



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

Appeal Against Order No. 47 of 2023

Anita W/o Rajesh Upadhyay

Versus

Automark Industries (India) Pvt. Ltd., Yavatmal, Nagpur through its
authorized signatory Mayur Khara

Office Notes, Office Memoranda of
Coram, appearances, Court's Orders
or directions and Registrar's order

Court's or Judge's Order

Shri Firdos Mirza, Advocate for the appellant.
Shri H.V.Thakur, Advocate for the respondent.

CORAM : ANIL S. KILOR, J.
DATED : 14th DECEMBER, 2023.

Heard.

2. The order below Exhibit 23 dated 30th June, 2023 passed by the learned District Judge-13, Nagpur in Trade Mark Suit No. 6 of 2019, rejecting the application moved by the appellant under Order 39 Rule 4 of the Code of Civil Procedure, is under challenge in this appeal.

3. The challenge is raised on the ground that when the injunction was granted in favour of the respondent vide Order Below Exhibit 4 dated 20th March, 2020, there was registration received to the

trade mark of the appellant but it was subsequently registered on 26th February, 2023 and accordingly thereafter the amendment was carried out and application under Order 39 Rule 4 of the Code of Civil Procedure was moved.

4. According to the appellant, the subsequent registration of trade mark is change in circumstance as contemplated under Rule 4 of Order 39 of Code of Civil Procedure.

5. On the other hand, Shri Thakur, learned counsel for the respondent has pointed out reasons recorded by the learned trial Court while granting injunction in favour of the respondent. It is pointed out that, not only the fact that the appellant was not holding any registration of trade mark but on merit also the Court has considered the matter and having found that the trade names of appellant and the respondent are similar and analogous structurally, visually or phonetically the injunction was granted. He, therefore, submits that the learned trial Court has rightly rejected the application moved by the appellant under Order 39 Rule 4 of the Code of Civil Procedure.

6. In the above referred backdrop, I have perused the record.

7. The learned trial Court while granting the injunction, has recorded its reasons in paragraphs 18 to 20, which read thus:

18.... Having regard to the submission made at bar by the learned Advocate for the parties to the suit and after having gone through the documents filed on record, it reveals that the plaintiff is the prior adopter and user of mark AUTOMARK since the year 1998. On the other hand, the defendant is carrying on its business from the year 2017 also the defence taken by the defendant is that the plaintiff's and defendant's trade name are not similar and analogous structurally, visually or phonetically is false. Plaintiff's Mark AUTOMARK is entirely reflected in the Defendants Trade Name AUTO MARK LINE; hence both the names are structurally visually and phonetically same.

19. The defendant has also taken the defence that the defendant is a registered user of the Trade name AUTO MARK LINE and that the registration certificate of its tradename AUTO MARK LINE, has been filed and him along with the written statement marked as D-2. However on perusal of the said document with the help of the counsel for the plaintiff, it was brought to my notice that the document produced by the defendant is not a registration certificate of the impugned trademark, instead it is advertisement published in the trade mark journal for inviting objections to the trademark applied for by the defendant. The plaintiff vehemently objected to the defendant to the defendant's conduct of giving a false statement before this court and has gone to the extent of saying and submitting that the defendant has committed perjury by stating that, she has a registered trademark for AUTO MARK LINE, and that she has acquired a

registration certificate under the Trademarks Act, 1999.

20. The claim of the plaintiff being a bonafide, prior and registered user appears to be correct. Per se the defendant has not been able to show the registration of their tradename / trademark. In addition to this the defendant has also admitted to the date 26.11.2017 as the date from which the defendant is using the Trademark AUTO MARK LINE. Hence the plaintiff company's claim to ownership over Trademark appears to be correct. The plaintiff company is also successful in proving that the using of the same name by the defendant in same line of business is causing the plaintiff business losses. For the same the plaintiff company has filed on record the profit and loss statements at document no.11. It is further to say that, I am satisfied that the plaintiff company has a genuine case and has filed this suit for the damages and losses arising to its business because of the confusion created by the defendant's proprietorship firm which has a similar trade name as of the plaintiff company's. On perusal of documents, it reveals that plaintiff has succeeded in proving that he is the prior adopter and user of the said mark AUTOMARK is required to be protected by way of injunction order restraining the defendant from using identical and similar impugned mark AUTO MARK LINE and it is well settled principle of law that prior user of mark is always required to be protected under passing off action.

8. From the above referred observations it is apparent that the injunction was not granted only for the reasons that the appellant was not possessing registration of trade mark, but on merit Court has considered the case and arrived at a conclusion that the

plaintiff is the prior adopter and user of mark AUTOMARK since the year 1988 and the defendant is carrying on its business from the year 2017. The learned trial Court has further found the names visually, structurally or phonetically same. It is further held that, plaintiff's trade name AUTOMARK is entirely reflected in the Defendants Trade Name AUTO MARK LINE.

9. The learned trial Court has further observed that on perusal of document it reveals that plaintiff has succeeded in proving that he is the prior adopter and user of the said mark AUTOMARK and therefore, is required to be protected by way of injunction, restraining the defendant from using identical and similar mark AUTO MARK LINE. The learned trial Court has observed the principle of law that prior user of mark is always required to be protected under passing off action.

10. In the circumstances, I do not find any error committed by the learned trial Court in rejecting the application filed by the appellant under Rule 4 of Order 39 of Code of Civil Procedure by holding that essentially there is no change in circumstances which is the pre-requisite to entertain the application under Rule 4 of Order 39 of the Code of Civil Procedure.

11. In the circumstances, the judgment cited by the learned counsel for the appellant of the Calcutta High Court in the case of Dover Park Builders Pvt. Ltd and others Vs. Smt. Madhuri Jalan and others¹ is distinguishable and is of no help to the appellant. Accordingly, the appeal against order is dismissed.

12. At this stage, Shri Mirza, learned counsel for the appellant submits that now the only remedy left with the appellant is to raise a challenge to the order granting injunction. He states that the respondent has however, filed a contempt proceeding and pressing it hard and therefore, it would be difficult for the appellant to raise a challenge to the said order.

13. The learned counsel for the respondent thereupon fairly submits that for four weeks from today he will not press for the action against the appellant for commission of contempt.

14. The statement is accepted.

[ANIL S. KILOR, J.]

1 AIR 2003 Calcutta 55