

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

**Appeal from Order No.73 of 2018
WITH
Civil Application No.13792 of 2018.**

1. Hindustan Distilleries,
A partnership firm, having its office
at Sai Prasad, Burudgaon Road,
Ahmednagar
Through its partner,
Chandrabhan s/o Atmaram Agrawal,
Age-62 years, Occu-Business,
2. Chandrabhan s/o Atmaram Agrawal,
Age-62 years, Occu-Business,
R/o Sai Prasad, Burudgaon Road,
Ahmednagar

– APPELLANTS

VERSUS

Brihan Karan Sugar Syndicate Pvt.Ltd.,
Company duly incorporated
under Companies Act,
Having its registered office at
B-102, Daffodils Wing B,
Hiranandani Gardens, A.S.Road,
Powai, Mumbai,
Through its Director,
Kanyalal Kimatram Kalani,
Age-52 years, Occu-Business,
R/o Nasik Road, Nasik

– RESPONDENT

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CORAM : RAVINDRA V. GHUGE, J.

Reserved on : 05/03/2019

Pronounced on : 15/03/2019

JUDGMENT :

1. By this Appeal, the Appellant original Defendant seeks to challenge the interlocutory order dated 12.10.2018 delivered by the learned District Judge-2, Ahmednagar (hereinafter referred to as the Trial Court) below Exhibit 5, in Trademark Suit No.1/2018. By the said order, the Trial Court has clamped the injunction on the Appellant/Defendant as follows :-

“The application (Exh.5) is allowed as follows :-

(a) The defendants by itself, its partners, servants, dealers and agents are hereby restrained by an order of temporary injunction till disposal of the suit from infringing the plaintiff's copyright in its artistic labels by reproducing the same or substantial part thereof in material form or by printing, publishing or using the impugned label or any other work which is an imitation or reproduction of the plaintiff's artistic labels or substantial part thereof or in any other manner whatsoever.

(b) The defendants by its partners, servants, dealers and agents are restrained by an order of temporary injunction till disposal of the suit from infringing the plaintiff's registered trade mark Nos.1051107, 884925 and 1612761 in Class 33 by using the trade mark labels and the work mark "TANGO" in respect of country liquor or by using any other trade mark/label which is identical with or deceptively similar to the plaintiff's registered trade mark Nos.1051107, 884925 and 1612761 in Class 33, upon or in relation to its country liquor or similar goods or in any other manner whatsoever.

(c) The defendants by its partners, servants, dealers and agents are restrained by an order of temporary injunction till disposal of the suit from manufacturing, selling, offering for sale,

advertising, or otherwise dealing in country liquor bearing the trade mark label or any other trade mark label deceptively similar to the plaintiff's trade mark labels particularly those at Annexure "A-1" and "B-1", so as to pass off or enable others to pass off the defendant's country liquor as and for the well known country liquor of the plaintiff."

2. I have extensively heard the learned Senior Advocate Shri Dixit on behalf of the Appellant/ original Defendant and Shri Kane, learned Advocate on behalf of the Respondent/ original Plaintiff, on 17.01.2019, 24.01.2019, 31.01.2019, 13.02.2019, 25.02.2019 and 05.03.2019.

3. The submissions of the original Defendant can be summarized as under :-

- (a) On 02.12.1993, the Defendant placed an order for designing a label with Narendra Art Printers.
- (b) On 23.12.1993, the Defendant was supplied with the design of the label.
- (c) Practically after 10 years, the Defendant made an application to the Commissioner of State Excise for permission to use the label for country liquor bottles.
- (d) On 07.04.2003, the Commissioner of State Excise granted permission to the Defendant to use the said label subject to the rider that the defendant would be responsible for violation of any trademark/ copyright.
- (e) On 03.05.2005, the Defendant made an application for registration of the trademark of the label "Golden Spot Tango".

- (f) The said application was published in the Trademarks Journal No.1412 in Class-33, on 16.03.2009.
- (g) The Plaintiff raised an objection on 30.03.2009 and a notice was served upon the Defendant, on 30.12.2011.
- (h) The Defendant filed it's counter claim on 15.02.2012 before the Registrar, Trademarks.
- (i) On 16.01.2017, an interlocutory application seeking condonation of delay in leading evidence, was filed by the plaintiff.
- (j) On 06.03.2017, the interlocutory application was allowed.
- (k) The Defendant filed an appeal against the said order before the Intellectual Property Appellate Board, which is still pending.
- (l) The Defendant filed an application for registration of the trademark which was rejected by the Assistant Registrar for Trademarks by order dated 22.03.2018.
- (m) An appeal has been filed before the Intellectual Property Appellate Board and the same is pending.
- (n) A notice was issued by the Plaintiff to the Defendant on 25.06.2018 vide which the Plaintiff objected to the use of the label as was approved by the Commissioner of State Excise.
- (o) The Defendant replied to the notice on 10.07.2018.
- (p) On 14.08.2018, the Plaintiff preferred Trademark Suit No.1/2018. An ex-parte ad-interim injunction was clamped by the Trial Court on the same day.
- (q) Several establishments are using the word "Tango" for selling liquor and hence, the Plaintiff has no reason to complain.
- (r) The Plaintiff has not taken a separate registration for the word "Tango".
- (s) Section 15 and Section 17 of the Trademarks Act, 1990 would squarely be applicable to this case.
- (t) The Plaintiff has approached the Court after 15 years.

- (u) The Plaintiff claims to be in business with their label from 2001.
- (v) There is no deceptive similarity.
- (w) No case for interim relief is made out by virtue of Section 124 of the Trademarks Act, 1990.
- (x) When the dispute with regard to the registration of the label was pending, the suit was rendered untenable.
- (y) The intention to file the suit is to create a monopoly in the society, which is unsustainable in law.
- (z) Reliance is placed upon several judgments.
- (aa) The Plaintiff has objected to the use of the word "Tango" which is not separately registered.
- (ab) The prayer clauses in the application for injunction, would amount to granting final relief at an interim stage.
- (ac) By virtue of Section 124 of the Act, the suit will have to be stayed.
- (ad) An irreparable harm, manifest inconvenience and grave hardship would be caused to the Defendant if the injunction is continued.
- (ae) The consumer is aware about his choices.
- (af) There are several dissimilarities in the labels used by both the sides and by virtue of the dissimilarities, no temporary injunction could have been granted by the Trial Court.

4 Mr.Kane, learned Advocate appearing on behalf of the plaintiff submits as under :-

- [a] The defendants claim to have placed an order for designing certain labels, with an entity Narendra Arts Printers, Ahmednagar, on 02/12/1993.
- [b] The defendants' claim that the designs were kept ready by

Narendra Arts Printers, Ahmednagar on the very next date viz. 03/12/1993.

[c] The plaintiff started using the label of “Sakhu Santra Tango” w.e.f. 01/05/1996.

[d] The plaintiff registered the trademark “Sakhu Santra Tango” on 03/11/1999 and was allotted T.M.No.884925.

[e] The plaintiff then started using the label “Sakhu Santra Tango Premium” in 2000.

[f] From 01/02/2001, the plaintiff started using the label “Tango Punch”.

[g] The plaintiff registered the trademark “Tango Punch” on 10/10/2001 and was allotted T.M.No.1051107.

[h] On 20/02/2003, the defendants filed an application to the State Excise Commissioner seeking permission to affix the labels on their bottles.

[i] On 07/04/2003, after receiving conditional permission from the State Excise Commissioner, the defendants began using the labels and which continued for a period of about 15 years.

[j] On 02/05/2005, the defendants filed an application to the Registrar of Trademarks seeking registration of the trademark “Goldspot Tango”.

[k] On 16/03/2009, the Office of the Registrar Trademarks published the official gazette mentioning the said registration.

[l] Immediately, on 30/03/2009, the plaintiff filed its objections to the application of the defendants.

[m] On 30/12/2011, the notice of hearing on the objections was received by the defendants.

[n] On 22/03/2018, the application of the defendants was rejected by the competent authority.

[o] On 25/06/2018, notice issued by the plaintiff was received by the defendants in which it was alleged that the defendants are

illegally using the registered trademark “Goldspot Tango”.

[p] The defendants replied on 10/07/2018 that they are users of the said labels prior to the plaintiff using them .

[q] After the plaintiff instituted the suit at issue i.e. Trademark Suit No.1/2018, it received a copy of the appeal in the Court and that was placed before the said Court by the plaintiff itself.

5. Having considered the submissions of the learned Advocates, I find that, at this prima facie stage, it is required to be seen as to whether any case for grant of injunction has been made out by the plaintiff and considering the comparative hardships and the balance of convenience, whether such an injunction can be granted.

6. While dealing with this petition, I have kept in mind that the main suit is pending adjudication and I am dealing with an interlocutory order which is in the form of a temporary injunction granted by the Trial Court in favour of the plaintiff. Though the learned Advocate for the respective sides have cited a long list of reported judgments, I am referring to only those which I find are relevant in this case.

7. It requires no debate that in the present matter this Court is considering the rival contentions of the two sides whose product is consumed by the lowest strata of this society. Since these two industries deal in manufacturing country liquor (*desi daru*), it would be

imperative for the Court to assess as to whether the labels used by the defendant are deceptively similar to the labels of the plaintiff and whether such labels are likely to cause deception and confusion in the mind of the consumer. So also, it needs to be seen as to who is the first user of such labels and whether the subsequent user has labels which are deceptively similar to those used by the first user.

8. In Neon Laboratories Ltd., Vs. Medical Technologies Limited and others [(2016)2 SCC 672], the Hon'ble Apex court considered a similar case wherein the trademark registered and continued on the register, was put to use after 12 years. For these many years, there being non use of the trademark, led the Hon'ble Apex Court to apply the first user tests or "first in the market" test. It was thus concluded that the proprietor of a trademark does not have the right to prevent use by another party of an identical or similar mark where that user commenced the use prior to the date of registration of the other party. It was further concluded that mere registration of a trademark does not vest permanent right with the owner of the said trademark and such a right is lost if it is not exercised within a reasonable time. It was then concluded that though the registration of the trademark by the defendant dates back to 1992, 6 years prior to the commencement of the user by the plaintiff, the latter has prima facie prove the first in the market test and therefore the plaintiff would be entitled to temporary

injunction. While considering the factors of grant of temporary injunction, it was held in Neon Laboratories (supra) that balance of convenience, irreparable loss concerning the litigating sides, should be considered, given the potential loss of goodwill and business that the plaintiff would suffer if injunction is denied. It was thus held that no interference would be warranted if interim injunction is granted. A similar view was earlier taken by this Court in the matter of Consolidated Foods Corporation Vs. Brandon and Company Private Limited. Prima facie, I am, therefore, of the view that since the defendant started using the labels said to have been designed on 03/12/1993, for the first time, from 07/04/2003, the principal of first user would lean in favour of the plaintiff.

9. While deciding the issue as to whether the label used by the defendant is deceptively similar to the label used by the plaintiff, I have carefully perused the labels placed before me. Prima facie and from the view point of the class of the consumers, I do find that a glance at the labels would indicate that the labels used by both the sides are quite similar and if the name of the manufacturer of the rival drinks were not known or were not divulged, I would feel that both these labels belong to a single company.

10. I have considered Sections 28, 29, 31, 124, 134 and 135 of the

Trademarks Act and Section 13 and 14 of the Copyright Act, which read as under :-

“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.

29. Infringement of registered trade marks —

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

Section 31 in The Trade Marks Act, 1999

31. Registration to be prima facie evidence of validity.—

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof.

(2) In all legal proceedings as aforesaid a registered trade mark shall not be held to be invalid on the ground that it was not a registrable trade

mark under section 9 except upon evidence of distinctiveness and that such evidence was not submitted to the Registrar before registration, if it is proved that the trade mark had been so used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration.

Section 124 in The Trade Marks Act, 1999

124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc.—

(1) Where in any suit for infringement of a trade mark—

(a) the defendant pleads that registration of the plaintiff's trade mark is invalid; or

(b) the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff pleads the invalidity of registration of the defendant's trade mark, the court trying the suit (hereinafter referred to as the court), shall,—

(i) if any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar or the Appellate Board, stay the suit pending the final disposal of such proceedings;

(ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is *prima facie* tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the Appellate Board for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b) (ii) of sub-section (1) within the time specified therein or within such extended time as the court may for sufficient cause allow, the trial of the suit shall stand stayed until the

final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.

134. Suit for infringement, etc., to be instituted before District Court.—

(1) No suit—

(a) for the infringement of a registered trade mark; or

(b) relating to any right in a registered trade mark; or

(c) for passing off arising out of the use by the defendant of any trade mark which is identical with or deceptively similar to the plaintiff's trade mark, whether registered or unregistered, shall be instituted in any court inferior to a District Court having jurisdiction to try the suit.

(2) For the purpose of clauses (a) and (b) of sub-section (1), a "District Court having jurisdiction" shall, notwithstanding anything contained in the Code of Civil Procedure, 1908 (5 of 1908) or any other law for the time being in force, include a District Court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceeding,

the person instituting the suit or proceeding, or, where there are more than one such persons any of them, actually and voluntarily resides or carries on business or personally works for gain.

Explanation.—For the purposes of sub-section (2), “person” includes the registered proprietor and the registered user.

Section 135 in The Trade Marks Act, 1999 -

135. Relief in suits for infringement or for passing off.—

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

(2) The order of injunction under sub-section (1) may include an ex parte injunction or any interlocutory order for any of the following matters, namely:—

(a) for discovery of documents;

(b) preserving of infringing goods, documents or other evidence which are related to the subject-matter of the suit;

(c) restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

(3) Notwithstanding anything contained in sub-section (1), the court shall not grant relief by way of damages (other than nominal damages) or on account of profits in any case—

(a) where in a suit for infringement of a trade mark, the infringement complained of is in relation to a certification trade mark or collective mark; or

(b) where in a suit for infringement the defendant satisfies the court—

(i) that at the time he commenced to use the trade mark complained of in the suit, he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was on the register or that the plaintiff was a registered user using by way of permitted use; and

(ii) that when he became aware of the existence and nature of the plaintiff's right in the trade mark, he forthwith ceased to use the trade mark in relation to goods or services in respect of which it was registered; or

(c) where in a suit for passing off, the defendant satisfies the court—

(i) that at the time he commenced to use the trade mark complained of in the suit he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was in use; and

(ii) that when he became aware of the existence and nature of the plaintiff's trade mark he forthwith ceased to use the trade mark complained of.

Section 13 in the Copyright Act, 1957

13. Works in which copyright subsists.—

(1) Subject to the provisions of this section and the other provisions of this Act, copyright shall subsist throughout India in the following classes of works, that is to say,

(a) original literary, dramatic, musical and artistic works;

(b) cinematograph films; and

(c) [sound recording].

(2) Copyright shall not subsist in any work specified in sub-section (1), other than a work to which the provisions of section 40 or section 41

apply, unless,—

(i) in the case of a published work, the work is first published in India, or where the work is first published outside India, the author is at the date of such publication, or in a case where the author was dead at that date, was at the time of his death, a citizen of India;

(ii) in the case of an unpublished work other than 2[work of architecture], the author is at the date of the making of the work a citizen of India or domiciled in India; and 2[work of architecture], the author is at the date of the making of the work a citizen of India or domiciled in India; and"

(iii) in the case of 2[work of architecture], the work is located in India. 2[work of architecture], the work is located in India." Explanation.—In the case of a work of joint authorship, the conditions conferring copyright specified in this sub-section shall be satisfied by all the authors of the work.

(3) Copyright shall not subsist—

(a) in any cinematograph film if a substantial part of the film is an infringement of the copyright in any other work;

(b) in any 1[sound recording] made in respect of a literary, dramatic or musical work, if in making the 1[sound recording], copyright in such work has been infringed. 1[sound recording] made in respect of a literary, dramatic or musical work, if in making the 1[sound recording], copyright in such work has been infringed."

(4) The copyright in a cinematograph film or a 1[sound recording] shall not affect the separate copyright in any work in respect of which or a substantial part of which, the film, or, as the case may be, the 1[sound recording] is made.

(5) In the case of 2[work of architecture], copyright shall subsist only in the artistic character and design and shall not extend to processes or methods of construction.

Section 14 in the Copyright Act, 1957

[14. Meaning of copyright.—For the purposes of this Act, “copyright” means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely:—1[14. Meaning of copyright.—For the purposes of this Act, “copyright” means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely:—

(a) in the case of a literary, dramatic or musical work, not being a computer programme,—

(i) to reproduce the work in any material form including the storing of it in any medium by electronic means;

(ii) to issue copies of the work to the public not being copies already in circulation;

(iii) to perform the work in public, or communicate it to the public;

(iv) to make any cinematograph film or sound recording in respect of the work;

(v) to make any translation of the work;

(vi) to make any adaptation of the work;

(vii) to do, in relation to a translation or an adaptation of the work, any of the acts specified in relation to the work in sub-clauses (i) to (vi);

(b) in the case of a computer programme,—

(i) to do any of the acts specified in clause (a); 2[(ii) to sell or give on commercial rental or offer for sale or for commercial rental any copy of the computer programme: 2[(ii) to sell or give on commercial rental or offer for sale or for commercial rental any copy of the computer programme:”

Provided that such commercial rental does not apply in respect of computer programmes where the programme itself is not the essential

object of the rental.]

(c) in the case of an artistic work,—

(i) to reproduce the work in any material form including depiction in three dimensions of a two dimensional work or in two dimensions of a three dimensional work;

(ii) to communicate the work to the public;

(iii) to issue copies of the work to the public not being copies already in circulation;

(iv) to include the work in any cinematograph film;

(v) to make any adaptation of the work;

(vi) to do in relation to an adaptation of the work any of the acts specified in relation to the work in sub-clauses (i) to (iv);

(d) in the case of a cinematograph film,—

(i) to make a copy of the film including a photograph of any image forming part thereof;

(ii) to sell or give on hire or offer for sale or hire, any copy of the film, regardless of whether such copy has been sold or given on hire on earlier occasions;

(iii) to communicate the film to the public;

(e) in the case of a sound recording,—

(i) to make any other sound recording embodying it;

(ii) to sell or give on hire, or offer for sale or hire, any copy of the sound recording, regardless of whether such copy has been sold or given on hire on earlier occasions;

(iii) to communicate the sound recording to the public. Explanation.— For the purposes of this section, a copy which has been sold once shall be deemed to be a copy already in circulation.]

11. It also needs to be noted that if Narendra Arts Printers prepared

the labels for the defendant on 03/12/1993 and if it is presumed that the plaintiff has copied the said labels in 1996, prima facie there is no evidence on record that the defendant had been delivered the said labels and that the said labels were leaked to the plaintiff so as to enable the plaintiff to copy the same. Moreover, in such trademarks matters, cases of copying labels and infringing trademark rights and copyrights occurs only when the subsequent user enters business and in order to capture the established business of a competitor, copies the labels of a well established product. The defendant admittedly has started using its label only from 07/04/2003 and by which time, the plaintiff was already a leading player in the Market from 1996.

12. It is settled law that the dissimilarities would not constitute a significant factor when pitted against the similarities. The class of users of the products of these litigating sides would find it extremely difficult to notice the dissimilarities. Per contra, they would easily notice the similarities and owing to such close similarities, that such a user would be deceived in believing that his choice of drink is the same one which he has purchased and which turns out to be the product of the defendant. In Laxmikant V. Patel Vs. Chetanbhai Shah [(2002) 3 SCC 65], it was concluded that it is common in trade and business for a trader or a businessman to adopt a name and/or a mark under which he would carry on his trade or business. According to KERLY (Law Of

Trademarks And Trade Names, 12th Edition, paragraph No.16 and 49), the name under which the business trade will almost always be a trademark. Independently of questions of trade or service mark, however, the name of a business will normally have attached to it a good will that the Courts would protect. An action for passing off will then lie wherever the defendant/company's name or its intended name is calculated to deceive or divert the business from the plaintiff or to cause a confusion between two businesses. If this is not established, the plaintiff would have no case. It is further laid down in *Laxmikant* (supra), that where there is a probability of confusion in the business, an injunction will be granted even though the defendants may have adopted the name innocently. A person may sell his goods or deliver his services such as in case of a profession under a particular trade name. With the passage of time, such business or services associated with a person acquired a reputation or goodwill which becomes a property which is protected by the Courts. A competitor initiating sell 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 Hon'ble Apex Court, while delivering the judgment in *Laxmikant* (supra), referred to Salmond and Heuston in Law of Torts (20th Edition), page No.395. Salmond and Heuston call this form of injury as injurious falsehood and observe the same having been awkwardly turn as passing off. The gist of the conception of passing off is that the goods are in effect

telling a falsehood about themselves, are saying something about themselves which is calculated to mislead. The Hon'ble Apex Court then referred to Oertli Vs. Bowman [1957 RPC 388 (CA)] in which the gist of passing of action was defined by stating that it was essential to the success of any claim to passing of based on the use of a given mark or a get-up that the plaintiff should be able to show that the disputed mark or get-up has become, by user in the country, distinctive of the plaintiffs' goods so that the use in relation to any goods of the kind dealt in by the plaintiff of that mark or get-up will be understood by the trade and the public in that country as meaning that the goods are the plaintiffs' goods.

13. It is universally known that such copying of labels is aimed at capitalizing the goodwill and the reputation of a leading player in the industry and the industry copying such a label would then profit on the basis of capitalizing on the goodwill and the reputation of the first user. At a prima facie stage, keeping in focus the above factors, it is a high probability that the defendant, after noticing the business built by the plaintiff, has copied the labels of the plaintiff so as to capitalize on the goodwill and reputation of the former. The sales records of the plaintiff which were available before the Trial Court as well as this Court, would indicate large volumes of sale and market share of the plaintiff. Considering the comparative sales figures coupled with the date of

registration of the labels by the rival sides, it is obvious that the Law laid down in Neon Lab (supra) would be applicable in favour of the plaintiff.

14. In a similar case to which the plaintiff is a party and the issue involved is with regard to the word “Tango”, this Court (Coram : R.M.Savant, J.) has delivered a judgment on 13/08/2007 in the matter of M/s Seven Stars Distilleries Vs. The Brihan Maharashtra Sugar Syndicate Limited (the plaintiff- the respondent herein) has concluded on the trademark label containing the words “Sakhu Santra” and “Tango” alongwith device of orange, that in so far as the issue of infringement of copyright, trademark and passing of action is concerned, the tests for deciding the question of deceptive similarities, laid down in Cadila Health Care Limited Vs. Cadila Pharmaceuticals, [AIR 2001 SC 1952], will have to be referred to. The said test relevant to the case in hand, read as under :-

[E] Trade and Merchandise Marks Act (43 of 1958), S.27 – Passing off action – Trade Mark unregistered – Deceptive similarity – Determination – Factors to be considered.

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.

15. It is thus held that the class of purchasers who are likely to buy the goods bearing the marks that they can identify on the basis of their education and intelligence and a degree of care that they are likely to exercise while purchasing or using such goods, is a significant test. Similarly, the degree of remarkableness between the marks, phonetically similar, the similarity in the nature, character and performance of the goods of the rival traders and surrounding circumstances which may be relevant to the extent of the dissimilarity between the competing marks, will have to be considered and weightage will have to be given to each of such factors. It was then concluded

that the product country liquor being consumed mostly by the lower strata of the society, that the effect of the labour on such consumers would have to be considered. The similarity in both the labels, if are sufficient to confuse an illiterate or labour class consumer, then an impression could be created in the mind of the consumer that the labels of the two parties are deceptively similar.

16. The defendant has relied upon the judgment of this Court in Narcinva Damodar Naik and others Vs. Rukma Abhijeet Sadekar [2016 citation], it was concluded by this Court that the Trial Court has to apply its mind to the case and has to notice whether the plaintiff has prima facie made out a case for grant of injunction. I find from the impugned order by which the Trial Court has granted temporary injunction to the plaintiff, that the said Court has rightly appreciated the facts and after noticing a strong prima facie case, has granted an order of injunction against the defendant.

17. In Morgan Stanley Mutual Fund Vs. Kartic Das with Arvind Gupta Vs. Securities and Exchange Board of India and others, citation it was noted that the guiding principles while granting ex-parte injunction were as follows :-

“(a) where irreparable or serious mischief will ensure to the plaintiff;

(b) whether the refusal of ex-parte injunction would involve greater

injustice than the grant of it would involve ;

(c) the Court would also consider the time at which the plaintiff first had notice of the act complained so that the making of improper order against a party in his absence is prevented ;

(d) the Court will consider whether the plaintiff had acquiesced for sometime and in such circumstances it will not grant ex-parte injunction ;

(e) the Court would expect a party applying for ex-parte injunction to show utmost good faith in making the application.

(f) even if granted, the ex-parte injunction would be for a limited period of time.

(g) General principles like prima facie case, balance of convenience and irreparable loss would also be considered by the court.”

18. In F.Hoffmann-la Roche and Company Limited Vs. Geoffrey Manner and Co.Pvt.Ltd.,AIR 1970 SC 2062], the Hon'ble Supreme Court has held in paragraph Nos.6 to 10 as under :-

“6. The first question to be considered in this appeal is whether the word "DROPOVIT" is deceptively similar to the word "PROTOVIT" and offends the provision of [s. 12 \(1\)](#) of the Act. In other words the question is whether the respondent's mark so nearly resembles the registered mark as to be "likely to deceive or cause confusion." It is not necessary that it should be intended to deceive or intended to cause' confusion. It is its probable effect on the ordinary kind of customers that one has to consider.

7. In Parker-Knoll Ltd, v. Knoll International Ltd, (1) Lord Denning explained the words "to deceive," and the phrase "to cause confusion" as follows 1:

. "Secondly, 'to deceive' is one thing. To 'Cause confusion' is another. The difference is this: When you deceive a man, you tell him a lie. You make a false representation to him and thereby cause him to believe a thing to be true. which is false. You may not do it knowingly, or intentionally, but still you do it, and so you deceive him. But you may cause confusion without telling him 'a lie at all, and without making any false representation to him. You may indeed tell him the truth, the whole truth and nothing but the truth, but still you may cause confusion in his mind, not by any fault of yours, but because he has not the knowledge or ability to. distinguish it from the other pieces of truth known to him. or because he may not even take the trouble to do so."

The tests for comparison of the two word marks were formulated by Lord Parker in Pionotist Co., Ltd.'s application(2) as follows:

"You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must' consider all the surrounding circumstances; and' you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion--that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be 'a confusion in the mind of the public which will lead 'to confusion in the goods--then you may refuse the registration, or rather you must refuse the registration 'in that

case."

It is necessary to apply both the visual and phonetic tests. [In Aristoc Ltd. v. Rysta Ltd.](#) (a) the House of Lords was considering the resemblance between the two words "Aristoc" and "Rysta". The view taken was that considering the way the words were pronounced in English, the one was likely to be mistaken for the other. Viscount Maugham cited the following passage of Lord Justice Luxmoore in the Court of Appeal, which passage, he said, he completely accepted as the correct exposition of the law :

"The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of [section 12](#) of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused; It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution. The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants".

It is also important that the marks must be compared as wholes. It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the

word in the other case there is no sufficient similarity to cause confusion. The true test 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. Thus in Layroma case(1). Lord Johnston said :

....we are not bound to scan the words as we would in a question of comparatio literarum. It is not a matter for microscopic inspection, but to be taken from the general and even casual point of view of a customer walking into a shop."

8. In order to decide whether the word "DIROPOVIT" is deceptively similar to the word "PROTOVIT" each of the two words must, therefore, be taken as a whole word. Each of the two words consists of eight letters, the last three letters are common, and in the uncommon part the first two are consonants, the next is the same vowel 'O', the next is a consonant and the fifth is again a common vowel 'O'. The combined effect is to produce an alliteration. The affidavits of the appellant indicate that the last three letters "VIT" is a well known common abbreviation used in the pharmaceutical trade to denote Vitamin preparations. In his affidavit dated January 11, 1961 Frank Murdoch, has referred to the existence on the Register of about 57 trade marks which have the common suffix "VIT" indicating that the goods are vitamin preparations. It is apparent that the terminal syllable "VIT" in the two marks is both descriptive and common to the trade. If greater regard is paid to the 'uncommon element in these two words, it is difficult to hold that one will be mistaken for or confused with the other. The letters 'D' and 'P' in "DROPOVIT" and the corresponding letters 'P' and 'T' in "PROTOVIT" cannot possibly be slurred over in pronunciation and the words are so dissimilar that there is no reasonable probability of confusion between the words either from the visual or phonetic point of view.

9. In the High Court, counsel for the respondent made a statement that the respondent was willing that the Court should direct in exercise of its powers under [s. 56\(2\)](#) that the Registrar should limit the respondent's trade mark "DROPOVIT" to medicinal and pharmaceutical preparations and substances containing principally vitamins and that the appeal should be decided on this basis. The question of deceptive similarity must therefore be decided on the basis of the class of goods to which the two trade marks apply subject to the limitation agreed to by the respondent. From the nature of the goods it is likely that most of the customers would obtain a prescription from a doctor and show it to the chemist before the purchase. In such a case, except in the event of the handwriting of the doctor being very bad or illegible the chance of confusion is remote. As we have already observed the evidence shows that there are as many as 57 trade marks in the Register of Trade Marks with the suffix "VIT". Therefore, even an average customer would know that in respect of Vitamin preparations the word "VIT" occurs in large number of trade marks and because of this he would naturally be on his guard and take special care against making a mistake. In this connection the provisions of the Drug Rules, 1945 are also relevant. Under r, 61(2) vitamin preparations would be covered by item 5 in Schedule C-(1) to the Rules and a licence would be required to stock such vitamin preparations and to sell them retail. The question of confusion must hence be determined on the basis that the goods with one of the two rival trade marks would be sold only by such 'a licensed dealer and would not be available in any other shop. The fact that the vendor would be a licensed dealer also reduces the possibility of confusion to a considerable extent.

10. Having taken into account all circumstances of the present case we are of the opinion that the High Court and the Joint Registrar of Trade Marks were right in holding that there was no real tangible danger of

confusion if respondent's trade mark was allowed to continue to remain on the Register and the application' for rectification made by the appellant should be dismissed."

19. In Hindustan Unilever Ltd., Vs.Ashique Chemicals and others [2011(5) Mh.L.J. 836], this Court has concluded in paragraph Nos.26 to 32 as under :-

"26. After referring to this judgment in Pidilite Industries Ltd. vs. S. M. Associates, 2003 (2) LJSOFT (URC) 4, I observed in paragraph 48 as under :—
"I do not read the judgment of the Appeal Court having laid down an inflexible rule that in every case where the entire mark of the Plaintiff is incorporated/finds place in the mark of the defendant, the Plaintiff is entitled to succeed in an action for infringement of a trademark." There is nothing that persuades me to take a different view even if I was entitled to do so. The question of deceptive similarity must necessarily be decided in respect of the marks in question in each case. The answer would depend upon a variety of factors, including whether the mark said to be infringed forms a dominant or significant part of the impugned mark or whether it is only an insignificant part thereof. If it is insignificant, the mere incorporation of the mark said to be infringed in the impugned mark would not deceive anybody. There are, for instance, names of places which comprise of almost a hundred letters. I cannot imagine a three letter word incorporated within such a name to deceive anybody. This may be an extreme example, but it illustrates the fallacy in the contention that as an absolute rule, the mere incorporation of the mark said to be infringed in the impugned mark constitutes infringement.

27. In the present case, however, the defendants' mark is not "Sunplus" to wit the defendants' mark does not comprise of one word. It comprises of two words viz., the word "Sun" and the word "Plus". That they are used separately is clear from the fact that only the letters "S" and "P" are in capitals. Moreover, the

words are also separated by the devise of a medical cross embedded essentially in the vertical bar of the letter "P". Even if there is no space between the letters "Sun" and "Plus" as a result of these factors a consumer will, in all probability, read it as two words. Significantly, the order of the Registrar in the opposition proceedings also considered them to be two separate words. This establishes the possibility of a person associating the mark Sunplus with the plaintiff's mark "Sun" absent anything else.

28. I do not suggest that the mere use of a word mark as an independent part of the impugned mark will ipso facto constitute infringement. It would depend on a variety of factors such as the number of words in the impugned mark, the placement of the mark said to be infringed in the impugned mark and the prominence given to the mark said to be infringed in the impugned mark. This flows from the principle that marks must be considered as a whole and not in fragments.

29. The word "Plus", however, indicates an addition to or an enhancement of a product earlier sold under the mark "Sun". The consumer would, in all probability, consider a product sold under the mark "Sun Plus" to be an improvement of the product sold by the same manufacturer under the mark "Sun".

30. The reference to the defendants' label was to indicate that there was a substantial difference between the plaintiff's packaging and the defendants' packaging in view of the added material and the entirely different get-up between the two labels. That, however, would not come to the aid of the defendant in an action for infringement.

(A) In Ruston and Hornsby Ltd. vs. Zamindara Engineering Co., 1970 2 SCR 222, the Supreme Court held that in an action for infringement, an injunction would issue as soon as it is proved that the defendant is improperly using the plaintiff's mark as such an action is a statutory right. The Supreme Court further held that in an action for infringement where the defendant's trademark is identical with the plaintiff's mark, the Court will not enquire whether the

infringement is such as is likely to deceive or cause confusion. In that case, the Supreme Court held that there was a deceptive resemblance between the word "Ruston" and the word "Rustom". The Supreme Court held that if the respondent's trademark is deceptively similar to that of the appellant, the fact that the word India is added to the respondent's trademark is of no consequence and the appellant is entitled to succeed in its action for infringement of the trademark.

(B) Dr. Tulzapurakr's reliance upon the judgment of a Division Bench of this Court in *M/s Girnar Tea., Bombay and anr. vs. Brooke Bond India Ltd., Calcutta*, 1990 PTC 245 is also well founded. The Division Bench held that if the essential features of the plaintiff's trademark had been adopted by the defendant, the fact that the get-up and other writing or marks on the goods or on the packets in which he offered his goods for sale show marked differences or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial. These aspects would be relevant in an action for passing off, if the defendant can show that the added matter is sufficient to distinguish his goods from those of the plaintiffs.

32. Despite the same, I am not inclined to grant an injunction against infringement. The plaintiff's mark was registered with effect from 19th January, 1951 as is evident from the registration certificate dated 16th August, 1954. The plaintiff has not used the mark even once since it was registered. There is nothing on record which indicates that the plaintiff intended using the mark during these 60 years. The mark has not even been used by an assignee or a licensee. In view of these facts, Mr. Safiyuddin's reliance upon the judgment of a learned single Judge of this Court in *Cluett Peabody and Co. Inc. vs. Arrow Apparel*, 1998 PTC 18 is well founded. In that case, the appellant had not used the mark for about 35 years. The learned Judge held thus :—

"27.....

(f) Object of the Act is to protect the right and not to be a source of monopoly. It is also to protect bona fide interests of traders from harassment by registered owners of a trade mark, apart from protection of public fraud, fraud by infringers of genuine trade mark.

(g) Registration enables the registered proprietor to sue for infringement of registered trade mark irrespective of the fact whether it is used or not used. Registration confers on the proprietor a monopoly right over the use of the mark. But, proprietary rights in a trade mark acquired by use are superior to rights obtained by registration under the Act. This is the main defence put up on behalf of the defendants in this Notice of Motion. Therefore, prior user of the marks should be protected against monopoly rights conferred by the Act. [Pages 5 and 6 of Narayanan]. A trade mark has no meaning even if it is registered unless it is used in relation to goods. Otherwise, its non-use may lead to its death. A trade mark which drops out of the use dies. Where there are no goods offered for sale, there is no use of trade mark.

(h)

(i)

(j) The mark can loose its distinctiveness by non-user. [Para 26 of Narayanan]. Therefore, the enforcement of the Right of exclusive use of a trade mark will depend on continuous use of the mark by the proprietor. If he fails, piracy will result and the mark will become common to the trade because there is no exclusive ownership of the symbol constituting a trade mark apart from the use of it in respect of vendible goods, particularly in context of principles governing them. Acquisition of proprietary right is different from enforcement of rights/reliefs."

.....???

The important point to be noticed is that the essential test for constituting the property in a trademark is that it should be used by the proprietor in his business or in connection with his vendible commodity. Delay by itself is no defence, but where by reason of non user for almost thirty years, the mark looses its distinctiveness or if the trade drops out of its use, or the mark is allowed to die for non user, then certainly delay in the context of the above facts provides a very strong defence for refusing injunction in favour of the plaintiffs. It is well settled that lapse of time may bring about a change in the state of things in such a manner that to grant injunction in favour of the plaintiffs would be harsh and it may cause irreparable damage or harm to the rights of the defendants.

.....

However, the owners of a trademark should not adopt a sort of rip van winkle policy of registering their mark and not putting the mark to use for thirty years because the effect of delay is on the grant of relief. Delay may effect the nature of relief granted. The Court may refuse interlocutory injunction if the mark is not used for a long period or if the mark has lost its distinctiveness in the Indian market by non user for a long period. The above observations are prima facie observations. Evidence will have to be led ultimately to prove the question of user or non user by the plaintiff. At this stage, it is repeated that the defendants have made out a strong prima facie case against grant of injunction. It is true that the defendants should have inspected the Register before putting the mark to use in 1985, but as pointed out by the learned counsel for the defendants, the goods were never in use in India and, therefore, user from 1985 by the defendants cannot be treated as dishonest. In the present case, the order passed by this Court is not based on abandonment or acquiescence on the part of the plaintiffs. This order is only based on the footing that user of the mark by the defendants from 1985 till 1997 has affected the nature of relief and it is for this reason that this Court is not inclined to grant injunction because it would totally disrupt the organized business of the defendants in India. It is true that registration of the mark confers proprietary rights even if the mark is proposed to be used and it is not actually used but if the mark is registered and it is not prima facie used for thirty years, the Court should be slow in granting injunction.

.....

31. The object of the Trade Marks Act is to protect the proprietary right of a registered trademark holder. However, if the mark is registered and not used for thirty years, depending on the facts, prima facie, it becomes a source of monopoly which is not the object of the Act. Just as the right of customers or the purchasers of the goods are required to be protected so also traders who are in business over a long period of time, cannot be harassed by threat of litigation by registered proprietors, particularly when after registration, they have not used the mark for long period. In the present case, prima facie, I am satisfied that there is no user of the mark in India, particularly when there is no evidence of

the date on which the reputation of the mark travelled into India. This again, is only my prima facie observation in the context of the nature of relief which this Court should grant depending on the facts of the present case. The entire order is based only on facts of this case.”

20. In Shelke Bevarages Pvt.Ltd., Vs. Rasiklal Manikchand Dhariwal and another [2010(4) Mh.L.J. 282], this Court has held in paragraph Nos.11, 17 to 19 as under :-

“11. We have heard the Learned Counsel at length and perused the rulings cited. In our opinion, the decision as to granting or refusing of interim injunction is taken upon on three essential questions depending upon facts and circumstances, namely,

(a) Whether the plaintiffs have made out a strong prima facie case to justify grant of interim injunction ?

(b) What would be the balance of convenience if injunction is granted as prayed for at the interim stage of suit ?

(c) Whether any irreparable damage or loss may result to plaintiffs if injunction is withheld ?

The Learned Judge is always expected to address himself on these questions while deciding a motion for interim injunction.

17. In a suit for infringement of Trade Mark, the Trial Judge has to exercise sound judicial discretion in the matter of grant or refusal of interim relief of injunction. It is well known that due to huge pendency of cases in High Court on its original side, suit reaches for hearing after a long time. Even if interim injunction is not granted, there is an option for the trial Court to award monetary compensation to the plaintiffs who may be successful at the end of trial. But interim injunction when granted may have devastating effect on the business of the defendants as the

defendants may be deprived of an opportunity to carry on their business in competition which is otherwise lawful. Interim injunction, if wrongly granted in favour of the plaintiffs, may destroy the business of the defendants irreparably, resulting in to uncompensatable disadvantage for the defendants.

18. *It is true that under the Act the registration of a Trade Mark entitles the owner thereof to the exclusive right of use of the Registered Trade Mark in respect of goods or services to be sold in market. In the present case, however, we find that there appears an agreement between the plaintiffs relating to assignment of user for consideration of Royalty payable under Royalty Agreement. No document is brought to our notice to show as to whether the Registrar under the Act was approached for approval under [Section 43](#) of the Act before creating assignment by agreement inter se between the plaintiffs relating to user of Trade Mark "MANIKCHAND OXYRICH" as also extract from the register indicating limitation, if any, geographical area of user of the Trade Mark for selling drinking water in packaged form. The remedy of injunction is available exclusively for the registered proprietor of a Trade Mark who can injunct other traders from using his Trade Mark and may claim damages for unlawful user thereof, but in the present case it must be prima facie established that defendants are actually infringing the Trade Mark exclusively owned by the plaintiffs, causing deception and confusion amongst the public and losses to the plaintiffs. Grant of injunction is judicial exercise of discretion upon prima facie proof. It can not be claimed as a matter of right (See: Shivkumar Chaddha Vs. Municipal Corporation of Delhi, (1993) 3 SCC 161). The order for interim injunction for infringement of a Trade Mark can be passed only when plaintiffs have made out a strong prima facie case in their favour to the effect that if interim injunction is not granted as prayed against defendants it would cause irreparable damage to the plaintiffs. There must be relevant prima*

facie material to support the exercise of discretion of granting interim injunction. The plaintiffs/respondents have not brought to our notice any document indicating diminishing profits in their account due to the alleged infringement and user of their Trade Mark by the defendants. Unless it is prima facie shown that the plaintiffs have suffered actual losses due to the alleged unlawful acts of the defendants using or infringing their Trade Mark, grant of interim injunction can not be justified as speculative or unproven damages can not be considered.

19. *In our opinion, no prima facie case is made out to establish that the defendants have infringed the copyright of the artistic work titled as "MANIKCHAND OXYRICH HEALTHY DRINKING WATER" by using "OXYCOOL" Trade Mark to sell mineral water/packaged drinking water in view of the distinguishing features between the Trade marks claimed by the plaintiffs and the defendants respectively. By obtaining the Trade Mark in the name as "MANIKCHAND OXYRICH" the word "OXY" can not be claimed as exclusively belonging to the plaintiffs. The word "OXY or OXYGEN" is used frequently without any reference to the plaintiffs or their product. The plaintiffs can not claim monopoly of such generic term. The Court cannot readily infer that use of word like "OXY" by a rival in the business as part of his trade name would be likely to deceive or create confusion. The defendants are entitled to claim benefit of even small variations in their Trade Mark from that of the plaintiffs' Trade Mark to plead that there would be no confusion in the mind of prospective buyers nor deception, as claimed."*

21. *In notice of motion (L) No.1142/2014 in Suit (L) No.480/2014 in which the plaintiff herein is also the plaintiff and the defendant is Yashwantrao Mohite Krishna Sahakari Sakhar Karkhana, this Court at*

the Principal Seat considered the similarity of the use of the plaintiff's trademark "Tango Punch" and the embossing on the glass bottle with the trademark "Tango" written in Devnagari was considered and injunction was granted in favour of the plaintiff thereby restraining the defendant from using the trademark "Tango" on the bottle and the label. In another Suit No.678/2014 between these parties, this Court at the Principal Seat has again dealt with the trademark "Tango" and the trademark "Santra" and decreed the suit in favour of the said plaintiff by granting the following 3 prayers :-

"(a) that the Defendant by itself, its office bearers, servants, agents, stockists, distributors and dealers, be restrained by an order an permanent injunction of the Hon'ble Court from infringing the plaintiff's registered trade mark bearing registration No.1051107 in Class 33 by using bottles embossed with the trade work "TANGO" with and/or without device of raised palm with the three fingers pointing in the upward direction or by the use of the trade mark "TANGO" or any other trade mark deceptively similar to the plaintiff's registered trade mark bearing registration No.1051107 in class 33, upon or in relation to country liquor or similar goods or in any other manner whatsoever ;

(b) that the defendant by itself, its office bearers, servants, agents, stockists, distributors and dealers, be restrained by an order and permanent injunction of the Hon'ble Court from manufacturing and/or marketing and/or bottling and/or selling and/or exhibiting for sale and/or distributing and/or keeping in possession and/or advertising and/or trading in and/or otherwise dealing in country liquor or similar goods packed in the bottles

embossed with the impugned trade mark “TANGO” with and/or without device of raised palm with the three fingers pointing in the upward direction or using any other trade mark identical with or deceptively similar to the plaintiff’s well-known trade mark TANGO so as to pass off or enable others to pass off the defendant’s goods as and for the plaintiff’s well-known goods or in any other manner whatsoever ;

(d) that the defendant be ordered and decreed to deliver up to the plaintiff for destruction the goods, bottles, labels and things bearing the impugned trade mark “TANGO” ;”

22. Similar orders have been passed in the matters involving the same plaintiff herein, at the Principal Seat in Suit No.478/2014, Suit No.463/2014, Suit No.479/2014, Suit No.448/2014, Suit No.559/2014 and many other matters involving the trademark “Tango”, “Tango Charlie”, “Tango Punch” etc.

23. Mr.Dixit, the learned Senior Advocate then contends that the word “Tango” is a generic term. In Argentina, the word “Tango” is used for Tango Dance, Tango Music, Tango Film. He contends that the plaintiff cannot have a monopoly over the word “Tango”. Mr.Kane submits that the word “Tango” is not a generic term and is not related to the taste of a product. Tango is a leading essential and a memorable feature.

24. In Reckitt and Colman of India Ltd., Vs. Wockhardt Limited in

Appeal No.1180/1991, vide judgment dated 08/07/1992, it has been concluded that the word “Tango” is not a generic term. In Hindustan Unilever Ltd. (supra), a similar case had occurred when the mark was not used for 60 years. In the instant case, though it is quite suspicious that Narendra Arts Printers prepared the label for the defendants within 24 hours, the said label, assuming to be actually prepared in 1993, was not used for more than 10 years by the defendants until 2003. At that time, the plaintiff had already started using the label “Sakhu Santra Tango” from 01/05/1996, “Sakhu Santra Tango Premium” in 2000 and “Tango Punch” from 10/10/2001. Per contra, the defendants started using the label “Goldspot Tango” in 2005 only to capitalize on the business and reputation built by the plaintiff.

25. The Senior Counsel Mr.Dixit then submits that the word “*publici juris*” is a Latin word dealing with a public right. The word “public” would mean pertaining to the people or affecting the rights of the community. He relies upon the judgment delivered by the Madras High Court in N.Ranga Rao and Sons Vs. Koya's Perfumery Works [2011 (45) PTC 140 (Mad.). The plaintiff points out from paragraph No.22 of the same judgment in N.Rangarao (supra) that the principle of *publici juris* can be invoked in this case only when a particular label can be said to be owned by the public or which is a common property so that anyone can make use of it as he likes, as in the case of light, air and water. He

relies upon paragraph No.33 to contend that the proper test where the use of the trademark by the other persons has caused to deceive the public is the use of the marker to the article. If piracy extends in volume, the genuine goods may fail to live up to the reputation of a mark, as the ultimate consumer would fail to appreciate the true position.

26. In Wyeth Holdings Corporation and Another Vs. Burnet Pharmaceuticals (Pvt.) Ltd., [2008(2) BCR 739], this Court, while dealing with the issue of exploiting the reputation and business of a competitor is concerned, it was concluded in paragraph No.20 that before the Court can accept that the words incorporated in a mark are elements which are common to the trade or business, certain essential ingredients must demonstrably be established. Before an applicant can assert the presence of a number of marks having 1 or more common features in the trade, he has to prove that these marks had acquired reputation by its user of the mark. The onus of establishing this lies on him who asserts the existence of such other marks. The relevant date for determining whether the plaintiffs have established a reputation and goodwill, is the date of the commencement of the action complained of. The relevant date for determining whether the conduct of the defendant amounts to passing off is when the conduct commenced.

27. In a case preferred by the same plaintiff in the matter of Brihan Karan Sugar Syndicate Pvt.Ltd., Vs. Lokranjan Breweries Pvt.Ltd., [2014(59) PTC 472 (Bom.)], this Court considered the essential feature mark Tango and the 3 finger device embossed on the plaintiff's glass bottles. The same plaintiff had sought registration of "Tango Punch" of which Tango is said to be an essential feature. The defendants opposed the application and contended that the plaintiff had no monopoly on the word "Tango". This Court concluded that as the use of the bottle with the embossing "Tango" and the registration of the word "Tango Charlie" began in May 2013, the defendants are estopped from contending that the word is generic. It was further concluded that even the use of the word "Punch", on its own, diverged from "Tango", could be said to take sufficient distinctiveness. Once a particular trademark is found to be distinctive, if that essential feature is used without permission, then it is an inevitable case of infringement.

28. Considering the above, I find that the Trial Court has not committed any error in delivering the impugned order granting injunction in favour of the plaintiff. The grounds for appeal formulated by the appellant/defendant do not convince this Court to conclude that the impugned order could be branded as being perverse or erroneous. The directions issued by way of injunctory orders are sound and do not call for an interference.

29. Nevertheless, it needs to be noted that the observations made by the Trial Court as well as by this Court, are based upon the material available and shall be treated as being of a prima facie nature. Since the Trial Court had injuncted the defendants by an ex-parte ad-interim order and as the order of the Trial Court dated 12/10/2018 below Exh.28 staying the effect of the impugned order dated 12/10/2018 passed below Exh.5, was continued by this Court, the same is being continued for a period of two weeks so as to enable the defendants to take effective steps for the implementation of the directions of the Trial Court set out in the impugned order.

30. The learned Advocate for the applicant prays that, since the Trial Court had stayed the impugned order on 12/10/2018 and the said status-quo was continued during hearing of this petition, the effect of this order may be stayed for a period of six weeks. Learned Advocate for the plaintiff opposes the said request.

31. I find that, since the status-quo before the Trial Court has been continued for almost five months, it would be appropriate to direct that the impugned interlocutory order passed by the Trial Court would be effective after six weeks from today.

(**RAVINDRA V. GHUGE, J.**)