

IN THE HIGH COURT OF JUDICATURE AT BOMBAY

CIVIL APPELLATE JURISDICTION

**APPEAL FROM ORDER NO. 297 OF 2022
WITH
INTERIM APPLICATION NO. 3311 OF 2020**

Bhuraram Jepaji Purohit
V/s.

....Appellant

Pritam Bacchulal Parmar
(Single Firm)

....Respondent

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Ms. Kalyani Tulankar i/by. Mr. Ranjit Shinde, for the Appellant.

Mr. Viraj V. Kadam a/w. Mr. Gopal Praba and Mr. Rukhsar Ansari,
For the Respondent.

CORAM : SANDEEP V. MARNE, J.

Dated : 28 August 2023.

P.C. :

1. By this Appeal, the Appellant challenges order dated 17 January 2020 passed by District Judge-16, Pune rejecting his application for temporary injunction.

2. Appellant-Plaintiff has filed Suit No.2/2019 before District Judge, Pune seeking declaration that he is the lawful and authorised owner of the Trademark of 'POWER ANCHOR FASTNERS'. The Appellant-Plaintiff has also sought injunction

against the Defendant from using his Trademark. Plaintiff's suit is premised on registration of the Mark vide Certificate dated 2 December 2017. The Mark was registered in the name of one Mr. Anand Basappa Basraji, who assigned the same in favour of Plaintiff by Deed of Assignment dated 29 December 2017.

3. The Defendant has filed application for rectification of the Mark before the Registrar of Trademarks on 19 July 2018, which Plaintiff has been opposing. During pendency of the rectification proceedings, Plaintiff instituted Civil Suit No.2/2019 on 4 January 2019. On application made by the Defendant for stay of suit under the provisions of Section 124 of the Trademarks Act, 1999 the Court passed order on 16 August 2019 staying Civil Suit No.2/2019 till decision of rectification proceedings. The Court, however directed that in view of provisions of sub-section 5 of Section 124, the parties would proceed with the application for temporary injunction. The Court thereafter proceeded to hear the application for temporary injunction and by order dated 17 January 2020, has rejected the same.

4. Ms. Tulankar, the learned counsel appearing for Appellant would contend that the only reason recorded by the District Judge for rejecting the application for temporary injunction is pendency of rectification proceedings. According to her, District Judge has used pendency of the rectification proceedings and its institution prior to filing of the suit, as the sole ground for refusal of

temporary injunction in Plaintiff's favour. She would invite my attention to the photographs at pages-80 and 81 of the Appeal to indicate similarity between the two Marks. She would further submit that Plaintiff, being registered owner of the Trademark, there is strong presumption in his favour for grant of temporary injunction and that mere filing of rectification proceedings could not be a ground for rejection of injunction.

5. Ms. Tulankar, would further submit that in view of the specific direction of the trial Court on 16 August 2019 for hearing the application for temporary injunction in view of the provisions of sub-section 5 of Section 124 of the Act, the Court could not have rejected the application only on the ground of pendency of rectification proceedings.

6. *Per-contra*, Mr. Kadam the learned counsel appearing for Respondent would oppose the Appeal and support the order passed by the Trial Court. He would submit that the Defendant has been using of Mark 'POWER FASTENERS' since the year 2002. He would invite my attention to the reply filed by the Appellant-Plaintiff opposing the rectification application in which the Plaintiff himself took a defence that the Mark used by him is distinctive and different than Defendant's Mark. He would invite my attention to various documents placed on record indicating use of Trademark by the Defendant since the year 2002. He would

also raise discrepancies in the Deed of Assignment by which the Plaintiff claims to have purchased the Trademark.

7. After hearing the learned counsels appearing for the parties and after going through the order passed by the trial Court, it must be observed at once that the Trial Court has not recorded proper reasons for rejecting the application for temporary injunction. The only reason recorded by the Trial Court are found to be in para-14 of the Order which reads thus:

“14. The Plaintiff himself has stated about the figures of sales of his business which is in Lacs of rupees. It means that, there is the monetary loss to the Plaintiff subjected to the rectification proceeding pending before the Registrar of the Trade Marks. The rectification proceeding against the Plaintiff was moved by the Defendant in the office of Registrar of Trade Mark on 19 /07/2018. This suit is filed on 04/01/2019. Thus the rectification proceeding is prior to the filing of the suit. Thus it is clearly seen that, in view of said rectification proceeding this suit has been filed by the Plaintiff. Hence, I answer point Nos.1 to 3 in the negative and proceed to pass the following order.”

8. Ms. Tulankar would not be entirely wrong in criticizing the Trial Court for using pendency of rectification proceedings as a reason for refusing temporary injunction since it directed by its order dated 16 August 2019 that such pendency would not come in the way of deciding application for temporary injunction. In that view of the matter, the Trial Court ought to have considered the other contentions raised by the parties for deciding the application

for grant of temporary injunction and same could not have been rejected only on the ground of pendency of rectification proceedings. Ordinarily, this would have been a good reason to remand the application for fresh decision to the Trial Court. However, I have heard rival contentions of the learned counsels on other points relevant for deciding whether any case was made out for grant of temporary injunction.

9. It is seen that the Defendant has set up a specific case that he has been in prior use of the Mark since the year 2002. Plaintiff has claimed use of the Mark since the year 2006. The Defendant has placed on record various invoices beginning from the year 2003 by which the products bearing the Mark “POWER FASTENERS’ appears to have been dispatched. While Ms. Tulankar quickly responded by pointing out that those invoices are handwritten and doubted their genuineness, it would be too early at this stage to go into the issue of genuineness of the invoices. Suffice it to observe that some material is placed on record by the Defendant to indicate prior use of the Mark since the year 2002.

10. Also of relevance is the reply filed by the Plaintiff in rectification proceedings. The Plaintiff has averred in his reply as follows :

‘114. It is denied that the mark **POWER FASTENER** of the Applicant is a well known mark. It is submitted by the

Registered Proprietor that the mark **POWER ANCHOR FASTENER** is quite distinctive in aura, phonetics, designs, visuals, soundings and is none the way similar to mark of the Applicant, and that the Registered Proprietor of the mark say that prior to the adoption of the mark the predecessor of the mark has been made prior search over the site of the Trade Mark Registry it is evident that several other marks are on record with several permutation and combination to the mark **POWER** it is also submitted that vide the search/examination report dated 04/04.2016 the mark of the Applicant has not been mentioned as conflicting or cited mark. I say that no exclusive right can be claimed over the mark **POWER** by the Applicant as allegedly claimed.”

“It is denied that the adoption of the impugned trademark ‘**POWER ANCHOR FASTENERS (DEVICE)**’ by the Registered Proprietor was not honest, tenable or bonafide or that the same has been intentionally adopted in an attempt to distinguish their mark from the Applicant’s trade mark despite being a slavish initiation or that the impugned mark bears visual, phonetic, structural similarity or that the impugned trademark was not distinctive of the registered Proprietor on the date of making application for even on the date of making application for rectification the impugned mark lacking in distinctive character.”

“The mark **POWER ANCHOR FASTENERS (DEVISE)**’ is a well known mark repute of its own and needs no piggy ride to ride upon the alleged goodwill or repute of the Applicant, the products are manufactured under the mark **POWER ANCHOR FASTENERS’ (DEVICE)** is completely different from as that of the Applicant, it is also submitted that the aura, design, phonetics, visuals, soundings endings are completely different from as that of the Applicant and no

confusion or deception may arise as allegedly claimed by the Applicant. It is denied that the impugned Trade Mark is identical and/or deceptively similar to the Applicant's trade Marks or there exists a likelihood of confusion on the part of the public including an association of the Registered Proprietors' Trade Mark with the Applicant's Trade Mark."

11. Thus, it is Plaintiff's own case before the Registrar that both the Marks are distinct and that there is no similarity between the two Marks. In the light of this stand taken by the Plaintiff, it cannot be said that a *prima-facie* case was made out by him for grant of temporary injunction.

12. Reliance of Ms. Tulankar on the judgment in the case of **Lupon Limited vs. Johnson and Johnson**, 2015 (1) Mh.L.J. 501 would not assist her case. The Full Bench of this Court in that judgment has held as under :

"43. It is true that the Plaintiff's argument is that registration of a trade mark is done after following the procedure prescribed under the Trade Marks Act and that if the Defendant wanted to raise any objection against the Plaintiff's mark, an opportunity was available to the Defendant when the plaintiff's application was advertised by the Registrar of Trade Marks and an opportunity was given to the world at large to raise an objection to the grant of registration of the trade mark in favour of the Plaintiff. We are of the view that it is precisely because of that reason that there is a strong presumption in favour of the validity of a registered trade mark and at an interlocutory stage in a suit for infringement action, the Civil Court will not easily doubt

the validity of the registration of the Plaintiff's trade mark. Even where the Defendant has taken rectification proceedings before the Appellate Board, the Civil Court will not treat it as a sufficient ground for refusing the grant of an ad- interim injunction in favour of the Plaintiff. But having said so, it is difficult to accept the Plaintiff's contention that the Court is barred from considering the Defendant's plea about fraudulent nature of the Plaintiff's registered trade mark or where the registration of the Plaintiff's trade mark bears the mark of invalidity on its forehead. For instance, in *Corn Products Refining Company v. Shangrila Foods Products Limited*, the Supreme Court held that the words like "Glucose Biscuits" or "Glucose biscuits" are ordinary dictionary words in which no one has any right."

59. (4) There is nothing in the Act to suggest that any different parameters for grant of injunction are required to be applied when a plaintiff seeks injunction on the basis of registered trade mark. The relief of injunction being a relief in equity, when the Court is convinced that the grant of interim injunction would lead to highly inequitable results, Court is not powerless to refuse such relief.

(5) However, a very heavy burden lies on the defendants to rebut the strong presumption in favour of the plaintiff on the basis of the registration at the interlocutory stage. The plaintiff is not required to prove that the registration of a trade mark is not invalid, but only in the cases where the factum of registration is ex facie totally illegal or fraudulent or shocks the conscience of the Court that the Court may decline to grant relief in favour of the plaintiff.

13. There can be no doubt that in the light of registration of Plaintiff's Trademark, heavy burden would lie on the Defendant to

rebut strong presumption in Plaintiff's favour. However in the present case, the Defendant has discharged the burden atleast *prima-facie* by placing reliance on various documents to show prior use of the Mark since the year 2002. Defendant has also sought rectification of Plaintiff's Mark by adopting proceedings prior to filing of Suit. Also, it is Plaintiff's own case before the Registrar that the two Marks are distinct and different. Therefore, mere registration of the Mark in Plaintiff's name in the present case would not be a factor for grant of temporary injunction in his favour.

14. In that view of the matter, though the order of the Trial Court is not happily worded, I am not inclined to interfere with the same. There is no merit in the Appeal. It is **dismissed** without any order as to costs.

15. With dismissal of the Appeal, Interim Application No. 3311/2020 does not survive. The same is disposed of as having become infructuous.

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SANDEEP V. MARNE, J.