

IN THE HIGH COURT OF JUDICATURE AT BOMBAY***CIVIL APPELLATE JURISDICTION*****APPEAL FROM ORDER NO. 393 OF 2016****IN****EXHIBIT 5 IN SUIT NO.01 OF 2015****IN****SUIT NO. 1 OF 2015****ALONGWITH****CIVIL APPLICATION NO. 513 OF 2016****Shri Rajeshwar Prasad @ Pappuji Singh)****Chand Sigh ,)****Prop.Alok Mehendi Product,)****Age:-40 Years, Occ : Business,)****Residing at R/O 1, Near Lal Baby Market)****Shastri Nagar, Patna State, Bihar,)****Patna City, State Bihar)****..... Appellant/
Orig.Defendant****VERSUS****Prem Mehendi Centre,)****Prop.Shri Chatraram Nemram Ehlot,)****having its off at Nashik through its Attorney)****holder Shri Jetharam Nemaram Gehlot,)****having its off. At Flt no.101, Shree Vayad)****Heights Apt.Hirawadi Road,)****Saraswati Nagar, Panchvati, Nashik,)****Maharashtra – 422 003)****..... Respondent/
Orig.Plaintiff****AND****APPEAL FROM ORDER NO. 394 OF 2016****IN****EXHIBIT 5 IN SUIT NO.02 OF 2015****IN****SUIT NO. 2 OF 2015****ALONGWITH****CIVIL APPLICATION NO. 512 OF 2016**

Suhagan Kaveri Dulhan Mehandi Centre,))
Prop.Abdul Noor Mohammad Avais,)
Age:-45, Occ : Business,)
Add:543/487, Shaikhpur, Habibpur,)
Opposit Eram Girls College,)
Thinni Chauraha Campwell Road,)
Thakurganj, Lucknow 226 003) **..... Appellant/**
Orig.Defendant

VERSUS

Prem Mehandi Centre,)
Prop.Shri Chatraram Nemram Ehlot,)
having its off at Nashik through its Attorney))
holder Shri Jetharam Nemaram Gehlot,)
having its off. At Flat no.101, Shree Vayad))
Heights Apt. Hirawadi Road,)
Saraswati Nagar, Panchvati, Nashik,)
Maharashtra – 422 003) **..... Respondent/**
Orig.Plaintiff

Mr.Nitin P.Dalvi, i/b. Ms.Sulbha Joshi for the Appellant.

Mr.Alankar Kirpekar, a/w. Ms.Jaya M.Khadilkar Manghwani, i/b. MAG Legal for the Respondent.

CORAM : R.D. DHANUKA, J.

RESERVED ON : 21st SEPTEMBER, 2016

PRONOUNCED ON : 19th OCTOBER, 2016

JUDGMENT :

Being aggrieved by both the orders dated 25th August, 2015 passed by the learned District Judge – 3, Nashik allowing the application (Ex.5) filed by the respondent (original plaintiff) in Suit No. 1 of 2015 and Suit No. 2 of 2015 inter alia praying for injunction against the appellant,his directors, partners, officers,

servants, agents and representatives restraining from using the marks, trade marks or labels that are similar or identical to that of registered trade mark and copyright of the respondent in any manner during the pendency of the suit and for other reliefs, the appellant (original defendant) has preferred these two separate appeals. The parties in this order are described as per their status before the learned trial judge. By consent of parties, both the appeals were heard together and are being disposed off by a common order. The parties have agreed that reasons as may be recorded by this court in Appeal from Order No.393 of 2016 shall also be applied to Appeal from Order No. 394 of 2016 and no separate reasons shall be recorded in Appeal from Order No.394 of 2016. This court is accordingly summarizing the relevant facts in Appeal from Order No.393 of 2016.

2. The plaintiff is proprietor of M/s.Prem Mehendi Centre and is manufacturer and seller of various mehendi products, mehendi cone, mehendi powder, hair dye, hair colours, etc. in the brand of Kaveri, Prem Dulhan, Nisha, etc. The plaintiff has been granted licence under Shop Act License No. E-14413/1 issued on 9th May, 2000. The defendant is carrying on business of manufacturing and selling mehendi products.

3. It is the case of the plaintiff that the plaintiff commenced his business in the name and style of M/s.Prem Mehendi Centre as a proprietor firm in the year 1998, of manufacturing, marketing and selling mehendi products. It is the case of the plaintiff that the plaintiff has been using the trade name “KAVERI” for his products since the year 2007. The plaintiff got his trade mark registered under the Trade Marks Act, 1999. The plaintiff's mark and label of “Kaveri Mehendi Cone” is registered vide registered no.1636298 dated 31st December, 2007. It is the case of the plaintiff that the wrapper of his product “Kaveri Mehendi Cone” is an

original artistic work, which is authored and created by Mr. Shripal Lodha on behalf of the plaintiff on payment of consideration. The plaintiff claims to be the owner of the copyrights of the artistic work and has obtained statutory protection of the said artistic work by acquiring the copyrights certificate under the provisions of Copyright Act on 9th July, 2009. It is the case of the plaintiff that the title of the work on the registration certificate is “PREM DULHAN'S KAVERI MEHANDI CONE WITH DEVICE OF LADY AND HANDS”. The plaintiff conceived of and adopted a label and name of “KAVERI” in respect of mehandi cone and mehandi powder. The said label comprises of pink coloured portion and brown coloured portion separated by a green coloured rectangular border. On the front portion the phrase “Kaveri Mehendi Cone Colour Aisa Jo Dewana Bana De” is written on topmost portion in red colour and below it word “Rajasthan's Mehendi” is written in black colour. Following it the word “KAVERI” is written in bold blue colour with the mark 'R' in circle and below it the word “Mehandi Cone” is written in bold green colour. Below the words there is image of hand with drawing of mehandi on its. Next to it is a circle describing “100% NATURAL HENNA CONE”. On the extreme right there is image of lady. On all the border of the wrapper the name and address of the plaintiff is written in yellow and white colour.

4. It is the case of the plaintiff that the plaintiff has been using the said label of his product for packing and selling all over the country and the products are also exported for sale in Nepal and Bangladesh. The said product has become famous because of its best quality. It is the case of the plaintiff that the said mark/label “KAVERI” has acquired valuable reputation and goodwill. The product of the plaintiff has acquired distinctiveness in the mind of the general public. The plaintiff has spent a huge amount of money on advertisement and

promotion in order to popularize the said mark/label. According to the plaintiff, the yearly turnover of the plaintiff is approximately Rs.50,00,000/-. The product of the plaintiff is available on a wide scale all over the country, even at the local cosmetics shops, beauty parlours, departmental stores etc.

5. It is the case of the plaintiff that the packaging of the defendant also comprises of an identical pink coloured portion and brown coloured portion separated by green coloured rectangular border. The word “KABERI” is also in bold blue colour with word “TM” above it. Similarly the other wording, description and connected descriptive matter is identical, similar to the products of the plaintiff.

6. It is the case of the plaintiff that the defendant has copied the entire get-up, layout and colour scheme of the packing material thereby infringing the copyrights of the plaintiff in the original artistic work. It is the case of the plaintiff that illegal activities of the defendant are susceptible to the naked eye easily. Any use of the impugned mark by the defendant would certainly cause confusion in the minds of the general public as well as purchasers. The phonetic similarity between the word “KAVERI” and “KABERI” is sufficient to cause confusion in the minds of the common public. The packaging work and colour combination is also identical and deceptively similar nature as to create confusion in the minds of the general public. The plaintiff therefore filed FIR vide Cr.No.54 of 2012 with the Khajekala Police Station, Patna City under sections 420, 465, 468, 471, 473, 474, 482, 483, 485, 487 of I.P.C. and sections 103 and 104 of Trade Marks Act, and sections 64, 65 of the Copyright Act on 21st April, 2012. The police station accordingly took action by seizing goods of the defendant. The defendant has obtained anticipatory bail from the Patna High Court.

7. The plaintiff once again lodged an FIR under the provisions of I.P.C., Trade Marks Act and Copyright Act on 8th March, 2014 against the defendant. It is the case of the plaintiff that the defendant deliberately initiated false criminal proceedings against the plaintiff vide M.A. NO.442 of 2013. It is the case of the plaintiff that recently the marketing executive of the plaintiff found that the defendant was selling the deceptive similar products i.e. “Kaberi Mehendi Kone” in Nashik market. The plaintiff accordingly issued a notice dated 23rd December, 2014 through his advocate to the defendant and calling upon the defendant to stop carrying the illegal activities constituting infringement of rights granted under the provisions of Trade Marks Act and to stop passing off the products. The defendant replied to the said notice through his advocate's letter dated 5th January, 2015 and denied the allegations made therein.

8. On 20th January, 2015 the plaintiff filed a suit (Trade Mark Suit No. 01 of 2015) in the Court of District and Sessions Judge, Nashik against the defendant inter alia praying for permanent injunction restraining the defendant, their partners, as the case may be, their officers, servants, agents and representatives from in any manner using marks or labels “Kaberi” that is similar or identical to that of registered trade mark and copyright of the plaintiff “Kaveri” and for other reliefs. The plaintiff also filed an application on 20th January, 2015 for a temporary/interim injunction against the defendant.

9. The defendant filed a written statement and also separate affidavit in reply in the said proceedings and resisted the suit as well as the application for interim relief.

10. By an order dated 25th August, 2015, the learned District Judge-3, Nashik allowed the said application (Ex.5) and granted injunction as prayed. Being aggrieved by the said order dated 25th August, 2015 passed by the learned District Judge-3, Nashik, the defendant has preferred this appeal from order.

11. Mr.Dalvi, learned counsel for the defendant invited my attention to some of the annextures to the plaint and also to the written statement. He submits that the defendant has already filed a copyright suit (13/2015) against the plaintiff before the learned District Judge, Patna to restrain the plaintiff from infringing copyright of the defendant and the said suit has been admitted. He submits that the plaintiff has not registered or is not authorized to use “Kaveri Mehandi Cone Colour Aisa Jo Deewana Bana De” to use it. He submits that the defendant has exclusive right to use the said phrase which has been registered as a copyright vide certificate No.A-108486/2013 under Copyright Act, 1957. He submits that the defendant has obtained another copyright certificate learning No.A-101964/2013 with an artistic work and get-up over Mehandi cone which get-up of the defendant is being used by the plaintiff illegally. He submits that the design of the label, the work and the wrapper (Kone label) is work of art which has been devised and created by the defendant.

12. It is submitted that in fact the plaintiff has been committing the infringement of the trade mark and copyrights of the defendant. It is vehemently submitted that though the trade name of “KAVERI” of the plaintiff is registered with the label, the plaintiff however is not using the trade name “KAVERI” on his own registered label and has on the contrary copied the label, design, wrapper, slogan, colour scheme and entire design of the defendant which is registered under provisions of Copyright Act which can be made out from the necked eye. He

submits that the plaintiff on the contrary is trying to confuse the common people and the consumer. He submits that the plaintiff in his label of product gave a circle describing "100% NATURAL HEENA CONE" which is part of the copyright of the defendant. He submits that the registration of the plaintiff has been objected by the defendant which is pending.

13. It is submitted by the learned counsel for the defendant that the plaintiff did not file the original certificate of the copyright alongwith the plaint nor produced any such original before the learned trial judge at the time of hearing of the interim application filed by the plaintiff. He submits that the learned trial judge has no opportunity to compare the original logo of the plaintiff with the logo of the defendant. He submits that the word used by the plaintiff i.e. KAVERI is generic word and cannot be exclusively used by the plaintiff. It is vehemently submitted by the learned counsel that even from the records and proceedings filed by the learned trial judge before this court, it is clear that the plaintiff has never produced the original certificate of trademark or copyright for perusal of the learned trial judge and for comparison of the original logo of the plaintiff with the logo of the defendant.

14. Learned counsel for the defendant placed reliance on section 107 of the Trade Marks Act, 1999 which provides for penalty for falsely representing a trade mark as registered. He submits that the symbol 'R' in relation to unregistered trade mark used by the plaintiff is an offence for which the penalty is provided under section 107 of the Trade Marks Act, 1999. He submits that there is no green colour border in the registered trade mark of the plaintiff. He submits that the word 'R' used by the plaintiff is actually in the trade name and not in the registered trade mark. He submits that the photo of the lady appearing in the logo of the

plaintiff is not registered under the provisions of the Trade Marks Act, 1999. He submits that the plaintiff has in fact copied the logo of the defendant and in respect of such an offence committed by the plaintiff, the defendant has already filed a suit in an appropriate court at Patna.

15. Learned counsel for the defendant placed reliance on section 17 of the Trade Marks Act, 1999 which provides for the effect of the registration of parts of a mark. He submits that admittedly, the plaintiff did not get the entire trade mark used by the plaintiff registered. He submits that the word “KAVERI” is not exclusively registered in the name of the plaintiff.

16. Learned counsel for the defendant placed reliance on the judgment of Delhi High Court in case of *Om Prakash Gupta vs. Parveen Kumar and anr.* decided on 19th May, 2000, **86(2000) DLT 181** and more particularly paragraphs 4, 10 and 16 thereof in support of his submission that since the trade mark of the petitioner registered is subject to various disclaimer, it would be apparent that the plaintiff is not allowed exclusive use of the entire trade mark claimed to have been registered by the plaintiff while alleging infringement against the defendant. He submits that the plaintiff has committed fraud by obtaining injunction against the defendant by suppressing true and material facts and thus the injunction order granted by the learned trial judge deserves to be vacated.

17. In support of passing of action alleged by the plaintiff against the defendant, it is submitted by the learned counsel for the defendant that the defendant has been using the said trade mark “KAVERI” since 1st June, 1998 whereas the plaintiff has been using the trade mark since 10th October, 2000. He submits that the defendant is thus prior user of the trade mark. He submits that the

word “KAVERI” is not registered, the colour of the border in the label used by the plaintiff and the defendant are totally different. Learned counsel for the defendant invited my attention to the annexure to the plaint and would submit that what is annexed to the plaint by the plaintiff is not a registered trade mark which is being used by the plaintiff but has annexed the copy of the label which is being used by the plaintiff. He submits that there is thus no question of infringement of any registered trade mark of the plaintiff by the defendant. He submits that the prayer granted by the learned trial judge in favour of the plaintiff is beyond that had been prayed by the plaintiff in the application for interim injunction.

18. Learned counsel for the defendant also placed reliance on the judgment of Delhi High Court in case of ***Rhizome Distilleries P. Ltd. & Ors. vs. Pernod Ricard S.A.France & Ors.*** in FAO(OS) No.484 & CM Nos.17352/08, 3429/09 on 23rd October, 2009 and led more emphasis on the judgment of Supreme Court in case of ***SBL Limited vs. Himalaya Drug Company, 1997 PTC (17) 540*** adverted in the judgment of Delhi High Court and would submit that the word “KAVERI” being a generic work, nobody can claim exclusive right to use any such generic word as a trade mark.

19. Learned counsel for the plaintiff on the other hand submits that the defendant has suppressed several documents from this court which were forming part of the record before the learned trial judge and tendered a copy of the compilation of documents. He submits that the plaintiff had produced a true copy of the certificate of trade mark of the plaintiff along with the plaint. My attention is invited to the said annexures to the plaint. He submits that the plaintiff had however produced the original of the said trade mark certificate of the plaintiff for perusal of the learned trial judge at the time of hearing of the interim application.

He submits that the plaintiff can file an affidavit of the learned advocate who had appeared before the learned trial judge who had produced the original of the trade mark certificate before the learned trial judge if necessary.

20. Learned counsel for the plaintiff invited my attention to the copyright certificate dated 9th July, 2009 issued to the plaintiff under the provisions of Copyright Act, showing the first publication of the said copyright by the plaintiff in the year 2006. The title of the work is “Prem Dulhan's Kaveri Mehendi Kone” with device of lady and hands. He submits that the said application was made by the plaintiff on 3rd April, 2009 and was received on 6th April, 2009 by the authority. Reliance is also placed on the label of the plaintiff at page 39 of the compilation. He submits that in view of infringement of the trade mark and copyright by the defendant, the plaintiff had issued a notice vide its advocate's notice dated 23rd December, 2014 calling upon the defendant to withdraw the application pending with the trade mark registry filed by the defendant and not to infringe the trade mark and copyright of the plaintiff. The plaintiff also threatened the defendant of criminal proceedings. My attention is also invited to the reply to the said notice issued by the defendant through its advocate alleging that the defendant was the owner of the trade mark “KABERI” and had got the copyright certificate under the provisions of Copyrights Act, 1957. He submits that the stand taken by the defendant in the reply to the legal notice is inconsistent with the stand taken by the defendant in its reply to the legal notice issued by the plaintiff through its advocate.

21. Learned counsel for the plaintiff invited my attention to the page 182 of the compilation of the documents i.e. photocopy of the copyright certificate issued to the defendant and would submit that even according to the said

certificate, the year of the first publication claimed by the defendant itself was in the year 2011 and the application for registration was made by the defendant on 6th December, 2011. He submits that the trade mark “KABERI” used by the defendant is admittedly not registered till date.

22. Learned counsel for the defendant invited my attention to the label of the defendant and compared the same with the label used by the plaintiff to show the similarity and in support of his submission that the label used by the defendant was totally deceptive. He submits that the defendant has admittedly applied for registration of the trade mark “KABERI”. The plaintiff has already lodged an objection to the said application made by the defendant. He submits that since the defendant itself has applied for registration of the said word “KABERI” the defendant cannot be allowed to urge that the word “KABERI” is a generic word and cannot be used as a trade mark and that the plaintiff has infringed his alleged trade mark.

23. Learned counsel for the plaintiff invited my attention to the reply to the legal notice issued by the plaintiff and would submit that it is the case of the defendant itself in its reply that the defendant is a manufacturer and producer as well as seller and supplier of the KABERI MEHANDI all over India and their products shall be sold in any market in India alleging that the defendant was the only right owner and proprietor of the trade mark KABERI MEHANDI. He submits that this stand of the defendant itself is false and misleading. He submits that in any case since the defendant claims to be the supplier of KABERI MEHANDI all over India, the plaintiff has made out a case of infringement and passing of.

24. It is submitted by the learned counsel for the plaintiff that the registered trade mark of the plaintiff is subsumed in the label of the defendant. The substantial ingredients of the label of the plaintiff are copied in the label of the defendant. It is submitted by the learned counsel for the plaintiff that all the ingredients of the registered trade mark of the plaintiff are subsumed in the label used by the plaintiff. He submits that the plaintiff has made out a case for injunction and has demonstrated the infringement of the registered trade mark of the plaintiff by the defendant and thus the learned trial judge was right in granting injunction against the defendant. It is submitted that the learned trial judge having exercised discretion in granting injunction after considering the documents and pleadings of both the parties on record and after application of mind and thus the impugned order cannot be modified or reversed by this court in this appeal.

25. It is submitted by the learned counsel for the plaintiff that the defendant has admittedly applied for registration of the trade mark in three names of label which itself show that the word "KAVERI" is not a generic word. He submits that insofar as copyright registered by the defendant is concerned, the registration of the copyright of the defendant is subsequent in point of time than the registration of the copyright of the plaintiff.

26. Insofar as registration of the trade mark is concerned, it is submitted that the date of registration of the trade mark of the plaintiff is 31st December, 2007 which is much prior to the adoption of the trade mark of the defendant in the year 2011.

27. Learned counsel for the plaintiff placed reliance on the judgment of this court in case of ***Ultra Tech Cement Limited vs. Alaknanda Cement Pvt. Ltd.***

(2011) 5 **Bom.C.R.588** and in particular paragraphs 8, 11, 15 to 18 and 25 to 28. It is submitted by the learned counsel that there is no specific disclaimer on the word “KAVERI” in the certificate of registration as per section 18(5) of the Trade Mark Act.

28. Learned counsel for the plaintiff distinguished the judgment of Delhi High Court in case of **Om Prakash Gupta** (supra) relied upon by the learned counsel for the defendant on the ground that the defendant has not satisfied the ingredients of the proposition of law laid down by the Delhi High Court in the said judgment. He submits that the disclaimer in case of **Om Prakash Gupta** (supra) was specifically granted under the old Act. Reliance is also placed on section 18(4) of the Trade Marks Act and it is submitted that the reasons have to be recorded while making any registration conditional by the authority. He submits that the defendant has not approached this court with clean hands.

29. Learned counsel appearing for the plaintiff placed reliance on the judgment of this court in case of **Kamat Hotels (India) Limited vs. Royal Orchid Hotels Limited and another, 2011(47) PTC 111 (Bom.)** and in particular paragraphs 13 and 14 on the issue of protection under section 34 of the Trade Mark Act and would submit that the plaintiff has satisfied the criteria laid down by this court in the said judgment on interpretation of the section 34 of the Trade Mark Act.

30. Learned counsel for the plaintiff placed reliance on the unreported judgment of this court delivered on 13th January, 2014 in Notice of Motion (L) No.1717 of 2013 in Suit (L) No.752 of 2013 in case of **Pidilite Industries Limited vs. Jubilant Agri & Consumer Products Limited** and more particularly paragraphs

4 to 6, 8 to 17 and 22.

31. Learned counsel for the defendant in rejoinder states that there is no discussion made by the learned trial judge in the impugned order about the prior user of the trade mark either by the plaintiff or by the defendant. He reiterates his submission that the plaintiff has not produced the original of the trade mark certificate but had only produced the colour label before the learned trial judge for comparison of the said colour label with the label of the defendant.

REASONS AND CONCLUSIONS

32. A perusal of the impugned order passed by the learned trial judge below Ex.5 indicates that the learned trial judge has framed four points for determination for deciding the said application (Ex.5). Learned trial judge has held that the plaintiff is using the trade mark “Prem Dulhans Kaveri Mehandi Kone” whereas the defendant is using trade mark “TM” “Kaberi Mehandi Kone”. The learned trial judge appears to have compared the packaging of both the products and has prima facie rendered a finding that the colour of both the packaging i.e. “Kaveri Mehandi Kone” and “TM” “Kaberi Mehandi Kone” are similar having same colour i.e. brown colour background of the same and both the products are in brown colour. It is held that the artistic work shown in both the packaging i.e. photograph of one lady having green background is also same. It is held that there is resemblance in packaging as well as in colour scheme as well as in the artistic work.

33. The learned trial judge has observed that the packaging are of similar size however, the only difference which is to be found is that the plaintiff's packaging discloses “Kaveri Mehandi Kone” whereas the packaging of defendant

discloses “Kaberi Mehandi Kone”. It is held that the essential features of the packaging of the plaintiff have been adopted by the defendant in his packaging in his product. It is held that it is crystal clear that the defendant has used the same packaging, same logo and the same artistic work which is of the plaintiff. It is held that the consuming public would be confused or deceived by the get-up into thinking that the product of the defendant is in reality the product of the plaintiff.

34. Learned trial judge has rendered a prima facie finding that after going into the entire products that its colour scheme, its logo, its packaging, it is shown that resemblance between the trade mark and the labels of both the products are similar visually or phonetically and the packaging of the defendant is same as that of the packaging of the plaintiff.

35. Learned trial judge has also adverted to various judgments relied upon by the parties including the judgment of this court in case of ***Encore Electronics Ltd. vs. Anchor Electronics And Electrical Pvt.Ltd., 2007(35) PTC 714*** and has held that the only difference between plaintiff's trade mark and the defendant's trade mark is “KAVERI” and “KABERI”. The defendant has adopted the same get-up, similar packing, writing and making on the packages which is on the packaging of the product of the plaintiff. The learned trial judge has held that the plaintiff has made out a prima facie case of dishonest passing off by the defendant of his goods as those of the plaintiff entitling him to grant an order of injunction. The learned trial judge accordingly allowed the application (Ex.5) filed by the plaintiff and granted an injunction restraining the defendant, his directors, partners, officers, servants, agents and representatives from using the marks, trade marks or labels that are similar or identical to that of the registered trade mark and copyright of the plaintiff in any manner till the final disposal of the suit on merits and also

from passing off the goods of the plaintiff and from substantially reproducing any material form the copyright in the artistic work of the packing which has been annexed to the plaint till the final disposal of the suit on merits. The injunction is also granted from in any manner manufacturing, packing, using, selling or offering for sale any products bearing the impugned “Kaberi Mehendi Kone” using the plaintiff's trade mark “Kaveri Mehendi Kone” till the disposal of the suit on merits.

36. In so far as the copyright certificate relied upon by the learned counsel for the defendant in respect of artistic work is concerned, a perusal of the record indicates that the defendant had applied for registration of his copyright on 6th December 2011. The said copyright certificate further indicates that the year of the first publication claimed by the defendant itself was in the year 2011. The copyright certificate produced by the plaintiff, however, clearly indicates that the said copyright was issued to the plaintiff on 9th July 2009 under the provisions of the Copyright Act showing the first publication of the said copyright by the plaintiff in the year 2006. The title of the work is “Prem Dulhan's Kaveri Mehendi Kone” with device of lady and hands. The plaintiff had made such application on 3rd April 2009 which was received by the authority on 6th April 2009.

37. In so far as the trademark registered in favour of the plaintiff is concerned, the date of registration of the said trademark of the plaintiff is 31st December 2007 whereas the trademark adopted by the defendant is in the year 2011 which is not even registered till date. It is thus clear beyond reasonable doubt that the user of the copyright and trademark by the plaintiff is much prior in point of time than the user of the defendant of its copyright and trademark.

38. In so far as the submission of the learned counsel for the defendant that the plaintiff has copied the registered copyright of the defendant is concerned, it is the case of the defendant that the defendant had already filed a suit before a Court in Patna. The defendant had not produced any copy of any injunction order restraining the plaintiff from using any such copyright of the defendant though the copyright suit filed by the defendant against the plaintiff is pending since 2015.

39. A perusal of the reply of the defendant to the legal notice issued by the plaintiff indicates that it was the case of the defendant that the defendant has not been selling its product not only in Bihar but all over India. The defendant, however, had taken a different stand in the written statement filed in the suit by the plaintiff and has now alleged that the defendant has not been carrying on any business in Nashik. It is the positive case of the plaintiff that sales representatives of the plaintiff had noticed that the defendant has been selling its similar product in Nashik. I am thus not inclined to accept the submission of the learned counsel for the defendant that the defendant is prior user of trademark and copyright claimed by the plaintiff.

40. This Court in the case of ***Kamat Hotels (India) Ltd. (supra)*** has interpreted Section 34 of the Trade Marks Act and has held that in order to avail of the protection under Section 34, trademark must be used by the Proprietor or by his predecessor in interest and such trademark must have been used from the date prior to the use of the registered trademark or the date of registration of the registered trademark whichever is earlier. It is held that if the user by the plaintiff is prior to registration, then the use by the defendant must be established to be prior to the use by the plaintiff. If the plaintiff has not used the mark prior

to the date of registration, the use by the defendant has to be prior to the date of registration of the plaintiff's mark. The use must be in respect of goods and services for which the plaintiff's mark is registered. The use must be continuous.

41. In my view, the principles laid down by this Court in the case of ***Kamat Hotels (India) Ltd. (supra)*** squarely applies to the facts of this case. On applying principles laid down in the said judgment, in my view, the user of the plaintiff of the trademark and the copyright is not only prior in point of time but the registration itself is prior in point of time in so far as the copyright of the defendant is concerned. The trademark of the defendant is not even registered. The plaintiff has thus made out a case for protection under Section 34 of the Trade Marks Act. It is not the case of the defendant that the plaintiff has not been continuously using the said registered trademark of the plaintiff.

42. In so far the submission of the learned counsel for the defendant that the plaintiff had not produced the original of the trademark certificate of the plaintiff for perusal of the learned trial Judge at the time of hearing of the interim application and thus the learned trial Judge could not have compared the colour of the original registered trademark of the plaintiff with the trademark of the defendant is concerned, it is the case of the plaintiff that the plaintiff had produced the original of the trademark for perusal of the learned trial Judge at the stage of hearing of the interim application filed by the plaintiff. The plaintiff is ready and willing to file an affidavit of the learned counsel who appeared for the plaintiff before the learned trial Judge at the stage of hearing of the interim application to place on record that the original of the trademark certificate was in fact produced before the learned trial Judge at the time of hearing of the interim application.

43. A perusal of the order passed by the learned trial Judge indicates that the learned trial Judge has compared the trademark certificate of the plaintiff with the document produced by the defendant and has rendered various prima facie findings in favour of the plaintiff. Though the record and proceedings of the interim application transmitted to this Court by the learned trial Judge does not contain the original of the trademark certificate as alleged by the learned counsel for the defendant, it is not the case of the plaintiff that the original of the trademark certificate produced by the plaintiff was taken on record and kept in custody of the Court by the learned trial Judge. In my view, there is no reason to disbelieve the plaintiff that the original of the trademark certificate was produced by the plaintiff through his counsel at the stage of hearing of the interim application filed by the plaintiff before the learned trial Judge.

44. Be that as it may, a perusal of the record and proceedings produced for perusal of this Court indicates that the original packagings of the plaintiff as well as the defendant which are undisputed are compared by this Court with the assistance of the learned counsel appearing for both the parties. There is no dispute that the plaintiff had been using the trademark "Prem Dulhan's Kaveri Mehendi Kone." A perusal of the packagings of both the products prima facie indicates that the background of both the packagings is in brown colour. The artistic work shown in both the packagings i.e. photograph of one lady having green background is also similar. There is resemblance in packaging as well as in colour scheme as well as in the artistic work. It is not in dispute that the artistic work of the plaintiff is registered under the provisions of the Copyright Act prior in point of time than the registration of the copyright of the defendant.

45. A comparison of the packagings of both the products clearly indicates that even size of both the packets are similar. The only difference that can be found is that the packaging of the plaintiff discloses “Kaveri Mehandi Kone” whereas the packaging of the defendant discloses “Kaberi Mehandi Kone.” The pronunciation of the word “Kaberi” and “Kaveri” is almost similar. In my view, the defendant had been deliberately using the name “Kaberi” which is even when pronounced is with a view to mislead and confuse the public at large. In my view, the learned counsel for the plaintiff is right in his submission that the impugned label used by the defendant in the name of “Kaberi” is deceptively similar to the plaintiff trademark “Kaveri.” A perusal of the two labels/packagings also prima facie indicates that the packaging of the defendant comprises of an identical pink coloured portion and brown coloured portion separated by green coloured rectangular border.

46. In my prima facie view, the trademark and the copyright of the defendant is identical and resembles the registered trademark and copyright of the plaintiff and is likely to deceive or cause confusion in the minds of the consumers in relation to similar product in respect of which the trademark of the copyright is registered.

47. A comparison of the labels/packagings of both the parties clearly indicates that the defendant has copied all essential features of the plaintiff's registered trademark and copyright. The impugned copyright and trademark of the defendant is structurally, visually, phonetically and confusingly similar to the prior adopted and registered trademark and copyright of the plaintiff. In my prima facie view, the label and packaging containing the registered trademark and copyright of the plaintiff will cause confusion in the minds of the consumers

with average intelligence as to the source or origin of the goods. In my view, the plaintiff has thus made out a case for infringement of the registered trademark and copyright of the plaintiff by the defendant and has been rightly granted injunction by the learned trial Judge in favour of the plaintiff.

48. In so far as the submission of the learned counsel for the defendant that the word “KAVERI” is a generic word and cannot be exclusively used by the plaintiff as trademark is concerned, it is not in dispute that the defendant himself had applied for registration of three trademarks containing the word “KABERI.” In my view, since the defendant himself has applied for registration of trademark containing the word “KABERI,” the defendant cannot be allowed to urge that the word “KAVERI” is a descriptive or generic or common to the trade and therefore cannot be allowed to be used by the plaintiff.

49. In so far as the submission of the learned counsel for the defendant that the word “Kaveri” is not exclusively registered in the name of the plaintiff and what is registered is subject to the various disclaimer and thus the plaintiff cannot be allowed to use exclusively the entire trademark being used by the plaintiff by alleging infringement against the defendant is concerned, a perusal of the certificate of registration of trademark of the plaintiff does not indicate that there is a disclaimer against the use of word “Kaveri” in the said registration certificate of trademark of the plaintiff. I am inclined to accept the submission of the learned counsel for the plaintiff that all the ingredients of the registered trademark of the plaintiff are subsumed in the label used by the plaintiff and that the registered trademark of the plaintiff is also subsumed in the label of the defendant.

50. In my view, even if the plaintiff has not been using the entire word of the registered trademark or artistic work of the registered copyright in the label/packaging of the plaintiff, in view of the fact that the plaintiff has been using the said trademark and copyright which is annexed to the plaint since the period prior in point of time and in view of the fact that the defendant has not got his trademark registered and the copyright of the defendant having been registered subsequently in point of time than the copyright of the plaintiff and also the user thereof subsequently in point of time than the plaintiff, the plaintiff has made out a case for infringement of the trademark and copyright of the plaintiff and also the case of passing off against the defendant.

51. In so far as the judgment of the Delhi High Court in the case of ***Om Prakash Gupta (supra)*** relied upon by the learned counsel for the defendant is concerned, the disclaimer in the said judgment was specifically granted under the old Act. Under Section 18(4) of the Trademarks Act, the authority granting any conditional registration has to record reasons. No such reasons are recorded by the authority while granting the certificate of the registration to the plaintiff while registering the trademark of the plaintiff. There is no case made out by the defendant of alleged disclaimer against the use of the word “Kaveri” by the plaintiff.

52. In so far as the judgment of the Delhi High Court in the case of ***Rhizome Distilleries P. Ltd. and Ors. (supra)*** relied upon by the learned counsel for the defendant is concerned, in my view, the said judgment of the Delhi High Court supports the case of the plaintiff and not the defendant. In so far as the judgment of the Supreme Court in the case of ***SBL Limited Vs. Himalaya Drug Company (supra)*** adverted in the judgment of the Delhi High Court holding that

nobody can claim exclusive right to use any word, abbreviation, or acronym which has become public juris is concerned, in my view, since the defendant itself has applied for registration of the trademark containing the word “Kaberi,” the judgment of the Supreme Court in the case of ***SBL Limited Vs. Himalaya Drug Company (supra)*** would not assist the case of the defendant.

53. A perusal of the record further prima facie indicates that the defendant was aware of the trademark and copyright of the plaintiff and inspite of such knowledge had been using the trademark and copyright similar to that of the plaintiff, the defendant cannot be allowed to rely on the trademark and the copyright being used by the defendant after such knowledge of similar trademark and copyright of the plaintiff. This Court in the case of ***Ultra Tech Cement Limited (supra)*** has adverted to the judgment of this Court in the case of ***Hiralal Parbhudas Vs. Ganesh Trading Company & Ors.***, reported in ***AIR 1984 Bom 218*** and more particularly paragraph 5 thereof which is extracted as under :-

"5. What emerges from these authorities is (a) what is the main idea or salient features, (b) marks are remembered by general impressions by some significant detail rather than by a photographic recollection of the whole, (c) overall similarity is the touchstone, (d) marks must be looked at from the view and first impression of a person of average intelligence and imperfect recollection, (e) overall structure, phonetic similarity and similarity of idea are imperfect recollection, (e) overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic tests must be applied, (f) the purchaser must not be put in a state of wonderment, (g) marks must be compared as a whole microscopic examination being impermissible, (h) 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 (i) overall similarity is sufficient. In addition, indisputably must also be taken into consideration the nature of the commodity, the class of purchasers, the mode of purchase and other

surrounding circumstances."

54. I am thus not inclined to accept the submission of the learned counsel for the defendant that the label/packaging used by the defendant is not exactly similar in so far as the colour of the background used in the label/packaging of the defendant with the label/packaging of the plaintiff is concerned and thus no case of infringement of copyright and trademark is made out by the plaintiff. The submission of the learned counsel for the defendant is contrary to the principles laid down by this Court in the case of ***Hiralal Parbhudas Vs. Ganesh Trading Company & Ors. (supra)***.

55. Division Bench of this Court in the case of ***M/s.National Chemicals and Colour Co. and Ors. Vs. Reckitt and Colman of India Limited and Anr.***, reported in ***AIR 1991 Bombay 76*** has considered the picture mark in one case consisted of two birds and the picture mark in another case consisted of only one bird and has held that one cannot compare two trade marks by putting them side by side to try to find out similarities and differences in the two marks. 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. In my view, the principles laid down by the Division Bench of this Court in the case of ***M/s.National Chemicals and Colour Co. and Ors. (supra)*** squarely applies to the facts of this case.

56. In my prima facie view, since there are similarities in the colour of the packagings, artistic work shown in both the packagings i.e. photograph of one lady having green background, size of the packagings being similar, the only difference being that the packaging of the plaintiff discloses "Kaveri Mehendi Kone" whereas the packaging of the defendant discloses "Kaberi Mehendi Kone,"

the defendant using the same logo thereby causing confusion in the minds of the consumers, the plaintiff has made out a case of infringement of trademark and copyright of the plaintiff duly registered and was thus entitled for protection and injunction against the defendant from committing further infringement of trademark and copyright of the plaintiff. In my view, the learned trial Judge has considered the pleadings and documents and various judgments of the Supreme Court and of this Court and has rendered a detailed judgment and has rightly granted injunctive relief to the plaintiff. I do not find any infirmity in the impugned order passed by the learned trial Judge. In my view, both the appeals are totally devoid of merit.

57. I therefore pass the following order :-

- (i) Appeal from Order No.393 of 2016 and Appeal from Order No.394 of 2016 filed by the appellant (original defendant) are dismissed;
- (ii) In view of dismissal of the appeal, Civil Application No.513 of 2016 in Appeal from Order No.393 of 2016 and Civil Application No.512 of 2016 in Appeal from Order No.394 of 2016 do not survive and are accordingly dismissed;
- (iii) Hearing of Suit nos. 01 of 2015 and 02 of 2015 is expedited.
- (iv) There shall be no order as to costs.

[R.D. DHANUKA, J.]