

IN THE HIGH COURT OF JUDICATURE AT BOMBAY

CIVIL APPELLATE JURISDICTION

COMMERCIAL APPEAL FROM ORDER NO. 13 OF 2023

ALONGWITH

INTERIM APPLICATION NO. 14655 OF 2023

ALONGWITH

INTERIM APPLICATION NO. 2503 OF 2023

IN

COMMERCIAL APPEAL FROM ORDER NO. 13 OF 2023

Santosh Vishnu Mardhekar

**..... Appellant/
Applicant**

VERSUS

Arun Shamrao Mardhekar

..... Respondent

Mr. Sandesh D. Patil i/b. Mr.Prithviraj S. Gole for the
Appellant/Applicant.

Mr. Vinaykumar Khatu a/w. Mr. Ashok D. Kadam, Ms. Sneha
Thakre for the Respondent.

Coram : A.S. Chandurkar & Rajesh S. Patil, JJ.

Date on which the arguments were heard : 19th August 2024

Date on which the judgment is pronounced : 3rd SEPTEMBER 2024

JUDGMENT (PER - RAJESH S.PATIL, J.) :-

The present Commercial Appeal from Order is filed by the
appellant (original defendant) challenging the judgment and
order dated 17th February 2023, passed below Ex.5, by the

District Court, Satara in Regular Civil Suit No. 1 of 2023.

2. The appellant herein is the original defendant before the Trial Court, and the respondent herein is the original plaintiff before the Trial Court. The parties are hereinafter referred as per their nomenclature in the Trial Court.

3. The plaintiff on 5th December 2022 filed a suit before the District Court, Satara against the defendant claiming recovery of an amount of Rs.10,92,799/- and also sought an order restraining permanently the defendant from manufacturing, selling and storing the product in the name of “शुभलक्ष्मी चिवडा रिटकवली”. Along with the suit, the plaintiff also preferred an interim application in the form of ‘Ex.5’ thereby seeking interim orders during pendency of the suit, against the defendant and their representatives to restrain them from manufacturing, selling and storing the product in the name of “शुभलक्ष्मी चिवडा रिटकवली”.

4. The plaintiff's suit is based on the ground that the plaintiff has a trademark as "रिटकवली", "रुचकर स्वादिष्ट खमंग", (R RITKAWALI)". The plaintiff's trademark was registered on 9th March 2015. It was further the case of the plaintiff that the defendant started selling the product Chiwda from the year 2012 under the name of "शुभ". However, since defendant was not able to earn sufficient income, therefore from the year 2014 – 2015 the defendant started his production in the name of "शुभलक्ष्मी" which was similar to the name of plaintiff product "महालक्ष्मी". However, even then as there was no good response, the defendant from the year 2016-2017 started selling his product in the name of "शुभलक्ष्मी चिवडा रिटकवली" which was similar to the name of the product of the plaintiff.

5. After, the defendant was served with the copy of plaint and 'Ex. 5' application, the defendant filed his reply to 'Ex.5'. The defendant denied the contentions of the plaintiff. He submitted that his family resides at Ritkawali. He has manufacturing unit

at Medha and the raw material process is carried out at Ritkawali.

6. The learned District Judge, Satara, thereafter heard the advocate of both sides, on the interim application 'Ex.5' and by his judgment and order dated 17th February 2023, partly allowed the 'Ex.5' application of the plaintiff, thereby temporarily restraining the defendant from manufacturing, selling, storing the product “रिटकवली स्पेशल शेव चिवडा” or “रिटकवली स्पेशल” or “शेव चिवडा रिटकवली स्पेशल ”.

7. Being dis-satisfied with the judgment and order dated 17th February 2023 passed by the District Judge, Satara partly allowing Ex.5 application, the defendant has filed the present Commercial Appeal from Order, under Section 13 of the Commercial Courts Act.

8. Mr. Sandesh D. Patil, learned counsel appeared on behalf of the applicant (original defendant) made his submissions. He

submitted that the case of the plaintiff was not that of 'passing off' but was that of 'infringement of trademark'. He submitted that the plaintiff's mark was that of "रिटकवली" written in bold font along with three words written below it "रुचकर स्वादिष्ट खमंग", with a portrait of a boy standing with the cap in his right hand, wearing a green T-shirt and the word "R" written on the said T-shirt and wearing orange trouser. He submitted that the plaintiff however was selling his product with the name "महालक्ष्मी" written in larger font and in a smaller font the word "रिटकवली" written below the word "महालक्ष्मी" and a upper body picture of a boy with a cap in his hand, on the top of the word "महालक्ष्मी" above which the word "रुचकर स्वादिष्ट खमंग" is written in a circle. The printing on packet in which the plaintiff was selling his product, was different from the actual registered *trademark* of the plaintiff. He submitted that the defendant was selling his product as per the plaintiff's own case in a packet wherein the name of "शुभलक्ष्मी" was written in a large font and below it, in a small font word "रिटकवली" written on the

background of blue colour. He submitted that there was no similarity between the registered trademark of the plaintiff and the packet on which the defendant was selling his product. He submitted that the plaintiff uses a logo and mark on his packet which infact is quite different than the registered trademark of the plaintiff.

9. Mr. Patil further submitted that, the ground on which the plaintiff had sought injunction, in the plaint, in fact on the bare reading will show that such injunction cannot be granted to the plaintiff. He submitted that the plaintiff had only sought an injunction against the defendant not to manufacture, sale and store product in the name of “शुभलक्ष्मी चिवडा रिटकवली”. Whereas the learned District Judge has passed an order restraining the defendant from the manufacturing, selling and storing the product “रिटकवली स्पेशल शेव चिवडा or रिटकवली स्पेशल or शेवचिवडा रिटकवली स्पेशल”. He submitted that the learned Judge failed to appreciate all these facts and without considering the legal

position, has passed the impugned judgment and order of infringement of the trademark against the defendant and has granted a relief which in real sense was not sought in the Ex.5 and/or in plaint.

10. To buttress his submissions, Mr. Patil referred to the following judgments :-

(a) The judgment delivered by Nagpur Bench of Bombay High Court in the case of *Orange City Mobile Collection, Nagpur vs. City Collection, Nagpur & Ors., 2017 (3) Mh. L. J. 180*

(b) The judgment of Full Bench of this Court in case of *Lupin Ltd. vs. Johnson & Johnson, 2015 (1) Mh.L.J. 501*

11. Mr. Patil, appearing for the appellant also tendered an undertaking of his client that his client is ready for the sake of removing any kind of ambiguity to change the colour of his packet from red colour background entirely to blue colour background.

12. Mr. Patil submitted that the present Commercial Appeal

From Order, requires to be allowed and the impugned judgment and order should be quashed and set aside.

13. Mr. Vinaykumar Khatu, learned counsel appeared on behalf of the respondent (original plaintiff) who made his submissions. He submitted that after taking into consideration the entire facts and hearing the parties, the learned District Judge had allowed the application Ex.5 of the plaintiff. He submitted that the plaintiff for generations was in business of Shev Chiwda at Village Ritkawali. He submitted that the defendant was trying to imitate the plaintiff in taking advantage of the brand of the plaintiff and has started the business in the similar kind of name, as that of the plaintiff. Hence, the plaintiff has no option but to file a suit for infringement of the trademark, against the defendant. He submitted that the plaintiff is carrying on his business in the village Ritkawali and the defendant has also now started conducting his business in the same village. He submitted that the defendant has not mentioned in his reply as to from when he has started conducting his business. He submitted

that the plaintiff and the respondent are into the same business that of 'Shev Chiwda'. Hence, the public at large are going to be confused that the product which the defendant is selling is that of the plaintiff. He relied upon the following judgments in support of his submissions :-

(a) The judgment of Supreme Court in case of *S. Syed Mohideen vs. P. Sulochana Bai*, (2016) 2 SCC 683

(b) The judgment of Delhi High Court in case of *Hamdard National Foundation (India) & Ors. vs. Sadar Laboratories Pvt.Ltd.*, 300 (2023) DLT 420

(c) The order of Supreme Court in Petition for *Special Leave to Appeal (C) No. 9494 of 2023 in case of Sadar Laboratories Pvt. Ltd. vs. Hamdard National Foundation (India) & Anr.*

(d) The judgment of this Court in case of *Pidilite Industries Ltd. vs. S. M. Associates & Ors.*, 2003 (5) Bom.C.R. 295.

(e) The order of Delhi High Court in case of *Siddharth Suri vs. Registrar of Trade Marks in C.A. (COMM IPD-TM) 77 of 2021 dated 10th January 2023.*

14. We have heard learned counsel of both the sides and with their help, considered the documents on record including the

10/26

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packet of Shev Chiwda in which the plaintiff is selling his product and also the packet of the defendant in which he is selling his product. Also before us the parties tendered copy of the registered trademark (device mark) of the plaintiff. For ease of reference, the registered trademark of the plaintiff is reproduced hereinbelow :-

1702294
2917476

FORM TM-1
TRADE MARKS ACT, 1999
Application for registration of a Trade Mark for goods or services (other than a collective mark or a certification trademark) in the register.
Section 18(1), Rule 25(1).

Proprietor Code:



Application is hereby made for registration in the register of the accompanying Trade Mark in Class 30 in respect of FARSAN, COFFEE, TEA, COCOA, SUGAR, RICE, TAPIOCA, SAGO, ARTIFICIAL COFFEE; FLOUR AND PREPARATIONS MADE FROM CEREALS, BREAD, PASTRY AND CONFECTIONERY, ICES, HONEY, TREACLE; YEAST, BAKING POWDER; SALT, MUSTARD; VINEGAR, SAUCES, (CONDIMENTS); SPICES; ICE, INCLUDED IN CLASS 30, in the name of **MR ARUN SHAMRAO MARDHEKAR**, (Proprietor – An Indian Resident) trading as **RITKAWLI**, (A Proprietary Concern), whose office address is: **MILKAT NO. 186, AT-RITKAWLI, POST-BIBHAVI, TALUKA-JAWALI, DISTRICT-SATARA**, Trade Description: MANUFACTURERS & TRADERS, who claim to be the owner thereof and by whom the said mark is being used 30-01-2014 in respect of the said goods.

RITKAWLI
MILKAT NO. 186, AT-RITKAWLI,
POST-BIBHAVI, TALUKA-JAWALI,
DISTRICT-SATARA

Dated this: 02-03-2015

2917476

रजिस्टर ऑफ बेल्युएबल मुंबई
स्वीड सं..... के माध्यम से
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दिनांक.....
रूपये नकद/चेक/डीडी/मनी ऑर्डर/.....
.....) प्राप्त हुए/गए: हुआ

FOR
FOR RITKAWLI
For RITKAWLI
(Proprietor)
MR ARUN SHAMRAO MARDHEKAR
(Proprietor)

To,
The Registrar of Trade Marks,
Trade Marks Registry,
Mumbai – 400 037
Mob. No.

Plaintiff's Trademark (Device)

15. So also, we have considered the pictorial representation of the packet of the plaintiff containing Shev Chiwda. The same also for the purpose of reference is reproduced hereinbelow :-



Plaintiff's Packet

16. From the bare perusal of the registered trademark of the plaintiff and the pictorial representation of the plaintiff of its packet appears to be quite different. Though the plaintiff has registered trademark which appears from the documents tendered before us to be a *device mark*, includes a name and a small boy standing with hat in his right hand. However, the pictorial representation of the plaintiff on his packet, the picture of boy is separated from the word “रिटकवली” and in the middle of two, in large font appears to be “महालक्ष्मी”. Therefore, it appears that the plaintiff is infact not using his registered ‘device mark’ on his packet meant for sale of Shev Chiwda.

17. Coming to the pictorial representation of the defendant used on his packet which was tendered before us, the same is reproduced hereinbelow for sake of easy reference.



Defendant's Packet

18. It appears that the defendant has used only a face of a young boy and in large font used the word “शुभलक्ष्मी” and below the same there is a word “रिटकवली” with blue background and again “शेवचिवडा” in red colour is used in the larger font.

19. On the mere perusal of the pictorial representation of the packet of the defendant, we find that the same is quite different than the registered trademark of the plaintiff. So also, the defendant has used in English language slogan “Bass Khate Jao”, which does not appear on the packet of the plaintiff. This coupled with the fact that the defendant is ready and willing to change the background colour of his pictorial representation of his packet, a copy of which has been tendered before us by the defendant, according to us the packet of defendant will then be quite different in colour than that of plaintiff. The proposed colour combination of defendant’s packet which was tendered before us is reproduced hereinbelow :-



Proposed packet of Defendant

20. We have also considered the submissions made by the plaintiff in his plaint. Paragraph nos. 2, 6, 7, 8 and 12 of the plaint are reproduced hereinbelow :-

2. The Plaintiff in order to increase the marketing and preserve the quality of products has register the trademark as "Ritkawali", "RuchkarSwadisthaKhamang" (R Ritkawali). The registration number is 2917476 and the same is registered on 9/3/2015.

6. The business of the plaintiff is being conducted under the name of " Mahalaxmi Chiwda Ritkawali". However since the name "Mahalaxmi" is the name of deity and "Ritkawali" being the name of place, the same cannot be legally registered as Trademark and considering the said legal difficulty, the plaintiff has registered his trademark as "Ritkawali", "Ruchkar Swadistha Khamang" and the plaintiff is selling the products under the said trademark.

7. The defendant is the resident of Medha and he is also carrying out the similar business of Chiwda and Farsan. The defendant has started his business in the year 2012 and 2013 under the name of "Shubh" Chiwda, Farsan, however he was not able to earn sufficient income through the same. Considering the said position, the defendant in the year 2014-2015 the defendant started production in the name of "Shubhlaxmi" which is similar to the name of Plaintiff's product "Mahalaxmi" However the defendant was still not getting proper response. The defendant there for in the year 2016-2017 had started to manufacture and sell his products under the name. "Shubhlaxmi Chiwda Ritkawali" which is similar to the name of product of the present plaintiff. Since the defendant was getting response from the customers, the defendant also started to match the packaging, design and colour in the year 2018-2019.

8. In reality, the defendant are using the name

"Shubhlaxmi Chiwda Ritkawali" which is quite similar to the name of product of plaintiff "Mahalaxmi Chiwda Ritkawali" and are continuing to do so even today.

12. The Plaintiff because of the said circumstances, have to clarify to everyone that the products Mahalakshmi and Shubhlakshmi are different and that they are not same. The Plaintiff has tried to mark out the difference to the people who had contacted him. However, the people who had not contacted him are being duped and are therefore not purchasing the product of the Plaintiff and hence the same is causing huge financial loss and is also depreciating the goodwill of the plaintiffs business and the said loss cannot be recovered and the same is irreparable and it is the defendant who is responsible for the same.

(Emphasis supplied)

21. Taking into consideration the pleadings of the plaintiff and considering the pictorial representation of the proposed packet of the defendant and the registered device mark of the plaintiff, we don't find that the defendant has infringed the plaintiff's registered trademark.

22. The learned Judge of the Trial Court while considering the "Ex-5" Application of the plaintiff did not consider the above facts and has arrived at the conclusion on the basis that the defendant did not place on record any matter to distinguish the wrapper of

defendant from that of plaintiff. The goods of both parties are the same and have same characteristics, the target users of the goods are not intelligent and are likely to misconceive the product of the defendant with that of the plaintiff. The geographical location for business of both parties and their products/ goods are entirely the same. The customers from small villages and market area of the defendants are the same so there is *prima facie* ground to assume that, the defendant wanted to ride on the reputation and goodwill of the plaintiff. Thus had arrived at the conclusion that the plaintiff was able to prove a *prima facie* case in order to grant interim relief on application Ex.5. Hence, the learned trial Judge granted temporary injunction, thereby directing defendant and his agents from manufacturing, storing, selling the product “रिटकवली स्पेशल शेव चिवडा” or “रिटकवली स्पेशल” or “शेव चिवडा रिटकवली स्पेशल ”, till the decision of suit.

23. We have considered the findings of the Trial Court, the learned Judge has granted a relief which infact was not even

sought by the plaintiff. The plaintiff's prayer was not to allow the defendant to use "शुभलक्ष्मी चिवडा रिटकवली" ("Shubhlaxmi Chiwda Ritkawali") whereas the learned Judge has granted injunction restraining the defendant using "रिटकवली स्पेशल शेव चिवडा" (Ritkawali Special Shev Chiwda) or "रिटकवली स्पेशल" (Ritkawali Special) or "शेव चिवडा रिटकवली स्पेशल" (Shev Chiwda Ritkawali Special).

24. Therefore the impugned judgment of the Trial Court on the face of it suffers from perversity as the learned Trial Court has travelled beyond the pleadings and granted a relief which is not even sought by the plaintiff. Therefore we are of the opinion that the impugned judgment requires to be interfered with.

25. Taking into consideration the registered trademark (device) of the plaintiff and the plaintiff's packet in which he sells his "Shev Chiwda" both are quite different. The defendant's packet as per the plaintiff case is deceptively similar to that of the plaintiff's packet and the same is creating confusion in the minds

of the customers.

26. According to us the plaintiff himself is not using his registered trademark on his packet. Hence, *prima facie* the plaintiff is not able to prove that the defendant's packet is similar to the registered trademark (device) of the plaintiff.

27. Full Bench of this Court in case of *Lupin Ltd.* (supra) while dealing with a reference question "*Whether the Court can go into the question of the validity of the registration of the plaintiff's trade mark at an interlocutory stage when the defendant takes up the defence of invalidity of the registration of the plaintiff's trade mark in an infringement suit?*", held that there is no express or implied bar taking away the jurisdiction of the Civil Court to consider the challenge to the validity of the trade mark at the interlocutory stage by way of *prima facie* findings. The purpose of registered trademark was to prevent others from using an identical trademark. Paragraph no. 34 of the said judgment reads as under :-

34. While we agree with Dr.Tulzapurkar for the Plaintiff that the object of providing for registration of a trade mark and recognising the exclusive right of the registered proprietor to use the registered trade mark in order to prevent others from using an identical or deceptively similar trade mark is to obviate the necessity of proving in each and every case the Plaintiff's title to the mark, its distinctiveness and its reputation, we are of the view that the object has been achieved by raising a presumption, and a strong presumption in law, as to the validity of registration of the mark. The burden is therefore cast, and a heavy burden at that, on the Defendant to question the validity of registration. While such a challenge can finally succeed only in a rectification proceedings which now lie before the Intellectual Property Appellate Tribunal (IPAT), we do not find any express or implied bar in the Trade Marks Act to completely take away the jurisdiction and power of the Civil Court to consider the challenge to the validity of registration of the trade mark at the interlocutory stage by way of a prima facie finding on such issue.

(Emphasis supplied)

28. In the present proceedings, according to us the plaintiff is not using the registered device mark, on his wrapper, therefore the plaintiff cannot seek infringement of his trademark, against the defendant on the basis that the defendant is using similar kind of trademark on his packet.

29. In the judgment delivered by Nagpur Bench of Bombay High Court, by one of us (A. S. Chandurkar, J.) in the case of

Orange City Mobile Collection, Nagpur (supra) Trial Court in suit for passing off, of goods, granted temporary injunction which was challenged before the High Court. The High Court held that the material placed on record by plaintiff was not sufficient to grant an order of temporary injunction in favour of the plaintiff. Hence, the High Court quashed and set aside the temporary injunction granted in favour of the plaintiff.

29.1. The High Court relied upon Supreme Court judgment reported in *AIR 1965 SC 980 – Kaviraj Pandit Durga Dutt Sharma vs. Navratna Pharmaceutical Laboratories*, which observed that, in an action for passing off, defendant could escape liability if it can be shown that the added matter was sufficient to distinguish his goods from those of the plaintiff. The High Court accepted the statement made by the defendant, that they are willing to increase fonts of the words “Orange” and “Mobile” in its logo to make the entire trade name of the defendant conspicuously visible. The defendant was directed without prejudice to the rights of the parties to increase the fonts of the said words in its

logo during the pendency of the suit.

30. The ratio laid down in the matter of *Orange City Mobile Collection, Nagpur (supra)* is squarely applicable in the present proceedings. Even before us the defendant through its counsel has tendered an undertaking that they are willing to change the background colour from red to blue colour of its packet, in which he is selling Shev Chiwda. Hence, in the present proceedings we are directing the defendant, without prejudice to the rights and contentions of the parties to change the background colour of the packet in which they are selling the Shev Chiwda, from red colour to blue colour background.

31. The plaintiff has also raised a grievance that the defendant has suppressed the fact about he being granted a new trademark by the Registry during the pendency of the present proceedings. The defendant has admitted that he had applied for two different trademarks, and the same have been granted by the Registry. He submitted that that will have no bearing on the present

proceedings.

According to us, the defendant now getting a new trademark will not have any bearing on the pending proceedings as a plaintiff's suit for infringement is based on a registered device mark, the fact that plaintiff himself is not using his device mark on the packet sold by him, that itself, calls for an interference from us to the discretion exercised by the Trial Court by granting an injunction.

32. Taking into consideration the facts of the present proceedings wherein the plaintiff is not using his registered device mark on his packet meant for selling Shev Chiwda, the Trial Court granted relief which was not even sought by the plaintiff. Hence the ratio laid down in the authorities relied upon by the learned counsel for the plaintiff will not be applicable to the present proceedings.

33. As a result of the aforesaid discussion, the following order is passed :-

ORDER

(a) The order passed by the Trial Court below Ex.5 dated 17th February 2023 is hereby quashed and set aside. The application below Ex.5 stands rejected.

(b) Without prejudice to the rights and contentions of the parties, the defendant is directed to change the background colour of the packet in which he sells Shev Chiwda, from red colour to blue colour as undertaken by him.

(c) The hearing of Regular Civil Suit No. 1 of 2023 pending before the District Court, Satara is hereby expedited.

34. The Commercial Appeal From Order No. 13 of 2023 is hereby allowed. No costs.

35. Pending Interim Applications are also disposed of.

[RAJESH S. PATIL, J.]

[A.S. CHANDURKAR, J.]