

IN THE HIGH COURT OF PUNJAB AND HARYANA
AT CHANDIGARH

RFA No.1654 of 2017(O&M)

Date of Order:08.06.2022

Reserved on:27.05.2022

Bansal Cotton and Oil Mills

...Appellants

Versus

Keshav Oil and Cotton Ginning Industries Pvt. Ltd.

...Respondent

CORAM: HON'BLE MR. JUSTICE ANIL KSHETARPAL

**Present: Mr. Akshay Bhan, Sr. Advocate, with
Mr. Santosh Sharma, Advocate
for the appellant.**

**Mr. S.K.Garg, Sr. Advocate with
Mr. Japjit Singh Johal, Advocate
for the respondent.**

ANIL KSHETARPAL, J.

1. This appeal preferred by the defendant (the appellant herein) questions the correctness of the judgment passed by the Additional District Judge, Hisar, restraining it from directly or indirectly using or doing business under the trademark of “DO GAI CHHAP”. The counter claim of the defendants has also been dismissed. The parties shall be referred to by their status in the suit.

2. Brief facts of the case are as under:-

3. The plaintiff (respondent herein) filed a suit through Sh. Shyam Sunder Aggarwal with a prayer to grant decree of permanent injunction while asserting that it is engaged in business of manufacturing, processing,

marketing and selling cattle feeds, oil cakes, seeds etc. as per class-31 of the Trademarks Act, 1999, and its products are consumed by the cattles. Since 15.07.1992, M/s Madan Lal Hans Raj was using the trademark “DO GAI CHHAP” which was later on assigned to the respondent for a consideration of Rs.20,000/- vide deed of agreement dated 27.01.2014. The plaintiff has earned goodwill and reputation and is deemed to be using the trademark since 15.07.1972. It is also claimed that the goods of the plaintiff enjoy unique and substantial reputation, unmatched goodwill in trade and the defendant is selling its products under the same trademark and trade name “DO GAI CHHAP” in order to pass off its products as that of the plaintiff. It is alleged that the defendant is manufacturing and selling the aforesaid products, namely, cattle feed, oil cakes, seeds etc. under the name and style of “DO GAI CHHAP” which is not only deceptive but is accompanied with the malafide intention to take benefit of the popularity and goodwill of the products of the plaintiff company under the trademark “DO GAI CHHAP” and device of “COW “DO GAI CHHAP”. The defendant has also started using similar label/device of COW as that used by the plaintiff and even the picture on the label/wrapper has been drawn with so much similarity that it is very highly improbable for a lay man or the general public including illiterate farmers to distinguish it from the products of the respondent. The colour, combination and design of label/wrapper used by the defendant is phonetically and deceptively similar to that of the plaintiff-company. Further, it is claimed that the plaintiff being prior user of the trademark has a preferential right to use the same.

4. The defendant while contesting claims that he is using B.A.C.O.M. DO GAI CHHAP since 01.09.1987 and its trademark is

registered with Government of India, trademark registry at New Delhi, vide trademark No.1885678 dated 18.11.2009, J.No.1450 under the Trademarks Act, 1999. It is alleged that Sh. Shyam Sunder Aggarwal's father Sh. Madan Lal being proprietor of M/s Madan Lal Hans Raj is also running the business of manufacturing, processing, selling cattle feeds for the last 4-5 years but his business did not pick up. Hence, the plaintiff while floating a new company namely Keshav Oil and Cotton Ginning Industries Pvt. Ltd. in the NCR area has started manufacturing substandardized and inferior quality cattle feeds, oil cakes and selling the same in the market by using the defendant's registered trademark. When the defendant became aware of this fact, a complaint was lodged with the Ganaur Police on 09.02.2013, resulting in FIR No.458 dated 19.12.2013 against the plaintiff wherein he gave statement that he is not manufacturing oil cakes but is only trading it by purchasing it from a wholesaler. Subsequently, M/s Madan Lal Hans Raj filed an application for registration of trademark "DO GAI CHHAP" and the trademark image i.e logo of the appellant at New Delhi, which is still pending. In the meanwhile, Sh. Madan Lal moved an application in the month of December, 2013, for rectification of this trademark so that this trademark "B.A.C.O.M. DO GAI CHHAP" and trademark image may be allotted to M/s Madan Lal Hans Raj instead of the defendant which is also pending. The plaintiff also applied for registration of trademark vide application no.2642596 dated 13.12.2013 as "KACOM DO GAI CHHAP". In that application, the plaintiff stated that he has been using this trade mark with effect from 15.07.1972. The plaintiff again applied in Maharashtra (Mumbai) for registration of copyright vide application No.2667033 dated 27.01.2014, in which the date of commencement of the business was stated

as 01.01.1972. On merits, it is asserted that the plaintiff has been misusing its trademark illegally and fraudulently and that M/s Madan Lal Hans Raj was neither owner of the trademark nor the said firm got registered the trademark with the registry of Trademarks, New Delhi. The plaintiff by selling the goods under the trade name and trademark "DO GAI CHHAP" has damaged the reputation of the defendant in general public. The appellant-defendant while filing the counter claim, prayed for grant of decree of permanent injunction against the plaintiff. The plaintiff while replying to the counter claim also filed a replication asserting that Sh. Madan Lal applied on 06.04.1970 for registration under Punjab General Sales Tax Act, 1948, which was registered on 28.04.1970, thus, the plaintiff is a prior user and consequently, protected under Section 134 of the Trademarks Act, 1999. The FIR registered at the behest of the defendant was cancelled. In para 4 of the reply to the preliminary objections, the plaintiff asserted that it being prior user though unregistered, is entitled to protect his trademark. In para 15 of the replication, the plaintiff admitted that the applications filed by the respondent or Sh. Madan Lal for registration of the trademark are pending.

5. The trial Court framed the following issues:-

- “1. Whether plaintiff is entitled for decree of prohibitory and mandatory injunction against respondent preventing it from using directly or indirectly or doing business under the trade mark of DO GAY CHHAP on the grounds taken in the plaint?OPP
2. Whether plaintiff has been using the trade mark in the name and style of DO GAY CHHAP allegedly prior to

defendant ?OPP

3. Whether the suit is not maintainable in the present form?OPD
4. Whether the plaintiff has no locus standi to file the suit?OPD
5. Whether this Court has no jurisdiction to entertain and try this suit?OPD
6. Whether plaintiff has not come to the court with clean hand and has suppressed true and material facts?OPD
7. Relief.”

ADDITIONAL ISSUE FRAMED ON 16.02.2017

“Whether defendant firm is using the trademark “DO GAY CHHAP prior to the period plaintiff firm using the same and defendant is entitled for a decree restraining the plaintiff firm from using the said trade mark on business products?OPD

6. The trial Court while deciding the application under Order 39 Rule 1 & 2 CPC, did not grant any injunction in favour of the plaintiff and the same was upheld in appeal by the High Court.

7. In order to prove its case, the plaintiff examined PW1-Dharambir Clerk, Office of Excise and Taxation Officer, sub-office, Hansi, who brought record of M/s Madan Lal Hans Raj registered on 28.04.1987 and record of M/s Keshav Oil and Ginning Industries Pvt. Limited registered on 09.09.1997. This witness in cross-examination admitted that as per the record, the licence was issued for trading of Tobacco to M/s Madan Lal Hans Raj and there is no mention of trade name i.e. “DO GAI CHHAP”.

Subsequently, as per the record, the business of the respondent was shown as retail and wholesale foodgrains. PW2-Sh. Satya Pal Goyal, a practicing Chartered Accountant of the plaintiff-company produced its audit report for the financial year 2013-2014. In cross-examination, he admitted that there is no mention of tradename “DO GAI CHHAP” in his audit report. PW3-Sh. Shayam Surender Aggarwal tendered his affidavit as Ex.PW3/A in lieu of the examination-in-chief and produced various documents. He claims that his father being proprietor of M/s Madan Lal Hans Raj sold the trademark rights to the plaintiff firm vide deed of assignment dated 27.01.2014 and his father was doing the business of sale and purchase of oil cake and “Binola” (cotton seeds). He admitted that as per registration certificate dated 06.04.1970, under the Haryana General Sales Tax Act, 1973, his father while working as a commission agent was doing business of wholesale and retail sale of foodgrain which is evident from Form No. ST-1 dated 11.03.1982, 31.03.1987, 28.02.1992 and the registration certificate was valid upto 31.03.2014. He admitted that in the sale tax form the words “Khall” (oil cakes) and “Binola” (cotton seeds) are not mentioned but claimed that “Khall” (oil cakes) and “Binola” (cotton seeds) are included in the foodgrains. He admitted that the respondent-company does not have any branch office at Mumbai nor conducts any business in Mumbai. When confronted with the photocopies of the invoices produced by him in the evidence, he stated that he does not possess its counterfoils as it was his deceased father who had prepared the photocopies of the aforesaid invoices. He admitted that now the firm M/s Madan Lal Hans Raj is being run by his son Mr. Shannu Garg, who also does not have original counterfoils or carbon copies of the above invoices. He denied that there is no photo of the

trademark in the invoices. In fact, he stated that he does not have any knowledge of the documents produced because the same were prepared by his father.

8. On the other hand, defendant examined DW1-Ramesh Kumar Pinghal, Sub Divisional Engineer in the office of General Manager, Telephones, BSNL, Hisar. He stated that in the area of Hisar and Hansi, all the telephone numbers in 1980, were of four digits and he was told by the technical staff that in the year 1990, the four digits numbers were converted into five digits. Further, in the month of December, 1992, manual STD facility was provided to the consumers by BSNL in District Hisar including Hansi and in March, 1993, this STD facility was converted into self dialing automatic facility. On 05.12.2002, all five digits telephone numbers were converted into six digit telephone numbers by pre-fixing digit 2 to all the telephone numbers assigned to the consumers of that District. In cross, he has admitted that he has no personal knowledge about the aforesaid facts and the same has been told to him by the staff of BSNL working at the relevant time. DW2-Sanjeev Sharma, Assistant Examiner in Trademark Registry, Dwarka, New Delhi, appeared and produced the summoned record. DW3-Subhash Chand Bansal, Proprietor of the defendant appeared while tendering his affidavit Ex.DW3/A in lieu of examination-in-chief. He stated that he started manufacturing cattle feeds, oil cakes and cotton seeds, since 01.09.1987 and, he after using an unregistered trademark, applied for registration of the trademark in the year 2007. He further reiterated the stand taken in the written statement.

9. A list of documents produced by both the parties has been prepared by this Bench which is as under:-

Ex.P1	Running into 88 pages (a) Consisting of Registration of the firm under Haryana Value Added Tax Act, 2003 on 01.04.2003. (b) Undated application for Renewal of Registration under Section 19/20 of the Haryana General Sales Tax Act, 1973, reflecting that Tobacco is the business of the Firm Madan Lal Hans Raj. (C) Renewal of Registration Certificate No.HGST//214 (28.11.07) Name of Business Food Grain and its renewal from time to time Retail and wholesale distinction of food grains, oil seeds, jute bags, kiriyana goods, Jaggery, Corn, Jute thread (d) In application dated 24.04.70 for registration under State & Central Sales Tax Name of business: Sales of foodgrains, binola etc.
Ex.P2	Undated application for Registration under Section 19/20 of Haryana General Sales Tax Act, 1973. Nature of business: Manufacturing and Trading of Oil Cakes, Oil, Cotton by Keshav Oil & Cotton Ginning Industries Certificate of Registration showing nature of business as Manufacturing trading of oil, oil seeds, cotton, paddy, rice and foodgrain Lubricants, rubber, plastic, packing material Valid from 09.09.1997 to 31.03.2002 Including statement of Vinod Kumar Proprietor of Keshav Oil Mill, describing business of the Firm to be Oil, rice, Foodgrain.
Ex.P-2A	Audited Register of Keshav Oil & Cotton Ginning Industries Pvt. Ltd. for the financial year 2013-2014.
Ex.PW3/A	Affidavit of Sham Sunder Aggarwal in evidence
Ex.PW3/B	Original Receipt 3/1(27.01.2014) "Do Gaye Chap" proving payment of Rs.20,000/-
Ex.PW3/2	Original Affidavit dated 27.01.2014 of Sham Sunder Aggarwal.
Ex.PW3/3	Original Deed of Assignment- 27.01.2014 between Madan Lal and Keshav Oil and Cotton Ginning Industries Pvt. Ltd.
Ex.PW3/4	Original application dated 13.02.2014/09.09.2014-defendant's application for registration of trade mark BACOM on the top with picture of 2 Cows, In English-Two Cows and in Hindi "Do Gaye Chapp" (date of use 01.09.1987)
Ex.PW3/5	Extract from the Register of Copy Rights dated 07.05.2014-Artistic work "Do Gaye Chaap" with 07.02.2014 as the date of application.
Ex.PW3/6	Certified copy of BACOM 2 Cows-Do Gaye Chaap" (same design/label)
Ex.PW3/7	Certification of incorporating Keshav Oil and Cotton Ginning Industry Pvt. Ltd. Dated 04.07.2013.
Ex.PW3/8	Copy of registration of BO17--- 18.02.2014
Ex.PA	Photocopy of invoices for 06.05.1973-25.12.1997 "Do Gaye Chhap"
Ex.PA	Information about application submitted by Madan Lal Hans Raj for registration of trade mark "Do Gaye Chaap" (logo) as revised on 25.10.2013.
Ex.PB	Information about application submitted by Madan Lal Hans Raj for registration of trade mark "Do Gaye Chaap" (label) on 23.08.2013.
Ex.PA	Copy of application submitted by appellant to ITO that the firm has now become sole proprietor partnership firm.
Ex.PB	Copy of label used by Defendant/appellant "Do Gaye Chaap"

	BACOM Picture of 2 Cows Two Cows Do Gaye Chhap (In Hindi) Bansal Cotton & Oil Mills
Ex.PC	Label
Ex.P1	Times of India Google Search Prefix 2 before all phone numbers
Ex.P2	Proprietor certificate No.982022, Trade Mark No.1885678, issued on 21.3.2011 (oil cake, cattle feed and seeds) application date- 18.11.2009 Trade Mark Type Revise /English Word Mark BACOM Two Cows
Ex. D4	Certificate of Registration of Trade Mark Section 23(2), Rule 62(1)
Ex. D6	Copyright NOC applciation No.41584, dated 11.7.2013
Ex. D7	Search Certificate
Ex. D8	Copyright Label NOC “Do Gaye Chhap” Photo of Subash Bansal Two Cows
Ex. D9	Search Certificate 15.05.2015
Ex. D10	Search Certificate 15.05.2015 Label attached
Ex. D11	Copyright NOC Label
Ex. D12	Trade Mark No.267432 dated 07.02.2004 in class 35 under No.267432 dated 07.02.2014 Bansal Cotton and Oil Mills
Ex. D13	Extract from the Register of copyrights – in favour of Subhash Chand Bansal Application dated 06.08.2013.
Ex. D14	Form No.3CB Income Tax Act balance sheet on 31.03.2000 M/s Bansal Cotton and Oil Mills
Ex.D15	Form No.3CB Income Tax Act balance sheet on 31.07.2007 M/s Bansal Cotton and Oil Mills
Ex.D16	Form No.3CB Income Tax Act balance sheet on 31.03.2014 M/s Bansal Cotton and Oil Mills
Ex.D17	Form No.3CB Income Tax Act balance sheet on 31.03.2015 M/s Bansal Cotton and Oil Mills
Ex.D18	Form No.3CB Income Tax Act balance sheet on 31.03.2016 M/s Bansal Cotton and Oil Mills
Ex.D19	I.T.R. Verification Form for Assessment year 2010-2011
Ex.D20	Income Tax Return Acknowledgement 2011-2012
Ex.D21	Income Tax Return Acknowledgement 2012-2013
Ex.D22	Income Tax Return Acknowledgement 2013-2014
Ex.D23	Income Tax Return Acknowledgement 2014-2015
Ex.D24	Income Tax Return Acknowledgement 2015-2016
Ex.D25	Income Tax Return Acknowledgement 2016-2017
Ex.D26	Order of High Court in Cr.M43377 of 2014 to look into the representation

Ex.D27	Website Printout of Haryana Excise & Taxation Notification
Ex.D28	Application for Registration of a Trade Mark for goods and services of Madan Lal dated 07.08.2013 Photograph of Proprietor Tow Cows Do Gaye Chhap” (in Hindi)
Ex.D29	Application for registration of Trade Mark for goods and services of Keshav Oil & Cotton Ginning Industries Pvt. Ltd.,
Ex.D30	Application dated 23.08.2013 under Trade Marks Act, 1999 submitted by the plaintiff.

10. Heard the learned senior counsels representing the parties at length and with their able assistance perused the paper book as well as the record of the courts below which was requisitioned.

11. On the one hand, the learned senior counsel representing the appellant while criticizing the judgment has contended that the trial Court has overlooked the material evidence while deciding the case. On the other hand, the learned senior counsel representing the respondent has supported the judgment passed by the Court.

12. Before proceeding further, it is appropriate to take a note of the reasons recorded in the impugned judgment which are as under:-

- (1) No evidence has been led by the defendant to rebut the evidence led by the plaintiff and to prove that the copies of the invoices produced on record are not genuine.
- (2) The respondent has led sufficient evidence to prove that initially from 1972 to 27.01.2014, his father was manufacturing and selling the products by using the trade name of “DO GAI CHHAP” and vide deed of assignment Ex.PW3/3, he transferred the said rights in favour of the plaintiff.
- (3) From certificate Ex.PW3/4, issued by the Government,

the Trade Mark image allotted to the defendant has been shown but the images Ex.PB and Ex.PC show that the appellant uses the logo as well as the mark as per his convenience from time to time which is not permissible under law as he is legally bound to use only that mark which has been allotted by the authorities.

(4) Perusal of the document Ex.D4 further reflects that the logo issued by the Trademark registry is in English language, black and white colour and not in coloured logo written as “B.A.C.O.M. TWO COWS”.

(5) The plaintiff has produced sufficient documentary evidence as well as oral evidence which proves that the plaintiff after purchase of the trade Mark and Logo has been using the same since a long a time now.

13. On the basis of the aforesaid findings, the Court restrained the defendant from directly or indirectly using or doing business under the trademark of “DO GAI CHHAP” while dismissing its counter claim.

14. For the sake of clarity, a photographic representation of the trademark of defendant and plaintiff is as under:-

Image-I-(defendant's (Appellant) Trademark and Logo)



Image-II (plaintiff's (Respondent's) Trademark and Logo)

15. It may be noted here that the plaintiff in his re-joinder has admitted that it is not a registered trademark owner of “DO GAI CHHAP”. In fact, various applications filed for that purpose are stated to be pending for the last 8 years. On the other hand, the defendant is a registered user of trademark BAKOM with picture of two cows and the words “two cows” are written underneath the picture of the two cows as shown in Image-I . The aforesaid registration was applied on 18.11.2009 but was issued on 21.03.2011 vide registered trademark No. 1885678. The trademark has been registered as worldmark “B A K O M” and “two Cows”.

16. Now, the Bench proceeds to analyze the correctness of the reasons recorded by the Additional District Judge.

17. With reference to the first reason, it may be noted that the defendant has failed to led evidence to rebut the evidence of the plaintiff. Firstly, when Sh. Shyam Sunder Aggarwal appeared as PW3, he was thoroughly grilled by the counsel representing the defendant. The invoices produced by the respondent to prove prior use of the trademark, have not been proved. Sh. Shyam Surender Aggarwal has claimed that the aforesaid

invoices exhibited as Ex.PA consisting of 21 pages are photocopies of the counter foils of the original invoices. On being further questioned, he admitted that he has no knowledge about the existence of its carbon copies/counterfoils and photocopies of these invoices were got prepared by his father. Moreover, on being further questioned, he admitted that his son Sh. Shanu Garg is at present, running the business of the firm M/s Madan Lal Hans Raj, however, even his son does not have the carbon copies. In other words, neither the primary evidence has been produced nor any evidence to prove the correctness of the aforesaid photocopies has been produced. Furthermore, on careful perusal of the aforesaid invoices which runs into 21 pages, it is evident that these invoices is with respect to the period from 06.05.1973 to 25.12.1997, spread over a period of more than 24 years. A bare look at the photocopies of the aforesaid invoices which are Ex.PA on the file, it is evident that the handwriting on aforesaid invoices is of the same person with the same pen. Furthermore, the telephone number on the top of the invoice is also five digit, whereas, an official of the telephone department has appeared in evidence and stated that in Hisar and Hansi area, the telephone numbers were four digits only upto 1990 and for the first time, in 1990, the four digit numbers were converted into five digit numbers. It was further stated that in the month of December, 1992, manual STD facility was provided to the consumers whereas in March 1993 automatic self dialing STD facility was provided. In the year 2002, the five digit telephone numbers were converted into six digit numbers by pre-fixing digit "2" to all assigned numbers. The invoices clearly show that STD No.01663 is consistently recorded on the invoices from 1973 to 1997.

Although, his evidence being hearsay was correctly not relied upon by the

trial Court.

Furthermore, the defendant has produced overwhelming evidence to prove that it is in the business of producing oil cakes and animal feed, whereas, Sh. Shyam Sunder or his father were never in the business of manufacturing or trading oil cakes or cattle feed. In fact, on perusal of Ex.P1, it is evident that M/s Madan Lal Hans Raj was marketing Tobacco. Subsequently, in 2007, the nature of business was depicted as foodgrains which was, later on, expanded to include retail and wholesale distribution of foodgrains, oil seeds, jute bags, kiriyana store, jaggrie, corn and jutes thread. No doubt, in the application submitted on 24.04.1970 which is again a part of Ex.P1, it is recorded that they deal in the sale of “Binola” (cotton seeds) which is the fruit of the cotton crop, however, there is still no reference to oil cakes. Even on registration of Keshav Oil and Cotton Industry, the initial registration did not depict business of oil cakes and oil. Subsequently, after adding “Ginning”, in its name the respondent started the business of oil cakes. In fact, a perusal of Ex.P2 proves that Sh. Vinod Kumar son of late Sh. Madan Lal (brother of Sh. Shyam Sunder Aggarwal), for the first time, registered firm M/s Keshav Oil and Ginning Industry reflecting its business of manufacturing and marketing oil cakes in the year 2002. No record of Keshav Oil and Cotton Ginning Industry Pvt. Ltd. has been produced to prove that it was using the trademark of “DO GAI CHHAP” prior to the defendant. In these circumstances, the trial court has erred in recording a finding that no evidence has been produced by the defendant to rebut the evidence.

18. The trial court has further erred in observing that the plaintiff has proved that he has been using the trademark since 1972. The Court has

referred to extract from the register of copyrights Ex.PW3/5. On a careful perusal of the aforesaid document, it is evident that such certificate has been procured from Mumbai, from where, admittedly, the plaintiff has never carried out any business, in any manner. The aforesaid extract is an attempt by the plaintiff to mislead the Court. Ex.PW3/5 shows that the plaintiff has got registered the copyright under the category of artistic work. Further, it is evident from perusal of Ex.PW3/6 that the plaintiff made an attempt to copy the label/logo of the defendant. The defendant has been using a logo by referring to BACOM with a picture of two cows under BACOM and then the words “two cows” are written in English language. The words “DO GAI CHHAP” have been written as visible in Image-I. On the other hand, the plaintiff has prepared a label/logo in which the only change is that B A C O M has been worded as K A C O M as can be seen in IMAGE-II. It is visually clear that the design and the art work is deceptively identical as can be seen on comparing Image-I and Image-II in para 14.

19. Moreover, the plaintiff applied for registering the label on 07.02.2014, at Mumbai, whereas, a similar application was moved by the defendant on 06.08.2013 was allowed and the trademark was registered by the office of the Copyright, New Delhi, vide Ex.D13.

20. The plaintiff has tried to prove his case by showing that he has purchased the tradename from M/s Madan Lal Hans Raj on payment of Rs.20,000/- on 27.01.2014. Sh. Madan Lal was Sh. Shyam Sunder Aggarwal's father. In the absence of evidence to prove that M/s Madan Lal Hans Raj or Sh. Madan Lal, the sole proprietor was ever using the tradename “DO GAI CHHAP”, the deed of assignment is only an attempt to fabricate the evidence.

21. The trial court has further erred in observing that the defendant is using the logo as per his convenience from time to time. It may be noted here that any manufacturer, producer or trader is not bound to maintain the same logo or mark throughout the period of his business. The Court has made the observations without referring to any provisions laying down any such prohibition.

22. The next reason assigned by the Court is also erroneous because the plaintiff has, itself, failed to prove that it was using the logo/trademark for a sufficiently long time. In fact, the court has failed to make a distinction between the certificate of registration and the application submitted by the plaintiff for registration. Mere submission of an application for registration is not sufficient to prove that a registered trademark has been issued. It is not even the case of the plaintiff in the rejoinder to the counter claim that the trademark "DO GAI CHHAP" is registered in its favour.

23. At this stage, it may be noted here that the plaintiff as well as the defendant, both have alleged that the other party is trying to pass off their goods as the goods of the other party. Thus, both the parties pray for an injunction while complaining passing off and not infringement of trademark. It is well settled that while deciding such an issue, the Court is required to consider the following:-

- (1) Whether the goodwill earned by a trader is sought to be misused by the other party?
- (2) Whether there is any misrepresentation?
- (3) Whether there is likelihood of injury or damage to the goodwill/reputation of the trader?

24. Reference in this regard can be placed on the judgment passed

by the Supreme Court in *S.Syed Mohideen vs. P. Sulochana Bai, (2016) 2 SCC 683* and *Wockhardt Limited vs Torrent Pharmaceuticals Limited and another, (2018) 18 SCC 346*.

25. In the present case, the plaintiff has been making attempts to deceptively pass off its goods as that of the defendant which is clear from the fact that the defendant started his business prior in time. Even from the perusal of the documents, the trademark is registered in defendant's name wherein it is recorded that the application dated 18.11.2009 was allowed on 23.11.2011, while granting trademark under device trademark type. On comparing Image-I and Image-II extracted in para 14, it is clearly visible that the plaintiff, except making some minor changes, adopted the same art work as well as the picture of two cows as that of the defendant. The plaintiff only made changes by replacing the first alphabet "B" with "K". Similarly, when the defendant got registered another type of label in which there is encircled photograph of the proprietor with picture of two cows and under that "DO GAI CHHAP" is written, the plaintiff also copied the same design while replacing it with his own photograph. Unless one carefully examines the labels used by the plaintiff as well as the defendant, they appear to be deceptively similar to the naked eye.

26. No doubt, the court was correct in observing that the evidence of DW1-Ramesh Kumar Pinghal is hearsay. However, the onus lies on the plaintiff to prove that during the relevant years, the telephone numbers as printed on the alleged invoices were correct.

27. Now, the question is what relief should be granted in the facts and circumstances of the present case. Once it is proved that the defendant is the prior user of the trademark "DO GAI CHHAP" and has designed his

label by adopting a particular art work and design, it would not be appropriate for the plaintiff to adopt a deceptively similar trademark and gain from the goodwill of the defendant. Therefore, the plaintiff is restrained from using the trademark “DO GAI CHHAP”.

28. With these observations, the appeal is allowed and the judgment passed by the trial court is set aside. Resultantly, the suit shall stand dismissed, whereas, the counter claim shall stand allowed.

29. All the pending miscellaneous applications, if any, are also disposed of.

08th June, 2022
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(ANIL KSHETARPAL)
JUDGE

Whether speaking/reasoned	:YES/NO
Whether reportable	:YES/NO