
(2018) 01 BOM CK 0025
In the Bombay High Court
Case No : 94 of 2017

Ansari Bilal Ahmadlal Mohd.

APPELLANT

Vs

Shafeeque Ahmed Mohammed Sayeed

RESPONDENT

Date of Decision : 12-01-2018

Acts Referred:

Trade Marks Act, 1999 — Section 35, Section 30(2), Section 2(zd)

Citation : (2018) 01 BOM CK 0025

Hon'ble Judges : Naresh H. Patil, R.G. Ketkar

Bench : Single Bench

Advocate : M.A. Khan, Alankar Kirpekar, Jaya Manghwani, Shekhar Bhagat

Final Decision : Dismissed

Judgement

1. Admit. Heard finally by consent of parties.

2. This appeal is directed against the order passed by the learned Single Judge of this Court (Coram: G.S. Patel, J) in Notice of Motion (L) No. 2311 of 2016 in Suit (L) No.810 of 2016 dated 26th October, 2016. The appellant is original defendant. The respondent-plaintiff filed Suit in the Ordinary Original Civil Jurisdiction of this Court invoking the provisions of Trade Marks Act, 1999 praying for various reliefs as described in the Suit. Pending hearing of the Suit a Notice of Motion was filed by the plaintiff for interim reliefs which are incorporated in impugned order in paragraph 26 by the learned Single Judge. The defendant filed reply to the said Notice of Motion. The learned Single Judge granted prayer clauses (a), (b),(c) and (d) of the

Notice of Motion.

3. The plaintiff filed a Suit for infringement of registered trade marks being a label mark of "SUKOON OIL" bearing registration no.1421905 in class 03 and also 1377947 in class 05. The Suit was filed for infringement of copyright in "SUKOON" label.

4. The plaintiff stated that in the year 1993 his father Mohammad Sayeed Gulam Husaain Attarwale independently created a distinctive label i.e. "SUKOON OIL" and "NAGEENA SUKOON OIL". The plaintiff's father started using the label since the year 1993 and manufacturing and marketing "SUKOON OIL" used as a pain relieving massage oil under the said distinctively designed label and mark. The said business was carried out by the plaintiff's father in the name and style of M/s. Nageena Ayurvedic Pharmacy. The plaintiff's father manufactured products under the style "NAGEENA SUKOON OIL".

5. It is the plaintiff's case that on 12 th February, 1994 plaintiff's father applied for trade mark registration of "SUKOON" label. The plaintiff's father expired on 4th June, 2000. The plaintiff's pharmacy has been manufacturing labels, photocopies of which were produced on record alongwith invoices raised by M/s. Super Arts. The plaintiff applied for registration of trade mark "SUKOON" label in class 05 on 17th August, 2005. The said application was numbered as 1377947. The application was accepted and advertised with condition that registration of this trade mark shall give no right to the exclusive use of device of lungs and word OIL and letters N, A and P. It is plaintiff's case that said trade mark was registered in class 05 after completion of entire procedure. The plaintiff has also applied for word mark "SUKOON" separately in class 05 and the said application is pending registration. The plaintiff states that he is registered proprietor of word mark "NAGEENA" by virtue of registration

No.1838403 in class 03.

6. The plaintiff further stated that in the month of July 2016 it came to the plaintiff's knowledge that product under the mark "SUKOON" is sold by one JBM Herbal Pharmacy in Mumbai.

Plaintiff made research in this regard and found that defendant had also made an application for registration of "HEENA SUKOON OIL" device mark claiming user since 1st June, 2012. The plaintiff's enquiry revealed that defendant was engaged in the manufacturing, marketing and selling a similar Ayurvedic/Unani medicine under the Trade Mark "SUKOON" and also under the deceptively similar label bearing the word "HEENA" written and depicted in similar manner to the word "NAGEENA", plaintiff's label.

7. The plaintiff states that by manufacturing, selling and/or offering for sale the impugned product, the defendant is violating plaintiff's valuable, intellectual and intangible proprietary rights contained in the registered trade mark "SUKOON" label and/or its essential ingredients i.e. word "SUKOON". It is stated that defendant has deliberately adopted the impugned trade mark with malafide intention of passing off their product as and for that of the plaintiff. The plaintiff placed on record necessary certificates issued by the trade mark authorities, invoices, photocopies of labels, examination report and affidavits in support of the contentions.

8. The defendant filed reply to the Notice of Motion. According to defendant the calligraphy used by defendant company is of different style compared to that of plaintiff's label which is described in Paragraph-3 by the defendant as under:

(i) As Plaintiff label display lungs and whereas label of Defendant display full skeleton.

(ii) Representation is different.

(iii) Plaintiff label is totally different than that of Defendant,

(iv) in no manner both the bottles i.e. bottle of Plaintiff and Defendant is likely create confusion,

(v) the word "SUKOON" reflects the nature of the product,

(vi) The word "SUKOON" is written in one the bottle of the Defendant is different in fonts, colour and style as compare to

written on the bottle of the plaintiff.

9. According to defendant-appellant herein, there was no confusion or deception since the product of plaintiff and defendant have different looks. These products are mainly used by mill and or textile loom workers. The essential features of the label marks is the word mark and not the colour combination. Since the two trade marks are entirely different, the plaintiff cannot seek protection on the ground of usage of the word "SUKOON" as the same is not even registered at the behest of the plaintiff. It is submitted that word "SUKOON" on the product is being used in the descriptive sense and not as a trademark. The claim of the plaintiff with regard to the colour combination and get up of the label being original artistic work is absolutely false. Defendant referred to provisions of Section 2(zd) and Section 30(2) of the Trade Marks Act, 1999. On the claim of passing off, defendants submits that since the expression used by the defendants is bonafide expression of character and quality of its own goods, the use of the said expression by the defendant is protected under Section 35 of the Trade Marks Act, 1999 and according to the defendant the plaintiff has failed to make out a prima-facie case of passing off. The defendant submitted that plaintiff failed to establish that the trade label in question is a deceptively similar to the plaintiff's label. The word "SUKOON" is used by defendant in association with "HEENA" which is distinctive in nature. The word "HEENA" is used by the defendant since the year 2012. The word "SUKOON" is common to trade for massage oil as many parties are using the same or a similar mark for massage oil.

It is submitted that registration of label mark titled "SUKOON OIL" under class 3 has a disclaimer on the other registrations of the marks and labels in respect of usage of device of Lungs and word OIL and letters N, A and P which is imposed by the Registrar of Trademarks. In this sense it was denied that "SUKOON" trademark has become distinctive with the ayurvedic preparation of plaintiff and is exclusively associated with the plaintiff.

10. Learned Counsel appearing for the appellant-defendant submitted that there is an error on the part of the learned Single Judge in allowing the Notice of Motion. The defendant has suffered a grave loss and injury due to restrictive orders passed by the learned Single Judge of this Court which has affected his business. Learned Counsel submitted that there is nothing distinctive in the label mark of the plaintiff. The registration of the plaintiff is a device mark. Colour combination of plaintiff's label and defendant's label are entirely different. The design and description of the words are entirely different and dissimilar, therefore, there is no question of defendant carrying his trade transaction with the product "HEENA SUKOON OIL" with a deceptively similar label as of the plaintiff which is sold in the market as "NAGEENA SUKOON OIL". Learned Counsel has referred to the certificate issued by the Trademark authorities, the photocopies of labels, applications made by the plaintiff and defendant for getting marks registered.

11. The learned Counsel appearing for respondents submitted that the appellant-defendant is applying wrong test in trying to establish that there is no deceptive similarity. The label of the plaintiff is an essential prominent feature which is "SUKOON". The plaintiff has applied separately for registration of word "SUKOON". The appellant is using this mark since the year 1993. Counsel submitted that the learned Single Judge has gone through the entire record and after

taking into consideration the material placed on record and submissions advanced has reached conclusions which do not call for interference by this Court. By placing reliance on the case of Wander Ltd. & anr. v/s. Antox India P. Ltd., 1990 (Supp) Supreme Court Cases 727. the learned Counsel

submits that Appellate Court will not reassess the material and seek to reach a conclusions different from the one reached by the Court below solely on the ground that if it had considered the material at the trial stage it would have come to a contrary conclusion. It is submitted that the learned Single Judge has exercised its discretion in a judicious manner and appellant has failed to establish that the interlocutory order granted by the learned Single Judge was contrary to the established principles.

12. We have perused the record placed before us, impugned order, judgments cited and considered the submissions advanced. We have also seen the original sample bottles of the NAGEENA SUKOON OIL and HEENA SUKOON OIL. The learned Single Judge observed that alongwith plaint, statement of year-wise purchases and sales from the year 2002-2003 to 2014-2015 was annexed by the plaintiff. The sale of the product had risen considerably from Rs.29,208/- in 2002-2003 to the extent of Rs. 1.52 Crores in the year 2014-2015. The learned Single Judge had even described in detail the discrepancies in labels of both the parties. Prima-facie case was noticed on the material placed on record, by the learned Single Judge.

13. It is the defendant's contention that SUKOON word cannot be used by the plaintiff in distinctive sense as everybody uses the word "SUKOON" not in a distinctive sense but in a common generic sense of the word. Therefore, plaintiff cannot claim exclusivity of the word "SUKOON". Taking into consideration the record placed before us, the registration obtained by the plaintiff and the label marks, we find

that the plaintiff has prima-facie established that the defendant has been using the label marks used by the plaintiff of his product "HEENA SUKOON OIL" which is deceptively similar to the plaintiff's product known and styled as "NAGEENA SUKOON OIL". The plaintiff has placed on record convincing material to show that they have been dealing with this product since the year 1993. The device label marks are printed at the behest of the plaintiff. Trade marks registrations are obtained, certificate of which is produced on record. The defendant has also applied for the registration of trade mark recently in the year 2013. According to defendant, word "HEENA" is used by the defendant since the year 2012. It is also noticed that rise in sale of plaintiff's product gives a reasonable cause to the plaintiff to raise claim of infringement of a trade mark and passing off against the defendant. On the principle of interference in the discretionary orders passed by the trial Court and test applied for in case of passing off and infringement of the trade mark, the learned Counsel appearing for the respondent-plaintiff has placed reliance on following case laws:

- i) Mr. Laxmikant V. Patel v/s. Chetanbhai Shah & anr., (2002) 3 SCC 65
- ii) Siddhant Ice Creams Pvt. Ltd. & ors. v/s. Tanco Enterprises & ors., Notice of Motion 1148/11 in Suit 820/11
- iii) Alaknanda Cement Private Limited v. Ultratech Cement Limited, 2011 SCC OnLine Bom 1487
- iv) Automatic Electric Limited v/s R.K. Dhawan & anr., 1999 SCC OnLine Del 27
- v) Wander Ltd. & anr. v/s. Antox India P. Ltd. (cited supra)
- vi) Corn Products Refining Co. v/s. Shangrila Foodo Products Ltd., (1960) 1 SCR 968
- vii) Indian Hotels Company Ltd. & anr. v/s. Jiva Institute of Vedic Science & Culture, 2008(37) PTC 468 Delhi
- viii) Pidilite Industries Limited v/s. Jubilant Agri & Consumer Products Limited, 2014(57) PTC 617 {Bom}

14. In the case of Wander Ltd. (cited supra), the observations are based on principles in respect of interference by the Appellate Court in discretionary orders passed by the trial Court. The relevant portion of Paragraph 14 in the said judgment is reproduced as under:

"14. The appeals before the Division Bench were against the exercise of discretion by the Single Judge. In such appeals, the appellate court will not interfere with the exercise of discretion of the Court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion.....".

15. In the case of Laxmikant V. Patel (cited supra), the Apex Court observed in Paragraph 8 as under:

"8. It is common in trade and business for a trader or a

business man to adopt a name and/or mark under which he would carry on his trade or business. According to Kerly (Law of Trade Marks and Trade Names, 12 th Edn., para 16,49), the name under which a business trades will almost always be a trade mark (or if the business provides services, a service mark, or both). Independently of questions of trade or service mark, however, the name of a business (a trading business or any other) will normally have attached to it a goodwill that the courts will protect. An action for passing-off will then lie wherever the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff, or to occasion a confusion between the two businesses. If this is not made out there is no case. The ground is not to be limited to the date of the proceedings, the Court will have regard to the way in which the business may be carried on in the future, and to its not being carried on precisely as carried on at the date of the proceedings. Where there is probability of confusion in business, an injunction will be granted even though the defendants adopted the name innocently."

16. In the case of Alaknanda Cement (cited supra) the Division Bench of this Court referred to Paragraph 28 of the judgment in the case of Kaviraj Pandit Durga Dutt Sharma v/s. Navaratna Pharmaceutical Laboratories {AIR 1965 Supreme Court 980} in which the Supreme Court has observed that:

"28. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which

he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that or the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

17. During the course of hearing it was submitted that majority of consumers of these products are labourers from Bhiwandi area. The test to be applied in the case is of a person of average intelligence and imperfect recollection. The device, label mark has to be seen in its entirety and after taking into consideration the facts of the case, a decision has to be arrived at as to whether the mark of the defendant is deceptively similar to the plaintiff's one.

18. From the record placed before us and conclusion drawn by the learned Single Judge and after considering the submissions advanced, we are convinced that a strong prima-facie case of passing off has been made out by the plaintiff. We do not notice any arbitrariness in the view adopted by the learned Single Judge. The issues have been dealt with by the learned Single Judge in a reasonable and judicious manner. In exercise of our appellate jurisdiction, we do not find that appellant-defendant has made out a case for interference. There is no merit in the appeal. The Appeal stands dismissed.