

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
BENCH AT AURANGABAD

APPEAL FROM ORDER NO. 05 OF 2016
WITH
CIVIL APPLICATION NO. 1200 OF 2016

M/s. Bothara Agro Equipments Pvt. Ltd.
A company incorporated under Indian
Companies Act, 1956
Having its Registered Office at,
B-16, MIDC, Ahmednagar,
District Ahmednagar
Through its Director,
Shri Santosh Manakchand Bothara
Age : 48 years, Occupation : Business,
Resident of B-16, MIDC, Ahmednagar,
Maharashtra.

...Appellant
(Original Plaintiff)

versus

- 1) M/s. J.J. Distributors Pvt. Ltd.
Having its Registered Office at,
55, Mangalwar Peth, Janganana Apartment,
Pune – 411 011, Maharashtra.
- 2) Shri Vinodkumar Nemichand Jain,
Director, M/s. J.J. Distributors Pvt. Ltd.,
Age : Major, Occupation : Business,
Resident of 55, Mangalwar Peth,
Janganana Apartment,
Pune – 411 011, Maharashtra.
- 3) Sau. Veena Vinodkumar Jain,
Director, M/s. J.J. Distributors Pvt. Ltd.,
Age : Major, Occupation : Business,
Resident of 55, Mangalwar Peth,
Janganana Apartment,
Pune – 411 011, Maharashtra.

...Respondents
(Original Defendants)

.....
Mr. A. S. Bajaj h/f Mr. Abhay D. Ostwal, advocate for the appellant
Mr. Amit Yadkikar, advocate for respondents
.....

CORAM : V. K. JADHAV, J.

**Date of Reserving
the Order : 07.04.2016**

**Date of pronouncing
the Order: 06.05.2016**

PER COURT :-

1. Being aggrieved by the order dated 29.12.2015 passed below Exh.5 in Trade Mark Suit No. 1 of 2015 by learned District Judge-1, Ahmednagar, the original plaintiff has preferred this appeal.

2. Brief facts, giving rise to the present appeal, are as under:-

a) The plaintiff-M/s. Bothara Agro Equipments Pvt. Ltd. is a Private Limited Company incorporated under the Companies Act, 1956, having its registered office at Ahmednagar. Plaintiff is doing business of manufacturing and marketing of all types of PVC pipes and plastic pipes included in class 17 under the registered trade mark "PARAS" since many years. In relation to the aforementioned products, plaintiff has conceived and adopted a trade mark "PARAS" and is using the said trade mark continuously since the year 1995. According to the plaintiff, said trade mark is most widely advertised trade mark and the same has been utilized honestly and bonafidely, so much so that the said trade mark is identified as the premier

brand in the Agro Industry. The plaintiff company is the largest manufacturer of PVC pipes etc. in India and the products of said "PARAS" Pipe command immense goodwill and reputation owing to its superior quality, coupled with a good network of dealers all over India and well supported by its excellent after-sale services. Thus, the plaintiff company, by virtue of being the registered proprietor of the trade mark "PARAS" and on account of continuous and uninterrupted use under the said name since the year 1995, claims valuable statutory and common law rights in the said trade mark, and thus, has the sole exclusive right to use the said trade mark in respect of the goods covered under the said registration.

b) Around the second week of August, 2014, the plaintiff was surprised and shocked to come across the PVC pipes, UPVC pipes bearing trade mark "PARAS GOLD" being manufactured and sold by the defendants in Pune, Ahmednagar and other areas. The defendants are indulged in manufacturing, marketing and selling its UPVC and PVC pipes under an identical mark "PARAS GOLD" to that of the plaintiff. According to the plaintiff, the very object of the impugned trade mark adopted by the defendant is dishonest and the impugned trade mark "PARAS GOLD" has been adopted in bad faith.

Consequently, plaintiff M/s. Bothara Agro Equipments Pvt. Ltd. is constrained to institute Trade Mark Suit No. 1 of 2015 before District Court, Ahmednagar for the relief as detailed in the plaint. Plaintiff M/s. Bothara Agro Equipments Pvt. Ltd. had also filed an application Exh.5 praying thereby to restrain the defendants by an order of temporary injunction, from using in any manner, in relation to any preparation, the impugned trade mark "PARAS" and/or "PARAS GOLD" and other word or mark which is identical with and/or deceptively similar in any manner whatsoever to the plaintiff's registered trade mark "PARAS", so as to infringe the plaintiff's registered trade mark "PARAS" bearing registration No. 683686 and No. 1336021.

c) The defendants strongly resisted the suit by filing written statement and also resisted the application Exh.5 by filing say. According to the defendants, they have applied for registration of trade mark in the name "PARAS GOLD" and the said application is pending approval with the Trade Mark Registry. According to them, trade mark "PARAS GOLD" is not at all identical to the trade mark registered by plaintiff and hence, does not amount to infringement and passing off plaintiff's goods. The defendants have taken a plea that word "PARAS" is a generic word in common usage of Devnagri Marathi which means "A stone which converts anything touched, in gold".

Defendant No.2 has an uncle by name Mr. Parasmal Jawanmal Jain who has inspired a lot to defendant No.2 in his life since his birth, and therefore, defendant No.2 being the director of defendant No.1-company, choose to name the company's products by name "PARAS GOLD".

d) Learned District Judge-1, Ahmednagar, by its impugned order dated 29.12.2015 passed below Exh.5 in Trade Mark Suit No. 1 of 2015, rejected the application for grant of temporary injunction. Being aggrieved by the same, the original plaintiff M/s. Bothara Agro Equipments Pvt. Ltd. has preferred present appeal.

3. Learned counsel for the appellant/original plaintiff submits that the defendants/respondents are manufacturing PVC Pipes and fitting under the name and style "PARAS GOLD" since 12.8.2014 which fact itself demonstrate that the present appellant is prior in using the said trade mark "PARAS" since 1995 and the respondents/defendants are deceptively and intentionally using the identical name "PARAS GOLD". Learned counsel submits that trade mark "PARAS" is the description of the goods of appellant/plaintiff and on account of use of voluminous sale and wide extensive publicity, the trade mark "PARAS" of the plaintiff is recognized as the market leader and also

the premier brand in the agriculture and construction industry. Learned counsel submits that the respondents-defendants themselves admit in their written statement that they applied for registration of trade mark in the name of "PARAS GOLD" and the said application is pending for approval with the Trade Mark Registry. Learned counsel submits that the appellant-plaintiff has made out a strong *prima facie* case and balance of convenience also lies in favour of the appellant/plaintiff.

4. Learned counsel for the appellant submits that by virtue of registered proprietary of trade mark "PARAS" and on account of continuous use of the said name since 1995 and 2005 and renewal from time to time, the appellant/plaintiff has got valuable statutory common law rights in the said trade mark "PARAS" and has the sole exclusive right to use the said mark "PARAS" in respect of the goods covered under the said registration. Learned counsel submits that the respondents-defendants are indulging in manufacturing, marketing and selling its UPVC and PVC pipes under identical mark "PARAS GOLD" as that of the appellant. Thus, learned counsel submits that adoption of said trade mark "PARAS GOLD" creates impression in the minds of prospective purchasers as premium production of the goods by the appellant/plaintiff under the name as PARAS GOLD. Thus, the very adoption of the impugned trade mark by the

defendants is dishonest and the impugned trade mark has been adopted in bad faith. Learned counsel submit that the UPVC and PVC pipes of respondents are the goods of same description as that of the appellant's and the UPVC and PVC pipes are available and are sold in the same agro equipment's shop, under the same roof, by the same people and over the same counter, and even the class of customers of the said two products are same. Learned counsel submits that the respondents-defendants are guilty of violating appellant's statutory and common law rights in trade mark "PARAS". By using identical trade mark, the respondents are misrepresenting the goods as those of the appellant's and representing that its goods have some connection or nexus with the goods of the appellant. Learned counsel submits that learned Judge of the trial court has erred and wrongly interpreted the provisions of Sections 29, 31, 135, and 137 of the Trade Marks Act 1999 (for short "the Act of 1999").

5. Learned counsel for the appellant submits that on bare reading of the provisions of Section 29 of the Act of 1999, it is crystal clear that there is an infringement of the registered trade mark of the appellant "PARAS", as the mark used by respondents "PARAS GOLD" is similar and identical and further, taking into consideration the class of consumers and customers like the agricultural community, farmers, traders, dealers etc., there is more possibility of

confusion. Learned counsel submits that the respondent's unregistered mark "PARAS GOLD" is so close to the appellants registered mark "PARAS", either visually, phonetically and even otherwise, that no further evidence is required to establish that the appellant's rights are violated.

6. Learned counsel for the appellant submits that the term "PARAS" is not a generic term with reference to the agricultural goods and manufacturing of machineries and goods and construction goods, etc. in question. It is settled proposition of law that mere filing of search report from the Trade Mark Office does not prove that the marks mentioned in the search report are actually being used. Learned counsel submits that the apprehension expressed by the appellant is well founded and irreparable loss and harm would be caused to the present appellant in case the respondents are not restrained from using the impugned mark. Learned counsel submits that the appellant-plaintiff has made out a very strong *prima facie* case for grant of injunction to restrain the respondents from using the trade mark PARAS. The balance of convenience also lies in favour of the appellant. Learned counsel submits that learned Judge of the trial court has failed to appreciate the ratio of the judgment of this Court as well the Hon'ble Supreme court in various authoritative pronouncements in this regard. Learned counsel submits that

passing of the impugned order dated 29.12.2015 thereby rejecting application Exh.5, resulted into gross miscarriage of justice and irreparable loss and harm to the appellant-plaintiff.

7. Learned counsel for the respondents-defendants submits that the trade mark "PARAS GOLD" used by the respondents-defendants is not similar or deceptively similar to the manufacturing, marketing and using the trade mark "PARAS", which is registered trade mark of the appellant/plaintiff. Learned counsel submits that the word "PARAS" cannot be a monopoly of the appellant-plaintiff and the same is a generic word and is also not sole registered trade mark of the appellant-plaintiff. Learned counsel submits that there are several companies other than the appellant-plaintiff being using the term or word "PARAS" in its trade mark. Learned counsel submits that the claim of appellant-plaintiff over the registered trade mark "PARAS" since 1995 is not correct. Learned counsel submits that in the year 1995, the said trade mark was registered in the name of Mr. Manakchand Ghevarchand Bothara and in the year 2005, the said trade mark shown to have been registered in the name of present appellant-plaintiff. Learned counsel submits that there is no evidence even *prima facie* to show, in view of the provisions of sections 37 and 38 of Act of 1999, the assignability and transmissibility of registered trade mark "PARAS" in favour of the appellant by said Manakchand

Ghevarchand Bothara. Learned counsel submits that the word “PARAS” is a generic word used in common usage of Devnagiri Marathi language which means “a rock having a golden touch” and a restriction on use of the word “PARAS” is not maintainable in law. There is no possibility of confusion in the mind of prospective customers about word “PARAS GOLD”.

8. Learned counsel for the respondents-defendants submits that interim injunction for infringement of trade mark can be passed only when the plaintiff has made out a strong *prima facie* case in their favour to the effect that if interim injunction is not granted as prayed, it would cause irreparable loss to them. Learned counsel submits that unless it is *prima facie* shown that the plaintiff has suffered actual loss due to alleged *mala fide* acts of the defendants using or infringing their trade mark, grant of interim injunction cannot be justified as speculative or unproven damages cannot be considered. Learned counsel submits that plaintiff's case is entirely based upon the speculative loss. Learned counsel submits that the dishonest and *mala fide* use of word “PARAS” in respect of the same goods would only be shown if plaintiff succeeds in showing impeachment upon the profits and goodwill of their registered trade mark. Learned counsel submits that since plaintiff's trade mark is a very common name in the Jain community, it cannot be said that merely by using such

word, there was infringement of the plaintiff's trade mark. Learned counsel submits that the suit is still pending before the trial court and instead of going into the controversy at the interlocutory stage in detail, the trial court may be directed to expedite the hearing of the suit and the suit may be directed to be disposed of in a time bound manner.

9. The appellant-plaintiff seeks to restrain the defendants by issuance of order of injunction from manufacturing, marketing and selling its PVC pipes and other like goods bearing trade mark "PARAS GOLD" or any trade mark similar thereto, as the same is identical to the plaintiff's reputed trade mark "PARAS" and the use thereof by the defendants amounts to infringement of plaintiff's registered trade mark and passing off their goods and business as and for those goods and business of the plaintiff. On account of continuous use under the said name since the year 1995, the plaintiff claims valuable statutory and common law right in the said trade mark "PARAS" and thus, has the sole exclusive right to use the said trade mark "PARAS" in respect of the goods covered under the said registration. According to the plaintiff, trade mark "PARAS" has become distinctive of the plaintiff's merchandise, both in the minds of the traders and the members of the public. The plaintiff has sold and continues to sell its aforementioned products under the trade mark

“PARAS” on an extensive scale throughout India. Thus, plaintiff's trade mark “PARAS” is recognized as well known trade mark in the agricultural field and construction industry and by the people in trading.

10. The defendants are indulging in manufacturing, marketing and selling its UPVC, PVC pipes under an identical mark “PARAS GOLD” as that of the plaintiff. According to the plaintiff, defendants, being aware of the reputation and the goodwill of the trade mark “PARAS”, have wrongly chosen to adopt an identical trade mark in relation to the goods of same description. According to the plaintiff, the very adoption of the impugned trademark by the defendants is dishonest *per se* and the impugned trade mark has been adopted in bad faith. However, the plaintiff contends that said UPVC and PVC pipes are available and are sold in the same agro equipments' shops, under the same roof, by the same people and over the same counter. Even the class of customers of the said two products are the same. According to the plaintiff, the defendants are guilty of using an identical mark in relation to the goods of similar description. The plaintiff further contends that such use of a well known trade mark in any manner whatsoever by the defendants, in relation to the identical and/or same description of goods is likely to result in confusion or deception in the minds of the unwary purchaser leading to passing

off under Section 27(2) of the Act of 1999, besides infringing upon the legally vested rights of the plaintiff in its trade mark "PARAS" under Section 29(1) read with 29(2) of the said Act.

11. The defendants admit that defendant No.1 has applied for registration of trade marks under the name of "PARAS GOLD" and the said application is pending for approval at the Trade Mark Registry. The said application is not rejected or dismissed. The defendants denied that the trade mark "PARAS GOLD" is identical to the trade mark registered by the plaintiff and there is infringement of trade mark of the plaintiff and passing off of the plaintiff's goods. According to the defendants, name "PARAS" is a generic word in nature and does not have any connection with the trade mark of the plaintiff Company and therefore, can be used by any person with suffix and prefix of any other word. It is also contended by the defendants that the trade mark of defendants consists of two names "PARAS" and "GOLD" out of which PARAS is a generic word used in common usage of Devnagiri Marathi language which means "A stone which converts anything touched in gold". Therefore, the restriction of use of word 'PARAS' is not maintainable in law. The defendants, by inviting attention towards the copy of search report obtained from the Registrar of Trade Marks, contend that there are several companies other than the plaintiff's company using the term or word

“PARAS” in its trade mark.

12. The learned District Judge, after having gone through the entire search report placed on record, observed that the manufacturing, marketing and using the trade mark “Paras Label” is also duly registered. In the same way, the trade mark “Parasilico” is registered under the Trade Marks Act of one Company from Belgium and there are also other companies in the market which are using trade name “PARAS” which is claimed to be the sole trade mark by the plaintiff company. It further appears from the impugned order that the learned District Judge has given importance to the contention of the defendants that though the trade mark ‘PARAS GOLD’ was not duly registered under Act of 1999, the defendant company had applied for registration before the Registrar of Trade Marks in the year 2014 and temporary registration was also provided and the application of defendants of the trade mark “PARAS GOLD” is also not rejected or dismissed. The learned District Judge has also observed in the impugned order that the defendants were using their trade mark “PARAS GOLD” which is clearly different and distinct from trade mark “PARAS” of the plaintiff. The learned district Judge has also observed that the trade mark “PARAS GOLD” being used by the defendants cannot be termed as similar or deceptively similar to the registered trademark “PARAS” of the plaintiff and the defendant

company has not committed infringement of the plaintiff's trade mark as provided under Section 29 of the Act of 1999. In the light of the above discussion, the learned District Judge held that the plaintiff company has failed to place on record sufficient material so as to establish a *prima facie* case for grant of temporary injunction and further held that in absence of sufficient material, it cannot be said that balance of convenience lies with the plaintiff and the plaintiff is likely to suffer any irreparable loss in case temporary injunction is not granted. Consequently, the learned District Judge, by its impugned order, rejected the application for temporary injunction.

13. Learned counsel of the appellant places reliance on the following cases:-

l) ***Ruston and Hornby Ltd. vs. Zamindara Engineering Co.,*** reported in **1970 SC 1649**, in which the Hon'ble Supreme has made the following observations:-

"In an action for infringement where the defendant's trade mark is identical with the plaintiffs' 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.

II) In the case of **Guru Kripa Manufacturing Private Ltd. vs. M/s. Duro Pipe Industries Private Ltd. and Anr**, reported in **AIR 2013 ALLAHABAD 91**, Allahabad High court, in para Nos. 27, 28 and 29, has made the following observations :-

“27. In the case at hand, we find that the passing off action particularly by the plaintiff was on the basis of prior user, and the use of logo of the plaintiff by the defendant on the same product viz., PVC pipes, which is likely to cause deception, and consequently harm the reputation and the business of the plaintiff. The trial court examined the trade marks used by the plaintiff and the defendant and arrived at a finding that though on close examination of the first and third words used by the defendant in the trade mark are different, the manner in which the word 'G.K.' has been used in a square and the word 'Plast' has been written and the placement of the words is likely to deceive the common people who purchase the PVC pipes. The trial court found that the masons and contractors who purchase the PVC pipes belong to common class of people, and these people are likely to be deceived by the use of the trade mark, which is deceptively similar to the trade mark of the plaintiff.

28. We have also examined the photographs of the trade marks used by the plaintiff and the defendant in which PVC pipes of the plaintiff is kept along with the PVC pipes of the defendant (Annexure-3 to the counter affidavit). On a careful scrutiny of the two marks, we find that if a trade make of the plaintiff is placed along side of the trade mark of the defendant, the persons

possessing common intelligence, namely, masons and contractors are likely to be deceived by the placement of the first word in a square and the word 'DURO'. The third word preceding the similar specifications of the PVC Pipes is also similar. We thus agree with the trial court's finding that the degree of resemblance, nature of goods and use of trade marks with similar number of words and design are likely to deceive the purchasers of the PVC pipes.

29. The plaintiffs have established that they are prior user inasmuch as they are using the trade mark since 1992-93 and they have established a reputation in the market. In the Directors' report of the plaintiff's Company, the financial result discloses that their net profit before tax and after tax is gradually decreasing, which shows the reduced sales in the market. The defendant has not supplied its balance sheet to demonstrate its turnover, sales and profits. It is admitted that the defendant had started manufacturing in the year 2009 and having failed to disclose its turn over and profit, the trial court did not commit any error in finding that the plaintiff is suffering loss of income every year on account of use of trade mark, and which can be attributed to the use of trade mark by the rival trader including the defendants."

III) In the case of **Smithkline Beecham Ltd. and Anr vs. Hanish K. Ajmera and another**, reported in **AIR 2014 Delhi 76**, Delhi High Court, in para 11, has made the following observations:-

"11. Thus, in view of the legal position as laid down in Kaviraj Pandit Durga Dutt Sharma (supra) in an action for infringement where the plaintiff is able to show that the defendant's mark is likely to

deceive either due to visual, phonetic or otherwise similarity, and the Court reaches a conclusion that there is an imitation, no further evidence is required to be established that the plaintiff's rights are violated. In the present case, learned counsel for the defendant has strenuously sought to support that there are numerous differences between the two marks, as the packaging"s are different, the price is different, one is allopathic medicine and the other is an ayurvedic medicine. However, the fact remains that there is a very close phonetic similarity between the two trademarks PIROCIN and CROCIN. Both the medicines are used for the same ailment i.e. relieving the pain, both are analgesics and soft on stomach, and there is not much variation in the prices of the two strips. Thus, the ex-parte ad interim injunction in favour of the plaintiff is required to be made absolute till the disposal of the suit."

IV) In the case of **Infosys Technologies Ltd. vs. Adinath Infosys Pvt. Ltd. and Ors.** reported in **AIR 2012 Delhi 46**, Delhi High Court, in para 9, has made the following observations:-

"9. Since the trademark INFOSYS on account of its continuous user by the plaintiff-company for the last many years and on account of considerable efforts made and CS(OS)No. 244/2008 Page 8 of 16 expenditure incurred by the plaintiff-company in building and promoting this brand name, coupled with the excellent quality of the products and services which the plaintiff- company offers under this brand name has become distinctive to the plaintiff company, a person who is offered IT related services under a brand name which includes the expression INFOSYS as its key component is likely to presume that either the defendant-company is in some manner or the other associated with the plaintiff-company or has been licensed

by it to provide such services and that is why the expression INFOSYS is being used as a key component of the corporate name/brand name of the defendant-company. This impression is likely to cause confusion in the mind of the customer as regards the source of the services being offered to him. Hence, use of the expression INFOSYS by the defendant-company while offering IT related services also constitute infringement within the meaning of Section 29(2) of the Trademarks Act.”

V) In the case of **Jagdish Sweets and Farsan and Anr vs. Jagdish Foods pvt. Ltd.**, reported in **AIR 2007 GUJARAT 112**, Gujarat High Court has considered the case of the plaintiff for infringement of trade mark as well as passing-off action and held that the trial court has rightly restrained the defendants by issuing an order of injunction.

VI) In the case of **Wockhardt Ltd. Through its Territory Manager Bharat Singh vs. D.M. Pharma and Anr**, reported in **AIR 2013 Madhya Pradesh 15**, while considering the relief for infringement of trade mark and passing-off of goods, the Madhya Pradesh High Court has given weightage to registered trade mark of the appellant as against unregistered trade mark of the respondents and further held that the result of confusion occurring on account of similarity of trade mark, would be disastrous.

VII) In the case of ***M/s. Shri Tirupati Industries vs. M/s. Tirupati Industries***, reported in ***AIR 2013 Rajasthan 15***, the Rajasthan High Court has held that grant of temporary injunction in favour of plaintiff restraining the defendants from using trade mark is proper.

VIII) In the case of ***M/s. D.R. Cosmetics Pvt. Ltd. and Anr. vs. M/s. J.R. Industries***, reported in ***AIR 2008 Bombay 122***, this Court, in para 22 of the judgment, has made following observations:-

“22. For all these reasons, I am of the view that the plaintiffs have made out a prima facie case for grant of an interlocutory injunction. The plaintiffs have a long standing presence in the trade dating back to 1972 when their predecessor-in-interest obtained registration of the word mark BUFIN. The defendant entered into business three decades later in 2003. The defendant cannot claim that he was unaware of the word and label marks of the plaintiffs and, in any event, a diligent search in the Register of Trade Marks would have revealed the existence of the word and label marks of the plaintiffs. The word mark adopted by the defendant is used on an identical product. The label mark adopted by the defendant consists of a device and get up which is deceptively similar. The plaintiffs have produced material which would prima facie indicate a significant goodwill associated with the continuous user of mark for over three decades. The defendant cannot, in these circumstances, be permitted to trade on the reputation of the plaintiffs. The balance of convenience lies in favour of the grant of an interlocutory

injunction and irreparable injury is liable to be caused to be plaintiffs if an injunction were not to be granted.”

IX) In the case of **Wyeth Holdings Corporation and Anr. vs. Burnet Pharmaceuticals (Pvt.) Ltd.** reported in **AIR 2008 Bombay 100**, this Court has considered that the plaintiff is proprietor of the registered grade mark since long and further considered the reputation/goodwill of the plaintiff and observed deceptive similarity of the trade mark of defendants and held that the balance of convenience in such case would be in favour of the plaintiff for grant of interim injunction.

X) In the case of **Ramdev Food Products (Pvt) Ltd. vs. Arvindbhai Rambhai Patel and others**, reported in **(2006) 8 SCC 726**, the Supreme Court has considered the essence of passing-off action and also infringement of the trade mark in comparative manner by discussing various case laws and the provisions.

XI) Similarly, in the case of **Vikram Stores and Anr. vs. S.N. Perfumery Works and Anr**, reported in **AIR 2008 GUJARAT 65**, the Gujarat High court has considered the case of infringement of trade mark and held that the plaintiff is entitled for injunction restraining the defendants from using the

trade mark which is deceptively similar to the registered trade mark of the plaintiff.

XII) In the case of ***Societies Des Produits Nesle S.A. and Anr. vs. Montu Sadhu and others***, reported in ***AIR 2014 Delhi 156***, the Delhi High Court has also made same observations in the given facts and circumstances.

XIII) In the case of ***Satyam Infoway Ltd. vs. Siffynet Solutions (P) Ltd. reported in (2004) 6 SCC 145***, the Supreme court has considered the domain names and justified the action for passing-off, which can be found where domain names are involved. The Supreme court has also observed that it is not essential for the plaintiff to prove long user to establish reputation in a passing-off action. It would depend upon the volume of sales and extent of advertisement.

XIV) In case of ***Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd.*** reported in ***(2001) 5 SCC 73***, the Supreme Court while considering the deceptive similarity in the trade mark held that it has to determine that the passing-off action is similarity and not the dissimilarity between the competing marks. Furthermore, the Supreme court has

observed that the question has to be approached from the point of view of an Indian of average intelligence and imperfect recollection and not from the view of an Englishmen.

XV) In the case of ***SMS Formulations Pvt. Ltd. and Anr. vs. Sahib Singh Agencies (Bom) Ltd. and others, reported in 2012 (6) Mh.L.J. 313***, this Court in para 14 of the judgment has made the following observations:-

14. It is the contention of the defendants that there are several other marks with the names which are identical to the trademark of the plaintiffs and also that of the defendants and, as such, the plaintiffs are not entitled to an order of injunction. The answer to this contention would lie in sub-section (3) of section 28 of the Trademarks Act which reads thus:

"28. Rights conferred by registration.-

(1)

(2)

(3) *Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the*

same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor."

It can, thus, clearly be seen that if two or more persons are registered proprietors of the trademarks which are identical with or nearly resemble each other, they shall not have exclusive rights of any of those trademarks to the exclusion of the persons whose identical marks are registered. However, the person who is having registered trademark will have the same right as against the other persons whose marks are not registered, as he would have if he were the sole registered proprietor. It is, thus, clear that the plaintiffs herein may not be entitled to an order of injunction against the persons who are having similar or identical trademarks with that of the plaintiffs and whose trademarks are registered. However, the plaintiffs would be entitled to enforce their rights against the persons whose marks are not registered as if the plaintiffs are the sole proprietor of their registered trademark. It can, thus, clearly be seen that since plaintiffs' mark is registered trademark and the defendants' mark is not a registered one, the contention of the defendants in that regard is without any substance."

XVI) In the case of ***Hindustan Petroleum Corporation Ltd. vs. H.P. Oil Corporation Ltd., reported in 2004 (3) Mh.L.J. 187***, in the facts and circumstances of the case, this Court held that the plaintiffs are justified in objecting to defendants using the mark which is identical or similar.

14. Learned counsel for the respondents, in order to substantiate his contentions, placed reliance on the following judgments;-

I) ***J.K. Sons, Mumbai vs Parksons Games and Sports and Anr***, reported in ***2011 Vol. 113 (2) Bom.L.R. 1150***. In the said judgment, the Division Bench of this Court held that in an trade mark infringement or passing off suit by plaintiff, if the defendant prima facie shows the Court that plaintiff's mark is itself an imitation of the mark of the third party, then relief may be refused to the plaintiff on grounds of approaching the Court with unclean hands.

II) In the case of ***Shelke Beverage Private Ltd. vs. Rasiklal Manikchand Dhariwal and Dhariwal Industries Ltd.*** reported in ***2010 Vol. 112 (4) Bom.L.R. 1479***, the Division Bench of this court held that the interim injunction for infringement of trade mark can be passed only when the plaintiffs have made out strong prima facie case in their favour to the effect that if interim injunction is not granted, as prayed, it would cause irreparable damage to them and unless it is prima facie shown that they have suffered actual losses due to the alleged unlawful acts of the defendant's using or infringing their trade mark, grant of interim injunction cannot be justified as speculative or unproven damages cannot be considered.

III) In the case of ***Atul Products Limited vs. V.P. Mehta (since deceased through L.Rs.) Shailesh Vinodrai Mehta and others, reported in MIPR 2009 (1) 0237***, this Court in the facts and circumstances of the case, held that the plaintiff has to prove that the defendant has used the plaintiffs trade mark or word mark dishonestly and malafide. Dishonest and malafide use by a trader dealing in the same goods would only be shown if the trader has sought to impeach upon the profits or goodwill of registered trade mark holder. It is also observed that in an action for infringement where the defendant's trade mark is identical with the plaintiff's trade mark, the Court would not inquire whether the infringement was likely to deceive or cause confusion. If the defendant's mark is similar to the plaintiff, it would require to be proved as in a passing off action. When the two marks are identical, no further questions arises as to infringement is made out or not. When the two marks are not identical, the plaintiff would have to establish that the defendant's marks so resemble the plaintiff's as is likely to cause confusion.

IV) In the case of ***Lupin vs. Johnson and Johnson, reported in AIR 2015 Bom.50***, a reference has been made to the Full Bench for considering the following question of law.

“Whether the court can go into the question of validity of the registration of the plaintiff's trade mark at an interlocutory stage when the defendant takes up the defence of invalidity of the registration of the plaintiff's trade mark in an infringement suit?”

In para 59 of the judgment the conclusion are drawn and in clause 8 of the said para, it is observed that, though it is considered as a practice of this Court in granting injunction in favour of the plaintiff having a registered trade mark, the same cannot be treated as a total embargo on the power of the Court to refuse grant of interim injunction. In exceptional cases, that is in cases of registration of trade mark being ex facie illegal, fraudulent or such as to shock the conscience of the Court, the Court would be justified in refusing to grant interim injunction.

V) In the case of ***Bajaj Auto Limited vs. TVS Motors Company Ltd.*** reported in ***MIPR 2009 (3) 0033***, the Supreme court held that in matters relating to trade marks, copyright and patents the proviso to Order XVII, Rule 1(2) CPC should be strictly complied with by all the Courts, and the hearing of the suit in such matters should proceed on day to day basis and the final judgment should be given normally within four months from the date of filing of suit. The Supreme court has further

observed that instead of deciding the case at interlocutory stage, the suit itself should be disposed of finally at a very early date.

15. In the case in hand, the plaintiff is *inter-alia* engaged in the business of manufacturing, marketing and exporting of all types of PVC Pipes, LLDPE Pipe, HDPE Pipe, Plumbing, suction, Hose and Garden Pipe and all types of plastic pipes, included in Class 17 under their registered Trade mark "PARAS", for past many years. The plaintiff is doing the trading under the name and style as "PARAS" from the year 1995. Learned counsel for the respondents original defendants vehemently submitted that the said trade mark "PARAS" was registered on 16.10.1995 in the name of Manikchand Ghewarchand Bothra and on 3.2.2005 the same trade mark is registered in the name of Bothra Agriculture Equipments Pvt. Limited i.e. present plaintiff. Learned counsel for the respondents defendants further submitted that though the registered trade mark subject to the provisions of Chapter V is assignable and transmissible with or without goodwill of the business concerned, there is no evidence to show that the same was assigned and transmitted in favour of the appellant/original plaintiff in the year 2005.

16. In the case of ***Lupin vs. Johnson and Johnson (supra)***, while answering the reference, the Full Bench of this Court while dealing with the issue whether the Court can enter into the validity of the plaintiffs trade mark at an interlocutory stage when the defendants take up the defence of invalidity of registration of the plaintiff's trade mark in an infringement suit, concluded the issue with observations that the same cannot be treated as total embargo on the power of the Court to refuse or grant of interim injunction and in exceptional cases i.e. case of registration of trademark, being ex-facie illegal, fraudulent or such as to shock the conscience of the Court, the Court would be justified in refusing to grant interim injunction. In the case in hand, I do not find registration of the trade mark of the plaintiff being ex-facie illegal or fraudulent. Furthermore, the same may be the matter between said Manikchand Bothra, who is having registered trade mark "PARAS" in the year 1995 and the appellant company. However, it would not lie in the mouth of infringer to raise any objection about the same.

17. In relation to aforementioned products, the plaintiff conceived and adopted trade mark "PARAS" and used the said trade mark continuously since many years. Furthermore, Manikchand Ghewarchand Bothra is one of the director and founder of plaintiff company, which is having registration No. 683686 dated 16.10.1995,

regarding RIGID PVC Pipes and Hose Pipes included in Class 17 and further vide registration No. 1336021 on 3.2.2005 regarding all types of P.V.C. Pipes, etc, included in class 17. There is no dispute that said registration has been renewed from time to time and is valid/subsisting and is in force till today. According to the plaintiff, by virtue of continuous and uninterrupted use since the year 1995, by the plaintiff themselves, the plaintiff has acquired immense and unparalleled goodwill and reputation in the said trade mark "PARAS" which has come to be associated in the minds of the purchasing public and in the trade with the plaintiff and none else. The plaintiff asserts that the trade mark "PARAS" is distinctive of the plaintiff and none else. *Prima facie*, the plaintiff's valuable statutory claim and common law rights in the said trade mark "PARAS" appears to be well founded.

18. In the second week of August, 2014, the plaintiff came across the PVC pipes/UPVC Pipes, bearing the trade mark "PARAS GOLD" being manufactured and sold by the defendants in Pune, Ahmednagar and other areas. It is difficult to believe that the defendants were not knowing about registered trade mark of the plaintiff and products being manufactured and sold under the said trade mark. The defendants are indulged in manufacturing and/or marketing its UPVC and PVC pipes under the mark as "PARAS

GOLD". It is not disputed that the said pipes are produced and sold in the same Agro. equipments shops, under the same roof, by the same people and over the same counter. Even the class of customers of the said two products are the same. It appears that the plaintiff complained of both evasion of statutory right of infringement of registered trademark and also for passing-off by the use of the same mark. So far as action of passing-off is concerned, the same can be considered at the time of final hearing of the suit. However, the infringement of trade mark of the plaintiff is concerned, looking to the similarity of trade mark, being used by the defendants, the trial court ought to have allowed the application Exh.5 for issuance of temporary injunction restraining the defendants for carrying out manufacturing activities of products under trade mark "PARAS GOLD".

19. The defendants by carrying out the research, raised a ground that there are several other marks with the names which are identical to the trade marks of the plaintiff and as such the plaintiff is not entitled to an order of injunction. It also appears from the impugned order that the learned District Judge has also given weightage to the same while rejecting application Exh.5. It appears that the learned District Judge, however, ignored the provisions of Section 28 of the Trade Marks Act 1999. It is clear from the provisions of Section 28

sub-section (3) that if two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, they shall not have exclusive rights of any of those trade marks to the exclusion of the persons whose identical marks are registered. However, the person, who is having registered trade mark, will have same right as against the other person, whose marks are not registered, as he would have, if he were sole registered proprietor. In view of this, the plaintiff may not be entitled to an order of injunction against the persons, who are having similar or identical trade marks with that of the plaintiffs and whose trade marks are registered. However, the plaintiff would be entitled to enforce his right against the persons whose marks are not registered. In this case, the plaintiff's mark is registered trade mark and the defendants trade marks is not registered one. Assuming that the defendants have carried out such search to point out that there are many other brands equally known in the market and the name "PARAS" is a generic word in nature and does not have any connection with the name of plaintiff company and therefore, can be used by any person with suffix or prefix of any other word, still then the question arises whether the name "PARAS", having meaning 'a stone which converts any metal in gold', is a generic word and can be used so far as the manufacturing of products like PVC/UPVC pipes. Prima facie, it appears that the word "PARAS" does not have any connection with

the manufacturing of products like PVC/UPVC pipes etc. It may have some relevance in the business dealing with the precious stone. By virtue of continuous and uninterpreted use, *prima facie*, it appears that the plaintiff has acquired reputation in the said trade mark "PARAS".

20. In the case of ***SMS Formulations Pvt. Ltd. and Anr. vs. Sahib Singh Agencies (Bom) Ltd. and others, (supra)*** the defendants raised contentions that the trade mark adopted by the plaintiff is derived from the generic term of medicines, which are used in the product and that names are common to the trade. It has also contended that there are several other marks with the names which are identical to the trademark of the plaintiffs and also that of the defendants. In the said case, this Court has referred to the observations of the Apex Court in the case of ***Corn Products Refining Co. vs. Shangrila Food Products Ltd. reported in AIR 1960 SC 142***. The Supreme court in the aforesaid case, in paras 13 and 15 made the following observations:-

"13. The second point on which the learned appellate Judges based themselves in arriving at the conclusion that there was no reasonable apprehension of confusion or deception was, as we have earlier stated, that there were various trade marks with a prefix or suffix 'Gluco' or 'Vita' and that made it impossible to say that the common features 'Glu' and 'Vita' were only associated with the

appellant's products. This view was founded on a passage which the learned appellate Judges quoted from Kerly on Trademarks, 7th Edn. p. 624. That passage may be summarized thus: Where there are a "series" of marks, registered or unregistered, having a common feature or a common syllable, if the marks in the series are owned by different persons, this tends to assist the applicant for mark containing the common feature. This statement of the law in Kerly's book is based on In re: an application by Beck, Kollar and company (England) Limited. It is clear however from that case, as we shall presently show, that before the applicant can seek to derive assistance for the success of his application from the presence of a number of marks having one or more common features which occur in his mark also, he has to prove that those marks had acquired a reputation by user in the market....

"15. The series of marks containing the common element or elements therefore only assist the applicant when these marks are in extensive use in the market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now in the present case the applicant, the respondent before us, led no evidence as to the user of marks with the common element. What had happened was that Deputy Registrar looked into his register and found there a large number of marks which had either 'Gluco' or 'Vita' as prefix or suffix in it. Now of course the presence of a mark in the register does not prove its user at all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register. If any authority on this question is considered necessary, reference may be made to Kerly p. 507 and Willesden Varnish Co. Ltd. v. Young & Marten Ltd. [1922] 39 R.P.C. 285 at p. 289. It also appears that the appellant itself stated in one of the affidavits used on its behalf that there were biscuits in the market bearing the marks 'Glucose Biscuits', 'Gluco biscuits' and 'Glucoa Lactine biscuits'. But

these marks do not help the respondent in the present case. They are ordinary dictionary words in which no one has any right. They are really not marks with a common element or elements. We, therefore, think that the learned appellate Judges were in error in deciding in favour of the respondent basing themselves on the series marks, having 'Gluko' or 'Vita' as a prefix or a suffix.

21. Thus, the series of marks containing the common element or elements therefore only assist the defendants when these marks are in extensive use in the market. The onus of proving such user is of course on the defendants, who want to rely on those marks. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register. The defendants have not produced any material to show that the marks on which they are relying have acquired reputation by user in the market.

22. The impugned trade mark of the defendants is identical to the plaintiff's registered trade mark and *prima facie* it appears that the word "GOLD" is added to the defendants' trade mark is of no consequence. Furthermore, the plaintiff's trademark since registered one, the defendants are deemed to have noticed the same and therefore, adoption of the impugned trade mark by the defendants is *prima facie* dishonest and no equities lies in their favour. The plaintiff's claim, *prima facie*, appears to be proper, correct and legal

to the effect that the addition of word "GOLD" to the plaintiff's trade mark "PARAS" by the defendants, may create impression in the minds of purchasers of the product that the same may be the product of premier quality by the plaintiff's company itself.

23. In view of the above facts and circumstances, I am of the view that the plaintiff has made out a strong prima facie case for grant of temporary injunction. Refusal of interim relief will cause irreparable harm, loss and injury to the plaintiff, which are incapable of being compensated monetarily. The defendants have not disputed the plaintiff's assertion of prior user and proprietorship of registered trade mark. Thus, the balance of convenience lies entirely in favour of the plaintiff. This is a case wherein statutory rights of the plaintiff are being infringed and as such, injunction needs to be granted during pendency of the suit. In case the plaintiff's statutory right is not protected, the plaintiff is likely to suffer irreparable loss.

24. In the light of observations of the Supreme Court in the case of ***Bajaj Auto Limited vs. T.V.S. Motors (supra)***, this appeal can be allowed by giving certain directions to the learned District Judge for expeditious disposal of Trade Mark Suit. Hence, I proceed to pass the the following order.

ORDER

- I. The appeal from order is hereby allowed.
- II. The impugned order dated 29.12.2015 passed by learned District Judge-1, Ahmednagar below Exh.5 in Trade Mark Suit No. 1 of 2015 is hereby quashed and set aside.
- III. The application Exh.5 in Trade Mark Suit No. 1 of 2015 is hereby allowed and the defendants by itself and/or through its directors, partners, proprietors, servants, agents, exporters, importers, stockists and/or otherwise, are hereby restrained by an order of temporary injunction from using in relation to any preparation, the impugned trade mark "PARAS" and/or "PARAS GOLD" and other word or mark, which is identical with and/or deceptively similar in any manner whatsoever to the plaintiff's registered trade mark "PARAS" so as to infringe the plaintiff's registered trade mark "PARAS" bearing registration No. 683686 and No. 1336021, pending, hearing and final disposal of the suit.
- IV. The learned District Judge, Ahmednagar shall dispose of Trade Mark Suit No. 1 of 2015 as expeditiously as possible, preferably within a period four months from the date of receipt of this order.
- V. It is made clear that this Court has not made any observations on merits of the case and the learned Judge shall decide the suit without being influenced by any observations made in this order.
- VI. Appeal from order is disposed of.

VII. In view of disposal of appeal from order, nothing remains to be decided in the pending civil application, and civil application No. 1200 of 2016 is also disposed of.

25. Learned counsel for the respondents submits that the respondents want to file Special Leave Petition in the Apex Court and thus prayed that the effect of this order may be stayed at least for a period of four weeks. Learned counsel for the appellant has strongly resisted the request.

26. Considering the peculiar facts of the case, the aforesaid request is accepted and the effect of this order is stayed for a period of four weeks from today.

(V. K. JADHAV, J.)

rlj/