

Shephali

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
INTERIM APPLICATION (L) NO. 19162 OF 2021
IN
COMMERCIAL IP SUIT (L) NO. 19160 OF 2021
WITH
LEAVE PETITION NO. 289 OF 2021
IN
COMMERCIAL IP SUIT (L) NO. 19160 OF 2021**

Pidilite Industrial Ltd ...Plaintiff
Versus
Saathi Adhesives Pvt Ltd & Ors ...Defendants

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**Mr Hiren Kamod, with Nishad Nadkarni, Aasif Navodia &
Khushboo Jhunjhunwala, i/b M/s. Khaitan & Co, for the
Plaintiff.
None for the Defendants.**

**CORAM: G.S. PATEL, J
DATED: 22nd September 2021**

PC:-

1. The Defendants have been served and also given notice of today's listing. There is an Affidavit of Service. It is taken on record.

2. The Defendants are absent despite service. Defendants Nos. 3 and 4 have received papers and have replied saying that they are no longer partners of Defendant No. 2 or concerned with it. It is, however, not known from their response letter whether these Defendants are directors of Defendant No. 1.

3. In view of the service effected, the Petition for leave under Clause XIV of Letters Patent is made absolute.

4. The Suit is an action in trade mark infringement and passing off.

5. The Plaintiff is Pidilite. It is a well-known manufacturer of adhesives and allied products sold under the various marks, including such well-known ones as **FEVICOL**, **FEVI KWIK**, **M-SEAL**, **DR. FIXIT**, **FEVISTIK** etc. The present Suit is in relation to some of these marks and a device used by the Plaintiff of two elephants pulling in opposite directions of a globe-like object, intended to convey the strength of the adhesive qualities of the Plaintiff's product.

6. The Suit alleges infringement of the following marks: (i) **FEVICOL**; (ii) **SH**; (iii) **MARINE**; and (iv) **D3**.

7. The Plaintiff has registrations of all four marks. The dates of user are stated along with details of registration in the Plaint. There is a material annexed to prima facie indicate the length of user, the volume of sales, the quantum of expenses, promotional material

and other matter that indicates the Plaintiff's reputation and goodwill in each of these three marks.

8. In November 2019, the Plaintiff came upon a range of adhesive products being sold by the Defendants under the marks **SAATHICOL, SSH, MARINE, D3 and D3-GOLD**.

9. So far as **SAATHICOL** is concerned, the Defendants have obtained registration of a label which features the word. There does not appear to be a separate registration of the word mark. While the Plaintiff may challenge Defendants' registration and seek rectification, the Plaintiff at present seeks an order of injunction in the cause of action in passing off in regard to **SAATHICOL**. The usual three factors that are to be considered when granting relief in passing off are all present today. In 1978-79, Diplock LJ set out five guidelines for passing off actions in *Erven Warnink v Townend & Sons Ltd*.¹ Oliver LJ in *Reckitt & Colman Products Ltd v Borden Inc.*² distilled these into the three probanda in the tortious actions in passing off that we now know as the 'Classic Trinity': (i) goodwill owned by a claimant; (ii) misrepresentation; and (iii) damage to that goodwill. The Classic Trinity places on a plaintiff the burden of proving goodwill in its goods or services, trade dress, brand, mark or even the thing itself. A plaintiff must also show false representation (it matters not that this is unintended) to the public that leads it to believe that the goods or services of the defendant are those of the plaintiff. Fraud is not a necessary element.³ The test of deception or

1 [1979] AC 731, 742 (HL). This is the famous 'Advocaat' case.

2 [1990] 1 All ER 873

3 *Laxmikant V Patel v Chetanbhai Shah & Anr*, AIR 2002 SC 275.

its likelihood is that of the common person. Here again, the similarity tests used in infringement actions have a role to play: a court will look to the aural, visual and conceptual similarity. A plaintiff need not prove actual or special damage; a reasonably foreseeable probability is sufficient.

10. Given the Plaintiff's reputation, goodwill, volume of sales, there seems to me a sufficient case made out that the attempt of the Defendants is nothing but calculated to deceive and is an attempt to pass off its products as emanating from the Plaintiff. There is no reason why the Defendants should have chosen a mark that so closely resembles to the Plaintiff on every metric.

11. I may be anticipating a possible defence but it is best done now. The law is not that a suit against a registered proprietor will not lie or is not maintainable. That aspect of the law has been firmly settled including by several binding decision of this Court. The question is whether one registered proprietor can obtain an order of injunction on the cause of infringement against another registered proprietor, and the statute clearly says that it cannot. But the law is equally settled that the relief in passing off, being a common law remedy, is always available even against the registered proprietor. I am, therefore, treating the case of the Plaintiff against **SAATHICOL** on a different footing than its case in respect of the other marks.

12. The Defendants do not have registration of the other marks. **SSH** is undoubtedly phonetically, structurally and visually similar to

the Plaintiffs registered mark **SH**. Between the Defendants' mark **MARINE** and the Plaintiff's mark **MARINE** used in relation to adhesives, there is no distinction at all. There is no purpose served by now saying that the Plaintiff's mark **MARINE** is descriptive. It has registration and has not been removed from the register. As far as **D3** is concerned, like **MARINE**, the mark is identical to that registered to the Plaintiff, and **D3-GOLD** has only a minor variant that will not lend sufficient distinctiveness.

13. There is a question of delay. The Plaintiff has been candid about this. Nothing seems to have been hidden from the Plaintiff. The Covid-19 outbreak, the pandemic and the lockdown prevented the Plaintiff from moving with any greater despatch. In any case, mere delay on its own cannot, unless there is a case made out in acquiescence, operate to defeat the rights of a registered proprietor. But the Plaintiff had on 29th November 2019 sent a cease and desist notice to the Defendants both in hard copy and by email. To this there was no reply. The lack of a reply of the Defendants lulled the Plaintiff into believing that the Defendants were not going to continue with the infringement or passing off having been put to notice of the Plaintiff's claim.

14. I believe there is a sufficient prima facie case. The balance of convenience is with the Plaintiff and I have no doubt that irretrievable prejudice will be caused to the Plaintiff if the reliefs are not granted.

15. There will, therefore, be an order in terms of prayer clauses (a) to (d) and (f), which read thus:

(a) Pending the hearing and final disposal of the Suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions or acting in concert with them be restrained by an order and injunction of this Hon'ble Court from manufacturing, marketing, selling, advertising, offering to sell or dealing in the Impugned Products or adhesives or any similar goods or any other goods bearing the impugned marks SSH or SH or MARINE or D3 or D3-Gold or SAATHICOL, with or without any mark, or any other mark identical with or similar to or in any manner comprising of the SH Registered Marks, MARINE Registered Marks, D3 Registered Marks and FEVICOL Registered Marks or any essential features thereof;

(b) Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions or acting in concert with them be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the SH Registered Marks of the Plaintiff bearing nos. 849884, 437301, 1109869, 311982, 2437823, 2437824, 2437825 and 2437826 in any manner and from using in relation to impugned products or any other goods for which the SH Registered Marks are registered or any goods similar thereto, the impugned marks SSH or SH, with or without any mark, or SAATHICOL SSH or any other mark which is identical with or similar to the SH Registered Marks of the Plaintiff and from manufacturing, selling, offering for sale,

advertising or dealing in such goods or any other goods bearing the impugned marks SSH or SH, with or without any mark, or SAATHICOL SSH or any marks similar to the SH Registered Marks;

(c) Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions or acting in concert with them be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the MARINE Registered Marks of the Plaintiff bearings nos. 1972339, 1918007, 1319822, 1319821, 1319823, 2425737 and 2110954 in any manner and from using in relation to impugned products or any other goods from which the MARINE Registered Marks are registered or any goods similar thereto, the impugned MARINE, with or without any mark, or SAATHICOL MARINE or any other mark which is identical with or similar to the MARINE Registered Marks of the Plaintiff and from manufacturing, selling, offering for sale, advertising or dealing in such goods or any other goods bearing the impugned marks MARINE, with or without any mark, or SAATHICOL MARINE or any marks similar to the MARINE Registered Marks;

(d) Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions or acting in concert with them be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the D3 Registered Marks of the Plaintiff bearing nos. 2828770, 2828771, 2720902 and 3483889 in any manner and from using in relation to impugned products or

any other goods for with the D3 Registered Marks are registered or any goods similar thereto, the impugned marks D3 or D3-GOLD, with or without any mark, or SAATHICOL D3 or any other mark which is identical with or similar to the D3 Registered Marks of the Plaintiff and from manufacturing, selling, offering for sale, advertising or dealing in such goods or any other goods bearing the impugned marks D3 or D3-GOLD, with or without any mark or SAATHICOL D3 or any marks similar to the D3 Registered Marks;

(f) Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions or acting in concert with them be restrained by an order and injunction of this Hon'ble Court from committing the tort of passing off in any manner and from manufacturing, marketing, selling, advertising, offering to sell or dealing in the Impugned Products or any similar goods or any other goods bearing the impugned marks SSH or SH or MARINE or D3 or D3-Gold or SAATHICOL, with or without any mark or any other mark identical with or similar to or comprising of the SH Registered Marks, MARINE Registered Marks. D3 Registered Marks and FEVICOL Registered Marks or any essential features thereof."

16. I will consider the remaining prayers including for a receiver at a later stage. The only reason is that the Defendants have not yet filed a Reply and Mr Kamod's application is only for ad-interim relief. The Defendants will be served with a copy of this order within one week from today.

17. Affidavits in Reply will be filed and served on or before 8th October 2021. Affidavit in Rejoinder, if any, to be filed and served on or before 20th October 2021.
18. List the Interim Application for hearing and final disposal on 27th October 2021.
19. This order will continue until 28th October 2021 or until a further order of the Court, whichever is later.
20. All concerned will act on production of a digitally signed copy of this order.

(G. S. PATEL, J)