



IN THE HIGH COURT OF KERALA AT ERNAKULAM

PRESENT

THE HONOURABLE MR. JUSTICE C.PRATHEEP KUMAR

THURSDAY, THE 18TH DAY OF SEPTEMBER 2025 / 27TH BHADRA, 1947

RFA NO. 287 OF 2024

OS NO.1 OF 2023 OF DISTRICT COURT, PALAKKAD

APPELLANT(S)/DEFENDANTS

- 1 SHORANUR METAL INDUSTRIES LLP,
'SHREEPADAM BUILDING', 1ST FLOOR, ROOM NO. VII/39, NEAR
IRATTAMBALAM SIVA TEMPLE, KALIPADAM, SHORANUR
REPRESENTED BY ITS DESIGNATED PARTNER SHRI.
KRISHNAKUMAR, PIN - 679122
- 2 KRISHNAKUMAR, AGED 50 YEARS
DESIGNATED PARTNER, SHORANUR METAL INDUSTRIES, LLP,
'SHREEPADAM BUILDING', 1ST FLOOR, ROOM NO. VII/39, NEAR
IRATTAMBALAM SIVA TEMPLE, KALIPADAM, SHORANUR, PIN -
679122

BY ADV SHRI.HARIKUMAR G.

RESPONDENT(S)/PLAINTIFFS

- 1 THE METAL INDUSTRIES LIMITED
(GOVERNMENT OF KERALA UNDERTAKING), METIND NAGAR,
SHORANUR REPRESENTED BY ITS MANAGING DIRECTOR, PIN -
679122
- 2 THE METAL INDUSTRIES LIMITED,
(GOVERNMENT OF KERALA UNDERTAKING), METIND NAGAR,
SHORANUR, KERALA REPRESENTED BY ITS MANAGING DIRECTOR
K.LAKSHMI NARAYANAN, PIN - 679122

BY ADVS.
SRI.SAJI VARGHESE T.G
SMT.MARIAM MATHAI
SMT.SREEPRIYA K.U.
SHRI.ABRAHAM JOSEPH

THIS REGULAR FIRST APPEAL HAVING BEEN FINALLY HEARD ON
26.8.2025, THE COURT ON 18.09.2025 DELIVERED THE FOLLOWING:



JUDGMENT

Dated : 18th September, 2025

The defendants in OS 1/2023 on the file of the District Court, Palakkad are the appellants. (For the purpose of convenience the parties are hereafter referred to as per their rank before the trial court.)

2. The plaintiff is a company incorporated by the Government of Kerala by name 'Metal Industries Limited'. They filed the suit for injunction, alleging infringement of its trade name by the defendants which is a firm by name 'The Shornur Metal Industries LLP.' According to the plaintiffs, the plaintiff/company was incorporated with the intention to manufacture iron and steel products namely agricultural tools and equipments such as sickle , spade, shovel, pickaxe, axe, saw, cutleries, mammatties and all types of agricultural allied tools and equipments. They have got a brand name 'Tusker' with an emblem. The plaintiff/company was found about 94 years back with registered office at Shornur. The products of the plaintiff/company has high demand and have adorable credibility among the people. The caption of the company was registered under Section 27 of the Trade Marks Act, 1999 and as such, no other person could infringe the registered trade mark of the plaintiff. The plaintiff/company is popularly known as 'Shornur Metal Industries', as it is situated in Shornur.

3. According to the plaintiffs, the 1st defendant/firm was established in 2019 and they are also manufacturing iron and steel agricultural tools and



equipments like the plaintiff and it is also functioning within a radius of three kms. from the plaintiff/company. In the year 2020, the plaintiff/company understood that the name of the 1st defendant has created confusion among the public and it is still continuing. Since the 1st defendant is also using the name 'Shornur Metal Industries' the people misunderstands that the 1st defendant firm is the 1st plaintiff company. Since the 1st plaintiff's domain name is registered under the Trade Marks Act, the 1st defendant has no right or authority to use the same name as that of the 1st plaintiff for identical or deceptively similar name. The caption 'Shornur Metal Industries' has deceptive similarity to the name of the 1st plaintiff 'Metal Industries' and the intention of the defendants is to confuse the common people and other innocent buyers and small traders who are trading with the plaintiff/company for long years. The defendants' domain name is deceptively similar to the domain name of the plaintiff. Though the plaintiff/company has sent registered notice to the defendants asking them to stop using the name 'Shornur Metal Industries', they have sent a reply raising false contentions. It was in the above context that the plaintiff filed the suit seeking remedies under Sections 134 and 135 of the Trade Marks Act, including a permanent prohibitory injunction against using the domain caption 'Metal Industries', a mandatory injunction to remove the domain name 'Metal Industries' from the defendants' caption, officially undergoing and advertising and for damages to the tune of Rs.1,00,000/-.

4. The defendants 1 and 2 filed a written statement, contending that the



business of the plaintiff/company and the 1st defendant firm are not similar or identical and therefore, there is no chance for any confusion among the public. According to them, the manufactured products of the defendants available are unique and the products are manufactured in accordance with the requirements of the customers. The products of the plaintiff/company are different from the products of the defendant firm. Therefore, there is no violation or infringement. The contention that 'Shornur Metal Industries' is deceptively similar to the domain name of the plaintiff is incorrect. The words 'Metal Industries' have nothing to do with the plaintiff. Various companies working and manufacturing similar products all over India are using similar names. The plaintiff/company cannot get advantage of any name which is commonly used by the public at large. The plaintiff could not claim that they are having exclusive right over such commonly used words and therefore, the plaintiff/company cannot get exclusive right to use those words. The contention that the plaintiff/company is popularly known as 'Shornur Metal Industries' is not correct. Therefore, the defendants prayed for dismissing the suit.

5. The trial court framed six issues. The evidence in the case consists of the oral testimonies of PW1, DW1, Exts.A1 to A15 and B1 to B4. After evaluating the evidence on record, the trial court decreed the suit restraining the defendants by a permanent prohibitory injunction from using the domain caption 'Metal Industries' in their business name and also directed the defendants by a mandatory injunction to remove the domain name 'Metal Industries' from their caption, official



communications, advertisements and using the above domain name in any newspapers, magazines, other printed items, electronic media, T.V., You Tube, social media, letter heads etc. and other published and publishing materials in future. Aggrieved by the above judgment and decree of the trial court, the defendants preferred this appeal.

6. Now the points that arise for consideration are the following :

1. Whether the defendants have infringed the registered trade mark of the plaintiff ?

2. Whether the defendants are entitled to have the protection of Section 30(2)(b) of the Trade Marks Act as claimed ?

3. Whether the defendants have been passing off their goods using the domain name of the plaintiff ?

7. Heard Sri.Harikumar G., the learned counsel for the appellants and Sri. Saji Varghese T.G., the learned counsel for the respondents.

8. The points:- The plaintiff is the owner of the registered trade mark 'Metal Industries' located at Shornur. The defendants who are using the trade name 'Shornur Metal Industries' have not registered their trade mark before the Registrar. Therefore, according to the learned counsel for the plaintiff, in the light of Section 29 of the Trade Marks Act, the above conduct of the defendants amounts to infringement of the registered trade mark of the plaintiff and as such the plaintiffs are entitled to get an injunction restraining the defendants from using the trade



mark 'Metal Industries' by the defendants. On the other hand, the learned counsel for the defendants relying upon Section 30(2)(a) of the Trade Marks Act, would argue that the words 'metal' as well as 'industries' are generic names and as such, the plaintiffs cannot claim exclusive right to use such generic words and therefore, according to the learned counsel, even against registered trade mark holder anybody can use such words and hence, the plaintiffs are not entitled to get any reliefs as prayed for in the plaint. Therefore, according to the learned counsel for the appellants, the trial court was not justified in decreeing the suit in favour of the plaintiff.

9. Section 30(2)(a) of the Trade Marks Act, which is an exception to Section 29 is extracted below for reference :

“30. Limits on effect of registered trade mark.—

(1)

(2) A registered trade mark is not infringed where—

(a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services. “

10. The learned counsel for the plaintiff relying upon various provisions under the Trade Marks Act, would argue that trade mark registration is granted under the Trade Marks Act, after following several procedure formalities and before registration, anybody can raise their objection and once objection is raised, only after enquiry the registering authority will register the trade mark. According



to the learned counsel, though such opportunities were available for the defendants they have not utilised the same and as such they are bound by Section 29 of the Trade Marks Act.

11. The learned counsel for the respondents/plaintiffs has relied upon the decision of the Hon'ble Supreme Court in **Ramdev Food Products P. Ltd. v. Arvindbhai Rambhai Patel and others, (2006) 8 SCC 726** in support of his argument. In the above decision, while discussing about the purpose of trade mark, in paragraph 52, the Apex Court held that:

“A trade mark is the property of the manufacturer. The purpose of a trade mark is to establish a connection between the goods and the source thereof which would suggest the quality of goods. If the trade mark is registered, indisputably the user thereof by a person who is not otherwise authorised to do so would constitute infringement. S.21 of the 1958 Act provides that where an application for registration is filed, the same can be opposed. Ordinarily under the law and, as noticed hereinbefore, there can only be one mark, one source or one proprietor. Ordinarily again right to user of a trade mark cannot have two origins. The first respondent herein is a rival trader of the appellant Company. It did not in law have any right to use the said trade mark, save and except by reason of the terms contained in the MOU or continuous user. It is well settled that when defences in regard to right of user are set up, the onus would be on the person who has taken the said plea. It is equally well settled that a person cannot use a mark which would be deceptively similar to that of the registered trade mark. Registration of trade marks is envisaged to remove any confusion in the minds of the consumers. If, thus, goods are sold which are produced from two sources, the same may lead to confusion in the mind of the consumers. In a given situation, it may also amount to fraud on the public.



A proprietor of a registered trade mark indisputably has a statutory right thereto. In the event of such use by any person other than the person in whose name the trade mark is registered, he will have a statutory remedy in terms of S.21 of the 1958 Act. Ordinarily, therefore, two people are not entitled to the same trade mark, unless there exists an express licence in that behalf."

12. On the other hand relying upon the decision of the Delhi High Court in **Pornasricharoenpun Co.Ltd and Ors. v. L'Oreal India Private Limited and Ors., MANU/DE/4515/2022**, the learned counsel for the appellant would argue that the defendants have every right to impugn the registered trade mark at the stage of registration as well as post registration. Further, he would argue that unless a descriptive mark acquires secondary meaning, it cannot be registered and the registered trade mark holder cannot claim exclusive right on it. After referring to various decisions on the point, in paragraph 14 the Delhi High Court reiterated the following conclusion :

"15. CONCLUSIONS--On a consideration of submissions and the judgments--

(i) The Court can at an interlocutory stage take a prima facie view as to the validity of a registered trade mark. This view can be taken based on averments made in the written statement/pleadings [see Lowenbrau AG (supra)]. The pleadings in this regard, as in every other case, has to be read 'meaningfully' [see Begum Sabiha Sultan v. Nawab Mohd. Mansar Ali Khan, (2007) 4 SCC 343].

(ii) Some marks are inherently incapable of distinctiveness [see Asian Paints Ltd. (supra)].



(iii) The rights under Section 28 are subject to other provisions of the Trade Marks Act. Also the registered proprietor or the permitted user can exercise his rights if the registered mark 'is valid'.

(iv) A descriptive mark can be registered provided it has Signature Not Verified acquired secondary meaning [see Girnar (supra)],

By:KAMAL KUMAR Signing Date:16.11.2022 19:15:09 Neutral Citation Number: 2022/DHC/004808

(v) If a descriptive mark is one, which is, essentially a combination of common English words the user of the marks has to bear the risk of, some amount of confusion. No monopoly can be claimed by the user of the mark [see Cadila Health Care (supra) & J.R. Kapoor (supra)].

(vi) The mark can be impugned both at the stage of registration and post registration. See provisions of Section 9(1)(a) to (c) of the Trade Marks Act for challenge at time of registration and Sections 30 and 35 for challenge after registration.

(vii) If the registered mark and the rival mark are not identical; in other words the two marks are similar then the same test as in the case of passing off is applicable; which is, is there a likelihood of deception or cause for confusion [see Ruston and Hornby Ltd. (supra)].

13. Thereafter the learned Judge referring to another decision held that, the trade marks 'Low Absorb' or 'Low Absorb Technology' used by the defendants cannot be restrained by injunction as they are descriptive use by normal English words characteristic or the quality of the defendant's goods unlike a trade mark which identifies the origin. This defence is available even against registered mark under Sections 30(2)(a) and 35 of the Trade Marks Act.



14. In the decision in **M/s.Pornsricharoenpun Co.Ltd** (supra), the appellant was using the trade name 'Hair Spa' for its cosmetic products for several years. The defendants were already using the brand name 'Hair Spa'. The question involved was whether the words 'Hair Spa' would constitute trade mark infringement for the products of the defendants. The Delhi High Court held that 'Hair spa' is not a coined term and it is merely a combination of two common English terms 'hair' and 'spa' that describe the nature of the product and the service. Therefore, the term 'Hair Spa' being a generic term, lacks distinctiveness to be considered as a valid trade mark to be registered or protected by law. In paragraph 21 the Court held that :

“21. Examining the facts of the present case on the anvil of the aforesaid judgments, in my prima facie opinion, the trademark 'HAIR SPA' is descriptive and the expression is commonly used in the trade for products which are used for treatment and nourishment of hair. 'HAIR SPA' is not a coined word and is merely a combination of two popular English words HAIR and SPA juxtaposed or placed side by side. Applying the principles explicated in Marico Limited (supra) and Cadila Health Care Ltd. (supra), the expression HAIR SPA, which only describes the characteristics of a product and is a common descriptive expression, is incapable of being distinctive. The function of a trademark as defined under Section 2(zb) of the Act is to distinguish the goods or services of one person from the others, i.e. it acts as a source identifier/indicator. From the plethora of material placed on record by the Appellant, it appears prima facie that HAIR SPA is a very commonly used expression and connotes and describes hair treatment and falls short of serving as a source identifier of the Respondents. The word 'HAIR' in its plain dictionary meaning is 'any of



the numerous fine, usually cylindrical, keratinous filaments growing from the skin of humans and animals'. Similarly, the dictionary meaning of the word 'SPA' is 'mineral spring or a luxurious resort or hotel'. Thus, the expression denotes nothing more than description of the product used for hair treatment/nourishment.”

15. In the decision in **Skyline Education Institute (India) Private Ltd v. S.L.Vaswani and Another, AIR 2010 SC 3221**, the dispute was with regard to the usage of the word 'skyline' by the respondent for educational institution against the use of the same word by the plaintiff company for imparting education in hotel management etc. The court held that the word 'skyline' being generic word used in the language and in the trade mark protection, such word cannot be granted to the exclusion of others. In paragraph 18, the court held that :

“18. In our opinion, the findings recorded by the learned Single Judge and Division Bench on the crucial factors like prima facie case, balance of convenience and equity are based on a correct and balanced consideration of various facets of the case and it is not possible to find any fault with the conclusions recorded by them that it is not a fit case for restraining the respondents from using the word 'Skyline' in the name of the institute established by them. It has not been disputed on behalf of the appellant that the word 'Skyline' is being used as trade name by various companies / organizations / business concerns and also for describing different types of institute / institutions. The voluminous record produced by the respondents before this Court shows that in India as many as 117 companies including computer and software companies and institutions are operating by using word 'Skyline' as part of their name / nomenclature. In United States of America, at least 10 educational / training institutions are operating with different names using 'Skyline' as



the first word. In United Kingdom also two such institutions are operating. In view of this, it is not possible to agree with the learned counsel for the appellant that the Skyline is not a generic word but is a specific word and his client has right to use that word to the exclusion of others. “

16. In the decision in **Institute of Directors v. Worlddevcorp Technology and Business Solutions Pvt. Ltd. & Ors., 2023 SCC OnLine Delhi 7841**, the dispute was with regard to the use of the words 'Institute of directors' used and registered by the plaintiff who conducted the business of international conferences, seminar, etc. The defendants started an organisation by name 'Directors' institute.' It was challenged by the plaintiff. The Delhi High Court held in paragraph 32 that :

“32. Obtaining of a registration in respect of a mark which consists of common English words is fraught with the possibility of its own adverse sequelae. While obtaining registration of such a mark, the registrant has to be conscious that, the mark being a combination of ordinary English words, and, in fact, as in the present case, being a mark as non-distinctive as “Institute of Directors”, there is every possibility of a similar mark being used by another person. Commonly used words, or a non-distinctive combination of commonly used words, cannot be monopolised by any one person, so as to disentitle the rest of the world to the use thereof.”

17. In **Yatra Online Limited v. Mach Conferences and Events Limited, 2025 SCC OnLine Delhi 5610**, the dispute was with regard to the usage of the word 'Yatra'. The plaintiff who had registered trade mark including the word 'Yatra', claimed that 'Yatra' is a dominant term in the trade mark and as such it



could not be used by the defendant. The Delhi High Court held that a generic or commonly descriptive words could never become trade mark or their own as they never acquire distinctiveness or a secondary meaning and do not indicate origin or source. The court further held that the words used in every day language could not be allowed to be monopolised. The word 'Yatra' being the Hindi term for travel as such is a day-to-day language and such a word cannot be monopolised. In paragraph 53 the court held that, the word 'YATRA', was a generic and commonly descriptive word, meaning 'travel' in Hindi and could never become trade mark on its own as such words never acquire distinctiveness or a secondary meaning and do not indicate origin or source. It is settled law that words used in everyday language cannot be allowed to be monopolized.”

18. In **Lake Mount Educational Society and Another v. Global Educational Trust, 2025 ICO 1273** (FAO 221/2018), the use of the word 'Global Public School' was under challenge. The respondent had a school in Ernakulam from 2006 by name 'Global Public School' and appellant also started a school by name 'Lake Mount Global Public School' in 2010 and it was registered. In appeal this Court found that even though 'Global', 'Public' and 'School' are generic words, its combination has obtained a secondary meaning for the respondent. The Court also found that the appellant had several schools in the same name and also found that the intention of the appellant was to mislead the public by using a similar trade name and to divert the business.



19. Relying upon the decision of the Hon'ble Supreme Court in **T.V. Venugopal v. Ushodaya Enterprises Ltd. and another** 2011 4 SCC 85, the learned counsel for the plaintiff would argue that even in case of generic or descriptive words, the courts are not powerless to grant injunction to protect the prior user, as well as registered trademark holders, from using the same name by other persons. In the above decision, the Apex Court held that the respondent company's mark 'Eenadu' has acquired extraordinary reputation and goodwill in the State of Andhra Pradesh, and thereby acquired a secondary or subsidiary meaning to the word 'Eenadu'. In paragraph 19 the court held that:

"The respondent company's mark, 'Eenadu' has acquired extraordinary reputation and goodwill in the State of Andhra Pradesh. Eenadu newspaper and TV are extremely well known and almost household words in the State of Andhra Pradesh. The word Eenadu may be a descriptive word but has acquired a secondary or subsidiary meaning and is fully identified with the products and services provided by the respondent company".

20. However, in the instant case, the plaintiffs have no case that the word 'Metal Industries' has acquired any secondary or subsidiary meaning, as in the case of the word 'Eenadu' in **T.V. Venugopal** (supra). In the above circumstances, it is to be held that the words 'Metal' as well as 'Industries' are either generic or descriptive terms and as such, the plaintiffs are not entitled to monopolized those words by registering them under the trade marks. Therefore, though the plaintiffs have registered the trade mark 'Metal Industries', by virtue of Section 32(1)(a) of the



Trade Marks Act, the defendants are entitled to use those words and as such, the trial court was not justified in granting a permanent prohibitory injunction against the defendants and in favour of the plaintiffs on the ground of infringement.

21. Though in the plaint there is no specific pleading with regard to 'passing off', there is allegation that the trade name of the plaintiffs and the defendants are identical and it is being used by the defendants with the intention to mislead the public. The learned counsel for the plaintiffs relying upon the decision in **Anwar Mohammad Khan v. Sri.Taj Mohammad Khan, 2006 (3) AWC 2166**, would argue that though the words 'passing off' is not specified, if the ingredients of 'passing off' is available, it is sufficient to constitute a claim for 'passing off'. In the above decision, the Court held that if the pith and substance revealed from the pleading is that of seeking action for 'passing off' along with infringement and violation of the trade mark, mere absence of the words 'passing off' in the plaint is of no consequence. In the instant case though the words ' passing off' are absent, the ingredients of 'passing off' are present, as argued by the learned counsel for the plaintiffs. The term 'passing off' is a cause which is premised on a misrepresentation by the defendants with a view to encash on the good will and reputation of the plaintiff leading to confusion amongst the consumers. Once the elements of confusion and misrepresentation are out of the frame, it cannot be urged that claim of 'passing off' is made out. In the instant case, 'Metal Industries' is only the domain name of the plaintiff. The brand name of the products of the



plaintiffs is 'Tusker' and the brand name used by the defendants is 'K.Kumar Tools'. It is also admitted by both sides that the domain name 'Metal Industries' does not find a place in the products of both the parties. Both these brand names 'Tusker' and 'K.Kumar Tools' are dissimilar and not at all identical in nature. In the above circumstance, it was argued that there is absolutely no chance for the consumers to get confused in the products of the plaintiffs and the defendants.

22. According to the learned counsel for the appellant, in order to establish a cause of action for 'passing off', the plaintiffs have to prove that because of the use of the trade name of the plaintiffs by the defendants, the plaintiffs have sustained damage. The essential ingredients to be established in an action for 'passing off' was considered and held by the Apex Court in the decision in **Mahavir Rice, Pulse Mills Bareja v. Jaikrishnan Trading Company, Miroli and Others, 2009 (4) KLT 593** in paragraph 12, as follows :

“We may first consider as to what is meant by 'passing off'. It means, as Lord Halsbury put in, 'nobody has any right to represent his goods as the goods of somebody else'. The law protects through a passing off action the goodwill between a trader and its customers, which to them are help to sustain. In normal case of passing off, the plaintiff has to prove a reputation sufficient for members of the public to be misled by the defendant's conduct into thinking that they are securing the goods or services of the plaintiff. It may not be enough for the public simply to be confused about whether it is getting the plaintiff's or the defendant's goods. The plaintiff will have to demonstrate the volume of sales and to supplement this by evidence from traders and public of the meaning that they attach to the distinguishing features of the plaintiff's goods. The



plaintiff must have some badge of recognition upon which to found his reputation. It is the plaintiff's reputation as a source of goods or services that is in issue. The starting point for deciding whether there has been a misrepresentation amounting to passing off is the understanding that the plaintiff has built up with the public. In the decision reported in Laxmikant V. Patel v. Chetanbhai Shah, 2002 (Vol. 110) Company Cases 518 it was held that the three elements of passing off action are the reputation of goods, the possibility of deception and the likelihood of damage to the plaintiff. It is also held that the same principle which apply to trade marks apply to trade names also. In the decision reported in Heinz Italia v. Dabur India Ltd., 2007 KHC 3635 : 2007 (6) SCC 1 it was held that in an action for passing off, the plaintiff has to establish prior user to secure relief. There are five elements to be proved. They are i) misrepresentation, ii) made by a trader in the course of a trade, iii) prospective customers of his or ultimate consumers of goods or services supplied by him, iv) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and v) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so."

23. In the decision in **Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., AIR 2001 SC 1952**, the Apex Court held that :

"Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered :

- (a) The nature of the marks, i.e., whether the marks are word marks or label marks or composite marks, i.e., both words and label works.*
- (b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.*
- (c) The nature of the goods in respect of which they are used as trade*



marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and / or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods, and

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”

24. In the decision in **Mariyas Soaps and Chemicals (M/s) v. M/s Wipro Enterprises Limited, 2023 (4) KHC 473**, the plaintiffs are the owners of the registered trademark 'Chandrika', who got registration under the Trade Marks act in 1976. While so, the defendants marketed their products with a deceptively similar name 'Chandra'. The plaintiffs were using the trademark 'Chandrika' for their products Ayurvedic soap since 1940. The defendants are also marketing products similar to the products of the plaintiffs. The trial court found that the label, the colour combination, writing style and design on the labels used by the defendants have resemblance and deceptive similarity with those of the plaintiff. Though the High Court also found that the above finding of the trial court is sustainable, in the absence of evidence to prove that the plaintiff sustained any economic loss or damage, the injunction granted in favour of the plaintiff was set aside by allowing the appeal. While discussing about the three elements which are considered to be the 'classical trinity' for proving a claim of passing of action, in paragraph 18, the Division Bench held that:



“18. The respondents ought to prove all the three elements which are considered to be the "classical trinity", goodwill, misrepresentation and damage if to get the appellants restrained from marketing their products. In **Cadila Healthcare Limited v. Cadila Pharmaceuticals Ltd. [2001 (5) SCC 73]**, the Apex Court held thus, -

"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 plaintiffs 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." (underline supplied)"

25. In **Delmon Diagnostics and Research Center, DDRC, Pathananthitta and others v. Doctors Diagnostics and Research Center, DDRC, Thiruvalla 2015 (3) KHC 14**, relied upon by the learned counsel for the defendants, in support of his argument that merely because there is similarity in the trade name, an action for passing off will not lie in paragraph 6 the learned Single Judge held that:

" It is therefore, clear that the elementary fact to be established by the plaintiff in an action for passing off is that he has acquired a goodwill or reputation attached to the product or service which he supplies, in the mind of the purchasing public by association with the identifying trademark under which his product or service is offered to the public and that the public is recognizing the product or service of the plaintiff on account of the distinctiveness of the trademark. In addition, the plaintiff has also to establish that a



misrepresentation by the defendant to the public is leading or likely to lead the public to believe that the product or service offered by him is the product or service of the plaintiff. The plaintiff has to further establish that he suffers or likely to suffer damage by reason of the erroneous belief engendered by the misrepresentation of the defendant".

26. In the decision in **Shakti Ceramics v. Supreme Ceramics, 2011 KHC 2924**, relied upon by the learned counsel for the appellants, while analysing the principles to be applied for ascertaining whether the grievance of 'passing off' action has been made out, a learned Single Judge has observed that: "*It is not sufficient for the plaintiff to prove deceptive similarity alone. It has to be established that the plaintiffs enjoyed reputation and goodwill among the customers and also that as a consequence of the act committed by the defendants, loss has been suffered or is likely to be suffered by the defendants*".

27. In **Sakthi Ceramics**, (supra) the plaintiffs were manufacturing and selling the products of flooring tiles, decorative tiles, pottery items etc. under the brand name 'Kathakali' and Kathakali emblem is engrossed on their products. They claimed exclusive right to use the brand name 'Kathakali', with the emblem engrossed on the product. The allegation in the plaint is that the defendants are also using the same trade name and mark and selling the same products as the first plaintiff firm does. It was in the above context that the learned Single Judge held that deceptive similarity between the brand name and trademark of the plaintiffs and defendants is not enough for an action for 'passing off'.

28. In the decision in **Heinz Italia and Another v. Dabur India Ltd. (2007)**



6 SCC 1 relied upon by the learned counsel for the plaintiffs, the plaintiff/appellant is the proprietor of the trademark 'Glucon-D'. Subsequently, the defendant, Dabur India, launched a similar product under the name 'Glucose-D' by using packaging which was deceptively similar to the packaging used for Glucon-D. In the above decision considering the fact that the plaintiffs were the prior users of the mark Glucon-D, an interim injunction was given in their favour. Since it was only an interim order, the Apex Court made it clear that any observation made in this order would not bind the trial judge in the proceedings in the suit. Since it is only an interim order and the Apex Court itself made it clear that the observations made therein are not binding on the trial judge, the above decision cannot be relied upon in this case.

29. From the above decisions it can be seen that, in order to constitute the offence of 'passing off', suffering of irreparable harm and injury in terms of reputation and money are necessary. But, in the instant case the plaintiffs have not adduced any evidence to prove that because of the use of the trade name 'Metal Industries' by the defendants, the plaintiffs have sustained any irreparable injury or damage. The words 'Metal' and 'Industries' are generic and descriptive words and the plaintiffs have no case that by the use of the trademark 'Metal Industries' for decades, the trade mark 'Metal Industries' has acquired any secondary or subsidiary meaning. In order to maintain an action for passing off, in addition to establishing deceptive similarity between the trade name used by the plaintiffs and the defendants, the plaintiffs also have to prove that they enjoys goodwill and reputation and also that they have suffered damage or that they are



likely to suffer damage by the use of the same trademark by the defendants. In the instant case there is absolutely no evidence to prove that the plaintiffs sustained any damage or is likely to sustain any such damage on account of the use of the same trade mark by the defendants and as such, the claims of infringement and passing off will not lie in the facts and circumstances of this case. In the above circumstances, the impugned decree of injunction granted by the trial court merely on the ground that the plaintiffs have been using the registered trade name 'Metal Industries' for decades and the defendants started using the similar trademark of the plaintiffs only recently, cannot be sustained. In other words, the impugned judgment and decree of the trial court granting a decree of permanent injunction in favour of the plaintiffs is liable to be set aside and the suit is liable to be dismissed. Points answered accordingly.

30. In the result, this appeal is allowed and the impugned judgment and decree of the trial court is set aside and the suit, O.S. 1/2023, on the file of the District Court, Palakkad, is dismissed. Considering the facts, I direct both the parties to suffer their respective costs.

All pending interlocutory applications in the appeal will stand dismissed.

Sd/-

C.Pratheep Kumar, Judge



APPENDIX OF RFA 287/2024

ANNEXURES

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|----------------|---|
| Annexure R1(a) | True copy of the plaint in OS No I of 2023 filed by the Plaintiffs against the Defendants before the District Court, Palakkad |
| Annexure R1(b) | True copy of the written statement filed by the defendants in OS 1 of 2023 |
| Annexure R1(c) | True Copy of the Certificate No 3305061 dated 12.11.23 issued by the Examiner of Trade Marks and GI, Government of India Trade Mark Registry Chennai India regarding the registration of Trade Mark |
| Annexure R1(d) | The Certificate issued by the Examiner of Trade Marks and GI, Government of India Trade Mark Registry Chennai dated 8.4.2024 |