

(2013) 05 BOM CK 0004

In the Bombay High Court

Case No : Notice of Motion (Lodg.) No. 1025 of 2013 and Suit (L) No. 400 of 2013

Haw Par Corporation Limited and Others

APPELLANT

Vs

Baidyaraj Ayurvedic Bhavan

RESPONDENT

Date of Decision : 07-05-2013

Acts Referred:

Citation : (2014) 57 PTC 390

Hon'ble Judges : S.J. Kathawalla, J

Bench : Single Bench

Judgement

S.J. Kathawalla, J.—This Application for ad-interim reliefs has been moved ex-parte in an action for infringement of registered trade marks and for passing off. The impugned product is sold outside the territorial jurisdiction of this Court and therefore leave under clause XIV of the Letters Patent Act is required before the claim in respect of passing off can be adjudicated upon. Therefore presently, reliefs in respect of passing off are not pressed for. Plaintiff No. 1 is a Company organized and existing under the Laws of Singapore, carrying on business inter alia, as manufacturers and dealers of medicinal products internationally known as "Tiger/Tiger Balm".

2. The Plaintiff No. 2 is a company organized and existing under the laws of Singapore and is a wholly owned subsidiary of Plaintiff No. 1. Plaintiff No. 2 is a Licensee of Plaintiffs No. 1 in respect of various medicinal products sold under the trade mark TIGER and device of Tiger throughout the world except Austria, West Germany, Switzerland and in Italy.

3. The Plaintiff No. 3 is a company incorporated under the Companies Act, 1956 in India and is entirely owned by Plaintiff No. 1 (except one share) and has been authorized by Plaintiff No. 2 to get said goods manufactured and/or distribute and/or market in India.

4. It is the Plaintiffs case that the Plaintiffs' predecessors adopted a mark inter

alia containing the word TIGER and device of a TIGER in the year 1890 for medicinal preparations and have been manufacturing and selling its medicinal products bearing the said mark since the year 1900. The history and adoption of the said marks is set out in paragraph 6 of the Plaint.

5. Plaintiff No. 1 is the registered proprietor of the marks/labels inter alia containing the word TIGER and device of the TIGER around the world including India. Plaintiff No. 1 is the registered proprietor of the marks/labels inter alia containing the word Tiger and device of Tiger in India under the Trade Mark Nos. 763605 and 763606 in class 5 inter alia in respect of medicinal, herbal and pharmaceutical preparations and substances including balm and oil being Exhibits-B1 and B2 to the Plaint. The essential feature of the said marks/labels is the word "TIGER" and the device of a "Leaping Tiger". Various products manufactured and sold by Plaintiffs in India are at Exhibits-A1, A2 and F to the Plaint. The sales figures from 2007-12 for the Plaintiffs' products in India and the sales figures for the Plaintiffs' products worldwide from 1989-2012 are set out at Exhibits C and D respectively.

6. The Defendant is a firm engaged in the manufacturing and selling of medicinal products including balm bearing the impugned trade mark TIGER/TIGER BALM and the device of Tiger being Exhibit-I (Colly.) to the Plaint.

7. Learned Counsel for Plaintiffs submits that the mark/label used by the Defendant is identical and/or deceptively similar to Plaintiff No. 1's registered mark inter alia containing the word TIGER and device of a TIGER bearing Exhibits-B1 and B2 to the Plaint. It is submitted that the Defendant's product is nothing but a counterfeit and the Defendant has used the impugned mark on the impugned product only in an attempt to ride on and/or cash in on the tremendous goodwill and reputation of the Plaintiffs marks. It is further submitted that the Plaintiffs apprehend that if the Defendant is given notice of the present Application, there is a strong likelihood that the Defendant would dump the existing stock of the impugned products into the market and/or part with possession and/or custody thereof to some other person. He submits that therefore in the present case, it has become necessary to seek an ad-interim order without notice in view of the brazen conduct of the Defendant in attempting to infringe upon the proprietary rights of the Plaintiff No. 1.

8. Learned Counsel for the Plaintiffs has also tendered a compilation of Orders of this Hon'ble Court where the Plaintiffs have secured orders against various parties in respect of its marks. It is submitted that the Plaintiffs have always remained, and are, extremely vigilant in respect of protecting its statutory as well as common law rights in respect of the said marks.

9. Insofar as the question of territorial jurisdiction of this Court is concerned, learned Counsel for the Plaintiffs submits that Plaintiff No. 3 is a subsidiary of Plaintiff No. 1 through whom the Plaintiff No. 1 operates, manufactures and sells its said goods in India. Plaintiff No. 3 has a place of business in Mumbai and is

carrying on business for gain in Mumbai. Invoices at Exhibit E (Colly.) to the Plaintiff also reflect that they are drawn in the name of Plaintiff No. 3. It is submitted that as such Plaintiff No. 1 carries on business through Plaintiff No. 3 within the meaning of Section. 134 of the Trade Marks, Act, 1999 and therefore this Court has jurisdiction to entertain the claim in respect of infringement. In support of this contention, reliance is placed on the judgment of the Delhi High Court in Heinz Italia S.R.I. and Anr. v. Mr. D. Koteswar Rao IA NO 7543/2005 in CS (OS) No. 1189/2005 decided on 22.01.2008 (para. 8).

10. I have compared the impugned mark with the registered marks of the Plaintiffs. I have also seen and compared the actual products. I am prima facie of the opinion that the impugned mark is identical and/or deceptively similar to the registered marks of Plaintiff No. 1. I am also of the prima facie view that since Plaintiff No. 1 carries on business through Plaintiff No. 3 (which is a subsidiary of the Plaintiff) within the territorial jurisdiction of this Court, the suit as framed in respect of infringement is maintainable in this Court.

11. In the circumstances, a prima facie case for the grant of relief for infringement of trade marks is made out. Unless relief is granted, the Plaintiff is likely to suffer injury. There shall accordingly be an ad-interim order in terms of prayer clause (b) which read as follows:

(b) that pending the hearing and final disposal of the suit, Defendants by themselves and/or through their partners, owners, servants, agents, manufacturers, dealers, associates, distributors, stockists and/or otherwise howsoever be restrained by an order of injunction of this Hon''ble Court from in any manner using in relation to any medicinal preparations;, the trade mark inter alia containing the word TIGER and/or the device of tiger and/or any other word or mark and/or device which is identical with and/or deceptively similar in any manner whatsoever to that of the Plaintiffs'' trade mark inter alia containing the word TIGER and/or the device of Tiger so as to infringe Plaintiff No, 1's trade mark Nos. 763605 and 763606 being Exhibits B1 and B2 to the Plaintiff.

12. In addition to the above, the Court Receiver, High Court Bombay is appointed for the limited purpose of making an inventory of the impugned products of the Defendant which are found at the premises of the Defendant and is directed to submit a report to this Court on 10th June 2013. The local police are directed to render all assistance to the Court Receiver in implementing this order. Parties to act on an ordinary copy of this order duly authenticated by the Associate of this Court.

13. Time to comply with the provision of Order 39 Rule (3) extended till such time as the Court Receiver makes an inventory of the impugned products. List the matter on 10th June 2013.