

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

APPEAL FROM ORDER NO. 32 OF 2015
WITH
CIVIL APPLICATION NOS. 4241 OF 2015 & 46 OF 2016

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

Versus

M/s. Janta Seva Enterprises**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. 1/2014 (trade mark suit) by learned Ad-hoc District Judge-1, Jalna. In a suit filed under the provisions of Trade Marks Act, 1999 and Copyright Act, 1957, relief of temporary injunction was claimed by the present appellant/plaintiff to prevent the defendant from infringement of trade mark registered under the Act and to prevent them from passing off their goods as that of plaintiff. Both the sides are heard.

2) Plaintiff Vikram Tea Processor is a private limited company and its office is situated at Jalna. Defendant is a

proprietor of Janta Seva Enterprises and he is doing business in Aurangabad and both plaintiff and defendant are in the business of tea products.

3) It is the case of plaintiff that it is selling tea packets of various weights under trade name 'Lion No. 5' in Maharashtra and adjoining States. It is contended that plaintiff is selling tea packets under other names like 'Vikram No. 11', 'Titali' and Tajgi Bhara Chai 'ताजगी भरा चाय ' etc.

4) It is the case of plaintiff that trade mark 'Lion No. 5' is registered in the year 2005 by Gujrat Tea Traders Pvt. Ltd. and under the deed of assignment of the year 2008 right is given to the plaintiff to use the trade mark. It is contended that plaintiff has been using artistic work in respect of 'lion' on the packet and it is proprietor of such copy also.

5) It is the case of plaintiff that it has spent huge amount for publication and promotion of its brand 'Lion No. 5' and plaintiff has acquired reputation and goodwill in respect of this brand. In the plaint, plaintiff has described the packet which is being used for selling the tea under this trade mark. It is contended that due to peculiar characteristics of packet, the

customers realise that the packets are of plaintiff company. It is contended that plaintiff spent more than Rs. 19 lakh in the year 2002-2003 and every year the amount on promotion went on increasing and in the year 2012-13, amount of Rs. 64 lakh was spent on the promotion of this brand.

6) It is contended that recently plaintiff came across packet marketed by defendant under trade mark 'Li-on No. 1'. It is contended that the packet used by defendant and the trade mark are very much similar to the packet and trade mark of plaintiff and it is causing confusion in the minds of customers. It is contended that the defendant is trading on reputation and goodwill of plaintiff and he is passing off the goods as that of plaintiff. It is contended that the trade mark 'Li-on' is both visually and phonetically similar to the trade mark of plaintiff and so there is deceptive similarity in the trade mark. It is contended that when plaintiff is using artistic work in respect of animal 'Lion' on the packet, defendant is also using picture of similar animal 'Tiger' at the same place to deceive customers. It is contended that the defendant has created such packet and has been using the trade mark dishonestly with the intention to pass off the goods as that of plaintiff. It is contended that defendant is new entrant in the market and due to aforesaid

activities of defendant, there has been infringement of registered trade mark of plaintiff and the act of defendant amounts to passing off.

7) The defendant filed written statement and denied that plaintiff is a proprietor of aforesaid trade mark or plaintiff has copyright in respect of particular kind of packet. The contention regarding amount spent on promotion and publicity is also denied. It is contended that plaintiff has no right to file such suit as it is not proprietor of both the artistic work and the trade mark.

8) It is the case of defendant that he has registered trade mark 'Li-on' and he has been selling tea products under the registered trade mark from prior to so called assignment of trade mark in favour of plaintiff. It is contended that defendant is in this business since the year 2001 and his trade mark is registered. It is contended that the artistic work appearing on the packet of defendant is original and it is no way similar to the packet which is being used by the plaintiff. It is contended that the plaintiff is trying to establish monopoly in the business and only with that intention, plaintiff has filed the present suit. It is the case of defendant that he has right to do the business and

such right is constitutional right.

9) The trial Court has refused relief by observing that there is no prima facie case in favour of plaintiff and there is no deceptive similarity in the trade mark and in the packets which are used by the defendant.

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 word mark, 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 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. As against this packet, there is the packet of tea of defendant, showing on the top its trade mark as 'J S T'. Below it, there is another name written as 'लि-ओन नं. 1 चाय' (Li-on No. 1 Chai) and below it, in white and red circle, there is picture of tiger. Below the picture of tiger, there is description of tea as ' हर पल आसाम चाय ताजगी भरा ' (Har Pal Aasam Chai Tajgi Bhara). Janta Seva Enterprises, defendant is shown as concern which has packed and marketed the packet. On the other side of the packet, there is picture of earth in red colour and on the earth, one Eagle is shown as sitting.

13) Defendant has produced copy of certificate of registration of trade mark and it shows that trade mark 'J S T' is registered by defendant. The application was given in November 2007 and certificate was issued in March 2009. Copy of certificate of registration obtained under Copyright Act is also produced by defendant and it shows that artistic work in respect of animal tiger is registered. The photocopy of the said work

shows that on the top, there is registered trade mark 'J S T', under it, the name of manufacturer is mentioned as Janta Seva and under it, the description is given as 'Saher Tea'. Below it, there is picture of tiger and under it, there is description of the tea as ' नये अंदाज मे जनता सेवा अनोखा स्वाद ' (Naye andaz me Janta Seva anokha swad). This certificate was issued in the year 2013. The artistic label was registered under the trade mark Act in the year 2012.

14) The record produced and the contentions show that from prior to the deed of assignment made in favour of plaintiff, the defendant is in this business and he had registered his own trade mark 'J S T'. The figures of promotion and publicity are not of plaintiff, but they appears to be of Gujrat Tea Traders. There is no specific case of plaintiff with regard to damage caused by the business of defendant. Thus, the plaintiff has a deed of assignment only in respect of trade mark 'Lion No. 5 Chai', but he is using the trade mark as ' भाईश्री की लायन नं 5 चाय ' to make the distinction between the trade mark which is being used by Gujrat Tea Traders and trade mark which is being used by the plaintiff. On the other hand, the defendant has his own trade mark 'J S T' though he is using this trade mark and other name like 'Li-on No. 1 Chai'. The plaintiff has taken care to distinguish

his goods as the photograph of person controlling plaintiff company is present on the packet and the description of the label, packet of defendant is altogether different. In view of these circumstances it is difficult to infer that persons are likely to be deceived due to use of packet of aforesaid nature by defendant. The colour of the packet appears to be similar, but there is no registration of such colour or copy in favour of plaintiff and the defendant has been using it from prior to 2007. Trade mark needs to be considered as a whole and so, it is not possible to hold at this stage that there is deceptive similarity.

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."

19) The observations made in cases cited supra show that each case need to be decided on the basis of facts and circumstances of that case. In view of the facts of the present matter, the following provisions of Trade Marks Act, 1999 need to be used :-

"27. No action for infringement of unregistered trade mark.- (1) No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark.

(2) Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods of another person or as services provided by another person, or the remedies in respect thereof.

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.

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 by 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 of 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."

20) The aforesaid provisions and facts of the present matter show that even on the packet of tea, the plaintiff has not mentioned the name of the packet ' भाईश्री की लायन नं. 5 चाय ' as registered trade mark. There is material produced to show that the right to use the trade mark 'लायन नं. 5 चाय' is acquired by the plaintiff, but he is not using that trade mark as it is. On the other hand, the defendant has been using his trade mark, which is registered as 'J S T' and it is his case that from prior to the assignment of rights in favour of plaintiff, he has been selling his product in the market as his mark was registered in the year 2007 and he has also registered the artistic work under the Copyright Act.

21) This Court has already discussed the differences between the trade marks and overall appearance of the two packets. It cannot be said that there is overall similarity in the two packets. In view of these circumstances, the plaintiff is not entitled to get the relief of injunction against the defendant.

Granting of such relief would prevent defendant from selling his product. The traders like plaintiff are always interested in creating monopoly in the market and in view of this possibility and aforesaid circumstances, this Court holds that the Trial Court has not committed error in refusing the relief. This Court sees no reason to interfere in the order made by the Trial Court.

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

[T.V. NALAWADE, J.]

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