

IN THE HIGH COURT OF KARNATAKA AT BENGALURU

DATED THIS THE 10TH DAY OF NOVEMBER, 2022

BEFORE

THE HON'BLE MR. JUSTICE M.I.ARUN

REGULAR FIRST APPEAL NO.106 OF 2015

BETWEEN:

1. MR. M.M. KARIAPPA
NO.4, ANAND TOWERS
III FLOOR, OPP. TO PF BUILDING
RAJARAM MOHAN ROY ROAD
RICHMOND CIRCLE
BENGALURU - 560 025.

2. VOGUE INSTITUTE OF MANAGEMENT
NO.4, ANAND TOWERS
III FLOOR, OPP. TO PF BUILDING
RAJARAM MOHAN ROY ROAD
RICHMOND CIRCLE
BENGALURU - 560 025
BY ITS PROPRIETOR.

... APPELLANTS

(BY SRI S.S.NAGANAND, SENIOR ADVOCATE
FOR SMT. SUMANA NAGANAND &
SRI VIKRAM U.R. FOR M/S.JUST LAW, ADVOCATES)

AND:

ADVANCE MAGAZINE PUBLISHERS, INC.
350 MADISON AVENUE

NEW YORK, NEW YORK - 10027
U.S.A.
REPRESENTED BY ITS CONSTITUTED
ATTORNEY SMT. VEENA P.
AGED ABOUT 40 YEARS
D/O. MR. RAMAKRISHNAN P.C.
R/O. NO.163, HEWO APARTMENTS
SECTOR - 15, PART II
GURGAON - 122 001.

... RESPONDENT

(BY SRI ARAVIND KAMATH, SENIOR ADVOCATE
FOR SRI VENKATA RAGHAVAN, ADVOCATE)

THIS RFA FILED UNDER ORDER 41 RULE 1 READ
WITH SECTION 96 OF CPC., PRAYING TO SET ASIDE THE
JUDGMENT AND DECREE DATED 25.09.2014 IN
O.S.NO.2934/1999 PASSED BY THE LEARNED XVIII
ADDITIONAL CITY CIVIL JUDGE, BENGALURU, ALLOW THIS
APPEAL AND DISMISS THE SUIT OF THE RESPONDENT
WITH COSTS THROUGHOUT.

THIS RFA HAVING BEEN HEARD AND RESERVED FOR
JUDGMENT ON 30.05.2022 AND COMING ON FOR
PRONOUNCEMENT OF JUDGMENT THROUGH PHYSICAL
HEARING/VIDEO CONFERENCING THIS DAY, THE COURT
DELIVERED THE FOLLOWING:

J U D G M E N T

Aggrieved by the judgment and decree dated 25.09.2014 passed by XVIII Additional City Civil Judge, Bengaluru in O.S.No.2934/1999, the defendants therein have preferred this appeal.

2. For the sake of convenience, the parties are referred to herein as per their status before the trial court.

3. The plaintiff i.e., the respondent herein has filed the said suit against the defendants i.e., the appellants herein for grant of an order of permanent injunction restraining the defendants from using the trademark 'VOGUE' as part of their name and trading style and to direct them to render accounts of profits made by them using the trademark 'VOGUE' and to pass decree for the amount found due after the defendants have rendered the accounts and for cost.

4. The case of the plaintiff in brief is as follows:

The plaintiff is an American Corporation and is publishing a fashion magazine in the name and style of 'VOGUE' since 1892. It is an internationally reputed

magazine having circulation in various countries including India. The plaintiff is the registered proprietor in India of Trademark 'VOGUE' under Number 315672B in Class-16 in respect of magazine publications and the same is valid and subsisting. In the month of March 1998, the plaintiff came to know about the defendants running a training institute under the name and style of 'VOGUE Institute of Fashion Technology' and using the slogans like 'VOGUE' the great career option. This act of the defendants amounts to infringing the registered trademark of the plaintiff and also amounts to passing off the services of the defendants as that of the plaintiff. Hence, the plaintiff issued a legal notice to the defendants on 31.03.1998. The defendants gave an untenable reply. Hence, the suit was filed for permanent injunction and rendering of accounts.

5. The defendants contested the suit and filed their written statement. It is contended that the plaintiff is not entitled for any relief as sought, as the name 'VOGUE' does not form part of the plaintiff's name or trading style. Thus, it cannot be stated to be a trademark in respect of plaintiff's

business. That magazines are not covered by Class-16, as such, the plaintiff cannot claim the right to all and everything. The plaintiff has committed fraud and misrepresentation and got registration of the trademark. The defendants are not selling the product like a magazine; there is no similarity between the business of the defendants and the plaintiff. The defendants are running an Educational Institute which is totally different from the business of the plaintiff and there is no similarity between them. The pleadings of the plaint do not disclose which branch of substantive law the plaintiff relies on to claim the relief prayed. It is also further contended by the defendants that the word 'VOGUE' is a common English word with a meaning (i) the leading place in popularity or acceptance, (ii) (a) popular acceptance or favor, (b) a period of popularity, and (iii) one that is in fashion at a particular time. Based on the meaning, they chose the same for the Educational Institute run by them. No monopoly can be claimed by any person in respect of ordinary English words of common use. Defendant No.2 is a proprietary concern of Mrs.Rukmini Kariappa and in order to establish its right in

the name of 'VOGUE Institute of Fashion Technology' got registered copyright in the said name and the logo as A-55364/98 and is in no way similar to that of the plaintiff. The defendants had right since 1996 and have been associated with Lectra Systems of France in relation to transfer of latest technology, know how pertaining to garment/fashion and computer technology. They had association with French Organisation from its inception and does not have to seek to gain its reputation from any other source. The defendants are doing good work as an Educational Institution and now able to conduct classes affiliated to Bangalore University and offer a Three year degree course, being Bachelor in Fashion and Apparel designing [B.Sc., FAD]. In order to promote their Institute, the defendants have advertised in the newspapers, magazines and signboards and have spent considerable amount and have gained reputation over the period only because of the quality of Education rendered and for dedicated service. The defendants have built up a reputation on its own as an Institution for training and the Bangalore University has recognized the same and they have been

permitted to run a degree course. On the above grounds, they pray for dismissal of the suit.

6. Based on the pleadings, the trial Court has framed the following issues for consideration:

1. Whether the plaintiff proves that it is the proprietor of the world famous trademark 'VOGUE' in respect of fashion magazine and is using the said trademark for over one hundred years since 1892 and it is the registered proprietor in India?
2. Whether the plaintiff proves that through over 100 years of use, plaintiff trademark VOGUE has been exclusively identified with the plaintiff?
3. Whether the plaintiff proves that the use of its world famous trademark VOGUE by defendant was to trade upon and benefit from reputation attached to its trademark VOGUE and to cause loss to it?
4. Whether the defendants prove that there is no similarity between the names and their name is sufficiently distinguished?
5. Whether the plaintiff is entitled for the relief of permanent injunction as prayed?
6. Whether the plaintiff is entitled to seek direction against the defendants to render an account of profits?
7. Whether the plaintiff is entitled for a decree for the amount due after the defendants have rendered an account?
8. What order or decree?

7. The plaintiff, in order to prove its case, has examined three witnesses and got marked Exs.P.1 to P.51. The defendants examined one witness and got marked Exs.D1 to D.10.

8. Based on the pleadings and evidence let in, the trial court has answered the aforementioned issues in the following manner:

Issue No.1: Affirmative.

Issue No.2: Affirmative.

Issue No.3: Affirmative.

Issue No.4: Negative.

Issue No.5: Affirmative.

Issue No.6: Affirmative.

Issue No.7: Affirmative.

Issue No.8: As per final order.

9. Consequently, the suit of the plaintiff has been decreed and the following order has been passed:

"The suit is decreed with costs. The defendants 1 and 2 are hereby restrained from using the trademark 'VOGUE' as a part of their name and trading style by way of permanent injunction.

Further the defendants 1 and 2 are hereby directed to render accounts of profits to the plaintiff made by using the trademark 'VOGUE'. The plaintiff shall recover the

amount from the defendant after ascertaining from accounts of profits furnished by the defendant.

Draw decree accordingly."

Aggrieved by the same, the instant appeal is preferred by the defendants.

10. The appellants/defendants pray that the appeal be allowed on the following grounds:

I. 'VOGUE' is a Generic word.

It is contended that 'VOGUE' is a common English word and it is not a coined word and that the plaintiff cannot prevent others from using the word and cannot monopolise the same. In support of the said contention, the appellants rely on the following decisions:

(a) LAL BABU PRIYADARSHI v. AMRITPAL SINGH [(2015) 16 SCC 795]. Paragraph No.16 reads as under:

"16. The appellant herein filed an application dated 25.08.1994 being No.638073-B in Class 3 for registration of a trademark consisting of the word "RAMAYAN" with the device of crown in respect of incense sticks (agarbattis) and perfumeries, etc. The appellant herein claimed the user since 1-1-1987. He further filed a request to rectify the user from 1-1-1981 which was allowed by the Assistant Registrar of

Trademarks. While opposing the application in Class 3 for registration of the trademark, the respondent herein filed a notice of opposition under Sections 9, 11(a), 11(b), 11(e), 12(1) and 18(1) of the Act. He claimed the use of the trademark "BADSHAH RAMAYAN" prior to the appellant herein. The respondent herein put forth an objection that the impugned mark, being name of a religious book, cannot become the subject-matter of monopoly for an individual. He further added that his application for the registration of the same trademark claiming user since 5-11-1986 is pending for registration. The application was further opposed with the reasoning that it carries a large sentimental value for the people and therefore, no one can claim sole right to the use of such a word. It was also admitted by the respondent herein that more than 20 traders in Patna are using the trademark "RAMAYAN". Finally, it was submitted that the impugned mark is identical with the respondent's mark "BADSHAH RAMAYAN" which is pending registration and the impugned registration will cause confusion among general public. Though the Assistant Registrar of Trademarks dismissed the application filed by the respondent herein, the Board set aside the said order after holding that the trademark "RAMAYAN" is not distinctive of the goods of the appellant as it is being used as a mark for the same products by more than 20 traders in Patna and in different parts of the country and has become public juris and common to the trade."

(b) S.B.L. LIMITED v. HIMALAYA DRUG CO.
(AIR 1998 DEL 126). Paragraph No.25 reads as under:

"25. To sum up :-

(1) *The crucial tests to be applied for judging an infringement action or a passing off action in the field of medicinal and pharmaceutical preparations remain the same as are applicable to other goods. However, in the case of preparations trading whereof is governed by statutory rules or regulations, additional considerations become relevant. They are : (i) the manner in which the trade is carried on, such as sales being made only by authorised or licensed vendors who will be educated, also having special knowledge of medicines and pharmacy; (ii) the class of persons who would be the purchasers, whether they would be accompanied by doctors' prescription and would in all probability remain in touch with doctor while consuming the medicine purchased. The court would ask - Is there such a similarity between the two trademarks that a doctor or a chemist or the both by some carelessness in expression, some obscurity in handwriting, some slip of recollection or some careless mistake not expected of a trained professional like doctor or chemist might lead to the one being confused for the other ? Regard shall be had not to the hypothetical possibilities but to ordinary practical business probabilities as applied to the circumstances of an individual case.*

(2) *The decision on the question of likelihood of deception is to be left to the court.*

(3) *Nobody can claim exclusive right to use any word, abbreviation, or acronym which has become public juris.*

In the trade of drugs it is common practice to name a drug, by the name of the organ or ailment which it treats or the main ingredient of the drug. Such organ, ailment or ingredient being public juris or generic cannot be owned by anyone for use as trademark.

(4) Whether such feature is public juris or generic is a question of fact.

(5) If the two trademarks by two competing traders use a generic word or an expression public juris common to both the trademarks it has to be seen if the customers who purchase the goods would be guided by the use of such word expression or would ignore it and give emphasis to prefixes or suffixes or words used in association therewith. The primary question to be asked is what would remain in the memory of customer ? The surrounding circumstances such as the presentation of goods, colour scheme and lettering style etc., used on the packing also assume significance."

II. The claim of the plaintiff is not established by the evidence let-in by them.

It is contended that the plaintiff has produced two reports which are investigation reports to demonstrate the awareness of VOGUE Magazine in India and they do not establish that many people in India are aware of the said magazine. So, the question of passing off does not arise

and the evidence let-in by the plaintiff does not prove that much of the general public are aware as to that Magazine.

III. The Trademark of the plaintiff is registered under the category - Class 16 and it does not cover the activity of the defendants i.e., a Fashion Institute and that the plaintiff has no trademark over the same. Thus, there is no infringement of trademark by the defendants and as already stated above, as many people in India are not aware of VOGUE magazine, the defendants using the name 'VOGUE' for its Institute does not amount to passing off and the plaintiff has miserably failed in proving the same and that the trial Court erred in holding it otherwise.

IV. The reputation of Trademark to be Territorial.

Mere assertion of transborder reputation of a trademark is not sufficient for the Court to conclude so and the Court should consider overall circumstances of the case having due regard to the documentary materials before the Court. The Courts must necessarily have to determine if there has been spillover of the reputation and

goodwill of the mark used by the plaintiff based on the adequate evidence on record to demonstrate the substantial goodwill for the subject brand and that the plaintiff has failed to establish the same. Mere presence in International market does not mean that they are well known in India. It is incumbent upon the user of trademark to plead and prove the twin concepts of goodwill and business to demonstrate that it has acquired business reputation in another domain in order to be entitled to be protected. To establish the said proposition, the defendants rely upon the following decision:

TOYOTA JIDOSHA KABUSHIKI KAISHA V. PRIUS AUTO INDUSTRIES LIMITED AND OTHERS [(2018)2 SCC 1]. Paragraph No.37 reads as under:

"37. Whether the second principle evolved under the trinity test, i.e., triple identity test laid down in Reckitt and Colman Ltd. (supra) would stand established on the test of likelihood of confusion or real/actual confusion is another question that seems to have arisen in the present case as the Division Bench of the High Court has taken the view that the first test, i.e., likelihood of confusion is required to be satisfied only in quia timet actions and actual confusion will have to be proved when the suit or claim is being adjudicated finally as by then a considerable period of time following the initiation of the action of passing off might have elapsed. Once the claimant who has brought the action of passing off establishes his goodwill in the jurisdiction in which he claims that the defendants are trying to

pass off their goods under the brand name of the claimant's goods, the burden of establishing actual confusion as distinguished from possibility thereof ought not to be fastened on the claimant. The possibility or likelihood of confusion is capable of being demonstrated with reference to the particulars of the mark or marks, as may be, and the circumstances surrounding the manner of sale/marketing of the goods by the defendants and such other relevant facts. Proof of actual confusion, on the other hand, would require the claimant to bring before the Court evidence which may not be easily forthcoming and directly available to the claimant. In a given situation, there may be no complaints made to the claimant that goods marketed by the defendants under the impugned mark had been inadvertently purchased as that of the plaintiff/claimant. The onus of bringing such proof, as an invariable requirement, would be to cast on the claimant an onerous burden which may not be justified. Commercial and business morality which is the foundation of the law of passing off should not be allowed to be defeated by imposing such a requirement. In such a situation, likelihood of confusion would be a surer and better test of proving an action of passing off by the defendants. Such a test would also be consistent with commercial and business morality which the law of passing off seeks to achieve. In the last resort, therefore, it is preponderance of probabilities that must be left to judge the claim."

V. It is also contended on behalf of the defendants that the plaintiff in the trial Court is confused whether the case is one that of passing off or infringement. It is also contended that the registration of trademark 'VOGUE' has not been properly established by the plaintiff in the manner known to law.

VI. The defendants further submitted that they are honest and concurrent user of the word 'VOGUE' and they have spent their own efforts, time and money to build a goodwill in this regard. The defendants rely upon the following decisions and contend that under the circumstances, the suit of the plaintiff deserves to be dismissed:

(a) VISHNUDAS TRADING AS VISHNUDAS KISHENDAS v. VAZIR SULTAN TOBACCO CO. LTD., HYDERABAD AND ANOTHER [(1997)4 SCC 201]. The relevant portion of paragraph No.48 reads as under:

*"48. The "class" mentioned in the Fourth Schedule may subsume or comprise a number of goods or articles which are separately identifiable and vendible and which are not goods of the same description as commonly understood in trade or in common parlance. Manufactured tobacco is a class mentioned in Class 34 of Fourth Schedule of the Rules but within the said class, there are number of distinctly identifiable goods which are marketed separately and also used differently. In our view, it is not only permissible but it will be only just and proper to register one or more articles under a class or genus if in reality registration only in respect of such articles is intended, by specifically mentioning the names of such articles and by indicating the class under which such article or articles are to be comprised.
....."*

(b) M/S. NANDHINI DELUXE v. M/S. KARNATAKA CO-OPERATIVE MILK PRODUCERS FEDERATION LIMITED [AIR 2018 SC 3516]. The relevant portion of paragraph No.31 reads as under:

"31. We may mention that the aforesaid principle of law while interpreting the provisions of the Trade and Merchandise Marks Act, 1958 is equally applicable as it is unaffected by the Trade Marks Act, 1999 inasmuch as the main object underlying the said principle is that the proprietor of a trade mark cannot enjoy monopoly over the entire class of goods and, particularly, when he is not using the said trade mark in respect of certain goods falling under the same class."

VII. The defendants further submitted that the defendants started its Institute way back in the year 1993 and the suit has been filed only in the year 1999. This amounts to acquiescence on the part of the plaintiff for the Institution of the defendants and accordingly, the suit has to be dismissed. In this regard, the defendants have relied upon the following decision:

VEERUMAL PRAVEEN KUMAR V. NEEDLE INDUSTRIES (INDIA) LTD. AND ANR. [2001 SCC Online Del 892].

Paragraph No.33 reads as under:

"33. On appreciation of the facts of the case we are unable to agree with conclusion of the learned

Single Judge that the adoption of the trademark '555' is dishonest. Delay simplicitor may not be a defense in a suit for infringement of trademark but where a trader allows a rival trader to expend money over a considerable period in building up a business with the aid of a mark similar to his own he will not be allowed to stop his rivals' business. If he were permitted to do so great loss would be caused not only to the rival trader but to those who depend on his business for their livelihood."

VIII. It is further contended that the subject trademark 'VOGUE' is used by many third parties and that the defendants have got a copyright registered in their favour which includes the use of the word 'VOGUE'.

IX. It is also submitted that the defendants have changed its name to *Vogue Career Options Private Limited* and the plaintiff has not taken steps to implead it and the suit had to be dismissed for non-compliance of Order XXII Rule 10 of CPC.

For the aforementioned reasons, the defendants pray that the suit be dismissed.

11. Per contra, the respondent/plaintiff prays for dismissal of the appeal on the following grounds:

I. In a passing off action, there cannot be a defence of 'generic word'. What matters is, in a passing off action is the reputation of the person and whether the Institution of the defendants can be passed off as the Institution of the plaintiff and that the plaintiff has been able to establish that the institution of the defendants can be passed off as the institution of the plaintiff and thus are entitled to protection. The plaintiff has relied on the following decision in this regard:

MYSORE SAREE UDYOG VS. MYSORE SILK UDYOG [1999 PTC (19) 389(Karn)]. The relevant portion of the judgment reads as under:

"..... The question is not whether the trade mark used by the defendant is distinguishable but whether it is deceptively similar one. As I am satisfied that the present name of "Mysore Silks Udyog" under which the defendant is carrying out the business is deceptively similar to the trade style of the plaintiffs' "Mysore Saree Udyog", in my opinion, this is a fit case to grant interim injunction which unfortunately has been rejected by the trial Court."

II. Though the defendants have alleged that third parties have been permitted to use the word 'VOGUE', they have failed to adduce any evidence in this regard. It is further submitted that the owners of the trademarks or copyrights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. It is sufficient that if they take action against the person who is affecting their business. In this regard, the plaintiff has relied upon the following decisions:

(a) DR. REDDY'S LABORATORIES LTD. V. REDDY PHARMACEUTICALS LIMITED [2004(29) PTC 435 (Del)]. The relevant portion of paragraph No.17 reads as under:

"17.

This plea of the defendant is also prima facie untenable for the reason that till August, 2003 there was no clash of interests between the plaintiff and defendant company and in fact the defendant was engaged in advancing and promoting the business of the plaintiff company by acting as its agent for the sale of bulk drugs. The threat came in August, 2003 when the defendant introduced in the market its pharmaceutical preparations and thereby threatened the business interests of the plaintiff company. This move of the defendant was mala fide on the face of it as it was not manufacturing pharmaceutical preparations earlier but now it was trying to market the

pharmaceutical preparations manufactured by others under the trade mark "Reddy". The plaintiff immediately raised objections, meetings were held and when nothing came out the plaintiff rushed to the Court. As such there was neither any acquiescence nor any laches on the part of the plaintiff to object to the impugned action of the defendant. It cannot be said that the plaintiff has allowed the defendant to build a reputation or goodwill in trade name "Reddy" for use on pharmaceutical preparations. Moreover, the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of harming their business interests, they may overlook and ignore petty violations till they assume alarming proportions. If a road side Dhaba puts up a board of "Taj Hotel", the owners of Taj Group are not expected to swing into action and raise objections forthwith. They can wait till the time the user of their name starts harming their business interests and starts misleading and confusing their customers."

(b) CORN PRODUCTS REFINING COMPANY V. SHANGRILA FOOD PRODUCTS LTD. [AIR 1960 SC 142]. Paragraph No.17 reads as under:

"17. We think that the view taken by Desai, J., is right. It is well known that the question whether the two marks are likely to give rise to confusion or not is a question of first impression. It is for the court to decide that question. English cases proceeding on the English way of pronouncing an English word by Englishmen, which it may be stated is not always the same, may not be of much assistance in our country in deciding questions of phonetic

similarity. It cannot be overlooked that the word is an English word which to the mass of the Indian people is a foreign word. It is well recognised that in deciding a question of similarity between two marks, the marks have to be considered as a whole. So considered, we are inclined to agree with Desai, J., that the marks with which this case is concerned are similar. Apart from the syllable 'co' in the appellant's mark, the two marks are identical. That syllable is not in our opinion such as would enable the buyers in our country to distinguish the one mark from the other."

III. In litigations before other High Courts, the plaintiff has obtained a favourable order under similar circumstances:

(a) ADVANCE MAGAZINE PUBLISHERS, INC. V. SHAKEEL AHMED (Civil Suit No.2487/2008). Paragraph Nos.9, 12, 14, 16, 35, 37, 41 and 42 read as under:

"9. It is in aid of such suit instituted on 17th April, 2008 that the Plaintiff has moved an application for interim relief being the current Notice of Motion. Therein the relief claimed is of temporary injunction to restrain the Defendants, his representatives and servants from using the trade mark B'VOGUE or any other mark identical/deceptively similar to the Plaintiff's well known trade mark VOGUE in relation to their business and / or services/ goods and thereby passing off their business and/or services/goods as that of the Plaintiff. This Notice of Motion was instituted in July, 2008 and is listed for hearing and final disposal."

to be argued is that there is distinct class of consumers and readers and they have been frequently using the services of the Defendant and there cannot be any confusion in their minds in relation to association of the Defendant with the Plaintiffs. This itself is nothing but an attempt to show that there may be adoption and usage by the Defendant, but there will be no confusion in the minds of consumers, is the emphasis in the submission of Mr. Parikh. That is clearly belied by the fact that the fashion magazine covering all such aspects as are enumerated above, is subscribed and read by the elite and rich class of consumers worldwide and even in India and what the Defendant has prima facie demonstrated is that the Plaintiffs' activities are in printing and publishing magazines and periodicals in relation to fashion. It is therefore, prima facie clear that the Plaintiffs and Defendant, both having stylized and elite class of consumers, the impression that the saloon of the Defendant is part of the activities or is associated with the Plaintiffs, cannot be ruled out.

42. *It is in these circumstance that I am of the opinion that the Plaintiffs have made out a prima facie case. There is no substance in the contention that the application of the Plaintiffs deserves to be dismissed on the ground of delay and laches. The principles are well settled to require any reiteration. No positive act is the foundation by which this relief can be denied by applying the principles of acquiescence. This is not even demonstrated even prima facie by the Defendant. Secondly, it is not the Plaintiffs fault that the application/motion has remained pending for all these years. The application has been made immediately after*

the Plaintiffs' mark, a property of very considerable value and repute. As to similarity, there can be no doubt; there is nothing to distinguish the Defendants' mark from the Plaintiffs' mark. The Defendants can have no monopoly in London; take that out and all that remains is the Plaintiffs' mark. Prima facie, it is also not possible to argue, even at this stage, that the mark VOGUE, as it is used in relation to apparel or fashion, is publici juris. I am also unwilling to accept a possible argument that the Plaintiffs' use is in relation to a magazine, whereas the Defendants' use is in relation to actual apparel. The Plaintiffs' mark is far too well-known to admit of so nice a distinction, in my prima facie view."

IV. There has been no delay or laches or acquiescence on the part of the plaintiff and that action has been initiated against the defendants once the plaintiff came to know about the passing off and notices have been issued to the defendants from 31.03.1998 itself.

V. The plaintiff has been able to establish by the evidence adduced that it is an internationally reputed magazine and it has registered its name 'VOGUE' in United Kingdom, Italy, France, Taiwan, Australia, Korea and other countries and that the name of the plaintiff has been associated with Fashion and the defendants are using the

said name only with a view to pass off their institution as that of the plaintiff.

VI. The reputation of the plaintiff has spilled over to India prior to adoption of the mark by the defendants. That the plaintiff has been able to show a connection in the course of the trade between the goods of the plaintiff and the defendants and the use of identical or deceptively similar mark by the defendants is for the sake of deceiving and causing confusion amongst its customers and that in the instant case, the plaintiff has used the word 'VOGUE' mark from 1892, and in India, it has obtained the registration of trademark in 1976 and that its magazines are well known in the field of Fashion and non-examination of the deponent who has sworn to the Certificate would not dilute or invalidate the evidence contained in the document and relies upon the following decisions:

(a) ARJUN PANDITRAO KHOTKAR V. KAILASH KUSHANRAO GORAANTYAL AND ORS. [AIR 2020 SC 4908]. Paragraph 34 reads as under:

"34. Despite the law so declared in Anvar P.V. (supra), wherein this Court made it clear that the special provisions of Sections 65A and 65B of the Evidence Act

are a complete Code in themselves when it comes to admissibility of evidence of information contained in electronic records, and also that a written certificate under Section 65B(4) is a sine qua non for admissibility of such evidence, a discordant note was soon struck in Tomaso Bruno (*supra*). In this judgment, another three Judge Bench dealt with the admissibility of evidence in a criminal case in which CCTV footage was sought to be relied upon in evidence. The Court held:

"24. With the advancement of information technology, scientific temper in the individual and at the institutional level is to pervade the methods of investigation. With the increasing impact of technology in everyday life and as a result, the production of electronic evidence in cases has become relevant to establish the guilt of the accused or the liability of the defendant. Electronic documents *stricto sensu* are admitted as material evidence. With the amendment to the Evidence Act in 2000, Sections 65-A and 65-B were introduced into Chapter V relating to documentary evidence. Section 65-A provides that contents of electronic records may be admitted as evidence if the criteria provided in Section 65-B is complied with. The computer generated electronic records in evidence are admissible at a trial if proved in the manner specified by Section 65-B of the Evidence Act. Sub-section (1) of Section 65-B makes admissible as a document, paper printout of electronic records stored in optical or magnetic media produced by a computer, subject to the fulfilment of the conditions specified in sub-section (2) of Section 65-B. Secondary evidence of contents of document can also be led under Section 65 of the Evidence Act. PW 13 stated that he saw the full video

recording of the fateful night in the CCTV camera, but he has not recorded the same in the case diary as nothing substantial to be adduced as evidence was present in it."

(b) SUN PHARMACEUTICALS INDUSTRIES LTD. V. MUKESH KUMAR P. AND ORS. [2013(55) PTC 209 (DEL)]. Paragraph 16 reads as under:

"16. Section 65B(4) provides for an alternative method of proving an electronic record by producing the certificate of a person in whose custody the computer device in which the document was stored in an electric form remained. In Rakesh Kumar and Ors. v. State 183 (2009) DLT 658, it was held that "sub-Section (4) of Section 65B provides for an alternative method to prove electronic record. Sub-section (4) allows the proof of the conditions set out in sub-Section (2) by means of a certificate issued by the person described in Sub-section 4 and certifying contents in the manner set out in the sub-Section. The sub-Section makes admissible an electronic record when certified that the contents of a computer printout are generated by a computer satisfying the conditions of sub-Section 1, the certificate being signed by the person described therein." In other words, no oral testimony of the person issuing the certificate may be necessary unless there is challenge to the accuracy of the computer evidence on account of misuse of the system or operational failure or interpolation. Consequently, the aforementioned objection of the Defendants is rejected."

(c) MAC PERSONAL CARE PVT. LTD. AND ORS. V. LAVERANA GMBH AND CO. KG AND ORS. [2016(65) PTC 357 (DEL)]. Paragraph Nos.18 to 21 read as under:

"18. In our opinion anything done at a commercial level should suffice to achieve the prima-facie satisfaction unless it can be called de minimis or trivial. Even if one is to assess in a rough way the amount or magnitude of the international reputation, there can be certain factors which assists in this process. If the trademark is registered in favour of the plaintiff in a jurisdiction abroad, said fact would demonstrate:-

(i) That the proprietor has declared to the world that the subject matter is its trademark;

(ii) That the declaration has been made in a public record open to inspection under the Trademark Laws of most jurisdictions; and

(iii) That in all probability, the Registering Authority of the registering country satisfied itself that the mark was distinctive and therefore, capable of distinguishing the Registrant's Trademark from those of other traders.

19. As against a single registration, registrations in multiple jurisdictions create an even stronger presumption that reputation inures in favour of the trademark.

20. If international magazines, journals and publications including books have referred to the trademark, then such publications, depending upon their renown can be taken as valuable of reputation, even if they are few.

21. Volume of sales is also valuable evidence of reputation to form a prima-facie opinion."

(d) AKTIEBOLAGET VOLVO OF SWEDEN V. VOLVO STEELS LTD. OF GUJARAT (INDIA) [1998 PTC (18) 47 (BOM)]. Paragraph No.65 reads as under:

"65. The most important material on which Shri Tulzapurkar led emphasis was publication entitled 'Brands' which is an international review by Interbrand which was first published in 1990 and reprinted in 1991. It is stated on the cover note that the concept of the brand started to grow in importance about a century ago. Indeed, many of today's greatest brands, among them Kodak and Coca-Cola, date from this period and branding is now of central importance to producers to differentiate their products or services around the world. Brands are, for many companies, the engines of growth and profitability and by far their most valuable assets. The book is about the growth and development of the world's most successful brands, how they started, and where they are today. The book describes, on a brand by brand basis, what makes each brand powerful and how each brand is differentiated from others. The scope of the book is international including brands which have power worldwide like Kellogg's and brand which operate mainly on a local basis like Snow Brand in Japan and Vegemite in Australia. It is expressly stated that only the world's leading brands have been represented here. They have been selected by Interbrand Group plc., the world's leading branding consultancy. Its selection of leading brands has been culled from an initial working list of over 500 brands which incorporate those key characteristics that, in the view of Interbrand,

constitute brand strength. These factors include leadership, stability, trend and support, as well as the markets in which the brand operates. Interbrand's selection focuses on brands with strong and distinctive brand personalities and favours free-standing product brands rather than more generalised corporate brands. A reference to 'Volvo' is found on page 101 of the book and this is what is written about Volvo :

"Volvo was founded in Sweden in the 1920s and the Volvo Group now has a worldwide turnover of some F10 billion. The word 'Volvo' means in Latin, 'I roll' and this distinctive trade mark was originally given to the fledgling car company by SKF, the Swedish bearing manufacturer, who had registered the name some years before but no longer needed it. Volvo reserves the brand name exclusively for its automotive products and has resolutely refused to allow third party licensing even for gift and novelty items as it is concerned that any dilution or misuse of the name may fundamentally damage its most valuable asset. In the luxury passenger cars sector of the automotive market, Volvo has a highly distinctive brand positioning with particular qualities of fine engineering, reliability, family values and care for the environment, all in a relatively wholesome Scandinavian context.

Most recently Volvo has formed an alliance with Renault to create a firm foundation for technical cooperation. The Volvo and Renault marks will, however, be kept entirely separate and no dilution of the brand identities will be allowed. It is also specifically mentioned that Volvo ranks alongside Kodak and Exxon in terms of hold. abstract branding and, like them, has benefited from being able to build a clear differentiated image."

(e) RANGOON CHEMICAL WORKS PVT. LTD. V. HAW PAR BROTHERS INTERNATIONAL LIMITED [2010(44) PTC 484 (KARN)]. Paragraph No.34 reads as under:

"34. With regard to the above, apart from the plaintiffs establishing the transborder reputation, the defendants themselves have filed the trade mark application No.244978 i.e., Ex.P133 with regard to their product being world famous and the said application has been made as if they are honest and concurrent user which would indicate that the defendants were aware of the existence of a similar product and mark. Further the enclosure to the said application is a pamphlet wherein it states 'No competitor in India for Tiger Balm' and in the said pamphlet the picture of a flying tiger and a hexagonal shaped bottle is indicated in the name of Rangoon Chemical Works. The said advertisement by the defendant stating that there is no competitor in India for Tiger Balm if considered in the background of the statement made in the written statement wherein it is stated that M/s Goolab and Moola company were the stockiest for Tiger Balm would indicate that the defendants were aware of the existence of the Tiger Balm as a product with the mark as leaping tiger and were attempting to trade upon such reputation. It also indicates that the Flying Tiger itself was being represented as if it is Tiger Balm by stating that there is no competitor in India for Tiger Balm. Hence the adoption in any event cannot be considered as honest adoption since it is not a situation where the defendants were not at all aware of a similar mark while adopting such mark and on coming to

know of such mark subsequently they have claimed such right of honest and concurrent user."

VII. The plaintiff has established its transborder reputation and it is not necessary to ascertain existence of real market but presence of the plaintiff through its mark within the territorial jurisdiction in a subtle form would suffice and it relies upon the following decisions:

(a) TOYOTA JIDOSHA KABUSHIKI KAISHA V. PRIUS AUTO INDUSTRIES LIMITED AND OTHERS [(2018)73 PTC 1]. Paragraph No.29 reads as under:

"29. To give effect to the territoriality principle, the courts must necessarily have to determine if there has been a spill over of the reputation and goodwill of the mark used by the claimant who has brought the passing off action. In the course of such determination it may be necessary to seek and ascertain the existence of not necessarily a real market but the presence of the claimant through its mark within a particular territorial jurisdiction in a more subtle form which can best be manifested by the following illustrations, though they arise from decisions of Courts which may not be final in that particular jurisdiction."

(b) LAVERANA GMBH & CO. KG V. MAC PERSONAL CARE PVT. LTD. AND ORS. [2015 (63)

PTC 87(DEL)]. The relevant portion of paragraph No.50 reads as under:

"50. The concept of trans-border reputation and goodwill is interesting in academic sense. However, due to advent of internet media, international travel, the insistence on the localized business as well as trans-border reputation is nowadays more or less dealt with in a kind of presumptive approach rather than by actual establishment of the same. As the international businesses grow and proximity between the markets would increase, over the time this concept will become weaker and on one good day world will be treated as one market."

VIII. The plaintiff and the defendants cater to the same pool of people although their businesses are different. It may be worthwhile to note as to who would be interested in the plaintiff's fashion magazine and in the defendants' Fashion Technology Institute. Anyone who would be interested in following fashion trends like new clothing, new designs and patterns would be interested in a fashion magazine. On the other hand, a fashion technology institute produces fashion professionals like fashion designers, fashion journalists and fashion merchandisers. Any person who aspires to be a fashion professional would

definitely be aware of the fashion magazine 'Vogue'. The business activities may be different but the field of activities are common between the plaintiff and the defendants. The plaintiff relies upon the following decisions in this regard:

(a) KIRLOSKAR DIESEL RECON PVT. LTD AND ANOTHER V. KIRLOSKAR PROPRIETARY LTD. AND ORS. [AIR 1996 BOM 149]. Paragraph No.13 reads as under:

"13. The expression 'common field of activity' was coined by Wynne-Parry J. in McCulloch v. Levis A. May (Product Distributors) Ltd. popularly known as 'Uncle Mac' case reported in 65 RPC 58 in which he held that its presence or absence was conclusive in determining whether or not there was passing off. However, the requirement that a 'common field of activity' is conclusive in determining whether there can be passing off has been extensively criticised by Manning J. in the case of Henderson v. Radio Corp. Pty. reported in (1969) RPC 218 holding that it would be unsafe to adopt the view expressed in McCulloch v. Mary that what has been called a common field of activity must be established in every case to entitle the plaintiff to succeed. He further held that it is going too far to say that the absence of this so-called common field of activity necessarily bars a plaintiff from relief. With the passage of time, law on requirement of common field of activity in a passing off action has radically changed. There is no requirement for a common field of activity to found a claim in passing off. In Marage Studies v. Counter Feat Clothing Co. Ltd. reported in (1991) FSR 145,

Browne Wilkison V-C said that the so-called requirement of the law that there should be a common field of activity is now discredited. The real question in each case is whether there is as a result of misrepresentation a real likelihood of confusion or deception of the public and consequent damage to the plaintiff. The focus is shifted from the external objective test of making comparison of activities of parties to the state of mind of public in deciding whether it will be confused. With the passage of time and reputation acquired, the trade mark 'Kirloskar' has acquired the secondary meaning and has become almost a household word. The judgments relied upon by Mr. Kane pertain to the cases of one type of business and not where variety of businesses have been carried by the plaintiff and defendant as in the instant case. The business activities of the Respondents vary from pin to piano as borne out from the object clauses of the Memorandums of Association of the Respondents. The Appellants have still to commence their business activities but as mentioned in the Memorandums of Association of 1st Appellant in each appeal, some of the object clauses therein over lap with the activities of Respondents and more particularly of Respondents Nos.6 and 7."

(b) P.C. MALLAPA & COMPANY v. Mc DONALD'S CORPORATION [1999(19) PTC 9 (Karn)]. Paragraph Nos.18 to 20 read as under:

"18. The suit filed by the respondent is one for bare injunction where the relief is to restrain the defendant from making use of logo "M" as they are passing off goods by making use of the plaintiff's logo.

19. *The parties have produced their respective mark Logo before the Court. The Logo "M" prefixed with the words Mallappa & Co., is similar and identical to that of Logo "M" used by the plaintiff. I do not find in the light of this admitted fact that the defendant has any defence to plead at this stage for making use of the plaintiff's Logo for promoting his business. Initially he has come out with a false plea that he is a manufacturer of sanitary wares. However, Mallappa & Co., is only trading style and he is selling the goods of others with this trading style Mallappa & Co., with logo "M" If these logos are compared, the contentions in the background in which they are pleaded, there is no mistaken mind of an ordinary customer that there is some connection between the plaintiff and the defendant in their trades.*

20. *What matters much in this case is the order of the Civil Court in O.S 11502 of 1994 filed by the appellant and failed to obtain an order of injunction restraining the respondent herein from interfering with his business by making use of Logo "M". The learned Sr. Counsel for the respondent is right in his submission that the counter injunction in this suit would create an incongruous situation. I have carefully scrutinised the discussion made by the learned trial Judge and the learned trial Judge upon elaborate consideration of the contentions, found prima facie case made out by the plaintiff. In addition, the balance of convenience is also in his favour. The appellant cannot be allowed to make use of the plaintiff's logo specially where the logo was registered in India under the Trade and Merchandise Marks Act, 1958. The trial Judge has appreciated the prima facie case made out by the parties and, has rightly exercised the*

discretion in favour of the plaintiff. The order in my opinion is neither perverse nor capricious and does not call for interference. The appeal is accordingly dismissed."

(c) RUSTON & HORNBY LTD. V. THE ZAMINDARA ENGINEERING CO. [AIR 1970 SC 1649]. Paragraph No.6 reads as under:

"6. The action for infringement is a statutory right. It is dependent upon the validity of the registration and subject to other restrictions laid down in Sections 30, 34 and 35 of the Act. On the other hand the gist of a passing off action is that A is not entitled to represent his goods as the goods of B but it is not necessary for to prove that A did this knowingly or with any intent to deceive. It is enough that the get-up of B's goods has become distinctive of them and that there is a probability of confusion between them and the goods of A. No case of actual deception nor any actual damage need be proved. At common law the action was not maintainable unless there had been fraud on A's part. In equity, however, Lord Cottenham L.C. in Millington v. Fox, 3 My & Cr. 338 held that it was immaterial whether the defendant had been fraudulent or not in using the plaintiff's trade mark and granted an injunction accordingly. The common law courts, however, adhered to their view that fraud was necessary until the Judicature Acts, by fusing law and equity, gave the equitable rule the victory over the common law rule."

IX. The onus and burden is on the defendants to show that the user and adoption at the initial stage was honest but the same was not proved in the instant case. For the aforementioned reasons, it is prayed that the appeal be dismissed.

12. Though the appellants/defendants have contended that the actual reputation of the plaintiff has not been established in the instant suit in the manner known to law, they have not been able to deny the International reputation of the plaintiff and admits that 'VOGUE' is an internationally reputed fashion magazine.

13. There is no dispute that the plaintiff and the defendants are using the word 'VOGUE' and the same are similar. The plaintiff in the course of arguments has given up its claim for infringement as it has registered its trademark 'VOGUE' Class 16 category and the business of the defendants is different.

14. In the instant case, the plaintiff has a registered trademark in Class 16 category under Number 315672B.

Class 16 of the Trade Marks Classification of Goods and Services reads as under:

"Class 16. Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers, type; printing blocks."

The plaintiff publishes the magazine pertaining to fashion and is internationally reputed. The trademark registered is under Class 16 as mentioned above. The defendants are running an institution under the name 'Vogue Institute of Fashion Technology' and it is an institution pertaining to Fashion Technology. Admittedly, the defendants/appellants are not publishing a magazine called 'VOGUE' but are running an institution. Thus, there is no infringement of trademark.

15. Under the circumstances, the question that arises for consideration in this appeal is, whether the use of the word 'VOGUE' by the defendants/appellants amounts to passing off their business as that of the plaintiff.

16. The gist of a passing off action is that a person has no right to pass off his goods or services as goods or services of someone else. It is an action for violation of common law rights and is enforceable in respect of all trademarks registered or unregistered. False and misleading representation resulting into deception or confusion is the key to the answer. The only aspect to be considered is whether the mark is likely to deceive or confuse the public who may buy defendants' goods as if they were the plaintiff's goods.

17. The Hon'ble Supreme Court in **CADILA HEALTH CARE LTD. VS. CADILA PHARMACEUTICALS LTD. [(2001)5 SCC 73]** in paragraph No.35 has held as under:

"35. 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.

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

Under the given facts and circumstances of the case, one needs to analyse the nature of goods/services in respect of

which the word 'VOGUE' is used by the plaintiff and the defendants and the class of purchasers who are likely to buy goods/services offered by the plaintiff and the defendants and based on their education, intelligence and the degree of care they are likely to exercise in availing the magazine of the plaintiff or the services of the defendants and are they likely to get confused.

18. The magazine which is published by the plaintiff is a fashion magazine which is not subscribed or read by large section of the general public. It is used by that limited section of the Society who are generally aware about fashion. The kind of purchasers who subscribe to the magazine of the plaintiff are likely to know that the plaintiff's magazine is involved only in the business of publishing magazines and not running any institute. Similarly, the persons who join the defendants' institute are those who have knowledge about the fashion world and taking into consideration the degree of care that an average student is likely to exercise, it is highly unlikely that they would confuse the institute of the defendants as one

belonging to the plaintiff. Further, no evidence is let in by the plaintiff to show otherwise.

19. The trial court has failed to appreciate the aforementioned factor. It has applied the test i.e., applicable to a common man who would get confused by the use of the word 'VOGUE' itself and has come to the erroneous conclusion that the defendants' institute can be passed off as the institute of the plaintiff.

20. For the aforementioned reasons, the appeal is allowed. The judgment and decree dated 25.09.2014 passed by XVIII Additional City Civil Judge, Bengaluru in O.S.No.2934/1999 is set aside. The suit of the plaintiff is hereby dismissed.

In view of disposal of the appeal, pending I.As., if any, do not survive for consideration and the same are hereby disposed of.

**SD/-
JUDGE**

hkh./VMB