

IN THE COURT OF THE DISTRICT JUDGE, THRISSUR

Present:

Sri. G.Girish., District Judge

Thursday, 6th day of July, 2023/15th Ashadha, 1945

I.A: 03/2023 in OS :01/2023

Petitioner/Plaintiff:-

ESAF small Finance Bank Limited,
Building No.VII/83/8, ESAF Bhavan,
Thrissur- Palakkad National Highway,
Mannuthy, Thrissur- 680 651, a Banking
Company rep by Senior Manager
Rajesh Kumar R, aged 45, S/o. Vasudevan Nair,
Pranavam House, Peruvayal Village,
Kozhikode Taluk, Kunnamangalam P.O.,
Kozhikode Dist., Pin- 673 571.

By Adv. Sri. Geofy George P.

Respondent/1st Defendant:-

SAAF CAPIT FEDERATION, Door No. 37/2060-3,
Chulliyil Tower, Sankarayya Road, West Fort,
Thrissur, Pin- 680 004 a company rep by
Managing Director.

By Adv. Sri.Vibin T.

This petition having been heard on 03.07.2023 and having stood over for consideration to this day, the court passed the following:-

ORDER

The plaintiff in the suit has filed this petition under Order 39 Rule 1 of the Code of Civil Procedure for temporary injunction against trademark violation and passing off at the instance of the 1st defendant.

2. The case of the petitioner/plaintiff is summarized as follows:- The plaintiff is a banking company licenced under Section 22(1) of the Banking Regulation Act, 1949 having trademark as shown in plaint A schedule. Ever since the plaintiff entered into banking business they have been trading under the name and

style “ESAF SMALL FINANCE BANK LIMITED”. The above trade name has acquired high reputation and goodwill as well as distinctiveness by virtue of continuous use from December 2015 onwards. The trademarks shown in plaint A schedule has been duly registered under class 36 with No.3459568 and 4392824 with validity upto 17.01.2027 and 30.12.2029 respectively. The plaintiff is having branch offices at different parts of the country, and its head office is situated at Mannuthy in Thrissur District, Kerala. The 1st defendant is a company represented by its Managing Director which conducts trade under the name and style “SAAF CAPIT FEDERATION” which phonetically and deceptively resembles the trade name and trademarks of the plaintiff. It is understood that the 1st defendant is giving the gullible public an impression that they are actually a part of the plaintiff’s banking business. It is known that the 1st defendant has been infringing the trademark and trade name of the plaintiff and passing off their business and services as those of the plaintiff by using the trade name and trademark described in plaint B and C schedule which are deceptively and phonetically similar and identical to the trademark and trade name of the plaintiff described in plaint A schedule. The defendant has recently started a new branch office at Mannuthy about 300 meters from the plaintiff’s head office. The above nefarious act on the part of the 1st defendant has been causing huge financial loss to the plaintiff in addition to loss of reputation. Hence the suit is instituted for damages and prohibitory and mandatory injunctions. Pending the disposal of the suit, the 1st defendant has to be restrained by a temporary injunction from carrying on their business with the trademarks and trade name shown in plaint B and C schedule which are phonetically and deceptively similar to the trademark of the plaintiff shown in plaint A schedule.

3. The respondent/1st defendant filed counter which is summarized as

follows:- The petition is not maintainable either in law or on facts. The logo of the respondent company is completely different from the logo of the petitioner company. Thus the contention of the petitioner that the respondent has been using trademark and trade name deceptively similar to the trademark of the petitioner, is absolutely false. The trademark and the trade name of the respondent are not visually or phonetically similar to the trademark and trade name of the petitioner. Both the logos and symbols are extremely different in terms of colour, similarity and identity. The business activities being conducted by the petitioner and respondent are also totally different. The petitioner is a public limited company having RBI licence to conduct banking business and to provide different types of loans to customers. But the respondent is a company incorporated under Section 8 of the Companies Act with an object to promote economic and developmental activities intended for the general welfare of the public. The respondent had never misused the registered trademark of the petitioner. The word "SAAF" used by the respondent is a generic word which literally means white, clean and pure in Hindi and other languages. It is not a coined or invented word of the petitioner. Thus the petitioner is not entitled to claim any kind of absolute statutory protection for it. There is no prima facie case for the petitioner. The respondent will be put to irreparable injury and hardship if the injunction sought for is allowed. Therefore the petition has to be dismissed.

4. Four documents were provisionally marked as Exts.A1 to A4 from the part of the petitioner, and one document was so marked as Ext.B1 from the part of the respondents for the purpose of this interim application.

5. **The point:-** Whether there is a prima facie case, supported by the elements of balance of convenience and irreparable injury, to grant a temporary injunction as prayed for in this petition?

6. Before going to the intricacies of the law relating to violation of the trademark rights of the parties, it is highly necessary to look into the question whether the trademark and trade name of the 1st respondent shown in plaint B and C schedule infringe the trademark and trade name of the petitioner shown in plaint A schedule. If only it is found that there is any such infringement, there arise the need to look into the question whether the 1st respondent is entitled to use the above trademark and trade name depicted in plaint B and C schedule.

7. Infringement of registered trademarks is dealt with in Section 29 of the Trade Marks Act 1999. As per Section 29(1) of the said Act a registered trademark is infringed when a person other than the registered proprietor or a permitted user uses, in the course of trade, a mark which is identical with or deceptively similar to the trademark in question in relation to the goods or services in respect of which that trademark is registered. As per Section 29(2) infringement of a registered trademark may be by way of three ways as enumerated thereunder in clause (a) to clause (c). As per the above provision infringement comes into play if a person other than the proprietor or permitted user, uses a trademark which, as a result of its identity with the registered trademark and the similarity of goods or services covered by it, or similarity to the registered trademark and the identity or similarity of the goods or services covered by it, or identity with the registered trademark and identity of the goods or services covered by it, is likely to cause confusion on the part of the public or to those who are likely to have association with the registered trademark. Thus, the identity or deceptive similarity of the challenged trademark with the registered trademark of the plaintiff to such an extent as to cause confusion on the part of the public or to those who are likely to have an association with the registered trademark, is the yardstick to ascertain whether there is infringement or not. It is also necessary to show that there is similarity or identity of the

goods or services in which the challenged trademark is being used by the offender and the goods or services in respect of which the trademark has been registered by the plaintiff.

8. The term ‘identity with the registered trademark’ and ‘similarity to registered trademark’ are not defined in the Trade Marks Act 1999. However, the provisions contained in Section 29(2) of the Trade Marks Act 1999 make it amply clear that the test to be applied to ascertain the ‘identity’ and ‘similarity’ referred above is to find whether it is likely to cause confusion on the part of the public or to those who are likely to have an association with the registered trademark.

9. The term “deceptively similar” is described in Section 2(1)(h) of the Trade Marks Act 1999 as follows: “*A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion*”. Therefore, to attract the term deceptive similarity it is not merely sufficient to show that the questioned trademark or trade name resembles the trademark or trade name of the plaintiff. On the other hand, it has to be established that the resemblance is to such an extent that it is likely to deceive or cause confusion in the minds of the persons using the products or the services concerned.

10. Now it is to be scrutinized whether the trademark and trade name shown in plaint B and C schedules are having resemblance of such an extent with the trademark and trade name shown in plaint A schedule so as to create confusion in the minds of the customers or to subject the customers to deception. It is apparent from the plaint A, B and C schedule that except for the similarity of the letters “SAAF” in the trademark of the respondent with the second, third and fourth letters shown as “SAF” in the trademark of the petitioner, there is absolutely no resemblance between the trademarks and trade

name of the petitioner and respondent. The font of writings, the colour given to such writings, the emblems shown by the side of the writings and the captions given beneath the writings in the trademarks and trade name of the petitioner and the respondent are totally different. It is also not possible to say that there is phonetic similarity in the trademarks of the petitioner and the respondent. This is because of the fact that the use of the letter “E” in the trademark of the petitioner would give a pronunciation to it which is clearly distinguishable from the pronunciation of the letters “SAAF” in the trademark of the respondent.

11. The learned counsel for the petitioner argued that the emblem inscribed on the left side of the trademark of the respondent resembles the letter “E”, and hence there is every possibility of the above trademark being misunderstood as the trademark of the petitioner. Per contra, the learned counsel for the respondent would contend that the above emblem shown on the left side of the letters “SAAF” is the pictorial representation of a phoenix bird and it could never be termed as the alphabetic letter “E” as submitted by the learned counsel for the petitioner. Whether it signifies the graphical representation of a phoenix bird or not, a primary look of the said emblem would give the impression that the letter “S” has been written in artistic imagination in the above manner. It is not possible to accept the argument of the learned counsel for the petitioner that the above emblem resembles the letter “E”, and hence there is the possibility of it being misread as “ESAAF”. Remote and far-fetched possibility of misconception cannot be attributed as the meaning of the term “nearly resembles” embodied in Section 2(h) of the Trade Marks Act, 1999. Therefore, the argument advanced by the learned counsel for the petitioner in the above regard is bereft of merit.

12. Since a bare perusal and comparison of the trademarks and trade name shown as plaintiff A schedule with the trademarks and trade name shown in

plaint B schedule and C schedule, itself reveal the marked and distinguishable features making it apparently different, it is not possible to accept the contention of the petitioner that the respondent is using trademark and trade name which are deceptively similar to the trademark and trade name of the petitioner.

13. It is also not possible to conclude on the basis of the available records of this case that there is identity or similarity of the goods or services rendered by the respondent and that of the goods or services of the petitioner to such an extent as to cause confusion on the part of the public or other persons having transactions with them. It is true that the documents marked as Exts.A1 to A4 would reveal that the petitioner as well as the respondent are registered with the authorities concerned in connection with financial services activities which include banking. At the same time, the Memorandum of Association of the respondent which is marked as Ext.B1 would go to show that the financial service activities of the respondent are apparently different from the banking service activities of the petitioner. Therefore, it is not possible to say that there is identity or similarity of the goods or services of the petitioner and the respondent so as to create confusion in the minds of the customers approaching them.

14. As a conclusion to the forgoing discussions, I find that the petitioner has failed to establish a prima facie case for the grant of temporary injunction as prayed for in this I.A. The point is so answered.

In the result, the I.A is hereby dismissed.

(Dictated to the Confidential Assistant, transcribed by her, corrected by me and pronounced in open court on this the 6th day of July, 2023).

Sd/-

**G. GIRISH.,
DISTRICT JUDGE.**

APPENDIX:Petitioner's Exhibits:

A1	17.09.2021	:	Legal certificate of Trademark certificate No.3459568.
A2	05.05.2016	:	Certificate of Incorporation certified true copy.
A3	04.08.2022	:	Print out of Form TM-A Firm ipindiaservices.gov.in/eregister.
A4	30.07.2022	:	Print out of Udyan Registration certificate of first defendant from ipindiaservices.gov.in/eregister.

Respondent's Exhibits:

B1	Memorandum of Association of SAAF CAPIT FEDERATION		
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Sd/-

DISTRICT JUDGE.

/true copy/

By Order,

Sheristadar

Copied by : kvs
 Compared by : kpb