

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION NO. 1149 OF 2024
IN
INTERIM APPLICATION NO. 142 OF 2024
IN
COMMERCIAL IP SUIT NO. 334 OF 2023

M. S. Industries & Ors. ... Applicants

In the matter between :

BTALI International through its sole proprietor
Murtuza Bhopalwala ... Plaintiff

Versus

M.S. Industries & Ors. ... Respondents

WITH
COMMERCIAL IP SUIT NO. 334 OF 2023
WITH
INTERIM APPLICATION NO. 142 OF 2024
WITH
COURT RECEIVER REPORT NO. 214 OF 2023
WITH
LEAVE PETITION (L) NO. 12601 OF 2023
IN
COMMERCIAL IP SUIT NO. 334 OF 2023

Mr. Hiren Kamod a/w Mr. Anees Patel and Ms. Prasanna Pawar
i/by Shamim & Co. for the Plaintiff.

Mr. Anjani K. Singh a/w Vatsal Verma and A. D. Siddiqui i/by D.
S. Mishra for Defendant Nos.1 to 5 and for the Applicant in
IA/1149/2024.

Ms. Charushila Vaidya, 2nd Assistant to Court Receiver.

CORAM: MANISH PITALE, J.
DATE : 20th FEBRUARY 2025

P.C. :

- . Heard learned counsel for the parties.
2. By this application, the applicants/defendant Nos.1 to 5 (hereinafter referred to as “defendants”) are praying for a direction to the Court Receiver to release the air compressors lying in the impugned packaging/corrugated boxes, so that the air compressors can be released to the defendants. It is further prayed that even if the impugned packaging/corrugated boxes remain in the custody of the Court Receiver, the air compressors so released in favour of the defendants may be permitted to be sold in packaging/corrugated boxes that are differently designed.
3. On the last occasion, this Court had called upon the plaintiff to respond to the said prayer made in the present application. Reply affidavit has been filed on behalf of the plaintiff opposing the prayers. An objection is raised that such prayers are not maintainable under an application filed under Order XXXIX Rule 4 of the Civil Procedure Code, 1908 (CPC).
4. Apart from raising an objection as to the maintainability of the application under the said provision, it is further submitted on behalf of the plaintiff that as per the statutory scheme under the Trade Marks Act, 1999, particularly Sections 101 to 104 thereof, this Court needs to appreciate that applying the impugned trade mark to the packaging/corrugated boxes, containing the impugned goods, would amount to applying such impugned trade mark to

the impugned goods themselves. Attention of this Court is further invited to the contents of the plaint, where a comparison table of the impugned rival products has been given, on the basis of which, this Court passed the *ex-parte* ad-interim order dated 4th May 2023. It is submitted that, if at all, the defendants were to approach the plaintiff for settlement of the dispute and in that process, it was agreed between the parties that the impugned goods can be sold in a different packaging, it would be a different matter. But, the prayers made in the present application ought not to be granted.

5. On the other hand, the learned counsel appearing for the defendants submits that this Court was misled when the *ex-parte* ad-interim order was passed on 4th May 2023, for the reason that the registration of the trade mark BTALI of the plaintiff is not for the purpose of manufacturing and sale of such goods. It was further submitted that the impugned packaging and the corrugated boxes with the impugned design were received by the defendants from the exporter located in China and therefore, there is no question of any infringement of the copyrights much less registered trade mark of the plaintiff. It is submitted that the trade marks used by the defendants being RUTH, THOR and RIT, are completely different from the registered trade mark BTALI of the plaintiff and therefore, there is no question of infringement of the trade mark. As regards copyrights, it is submitted that the pleadings in the plaint are deficient in that regard and therefore,

this Court may consider modifying the ad-interim order as per prayers made in the present application.

6. The learned counsel for the defendants also sought to rely on the written statement to contend that as regards certain accessory products being found bearing the trade mark BTALI, the same has been explained sufficiently by the defendants on the basis that such accessories were actually bought from an authorized dealer of the plaintiff itself and hence, there is no question of any infringement on the part of the defendants.

7. It is to be noted that the prayers made in the present application are on the basis that the entire grievance of the plaintiff is limited to the use of the artistic work on the packaging/corrugated boxes, within which the impugned products of the defendants were found.

8. An attempt is sought to be made to segregate the packaging/corrugated boxes from the impugned products/goods in order to pursue the aforesaid prayers. This Court has considered the said contentions raised on behalf of the defendants in the backdrop of Sections 101 to 104 of the Trade Marks Act. A perusal of the said statutory provisions indicates that when a deceptively similar mark is used on a packaging, within which goods are contained, the allegation pertaining to infringement of the trade mark is not only limited to the trade marks being found on such packaging, but on the impugned goods contained in such packaging also. There is a strong *prima facie* case made out by the plaintiff in its favour to

claim that a proper interpretation of the aforesaid provisions of the Trade Marks Act would show that the defendants herein, despite their dishonest conduct, cannot claim that the impugned products/goods contained inside the packaging/corrugated boxes, can be segregated and permission can be granted for sale of such impugned goods, while the packaging/corrugated boxes can be retained with the Court Receiver for evidence and for purposes of trial.

9. In this regard, the learned counsel for the plaintiff is justified in relying upon an order dated 20th June 2022 passed in Interim Application (Lodging) No. 28994 of 2021 in Commercial IP Suit No. 47 of 2021 (*Khushi Impex v/s. Neha Overseas*), wherein the defendant i.e. Khushi Impex was the applicant. A similar relief was sought, but the application was dismissed by this Court by the aforesaid order, taking note of the effect of Sections 101 to 103 of the Trade Marks Act. This Court agrees with the approach adopted in the said order dated 20th June 2022 passed in the said application.

10. Apart from this, a perusal of the *ex-parte* ad-interim order dated 4th May 2023 would show that this Court in paragraph 3 of the order, specifically recorded that apart from the plaintiff claiming to be in business of manufacturer and sale of industrial equipment and machine products, was also engaged in importing, marketing, distribution and trading of industrial equipment and machinery products, particularly air compressors with which the

defendants in the present case are concerned. In paragraph 4 of the order, this Court specifically noted that the pleadings in the plaint with regard to the subsisting copyright claimed by the plaintiff in the original artistic work associated with the registered trade mark of the plaintiff and a reference was also made to a letter addressed by the designing agency to the plaintiff in respect of the original artistic work.

11. A perusal of the comparison table reproduced in the *ex-parte* ad-interim order dated 4th May 2023 also shows that the same reveal, not only the fact that leading and essential features of the original artistic work, in which the plaintiff holds subsisting copyright, were seen to have been copied, but the presentation of the products itself demonstrated an attempt made on the part of the defendants to come as close as possible to the packaging, as well as the impugned products/goods of the plaintiff.

12. In the face of such findings and the statutory scheme noted hereinabove, as also the mandate of Section 29(6) of the Trade Marks Act, which indicates that a registered trade mark is said to be used, if it is affixed on the goods or packaging thereof, this Court is satisfied that the plaintiff in the present case is justified in resisting the prayers made on behalf of the defendants in the present application. There is substance in the contention raised on behalf of the plaintiff in this regard by relying upon Section 66 of the Copyright Act, 1957. Allowing such an application in the facts of the present case, would amount to placing a premium on the

dishonest conduct of the defendants, as noted in the *ex-parte* ad-interim order dated 4th May 2023.

13. It would be appropriate for the defendants to contest the application filed under Order XXXIX Rules 1 and 2 of the CPC by the plaintiff, to demonstrate that the findings rendered in the order dated 4th May 2023 could be varied or set aside, but the prayers made in the present application cannot be granted.

14. In view of the above, Interim Application No.1149 of 2024 is dismissed.

15. It is made clear that the observations made in this order, will not come in the way of the defendants in contesting Interim Application (Lodging) No. 12616 of 2023 (Interim Application No. 142 of 2024), on the merits of the matter.

16. Statement made on behalf of the defendants was recorded that the written statement filed in the suit be treated as reply to the Interim Application No. 142 of 2024. Rejoinder affidavit, if any, be filed by the applicant/plaintiff within three weeks from today.

17. List Interim Application No. 142 of 2024 for further consideration on 24th March 2025 (High on Board).

18. Needless to say, the ad-interim order shall continue to operate until further orders.

MANISH PITALE, J.