

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

**NOTICE OF MOTION NO.2120 OF 2019
WITH
COMMERCIAL IP SUIT NO.1115 OF 2019**

Kinjal Ramesh Savla	...	Applicant/Plaintiff
Versus		
Euphoric Innovations Private Limited	...	Defendant

.....

Dr. Veerendra Tulzapukar, Senior Advocate a/w Mr. Hiren Kamod a/w Miss. Priya Pandey i/b Eternity Legal for the Applicant/Plaintiff.
Mr. Janak Dwarkadas, Senior Advocate a/w Dinyar Madon-Senior Advocate, Mr. Chirag Kamdar, Mr.Meit Sampat, Ms. Chandni Dewani, Dr. Sheetal Vohra and Mr. Shridharan i/b Little & Co. for the Defendant.

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CORAM : S.C. GUPTE, J.

DATE : 30 JANUARY 2020

(Oral Judgement)

. This Notice of Motion is taken out in a commercial IP suit claiming infringement of a registered trademark as well as breach of copyright and passing off of goods.

2 The Plaintiff's trademark, originally adopted, is "BUCKAROO". It is claimed to be an essential part of his business. He holds a

registration for the trademark. Beside the word mark “Buckaroo” and its depiction in different device marks, all of which are registered separately as trademarks, the Plaintiff also has registration for the word marks “Jackaroo” and “Vaquaroo”. It is the Plaintiff’s case that the Defendant is infringing its aforesaid registered trademarks and also passing off its goods as the goods of the Plaintiff. Considering that the Defendant holds a registration for the rival mark “WALKAROO”, Mr. Tulzapurkar, learned Senior Counsel appearing for the Plaintiff, restricts his case to the common law action of passing off.

3 The only case of Mr. Tulzapurkar, in support of his plea of passing off, is the similarity of the two marks. It is, in the first place, doubtful if a registered proprietor of a trademark, who cannot be restrained from using his registered trademark for an alleged infringement, can still be restrained from using it on the basis of the common law tort of passing off, merely on the ground of resemblance of his trademark to the other registered trademark. No doubt, as Mr. Tulzapurkar submits, there could be a case of passing off against a proprietor of a trademark, who holds registration for his mark; it may well be possible to say that the use of the mark by the defendant, having regard to the manner of representation or any other appropriate element, other than a mere phonetic or visual similarity between the two marks, is dishonest or that he is thereby trying to pass off his goods as the goods of the plaintiff. Of course, this is not to say that the plaintiff cannot at all base his action of passing off on

deceptive similarity between the two marks. The Plaintiff, for example, may make out a case of a very strong reputation and goodwill built around his mark so that the very adoption, particularly in the light of the manner or the time of such adoption, on the part of the defendant, may be termed as dishonest or as something calculated to trade on the reputation and goodwill of the plaintiff, and which makes out a serious case of confusion amongst the consuming public. The point of the matter is that *prima facie* the plaintiff must show some other element besides mere phonetic or visual similarity for seeking relief in passing off in case the defendant's offending mark is a registered trade mark. The trade mark, for sustaining a claim of passing off, must be shown to have acquired reputation among the general public; it should appear that the public associate the particular trademark with particular goods. That would primarily depend on extensive use and promotion of the mark. As the Supreme Court held in **Corn Products Refining Co. Vs. Shangrila Food Products Limited**¹, presence of a mark in the register does not by itself prove its user. Besides reputation, it must also be shown that there is a clear likelihood of deception or confusion amongst the public if the defendant is allowed to use the offending mark. At this interim stage, on the basis of the facts and materials placed before this court, it is not possible to come to any such conclusion or grant any injunctive relief. Such relief, if at all, must await a full-blown trial, where the parties may lead their respective evidence.

1 AIR 1960 Supreme Court 142

4 Besides, and in any event, at this *prima facie* stage, it is not possible to say merely by looking at the marks that the marks “Buckaroo” or “Jackaroo” or “Vaquaroo” on the other hand, and “Walkaroo”, on the other, have such phonetic or visual similarity so as to indicate, by reason of it alone, a strong possibility of deception or confusion, which might ensue and which ought to be prevented at the very interim stage.

5 The Notice of Motion is, in the premises, dismissed. The Commercial IP Suit to come up on 13 February 2020 as per CMIS.

(S.C. GUPTE, J.)

Rajesh V. Chittewan
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