

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
NOTICE OF MOTION (L) NO. 1480 OF 2015

IN

SUIT (L) NO. 560 OF 2015

ALONG WITH

LEAVE PETITION NO. 117 OF 2015

ULTRATECH CEMENT LIMITED)
GRASIM INDUSTRIES LIMITED)..Applicants

In the matter between:

ULTRATECH CEMENT LIMITED & ANR. ...Plaintiffs

Versus

JAI SHREE KRISHNA CEMENT ...Defendant

Dr. Veerendra Tulzapurkar, Senior Advocate, along with Mr. Amit Jamsandekar
i/b VA Associates for the Plaintiffs.

Mr. J. Ranawat for the Defendant.

CORAM : S. J. Kathawalla, J.

DATED :22nd June 2015

PC:

1. Heard the Learned Senior Advocate for the Plaintiffs and Mr. J. Ranawat for the Defendant.
2. Leave under Rule 14 of the Letters Patent Act is granted.
3. The present suit is filed by the Plaintiffs to prevent the acts of infringement and Passing-off and unfair trading committed by the Defendant by using the marks **“Jai Shree Ultratech CEMENT The Engineer’s Choice with Sun Logo”**, **“Ultra Strong CEMENT The Engineer’s Choice with Sun**

Logo” and/or “Jai Shree Ultratuck CEMENT The Emerging Choice with Sun Logo”.

4. The Plaintiffs are seeking reliefs inter alia of injunction, accounts of profit, delivery of products bearing the impugned marks for destruction , damages, etc.

5. The registration details and application pending registration of trademarks **“UltraTech”** are given in paragraph 8 of the Complaint (UltraTech marks). Exhibits A1 to A-32 to the complaint are the certified copies/registration certificates /additional representations of the aforesaid registered/pending trademarks of Plaintiffs. It is stated that Plaintiff No. 1 is the Proprietor of the marks and Plaintiff No. 2 is the licensee of the trademarks. The photographs of Plaintiffs products bearing the trademark **“UltraTech CEMENT The Engineer’s Choice”** along with sun device, which is solely and exclusively associated with Aditya Birla Group of companies is at **Exhibit B** to the Complaint. The description of Plaintiffs' mark as used in the course of trade is given in paragraph 9 of Complaint.

6. The Plaintiffs have produced documents to establish that the **“UltraTech”** trademarks are used by the Plaintiffs on an extensive scale and continuously and that the **“UltraTech”** marks are solely and exclusively associated by the members of the public and the traders with the Plaintiffs and none else. The documents produced by the Plaintiffs includes a copy of extract of the Annual Report for the year 2013-14, copies of the sales invoices, statement of sales and promotional expenses certified by the Chartered

Accountant. The certificate of the Chartered Accountant produced by the Plaintiffs shows that the sales of the Plaintiffs bearing the “UltraTech” marks in the year 2003-4 were 2251 Crores and 22,656 Crores in the year 2014-15. The certificate also shows that expenses incurred by the Plaintiffs to promote and advertise their products bearing the marks “UltraTech”, which in the year 2003-4 are 14.58 Crores and 130.55 in the year 2014-15. The Plaintiffs submitted that the “**UltraTech**” trademarks of the Plaintiffs are heavily advertised in various media which includes, television, radio, digital media, print media, internet. The Plaintiffs have relied upon various orders passed in their favour in the proceedings initiated by the Plaintiffs to protect their marks. It is submitted that the Ultra Tech marks are well-known marks and have tremendous reputation and goodwill, which is owned by the Plaintiffs. The Plaintiffs have produced substantial material on record to establish that the trade marks “**UltraTech**” are used on an extensive scale all over India as well as in the International market.

7. The Defendants are manufacturing, selling, offering for sale, distributing and offering for distribution cement under the impugned mark/labels as depicted in Exhibits- H to H-5 of the Plaint. The Learned Senior Advocate appearing for the Plaintiffs has pointed out in detail how the impugned marks of the Defendant when compared with the Plaintiffs marks clearly establish that the same are depicted in an identical manner as that of the Plaintiffs marks with a mala fide intention to cause deception and confusion inter alia among the members of the public, the traders and consumers of cement, and trade upon the goodwill and reputation of the Plaintiffs. It is submitted that the Defendant is therefore guilty of infringing the Plaintiffs marks

and its parts. The Defendant is also guilty of passing off their products as that of the Plaintiffs. It is submitted that the cease and desist notice sent by the Plaintiffs to the Defendant is annexed as Exhibit-F to the Plaint to which the Defendants have not replied. It is submitted that the Plaintiffs have made out a strong prima facie case of infringement and passing off against the Defendant. The balance of convenience is overwhelmingly in favour of the Plaintiffs. It is submitted that the Plaintiffs are therefore entitled to the ad-interim reliefs in terms of prayer clauses (a) and (b) of the Notice of Motion.

8. The Learned Advocate for the Defendant has submitted that except for the mark “UltraTech CEMENT TheEngineer's choice” , the other marks of the Plaintiffs are not registered and the Defendant is therefore entitled to use the same. The said submission is untenable and baseless. As pointed out by the Plaintiffs, the impugned marks **“Jai Shree Ultratech CEMENT The Engineer’s Choice with Sun Logo”**, **“Ultra Strong CEMENT The Engineer’s Choice with Sun Logo”** and/or **“Jai Shree Ultratuck CEMENT The Emerging Choice with Sun Logo”** when compared with the marks of the Plaintiffs clearly establish that the same are depicted in an identical manner as that of the Plaintiffs' trademarks more particularly **“Sun Device followed by Jai Shree Ultratech CEMENT The Engineer’s Choice”** **Ultra Strong CEMENT The Engineer’s Choice”** and **“Sun Device followed by Jai Shree Ultratuck CEMENT The Emerging Choice”**. The manner in which the word CEMENT and Sun Logo are used on the cement bags of the Defendant is same and/or deceptively similar to that of the Plaintiffs and also the Sun Device is depicted in the same/similar manner in which the Sun Device appears on the cement bag of the Plaintiffs. The manner of writing of the words, style of font, the size of font, the placement of material of the Defendant's mark on cement bags is similar to the

manner, font and style of the Plaintiffs' trademarks. I am prima facie satisfied that the Defendant has adopted the impugned mark with a mala fide intention to cause deception and confusion inter alia amongst the members of the public and the traders/users of the product – cement. In my view the Plaintiffs have made out a prima facie case that the use of the impugned marks by the Defendant is dishonest and calculated to trade upon the goodwill and reputation of the Plaintiffs. The Plaintiffs are in my view correct in their submission that by using the impugned trademark the Defendant has and is continuing to infringe the Plaintiffs' trademarks and also passing off the Defendant's goods and business as and for the Plaintiffs. The Plaintiffs have therefore made out a strong prima facie case in their favour and against the Defendant for grant of ad-interim reliefs in terms of prayer clauses (a) and (b) of the Notice of Motion. The submission made on behalf of the Defendant that since some of the said ultra marks are not registered, the Defendant is entitled to use the impugned mark, is made without understanding the law regarding infringement and passing off. The balance of convenience is also completely in favour of the Plaintiffs and against the Defendant. In view thereof, the Plaintiffs are granted ad-interim reliefs in terms of prayer clauses (a) and (b) of the Notice of Motion which reads as follows:

*“(a) pending the hearing and final disposal of the Suit, the Defendant by itself and/or by its servants, agents and distributors or representatives or any person claiming through or under it and the like be restrained by a temporary order and injunction from in any manner in relation to any of its goods from using the marks/labels containing the words **“Jai Shree Ultratech CEMENT The Engineer’s Choice with Sun Logo”, “Ultra Strong CEMENT The Engineer’s Choice with Sun Logo” and/or “Jai Shree Ultratuck CEMENT The Emerging Choice with Sun Logo”** together or by*

themselves and/or any other mark or the impugned mark being **Exhibit H-H5** or any other deceptively similar words written in a stylized manner or in any manner which is identical with and/or deceptively similar to all the registered and well-known “**UltraTech**” trademarks or parts thereof bearing Registration Nos.1244745, 1326528, 1575299, 1544648, 1544649, 1340606, 1525671, 1525672, 1908355, 1908356, 2080447 and 2080448 so as to infringe the Plaintiffs said registered trademarks;

(b) pending the hearing and final disposal of the Suit, the Defendant by itself and/or by its servants, agents and distributors or representatives or any person claiming through or under it and the like be restrained by a temporary order and injunction from in any manner in relation to any of its goods from using the marks/labels containing the words “**Jai Shree Ultratech CEMENT The Engineer’s Choice with Sun Logo**”, “**Ultra Strong CEMENT The Engineer’s Choice with Sun Logo**” and/or “**Jai Shree Ultratuck CEMENT The Emerging Choice with Sun Logo**” together or by themselves and/or any other mark or the impugned mark being **Exhibit H-H5** or any other deceptively similar words written in a stylized manner or in any manner and/or any other deceptively similar marks to the Plaintiff;s “**UltraTech**” trademarks or parts thereof so as to pass off and/or enable others to pass off the Defendant's goods as and for the goods of the Plaintiffs or in some way connected with the Plaintiffs.”

9. Place the Notice of Motion for hearing and final disposal on 6th July, 2015, First on Board.
10. Parties to act on an ordinary copy of this order, duly authenticated by the Associate of this Court.

(S.J. KATHAWALLA, J.)