

ORDER SHEET
APO/125/2021
WITH
CS/145/2021
IA NO: GA/2/2021
IN THE HIGH COURT AT CALCUTTA
CIVIL APPELLATE JURISDICTION
ORIGINAL SIDE
(Commercial Division)

AMIR BIRI FACTORY AND ORS.
VS
MR. RASHID ALI

BEFORE:

The Hon'ble JUSTICE I. P. MUKERJI
The Hon'ble JUSTICE ANIRUDDHA ROY
Date : 30TH NOVEMBER, 2021.

Appearance:
Mr. Debnath Ghosh, Adv.
Mr. Sarosij Dasgupta, Adv.
Mr. Avijit Dey, Adv.
...For the appellant

Mr. S. Sengupta, Adv.
Mr. S. Mishra, Adv.
Mr. B. Sen, Adv.
...For the respondent

The Court : This is a trademark appeal.

It arises from a judgement and order dated 27th September, 2021 made by a learned single judge which substantially modified an ex parte ad interim order made on 16th August, 2021. This modification was made on an application by the respondent/defendant.

On 16th August, 2021, an order in terms of prayer (a) of the interim application taken out by the appellant/plaintiff had been made by the learned single judge. Prayer (a) is set out below :

“a) The respondent, his men, servants, agents, assigns, dealers, distributors and/or any one claiming on his behalf be restrained from infringing the petitioners’ registered trademark “MAJDUR BIRI” by selling, manufacturing, marketing, advertising and/or otherwise dealing in any goods or services under the marks “GOLD MAZDOOR BIRI” and/or “GOLD MAZDOOR BIRI NO. 0440”, or under any other mark which is identical with or

deceptively similar to the petitioners' registered trademark "MAJDUR BIRI", in any manner whatsoever."

On 27th September, 2021, on an application to vacate the order by the respondent, this interim order was modified to the following effect :

"Since at least two of the disclaimers show that the petitioners' registration shall be restricted only to West Bengal, the order of injunction shall restrain the respondent from infringing the petitioners' mark only in the State of West Bengal.

Since it has also been shown that the words "MAJDOOR/MAJDUR BIRI" are being used by a large number of traders for the same products and that the petitioners cannot claim to have exclusive use of the descriptive matters in the packaging which would include the words "MAJDUR BIRI", the order shall be confined only to the get-up of the packaging used by the respondent incorporating the green colour and the overall colour combination and the placement of the picture and the label. The reason for continuing the injunction in respect of the get-up is that on a comparison of the two packaging which have been handed up in Court today, there is no doubt that the two packaging are virtually identical save and except the picture of the gentlemen appearing on both the packaging. It may be useful to mention that the injunction order was also passed on the Court coming to the conclusion that while the petitioners have been using the marks since 1979, the respondent has only come into the market in 2020.

The petitioners shall be at liberty of filing the affidavit-in-opposition within two weeks from date; reply within two weeks thereafter.

List this matter in the fourth week of November, 2021.

The injunction as modified by this order shall continue till further orders are passed by this Court on this application.”

The appellant is the registered proprietor of a label mark containing the words “MAJDUR BIRI”. The appellant is entitled to use this label mark within West Bengal.

There were two issues involved during consideration of these applications at the prima facie stage.

Whether by virtue of this registration, the appellant has the exclusive right to use the word mark “MAJDUR BIRI” ?

Whether the appellant could restrain the respondent from using the label mark or the word mark outside West Bengal ?

Mr. Ghosh, learned counsel appearing for the appellants submits that this interim order was substantially modified without giving his client a chance of filing an affidavit-in-opposition and without an opportunity to counsel to make substantive arguments.

This is denied by learned counsel for the respondent. He submits that the appellants had an ample opportunity to make submissions and if their learned counsel chose not to do so, they are to be blamed for it.

The net result is that an ex parte ad interim order was passed restraining the respondent from using the mark. An order was passed at the interim stage on an application to vacate that order substantially doing away with that order.

At the same time, by the impugned order dated 27th September, 2021, the learned judge directed filing of affidavits. If affidavits were invited, it is to be presumed that the Court was making findings prima facie on the available evidence in the application to set aside the interim order taken together with the evidence in the interim application. A final order would be considered when the evidence in the form of affidavits was received.

The nature of the impugned order is that of a final interim order. We are of the view that this kind of a final order ought not to have been passed at the interim stage of the application for vacation of the ex parte interim order.

For those reasons, we simply extend the initial ad interim ex parte order dated 16th August, 2021 till 22nd December, 2021.

We direct that affidavits should be exchanged in the application to vacate the interim order if not already exchanged as per the following extended directions :

Affidavit-in-opposition be filed by 6th December, 2021.

Affidavit-in-reply be filed by 10th December, 2021.

The impugned order dated 27th September, 2021 is set aside.

The learned single judge is requested to hear out the interim application to vacate the interim order on affidavits before expiry of the extended interim order, if possible, otherwise, the learned single judge may extend the interim order, if his lordship thinks fit and proper.

Mr. Ghosh, learned advocate appearing for the appellants submits that his client is not interested in proceeding with the application (GA No.2 of 2021) under Order 41 Rule 27 of the Civil Procedure Code. It is, accordingly, dismissed as not pressed.

The appeal is disposed of along with any pending application.

Learned counsel appearing for the respondent prays for stay of operation of our order. Such prayer is considered and refused.

(I. P. Mukerji, J.)

(Aniruddha Roy, J.)