IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
INTERIM APPLICATION NO. 836 OF 2022
IN
COMMERCIAL IP SUIT NO. 473 OF 2021

Paras Products	…	Applicant / Orig. Plaintiff
vs.		
SPV Laboratories OPC Pvt. Ltd. and 2 others	…	Defendants

WITH
INTERIM APPLICATION (LODGING) NO. 28274 OF 2021
IN
COMMERCIAL IP SUIT NO. 473 OF 2021

SPV Laboratories OPC Pvt. Ltd.	…	Applicant / Orig. Defendant No.1
In the matter between:		
Paras Products	…	Plaintiff
vs.		
SPV Laboratories OPC Pvt. Ltd. and 2 others	…	Defendants

Mr. Yatin Khochare a/w. Mr. Minesh Andharia and Mr. Hardik Sampat, i/by. Krishna & Saurastri Associates LLP for applicant in IA/836/2022 and for plaintiff.

Mr. Rakesh K. Singh a/w. Ms. Shivani Soni for applicants in applicant in IA(L)/28274/2021 and for defendants.

CORAM : MANISH PITALE, J
DATE : 28th NOVEMBER, 2022

P.C. :

. By this order, two applications are being decided, one filed by the defendants for rejection of plaint under Order VII Rule 11 of the Code of Civil Procedure, 1908 (CPC), and the other is an application filed on behalf of the plaintiff under Order XXXIX Rules 1 and 2 of CPC for grant of interim reliefs/temporary injunction.

2. Insofar as the application filed on behalf of the defendants for rejection of plaint under Order VII Rule 11 of CPC is concerned, Mr. Singh, learned counsel appearing for defendants has referred to the contents of the said application and it is contended that the plaint deserves to be rejected in the light of Section 12A of the Commercial Courts Act, 2015, for the reason that the plaintiff failed to first exhaust the remedy of pre-institution mediation and settlement. It was specifically submitted that there was no urgency in the matter at all, which was manifested from the admitted facts in the present case i.e. the plaintiff having become aware of the registered trademarks of the defendants, as far back as in November, 2019 and filing the present suit after about two years on 29th October, 2021. It was submitted that in the interregnum, the plaintiff also challenged the trademarks of defendants before the Registrar of Trade Marks in rectification proceedings, apart from opposition proceedings in applications filed by the defendants for registration of further trademarks. Learned counsel appearing for the defendants placed reliance on judgment of this Court in the case of *Deepak Raheja vs. Ganga Taro Vazirani* **(2021 DGLS (Bom.) 1087** (Judgment and order dated 1st October, 2021 passed in Commercial Appeal (L) No.11950 of 2021).

3. On the other hand, Mr. Khochare, learned counsel appearing for the plaintiff submitted that there was no substance in the contention raised on behalf of the defendants, for the reason that the plaintiff having approached this Court in October, 2021, could not be a ground to claim that there was no urgency in the matter or that the exception culled out in Section 12A of the

Commercial Courts Act, 2015, was not applicable in the facts of the present case. It was submitted that there was obvious urgency in the matter, for the reason that the plaintiff is claiming reliefs on the basis of registration of its trade mark, which dates back to the year 2004 and the plaintiff is consistently using the same for years and has earned substantial goodwill. Each day the defendants infringe the registered trademark and pass off their goods as those of the plaintiff, it was entitled to move this Court to seek urgent interim reliefs, thereby showing that Section 12A of the Commercial Courts Act, 2015, did not apply to the facts of the present case. Reliance was placed on the judgment of Supreme Court in the case of *M/s. Patil Automation Private Limited and others v/s. Rakheja Engineers Private Limited* (**Judgment and order dated 17th August, 2022 passed in Civil Appeal arising out of SLP (C) No.14697 of 2021**).

4. This Court has perused Section 12A of the Commercial Courts Act, 2015. The applicability of the said Section specifically concerns a situation where a Suit does not contemplate any urgent interim reliefs under the Act. It is only in those cases, where urgent interim relief cannot be contemplated, that the aforesaid provision would apply and it would be mandatory for the plaintiff to exhaust the remedy of pre-institution mediation and settlement, before filing the suit. In this regard, learned counsel for the plaintiff is justified in relying upon the judgment of Supreme Court in the case of **M/s. Patil Automation Private Limited and others v/s. Rakheja Engineers Private Limited** (*supra*), wherein it was held as follows:

> ‘54. The potential of Section 89 of the CPC for resolving disputes has remained largely untapped on account of the fact that mediation has become the product of volition of the parties. Courts, no doubt, have begun to respond

> positively. However, there was a pressing need to decongest the trial courts, in commercial matters in particular, as they bear the brunt of docket explosion. It is noteworthy that Section 12A provides for a bypass and a fast-track route without for a moment taking the precious time of a court. At this juncture, it must be immediately noticed that the Law-giver has, in Section 12A, provided for pre- institution mediation only in suits, which do not contemplate any urgent interim relief. Therefore, pre- institution mediation has been mandated only in a class of suits. We say this for the reason that in suits which contemplate urgent interim relief, the Law-giver has carefully vouch-safed immediate access to justice as contemplated ordinarily through the courts. The carving out of a class of suits and selecting them for compulsory mediation, harmonises with the attainment of the object of the law. The load on the Judges is lightened. They can concentrate on matters where urgent interim relief is contemplated and, on other matters, which already crowd their dockets.'

5. Applying the said position of law, which obviously emanates from a bare reading of Section 12A of the Commercial Courts Act, 2015, this Court is of the opinion that there is no substance in the ground raised on behalf of the defendants while seeking rejection of plaint under Order VII Rule 11 of the CPC.

6. Reliance placed on judgment of this Court in **Deepak Raheja vs. Ganga Taro Vazirani** (*supra*) is misplaced, for the reason that the appeal was allowed by the Division bench in the said case, due to the fact that the learned Single Judge therein had proceeded on the basis that Section 12A of the Commercial Courts Act, 2015, was merely a procedural requirement and that it was not necessary to examine whether, in the facts of a given case, there was necessity of exhausting the remedy of pre-institution mediation.

7. In the present case, the plaintiff is claiming urgent interim relief on the basis that it holds a registered trade mark since the year 2004 and that the material on record indicates that the defendants entered the market and obtained registration for a deceptively similar/identical mark in the year 2017. This Court is of the opinion that merely because the plaintiff in the present case first instituted rectification proceedings against the defendants as also opposition proceedings in pending applications, it would not disentitle the plaintiff from claiming that urgent interim relief is necessary, particularly because each day the defendants infringe the registered trade mark of the plaintiff, the cause of action arises not only for seeking final relief but for claiming urgent interim relief also.

8. In view of the above, there is no substance in Interim Application (Lodging) No.28274 of 2021, preferred by the defendants seeking rejection of plaint and accordingly, it is dismissed.

9. Insofar as the application for grant of interim reliefs/temporary injunction filed by the plaintiff under Order XXXIX Rules 1 and 2 of CPC is concerned, elaborate submissions have been made by the learned counsel for the rival parties.

10. Learned counsel for plaintiff invited attention of this court to the pleadings in the plaint as well as the application to emphasize that it has been in the market since the year 2004 and that it holds registration of the trade mark 'GREENKURE', which dates back to 5th October, 2004. The registration pertains to Class 5, relatable to medicinal and pharmaceutical preparations. The product of the plaintiff specifically pertains to treatment for pain relief. Learned counsel for the plaintiff relied upon the documents

placed on record, which demonstrate its presence in the market since the year 2004. It is submitted that alongwith the plaint, copies of invoices dating back to June, 2007 onwards were placed on record to indicate the extent and duration of presence of the product of the plaintiff with the registered trade mark. Reliance was placed on certificate issued by Chartered Accountant showing the sales turnover of the plaintiff in respect of the said product from the year 2004-2005 to 2020-2021. The sales figure for the year 2020-2021 is shown to be Rs.34,78,930. Attention is also invited to advertisements and articles in the public domain from the year 2007, to emphasize upon the presence of the product of the plaintiff with the registered trade mark and the fact that it was in public domain for a long period of time.

11. It is pleaded on behalf of the plaintiff that in November, 2019, the plaintiff became aware about the existence of impugned products of defendants in the market, which were being sold under the trade mark 'GREENCURE'. The plaintiff claims to have undertaken search and it was found that a number of impugned marks were registered in the name of the defendants under Class 5 since the year 2017 onwards. Plaintiff also noticed that there were certain applications preferred by the defendants, also in Class 5 of the Schedule to the Trade Marks Act, 1999, for various medicinal and pharmaceutical preparations. Learned counsel for the plaintiff referred to a table presented across the bar, giving details of 10 rectification proceedings initiated by the plaintiff against the defendants and 9 opposition proceedings undertaken by the defendants in respect of proposed registration of trade marks.

12. Learned counsel for the plaintiff vehemently submitted that the plaintiff has placed on record sufficient material to make out a strong prima facie case in its favour, for the reason that it sufficiently indicates the presence of the plaintiff in the market since the year 2004 and the consistent presence of the product of the plaintiff till date. The material on record indicates the goodwill earned by the plaintiff in respect of the registered trade mark. It was submitted that even if the defendants had obtained the registration for the impugned trade mark, that in itself could not be a factor for denying interim reliefs to the plaintiff, for the reason that even if the stand taken on behalf of the defendants in the written statement and in the reply filed to the application was to be taken into consideration, the defendants admittedly entered the market, sometime in the year 2017 and all the registration certificates were obtained from the year 2017 onwards on ‘proposed to be used’ basis. It was submitted that prior use of the registered trade mark by the plaintiff sufficiently demonstrates that the application for grant of interim reliefs ought to be considered favourably by this Court, despite registration certificates obtained by the defendants for the impugned trademarks, for the reason that the impugned trade mark is identical and deceptively similar to the registered trade mark of the plaintiff. Reliance was placed on Full Bench judgment in the case of *Lupin Limited v/s. Johnson and Johnson* [**2015(1)Mh.LJ. 501**], wherein it was held that there could be no express or implied bar taking away the jurisdiction and power of the Civil Court to consider challenge to the validity of the trade mark at the interlocutory stage by way of prima facie finding.

13. Learned counsel for the plaintiff submitted that since the plaintiff had word mark registration in its favour, merely by replacing the alphabet ‘K’ with ‘C’, the defendants could not claim any distinctiveness in its mark. It

was submitted that the impugned mark being used by the defendants was phonetically similar and so was its idea as well as its structure similar to the registered trade mark of the plaintiff. Much emphasis was placed on the protection provided to a registered trade mark under the provisions of the Trade Marks Act, 1999, particularly, under Section 28 thereof, in support of the contentions raised on behalf of the plaintiff. It was submitted that the case of the defendants could not be said to be a case of honest concurrent use. Learned counsel then emphasized on the tests laid down in a series of judgments of the Supreme Court and this Court in such cases, concerning the plaintiff's claim for interim injunction/reliefs on the basis of infringement and passing off against the defendants. Much emphasis was placed on the fact that when the defendants had been dishonestly using the impugned mark in question, the aspect of balance of convenience lies in favour of the plaintiff and since the plaintiff had established all the three parameters for grant of interim reliefs, the present application ought to be allowed in terms of prayer clauses (a) and (b). Learned counsel for the plaintiff placed reliance on the judgements of Supreme Court in the case of *Kaviraj Pandit Durga Dutt Sharma v/s. Navaratna Pharmaceutical Laboratories,* (**AIR 1965 S.C. 980**), *S. Syed Mohideen v/s. P. Sulochana Bai*, [**(2016) 2 SCC 683**], *Midas Hygiene Industries (P) Ltd. and another v/s. Sudhir Bhatia and others*, [**(2004) 3 SCC 90**] and judgment of this Court in the case of *Bal Pharma Limited v/s. Centaur Laboratories Pvt. Ltd. and another*, [**2002 (24) PTC 226 (Bom)(DB)**].

14. On the other hand, Mr. Singh, learned counsel appearing for the defendants vehemently submitted that even if the position of law, as relied upon by the learned counsel for the plaintiff, was to be taken into consideration, its application to the facts of the present case would show that

no case was made out for grant of interim injunction as claimed. It was submitted that the word 'GREENCURE' is generic in nature and lacks distinctiveness and that a comparative analysis of the two marks would show that there was difference between the two and the aspect of the distinctiveness outweighed the similarities. It was submitted that the registered trade mark of the defendants consisted of the words 'green' and 'care' together with the words 'with respect to nature', which was completely distinct from the registered trade mark of the plaintiff i.e. 'GREENKURE' with alphabet 'K' written in a particular stylized manner. It was submitted that the products of the defendants were in a different line of business as compared to the product of the plaintiff. Much emphasis was placed on the sales turnover of the defendants concerning a number of products of the defendants to emphasize that the sales turnover and the amounts spent on advertisements by the defendants was far more than that of the plaintiff and that there could be no comparison between the two. It was submitted that such figures also indicate that the plaintiff had failed to make out *prima facie* case as regards loss suffered over a period of time. It was submitted that the defendants were honest concurrent users of their mark, for which they had registration certificate and in the light of the fact that the plaintiff had already instituted rectification proceedings, this Court may not grant interim injunction/relief as claimed on behalf of the plaintiff. It was submitted that the plaintiff had not only failed to make out a strong *prima facie* case in its favour, but the balance of convenience also does not lie in favour of the plaintiff. The volume of sales of the defendants concerning its various products ought to be taken into consideration by this Court. If the said figures were to be taken into consideration, it would be clear that the balance of convenience tilted in favour of the defendants and that therefore, the application deserved to be rejected.

15. By referring to a number of judgments of Supreme Court and this Court, the learned counsel for the defendants submitted that the plaintiff had not only failed to make out a *prima facie* case in respect of infringement, but there was no material on record to indicate that the plaintiff can claim passing off. Learned counsel for the defendants placed reliance on the judgment of Supreme Court in the case of *Skyline Education Institute (India) Private Limited v/s. S. L. Vaswani and another*, [**(2010) 2 SCC 142**] and judgment of Delhi High Court in the case of *FDC Limited v/s. Faraway Foods Pvt. Ltd.* (**Judgment and order dated 10th February, 2021 in I.A. No.18292/2019 in CS (Comm.) No.720/2019**).

16. Having heard learned counsel for the rival parties, this Court has taken into consideration the provisions of the Trade Marks Act, 1999, and the position of law clarified by the Courts in this context as regards the manner in which the material available before the Court is to be appreciated while deciding as to whether the plaintiff has made out a case for grant of temporary injunction/relief.

17. The three parameters to be examined for passing an order of temporary injunction are, by now, well-established. The plaintiff is required to make out a *prima facie* case in its favour and to show that the balance of convenience also lies in its favour, for the reason that it would suffer grave and irreparable loss in the absence of order of temporary injunction in its favour.

18. In order to examine as to whether the plaintiff has indeed made out a *prima facie* case for grant of temporary injunction/relief as prayed, it would

be necessary to refer to the relevant material brought to the notice of this Court.

19. The material on record shows that there are pleadings in the plaint to the effect that the plaintiff has been in the market with its medicinal/pharmaceutical preparations for pain relief from the year 2004 onwards. The registration certificate for the trade mark 'GREENKURE', shows that it is a word mark and that the registration dates back to 5th October, 2004. The plaintiff claims its presence in the market with the said product and its registered trade mark since the year 2004, although the invoices placed on record date back to 11th June, 2007 onwards. There is material placed on record alongwith the plaint to indicate advertisements and articles pertaining to the product of the plaintiff since the year 2007. Certificate issued by Chartered Accountant indeed shows that there has been increase in the sales turnover of the plaintiff over the years and for the year 2020-2021, it was recorded at Rs.34,78,930.

20. The defendants, in their written statement and the reply to the instant application, have not been able to seriously dispute the aforesaid claim made on behalf of the plaintiff. Thus, this Court is of the opinion that *prima facie*, the plaintiff has been able to establish its presence in the market with the aforesaid medicinal preparations since the year 2004, particularly because its registration dates back to 5th October, 2004. There are invoices placed on record alongwith advertisements and articles concerning the product of the plaintiff, which date back to the year 2007, demonstrating that at least from the year 2007, the presence of the plaintiff is *prima facie* established in the market.

21. As opposed to this, the material placed on record alongwith the plaint by the plaintiff and also by the defendants alongwith the written statement shows that there are number of registration certificates pertaining to the trade mark 'GREENCURE' obtained by the defendants from the year 2017 onwards. It is significant that all the applications pertaining to such certificates were submitted on 'proposed to be used' basis. The earliest of such certificates granted for the trade mark 'GREENCURE' in favour of the defendants dates back to 24th April, 2017. The material on record indicates that according to the defendants, they are selling large volumes of products with the impugned trade mark 'GREENCURE', but all such products are under Class 5 of the Schedule to the said Act, for which, the plaintiff has registration certificate of its trade mark since the year 2004.

22. This Court is of the opinion that the plaintiff has been able to place on record sufficient material to establish a strong *prima facie* case about its presence in the market, much prior to the advent of the defendants and their entry into the market. The registration certificate of the plaintiff dates back to 5th October, 2004, while the earliest registration certificate issued in favour of defendants is dated 24th April, 2017. There is sufficient material on record to indicate use of registered trade mark by plaintiff and sale of its product at least from the year 2007 onwards and the certificate of the Chartered Accountant placed on record does indicate the sales turnover. On this basis, this Court is of the opinion that the defendants used the impugned trade mark 'GREENCURE' much after the plaintiff was already in the market and its products bearing the registered trade mark were available in the public domain. Therefore, the defendants cannot claim that merely because it had obtained registration for its mark from the year 2017 onwards, the plaintiff is disentitled from claiming any interim relief or order of temporary injunction

from this Court. Learned counsel for the plaintiff is justified in relying upon the Full Bench judgment in the case of **Lupin Limited v/s. Johnson and Johnson** (*supra*), which specifically holds that there could be no express or implied bar in the Civil Court exercising power to consider challenge to the validity of the trade mark at the interlocutory stage by way of *prima facie* finding.

23. Thus, this Court can certainly look into the trade mark of the defendants, although it is registered, to examine *prima facie* as to whether the plaintiff deserves order of interim injunction, despite the impugned trade mark of the defendants being registered.

24. This Court is of the opinion that the defendants having obtained registration of the impugned mark starting from the year 2017, much later than the registered trade mark of the plaintiff, which dates back to 5th October, 2004, is a crucial factor in favour of the plaintiff. In this backdrop, it would be necessary to compare the two marks to examine the contentions raised by the learned counsel for the rival parties.

25. This Court has compared the two marks, keeping in mind the position of law that the marks have to be compared in order to examine as to whether a person of average intelligence and imperfect recollection would be confused or at least placed in a situation of wonderment. A perusal of the two marks shows that *prima facie*, phonetically there cannot be said to be any difference between the two marks. The pronunciation of the registered trade mark 'GREENKURE' is no different from the impugned trade mark of the defendants 'GREENCURE'. It is crucial that the plaintiff holds the registration of its trade mark from 5th October, 2004 and the trade mark type

is recorded as word mark in Class 5 of the Schedule to the aforesaid Act. The impugned trade marks of the defendants are registered much later in the year 2017 onwards, also in Class 5. Thus, the product of the plaintiff and the products of the defendants are in the very same class of products and the defendants are not justified in seeking distinctiveness on the ground that its products are wide-ranging and for a purpose other than pain relief, for which the product of the plaintiff is existing in the market. Such hair-splitting distinction is not contemplated when statutory protection is available to the plaintiff for its registered trade mark, which dates back to 5th October, 2004.

26. The attempt on the part of the defendants to highlight distinction on the basis of the alphabet 'K' used in the registered trade mark of the plaintiff, or that the look of impugned mark is different, or that in some of its marks there is space between the words green and cure, cannot be of any assistance to the defendants, simply for the reason that the prominent, fundamental and essential feature of the registered trade mark of the plaintiff *prima facie* appears to be present in the impugned trade mark of the defendants. This shows that the plaintiff has indeed made out a *prima facie* case to claim that the impugned trade mark is identical or deceptively similar to the registered trade mark of the plaintiff.

27. The distinction sought to be made on behalf of the defendants on the aspect of passing off is also not justified in the facts and circumstances of the present case, for the reason that as per settled law, if there is phonetic similarity in the two marks and the idea conveyed by the mark of the plaintiff is found to be dishonestly used by the defendants, a prima facie case of passing off is certainly made out. Learned counsel for the plaintiff is justified in relying upon the judgment of Supreme Court in the case of

Kaviraj Pandit Durga Dutt Sharma v/s. Navaratna Pharmaceutical Laboratories (*supra*), wherein the Supreme Court held as follows:

> ‘28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in their colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negativing the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy in the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of "the exclusive right to the use of the trade mark in relation to those goods" (vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is

the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coinside in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's 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 plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is suflicient to distinguish his goods from those of the plaintiff.

29. When once the use by the defendant of the mark which is claimed to infringe plaintiff's mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (vide Section 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an

> extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive." But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks- the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essense a question of fact and depends on the judgment of the court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff.'

28. Having found that the plaintiff has indeed made out a strong *prima facie* case in its favour as regards the causes of action of infringement and passing off, this Court needs to examine as to whether the defendants are justified in claiming that the aspect of balance of convenience tilts in their favour. In this regard, learned counsel for the defendants has specifically relied on the judgment of Delhi High Court in the case of **FDC Limited v/s. Faraway Foods Pvt. Ltd.** (*supra*). It is emphasized that in the said judgment, the position of law pertaining to the principal issue determinative of grant of temporary injunction has been comprehensively considered and reference is also made to landmark judgments of the Supreme Court on the said aspect,

including the case of *Nandhini Deluxe v/s. Karnataka Co-operative Milk Producers Federation Ltd.,* [**(2018) 9 SCC 183**]. It is emphasized that principles have been culled out on the basis of landmark judgments of the Supreme Court and if the said principles are applied to the present case, the application deserves to be dismissed, for the reason that the balance of convenience is in favour of the defendants.

29. This Court has perused the aforementioned judgment of the Delhi High Court. The earlier judgments of the Supreme Court on the aforesaid aspect have been referred to and in paragraph No.65 of the said judgment, the principles have been culled out. Much emphasis was placed on behalf of the defendants on the observation in the said judgment that the plaintiff ought to prove its established reputation by showing volume of its sales and it was submitted that the same ought to be compared to the volume of sales of the defendants. It was further emphasized that when the trade mark of the defendants is registered, the Court ought to be slow in granting temporary injunction in favour of the plaintiff. It was laid down in the aforesaid judgment of the Delhi High Court that a meticulous comparison of the word marks ought to be undertaken, applying the time honoured test, concerning a person of average intelligence and imperfect recollection. Ultimately, it was recognized that the application of the aforesaid tests would always depend on the facts of the case and findings to be rendered by the Court necessarily would involve questions of facts. In this regard, judgment of this Court in the case of **Bal Pharma Limited v/s. Centaur Laboratories Pvt. Ltd. and another** (*supra*) is also significant, which has taken into consideration the fact of registration of trade mark and existence of proprietary rights of the plaintiff, particularly, when the application for grant of temporary injunction is to be considered. Perusal of aforesaid judgment

shows that even if the defendants claim to be concurrently using the mark, as long as the plaintiff is able to show sufficient *prima facie* material about registration in its favour prior in point of time, grant of injunction ought to follow in such cases. It is further laid down that when there is enough material to show prior use of the registered trade mark by the plaintiff, the defendants cannot claim to be honest concurrent users, for the reason that it is the duty of the defendants to make sufficient enquiry from public records before embarking upon the use of its mark, which is deceptively similar to the registered mark of the plaintiff. If such enquiry is not conducted, the defendant takes the risk of the consequences when the plaintiff approaches the Court on the basis of prior use and prior registration of its trade mark.

30. Applying the aforesaid principles to the facts of the present case, this Court is of the opinion that so long as there is sufficient material, indicating strong *prima facie* case in favour of the plaintiff as regards its prior registration dating back to 5th October, 2004 and use of the same in the very same class of products for which the defendants claim registration of mark much later in point of time, which is found to be deceptively similar, it cannot lie in the mouth of such defendants that the balance of convenience would tilt in their favour merely because their volume of sales is more.

31. This Court is of the opinion that the material presently available on record *prima facie* shows that even according to the defendants, it entered the market from the year 2017 onwards. The earliest registration of the impugned mark is dated 24th April, 2017. All the applications, on the basis of which the defendants obtained registration of the impugned mark, were submitted on ‘proposed to be used’ basis. All these factors clearly tilt the question of balance of convenience in favour of the plaintiff.

32. It is a matter of record that the plaintiff has indeed initiated rectification proceedings in respect of 10 certificates of registration obtained by the plaintiff and that as regards 9 other applications of the plaintiff pending for the impugned mark again on 'proposed to be used' basis, the plaintiff has admittedly filed opposition proceedings.

33. This Court is of the opinion that based on the material placed on record by the plaintiff, even the third parameter pertaining to the likelihood of the plaintiff suffering grave and irreparable loss is also made out and that therefore, the plaintiff having satisfied all the three parameters for grant of temporary injunction, the present application indeed deserves to be allowed.

34. This Court is of the firm opinion that the plaintiff has indeed made out a strong *prima facie* case in its favour as regards both the causes of action of infringement and passing off, particularly for the reason that the registration of trade mark on 5th October, 2004, pertains to a word mark, the prominent, essential and fundamental feature of which appears to be dishonestly copied by the defendants, while obtaining registration for its trade mark i.e. 'GREENCURE'. There is also no substance in the contention raised on behalf of the defendants that there is lack of distinctiveness in the mark of the plaintiff, for the reason that if that was the case, why did the defendants apply for registration of its mark. The defendants cannot be permitted to blow hot and cold at the same time.

35. In view of the above, the application is allowed in terms of prayer clauses (a) and (b), which read as follows:

(a) that pending the hearing and final disposal of the suit the Defendants by themselves through their partners, directors, proprietors, servants, agents, dealers, manufacturers, stockiest and/or otherwise howsoever be restrained by a temporary order and injunction of this Hon'ble Court from in any manner using in relation to any pharmaceutical, medicinal preparations and ayurvedic medicines, the impugned trade mark GREENCURE and/or any other word or mark and/or domain name www.greencure.co.in which is identical with and/or deceptively similar in any manner whatsoever to that of the Plaintiff's trade mark GREENKURE so as to infringe the Plaintiff's trade mark GREENKURE bearing registration No. 1313011 being Exhibit -'A' hereto.

(b) that pending the hearing and final disposal of the suit, the Defendants by themselves, and/or their directors and/or servants and/or agents and/or officers and/or affiliates and/or any other person claiming through and/or under such Defendants, be restrained by a temporary order and injunction of this Hon'ble Court from in any manner using in relation to any pharmaceutical, medicinal preparations and ayurvedic medicines the impugned trade mark GREENCURE and/or any other word or mark and/or domain name www.greencure.co.in which deceptively similar in any manner whatsoever to that of the Plaintiff's mark GREENKURE so as to pass off and/or enable others to pass off the Defendants' goods as and for that of the Plaintiff;

36. Both the applications are disposed of.

37. At this stage, the learned counsel for the defendants seeks stay of the order passed today.

38. The prayer made on behalf of the defendants is rejected in the light of the findings rendered above pertaining to dishonest use of trade mark by the defendants.

(MANISH PITALE, J)

Priya Kambli