

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 11.03.2021

Pronounced on : 01.04.2021

CORAM

THE HONOURABLE MR. JUSTICE C.V.KARTHIKEYAN

O.A.Nos.359, 360, 361 and 362 of 2020

and

A.Nos.423, 424 and 425 of 2021

in

C.S.(Comm.Div) No.203 of 2020

O.A.Nos.359, 360, 361 and 362 of 2020

in

C.S.(Comm.Div) No.203 of 2020

Manohar Singh

Proprietor trading as M/s.Singh Mehendi Industries

160m 10th Block,

Above Annapoorneshwari Nagar Police Station,

Service Road, Outer Ring Road,

Nagarbhavi 2nd Stage,

Bengaluru – 560072.

... Applicant/Plaintiff

(in all Original Applications)

Vs.

1.Vimal Sehnaaz (India)

Samdar Castle, Flat No. G-2, Plot No.5,

Chinnammal Nagar, Puzhuthivakkam,

Chennai – 600091.

2.Golecha Henna World,
Samdar Castle, Flat No. G-2, Plot No.5,
Chinnammal Nagar, Puzhuthivakkam,
Chennai – 600091.

3.Kalu Singh Rathore,
Proprietor trading as M/s.Aditya Raj Mehendi Product,
House No.11, Raj Hans Colony,
Brahmapuri, Jaipur – 302 002.
Rajasthan.

4.Manak Fancy
356 Mint Street, Sowcarpet,
Chennai – 600079.

5.Bharat Trading Co.
#Shop No.6,7 #11-42-29/30,
Rathi Towers, Ramgopal Street, Vijayawada – 520001,
Andhra Pradesh.

6.Ranawat Mehendi Industries
H-101, IIIrd Phase, Industrial Area,
Sojat, Rajasthan – 306104.

7.Radha Madhav Agency
Pandey Hatta Chauraha, Raiganj Sauth
Post – Gita press District – Gorkhpur,
Uttar Pradesh – 273005.

8.Shree Radha Rani Enterprises
9/37 Shakuntla Complex Kanwari Ganj,
Aligar, Uttar Pradesh – 202001.

9.Kamal Traders
225, Rama Krishna Market, Khanda Choti Choppar,
Rajasthan - 302001.

10.GD Enterprises
Near UCO Bank, Sundar Das Marg,
Jhunjhunu, Rajasthan – 303303.

11.Nagpal Enterprises
Shop No.21A, 1st Floor, Sadar Bazar,
Sadar Bazar Road, Sri Ganga Nagar,
Rajasthan – 335001.

12.Himanshu Traders
Old Anaj Mandi, Bandikui,
Rajasthan – 303313.

13.Amar Agencies
Ward No.15, Girl School Road, Bandikui the Baswa,
Rajasthan – 303313.

14.Aaditya Traders
Bandikui Road, 2nd Floor,
Near UCO Bank, Sikandra, Sikrai,
Jhunjhunu, Rajasthan – 303326.

15.Vishvanath Sanjay Kumar
Naman Tower, 2nd Floor, Near UCO Bank,
Rani Sati Road, Jhunjhunu,
Rajasthan – 333001.

16.Vikas Novelty
Sedhi Complex, 1st Floor,
Purohitji Ka Katla,
Near Badi Choupad, Jaipur – 302002.

17.Mehandi House
Ward No.9, Opposite Old Telephone Exchange Sadulsahar,
Sri Ganganagar, Rajasthan – 335062.

... Respondents / Defendants
(in all Original Applications)

A.Nos.423, 424 and 425 of 2021
in
O.A.Nos.359, 360 and 362 of 2020
in
C.S.(Comm.Div) No.203 of 2020

Kalu Singh Rathore,
Proprietor trading as M/s.Aditya Raj Mehendi Product,
House No.11, Raj Hans Colony,
Brahmapuri, Jaipur – 302 002.
Rajasthan.

...Applicant/3rd Respondent/3rd Defendant
(in all applications)

Vs.

1.Manohar Singh
Proprietor trading as M/s.Singh Mehendi Industries
160m 10th Block,
Above Annapoorneshwari Nagar Police Station,
Service Road, Outer Ring Road,
Nagarbhavi 2nd Stage,
Bengaluru – 560072.

...Respondent / Applicant / Plaintiff
(in all applications)

2.Vimal Sehnaaz (India)
Samdar Castle, Flat No. G-2, Plot No.5,
Chinnammal Nagar, Puzhuthivakkam,
Chennai – 600091.

3.Golecha Henna World,
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Ward No.15, Girl School Road, Bandikui the Baswa,
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Naman Tower, 2nd Floor, Near UCO Bank,
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Sedhi Complex, 1st Floor,
Purohitji Ka Katla,
Near Badi Choupad, Jaipur – 302002.

17.Mehandi House
Ward No.9, Opposite Old Telephone Exchange Sadulsahar,
Sri Ganganagar, Rajasthan – 335062.

...Respondents/Defendants
(in all applications)

Prayer in O.A.Nos.359 of 2020:- This Original Application filed under Order XIV Rule 8 of Original Side Rules read with Order XXXIX Rule 1 & 2 of C.P.C., praying that this Court should not be pleased to grant an interim injunction restraining the respondents/defendants, their men, assigns, servants, agents, officers, distributors, representatives, or anyone claiming through or under them from in any way or manner passing off and enabling others to pass off their products by using the mark 'BANSURI' or any other mark and /or getup and/or colour combination that is deceptively and/or phonetically and/or visually similar to that of the plaintiff's mark Bansuri in any way or manner whatsoever pending the disposal of the above suit and an ad interim injunction pending the disposal of the present application.

Prayer in O.A.Nos.360 of 2020:- This Original Application filed under Order XIV Rule 8 of Original Side Rules read with Order XXXIX Rule 1 & 2 of C.P.C., praying that this Court should not be pleased to grant an interim injunction restraining the respondents/defendants, their men, assigns, servants, agents, officers, distributors, representatives or anyone claiming through or under them from in any way or manner infringing the plaintiff's copyright over and in respect of his artistic work Bansuri by use of any work and / or mark which is identical and/or deceptively similar to the artistic work of the plaintiff pending the disposal of the above suit and an ad interim injunction pending the disposal of the present application.

Prayer in O.A.Nos.361 of 2020:- This Original Application filed under Order XIV Rule 8 of Original Side Rules read with Order XXXIX Rules 1 & 2 of C.P.C., praying that this Court should not be pleased to grant an interim injunction restraining the respondents/defendants, their men, assigns, servants, agents, officers, distributors, representatives, or anyone claiming through or under them from manufacturing, selling, offering for sale and distributing mehendi cones and or any other cosmetic products using the mark 'BANSURI" and /or any other mark which is deceptively and/or phonetically and/or visually similar to that of the plaintiff's mark Bansuri pending the disposal of the above suit and an ad interim injunction pending the disposal of the present application.

Prayer in O.A.Nos.362 of 2020:- This Original Application filed under Order XIV Rule 8 of Original Side Rules read with Order XXXIX Rules

1 & 2 of C.P.C., praying that this Court should not be pleased to grant an interim injunction restraining the respondents/defendants, their men, assigns, servants, agents, officers, distributors, representatives, or anyone claiming through or under them from in any way or manner infringing plaintiff's registered trademark Bansuri by using the mark 'BANSURI' or any other mark which is deceptively similar and/or identical and /or phonetically similar as that of the plaintiff's registered trademark Bansuri in any way or manner whatsoever pending the disposal of the above suit and an ad interim injunction pending the disposal of the present application.

Prayer in A.No.423 of 2021 in O.A.No.359 of 2020:- This Application filed under Order XIV Rule 8 of Original Side Rules read with Order XXXIX Rule 4 of C.P.C., praying to vacate the interim injunction granted in O.A.No.359 of 2020 in C.S.No.203 of 2020 Order dated 02.09.2020.

Prayer in A.No.424 of 2021 in O.A.No.362 of 2020:- This Application filed under Order XIV Rule 8 of Original Side Rules read with Order XXXIX Rule 4 of C.P.C., praying to vacate the interim injunction granted in O.A.No.362 of 2020 in C.S.No.203 of 2020 Order dated 02.09.2020.

Prayer in A.No.425 of 2021 in O.A.No.360 of 2020:- This Application filed under Order XIV Rule 8 of Original Side Rules read with Order XXXIX Rule 4 of C.P.C., praying to vacate the interim injunction granted in O.A.No.360 of 2020 in C.S.No.203 of 2020 Order dated 02.09.2020.

For Applicant : Rajeev Kumar Jain,
Senior Counsel
For Mr.Vivek Menon
in O.A.Nos.359 to 362 of 2020
and A.No.1833 of 2020

For Applicant : Mr.R.Priyakumar
in A.Nos.423 to 425 of 2021

COMMON ORDER

O.A.Nos.359 to 362 of 2020 have been filed by the plaintiff in the suit seeking an order of interim injunction restraining the respondents / defendants from passing off their products by using the mark 'BANSURI' or any other mark deceptively or phonetically or visually similar to the plaintiff's mark 'BANSURI' pending disposal of the said suit and for an order of interim injunction restraining the respondents / defendants from infringing the copyright of the plaintiff with respect to the artistic work 'BANSURI' and for an interim injunction restraining the respondents / defendants from offering for sale and distribute Mehendi cone or any other cosmetic products using the mark 'BANSURI' and for an interim injunction restraining the respondents / defendants from infringing the registered trademark of the plaintiff 'BANSURI'.

2. These applications came up for consideration on 02.09.2020 and holding that a prima facie case had been made out by the plaintiff and that the balance of convenience was also in favour of the plaintiff, an order of ex-parte interim injunction as prayed was granted in O.A.No.359, 360 and 362 of 2020. The said orders of injunction are still in force.

3. It is also to be mentioned that pending the proceeding, the plaintiff had entered into a Memo of Compromise with the 4th, 11th, and 15th defendants. The Memos of Compromise have also filed into the Court and the Court had also passed a judgment dated 25.02.2021 recording the Memo of Compromise as against the 4th defendant and partly decreed the suit with respect to reliefs A, B, C and D relating to grant of injunction as stated above and dismissed the suit as against the 4th defendant with respect to reliefs.

4. The 3rd defendant had filed A.Nos.423 of 2021, 424 of 2021 and 425 of 2021 seeking to vacate the interim injunction in O.A.Nos.359 of 2020, 360 of 2020 and 361 of 2020.

5.The plaintiff, Manohar Singh, Proprietor, trading as M/s.Singh Mehendi Industries, having address at Bengaluru, had filed the suit as against the 17 defendants seeking protection of the registered copyright with respect to the artistic packaging and also seeking protection of the registered trademark 'BANSURI' from infringement. It is to be noted that the plaintiff is carrying on business in manufacturing and marketing various Mehendi products which are categorized as Herbal / Ayurvedic Cosmetic Products. They manufacture and market Mehendi Powder, Mehendi Paste and Herbal Hair Dyes. The plaintiff has its head office at Bengaluru and has various other offices across the country including M/s.Singh Mehendi & Cosmetics at Rajasthan, Singh Mehendi Industries Private Limited and Singh Mehendi Industries, a Partnership Firm. All these entities have been constituted as one single unit. The plaintiff claimed that their business has spread throughout the length and breadth of the country.

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6.The plaintiff seeks protection of their copyright and trademark (Logo and Trademark word) and a pictorial representation of the same is shown below:



7.The plaintiff claimed that they are in this business from the year 1997 and have been using the mark 'BANSURI' both logo and word mark and also the copyright in the artistic design and colour scheme continuously and they also claimed that they have built up substantial market across the country. This reflected in the turnover for the financial year 2019-2020 which was Rs.62,51,73,490/- till 17.03.2020. They had also expended a sum of Rs.4,07,59,456/- in promoting their products.

8.In the plaint, it had been further stated that the plaintiff had come across the 3rd defendant, who attempted to copy and imitate the

plaintiff's registered copyright over the artistic packing and registered trademark 'BANSURI'. This was in the year 2012. The plaintiff gave a complaint before the jurisdictional Police Station on 26.07.2012 under various sections of the Indian Penal Code and Copyright Act, 1957. The defendants stopped the sales of the infringing products. Therefore, a closure report was filed. At that time, the 3rd defendant had projected their marks as STAR GOLD and SHAMA and though they resembled the mark of the plaintiff, a closure report had been filed.

9.The 3rd defendant had applied for registration for the word 'BANSURi' on 10.08.2012 under trademark No.2377817 claiming usage from 01.04.2003. This was registered on 27.03.2018.

10.The 3rd defendant thereafter, commenced sale of products bearing an identical and deceptively similar artistic packaging with the trademark 'BANSURi'. The package of the 3rd defendant product is shown below:-



11.It had been stated that the goods of the 3rd defendant bear the identical and deceptively similar packaging and the same trademark. The plaintiff therefore filed O.S.No.7454 of 2018 before the City Civil Court at Bengaluru. The plaintiff also filed an application to rectify the registered trademark of the defendant before the Intellectual Property Appellate Board in ORA/31/2019/TM/AMD. The said petition is pending. The City Civil Court, Bengaluru had granted an order of interim injunction on 11.11.2019 protecting the plaintiff's registered copyright No.A74421/2005 and registered trademark No.1332625. However, injunction was not granted restraining the defendants from passing of their products as that of the plaintiff, since no such relief was sought. The plaintiff had later filed an application claiming such a relief which is pending.

12. It had been further stated in the plaint, that on or about 12.03.2020, the plaintiff received complaints that the defendants are also marketing their products within the jurisdiction of this Court. The plaintiff purchased the products on 16.03.2020. It had the name of the 1st defendant as its marketer and the 3rd defendant as a manufacturer. The name of the 2nd defendant was given as the contact information name. It had been claimed that the other defendants are assisting by selling the products of the defendant to the detriment of the plaintiff.

13. The plaintiff claimed that the colour scheme and trade dressage of the package of the both products are same. The products are same. The names are also the same. It was therefore stated that there was every possibility of the general customers being misled into believing that the products of the 3rd defendant are actually the products of the plaintiff. It is under these circumstances, that the suit had been filed and the applications had been filed seeking protection of the registered trademark and registered copyright of the plaintiff and also to restrain the 3rd defendant from passing off their products as if they are the products of the plaintiff. As stated, interim injunction had been granted and is still in force.

14.A counter affidavit had been filed by the 3rd defendant. The 3rd defendant, Kalu Singh Rathore, Proprietor M/s.Aditiya Mehandi Product, in Rajasthan, had stated that he is doing business in the State of Rajasthan, Madhya Pradesh, Uttar Pradesh and Andhra Pradesh and also in the States of Punjab, Haryana, Odisha, Bihar and in the North Eastern States from the year 2003 manufacturing and selling Mehanti Cones under the brand name 'BANSURI'. The 3rd defendant claimed that they had adopted the said name and the word 'BANSURI' means Flute in Hindi language. It is a common word. In the year 2012, the 3rd defendant had applied for registration of the brand name 'BANSURI' with the Ahmedabad Trademark Registry as a word mark under Class 3 for Mehandi Cones and Powder in A.No.2377817. The mark was advertised in Trade Marks Journal No.1835 and therefore, a Certificate of Registration was issued.

15.It had been stated that notice was also received from the Intellectual Property Appellate Board questioning that registration. However, the registration still subsist. It had been further stated that there is no cause of action for filing of the suit. It had been stated that the Civil Court does not have the authority to decide the validity of the registration

of the trademark, since a petition is pending before the Intellectual Property Appellate Board. It had been stated that the suit itself is not maintainable.

16. Reliance had been placed on Section 124 of the Trade Marks Act 1999. It had been reiterated that the 3rd defendant had been using the mark 'BANSURI' from 2003. It had been stated the plaintiff has no business in Rajasthan or in any of the North Indian States or in Andhra Pradesh or Kerala where the 3rd defendant has business from 2003 and 2007. The 3rd defendant further denied that the plaintiff has exclusive right over the trademark 'BANSURI' and over the copyright of the artistic images in the package. It had been stated that the 3rd defendant has no knowledge about the plaintiff or its reputation. It had been stated that the directions of the City Civil Court, Bengaluru, had been complied with, wherein, injunction had been granted from using the copyright and artistic package material of the plaintiff. It had been stated that the 3rd defendant is a registered user of the mark 'BANSURI' and thereby entitled to use the mark. It had been stated that the original applications should be dismissed.

17.A re-joinder had been filed by the plaintiff to the said counter affidavit. It had been stated that both the plaintiff and the 3rd defendant are in the same line of business, namely, Mehendi cones. The averments made in the counter affidavit had been denied. It had also been denied that the 3rd defendant can claim the mark 'BANSURI' as his brand name since rectification has been sought and it is pending before the Intellectual Property Appellate Board. It had been reiterated that the plaintiff was entitled for injunction, since a prima facie case had been made out. The assertion of the 3rd defendant that they are the prior users from the year 2003, had also been denied. It had been stated that the Court has jurisdiction to examine the issues relating to injunction even if matters are pending before the Intellectual Property Appellate Board. The assertion that the plaintiff has no business in Rajasthan or in any other North Indian State or in Andhra Pradesh and Kerala has also been denied. It was again reiterated that the plaintiff is entitled for injunction and that the 3rd defendant is a dishonest user of the mark 'BANSURI'.

18.As stated, the 3rd defendant filed A.Nos 423, 424 and 425 of 2021 seeking to vacate the orders of interim injunction granted in O.A.Nos.359, 360 and 362 of 2020. The affidavit filed in support of the

said application is a replication of the counter affidavit filed with respect to O.S.Nos.359 to 362 of 2020. As a matter of fact, even the affidavit is termed as counter affidavit.

19.The plaintiff had filed their counter which is also an replication of their affidavit filed in O.S.Nos.359 to 362 of 2020. In view of the said facts, the averments made therein are not repeated, since they had been extracted above.

20.Heard arguments advanced by Mr.Rajeev Kumar Jain, learned Senior Counsel appearing on behalf of the applicant in O.A.Nos.359 to 362 of 2020 and Mr.R.Priyakumar, learned counsel appearing for the applicant in A.Nos.423 to 425 of 2021.

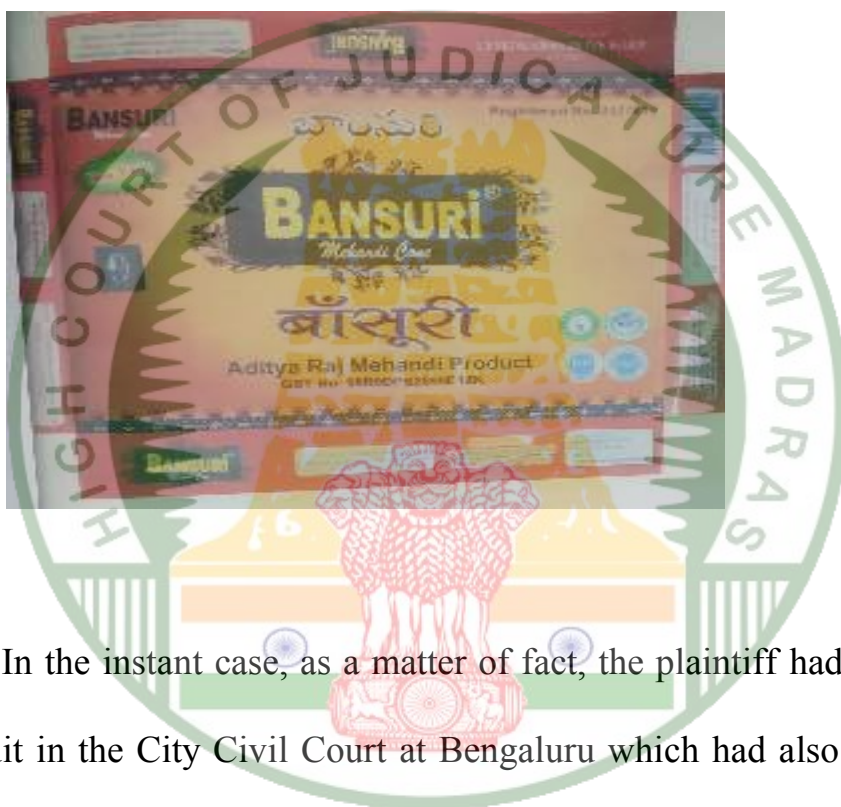
21.The applicant in A.Nos.423 of 425 of 2021 is the 3rd defendant in the suit. Therefore, for the sake of convenience the parties would be referred as plaintiff and the 3rd defendant.

22.It is the contention of the plaintiff that they have obtained registration of copyright with respect to the colour combination and

artistic work in the package of their product Mehandi cone and they have also obtained registration of the trademark 'BANSURI' both as a logo and as a word mark. The plaintiff claimed that they are the original creators and first users of the trademark and registered proprietors of the artistic package of the trademark 'BANSURI'. They have obtained registration under the Copyright Act, 1957 in No. A-74421/2005 and registration under the Trade Marks Act, 1999 in Nos.1332625 and 1332872. At the cost of repetition, the pictorial representation of the plaintiff's copyright and trademark both logo and word are reproduced below:



23.The plaintiff is aggrieved by the usage of the 3rd defendant of the very same mark 'BANSURI' also for Mehandi products and also in the manner in which the said product is marketed. At the cost of repetition the 3rd defendant's package is shown below:



24.In the instant case, as a matter of fact, the plaintiff had already filed a suit in the City Civil Court at Bengaluru which had also granted an order of interim injunction restraining the 3rd defendant herein from infringing the registered trademark and copyright of the plaintiff. However, since no application was filed seeking injunction from passing off, such orders were not granted.

25.A casual glance at the pictorial representation of the two pictures shown above would indicate that there is a strong resemblance between the two pictures and there is every possibility of confusion being caused in the minds of the general public who would be misled into thinking that the products of the 3rd defendant are actually the products of the plaintiff. The resemblance is so striking. Since the distribution channels are the same, even traders would be equally confused. The contention of the 3rd defendant that the plaintiff has no sales in Rajasthan or in North Indian States or in Andhra Pradesh or in Kerala are matters to be decided in the course of trial. Whether the plaintiff is the prior user or the 3rd defendant was the prior user of the mark is again an issue to be decided during trial. I hold that the plaintiff has made out a prima facie case owing to their registration of both copyright and trademark.

26.The pendency of the petition before the Intellectual Property Appellate Board will not be a bar to examine the issues relating to injunction, in view of Section 124 (5) of the Trade Marks Act, 1999.

27.The said provision is as follows:

“124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc.

.....

.....

(5) The stay of suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction, directing account to be kept, appointing a receiver or attracting any property), during the period of the stay of the suit.”

28.The cause of action arose within the jurisdiction of this Court since the plaintiff has alleged that the 3rd defendant products are available in Chennai. If the 3rd defendant were to contest this fact they can do so only by joining in the trial. It is also seen that the plaintiff has gained substantial goodwill and their turnover for the financial year 2019-2020 had been given as Rs.62,51,73,490 till 17.03.2020. For the very same period they had also expended a sum of Rs.4,07,59,456/- towards marketing, advertisements and travelling expenses. It is thus seen that the plaintiff is actively involved in promoting their products.

29. There is a further averment in the plaint that a Police complaint was given against the 3rd defendant and the same had been closed. The contention of the plaintiff is that the 3rd defendant produced packages not in the name of 'BANSURI' but in the trademarks STAR GOLD and SHAMA. These are also facts that can be established only during trial.

30. The contention raised by the learned counsel for the 3rd defendant that they have a valid registration cannot be a deterrent for grant of injunction with respect to passing off. As a matter of fact, the 3rd defendant has suffered an order of injunction with respect to infringement of copyright and trademark. It is the specific allegation of the plaintiff that after that injunction order by a competent Court in Bengaluru,, the products started to appear in Chennai. The balance of convenience is certainly in favour of the plaintiff owing to their registrations and the fact that the registration of the defendants is under challenge before the Intellectual Property Appellate Board.

31. In *Parle Products (P) Limited., Vs. J.P., and Co., Mysore* reported in *AIR 1972 SC 1359*, the broad and essential features to be considered to examine whether there has been infringement had been

stated as follows:-

“9. It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. Anyone in our opinion who has a look at one of the packets to-day may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs goods, he might easily mistake the defendants' wrapper for the plaintiffs if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered.”

32. In *Cadila Health Care Ltd., Vs. Cadila Pharmaceuticals Ltd.*,

reported in *AIR 2001 SC 1952*, the factors to be considered while examining the action for passing off had been stated as follows:-

“42. Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered:

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 resemblance 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.”*

33. In **(2016) 2 SCC 683 S.Syed Mohideen Vs. P.Sulochana Bai**, after trial, the plaintiff's suit was decreed. That decree was upheld by a Division Bench of this Court. The matter finally reached the door steps of the Hon'ble Supreme Court. It was a *lis* between “Iruttukadai Halwa” and “Tirunelveli Iruttukadai Halwa”. The Hon'ble Supreme Court held that even in a case when both marks are registered, the action of passing off will lie since the latter user of the mark/name cannot misrepresent his business as that of the business of a prior right holder. It was held that the registration of the trademark by the defendant is no defence to a passing off action. It was held as follows:-

“31.1. Traditionally, passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation caused in the course of trade and for prevention of resultant damage on account of the said misrepresentation. The

three ingredients of passing off are goodwill, misrepresentation and damage. These ingredients are considered to be classical trinity under the law of passing off as per the speech of Lord Oliver laid down in the case of **Reckitt & Colman Products Ltd. v. Borden Inc (1990) 1 WLR 491: (1990) 1 All E.R. 873 (HL)** which is more popularly known as "Jif Lemon" case wherein the Lord Oliver reduced the five guidelines laid out by **Lord Diplock in Erven Warnink v. Townend & Sons Ltd. [1979] AC 731, 742 (HL)**] (the "Advocate Case") to three elements: (1) Goodwill owned by a trader, (2) Misrepresentation and (3) Damage to goodwill. Thus, the passing off action is essentially an action in deceit where the common law rule is that no person is entitled to carry on his or her business on pretext that the said business is of that of another. This Court has given its imprimatur to the above principle in the case of **Laxmikant V. Patel v. Chetanbhat Shah (2002) 3 SCC 65**.

31.2. The applicability of the said principle can be seen as to which proprietor has generated

the goodwill by way of use of the mark name in the business. The use of the mark/carrying on business under the name confers the rights in favour of the person and generates goodwill in the market. Accordingly, the latter user of the mark/name or in the business cannot misrepresent his business as that of business of the prior right holder. That is the reason why essentially the prior user is considered to be superior than that of any other rights. Consequently, the examination of rights in common law which are based on goodwill, misrepresentation and damage are independent to that of registered rights. The mere fact that both prior user and subsequent user are registered proprietors are irrelevant for the purposes of examining who generated the goodwill first in the market and whether the latter user is causing misrepresentation in the course of trade and damaging the goodwill and reputation of the prior right holder/former user. That is the additional reasoning that the statutory rights must pave the way for common law rights of passing off.

32. Thirdly, it is also recognized

principle in common law jurisdiction that passing off right is broader remedy than that of infringement. This is due to the reason that the passing off doctrine operates on the general principle that no person is entitled to represent his or her business as business of other person. The said action in deceit is maintainable for diverse reasons other than that of registered rights which are allocated rights under Recent Civil Reports the Act. The authorities of other common law jurisdictions like England more specifically **Kerry's Law of Trademarks and Trade Names, Fourteenth Edition, Thomson, Sweet & Maxwell South Asian Edition** recognizes the principle that where trademark action fails, passing off action may still succeed on the same evidence. This has been explained by the learned Author by observing the following:--

15-033 "A claimant may fail to make out a case of infringement of a trade mark for various reasons and may yet show that by imitating the mark claimed as a trademark, or otherwise, the Defendant has done what is calculated to pass off his goods as those of the claimant. A claim in "passing off" has

generally been added as a second string to actions for infringement, and has on occasion succeeded where the claim for infringement has failed””.

The Hon'ble Supreme Court had laid down that even if there is a registered mark, the prior proprietor of registration can still maintain an Application for passing off.

34.It would only be appropriate that the 3rd defendant awaits decision of the Intellectual Property Appellate Board. However, I hold that owing to their continuous usage of the mark 'BANSURI', the plaintiff has made out a *prima facie* case and this is strengthened by their registration both under the Trade Marks Act, 1999 and under the Copyright Act, 1957. Any infringement necessarily will have to be struck down by the Court. It would only be appropriate that the Court also recognizes the fact that the plaintiff has been in the business for a considerable period of time. The contention of the 3rd defendant that they have been in the business earlier to that of the plaintiff is a fact which is to be asserted and decided during cross-examination.

35.In view of the above reasons, particularly in view of the fact that the 3rd defendant has moved very close to the colour scheme and

trade dressage of the plaintiff, as is evident from a casual glance of the pictorial material used by the 3rd defendant, the orders of interim injunction is made absolute pending disposal of the suit. An order of interim injunction is also granted in O.A.No.361 of 2020 till disposal of the suit. Accordingly, the Original Applications are allowed. The Applications in A.Nos.423, 424 and 425 of 2021 filed by the 3rd defendant to vacate the order of interim injunctions granted in O.A.Nos.359, 360 and 362 of 2020 are dismissed. No order as to costs.

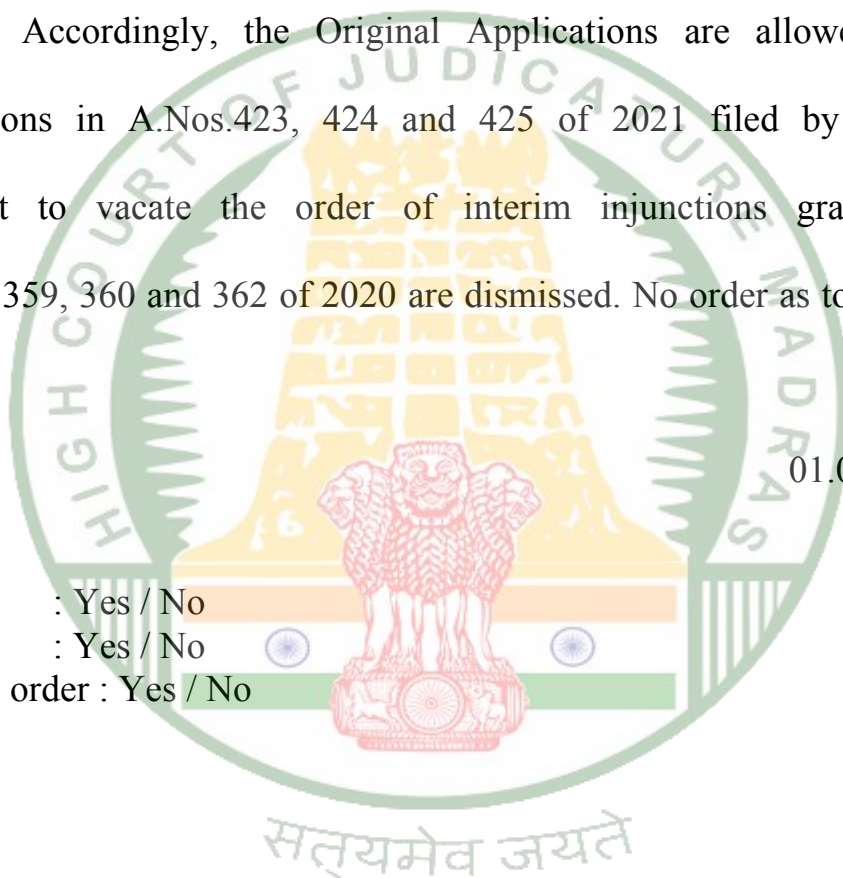
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Index : Yes / No

Internet : Yes / No

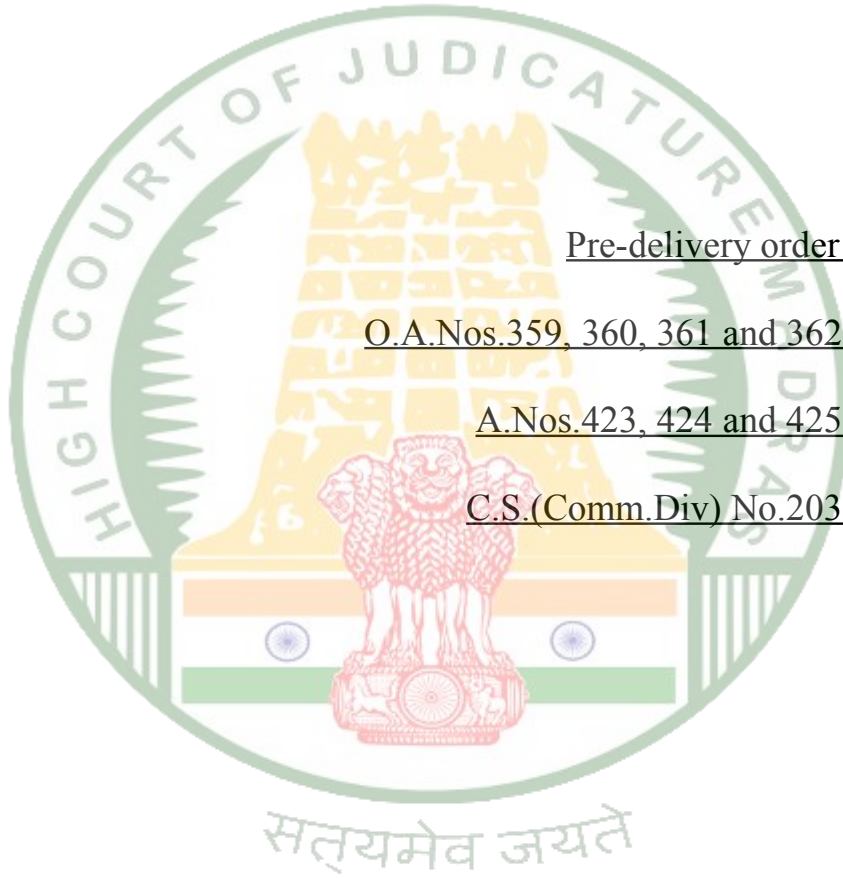
Speaking order : Yes / No



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C.V.KARTHIKEYAN, J.,

smv



Pre-delivery order made in
O.A.Nos.359, 360, 361 and 362 of 2020
and
A.Nos.423, 424 and 425 of 2021
in
C.S.(Comm.Div) No.203 of 2020

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