

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

**APPEAL FROM ORDER NO.18 OF 2021 WITH
CIVIL APPLICATION NO.5772 OF 2021**

Jalna Hospital,
A unit under Shri Vitthal Multi-
Speciality Research Centre LLP
through its Authorised Signatory
Dr. Pradeep Prabhakar Hushe,
Age 42 years, Occ. Medical Practitioner,
R/o Old Jalna – 431 203 **...APPELLANT**

VERSUS

Jalna Critical Care and Research
Center Pvt. Ltd.
through its Director
Dr. Hitesh Kishore Bhai Raithatha
Age 54 years, Occu. Medical Practitioner
having its address at Mantha Chowfully,
Mahalaxmi Nagar, New Jalna,
Tq. and District Jalna – 431 203 **...RESPONDENT**

.....

Shri Sanjay Deshpande, Advocate holding for
Shri Shreyas S. Deshpande, Advocate for appellant
Shri A.P. Bhandari, Advocate for respondent

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CORAM : R. G. AVACHAT, J.

Date of reserving judgment : 18th August, 2021

Date of pronouncing judgment : 31st August, 2021

J U D G M E N T :

The challenge in this appeal is to the order dated
5/1/2021, passed by learned District Judge-5, Jalna, rejecting

an application (Exh.5) for temporary injunction in a Trade Mark Suit, Regular Civil Suit No.3/2019, for compensation and perpetual injunction, restraining the respondent (original defendant) from using the trade mark similar or deceptively similar to one used by the appellant (plaintiff). It is the case of the plaintiff that, Vitthal Multi Speciality Research Center is a limited liability partnership firm (LLP). It runs "JALNA HOSPITAL" at Jalna. Some of the Directors of both the appellant and the respondent earlier run their hospital. They had, however, to part ways and form separate hospitals. It was an understanding amongst them that the appellant shall be entitled to use the mark "JALNA HOSPITAL". The appellant claims to have been using the said trade mark for over five years. Based on application preferred in February 2016, the appellant has been granted certificate of registration of its trade mark – JALNA HOSPITAL in Class 44. The appellant is, therefore, entitled for exclusive user thereof. It was, however, noticed that the respondent has been running hospital - "Jalna Critical Care and Research Center". The word "Jalna" is being used by the respondent only with a view to make it appear to patients that the hospital run by it belongs to the appellant. The respondent wants to cash on the goodwill and popularity of the appellant's hospital. It, therefore, issued respondent

cease and desist notice. The respondent responded it with a false reply. The appellant, therefore, filed the suit for perpetual injunction and compensation and moved therein an application for temporary injunction. After hearing the parties, the learned Judge refused to grant the relief. Hence the appeal.

2. The learned trial Court observed to have found substance in the submissions advanced on behalf of the defendant. It found the logo and design of the trade mark of the defendant to be totally different and similarity of name of a town 'Jalna', being geographical name, can hardly be a monopoly of an individual or an institution. It further observed that, when there were several hospital with the word 'Jalna' in their name and the plaintiff did not bring any law suit against them, the plaintiff would not suffer any irreparable loss.

3. Learned Advocate for the appellant would submit that the trial Court failed to appreciate that the plaintiff is the registered proprietor of the trade mark in Class-44, and the defendant's use thereof upon and in relation to identical services amounts to infringement of the plaintiff's registered

trade mark. Refusing to grant the relief of injunction, in the facts and circumstances of the case, is contrary to mandate of Section 29(1) of the Trade Marks Act. According to him, Statute mandates a presumption of likelihood of confusion and hence, relief of injunction should have necessarily followed. The standard of comparison to be adopted in judging the resemblance is from the point of view of a man of average intelligence and imperfect recollection.

4. According to learned Advocate, as long as distinctive character as a result of use of trade mark is shown, marks of geographic origin can be registered. There is, as such, no absolute bar in registering mark having geographical origin. The trial Court ought to have considered that, when the plaintiff has a registered trade mark, it is a case of breach of statutory duty on the part of the defendant. It is a set practice of this Court to issue temporary injunction in favour of a person having registered trade mark. There was nothing ex facie illegal, fraudulent or such as of shock the conscience of the Court for it to refuse to grant interim injunction. The defendant has neither resorted to provisions of Section 124 of the Trade Marks Act to challenge the validity of registration of the plaintiff's trade mark nor has filed for rectification. In

absence of such proceedings, the trial Court should have applied statutory presumption in favour of the plaintiff. When the defendant itself applied for registration of trade mark with the word 'Jalna', it could not be heard to say that, it being a geographical name and, therefore, could not be used. According to learned Advocate, the defendant is riding two horses at a time. The Trade Marks registry has raised an objection to register the defendant's trade mark in Class-44. Once the trade mark is registered, in infringement suits, only question the Court can go into is as to whether there is similarity/ deceptive similarity between rival marks. The Civil Courts cannot go into validity of registration of trade mark at the interlocutory stage. The heavy burden lies on the defendant to rebut the strong presumption in favour of the plaintiff.

5. In case of **Midas Hygiene Industries P. Ltd. & ors. Vs. Sudhir Bhatia & ors. [2004(28) PTC 121 (SC)]**, the Apex Court observed that, in cases of infringement of either of trade mark or copyright, normally, an injunction must follow. According to learned counsel, the impugned order is unsustainable in law and facts as well. It, therefore, deserves to be set aside.

6. The learned counsel relied on the following authorities :

- (1) Hi-Tech Pipes Ltd.. Vs. Asian Mills Pvt. Ltd.,
[2006(32) PTC 192 (Del.)
- (2) Shankar Seeds Corporation Vs. Dharti Seeds
[2017 (71) PTC 77 (Guj).
- (3) Patel Field Marshal Agencies & ors. Vs.
P.M. Diesels Ltd. & ors. [AIR 2017 SC 5619]
- (4) Greepee Ceval Proteins and Investment Pvt. Ltd. Vs.
Saroj Oil Industry [2003 (27) PTC 190 (Del.)
- (5) Midas Hygiene Industries P. Ltd. & ors. Vs.
Sudhir Bhatia & ors. [2004(28) PTC 121 (SC)]
- (6) Lupin Vs. Johnson and Johnson [AIR 2015 Bom. 50]

7. Learned counsel for the defendant would, on the other hand, submit that, the trial Court has, on appreciation of the material before it, refused to grant discretionary relief. The Court of appeal should be slow in interfering with the orders passed with due exercise of a discretionary jurisdiction. He would further submit that, the plaintiff has not placed on record any material to show that, pursuant to the understanding arrived at between the Directors of the plaintiff and defendant, who were jointly running the hospital in the past, that with an understanding the plaintiff was assigned the right to use the trade mark "JALNA HOSPITAL". He would

further submit that, 'Jalna' is a name of city and as such, is a geographical name, unless special characteristic and features are made out, there cannot be one exclusive trade mark in the name of city. The word 'Jalna' is also used by many hospitals operating at Jalna itself. According to him, except similarity in the word 'Jalna', in both the marks and device, rest are dissimilar from each other. The trial Court has rightly observed accordingly. The learned counsel would support the impugned order. He would submit that, the trial Court may be directed to expedite the hearing of the suit. He relied on the following authorities :

- (1) Amritdhara Pharmacy Vs. Satyadeo Gupta
(Civil Appeal No.22 of 1960 Decided on 27/4/1962)
- (2) Wander Limited Vs. Antox India Pvt. Ltd.
[1990 STPL 2452 SC)
- (3) Surat Goods Transport P. Ltd. & ors. Vs.
Total Logistics India pvt. Ltd. & ors.
[2011 STPL 17585 Bombay]
- (4) Mrs. Sharmilee Kapur & ors. Vs. Mr. Kiran Bharekar
(Appeal from Order No.1092 of 2019 -
Decided on 9/3/2021)
- (5) Peps Industries Pvt. Ltd. Vs. Kurlon Limited
[CS (COMM) 174/2019 – Delhi High Court)
(Decided on 16/3/2020)

8. Before advertng to the factual matrix, it would be apposite to have a glance at the relevant legal position in this

regard. Section 2(h) of the Trade Marks Act , 1999 (for short TM Act) defines the term “deceptively similar” as under :-

“(h) “deceptively similar” :- A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion.”

9. Clause (m) and (zb) of the very Section defines the terms “Mark” and “trade mark” respectively as under :

“(m) “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.”

“(zb) “trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and

- (i) in relation to Chapter XII (other than Section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and
- (ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purposes of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some

person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark.”

10. Section 28 speaks of right conferred by registration. The Section reads :-

“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.”

11. Section 29 speaks of infringement of registered trade mark. It reads thus :-

“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.”

12. In view of Section 31 of the said Act, registration is prima facie evidence of validity in all proceedings relating to a trade mark, registered under the said Act.

13. In case of Midas Hygiene Industries P. Ltd. (supra), it has been observed that, in cases of infringement of either of trade mark or copy rights, normally an injunction must follow.

In case of Patel Field Marshal Agencies & ors. (supra) it has been held that, registration of a trade mark vests in the registered owner and exclusive right to use the mark in relation to the goods, in respect of which the mark has been registered.

While in case of Amritdhara Pharmacy (supra), it was held that, the question whether a trade name is likely to deceive or cause confusion by its resemblance to another already registered is a matter of first impression and one for decision in each case and has to be decided by taking an over all view of all the circumstances – The standard or comparison to be adopted in judging the resemblance is from the point of

view of a man of average intelligence and imperfect recollection – It was held further that the two names as a whole should be considered for comparison and not merely the component words thereof separately.

14. The plaintiff is a proprietor of a registered trade mark - "JALNA HOSPITAL". The plaintiff has been granted registration certificate of its trade mark on 2/2/2017. The plaintiff claims to have been using the said trade mark for little over five years. It is his case that, in the past, some of the Directors of the defendant and the plaintiff would run a hospital jointly. The group split up. An understanding was arrived at between the two groups, authorising the plaintiff to use the mark "JALNA HOSPITAL". Although the plaintiff has based its claim inter alia on the said understanding, it did not produce on record before the trial Court or here as well any material to reinforce its claim. It is the plaintiff which has come to the Court and, therefore, is under obligation to discharge its initial burden so as to shift the onus onto the defendant.

15. The relief of injunction being an equitable relief, the plaintiff is supposed to make out a prima facie case in its favour. He is also required to show that the balance of

convenience tilts in its favour and if the injunction is refused, it will be the plaintiff to suffer irreparable loss. If it is found that the trial Court, on appreciating the material before it has rightly exercised its discretion either way, the appellate Court shall be slow in interfering therewith.

True, the plaintiff being the proprietor of a registered trade mark, has an exclusive right to use the same. The plaintiff's trade mark has been registered in Class 44 i.e. medical services, veterinary services, hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services. The defendant is a proprietor of registered trade mark - "Jalna Critical Care and Research Centre Pvt. Ltd.", in Class 35. Pending the suit, the defendant has been granted the said registration pursuant to the application in that regard, which precedes the filing of the suit. Since both the plaintiff and the defendant have been proprietors of their respective registered trade marks, granted for different class, both of them are entitled to make exclusive use thereof in their respective spheres. The plaintiff appears to have not raised any objection for registration of the defendant's trade mark. True, the defendant cannot make use of the plaintiff's trade mark or which is similar or deceptively similar to that of the plaintiff's for its medical

services/ health services. The question is, whether the trade mark of the defendant is deceptively similar to that of the plaintiff. The only common factor between the two trade marks is use of the word 'Jalna'. Jalna is a geographical name. True, if it is shown that if a geographical name has acquired secondary significance and has distinctiveness in respect of the services rendered by the plaintiff by such name, then merely because a trade name is geographical descriptive, it does not imply that an action for infringement or for passing off cannot be maintained provided the plaintiff is able to establish the requisite grounds of deceit by use of similar name (Hi-Tech Pipes Ltd. - supra). There is prima facie nothing to indicate the plaintiff has acquired any significance by the use of the word 'Jalna'. Admittedly, there are not less than five hospitals using the word - 'Jalna' in their names operating at a small district place - Jalna. The approach of the plaintiff appears to be selective since there are following five hospitals operating at Jalna for long :-

- (1) Jalna Diagnostic Centre
- (2) Jalna Kidney Care
- (3) Civil Hospital, Jalna
- (4) Jalna Mission Hospital
- (5) Jalna Hospital and Critical Care Centre

The plaintiff could not be heard to say that it is its choice to decide against whom it shall proceed. No doubt it may have its choice, but if it is found to be selective and vindictive as well, it must suffer for that. At first instance, I do not find similarity or deceptive similarity in both the competing trade marks. Moreover, the plaintiff's inaction in not pursuing its remedy against the other hospitals named above does indicate that it will not suffer irreparable loss if the relief of injunction is not granted in its favour. The trial Court has rightly been justified in refusing to grant the interim relief. I am at one with the conclusion arrived at by the trial Court. No interference with the impugned order is, therefore, called for. In the result, the appeal fails. The same is dismissed.

16. In view of disposal of the Appeal, Civil Application stands disposed of.

(R. G. AVACHAT)
JUDGE

fmp/-