

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
CIVIL APPELLATE JURISDICTION**

**APPEAL FROM ORDER NO. 352 OF 2021
WITH
INTERIM APPLICATION NO.3035 OF 201
IN
APPEAL FROM ORDER NO.352 OF 2021**

Samya International,
through its partner
Nayan Dineshkumar Shah

..Appellant.
(Org. Defendant No.1)

v/s.

1. Relaxo Domeswear LLP
& Ors.

..Respondents

Adv. Shilpa Kapil for the Appellant.
Adv. Afrim Khan i/b. Mr. Mateen Shaikh for the Respondent.

**CORAM : ANUJA PRABHUDESSAI, J.
DATED : 18th January, 2024.**

P.C.

1. The challenge in this appeal is to the order dated 28.09.2021 passed by the learned District Judge, Nashik, allowing the Application for temporary injunction at Exhibit 5 filed by the respondent in Civil Suit (Trade Mark) No.2 of 2021.

2. The respondent nos.1 and 2 are the plaintiffs and the appellant is defendant no.1 in the suit, and shall be hereinafter referred to as

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PRADEEP
SALGAONKAR**

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the plaintiffs and defendant respectively.

3. The plaintiff no.1 is a limited liability partnership firm, whereas plaintiff no.2 is the designated partner of plaintiff no.2 firm. The plaintiff no.2 is in business of manufacturing and trading grain preservatives, household insecticides, mosquito coils and agarbatti, liquid blue (neel), etc., under well known brands. The plaintiffs claim to be the owners of trade mark 'Dengue Don' which is in use since 2006 for household insecticides, mosquito repellents, coils, agarbatti etc. The trade mark 'Dengue Don' vide application no.2945722 is registered in the name of plaintiff no.2 for goods in class 5. On 3.9.2021, plaintiff no.2 assigned the said trade mark in favour of plaintiff no.1. The trademark 'Dengue Don' vide application no.4261620 is registered in the name of plaintiff no.1 for goods -agarbatti, soaps, perfumes etc in class 3. They have been openly, continuously and extensively manufacturing, packing and marketing and selling its goods under the said trade marks. In addition to 'Dengue Don' trade mark, the plaintiffs have also adopted and is continuously using tag line "Garden Incense Stick" on the packing of incense sticks. It is stated that with extensive, continuous and long use of trade mark 'Dengue Don' plaintiff has gained enormous good will and reputation, across border. The

plaintiffs claim to have statutory right in respect of the said trade marks.

4. In July 2019, the plaintiffs came across incense sticks of defendant no.1 with trade mark “Dengue Don” which is identical and deceptive to the trade mark of the plaintiffs. By legal notice issued in August 2019, the plaintiffs called upon defendant no.1 to cease and discontinue from using the said trade mark. The plaintiffs claim that the defendant vide reply dated 15.9.2019 turned down the request to stop using the said trade mark. However, subsequently the defendant orally assured to stop using the said trade mark after clearance of the pending stock. The plaintiffs state that they did not take any steps against the defendant in view of the oral assurance given by the defendant.

5. In February 2021 the plaintiffs learnt that the defendants had applied for identically and deceptively similar trade mark “Garden Dengue Don” in respect of identical goods i.e. agarbatti, mosquito agarbatti, dhoop and loban. The plaintiffs claim that even the Registrar of Trade Marks had raised objection for registration of impugned trade mark citing similarity to the earlier trade mark of

the plaintiffs. The plaintiffs also opposed registration of the impugned trade mark.

6. In August 2021, the plaintiffs learnt that the goods of defendant no.1 under identical trade mark are being sold in Jalgaon City. It is stated that the impugned trade mark is visually, phonetically and structurally identical and similar to the prior used and prior registered trade mark of the plaintiffs. Furthermore, the goods sold by the Defendant are also similar and this creates confusion in the minds of the purchasers. It is averred that the Defendant is passing off its goods as those of the Plaintiffs. The plaintiffs therefore filed a suit for perpetual injunction to restrain the Defendant from infringing the trade mark, by reproducing, printing, publishing, using and/or communicating to the public the impugned trade mark or any other deceptively similar trademark or substantial part thereof in any other manner whatsoever. The plaintiffs filed an application at Exhibit 5 for interim relief against infringement of trade mark and also sought appointment of a Court Commissioner/ Receiver.

7. The defendant denied that the plaintiff no.1 is in business of

manufacturing or sale of agarbatti or mosquito coil and contended that the plaintiff no.2 is in business of manufacture and sale of insecticides, which under mark no. 2945722 falls in Class 5 goods. It is stated that a few days before filing of the suit, plaintiff no.2 in collusion with plaintiff no.1 executed a deed of assignment and assigned the mark to plaintiff no.1. The mark no.4261620 applied for by plaintiff no.1 on 9.8.2019 shows the user as 'proposed to be used'. The defendant claims that the mark applied by it vide TM application no. 4309171 shows the user since 5.6.2011. The defendant had also produced invoices indicating the use of mark 'Garden Dengue Don' since the year 2011. The defendant therefore claims to be the prior user, adopter, owner and proprietor of the mark 'Garden Dengue Don'. The defendant has further stated that it has applied for rectification against registration of trademark of plaintiff no.1, which is pending adjudication before the Trade Mark Registry.

8. Upon considering the material on record, the learned Judge observed that 'Dengue Don' mark is registered in the name of plaintiff no.2 in class 5 and that the said mark has been assigned in favour of plaintiff no.1. Learned Judge further held that the mark

‘Dengue don’ for goods in class 3 is registered in the name of plaintiff no.1. The learned Judge has opined that the defendants are using the ‘Garden Dengue Don’ mark since the year 2011, but the status report shows that the trade mark application of defendant no.1 is still pending before the Registrar of Trade Marks for registration. Learned Judge observed that the plaintiffs have prima facie proved infringement of registered trade marks in their favour. Learned Judge has further observed that the mark of the defendant is identical and deceptively similar to the mark of the plaintiffs. The learned Judge held that the plaintiff has made out a prima facie case and hence allowed the application at Exhibit 5 and restrained the defendants from infringing the trade mark ‘Dengue Don’, and further restrained the defendants from manufacturing, packing, selling, exhibiting for sale agarbatti, mosquito agarbatti under the impugned trade mark or deceptively similar trade mark so as to pass off the plaintiffs goods. The learned Judge also appointed Court Commissioner to take charge of the goods of the defendant by entering into their premises and to make inventory and seal the said goods. Being aggrieved by the said order, the defendants have filed this appeal.

9. The learned Judge had stayed the operation/execution of the order for a period of four weeks. By order dated 25.10.2021 this Court declined to continue the interim relief on the ground that the application for registration of trade mark filed by the plaintiff was prior in point of time and that the trade mark adopted by the defendant is phonetically identical.

10. Adv. Shilpa Kapil, learned Counsel for the defendant submits that the trade mark by the plaintiff no.1 was granted on 21.4.2015 under class 5 for household insecticides. It is submitted that the plaintiffs were not in the business of sale of agarbatti, dhoop and loban before 9.8.2019. It is submitted that the trade mark granted to the plaintiff no.2 on 9.8.2019 is under class 3 and that the plaintiff had made a categorical statement in form TM-A filed on 9.8.2019 that it was 'proposed to be used'. It is submitted that the said statement clearly indicates that prior to 9.8.2019 the trade mark 'Dengue Don' was not used but was 'proposed to be used' in respect of goods in class 3. It is therefore submitted that the learned Judge has erred in holding that the plaintiff was the prior user of the trade mark 'Dengue Don'.

11. It is submitted that the trade mark of plaintiff no.2 which is under class-5 for household insecticides does not have any similarity with the mark of the defendant which is in respect of goods under class 3. The defendants have filed rectification application challenging registration of trade mark of plaintiff No.1 in class-3. It is submitted that registration of the mark or similar mark prior in point of time is irrelevant, and what is relevant is the use of the mark prior in point of time. She contends that the learned Judge failed to appreciate that the defendants were prior user of the trade mark 'Dengue Don' since the year 2011, and the sale figures produced by them indicate that they have goodwill all over the country. She further claims that the plaintiffs had approached the court after considerable delay. She has relied upon the decisions in ***R.J. Components and Shafts vs. Deepak Industries Limited and Ors.*** 244 (2017) *Delhi Law Times* 502, to contend that prior user of goods will override subsequent users even though subsequent user has registered trademark. Reliance is also placed on order dated 11.04.2016 of the learned single Judge of this Court in ***International Foodstuffs Co. LLC vs. Parle Products Pvt. Ltd. and Anr., (Notice Motion No.2624 of 2012 in Suit No.2497 of 2012)*** and the decision of the learned Single Judge of Delhi High

Court in ***Peps Industries Pvt. Ltd. vs. Kurlon Ltd. (IA No.4871 of 2019 and 6715 of 2019 in C.S. (COMM) 174 /2019)***.

12. Per contra, learned Counsel for the plaintiffs submits that the trademark 'Dengue Don' is registered in favour of the plaintiffs and that the user is since 31.12.2006. Relying upon the decision in ***Allied Auto Accessory Ltd. vs. Allied Motors Pvt. Ltd., 2003(3) BCR 367*** he submits that guidelines or classification list which is published by trademark registry is only for administrative purpose. He further submits that the defendant has applied for deceptively similar trademark in respect of identical goods. The trade channels and consumers for the said goods are also the same. He contends that even the Registrar of Trademark has raised objections for registration of the said trademark citing similarity to the earlier trademark of the plaintiff. Learned counsel for the plaintiff further submits that the defendants have infringed the registered trademark of the plaintiffs and have thereby violated the statutory right of the plaintiffs. The learned Judge was therefore justified in granting the interim relief in favour of the plaintiff.

13. I have perused the records and considered the submissions

advanced by the learned counsel for the respective parties.

14. Before advertng to the facts of the case, it would be advantageous to refer to the decision of the Apex Court in ***Renaissance Hotel Holdings INC. vs. B. Vijaya Sai and Others (2022) 5 SCC 1*** wherein the Hon'ble Supreme Court revisited the entire scheme of the Trade Mark Act and held thus :-

33.Sub-section (1) of Section 28 of the said Act provides that subject to the other provisions of the said Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by the said Act. Sub-section (2) of Section 28 of the said Act provides that the exclusive right to the use of a trade mark given under sub-section (1) of Section 28 of the said Act shall be subject to any conditions and limitations to which the registration is subject. ...

34.Sub-section (1) of Section 29 of the said Act provides that a registered trade mark is infringed by a person who, not being a registered proprietor or a

person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

35.Sub-section (2) of Section 29 of the said Act provides that a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

36.Sub-section (3) of Section 29 of the said Act is of vital importance. It provides that in any case falling under clause (c) of sub-section (2) of Section 29 of the said Act, the court shall presume that it is likely to cause confusion on the part of the

public.

37. A perusal of sub-section (2) of Section 29 of the said Act would reveal that a registered trade mark would be infringed by a person, who not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of the three eventualities mentioned in clauses (a), (b) and (c), is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark. The first eventuality covered by clause (a) being its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark. The second one covered by clause (b) being its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark. The third eventuality stipulated in clause (c) would be its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark.

38. It is, however, pertinent to note that by virtue of sub-section (3) of Section 29 of the said Act, the legislative intent insofar as the eventuality contained in clause (c) is concerned, is clear. Sub-section (3) of Section 29 of the said Act provides that in any case falling under clause (c) of sub-section (2) of Section 29 of the said Act, the

Court shall presume that it is likely to cause confusion on the part of the public.

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46. Section 31 of the said Act is also relevant in the present case, which reads thus:

“31. Registration to be prima facie evidence of validity.—(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof.

(2) In all legal proceedings, as aforesaid a registered trade mark shall not be held to be invalid on the ground that it was not a registrable trade mark under Section 9 except upon evidence of distinctiveness and that such evidence was not submitted to the Registrar before registration, if it is proved that the trade mark had been so used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration.”

47. It could thus be seen that in all legal proceedings relating to trade mark registered under the said Act, the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof.

48. The legislative scheme is clear that when the mark of the defendant is identical with the registered trade mark of the plaintiff and the goods or services covered are similar to the ones covered by such registered trade mark, it may be necessary to prove that it is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark. Similarly, when the trade mark of the plaintiff is similar to the registered trade mark of the defendant and the goods or services covered by such registered trade mark are identical or similar to the goods or services covered by such registered trade mark, it may again be necessary to establish that it is likely to cause confusion on the part of the public. However, when the trade mark of the defendant is identical with the registered trade mark of the plaintiff and that the goods or services of the defendant are identical with the goods or services covered by registered trade mark, the Court shall presume that it is likely to cause confusion on the part of the public.”

15. The Hon’ble supreme Court referred to the relevant judicial precedents and summarized the difference between the causes of action and right to relief in suits for passing off and for

infringement of a registered trademark as under:-

50. It could thus be seen that this Court has pointed out the distinction between the causes of action and right to relief in suits for passing off and for infringement of registered trade mark. It has been held that the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark, cannot be equated. It has been held that though an action for passing off is a Common Law remedy being an action for deceit, that is, a passing off by a person of his own goods as those of another; the action for infringement is a statutory right conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive rights to the use of the trade mark in relation to those goods. The use by the defendant of the trade mark of the plaintiff is a sine qua non in the case of an action for infringement. It has further been held that if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark, would be immaterial in a case of infringement of the trade mark, whereas in the case of a passing off, the

defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

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52. It could thus be seen that this Court again reiterated that the question to be asked in an infringement action is as to whether the defendant is using a mark which is same as, or which is a colourable imitation of the plaintiff's registered trade mark. It has further been 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 has been reiterated that no case of actual deception nor any actual damage needs to be proved in such cases. This Court has further held that though two actions are closely similar in some respects, in an action for infringement, where the defendant's trade mark is identical with the plaintiff's trade mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion."

16. In the present case, the plaintiffs are in business of sale of

various products such as grain preservatives, mosquito coil, agarbatti, detergent, etc. It is not in dispute that mark 'Dengue Don', for household insecticides in class-5, applied vide TM Application No.2945722, dated 21.04.2015, is registered in the name of plaintiff no.2. By deed of assignment dated 3.9.2021, the plaintiff no.2, inter alia assigned the said trade mark in favour of plaintiff no.1. It is also not in dispute that trade mark 'Dengue Don' registration no.4261620 in respect of Class 3 goods is registered in the name of plaintiff no.1. In terms of Section 31 of the Trade Marks Act, in all legal proceedings relating to a trade mark registered under the Act, the original registration of the trade mark and of all subsequent assignments and transitions of the trade mark shall be prima facie evidence till validity thereof. The plaintiffs being the registered proprietors of the said trademarks have statutory right to use of the trademarks in relation to the goods in respect of which the trademark is registered.

17. The mark 'Garden Denguedon' applied by the defendant vide TM application no. 4309171 is in respect of class 3 goods and the registration is pending. As per the said application the user is since 15.6.2011, whereas user of mark 'Dengue Don' in class 5 is since

31.12.2006. Thus there is no prima facie merit in the contention that the defendant is the prior user.

18. It is sought to be contended that the mark no.2945722 registered in the name of plaintiff no.2 is for household insecticides, falling under class 5 and not for agarbatti (incense sticks) which fall in class 3. In **Allied Auto Accessories** (supra), the mark 'Allied' in respect of parts and fittings of automobiles was classified under Class 12. The Registrar had allowed the application for rectification on the ground that goods in respect of which the mark was used, did not fall in Class 12 and therefore the mark was not used in respect of the goods for which it was registered. While setting aside the said order, the learned Judge of this Court as His Lordship then was, held that *'the well-settled position therefore, is that guidelines of classification lists which are published by the Trade Mark Registry are only administrative guidelines. The same principle applies to classification lists prepared on the basis of international arrangements. These do not constitute binding determinations on the proper classification of goods and on every occasion when the classification of particular goods is in dispute, it is for the Registrar to apply his mind to that question and to arrive*

at a proper adjudication. Similarly, where the question arises before the court, the adjudicatory function of the court is not ousted and the court must decide the question as to appropriate classification of the goods in question.”

20. It is thus well settled that the classification of goods and services under Section 7 of the Trademark Act is not the criterion to decide the question of similarity in goods and services. The goods, which form the subject matter of the present case are mosquito repellent, mosquito repellent coil, agarbatti. In mark ‘Dengu Don’ application No.294722 these goods are classified under class-5 whereas the goods of the very same description are classified in mark No.4261620 in class-3. The nature or composition of goods, the trade channel and class of customers in respect of these goods classified under class-5 and class-3 is the same. In any event whether the goods, which are otherwise similar, are household insecticide under class-5 or whether these are articles of perfumery under class-3 is not relevant to decide the issue at this stage and the same will have to be determined on merits.

21. The material on record prima facie indicates that the mark

‘Dengu Don’ vide application No.2945722 was registered in the year 2015 and the user of the same was since 31/12/2006 whereas the mark ‘Dengu Don’ vide application No.42616200 was registered in the year 2019. The defendant vide application no.4309171 applied for the mark ‘Garden Dengudon’, in respect of identical and similar goods. There is not only phonetic similarity between the two trade marks, but both the trade marks relate to similar products, and is likely to deceive the customers in purchasing the product of the defendants on an assumption that it is of the plaintiffs. It is also pertinent to note that the Registrar of Trademarks had raised an objection for registration of the said trademark in view of the similarity to the earlier trademark of the plaintiffs. This fact prima facie supports the contention of the plaintiffs that the impugned trademark is identical and similar to their trademark.

22. The plaintiffs are the proprietors of the mark ‘Dengue don’. The plaintiffs have prima facie proved that they have been using the said trade mark well before the attempted use of the identical trade mark by the defendant. The plaintiffs have prima facie proved infringement of the trade mark. As observed by the Apex

Court in *Midas Hygiene Industries (P) Ltd. vs. Sudhir Bhatia (2004) 3 SCC 90*, in cases of infringement either of trade mark or of copy right, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. Under the circumstances, the learned Judge was justified in granting the interim relief. The impugned order is not arbitrary, capricious or perverse and is not against the settled principles of law. Hence, no case is made out to interfere with the exercise and discretion of the court of first instance. Hence, the appeal is dismissed.

. Interim application, if any, stands disposed of.

(ANUJA PRABHUDESSAI, J.)