

(2001) 03 DEL CK 0177

In the Delhi High Court

Case No : Suit No. 751 of 2000 and is No. 7414 of 2000

M/s. Puran Chand Jain

APPELLANT

Vs

Shri Shyamji Industries

RESPONDENT

Date of Decision : 19-03-2001

Acts Referred:

Citation : (2001) 4 AD 137 : (2001) 91 DLT 288 : (2001) 2 RAJ 234

Hon'ble Judges : Jiwan Dass Kapoor, J

Bench : Single Bench

Advocate : Mr. Shaliender Bhatia and Mr. Dheeraj Bhatia, for the Appellant; Mr. M.L. Mangla and Mr Amjad Hussain, for the Respondent

Judgement

J.D. Kapoor, J.—Since the defendant through this application under order 39 Rule 4 CPC seeks vacation of ex parte ad interim injunction passed vide order dated 28th April, 2000 whereby the defendants were restrained from manufacturing, exporting, selling, offering for sale, advertising, exhibiting directly or indirectly dealing in Gutka, pan masala goods and cognate and allied goods such as in pouch having the same getup, colour combination or any other identical/deceptively similar pouch to the plaintiff's pouch and also restrained from infringing the copyright of the plaintiff in the artistic work titled "MAHAK" registered under No. A-57188/99, the order shall dispose not only the instant application but also the application under order 39 Rules 1 & 2 CPC as the grant or refusal of one shall decide the fate of the other.

2. The short ground on which vacation of stay has been sought is that the plaintiff obtained a stay order on the basis of the registration of trade mark "MAHAK" under no. 422322B in clause 31 i.e. for Mouth Fresher and not for Gutka whereas the fact remains that the said trade mark was cancelled in the year 1998 prior to the filing of the suit and as such the stay order has been obtained by filing wrong affidavit.

3. As is apparent from the impugned order, the plaintiff was afforded the

protection in respect of pouch containing the Gutka with regard to its get up, colour combination which is its own artistic work and against any other identical or deceptively similar pouch. As regards the copyright of the plaintiff in the artistic work titled MAHAK, there is no dispute that plaintiff has copyright in his favor by way of copyright registration.

4. Mere glance on the colour combination of the trade mark MAHAK shows that the trade mark used by the defendant Along with the pouch containing the Gutka not only is strikingly identical but also is the reproduction of the trade name MAHAK as well as pouch having the same get up and colour combination of the pouch.

5. It is contended by the Learned Counsel for the Defendant that at the time the defendant started manufacturing Gutka the brand name MAHAK contained in the pouch having the same get up, colour combination, the registration of the trade mark "MAHAK" was not in existence as it was cancelled in the year 1998 whereas the suit was filed in the year 2000 and as such defendant was free not only to use or get the same trade and registered but also the pouch. On the contrary the learned counsel for the plaintiff contends that the cancellation of the registered trade mark by the Registrar was without any notice to the plaintiff without any opportunity of being heard nor was he informed that trade mark has since been cancelled. This fact has received confirmation from the affidavit of the counsel shri. S.K. Aggarwal, attorney of the plaintiff. When this fact came to the knowledge of the plaintiff, he immediately applied for fresh registration although in the name of present plaintiff but as an assignee. Trade mark was immediately restored in favor of the plaintiff.

6. It appears that the defendant took undue advantage of the factum of the cancellation of the registered trade mark which has now been assigned to the plaintiff unabashedly not only adopted the same trade mark viz. MAHAK but also the same pouch with out making even cosmetic changes in its get up and colour combination.

7. Even if it is assumed for the sake of argument that the registered trade mark was cancelled and was not in vogue at the time of the filing of the suit still it did not confer any right upon the defendant to use the same trade mark as well as the pouch. This act not only infringed the copyright of the plaintiff but also its trade mark.

8. Mere discontinuation or cancellation of the registered trade mark, wrapper or pouch used for its contents for any reason whatsoever does not entitle any prospective party to use the same trade mark or pouch without consent of the party which is its prior user as it becomes its intellectual property for all times to come unless any law provides to the contrary.

9. However in the instant case, the trade mark was revived. Since the registration of the trade mark exists as on today, the interim order restraining the defendants from using the same trade mark as well as the pouch having the

same get up, colour combination cannot be vacated or interfered with as it will amount to allowing the defendants to commit breach of copyright and infringe the trade mark that has been in prior and language use, though with a brief stint of interruption on account of its cancellation which fact was not within the knowledge of the plaintiff and the moment it came to know about it, it took no time in restoring it. Had it been in the knowledge of the plaintiff, the plaintiff would not have continued the manufacture and sale of the goods under the same trade name and the pouch of same design. The fact that the representation of the plaintiff for restoration of the trade mark immediately found favor with the authorities, tends to prime facie to support the above plea.

10. In view of the foregoing reasons, the application under order 39 Rule 4 CPC is dismissed whereas the application under order 39 Rules 1 & 2 is allowed. Interim ex parte order is confirmed.

11. The application stands disposed of.

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12. Pleadings are complete.

13. The parties may file additional documents within eight weeks.

14. List the matter before the Joint Registrar for admission/denial of the documents and scrutiny on 22nd May, 2001.

15. Renotify for framing of issues on 27th July, 2001.