

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION (L) NO.1181 OF 2019
IN
COMMERCIAL I.P.SUIT (L) NO.548 OF 2019

Royal Dryfruit Range)....Applicant

IN THE MATTER BETWEEN :

Royal Dryfruit Range)....Plaintiff

V/s.

Royal Suvidha)....Defendant

Mr.Hiren Kamod a/w Mr.Vaibhav Keni and Mr.Sumeet Rane I/by
M/s.Legasis Partners for applicant/plaintiff.

Mr.S.J.Shah a/w Mr.Shivajirao Satpute I/by Satpute and Co. for
defendant.

CORAM : K.R.SHRIRAM,J

DATE : 17.6.2019

P.C.:-

1. Though listed for ad-interim reliefs, as pleadings are completed, by consent, taken up for final lhearing.

2. Plaintiff seeks to restrain defendant by an order of injunction from infringing plaintiff's registered trade mark bearing no.2303463 in class 29 by the use of the impugned

mark/name/trading style ROYAL SUVIDHA and/or ROYAL Falooda Mix and/or any other impugned mark/name/trading style/label containing the word ROYAL and also restrain defendant from passing off defendant's product and/or business in such a way which is similar to or deceptively similar to plaintiff's registered trade mark ROYAL DRYFRUIT RANGE.

3. It is plaintiff's case that plaintiff is a registered proprietor of the trade mark ROYAL DRYFRUIT RANGE. The trade mark certificate is at Exh.A to the plaint. Plaintiff is one Mukesh Kumar Gupta who is carrying on business as sole proprietor of Royal Dryfruit Range. The trade mark at Exh.A was obtained by plaintiff's predecessor in title who has assigned the rights to plaintiff vide a deed of assignment dated 9.1.2013. Plaintiff claims that the name/mark "ROYAL DRYFRUIT"/"ROYAL DRY FRUITS" is a trusted name in the dry fruit industry and associated with plaintiff alone and nobody else. Plaintiff states that plaintiff's shop(s) in Crawford market and Bandra were inaugurated by well known politicians. It is the case of plaintiff that plaintiff's registration contained the word "ROYAL" as its leading, essential, prominent, distinguishing and distinctive feature under the Trade Marks Act in class-29. It is stated that the subject matter of the present suit is plaintiff's registered trade mark bearing no.2303463 in

class-29 for dried and cooked fruits, jams, dairy products, oils and food stuffs. The trade mark is valid and subsisting. Plaintiff has in the plaint given a statement containing plaintiff's annual turn over. For the financial year 2012-13 the sales was Rs.11,81,467/-, and for 2013-14 it was Rs.2,11,66,104/-. Plaintiff's turn over has increased by leaps and bounds and finally for the year 2017-18 it was Rs.13,43,99,525/-. Mr.Kamod for plaintiff also submitted that defendant has put up a board ROYAL SUVIDHA DRYFRUITS outside his shop but has highlighted the words ROYAL and the words SUVIDHA looks rather smudged and that itself shows the intention of defendant that he wants to pass off his business as that of plaintiff. Plaintiff carries on business inside Mahatma Jyotiba Phule market which is popularly known as Crawford market. It is the case of plaintiff that defendant whose shop is admittedly about 70 to 100 yards from plaintiff's shop is carrying on business in the name of ROYAL SUVIDHA and also selling the same goods as plaintiff and his products are sold in packets with the package containing in bold the words "ROYAL SUVIDHA". Therefore, Mr.Kamod submits defendant has breached trading mark of plaintiff and also by using a similar and/or deceptively similar mark containing the word "ROYAL" is passing off defendant's product as plaintiff's product. It is the case of plaintiff that by naming his business ROYAL SUVIDHA or ROYAL FALOODA MIX, defendant is

trying to give an impression to the general public that defendant is part of or extension of plaintiff. Plaintiff states that defendant has also wrongfully applied for registration of trade mark 'ROYAL SUVIDHA' pursuant to an application filed on 23.4.2019. Therefore, plaintiff is seeking restraining order as prayed for in the Notice of Motion.

4. The defences taken by defendant are as under :-

(a) plaintiff claims to be an assignee of the trade mark and plaintiff has not shown compliance with provisions of section 42 of the Trade Marks Act 1999 as there is nothing on record to show that plaintiff is in fact the assignee. Hence plaintiff is not entitled to file the suit as the owner of the said trade mark ;

(b) defendant has been carrying on business since 2016 and has used the name ROYAL SUVIDHA DRYFRUITS since the commencement of business ;

(c) plaintiff has no exclusive rights to use the word "ROYAL" in its trademark and defendant's trade mark does not in any way constitute any infringement of any right of plaintiff. Therefore, question of defendant's trade mark being deceptively similar to that of plaintiff does not arise ;

(d) The only thing common between two words i.e., plaintiff's mark and defendant's mark is the word 'ROYAL' and plaintiff cannot claim

exclusive rights to the word 'ROYAL' ;

(e) Defendant's shop is about 70 to 100 yards away from plaintiff's shop and number of general public acquainted with plaintiff's shop would never be confused in thinking that plaintiff's business and defendant's business are the same or defendant's goods or plaintiff's goods are the same or that defendant is connected to plaintiff ;

(f) Plaintiff's attempt is to kill all competition and therefore, plaintiff is suing all others who are using the word "ROYAL" and getting injunction order against those others ;

(g) There are close to 22 others who have registered trade mark in which the word "ROYAL" forms a part of but plaintiff has not bothered to sue any of them.

5. It is settled law that under Section 28 of the Trade Marks Act, 1999 (the said 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 in the Act. Under section 29 of the said Act, 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, a 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. A trade mark is infringed by a person who uses in the course of trade, a mark which because of its identify with the registered trade mark and the similarity of the goods or services covered by such registered trade mark ; or its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade marks or 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. In any case falling under sub-section 2 (c) of section 29 the court shall presume that it is likely to cause confusion on the part of the public.

6. Plaintiff has annexed to the plaint, copies of the assignment deed by which plaintiff has been assigned the trade mark. Section 45 of the said Act reads as under :-

“45. Registration of assignments and transmissions-
(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shalll apply

in the prescribed manner to the Registrar to register his title, and the Registrar shall, on receipt of the application, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of such assignment or transmission to be entered on the register ;

(2) The Registrar may require the application to furnish evidence or further evidence in proof of title only where there is a reasonable doubt about the varacity of any statement or any document furnished ;

(3) Where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until the rights of the parties have been determined by a competent Court and in all other cases the Registrar shall dispose of the application within the prescribed period ;

(4) Until an application under sub-section (1) has been filed, the assignment or transmission shall be ineffective against a person acquiring a conflicting interest in or under the registered trade mark without the knowledge of assignment or transmission.”

7. Therefore, where a person becomes entitled by assignment to a registered trade mark, he shall apply in the prescribed manner to the Registrar to register his title and the Registrar shall, on receipt of the application, register him as a proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of such assignment or transmission to be entered on the register. The Registrar may require the applicant to furnish evidence or further evidence in proof

of title only where there is a reasonable doubt about the veracity of any statement or any document furnished. In this case defendant has not produced any document to even suggest that there is any doubt on the veracity of statement made by plaintiff or Registrar has called upon plaintiff to furnish evidence or further evidence in proof of title. Under sub-section 3 of Section 45 the Registrar may refuse to register the assignment where the validity of an assignment or transmission is in dispute between the assignor and assignee. Once again there is nothing on record to indicate that there is any such dispute between the assignee or assignor or there are any proceedings pending in any court of law.

8. A single Judge of this Court (S.J.Vazifdar, J as he then was) in ¹***Skol Breweries Ltd. Vs. Som Distilleries & Breweries Ltd. & Anr.*** has held that nothing will preclude the Court from granting interlocutory reliefs in favour of a person who becomes entitled by assignment or transmission to a registered trade mark prior to or pending an application under Section 45 to register his title to the trade mark. Paragraph-9 of the said judgment reads as under :-

“9. The submission even if well founded would have force only up to a point. I have later in this judgment held that the court is entitled to grant even the final relief in

¹ MANU/MH/1194/2009

an action for infringement instituted by an assignee of a registered trade mark prior to or even pending an application under Section 45 to register him as the proprietor of the trade mark. I will however for the moment assume that the final relief against or in respect of infringement can be granted only to the registered proprietor of the trade mark. That however would not preclude a court from granting interlocutory reliefs in favour of a person who becomes entitled by assignment or transmission to a registered trade mark prior to or pending an application under Section 45 to register his title to the trade mark. The words “and to obtain relief” in the context of the section and the other sections which I will refer to shortly, refers to the final relief. It does not refer to interlocutory reliefs. This limitation in Section 28(1) is also subject to the discretion granted to the court, Registrar or the Appellate Board under Section 45(2) which I will now refer to.”

9. Therefore, plaintiff, in my view, can certainly maintain his action. This takes care of the 1st objection of defendant, which has to be rejected.

10. Even for a moment, I view plaintiff's case as plaintiff could not have registered the trade mark, still, indisputably plaintiff has been carrying on the business with the name 'ROYAL' since 2012 whereas admittedly defendant has started the business only in 2016. This will also come in the way of defendant using the word 'ROYAL' as plaintiff has been using it much prior to defendant starting his business and strangely within 70-100 yards of plaintiff's outlet. This

answers objection no.2 that it has to be rejected..

11. As regards defendant's submission that plaintiff cannot use the word 'ROYAL' as part of any trade mark and therefore, defendant using the word 'ROYAL' in its business, would not infringe plaintiff's trade mark or rights, this objection also has to be rejected. Admittedly defendant states that the word 'ROYAL' is common between plaintiff and defendant. In ²*Pidilite Industries Limited V/s.Jubilant Agri & Consumer Products Limited*, a learned single Judge of this Court (S.J.Kathawalla, J) has held that even where there is identity of the prominent and/or essential features, there can be a restraining order against defendant. It is plaintiff's case that prominent and essential feature of the word is 'ROYAL' ; and I agree with plaintiff. In *Pidilite* (supra) plaintiff had alleged infringement of its trade mark in which the word MARINE was prominent. Like in the case at hand in *Pidilite* (supra) also defendant had applied for registration of a mark "MARINE PLLUS" comprising of the words MARINE PLUS as its leading and essential feature. The Court held that defendant was estopped from contending that the word 'MARINE' is descriptive or has become *publici juris* or 'common to trade.'

12. Mr.Shah for defendant also made submissions similar to those made by defendants in *Pidilite* (supra). If that is the case of defendant then I fail to understand how can defendant itself apply for registration of the mark `ROYAL SUVIDHA' where the word `ROYAL' is prominent. Under Section 18 of the said Act, any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark. If according to defendant, the word `ROYAL' is generic and plaintiff cannot claim exclusivity to the word `ROYAL', certainly the same principle would apply to defendant and defendant cannot claim to be the proprietor of a trade mark used or proposed to be used by him where the word "ROYAL" is prominent.

13. Dealing with the other defences together, admittedly, defendant's business/shop is just 70 to 100 yards away from plaintiff's shop. The board put outside defendant's shop is as under :-



From this photo it is evident that the words “SUVIDHA” is written in English and Marathi above the shutters but defendant has put a board in English 'ROYAL....DRY FRUITS.....’ The prominent words are ROYAL DRYFRUITS which are part of the registered trade mark of plaintiff.

14. Plaintiff's turnover in 2017-18 is in excess of Rs.13 crores. By carrying on business less than 100 yards from plaintiff's outlet by using the word “ROYAL DRY FRUITS” prominently, I am satisfied that the attempt is to pass off defendant's business as some how connected to plaintiff. As held by this court in *Pidilite* (supra) I also come to the conclusion that defendant is infringing on the trade mark registered by

plaintiff. In any event, defendant, in my view, also by using the word 'ROYAL DRY FRUITS' prominently in his shop is attempting to pass off defendant's business as that of plaintiff.

15. Mr.Kamod stated that plaintiff has already filed 7 suits before this suit and after the Court granted ad-interim relief, defendant in those suits came forward and submitted to a decree. The list of those suits are as under :-

- 1) Commercial I.P. Suit (L) No.457 of 2019
- 2) Commercial I.P. Suit (L) No.492 of 2019
- 3) Commercial I.P. Suit (L) No.547 of 2019
- 4) Commercial I.P. Suit (L) No.564 of 2019
- 5) Commercial I.P. Suit (L) No.618 of 2019
- 6) Commercial I.P. Suit (L) No.617 of 2019
- 7) Commercial I.P. Suit (L) No.616 of 2019

16. Mr.Kamod stated that whoever is found to be infringing, plaintiff will be taking action against them. In my view, even if plaintiff does not take action, that does not give right to defendant to state that unless plaintiff takes action against whole world, he would continue to commit infringement of plaintiff's trade mark or pass off his goods as that of plaintiff.

17. In the circumstances, in my view, this Notice of Motion has to be allowed and hereby allowed in terms of prayer clauses-(a), (b) and (c) which read as under :-

“(a) That pending the hearing and final disposal of the suit, the Defendant by itself, its proprietors, partners, servants, agents and all persons acting on its behalf be restrained by a temporary order and injunction of this Hon'ble Court from infringing the Plaintiff's said registered trade mark bearing no.2303463 in class 29 by the use of the impugned mark/name/trading style ROYAL SUVIDHA and/or ROYAL Falooda Mix and/or any other impugned mark/name/trading style/label containing the word ROYAL and/or any other impugned mark/name/trading style/label identical with and/or deceptively similar to the plaintiff's said registered trade mark bearing no.2303463 in class 29 in respect of dryfruits and/or selling dryfruits and or allied goods/business or in any manner whatsoever ;

(b) That pending the hearing and final disposal of the suit, the Defendant by itself, its proprietors, partners, servants, agents and all persons acting on its behalf be restrained by a temporary order and injunction of this Hon'ble Court from using the impugned mark/name/trading style ROYAL SUVIDHA and/or ROYAL Falooda Mix and/or any other impugned mark/name/trading style/label containing the word ROYAL and/or any other impugned mark/name/trading style/label identical with and/or deceptively similar to the plaintiff's well-known trade mark/name ROYAL DRYFRUIT RANGE in respect of the business of dryfruits and or allied/cognate/complimentary goods/business so as to pass off or enable others to pass off the Defendant's impugned business and/or goods as and for the plaintiff's well known business and/or goods, or in any other manner whatsoever ;

(c) That pending the hearing and final disposal of the suit, the Court Receiver, High Court, Bombay be

appointed under Order XL Rule 1 of Civil Procedure Code, 1908 as the Receiver of all the Defendant's goods/products, boards, hoarding, labels, cutlery, uniforms, brouchers, visiting cards, pamphlets, flyers, advertising material, papers, stationery, printed matter, things, records (including electronic records), account books and such material and documents of the Defendant bearing or containing the impugned mark/name/trading style ROYAL SUVIDHA and/or ROYAL Faloods Mix and/or any other impugned mark/name/trading style/label containing the word ROYAL and/or any other impugned mark/name/trading style/label identical with and/or deceptively similar to the plaintiffs' said well-known trade mark/name ROYAL DRYFRUIT RANGE with all powers to enter in the premises of the Defendant and/or its proprietors, partners, servants, agents, at any time of the day or night without notice to the Defendant and/or their proprietors, partners, servants, agents and with the help of the police if necessary, to seize and take charge, possession and control of the aforesaid products/goods/material in possession and control of the Defendant”

18. Mr.Shah seeks stay of this order. Stay upto and including 1.7.2019 is granted.
19. Mr.Shah waives service of writ of summons.

(K.R.SHRIRAM,J)