

IN THE HIGH COURT OF JUDICATURE AT BOMBAY  
NAGPUR BENCH, NAGPUR.

**FIRST APPEAL NO. 598 OF 2019**  
**IN TRADEMARK SUIT NO. 2 OF 2014**

M/s. Orange City Mobile Collection,  
17, Gandhi Grain Market, Opposite Axis Bank,  
Chaproo Nagar Square, Central Avenue Road,  
Near Dena Bank, Nagpur, through its Partners.



...APPELLANT  
ORI. DEFENDANT NO.1

**Versus**

1. M/s. City Collection, a duly registered partnership firm, Shop No.2, Neelkamal Complex, Mahajan Market, Sitabuldi, Nagpur – 440012, through its Partners.
2. Javed Sharif s/o Abdul Lateef Sharif, aged about 43 years, Occ. Business.
3. Mohammad Yasin Maka s/o Haji Dilawara Maka, aged about 37 years, Occ. Business, Both R/o City Collection, Shop No.2, Neelkamal Complex, Mahajan Market, Sitabuldi, Nagpur – 440012.



...ORIGINAL PLAINTIFFS

4. Vikram Mohanlal Chug,  
C/o M/s. Orange city mobile collection,  
Opp. Axis Bank, Chaproo Nagar Square,  
Central Avenue Road, Near Dena Bank, Nagpur.

...ORIGINAL DEFENDANT NO.2  
...RESPONDENTS.

Shri R.L. Khapre, Senior Advocate assisted by Shri A.P. Thakre, Advocate for the appellant.  
S/Shri D.V. Chauhan, Chaitnaya J. Dhruv and Aditya D. Chaudhari, Advocates for the respondents.

CORAM : PUSHPA V. GANEDIWALA, J.  
ARGUMENTS WERE HEARD ON : AUGUST 31, 2021.  
JUDGMENT IS PRONOUNCED ON : OCTOBER 13, 2021.

**JUDGMENT :**

Heard finally with the consent of learned counsel  
for both the parties.

2.           **Admit.** Shri D.V. Chauhan, learned counsel, waives  
service of notice for the respondents.

3.           This is the defendants' Appeal against the judgment  
and decree dated 24/04/2018 passed by the District Judge-6,  
Nagpur in Trademark Suit No.2/2014, whereby the defendants,  
i.e., the appellant and respondent No.4 herein and their  
servants etc., have been perpetually restrained from rendering  
any service by marketing or by any other mode or manner  
dealing in or using the plaintiffs', i.e., respondent Nos.1 to 3  
herein, trade name 'City Collection' and/ or trademark and logo/  
label or any part of it in relation to the impugned business of the  
defendants in question, and from doing any other acts or deeds  
amounting to or likely to infringe the aforesaid trademark and

logo/ label as word mark or in label form, and also by passing off any violation of the plaintiffs' trade name or trademark. The defendants' are further perpetually restrained from infringing the plaintiffs' copyright in its logo. They are further directed to desist from using the sign board containing words 'City Collection' or any part thereof, in any manner whatsoever. They are further perpetually restrained from applying for registration of trademark and copyright identical to plaintiffs' trademark 'City Collection' or using any part of it in any manner whatsoever. That the defendants were also directed to pay punitive damages of Rs.2,00,000/- to the plaintiffs within a period of two months from the date of passing of the judgment.

For the sake of convenience, the parties are referred to as per their original status before the trial Court.

The facts leading to the filing of the present Appeal may be stated as under :

i. Plaintiff No.1 is a registered partnership firm and plaintiff Nos. 2 and 3 are its partners. It is stated that initially, plaintiff No.2 Javed was doing the business of selling of mobile phones and allied items under the name and style as 'City Collection' since 2001-02 as a proprietary concern. Later on, the proprietorship came to be converted into partnership. Plaintiff No.3 Mohd. Yasin Maka was added as a partner for the purpose of carrying on business of selling of mobile phones, cameras, etc. under the name and style as 'City Collection'.

ii. The plaintiffs claimed that their trademark 'City Collection' have an artistic design, style, layout and distinctive features. It is the case of the plaintiffs that the trademark 'City Collection' has been duly registered under the Copyright Act, 1957 ("**the Copyright Act**") bearing registration No. A-101585/2013.

iii. With regard to registration of trademark, it is stated that the plaintiffs have already applied for registration of trademark 'City Collection' under the Copyright Act vide application dated 28/12/2011, and that process for registration

is underway.

iv. It is further stated that the plaintiffs have recently came across the fact that the defendants have brought into market and using the service mark in mobile distribution and sale services which are not of plaintiffs' origin but are deceptively similar with the plaintiffs' above said design. The defendants are carrying out their business under the name and style as 'Orange City Mobile Collection' and they have placed the signboard on their shop under the said name. A mere look at the board will be sufficient enough to convince anybody that the defendants have copied the aforesaid trade name and/ or trademark logo of the plaintiffs' design with distinctive feature inasmuch as the same is deceptively similar to the trade name and/ or trademark of the plaintiffs' 'City Collection'. This has been deliberately done by the defendants with a view to cause confusion amongst the public at large and practice deception in the course of its trade and passing off its service as those of the plaintiffs. It is further stated that the plaintiffs have not entered into any agreement with any person/ party/ company etc.

including the defendants thereby conferring any right on them to conduct any business in Nagpur or elsewhere using the said trade name and/ or trademark etc., and therefore, nobody, except the plaintiffs, is entitled to conduct any business in Nagpur or elsewhere using its said trade name and/ or trademark.

v. It is further alleged that a feeble attempt made by the defendants to distinguish its label from that of the trade name/ trademark of the plaintiffs by inserting word 'Orange' before the word 'City' and word 'Mobile' in between the words 'City' and 'Collection'. This clearly pin-points the guilt of the defendants which is indicative of the fact that the defendants are making a feeble attempt to escape from the legal consequences of its guilt. The arrangement of the various designs, wordings and placing of logo clearly exposes the defendants as a flagrant imitator and a dishonest trader who is making illegal gains by committing breach of copyrights and trademark of the plaintiffs, thereby causing irreparable legal injury not only to the plaintiffs but also to the business, trade, reputation and goodwill of the plaintiffs.

vi. By way of an amendment, the plaintiffs added pleading with regard to the subsequent events. The plaintiffs state that in the first week of November-2015, they were served with the certificate of registration of trademark, issued by the Registrar of Trademark, under Section 23(2) Rule 62(1) of the Trade Marks Act, 1999 (**“the Act of 1999”**). The certificate of registration of trademark was issued to them on 10/09/2015 under class-35 of Schedule - IV with effect from 28/12/2011. The plaintiffs further state that the impugned adaptation and use by the defendants of the deceptively similar mark is nothing but infringement of registered trademark of the plaintiffs, as the same is done illegally and without the consent of the plaintiffs, and is done merely to take advantage of the reputation and goodwill of the plaintiffs, and to cause wrongful loss to the plaintiffs and wrongful gain to the defendants.

vii. The plaintiffs, upon receiving knowledge about the illegal trade practices commenced by the defendants, caused a legal notice dated 03/03/2014 served upon the defendants through its partner. The said notice was duly received by the

defendants. The defendants, instead of complying with the said notice, had sent a reply dated 15/03/2014, from which the malafide intention of the defendants are quite clear. The plaintiffs, having left with no other alternative, was constrained to approach the Court for redressal of their grievance. The plaintiffs filed suit for permanent injunction and claimed for damages and passing off action.

viii. Along with the plaint, the plaintiffs have also filed an application for temporary injunction under Order 39 Rules 1 and 2 of the Code of Civil Procedure, 1908 (“**CPC**”) below Exh.5. to which the defendants filed their reply below Exh.12. The trial Court found *prima-facie* case and balance of convenience in favour of the plaintiffs, and allowed the application vide order dated 12/06/2014, thereby restrained the defendants and their partners, agents etc. from using the trademark or trade name ‘City Collection’ of the plaintiffs in any manner whatsoever for its business purpose or otherwise, pending disposal of the suit. This order, below Exh.5, is challenged before this Court under Order 43 Rule 1(r) of the CPC in Appeal against Order No. 81/2014. This Court, vide

judgment and order dated 28/02/2018, quashed and set-aside the order passed by the trial Court below Exh.5, and without prejudice the rights of the parties in the suit, directed the defendants to increase the size of the fonts of the words 'Orange' and 'Mobile' in its logo so as to make their entire trademark 'Orange City Mobile Collection' conspicuously visible. It is further directed that necessary changes in that regard be carried out within a period of four weeks from the date of order. Accordingly, the defendants complied with the order of this Court, if not within the stipulated time but shortly thereafter.

It is worthwhile to mention here that the aforesaid directions came to be given in the light of the statement made by the defendants across the bar that they were willing to increase fonts of the words 'Orange' and 'Mobile' in their logo to make the entire trade name conspicuously visible.

ix. This Court, while rejecting the application of the plaintiffs for interim relief, observed that the plaintiffs had failed to place on record any *prima-facie* material to indicate

that due to the alleged use of deceptively similar trade name by the defendants, they had suffered some loss of clientele or their turnover is reduced. There is not a single instance, either pleaded or placed on record, of a customer being misled or deceived on account of the use of deceptively similar trade name by the defendants. It is further observed that some material in that regard is necessary in the facts of the present case for the purpose of making out a *prima-facie* case as one of the ingredients while seeking interim injunction and *prima-facie* material in that regard appears to be lacking on record.

x. The defendants filed their written statement below Exh.16. The defendants resisted the suit in toto, however, admitted that the defendants' firm is carrying on its business under the name and style 'Orange City Mobile Collection', and have displayed the sign board on their shop under the said name.

xi. The defendants state that they are doing their independent business since 11/02/2014 for which they have obtained shop and establishment license and have completed

other necessary formalities for that purpose. The defendants state that they have also applied for trademark vide application dated 12/03/2014 bearing C.N. No. 2725774 with the Registrar of Trademark, and registration process is under way. The defendants state that they are carrying on their business of selling of mobile phones in a rented premises having its address at Gandhi Grain Market, Opp. Axis Bank, Chaproo Nagar Square, Central Avenue Road, Near Dena Bank, Nagpur, which is 12 kilometers away from the alleged place of business of the plaintiffs.

xii. It is the case of the defendants that there are umpteen number of traders who are using the common words 'City' and 'Collection' for selling and identifying their products. That 'City' and 'Collection' are common terms, and hence, there cannot be monopoly of anybody. The defendants state that bare perusal of arrangement of panels, designs, wordings, logo, font, design, colors etc., anybody can say that the trademark used by the plaintiffs and the trademark used by the defendants are altogether different. There is no similarity in it as claimed by the plaintiffs.

xiii. The defendants further submitted that the word 'City' as well as the word 'Collection' are generic words and cannot be treated as distinctive words within the meaning of Section 9 of the Act of 1999. The words 'City' and 'Collection' are customary and are being used in various kind of services including services of electric bill collection, water bill collection, collection of networking fees, mobile company collection centre, etc. and is a common trade name, which could not be treated as not being capable of any distinctive character and goods of one or services of one person from those of other person.

xiv. It is further stated that in the action of passing off, it is clear that mere using of other trade name, based on generic similarity, is not itself sufficient but it must be shown by virtue of said name that plaintiffs have acquired distinct identity in their business. It is submitted that in order to establish distinct identity, plaintiffs in such action come up with the case that except defendants, no other person in the entire world using the said name, and the business of the plaintiffs is relatable to their trade name. In conclusion, the defendants

state that the plaintiffs have unnecessarily dragged them in such a false litigation without there being any valid reason and with some ulterior motive. The defendants urged to dismiss the suit with compensatory cost of Rs.25,000/-.

xv. On the basis of pleadings between both the parties, the trial Court framed the following issues below Exh.35 :

*“1. Do the plaintiffs prove that it has the copy right in respect of business of mobile phone under the name M/s. City Collection by using Logo/ Label mentioned in annexure attached with the plaint ?*

*2. Do the plaintiffs prove that defendant is using a deceptively similar service mark in mobile distribution and sale as that of the plaintiffs i.e. under the name “Orange City Mobile Collection” ?*

*3. Do the plaintiffs further prove that the defendants have deliberately used a deceptively similar service mark to cause confusion in the public and are passing off their services as those of the plaintiffs ?*

*4. Do the plaintiffs further prove that the above act of the defendant is in violation and infringement of the plaintiffs right thereby causing wrongful loss to the plaintiffs and their good will?*

5. *Do the plaintiffs further prove that due to above act of the defendant they have suffered losses to their trade business, reputation and good will ?*

6. *Are the plaintiffs entitled to a perpetual and mandatory injunction as prayed ?*

7. *Are the plaintiffs entitled to damages as claimed ?”*

**Additional issues :**

*“5-A Whether the suit is barred by limitation ?*

*5-B Whether the suit as filed is tenable ?”*

xvi. In order to substantiate their case, the plaintiffs examined in all five witnesses. They are as under :

- PW1 Javed Sharif S/o Abdul Lateef Sharif
- PW2 Mohd. Yasin Maka S/o Haji Dilawar Maka
- PW3 Tushar Bumbar
- PW4 Abdul Sajid @ Abdul Hamid
- PW5 Ganesh Chakarwar.

The plaintiffs have brought on record the following documents :

- Certificate of copyright registration dated 29/08/2013 at Exh. 39
- Certificate of trademark dated 10/09/2015 with effect from 28/12/2011 at Exh. 40
- Copy of public notice at Exh.41
- Partnership deed at Exh.60
- Shop and establishment license at Exh.61
- Purchase bills at Exhibit Nos.62, 66 and 72.
- Photographs of the sign Board of defendants shop Exh. 52, 53, 99.

xvii. On the other hand, the defendants examined one witness, i.e., defendant No.2, the partner of defendant No. 1 firm, and brought on record the partnership deed at Exh.86, GST registration certificate at Exh.87, application for registration of trademark at Exh.94 and receipt at Exh.95.

xviii. The trial Court, on the basis of material on record and the submissions put forth on behalf of both the parties, decreed the suit of the plaintiffs. This judgment is impugned in

this Appeal.

4. I have heard Shri R.L. Khapre, learned Senior Counsel assisted by Shri A.P. Thakre, learned counsel for the appellant, and Shri D.V. Chauhan, learned counsel for the respondents.

5. Shri Khapre, learned Sr. counsel appearing on behalf of the appellant, reiterated the defence of the appellants in their pleadings and evidence. The learned Sr. counsel made the following submissions :

i. That the words 'City' and 'Collection' are generic words, and therefore, nobody can claim exclusive right over these words. The plaintiffs could not prove the distinctive character in the impugned logo 'City Collection' and the distinctiveness is only in the style of writing of the plaintiffs' logo. The learned Sr. counsel urged that the phrase 'Orange City' is well known for Nagpur city due to its specialty in growing oranges. Furthermore, the words 'Mobile Collection'

are used for the defendants' trade name in order to indicate as to what the customer is likely to get from the defendants' shop. As the defendants are only dealing in mobiles, it is necessary to indicate that mobiles of all categories are available, and therefore, according to the learned Sr. counsel, the prefix 'Mobile' to the word 'Collection' is not by way of dishonest commercial practice with malafide intention to deceive the prospective customers of the plaintiffs. The words 'City' and 'Collection' are normally used in business arenas, and the same are not being used with the malafide intention to infringe over anybody's exclusive proprietary and intangible right. However, it is the honest commercial practice and the purpose of the trademark to protect the customers so that they are not deceived. It is urged that the plaintiffs are not the manufacturers of goods, and their alleged trademark is only for the services, and therefore, there is no question of confusion for the customers in purchasing the goods.

ii. The learned Sr. counsel further submitted that the shops of the respective parties are at a far away distance. The learned Sr. counsel read out the relevant Sections, i.e., Sections

9, 17(2), 29, 30 and 35 of the Act of 1999 in order to see whether the generic term 'City Collection' can be treated as barring the user of any of the words in company of each other constitutes infringement of trademark registered in the name of the plaintiffs. To substantiate his contention, the learned Sr. counsel relied on the bulk of authorities, which will be referred to at the appropriate places in the judgment.

iii. With regard to damages, the learned Sr. counsel submitted that the trademark of the plaintiffs was not registered at the time of institution of the suit, and was registered during the pendency of the suit, and therefore, there is no question to impose punitive damages. Lastly, the learned Sr. counsel urged to quash and set-aside the impugned judgment and order of the trial Court, being perverse and infected with error apparent on the face of record.

6. Per contra, Shri D.V. Chauhan, learned counsel appearing for the respondents/ plaintiffs, first and foremost, submitted that the object of trademark is to protect commercial dishonesty. The defendants themselves have applied for their

trademark under the name and style 'Orange City Mobile Collection' in Class 35 of the trademark Rules then applicable, and therefore, it cannot lie in the mouth of the defendants that the words 'City' and 'Collection' are generic words. The plaintiffs have exclusive right in the expression in composition of two words 'City Collection' with additional advantage of copyright in the style of writing. The plaintiffs are using the same logo since 2001.

The learned counsel further read out Section 29 and other relevant provisions of the Act of 1999, and submitted that Sections 9 and 11 of the said Act are not relevant for consideration in the facts and circumstances of the present case. He also read out the depositions of the witnesses, and submitted that it is established on record through the witness, namely Abdul Sajid Abdul Hamid, that the usage of the defendants' trademark has indeed caused confusion and deception to the customers. It has also come on record, through this witness, that the defendants have played mischief inasmuch as when enquired as to if the shop is 'City Collection', the answer was given in affirmative. The witness has also

established that in fact, the board for 'City Collection' was displayed on the shop of the defendants. The witness, in fact, lodged police complaint because of the deception and confusion caused by the display board similar to that of the plaintiffs concern. Thus, it is submitted that the intent of the defendants was obvious to deceive the customers to believe that the business undertaken by them is that of the plaintiffs.

In response to the defence that the words 'City' and 'Collection' are generic, Shri Chauhan, learned counsel, submitted that the approach is absolutely misconceived, and the defendants did not bring to the notice of this Court the fact that they themselves had applied for registration of their trademark under the name and style 'Orange City Mobile Collection' under the same Class, i.e., Class 35 with the Registry of trademark on 12/03/2014. Thus, it would certainly not lie in the mouth of the defendants to claim that they are conducting their business in a different field or for different products. There is, in fact, commonality of the business of the defendants and the plaintiffs, both being in the business of selling of mobile phones. In support of his submission, he relied

on the judgments delivered in the cases of i) **Anjani Kumar Goenka and Ors. Vs. Goenka Institute of Education and Research**, (2009) ILR 3 Delhi 758; ii) **Rahul Uttam Suryavanshi Vs. Sunil Manikchand Kasliwal**, 2016 (6) ABR 319; and iii) **Pidilite Industries Limited Vs. Poma – Ex Products**, 2017 SCC OnLine Bom 7237.

The learned counsel further submitted that the submission that the purpose is to protect the interest of customer, is equally fallacious. The object of bringing about the actions, either of passing off or infringement, is to ensure that there is no commercial dishonesty inasmuch as the parties do not try to usurp other business by projecting it or presenting it to be their own. The primary purpose is obviously to protect the interest of the person in trade and to avoid any loss not only financial but also to the reputation and goodwill of the person in trade. The scheme of the Act confers such right on the proprietor of a trademark. The tests that likelihood of a confusion would be looked into while dealing with a case of passing off or infringement is not restricted to the customers alone but to the person in trade.

In response to the submission that once there is change in style of writing, the defendants cannot be blamed to infringe the trademark, the learned counsel submitted that it is not the style of writing which is registered, but the trademark of the business concern of the plaintiffs is registered as 'City Collection'. The infringement happens moment there is a copying of registered trademark irrespective of the manner of copy. Should such change or of style of writing is allowed by the Court, it would be opening flood gates for other infringers to merely change the style of writing and use the registered trademark of the proprietor of a trademark.

With regard to the claim of the defendants for protection of their actions under Section 29(5) of the Act of 1999, Shri Chauhan, learned counsel, submitted that sub-section 5 of Section 29 from its language applies only to a case where the registered trademark is used as a part of business - corporate name provided the business of the infringer is also dealing with goods or services in respect of which the trademark is registered. To buttress his submission, learned counsel relied on the judgment delivered by the Full Bench of

this Court in the case of **Cipla Ltd., Mumbai Vs. Cipla Industries Pvt. Ltd., Delhi and another, 2017(2) Mh.L.J. 877**. He further submitted that should the aforesaid ratios are to be applied to the facts of the present case, the plaintiffs satisfy the twin condition contemplated by sub-section 5 of Section 29 of the Act of 1999. The fact that the plaintiffs are using its registered trademark 'City Collection' as its business concern name/ trade name, is well established on record. It is further on record that both the defendants and the plaintiffs are in the business of selling of mobile phones, therefore establishing the commonness of their interest of business. This commonness is further confirmed by the fact that the plaintiffs have themselves applied for registration of their trademark 'Orange City Mobile Collection' under the same Class, namely Class 35 of Schedule - IV. If both these tests stand satisfied in the facts of the present case, there is nothing further that is required to be inquired into much less whether it would cause deception, confusion or other requirements contemplated by other sub-sections of Section 29 of the Act of 1999. The case of the plaintiffs, according to the learned counsel, therefore squarely falls within the purview of sub-section 5 of Section 29 of the

Act of 1999 thereof.

The learned counsel further submitted that to come out of the clutches of rigors of sub-section 5 of Section 29 of the Act of 1999, a feeble attempt was made to place reliance on Section 35 of the said Act. An attempt was made to show that since the place of business - Nagpur is associated and is commonly known as 'Orange City', the case would fall under Section 35 of the Act of 1999. However, according to the learned counsel, there is no pleading as such in the written statement, and no evidence accordingly. He submitted that all the defences are available during the course of trial, and cannot be for the first time argued in Appeal to challenge the judgment impugned. In support of his submission, he relied on the judgment delivered by the High Court of Karnataka in the case of **M/s. Cothas Coffee Co. Vs. M/s. Cotha Associates and others, ILR 2017 Karnataka 4927**, so also on the judgment delivered by the Delhi High Court in the case of **Manju Monga Vs. Manju Mittal, 2012 SCC OnLine Del 3331**.

The learned counsel submitted that the interplay between the two provisions - Sections 29 and 35 of the Act of 1999 would show that the Court has to first identify if and under what category the trademark in dispute would be covered under Section 29 of the Act of 1999. Once that identification is complete, the defence of bonafide user under Section 35 of the Act of 1999 would be considered. Without examining the category in which the trademark would fall, the Court cannot straightaway jump to the defence contemplated by Section 35 of the Act of 1999. If the defence of bonafide user, under Section 35 of the Act of 1999, is neither pleaded nor established, such interpretation, if adopted, would lead to a chaos inasmuch as a party would conveniently copy a registered trademark and would come up with a defence of bonafide user under Section 35 of the Act of 1999. Such cannot be and can never be the intention of the legislature while inserting Section 35 of the Act of 1999 and the defence that which Section makes available.

The learned counsel further submitted that the interpretation, put by the defendants to the provisions of the

Act of 1999, Section 35 in particular, is outrageous, misconceived and runs contrary to the scheme of the Act of 1999.

With regard to punitive damages, the learned counsel submitted that grant of punitive damages is an accepted proposition in law once the party establishes that because of the conduct of the other side, it has suffered damage to its reputation, good will and its presence in the market is getting affected. He submitted that the trial Court had overwhelming evidence of the presence of the plaintiffs' business concern in the market and also observed the malafide conduct of the defendants, and therefore, reasonable amount was calculated and granted as punitive damages.

Lastly, the learned counsel submitted that no error can be found from the judgment of the trial Court to cause interference in the appellate jurisdiction of this Court.

7. I have considered the rival submissions put forth on behalf of both the sides. I have also minutely perused the

record, and considered the authorities cited.

8. Now the point for consideration of this Court is whether there is an infringement of trademark of the plaintiffs by the defendants under Section 29 of the Act of 1999 ?

9. Before advertizing to deal with the evidence on record and the submissions made on behalf of both the parties, it would be advantageous to reproduce the relevant provisions of the Act of 1999, which reads thus :

**Section 2(1)(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;

**Section 2(1)(j)** “goods” means anything which is the subject of trade or manufacture;

**Section 2(1)(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;

**Section 2(1)(z)** “service” means service of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters such as banking, communication, education, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising;

**9. Absolute grounds for refusal of registration.** - (1) The trade marks -

*(a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;*

*(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;*

*(c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade,  
shall not be registered :*

*Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.*

*(2) A mark shall not be registered as a trade mark if-  
(a) it is of such nature as to deceive the public or cause confusion;*

*(b) it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;*

*(c) it comprises or contains scandalous or obscene matter;*

*(d) its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950).*

*(3) A mark shall not be registered as a trade mark if it consists exclusively of -*

*(a) the shape of goods which results from the nature of the goods themselves; or*

*(b) the shape of goods which is necessary to obtain a technical result; or*

*(c) the shape which gives substantial value to the goods.*

**17. Effect of registration of parts of a mark.-** *(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.*

(2) *Notwithstanding anything contained in sub-section (1), when a trade mark -*

*(a) contains any part -*

*(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or*

*(ii) which is not separately registered by the proprietor as a trade mark; or*

*(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.*

**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) XXXX

(4) XXXX

(5) *A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or*

*services in respect of which the trade mark is registered.*

(6) XXXX

(7) XXXX

(8) XXXX

(9) XXXX

**30. Limits on effect of registered trade mark.—**

(1) *Nothing in section 29 shall be construed as preventing the use of a registered trade mark by any person for the purposes of identifying goods or services as those of the proprietor provided the use—*

*(a) is in accordance with honest practices in industrial or commercial matters, and*

*(b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.*

(2) *A registered trade mark is not infringed where—*

*(a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;*

*(b) XXXX*

*(c) XXXX*

*(d) XXXX*

*(e) XXXX*

(3) XXXX

(4) XXXX

**35. Saving for use of name, address or description of goods or services.** - *Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character of quality of his goods or services.*

10. A collective reading of the aforesaid provisions would show that a trademark is used in relation to goods and services. Ordinarily, registration is not granted if the mark falls

under sub-sections 1(a) to 1(c) of Section 9 of the Act of 1999. The proviso, however, provides for entitlement to registration although ordinarily not permissible under Section 9 1(a) to 1(c), provided that the mark has acquired a distinctive character as a result of its use prior to registration or is otherwise a well known trademark. Furthermore, even though it is an exclusive right but certainly, it is not an absolute right. There are number of safeguards available to the defendants under Sections 30 to 35 against the claim of infringement of the registered trademark of the plaintiffs. If the case of the defendants falls in any of the aforesaid safeguards, an action for infringement is not warranted.

11. Section 17 of the Act of 1999 deals with the effect of the registration of parts of a mark and explicitly states the general proposition that the registration of a trademark confers exclusive right to the use of the trademark taken as a whole and not separately to each of its constituent parts, if any.

12. Section 29 entitles an action being filed for infringement of a registered trademark against an identical,

nearly identical or deceptively similar trademark used in similar goods or services in respect of which the trademark is registered. Section 29 explicitly states as to various acts which constitute infringement. Sub-section (1) states the general proposition of law in this respect. The ingredients of Section 29(1) are as follows :

1. The plaintiffs mark is registered.
2. The defendants mark is identical with, or deceptively similar to the plaintiffs registered mark.
3. The defendants use of the mark is in the course of trade in respect of goods/ services covered by the registered trade mark.
4. The use by the defendants is in such a manner as to render the use of the mark likely to be taken as being use as a trade mark.
5. The defendants use of the mark is not by way of permitted user, and accordingly, unauthorized infringing use.

While the above is a general proposition of law, as per Section 29 (1), the various circumstances in which the trade mark is infringed are enumerated in sub-sections (2) to (9) of Section 29.

13. In the instant case, in order to get the relief of infringement of trademark under the provisions of the Act of 1999, the plaintiffs have to establish under Section 29(1) that identical or deceptively similar mark is being used by the defendants in relation to the services for which the plaintiffs have acquired exclusivity. It is well settled that the test to be applied in determining whether two marks are identical with or too nearly resembles each other or is likely to deceive or cause confusion or deceptively similar is the test of an average person with imperfect recollection. The Court has to visualize a customer who may happen to have dealings with the plaintiffs or to avail the services rendered by the plaintiffs and to decide whether such a customer would get confused. Under Section 2(1)(d), the words 'deceptively similar' are defined as 'a mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely deceive or

cause confusion'. The Hon'ble Apex Court says that the test of deceptive similarity is of impression to the 'eye' and 'ear' of the Judge hearing the matter at the first instance, and when on comparison of two marks, there is no likelihood of confusion and they are not deceptively similar.

14. In this context, the learned Single Bench of this Court in the case of **Macleods Pharmaceuticals Ltd. Vs. Swisshem Healthcare And Anr (Commercial IP Suit No. 32/2011 decided on 02/07/2019)** noted down the principles for deciding the question of deceptive similarity as are laid down by the Hon'ble Apex Court in the case of **Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73**, which reads thus :

*“a. The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.*

*b. The degree of resemblances between the marks, phonetically similar and hence similar in idea.*

*c. The nature of the goods in respect of which they are used as trade marks.*

*d. The similarity in the nature, character and performance of the goods of the rival traders.*

*e. The class of purchasers who are likely to buy the goods bearing the marks, they require, on their*

*education and intelligence, and a degree of care they are likely to exercise in purchasing and / or using the goods.*

*f. The mode of purchasing the goods or placing orders for the goods, and g. Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”*

The learned Single Bench of this Court has also observed that "weightage is to be given to each of the aforesaid factors depending upon the facts of each case, and same weightage cannot be given to each factor in every case."

15. Now I propose to deal with the relevant factors from the above mentioned test as laid down in the case of **Cadila Health Care Ltd.** (*supra*). Evidently, the nature of plaintiffs' trade mark is a logo/ device mark. A device mark gives the owner the right to a particular combination of images, design and words taken together. Therefore, the protection given to the plaintiffs' trade mark 'City Collection', expressed in an artistic style, is limited, since the rights in a logo are entitled only to the logo as a whole and not to a specific word. The plaintiffs cannot claim exclusivity in the words 'City' or 'Collection' separately. Furthermore, the

plaintiffs have not coined or discovered the words 'City' and 'Collection'. They are common descriptive words, and the plaintiffs have exclusivity in the device/ logo 'City Collection' expressed in an artistic style. While the defendants' trade name 'Orange City Mobile Collection' in the first impression of this Court cannot be called as deceptively similar so that there is a likelihood of creation of confusion in the minds of the prospective buyer of the plaintiffs. Furthermore, the defendants have already changed the style of expressing their trade name by increasing the fonts of the words 'Orange' and 'Mobile'.

16. It is worthwhile to mention here that, at the very inception of the arguments, the learned counsel for the rival parties were at *ad idem* that the Court has to examine only the issue of infringement of the trademark of the plaintiffs with respect to the changed expression of the trade name of the defendants, as the defendants have already increased the fonts of the words 'Orange' and 'Mobile' as directed by this Court on the statement made by the defendants during the hearing of the Appeal against Order No. 82/2016.

17. With regard to the nature of goods, as laid down in the aforesaid test, the defendants are dealing only in mobile phones, while the plaintiffs are dealing not only in mobile phones but also in all imported cosmetics, perfumes, digital cameras, handy cameras and electronic goods. Generally, these items are sold under their brand names. The plaintiffs have to prove as to how they have acquired a distinctive name in providing services for selling mobile handsets under the name 'City Collection' and as to how the defendants have infringed their proprietary rights by using the trade name 'Orange City Mobile Collection'.

18. As far as the class of customers, one of the factors to be considered, considering the nature of goods, i.e., all the elite items, for which the plaintiffs are providing their services, naturally, the class ought to have been the elite class, that again reduces the chances of deception.

19. As stated earlier, the plaintiffs' trademark is for the composite word 'City Collection' expressed in an artistic way under the Copyright Act. It is a kind of device mark/ logo,

which conferred upon the plaintiffs a monopoly over the trademark taken as a whole. It is not the plaintiffs' contention that the registration of trademark confers upon them exclusivity over each and every constituent part thereof. The Court, therefore, has to examine the mark as a whole.

20. In this context, Section 17 of the Act of 1999 explicitly states the general proposition that the registration of the trademark confers exclusive right to the use of the trade mark taken as a whole and not separately to each of its constituent parts, if any. Section 17(2)(b) of the said Act expressly prescribes that where a composite mark contains matter, which is common to the trade or is otherwise of a non-distinctive character, registration of the composite mark shall not confer any exclusive right in the matter forming only a part of the whole of the registered mark. In other words, the statute does not grant protection (exclusivity) over such parts or constituents of a composite mark, which are 'common to the trade' or of a 'non-distinctive character'. Consequently, by reason of Section 17(2)(b), the plaintiffs, in this case, cannot claim any exclusivity.

21. In this context, the Division Bench of this Court in the case of **Medley Laboratories (P) Ltd., Mumbai and another Vs. Alkem Laboratories Limited, 2002(3) Mh.L.J. 546** quoted the following para from the judgment of the Hon'ble Apex Court :

*"It is important that the marks must be compared as wholes. It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in the other case there is no sufficient similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark."*

22. In the instant case, the word 'City' and the word 'Collection' both forms separate parts of the composite mark 'City Collection'. Both these words, i.e., 'City' and 'Collection' clearly are common to the business circle and/ or of non-distinctive characters. Obviously, they are not coined by the plaintiffs. If this test is applied, then the marks to be compared are 'City Collection' and 'Orange City Mobile Collection'. The Court has to consider the overall similarity of these two comparative expressions.

23. In this context, the Delhi High Court in the case of **Phonepe Private Limited Vs. EZY Services & Anr. (I.A. 8084/2019 in CS (Comm) 292/2019 decided on 15/04/2021)** upholds non-exclusivity over the mark 'Pe'. The Delhi High Court refused to grant a permanent injunction in a trademark infringement suit instituted by Phonepe Private Limited against EZY Services for the use of word 'Pe' in its trademark 'Bharat Pe'. The plaintiff therein claimed that the suffix of its registered trademark 'Pe' is a translation of the Devanagari letter, which is an innovative and fanciful adaptation by the Plaintiff. Conversely, the defendant argued that the plaintiff did not have any trademark rights on the word 'Pe' in order to seek the relief of injunction. Reliance was placed on Sections 15 and 17 of the Act of 1999 to state that competing trademarks should not be dissected, but have to be compared as a whole. Accordingly, the defendant pointed out that the trademarks 'Phone Pe' and 'Bharat Pe' mark were visually, phonetically and structurally different when viewed as a whole. The Court observed that 'Phone Pe' and 'Bharat Pe' are both composite marks; therefore, the trademarks cannot be dissected and 'Pe' being a misspelling of the word 'Pay', does not change the legal position that the

word is descriptive, and no individual shall be permitted to claim proprietary rights over the same. The Court also rejected the plaintiff's submission that the word 'Pe' has an acquired secondary meaning for the plaintiff to claim exclusivity over it. The Court opined that exclusivity may be claimed over a descriptive part of a mark wherein the part has attained distinctiveness through means of extensive use and has resulted in the mark becoming identified exclusively with goods or services of the claiming exclusivity. Accordingly, the Court held that the plaintiff cannot claim exclusivity solely over the suffix 'Pe', as no infringement can be claimed on the basis of the parts of a registered trademark.

24. At this juncture, it would be apposite to examine the evidence of the plaintiffs on record. Both the partners of the plaintiffs' firm have examined themselves and reiterated their pleadings in their deposition. Witness No.1 Shri Javed Sharif s/o Abdul Latif Sharif, in his cross-examination, has admitted that defendants' shop is at a distance of around 6-7 kilometers from his shop and his shop is situated in western Nagpur area and the shop of the defendants is situated in

eastern Nagpur area. He further admitted that as on today, he has no other branch of his shop except the one situated in western Nagpur area. He has further admitted that there is difference between the words 'City' and 'Orange City'. He has further admitted that at Nagpur, other establishments such as hospitals and medical stores have used the words 'City' and 'Collection'.

25. Plaintiffs' witness No.2 Mohd. Yaseen Maka s/o Haji Dilawar has admitted that there were 9 shops in Nagpur using the words 'City' and 'Collection'. There is a hospital by name 'Orange City Hospital' in Nagpur. A question being put to him about the expenditure on advertisements the plaintiffs incurred, he expressed inability to answer so also failed to file any document in this regard.

26. Plaintiffs' witness No.3 Tushar Bhaiyaji Bhumbar is examined on the point that he was deceived by the defendant Vikram Chug, who introduced himself being the owner of 'City Collection' and he could only see the word 'City Collection' signboard. He further deposed that he was not guided properly

nor explained features of mobiles properly and Mr. Chug was hurrying him and asking him to select hastily. He was utterly displeased, and hence, reluctantly bought Xolo prime mobile handset for Rs.7100/- as if he was compelled to purchase it. He had a bad experience there. Lateron, he came to know that he ended up to going to a wrong shop. He wanted to book through plaintiffs' shop. In his cross-examination, he has admitted that he had visited the Advocate with plaintiffs as per his request to lodge objection. He has further admitted that he had lodged a complaint against the owner of the said shop, however, he doesn't remember the date of lodging of complaint and he does not have a copy of the said complaint.

A holistic reading of the testimony of this witness, this witness is completely unreliable and appears to be after thought witness procured by the plaintiffs.

27. Witness No.4 Abdul Sajid Abdul Hamid is examined by the plaintiffs on the point that he went to the plaintiffs' shop in Wardhman Nagar on 15/11/2017 and purchased one Nokia 105 DS mobile handset for Rs.1399/- and one Nokia 130

mobile handset for Rs.1679/-. He also complaint deception at the hands of defendants. He also repeated the same fact that he was not guided properly, nor explained about the features of the mobile properly and also Mr. Chug was hurrying him and asking him to select hastily, and hence, he reluctantly agreed to buy Nokia handsets, as stated above, as he was told that 'City Collection' is the best shop where he would receive the best services. He lodged a report at the Police Station, Sitabuldi on the same day. He produced the complaint at Exh. 72/3. A perusal of his affidavit and his report could at once give an impression that he is nothing but a created witness of the plaintiffs to suit their purpose.

28. Witness No.5 Ganesh Ram Chakarwar is a Chartered Accountant, and he has produced the audited balance sheet along with his report Exh.7. In his cross-examination, he has admitted that in the year 2013-14, the total profit of the plaintiffs was around Rs.55 to 56 lakh, and in the year 2016-17, it was around Rs.1.28 crores. This fact itself indicate that there is no loss to the plaintiffs in their business as

alleged due to the alleged act of 'passing off' warranting any damages much less punitive damages.

29. Furthermore, it is an admitted fact that as the plaintiffs' trade mark is registered only as a service provider under Class 35 and not the manufacturers of the goods, therefore, there would not be any confusion with regard to the quality of mobile, as the mobiles are generally purchased according to the brand names, categories, features and nowadays after exploring online comparative prices. As regards the services of distribution, display, etc., the plaintiffs could not prove as to how the services provided by the plaintiffs are distinctive and distinguishable in nature from those of the defendants.

30. Moreover, the plaintiffs are providing services not only for mobile phones but also for all imported cosmetics, perfumes, digital cameras, handy cameras, electronic goods, etc., while the defendants are only dealing in mobile phones of different kinds and categories. This is also one of the vital facts

to be considered while examining the question of infringement of the trademark. The plaintiffs could not distinguish their earnings separately from the mobile handset business to indicate their distinctive service in selling mobile phones.

31. Now, it is apposite to examine as to what weighed the trial Court in passing the impugned judgment and decree. The learned trial Court noted that both the parties are engaged in the same business of selling mobile handsets. The words 'City' and 'Collection' are the essentials and integral components of the plaintiffs' registered trademark. According to the trial Court, the defendants have virtually lifted two words out of the registered trademark 'City Collection'. Then the trial Court considered whether by prefixing the word 'Orange' and suffixing the word 'Mobile', there will be any difference in the case of defendants. The trial Court relied on various judgments of the Hon'ble Apex Court and reached the conclusion that mere prefixing and suffixing certain words in essential features of the registered trademark of the plaintiffs by the defendants will not help their case. In the judgments relied on by the trial Court, the question for consideration of

the Courts was *inter-alia* as to whether the two comparative marks are deceptively similar or not. I propose to mention the same in tabular form to get the clear ideas as under :

| Sr. No. | Citation                                                                                                                           | Plaintiffs' mark | Defendants' mark   | Court held                                                             |
|---------|------------------------------------------------------------------------------------------------------------------------------------|------------------|--------------------|------------------------------------------------------------------------|
| 1       | K.R. Chinna Krishna Chettiar<br><b>Vs.</b><br>Sri Ambal & Co. and another,<br>AIR 1970 SC 146                                      | Sri Ambal        | Sri Andal          | Word Ambal was an essential feature of the registered mark             |
| 2       | De Cordova and Ors.<br><b>Vs.</b><br>Vick Chemical Coy.,<br>(1951) 68 R.P.C. 103                                                   | Vaporub          | Karsote vapour Rub | The defendants used the essential feature of the plaintiffs' trademark |
| 3       | Ruston & Hornsby Ltd.<br><b>Vs.</b><br>The Zamindara Engineering Co,<br>1970 AIR 1649                                              | Ruston           | Rustam India       | Rival marks were deceptively similar                                   |
| 4       | KSB Aktiengesellschaft & Ors.<br><b>Vs.</b><br>KSB Global Limited<br>(CS (OS) No. 1250/2008 d/on 04/06/2010)<br>(Delhi High Court) | KSB              | KSB Global Ltd.    | Defendants' mark is deceptively similar                                |

32. In the aforesaid judgments, the word marks, as noted above, are not of generic or of descriptive in nature.

They are specially coined words by the owner of the trade mark, and the Courts found the same to be the essential feature of the registered trade mark of the owner.

33. In the case in hand, neither the word 'City' nor the word 'Collection' has been registered separately by the plaintiffs, nor any of these words are of any distinctive character or coined by the defendants. Hence, with due respect, the ratio laid down in aforesaid judgments would not be applicable to the facts of the present case.

34. The trial Court has noted the admission of the defendants that they have also applied for registration of trademark as per their old signboard comprising the essential features of the plaintiffs' trademark. The Trial Court found this admission as vital which according to the trial Court reflected on the conduct of the defendants since beginning that they want to use the deceptively similar trademark as that of the plaintiffs. The trial Court concluded that as the plaintiffs have succeeded in proving that the defendants have infringed their

trademark in copyright, therefore, the trial Court awarded punitive damages of Rs.2 lakh to the plaintiffs.

35. It is worthwhile to note that, at the time of filing of the suit, admittedly, the plaintiffs' trade name 'City Collection' was not registered under the Act of 1999, as the application for the same was pending before the trademark registry. However, the same was registered under the copyright Act. The trial Court was pleased to protect the plaintiffs by way of an interim injunction. The order of the trial Court was challenged before this Court in Appeal against Order bearing No. 81/2014. This Court quashed and set-aside the trial Court's order. This Court held that the plaintiffs have failed to make out a *prima-facie* case for granting interim injunction. While rejecting the plaintiffs' application, this Court (Coram : A. S. Chandurkar, J.) had categorically observed as under :

*"16. XXXX Considering the various services being provided by the plaintiffs in contrast with the exclusive service with regard to mobile phones offered by the defendant, prima facie, use of the word 'mobile' in the trade name of the defendant has relevance for being considered as a distinguishing feature in both the marks. The observations of the Honourable Supreme*

*Court in S.M. Dychem Ltd. [supra] that additions in the trade name would be relevant in a passing off action would, therefore, apply to the case in hand, at least at this prima facie stage.*

*17. After considering the law laid down in Ruston and Hornby Ltd., Ramdev Food Products Pvt. Ltd, and Midas Hygiene Industries Pvt. Ltd. [supra], I find the material placed on record by the plaintiffs insufficient to make out a prima facie case for grant of temporary injunction in their favour. The variety of services provided by the plaintiffs as contrasted with the services provided by the defendant use of the word 'mobile' in the trade name of the defendant which is prima facie found relevant in the passing off action and absence of any material to indicate customers being misled or deceived are relevant aspects resulting in absence of making out a prima facie case. These factors would also have a bearing on the comparable strength of the plaintiffs' case which has also to be taken into account while considering the prayer for grant of temporary injunction. There is further no prima facie material placed on record by the plaintiffs that there has been some fall in their sales as a result of the alleged passing off acts of the defendant which aspect has been found relevant by the Division Bench in Shelke Beverages Pvt. Ltd. [supra]. This factor has also been considered in M/s. AZ Tech (India) [supra] that was relied upon by learned counsel for the plaintiffs.*

*18. Hence, I do not find the material placed on record by the plaintiffs prima facie sufficient to grant an order of temporary injunction in their favour as prayed. The trial Court while passing the impugned order failed to take into consideration the aforesaid settled principles of law regulating grant of temporary injunction. On said count, by following the ratio of the decision in Wander Ltd. Vs. Antox India (P) Ltd. [1990 (Supp) SCC 727] that has been reiterated in Ramdev Food Products P. Ltd. and Skyline Education Institute (Pvt.) Ltd. [supra], a case for interference with the discretion exercised by the trial Court has been made out. However, in the decision in Kaviraj Pandit Durga Dutt Sharma [supra], it has been observed that in an action*

*for passing off, defendant could escape liability if it can be shown that the added matter was sufficient to distinguish his goods from those of the plaintiff. In the light of this position and accepting the statement made on behalf of the defendant that the defendant was willing to increase fonts of the words “Orange” and “Mobile” in its logo to make the entire trade name of the defendant conspicuously visible, the defendant can be directed without prejudice to the rights of the parties to increase the fonts of said words in its logo during pendency of the suit.”*

The learned counsel Shri Chauhan has expressed his strong opposition for relying on the order of this Court while considering an Appeal against an interlocutory order. It is worthwhile to note here that in the compilation of the citations provided by Shri Chauhan, some of the citations are the judgments in Appeal against interlocutory orders. Secondly, in the aforesaid order this Court observed that the material placed on record by the plaintiffs insufficient to make out a *prima-facie* case for grant of temporary injunction in their favour. Even after a full-fledged trial, the position on record is more or less the same, as discussed earlier, the plaintiffs could make out a case for infringement of their right in trademark as contemplated in law by leading a convincing evidence.

Relying on the case of **Ayushakti Ayurved Pvt. Ltd. and others Vs. Hindustan Lever Limited.**, 2003(4) Mh.L.J. 915, this Court in the aforesaid order has observed that at a *prima-facie* stage without any actual instance of witnesses having been deceived, it would be sufficient for the Court to form a broad impression that there is no confusion by and large. This Court has noted that the variety of services being provided by the plaintiff apart from mobiles as contrasted with the services provided by the defendant and in the absence of any material to indicate customers being misled or deceived are relevant aspects resulting in absence of making out a *prima-facie* case. It is further observed that these factors would also have a bearing on the comparable strength of the plaintiffs case which has also to be taken into account while considering the prayer for grant of temporary injunction.

36. The plaintiffs could not change his aforesaid position even by leading of evidence. The plaintiffs examined two customer witnesses showing that they have been deceived by the defendants as they purchased mobiles from the defendants' shop with the bonafide belief that it is a shop 'City

Collection', and therefore, they lodged police report. A holistic reading of their affidavits and cross-examinations could give no other inference than that these witnesses are the afterthought and created witnesses by the plaintiffs.

37. This Court takes a judicial notice that the words 'Orange City' are very popular name for Nagpur City due to the quality and quantity of Oranges grown in Nagpur region, and therefore, the contention of Shri Chavhan, learned counsel, for absence of the aforesaid fact in the pleadings of the defendants, holds no water.

38. It is also the contention of Shri Chavhan that the defendants have also applied for registration of their trade name 'Orange City Mobile Collection', and therefore, the defendants need to be estopped from claiming that words 'City' and 'Collection' are common and generic words. Secondly, the learned counsel also vehemently submitted that the defendants has suppressed this material fact from this Court.

It is difficult to accept these arguments. Firstly a, perusal of the written statement of the defendants would reflect that in para 16, they have mentioned that they have applied for trademark vide application dated 12/03/2014 bearing CN No. 2725774 with Registrar of trademark, and the registration process was under way. Secondly, it is well settled that there cannot be an estoppel against the statutory provisions. Sections 30 to 35 of the Act of 1999 are the statutory safeguards against the act of infringement of trademark under Section 29 of the Act of 1999. The defendants' trade name consisting of phrase 'Orange City' matches with Nagpur City indicating its place of business and geographical origin and according to Sections 30 and 35 of the Act of 1999, there would not be any infringement under Section 29 of the Act when there is a bonafide use of the trademark by a person of his 'place of business' and 'geographical origin'. The words 'Mobile Collection' indicates the 'bonafide description of the goods and services' rendered by the defendants to indicate that mobiles of different categories and brands are available in the shop of the defendants, and therefore, in the considered view of this Court, the entire mark

‘Orange City Mobile Collection’ is safeguarded within the meaning of Sections 30 and 35 of the Act of 1999. The judgments in the case of **Anjani Kumar Goenka** (*supra*) and **Rahul Uttam Suryavanshi** (*supra*) which are relied on by the learned counsel Shri Chauhan on this aspect are distinguishable on facts and law. Furthermore, both these Appeals are against the order passed by the trial Court under Order 39 Rules 1 and 2 of the CPC.

39. The learned counsel Shri Chauhan could not convince this Court as to in what way there is a commercial dishonesty on the part of the defendants. On the contrary, having considered all the relevant factors, it has to be held that there is no dishonesty on the part of the defendants in using their trade name. This Court is also not convinced with the argument of learned counsel Shri Chauhan that the case of infringement, asserted by the plaintiffs, falls under Section 29 (5) of the Act of 1999. According to this provision, a registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or

name of his business concern or part of the name of his business concern dealing in goods or services in respect of which the trade mark is registered.

As discussed earlier, in the considered opinion of this Court, the defendants are not using the plaintiffs' logo/device mark 'City Collection' as their trade name or name of their business concern or part of their trade name or business concern, as the trade name of the defendants 'Orange City Mobile Collection' is found to be phonetically and visibly altogether different. Secondly, the defendants are dealing only in mobile handsets, while the plaintiffs are dealing not only with mobile handsets but number of other items too.

40. In the light of the above discussion, the plaintiffs have measurably failed to prove the infringement of their proprietary right in the logo 'City Collection' by the defendants, and, hence the judgment and decree of the trial Court (District Judge – 6, Nagpur) dated 24/04/2018 passed in Trademark Suit No. 2/2014 deserves to be quashed and set-aside and the same is accordingly quashed and set-aside.

41. Accordingly, the present Appeal is allowed with costs and the plaintiffs' suit is dismissed with costs.

**JUDGE**

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Sumit