

IN THE HIGH COURT OF JUDICATURE AT BOMBAY***CIVIL APPELLATE JURISDICTION*****APPEAL FROM ORDER NO. 761 OF 2016****ALONGWITH****CIVIL APPLICATION NO.957 OF 2016****IN****APPEAL FROM ORDER NO. 761 OF 2016**

Rahul Uttam Suryavanshi,)
Age : 30 yrs., Occ: Business,)
Residing at Theur Road,)
New Power House, Taluka Haveli,)
District Pune,)
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Mumdhwa Road, Hadapsar,)
Pune 411 036)

..... Appellant
(Orig.Defendant)

VERSUS

Sunil Manikchand Kasliwal,)
Age : 55 years, Occupation : Business)
Having address at Gat No. 148, B-2)
Daregaon Road, Manmad – 423 104)
Dist. Nashik, Maharashtra)

..... Respondent
(Orig.Plaintiff)

Mr.Vikrant Parashurami for the Appellant.

Mr.Pramod Patni, i/b. Mr.Chetan Agrawal for the Respondent.

CORAM : R.D. DHANUKA, J.

RESERVED ON : 19th AUGUST, 2016

PRONOUNCED ON : 30th SEPTEMBER, 2016

JUDGMENT :

By this Appeal from Order, the appellant (original defendant) has impugned the order dated 8th June, 2016 passed by the learned District Judge 3,

Malegaon allowing the application filed by the respondent (original plaintiff) i.e. Ex.5 in Trade Mark Suit No. 01 of 2015 thereby restraining the defendant from manufacturing, trading, offering or dealing in his product Sanala Lime Plaster under the name of 'SUPER MOR CHHAP' which is deceptively and phonetically similar to that of the plaintiff till the decision of the suit. The learned trial judge however made it clear that the defendant would be at liberty to manufacture and sale the said product by using any other different trade mark. The parties described in this order are described as they were described in the proceedings before the learned trial judge. Some of the relevant facts for deciding this appeal are as under :-

2. The plaintiff is the owner of the and proprietor of the trade mark of 'MOR CHHAP' under the provisions of the Trade and Merchandise Act bearing Certificate No.205389 which is valid upto 24th April, 2015. It was the case of the plaintiff that the plaintiff has been carrying on an established business as manufactures of and/or dealers in plaster, lime, mortar, limestone, cement, wall putty, wall coating and water proofing material for almost three decades and has been doing the said business under the trade name as 'MOR CHHAP'. It is the case of the plaintiff that the plaintiff was the creator of the said trade mark and its artistic work. The artistic work consists of the word 'MOR CHHAP' from Devnagri script as one of its leading and essential feature of registered trade mark. Below the said words 'MOR CHHAP' there is a picture of peacock spreading the peacock feathers and below that in Devnagri script it was written in Gold as instant Niru (Sanla).

3. It was the case of the plaintiff that the plaintiff was using the said trade mark and the trade name since last more than 28 years prior to the date of

filing the suit. The plaintiff had applied for registration of the said trade name and and trade mark under class 19, and after following the due procedure the said trade name and trade mark has been registered in the name of the plaintiff. According to the plaintiff, the plaintiff is the first and original adopter of the said trade mark 'MOR CHHAP' with device of Mor (peacock) in respect of the said product and the plaintiff has spent extensive amount for advertising its goods in the market and also held many advertisement campaign for promoting his goods.

4. It is the case of the plaintiff that by virtue of long, continuous and extensive usage and wide publicity and quality of goods, the trade mark 'MOR CHHAP' has become very popular amongst the customers and in the trade and the goods marketed by the plaintiff under the said trade mark are well known for their intrinsic good quality and are well reputed in the market. The plaintiff is the exclusive and concurrent user of the said trade mark.

5. The defendant is also dealing in the same business as that of the plaintiff and has been marketing his product i.e. Sanla under the trade name 'SUPER MOR CHHAP'. According to the plaintiff, the said trade name 'SUPER MOR CHHAP' is deceptively and phonetically similar to that of the trade mark and trade name of the plaintiff. The defendant had also applied for registration of the said trade name and trade mark with the registration authority under clause 19. The plaintiff had raised an objection in respect of the registration of the said trade mark applied by the defendant. The defendant had thereafter abandoned the said application.

6. It was the case of the plaintiff that since the defendant had been adopting the impugned mark with the malafide, dishonest and mischievous

intention of trading upon the goodwill and reputation accrued to the trade mark of the plaintiff 'MOR CHHAP' and to cheat the general public and/or to cause confusion in the course of trade, the plaintiff filed a suit on 17th July, 2015 before the learned District Judge, Malegaon, Trade Mark Suit No.01 of 2015 against the defendant for a declaration and injunction.

7. The plaintiff also filed an application (Ex.5) inter alia praying for temporary injunction against the defendant restraining him from using the impugned trade mark or any other trade mark which is deceptively similar to that of the plaintiff's registered trade mark. The defendant filed an affidavit in reply to the said Ex.5 on 6th January, 2016 and denied the allegations made therein. The learned trial judge passed a detailed order on 8th June, 2016 and allowed the said application at Ex.5 and granted injunction against the defendant from manufacturing, trading, offering or dealing any product Sanala Lime Plaster under the name of 'SUPER MOR CHHAP' which is deceptively and phonetically to that of plaintiff till the decision of the suit. Being aggrieved by the said order passed on 8th June, 2016 passed by the learned trial judge, the defendant has impugned the said order in this appeal from order.

8. Mr. Parashurami, learned counsel appearing for the defendant invited my attention to the copy of the trade name 'SUPER MOR CHHAP' used by the defendant. It is submitted that the registration certificate issued by the plaintiff registering the trade mark 'MOR CHHAP' was valid only upto 24th April, 2015. The suit filed by the plaintiff after expiry of the validity period of the said certificate was thus not maintainable and was liable to be rejected on that ground alone. It is submitted that if the plaintiff was using 'MOR CHHAP' as his business mark, the defendant has been using 'SUPER MOR CHHAP' and below that SMC

Lime Plaster is mentioned. The defendant has been using the said name and Mor in blue colour. He states that the defendant is not aware of the period since when the plaintiff has been using the trade mark or has adopted of the words 'MOR CHHAP'.

9. It is submitted by the learned counsel that the plaintiff and the defendant are in business of different kinds of products and thus there is no effect on the business of the plaintiff by virtue of the defendant selling his products in the name of 'SUPER MOR CHHAP'. He submits that there is no similarity between the trade mark of the plaintiff and the trade name used by the defendant and they are way apart from each other. He submits that since two words 'Mor' and 'Chhap' are very common in nature and are fully used by the public, the plaintiff cannot claim exclusive ownership over those two words i.e. 'Mor' and 'Chhap' and thus there are no chances of misleading or confusing the customers. He submits that the defendant has not been using the trade name 'SUPER MOR CHHAP' for business of disrepute the name and business of the plaintiff by the defendant. He submits that the application for registration of the mark being used by the defendant is pending with the concerned authority since 2009 in respect of which the plaintiff has already raised an objection.

10. It is submitted by the learned counsel for the defendant that the learned trial judge has failed to appreciate the word 'Mor' the meaning of which in Hindi and Marathi is peacock. Meaning of 'Chhap' in Hindi and Marathi is 'seal' which are common words and no exclusive rights or ownership could be claimed by the plaintiff in respect of two words which are ordinary words and are commonly used in Hindi and Marathi language. He submits that the impugned order thereby allowing the plaintiff to use 'MOR CHHAP' trade mark exclusively

is contrary to sections 15, 17, 28 and 30 of the Trade Marks Act, 1999 which is not permissible. It is submitted that the plaintiff had admittedly not applied for registration of the parts of the trade mark i.e. 'MOR CHHAP' and if had claimed exclusive ownership thereof, ought to have applied for registration of that part of the trade mark.

11. It is submitted by the learned counsel for the defendant that the learned trial judge has not considered the issue of limitation while granting injunction against the defendant in the impugned order. He submits that the entire business of the defendant has come to a stand still in view of the injunction granted by the learned trial judge. The defendant has taken substantial amount of loan for carrying on the business. Large number of employees working in the manufacturing unit of the defendant are sitting idle. The defendant is required to pay the salaries and wages to those employees without any work. He submits that if the court comes to the conclusion that the defendant shall not use the said trade name which is a registered trade mark of the plaintiff, the defendant be permitted to dispose of the existing stock of the defendant by modifying the impugned order passed by the learned trial judge.

12. It is submitted by the learned counsel for the defendant that the registration certificate issued by the authority in favour of the plaintiff also is conditional and in view of the said conditional registration granted to the plaintiff, the plaintiff even otherwise could not claim any exclusive right or any part of the said registered trade mark.

13. Learned counsel for the plaintiff on the other hand invited my attention to the photocopy of the trade mark registered by the plaintiff and

photocopy of the trade name used by the defendant. He submits that the plaintiff has been carrying on the business as manufacturer and/or dealers in various products including products sold by the defendant. He produced a copy of the registration certificate showing the validity of the certificate till 24th April, 2025. He submits that the plaintiff has spent substantial amount for advertisement and for promoting his goods in the market and has been held several advertisement campaign for the said purpose. He submits that the goods marketed by the plaintiff under the said trade mark are well known for their intrinsic good quality and are well reputed in the market.

14. It is submitted that the defendant is also dealing in the same business as that of the plaintiff. He submits that the plaintiff has been attempting to adopt the words 'MOR' and 'CHHAP' in Hindi and Marathi fonts alongwith device of a graphic representation of 'MOR' without any distinguishing features and seeks to take undue advantage and exclusivity of the words in common use. He submits that the impugned trade mark used by the defendant is devoid of any distinctive character and is not capable of distinguishing the goods of defendant from that of others. He submits that the intention of the defendant to adopt such deceptive and similar trade name and trade mark is malafide and dishonest intention, so as to damage the reputation and the goodwill of the plaintiff in the market.

15. It is submitted that the goods i.e. lime plaster is purchased mostly by the uneducated class i.e. the mesons that is very easy to create the confusion in the mind of the customer. He submits that the use of the impugned trade mark by the defendant is deemed to be the use of the counterfeit trade mark and thus the defendant has committed infringement of the trade mark of the plaintiff. He submits that the impugned trade mark is imitation of the plaintiff's trade mark

'MOR CHHAP'. It is submitted that the impugned trade mark is having phonetic similarity and the device of MOR (peacock) is similar to that of the plaintiff. The colour combination of the label of the word 'MOR CHHAP' is similar to that of plaintiff's label. He submits that since the overall view of the said label/pamphlet was phonetically similar to that of plaintiff, it causes confusion in the mind of the public at large and thus it amount to passing of action and infringement of plaintiff's registered trade mark under sections 28 and 29 of the Trade Marks Act, 1999.

16. It is submitted by the learned counsel for the plaintiff that it is the choice of the plaintiff whether to apply for registration of any part of the trade mark or not. He submits that the provisions of section 17 has to be read with sections 28 and 29 of the Trade Marks Act, 1999.

17. It is submitted that the neck of the peacock which is forming part of the trade mark of the plaintiff is tilting towards right whereas the neck of the peacock used by the defendant is tilting towards left. Reliance is also placed on sections 30 and 31 of the Trade Marks Act, 1999. He submits that the defendant had applied for registration of the trade mark 'SUPER MOR CHHAP' and abandoned the said application. He submits that the mere alleged delay in making an application for injunction is not sufficient to reject the application for injunction. In support of this submission, learned counsel for the plaintiff placed reliance on the judgment of this court in case of **Lokhandwala Construction Industries Pvt.Ltd. and another vs. Lokhandwala Infrastructure Pvt.Ltd. and others, 2016(1) Mh.L.J.221** and in particular paragraphs 11 and 15. He also placed reliance on the judgment of Supreme Court in case of **Midas Hygiene Industries (P) Ltd. and another vs.Sudhir Bhatia and others, (2004) 3 SCC 90**

and in particular paragraphs 5 to 7.

18. Learned counsel for the plaintiff placed reliance on the judgment of Division Bench of this court in case of *M/s.National Chemicals and Colour Co. and others vs. Reckitt and Colman of India Limited and another*, AIR 1991 *Bombay* 76 and in particular paragraphs 9 to 12, 17, 21, 23 and 25.

19. It is submitted by the learned counsel for the plaintiff that the arguments advanced by the learned counsel for the defendant that the employees of the defendant are sitting idle and are required to be paid salary without any work and that goods already manufactured by the defendant cannot be sold in view of the injunction order passed by the learned trial judge causing loss to the defendant is concerned, it is submitted that no such plea was raised by the defendant before the learned trial judge and cannot be allowed to be raised for the first time in this appeal.

20. Learned counsel for the defendant in rejoinder submits that the plaintiff has also not come to this court with clean hands. It is submitted that the plaintiff has been using the trade mark not similar to that is registered with the authority. He submits that since the defendant had raised an objection to the application of the plaintiff for registration of the trade mark in the year 2014, the plaintiff filed a false and frivolous suit for injunction against the defendant. He submits that the injunction thus granted by the learned trial judge be vacated and appeal filed by the defendant be allowed.

REASONS AND CONCLUSIONS :

21. It is not in dispute that the trade mark “MOR CHHAP” adopted by the

plaintiff is a registered trade mark and that the plaintiff is the owner and proprietor of the said trade mark duly registered under the provisions of the Trade and Merchandise Act bearing certificate no.205389 on 24th April, 1991. It is the case of the plaintiff that the plaintiff has been using the said trade mark since last three decades and has been doing the business as manufacturers of and/or dealers in plaster, lime, mortar, limestone, cement, wall putty, wall coating and water proofing material. It is the case of the plaintiff that the plaintiff is a creator of the said trade mark and its artistic work. The artistic work consists of the word “MOR CHHAP” in Devnagri script as one of its leading and essential features of the registered trade mark. Below the said word “MOR CHHAP”, there is a picture of Peacock spreading its feathers and below that in Devnagri script it was written as “INSTANT NIRU (SANLA)”.

22. It is not in dispute that the trade mark used by the defendant (SUPER MOR CHHAP) is not yet registered. The defendant had made an application on 13th October, 2011 for registration of the trade mark “SUPER MOR CHHAP” but abandoned the said application. A perusal of the said application also indicates that according to the defendant, the defendant has been using the said trade mark since 20th February, 2008. The defendant has also applied for registration of another trade mark “SUPER MOR CHHAP SANLA”. The said application made by the defendant is also abandoned. The document produced before this Court by the parties indicates that the user name mentioned by the defendant while applying for registration of the trade mark “SUPER MOR CHHAP SANLA” was as on 8th June, 2005. There is no dispute that the plaintiff has also raised an objection in respect of the application made by the defendant for registration of the trade mark “SUPER MOR CHHAP”.

23. In the affidavit in reply filed by the defendant before the learned trial Judge, the defendant alleged that he was not aware as to the period for which the plaintiff has been using the trade mark “MOR CHHAP”. A perusal of the impugned order passed by the learned trial Judge below Exhibit-5 on 8th June, 2016 indicates that the learned trial Judge has considered the document produced by the plaintiff showing that the registration of the trade mark of the plaintiff has been renewed upto the year 2025. It is *prima-facie* held by the learned trial Judge that there was no dispute that the names “MOR CHHAP” and “SUPER MOR CHHAP” are in respect of the same description of goods viz. Sanla Plaster used in the building construction. Such product is purchased mostly by the purchaser, instead of going to Architect or an expert and goes to the shop directly and purchase it. The purchaser may be the villager or illiterate or may be literate. It is held that the Court has to approach from the point of view of a man of average intelligence and imperfect recollection. The purchaser will not interpret the two words and split the meaning of components. It is held that the purchaser would go more by the over all structural and phonetic similarity and ultimately deceived by the over all similarity of the product. It is held that the trade mark used by the defendant is such that it is likely to cause deception or confusion in the mind of the person accustomed to the existing trade mark and has accordingly infringed the legal right of the plaintiff.

24. Learned counsel appearing for the plaintiff invited the attention of this Court to the registered trade mark of the plaintiff and the mark of the defendant. It is clear that the plaintiff and the defendant are using the trade mark showing pictorial presentation of Peacock with spreading feathers. The trade mark used by the plaintiff is titled as “MOR CHHAP”, whereas the trade mark used by the

defendant is titled as “SUPER MOR CHHAP”. In my *prima-facie* view the business of the plaintiff and the defendant is in the same area. The defendant admittedly supplies lime plaster which is essential elements in the building construction. The pictorial presentation of the Peacock reflected in both the trade marks only makes out a difference that the head of the Peacock in the trade mark of the plaintiff is tilted towards right whereas, the head of the Peacock in case of the defendant is tilted towards left. In my view, though the two trade marks “MOR CHHAP” and “SUPER MOR CHHAP” are two different words, there is deceptive synonymous and phonetically similarity to the trade mark of the plaintiff.

25. It is not in dispute that the trade mark of the plaintiff is not only registered but the user of the said trade mark of the plaintiff is also prior in point of time than the user thereof by the defendant.

26. The Division Bench of this Court in case of ***M/s.National Chemicals & Colour Co. & Ors. vs. Reckitt & Colman of India Limited & Anr. AIR 1991 Bombay 76*** has held that one cannot compare two trade marks by putting them side by side and by trying to find out similarities and differences in the two marks. It is held that what one has to see is the overall impression which the trade mark gives, because this is what members of the public carry in their minds. I am not inclined to accept the submission of the learned counsel for the defendant that the trade name “SUPER MOR CHHAP” used by the defendant is not deceptive or phonetically similar to that of the trade mark and the trade name of the plaintiff.

27. In my *prima-facie* view, device of the picture of the Peacock of the defendant is similar to that of the device of the plaintiff. The writing of words “MOR CHHAP” is also similar to that of the words used in the trade mark of the plaintiff. The colour combination of the label is also similar. The mode of writing and the words used in the name plate are also similar. The defendant has not disputed that the plaintiff has spent substantial amount for advertising his goods in the market and had held several advertisement campaign for promoting his goods and had earned the good will and reputation in the market.

28. Insofar as the submission of the learned counsel for the defendant that since two words “MOR” “CHHAP” are very common in nature and are fully used by the public, the plaintiff cannot claim conclusive ownership over those two words i.e. “MOR ” “CHHAP” and thus there are no chances of misleading or confusing the customers is concerned, a perusal of the application made by the defendant for registration of the trade mark “SUPER MOR CHHAP” and “SUPER MOR CHHAP SANLA” clearly indicates that the word “MOR CHHAP” which is common in both the applications made by the defendant are similar to the words used in the trade mark registered by the plaintiff. In my view, since the defendant himself has applied for registration of the impugned mark containing the word “MOR CHHAP”, he cannot be allowed to urge that the mark of the plaintiff containing the words “MOR ” “CHHAP” used by the plaintiff in his trade made is descriptive or common to the trade and thus no infringement thereof is committed by the defendant.

29. In my view, there is no substance in the submission of the learned counsel for the defendant that the plaintiff and the defendant are carrying on

business of different kinds of products and there is no effect on the business of the plaintiff by virtue of the defendant selling his products in the name of “SUPER MOR CHHAP”. It is not in dispute that the products sold by the defendant i.e. lime plaster is an essential element of the building construction. In my view, both the parties are thus carrying on similar business. There is no substance in the submission that the impugned order allowing the plaintiff to use “MOR CHHAP” trade mark exclusively is contrary to sections 15, 17, 28 and 30 of the Trade Marks Act, 1999 or that the same is not permissible. In my view, whether the plaintiff has to apply for registration of the part of the trade mark or for the entire trade mark being used by the plaintiff, the choice is of the plaintiff and not the defendant.

30. Insofar as the submission of the learned counsel for the defendant that there is delay on the part of the plaintiff in approaching the Court for grant of injunction and thus the learned trial Court could not have granted an injunction at the belated stage, in view of the defendant using the said trade mark for last several years is concerned, the learned counsel for the plaintiff has rightly placed reliance on the judgment of the Supreme Court in case of ***Midas Hygiene Industries (P) Limited & Anr. vs. Sudhir Bhatia & Ors., (2004) 3 SCC 90***. The Supreme Court in the said judgment has held that in cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it *prima facie* appears that the adoption of the mark was itself dishonest.

31. In my view, the defendant himself had applied for registration of his trade mark in the year 2009, which was admittedly objected by the plaintiff. The defendant was fully aware of the registration of the trade mark of the plaintiff and thus having continued to use the offending trade mark of the plaintiff continuously at his own risk inspite of the knowledge of registration of the trade mark and also to the objection raised by the plaintiff in respect of the application made by the defendant for registration of his trade mark, in my view the defendant cannot be allowed to raise a plea of delay. I am thus not inclined to accept the plea of delay raised by the defendant against the plaintiff.

32. Insofar as the submission of the learned counsel for the defendant that the registration certificate issued by the authority in favour of the plaintiff is conditional and thus the plaintiff cannot claim any exclusive right to use any part of the registered trade mark is concerned, a perusal of the certificate issued by the authority while registering the trade mark of the plaintiff “MOR CHHAP” does not indicate that the plaintiff cannot claim exclusive use of the words “MOR CHHAP” or device of Peacock.

33. Insofar as the submission of the learned counsel for the defendant that hardship is caused to the defendant in view of the injunction order granted by the learned trial Judge and that the defendant is unable to sell the products already manufactured and has to pay the salary to the employees without any work is concerned, a perusal of the record indicates that no such plea was raised by the defendant before the learned trial Judge. The defendant also did not produce any material on record before the learned trial Judge in support of this submission. Be that as it may, since the defendant has *ex-facie* committed infringement of the

trade mark of the plaintiff knowing well the registration of the trade mark of the plaintiff since long and the plaintiff having raised an objection for registration of the trade mark of the defendant, the defendant cannot be allowed to raise such plea even at this stage.

34. I am thus not inclined to accept this plea of the defendant at this stage. Be that as it may, a perusal of the impugned order passed by the learned trial Judge indicates that in the said order it is made clear that the defendant is at liberty to manufacture and sell the said product by using any other different trade mark. In my view, no prejudice is thus caused to the defendant as canvassed by the learned counsel for the defendant before this Court.

35. In my view, the impugned trade mark of the defendant is structurally, phonetically and visually similar to the registered trade mark of the plaintiff and is likely to cause confusion in the mind of the customers with average intelligence and imperfect recollection as to the source of origin of the goods. In my view, the plaintiff as an owner of the registered trade mark, is thus entitled to protection under section 29 of the Trade Marks Act, 1999 in view of the defendant committing infringement thereof.

36. In my view, the learned trial Judge has considered the pleadings and documents produced by both the parties and has also considered several judgments of the Supreme Court and this Court in the impugned order and has rightly applied the principles laid down in those judgments in the impugned order. I do not find any infirmity with the impugned order passed by the learned trial Judge. The

appeal is devoid of merits and is accordingly dismissed. No order as to costs.

37. In view of the dismissal of the appeal from order, Civil Application No.957 of 2016 does not survive and is accordingly dismissed.

[R.D. DHANUKA, J.]