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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION (L) NO. 3528 OF 2015
IN
SUIT (L) NO. 1320 OF 2015

Khursheed Anwar Mohammad Ali & Anr. ...Applicants/Plaintiffs
vs
Arya Herbals & Anr. ...Defendants

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Mr Alankar Kirpekar a/w Piyush Pande i/b MAG Legal for the Plaintiffs
Mr Yatin Khochare i/b Mehul Shah for Defendant No.1
Mr Mehul Shah for Defendant No.2.

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CORAM : S.C. GUPTE, J.
Reserved for orders : FEBRUARY 02, 2016
Pronounced on : March 2, 2016

P.C. :

This is a trademark infringement and passing off suit. The Notice of Motion seeks a temporary injunction restraining the Defendants from using the trademark “FEED FINE” or any other mark or word deceptively similar thereto.

2 The case of the Plaintiff, briefly stated, is as follows :

In or about 2000, Plaintiff No.1, who is a promoter and managing director of Plaintiff No.2, and who is in the business of marketing and exporting medicinal and pharmaceutical preparations, conceived and adopted a mark - “FEED FINE” - for cyproheptadine tablets used as an appetite stimulant. The word mark “FEEDFINE” was registered by Plaintiff No.1 with the Trade Marks Registry as of 6 November 2006. Plaintiff No.1 also claims to have created a distinctive carton for marketing his goods. The intellectual property rights in the trade mark and the distinctive design of the carton have been licensed by Plaintiff No.1 to Plaintiff No.2. The Plaintiffs have been exporting their goods bearing the mark “FEED FINE” in their distinctive cartons. It is the Plaintiffs' grievance that in December 2015, they came to know of the first Defendant's use of an identical trade mark “FEED FINE” in respect of ayurvedic medicinal preparations and with an identical or substantially similar carton. The Plaintiffs' case is that this user constitutes infringement of the Plaintiffs' registered trade mark as well as copyright in the distinctive design and artwork of the carton as also, passing off of goods. After filing of this suit, the Plaintiffs learnt about the registered trade mark "MOREFEEDFINE" of Defendant No.2 in Class 5 in respect of medicinal and pharmaceutical preparations. Defendant No.1 claimed to be a manufacturer of goods for and under instructions from Defendant No.2, who holds registration for the mark "MOREFEEDFINE". The Plaintiffs have, in the premises, amended the plaint by impleading Defendant No.2 and seeking appropriate reliefs against it.

3 The Defendants' case may be briefly stated thus: Defendant No.2, who is the registered proprietor of the trade mark "MOREFEEDFINE" in class 5, claims to be an associate of one Morehope Medicals Ltd., a company having base in Nigeria. Whereas Morehope Medicals is a registered proprietor of the mark "MOREFEEDFINE" in Nigeria, Defendant No.2 is its registered proprietor in India. Morehope Medicals approached Defendant No.2 in 2009 for manufacture of herbal tablets under the name and style of "MORE FEED FINE" for delivery to them for sale in Nigeria. After obtaining necessary approvals of FDA, India and its counterpart in Africa, NAFDAC, the Defendants have been manufacturing and marketing the product under their registered trade mark in Nigeria. The Defendants submit that the Plaintiffs were smuggling their goods under the trade mark "FEED FINE" in Nigeria; that the Plaintiffs' goods were seized by Nigerian authorities as fake and spurious; that the Plaintiffs' goods contain "Cyproheptadine Hydrochloride BP" equivalent to "Anbydrous Cyproheptadine Hydrochloride 4 mg", which is banned in Nigeria /Africa and several other countries. As for the use of the distinctive carton, it is the case of the Defendants that the carton/ label/ artistic work is created actually by Morehope Medicals which has registered the packaging label with NAFDAC. It is submitted that the Plaintiffs actually use a different label for marketing their goods and which label is registered by the Plaintiffs with the Trade Marks Registry. It is submitted that the Plaintiffs have purposely created the alleged labels/ packaging/ cartons, which are similar to those of the Defendants, only for filing of the present suit.

4 At the outset, it must be noted that what the Plaintiffs have registered with the Trade Marks Registry is the word mark “FEEDFINE” and not “FEED FINE”, though the Plaintiffs claim to be actually using the latter mark for marketing their goods. It is quite obvious that the words “FEED” and “FINE” cannot be registered as a combination of two separate words, namely, as “FEED FINE” for goods which are used as appetite stimulants. The Plaintiffs could not possibly have expected to hold a registration in respect of “FEED FINE” and have, therefore, admittedly registered their mark as “FEEDFINE”. If that is so, they certainly cannot claim monopoly to use the mark “FEED FINE” on the strength of their registration of “FEEDFINE”.

5 Secondly, the Defendants do hold registration for the mark “MOREFEEDFINE” and cannot be prevented from using the same. “MOREFEEDFINE” is a combination of three words “MORE”, “FEED” and “FINE”, albeit as one word. If the Defendants use this combination, they are well within their rights. It is another matter that may seem to be using these three words not as a single combination word, but as a combination of three separate words, namely, “MORE FEED FINE”. Whilst the Defendants may possibly do so at their own risk inasmuch as they would not be entitled to a trade mark protection against the world at large in respect of the combination as three separate words, at the same time, it may not be permissible to the Plaintiffs to injunct the Defendants from using their mark in such combination, on the strength of the Plaintiffs' own mark “FEEDFINE” which they use as “FEED FINE”.

6 What, however, seems to be offending is the use of the word “MORE” by the Defendants in an extremely small font and size, giving a distinct prominence to the words “FEED FINE” in their use of the words. This does bring their mark dangerously close to the Plaintiffs' registered trade mark. Learned counsel for the Defendants, however, in the course of their submissions, offered to discontinue with such user and give equal prominence henceforth to the word “MORE” as the other two words “FEED” and “FINE”. If they do so, the only cause for a possible infringement or passing off in the Defendants' use of their

registered trademark, is satisfactorily removed. The Plaintiffs cannot, thereafter, have any grievance regarding the Defendants' use of their own registered trade mark.

7 The only questions that now need to be considered are of the alleged infringement of copyright claimed by the Plaintiffs in their label/ packaging/ carton, and the case of passing off urged in connection with the use of such label/ packaging/ carton. As noted above, the rival cases of the parties on the Defendants' adoption and use of their label/ packaging/ carton suggest that whereas the Plaintiffs claim to have conceived, adopted and used the label first and the Defendants are claimed to have copied it, on the other hand, the Defendants claim to have registered it first with NAFDAC in 2009 and it is the Plaintiffs (who were using a different label earlier), who have copied the Defendants' label, particularly to claim infringement of copyright and passing off by the Defendants.

8 The material on record *prima facie* suggests that the Plaintiffs had applied for registration of a different label in 2011 for use with their goods marketed under the trade mark “FEEDFINE”. The present label, in connection with which the claim of breach of copyright and passing off is made, was actually applied for by the Plaintiffs on 15 September 2015. This would obviously be after the Defendants got their label approved by NAFDAC. The Defendants have *prima facie* established that their label is approved by NAFDAC on 9 April 2013. A permit issued by NAFDAC as of 7 February 2011 to Morehope Medicals shows that “MORE FEED FINE” tablets were to be imported from Defendant No.1 for registration/ clinical trial purpose to Nigeria. The Defendants have shown material that without approved labeling, pharmaceutical goods are not allowed to be imported into Nigeria. This does suggest that the Defendants actually had conceived of and designed the particular label even before February 2011 and that forms the basis of the Defendants' plea that the label was actually copied by the Plaintiffs from the Defendants and not the other way round. The Defendants, in fact, submit that the Plaintiffs have created these labels now only to urge a case of breach of copyright and passing off against the Defendants. The

Plaintiffs, on the other hand, rely on their goods marketed under the trade mark “EAT FINE” earlier as also their application for the label of “EAT FINE” in 2009 displaying the same design features and colour scheme. The Plaintiffs have submitted a specimen carton showing the manufacture date of 2009 for goods marketed by them under the trademark “EAT FINE”. Based on this material, it is difficult at this *prima facie* stage to come to any definitive finding as to who conceived of the artwork first. The Plaintiffs can be said to have a *prima facie* case that they conceived of, and used, it at least in connection with their goods marketed under the trade mark “EAT FINE” in or about 2009. On the other hand, the Defendants also have an arguable case that they conceived of it and used it in connection with their goods sold under the trade mark “MORE FINE FEED” since 2009, though the material produced by them as on date does not show their use of the label prior to February 2011.

9 In the premises, it would clearly be unsafe to grant any temporary injunction without considering the question of balance of convenience as between the parties to the fullest measure. On the question of balance of convenience, this is where the respective parties stand. Both parties have been marketing goods under the respective trade marks “FEED FINE” and “MORE FEED FINE” for the last four years; both claim to be doing so with the use of labels which have some features in common with each other. But their target customer base appears to be different. The Defendants have been exclusively exporting their goods, which contain herbal extracts, to Nigeria for a particular party; whereas the Plaintiffs have no sales at all in Nigeria. The Nigerian party, for whom the Defendants export goods, holds a registration for the mark “MORE FEED FINE” in Nigeria. It has also got the distinctive label containing the words “MORE FEED FINE” approved from the Nigerian Food & Drugs Authority, NAFDAC. The Plaintiffs' product, containing cyprohaptadine Hydrochrede B.P. equivalent to anhydrous Cyproheptadine Hydrochloride 4 mg is banned in Nigeria. If the Defendants are to be prevented from marketing goods bearing the trade mark “MORE FEED FINE” and packed in the particular carton or label, the Defendants are likely to suffer irreparable damage since the reputation and goodwill built up by them would no longer be available to them for commercial exploitation. On the

other hand, the Plaintiffs have no reputation or goodwill in Nigeria which the Defendants could be said to be trading upon. If the interim injunction is not granted, the Plaintiffs are not going to suffer any damage. As for the likelihood of deception and confusion amongst the buying public, whose interests are paramount in any trade mark infringement or passing off case, there is practically no possibility of such deception or confusion. If the Plaintiffs succeed in showing at the trial that the user of the particular artwork for their label or carton by the Defendants is indeed unauthorized and in breach of the Plaintiffs' copyright, the court can certainly award a suitable compensation to the Plaintiffs. The balance of convenience, thus, weighs heavily in favour of the Defendants.

10 Learned counsel for the Plaintiffs relied on the decisions of this Court in the cases of **Cadila Pharmaceuticals Ltd. Sami Khatib of Mumbai**[1] and **Rishabh Impex Vs. Naman Pharma Drugs & Anr**[2] in support of his contention that a trademark registered in India but applied to goods exported from India is deemed to be used in relation to those goods for the purpose of 'use' under the Act in India and action for passing off lies on the basis of such use. The Division Bench of our Court in **Cadila Pharmaceuticals (**supra) did consider the applicability of Section 56 of the Act where the offending goods were claimed to be exclusively exported outside India. The Court held that application of the impugned mark to the goods in India before they were exported was deemed to constitute the use of the trademark in relation to the goods within India. Such deemed use was relevant for establishing the act of infringement or passing off within India. Quite so, but we have examined the aspect of exclusive exports of the goods not to see if there is any passing off within India, but to examine the question of balance of convenience. Even if the use by the Defendants of the particular label/ carton were to constitute an act of passing off within India and thus could be objected to, it is relevant and apposite to note the fact that exclusive export of the Defendants' goods to a country where the Plaintiffs have no presence at all makes the injunction far more onerous and damaging to the Defendants compared to the harm caused to the Plaintiffs if the label/ carton were

1 2011(47) PTC 69 (Bom.) (DB)
2 Notice of Motion (L) No.107 of 2015 in Suit (L) No.35 of 2015 decided on 9 March 2015

allowed to be used by the Defendants in connection with the exports, as pointed out above.

11 In the premises, I am not inclined to grant any injunctive reliefs to the Plaintiffs even from the standpoint of copyright infringement or passing off action. (I have already held above that there is no case of trade mark infringement against the Defendants, since they themselves hold registration for the offending mark and propose to henceforth use all three words forming part of their mark, namely, “MORE”, “FEED” and “FINE” with equal prominence.) As far as the case of copyright infringement and passing off action is concerned, interests of justice would be adequately met, if the Defendants are asked to maintain separate accounts in respect of their goods marketed with the use of the particular label/ carton, which is claimed to be a copy of the Plaintiffs' label/ carton.

12 The Notice of Motion is disposed of, accordingly, with the following order:

(i) Pending the hearing and final disposal of the suit, the Defendants are directed to maintain separate accounts in respect of goods marketed by them with the use of the label/ carton/ artwork referred to in Exhibit “B” to the plaint or any other similar label/ carton/ artwork;

(ii) The Defendants state that the Defendants shall hereafter use all three words forming part of their registered trade mark, namely, “MORE”, “FEED” and “FINE” with equal prominence. The statement is accepted;

(iii) In the event the Defendants propose to use the particular label/ carton/ artwork referred to above for goods sold in India or any other country except Nigeria, they shall give at least a week's notice to the Plaintiffs before commencing such sales;

(iv) The Plaintiffs shall be at liberty to apply for interim reliefs in such case with notice to the Defendants. All rights and contentions of both parties on the merits of such application are kept open;

(v) No other order on the Notice of Motion.

13 The ad-interim receiver appointed earlier to stand discharged without passing accounts but subject to payment of its costs, charges and expenses. Such costs, charges and expenses to be borne by the Plaintiffs. The receiver shall remove his seal and hand over custody of the goods to the Defendants.

(S.C.GUPTE J.)