

**IN THE HIGH COURT AT BOMBAY
APPELLATE SIDE, BENCH AT AURANGABAD**

APPEAL FROM ORDER NO. 31 OF 2015
WITH
CIVIL APPLICATION NOS. 4240 OF 2015 & 45 OF 2016

M/s. Vikram Tea Processor Pvt. Ltd.**Appellant.**

Versus

M/s. Deluxe Tea Suppliers**Respondent.**

Mr. S.B. Deshpande, Advocate for appellant.

Mr. Rajendra S. Deshmukh, Advocate for respondent.

CORAM : T.V. NALAWADE, J.
DATED : 8th February, 2016.

ORDER :

1) The appeal is filed against order made on Exh. 5 in R.C.S. No. 5/2011 (trade mark suit) by learned Ad-hoc District Judge-1, Jalna. The suit is filed under the provisions of Trade Marks Act, 1999 and Copyright Act, 1957. Relief of temporary injunction was claimed by the present appellant/plaintiff, but the relief is refused by the Trial Court. Both the sides are heard.

2) Today itself, this Court has decided other appeal bearing O.A. No. 32/2015 filed by the present appellant, plaintiff against other party, in which relief of temporary injunction was refused to the plaintiff. The plaintiff is a private limited company

and it is in the business of tea products. It is the case of plaintiff that it is selling products under the trade names like 'Lion No. 5', 'Vikram No. 11', 'Titali' and 'Tajgi Bhara Chai' (ताजगी भरा चाय) etc. The plaintiff is doing business in Maharashtra and adjoining States. It is the case of plaintiff that it is owner of registered trade mark 'Lion No. 5' which was registered in the year 2005. It is his case that artistic work under the Copyright Act is also registered and this work is being used by the plaintiff on tea packets. It is the case of plaintiff that it has purchased the trade mark under the deed of assignment in the year 2008 from the party who has registered the trade mark.

3) It is the case of plaintiff that from prior to the date of registration of trade mark, it has been using the aforesaid trade mark 'Lion No. 5' and it has acquired reputation and goodwill in respect of this trade mark. In the plaint, the plaintiff has given the so called features and particulars of his trade mark and artistic work. It is contended that due to such characteristics of the trade mark and packet, the customers can realise that these packets are prepared by plaintiff company.

4) It is the case of plaintiff that it has spent huge amount on promotion and advertisement of the product, 'Lion

No. 5'. It is contended that in the year 2002-03 amount of more than Rs. 19 lakh was spent on promotion and advertisement and the amount went on increasing every year and in the year 2012-13 the amount of more than Rs. 64 lakh was spent on promotion and advertisement.

5) It is the case of plaintiff that plaintiff recently came across tea packets marketed by defendant under the trade name 'Deluxe Tiger Chai'. It is contended by the plaintiff that there is deceptive similarity in the trade mark, which is being used by the defendant and the trade mark used on packet of tea used by the defendant. Plaintiff has given description of his own packets and similarities which are appearing on the packets of defendant. It is the case of plaintiff that his packets are green in colour and red colour is used for the trademark and picture of animal is used in the center. It is contended that the defendant has changed the picture of the animal and he has been using the picture of tiger in place of picture of lion, but, the appearance of the two packets is similar. It is the case of plaintiff that defendant is passing off his goods as that of plaintiff and he is using goodwill and reputation acquired by the plaintiff by spending huge amount.

6) The defendant has filed written statement and has denied aforesaid contentions of the plaintiff. He has denied that the plaintiff has right to use the aforesaid trade mark and he has right to get the injunction. He has denied that there is deceptive similarity in the trade mark and also packet used for selling the tea. It is the case of defendant that animal lion and tiger are different animals and anybody can distinguish between the two animals and so, anybody can distinguish the packets of plaintiff from the packets of defendant.

7) It is the case of defendant that he is in market since year 1971. It is the case of defendant that he has applied for registration of his own trade mark in the year 2009. It is his case that he has obtained registration under the Copyright Act under certificate dated 23.5.2012 and he has been selling the tea as 'Aasam Chai' (আসাম চায়). It is the case of defendant that plaintiff wants to establish monopoly in the market and he has filed similar suits against many businessmen to prevent them from doing the business of tea.

8) The Trial Court has rejected the application of plaintiff by holding that there is no prima facie deceptive similarities either in the trade mark or in the colour combination

and picture used on the tea packets.

9) This Court has already considered the record, which is available with the plaintiff in other matter bearing O.A. No. 32/2015, which is as under :-

"10) Copy of registration certificate of trade mark 'Lion No. 5 Chai' is produced on the record and type of trade mark is "devise". This trade mark is registered by one Rameshbhai Patel and not by plaintiff. There is photocopy of the devise on the certificate showing that the wordmark is written in Devnagari script at the top and below it, there is cup and saucer apparently yellow in colour and below that there is description of tea as 'आसाम चाय' (Aasam Chai). It is the case of plaintiff that this trade mark is assigned to him under deed of assignment in the year 2008. The application for aforesaid registration was made in the year 2001 and the certificate was issued in the year 2005. The plaintiff has produced copy of certificate issued under Copyright Act and it shows that Gujrat Tea Traders Pvt. Ltd. has registered artistic work in respect of 'Lion' and the certificate was issued in the year 2009. On the certificate, there is no photocopy of the artistic work, which is said to be registered by Gujrat Tea Traders. In any case, the so called deed of assignment is only in respect of aforesaid trade mark and no right is given by

Gujrat Tea Traders in respect of aforesaid artistic work.

11) A copy of a packet which is being used to sell tea is produced on the record and it shows that the packet has the background of green colour and the trade mark is written as 'लायन नं 5 चाय ' [Lion No. 5]. Under this wordmark, there is picture of lion and below that there is description of the tea as ' नई स्टाईल मे वही कडक स्वाद ' (Nai style me wohi kadak swad). However, the company which had packed and marketed the tea is shown shows as Gujrat Tea Pvt. Ltd. and not the plaintiff. This packet is of January 2009 and the copy is issued by Copyright Office, New Delhi on 30.8.2010. It needs to be mentioned here that Gujrat Tea Traders is not plaintiff in the present case and so, this packet need not be compared with the packet which is being used by the defendant.

12) Another packet of tea, having description of trade mark ' भाइश्री की लायन नं 5 चाय ' (Bhaishri ki Lion No. 5 Chai) is produced and on that packet also, at the center, there is picture of lion which is in yellow and red circle and under it, there is description of tea ' नई स्टाईल मे वही कडक स्वाद ' (Nai style me wohi kadak swad). There is picture of the manufacturer on other side of the packet and the Vikram Tea Processor Pvt. Ltd. is

shown as manufacturer and company which has packed the tea."

13) As against the aforesaid trade mark and packet used by plaintiff, the trademark of defendant is 'Deluxe Tiger Chai'. Under this trade mark, there is artistic picture of animal, tiger, which is in yellow and red circle. Under that picture there is promotional line like 'वाघांसारख्या मर्दासाठी ' (for men like tiger). The aforesaid picture and trade mark have background of green colour. But, the appearance of the two packets from front side does not appear to be similar. The idea also does not appear to be similar. On the backside of the packet, there is the name of the person, who has packed and marketed the packets as Deluxe Tea Suppliers and he is from Aurangabad. The plaintiff is from Jalna. The photo of defendant is appearing on the backside showing that he has marketed these packets. He has further described his tea as 'total Indian Chai' (शुद्ध स्वदेशी चाय).

14) This Court has considered the cases on which reliance was placed by the learned counsel for the plaintiff in aforesaid other case which is as follows :-

"15) The learned counsel for plaintiff placed reliance on some reported cases and unreported cases which are as follows:-

(i) AIR 2001 SUPREME COURT 1952 [Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd],

(ii) 2012 BCI (0) 956 (BOMBAY HIGH COURT) (Sopariwala Exports & Anr. Vs. Kuber Khaini Private Ltd.),

(iii) 2007 (6) Mh.L.J. 7 (SC) [Heinz Italia & Anr Vs. Dabur India Ltd.],

(iv) 2005 (31) PTC 451 (Bom.) (HIGH COURT OF BOMBAY) [Hasmukhrai & Co. Vs. Raj Tea & Co. & Anr.],

(v) AIR 1984 BOMBAY 218 (1) [M/s. Hiralal Parbhudas Vs. M/s. Ganesh Trading Company and ors.],

(vi) 1990 (10) PTC 245 (Bom) (DB) (HIGH COURT OF BOMBAY) [Girnar Tea, Bombay and Anr. Vs. Brooke Bond (India) Limited, Calcutta],

(vii) AIR 1993 SUPREME COURT 276 [Dalpat Kumar and Anr. Vs. Prahlad Singh and Ors.],

(viii) 2002 (24) PTC 1 (SC) [Laxmikant V. Patel Vs. Chetanbhat Shah & Anr],

(ix) 2004 (28) PTC 121 (SC) [Midas Hygiene Industries P. Ltd. & Anr. Vs. Sudhir Bhatia & Ors],

(x) AIR 1973 (Del) 225 [Lakbir Singh Vs. Bakhat Singh and Anr],

(xi) AIR 1984 Bom. 218 [Bombay High Court] [Hiralal Parbhudas Vs. Ganesh Trading Company and Ors.],

(xii) 2009 (1) Bom. C.R. 862 (Aurangabad Bench) [Deccan Bottling & Distilling Industries Pvt. Ltd. Vs. Brihan Maharashtra

Sugar Syndicate],

(xiii) 2004 (28) PTC 83 (Bom) [Tata Tea Limited Vs. Suruchi Tea Company and Anr.],

(xiv) 1989 (9) PTC 237 (Mad) (HIGH COURT OF MADRAS) [Brooke Bond India Limited, Madras Vs. Raj Kamal Enterprises, Vizianagaram],

(xv) Copy of judgment in FA No. 2855/2013 of this Court dated 7.5.2014 [Bharat Tea Suppliers Vs. Gujrat Tea Traders Private Ltd.], and

(xvi) 68 (1997) DLT 355 (DELHI HIGH COURT) [Madan Lal Arora Vs. Soni Udyog and Anr.] dt. 20.8.1997.

16) In the case of **Cadila Health Care Ltd.** cited *supra*, which is on infringement of registered trade mark, the observations made by the Apex Court in the previous case reported as **AIR 1965 SC 980 [Durga Dutt Sharma Vs. N.P. Laboratories]** are considered and used. They are as follows :-

"In an action for infringement, the plaintiff must, no doubt, make out the case that the defendant's mark is likely to deceive, but when the similarity between plaintiff's mark and defendant's mark is so close either visually, phonetically or otherwise and the Court reaches to the conclusion that there is the imitation, no further evidence is required to establish that the plaintiff's rights are violated"

17) In action for passing off on unregistered trade mark, in the case of **Cadila Health Care Ltd.** cited *supra*, the Supreme Court has in paragraph No. 35 observed that the following factors can be considered :-

"35. Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered :

a) The nature of marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.

b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

c) The nature of the goods in respect of which they are used as trade marks.

d) The similarity in the nature, character and performance of the goods of the rival traders.

e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

f) The mode of purchasing the goods or placing orders for the goods and

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

Weightage to be given to each of the aforesaid factors depends upon facts of each case and the same weightage cannot be given to each factor in every case."

18) In the case of **Sopariwala Exports** cited *supra*, this Court has quoted and considered the law developed on the points involved in the present matter and it is quoted

at para No. 13 and 14. The law quoted is as follows :-

"13. It is a settled position as emerges from the decided cases that while comparing the two marks, the Court would be required to ascertain what is the main idea or salient features. That it has to be taken into consideration, that marks are remembered by the general impressions or by some significant detail rather than by a photographic recollection of the whole. It is to be considered as to whether there is overall similarity. In the touchstone, marks must be looked at from the view and first impression of a person of average intelligence and imperfect recollection. Overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic tests must be applied. The purchaser must not be put in a state of wonderment. Marks must be compared as a whole, microscopic examination being impermissible. The broad and salient features must be considered for which the marks must not be placed side by side to find out differences in design, and overall similarity is sufficient.

14. In a case of this nature what will be relevant to consider is that whether there is any overall visual similarity between the label of the plaintiffs and that of the defendants and while doing so it will not be permissible to compare the same by keeping them side by side. In addition to this, the factors like nature of the commodity, the class of purchasers and other surrounding circumstances would also have to be taken into consideration. In that view of the matter, I find that contention of the learned Counsel for the defendant that the Court while comparing the mark of the plaintiffs and defendants should only take into consideration the words AFZAL and KUBER is without substance."

15) In view of the facts and circumstances of the present matter this Court holds that on merit the case of the defendant that he has vested right needs to be considered and in that regard provision of section 34 of the Trade Mark Act, 1999 needs to be kept in mind, which is as follows :-

"34. Saving for vested rights.- Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior -

(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or

(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his, whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark."

16) The trade mark needs to be considered as a whole and there is no similarity of nature mentioned above. In view of the aforesaid circumstances, this Court holds that the trial Court

has not committed error in refusing to use the discretion in favour of plaintiff. The appellate Court is not expected to interfere lightly in such order made by the trial Court.

17) In the result, the appeal stands dismissed. Civil Applications are disposed of.

[T.V. NALAWADE, J.]

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