

(2017) 03 CAL CK 0131

In the Calcutta High Court

Case No : GA 3071 of 2016, GA 3072 of 2016, APOT 349 of 2016 with CS 27 of 2012

Parakh Vanijya Private Limited

APPELLANT

Vs

Baroma Agro Product

RESPONDENT

Date of Decision : 01-03-2017

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1
Trade Marks Act, 1999 — Section 23, Section 29

Citation : (2017) AIR(Calcutta) 50 : (2017) 2 CalLT 241

Hon'ble Judges : Nishita Mhatre, ACJ. and Tapabrata Chakraborty, J.

Bench : Division Bench

Advocate : Mr. Pratap Chatterjee, Sr. Adv., Mr. Jishnu Saha, Mr. D. Ghosh, Mr. Sanjib Dawn, Mr. Debasish Mukherjee, Mr. A. Goopta, Mr. Anirban Banerjee and Mr. Ishan Saha, Advocates, for the Appellant; Mr. Sidharth Mitra, Sr. Adv., Mr. P. R. Sinha, Mr. Goutam Kr. Roy, Mr. S. Jana and Mr. Domingo Gomes, Advocates, for the Respondents

Final Decision : Dismissed

Judgement

Tapabrata Chakraborty J. - This is the plaintiff's appeal against the order dated 8th August, 2016 passed by the learned Single Judge disposing of the plaintiff's main injunction application being GA 555 of 2012 and the defendants' vacating application being GA 1512 of 2013.

2. Records reveal that the appellant preferred CS 27 of 2012 for infringement and passing off special Biryani rice under the mark "MALABAR" GOLD" or other mark/trade name which is identical with and/or a fraudulent imitation of the plaintiff's trademark "MALABAR". In connection with the said suit, the appellant filed an injunction application being GA 555 of 2012. In the same an interim order was passed on 2nd July, 2012 in terms of prayer "a" of the Notice of Motion which runs as follows :-

" a) The Respondents and their men, servants, agents, employees dealers, and

distributors and/or assigns be restrained by an order of injunction from using and/or applying and/or utilising and/or advertising the impugned trade mark "MALABAR GOLD" as shown in Annexure "D" hereto or any trademark which is deceptively similar or so nearly resembles the said trademark "MALABAR" of the Plaintiff in any manner whatsoever."

3. Aggrieved by the said interim order the defendants/respondents preferred an appeal being APOT 433 of 2012. The said appeal was heard and disposed of on 14th September 2012 without interfering with the interim order. However, it was made it clear that in the event the appellant succeeds in the application for obtaining registration of the trade mark then it would be open to the appellant to apply to the learned Trial Judge for appropriate interlocutory relief on subsequent development. It was further clarified that the observation recorded by the learned Trial Judge will not be binding or influencing factor before the Trade Mark Registry and that the Trade Mark Registry will decide the matter as early as possible. All other points were kept open to be decided by the learned Trial Judge.

4. Subsequent thereto, the defendants/respondents herein affirmed the application being GA 1512 of 2013 on 10th May, 2013 and in the same an order was passed on 5th July, 2016 which runs as follows:

" The defendants propose to use the label mark which is part of the defendants' application made in 2011. The mark is circular in form and though the most prominent word therein is "MALABAR", the plaintiff cannot claim any exclusivity over "MALABAR" in its label mark since there is a disclaimer in respect thereof. The other prominent feature in both the plaintiff's mark and the defendants' proposed mark is the presence of coconut trees, that may be substantially associated with the word "MALABAR".

Liberty is given to the defendants to file a supplementary affidavit to clearly indicate the device mark that they propose to use. The supplementary affidavit should also include the plaintiff's device mark and the defendants' device mark that remains enjoined by the subsisting interim order. All three device marks should be to the same scale and, preferably, in actual size. Such supplementary affidavit be filed within a fortnight from date; rejoinder thereto may be filed within a fortnight thereafter. The petition will appear as an adjourned motion in the monthly list of August, 2016."

5. The said order was not appealed against and as per leave granted the respondents filed a supplementary affidavit annexing thereto a coloured copy of the plaintiff's package, a coloured copy of the defendants' package that has been enjoined and the package with the new get-up that the defendants propose to use and upon consideration of all the materials on record the learned Single Judge disposed of the plaintiff's injunction application and the defendants' vacating application by the order impugned in the instant appeal.

6. Mr. Chatterjee, learned senior advocate appearing for the appellant submits that the learned Single Judge erred in law in modifying the interim order and

observing that the respondents would be entitled to use the word "MALABAR" in conjunction with "BAROMA" whether as part of any device or word mark where the get-up and packaging is not deceptively similar to the plaintiff's being oblivious of the fact that the appeal preferred by the respondents against the order of injunction dated 2nd July, 2012 was not interfered with by the Appeal Court.

7. According to Mr. Chatterjee, the learned Single Judge erred in law in permitting the respondents to pursue an application for registration of a device detailing the changes and the differences to be made. The said observations made by the learned Single Judge would be binding upon the Registrar and that while considering the respondents' application for registration, the Registrar cannot take any different view and that the result would be a fait accompli.

8. He further submits that the learned Single Judge failed to appreciate the attempt on the part of the respondents to cash in on the goodwill and reputation of the appellant and that the respondents failed to make out any case disentitling the appellant to claim exclusivity in the use of the word mark "MALABAR" in respect of rice, particularly in view of their admission that the appellant was the prior adopter and user of the said word mark in respect of the rice and their failure to demonstrate that the word "MALABAR" could or did have any nexus or relation with rice or more particularly Biryani Rice in the course of its trade.

9. Per contra Mr. Mitra, learned senior advocate appearing for the respondents submits that considering the device mark of the respective parties as disclosed in the supplementary affidavit, the learned Judge arrived at a, prima facie, finding that the respondents' proposed get-up looks substantially different from the appellant's get-up containing the label mark and the proposed get-up of the respondents is quite a departure from their previous get-up. Taking into consideration the fact that both the parties are claiming impressive sales of the relevant product, the learned Single Judge in exercise of his discretion modified the interim order and directed that the respondents would be entitled to use the word "MALABAR" in conjunction with "BAROMA". Such entitlement of the respondents has, however, been made subject to the outcome of the suit. The discretion exercised in favour of the respondents is neither perverse nor unfair and such exercise of discretion stands sufficiently explained and as such question of any interference with the order impugned does not occasion.

10. He further argues that appreciating the frailty of human nature, the test to be applied while determining the similarity is one of possibility and not probability of confusion and applying such test the learned Single Judge directed the changes that are required to be made which would be clear indicators as possible to distinguish the label marks between the two products.

11. Mr. Mitra further submits that alleging violation of the interim order dated 2nd July, 2012, the appellant preferred a contempt application being C.C. No.21 of 2013 and in the same the appellant could not produce a single invoice to

establish the allegation of user of the impugned label mark and the said application was disposed of by an order dated 22nd March, 2013 by recording that the respondents are not using the impugned mark in course of trade.

12. Considering the irreproachable conduct of the respondents and the balance of convenience and inconvenience amongst the parties and taking into consideration the fact that the denial of modification would totally stall the substantial business of the respondents, the injunction order dated 2nd July, 2012 has been rightly modified by the order impugned and that there is no infirmity in the same.

13. Heard the learned advocates appearing for the respective parties and considered the materials on record.

14. It is now well entrenched in our jurisprudence that the Appellate Court should not flimsily, whimsically or lightly interfere in the exercise of discretion by a trial court unless such exercise is palpably perverse. 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 and we should be careful not to transgress these frontiers. Since we are confronted with the legal propriety of a temporary injunction, we must abjure from going into minute details and refrain from discussing the case threadbare, in order to preclude rendering the suit itself an exercise in futility and the decision therein a foregone conclusion.

15. A perusal of the order impugned would reveal that the interim order initially passed has been modified to the effect that subject to the outcome of the suit the respondents can pursue their application for registration of the device and would be entitled to use the word "MALABAR" in conjunction with "BAROMA" where all the words and letters must be in the same font but the word "MALABAR" may be increased by point-size of not more than 25% than the rest of the words or letters. The said order, in our opinion, has been passed balancing the vital interests of the parties to the proceeding and putting into the scales the need to protect the interest of the respective parties who were having a substantial turn over in their respective business and in consideration of the fact that the denial of such modification would severely affect the business of the respondents. The said modification is neither iniquitous nor the exercise of discretion towards issuance of the said order was injudicious. By the said order interests of both the parties have been safeguarded.

16. The argument of Mr. Chatterjee to the effect that the permission granted to the respondents to pursue any application for registration of a device and the observation that the respondents would be entitled to use the word "MALABAR" in conjunction with "BAROMA" leaves nothing to be determined by the Registrar of Trademarks and that the respondents would be automatically getting registration of the device, is not acceptable to this Court. The power exercised by the Registrar under Section 23 of the Trade Marks Act, 1999 (hereinafter referred

to as the said Act of 1999) is a quasi-judicial power and not an administrative one and in exercising such power the Registrar shall be required to afford an opportunity to the concerned parties and to decide on objective consideration of relevant facts and to pass a speaking order. Even in the event the Registrar holds in favour of the respondents, the registration of the mark would not confer any indefeasible right upon the respondents moreso when the Court has directed that such determination and user of the device would be subject to the result of the suit.

17. For the reasons discussed above, we are not inclined to interfere with the order impugned and the appeal is, accordingly, dismissed.

18. There shall, however, be no order as to costs.

19. Urgent Photostat certified copy of this judgment, if applied for, be given to the parties, as expeditiously as possible, upon compliance with the necessary formalities in this regard.