

ORDER BELOW EXH.5 IN TRADEMARK SUIT NO.2/2022

[1] The plaintiff has preferred the present suit against defendant for Permanent Injunction Restraining permanently and perpetually from marketing , advertising and providing their services under the Trademark SPG and its label along with device and passing off by providing their services under the Trademark SPG. The Plaintiff has filed present application for interim injunction under O.39 Rule 1 & 2 of the CPC inter alia praying as under :

"(A) Till the pendency and final disposal of the suit, the defendant , their successors, servants, agents, dealers, stockiest and distributors be restrained by an order of ad interim and temporary injunction from manufacturing, marketing, advertising and selling and or offer for sale and or provide their products/services under the impugned Trademark / label mark SPG.

(B) The defendant, their directors, successors, servants, agents, dealers, stockiest and distributors be restrained till final hearing and disposal of the suit from providing their goods/products/services under the Trademark/label mark SPG and / or such other mark being identically, phonetically and or confusingly and or deceptively ad or ditto to ditto similar to the plaintiff's Trademark/label mark SPG and be further restrained from committing the act of passing off the plaintiff's products/services under the impugned Trademark and

may further be restrained from claiming any rights titles or interest in the said Trademark.

(C) The Hon'ble Court may further be pleased to restrain the defendant from causing interference and obstruction in any way, interfering with the sale, marketing offer for sale in any manner, which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded by this Hon'ble Court to the Plaintiff.

(D) For ad interim and interim relief of prayer (C), this Hon'ble Court be pleased to appoint the Court Receiver or such other person as this Hon'ble court may deem fit and proper, with all powers under Order XL of the Code of Civil Procedure, 1908, to forcibly enter/visit any premises of the defendant at any time of the day or night, on any day, including on Sundays and holidays, without prior notice, with police held, if so required and for that purpose to break open any lock or latch or door and to search collect seize, destroy, erase and or store any goods, stationery, letterheads, signage, reprographic material, packaging, signboards, hoardings, labels and or other material for advertising, selling or marketing any goods and or other material featuring or bearing the Trademark/label mark SPG.

(E) Any other and further relief as may be deemed just and proper looking to the facts and circumstances of the case be granted in the interest of justice. "

[2] **Brief Facts of plaintiff's case is as under :**

[2.1] Plaintiff Shree Sardar Patel Sevadal is Trust registered under provisions of Bombay Public Trust Act, 1950. Name of the trustees are mention in the petition. It is further stated that plaintiff is engaged in the public services under the trademark SPG along with its distinctive colour scheme, get up, trade dress, style since long. It is further stated that due to wide setup and services plaintiff trust become very famous and acquired tremendous reputation and goodwill in general public.

[2.2] It is stated that the defendant is also doing public services like free blood camp, legal services, security services under the name and style of Trade mark "SPG" which is exactly similar to plaintiff's logo/label. It is further stated that previously present defendant was one of the trustee of the plaintiff's trust and served as a trustee for the year 2004 to 2020. It is further stated that in the year 2020 defendant was terminated from the plaintiff's trust by resolution passed in General Meeting. It is further stated that defendant is well within the knowledge about the goodwill and reputation of plaintiff's Trademark SPG. It is further stated that in the year 2016, the plaintiff Trust authorized the present defendant to file a trademark application on behalf of plaintiff Trust. It is further stated that said application was refused by the Trade Marks Registry.

[2.3] It is further stated that plaintiff Trust is using Trademark SPG along with colour combination, since 2007 and

same is within the knowledge of the defendant being former trustee of the Trust.

[2.4] It is further stated that the plaintiff Trust again filed Trademark application for trademark SPG along with device which was pending for registration. It is stated that plaintiff being Trust since long using Trademark SPG along with colour combination and label. It is further stated that services of the plaintiff have become known and popular under the said Trademark.

[2.5] It is further stated that recently plaintiff came to know that the defendant has started providing very services under the Trademark SPG along with colour combination, label same to the plaintiff's label mark. It is further stated that defendant is providing his services under identical and deceptively similar Trademark SPG to cause damage to the reputation and goodwill of plaintiff Trust. Hence, plaintiff filed present suit and also file present application. Plaintiff has also produced list of documentary evidences in support of their claim.

[2.6] On Service of notice, defendant appeared and filed written statement vide Exh. 12 qua main petition and injunction application. In written statement defendant denied the facts mentioned in the petition and further stated that trademark application bearing no. 3148977 of plaintiff Trust was refused by the Registrar of Trade marks on 13/2/19 wherein stated that mark is not capable of distinguishing the goods/services of one person from the others. It is further submitted that plaintiff is not the owner of the logo/label SPG. It is stated that the plaintiff is Trust being legal person cannot create or invent logo/ label SPG and in the plaint

or in injunction application nothing has been mention that who has created said logo/label. It is further stated that prior to the adoption of logo/label SPG some other persons have used the said trade mark for same services, hence plaintiff cannot claim any monopoly or any exclusive rights over the same and therefore requested to dismissed application.

[2.7] It is further stated that defendant was doing the social activities related to welfare of Patidar Samaj and in 2004 logo/label SPG was created by defendant prior to establishment of plaintiff Trust in presence of Mr. Sureshbhai Manilal Patel who also filed affidavit in favour of defendant regarding same. Even, plaintiff has no documentary evidence to show ownership on logo/label SPG.

[2.8] It is further submitted that the word Sardar Patel Group or word SPG is non distinctive trade mark and further the same is not capable of distinguishing the services of one person from the others. Thus plaintiff is not entitled to claim any monopoly or exclusive rights over the said trade mark/logo/label. It is stated that present suit as well as injunction application should be dismissed on ground of non joinder and mis joinder of the parties as said trade mark is used and registered before the Trade Mark registry by others even prior to the claim and trade mark application filed by the plaintiff, such proprietors are necessary party to the suit.

[2.9] It is submitted that suit as well as injunction application is deserve to be dismissed on the ground of delay latches and acquiescence. It is submitted that the plaintiff is failed to prove that defendant is doing act of passing off. It is further submitted that the plaintiff is engaged in the social activities for the charity purpose, the logo/label used by the same cannot be considered as trade mark in relation to the services in the course of trade hence, as per the provisions of Sec. 2(1)(zb) r/w sec. 2 (1)(m) the plaintiff is not entitled to claim any rights over the same.

[2.10] It is further submitted that present suit is not signed by the authorized person of the plaintiff Trust and Trust has not authorized Mr. Laljibhai D Patel to sign and filed present suit. It is further submitted that the plaintiff is the public Trust, so prior permission of charity commissioner is mandatory to filed present suit. Hence, it is prayed that the suit of the plaintiff along with injunction application be dismissed by the court with costs.

[2.11] Plaintiff also filed rejoinder vide Exh. 15 wherein the contention raised by the defendant were denied and contentions raised in the plaint are reiterated. I have gone through all the documentary evidence.

Ld. Advocates for the plaintiff and defendant orally argue matter in details.

[3] **Sum and substance of arguments of the plaintiff**

1. The plaintiff is Trust registered under Bombay Public Trust and adopted logo/label "SPG" since long. Defendant was one of the trustee of plaintiff trust and in 2020 he was terminated from plaintiff trust, so, he was well aware with the logo "SPG".

2. It is submitted that during pendency of present application plaintiff's Trademark SPG along with its trade dress is registered by Trade mark registry. It is argued that once mark is registered same has to be protected.

3. It is further argued that defendant also gave application to register Trademark SPG along with its logo by application no. 5247973 on 15/12/2021 which was refused by trade mark registry on 23 rd March 2023 and same was within the knowledge of defendant and still using plaintiff's trademark SPG. 4. It is further argued that by using plaintiff's trademark defendant is taking monetary benefits and causing damages to reputation of plaintiff's Trust. In support of his argument he relied on following judgment.

[1] 1969 Supreme 348

Ruston and Hornby Ltd. V/S Zamindara Engineering Co.,

[2] 1994 Supreme 103

Duncans Agro Industries Ltd. V/S Somabhai Tea Processors Pvt.

[3] 2012 Supreme 848

M/S Medicure Hygiene & Ors. V/S M/S Medicare Hygiene Private Limited .

[4] 2015 Supreme 935

Neon Laboratories Ltd. V/S Medical Technologies Ltd & Ors.

[5] 1985 (0) Supreme DEL 427

Swaran Singh V/S Usha Industries

[6] 1999 0 PTC 81

Automatic Electric Ltd. V/S R K Dhawan

[7] 2004 Supreme 84

Midas Hygiene Industries Ltd. V/S Sudhir Bhatia

[8] 2011 Supreme 394

T V Venugopal V/S Ushodya Enterprises Ltd.

[9] 2001 Supreme 558

Laximakant V Patel V/S Chetanbhai Shah & ors.

[10] Delhi High Court , CS 851/2012

Sanjay Kapur & Anr V/S Supreme Dev Agri Farms Pvt.

[11] Commercial Appeal No. 36947 of 2022

Palmview Investments Overseas Ltd. V/S Ravi Arya and Ors.

[4] **Sum and substance of arguments of the defendant.**

1. It is argued that plaintiff is not the owner of logo/label SPG. It is argued that being Trust plaintiff is legal person and in absence of who has created logo/label SPG, plaintiff cannot claim over it.

2. It is argued that word Sardar Patel Group and word SPG is a non distinctive trade mark and application of plaintiff's was rejected by trade mark registry on same ground.

3. It is argued that no cause of action arise to file present suit as their is nothing on record which shows

that defendant is using logo/label SPG which was similar to plaintiff's logo/label.

4. It is argued that plaintiff is well aware about adoption of logo/label by defendant in 2021 so present suit is as well as injunction application dismissed on the ground of delay.

5. It is further argued that plaintiff being trust permission of charity commissioner is required to be taken. In support of his argument he relied on following judgment.

[1] 2017 AIJ 1373652 Britannia Industries Ltd. V/S ITC Ltd

[2] 2018 2 SCC Toyota JidosaaH Kabushiki Kaisha V/S Prius Auto Industries Ltd

[3] NM No. 711/2016 in Suit no. 186/2015, Bombay High court Manish M Turakhia & Anr V/S Neerav N Turakhia

[4] Appeal No. 643/2016, Manish M Turakhia & Anr V/S Neerav N Turakhia

[5] Interim Application No. 3737/2020 in Commercial IP Suit no. 3737/2020, Plex Inc V/S Zee Entertainment Enterprises Ltd.

[6] 2016 AIJ MH 174550 People Interactive Pvt Ltd. V/S Vivek Pahwa

[7] 2017 AIJ 1343596, Marico Ltd V/S Agro Tech Foods Ltd.

[8] 1994 AIJ HP 700020, Amrit Banaspati Co Ltd. V/S Suraj Industries Ltd.

[9] 2007 AIJ 1334039, Cipla Ltd. V/S M K Pharmaceuticals

[10] CS 447/2021 Om Logistics Ltd. V/S Mahendra Pandey

[11] FAO 30278/22, Delhi High Court, Raman Kwatra V/S Kei Industries Ltd.

[12] 2019 AIJ 1378383 Elder Projects Ltd. V/S Elder Pharmacia LLP

[13] 2004 AIJ 129874, Vidarbha Distillers V/S Vidarbha Bottlers Pvt.

[14] 1997 PTC 364, Ciba Geigy Ltd. V/S Sun Pharmaceutical Industries

I have gone through judgments relied by both parties, to avoid repetition, I do not discuss all of them but relevant are discuss.

[5] I have gone through record from which following things are undisputed in present suit.

1. Plaintiff is register Trust under provisions of Bombay Trust Act. For 2004 to 2020 the defendant served as trustee in plaintiff Trust. In the year 2016 defendant along with other trustees applied for registration of trademark SPG on behalf of plaintiff Trust. Said application was refused.

2. In the year 2020 the defendant was terminated from his post as trustee by passing resolution in the General Meeting.

3. Plaintiff again filed trademark application on 7/2/22 for registration of trademark SPG along with device mark. Looking to record it transpires that said application has been accepted by trademark registry

after filling present suit. So, admittedly plaintiff's trade mark SPG along with device mark is register trade mark.

4. Defendant also applied to register trade mark SPG along with device mark in his name on 15/12/21 which was refused on 23 rd March 2023.

5. Admittedly defendant's mark SPG along with device mark is exactly same to same of plaintiff's registered trade mark SPG.

[6] I have gone through documentary evidence produced by plaintiff. Looking to same it appears that plaintiff is using logo SPG along with device mark since long. I have also gone through trade mark application filed by the defendant wherein in coloum of user detail it has been mention that mark is proposed to be used. So, from the application filed by the defendant before trademark registry it transpires that plaintiff is prior user of trade mark SPG along with its device mark and same is within the knowledge of the defendant.

[7] So, far as argument advance by Ld. Advocate that the prior permission of charity commissioner is mandatory to filed suit, on this point I have gone through prayer clause of plaint and relief pray by the plaintiff, as same are not covered under Sec. 50 read with Sec 51,79 and 80 of the Bombay Public Trust, permission of charity commissioner is not required. So, far as argument advance by Ld. Advocate for the defendant that the plaint is not signed by the authorized person of the Trust, I am of the view that whether plaintiff Trust has given authority to file suit or not is question of evidence and when prima facie case is made out by plaintiff injunction can not denied on this ground. On this point

Ld. Advocate for the plaintiff relied on the judgment of **Commercial Appeal No. 36947 of 2022 in Commercial Arbitration Petition no. 25151 of 2022 in the case of Palmview Investments Overseas Limited V/S Ravi Arya, and ors.** wherein held that "22. In United Bank Of India (supra) the Apex Court has held that letter of authority of an individual who had signed the pleadings on behalf of the company can be cured by the company subsequently. The court held that where suits are instituted or defended on behalf of a public corporation, public interest should not be permitted to be defeated on a mere technicality. Though appellant is not a public corporation, litigant's interest should not be permitted to be defeated on mere technicality. Procedural defects which do not go to the root of the matter should not be permitted to defeat a just cause. There is sufficient power in the courts, under the CPC to ensure that injustice is not done to any party who has just case. As far as possible a substantive right should not be allowed to be defeated on account of procedural irregularity which is curable. The court also held that in the absence of a person expressly authorized to sign the pleadings on behalf of the company, for example by the Board of Directors passing a resolution to that effect or by a power of attorney being executed in favour of any individual, the company can ratify the said action of it's officer in signing the pleadings. Such ratification can express or implied. "

[8] Ld. Advocate for the defendant argued that looking to memorandum of plaintiff trust, same is for charity

purpose so logo used by the plaintiff can not be considered as trade mark within the preview of Sec. 2(1)(zb) r/w 2(1)(m). On this point I have gone through Sec. 18, wherein stated that " a person who claims to be the proprietor of the trade mark in relation to goods and services may apply for the registration of a Trade mark and "person" includes Trust. So, even Trust, only for the purpose of charity can apply for Trade mark for the services which are provided by the Trust to public at large.

- [9] So, far as argument advance by Ld. Advocate for the defendant that the plaintiff is not the creator or owner of logo SGP and also claimed that same is designed by defendant. On this point I am of the view that for registration of Trade mark author of the mark is not necessary and if it is case of defendant that mark SGP was created by him, he could have applied for same in past. Looking to record it transpires that in 2016 defendant himself on behalf of plaintiff trust apply for the registration of trade mark SGP. Now, once he remove as a trustee he can not permitted to claim that said mark is created by him. If he was the owner of mark SGP along with device mark he could have protect it by applying copyright. Looking to documentary evidence it prima facie appears that since 2007 plaintiff is using logo SGP with device mark and same is within the knowledge of defendant. So, argument advance by Ld. Advocate for the defendant is not tenable.

- [10] Ld. Advocate for the defendant argued that earlier application for the registration of trademark SPG was rejected by Trademark Registry on the ground that trade mark is not capable of distinguishing the goods/services of one person from others hence, no prima facie case is made out in favour of plaintiff. As discuss above after filling present suit trade mark of plaintiff has been registered. So , once subsequently trade mark application is accepted and mark is registered, earlier order of refusal of trade mark is not relevant.
- [11] Ld. advocate for the defendant argued that application should be rejected on the ground of delay, on this point I have gone through judgment of **Heinz Italia & Ors. (supra)** wherein in para 15 and 16 the Hon'ble Supreme Court held that **15.** " In an action for passing off, the plaintiff has to establish prior user to secure an injunction and the registration of the mark or similar mark in point of time is irrelevant. Modern tort of passing off has five elements, i.e (1) a misrepresentation (2) made by a trader in the course of trade, (3) prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business of goodwill of another trade (in the sense that this is a reasonably foreseeable consequence), and (5) which causes actual damage to a business or goodwill of the trader by whom the action is sought or (in a quia time action) will probably do so.
- [12] Furthermore, the principle of similarity cannot be very rigidly applied and if it can be prima facie shown that

there was a dishonest intention on the part of the defendant in passing off goods, an injunction should ordinarily follow and the mere delay in bringing the matter to court is not ground to defeat the case of the plaintiff. “

Even in the case of **Midas Hygine Industries (P) Ltd. (supra)** the Hon’ble Supreme Court in para 5 held that “**5.** The law on the subject is well settled. In cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest.”

So, in view of the judgments of Heinz Italia & Ors. (supra) and Midas Hygine Industries (P) Ltd. (supra), the delay is of no use to the defendants, thus , the contention, of the Ld. Advocate for the defendant qua delay is rejected.

By filling present suit the plaintiff is seeking relief for passing off in respect of trademark SPG. On this point both the advocates relied on various judgment. I have gone through all the judgments. I would like to refer few of them.

1. 2001 (8) Supreme 558, Laxmikant V Patel V/S Chetanbhai Shah wherein held that " In an action for passing off it is usual, rather essential, to seek an injunction temporary or ad-interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. The plaintiff must prove a prima facie case, availability of

balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction. According to Kerly (ibid, para 16.16) passing off cases are often cases of deliberate and intentional misrepresentation, but it is well-settled that fraud is not a necessary element of the right of action, and the absence of an intention to deceive is not a defence though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception. Christopher Wadlow in Law of Passing Off (1995 Edition, at p.3.06) states that the plaintiff does not have to prove actual damage in order to succeed in an action for passing off. Likelihood of damage is sufficient. The same learned author states that the defendants state of mind is wholly irrelevant to the existence of the cause of action for passing off (ibid, paras 4.20 and 7.15). As to how the injunction granted by the Court would shape depends on the facts and circumstances of each case. Where a defendant has imitated or adopted the plaintiffs distinctive trade mark or business name, the order may be an absolute injunction that he would not use or carry on business under that name. (Kerly, ibid, para 16.97).

2. 2017(0) AIJ DL 1373652, Britannia Industries Ltd V/S ITC Ltd. wherein held that

9. The present case, therefore, has to be considered as one of passing off in relation to the trade dress/get up. Passing off is a common law tort and each case of passing off depends on its own facts. The essential attributes which need to be established for a successful passing off action have often been considered as the classical trinity, which in

the words of Lord Oliver in *Reckitt & Colman Products Ltd. V Borden* : 1990 RPC 341 HL, are as under :-

"First , he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying "get up" (whether it consists simply of brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Thirdly , he must demonstrate that he suffers or , in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

10. It is evident that a passing of action has to be examined from the standpoint of three factors : (1) goodwill and reputation; (2) misrepresentation/possibility of deception; and (3) likelihood of damage. We must also note that goodwill and reputation do not refer to the same thing though, there could be some degree of overlap. There may be a reputation and yet there may not exist any goodwill. As an example, a particular mark may have a reputation worldwide. But there may be no sales under that mark in a particular territory, say India. Thus, although the mark would have a reputation

worldwide, including India, it would not have a goodwill attached to it in India. It is not just the reputation, but the goodwill which constitutes property inasmuch as it represents a link between the business and the customer. "

Keeping in mind above principle we have to see facts of our case. As discussed above looking to the documentary evidence plaintiff trust established in the year 2004 and since 2007 trade mark SPG is used by the plaintiff. It is further admitted that defendant being one of the trustees applied for the registration of trademark SPG in the year 2016 and same was refused. So, defendant is well aware with the goodwill and existence of trade mark SPG. Even the defendant applied for registration of trade mark SPG which is identically similar to plaintiff's trade mark SPG in his name after his removal from trustee and same is also refused. So, defendant is trying to use goodwill of plaintiff's trade mark SPG. After filing present suit plaintiff's mark SPG is registered by trade mark registry. On this point I would like to refer Sec. 28 of the Trade mark Act.

Section 28 - Rights conferred by registration.

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

(3) Where two or more persons are registered proprietors of trademarks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trademarks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by anyone of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

Here, admittedly plaintiff's trademark SPG is registered trade mark now, and trademark application filed by the defendant was refused. So, in present case plaintiff proves passing off as well as infringement of plaintiff's mark. It is admitted that both trade marks are identically similar. Now, considering above points prima facie case is made out in favour of plaintiff, further not granting injunction in favour of plaintiff, would cause injury to plaintiff. Balance of convenience is in favour of plaintiff. Thus, in view of the above discussions, the present application of injunction is required to be allowed and accordingly, I pass the following order.

: ORDER :

1. The application below Exh. 5 is hereby allowed.

2. The defendant by itself, its servant, agents, dealers, stockist and distributors are hereby restrained from passing off services by marketing, advertising and providing their services under Trade mark SPG along with device mark .
3. No order as to costs.

Pronounced in the open Court to-day on this 19th day of October, 2023, at Mahesana.

Date :19.10.2023.

Place : Mahesana.

(Zankhana V.Trivedi)
3rd Additional District Judge,
MAHESANA.
CODE NO.GJ00676