

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

APPEAL AGAINST ORDER NO. 12 OF 2022

Dr. Rushikesh Anil Thakre,
Aged 37 years, Occ. Doctor,
Proprietor of Ajan Vruksha,
Residing at New State Bank Colony,
Nagpur Road, Wardha-442001.

... **APPELLANT**

// VERSUS //

Nilesh Shankarrao Adkane,
Aged: , Occupation: Business,
Residing at proprietor of Nilesh
Pharmaceutical Company, Juni Wasti,
Teli Pura, Plot No. 1014, Ward No. 72,
Badnera-444701, Dist. Amravati,
Maharashtra.

... **RESPONDENT**

Shri R. D. Dhande, Advocate for appellant.
Shri A. R. Takode, Advocate for respondent.

CORAM :- AMIT B. BORKAR, J.

DATED :- 22.07.2022

ORAL JUDGMENT:-

1. Heard.
2. **Admit.**
3. The appellant is the original plaintiff, who had filed suit under Section 134 read with Sections 28 and 29 of Trade Marks Act, 1999 (for short, "the said Act"), is a registered propitiatory of Trade Mark "Khandu Chakka", which is pain relief oil having Ayurvedic

properties curing body pain, joint pain, muscular pain, arthritis, cervical pain, backaches etc. On 02.11.2018, the appellant filed an application for registration of Trade Mark "Khandu Chakka" in Class-5 as a specification for goods pertaining to medical and veterinary preparation, dietetic food and substance adapted for medical or veterinary use, and dietary supplements for humans and animals. On 10.12.2018, the appellant's Trade Mark was advertised under Application No. 3990363 in Class 5 of the Trade Marks Journal No. 1879 on Page No. 1608. The appellant has a tie-up with M/s. Nature Boon, which is a sole proprietary firm having its factory in the State of Madhya Pradesh, had applied to the Drug Controller for the inclusion of 34 proprietary Ayurvedic medicines under the Drugs Manufacturing License. On 31.12.2018, the Drugs Controller, Bhopal, granted permission to M/s. Nature Boon to include 34 proprietary Ayurvedic medicines. On 03.05.2019, the Registrar of Trade Marks, Mumbai, issued a registration certificate to the appellant's Trade Mark "Khandu Chakka" bearing Registration No. 3990363 in Class 5. The appellant has been continuously and extensively manufacturing its product bearing Trade Mark "Khandu Chakka" in large quantities. The turnover of the appellant's goods amounts to ₹ 3,16,670/- for the financial year 2020-21 and ₹ 9,27,100/- for the financial year 2021-22.

4. On 11.02.2020, the appellant applied with Assistant Commissioner, Food and Drugs Administration, Amravati, against the respondent, alleging that the respondent is selling pain relief oil under the trade name "Nilesh Ayurvedic Khandu Chakka + Malish Tel". It is alleged that the respondent has been selling the said oil in various medical shops without obtaining prior approval from the Competent Authority. The respondent had also published an advertisement of the impugned Trade Mark in Trad Mark Journal No. 1942-0 on Page No. 1208 under Application No. 4327088 in Class 5 for registration on 24.02.2020. On 17.04.2020, the appellant filed opposition proceedings against the respondent under Section 21 of the said Act before the Registrar, which is pending.

5. On 02.08.2021, the appellant sent a notice to the respondent to cease and desist from using the impugned Trade Mark. The defendant, vide reply dated 12.08.2021, refused to comply with the said notice. The appellant, therefore, filed Trade Mark Suit No. 1/2021 seeking an injunction against the respondent restraining him from using of impugned Trade Mark "Nilesh Ayurvedic Khandu Chakka + Malish Tel". The appellant, along with the said Suit, applied to under Order 39, Rule 1 and 2 of the Code of Civil Procedure r/w. Section 135 of the said Act for restraining the respondent by temporary injunction.

6. The respondent contested the suit and temporary injunction application by filing a written statement-cum-reply. It is contended that the respondent is doing business in manufacturing and selling Ayurvedic medicine under the title "Nilesh Ayurvedic Pharmaceutical Company" and obtained a licence from the office of Drugs Controller (AYUSH), Madhya Pradesh vide Licence No. 25D/47/05. The said, "Khandu Chakka" is a common medicine for pain and fracture, which has been used in villages of India from time immemorial, and "Khandu Chakka" is a plant. It is neither a creation of the appellant nor the name of "Khandu Chakka" is peculiar. It is the vernacular name of a plant called by the common people; hence, it cannot be used for Trade Mark. The product of the appellant is pain relief oil. Since the proceedings initiated by the appellant under Section 21 of the said Act are pending, the present proceeding is not maintainable. The name of the product of the respondent is "Nilesh Ayurvedic Khandu Chakka + Malish Tel". The sign "+" is distinctive. The Malish Tel is extracted from the medicinal plant of common use. The label of the product of the respondent is exclusively in the vernacular Marathi language in Devnagri script, and therefore, there is no likelihood of similarity between the two labels. The "Khandu Chakka" is a medicinal plant, and until it is proved and established that the appellant has the exclusive right to use the said plant as medicine,

he is not entitled to any relief. The appellant cannot claim the benefit of naming a particular medicine in Trade Mark. The appellant's goods only pertain to the use of "Khandu Chakka" as a medicinal product; therefore, the Suit is liable to be dismissed.

7. The learned Trial Court has rejected the application for a temporary injunction, holding that there is nothing on record to ascertain that the word "Khandu Chakka" is the self-generated name and is self-created by the appellant. It has also rejected the application on the ground that the word "Khandu Chakka" is descriptive and has a generic expression. The respondent is not selling its product using the sole word "Khandu Chakka".

8. Shri R. D. Dhande, learned Advocate for the appellant, submitted that the respondent applied for registration of Trade Mark containing the word "Khandu Chakka"; therefore, the respondent shall be estopped from using the word "Khandu Chakka", which is distinctive and descriptive. He submitted that the Trade Mark of the appellant "Khandu Chakka" is registered by the Registrar of Trade Marks, which shows its distinctiveness. The registration of Trade Mark is *prima facie* evidence of the validity of the Trade Mark. The Trial Court has not considered the letter dated 01.04.2022 issued by the Drugs Controller (AYUSH), Bhopal, Madhya Pradesh, informing the manufacturer of the respondent that the use of Trade Mark "Nilesh Ayurvedic Khandu

Chakka + Malish Tel” amount to Trade Marks infringement. Learned Advocate for the appellant relied upon the judgment in the case of ***Ultra Tech Cement Ltd. Vs. Alaknanda Cement Pvt. Ltd. [2011 (5) Bom C. R. 588]***

9. *Per contra*, Shri A. R. Takode, learned Advocate for the respondent, submitted that “Khandu Chakka” is a generic and descriptive term for a local plant known as Khandu Chakka. It is settled law that generic words cannot be registered under the Trade Marks Act. The registration of Mark does not confer any exclusive right on the word “Khandu Chakka”. Both the Marks are different, and there is no likelihood of causing deception in the mind of common consumers. In support of his submission, the learned Advocate for the respondent relied upon the judgment of this Court in the case of ***Sarah International Vs. Kamruddin I. Mehsaniya [AIR 2021 Bom 57]***.

10. This Court has laid down the principle for deciding the question of deceptive similarity in its decision in ***M/s. Hiralal Prabhudas Vs. M/s. Ganesh Trading Company [AIR 1984 Bombay 218]***. In para no. 5 of the judgment, it is held as under:-

“5. What emerges from these authorities is (a) what is the main idea or salient features, (b) marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole, (c) overall similarity is the touchstone, (d) marks must be looked at from the view and first impression of a person of average intelligence and imperfect recollection, (e) overall structure phonetic similarity and similarity of idea are important and both visual and

phonetic tests must be applied, (f) the purchaser must not be put in a state of wonderment, (g) marks must be compared as a whole, microscopic examination being impermissible, (h) the broad and salient features must be considered for which the marks must not be placed side by side to find out differences in design and (i) overall similarity is sufficient. In addition indisputably must also be taken in-to consideration the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances.”

11. While considering overall structural and phonetic similarity, the Apex Court, in its decision in the case of ***Amrutdhara Pharmacy Vs. Satyadeo Gupta [AIR 1963 SC 449]*** in para no. 8 has held as under:-

“8. Let us apply these tests to the facts of the case under our consideration. It is not disputed before us that the two names 'Amritdhara' and 'Lakshmandhara' are in use in respect of the same description of goods, namely, a medicinal preparation for the alleviation of various ailments, Such medicinal preparation will be purchased mostly by people who instead of going to a doctor wish to purchase a medicine for the quick alleviation of their suffering, both villagers and townsfolk, literate as well as illiterate. As we said in Corn Products Refining Co. v. Shangrila Food Products Ltd [AIR 1960 SC 142] the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity of the two names 'Amritdhara' and 'Lakshmandhara' is, in our opinion likely to deceive or cause confusion. We must consider, the overall similarity of the two composite words 'Amritdhara' and 'Lakshmandhara'. We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one 'for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meanings of the composite words as 'current of nectar' or 'current of Lakshman'. He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has other wise learnt and which he wants to purchase. Where the trade relates to goods largely sold to illiterate or badly educated persons, it is no answer to say that a person educated in the Hindi language would go by the etymological or ideological meaning and see the difference between 'current of nectar' and 'current of Lakshman'. 'Current of Lakshman' in a literal sense has no meaning; to give it meaning one must further make the inference that the 'current

or stream' is as pure and strong as Lakshman of the Ramayana. An ordinary Indian villager or townsmen will perhaps know Lakshman, the story of the Ramayana being familiar to him but we doubt if he would etymologise to the extent of seeing the so called ideological difference between 'Amritdhara' and 'Lakshmandhara'. He would go more by the similarity of the two names in the context of the widely known medicinal preparation which he wants for his ailments."

12. The Hon'ble Apex Court, in a recent judgment in the case of ***Renaissance Hotel Holdings Inc. Vs. B. Vijaya Sai And Ors.*** reported in ***[(2022) 5 SCC 1]*** has held that in action for infringement, once it is found that the defendant's trade mark was identical with the plaintiff's registered trade mark, the Court could not have gone into an enquiry whether the infringement is such as is likely to deceive or cause confusion. In an infringement action, an injunction would be issued as soon as it is proved that the defendant is improperly using the trade mark of the plaintiffs. It is held that the question to be asked in an infringement action is as to whether the defendant is using a mark which is the same as or which is a colourable imitation of the plaintiff's registered trade mark. It is held that though the get-up of the defendant's goods may be so different from the plaintiff's goods and the prices may also be so different that there would be no probability of deception of the public, nevertheless, even in such cases, i.e. in an infringement action, an injunction would be issued as soon as it is proved that the defendant is improperly using the plaintiff's mark. It is not necessary to prove actual deception or any actual damage.

13. The respondent's first contention that the word "Khandu Chakka" is descriptive or common to trade or generic in nature belies itself when the respondent himself applied for registration of Mark using the word "Khandu Chakka". Since the respondent had sought to claim Trade Mark registration, it does not lie in its mouth that the Mark "Khandu Chakka" is a generic expression. In the case of **Ultra Tech Cement Ltd.** (supra), in para no. 31, this Court has observed as under:-

31. The defendants have further contended that Plaintiff's Mark containing the word ULTRATECH is descriptive or common to the trade. However, the defendants have themselves applied for registration of the impugned Mark containing the word ULTRATUFF. The Delhi High Court, in its decision in the case of Automatic Electric Limited V/s. R. K. Dhawan reported in 1999 PTC 81, has observed in paragraph 16 as follows:-

"16. The defendants got their trade mark "DIMMER DOT" registered in Australia. The fact that the defendant itself has sought to claim trade proprietary right and monopoly in "DIMMER DOT", it does not lie in their mouth to say that the word "DIMMER" is a generic expression. User of the word "DIMMER" by others cannot be a defence available to the defendants, if it could be shown that the same is being used in violation of the statutory right of the plaintiff."

The Division Bench approved the above decision of the Delhi High Court in the case of Indian Hotels Co. Ltd. V/s. Jiva Institute of Vedic Science & Culture reported in MIPR 2008 (3) 0082 at 0103. Paragraph 40 of the said decision is reproduced hereunder :-

"40. It was next argued by Mr. Rohtagi that the word "JIVA" is a descriptive word which cannot be protected as a trade mark by a Civil Court. We do not think so, the Appellant has itself applied for registration of the Jiva as a trade mark and cannot, therefore, argue that the Mark is descriptive. In Automatic Electric Limited v. R.K. Dhawan and Anr. 1999 PTC (91) 81 this Court has in similar circumstances repelled the contention and held, that since the Defendant had itself sought to claim a proprietary right and monopoly in "DIMMER DOT", the disputed trade mark it did not lie in its mouth to say that

the said Mark was a generic expression. The Court observed:

16. The Defendants got their trade mark "DIMMER DOT" registered in Australia. The fact that the Defendant itself has sought to claim trade proprietary right and monopoly in "DIMMER DOT" is a generic expression."

Thus defendants who have admittedly applied for registration of the impugned Mark containing the word "ULTRATUFF" are therefore estopped from contending that the plaintiff's Mark containing the word ULTRATECH is descriptive or common to the trade and therefore cannot be registered."

14. The phonetic similarity between “Khandu Chakka” on the one hand and “Nilesh Ayurvedic Khandu Chakka + Malish Tel” on the other is strikingly similar. The two Marks are phonetically, visually and structurally similar. The overall impression conveyed by the Mark, as a whole, has to be assessed in evaluating whether the Mark of the respondent is deceptively similar to the Mark of the appellant. Phonetic similarity constitutes an important index whether the Mark bears deceptive or misleading similarity to another. The phonetic structure indicates how the rival Mark ring in-ear, the overall impact of phonetic uses of one of striking similarity. The test is not whether the customer who wishes to buy the appellant's product is likely to undertake the respondent's product. The test is whether the original customer is likely to be led to believe that “Nilesh Ayurvedic Khandu Chakka + Malish Tel” is associated with the Mark and trading style of the appellant. The phonetic, visual and structural get-up of the two words is so structurally the same as it leads to the likelihood of

deception. The respondent has no *bona fide* and logical explanation for adopting such Mark. To mere assert that “Khandu Chakka” is the name of a tree is no explanation whatsoever unless the respondent proves it. In my opinion, it is merely an afterthought to supply some justification for the adoption of the Mark, which is deceptively similar. This is not a case where it can be said that there is *bona fide*, honest and concurrent use of the Mark by the respondent.

15. The test of phonetic similarity was accepted in the judgment of the Apex Court in the case of *Amrutdhara Pharmacy* (supra). This principle is reiterated in the judgment of the Apex Court in the case of *Candila Health Care Ltd. Vs. Candila Pharmaceuticals Ltd. [(2001) 5 SCC 73]*, holding that the earlier decision in the case of *M/s. S. M. Dychem Ltd. Vs. M/s. Cadbury (India) Ltd. [(2000) 5 SCC 573]*, which had taken a contrary view, did not laid down the agreed position. The Larger Bench, in the case of *Candila Health Care (supra)*, it was not agreed in law to hold that principle of phonetic similarity is to jettisoned with the manner in which the word are written. The Court held that both *Amrutdhara Pharmacy* (supra) and *Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories [AIR 1965 SC 980]* case, the relevancy of test of phonetic similarity. In the fact of the present case, both the Marks contain an overwhelming emphasis on the letter “Khandu Chakka” and the fact that the Mark of the

respondent begins with the word “Nilesh Ayurvedic Khandu Chakka + Malish Tel” would make little difference to the manner in which rival Mark is pronounced. The manner in which Mark would be written in Devnagri script bears a close resemblance to the product of the appellant, which leads to believe that the goods of the respondent are associated with the goodwill and reputation associated with Mark of the appellant.

16. In this circumstance, the order passed by the Trial Court cannot be sustained. The appellant has established *a prima facie* case for grant of an order of injunction. The essential requirement in action for infringement has been duly established. The balance of convenience lies in favour of the appellant. The large turnover of the appellant is pointed out by the figures which are disclosed in the complaint. The appellant has expended an extensive sum of money in advertisement, and irreparable harm and prejudice are likely to be caused to the appellant's business unless the interlocutory order of injunction was not passed as prayed for. The goodwill and reputation associated with the appellant's Mark would be liable to suffer serious damage unless the respondent is enjoined. I do not see any reason as to why the injunction should be denied to a party if a clear case of infringement of registered Trade Mark is made out.

17. In the result and in view of the foregoing discussion, the appeal is **allowed**.

18. The impugned order dated 13.04.2022 passed by District Judge-3, Wardha below Exh.5 in Trade Marks Suit No. 1/2021 is quashed and set aside.

19. The application below Exh.5 in Trade Marks Suit No. 1/2021, pending before the District Judge-3, Wardha, is allowed in terms of prayer clauses (a) and (b) of the application.

20. Pending application, if any, stands disposed of accordingly.

(AMIT B. BORKAR, J.)

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