

IN THE HIGH COURT OF JUDICATURE AT BOMBAY,
AURANGABAD BENCH, AURANGABAD

APPEAL FROM ORDER NO. 39 OF 2017
WITH
CIVIL APPLICATION NO. 10457 OF 2017.

- 1 Manu Kagliwal, .. **Appellants.**
C/o. Mayo Life-Sciences Pvt.Ltd.
Nath House, Nath Road, Aurangabad.
- 2 Mayo Life-Sciences Pvt. Ltd., Nath
House, Nath Road, Aurangabad,
Maharashtra - 431 005.
- 3 Mayo Remedies Limited, Nath House,
Nath Road, Aurangabad, Maharashtra
- 431 005.

VERSUS

Mayo Foundation for Medical .. **Respondent**
Education & Research, 200 First
Street, S.W. Rochester, Minnesota -
55905, USA.

.....

Mr.Sanjeev B. Deshpande, Advocate, for the Appellants.

Mr. P.M.Shah, Senior Counsel with Mr. Santosh
Chapalgaonkar & Mr. Rounak Kamath, Advocates, for
respondents.

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CORAM : K.L. WADANE, J.

RESERVED ON : 31.08.2017.
PRONOUNCEMENT ON : 07.09.2017.

JUDGMENT :-

1. Parties are referred to their original status.
2. Present appeal is presented by the plaintiff against the order passed below Exh. 9 in Civil Suit No. 03/2016 by the learned District Judge-1, Aurangabad on 13.07.2017.
3. The plaintiff filed suit for perpetual injunction restraining infringement of trademark and passing-off, damages etc., in which he has also applied for temporary injunction. The brief facts may be stated as follows.
4. The plaintiff, Mayo Foundation for Medical Education and Research, is a charitable organization incorporated under the law of United States of America. The plaintiff's Mayo Clinic is a leading internationally known medical center recognized for *inter-alia* providing the highest quality medical care through the physician-led-team of diverse people

involved providing clinical, educational, diagnostic and research services in a unified multi-campus system.

5. Plaintiff is doing its activities under the name/trade styled as "MAYO", "MAYO CLINIC", 'the Triple Shield Design' and MAYO formative trademarks are used as part of the plaintiff's trade name and style as well as its trademarks. The trademark "MAYO" also form a key part of the domain name as plaintiff's website www.mayoclinic.org and www.mayo.edu. Through its global activities, the plaintiff's reputation and good will has split over to India and the plaintiff's services and goods under the trade mark are well known amongst the public in India as a valuable sources and repository of knowledge regarding health and medicine.

6. Since 2011 to 2015, 1,930 citizens from India have visited the hospitals in Rochester, Scottsdale and Jacksonville to avail their highly acclaimed medical services, out of which more than 1000 have been unique visitors. Further the plaintiff has

recorded 347 profile of Indian citizens who have enrolled in the plaintiff's Mayo School of Continuous Professional Development and 28 Indians who had been selected to participate in Mayo Cardiovascular Continuing Education Courses. Additionally, the plaintiff's websites have noted a progressive rise in traffic from individuals residing in India.

7. Apart from India, the plaintiff's said trademarks are also registered or have been applied for registration in 73 countries around the world.

8. The defendants are believed to be engaged in the business of marketing and selling pharmaceuticals products under the mark "MAYO" and other MAYO formative marks. The defendant No. 3 has believed to be stopped conducting its business through this company in 2011 and incorporated defendant no. 2 to carry on its business activity. So, in short, it is the contention of the plaintiff that, the defendants are using his trade name/mark "MAYO" to introduce their products in market in India and the ordinary

customer is likely to be confused about the trade name/mark and may purchase the goods under the impression that the goods are belonging to the plaintiff's product.

9. According to the plaintiff the name/mark "MAYO" is phonetically and visually used by the defendants is similar to the trade name/mark of the plaintiff's MAYO Foundation.

10. As against this, it is the case of the defendants that, the origin of the name is taken from "MAA YOGMAYA" which is the name of deity of the defendants.

11. Considering the evidence on record and upon hearing both the sides the learned District Judge-1 restrained the defendants from using word "MAYO". Therefore, the present appeal.

12. I have heard the arguments of Mr. Sanjiv Deshpande, learned counsel appearing for the

appellant/defendant and Mr. P.M. Shah, learned Senior Counsel appearing for the respondent/plaintiff.

13. Mr. Deshpande learned counsel has submitted that the plaintiff applied for the registration of the trademark in India in the year 2011 and the defendants are using the trade name "MAYO" since 1982. Therefore, the defendants are first in time in the business. Therefore, it cannot be said that the trade name of the plaintiff's is used by the the defendants. Further, he argued that, the activities of the plaintiff are in regards mainly with the medical services and the business of defendants is marketing and selling the pharmaceuticals products. Therefore, the class of the business is altogether different and therefore it cannot be said that the defendants are using the trade name/mark of the plaintiff for doing their business of selling pharmaceuticals.

14. Mr. Deshpande further submitted that the trade name/mark and area of plaintiff and defendants is altogether different, as the plaintiff is doing the

business in USA and other countries and the defendants area of business is of India.

15. As against this Mr. Shah, learned senior counsel has argued that the word "MAYO" is trade name /mark of plaintiff and the plaintiff is using it since 1914. Number of citizens of India have visited the plaintiff's institution either for treatment or for academic sessions. Mr. Shah further argued that, the defendants have copied the origin of the plaintiff's from its website and displayed it, as it is their origin. Mr. Shah further argued that, though the plaintiff is doing services but such services are regarding the same field i.e. the medical field. He further submitted that, the feature of the word "MAYO" used by the defendants is phonetically and visually are similar with the trade name/mark of the plaintiff. According to Mr. Shah the area of the trade of plaintiff is not restricted to USA but it extend to all over the world. The plaintiff is using his trade name/mark since 1914 and registered in almost 200 countries in the world.

16. Mr. Shah, further argued that, when the defendants applied for the registration of the trade name/mark "MAYO" at the relevant time the plaintiff have objected the same. Therefore, the claim of defendants is abundant.

17. Considering the arguments advanced by both the sides, I have carefully observed the trade name/mark of the plaintiff as well as the trade name/mark used by the defendants. Looking to the both trade names, it appears that the trade name/mark used by the defendants is exactly similar with the trade name/mark of the plaintiff, who is in the global market since 1914. Further, it appears that the defendants were in the market since 1982. The defendants applied for using trademark in India in the year 2011.

18. Nowadays, it is very easy for any person to know the the facilities provided by the plaintiff through the Internet. So also, it is possible to purchase the articles online. Due to development in the information and technology, the whole world came

under one roof. Therefore, distinction cannot be made in regards with the trade in one country and in multiple countries. In such circumstances it cannot be said that the area of the business of the plaintiff is restricted to the USA and it has no connection with the business in India, as due to Internet the whole world comes on a finger point.

19. As referred above, the prefix name as used by the plaintiff as well as the defendants is exactly similar. Hence, infringement mostly occurs when another trader copies the essential features of the trademark but sell the goods in his own name in contrast to counterfeiting where the counterfeiter holds out that the goods are produced by the actual proprietor. Some elements of inconsequential nature are intentionally inserted in the Trade Marks, so as to plead the differences in faced with civil or criminal proceedings. If a mark/name is confusingly similar to a registered Trade Marks used on similar goods or services, it constitutes infringement. The infringement action is a statutory remedy available to

the registered proprietor or to the registered owner, based upon the statutory rights conferred by the Registration of a Trade Mark. The infringement action is now contemplated when a mark is unauthorizedly used not only on the same goods or services but also on similar goods or services to those covered under the registered trademark.

20. Section 29(2) provides three circumstances in which the infringement may take place if any of the two results take place.

- (i) The use of the trade mark is unauthorized.
- (ii) Use of the mark is in course of trade,
- (iii) (a) Offending mark is identical to the registered Trade Mark and goods or services are similar; or
(b) Offending mark is similar to the registered Trade Mark and goods or services are identical or similar; or
(c) Offending mark is similar to the registered Trade Mark and goods or services are identical. In this case there

is a presumption of likelihood of confusion on the part of the public, or in other words the act of infringement is complete.

The result should be any one of the following two, if any one of the above situation is applicable.

- (i) Likelihood of confusion on the part of the public, or
- (ii) The infringement mark is likely to hold out an association with the registered Trade Mark.

21. Herein the present case, looking to the features of the word "MAYO" used by the defendants for trading their products, an ordinary person can confuse, as the trade name/mark used by the defendants is phonetically and visually is exactly similar with the trade name/mark of the plaintiff. Due to such features adopted by the defendants in their trade name/mark, definitely an ordinary customer will confuse and will be under impression that the products introduced by the defendants are belonging to the

plaintiffs.

22. In the present case, though the class of business of the plaintiff and defendants is different but it relates to one field i.e. medical. Therefore, there is close proximity between the services of the plaintiff as well as trade of the defendants.

23. The defendants have applied for registration as trade mark/name "MAYOCIP" and the status of the above application as on 29.06.2016 is "abandoned". Another application was filed by the defendants for trade mark/name "MAYOFLAM". It was opposed by the plaintiff and it's status as on 29.06.2016 was "opposed". Another application was filed by the defendants for registration of trade name/mark "MAYOPRESS". It was also objected. Another application was filed by the defendants for registration of trade name/mark "MAYOTAL DS" was also objected by the plaintiff. From the web-page of defendants the trade name/marks appearing as "MAYO" is similar with the trade name/mark of the plaintiff. Therefore, it

appears from the record that an ordinary customer can carry impression in his mind that the product under the trade name/mark starts from the word "MAYO" must be belonging to the plaintiff's institution.

24. Mr. Deshpande learned counsel for the appellant has relied upon the following case laws.

(1) Cadila Health Care Ltd., V/s. Cadila Pharmaceuticals Ltd., reported in 2001 (21) PTC 300 (SC).

(2) CIPLA Limited V/s. CIPLA Industries Private Limited and Ors., reported in 2017 (3) ARBR 97.

(3) Vishnudas Trading V/s. Vazir Sultan Tobacco, reported in AIR 1996, Supreme Court, 2275,

(4) Bombay High Court, International Foodstuff Co. V/s. Parle Products, reported in MIPR 2016(2) 34,

(5) MANU/MH/1892/2016, Advance Magazine Publishers, V/s. Just Lifestyle Pvt. Ltd.

(6) Balkrishna Hatcheries V/s. Nandos International Ltd. and Anr., reported in 2007 (4) BomCR 48.

(6) Thomas Bear & Sons V/s. Prayag Narayan,

reported in 1940(42) BOMLR 734.

(7) Khoday Distilleries Limited V/s. Scotch Whisky Association, reported in AIR, 2008, SC 2737,

(8) Power Control Appliances V/s. Sumit Machines Private Limited, reported in 1994 (2), Supreme Court Cases, 448,

(9) Neel Electro Techniques and Ors. V/s. Neelkanth Power Solutions and Ors. reported in 2016(4) ABR 345.

(10) Torrent Pharmaceuticals V/s/ Wockhardt. Ltd., reported in MIPR 2017(2) 136.

(11) Kamat Hotels (India) Limited V/s. Royat Orchid Hotels, reported in 2011(7) ALLMR 514.

25. Mr. Shah, learned senior counsel appearing for the respondent has relied upon following case laws.

(1) Midas Hygiene Industries (P) Ltd., V/s. Sudhir Bhatia and others, reported in (2004) 3 Supreme Court Cases 90.

(2) Milmet Oftho Industries and others V/s. Allergan Inc. reported in (2004) 12 Supreme Court Cases 624.

(3) Wander Ltd. and another V/s. Antox India P. Ltd., reported in 1990 (Supp) Supreme Court Cases 727.

(4) S. Syed Mohideen V/s. P. Sulochana Bai, reported in (2016) 2 Supreme Court Cases 683.

(5) FDC Limited V/s. Docsuggest Healthcare Services Pvt. Ltd. & Anr. reported in 2017 SCC OnLine Del 6381.

(6) Bhavnesh Mohanlal Amin & another V/s. Nirma Chemicals Works Ltd., and another, reported in (2006) 1 Supreme Court Cases 185.

(7) Laxmikant V. Patel V/s. Chetanbhai Shah & another, reported in (2002) 3 Supreme Court Cases 65.

(8) T.V. Venugopal V/s. Ushodaya Enterprises Limited and another.

26. Mr. Deshpande, learned counsel relying upon the observations in 2001 (21) PTC 300 (SC) which reads as follows :

"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 the marks i.e. whether the marks are word 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.

27. Mr. Deshpande, learned counsel strongly relied upon the observations of the full Bench of this Court reported in AIR 2017, CIPLA Limited V/s. CIPLA Private Limited Industries and others, which reads as follows:

“For the reasons which we have set out earlier,

we are unable to concur with the view expressed in the aforesaid highlighted portions of paragraphs 45.4 and 51 of the judgment which otherwise is a very erudite opinion of the learned single Judge of the Delhi High Court. He has read into Sub-section (4) the use of a trade mark as a part of corporate/trade/business name. With greatest respect, Sub-section (4) applies only when a mark is used during the course of trade in relation to goods or services which are not similar to those for which the trade mark is registered. By way of illustration, we may say that when a trademark "XYZ" is registered in respect of goods "A" is used while selling goods of the category "B" which are not similar to "A", Sub-section (4) will apply if the other conditions are satisfied. Sub-section (5) will apply when a trademark "XYZ" is registered in respect of the goods "A" and the defendant uses "XYZ" as a part of the name of his business concern dealing in the goods similar to the goods in respect of which the trade mark is registered.

28. Mr. Deshpande further relied upon the observations in AIR 1996 SC 2275 , which reads as follows:

"The "class" mentioned in the 4th Schedule may subsume or comprise a number of goods or

articles which are separately identifiable and vendible and which are not goods of the same description as commonly understood in trade or in common parlance. Manufactured tobacco is a class mentioned in Class 34 of 4th Schedule of the Rules but within the said class, there are number of distinctly identifiable goods which are marketed separately and also used differently. In our view, it is not only permissible but it will be only just and proper to register one or more articles under a class or genus if in reality registered only in respect of such articles are intended, by specifically mentioning the names of such articles and by indicating the class under which such article or articles are to be comprised. It is, therefore, permissible to register only cigarette or some other specific products made of manufactured tobacco as mentioned in Class 34 of 4th Schedule of the Rules. In our view, the contention of Mr. Vaidyanathan that in view of change in the language of Section 8 of Trade Marks Act as compared to Section 5 of Trade Marks Act 1940, registration of trade mark is to be made only in respect of class or genus and not in respect of articles of different species under the genus is based on incorrect appreciation of Section 8 of the Trade Marks Act and 4th Schedule of the rules."

29. By relying upon the observations of the above cited authorities, Mr. Deshpande, learned counsel has submitted that the Class of the business of the plaintiff and the defendants is altogether distinct. The plaintiff's institution is mainly dealing with the medical services whereas; the defendants are dealing in the business of manufacturing and marketing of pharmaceuticals product. But it is important to note that the activities of the plaintiff as well as the defendants are in relation to the trade relating to the same field i.e. medical.

30. Mr. Deshpande, learned counsel, repeatedly harping on the aspect of delay and latches in taking the action. For which Mr. Shah, learned senior counsel has relied upon the observations of Hon'ble Supreme Court in case reported in 2011 (4)Supreme Court Cases, 85 which reads as follows :

"The learned counsel for the respondent Company also relied on a judgment of this Court in *Midas Hyugine Industries (P) Ltd. Vs. Sudhir Bhatia*. The Court observed that:

"The law on the subject is well settled. 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. Thus the observations of the Division Bench of the Hon'ble Supreme Court is complete answer to the question raised by Mr. Deshpande, learned counsel. In my opinion, the prima-facie case is made out by the plaintiff in regards to the infringement of trade name/mark then the temporary injunction has to be issued against the defendants and in such circumstances some delay has no significance looking to the interest of the parties to the litigation.

32. Mr. Shah, learned senior counsel further relied upon the observations in case reported in 2017 SCC Online Del 6381, which read as follows:

"Goods and Services can be "related" without being Competitive. To be "related" in the

parlance of trademark law, the conflicting good or services do not have to be *in* competition with each others. That the goods or services are noncompetitive does not answer the question of whether the goods are so "related" that a reasonable buyer is likely to think that defendant's goods or services are somehow connected with, or sponsored by, the plaintiff, due to similar marks. There is no simple, one question test for determining whether noncompetitive products are "related" such that confusion is likely as to source, affiliation, connection or sponsorship.

What does "related" mean ? Goods are "related", not because of any inherent common quality of the respective goods, but "related" in the sense that buyers are likely to believe that such goods, similarly marked, come from the same source, or are somehow connected with or sponsored by a common company. As the Federal Circuit observed, "related" means related in the minds of potential buyers:

Goods that are neither used together nor related to one another in kind may still "be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis".

"Related" does not mean that there is

necessarily any physical relationship between the goods or services identified by the conflicting marks. Rather, it means that the marks as used are "related" in the mind of the consuming public. Goods are "related" if customers are likely to mistakenly think that the infringer's goods come from the same source as the senior user's goods or are sponsored by, affiliated with or connected with the senior user. As the Ninth Circuit stated : "The (defendant's) use need not to be the same as, nor one in competition with the original use. The question is, are the uses so related that they are likely to be connected in the mind of a prospective purchaser?..."

33. From the observations referred above it appears that the business relating to the services as well as goods are related business. Therefore, in my opinion, there is proximity between the services of the plaintiff and the business of the defendants.

34. Mr. Shah, learned senior counsel further relied upon a case reported in 1990 SCC 727 in which it is observed that,

"The appellate court will not interfere with

the exercise of discretion of the Court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by the court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion. After referring to these principles Gajendragadkar, J. in *Printers (Mysore) Private Ltd. Vs. Pathan Joseph*:

"...These principles are well established, but

as has been observed by Viscount Simon in *Charles Osenton & Co. v. Jhanaton*... the law as to the reversal by a court of appeal of an order made by a judge below in the exercise of his discretion is well established, and any difficulty that arises is due only to the application of well settled principles in an individual case."

35. Herein the present case on going through the reasons recorded by the learned District Judge, it appears to me that he has passed well reasoned order and it cannot be said that the District Judge has exercised its discretion arbitrarily or capriciously or perversely. Therefore, there is no reason for this court to substitute its own discretion.

36. As already referred above, the services and the business of the plaintiff respectively are in relation to the same field i.e. medical, therefore, the following observations of the Supreme Court in case reported in (2004) 12 Supreme Court 624, is important, which quoted below :

"7. In the case of *Cadila Health Care Ltd v.*

Cadila Pharmaceuticals Ltd., the question was whether the marks "Falicigo" and "Falcitab" were deceptively similar. The trial court refused interim injunction. The appeal was also dismissed. This Court did not interfere on the ground that the matter required evidence on merits but laid down principles on which such cases were required to be decided. This Court held that in a passing-off action for deciding the question of deceptive similarity the following facts had to be taken into consideration:

"(a) The nature of the 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.

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

In respect of medicinal products it was held that exacting judicial scrutiny is required if there was a possibility of confusion over marks on medicinal products because the potential harm may be far more dire than that in confusion over ordinary consumer products. It was held that even though certain products may not be sold across the counter, nevertheless, it was not uncommon that because of lack of competence or otherwise mistakes arise specially where the trade marks are deceptively similar. It was held that confusion and mistakes could arise even for prescription drugs where similar goods are marketed under the marks which looked alike and sound alike. It was held that physicians are not immune from confusion or mistake. It was held that it was common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently the handwriting is not legible. It was held that these facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike.

8 We are in all agreement with what has been laid down by this Court. Whilst considering the possibility of likelihood of deception or confusion, in present times and particularly in the field of medicine, the courts must also keep in mind the fact that nowadays the field of medicine is of an international character. The court has to keep in mind the possibility that with the passage of time, some conflict may occur between the use of the mark by the applicant in India and the user by the overseas company. The court must ensure that public interest is in no way imperilled. Doctors, particularly, eminent doctors, medical practitioners and persons or companies connected with the medical field keep abreast of latest developments in m medicine and preparations worldwide. Medical literature is freely available in this country. Doctors, medical practitioners and persons connected with the medical field regularly attend medical conferences, symposiums, lectures, etc. It must also be remembered that nowadays goods are widely advertised in newspapers, periodicals, magazines and other media which is available in the country. This results in a product acquiring a worldwide reputation. Thus, if a mark in respect of a drug is associated with the respondents worldwide it would lead to an

anomalous situation if an identical mark in respect of a similar drug is allowed to be sold in India. However, one note of caution must be expressed. Multinational corporations, which have no intention of coming to India or introducing their product in India should not be allowed to throttle an Indian company by not permitting it to sell a product in India, if the Indian company has genuinely adopted the mark and developed the product and is first in the market. Thus the ultimate test should be, who is first in the market.

9. In the present case, the marks are the same. They are in respect of pharmaceutical products. The mere fact that the respondents have not been using the mark in India would be irrelevant if they were first in the world market. The Division Bench had relied upon material which prima facie shows that the respondents' product was advertised before the appellants entered the field. On the basis of that material the Division Bench has concluded that the respondents were first to adopt the mark. If that be so, then no fault can be found with the conclusion drawn by the Division Bench."

37. Mr. Shah learned senior counsel has further

relied upon the observations in case reported in (2004) 3 Supreme Court Cases 90 wherein it is observed that, " Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases." It is further held that, "grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest and deceptive and similar to the marks of the other party."

38. In view of the above, I am of the opinion, the plaintiff has made out the case to show that the defendants are using trade name/mark "MAYO" deceptively similar to the trade name/mark of the plaintiff. The reasons recorded by the learned Trial Court while issuing the injunction appears to be proper.

39. The above observations of this Court are made in order to decide the present appeal at prima-facie stage and the learned trial court shall not influence about such observations at the time of final disposal

of the suit.

40. For the reasons stated, I am of the opinion that, there is no substance in the appeal. Therefore, it is liable to be dismissed at the stage of admission itself and accordingly it is dismissed.

41. Pending A.O. is disposed of.

42. As A.O. is dismissed, hence, Civil Application No. 10457 of 2017 is disposed of.

(K.L. WADANE, J.)

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