

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
CIVIL APPELLATE JURISDICTION**

APPEAL FROM ORDER NO.1015 OF 2016

Bharat Paint Company

A partnership concern through its
partners-

a. Bajirao s/o Shivram Nagaonkar
Age-62 years, Occu-Business.

b. Mrs. Pramodini w/o Bajirao
Nagaonkar Age-55 years, Occ-
Business Both-R/o-11/2-B,
Paschim Mangalwar Peth,
Solapur-413002.

Having its place of business at 10,
Budhwar Peth, Balives, Solapur-
413002 and

Also at 590, West Mangalwar Peth,
Balives, Solapur-413002.

...Appellants

Versus

Mahendra N. Chavan

Proprietor of Vishwa Bharat Paint
Enterprises

Age- Adult, Occu-Business

Having its place of business at 5

Nivara Nagar, in front of Nadgeri

Petrol Pump, Vijapur Road, Solapur-
413 004.

...Respondent

...

**WITH
APPEAL FROM ORDER NO.394 OF 2017**

Bharat Paint Company

A partnership concern through its
partners-

a. Bajirao s/o Shivram Nagaonkar
Age-62 years, Occu-Business.

b. Mrs. Pramodini w/o Bajirao
Nagaonkar Age-55 years, Occ-
Business Both-R/o-11/2-B,
Paschim Mangalwar Peth,
Solapur-413002.

Having its place of business at 10,
Budhwar Peth, Balives, Solapur-
413002 and

Also at 590, West Mangalwar Peth,
Balives, Solapur-413002.

...Appellants

Versus

Shashikumar Shankar Jadhav
Proprietor of Sunrise Bharat Paint
Enterprises

Age- Adult, Occu-Business

Having its place of business at Ashok
Nagar Block No.2, Vijapur Road,
Solapur-413004

...Respondent

Mr. R.S. Alange for the Appellants.

Mr. Surel S. Shah for the Respondents.

CORAM: SMT. ANUJA PRABHUDESSAI, J.

JUDGMENT RESERVED ON : 5/12/2017.

JUDGMENT PRONOUNCED ON :18/12/2017.

JUDGMENT.

The Appellant herein who was the Plaintiff in Regular Civil
Suits No. 1 of 2016 and 2 of 2016 has challenged the order dated 25th
August, 2016, whereby the learned District Judge, Solapur, dismissed
the application for injunction.

2. Brief facts necessary to decide these Appeals are as under:

The Appellant, who shall be hereinafter referred to as the Plaintiff, is a partnership firm engaged in wholesale and retail distribution and sale of paints since over 60 years under the trade Name “Bharat Paint Company”. The Plaintiff has made an application bearing No. 2863485 on 16th December, 2014 to the Registrar of Trade Marks seeking registration of the label mark “Bharat Paint Company a paint showroom”. The said application is pending registration. The Plaintiff claims that high quality product and services offered by it, combined with continuous use of the trade name, the said trade name has become synonymous with the Plaintiff and has acquired enormous recognition, good will and reputation.

3. The Respondents, were the Defendants in the respective suits and shall be hereinafter referred to as the 'Defendants'. The Defendants are also engaged in the business of distribution and sale of paints. The grievance of the Plaintiff is that sometime in November or December, 2015 they learnt that the Defendants have been conducting the business in the trade name “Vishwa Bharat Paint Enterprises” and “Sunrise Bharat Paint Enterprises”. The Plaintiff claims that the said

trade names are deceptively similar to its trade name and is likely to cause confusion in the minds of the consumer/customers and the public in general. The Plaintiff claims that despite the legal notice, the Defendants continue to pass off their business as that of the Plaintiffs by capitalizing on the goodwill earned by the Plaintiff, thus causing serious financial loss as well as damage to the reputation of the Plaintiff. The Plaintiff therefore, filed a suit for perpetual injunction and by way of temporary injunction sought to restrain the Defendants from “distributing, selling, offering for sale, etc. paints or such other similar products and or services by using a trademark/trade name that is identical with or deceptively similar to that of the Plaintiff's said trade name 'Bharat Paint Company' so as to pass off or enable others to pass off the business of the Defendants as and for that of the Plaintiff”.

4. The Defendants have denied having infringed any trademark. The Defendants have claimed that the Plaintiff does not manufacture any goods and both being dealers of Nerolack, Nobel, Asian Paints, Levis Burger etc., there is no possibility of passing off their product as that of the Plaintiff. The Defendants have further stated that there is no deceptive similarity between the trade marks and as such there is no question of causing any confusion in the minds of the

purchasers.

5. The learned Judge after considering the pleadings and the documents of the respective parties held that there is no similarity in the trade names. The learned Trial Judge further held that the Plaintiff and the Defendants are not the manufacturers of any products but are only the dealers of paint manufactured by different companies. Hence, there is no possibility of the Defendants deceiving the customers or passing off their goods as those of the Plaintiff. The learned Judge further held that the Defendants have been carrying on the business since 2013 and that there is inordinate delay in seeking the interim relief. In the light of the said findings, the learned District Judge dismissed the applications for injunction. Being aggrieved by the said orders the Plaintiff has filed these Appeals.

6. Mr. R.S. Alange, the learned counsel for the Plaintiff submits that the Plaintiff's firm is in a business of paint since last 60 years and has been using the trade name "Bharat Paint Company" since last 60 years. He contends that the Plaintiff has accrued substantial goodwill and reputation in its unique and distinctive trade name. He has submitted that the trade name "Vishwa Bharat Paint Enterprises"

and “Sunrise Bharat Paint Enterprises”, are deceptively similar to that of the Plaintiff's trade name and creates a confusion in the minds of consumers that the Defendants' shop is a branch of the Plaintiff's business and or some how associated with the Plaintiff's business. He contends that the Defendants are misleading and deceiving the customers by using a deceptively similar trade names and are capitalising on the goodwill and reputation of the Plaintiff and are thus causing financial damage as well as damage to the reputation of the Plaintiff. He further submits that the delay per se is not a ground to reject the applications. He has relied upon the decision of the Apex Court in *Mahendra & Mahendra Paper Mills Ltd. Vs. Mahindra and Mahindra Ltd. (2002) 2 SCC 147* and decisions of the Bombay High Court in *Rahul Uttam Suryavanshi vs. Sunil Manikchand Kasliwal 2017 (1) Mh. L.J. and Lokhandwala Construction Industries Pvt. Ltd. & Anr. Vs. Lokhandwala Infrastructure Pvt. Ltd. & Ors. 2016(1) Mh. L.J.*

7. Mr. Surel S. Shah, the learned counsel for the Defendants has submitted that there is no similarity in the trade names. He has further submitted that the Plaintiff, as well as the Defendants, are only the dealers and not manufacturers of the Paints and as such there is no

possibility of the Defendants passing off the product manufactured by the Plaintiff as their own. He has further submitted that there is no prima facie material on record to indicate that the Defendants have misled or misrepresented the consumers or that the Plaintiff has sustained any loss on account of the business of the Defendants. He has further submitted that the Plaintiff has approached the Court after considerable delay. He submits that the impugned order does not suffer from any illegality or any perversity and as such same does not warrant any interference.

8. I have perused the records and considered the submissions advanced by the learned counsels for the respective parties.

9. In the instant case, the issue is not of infringement of trade mark, but is of passing off action. In an action of passing off, the Plaintiff has to prima facie prove that the Defendants are passing off their own goods as those of the Plaintiff. The three elements of passing off action are representation of goods, possibility of deception and likelihood of damages. In *Mahendra and Mahendra Paper Mills* (Supra) the Apex Court has considered the previous decision in *Cadila Healthcare Ltd. Vs. Cadila Pharmaceuticals Ltd., 2001 (5) SCC 73*,

wherein a Bench of three learned Judges of the Apex Court has summed up the position of law regarding tests to determine a passing off action, as under:-

“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 label marks or composite marks, i.e. both words and label works.

b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

c) The nature of the goods in respect of which they are used as trade marks.

d) The similarity in the nature, character and performance of the goods of the rival traders.

e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

f) The mode of purchasing the goods or placing orders for the goods and

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

Weightage to be given to each of the aforesaid factors depends upon facts of each case and the same weightage cannot be given to each factor in every case.”

10. Reverting to the facts of the present case, it is not in dispute that neither the Plaintiff nor the Defendants are the manufacturer of

the products, which are sold by them under their respective trade names. The Plaintiff, as well as the Defendants are in the business of wholesale and retail distribution and sale of paints manufactured by different companies. This being the case, there is no question of the Defendants passing off their goods as those of the Plaintiff and/or deceiving or creating any confusion in the minds of the purchasers that the goods sold by the Defendants are the one manufactured by the Plaintiff.

11. It is to be noted that the Plaintiff is carrying on the said business under the trade name “Bharat Paint Company”, whereas the Defendants are running the business under the name “Vishwa Bharat Paint Enterprises” and “Sunrise Bharat Paint Enterprises”. A bare perusal of these trade names prima facie indicates that there is no structural, phonetical or visual similarity in the trade names. The records also reveal that the Defendants had started their business in the year 2013, whereas the interim relief was sought in the year 2016. There is no prima facie material on record to indicate that in these three years the business of the Plaintiff was adversely affected. On the contrary, the figures given in paragraph 8 of the plaint indicate that there has been considerable increase in the turnover in the Plaintiff's

business since 2013. The Plaintiff has thus failed to make out a prima facie case.

12. It is also pertinent to note that there is no prima facie material to suggest that the Defendants' use of the name is not bonafide, honest or genuine. The Defendants have been carrying on the business under the said trade name for a period of over three years from the date of institution of the suit, and as such the possibility of creating their own goodwill and reputation over these years cannot be ruled out. Hence, granting of injunction would not only disturb the status quo existing as on the date of the suit, but will cause greater hardship to the Defendants.

13. In the light of the above, the trial Judge was justified in holding that the Plaintiff had failed to establish the pre-requisites of Temporary Injunction. In *Wander Ltd. And Anr. vs Antox India P. Ltd. 1990 Supp (1) SCC 727* and *N.R. Dangre Vs. Whirlpool Corporation and Anr. 1996(5) SCC 714*, the Apex Court has reiterated that the Appellate Court cannot ordinarily interfere with the exercise of discretion by the Trial Court in the matter relating to grant or refusal of temporary injunction and substitute its own discretion, except where

the Trial Court has exercised the discretion arbitrarily, capriciously or perversely, or that the order of the Trial Court is in contravention of the settled principles of law regulating, grant or refusal of interlocutory injunction. In the instant case, the discretion exercised by the Trial Court is neither arbitrary nor against the settled principles of law. Hence, this is not a fit case to interfere the discretion exercised by the learned Trial Judge.

14. Under the circumstances, both the Appeals are dismissed with no orders as to costs.

(SMT. ANUJA PRABHUDESSAI, J.)