

IN THE HIGH COURT OF JUDICATURE AT BOMBAY**ORDINARY ORIGINAL CIVIL JURISDICTION****SUIT NO. 678 OF 2014**

Brihan Karan Sugar Syndicate Pvt. Ltd., a]
company incorporated under the Companies]
Act, 1956 having its office at B-2 Daffodil,]
Hiranandani Garden, Pawai, Mumbai- 400076,]
Maharashtra] ... Plaintiff

VERSUS

Yashwantrao Mohite Krushna Sahakari Sakhar]
Karkhana, a Co-operative Society incorporated]
under The Maharashtra Co-operative Societies]
Act, 1960 having its Office at Shiv Nagar,]
Rethare Budruk, Satara, Maharashtra- 415 108]... Defendant

Mr. Hiren Kamod, along with Ms. Akshata Kamath, instructed by M/s. W.S.
Kane & Co., for the Plaintiff.
Mr. Kanhaiyalal Kalani, Director of the Plaintiff abovenamed, present.
Mr. A.B. Borkar for the Defendant.

CORAM : S. J. KATHAWALLA, J.
DATE : JULY 1, 2015.

JUDGMENT:

1. The Plaintiff is a private limited company incorporated under the Companies Act, 1956. According to the Plaintiff, the Plaintiff carries on an old, established and reputed business as manufacturer and seller of country liquor inter alia from its address mentioned in the cause title.

2. The Defendant is a Co-operative Society incorporated under The Maharashtra Co-operative Societies Act, 1960 having its office mentioned in the cause title. The Defendant carries on similar business as manufacturer and seller of country liquor.

3. The Plaintiff has filed the present Suit against the Defendant, inter alia, for an order and perpetual injunction restraining the Defendant from in any manner whatsoever, infringing the Plaintiff's registered trademark TANGO bearing registration No. 1051107 in Class 33 and also from passing off the Defendant's goods as and for those of the Plaintiff's goods and/or enabling others to do so by using bottles embossed with the trade mark "TANGO" with and/or without device of raised palm with three fingers pointing in the upward direction or by the use of the trade mark "TANGO" or any other trade mark deceptively similar to the Plaintiff's well-known

trade mark TANGO, upon or in relation to country liquor or similar goods or in any other manner whatsoever.

4. The Plaintiff has its office in Mumbai from where it is carrying on its business. Therefore, this Court has jurisdiction to entertain and try this suit so far as it relates to infringement of the Plaintiff's said registered trade mark by virtue of Section 134(2) of the Trade Marks Act, 1999 (hereinafter, "the Act"). The Plaintiff had filed Leave Petition No. 154 of 2014 for obtaining leave under Clause XIV of the Letters Patent to combine the cause of action for passing off with the cause of action for infringement, which leave was granted by this Court by an order dated 8th May, 2014.

5. The Plaintiff had also taken out Notice of Motion No. 1210 of 2014 seeking ad-interim and interim reliefs. By an order dated 21st November, 2014, the said Notice of Motion No. 1210 of 2014 was made absolute against the Defendant in terms of prayer clauses (a) and (b) of the said Notice of Motion.

6. The suit is listed under the caption "For ex-parte decree" today before me. Mr. Borkar, the Ld. Advocate for the Defendant has appeared before me today and requested for time to file Written Statement on behalf of the

Defendant, at this belated stage. I am not inclined to allow the said request of the Ld. Advocate, in view of the following:

7. On 9th June, 2014, Mr. Borkar, Advocate had appeared before this Court during the hearing of the Notice of Motion No,1210 of 2014 in the present Suit and thereafter filed his Vakalatnama on behalf of the Defendant.

8. On 27th January, 2015, when the present suit was listed before the Prothonotary and Senior Master, none appeared for the Defendant. On the said date, the Prothonotary and Senior Master passed a conditional order directing the Defendant to file its Written Statement on or before 23rd April, 2015 failing which the above suit was to be transferred to the list of undefended suits. The relevant portion of the order is reproduced hereinbelow:

“Defendant to file Written Statement on or before 23-04-2015, failing Suit against Defendant will be transferred to the list of Undefended Suits.”

9. Despite the conditional order dated 27th January 2015, the Defendant did not file its written statement. In fact, when the above matter came up for hearing before the Prothonotary and Senior Master on 23rd April, 2015, none appeared on behalf of the Defendant. By an order dated 23rd April, 2015, the above Suit was therefore transferred to the list of

undefended suits. The relevant portion of the said order dated 23rd April 2015 is reproduced herein below:

“On last occasion when matter appeared on my board on 27.01.2015 Conditional Order was passed, directing Defendant to file written statement till today, failing which Suit against Defendant will be transferred to the list of Undefended Suits. Today matter is listed under caption ‘Written Statement’. Despite that, neither Defendant is present nor filed written statement. Suit against Defendant is transferred to the list of Undefended Suits.”

10. Thereafter, the suit was listed under the caption “For Directions” before this Court on 10th June 2015, when again none appeared for the Defendant and the suit was directed to be listed today under the caption “For ex-parte decree”.

11. Even thereafter, the Defendant did not take any steps either to set aside the order dated 23rd April 2015 passed by the Prothonotary and Senior Master or to get the delay in filing the Written Statement condoned.

12. Today, Mr. Borkar, Advocate for the Defendant appears and seeks time without assigning any reason why the Defendant did not bother to file its written statement despite several opportunities being granted to do so. I would have still shown indulgence and considered granting some time to the Defendant at this belated stage, had the Defendant taken out a proper application for setting aside the orders passed by the Prothonotary and

Senior Master and for condonation of delay in filing the Written Statement but there is no such application taken out by the Defendant, even as on today. The Plaintiff, on the other hand, has been diligently prosecuting the above suit since the beginning. In view thereof, the Defendant's request for granting time to file Written Statement in the above matter, at this belated stage, is rejected. The above matter has therefore proceeded ex-parte against the Defendant.

13. Mr. Kanhaiyalal Kalani, Director of the Plaintiff Company, has filed his Affidavit dated 29th June, 2015 in lieu of Examination-in-Chief along with the Compilation of Documents which are taken on record and marked as **Exhibits P-1 to P-20** collectively.

14. Mr. Kamod, the Ld. Advocate for the Plaintiff submits that sometime in the year 2001, Brihan-Maharashtra Sugar Syndicate Ltd., the Plaintiff's predecessor, adopted a composite trade mark label containing the word "TANGO PUNCH" (in devnagari script) as its leading, essential and memorable feature for and in respect of its country liquor having either orange or lime flavor with a view to distinguish its said goods from those of the others. He submits that on or about 10th October, 2001, the Plaintiff's predecessor applied for and eventually obtained registration of its "TANGO PUNCH" trade mark label used in respect of country liquor having orange flavour under registration number 1051107 in Class 33 in respect of its said

goods. He submits that by Deed of Assignment made and executed on 9th June, 2008 by and between the Plaintiff's predecessor as the Assignor of the One Part and the Plaintiff as the Assignee of the Other Part, the Plaintiff's predecessor assigned and transferred unto and to the use of the Plaintiff inter alia the aforesaid registered trade mark bearing registration No.1051107 in Class 33, together with the goodwill associated therewith. He submits that the Plaintiff, thereupon, made a request on Form TM-24 dated 4th August, 2008 to the Registrar of Trade Marks to enter the Plaintiff's name as the proprietor of the said trade mark. Pursuant to the order dated 4th December, 2008 passed by the Ld. Registrar of Trade Marks on the said request, the name of the Plaintiff has been entered in the Register of Trade Marks as the subsequent proprietor of the aforesaid registered trade mark no.1051107 in Class 33. He submits that the registration of the said mark has been renewed and is currently valid and subsisting. The certified copy of the entries made in the Register of Trade Marks in respect of the registered trade mark No.1051107 for use in legal proceedings recording the Plaintiff as the proprietor of the said trade mark is at Exhibit P-1 of the Compilation of Documents.

15. Mr. Kamod submits that sometime in the year 2011, the Plaintiff conceived an idea to emboss its trade mark inter alia containing the word TANGO (written in devnagri script) with or without the device of a raised palm with the three fingers pointing in the upward direction on its front and

back surface on the bottles used by it to pack and sell its country liquor. He submits that since then the Plaintiff has sold its country liquor in the bottles embossed with the said trade mark. Photographs of some of the bottles of the Plaintiff embossed with its said trade mark "TANGO" (written in devnagri) on the front and back face are at Exhibits P-7 to P-9 of the Compilation of Documents. He submits that the Plaintiff's move to emboss its bottles with the said trade mark was driven by the need and strategy to distinguish its said goods from those of others by reference to the said trade mark "TANGO". He submits that during all these years, the trade mark TANGO has become immensely popular amongst the consumers and the Plaintiff has acquired immense reputation and goodwill in the said trade mark and the goods bearing the same. He submits that consequently, the said trade mark has been exclusively denoting, connoting and identifying the Plaintiff's country liquor.

16. Mr. Kamod submits that since the beginning, the Plaintiff and its predecessor have been continuously, openly and extensively using the said trade mark in respect of its said goods. He submits that during the said period the Plaintiff has also taken efforts to popularize its said goods bearing the said trade mark and has expended substantial sums of money on sales promotional expenses. Original statement dated 8th April, 2014 containing the Plaintiff's annual sales turnover and sales promotional expenses in respect of its country liquor bearing the said trade mark since the year 2008,

certified by the Plaintiff's Chartered Accountants and Plaintiff's original invoices relating to the sale of its said goods bearing the said trade mark TANGO are at Exhibits "P-2" and "P-3" to "P-6" respectively of the Compilation of Documents.

17. Mr. Kamod submits that the Plaintiff has been vigilant in safeguarding and protecting its rights in the said trade mark label and the word mark "TANGO" and has initiated legal action against third parties attempting to misappropriate or misuse the said mark or the word mark "TANGO". He submits that in or about April 2014, the Plaintiff came to learn that one Radico N.V. Distilleries Maharashtra Ltd. had started manufacturing, distributing and selling its country liquor in the bottles embossed with the Plaintiff's said trade mark TANGO (written in devnagri script) on its front and back face. The Plaintiff therefore filed Suit (L) No. 438 of 2014 in this High Court against Radico N.V. Distilleries Maharashtra Ltd. for restraining them from using the trade mark TANGO or bottles embossed with the trade mark "TANGO" and for other reliefs. In the said suit, the Plaintiff took out Notice of Motion (L) No. 1040 of 2014 for interim reliefs including temporary injunction. The Defendant therein, however, submitted to a decree of permanent injunction restraining it from infringing the Plaintiff's trade mark bearing registration No.1051107 in class 33 as also passing off its impugned goods as and for the Plaintiff's goods by use of the impugned

trade mark. Certified copy of the order dated 2nd May 2014 passed by this Court in the said Suit is at **Exhibit P-12** to the Compilation of Documents.

18. Mr. Kamod submits that sometime in the first week of November 2011, the Plaintiff came to learn that the Defendant has been selling country liquor in bottles embossed with the trade mark TANGO written in devnagri script with the device of a raised palm with three fingers pointing in the upward direction and also without the said device of raised palm on its front and back face respectively. The Defendant was found to be selling its country liquor in the said bottles bearing its label “DESHI DARU PAHILI DHAR SANTRA” (written in devnagri script). He submits that aggrieved by the use of the bottles embossed with the trade mark TANGO, the Plaintiff through its Advocate sent a cease and desist notice dated 8th November, 2011 to the Defendant informing the Defendant of its proprietary rights in the said trade mark TANGO and calling upon the Defendant to cease and desist use of bottles embossed with the impugned trade mark in respect of its country liquor. Office copy of the said cease and desist Notice dated 8th November, 2011 is at **Exhibit P-13** to the Compilation of Documents. In response to the said cease and desist notice, the Defendant by its letter dated 22nd November, 2011 stated that it has always taken care to not use bottles embossed with trade marks of other proprietors in respect of its country liquor and its use of the bottles embossed with the impugned trade mark in respect of its country liquor was owing to inadvertence on the part of the

Defendant. The Defendant assured the Plaintiff that henceforth it shall take utmost care and precaution to ensure that it does not use any bottle embossed with the Plaintiff's trade mark in respect of its country liquor. Mr. Kamod submits that believing the assurance given by the Defendant, the Plaintiff assumed that the Defendant has stopped using the bottles embossed with the Plaintiff's trade mark TANGO. The original reply letter dated 22nd November 2011 from the Defendant as received by the Plaintiff is at **Exhibit P-14** to the Compilation of Documents.

19. Mr. Kamod submits that in March 2014, the Plaintiff was surprised to once again come across the Defendant's country liquor sold in the bottles embossed with the Plaintiff's said trade mark TANGO (written in devnagri script) with the device of a raised palm with the three fingers pointing in the upward direction and also without the said device of raised palm on its front and back face respectively and bearing its label "DESHI DARU PAHILI DHAR SANTRA" (written in devnagri script). Photographs of the Defendant's impugned bottle embossed with the Plaintiff's said trade mark TANGO with and without device of raised palm with the three fingers pointing in the upward direction on the front and back face are at **Exhibits P-15 to P-18** to the Compilation of Documents. Despite the assurance, the Defendant continued using the bottles embossed with the Plaintiff's trade mark TANGO in respect of its country liquor and thereby committed acts of infringement

of Plaintiff's registered trade mark bearing No.1051107 in class 33 and passing off.

20. Mr. Kamod submits that the Plaintiff, before filing the present suit, through its Advocates sent a notice dated 8th March, 2014 as required under the provisions of The Maharashtra Co-Operative Societies Act, 1960 to the Registrar, Co-operative Societies, Pune informing them that it proposes to institute a suit for permanent injunction restraining the Defendant from using the bottles embossed with the trade mark TANGO or from using the trade mark TANGO or any other trade mark deceptively similar to the Plaintiff's trade mark TANGO in relation to its country liquor as more particularly stated in the said notice. Copies of the said notice were sent to the Defendant, the Commissioner of Sugar, The Regional Joint Director Sugar, Kolhapur Region and Mr. A.A. Katke and The District Deputy Registrar, Satara. The office copy of the notice dated 8th March, 2014 is at **Exhibit P-19** to the Compilation of Documents. He submits that by its Advocate's reply dated 26th April 2014 received by the Plaintiff on 28th April 2014, the Defendant falsely denied several statements and contentions in the Plaintiff's Advocate's notice dated 8th March 2014. The original reply dated 26th April, 2014 addressed by the Defendant's Advocate to the notice dated 8th March, 2014 as received by the Plaintiff is at **Exhibit "P-20"** to the Compilation of Documents.

21. Mr. Kamod submits that it appears that the Defendant has procured from the secondary market, the Plaintiff's bottles and used them to bottle and sell its country liquor in the said bottles. He submits that the use of the impugned bottles embossed with the impugned trade mark TANGO, in respect of the same goods, viz. country liquor by the Defendant without due cause takes unfair advantage of and is detrimental to the distinctive character and repute of the Plaintiff's said trade mark apart from causing confusion and/or deception among the consumers as to the trade origin.

22. Mr. Kamod submits that the use of the impugned bottles embossed with the Plaintiff's trade mark TANGO by the Defendant, amounts to infringement of the Plaintiff's said registered trade mark bearing No.1051107 in Class 33 in view of the provisions of Section 29 (2) (c) of the Trade Marks Act, 1999. He submits that the rival trade marks and goods, both are identical and in view of the said identity, the Court shall presume that the use by the Defendant of the impugned trade mark is in order to cause confusion in the minds of the public in view of the provisions of Section 29 (3) of the Act. He submits that the Plaintiff has acquired wide and enviable reputation and goodwill in respect of its said trade mark and the said goods sold thereunder and the Plaintiff's said trade mark TANGO is exclusively associated with the Plaintiff's country liquor. He submits that members of the trade and public who are acquainted with the Plaintiff's country liquor bearing the said trade mark TANGO, upon coming across the

Defendant's country liquor offered in impugned bottles embossed with the impugned trade mark TANGO are likely to be confused or deceived into believing that the Defendant's impugned goods are those of the Plaintiff and/ or are originating from the Plaintiff and/ or are connected in the course of the trade with the Plaintiff. Alternatively, they might be put in a state of wonderment as to origin of the impugned goods. He submits that by the aforesaid acts of manufacturing, bottling, marketing and selling country liquor in the impugned bottles embossed with the impugned trade mark TANGO, the Defendant is passing off its impugned goods as and for the Plaintiff's well-known goods.

23. Mr. Kamod submits that the Plaintiff's country liquor bearing the said trade mark is being sold across Maharashtra. He submits that the Defendant was therefore aware of and/ or ought to have been aware of the Plaintiff's country liquor sold under the said trade mark and the reputation acquired by the said trade mark, before manufacturing, bottling and selling the impugned goods in the impugned bottles. He submits that the Defendant has therefore knowingly and deliberately manufactured, bottled, sold and offered its goods in the impugned bottles embossed with the trade mark TANGO to cash upon the Plaintiff's goodwill and reputation in the trade mark TANGO.

24. Mr. Kamod submits that the Plaintiff has suffered and is likely to suffer irreparable loss to its trade and reputation on account of the aforesaid acts of infringement and passing off committed by the Defendant. He submits that unless the Defendant is restrained by a permanent order and injunction of this Court from continuing to commit the aforesaid acts of infringement and passing off, the Plaintiff will suffer irreparable loss and injury and pecuniary compensation will not be an adequate relief.

25. I have considered the submissions made on behalf of the Plaintiff and have also perused the pleadings and the evidence led by the Plaintiff. I find merit in the submissions made by Mr. Kamod, the Ld. Advocate for the Plaintiff. The Plaintiff has proved all its contentions satisfactorily by providing substantial material in support of the same. It is clear that the Defendant has merely procured from the secondary market, the Plaintiff's bottles embossed with the Plaintiff's trade mark and used them to bottle and sell its country liquor in the said bottles. The same is an admitted fact by the Defendant in its reply letter dated 22nd November, 2011. Despite the assurance given by the Defendant to the Plaintiff that it shall take utmost care and precaution to ensure that it does not use any bottle embossed with the Plaintiff's trade mark in respect of its country liquor, the Defendant has continued to use the same in respect of its country liquor. Whether the use by one entity, of the bottles embossed with another entity's registered trade

mark, for packing and selling one's own products, amounts to infringement and passing off was considered and decided by this Court in the case of **SABMiller India Ltd. Vs. Som Distilleries & Breweries Ltd.**¹, wherein this Court held:

22. As regards the Defendant's contention that the High Court of Madhya Pradesh has held that there is no possibility of confusion, it is clear that the High Court of Madhya Pradesh has expressed its view whilst determining the Plaintiff's claim that the Defendants are passing off their goods/products as that of the Plaintiff. The said finding of the High Court of Madhya Pradesh will not be of any assistance to the Defendant in the present suit which is for infringement of the Plaintiff's registered trade mark. [Section 29](#) (2) (c) and (3) of the Act are relevant and reproduced hereunder:

"29. Infringement of registered trade marks.-

(1)

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

(a)

(b)

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

¹ 2013 (54) PTC 291 (Bom)

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

*23. In the instant case, in view of the identity of the two marks and identity of goods, the statute requires that the Court shall presume that the use by the Defendant of the impugned trade mark is likely to cause confusion on the part of the public. Therefore, in the present suit, under [Section 29](#)(2) and (3) of the Act, a legal presumption is required to be raised by the Court, that having regard to the identity of the mark and identity of the goods, it is likely to cause confusion on the part of the public. In any event, in view of the decision of the Supreme Court in *Ruston & Hornsby Ltd.* (supra), no further enquiry is required to be called for, to find out whether there is in fact any confusion. In view thereof, the finding of the Madhya Pradesh High Court in a passing off action, cannot act as res judicata as regards the present suit and the said finding has no relevance to the issue involved in the present suit.*

*24. The Defendant's contention that the Defendant is using its own label bearing a different mark as also the name of the Defendant is no defence to the action for infringement. In this connection, reference may be made to the decision of the Supreme Court in the case of *Ruston & Hornsby Ltd.* (supra). Paragraphs 3, 7 and 8 of the said decision are relevant and reproduced hereunder.*

"3. The distinction between an infringement action and a passing off action is important. Apart from the question as to the nature of trade mark the issue in an infringement action is quite different from the issue in a passing off action. In a passing off action the issue is as follows:

"Is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe that they are the plaintiff's goods?"

But in an infringement action the issue is as follows: "Is the defendant using a mark which is the same as or which is a colourable imitation of the plaintiff's registered trade mark?"

7. In an action for infringement where the defendant's trade mark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. But where the alleged infringement consists of using not the exact mark on the Register, but something similar to it, the test of infringement is the same as in an action for passing off. In other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions.

8. In the present case the High Court has found that there is a deceptive resemblance between the word "RUSTON" and the word "RUSTAM" and therefore the use of the bare word "RUSTAM" constituted infringement of the plaintiff's trade mark "RUSTON". The respondent has not brought an appeal against the judgment of the High Court on this point and it is, therefore, not open to him to challenge that finding. If the respondent's trade mark is deceptively similar to that of the appellant the fact that the word 'INDIA' is added to the respondent's trade mark is of no consequence and the appellant is entitled to succeed in its action for infringement of its trade mark".

In the case of Kaviraj Pandit Durga Dutt Sharma (supra), the Supreme Court has in paragraph 28 of the Judgment at page 989 while noting the difference between an action for infringement and action for passing off, has observed as follows:

"28. 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."

The Defendant therefore cannot be heard to say that since the Defendant, in addition to the trade mark 'SABMILLER INDIA', is using its own label bearing a different mark as also the name of the Defendant, the question of any infringement or confusion being created or likely to be created in the minds of consumers does not arise.

The Appeal preferred by the Defendant in the case of SABMiller (supra) was dismissed by the Hon'ble Division Bench of this Court in the matter of Som Distilleries and Breweries Ltd. Vs. SABMiller India Ltd.². The Hon'ble Division Bench while confirming the above view, held:

4. Section [29\(1\)](#) of the Trade Marks Act 1999 provides that a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to the trade mark in relation to goods or services in respect of

² 2013 (56) PTC 237 BOM (DB)

which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark. Clause (c) of sub-section (2) of Section 29 provides that a registered trade mark is infringed by a person, who not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public or which is likely to have an association with the registered trade mark. Under sub-section (3) of Section 29 in a case falling under clause (c) of sub-section (2) a presumption is raised that it is likely to cause confusion on the part of the public. Undoubtedly that presumption is capable of being rebutted.

5. Now before we consider the facts of this case, it would be at the outset necessary to advert to the test which was formulated by the Supreme Court in the judgment in Ruston and Hornby Ltd. v. Zamindara Engineering Co. AIR 1970 SC 1649. to guide the adjudication of a case involving a claim of infringement. The Supreme Court held as follows:

It very often happens that although the defendant is not using the trade mark of the plaintiff, the get-up of the defendant's goods may be so much like the plaintiff's that a clear case of passing off would be proved. It is on the contrary conceivable that although the defendant may be using the plaintiff's mark in the get-up of the defendant's goods may be so different from the get-up of the plaintiff's goods and the prices also may be so different that there would be no probability of deception of the public. Nevertheless, in an action on the trade mark,

that is to say, in an infringement action, an injunction would issue as soon as it is proved that the defendant is improperly using the plaintiff's mark.

6. Consequently, in an action for infringement an injunction would issue once it is proved that the Defendant is improperly using the mark of the Plaintiff.

7. The facts as disclosed before the Court make it clear that-

(i) Both the Appellant and the Respondent are engaged in the sale of the same product viz. beer;

(ii) The bottles in which the Appellant sells its product have the same height and characteristic as the bottles in which the Respondent sells beer;

(iii) The Respondent is the registered proprietor of the marks SABMiller India and SABMILLER INDIA; and

(iv) The infringing bottles of the Appellant used the same mark as the registered mark of the Respondent.

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10. The case of the Appellant was that used bottles of beer are collected by the cabadis from the market and are sold back to the brewers for the purposes of recycling. In the process of recycling the previous labels are removed and the labels of the respective companies are affixed. The Appellant stated that though every possible care and precaution is taken to ensure that only the bottles bearing the labels and brand name of the Appellant are taken out in the recycling process, the

possibility of a minuscule minority of the bottles of the Respondent or of any other company having similar shape and size of the bottle sneaking into the process of recycling on account of human error could not be ruled out.

.....

13. There is no merit in the second submission as well. Section [29\(1\)](#) provides that a registered trade mark would be infringed by a person who though not being a registered proprietor or a permitted user uses in the course of trade, a mark which is identical with, or deceptively similar to the trade mark in relation to goods and services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark. In order to attract Section [29\(1\)](#) several ingredients must be established. Firstly, there must be in existence a registered trade mark. Secondly, there has to be a use by a person who is not a registered proprietor or a person using by way of a permitted use. Thirdly, the use must be in the course of trade. Fourthly, the use must be of a mark which is identical with or deceptively similar to the trade mark. Fifthly, the use must be in relation to goods and services in respect of which the trade mark is registered. Finally, the use must be in such a manner as to render the use of the mark likely to be taken as being used as a trade mark. All these ingredients which have been set out in sub-section (1) of Section [29](#) have been fulfilled. The respondent is the registered proprietor of the marks in question. The Appellant is not a registered proprietor or a person entitled to permissive use. The Appellant has used on the bottles of beer the very mark of the Respondent in respect of which the mark of the Respondent is registered. This use is in such a manner as would render the use of the mark likely to be taken as being used as a trade mark.

The SLP filed against the above order was dismissed by the Hon'ble Supreme Court of India vide its order dated 2.12.2013³.

26. Applying the above principles, I am of the view that, by using the bottles embossed with the Plaintiff's trade mark TANGO in respect of its country liquor, the Defendant has infringed the Plaintiff's registered trade mark No.1051107 in class 33. The continued use of the impugned bottles embossed with the impugned mark by the Defendant is bound to create confusion and deception in the minds of the public and is bound to pass off the Defendant's impugned products as and for the Plaintiff's products.

27. There is no written statement on record. Thus, there is no explanation provided or defense raised by the Defendant in respect of the use of the impugned bottles embossed with the Plaintiff's trade mark TANGO. The evidence of the Plaintiff is therefore uncontroverted. It is quite clear that Defendant by use of the impugned bottles embossed with the trade mark TANGO is dishonestly attempting to trade on the goodwill and reputation of the Plaintiff thereby causing irreparable loss and damage to the Plaintiff.

28. The Plaintiff is not pressing for damages other than punitive damages. In the circumstances, suit is decreed against the Defendant in terms of Prayer Clauses (a), (b) and (d) of the Plaint. Costs to be quantified as per

³ SLP (Civil)... /2013 CC 20301/2013 *Som Distilleries & Breweries Ltd. Vs. SABMiller India Ltd.*

rules. The said prayer clauses (a), (b) and (d) of the Plaint are reproduced hereunder:

(a) *that the Defendant by itself, its office bearers, servants, agents, stockists, distributors and dealers, be restrained by an order and permanent injunction of the Hon'ble Court from infringing the Plaintiff's registered trade mark bearing registration No. 1051107 in Class 33 by using bottles embossed with the trade mark "TANGO" with and/or without device of raised palm with the three fingers pointing in the upward direction or by the use of the trade mark "TANGO" or any other trade mark deceptively similar to the Plaintiff's registered trade mark bearing registration No. 1051107 in Class 33, upon or in relation to country liquor or similar goods or in any other manner whatsoever;*

(b) *that the Defendant by itself, its office bearers, servants, agents, stockists, distributors and dealers, be restrained by an order and permanent injunction of the Hon'ble Court from manufacturing and/or marketing and/or bottling and/or selling and/or exhibiting for sale and/or distributing and/or keeping in possession and/or advertising and/or trading in and/or otherwise dealing in country liquor or similar goods packed in the bottles embossed with the impugned trade mark "TANGO" with and/or without device of raised palm with the three fingers pointing in the upward direction or using any other trade mark identical with or deceptively similar to the Plaintiff's well-known trade mark TANGO so as to pass off or enable others to pass off the Defendant's goods as and for the Plaintiff's well-known goods or in any other manner whatsoever;*

(d) *that the Defendant be ordered and decreed to deliver up to the Plaintiff for destruction the goods, bottles, labels and things bearing the impugned trade mark "TANGO";*

29. Considering the nature of infringement and with a view to dissuade others from indulging into such activities it is imperative that some punitive damages be awarded to the Plaintiff. I, therefore award punitive damages amounting to Rs.1,00,000/- to the Plaintiff and against Defendant.

30. The office shall return the original documents to the Advocates for the Plaintiff upon the Advocates for the Plaintiff handing over photostat copies of the said documents duly certified by them as true copies. Refund of court fee, if any, as per rules.

(S. J. KATHAWALLA, J.)