SS TUBES**, is likely to deceive a consumer of average intelligence and imperfect recollection that the



goods of the defendants, on which the mark is used, are those of the plaintiff. The plaintiff, admittedly is not known as “R.N. Jindal” or “RNJ”, and that, indeed, is not even the plaintiff’s case. Besides, unlike the position that obtains in the US (as the extracts from *Parker Knoll* seem to suggest), Section 35 protects *bona fide* use of one’s own name, and proscribes *any* interference therewith. No exception is created in a case where the name is used as a trade mark, or otherwise. Whereas innocent use is, therefore, as per *Parker Knoll*, impermissible, if the use is *bona fide*, the defendant, in India, is entitled to the benefit of Section 35. Whether *Parker Knoll* applies, *mutatis mutandis*, to India and the law in this country, may, therefore, be debatable. To the extent it does, however, it does not substantiate the plaintiff’s case for injunction.

32. Para 22 of *B.K. Engineering* reads thus:



“22. In *Parker-Knoll Ltd. v. Knoll International Ltd.* (supra) both parties were manufacturers of furniture, the plaintiff being a company well-known in the United Kingdom and the defendant an American Company which had only recently begun to trade in England. Notwithstanding that the defendant company did no more than use its own name on its furniture, the House of Lords, by majority, granted an injunction to restrain it from continuing to do so without distinguishing its goods from those of the plaintiff. The plaintiff had established that its name had come to denote goods made by it alone and not goods made by someone else possessing or adopting that name, and the use by the defendant of a similar name did, in the opinion of the majority, amount to the false representation that its goods were the plaintiff’s goods.”

As Mr. Sai Deepak correctly submits, the injunction granted in *Parker Knoll*, as noted in para 22 of *B.K. Engineering*, was against the defendant continuing to use its name on its furniture *without distinguishing its goods from those of the plaintiff*. Inasmuch as the




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manner in which the defendants print the impugned  mark on their furniture is completely different from the manner in which the plaintiff uses its JINDAL mark (), the goods are clearly distinguished.

33. *Joseph Rodgers*, again, was a case of passing off. As would be noted hereinafter, no case of passing off can be said to exist here; ergo, *Joseph Rodgers* would also not apply.

34. Indeed, one who obtains registration of a common name, or surname, like JINDAL, as a trade mark in his favour, does so with all the risks that such registration entails. It is open to anyone, and everyone, to use his name on his goods, and, therefore, the possibility of there being several JINDAL's looms large. The plaintiff cannot, by obtaining registration for JINDAL as a word mark, monopolize the use of JINDAL even as a part – and not a very significant one at that – of any and every mark, even in the context of steel, or SS pipes and tubes. The Trade Marks Act, and the privileges it confers, cannot be extended to the point where one can monopolize the use of a common name for goods, and, by registering it, foreclose the rest of humanity from using it.

35. For that reason, Mr. Lall's lament that, if the defendants are permitted to use the impugned  mark, the plaintiff's statutory rights in its registered JINDAL word mark would be jeopardized is really misplaced. The risk of having others *bona fide* using



“JINDAL” as a name for their products, and in the marks used on their products, is a risk that the plaintiff consciously took, when it obtained registration of the mark. If one registers a mark which lacks inherent distinctiveness, the possibility of others also using the same mark for their goods, and of the registrant being powerless to restrain such use, is a possibility that looms large, which the registrant has to live with.

36. Albeit in an entirely different context, the Supreme Court has this to say, with respect to a name and its importance:

“1. “*What's in a name? That which we call a rose by any other name would smell as sweet*”, said Juliet. This quote from William Shakespeare's “Romeo and Juliet” is unarguably one of the most iconic dialogues in classical literature. It conveys that the natural characteristics of an individual are more important than his/her artificial/acquired characteristics. A poetic statement as it certainly is, it does not go in tune with the significance of a name in marking the identity of an individual in his/her societal transactions. To put it differently, name is an intrinsic element of identity.

123. The question whether bye-laws under consideration impose reasonable restrictions on the exercise of rights under Article 19 of the Constitution of India, may have to be understood in the context of enunciation of this Court that the core existence of an individual is not exemplified by her outer characteristics but by her inner self-identification and also about the significance of the acquired identity in the form of name. The identity of an individual is one of the most closely guarded areas of the Constitutional scheme in India. The sanctity of identity has been recognised by this Court in a plethora of cases including *National Legal Services Authority v. Union of India*³⁷, *Navtej Singh Johar v. Union of India*³⁸, and *K.S. Puttaswamy (Privacy-9J.) v. Union of India*³⁹.

124. In fact, in *Navtej Singh Johar*, the Court noted how the core existence of an individual is not exemplified by her outer characteristics but by her inner self-identification. In the context of

³⁷ (2014) 5 SCC 438

³⁸ (2018) 10 SCC 1; (2019) 1 SCC (Cri) 1

³⁹ (2017) 10 SCC 1



natural identity of an individual, this Court in *Navtej Singh Johar* had noted that:

“5. The natural identity of an individual should be treated to be absolutely essential to his being. What nature gives is natural. That is called nature within. Thus, that part of the personality of a person has to be respected and not despised or looked down upon. The said inherent nature and the associated natural impulses in that regard are to be accepted. Non-acceptance of it by any societal norm or notion and punishment by law on some obsolete idea and idealism affects the kernel of the identity of an individual. *Destruction of individual identity would tantamount to crushing of intrinsic dignity that cumulatively encapsulates the values of privacy, choice, freedom of speech and other expressions.* It can be viewed from another angle. An individual in exercise of his choice may feel that he/she should be left alone but no one, and we mean, no one, should impose solitude on him/her.”

125. Identity, therefore, is an amalgam of various internal and external including acquired characteristics of an individual and name can be regarded as one of the foremost indicators of identity. And therefore, an individual must be in complete control of her name and law must enable her to retain as well as to exercise such control freely “for all times”. Such control would inevitably include the aspiration of an individual to be recognised by a different name for a just cause. Article 19(1)(a) of the Constitution provides for a guaranteed right to freedom of speech and expression. In light of *Navtej Singh Johar*, this freedom would include the freedom to lawfully express one's identity in the manner of their liking. In other words, expression of identity is a protected element of freedom of expression under the Constitution.”

(Underscoring supplied; italics in original)

37. To the extent it protects against interference with the use of one’s name, Section 35 has to be understood in the context of the law enunciated in the above decision, and those cited within it. The right of a person to use her, or his, own name on her, or his, own goods, cannot be compromised; else, it would compromise the right to use



one's name as an identity marker, which would *ex facie* be unconstitutional.

38. In the absence of any such caveat to be found in Section 35, it may be arguable, at the very least, whether, while the use of one's name as an identity marker is permissible under Section 35, but the instance it spills over into "trade mark" territory, it is rendered impermissible. Any such interpretation, in my *prima facie* view, would be reading a non-existent proviso into Section 35 and, in effect, rewriting the provision.


39. The proscription under Section 35 is absolute, and would extend to infringement as well as passing off actions. The restraint against interference with the *bona fide* use, by a person, of his own name, is not dependent on whether the action is one for infringement or passing off.

40. The plaintiff's prayer for injunction is, therefore, bound to fail even on the sole anvil of Section 35.

41. That said, even on merits, no case of infringement or passing off is made out.

42. Infringement can be said to take place only where one, or the other sub-sections of Section 29 of the Trade Marks Act apply. Without going into the specifics of the various sub-sections of Section 29, suffice it to state that, in each of them, identity, or deceptive



similarity, between the rival marks, is the *sine qua non* for a finding of infringement to be returned. The word mark JINDAL, and the logo  , seen as whole marks, are neither identical nor deceptively similar. No infringement can, therefore, be said to exist.

43. The case of the plaintiff, for passing off, is even weaker. Para 28 of the decision in *Kaviraj Pt Durga Dutt Sharma v. Navaratna Pharmaceuticals*⁴⁰ classically encapsulates the difference between an action for infringement and one for passing off:


“28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. *The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for*

⁴⁰ AIR 1965 SC 980



infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods” (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas *in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.*”

(Emphasis supplied)


Viewed thus, there is no *prima facie* likelihood of confusion, or deception, resulting as a consequence of the use, by the defendants, of the  mark. Seen as a whole mark, it possesses several features of distinction, *vis-à-vis* the bare word mark JINDAL of the plaintiff, such as the bold and prominent “RNJ” logo, the sun symbol and the words “R N JINDAL SS TUBES” prominently written below it.



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44. The tort of passing off connotes, in its essence, an attempt by the defendants to pass off its goods or services as those of the plaintiff. In trade mark jurisprudence, that would be by use of a mark which is so similar to that of the plaintiff that the use of the mark results in the defendants' goods or services, in or in connection with which the mark is used, being passed off, in the perception of the consumer of average intelligence and imperfect recollection, as the goods or services of the plaintiff. Where the mark of the defendants, therefore, possesses "added matter" which is sufficient to distinguish it from the mark of the plaintiff, no passing off is made out.

45. In the present case, not only does the impugned  mark of the defendants possess added matter, and added features, which clearly distinguish it from the JINDAL mark of the plaintiff; the defendants, quite clearly, have made every effort to *minimize* any chance of confusion, by prominently using the initials "RNJ" along with the complete name of the proprietorship of Defendant 2, "RN JINDAL STAINLESS STEELS", below it. No one, much less a consumer of average intelligence, who reads the text on the defendants' impugned mark, would regard it is a mark of the plaintiff. The defendants' impugned mark is clearly a source identifier, and identifies the product, on which it is used, with the defendants, and with no one else.



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46. The use of the impugned  mark by the defendants cannot, therefore, be regarded, even *prima facie*, as passing of their goods as those of the plaintiff.

Conclusion

47. Resultantly, the plaintiff is not entitled to interim injunction as sought.

48. IA 18962/2023 is, therefore, dismissed.

C. HARI SHANKAR, J

MARCH 7, 2024