

Shephali

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
NOTICE OF MOTION (L) NO. 212 OF 2017
IN
COMMERCIAL SUIT (L) NO. 221 OF 2017**

Kalpataru Properties Pvt Ltd ...Plaintiffs
Versus
Kalpadatru Foundation ...Defendants

**WITH
LEAVE PETITION NO. 159 OF 2017
IN
COMMERCIAL SUIT (L) NO. 221 OF 2017**

**Dr Veerendra Tulzapurkar, Senior Advocate, a/w Ms Smriti
Yadav, for the Plaintiffs.**
Mr Nitesh Bhutekar , for the Defendants.

CORAM: G.S. PATEL, J
DATED: 4th May 2017

PC:-

1. The Defendants are served and represented.
2. The Petition under Clause 14 is made absolute.

3. The Plaintiff is a well-known company of developers. The Plaintiff's Chairman Mr Mofatraj Munot conceived and adopted the trademark KALPATARU in relation to the activities of his then proprietorship concern almost 60 years ago in the 1906s. The company was incorporated in 1975. It went through certain post-incorporation name changes that are not immediately material.

4. The Plaintiff is the registered proprietor in various classes of the mark **KALPATARU**. This is uniquely depicted and is used with a device of a stylised logo of a tree.

5. In April 2006, one of the Plaintiff's sister concerns, Kalpataru Power Transmission Limited formed a trust called "Kalpataru Welfare Trust". This is engaged in various activities such as public health, education and so on. By this time, the mark KALPATARU had become a house mark and the entire group was and is known as Kalpataru Group of Companies.

6. The Plaintiff has in that time secured registrations of its mark in various classes. The mark has been used continuously and without interruption. One of the classes in which it has registration is class 41 relating to education, training etc. The relevant registration certificate in this regard is at page 118 of the Plaintiff.

7. In April 2015 the Plaintiff learnt of the Defendant using a mark with the same name KALPATARU as its name. The Defendant is a society. The Defendant also provides educational assistance and engages in other welfare activities. It apparently has a

website www.kalpatarufoundation.org. It uses the very mark KALPATARU with the word *foundation* and, to the left of the mark, is stylised image of a tree. It is true that the two tree images are not identical; but that is not the issue. The point is that both use an image of a tree and they do so with conjunction with the mark KALPATARU. The Kalpataru Welfare Trust and the Kalpataru Foundation thus both provide public charitable or welfare services of various kinds.

8. The Plaintiff first gave notice to the Defendant on 17th April 2015. There was no reply. The Defendant continued to use the mark. A second notice followed on 18th July 2016. There is no reply to this notice either.

9. There is no manner of doubt about the similarity, phonetic, structural and visual, between the two marks and, given the manner of their depiction, the ad-interim injunction that Dr Tulzapurkar seeks must follow. A *prima facie* case has been made out and the balance of convenience is clearly with the Plaintiffs. Even if one is to consider only the case in infringement, that would only mean that the question of honesty in adoption is wholly irrelevant. There is no possibility of being able to easily or readily distinguish one mark from the other and I imagine that persons visiting the Defendant's website are apt to mistake it for that of the Plaintiffs and to draw a conclusion that the Defendant is somehow related to the Plaintiff and its group.

10. There will be, therefore, an ad-interim order in terms of prayer clauses (a) and (b), which read thus:

"(a) That pending the hearing and final disposal of the Suit, the Defendant, directly and/or indirectly, by itself, its partners, members, concerns, associates, employees, servants, agents, dealers, licensees and all persons claiming under it be restrained by a temporary order and injunction of this Hon'ble Court from infringing the Plaintiff's said registered Trade Mark "KALPATARU" bearing Nos. 1213736, 1213737, 1213738, 1213739, 1262206, 1262207, 2225552, 2225553, 1973699, 2225555, 2225560, 2225562 and 2225561 in any manner and/or from using the Impugned Mark or any word identical with or similar to the said registered Trade Mark "KALPATARU" by itself or in combination with any other word/s or mark/s in connection with said goods and services for which the Plaintiff's said Trade Mark is registered or in relation to Impugned Services or any goods or services similar thereto and upon or in relation to the Defendant's society name/ business name/ trade name/ trading style, signage's, banners, hoardings, invoices, carry bags goods, labels, cartons, packing material, stationery, literature and/or on any other material or as a part of its Impugned Domain Name or any other domain name, in any manner from marketing or offering for sale, advertising or dealing in any products/ rendering any services under or bearing the said registered Trade Mark of the Plaintiff or any other mark which is identical or similar to the Plaintiff's said registered Trade Mark, so as to infringe the Plaintiff's said registered Trade Mark;

(b) that ending the hearing and final disposal of the Suit, the Defendant, directly and/or indirectly, by itself, its partners, members, concerns, associates, employees,

servants, agents, dealers, licensees and all persons claiming under it be restrained by a perpetual order and injunction of this Hon'ble Court from passing off the Impugned Services of the Defendant as those of the Plaintiff by using the Impugned Mark "KALPATARU" by itself or in combination with any other word/s or mark/s in connection with said goods and services or in relation to any goods or services similar thereto and upon or in relation to the Defendant's society name/ trade name/ trading style, signage's, banners, hoardings, invoices, carry bags goods, labels, cartons, packing material, stationery, literature and/or on any other material or as a part of its Impugned Domain Name or any other domain name, in any manner from marketing or offering for sale, advertising or dealing in any products/ rendering any services under or bearing the said registered Trade Mark of the Plaintiff or any other mark which is identical or similar to the Plaintiff's said registered Trade Mark, so as to pass-off or enable others to pass-off the Defendant's services as being those of the Plaintiff."

11. Affidavit in Reply to be filed and served on or before 16th June 2017. Affidavit in Rejoinder to be filed and served on or before 30th June 2017.

12. List the Notice of Motion for hearing and final disposal on 10th July 2017.

(G. S. PATEL, J.)