

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
INTERIM APPLICATION NO. 2165 OF 2024
IN
COMMERCIAL IP SUIT NO. 80 OF 2024**

Chemco Plastic Industries Pvt Ltd.,
a company incorporated under the provisions of
the Companies Act, 1956, having its registered
address at 78, Virwani Industrial Estate,
Western Express Highway, Goregaon(East),
Mumbai, Maharashtra – 400 063 and
corporate office at Chemco House,
D Sukhadwala Road, Fort, Mumbai,
Maharashtra – 400 001.

...Applicant/
Org Plaintiff

In the matter between

Chemco Plastic Industries Pvt Ltd.,
a company incorporated under the provisions of
the Companies Act, 1956, having its registered
address at 78, Virwani Industrial Estate,
Western Express Highway, Goregaon(East),
Mumbai, Maharashtra – 400 063 and
corporate office at Chemco House,
D Sukhadwala Road, Fort, Mumbai,
Maharashtra – 400 001.

..Plaintiff

ARUN
RAMCHANDRA
SANKPAL

Digitally signed by
ARUN
RAMCHANDRA
SANKPAL
Date: 2025.12.03
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Versus

M/s Chemco Plast,
a registered partnership firm
through its partner Alok Maheshwari,
having its office at 2, Ganesh Kripa CHS Ltd,
behind Rajendra Park, Station Road,
Goregaon(West), Mumbai – 400 104
and factory at F-3,

Udyog Nagar Industrial Estate, (0.1.D.C.),
Ringanwada, Nani Daman, Daman – 396210.

...Defendant

Dr Veerendra Tulzapurkar, Senior Advocate, with Hiren Kamod,
Farhad Sorabjee, Pratik Pawar, Siddhesh S. Pradhan, Meher
Mistri and Aneez Patel, i/b J Sagar Associates, for the Plaintiff
in COMIP/80/2024, and for the Applicant in IA/2165/2024.
Mr. Rashmin Khandeka, with Anand Mohan, Maitri Asher and I.K.
Paranjape, i/b W.S. Kane & Co, for the Defendant in COMIP/80
of 2024 and for the Respondent in IA/2165/2024.

CORAM: N. J. JAMADAR, J.
RESERVED ON: 20th JUNE 2025
PRONOUNCED ON: 3rd DECEMBER 2025.

ORDER:

1. This Interim Application is filed to restrain the Defendant from infringing all or any of the Plaintiff's/Applicant's mark, "CHEMCO" by use of the impugned mark "CHEMCO", the impugned trading name "CHEMCO PLAST" and/or the impugned domain name, "www.chemcoplast.com" and/or any other trade mark/trading name/domain name which is identical with and/or deceptively similar to the Applicant's registered Mark, "CHEMCO" and also to restrain the Defendant from using the impugned mark, trading name and/or domain name so as to pass off or enable others to pass off the Defendant's business and/or the impugned goods as and for the Applicant's business and/or the said goods or in any other manner whatsoever, and for appointment of the Court Receiver.

2. The background facts can be stated as under:

2.1 The Plaintiff is the flagship company of CHEMCO group. The Plaintiff is engaged in the business of *inter alia*, manufacturing and trading in a wide range of plastic goods such as bottles, bottle cap closures, water filters, dispensers, home beautification items, PET preforms, containers, jars etc under the trade mark “CHEMCO”. The Plaintiff's trading name also contains the Plaintiff's trade mark, “CHEMCO” as its leading, prominent and essential part. The Plaintiff claims the goods emanating from the Plaintiff's are well-known for their superior and high quality and technical excellence.

2.2 The Defendant is a registered partnership firm. The Defendant is also engaged in the business of manufacturing of plastic articles similar to those manufactured by the Plaintiff.

2.3 M/s Chemco Supply Corporation, according to the Plaintiff, was the predecessor-in-title of the Plaintiff. Under the Deed of Assignment dated 11th September 1980, M/s Chemco Supply Corporation sold its entire business as a running concern to M/s Chemco Plastic Corporation, a partnership firm. Ramawatar Saraogi (Promoter of the Plaintiff) was one of the partners of M/s Chemco Plastic Corporation. On 14th November 1985 upon retirement of all other partners Mr. Ramawatar Saraogi and Bimla R. Saraogi (Promoters of the Plaintiff) entered

into a Deed for the reconstituted partnership of M/s Chemco Plastic Corporation.

2.4 On 6th February 1996, the partners of M/s Chemco Plastic Corporation incorporated the Plaintiff as a private limited company to consolidate the business activity of the said firm.

2.5 The Plaintiff claims, the Plaintiff through its promoters and predecessor-in-title has been in undisputed and uninterrupted possession and use of the mark, “CHEMCO” since 1973. The mark “CHEMCO” is inherently distinctive.

2.6 The Plaintiff got its mark “CHEMCO” (word *per se*)

registered on 6th May 2014 and the logo  on 30th August 2016, under Class 21. The Plaintiff has secured registration of various trade marks under other Classes as well.

2.7 It is the claim of the Plaintiff that in or around September 2015, the Plaintiff learnt that the Defendant was carrying on a competing business of manufacturing and sale of plastic jars, containers, bottles etc (the impugned goods) which are identical with and/or similar to the Plaintiff's good, under the impugned trading name, “CHEMCO PLAST”. A cease and desist notice dated 19th September 2015 was addressed to the Defendant. As there was no response, a follow up notice dated 12th October 2015 was addressed to the Defendant. Vide Reply

dated 14th October 2015, the Defendant contested the claim of the Plaintiff.

2.8 It transpired that the Defendant had attempted to seek registration of the impugned mark, “CHEMCO” under Classes 17, 35 and 21 on “proposed to be used” basis. Eventually the Defendant abandoned those Applications. Another effort was made on 5th January 2017 to register the impugned mark “CHEMCO” with purported prior use since 22nd August 1998 under Class 21. That Application was also eventually abandoned.

2.9 In the meanwhile, the Plaintiff received communication from its customers which indicated that the Plaintiff's customers were misled into believing that the Plaintiff and the Defendant were one and the same entity. The Defendant was thus misusing the goodwill and repute of the Plaintiff's trading name and mark, “CHEMCO” for its commercial gain. As a part of its strategy to obtain undue advantage on 12th January 2019, the Defendant filed a fresh Application under Class 35 seeking registration of the impugned mark, “CHEMCO”. The said Application was opposed by the Plaintiff. The opposition proceedings are pending hearing and final disposal before the Trade Mark Registry.

2.10 As the infringement of the trade mark, trading name and domain name, of the Plaintiff continued unabated, the Plaintiff initiated criminal action against the Defendant. Despite numerous complaints, there was no action by the Police. The Defendant, however, continues to misuse and infringe the Plaintiff's mark, "CHEMCO" with impunity. The Defendant's adoption and use of the impugned "CHEMCO" mark is a deliberate, fraudulent and dishonest attempt to encash upon the enviable reputation and goodwill of the Plaintiff and make illicit gain. The Defendant's usage of the Plaintiff's mark is *ex-facie* unlawful and in breach of the provisions of the Trade Marks Act 1999. The Defendant is gaining an unfair advantage to the detriment of the distinctive character and repute of the Plaintiff's well-known mark, "CHEMCO". The Plaintiff was thus constrained to institute the instant Suit.

2.11 The Plaintiff has taken out the instant Application for interim relief as the infringement of the Plaintiff's trade mark, trading name and domain name is blatantly malicious, dishonest and fraudulent. The use of the mark, "CHEMCO" is not *bona fide*. There are, thus, no equities in favour of the Defendant. Hence this Application for interim reliefs, as described above.

3. The Defendant resisted the Application by filing an Affidavit in Reply. The Defendant has denied the averments in the Application adverse to the interest of the Defendant. The tenability of the Suit was put in contest.

3.1 The Defendant controverted the claim of the Plaintiff that the Plaintiff is a prior user of the mark, "CHEMCO". According to the Defendant its predecessor-in-title M/s Chemco Industries has been engaged in the business of manufacturing and dealing in plastic goods since the year 1977 under the trading name and style, "CHEMCO". Kailash Parasrampuriah and Hemant Parasrampuriah were the partners of M/s Chemco Industries.

3.2 Since 1977, the Defendant and its predecessor-in-interest have been openly, widely and continuously engaged in the business of the manufacturing and dealing in plastic and electrical goods under the trading name, "CHEMCO". A reference is made to the invoices raised by the Defendant and the approval obtained by the Defendant from various Regulatory and Revenue Authorities, including the Sales Tax Department and Factories Department. On the basis of the *bona fide*, continuous and uninterrupted user of the name, "CHEMCO PLAST" the Defendant claims to have acquired wide reputation and goodwill in its trade name, "CHEMCO".

3.3 The Plaintiff's claim was stated to suffer from vice of *suppressio veri and suggestio falsi*. The Plaintiff has allegedly suppressed the date of the knowledge of the use of the mark, "CHEMCO". According to the Defendant, much prior to September 2015, the period during which the Plaintiff claimed to have become aware of the alleged infringement, the employees of the Plaintiff and the Defendant have had business relations. Moreover, when requisitions were received from the customers of the Plaintiff, the Defendant directed them to the Plaintiff. The Plaintiff had deliberately suppressed its interaction with the Defendant and actual date of knowledge of the user of the mark and trading name by the Defendant. It was further contended that the Plaintiff and the Defendant were members of the Plastic Manufactures Association and, thus, the claim of the Plaintiff that it was not aware of the use of the mark by the Defendant was inconceivable.

3.4 The Defendant further contends the goods manufactured and sold by the Plaintiff and Defendant and their respective target customers are starkly different. Therefore, there was no likelihood of confusion between the rival trade names as alleged by the Plaintiff. The use of "CHEMCO" by the Defendant

is only as a trade name and the same bears no mention of any of the goods manufactured and sold by the Defendant.

3.5 With regard to the domain name, the Defendant contended that the Defendant's domain name, "www.chemcoplast.com" was registered prior to the registration of the Plaintiff's domain name, i.e., 17th March 2006. It, therefore, defies comprehension that for a over decade of the Defendant using it's domain name containing the word "CHEMCO", the Plaintiff did not come across the Defendant or it's domain name.

3.6 On account of definitive positive act on the part of the Plaintiff in engaging in business with the Defendant, and on account of inordinate delay in initiating action, the Plaintiff's claim is barred by delay, laches and acquiescence. In the face of multitude of common business links between the Plaintiff and the Defendant who operate in a small business segment, it is inconceivable that the Plaintiff would not have known the use of the mark, "CHEMCO" by the Defendant especially when the Defendant has been openly using the mark since the year 1977.

3.7 With regard to the passing off action, the Defendant claims the rival goods manufactured by the Plaintiff and the Defendant are consumed by completely different consumers. The business of the Plaintiff is that of a B2C nature and the Defendant

operates on a B2B model and manufactures the goods for the purpose of the bulk consumption or made to order. At any rate, the Defendant does not manufacture its goods under the trade mark, "CHEMCO". The said word is used only as a trading name. In substance, the Defendant contends the Plaintiff has failed to make out a strong *prima facie* case and the balance of convenience tilts in favour of the Defendant.

4. After the initial pleadings a number of further Affidavits were filed on behalf of the Plaintiff and the Defendant. A detail reference to all the contentions in of each of the Affidavits is not warranted. Suffice to note that the controversy between the parties revolves around the question as to who of the parties is prior user of the mark, "CHEMCO", whether there is material to show that the Plaintiff and the Defendant are entitled to claim the benefit of the purported prior user of the said mark, "CHEMCO" by their respective predecessor-in-interest, whether there is acquiescence on the part of the Plaintiff and whether, in the totality of the circumstances, the Plaintiff is entitled to the interim reliefs.

5. The Court, therefore, considers it appropriate to refer to the relevant further pleadings wherever warranted. It is also necessary to note that the parties have placed on record a number of documents to substantiate their rival claims. Reference to the documents which are

necessary for the determination of the Application would be made at an appropriate stage.

6. In the backdrop of the aforesaid pleadings and the material on record, I have heard Dr. Veerendra Tulzapurkar, the learned Senior Advocate for the Plaintiff, and Mr. Rashmin Khandekar, the learned Counsel for the Defendant, at length. The learned Counsel took the Court through the pleadings and the documents on record.

7. At the outset, Dr. Tulzapurkar, the learned Senior Advocate, submitted that the entire controversy boils down to the question as to whether the Plaintiff is the prior adopter of the mark, “CHEMCO” or the Defendant is the prior user of the said mark. The aforesaid question, according to Dr. Tulzapurkar, is required to be answered in the light of the uncontroverted facts that the Plaintiff is a registered proprietor of the trade mark, “CHEMCO”. Incontrovertibly, the Defendant has been using the mark, “CHEMCO”, the trading name, “CHEMCO PLAST” and the domain name, “www.chemcoplast.com”. Indisputably, the Defendant had not secured any registration for the impugned mark.

8. Inviting attention of the Court to the documents which show the nature and description of the goods manufactured and sold by the Plaintiff and the Defendant, Dr. Tulzapurkar would urge that, the goods manufactured and sold by the Plaintiff and Defendant are similar. The Plaintiff's mark and impugned mark are identical. The Plaintiff's

mark is registered in the same Class, i.e., Class 21 in respect of which the Defendant has been using the impugned mark. The rival goods are sold by the parties through the same trade channel and have common purchasers. With reference to the nature of the goods manufactured and sold, the queries/requisitions received from the customers, Dr. Tulzapuarkar would urge that, the confusion is bound to arise and has, in fact, arisen even in the mind of discerning customers.

9. Dr. Tulzapurkar would urge, since the rival marks and rival goods are identical, the infringement in question squarely falls within the ambit of Section 29(2)(c) of the Act, 1999 and, resultantly, it is required to be presumed that the use of the impugned trade mark by the Defendant is likely to cause confusion on the part of the public as provided in Section 29(3) of the Act, 1999.

10. Dr. Tulzapurkar submitted that the contention of the Defendant that the goods manufactured and sold by the Plaintiff and the Defendant are dissimilar is demonstrably untenable. A bare perusal of the documents which evidence the nature of the goods manufactured and sold by the Plaintiff and the Defendant would indicate that the goods are identical and are put for a similar use. It was submitted that the question of similarity of the goods cannot be tested on the basis of the the Classes in which the marks are registered but adopting a business and common sense approach. To buttress this submission, Dr.

Tulzapurkar placed reliance on the decisions in the cases of **Allied Auto Accessories Ltd Vs Allied Motor Pvt Ltd¹** and **Eagle Potteries Pvt Ltd Vs Egale Flask Industries Pvt Ltd.²** Moreover, the Plaintiff has brought material on record to show the instances of actual confusion amongst the customers and the members of the public.

11. In the alternative, Dr. Tulzapurkar would urge, the Plaintiff's mark, "CHEMCO" is a "well-known mark". Consequently, the use of the impugned mark by the Defendant even in respect dissimilar goods amounts to infringement of the Plaintiff's registered trade mark under Section 29(4) of the Act. By placing on record voluminous material in the nature of the Annual Financial Statements, Chartered Accountant's Certificate and the details of expenditure on sales and promotion and the manner in which the Plaintiff's goods are received in the market, according to Dr. Tulzapurkar, the Plaintiff has conclusively demonstrated that the Plaintiff's mark has an enviable reputation in India and the use of the impugned mark by the Defendant is without due cause. Once it is established that the mark is a 'well-known mark', even the likelihood of confusion pales in significance. To this end, Dr. Tulzapurkar placed reliance on the judgments in the cases of **RPG Enterprises Ltd Vs Riju Ghoshal & Anr,³** **KSB Aktiengesellschaft & Anr Vs**

1 2022 SCC OnLine Bom 1138.

2 1992 SCC OnLine Bom 490.

3 2022 SCC OnLine Bom 626.

KSB Real Estate and Finance Private Limited⁴ and Rolex SA Vs Alex Jewellery Pvt Ltd & Ors.⁵

12. Dr. Tulzapurkar submitted that the material on record makes out a strong *prima face* case of passing off. All the ingredients to sustain an action of passing off namely; i) goodwill and reputation, ii) likelihood of deception and confusion by the Defendant's use of the impugned trade mark, and, iii) likelihood of injury to the Plaintiff by such use, are satisfactorily made out. The instances of the actual confusion were pressed into service by Dr. Tulzapurkar to substantiate the claim of the Plaintiff.

13. In the case at hand, Dr. Tulzapurkar would urge, the goods are similar and even when the goods are totally dissimilar, an action for passing off can be sustained where such goods are sold under the Plaintiff's trade mark or trade mark deceptively similar and there is a real likelihood of confusion or deception being caused among the public. To bolster up this submission and sustain the prayer for restraint against passing off, Mr. Tulzapurkar placed reliance on the judgments in the cases of **RPG Enterprises (Supra)**, **S Sayed Mohideen Vs P. Sulochana Bai**,⁶ **Laxmikant Patel Vs Chetanbhai Shah & Anr**,⁷

4 Notice of Motion No. 4019 of 2007 in Suit No. 2930 of 2007, order dated 11th February 2008.

5 2014 SCC OnLine Del 1619.

6 (2016) 2 SCC 683.

7 (2002) 3 SCC 65.

Cadila Health Care Ltd Vs Cadila Pharmaceuticals Ltd,⁸ Kirloskar Diesel Recon Pvt Ltd & Anr Vs Kirloskar Proprietary Ltd,⁹ Sunder Parmanand Lalwani Vs Caltex (India) Ltd,¹⁰ Bata India Limited Vs Pyare Lal & Co¹¹ and International Society for Krishna Consciousness (ISKCON) Vs Iskon Apparel Pvt Ltd.¹²

14. The defence of vested interest based on prior user of the impugned mark “CHEMCO”, was also stated to be unsustainable. On the one hand, the Plaintiff has demonstrated that the Plaintiff is both a registered proprietor of the mark, “CHEMCO” and also prior user thereof. On the other hand, the Defendant has singularly failed to bring material on record to show the alleged user of the impugned mark by the predecessor-in-title of the Defendant. At any rate, the Plaintiff has shown prior user with effect from 4th April 1998. In contrast, the prior user of the Defendant as such is, at best, from the year 1999. Consequently, the Plaintiff's user and registration being prior to the Defendant's use, the Defendant is not entitled to benefit of the provisions contained in Section 34 of the Act, 1999. A strong reliance was placed by Dr. Tulzapurkar on the judgment in the case of **Kamat Hotels (India) Ltd Vs Royal Orchid Hotels Ltd¹³**

8 (2001) 5 SCC 73.

9 1995 SCC OnLine Bom 312.

10 1965 SCC OnLine Bom 151.

11 1985 SCC OnLine All 79.

12 2020 SCC OnLine Bom 729.

13 2011 (4) MhLJ 71.

15. With regard to the defence of delay and acquiescence, Dr. Tulzapurkar submitted that mere delay by itself, without anything more, would not be an impediment in restraining infringement of a trade mark, as the infringement of the mark constitutes a continuing cause of action and the registered proprietor of the marks suffers injury everyday. In support of the aforesaid submission, Mr. Tulzapurkar placed reliance on the judgments in the cases of **Midas Hygiene Industries Pvt Ltd Vs Sudhir Bhatia & Ors**,¹⁴ **Schering Corporation Vs Kilitch Co (Pharma) Pvt Ltd**¹⁵ and **Cadila Pharmaceuticals Ltd Vs Sami Khatib of Mumbai**¹⁶

16. Refuting the contention on behalf of the Defendant that the action is inordinately delayed and it is barred by acquiescence, Dr. Tulzapurkar submitted that no sooner the Plaintiff became aware of the infringement of its marks in the year 2015, cease and desist notice was issued and the Plaintiff also filed criminal complaint with the police. Consequently, it cannot be said that there was acquiescence by positive acts. On the contrary, the steps taken by the Plaintiff would show that the Defendant continued to infringe the mark of the Plaintiff with full knowledge that the Plaintiff was the registered proprietor of the mark. In any event, it was incumbent upon the Defendant to cause a search of

14 (2004) 3 SCC 90.

15 1990 SCC OnLine Bom 425.

16 2011 SCC OnLine Bom 484.

the Trade Mark Registry and ascertain whether there was a prior user of the impugned mark. In the absence thereof, the Defendant is not entitled to take the plea of acquiescence. Reliance was also placed by Dr. Tulzapurkar on the judgment in the case of **Bal Pharma Ltd Vs Centaur Laboratories Pvt Ltd.**¹⁷

17. Amplifying the submission, Dr. Tulzapurkar submitted that to succeed in the plea of acquiescence there ought to be an element of honesty in the adoption of the mark. If the adoption of the mark is itself dishonest, as is the case at hand, defence of acquiescence is not available. Placing reliance on the judgment of the Supreme Court in the case of **Power Control Appliances Vs Sumeet Machines Pvt Ltd**¹⁸ and a Division Bench judgment of this Court in the case of **Torrent Pharmaceuticals Limited Vs Wockhardt Limited and Ors**¹⁹ which was affirmed by the Supreme Court in **Wockhardt Limited Vs Torrent Pharmaceuticals Limited & Anr**,²⁰ Dr. Tulzapurkar would urge mere delay in approaching the Court by itself does not amount to a positive act to constitute acquiescence. On the contrary, in the facts of the case, the actions on the part of the Plaintiff constitute negative acts. Support was sought to be drawn from the judgments in the cases of **Jagdish**

17 2001 SCC OnLine Bom 1176.

18 (1994) 2 SCC 448.

19 2017 SCC OnLine Bom 9666.

20 (2018) 18 SCC 346.

Kamath Vs Lime and Chilli Hospitality Services,²¹ Willmott Vs Barber²² and Abdul Rasul Nurallah Virjee & Anr Vs Regal Footwear.²³

18. In the totality of the circumstances, according to Dr. Tulzapurkar, a very strong *prima facie* case was made out to grant interim reliefs. Lest the Plaintiff would suffer irreparable loss.

19. Per contra, Mr. Rashmin Khandekar, the learned Counsel for the Defendant, stoutly resisted the submissions on behalf of the Plaintiff. First and foremost, Mr. Khandekar would urge the Plaintiff's claim of user of the mark, "CHEMCO" since 1973 is demonstrably false. In contrast the Defendant's honest adoption and continuous use of "CHEMCO" as a part of its trading style/business name is traceable to Defendant's predecessor-in-interest since 1977.

20. Taking the Court through the averments in the Plaint, in regard to the use of the mark "CHEMCO" by the purported predecessor-in-interest of the Plaintiff, Mr. Khandekar would urge that, there is not an iota of material to show that the assignment and transfer of "CHEMCO" mark from M/s Chemco Plastic Corporation to the Plaintiff. There is not a shred of material to show that the business of M/s Chamco Plastic Corporation was purportedly consolidated into the Plaintiff. On the contrary, the material shows that the Plaintiff was

21 2015 SCC OnLine Bom 531.

22 1879 W. 48 (Chancery Division).

23 2023 SCC OnLine Bom 10.

initially incorporated as, “Net-Guard Polynet” on 6th February 1996 and its name was changed to M/s Chemco Plastic Corporation on 7th May 1997. Furthermore M/s Chemco Plastic Corporation, the partnership firm, continued to exist even after the incorporation of the Plaintiff and that erodes the claim of the Plaintiff, that M/s Chemco Plastic Corporation's business was consolidated into the Plaintiff irretrievably.

21. Mr. Khandekar would urge, despite filing multiple Affidavits, the Plaintiff has failed to bring on record any material to substantiate its case that M/s Chemco Plastic Corporation's business was consolidated into the Plaintiff. Reliance was placed by Mr. Khandekar on the judgment in the case of **Power Control Appliances (Supra)** to draw home the point that there is one mark, one source and one proprietor.

22. According to Mr. Khandekar, due to the failure on the part of the Plaintiff to demonstrate any assignment or transfer of the “CHEMCO” mark from the alleged predecessor-in-interest to the Plaintiff, the Suit itself is not tenable. To lend support to the submission that the Plaintiff cannot claim use of the mark, as a successor-in-interest, without producing cogent evidence, Mr. Khandekar placed reliance on the judgments in the cases of **Shemaroo Entertainment Ltd Vs Super Cassettes Industries Pvt Ltd & Ors²⁴** and **T. G. Balaji Chettiar Vs Hindustan Lever Ltd, Bombay.²⁵**

24 Interim Application NO. 2987 of 2022 in Commercial IP Suit No. 297 of 2022, order dated 5th June 2023.

25 1965 SCC OnLine Mad 69.

23. To buttress the submission that clear proof of flow of title is required to be shown to lay claim over a mark through predecessor-in-interest, Mr. Khandekar banked upon the judgments in the cases of **Yogi Ayurvedic Products Pvt Ltd Vs Vaishali Industries²⁶** and **Lords Inn Hotels & Developers Private Limited Vs Vikas Seth, Trading as Lords Residency, Manali.²⁷**

24. Mr. Khandekar would urge, the Plaintiff had initially annexed documents with the Plaint which indicated that the mark in question was being used by the Plaintiff with effect from March 2003 only. When the Defendant highlighted the said fact the Plaintiff sought to introduce the documents to show that the Plaintiff has been using the mark since the year 1998. Banking upon the provisions contained in Order IX of the Code of Civil Procedure, 1908 (“the Code”), as applicable to commercial suits, Mr. Khandekar would urge, the Plaintiff cannot be permitted to rely upon those documents, which were clearly within the power, possession and control or custody of the Plaintiff, when no explanation has been offered why those documents were not produced along with the Plaint. To this end, reliance was placed by Mr. Khandekar on the judgments in the cases of **Shemaroo Entertainment**

26 Interim Application No. 1598 of 2023 with Court Receiver’s Report No. 288 of 2022 in Commercial IP Suit No. 45 of 2023, order dated 17th February 2025.

27 Interim Application No. 190 of 2025 with Leave Petition (L) No. 3592 of 2025 and Commercial IP Suit No. 247 of 2024.

Ltd (Supra), Nitin Sukanraj Jain Vs Neoliva Life Science Private Limited²⁸ and Khanna Rayon Industries Pvt Ltd Vs Swastik Associates and Ors.²⁹

25. Mr. Khandekar would further urge, even if the prior user of the predecessor-in-title of the Defendant is discounted, there is material to show that the Defendant has been using “CHEMCO” as a part of its trading style/business name, openly, extensively and continuously since 1998.

26. It was submitted that, the fact that the Defendant has been using “CHEMCO” as a part of its trading style/business name and not as a mark is of material significance. That rules out the applicability of the provisions contained in sub-Section (1), (2) and (4) of Section 29 of the Act, 1999. The provisions contained in sub-Section (1), (2) and (4) of Section 29 governs, “trade mark Versus mark” situation and have no application where a Defendant is using a mark as a part of its trade/business name. At best, the case of the Plaintiff would be required to be tested on the anvil of the infringement covered by the sub-Section (5) of Section 29. For the said purpose, the identity of goods is a prerequisite. The material on record, according to Mr. Khandekar, would clearly indicate that the provisions contained in sub-Section (5) of Section 29 are not attracted to the facts of the case. A very strong

²⁸ Interim Application (L) No. 17260 of 2023 in Commercial IP Suit No. 451 of 2022.

²⁹ 2023 SCC OnLine Bom 1372.

reliance was placed on the Full Bench judgment of this Court in **Cipla Ltd Vs Cipla Industries Pvt Ltd, Delhi**.³⁰

27. Since the Plaintiff does not have registration for the subject mark under Class 35, the primary ingredient of, “dealing in goods and services in respect of which the trade name is registered” envisaged by sub-Section (5) of Section 29, is not satisfied. To buttress the submission that Section 29(5) is not applicable where the goods or services offered by the Defendant are not identical to the one in respect of which the Plaintiff holds a registration, Mr Khandekar placed reliance on the judgments in the case of **Raymond Ltd Vs Raymond Pharmaceuticals Pvt Ltd**³¹ and **Mankind Pharma Ltd Vs Chandra Mani Tiwari & Anr.**³²

28. On the aspect of passing off, Mr. Khandekar would urge, on first principles, the action of passing off would not survive as the Defendant is the prior user. Even otherwise, there is material to show the Defendant's own/independent use of “CHEMCO” since 1998 onwards. The Plaintiff has miserably failed to demonstrate that it had goodwill and reputation in the market as of 1998, much less substantial goodwill/reputation. The Plaintiff has placed on record documents to show the use of the mark since the year 2003 onwards. These

30 2017(2) MhLJ 877.

31 2010(7) MhLJ 646.

32 2018 SCC OnLine Del 9678.

documents are of no assistance as the relevant date for reckoning the goodwill/reputation is the date when the Defendant allegedly adopted the impugned mark.

29. Mr. Khandekar would further urge that, the Plaintiff has also failed to show any likelihood of deception or confusion on account of the differences in rival businesses and discerning nature of rival consumers. For this purpose, Mr. Khandekar placed reliance on the judgments in the cases of **Corona Remedies Private Limited Vs Franco-Indian Pharmaceuticals Private Limited**,³³ **Cadbury Schweppes Pty Limited Vs The Pub Squash Co Pty Limited**³⁴ and **Wyeth Holdings Corporation Vs Burnet Pharmaceuticals (Pvt) Ltd.**³⁵

30. With regard to the delay and acquiescence, Mr. Khandekar urged with tenacity that a clearest case of acquiescence coupled with gross delay and laches disentitles the Plaintiff from any of the reliefs. Several factors like online business of rival trading style/business names, membership of the same Trading Association since 2011/12 with names appearing on the same page/one below the other in the Members Directory, direct interaction between the employees of the Plaintiff and Defendant and common suppliers, buyers and business links between the Plaintiff and the Defendant were pressed into service

33 MANU/MH/0410/2023.

34 MANU/UKPC/0005/1980.

35 2008(2) Bom CR 739.

to bolster up the submission that it is inconceivable that the Plaintiff would not have known about the presence of, and use by, the Defendant of “CHEMCO” as its trading name.

31. Mr. Khandekar would urge that the only inference that can be drawn on the basis of the voluminous material is that the Plaintiff not only sat by for several years but knowingly permitted the Defendant to build up a formidable business under “CHEMCO” trading style/business name and even encouraged the Defendant to do so through the positive acts. A very strong reliance was placed by Mr. Khandekar on the judgments in the case of **Amritdhara Pharmacy Vs Satya Deo Gupta**,³⁶ **Power Control Appliances (Supra)** and **Yonex Kabushiki Kaisha Vs Phillips International & Anr.**³⁷

32. Mr. Khandekar submitted that, even if a *prima facie* case is presumed to exist in favour of the Plaintiff, discounting all the aforesaid factors, yet, looked at from any perspective, the balance of convenience firmly tilts in favour of the Defendant.

33. Indisputably, the Defendant has, on its own, been using “CHEMCO” as a part of its trading name since the year 1998. The Defendant has garnered a formidable business. On the own showing of the Plaintiff, the Plaintiff became aware of the alleged infringement in the year 2015. Yet, the Suit came to be instituted in the year 2023. In

36 AIR 1963 SC 449.

37 2007 SCC OnLine Del 1109.

this backdrop, according to Mr. Khandekar, the balance of convenience firmly lies in favour of the Defendant and, in such a situation, an injunctive relief cannot be granted.

34. Lastly, Mr. Khandekar would urge, in a case of the present nature, where there is a serious dispute in regard to the Plaintiff's title and/or priority of user vis-a-vis Defendant's adoption/use of the impugned name and serious issues of facts crop up, which can only be legitimately adjudicated at the trial, interim injunction cannot be granted. To lend support to this submission, Mr. Khandekar placed reliance on the judgments in the cases of **Uniply Industries Ltd Vs Unicorn Plywood Pvt Ltd & Ors**,³⁸ **Shamoil Ahmad Khan Vs Falguni Shah & Ors**,³⁹ **Hubbard And Anr Vs Vosper & Anr**,⁴⁰ **Kamat Hotels (India) Ltd(Supra) and Exegesis Infotech (India) Pvt Ltd & Anr Vs Medimanage Insurance Broking Pvt Ltd**.⁴¹

35. In Rejoinder, Dr. Tulzapurkar would submit, the balance of convenience plays a role only in unusual circumstances and the Defendant who blatantly infringes the registered mark cannot take refuge under the principle of balance of convenience. To this end, Dr. Tulzapurkar placed reliance on a Division Bench judgment in the case of

38 (2001) 5 SCC 95.

39 2020 (6) MhLJ 465.

40 (1972) 2 Q.B. 84.

41 2015 SCC OnLine Bom 3797.

Express Bottlers Services Pvt Ltd & Anr Vs Pepsi Co Inco⁴² and on an order of a learned Single Judge in the case of **Dr Ashok M. Bhat Vs Sandeep Udai Naraian Gupta & Anr.⁴³**

36. In regard to the objection under Order IX Rule 1 of the Code, Dr. Tulzapurkar submitted, the Plaintiff is entitled in law to rely on documents in answer to the Defendant's contentions in Reply and, therefore, the objection is clearly unsustainable. Reliance was placed on a judgment in the case of **Soni Music Entertainment India Private Limited Vs Ilaiyaraaja Music N Management Private Limited & Ors.⁴⁴**

CONSIDERATION:

37. Evidently both the Plaintiff and the Defendant lay claim over the use of, “CHEMCO” through their predecessor-in-title. Which of the parties is the prior user of “CHEMCO” either individually or through its predecessor-in-title is at the heart of the controversy. The nature of the user of, “CHEMCO” also assumes critical significance. Whether “CHEMCO” is used as a mark in relation to goods or services offered by

⁴² 1991 SCC OnLine Bom 549.

⁴³ Interim Application (L) No. 37430 of 2024 in Commercial IP Suit (L) No. 37157 of 2024.

⁴⁴ Interim Application (L) No. 25506 of 2023 in Commercial IP Suit No. 562 of 2022.

the Defendant or it is merely used as a trading name would also bear upon the rights and liabilities of the parties.

38. The aforesaid being the nature of the controversy, at the outset, it may be advantageous to briefly trace the flow of title to the mark, “CHEMCO” claimed by the Plaintiff and Defendant.

39. M/s. Chemco Supply Corporation (CSC) commenced its operations in the year 1973. The Plaintiff claims CSC commenced the manufacture of plastic containers in December 1973. The entire business of CSC came to be assigned to Chemco Plastic Corporation, a partnership between Mr. Ramawatar Saraogi, the Promoter of Plaintiff and others. On 11th September 1980, reconstituted Partnership Deed of Chemco Plastic Corporation came to be executed on 14th November 1985 between Mr. Ramawatar Saraogi and Bimla R. Saraogi, the Promoters of the Plaintiff.

40. On 6th February 1996 the Plaintiff was allegedly incorporated as a private limited company under the name and style of “Net-Guard Polynet Private Limited” by the partners of Chemco Plastic Corporation. On 7th May 1997 a Certificate of Incorporation pursuant to the name change from “Net-Guard Polynet Private Limited” to “Chemco Plastic Corporation Limited” came to be issued.

41. In this fashion the Plaintiff traces the use of the mark, “CHEMCO” to M/s Chemco Supply Corporation with effect from 20th December 1973.

42. In contrast, Kailash Parasrampurua commenced the business of M/s Chemco Industries in 1977. In 1978 Kailash Parasrampurua and Sanvarmal Sharma, executed a Deed of partnership to continue the business commenced by Kailash Parasrampurua. The partnership was dissolved on 8th November 1980. Kailash Parasrampurua continued to operate M/s Chemco Industries as a sole proprietor thereof from 1980 to 1987.

43. On 22nd October 1987, a Deed of Partnership was executed between Kailash Parasrampurua and Hemant Parasrampurua to carry on the business of Chemco Industries in partnership. In 1998, Kailash Parasrampurua retired from M/s Chemco Industries and Hemant Parasrampurua continued the business as a sole proprietorship.

44. On 22nd August 1998, a Deed of Partnership was executed between Hemant Parasrampurua and others to incorporate M/s Chemco Plast, the Defendant. On 1st April 2001, Hemant Parasrampurua retired from the firm and the rest of the partners continued to carry on the business in partnership. Thus, the Defendant traces the user of “CHEMCO” to M/s Chemco Industries since the year 1977.

45. Keeping the aforesaid historical context of the user of, “CHEMCO” it may be appropriate to note as to how the marks have been registered with the Trade Mark Registry. The Plaintiff first registered the mark “CHEMCO” vide Application dated 1st February 2012 under Class (21) with user claim from 1st April 1973. “CHEMCO”



logo was registered on 30th August 2016 with user claim from 1st April 1996. “CHEMCO” mark was again registered under Class 11 on 12th June 2023 with prior user claim from 6th March 1973. Likewise, the mark “CHEMCO” was registered on 15th November 2020 in Classes 20 and 22. Lastly “CHEMCO” mark was registered under Class 16 with user claim from 6th March 1973.

46. The Defendant opposed the registration of the mark “CHEMCO” under Class 17 with prior user claim from 6th March 1973 and the mark, “CHEMCO” under Class 35 with user claim from 6th March 1973.

47. In contrast, the Applications for registration of the mark Chemco Plast under Classes 17, 35 and 21 were abandoned by the Defendant. The Applications dated 3rd June 2014 were filed in respect of Chemco Plast on proposed to be used basis. An Application for registration of the mark “CHEMCO” under Class 21 was abandoned and another application under Class 35 with prior user claim from 9th April 1977, awaits adjudication by Trade Mark Registry.

48. The situation which thus obtains is that, as of the date of the Suit, the Plaintiff has secured registration of its mark and logo under Classes 11, 16, 20, 21 and 22. Per contra the Defendant is not the proprietor of any registered trade mark.

49. Keeping in view these primary facts, the question of infringement of the mark “CHEMCO” is required to be evaluated *prima facie*. The Registration of the trade mark subject to the provisions of the Trade Marks Act 1999 gives to the registered proprietor of the trade mark the exclusive right to 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. The first question that warrants consideration is, whether the infringement would fall within the ambit of sub-Sections (1), (2) and (4) of Section 29 of the Act, 1999 or sub-Section (5) of Section 29.

50. The thrust of the submission of Mr. Khandekar was that, at best, the case of the Plaintiff may fall within the ambit of sub-Section (5) of Section 29 as the Plaintiff has failed to demonstrate that the Defendant is using the registered trade mark in relation to the goods or services in respect of which the above trade marks are registered in the name of the Plaintiff.

51. There is indeed a subtle yet significant distinction between sub-Sections (4) and (5) of Section 29 of the Act, 1999. Relevant part of Section 29 reads as under:

“29. Infringement of registered trade marks.—(1) 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.

(2) 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—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) 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.

(3) In any case falling under clause (c) of subsection (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) 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—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

...”

52. On their plain reading, sub-Sections (1) and (2) of Section 29 apply to “trade mark Vs mark” situation. The sub-Sections (1) and (2) use an identical expression “uses in the course of trade”. However, they do not cover a situation when the Defendant allegedly uses a registered trade mark as a part of his trade/business name. Sub-Section (4) of Section 29 governs a situation where the Defendant against whom allegations of infringement is made uses a mark in relation to the goods or services which are not similar to those for which the trade mark is registered. In other words, it applies when a mark is used during the course of trade in relation to dissimilar goods.

53. Sub-Section (5), on the other hand, governs a “trade mark Vs trade or business name” situation. Sub-Section (5) of Section 29 proscribes infringement of a trade mark by making use of the same in the trade or business name, while dealing in goods or services in respect of which the trade mark is registered.

54. In the case of **Cipla Ltd (Supra)**, a Full Bench of this Court was called upon to answer the following questions.

“(1) Where a party is found to be using a registered trade mark as a 'name', viz., as a corporate or trading name or style, though in respect of goods dissimilar to the ones for which the trade mark is registered, is the proprietor of the registered trade mark entitled to an injunction on a cause of action in infringement under Section 29(5) of the Trade Marks Act, 1999?

(2) Whether the use of a registered trade mark as corporate name or trading name or style is excluded from the purview of Sections 29(1), 29(2) and 29(4) of the Trade Marks Act, 1999, and whether those Sections are restricted to the use of a trade mark 'as a trade mark', i.e., in the 'trade marky' sense?

(3) Whether Sections 29(4) and 29(5) operate in separate and mutually exclusive spheres, i.e., whether, if the defendant uses the registered trade mark only as a corporate name or trading name or style in respect of dissimilar goods, a Plaintiff can have no remedy and is not entitled to an injunction?"

55. The Full Bench after pointing out the distinction between sub-Sections (4) and (5) of Section 29 of the Act, 1999, answered the first question in the negative and the second in the affirmative. It was observed that sub-Sections (1), (2) and (4) of Section 29 will apply in “trade mark Vs mark” situation. Question No.3 was also answered in the affirmative.

56. The Full Bench pointed out the distinction between sub-Sections (4) and (5) of Section 29 as under:

“26. Unless both the conditions are satisfied, Sub-Section (5) will not apply. The question before us is when the first condition of Sub-Section (5) is satisfied but the second is not satisfied, whether Sub-Section (4) can be invoked. In other words, the question is whether a person who is dealing with goods or services which are dissimilar to those for which the trade mark is

registered, uses registered trade mark as a part of business/corporate name, such use will attract the mischief covered by Sub-Section (4). The plain language used by the Sub-Sections (4) and (5) answers the question. Sub-Section (4) 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 – (a) is identical with or similar to the registered trade mark, and (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered...” Thus, the provision is attracted when a mark which is identical with or similar to registered trade mark is used in the course of trade in relation to goods or services which are not similar to those for which the trade mark is registered. Whereas Sub-Section (5) provides that “A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern...” .

27. The Sub-Section (4) uses the words “in the course of trade” and “in relation to goods or services” which are absent in Sub-Section (5). The Sub-Section (5) uses the words “..... if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern..” These words are conspicuously absent in the Sub-Section (4). The difference in the phraseology and language used in the two Sub Sections makes it clear that Sub-Section (4) applies in “trade mark versus mark”

situation. It applies when the mark is used in the course of trade in relation to goods and services. Sub-Section (5) applies to a “trade mark versus trade/corporate/business name” situation. It is a special provision which is different from Sub-Sections (1), (2) and (4). Thus, Sub-Sections (4) and (5) apply to different situations arising out of use of a mark. Sub-Section (5) does not make Sub-Section (4) otiose. The fact that the definition of the word “mark” includes “name” is of no consequence while interpreting Sub-Sections (4) and (5). If we hold that Sub-Section (4) will apply to those cases where the first condition of Sub-Section (5) is satisfied but second one is not satisfied, the requirement specifically incorporated in Sub-Section (4) of the mark being used in relation to goods and services will become redundant. A statute cannot be interpreted in such a manner. The use of trade mark as a part of corporate/business/trade name cannot be read into Sub-Section (4).”

(emphasis supplied)

57. The question as to how the similarity or dissimilarity of the goods, in which the Plaintiff and the Defendant are dealing in, is to be determined next arises for consideration.

58. Dr. Tulzapurkar submitted that the defence of the Defendant that the Defendant goods are dissimilar is plainly unsustainable. Taking the Court through the goods manufactured by the Plaintiff and the Defendant, as evidenced from the documents placed on

record, Dr. Tulzapurkar would urge that the question is required to be determined by adopting a business and common sense approach.

59. The factors which weigh in the determination of the similarity of the goods and services are fairly well-settled. The Court is required to take into account the nature and composition of the goods, their respective uses and function and the trade channel through which they are bought and sold. The matter is required to be ultimately judged in a business sense. Reliance placed by Dr. Tulzapurkar on the decision in the case of **Allied Auto Accessories Ltd (Supra)** and **Eagle Potteries Pvt Ltd (Supra)** appears to be well-founded.

60. On perusal of the material on record this Court *prima facie* finds that the goods manufactured by both the Plaintiff and Defendant have an element of similarity. The specific products, variety and refinement may be different. However, by and large, both the Plaintiff and the Defendant are *prima facie* engaged in the manufacture of the plastic products which cater to the same customers, have similar trade channel, and are put to similar use.

61. Dr. Tulzapurkar next submitted that even if it is assumed that the goods manufactured by the Plaintiff and Defendant are dissimilar yet, in view of “CHEMCO” having garnered an enviable reputation of a “well-known brand”, a case of infringement under sub-Section (4) of Section 29 would be made out. If the case falls within

the ambit of sub-Section (4) of Section 29, the question of similarity of the goods pales in significance.

62. For the application of sub-Section (4) of Section 29, the conditions that are required to be satisfied are; the registered trade mark has a reputation in India and the use of the impugned mark is without cause and the Defendant obtains unfair advantage of or the use of the mark is detrimental to the distinctive character of the registered trade mark or the reputation of the registered trade mark. If these conditions are satisfied, the requirement of having to demonstrate the likelihood of confusion is absent.

63. In the case of **RPG Enterprises Ltd (Supra)** it was enunciated that the aforesaid features which protect the infringement in a well-known mark afford a stronger protection to those mark that have wide reputation without the registered proprietor of such marks having to demonstrate the likelihood of confusion arising from the use of an identical or similar mark in relation to dissimilar goods and services.

CLAIM OF USER OF “CHEMCO” BY THE PREDECESSOR-IN-INTEREST:

64. To substantiate its claim of user since 1973 traceable to the predecessor-in-interest, reliance placed by the Plaintiff on the Agreement for Sale dated 6th March 1973 between the M/s Virwani Construction Company and M/s Chemco Supply Corporation, Certificate dated 12th January 1977 granting registration to Chemco Supply

Corporation as a small scale industry, Deed of Assignment dated 11th September 1980 between Chemco Supply Corporation and Chemco Plastic Corporation and the Share Certificate issued by M/s Virwani Industrial Premises Cooperative Society to M/s Chemco Supply Corporation, and the audited financial statements of Chemco Plastic Corporation for the financial year 1990-1996 *prima facie* appear to be of no avail. The aforesaid documents do not vouch for the use of the trade mark/name, "CHEMCO".

65. The two invoices dated 20th April 1989 and 5th September 1989 issued by the Chemco Plastic Corporation also do not indicate that "CHEMCO" or "CHEMCO PLAST" was used either as a trade mark or trade name. The invoices were issued in the trade name, "Chemco Plastic Corporation". The device mark in respect of which the Plaintiff has obtained the registration does not find mention in any of the invoices.

66. In the aforesaid backdrop, the moot question that comes to the fore is, whether there is material to show any assignment of the trade mark/name, "CHEMCO" from the predecessor-in-interest of the Plaintiff.

67. The aforesaid documents though indicate continuous business activities at one and the same premises in plastic blow moulded containers (jars, jerry cans and carboys), as the certification of

registration as a small scale industry shows, the assignment or transfer as such of the trade mark/name “CHEMCO” is *prima facie* not evident from one entity to the succeeding entity.

68. It is the claim of the Plaintiff that the Plaintiff-company was incorporated in 1996 by the partners of “M/s Chemco Plastic Corporation” with a view to consolidate the business of the said firm into a private limited company. Whether there is material which *prima facie* lends credence to this claim?

69. First and foremost, it is necessary to note the Plaintiff-company was initially incorporated as, “Netguard Polynet Pvt. Ltd” on 6th February 1996. The Memorandum of Association of the Plaintiff does not give any indication that the said company was incorporated to consolidate the business of M/s Chemco Plastic Corporation. Evidently, pursuant to the certificate of change of name, the name of the Plaintiff was changed to, “Chemco Plastic Industries Private Limited” from “Netguard Polynet Pvt. Ltd”.

70. Secondly, the material on record indicates that, even after the incorporation of the Plaintiff M/s Chemco Plastic Corporation continued to exist as a partnership firm. This factor, *prima facie*, runs counter to the claim of the Plaintiff that the Plaintiff-company was incorporated to consolidate the business of M/s Chemco Plastic Corporation.

71. An endeavour was made on behalf of the Plaintiff to the salvage position by asserting that the promoters of the Plaintiff and partners of M/s Chemco Plastic Corporation are one and the same and the change in the name of the Plaintiff-company occurred much prior to the date on which the Defendant was incorporated as a partnership firm.

72. I am afraid the aforesaid factors advance the cause of the submission on behalf of the Plaintiff. The mere fact that the promoters of the Plaintiff and the partners of M/s Chemco Plastic Corporation were the same may not necessarily imply that the entire business and especially the goodwill, mark and name of “CHEMCO” came to be transferred to the Plaintiff, especially when there is material to show that M/s Chemco Plastic Corporation continued to exist as a partnership firm even after the incorporation of the Plaintiff.

73. At this stage, it appears that the link in respect of user of CHEMCO between the Plaintiff and its predecessor-in-interest was snapped, firstly, with the incorporation of the Plaintiff as “ Netguard Polynet Pvt. Ltd”, without any reference to the trade name or mark of CHEMCO and, secondly, by the continuation of M/s Chemco Plastic Corporation as a partnership firm despite the incorporation of the Plaintiff.

74. In this backdrop, the absence of the documents evidencing the assignment of the goodwill of CHEMCO and the mark CHEMCO assumes significance.

75. In the case of **T. G. Balaji Chettiar (Supra)** a learned Single Judge of the Madras High Court enunciated that the concurrent user must be of the entire trade mark and it would not be enough if one feature of it alone had been used. The evidence must be evidence of the user of the trade mark as a whole and documentary evidence must be furnished to prove the same when challenged. User by different persons at different time cannot avail and the Applicant must prove that the alleged prior users are his predecessors-in-title, one claiming through the other in other words independent user of trade mark by independent unconnected persons cannot constitute the concurrent user. In the facts of the said case it was found that there was no proof how the Applicant who claimed title to the mark, derived title and became the owner of the trade mark and how he was entitled to rely upon prior user of other persons.

76. In the case of **Shemaroo Entertainment Ltd (Supra)**, a learned Single Judge of this Court emphasized the necessity of filing the link documents along with the Plaint while claiming copyright in the capacity of assignee.

77. In the case of **Yogi Ayurvedic Products Pvt Ltd (Supra)**, in the context of the absence of assignment of the trade mark, a learned Single Judge of this Court enunciated that assignment of a trade mark under the provisions of the Section 2(1)(a) of the Trade and Merchandise Marks Act, 1958 and Section 2(1)(b) of the Act, 1999 is mandatorily required to be in writing by the act of the parties concerned. Consequently, in the absence of such assignment in writing, as a matter of law, the Defendant cannot claim that its predecessor-in-interest had assigned that trade mark in favour of the Defendant. Once that link is snapped, there was no question of Defendant claiming that use of the mark, “YOGI” in he invoices issued by M/s D.V. Deo Aromatics Pvt Ltd, in the year 1997, would inure to the benefit of the Defendant.

78. In the case of **Lords Inn Hotels & Developers Private Limited (Supra)**, this Court enunciated that there has to be a continuous commercial use of the impugned mark in relation to goods and services by the party or its predecessor. There has to be cogent material on record to show such continuous commercial use and use in a stray/isolated or disjointed manner, can be of no avail.

79. Dr. Tulzapurkar attempted to wriggle out of the situation by asserting that in the case at hand the Plaintiff and Defendant stand on the the same footing in the matter of assignment of the mark. It was urged that though the Defendant claims prior user since 1977 through

its alleged predecessor-in-interest, yet, the Defendant has not placed on record any document to evidence the assignment of the goodwill and the mark.

80. The aforesaid submission, in my considered view, is of no avail to the Plaintiff. Having approached the Court with a positive case that the Plaintiff is the prior user of the mark, “CHEMCO” since 1973 and even obtained registration of the mark by propounding such user, it is not open to the Plaintiff to urge that the absence of assignment is of no significance, for the Defendant who claims prior user since 1977 has also failed to place on record documents evidencing the assignment.

81. Though, Mr. Khandekar, the learned Counsel for the Defendant, forcefully urged that there is unbroken chain of user of “CHEMCO” by the Defendant, at this stage, this Court may not delve into this aspect of the matter; suffice to note that, the Plaintiff who seeks interim relief on the basis of prior user, *prima facie*, failed to establish the nexus between the predecessor-in-interest of the Plaintiff and the Plaintiff.

USE OF CHEMCO AS A MARK BY THE DEFENDANT:

82. At this juncture, the claim of the Defendant that it has not used “CHEMCO” as a mark and used the same as a trade/business name

deserves to be appreciated in the light of the material on record. As noted above, the Defendant had filed Applications to register the mark, “CHEMCO PLAST” under Classes 17 and 35 on proposed to be used basis. The Defendant had also filed an Application to register the trade mark “CHEMCO PLAST” under Class 21 with claim of user from 22nd August 1998. All these Applications were abandoned. The fourth Application dated 12th January 2019 seeking the registration of the mark, “CHEMCO” under Class 35 with claim of user from 9th April 1977, was opposed by the Plaintiff.

83. Mr. Khandekar would urge no mileage can be drawn from the abandoned Applications for trade mark registration. The submission may carry some substance in relation to the Application in which the marks, “CHEMCO” and “CHEMCO PLAST” were proposed to be used. However, in relation to the Applications in which the user was claimed from August 1998 and April 1977, it cannot be said that the aforesaid factor is of no relevance.

84. Secondly, the invoices raised by the Defendant (“Exhibit “BB” to the Plaint”) do reveal the mark  being used along with, “CHEMCO PLAST”. It would be contextually relevant to note that in the Affidavit filed in Support of the Application for registration of the trade mark “CHEMCO” in Class 21, the partner of the Defendant affirmed that the said trade mark has been used by the Defendant

continuously since 22nd August 1998 in relation to the goods enumerated therein. The printout of the Defendant's website also reveal that “CHEMCO”  and “CHEMCO PLAST” were being used by the Defendant.

85. In the Reply to the cease and desist notice dated 14th October 2015, on behalf of the Defendant, it was contended that the Defendant was carrying on business under the name and style of, “CHEMCO PLAST” since the year 1998 and that the Defendant was manufacturing and/or marketing wide range of products under the trade mark, “CHEMCO” and trade name, “CHEMCO PLAST” and the domain name “www.chemcoplast.com” sine the year 2006.

86. In the face of the aforesaid material, the submission on behalf of the Defendant that the Plaintiff is relying upon stray sentences and sporadic use to establish that the Defendant is using, “CHEMCO” as a mark, cannot be readily acceded to. Cumulatively, the aforesaid material *prima facie* indicates that the Defendant has used and/or attempted to use “CHEMCO” as a mark and, when confronted, even asserted that it has been using “CHEMCO” as a trade mark. Thus, the submission that the case, at best would be governed by the provisions contained in sub-Section (5) of Section 29 of the Act, 1999 loses traction. Resultantly a *prima facie* case that the Defendant has invaded, attempted to invade and, in the least, threatened to invade the rights of

the Plaintiff as a registered proprietor of the trade marks, can be said to have been made out.

PASSING OFF:

87. Passing off is a right for protection of goodwill against the misrepresentation actuated by a design to show that the business belongs to the person whose goodwill is sought to be exploited. The classical elements of the passing off action are : (1) goodwill owned by a trader, (2) misrepresentation by the defendant so as to cause confusion as to the source, and, (3) resultant damage to the goodwill of the trader who has built a reputation and goodwill by prior user. The goodwill, misrepresentation and damage form a trinity which sustains an action for passing off.

88. In the case of **S Sayed Mohideen Vs P. Sulochana Bai (supra)**, after adverting to the classical requirements of an action in passing off, the Supreme Court expounded that the passing of action is essentially an action in deceit where common law rule is that no person is entitled to carry on his or her business on the pretext that the said business is that of another. It was held that the Supreme Court has given its imprimatur to the aforesaid principle in the case of **Laxmikant Patel Vs Chetanbhai Shah & Anr. (supra)**, wherein it was enunciated that three elements of passing of action are, reputation of the goods, possibility of deception and likelihood of damage to the Plaintiff. In the

said case, the Supreme Court further enunciated that the same principle which applies to trademark is applicable to trade name.

89. With regard to the necessity of injunction, where an action is for passing off, the Supreme Court postulated that, it is usual rather essential to seek an injunction temporary or ad-interim. The principles for grant of such injunction are the same as in the case of any other action against the injury complained of. The Plaintiff must prove a prima facie case, availability of balance of convenience in his favour, and, he is suffering an irreparable injury in absence of grant of injunction. It was further clarified that, as to how the injunction granted by the Court would shape, depends on the facts of the each case. Where the Defendant has imitated or adopted the Plaintiff's trademark or business name, the order may be an absolute injunction that he would not use or carry on business under that name.

90. With the passage of time, the concept of passing off has evolved to cover in its fold the misrepresentation even where the goods and services in respect of which the goodwill and reputation is sought to be exploited do not fall within "common field of activity". If the trademark or trade name of the Plaintiff which has garnered formidable reputation and goodwill is used to pass off dissimilar goods and services, then an action also in passing off is sustainable on the foundational premise that no one has a right to represent his goods or

services as those of someone else who has earned a reputation in trade, albeit in relation to different goods and services.

91. In the case of **RPG Enterprises Ltd Vs Riju Ghoshal & Anr. (supra)**, this Court has, after adverting to the previous pronouncements in the cases of **Kirloskar Diesel Recon Pvt Ltd & Anr Vs Kirloskar Proprietary Ltd. (supra)**, and, **Bata India Limited Vs Pyare Lal & Co. (supra)**, ruled that the principle that the “common field of activities” is not essential to succeed in case of passing off, is well established. Thus, in the facts of the said case, the fact that the Plaintiff and Defendant’s field of activities were not identical, was held to be of no consequence. Such representation by the Defendant was certainly likely to cause damage to the Plaintiff.

92. The aforesaid being the position in law, the aspect of similarity or dissimilarity of the goods wanes in significance. It has to be seen, whether the classical trinity of elements is prima facie made out. On the first count of goodwill and reputation, the Plaintiff relies upon invoices, audited financial statements, Chartered Accountant’s Certificate, volume of sales and promotional expenses. Most of the aforesaid documents pertain to the period 2003 and onwards. In addition, the Plaintiff has relied upon the material available in public domain, which shows the repute of the Plaintiff’s business under the mark and name “CHEMCO”.

93. The point in time at which the person, who seeks protection of rights on account of prior user, ought to have garnered the reputation, is of critical salience. The aforesaid material pressed into service to show the goodwill and reputation of the Plaintiff is required to be co-related with the commencement of the complained action of passing off the goods by the Defendant. Whether at that point of time, the Plaintiff had the reputation and the Defendant tried to ride on the said reputation and goodwill so as to pass off the Defendant's goods as that of the Plaintiff becomes critical.

94. What is the relevant date to judge, whether the Plaintiff had established reputation or goodwill ? In the case of **Cadbury Schweppes Pty Limited Vs The Pub Squash Co Pty Limited (supra)**, the Judicial Committee of the Privy Council enunciated that, in that case, the Judge had misdirected himself in holding that the relevant date for determining whether the Plaintiff has established the necessary goodwill or reputation of his project, is the date of the commencement of the proceedings. The relevant date is in law the date of the commencement of the conduct complained of i.e. when the Respondent began to market his product.

95. In the case of **Wyeth Holdings Corporation Vs Burnet Pharmaceuticals (Pvt) Ltd. (supra)**, a learned Single Judge of this Court held that the relevant date for determining whether the Plaintiffs have

established reputation or goodwill is the date of the commencement of the conduct complained of.

96. In **Corona Remedies Private Limited Vs Franco-Indian Pharmaceuticals Private Limited (supra)**, a Division Bench of this Court reiterated that, there can be no quarrel with the principle that, in an action for passing off, it is incumbent upon the Plaintiff to show that he has acquired goodwill and reputation in respect of his goods and/or services for which mark is used. However, it is also settled principle of law that, in determining this question, it must be proved that the Plaintiff had acquired such goodwill and reputation when the Defendant began use of its trade mark.

97. Reverting to the facts of the case at hand, the aspect of acquisition of goodwill and reputation is required to be appreciated in two parts. First, the time from which the Plaintiff started to use CHEMCO in its own name, and the Defendant's alleged first use of the same in its individual capacity. Second, the user of CHEMCO by the predecessor-in-interest of the Plaintiff and Defendant. The second part has been discussed hereinabove.

98. The Plaintiff's user of CHEMCO, in its own name, prima facie, commenced in the year 1998, as is evident from the invoices raised from 4 April 1998 (Exhibits B-1 to B-5 – further Response Affidavit). Rest of the documents in respect of the claim of user since

1996, namely, the Memorandum of Association of CHEMCO Plastic Industries Ltd., Certificate of Incorporation of Netguard Polynet Pvt. Ltd., and the certification of incorporation pursuant to the Plaintiff's change in name, are prima facie of no assistance in demonstrating that the Plaintiff has been using CHEMCO as a mark or tradename, and, more importantly, by that time, the Plaintiff had acquired the reputation and goodwill in the mark CHEMCO.

99. Keeping the aforesaid factors in view, if the time of the commencement of the conduct of the Defendant complained of, is considered, prima facie, it appears that the Defendant's invoices bearing the name CHEMCO were raised since the year 1999. The Defendant has placed on record the financial statements commencing from the years 1998-99. There was a time lag of hardly one year in the first user of CHEMCO by the Plaintiff and Defendant in their individual names.

100. The material on record, prima facie, does not indicate that by the time, the Defendant commenced the use of CHEMCO i.e. 1999, the Plaintiff had established a formidable goodwill and reputation. Thus, the existence of goodwill and reputation as of the relevant date i.e. commencement of the offending act so as to taint the user by the Defendant, with a view to ride on the reputation and goodwill of the Plaintiff cannot be said to have been made out. The fact that

subsequently the Plaintiff succeeded in establishing a more formidable business and reputation than the Defendant, does not seem to be decisive as at the commencement of the user by the Defendant *prima facie* there was no element of misrepresentation.

ACQUIESCENCE:

101. Acquiescence on the part of the Plaintiff was sought to be demonstrated with reference to parallel online presence of the Plaintiff and Defendant since the year 2006; the Plaintiff and Defendant being the members of the same trade association, i.e., All Indian Plastic Manufactures Association, since the year 2011-2012, and direct interactions between the Senior Officers of the Plaintiff and Defendant. The exchange of correspondence would indicate positive actions on the part of the Plaintiff to draw an inference of clear acquiescence. Therefore, the Plaintiff who has allowed the Defendant to build up a formidable business is not entitled to seek equitable relief, was the thrust of the submission of Mr. Khandekar.

102. Acquiescence is one of the defences available to the Respondent in an action for infringement of a trade mark. In the case of **Power Control Appliances (Supra)**, the Supreme Court elucidated as to what constitutes acquiescence. The observations in paragraphs 26 and 27 read as under:

“26. Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a

course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name etc. It implies positive acts; not merely silence or inaction such as is involved in laches. In **Harcourt Vs White (1860) 28 Beav 303** Sr. John Romilly said: "It is important to distinguish mere negligence and acquiescence." Therefore, acquiescence is one facet of delay. If the plaintiff stood by knowingly and let the defendants build up an important trade until it had become necessary to crush it, then the plaintiffs would be stopped by their acquiescence. If the acquiescence in the infringement amounts to consent, it will be a complete defence as was laid down in **Mouson (J. G.) & Co. Vs. Boehm (1884) 26 Ch D 406**. The acquiescence must be such as to lead to the inference of a licence sufficient to create a new right in the defendant as was laid down in **Rodgers Vs Nowill (1847) 2 DE GM&G 614**.

27. The law of acquiescence is stated by Cotton, L.J. in **Pro tor Vs Bannis (1887) 36 Ch D 740** as under:

"It is necessary that the person who alleges this lying by should have been acting in ignorance of the title of the other man, and that the other man should have known that ignorance and not mentioned his own title." In the same case Bowen, L.J. said:

"In order to make out such acquiescence it is necessary to establish that the plaintiff stood by and knowingly allowed the defendants to proceed and to expend money in ignorance of the fact that he had rights and means to assert such rights."

(emphasis supplied)

103. In **Amritdhara Pharmacy (Supra)**, the Supreme Court, in the facts of the said case found that the plea of acquiescence was established. The observations in paragraph 14 reads as under:

“14. We now go the second question, that of acquiescence. Here again we are in agreement with the Registrar of Trade Marks, who in a paragraph of his order quoted earlier in this judgment has summarised the facts and circumstances on which the plea of acquiescence was based. The matter has been put thus in Halsbury's Laws of England, Vol. 32 (second edition) pages 659-657, paragraph 966.

“ If a trader allows another person who is acting in good faith to build up a reputation under a trade name or mark to which he has rights, he may lose his right to complain, and may even be debarred from himself using such name or mark. But even long user by another, if fraudulent, does not affect the plaintiff's right to a final injunction; on the other hand prompt warning or action before the defendant has built up any good- will may materially assist the plaintiff 's case”.

We do not think that there was any fraudulent user by the respondent of his trade name 'Lakshmandhara'. The name was first used in 1923 in a small way in Uttar Pradesh. Later it was more extensively used and in the same journals the two trade marks were published. The finding of the Registrar is that the appellant and its agent were well aware of the advertisements of the

respondent, and the appellant stood by and allowed the respondent to develop his business till it grew from a small beginning in 1923 to an annual turnover of Rs. 43,000/- in 1949. These circumstances establish the plea of acquiescence and bring the case within sub-s. (2) of S 10, and in view of the admission made on behalf of the respondent 'that his goods were sold mainly in Uttar Pradesh, the Registrar was right in imposing the limitation which he imposed.

(emphasis supplied)

104. Dr Tulzapurkar would urge the plea of delay and acquiescence is not at all sustainable. Mere delay in itself is of no significance. A party who infringes the rights of another, dishonestly is not entitled to raise the plea of acquiescence. To buttress the submission that, where the adoption of the mark is not honest the defence of delay and acquiescence loses significance, strong reliance was placed on the judgment in the case of **Bal Pharma (Supra)**, wherein a Division Bench of this Court, after following the judgment in the case of **Power Control Appliances (Supra)** and the Appellate Court in England in the case of **Electrolux LD V Electrix** enunciated that there is no hard and fast rule that delay *per se* would defeat an Application for interlocutory injunction. In a situation where the Defendant to an action has been using the mark, even if concurrently without making himself aware of the fact as to whether the same mark is subject matter of the registration and belongs to another person, the first person cannot be

heard to complain that he has been using it negligently in as much as, he has not taken elementary precaution of making himself aware by looking at the public record of Register as to whether the mark in question is the property of another.

105. In **Cadila Health Care Ltd (Supra)** a Division Bench of this Court referred to a judgment of a learned Single Judge of Delhi High Court in **Hindustan Pencils Private Limited Vs India Stationery Products Co,**⁴⁵ wherein it was observed that where there is an honest concurrent user by the Defendant then inordinate delay or laches may defeat the claim of damages or rendition of accounts but the relief of injunction should not be refused. Thus the interest of the general public, which is third party in such cases which has to be kept in mind.

106. In the instant case, the prime question that wrenches to the fore is, whether the concurrent user of “CHEMCO” by the Defendant can be said to be dishonest. The material on record would *prima facie* indicate that there is a chain of entities which had been using, “CHEMCO” culminating in user by the Defendant. Even the user of, “CHEMCO” by Plaintiff and Defendant, in their individual capacities, commenced in the year 1998 and 1999, respectively. Both the parties claim a right of prior user on the basis of user of “CHEMCO” by their predecessors-in-interest. The concurrent user by the Defendant has continued for over 15 years before the mark, “CHEMCO” came to be

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registered in the name of the Plaintiff. Thus, in the considered view of this Court, at this interim stage, the user of “CHEMCO” by the Defendant cannot be termed as dishonest.

107. Whether the factors like, online presence of the Defendant in proximity with the Plaintiff, both the Plaintiff and the Defendant being the members of the same Association and that the officers of the Plaintiff and the Defendant have had exchange of correspondence, constitute positive acts of acquiescence may warrant adjudication at the trial. At the same time, there is material to indicate that since the year 2015, the Plaintiff took efforts to secure its intellectual property. A cease and desist notice was issued to the Defendant. Criminal complaints were filed with the police seeking action for infringement of the trade mark. Certainly, these actions on the part of the Plaintiff cannot be termed as positive acts of acquiescence. Thus, whether the Plaintiff stood by and allowed the Defendant to build up a formidable business appears to be debatable.

108. Nonetheless, the material on record does indicate that there were multiple opportunities for the Plaintiff to become aware of the presence of the Defendant in the market as a competing manufacturer of the goods in which the Plaintiff has been dealing. The trail of purported user treacable to the predecessor-in-interest of the Defendant *prima facie* shows that the user was neither dishonest nor

negligent. Even if the claim of prior user is kept aside, the use of “CHEMCO” by the Defendant, in its individual capacity, is traceable to the year 1999. *Prima facie* it does not appear that the user of “CHEMCO” was either clandestine or dishonest.

EQUITY AND BALANCE OF CONVENIENCE:

109. At this juncture, the element of balance of convenience and equity comes into play. Should the Court grant the injunctive reliefs in a situation where the concurrent user competes in probability, with a claim of prior user which is also for the comparable period, arises for consideration.

110. In the case of **Hubbard And Anr (Supra)**, the Court of Appeal, postulated that, in considering whether to grant an interlocutory injunction, the right course for a Judge is to look at the whole case. He must have regard not only to the strength of the claim but also to the strength of the defence, and then decide what is best to be done. Sometimes, it is best to grant an injunction so as to maintain the status quo until the trial. At other times, it is best not to impose a restraint upon the Defendant but leave him free to go ahead.

111. In the case of **Uniply Industries Ltd (Supra)** in an action for passing off, the Supreme Court observed that, in a case where the serious questions are required to be determined, those questions should be thrashed out at the trial.

112. In the case of **Yonex Kabushiki Kaisha (Supra)**, a learned Single Judge of the Delhi High Court, after noting the facts of the case observed that, *inter alia*, there was delay in approaching the Court and a number of years had passed since the Defendant therein had established business with significant sales and there was a serious dispute as to who was the prior user of the mark in India, and, thus, following the observations of Lord Denning in **Hubbard And Anr (Supra)**, declined to grant interim order in favour of the Plaintiff therein. The learned Judge observed, each individual factor, by itself, may not have been sufficient but it was the combined effect thereof and by taking a holistic view in so far as the aspect of injunction was concerned, the case did not warrant grant of injunction.

113. Dr. Tulzapurkar would submit that, balance of convenience plays a part in cases of infringement of the trade mark only in unusual circumstances. It was submitted, though the balance of convenience is a relevant factor, yet, where a clear case of infringement is made out the Plaintiff would continue to suffer grave and irreparable loss if the element of balance of convenience is placed on a higher pedestal.

114. Reliance was placed on a Division Bench judgment of this court in the case of **Express Bottlers Services Pvt Ltd (Supra)** wherein it was enunciated that it is only in unusual circumstances that the balance of convenience should play a part in a matter where the Plaintiff is the

owner of a registered trade mark. Reliance was also placed on the observations of a learned Single Judge in case of **Dr Ashok M. Bhat (Supra)**.

115. On a careful analysis of the factual context, this Court finds that the period of user of “CHEMCO” by the Defendant, in its individual capacity, is almost parallel to its user by the Plaintiff. Secondly, the commencement of user of “CHEMCO” by the Plaintiff and the Defendant before the cease and desist notice was issued by the Plaintiff was for almost 18 years. Thirdly, the first trade mark came to be registered in the name of the Plaintiff in the year 2014. Fourthly, the prior user through the predecessor-in-interest by both the Plaintiff and the Defendant is for a comparable period of almost 20 years, before the individual user. Fifthly, it does not appear that the Defendant had resorted to the user of “CHEMCO” dishonestly. Sixthly, the user of “CHEMCO” by the Defendant, in its individual capacity, as of now, has been for almost 25 years. Lastly, *prima facie*, there is material to show that there were multiple occasions for the Plaintiff to become aware of the existence of the Defendant as a competing trader and use of “CHEMCO” by the Defendant.

116. In my view, the aforesaid factors, cumulatively render balance of convenience to have a significant role. Admittedly, there are serious questions of facts as regards the prior user, which warrant

adjudication at the trial. The time lag also assumes significance. Thus, a blanket order of injunction may not be justifiable, as it would cause irreparable loss to the Defendant.

117. In my view, a distinction is required to be drawn between the user of “CHEMCO” and “CHEMCO PLAST” as a trade mark (word or device) and use of “CHEMCO” as a part of trade/business name and domain name. In the light of the presence of the Defendant in the market with the trade name “CHEMCO” for almost 25 years, grant of injunction from using “CHEMCO” as a trade name/business name or part of the domain name may not be justifiable. Conversely, as discussed above, there is *prima facie* material to show that the Defendant invaded, attempted to invade and threatened to invade the registered trade mark of the Plaintiff and, thereby, committed breach of its obligation qua the Plaintiff. Moreover, since it is the case of the Defendant that it has never used “CHEMCO” as a mark, injunction can be granted to restrain the Defendant from using “CHEMCO” and “CHEMCO PLAST” as a mark in relation to its goods and service.

118. Since, for the reasons recorded under the caption “Passing off”, the action for passing off was *prima faice* found unsustainable, no interim relief in that regard can be granted.

119. Resultantly, the Application deserves to be partly allowed.

120. Hence, the following order:

: O R D E R :

- (i) The Interim Application stands partly allowed.
- (ii) Pending hearing and final disposal of the Suit the Defendant by itself, its partners, servants and agents, dealers, distributors and all persons acting for and on its behalf are restrained from infringing all or any of the Applicant's Mark CHEMCO registered under Nos. 4487323 in Class 11, 4696915 in Class 16, 4487326 in Class 20, 2275010 in Class 21 and 4487327 in Class 22 by use of the impugned mark CHEMCO, and/or CHEMCO PLAST or any other trade mark which is identical with and/or deceptively similar to the Applicant's registered Mark CHEMCO in respect of the impugned goods including plastic bottles, caps for plastic bottles and other plastic packing materials and/or same or similar goods or services or in any other manner whatsoever.
- (iii) Rest of the prayers in the Application stand rejected.

Costs in cause.

[N. J. JAMADAR, J.]

At this stage, Mr. Khandekar, the learned Counsel for the Defendant, seeks stay to the execution and operation of the order.

Ms. Pratik Pawar, the learned Counsel for the Plaintiff, resisted the prayer for stay.

In the light of the view this Court has taken in this order, the execution and operation of this order is stayed for a period of six weeks.

[N. J. JAMADAR, J.]