

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

**901 CIVIL APPLICATION NO. 4817 OF 2021
IN
APPEAL FROM ORDER NO. 11 OF 2021**

**BABA WHEEL ALIGNMENT THR ITS PROPRIETOR MOHAMMED FIROZ
MOHAMMED SHAFI
VERSUS
SAILANI BABA WHEEL ALIGNMENT THR ITS PROPRIETOR SAYYAD
KADAR SAYYAD SHABBIR**

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Mr. R. S. Deshmukh, Sr. Advocate with Ms Yugandhara A. Namde i/b
Mr. Devang R. Deshmukh, Advocate for Applicant
Advocate for Respondent : Mr. Mangesh R. Jadhav

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CORAM : RAJESH S. PATIL, J.

DATE : DECEMBER 14, 2022

PER COURT : -

1. By this Civil Application in Appeal from Order, the applicant seeks direction to the respondent/original defendant that, till the decision on the Appeal from Order the defendant be restrained from carrying out the business in the name of "Sailani Baba Wheel Alignment".

2. This matter was extensively heard yesterday. Respondent was present in the Court yesterday along with his Advocate, who showed me some photographs of a sign board at front of a shop wherein name "Sailani Baba" is mentioned. Respondent also informed this Court

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that from the year 2017 he is not using the trademark as shown on page no. 48 of this application. Hence, this Court directed the respondent / defendant to file an affidavit to this effect and the matter was adjourned to today.

3. When the matter was called out today, the advocate for the respondent / original defendant has tendered an affidavit along with four photographs. The photographs annexed with the affidavit dated 13.12.2022 filed by respondent / defendant shows a name in big font on a flex sign board i.e. "Sailani Baba". Advocate for the applicant / original plaintiff has countered this submission and shown before this Court photographs taken inside the subject shop of the respondent / defendant. The photographs clearly show the name on prominent places as "BABA". Further, the learned Senior Counsel for the applicant / original plaintiff has also placed on record the Respondent's / Original Defendant's 'Cash Credit Memo' of shop by name Sailani Baba. The said Cash Credit Memo shows that the word "Sailani" has been affixed by a sticker above "BABA".

4. Therefore, as to when the sticker "Sailani" is affixed on Cash Credit Memo, and whether it is affixed to all the Cash Credit Memos, is questionable. Taking into consideration over all conduct of respondent / defendant, this Court is not satisfied with the same.

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5. The original plaintiff had filed a suit for a declaration, permanent injunction, damages and passing off under the Trademark Act against the respondent / defendant. It was the case of the applicant / original plaintiff that they are using brand name “Baba Wheel Alignment” from the year 2003. They have further stated that they are in the business of wheel alignment from the year 1991. They had applied for a device mark in the year 2013 and the said device mark was granted to them in the year 2017. They have further stated that they have also applied for registration of word mark “Baba Wheel Alignment” by preferring an application bearing No. TM 3744203 and 3744204 in Class 37 on 03.02.2018 and the same is pending. It is further stated that earlier a suit was filed by the plaintiff against the defendant for peaceful possession of a shop before the Civil Court, Aurangabad, being Reg.C.S. No. 1596/2012. However, in the said suit, a Compromise Purnis was filed and as per paragraph ‘E’ of the the compromise purnis, defendant had agreed not to carry out the business in the name of Baba Wheel Alignment and plaintiff / applicant herein is entitled to continue with his own business in the trade name of “Baba Wheel Alignment” with having exclusive right related to the said trademark. It is further case of the plaintiff / applicant that defendant committed an offence of passing off and unfair trade and unfair competition by engaging in the same business and using identical, sgp

deceptively and phonetically similar trademark / brand name with logo initially as **“(S) Baba Wheel Alignment”** and thereafter **“Sailani Baba Wheel Alignment”**.

6. The plaintiff hence filed suit for declaration, injunction, damages and passing off and had also moved an Application Exh. 5 for interim reliefs, however, the learned lower Court by its order dated 29.01.2021, rejected the said application for temporary injunction. Against the said order, the present Appeal from Order is filed before this Court.

7. I have gone through the impugned order and I have noted the submissions made by both the parties. I have also seen the photographs at page nos. 48 of the Civil Application. Perusal of same clearly shows that the word “Sailani” is written in a very small font and the word “Baba” is written in a very large font. In earlier suit, the Defendant had agreed in Compromise Pursis, not to carry out business in the name of “Baba Wheel Alignment” and only plaintiff is entitled to carry out business in the trade name “Baba Wheel Alignment”.

8. The Applicant / Plaintiff is owner of a registered device mark and is using the said device mark and more particularly in Aurangabad. They have attached their sales figures to the Plaint which
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shows that there is great reputation and goodwill attached to the said device mark. The *prima facie* case and balance of convenience rests in favour of the Plaintiff. In **Cadila Health Care Ltd. Versus Cadila Pharmaceuticals Ltd.** reported in (2001) 5 SCC 73, it is held in paragraph nos. 18, 19, 20 and 35, which reads thus:

18. We are unable to agree with the aforesaid observations in Dychem case. As far as this Court is concerned, the decisions in the last four decades have clearly laid down that what has to be seen in the case of a passing off action is the similarity between the competing marks and to determine whether there is likelihood of deception or causing confusion. This is evident from the decisions of this Court in the cases of National Sewing Thread Co. Ltd. case, Corn Products Refining Co. case, Amritdhara Pharmacy Co. case, Durga Dutt Sharma case and Hoffmann-La Roche & Co. Ltd. case. Having come to the conclusion, in our opinion incorrectly, that the difference in essential features is relevant, this Court in Dyechem case sought to examine the difference in the two marks 'Piknik' and 'Picnic'. It applied three tests, they being: 1) is there any special aspect of the common feature which has been copied? 2) mode in which the parts are put together differently i.e. whether dissimilarity of the part or parts is enough to make the whole thing dissimilar, and 3) whether, when there are common elements, should one not pay more regard to the parts which are not common, while at the same time not disregarding the common parts?. In examining the marks, keeping the aforesaid three tests in mind, it came to the conclusion, seeing the manner in which the two words were written and the peculiarity of the script and concluded (SCC p.597, para 39) that "the above three dissimilarities have to be given more importance than the phonetic similarity or the similarity in the use of the word PICNIC for PIKNIK".
19. With respect, we are unable to agree that the principle of phonetic similarity has to be jettisoned when the manner in which the competing words are written is different and the conclusion so arrived at is clearly contrary to the binding precedent of this Court in Amritdhara case (supra) where the phonetic similarity was applied by judging the two competing marks. Similarly, in Durga Dutt Sharma case, it was observed (AIR p.990, para 28) that

‘in an action for infringement, the plaintiff must, no doubt, make out that the use of the defendants mark is likely to deceive, but where the similarity between the plaintiffs and the defendants mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiffs rights are violated’.

20. Lastly, in Dyechem case, it was observed in para 54 as under: (SCC p. 600)

“54. ‘As to scope of a buyer being deceived, in a passing-off action, the following principles have to be borne in mind. Lord Romer, L.J. has said in *Payton & Co. v. Snelling, Lampard & Co.* (1900) 17 RPC 48 that it is a misconception to refer to the confusion that can be created upon an ignorant customer that the courts ought to think of in these cases is the customer who knows the distinguishing characteristics of the plaintiffs goods, those characteristics which distinguish his goods from other goods in the market so far as relates to general characteristics. If he does not know that, he is not a customer whose views can properly be regarded by the Court. (See the cases quoted in *National Sewing Thread & Co. Ltd. v James Chadwick & Bros. Ltd.* AIR 1948 Mad 481 which was a passing-off action.) In *Schweppes Case* (1905) 22 RPC 601 (HL) Lord Halsbury said, if a person is so careless that he does not look and does not treat the label fairly but takes the bottle without sufficient consideration and without reading what is written very plainly indeed up the face of the label, you cannot say he is deceived.”

These observations appear to us to be contrary to the decision of this Court in *Amritdharas* case (*supra*) where it was observed that the products will be purchased by both villagers and townsfolk, literate as well as illiterate and the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. A trade may relate to goods largely sold to illiterate or badly educated persons. The purchaser in India cannot be equated with a purchaser of goods in England. While we agree that in trade mark matters, it is necessary to go into the question of comparable strength, the decision on merits in *Dyechem* case does not, in our opinion, lay down correct law and we hold accordingly.

35. 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 are 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.

9. The observation made in this case are squarely applicable to the case at hand. I am *prima facie* satisfied that the trademark of the defendant is deceptively similar to that of the plaintiff. Irreparable injury would be caused to the reputation and goodwill of the Applicant / Plaintiff, if Defendant/Respondent is allowed to proceed ahead with his mark.

10. In view of aforesaid, the Civil Application is allowed in terms of prayer clause 'B'.

[RAJESH S. PATIL]
JUDGE