

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION**

**INTERIM APPLICATION (L) NO. 7226 OF 2024
IN
COMMERCIAL IP SUIT NO. 44 OF 2024**

RKRM International Products
Private Limited & Anr. ... Applicants

In the matter between :

Laser Shaving (India) Private Limited ... Plaintiff
Versus

RKRM International Products
Private Limited & Ors. ... Defendants

**WITH
COURT RECEIVER REPORT NO. 110 OF 2024
WITH
INTERIM APPLICATION (L) NO. 1515 OF 2024
IN
COMMERCIAL IP SUIT NO. 44 OF 2024**

Dr. Veerendra Tulzapurkar, Senior Counsel, a/w Mr. Amit Jamsandekar, Mr. Siddhesh Bhole, Mr. Yakshay Chheda, Ms. Maithili Jha and Ms. Archita Gharat i/by SSB Legal & Advisory for Applicants in IAL/7226/2024 and for original Defendant Nos.1 and 2 in COMIP/44/2024.

Mr. Ravi Kadam, Senior Counsel, a/w Mr. Rohan Kadam, Mr. Himanshu Kane, Mr. Ashutosh Kane, Vedangi Soman and Ms. Sumana Roychowdhury i/by W. S. Kane & Co. for Respondent in IAL/7226/2024 and for original Plaintiff in COMIP/44/2024.

**CORAM: MANISH PITALE, J.
DATE : 2nd MAY 2024**

P.C. :

. The defendants have moved this application for vacating ex-parte ad-interim order dated 30th January 2024, passed by this

Court in Interim Application (Lodging) No. 1515 of 2024 in the present suit. The defendants have invoked Order XXXIX Rule 4 of the Code of Civil Procedure, 1908 (CPC) on the ground that the plaintiff suppressed vital information, thereby misleading this Court while claiming that it was entitled to ad-interim relief without notice to the defendants.

2. The plaintiff has filed the suit praying for an injunction against the defendants from infringing its copyright in the original artistic work and packaging/trade dress concerning its trademark “SET MAX”. The plaintiff has also sought an injunction restraining the defendants from using the trademark, so as to pass off their goods as that of the plaintiff. The plaint and the application for interim reliefs moved on behalf of the plaintiff, proceed on the basis that the impugned trademark of the defendants is identical or deceptively similar to the trademark of the plaintiff. In paragraph 21 of the plaint, the plaintiff stated reasons, as to why it was entitled to ad-interim reliefs without notice to the defendants. The plaintiff prayed for ex-parte ad-interim reliefs, in respect of restraining the defendants from infringing the plaintiff’s copyright and from passing off their goods as that of the plaintiff. A further prayer was made for appointment of Court Receiver with ancillary reliefs in that context.

3. This Court passed the said order on 30th January 2024, on

the basis of the contentions raised on behalf of the plaintiff with reference to the pleadings in the plaint as well as the application for grant of interim reliefs. It was noted that the plaintiff had specifically pleaded in paragraph 21 of the plaint, as to why urgent ex-parte ad-interim reliefs were necessary in the facts and circumstances of the present case.

4. As per the statements made in the plaint, this Court proceeded on the basis that the plaintiff came to know about the impugned products of the defendants in the first week of January 2024. In terms of the said order dated 30th January 2024, the Court Receiver through Additional Special Receiver executed the order of this Court and Court Receiver's Report No. 110 of 2024 was filed in the present proceedings.

5. The defendants moved the present application after giving required notice to the plaintiff. The pleadings in the present application were completed and it was taken up for hearing.

6. Dr. Veerendra Tulzapurkar, learned Senior Counsel appearing for the applicants (defendants), submitted that vital information pertaining to the trademark of the plaintiff was suppressed in the plaint as well as the application for interim reliefs. It was submitted that a passing reference was made in paragraph 7 of the plaint in respect of the status of the applications filed on behalf of the plaintiff for registration of its trademarks, stating that the plaintiff would rely upon and refer to

the examination reports and the replies of the plaintiff when produced. It was emphasized that even the plaintiff was aware that the proceedings before the Registrar of Trademarks in respect of the application for registration of trademark submitted by the plaintiff, were relevant and yet, details of the same were not placed on record, thereby misleading this Court.

7. The learned Senior Counsel for the defendants referred to the documents filed along with the application at Exhibits 'C' to 'G', to contend that the contents thereof demonstrated that the Registrar of Trademarks addressed the examination report dated 20th November 2023 to the plaintiff, raising objections on relevant grounds of refusal under Section 11 of the Trade Marks Act, 1999 (hereinafter referred to as 'Trade Marks Act'). The Registrar raised the ground that a same/similar trademark was already on the register and also the objection under Section 11(1) of the Trade Marks Act, that the mark of the plaintiff in respect of which application was submitted, was identical or similar to earlier marks, due to which, there was likelihood of confusion in the mind of the public at large. A reply dated 13th December 2023 was sent on behalf of the plaintiff claiming that the plaintiff had started using its trademark since 1st September 2023 and therefore, it was a prior user. When the Registrar of Trademarks sent an examination report dated 7th November 2023 to the plaintiff, in respect of application for device mark of the plaintiff, identical objections were raised, in response to which, a reply was sent on

behalf of the plaintiff on 1st December 2023. While dealing with the said objections, the plaintiff took a specific stand that its mark “SET MAX” did not resemble the mark of the licensor of defendant no.1, enclosed by the Registrar of Trademarks with the examination report. It was boldly stated that the mark of the plaintiff could not be said to be deceptively similar or identical and that therefore, there was no question of conflict.

8. By referring to the said documents, the learned Senior Counsel appearing for the defendants submitted that such a stand specifically taken by the plaintiff was completely contrary to the assertions made in the plaint as regards the alleged identity and/or deceptive similarities between the trademark of the plaintiff and the trademark used by the defendant on its goods. According to him, this was a relevant factor, which ought to have been placed before this Court while pressing for ad-interim reliefs. If despite such material being brought to the notice of this Court, it was found that the plaintiff could be granted ad-interim reliefs without notice, it would have been a different matter. But, by suppressing the aforesaid relevant and crucial material from this Court, the plaintiff misled this Court and there was no opportunity for examining the question as to whether notice ought to have been issued to the defendants. It is the case of the defendants that if all such material was placed before this Court, notice would have been issued before considering ad-interim/interim reliefs.

9. The leaned Senior Counsel appearing for the defendants

invited attention of this Court to Exhibits ‘H’ and ‘I’ filed along with the application. At Exhibit ‘H’ is a cease and desist notice dated 28th November 2023, sent on behalf of M/s. Galactic Conquistadors FZE (hereinafter referred to as ‘Galactic’) i.e. the licensor of defendant no.1. By the said notice, Galactic relied upon its trademark “SET MAX” in respect of identical products. Reference was made to application dated 31st August 2023 filed by Galactic before the Registrar of Trademarks for registration and thereupon Galactic called upon the plaintiff to cease and desist from using the trademark “SET MAX”. At Exhibit ‘I’, is the reply dated 7th December 2023 sent by the plaintiff, wherein it was claimed that the trademark “SET MAX” was being used by the plaintiff openly, widely, extensively and continuously, thereby justifying its use and the plaintiff denied that Galactic was a prior user of the mark.

10. According to the learned Senior Counsel appearing for the defendants, these documents were also relevant and within the knowledge of the plaintiff, which ought to have been placed before this Court along with the plaint, so that this Court could have examined the claims of the plaintiff and before any ad-interim/interim order could be granted, notice would have been issued to the defendants. It was clarified that the defendants were not arguing in this application on the merits of the claim of the plaintiff, but the contentions were limited to the conduct of the plaintiff, which indicated that sufficient ground is made out for

vacating and discharging the ad-interim order dated 30th January 2024, by exercising power under Order XXXIX Rule 4 of the CPC. The learned Senior Counsel further submitted that the stand taken by the plaintiff before the Trademarks Registry, often referred to as prosecution history, was relevant as this Court has given importance to the same in various precedents, while considering the question of granting discretionary interim relief. It is submitted that when the Court is exercising discretion to grant or refuse interim orders, such material assumes significance. According to the defendants, the aforesaid submission would apply with equal force to the claim of the plaintiff pertaining to infringement of copyright as well as passing off. It was submitted that if the integrity of the judicial process was to be ensured, the plaintiff was expected to disclose all material relevant to the anticipated defence or arguments likely in opposition. On this basis, it was submitted that since the plaintiff did not make honest disclosures while claiming ad-interim reliefs without notice to the defendants, the order dated 30th January 2024, deserves to be vacated. He specifically relied upon order of this Court dated 7th June 2021, passed in Interim Application (Lodging) No. 10937 of 2021 in Commercial IP (Lodging) No. 10928 of 2021 (*Sun Pharmaceuticals Industries Ltd. v/s. Emil Pharmaceuticals Industries Pvt. Ltd. & Anr.*).

11. It was submitted that in similar circumstances, this Court by order dated 7th September 2020, passed in case of *Franco-Indian*

Pharmaceuticals Pvt. Ltd. v/s. Hamdard Laboratories (India) (LD-VC-Interim Application No. 1 of 2020), vacated an ad-interim order, only because the plaintiff did not place on record all the pages available on the web-site that was relied upon. Only one page was held back and yet this Court found it fit to vacate the ex-parte ad-interim order. Reliance was further placed on order of Division Bench of this Court in the case of ***Kewal Ashokbhai Vasoya & Anr. v/s. Suarabhakti Goods Pvt. Ltd., 2022 SCC OnLine Bom 3335***, wherein the necessity of sufficient disclosures on the part of the plaintiff was emphasized upon. Reliance is also placed on judgment of the Supreme Court in the case of ***S. P. Chengalvaraya Naidu (dead) by LRs. v/s. Jagannath (dead) by LRs. & Ors., (1994) 1 SCC 1***, wherein non-disclosure of relevant material was held as fraud on the Court that vitiated everything, on the basis of which, the decree itself was set aside.

12. Reliance is also placed on order of the Delhi High Court in the case of ***Lightbook & Anr. v/s. Pravin Shriram Kadam & Ors., 2023 SCC OnLine Del 2308*** to assert that the plaintiff cannot escape the consequences of its stand taken before the Registrar of Trademarks, particularly when ad-interim reliefs were being pressed.

13. On the stand of the plaintiff that such prosecution history concerning proceedings before the Trademarks Registry would have no application for copyright, it was submitted that since fraud vitiates everything, the said stand taken by the plaintiff

cannot be accepted. It is further submitted that in the present case, the core and only artistic work in respect of which the plaintiff claims copyright is the stylized manner in which the word “SET MAX” is presented. The learned Senior Counsel for the defendants also placed reliance on the judgment of learned Single Judge of this Court in the case of ***Shantapa alias Shantesh S. Kalasgond v/s. M/s. Anna*** (judgment and order dated 30th November 2023 passed in Appeal from Order No. 915 of 2023), to claim that prosecution history before the Trademarks Registry is relevant even with respect to passing off and that therefore, in the present case, it was incumbent upon the plaintiff to divulge its stand taken before the Trademarks Registry. It is further submitted that the plaintiff cannot escape the effect of its stand taken before the Registrar of Trademarks, as also its response to the cease and desist notice issued by Galactic only on the ground that the said Galactic is not a defendant. It is submitted that the said Galactic is a licensor of the defendants, which fact the plaintiff could have realized if necessary inquiries were made and that in any case, if notice was issued to the defendants, the said fact would have come before this Court. It is submitted that even otherwise, the stand taken by the plaintiff before the Registrar of Trademarks concerned its analysis and interpretation of its own mark when compared to the mark of Galactic, which is the very mark being used by the defendants as licensees. On this basis, it is submitted that the ex-parte ad-interim order dated 30th January 2024, ought to be vacated.

14. The learned Senior Counsel appearing for the defendants also sought to distinguish the judgments upon which the plaintiff placed reliance.

15. Mr. Ravi Kadam, learned Senior Counsel appearing for the plaintiff, submitted that in the facts of the present case, there was no question of alleging any suppression of material fact on the part of the plaintiff. It is submitted that the plaintiff had no means to know the business relationship between the defendant No.1 and Galactic. It is submitted that the licence agreement or permitted user agreement executed between the said parties is not in the public domain and even the goods of the defendants did not indicate that they are manufactured under licence from Galactic. On this basis, it is submitted that the plaintiff was justified in proceeding on the *bona fide* belief that the defendant No.1 was a third-party stranger. In such a situation, the plaintiff was entitled to seek ad-interim reliefs without notice to the defendants. It was submitted that in such cases urgent ad-interim relief is necessary, not only to protect the rights of the plaintiff, but also to protect the public at large. In this context, it is submitted that prosecution history estoppel cannot operate against the plaintiff in as much as Galactic is not before the Court.

16. It is further submitted that a particular fact can be said to be material and relevant only if it is relevant for the merits of the case. The plaintiff is expected to only reasonably disclose the legal

defences that may arise and in the present case, since there was no way in which the plaintiff could have known that defendant No.1 is the licensee of Galactic, the allegation of suppression cannot survive. In this regard, the learned Senior Counsel appearing for the plaintiff relied upon judgments of the Supreme Court in the case of *M/s. S.J.S. Business Enterprises (P) Ltd. v/s. State of Bihar & Ors.*, (2004) 7 SCC 166 and *Mayar (H. K.) Ltd. & Ors. v/s. Owners and Parties, Vessel M.V. Fortune Express & Ors.*, (2006) 3 SCC 100, as also judgment of Bombay High Court in the case of *Kewal Ashokbhai Vasoya & Anr. v/s. Suarabhakti Goods Pvt. Ltd.*, 2022 SCC OnLine Bom 3335.

17. It is further submitted that in any case, the allegations of non-disclosure of prosecution history cannot be available in respect of passing off. Reliance is placed on *McCarthy on Trademarks and Unfair Competition (5th Edition)*, to contend that non-disclosure of prosecution history may be relevant for a registered trademark under the statute, but it is irrelevant when the plaintiff specifically relies upon prior use of the trademark. In this regard, reliance is also placed on Section 27(2) of the Trademarks Act, which provides that a person would be entitled to exercise rights of action of passing off on the basis of prior use. On the aspect of prior use, reliance is placed on judgment of this Court in the case of *Harish Motichand Sariya v/s. Ajanta India Ltd. & Anr.*, 2003 (4) Mh.L.J. 291. As regards judgment of this Court in the case of *Shantapa alias Shantesh S. Kalasgond v/s. M/s.*

Anna (supra), learned Senior Counsel for the plaintiff submitted that the said judgment is *per incuriam* and that there is no question of estoppel against the plaintiff in the facts of the present case, particularly on the question of passing off. Reliance is also placed on judgment of Supreme Court in the case of **Chhaganlal Keshavlal Mehta v/s. Patel Narandas Haribhai, (1982) 1 SCC 223** to claim that estoppel would apply in the context of the person to whom the representation is made. According to the plaintiff, in the present case, at worst, the representation pertaining to prosecution history before the Trademarks Registry was made to Galactic and not the defendants. Therefore, the defendants cannot rely upon such representation to claim that prosecution history estoppel would apply against the plaintiff.

18. The learned Senior Counsel for the plaintiff submitted that in any case, the aforesaid contentions raised on behalf of the defendants cannot apply to the infringement of copyright claimed by the plaintiff because the art work in which the plaintiff claims proprietary right, not only includes the word “SET MAX” written in a stylized manner, but it also consists of multiple other integers like colour of the label, its scheme, placement of the text and the device of blade used in the artistic work. On this basis, it is submitted that the application should not to be entertained and that this Court ought to dismiss the application, so that the aspect of confirmation of the ad-interim order can be decided on merits.

19. After the arguments were completed, judgments were tendered across the bar on behalf of the parties. This Court was of the opinion that after the arguments were over on 17th April 2024 and the application was specifically kept for orders on 2nd May 2024, it was not appropriate on the part of the advocates for the parties to tender judgments on 26th April 2024. Be that as it may, this Court has perused and considered the said judgments and they shall be dealt with hereinbelow.

20. In this application, the defendants have invoked Order XXXIX Rule 4 of the CPC, while pressing for the relief of vacating ex-parte ad-interim order dated 30th January 2024. It would be appropriate to refer to the said provision of law, so as to understand whether the power under the said provision can be exercised in the facts of the present case.

21. Order XXXIX Rule 4 of the CPC, reads as follows:

4. Order for injunction may be discharged, varied or set aside.
- Any order for an injunction may be discharged, or varied, or set aside by the Court, on application made thereto by any party dissatisfied with such order:

Provided that if in an application for temporary injunction or in any affidavit supporting such application, a party has knowingly made a false or misleading statement in relation to a material particular and the injunction was granted without giving notice to the opposite party, the Court shall vacate the injunction unless, for reasons to be recorded, it considers that it is not necessary so to do in the interests of justice:

Provided further that where an order for injunction has

been passed after giving to a party an opportunity of being heard, the order shall not be discharged, varied or set aside on the application of that party except where such discharge, variation or setting aside has been necessitated by a change in the circumstances, or unless the Court is satisfied that the order has caused undue hardship to that party.

22. The defendants in this application relied upon the first proviso to Order XXXIX Rule 4, which provides that the Court shall vacate an order of temporary injunction if in the affidavit supporting the application filed by the plaintiff a false or misleading statement is knowingly made in relation to a material particular and such temporary injunction is granted without notice to the opposite party. It is further provided that the Court may still not vacate the temporary injunction if it is not necessary to do so in the interest of justice. It is clear that suppression of a material fact renders the application and the affidavit filed in support thereof on behalf of the plaintiff as false and misleading. In the present case, the defendants claim that the examiner report of the Registrar of Trademarks pertaining to the applications filed by the plaintiff for registration of word mark as well as device mark and the replies sent thereto by the plaintiff were vital and therefore, necessarily required to be placed by the plaintiff on the record of this Court. It is also claimed that the cease and desist notice sent by Galactic and the reply thereto sent by the plaintiff also ought to have been placed on record. According to the plaintiff, the said material is irrelevant.

23. But, there is substance in the contention raised on behalf of

the defendants that when the plaintiff itself referred to the pending proceedings before the Trademarks Registry in paragraph 7 of the plaint, even the plaintiff was aware that such proceedings were relevant. In paragraph 7 of the plaint, the plaintiff referred to the said proceedings and merely stated that the documents pertaining thereto would be referred to when produced. The question is whether the failure to produce such documents pertaining to the proceedings before the Trademarks Registry and the exchange of cease and desist notice and reply between Galactic and the plaintiff could be said to be relevant material to be produced at the outset on behalf of the plaintiff.

24. In this regard, it would be appropriate to refer to the position of law laid down by this Court in the case of ***Sun Pharmaceuticals Industries Ltd. v/s. Emil Pharmaceuticals Industries Pvt. Ltd. & Anr.*** (supra). In the said judgment, this Court laid down the key principles that would apply to every ex-parte application. The relevant portion of the said judgment, reads as under:

“5. To avoid ambiguity, I take the liberty of briefly summarizing the key principles I believe apply to every ex parte application. I do so because I believe an application for leave to move ex parte can never be granted for the asking or automatically.

(a) The general principle is that the Court will hear both sides before rendering a decision. This is the essence of any adversarial justice-delivery process, and based on the fundamental rule of natural justice and fairness, audi alteram partem. An ex parte application, without notice to or hearing, the other side is, therefore, the exception, a

derogation from this general principle.

- (b) It is every advocate's and every court's paramount duty, of the very first importance, to ensure the integrity of the judicial process. When, therefore, a court is asked to depart from the general process and general rule, it must be able to rely on the applicant (who or which is appearing without an opponent on notice) to present its case fairly and evenly. This means that the applicant's case must contain a disclosure or statement of an anticipated defence or arguments likely in opposition. In turn, this means that an applicant seeking an ad-interim relief without notice must make a full and reasonably accurate disclosure of material facts and must invite the court's attention to factual, legal and procedural issues. On the factual issues to be disclosed, the applicant need only disclose as much – but every bit as much – as is within his knowledge, or that which, with reasonable efforts, he could discover. Material in the public domain, including in open registries, falls within this class of factual material.*
- (c) The disclosure and statement in the application or plaint must be neutrally and objectively presented so that the court has confidence in the case brought. Merely annexing a slew of documents does not, of itself, serve this purpose.*
- (d) Necessarily, this means that the applicant must be shown to have made the necessary and proper enquiries, within the bounds of reason, before making the application. This material can be in a supporting affidavit, but it must be before the court. Some level of investigation and enquiry must be demonstrated. This duty of disclosure includes matters of which the applicant would have been aware had he made reasonable enquiries. Specific to IPR matters, for instance, is the requirement for a search in the registry as to what, if anything, the defendant has done in regard to the competing mark, service, product or thing. For trademarks: has the defendant sought registration? When and with what effective date? With or without a disclaimer? There must be market information too: how long has the defendant been in the market with the rival product and mark? In what area? In what manner?*
- (e) Ex parte applications are, by definition, moved in urgency. This must be demonstrated too. The compilation of relevant*

material may be less than optimally organized in view of the urgency, but the urgency does not excuse the need for a sufficient disclosure. The requirement is not of the fullest and most complete disclosure but enough to make the court cognisant of the likely issues and possible defences. A detailed analysis of every single possible point is not required. Undoubtedly, the requirement of disclosure relates to relevant material, and kept within sensible limits. The disclosure must be proportionate, and the task is not the pursuit of perfection (for it will always be argued that the disclosure might have been bettered). The disclosure requirement is, above all, a safeguard to ensure that the court is not misled on a material and relevant aspect.”

25. This position of law was further confirmed by the Division Bench of this Court in the case of ***Kewal Ashokbhai Vasoya & Anr. v/s. Suarabhakti Goods Pvt. Ltd.*** (supra). The said judgment places emphasis on the integrity of the judicial process. It is laid down that every advocate and every Court must perform the paramount duty of ensuring the integrity of the judicial process. This requires the plaintiff, pressing for an ex-parte ad-interim order, to fairly and evenly state its case by making disclosures and statements on the basis of anticipated defence or arguments likely to be made by the opposite party. In other words, all the material within the knowledge of the plaintiff must be placed on record while pressing for an ex-parte ad-interim order. It is for the Court to consider such material and then proceed to either issue notice to the opposite party or reach a finding that despite such honest disclosures the plaintiff has indeed made out a case for granting ex-parte ad-interim order. What is most important in such cases is the manner in which the plaintiff discloses all relevant material and it does not hold back anything from the Court.

26. The said requirement was raised to a high level by this Court in the case of *Franco-Indian Pharmaceuticals Pvt. Ltd. v/s. Hamdard Laboratories (India)* (supra), wherein ex-parte ad-interim order was recalled, only because the plaintiff did not place one page from a website in which the defendants products were advertised, while all other pages were placed on record. It was found that if the entire material was placed on record the Court would probably have been alerted that the defendants were required to be put to notice, before considering the question of ad-interim/ interim reliefs.

27. In the case of the *S. P. Chengalvaraya Naidu (dead) by LRs. v/s. Jagannath (dead) by LRs. & Ors.* (supra), the Supreme Court categorically laid down that fraud vitiates everything. This includes non-disclosure of vital material to the Court while obtaining an order. In the said case, the decree was set aside on the basis that non-disclosure of a particular document amounted to fraud on the Court. Thus, it is evident that Courts have placed immense importance on the necessity of the party seeking relief from the Court to come with clean hands and to place all relevant material before the Court. It is a different matter that ultimately the plaintiff may be able to make out its case on merits, but the question in the present application is, as to whether all relevant material was placed on record while insisting on ad-interim relief without notice to the defendants. It is for this reason that this

Court in the case of *Franco-Indian Pharmaceuticals Pvt. Ltd. v/s. Hamdard Laboratories (India)* (supra), while recalling the ex-parte ad-interim order stated that no observation was being made on the merits of the matter. In this context, the defendants are also justified in relying upon the judgement of the Delhi High Court in the case of *Lightbook & Anr. v/s. Pravin Shriram Kadam & Ors.* (supra).

28. It has been argued on behalf of the plaintiff that the documents pertaining to the proceedings before the Trademarks Registry and the reply to the cease and desist notice issued by Galactic cannot be relevant as there was no way in which the plaintiff could have known that defendant No.1 had a permitted user agreement with Galactic, indicating that defendant No.1 was a licensee of Galactic. It was emphasized that even the impugned goods do not indicate that they are manufactured under licence from Galactic. The aforesaid contention raised on behalf of the plaintiff cannot be accepted because the plaintiff itself had referred to proceedings before the Trademarks Registry in paragraph 7 of the plaint. The said proceedings pertain only to Galactic and having mentioned the said proceedings in the plaint, it was incumbent upon the plaintiff to have produced such material before this Court. The stand taken by the plaintiff before the Trademarks Registry, while pursuing its application for registration of its word mark and device mark, at one place is diametrically opposite to the stand taken in the plaint as regards identity and/or

deceptive similarity with the mark of Galactic. It is the stand of the plaintiff in respect of the two trademarks that is significant and crucial. The plaintiff cannot escape the consequence of its stand merely by claiming that such a stand was relevant for Galactic and not any other party, on the ground that the plaintiff was unaware about the relationship between defendant No.1 and Galactic or that it could not have any knowledge about the same.

29. This is crucial, for the reason that if the aforesaid material held back from the Court was indeed placed along with the plaint and the application for interim reliefs, this Court would have had an opportunity to consider issuing notice to the defendants for a response. Hence, the said argument made on behalf of the plaintiff cannot be accepted. For the same reason, reliance placed on behalf of the plaintiff on the judgment of Supreme Court in the case of *Chhaganlal Keshavlal Mehta v/s. Patel Narandas Haribhai* (supra) cannot take its case any further.

30. In this regard, reliance placed on behalf of the plaintiff on the judgments of Supreme Court in the cases of *M/s. S.J.S. Business Enterprises (P) Ltd. v/s. State of Bihar & Ors.* (supra) and *Mayar (H. K.) Ltd. & Ors. v/s. Owners and Parties, Vessel M.V. Fortune Express & Ors.* (supra) also cannot take its case much further. The question of suppression and the necessity to reveal material before the Court turned on the facts of those individual cases. The Supreme Court found in the case of *M/s. S.J.S. Business*

Enterprises (P) Ltd. v/s. State of Bihar & Ors. (supra) that when the High Court exercised writ jurisdiction under Article 226 of the Constitution of India, failure to mention filing of a suit would not be fatal. Such are not the facts in the present case. Similarly, the effect of non-mentioning of a particular fact was not found to be fatal in the case of *Mayar (H. K.) Ltd. & Ors. v/s. Owners and Parties, Vessel M.V. Fortune Express & Ors.* (supra), where the question of rejection of plaint under Order VII Rule 11 of the CPC, was involved.

31. It was also vehemently submitted on behalf of the plaintiff by relying upon judgment of this Court in the case of *Harish Motichand Sariya v/s. Ajanta India Ltd. & Anr.* (supra) that the effect of Section 27(2) of the Trademarks Act cannot be ignored. It was emphasized that the plaintiff is seeking to exercise its right under passing off and not the statutory right under the Trademarks Act, thereby indicating that the documents pertaining to the statutory proceedings for registration of trademark cannot be said to be relevant when an action of passing off is concerned. Much reliance is placed on *McCarthy on Trademarks and Unfair Competition (5th Edition)* to claim that prosecution history estoppel may be relevant for statutory proceedings, but it is irrelevant for an action of passing off.

32. In this regard, judgment of this Court in the case of *Shantapa alias Shantesh S. Kalasgond v/s. M/s. Anna* (supra) is

relevant. In the said case, the aforesaid contention was specifically raised in the context of a passing off action. The doctrine of prosecution history estoppel was pressed into service even in the context of passing off action and after taking note of various relevant judgments of Courts, this Court found that even in the case of passing off the doctrine of prosecution history estoppel applies. Thus, the position of law, as it stands, negates the contention raised on behalf of the plaintiff. The plaintiff is presumed to be aware of law and ignorance of the position of law cannot be the basis for contending that documents pertaining to the proceedings before the Trademarks Registry were not required to be placed before this Court, while claiming ex-parte ad-interim reliefs.

33. The contention raised on behalf of the plaintiff that the said judgment of this Court in the case of *Shantapa alias Shantesh S. Kalasgond v/s. M/s. Anna* (supra) is *per incuriam* cannot be countenanced, simply for the reason that entertaining the said contention would take this Court into the merits of the rival stands, while in the present application, this Court is only concerned with the limited question as to whether the plaintiff held back or failed to place relevant material along with the plaint and the application for interim reliefs, while obtaining ad-interim reliefs without notice to the defendants. The question as to what would be the impact of the plaintiff claiming prior use of the trademark and the fact that the applications for registration of

trademark of the plaintiff as well as the said Galactic, are pending, would be relevant when the merits of the material are to be considered. But, in the facts and circumstances of the present case, this Court is convinced that for maintaining the integrity of the judicial process, it was incumbent upon the plaintiff to have placed on record the aforesaid material, as disclosure of such material was necessary for the anticipated defence or arguments likely to be taken by the defendants.

34. As indicated hereinabove, this Court shall now deal with the judgments tendered by the advocates for the parties on 26th April 2024, after the arguments were over on 17th April 2024 and the application was kept for orders on 2nd May 2024.

35. On behalf of the defendants, judgment of Division Bench of this Court in the case of ***Vimal Vitthal Chavan v/s. L. Nava Maharashtra Education Society & Ors., 2005 SCC OnLine Bom 916*** was tendered. The said judgment was passed in a Writ Petition wherein the Division Bench of this Court referred to a number of judgments concerning the situation where relevant material was concealed by the parties seeking reliefs. The Division Bench of this Court reiterated the position of law that if a party concealed anything, which it knows to be material, it amounts to a fraud and that when a party comes to Court claiming equity, it must come with clean hands. There can be no quarrel with the said proposition.

36. The plaintiff tendered orders passed by this Court in the case of *Asma Farid Noorani v/s. Haji Ali Fresh Fruit Juices & Ors.* (order dated 11th November 2022, passed in Interim Application No. 3281 of 2021 in Commercial IP Suit No. 189 of 2021) and in the case of *Sabmiller India Ltd. v/s. Jagpin Breweries Ltd., 2014 (5) Bom C.R. 721*. In the case of *Asma Farid Noorani v/s. Haji Ali Fresh Fruit Juices & Ors.* (supra), this Court dismissed an application seeking vacating of ex-parte ad-interim order. It appears that the plaintiff relies upon the said judgment because in the said case non-disclosure by the plaintiff of a suit pending in Kerala was not held against the plaintiff in the facts of the said case. In the said case, this Court did find that the internal arrangement of defendant No.2 with a partnership firm not being in the public domain, was a relevant factor. The said case is distinguishable for the reason that in the present case, the plaintiff had received cease and desist notice dated 28th November 2023 issued by Galactic in respect of the same impugned mark and the reply of the plaintiff was sent on 7th December 2023. The plaintiff had also taken a diametrically opposite stand before the Trademarks Registry in respect of the very same mark on 1st December 2023. In the plaint, the plaintiff stated that it became aware sometime in December 2023, when the defendant No.1 was planning to launch a packaging/trade dress bearing identical/deceptively similar trademark as that of the plaintiff and that upon conducting market investigation, in the first week of

January 2024, the plaintiff learnt that defendant No.1 was marketing and defendant No.2 was manufacturing the impugned goods with the alleged identical trademark “SET MAX”, which was a substantial reproduction of the plaintiff’s packaging/trade dress.

37. The pleadings in the plaint and the said cease and desist notice, reply thereto and the reply of the plaintiff to the examination report of the Registrar of Trademarks, all pertaining to November 2023 and December 2023, indicate that such material held back by the plaintiff, was indeed relevant and it should have been placed before this Court. The absence of such material gave a different colour to the claims made by the plaintiff and this is the only relevant factor while deciding the present application filed under Order XXXIX Rule 4 of the CPC. Hence, the aforesaid judgment in the case of ***Asma Farid Noorani v/s. Haji Ali Fresh Fruit Juices & Ors.*** (supra), is distinguishable.

38. As regards the judgment in the case of ***Sabmiller India Ltd. v/s. Jagpin Breweries Ltd.*** (supra), this Court, *inter alia*, held that there is no rule that the plaintiff has to disclose entire history of its trademark while filing a suit before any Court, especially when it is irrelevant. In the facts of the said case, this Court found that such history was irrelevant to the case. But, in the present case, this Court finds that such material pertaining to the history of the trademark of the plaintiff, particularly its stand before the

Trademarks Registry was relevant, specifically on the question as to whether ex-parte ad-interim reliefs could be granted without notice to the defendants. Thus, the said judgment also cannot take the case of the plaintiff further.

39. On the aspect of copyright, it is urged on behalf of the plaintiff that even if non-disclosure of prosecution history pertaining to proceedings before the Trademarks Registry could be said to be relevant in the context of the trademark, the same was wholly irrelevant for the infringement of copyright of the artistic work of the plaintiff. In this context, this Court finds substance in the contention raised on behalf of the defendants that the central, essential and core feature of the artistic work in respect of which the plaintiff claims copyright, is the stylized manner in which the word “SET MAX” is written by the plaintiff. The emphasis placed on behalf of the plaintiff on the colour scheme of the label, placement of text, etc. at this stage, is irrelevant, particularly, when the statements made on behalf of the plaintiff before the Trademarks Registry in respect of the device mark are appreciated. In any case, as noted hereinabove, the suppression of vital material vitiates everything and it would equally apply to the claim of copyright made on behalf of the plaintiff, in the context of its right for ad-interim reliefs without notice to the defendants. This Court clarifies that the aforesaid observations are being made only in the context of the question as to whether sufficient grounds are made out by the defendants for vacating the ex-parte ad-interim order

under Order XXXIX Rule 4 of the CPC. The said observations are not to be construed as any comment on merits, as regards the claim of the plaintiff regarding copyright in its artistic work concerning the mark “SET MAX”.

40. The failure on the part of the plaintiff to place the aforesaid material on record along with the plaint and/or with the application for interim reliefs does make out a case for the defendants to claim applicability of the first proviso of Order XXXIX Rule 4 of the CPC, thereby justifying its prayer for vacating the ex-parte ad-interim order. This has nothing to do with the merits of the rival claims and it has everything to do with ensuring the integrity of the judicial process. Therefore, the present application deserves to be allowed.

41. Accordingly, the application is allowed and the order dated 30th January 2024, passed by this Court in Interim Application (Lodging) No. 1515 of 2024 is vacated.

42. The said order is vacated only on the short ground that the plaintiff held back relevant material due to which this Court was unable to examine the necessity of issuing notice to the defendants before considering ad-interim reliefs. If the said material was placed before this Court, notice would have been issued to the defendants before considering the question of granting ad-interim/interim reliefs. This Court is not making any observations on the merits of the entitlement of the plaintiff to interim reliefs.

43. The defendants shall file their affidavit in reply in Interim Application (Lodging) No. 1515 of 2024, if not already filed, within a period of four weeks from today. The merits of the rival stands of the parties on the question of interim reliefs shall be considered once pleadings are completed in Interim Application (Lodging) No. 1515 of 2024.

44. Interim Application (Lodging) No. 7226 of 2024 is allowed in above terms, thereby vacating the *ex-parte* ad-interim order dated 30th January 2024. As a consequence, the Court Receiver is discharged without passing up of accounts. The Court Receiver's Report No. 110 of 2024 is disposed of and the goods of the defendants seized and sealed by the Court Receiver shall be released forthwith.

45. At this stage, the learned counsel appearing for the plaintiff submits that this Court may consider continuing operation of the *ex-parte* ad-interim order dated 30th January 2024 for a period of two weeks, as the plaintiff intends to challenge the order passed today. This is vehemently opposed by the learned counsel appearing for the defendants.

46. Since this Court, while passing the order today, has specifically observed that the merits of the claim of the plaintiff for grant of interim reliefs, is kept open and the *ex-parte* order has been vacated, only on the touchstone of the first proviso of Order

XXXIX Rule 4 of the CPC, no case is made out for extending the effect of *ex-parte* ad-interim order dated 30th January 2024.

47. The prayer made on behalf of the plaintiff, is rejected.

48. List Interim Application (Lodging) No. 1515 of 2024 for further consideration on 24th June 2024.

MANISH PITALE, J.

BIPIN DHARMENDER PRITHIANI
Digitally signed by BIPIN
DHARMENDER PRITHIANI
Date: 2024.05.02 18:03:03 +0530