

13.07.2022
KC(24)

F.M.A. 785 of 2022
Vanesa Care Private Limited and Anr.
-versus-
McNroe Consumer Products Private
Limited and Ors.

Mr. Ranjan Bachawat, Sr. Adv.,
Mr. Sayan Roy Chowdhury,
Mr. Mohan Vidhani,
Mr. Avijit Dey,
Mr. Sumit Agarwal.....For the appellants.

Mr. Sayantan Bose,
Mr. Rajdeep Shaw,
Mr. Saptarshi Das.....For the respondents.

We admit the appeal against the ex-parte ad-interim order dated 22nd December, 2021 made by the Judge-in-charge, Bench-VI, learned City Civil Court, Calcutta in Title Suit No. 1604 of 2021.

By the impugned order the appellants/defendants have been restrained from “using, marketing and advertisement under the mark ‘TEMPTATION’ and the said artistic representation of the said trade mark and also from passing of their goods under impugned mark TEMPTATION”.

As will appear from our observations below, we are in a position to dispose of this appeal by dispensing with all formalities.

The appellants/defendants claim to be the registered proprietor of the word mark “Temptation” for

use in “cosmetics, perfumeries, toiletries included in class 3” according to the certificate of registration issued by the Trade Marks authority.

Mr. Ranjan Bachawat, learned senior advocate for the appellants contends that his clients are using this word mark since 2002.

The respondents/plaintiffs is the registered proprietor of a label mark comprising, inter alia, of the word “Temptation”.

Mr. Sayantan Bose, learned advocate for the respondents/plaintiffs submits that his client has been using this label mark from 1998 whereas Mr. Bachawat submits that admittedly this use is from 2007.

Mr. Bachawat submits that as would appear from the relief (a) claimed in the plaint, the foundation of the cause of action of the respondent/plaintiff is infringement of copyright in “Temptation”. The impugned judgment and order narrates the case of the respondents/plaintiffs as if it was for infringement of their trade mark.

Mr. Bachawat placed Section 28(3) of the Trade Marks Act, 1999 and argued that a proprietor of a registered trade mark could not maintain an action for infringement against another.

Both learned counsel, however, admitted that a passing off action was maintainable. Mr. Bose

emphasises that his action is on passing off and on that basis the impugned order has been passed.

In our opinion, the impugned judgment and order is totally bereft of reasons which were required to be advanced by the learned judge while considering grant or refusal of grant of an ad-interim order in such an action. There is no prima facie finding regarding user or length of use of the respective marks by the parties.

The registration of the respective marks and the effect thereof are not discussed. Even if the respondents alleged passing off, to what extent the appellants were passing off their goods as those of the respondents, ought to have been discussed even shortly in the judgment.

Moreover, the fact that the notice to “cease and desist” was issued by the respondents/plaintiffs on 22nd December, 2020, replied to by the appellants/defendants on 4th January, 2021 but the suit instituted by the respondents/plaintiffs a year later was an important consideration before grant of an order of injunction.

When the respondents/plaintiffs could wait for one year to file the suit why could not the application for injunction have been considered in the presence of the appellants/ defendants and upon hearing them?

The appellants have also filed this appeal about five months after the order of injunction. This is

explained by their learned counsel by saying that his clients had waited to contest the matter on its returnable date, but for a substantial period of time, the bench was not sitting. Hence, they were compelled to file the appeal before this court.

We are of the view that the above facts need to be established at the trial court level. Whether the respondents/plaintiffs are entitled to an order of injunction or not, must be decided upon full prima facie consideration of the above facts, upon hearing the appellants/defendants and by a reasoned order.

We order accordingly.

If the bench is not available, the learned Chief Judge, City Civil Court shall assign this injunction application to another bench within a week of communication of this order to hear it out as expeditiously as possible from the 'Motion' stage.

Before exchange of affidavits or written objection, the learned trial court has to come to a decision whether at all an interim order of injunction should be granted in favour of the respondents/plaintiffs.

Since the impugned order of injunction is continuing for a period of about seven months, we limit the said order of injunction till 31st July, 2022. After 31st July, 2022 it shall automatically expire, if not discharged or varied earlier by the learned trial court.

Within that time, the learned court shall consider the application for injunction taken out by the respondents/plaintiffs at the “Motion” stage in the presence of the appellants/ defendants. The learned trial court shall endeavour to dispose of the interim application after exchange of affidavits within three months from date.

The appeal (F.M.A. 785 of 2022) is accordingly disposed of.

(I.P. MUKERJI, J.)

(SUBHENDU SAMANTA, J.)