

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
CIVIL APPELLATE JURISDICTION

APPEAL FROM ORDER (STAMP) NO.25524 OF 2018
ALONG WITH
CIVIL APPLICATION (STAMP) NO.25528 OF 2018

Dorabjee & Company Private Limited,	]	
A Company incorporated under the	]	
Companies Act, 1956 and having its	]	
Registered Office at 1-B, Moledina Road,	]	
Camp, P.O. Box 67, Pune - 411 001, India,	]	
Through its Director :-	]	 Appellant/Applicant
Mr. Farsheed Bujor Patell	]	[Original Plaintiff]

Versus

- | | |
|--|---|
| 1. Jehangir Nariman Dorabjee, |] |
| having his address at Office No.6, |] |
| 6 th Floor, Siddhi Towers, |] |
| Above Co-operative Bank, |] |
| Kondhwa Road, Pune - 411 048 and |] |
| a residential address at 502, |] |
| Serene Manor, Baker's Hill, |] |
| Kondhwa, Pune - 411 040. |] |
| 2. Firoza Jehangir Dorabjee, |] |
| having her address at Office No.6, |] |
| 6 th Floor, Siddhi Towers, |] |
| Above Co-operative Bank, Kondhwa Road, |] |
| Pune - 411 048 and a residential address |] |
| at 502, Serene Manor, Baker's Hill, |] |
| Kondhwa, Pune - 411 040. |] |
| 3. Daniel Jehangir Dorabjee, |] |
| having its address at Office No.6, |] |

6th Floor, Siddhi Towers,]
 Above Co-operative Bank, Kondhwa Road,]
 Pune - 411 048 and a residential address]
 at 502, Serene Manor, Baker's Hill,]
 Kondhwa, Pune - 411 040.]
 4. Jasminder Oberoi,]
 having his address at Dorabjee's Mall,]
 Next to Vibgyor School, NIBM Extension,] Respondents /
 Pune - 411 060.] [Original Defendants]

Mr. Virag Tulzapurkar, Senior Counsel, a/w. Mr. Hiren Kamod, Mr. Mustafa Safiyuddin and Mr. Hasan Safiyuddin, I/by M/s. ABH Law LLP, for the Appellant.

Dr. Birendra Saraf, Senior Counsel, a/w. Mr. Zaher Khambatte, Ms. Sanaya Khan and Mr. T.D. Deshmukh, I/by Mr. Sagar Kursija, for Respondent Nos.1 and 2.

CORAM : DR. SHALINI PHANSALKAR-JOSHI, J.

RESERVED ON : 29TH OCTOBER, 2018.

PRONOUNCED ON : 4TH DECEMBER, 2018.

JUDGMENT :

1. Heard Mr. Tulzapurkar, learned Senior Counsel for the Appellant, and Dr. Saraf, learned Senior Counsel for Respondent Nos.1 and 2.

2. This Appeal is preferred by the Original Plaintiff taking an exception to the order dated 18th August 2018, passed by District Judge-5, Pune, thereby dismissing the application filed at 'Exhibit-5' in Special

Civil Suit No.29 of 2017, for interim injunction in a Suit for infringement of trade mark and passing-off action.

3. Brief facts of the Appeal are to the effect that, the Appellant is a Corporate in the name of “Dorabjee & Company Private Limited” and running its business of 'Retailer' in household articles and food products. Appellant's business has a history of more than 105 years. In or about 1911, one 'Dorabjee Pallonji Patell' had acquired this retail business carried on at 1-B, Moledina Road, Pune Camp, Pune from an English Company and named it as 'Dorabjee & Co.'. Thereafter, 'Dorabjee & Co.' was converted into a 'Partnership Firm' and then in the year 1996, into a 'Private Limited Company', under the provisions of the Companies Act, 1956. The business is carried on as a family business, which has been passed on from generation to generation and conducted from the Department / Provisions Store located on the ground and mezzanine floor, occupying about 22,000 sq.ft. Though the trade name of the Appellant's business is 'Dorabjee & Co.', the store came to be generally known by the public and the customers as '*Dorabjee's*'. The Appellant had obtained several registered trade marks for this business, of which '*Dorabjee's*' is a prominent feature.

4. It is further case of the Appellant that, in the year 1999, the

original building comprising of the Departmental Store / Super Market was demolished and re-constructed. Upon such re-construction, the trading style and the trade name and the signage of the Departmental Store / Super Market was also slightly altered from 'Dorabjee & Co.' to '*Dorabjee's*', by which name, it was always popularly known. In addition to the original '*Dorabjee's*' Departmental Store/Super Market at Moledina Road, Camp, the Appellant had established two more '*Dorabjee's*' Departmental Stores / Super Markets' at Viman Nagar / Lohegaon area and NIBM area, in the year 2011 and in February 2016, respectively.

5. The business of the Appellant comprises of hundreds of items and is known for providing high quality goods and services. Appellant is the Stockist / Distributor / Dealer of various reputed multinational and Indian Companies and their well known products; such as, Nestle, Hindustan Unilever, Tata Tea & Coffee, Britannia, Parle, Kelloggs, Amul, Coca Cola, Pepsico, Bisleri, Dabur, Marico, Cadbury, Loreal, Proctor & Gamble, Colgate, Himalaya etc. and this list has kept on evolving and increasing every year. In the course of its retail business carried on under the trade mark '*Dorabjee's*', Appellant not only sells the brands of third parties, but also sells some of its own products bearing the brand '*Dorabjee's*'. Appellant has also received several awards in recognition of

the extensive and high quality service provided under the trade name '*Dorabjee's*' retailing business. It has also received several letters in appreciation of its business from the customers / Companies, for which the Appellant is a Stockist / Distributor / Dealer. Thousands of customers visit the Appellant's '*Dorabjee's* Stores' every day and its business turnover has exceeded 100 Crores for the last two years.

6. Appellant's business in the name of '*Dorabjee's*' has been extensively advertised and has received coverage in the 'Press' over the years in several newspaper articles and magazines, some of which are already produced on record. Appellant has incurred extensive expenditure in promoting the '*Dorabjee's*' business through its various promotional schemes. The Appellant has, accordingly, made an application in 'Class 35' for registering the mark '*Dorabjee's*' as per the details given below :-

Mark	Application Number	Class	Specification of Services
<i>Dorabjee's</i>	3245183	35	Business management, brand management, business administration, relating services, wholesale & retail outlets, supermarkets and stores, showroom including services relating to mineral & aerated water, other non-alcoholic drinks,

			beers and alcoholic beverages, fresh fruits and vegetables, live plants & flowers, preparation made from cereals, bread, biscuits, cakes, patties, burgers, cookies, chocolates, meat, fish, poultry and game; meat extracts, preserved, dried and cooked fruits and vegetables, jams and jellies, milk and dairy products, pickles, coffee, tea, cocoa, sugar, rice, cereals spices and condiments, air coolers, air conditioners & cooling installation, furniture made of wood, steel, plastic including office furniture.
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7. Thus, according to the Appellant, the trade name of its business '*Dorabjee's*' has acquired the status of an iconic brand and has generated immeasurable goodwill and reputation. The word '*Dorabjee's*' has also acquired distinctiveness and a secondary meaning, exclusively associated with the Appellant's business and hence, the Appellant alone is entitled to use the said name. Otherwise, the use of the mark '*Dorabjee's*' in the same, similar, connected or related areas to the field of operation of the Appellant is bound to cause or likely to cause confusion amongst the consumers, traders and the public at large, which would cause or would likely to cause deception.

8. In this backdrop, the Respondents have, according to the Appellant, unauthorizedly commenced the operation of a 'Mall', originally in the trading style of 'Royal Heritage Mall', which has changed to the trading style of 'DORABJEE'S Royal Heritage Mall' and thereafter to 'DORABJEE'S MALL'. This conduct of the Respondents, according to the Appellant, amounts to passing-off action and infringement of trademark. The Respondents were well aware of the reputation of '*Dorabjee's*' and, in fact, had agreed with the Appellant to set up a '*Dorabjee's* Departmental Store' in their 'Mall'. A 'Letter of Intent' was executed accordingly between the Appellant and the Respondents in or around May, 2011. The said 'Letter of Intent' also acknowledges that, Appellant is engaged in the business of 'Super Markets' known as '*Dorabjee's*'. However, that 'Letter of Intent' was not implemented for various reasons, but the said fact, according to the Appellant, is sufficient to infer that the trading style of the Respondents was to be 'Royal Heritage Mall' and Respondents were well aware about the reputation of the Appellant's business in the name of '*Dorabjee's*' reputation. Hence, Respondents' subsequent use of the term 'DORABJEE'S', as part of their trading style, according to the Appellant, is dishonest and is an attempt to ride upon the reputation and goodwill of the trade name '*Dorabjee's*', by showing a connection or association with the Appellant's business.

9. The soft launch with the changed trading style to 'DORABJEE'S Royal Heritage Mall' was made by the Respondents sometime in the year 2016 and thereafter, recently, in the year 2017, the trading style 'DORABJEE'S MALL' has been used. The photographs, hoardings and signages used by the Respondents for its advertisement make it evident that, the dominant feature of the trading style of the Respondents has been changed to 'DORABJEE'S Royal Heritage Mall and then to DORABJEE'S MALL', giving greater prominence to the word 'DORABJEE'S'. Appellant also came to know that, Respondents have filed an application for registering the mark 'DORABJEE'S' in 'Class-35', when the said application was published in the 'Trade Marks Journal', dated 1st August 2016. Appellant opposed the said application of the Respondents and as a result, the said application is yet pending for decision.

10. The grievance of the Appellant is that, the Respondents are, thus, using the trade mark 'DORABJEE'S' as a prominent part of their trading style, which amounts to misrepresentation, causing or likely to cause confusion to the general public and damage the goodwill of the Appellant. Appellant has received several e-mails / letters from various customers and friends, who have been actually confused, considering that of Respondents' 'DORABJEE'S MALL' is that of the Appellant or connected

with the business of the Appellant. Thus, according to the Appellant, the Respondents are, by using the trade name 'DORABJEE'S' as trading style of their 'Mall', passing-off or attempting to pass-off their business as the business of the Appellant or having an association or connection with the Appellant and/or the business of the Appellant carried on under the mark '*Dorabjee's*'. The Respondents are thereby infringing the Appellant's registered mark '*Dorabjee's*', by using it in relation to the services, which are similar to the services, which Appellant is rendering. This conduct of the Respondents of using an identical or similar mark is detrimental to the distinctive character or repute of the Appellant. Therefore, the Appellant is constrained to file this Suit for injunction for infringement of its trade mark; for passing-off action and for restraining the Respondents from using or displaying the mark / trading style / trade name 'DORABJEE'S Royal Heritage Mall' / 'DORABJEE'S MALL' or any other mark / trading style / trade name bearing the mark '*Dorabjee's*' or any other mark similar to the mark '*Dorabjee's*' in any manner, including in relation to their business / Mall/ Shopping Complex or advertising or as a part of the Respondents' domain name, and from operating, leasing, letting, licensing or offering to lease, let, license any premises in the Respondents' Mall in the name of '*Dorabjee's*'. Appellant has also claimed the compensation of Rs.50 Crores as and by way of damages caused to

the Appellant by the Respondents' wrongful act of passing-off and infringing the Appellant's trade mark.

11. Pending the hearing and final disposal of the Suit, Appellant has claimed the relief of interim injunction by filing the application at 'Exhibit-5', for restraining the Respondents from using the trade name '*Dorabjee's*' in any way in the services similar to the one, which the Appellant is rendering.

12. This application came to be resisted by the Respondents vide affidavit-in-reply of Respondent No.1, filed before the Trial Court at 'Exhibit-35', denying all the adverse allegations made therein and contending, *inter alia*, that, Appellant does not have the registered trade mark in the name of '*Dorabjee's*', on the basis of which the Suit is filed. It is submitted that, the only registered trade mark, which the Appellant has, is in the name of 'Dorabjee & Co.'. In fact, the Appellant's application for registration of its business in the trade name of '*Dorabjee's*' in 'Class-35' is yet not granted and it is liable to be rejected, as the similar trade name of the Respondents' is existing. Appellant is fully well aware of the fact that, it has not been allowed to use the name '*Dorabjee's*', but instead of taking up the matter with the Registrar of Trade Marks, Mumbai, Appellant has approached the Court.

13. According to the Respondents, they are having the registered trade mark in the name of 'DORABJEE'S Royal Heritage Mall', bearing No.3008447 dated 13th July 2015. The name 'DORABJEE'S' is, thus, a part of registered trade mark of the Respondents and Appellant has no such name in its trade mark with the “ 's ”, after the word 'DORABJEE'. Hence, if there is an infringement of the trade mark, it is done by the Appellant and not by the Respondents. According to the Respondents, the original name of the 'Mall' was 'Royal Heritage Mall'. The same was changed in July, 2015 to 'DORABJEE'S Royal Heritage Mall' and is attentively called as 'DORABJEE'S MALL'.

14. Moreover, the writing style of both the trade marks is different. The name of the Appellant's business '*Dorabjee's*' is not written in capital letters, like that of the Respondents, but it is written in running script with the words '*Dorabjee & Co.*'. Hence, there is no question of any confusion.

15. Further, it is submitted by the Respondents that, the name 'Dorabjee' is the surname belonging to Respondent Nos.1 to 3. The ancestor of Respondent No.1 has started a 'Restaurant' at Dastur Meher Road, Pune in 1878 under its family name, calling it 'Dorabjee & Sons'. The said name still remains. The Restaurant is also still running in that

name. It has been acclaimed as amongst the best Parsee Cuisines in Pune and has been applauded on several occasions with articles in the newspapers and in the Media. The name 'Dorabjee', therefore, has been used in the family of the Respondents for much longer period, than it has been used by the Appellant. Hence, to prohibit the individual from using his true family surname is to *“take away his identity”; without which, he cannot make known who he is to those, who may wish to deal with him.*

16. It is submitted that, Respondent Nos.1 to 3 are in the Real Estate business for long. They run the business, *inter alia*, under the names of 'Dorabjee Estate Private Limited', 'Dorabjee Construction Private Limited' and 'Dorabjee Indiareit Properties Private Limited'. They have constructed several complexes, all of which have been christened with the name “DORABJEE”. As far as Mohammadwadi NIBM Annex is concerned, where the 'Mall' in question is situated and where the new Store of the Appellant has been recently opened, the complexes of 'Dorabjee' have a reasonable presence since the year 2003. Respondents have constructed several residential and commercial buildings in that area. Respondent's use of the name 'DORABJEE' is, thus, prior, longer and extensive, than that of the Appellant. Hence, the Respondents are fully entitled to use the name 'DORABJEE'S' for their 'Mall'. Accordingly, Respondents have prominently displayed the same, well before the Appellant started its Super Market in the vicinity.

17. According to the Respondents, there is also no question of any confusion being caused to the general public at large, resulting into the losses in the business of the Appellant. It is submitted that, the Appellant's business is thriving and has improved over the years, as per its own case. It is denied that, Appellant has acquired immeasurable goodwill or reputation, as alleged, or its continuous usage and extent of its business has created an illusion of secondary meaning, exclusively associated with the Appellant.

18. Thus, according to the Respondents, in the first place,

- (a) The word '*Dorabjee's*' is not the registered trade mark of the Appellant; its application for registration in the name of '*Dorabjee's*' having been yet not approved by the Registrar of Trade Marks, Mumbai.
- (b) Secondly, Respondents' user of the trade mark 'DORABJEE'S' is much prior and much extensive.
- (c) Thirdly, the writing style of both the Appellant's business in the name of '*Dorabjee's*' and Respondents' business in the name of 'DORABJEE'S' is different. Appellant's trade name is in running script; whereas Respondents' trade name is in capital letters.

- (d) Fourthly, there is no question of any confusion being caused to the public at large, as the Respondents are running the business of construction and in its 'Mall', there is already a branded outlet of 'D' Mart. So, no question arises of general public being confused in assuming that the business of the Respondents is associated with the business of the Appellant.
- (e) Lastly, that the Appellant has sought this short-cut way to stop the Respondents from running their own business in their own style.

19. The Trial Court has, after hearing the submissions advanced at bar by learned Senior Counsel for both the parties, refused to grant the relief of interim injunction in favour of the Appellant and it was done on the following grounds;

- (i) In view of Section 23 of the Trade Marks Act, 1999, the adequate and efficacious remedy is available to the Appellant, which should have been availed by the Appellant, instead of rushing to the Court;
- (ii) As the Appellant was seeking an equitable relief, that too, against the registered owner of the trade mark, at the interim stage, such a relief cannot be granted;
- (iii) The trading activities of the Appellant and the Respondents are not similar and hence, there is no question of any confusion being caused in the mind of general public at large;

- (iv) The turnover of the Appellant's business has been increasing materially, notwithstanding, the existence of the Respondents' 'Mall'. Therefore, there is no substance in the Appellant's contention that, it is suffering losses in the business;
- (v) There is dissimilarity in the essential features of the trade marks adopted by the Appellant and the Respondents; and
- (vi) There was nothing on record to show that the Appellant's prior or continuous user of the trade mark 'Dorabjee', as used by the Respondents.

20. As a result, the Trial Court was pleased to hold that, the Appellant has failed to make out prima facie case or to prove that the balance of convenience lies in its favour and the Appellant will suffer irreparable loss, if relief of interim injunction is not granted.

21. While challenging this order of the Trial Court, the submission of learned Senior Counsel for the Appellant is that, the Trial Court has erred in interpreting the provisions of Section 41(h) of the Specific Relief Act and Section 23 of the Trade Marks Act. It is submitted that, merely opposing / objecting the application for registration filed by the Respondents in 'Class-35', cannot be sufficient to redress the grievance of the Appellant and hence, cannot prevent the Appellant from seeking

common law remedy of passing-off action. It is submitted that, the 'Authority' under the Trade Marks Act could not have granted the relief of interim injunction, which the Appellant is claiming in this case.

22. Further, according to learned Senior Counsel for the Appellant, the Trial Court has also failed to appreciate that the Respondents have also filed an application for registration of trade name 'DORABJEE' in 'Class-35' for doing the business in retail sector; the same business, which the Appellant is running and, therefore, it was a fit case where the relief of interim injunction should have been granted, as the Appellant's use of the trade name '*Dorabjee*' for retail business is much prior, since last more than 100 years.

23. Thirdly, it is submitted that, the real test for grant of the relief of interim injunction is not the actual confusion, being caused in the mind of general public due to the similarity in the trade marks, but the likelihood of such confusion being caused and which, in the present case, was bound to be caused, as now the Respondents have started using the name 'Dorabjee's' to their 'Mall', instead of the earlier name 'Royal Heritage Mall'. According to learned Senior Counsel for the Appellant, this act of the Respondents, changing the name of the 'Mall', is, in itself, sufficient to discern the dishonest intention on the part of the

Respondents, which is to exploit the goodwill and reputation earned by the Appellant in its business.

24. Lastly it is submitted that, it is totally irrelevant at this interim stage to consider whether the business of the Appellant is running in losses or earning profit. It will be a relevant consideration only at the final stage of deciding the question '*whether Appellant is entitled to damages?*'.

25. According to learned Senior Counsel for the Appellant, therefore, the entire approach adopted by the Trial Court in rejecting the Appellant's application, being not legal and correct, the impugned order passed by the Trial Court is required to be quashed and set aside.

26. Per contra, learned Senior Counsel for the Respondents has supported the impugned order of the Trial Court by pointing out that, when Appellant has not been successful in resisting the registration of the Respondents' business in the name of 'DORABJEE'S MALL', the Appellant cannot be entitled to get the equitable relief of interim injunction. Moreover, there is no question of the Respondents indulging in the same business of the Appellant. Respondents are not carrying on any retail business in food products. It's business is of construction activity and as 'Dorabjee' is a family name of the Respondents, they have

called their 'Mall' as 'DORABJEE'S MALL'. If in that 'Mall', there is one Departmental Store of 'D' Mart, which is already a well known name in the retail business, there is no question of any one getting confused that the said business is that of the business of the Appellant. Thus, it is submitted that, the very premise on which the relief of interim injunction is sought by the Appellant, is incorrect and wrong and hence, the Trial Court has rightly rejected the Appellant's application for interim injunction.

27. Moreover, it is submitted that the Suit filed by the Appellant also suffers from delay and laches. Since last more than three years, the Respondents are using the name 'DORABJEE'S Mall'. Hence, the Trial Court has rightly held that, at this interim stage, no prima facie case is made out for granting the relief of interim injunction, to restrain the Respondents from using the name 'Dorabjee'. Hence, it is the Respondents, who will suffer irreparable loss, hardship and inconvenience, if such a relief of interim injunction is granted. In the opinion of the learned Senior Counsel for the Respondents, therefore, this Court should be slow to interfere in the discretion exercised by the Trial Court in passing the impugned order.

28. In this case, the undisputed factual position, which emerges from the rival submissions advanced by learned Senior Counsel for both the

parties is that, the Appellant is running the 'Departmental Store' / 'Super Market' in the retail business of food products and household articles of the reputed companies in the trade name, of which '*Dorabjee's*' is a prominent feature, since last more than 100 years. Appellant's long and prior use of the name, containing the word '*Dorabjee*' as its prominent feature, is sufficiently established through the voluminous material produced on record. The fact that the Appellant has achieved reputation and goodwill in its business under the name '*Dorabjee*' is also prima facie proved on record. There is sufficient material on record to that effect also. The very fact that the Respondents have entered into a 'Letter of Intent' with the Appellant for opening its outlet in the 'Mall' of the Respondents, is testimony to the said fact. Hence, so far as retail business of household articles and food products carried on by the Appellant is concerned, it has to be held that, the name '*Dorabjee*' has achieved a distinctiveness and a secondary meaning, exclusively associated with the Appellant's business.

29. Whereas in 'Restaurant' and 'Construction Activities', Respondents' trade name 'DORABJEE' has achieved sufficient goodwill and reputation on account of its prior use. Since last several years, they are running the construction business under the names of 'Dorabjee Estate Private Limited', 'Dorabjee Construction Private Limited' and 'Dorabjee Indiareit

Properties Private Limited'. Not only this particular 'Mall', but they have constructed several other complexes, all of which have been christened with the name 'DORABJEE'. They have also obtained the 'Certificate for Registration' of trade name 'DORABJEE', dated 20th October 2016, in 'Class-37', in respect of construction project, management services, construction supervision, services etc.

30. Appellant has also, as such, no grievance against the Respondents for using the trade name 'Dorabjee', so far as construction activities are concerned, or, for that matter, even for the business of 'Restaurant' run in the name of 'DORABJEE'. This position is made fairly clear by learned Senior Counsel for the Appellant in his oral submission before this Court and also in written notes of arguments.

31. The only grievance of the Appellant is to the application made by the Respondents for registration of its business / 'Mall' under 'Class-35', which includes registration for retail business. According to learned Senior Counsel for the Appellant, as now Respondents are entering into the retail business, that too, in the name of 'DORABJEE'S MALL', from changing its earlier name 'Royal Heritage Mall', then 'Dorabjee's Royal Heritage Mall' and now only 'DORABJEE'S MALL', of which, 'Dorabjee' is associated with the Appellant's business, there is likelihood of confusion of passing-off action for injunction.

32. Keeping in mind this factual backdrop, it is necessary first to deal with the legal issues raised by the Trial Court's order.

33. According to the Trial Court, the Respondents have obtained the registered trade mark in the name of 'DORABJEE'S'; despite the opposition and the challenge raised by the Appellant on the count that, the trade mark, which Respondents are seeking, is identical or similar to the Appellant's trade mark. Hence, the Trial Court has held that, in view of the provisions of Section 28 of the Trade Marks Act, 1999, when certain rights are conferred by registration on the registered proprietor of the trade mark, then the remedy available to the affected person is to approach the 'Authority' under the Trade Marks Act and the remedy to approach the Civil Court is not available.

34. However, this finding of the Trial Court is neither factually correct nor legally tenable. What the Trial Court has done while giving such finding is to consider the 'Registration Certificate' of the Respondents dated 20th October 2016, which is in 'Class-37' i.e. construction business. Appellant is not having any grievance about it. Hence, this 'Registration Certificate' is irrelevant for the purpose of the present case. Moreover, Section 28 of the Act, which is reproduced hereinafter, does not take away the right of the prior user of the trade mark to sue for passing-off action.

35. The Trial Court has also committed an error in holding that,

“It would not be apposite to pass an order contrary to the terms of Section 28 of the Trade Marks Act, which confers certain rights by registration.”

36. Section 28 of the Trade Marks Act, 1999, reads as follows :-

“28. Rights conferred by registration :-

- (1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services, in respect of which the trade mark is registered, and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.*
- (2) The exclusive right to the use of a trade mark, given under sub-section (1), shall be subject to any conditions and limitations, to which the registration is subject.*
- (3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not, (except so far as their respective rights are subject to any conditions or limitations entered on the register), be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks, but each of those persons has otherwise the same rights as against*

other persons, (not being registered users, using by way of permitted use), as he would have, if he were the sole registered proprietor.”

37. Thus, sub-section (3) of Section 28 makes it clear that, where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to use of any of those trade marks shall not be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks, but each of those persons has otherwise the same rights as against other persons, as he would have, if he were the sole registered proprietor. Therefore, this Section makes it clear that, even two or more persons can use the same trade mark, if they were already using the same trade mark. Mere registration by one person of his trade mark will not affect the right of the other person to the use of that trade mark, if he was using it since before. Thus, Section 28 of the Act nowhere creates any bar to exercise the right, which is available to the prior user of the trade mark under the common law.

38. Hence, further finding of the Trial Court that when there is an efficacious remedy available under Section 23 of the Trade Marks Act to the Appellant to challenge the registration of the trade mark, sought by the Respondents for the similar business of retail activity, under the name of 'DORABJEE'S MALL', the Civil Court should not and cannot

interfere, in view of Section 41(h) of the Specific Relief Act, 1963, is also not legally sustainable, as the Trial Court has itself held that, under Section 27(2) of the Act, the 'common law remedy' is not taken away.

39. It is pertinent to note that, Section 23 merely provides for registration of the trade mark, after considering and deciding the opposition, if any, raised for registration of such trade mark. It does not provide for anything further. It does not provide efficacious remedy for infringement of trade mark or for passing-off action. For that, the recourse has to be taken to the Civil Court, as only the Civil Court can grant the relief of injunction.

40. That's why Section 27(2) of the said Act clearly recognizes the 'common law remedy' in respect of passing-off goods and services. Section 27 of the Trade Marks Act is very clear to that effect and it reads as follows :-

“27. No action for infringement of unregistered trade mark:-

- (1) No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark.*
- (2) Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services, as the goods of another person or as services*

provided by another persons, or the remedies in respect thereof."

41. Thus, Clause (2) of Section 27 retains the Appellant's right to file a Suit for injunction, which is the only efficacious remedy available to the Appellant under the common law for restraining the Respondents from passing-off its goods or services as the goods of the Appellant or as services provided by the Appellant and the remedies in respect thereof. Therefore, the Trial Court has committed an error in holding that the relief of interim injunction cannot be granted to the Appellant on the ground that, efficacious remedy is available to the Appellant under the Trade Marks Act.

42. Now coming to the factual aspects of the case, it has to be held that, for succeeding in an action for passing-off, the Appellant has prima facie established that its use of the name '*Dorabjee*' for its 'retail business' is prior in time, than that of the Respondents and it has acquired a distinctiveness or secondary meaning to the extent that any other person using the trade name 'Dorabjee' for its retail business will be considered to be having association with the Appellant's business. This fact cannot be disputed by the Respondents also. That's why, the 'Letter of Intent' was executed between the Appellant and the Respondents for opening Appellant's 'Super Market' in Respondents' 'Mall'. Moreover,

when any retail business is running in profit for more than ten decades, from generation to generation, it is expanding every decade and earning profits, the reputed brands are engaging its services for sale of their articles, media is covering this business as distinctive and there are generations of loyal customers attached to it, it is not difficult to hold that this trade name 'Dorabjee' has acquired its own identity and distinctiveness. Hence, the use of that name by anyone else, even in respect of other or similar business, is likely to create confusion in the mind of the general public that the said business has association with the Appellant's business.

43. The law also no more requires that the common field of activity is an essential condition for a claim in passing off action. Judgment of this Court in the case of *M/s. SIA Gems and Jewellery Pvt. Ltd., Mumbai Vs. SIA Fashion, Mumbai, AIR 2004 BOMBAY 10*, sufficiently illustrates this point. In that case, the Plaintiff was running the business of costume jewellery under the trade name 'SIA', which was also the name given to their shop from the year 1995. The Defendant started the business of selling dress materials and sarees in a shop under the same name 'SIA' sometime in December, 2000. The contention of the Defendant was that, its goods were not in the common field of activities; i.e. sarees and dress materials were not in the same field, as those of the Plaintiff, which were costume jewellery. While rejecting this contention, it was held that,

“There is no doubt that the existence of a common field of activity of the Plaintiff and Defendant is not a condition precedent for the grant of an injunction against passing-off. There may be cases, where an attempt is made to pass off, even if the Defendant's goods are not in the common field of activities.”

44. In this case, the reliance was placed on the observations made by this Court in the case of *Kirloskar Diesel Recon Private Limited Vs. Kirloskar Proprietary Limited*, AIR 1996 Bombay 149, wherein it was held that,

“With the passage of time, law on the requirement of a common field of activity in a passing off action has radically changed. There is no requirement of common field of activity as a necessary foundation of a claim in passing off.”

45. This Court has, in the Judgment of *Kirloskar Diesel Recon Private Limited (Supra)*, further relied on the Judgment in the case of *Mirage Studios Vs. Counter Feat Clothing Co. Ltd.*, (1991) FSR 145, and observed that,

“The real question in such case is, ‘whether there is, as a result of misrepresentation, a real likelihood of confusion or deception of the public and consequent damage to the Plaintiff ?’ The focus has shifted from the external objective test of making a comparison of the activities of parties to the state of mind of the public in deciding whether it will be confused.”

46. Thus, by applying this test, it was held that,

“The Defendant's goods, i.e. the sarees and dress materials, are the goods, which are cognate to the Plaintiff's goods i.e. costume jewellery. It is more important to see whether the customers, most likely female in this case, would think upon coming across the Defendant's shop that the shop has some connection with the Plaintiff's shop, which bears the same name. The Defendant's shop is at Vile Parle and the Plaintiff's shop is at Santacruz. They are not considered to be very far away from each other. As such, there is no doubt that, a customer, who comes across the Defendant's shop with the name 'SIA', boldly displayed on it, would think that there is some connection with the Plaintiff's Shop, which also has the name 'SIA' displayed on it. There is every likelihood of consequent confusion that the Defendant's shop has connection in some way with the Plaintiff's shop, although it deals with different goods; such as sarees and dress materials.”

47. Thus, it is settled that, if the prior use of the trade name is established, then, even if the Defendant is dealing in different business, but under the same trade name, he can be restrained from using the same trade name.

48. In this respect, useful reference can also be made to the Judgment of another Single Bench of this Court in the case of *Mahindra &*

Mahindra Limited and Another Vs. MNM Marketing Private Limited and Another, 2014 SCC OnLine Bom. 1343. In the said case also, the Plaintiff-Company was a flagship company of the Mahindra Group of Companies and was a highly reputed, established and well-known business house, having interest in a very wide range of businesses and activities. They were conducting the retail trade business, with focus on the premium life-style and retail business stores selling apparels, toys and furnishings, by using the trade marks 'MAHINDRA' and 'M & M'. Defendant No.1 therein has started a 'Firm', under the name of 'Manhar & Manhar', and started using the abbreviation as "MNM" for their Shopping Mall / retail business, which falls within 'Class 35'. Hence, the grievance raised by the Plaintiffs was that, the business of the Defendants being identical or, in any event, deceptively similar to the Plaintiff's trade mark 'M & M', which was registered, *inter alia*, in 'Classes 35 and 42', such use of the impugned mark constitutes infringement of the Plaintiffs' registered trade mark 'M & M' and also results in passing off the Defendants' retail services / business as and for those of the Plaintiffs. It was submitted by the Plaintiffs that, the Defendants' registration of the impugned mark is in several other class in respect of goods, but not in 'Class 35' or 'Class 42' and use thereof is much after the registration and use by the Plaintiffs of the said trade mark 'M & M', and in any event, the Defendants do not have any registration of the impugned mark 'M & M' in 'Class 35' for retail trade

services, in respect of which the Defendants are using the same and, therefore, they should be restrained from doing so.

49. The argument advanced on behalf of the Defendants in that case was that, the Plaintiffs have no presence in Shopping Malls. There was no commonality in the field of activity of the Plaintiffs and the Defendants and there was a vast difference between the nature of services of the Plaintiffs and the Defendants. It was submitted that, the classes, under which the Defendants have got the marks registered, pertain only to specific goods and not for services at all. The Defendants do not have any registration in 'Classes 35 and 42'. Hence, there was no question of Defendants infringing the trade mark of the Plaintiffs or being guilty of passing off action.

50. While considering these rival submissions, the reliance was placed on the observations made in paragraph No.24 of the Judgment of the Hon'ble Apex Court in the case of *Mahendra & Mahendra Paper Mills Limited Vs. Mahindra & Mahindra Limited*, (2002) 2 SCC 147, and it was held as follows :-

“24. Judging the case in hand on touchstone of the principles laid down in the aforementioned decided cases, it is clear that the Plaintiff has been using the word 'Mahindra' and 'Mahindra & Mahindra' in its companies/business concerns for a long span of time, extending over five decades. The name has acquired a

distinctiveness and a secondary meaning in the business or trade circles. People have come to associate the name 'Mahindra' with a certain standard of goods and services. Any attempt by another person to use the name in business and trade circles is likely to and in all probability will create an impression of a connection with the plaintiff's group of companies. Such user may also affect the Plaintiff prejudicially in its business and trading activities. Undoubtedly, the question whether the Plaintiffs' claim of 'passing-off action' against the Defendant will be accepted or not has to be decided by the Court after evidence is led in the Suit. Even so, for the limited purpose of considering the prayer for interlocutory injunction, which is intended for maintenance of status-quo, the Trial Court rightly held that the Plaintiff has established a prima facie case and irreparable prejudice in its favour, which calls for passing an order of interim injunction, restraining the Defendant-Company, which is yet to commence its business, from utilizing the name of 'Mahendra' or 'Mahendra & Mahendra' for the purpose of its trade and business. Therefore, the Division Bench of the High Court cannot be faulted for confirming the order of injunction passed by the learned Single Judge.”

51. It was further held that,

“Though there was no commonality in the field of activity of the Plaintiffs and Defendants and as there was vast difference between the nature of services of the Plaintiffs and the Defendants, considering that the Defendants' impugned mark is identical with or deceptively similar to the Plaintiffs' registered trade mark, the presumption under Section 29(2) of the

Act, that the same is likely to cause confusion or association with the registered trade mark also applies here.

Defendants' contention that, there cannot be any confusion, as the impugned trade mark is used in relation to Shopping Malls, which is alleged to be different from the goods / services covered by the Plaintiffs' trade mark, cannot be accepted."

52. In the present case also, as rightly submitted by learned Senior Counsel for the Appellant, the Appellant's goodwill and reputation in its trade name '*Dorabjee's*' is sufficiently established from the materials produced on record and from its long user of more than 100 years. Admittedly, the Appellant's user of the trade name '*Dorabjee's*' in retail business is long and prior to that of the Respondents. Hence, secondary significance has been acquired by the Appellant's trade name. Therefore, use of the said trade name 'DORABJEE'S' by the Respondents, particularly in the retail business, in which the registration is sought, will inevitably lead to an association of Respondents' business with that of the Appellant and the damage will thereby result into Appellant's reputation. The Appellant has also produced on record various letters received from its clients, making enquiry as to whether this recent 'Mall' opened by the Respondents is having any connection with the Appellant's business under the trade name '*Dorabjee's*'.

53. The contention of the Respondents that they are using the name 'DORABJEE'S' for their construction activity since for a long period and at no time, the Appellant has raised any objection thereto, cannot be of any avail. Admittedly, their prior use was only in respect of the construction activity and as on today also, the Appellant has no grievance for the use of the name 'Dorabjee' by the Respondents in the construction activity, as it has no connection with the retail business of running a 'Super Market'. However, now the Respondents have sought registration under 'Class 35', for retail trade business and have changed the name of their 'Mall' from 'Royal Heritage Mall' to 'DORABJEE'S MALL', in which such retail business of sale of food products is intended to be conducted. It gives ground for the case of the Appellant, as it is definitely going to cause confusion in the mind of the general public that Respondents' 'DORABJEE'S MALL' is having some connection or association with the business of the Appellant.

54. It is pertinent to note that, the Appellant has acquired reputation for its retail business in the name of '*Dorabjee's*'. Now by opening a 'Mall' in the same name of 'DORABJEE'S MALL' and at the same stage, applying for registration in the same 'Class 35' for the 'retail business', the Respondents are also trying to enter into the same business. Considering that the 'Super Market' is as good as a 'Mall', there is every likelihood of the customers, who are interested in purchasing the

household goods, being confused in their mind, associating the 'Mall' of the Respondents with the business and 'Departmental Store' of the Appellant. It is common knowledge that, in a 'Mall', apart from various goods; like clothes, electronic items etc., there are also shops dealing in retail business. It may be in the name of 'D' Mart or otherwise, but when the 'Mall' itself is carrying the name of 'DORABJEE', then there is every likelihood of the customers connecting the said 'DORABJEE'S MALL' with the 'Super Market' of the Appellant in the name of '*Dorabjee's*'. As both, the Respondents' 'Mall' and the Appellant's 'Super Market', are dealing in the same retail business of selling the household products, there is all the more possibility that the customers will understand that Respondents' 'Mall' has some connection with the Appellant's 'Super Market' or, may be, it is even a 'Branch' of that 'Super Market'.

55. In this respect, learned Senior Counsel for the Appellant has rightly placed reliance on the Judgment of the Hon'ble Apex Court in the case of *Laxmikant V. Patel Vs. Chetanbhai Shah and Another*, (2002) 3 SCC 65. In that case, the Plaintiff was running his business in Ahmedabad, under the name and style of Muktajivan Colour Lab and Studio, since 1982 and has earned a reputation and developed a goodwill associated with it. The name 'Muktajivan' was extensively advertised and used by the Plaintiff. The Defendants were carrying on similar business under the name and style of "Gokul Studio". Now they intended

to start business in another part of Ahmedabad, by adopting the Plaintiff's name and style as 'Muktajivan Colour Lab'. On the Plaintiff initiating action for passing-off on 12th May 1997, the District Court passed ex-parte injunction order against the Defendants. The Defendants contested and pleaded that, they had already started their business with the offending name before institution of the Suit and that the actual name of the Plaintiff's business was "QSS – Muktajivan Colour Lab" and that it was in a different locality of Ahmedabad. The Trial Court vacated the ex-parte injunction, despite the finding that, at-least from 1995, the Plaintiff was using 'Muktajivan' as part of its business name and the Defendants' Studio's name was "*some what identical*" with the trade name of the Plaintiff, on the ground that, although the businesses of the Plaintiff and the Defendants were situated in Ahmedabad, but the business of the Defendants was in the outer periphery of the city of Ahmedabad, at a distance of about 4 to 5 kms. from the place where the Plaintiff was carrying on his business, which was mainly in the city area. The Plaintiff preferred an Appeal to the High Court. However, the High Court dismissed the same mainly on the ground that, Defendants' business had already come into existence on the date of the institution of the Suit and, therefore, Defendant could not be restrained by issuance of a preventive injunction. While interfering and setting aside this concurrent order passed by the Trial Court and the High Court, the Hon'ble Apex Court held that,

“As the discretion exercised by both the Courts below was not sound on the relevant settled principles of law governing the grant or refusing the interlocutory injunction in the trade mark and trade name disputes, it becomes obligatory on its part to interfere in the said discretion.”

56. It was held that,

“It is common in trade and business for a trader or a businessman to adopt a name and/or mark, under which he would carry on his trade or business. An action for passing-off will then lie wherever the Defendant-Company's name, or its intended name, is calculated to deceive and so to divert business from the Plaintiff, or, to occasion a confusion between the two businesses. The ground is not to be limited to the date of the proceedings. The Court will have regard to the way, in which the business may be carried on in the future and to its not being carried on precisely, as carried on at the date of the proceedings. Where there is probability of confusion in business, an injunction will be granted even though the Defendants adopted the name innocently.”

57. In paragraph No.10 of its Judgment, the Hon'ble Apex Court was pleased to observe as follows :-

“10. A person may sell his goods or deliver his services, such as in case of a profession under a trading name or style. With the lapse of time, such business or services associated with a person acquire a reputation or goodwill, which becomes a property, which is protected

by Courts. A competitor initiating sale of goods or services in the same name or by imitating that name results in injury to the business of one, who has the property in that name. The law does not permit any one to carry on his business in such a way, as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services, which already belongs to someone else, it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.” [Emphasis Supplied]

58. In paragraph No.12 thereof, it was further held that,

“The three elements of passing-off action are the reputation of goods, possibility of deception and likelihood of damages to the Plaintiff and this principle, which applies to the trade mark, is applicable to the trade name also.”

59. In paragraph No.13 of its Judgment, the Hon'ble Apex Court was pleased to categorically hold that,

“In an action for passing-off, it is usual, rather essential, to seek an injunction, temporary or ad-interim. The principles for the grant of such injunction are the same, as in the case of any other action against

injury complained of. The Plaintiff must prove a prima facie case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction.

60. Hence, as held in this case, once a case of passing-off is made out, the practice is generally to grant a prompt ex-parte injunction. In such cases, fraud is not a necessary element for the right of action and the absence of an intention to deceive is not a defence, though proof of fraudulent intention may materially assist the Plaintiff in establishing probability of deception. In such cases, even Plaintiff does not have to prove actual damage, in order to succeed in an action for passing-off. Likelihood of damage is sufficient.

61. In the above-said case, having regard to the fact that, the Plaintiff was running his business in the name and style of 'Muktajivan Colour Lab and Studio' since 1982 and Defendant has just commenced an identical business by adopting the word 'Muktajivan' as a part of his business name, it was held that,

“The intention of the Defendant to make use of the business name of the Plaintiff, so as to divert his business or customers to himself was apparent; especially in the fact that, it was not the case of the Defendant that, he was not aware of the word 'Muktajivan', being the property of the Plaintiff or the Plaintiff running his business in that name, though

such a plea could only have indicated the innocence of the Defendant and yet no difference would have resulted in the matter of grant of relief to the Plaintiff, because the likelihood of injury to the Plaintiff was writ large.”

62. It was further held that,

“The distance of about 4 to 5 kms. between the Plaintiff's and Defendant's business was not material. In the event of Plaintiff having acquired a goodwill as to the quality of services being rendered by him, a resident of Ahmedabad city would not mind travelling a distance of a few kilometers for the purpose of availing a better quality of services.”

63. Hence, it was held to be a fit case where such relief needs to be granted; despite the fact that, the business name some times adopted by the Plaintiff used “QSS” as prefixed to 'Muktajivan Colour Lab'.

64. In the facts of the present case also, the material on record sufficiently establishes the user of the word '*Dorabjee's*' by the Appellant for its retail business since last more than a century. Respondents have adopted and applied for its registration under 'Class 35' category for retail business very recently. Respondents were using the name 'DORABJEE'S' only for the construction activities. It is pertinent to note that, even as regards the 'Mall', initially its name was 'Royal Heritage

Mall', which was subsequently changed to 'DORABJEE'S MALL'. It is also not the case that the Respondents were not aware about the goodwill and reputation of the Appellant in this retail business. There is documentary evidence produced on record to show that, the Respondents have offered and Appellant has accepted to open its business in the name of '*Dorabjee's*' in the 'Mall' of the Respondents. A 'Letter of Intent' to that effect was also drafted. It may be true, that the said 'Agreement' did not materialize, but the fact remains that, the Respondents were very much aware that the Appellant was running its retail business in the name of '*Dorabjee's*' and only because the Appellant's business has acquired considerable reputation and goodwill in the passage of time, the Respondents have offered its premises in the 'Mall' to the Appellant for running its business.

65. As a matter of fact, the very change of the name of the 'Mall' by the Respondents from 'Royal Heritage Mall' to the 'DORABJEE'S Mall', knowing fully well that the name '*Dorabjee's*' is already used by the Appellant for its retail business, goes to indicate, prima facie, that the intention of the Respondents was to take benefit of the reputation and goodwill obtained by the Appellant in the said business. Though it is true that the existence of such dishonest intention is not an essential condition for awarding the claim in the passing-off action, but it assists

the Plaintiff, as held by the Hon'ble Apex Court in this Judgment of *Laxmikant V. Patel Vs. Chetanbhai Shah and Anr.*, (2002) 3 SCC 65, in getting such relief of interim injunction. Mere distance of some kilometers between Appellant's business at Moledina Road in Camp and Respondent's Mall at NIBM Complex, also cannot be material in that aspect, so as to deny the relief of interim injunction to the Appellant, which is to follow ordinarily in the case of passing-off action. As held in the above-said Judgment, the customers would not mind travelling the distance of a few kilometers for the purpose of availing the quality of services, which the Appellant is rendering and is known for, on account of its goodwill and reputation. Therefore, as in the instant case also, considering the similarity in the trade name, which is very deceptive, as both are using the same trade name 'Dorabjee', it is likely to cause confusion in the mind of the customers, who are to avail the products. Hence, the relief of interim injunction should ordinarily follow.

66. As a matter of fact, as held in the Judgment of *Mahindra & Mahindra Limited and Another Vs. MNM Marketing Private Limited and Another*, 2014 SCC OnLine Bom 1343, by the Single Bench of this Court, the mere fact that, Appellant in this case has no presence in Shopping Malls, it cannot be accepted that there is no commonality in the field of activity of the Appellant and Respondents and there is vast difference between the nature of services rendered by them. Considering that the

Respondents' name is not only identical, but exactly the same to that of the Appellant's trade name and now Respondents intend to use it for similar services as that of the Appellant, the presumption under Section 29(2) of the Trade Marks Act, 1999, that the same is likely to cause confusion or association with the registered trade mark also applies here.

67. Otherwise also, the Appellant has made out a strong prima facie case. Even in passing-off action, as per the law, the registration of trade mark is no defence to such action. Hence, merely because the Respondents have applied for registration of the trade name as 'DORABJEE'S' cannot be a ground to reject the relief of interim injunction to the Appellant. The finding of the Trial Court, therefore, that the Appellant has circumvented the remedy available to him under the Trade Marks Act, 1999, can hardly be accepted, once it is held that the claim for passing-off action is maintainable in view of the provisions of Section 27(2) of the Trade Marks Act, 1999.

68. In this respect, learned Senior Counsel for the Appellant has also relied upon the Judgment of the Hon'ble Apex Court in the case of *N.R. Dongre and Others Vs. Whirlpool Corporation and Another*, (1996) 5 SCC 714, wherein it was clearly held that, even if the Plaintiff may not be a registered owner of the trade mark and it is the Defendants, who have

applied for such trade name, that will not make any difference for passing-off action. It was held that, the Appellants therein, who were the proprietors of the trade mark 'WHIRLPOOL', cannot stop others from using the said trade mark. The lack of registration of the trade mark 'WHIRLPOOL' in favour of the first Respondent could not have conferred a higher right on the Appellant, than it would have, with a registration in its favour. Considering that the Respondents were using the trade mark 'WHIRLPOOL' from the year 1941 and had acquired worldwide reputation and goodwill in respect of the said trade mark in the mind of general public, it was held that the Appellant wanted to take the benefits of the reputation and goodwill acquired by the Respondents by using the trade mark 'WHIRLPOOL' on their products. Hence, as the adoption of the trade mark by the Appellant was not honest and bonafide, it was necessary to restrain the Appellant from using the same, having regard to the fact that the Respondents were the prior user of the said trade mark. These observations of the Appellant squarely apply to the facts of the present case.

69. This brings me to the contention that, Respondents are also holding the surname 'Dorabjee' and, therefore, they have right to use their personal name for the purpose of their business; as such, Appellant cannot restrain the Respondents from using the same. In answer to it, the Judgment of this Court in the case of *Kirloskar Diesel Recon Private*

Limited and Another Vs. Kirloskar Proprietary Limited and Others, AIR 1996 Bombay 149, can be quoted, wherein it was held that,

“The defence that a man has a right to use his personal name is not available in a passing-off action and interlocutory injunction is to be ordered, since no man is entitled, even by the honest use of his own name, so to describe or mark his goods, as, in fact, to represent that they were the goods of another person.”

70. It was further held that,

“If the use of the surname is calculated to deceive either by diverting the customers from the Plaintiff to the Defendant or by occasioning a confusion between the two businesses i.e. by suggesting that the Defendant's business is an extension branch or agency or otherwise connected with the Plaintiff's business, then such use cannot be permitted.”

71. It was reiterated that, in passing-off action, it was not necessary for the Plaintiff to establish fraudulent intention on the part of the Defendant. It was even not necessary for the Plaintiff to prove causing of actual confusion among the customers or public at large by the Defendants adopting the same trade name. What the Plaintiff is required to establish is the likelihood of deception or confusion, which the Plaintiff has established in this case by use of the word 'KIRLOSKAR' by the

Defendants as a part of their business on the spacious plea that, it was their personal name.

72. A useful reference, at this stage, can be made to the Judgment of the *Midas Hygiene Industries P. Limited and Another Vs. Sudhir Bhatia and Others, 2004 (28) PTC 121 (SC)*, which emphasizes that, in case of infringement or passing-off action, an injunction must follow. Mere delay in bringing the action is also not sufficient to defeat the grant of injunction in such cases and such grant of injunction also becomes necessary, if it prima facie appears that the adoption of the mark was itself dishonest.

73. As to the contention of the Respondents that, the writing style or the font of the Appellant's trade name '*Dorabjee's*' and Respondents' trade name 'DORABJEE'S' is different, this contention also needs to be rejected by applying the tests laid down by the Hon'ble Apex Court in the case of *M/s. Hiralal Parbhudas Vs. M/s. Ganesh Trading Co., AIR 1984 Bombay 218*, as follows :-

“5. What emerges from these authorities is (a) what is the main idea or salient features, (b) marks are remembered by general impressions or 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 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.”

74. Therefore, what is essential is the overall similarity, variation in detail notwithstanding. Here when the name 'Dorabjee' itself is the same, hardly the customers will understand that both these businesses belong to different 'Concerns', merely because there is different writing style and different script in using the said name. In the mind of the customers, who are ordinary consumers of the household products, the name 'Dorabjee' is of importance; not whether it is written in the capital letters or in the running script.

75. The true test laid down by the Hon'ble Apex Court in the case of *Roche and Co. V/s. Geoffrey Manner and Co., (1969) 2 SCC 716*, is, *'whether the totality of the proposed trade mark is such that, it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark?'*

76. In the present case, admittedly, the trade marks are just identical and not merely similar. As the word 'Dorabjee' is used in both the trade names, it is hardly relevant from the perception of a common customer as to whether those words are written in capital letters or in running script.

77. As observed by the Delhi High Court in the case of *Baker Hughes Limited and Another Vs. Hiroo Khushalani and Another*, ILR (1999) I Delhi 41,

“There can be an informed class of purchasers, who have a degree of knowledge and a sense of discrimination, more substantial than that of an ordinary purchaser, but the mere fact that the customers are sophisticated, knowledgeable and discriminating, does not rule out the element of confusion, if the trade marks / trade names / corporate names of two companies are identical or if the similarity between them is profound. In several cases, it has been held that, initial confusion is likely to arise even amongst sophisticated and knowledgeable purchasers under a mistaken belief that the two companies using the same corporate name, trading name or style are inter-related. It is the awakened consumers, who are more aware of the modern business trends, such as trade mark licensing, mergers, franchising, etc. It is this class of buyers, who are likely to think that there is some sort of association between the products of two different companies, when they come across

common or similar trade names or corporate names or trading styles used by them. Therefore, the sophistication of a buyer is no guarantee against likely confusion. In some case, however, it is also possible that, such a purchaser, after having been misled into an initial interest in a product manufactured by an imitator, discovers his folly, but this initial interest, being based on confusion and deception, can give rise to a cause of action for the tort of passing-off, as the purchaser has been made to think that there is some connection or nexus between the products and business of two disparate companies.”

78. In the facts of the present case, there can hardly be any doubt that, as both the Appellant and Respondents are using the same trade name, there is likelihood of confusion, which has also actually occurred in respect of some of the purchasers, as can be seen from the letters written by them to the Appellant. It can hardly be accepted that those letters are manipulated one.

79. As to the Judgment of the Delhi High Court in the case of *Rajinder Kumar Aggarwal Vs. Union of India and Another*, 2007 SCC OnLine Del 952, relied upon by learned Senior Counsel for the Respondents, in that case, the application was made for registration in the name of 'AGGARWAL SWEET CORNER'. Hence, the question involved was, 'whether the word 'AGGARWAL' can be registered as a trade mark?' In

that context, it was held that the word 'AGGARWAL' being common surname and also the surname of a particular cast, it cannot, by itself, be registered under Section 9(1) of the Trade and Merchandise Marks Act, 1958, except upon evidence of its distinctiveness. Thus Judgment, therefore, cannot be useful in the present case.

80. The facts of the Judgment in the case of *Goenka Institute of Education & Research Vs. Anjani Kumar Goenka & Another*, ILR (2009) VI DELHI 415, relied upon by learned Senior Counsel for the Respondents, are also different. In that case, the word 'Goenka' was registered by the Plaintiff in the year 2005, with effect from 2002, in different classes under the Trade Marks Act, 1999, and on that basis the relief of interim injunction was claimed, restraining the Defendants from using the surname 'Goenka' for their educational activity. In that context, it was held that, mere registration cannot confer right on the Respondents, as registration without user is of no effect. There was no material evidence on record to show that, the word 'Goenka' has acquired a distinctive or secondary meaning, so as to restrain the Defendant from using the same name, which was also their surname. In that case, a specific finding was arrived at on the facts of the said case that, the word 'Goenka' being a common surname, *per se*, is not distinctive and to acquire distinctiveness in such a common surname, is not possible. Even if distinctiveness can be achieved for such a common

surname, it was held that, the Plaintiff has not achieved such distinctiveness. Moreover, it was found that, there was honest concurrent prior user of the word 'Goenka' by the Plaintiff and Defendant and hence, it was held that, Plaintiff cannot restrain the Defendant from using their surname.

81. As against it, in the present case, it is more than clear that, in the first place, the name 'Dorabjee' is not such a common surname and, secondly, the Appellant being in this 'retail business' since more than 100 years, the name 'Dorabjee' has acquired the distinctiveness; whereas Respondents were, though using their surname 'Dorabjee', it was in different field of activity, that of the 'construction' or 'restaurant'. They may have acquired distinctiveness in those activities. However, so far as 'retail business' is concerned, it is the Appellant, who has acquired distinctiveness. Respondents are recently entering into the said business, by making application for registration under 'Class 35'.

82. In this respect, their use of the name 'DORABJEE' for their 'Mall' also does not appear to be honest, considering that earlier it was called as 'Royal Heritage Mall' and now when the Respondents want to enter in the retail business, they have changed the same to 'DORABJEE'S MALL'.

83. In this context, useful reference can be made to the Judgment of

the Delhi High Court in the case of *Dr. Reddy's Laboratories Limited V/s. Reddy Pharmaceuticals Limited, 2004 (29) PTC 435 (Del)*. In that case also, the plea was raised by the Defendant that, it has a bonafide statutory right to use the trade name 'Reddy', as its Managing Director is Mr. Reddy. However, this plea was rejected for the reason that, the trade mark 'Dr. Reddy', in spite of not being registered, has acquired considerable trade reputation and goodwill in the community dealing with drugs and pharmaceuticals, not only in India, but abroad also. This trade mark is now distinctively associated with the Plaintiff's Company. Its long and continuous user by the Plaintiff is established and hence, the use of the trade name / mark 'Reddy' by the Defendant was capable of causing confusion and deception, resulting in injury to the goodwill and reputation of the Plaintiff-Company. It was held that,

“No other 'Reddy' has a right to start a rival business by using the said trade name on the plea that, it is his surname. This would encourage deception. If such a plea is allowed, rivals in trade would be encouraged to associate in their business ventures persons having similar surnames, with a view to encash upon the trade reputation and goodwill acquired by others over a period of time.

In Bajaj Electrical Limited, Bombay Vs. Metals & Allied Products, Bombay and Another, AIR 1988 Bombay 167, the use of a family name by the Defendants was held to be an act of passing-off the goods and it was observed that the use of such family name as a trade mark was not permissible. The pleas

of the Defendants that, the surname of the partners of its firm could be used to carry on trade in their own name was rejected. It was held that, prima facie, the Defendants were intentionally and dishonestly trying to pass-off their goods by use of name “Bajaj” and as such the Plaintiff had made out a case for grant of injunction.

In the case of Kirloskar Diesel Recon Pvt. Ltd. and Another Vs. Kirloskar Proprietary Ltd. and Others, AIR 1996 Bombay 149 also, it was held that, the use of surname was not saved by Section 34 of the Trade and Merchandise Marks Act, 1958 for an artificial person like incorporated company. It was also held that, the mark 'Kirloskar' used by the Plaintiffs had acquired a secondary meaning and had become a household word and as such Section 34 of the Act could not come to the rescue of the Defendants.”

84. In the present case also, having regard to the facts discussed above, it is apparently and clearly established that the word '*Dorabjee's*' has achieved the distinctiveness in the 'retail trade business' and hence, so far as that business is concerned, the Respondents are required to be restrained from using the name '*Dorabjee*', though it may be their surname.

85. Learned Senior Counsel for the Respondents has then relied upon the Judgment of the Karnataka High Court in the case of *Somashekar P. Patil Vs. D.V.G. Patil*, (2018) SCC OnLine Kar 637. In that case, it was

found that, both, the Plaintiff and Defendant, were belonging to the same family and shared common surname 'Patil'; the products of both, Plaintiff and Defendant, were, however, different and only the name of the Company was similar i.e. 'Patil'; 'Patil Parimala Works' of the Appellant and 'Patil Fragrances' of the Defendant. In view thereof, it was held that, when both of them were concurrently and bonafidely using their own surname for their businesses and there was nothing on record to show that the said surname in the business of the Plaintiff has achieved distinctiveness, the relief of injunction cannot be granted.

86. As regards the Judgment of this Court in the case of *Ayushakti Ayurved Private Limited and Others Vs. Hindustan Lever Limited, 2003 (4) Mh.L.J. 915*, relied upon by learned Senior Counsel for the Respondents, the facts of the said case also go to show that, the Plaintiffs' mark was 'Ayushakti'; whereas, Defendant's mark was 'Ayush'. In that context, it was held that,

“Since the words are not similar and are pronounced and also read differently, there is no reason for customers to imagine that the product 'Ayush' has the same origin as those of the products sold under the name 'Ayushakti'. Merely because it is possible to imagine that a given person may get confused as to the product, it is no reason to imagine that everyone would get confused.”

87. Thus, it can be easily seen that the facts of this decision are also totally different, as the trade names of both the products were different. Here the trade name is the same.

88. Learned Senior Counsel for the Respondents has then placed reliance on the Judgment of the learned Single Judge of this Court in the case of *Pidilite Industries Limited and Another Vs. Vilas Nemichand Jain and Another*, 2015 SCC OnLine Bom. 4801, wherein also, the rival marks were identical, as in the present case. They were 'LEAKGUARD'. Hence, it was held that,

“There was no question of assessing any similarity or deceptive similarity. Both sides claim to be using the same mark in relation to solvent cements and similar chemicals and compounds.”

89. In that backdrop, it was held that,

“The question of distinctiveness in a matter such as this, based on a cause of action in passing-off, is necessarily a factual test. If the contesting sides have both been using the mark in the same fashion and one of them is shown to have been using it prior to the other, and it is also shown that, that prior user is extensive, then the action in passing-off can be maintained and protective relief cannot be denied.”

90. In the instant case, if the above-said test is applied, then it has to

be held that, the Appellant is using this trade name since prior to the Respondents. Its use is extensive in the 'retail business' and as such, it has achieved the distinctiveness. There is much substance in the submission of learned Senior Counsel for the Appellant that, this trade name 'Dorabjee' has also acquired a secondary meaning, where invocation of the said name is in public mind and in public perception necessarily and usually associated with Appellant's business. In other words, the very use of the name '*Dorabjee's*', so far as 'retail business' is concerned, is bound to bring to the mind of the common customer Appellant's 'Super Market' and none other. The name '*Dorabjee's*' is exclusively associated with the Appellant's business, to such an extent, the public, immediately and unmistakably, co-relates the name '*Dorabjee's*' with the source or with the Appellant's 'Super Market'. In such situation, relief of interim injunction cannot be denied. In that case, it was denied because of the delay in bringing the action, as the Plaintiffs in the said case had learnt of the Defendants' user only in the year 2009, though Defendants were using the same since 2005 openly and without any attempt at concealment. Hence, it was held that, it would be hard to accept that, Plaintiff learnt about Defendant's user only in 2009, considering that the markets and channels of the business were very likely the same and hence, Plaintiffs cannot be unaware of the Defendant's use. The Suit itself was filed only in the year 2010, after a

notice a little earlier. It was also pointed out that, since from the time the Suit was filed till the year 2010, Plaintiffs had not obtained an ad-interim injunction. The Suit was actually at the stage of trial and hence, it was held that, the Plaintiffs have to make out an even stronger case to establish, not only a prima facie case, but also to show that the balance of convenience is so overwhelmingly in their favour that, despite their own delay in bringing the Suit and despite the fact that they have enjoyed no protection in these intervening years, an order of injunction must now be granted. It was, therefore, held in the fact situation of that case that, Plaintiffs must show that the want of an injunction will now result in irredeemable prejudice and loss to them and that it will result in an irreparable dilution of their mark. As Plaintiffs had not been able to do so, the relief of interim injunction was refused to them.

91. Needless to state, that the facts of the present case are totally different. Immediately after the Respondents have changed the name of its 'Mall' from 'Royal Heritage Mall' to 'DORABJEE'S MALL' and applied for registration under 'Class 35' for dealing in 'retail business', the Appellant has rushed to the Court and sought the relief of interim injunction, restraining the Respondents from using the trade name 'Dorabjee', so far as 'retail business' is concerned. There is no delay, much less acquiescence, as such. Therefore, Appellant's claim cannot be defeated, when Appellant has made out all the necessary ingredients for

the grant of the relief of interim injunction and the relief claimed by the Appellant is also to a limited extent of restraining the Respondents from using the trade name 'Dorabjee' in the limited field of 'retail business'.

92. As regards the Respondents' business of 'Restaurant' and 'Construction Activity', the Appellant is not claiming the said relief and rightly so, as the use of the Respondents of the name 'Dorabjee' for the said business is much prior to; whereas, in this 'retail business', Respondents are entering for the first time and, that too, changing the name of the 'Mall' from 'Royal Heritage Mall' to 'DORABJEE'S MALL', which change cannot be, *per se*, called as honest and appears to be to take advantage of the goodwill and reputation earned by the Appellant to the name '*Dorabjee's*' for its retail business.

93. In my considered opinion, therefore, as the Trial Court has not considered all these essential aspects in a passing-off action, in which the relief of interim injunction should follow, the impugned order passed by the Trial Court is required to be quashed and set aside.

94. Accordingly, the Appeal is allowed. The impugned order passed by the Trial Court is quashed and set aside. In consequence thereto, the application filed by the Appellant before the Trial Court at 'Exhibit-5', seeking the relief of interim injunction, is allowed in following terms :-

“The Respondents are hereby restrained from using or displaying the mark / trading style / trade name '*Dorabjee's*' or any other mark / trading style / trade name similar to the mark '*Dorabjee's*' in any manner, including in relation to their business / Mall / Shopping Complex, until the decision of the Suit.”

95. In view of the above, Civil Application (Stamp) No.25528 of 2018 pending in the Appeal, does not survive and the same stands disposed off as infructuous.

96. Learned Senior Counsel for the Respondents seeks stay to the execution and implementation of this order, in order to enable the Respondents to approach the Hon'ble Supreme Court.

97. Learned Senior Counsel for the Appellant strongly resists the same, on the count that, it being a matter pertaining to infringement of trade mark and passing-off action, no stay should be granted.

98. However, considering that, during the pendency of the Suit and this Appeal also, there was no order of interim injunction and for the

first time, it is pressed today, in order to enable the Respondents to approach the Hon'ble Supreme Court, the execution and implementation of the order passed by this Court is stayed for a period of six weeks from today.

[DR. SHALINI PHANSALKAR-JOSHI, J.]