KADK010034762024

In the Court of IV Additional District Judge and Commercial Court, D.K., Mangaluru.

Present:- **Smt. Sunitha S.G.,** B.Sc., LL.B.,
IV Additional District and Sessions Judge,
D.K., Mangaluru.

Dated: - This the **18th day of February, 2025.**

Com. O.S. No.269/2024

Plaintiff/ Respondent:	Mrs. Usha Shenoy, Aged 52 years, W/o. G. Nandagopal Shenoy, The Proprietrix, M/s. DEVGIRI TEA AND PRODUCE, Residing at 1-2-76/1, Gurunagara, Airport Road, Konchady, Mangaluru-575008, Dakshina Kannada District, Karnataka, India. (By Sri Prashanth K, Advocate)

Versus

Defendants Applicant:	1. The Authorised Signatory, M/s. Sachin Trading Company, Trademark; VEDGIRI, B/at 4-725/1, 4-725, 4-726, 4-727, Main Road, Darbe, Puttur, Karnataka-574202.

2. The Managing Partner,
M/s. Sachin Trading Company,
Trademark: VEDGIRI,
B/at 4-725/1, 4-725,
4-726, 4-727,
Main Road, Darbe, Puttur,
Karnataka-574202.

3. The Proprietor/The Proprietrix/
The Partner/ The Managing Partner/
The Authorised Signatory,
M/s. Sachin Trading Company,
Trademark: VEDGIRI,
B/at 4-725/1, 4-725,
4-726, 4-727,
Main Road, Darbe, Puttur,
Karnataka-574202.

4. The Manager,
M/s. Sachin Trading Company,
Trademark: VEDGIRI,
B/at 4-725/1, 4-725,
4-726, 4-727,
Main Road, Darbe, Puttur,
Karnataka-574202.

5. Mr. Manjunath Nayak,
The Authorised Signatory,
M/s. Sachin Trading Company,
Trademark: VEDGIRI,
B/at 4-725/1, 4-725,
4-726, 4-727,
Main Road, Darbe, Puttur,
Karnataka-574202.

6. The Authorised Signatory,
M/s. Lobosa Food and Beverages,
KSSIDC Industrial Estate,
Plot No.L/6, Hatalageri Road,
Gadag, Karnataka-582101.

7. Mr. Nagraj N. Kabadi,
   The Authorised Signatory,
   M/s. Lobosa Food and Beverages,
   KSSIDC Industrial Estate,
   Plot No.L/6,
   Hatalageri road,
   Gadag, Karnataka-582101.

8. The Manager,
   M/s. Lobosa Food and Beverages,
   KSSIDC Industrial Estate, Plot No.L/6,
   Hatalageri Road,
   Gadag, Karnataka-582101.

9. The Proprietor/ The Proprietrix/
   The Partner/ The Managing Partner/
   The Authorised Signatory,
   M/s. Lobosa Food and Beverages,
   KSSIDC Industrial Estate,
   Plot No.L/6, Hatalageri road,
   Gadag, Karnataka-582101.

(D-1 to 5 by Sri.Manamohana Jois G,
D-7 by Sri. L.M. Akki, Advocates)
(D-6, 8 and 9 placed exparte)

Order on I.A. No.3

The plaintiff has filed I.A. No.3 under Order 39 Rule 1 and 2 read with Section 151 of Civil Procedure Code praying to grant emergent ad-interim temporary prohibitory injunctive relief against the Defendants and the Defendants be restrained by themselves, their agents, employees, representatives, licensees, partners, properties, servants and or otherwise any person through or under them howsoever be restrained by a temporary order and injunction of this Court from using the name and/or mark and/ or artistic work including on any products and on the sales or domain name, interalia containing the word/mark 'VEDGIRI' and/or any other word/name/expression/label identical with and/or deceptively similar thereto similar with that of Plaintiff registered mark “DEVGIRI”, in any manner whatsoever, including and not limited to use of it on the products/sales counter offline or online through internet or any other such form of use, in relation to manufacturing, preparing, selling, marketing of same or similar goods and services so as to infringing/passing off the Plaintiff trademark and artistic work 'DEVGIRI' during the pendency of the suit, pending disposal of this application.

2. In the affidavit, the Plaintiff stated that she is the registered Proprietrix of the business mark 'M/s. Devgiri Tea and Produce' at the above said address. The Plaintiff under the said commercial establishment has been manufacturing the products/goods in the line of tea, tea power, Teas; Packaged tea; tea leaves and thereafter the same is offered for sale having her own distribution channels including online sales; since 2nd

November 1986 by applying her registered trademark “DEVGIRI”, “DEVGIRI TEA”, “DEVGIRI Special Tea”, “DEVGIRI Special Leaf Tea” and such other marks. She is the registered proprietrix of the trademark “DEVGIRI” under the provisions of the Trade Marks Act, 1999 and she is the registered owner and Author of the copyright artistic work titled “DEVGIRI” under the provisions of the Copyrights Act, 1957. The Defendants are unknown and third parties to the Plaintiff. The Plaintiff in the recent past through its distribution channels and through the customers gained the knowledge that the Defendants jointly and severally have been indulged in manufacturing and selling the tea powder and various tea powder variants by affixing the similar artistic work of the Plaintiff and the trademark “DEVGIRI'” and “VEDGIRI”. The acts of the Defendants amounts to infringement/passing off of the registered Intellectual Property Rights of the Plaintiff.

It has been found that, the Defendant No.1 is selling the infringing/passing off products in the line of the tea and tea powder variants/tea based products under similar mark and artistic work “VEDGIRI” with that of the registered work and copyright artistic work titled 'DEVGIRI”. The Defendant Nos.2 to 5 are the persons through whom the Defendant No.1 has been himself infringing/passing off the Plaintiff rights. The infringing/passing off products have been manufactured by the Defendant No.6 as per the details shown in the infringing/passing off products. The Defendant Nos.7 to 9 are the persons through whom the Defendant No.6 has been himself infringing/passing off the Plaintiff rights. In the market the Defendants have been selling the infringing/passing off the goods in the place of the Plaintiff products by infringing/passing off the Plaintiff lawful rights. The Defendants have adopted the said mark to confuse the general public and the consumer at large as to mislead the public in order to purchase their product in the place of the Plaintiff products.

The Defendants have pre-planned and arranged to print items to affix the mark to the goods or packaging thereof, offering or exposing goods for sale, putting them in the market, or stock them for those purposes under deceptive similar mark and artistic work with that of the registered mark and copyright work of the Plaintiff, or offering or supplying services under deceptive similar mark and artistic work with that of the registered trademark and copyright artistic work of the Plaintiff, importing or exporting under the mark, using deceptive similar mark and artistic work with that of the Plaintiff registered mark or copyright artistic work on business papers or in advertising or applying the registered mark to a material intended to be used for labeling or packaging goods or services, taking unfair advantage over the deceptive similar mark and artistic work with that of the registered mark or spoken use of those words as well as by visual representation and reference of Plaintiff's registered trademark. The Defendants have highlighted the infringing mark 'VEDGIRI' with bold and capital English language letters with yellow and red background with leafs in green colour. The act of the Defendants causes confusion on the part of the public or to have an association with the registered trademark and copyright work of the Plaintiff and causing monetary and identity loss to the Plaintiff. The Plaintiff shall be immediately granted with injunctive relief including temporary injunction restraining the Defendants from making use of deceptive similar mark and artistic work with that of the registered trademark and copyright artistic work of the Plaintiff ‘DEVGIRI’ as ‘VEDGIRI’ including artistic work with any same or similar or with deceptive similarity.

The Defendant mark 'VEDGIRI' is a clear indication calling the public to deal with him in respect of the goods and services in the line of tea and tea products including on-line sales and services. In the market / in the minds of the general public the Plaintiff mark is well known. The Plaintiff mark has gained heavy reputation across the globe and extensively in Mangaluru, Dakshina Kannada District, Karnataka State, India. Thus the infringing mark 'VEDGIRI' is not a coined mark of the Defendants and Defendants are not the prior user of their mark. The Defendants have adopted the mark 'VEDGIRI' deceptive similar mark and artistic work with that of the Plaintiff so as to cover up their malafide and to adopt the Plaintiff identity within the Defendants. As on this date in the market the mark 'DEVGIRI' in respect of the tea and tea products is the identity of the Plaintiff. Now the Defendants , to establish themselves under the deceptive similar mark and artistic work with that of the Plaintiff Mark claim their mark as 'VEDGIRI'. The Plaintiff mark and the Defendant mark that is visually the same/ similar/ deceptively similar. All that causes confusion in the mind of the general public/ person of average intellect. Hence the Plaintiff mark has been infringing/ passing off in the hands of the Defendants in the open market. On a day today basis the Defendants dishonestly placing themselves within the umbrella of the Plaintiff mark and/ or deceptive similar mark and artistic work with that of the Plaintiff and reputation of the Plaintiff and Plaintiff's mark and by playing deception in the minds of the general public has been causing loss and hardship to the Plaintiff, Plaintiff Mark and Plaintiff reputation. Hence there is an urgency to grant the interim relief in favour of the Plaintiff under this suit.

The Plaintiff coming to know the said fact and considering the labour, skill and judgment and all that effort taken by the Plaintiff from its inception to till date in establishing the trademark 'DEVGIRI' in the market and the infringing/ passing off acts of the Defendants is considered for the monetary loss and hardship and claimed the damages to the tune of ₹.3,00,000/- (Rupees Three Lakh Only). The Plaintiff has issued legal notice in this regard against the Defendants, so as to bring the knowledge of Plaintiff's right within the minds of the Defendants. The Defendants have not considered the said legal notice and continued to infringe/ passing off the registered rights of the Plaintiff. Hence the Plaintiff filed the above suit. The cause of action of this suit aroused on the 23rd July

2024 the day on which the Plaintiff first came to know/ confirmed about the Defendants acts and from thereafter continued infringing/ passing off act of the Defendants and the suit is well within the jurisdiction of this Court.

3. The Defendant No.7 has filed objection to the I.A. No.3 and contended that, the suit of the plaintiff is not maintainable either in law or on the facts of the case. The reference in the cause title of the plaint in the names of the defendant Nos. 6, 8 and 9 are wrongly mentioned who are nowhere concerned to the M/s LOBOSA FOOD & BEVERAGES, and wrongly cited in the plaint and no existence on this ground, the suit itself is not maintainable. Further the contents taken in the para nos. 2 and 3 are not true and correct that M/s Devgiri Tea and products under the said commercial establishment has been manufacturing products/goods in the line of tea, tea powder, tea package etc since 2nd November 1986 by applying her registered trade mark ‘DEVGIRI’ ‘DEVGIRI Tea’ ‘DEVGIRI Special Tea’ ‘DEVGIRI Special Tea’ and such other marks. Strict proof is required by the plaintiff with the support of reliable documents in the affairs of business alleging trade since 1986 till this day. Further it must be required registered proprietrix

of the trade mark [word mark] ‘DEVGIRI’, and class 35 schedule A. Its status is opposed search date 22-08-2024 and its application No 5622622 and also, application no 5622623 35 DEVGIRI only having have work DEVGIRI no Special Tea on this ground there is no fair pleadings of the plaint on this ground the suit itself is not maintainable.

The contents of the para Nos. 4 and 5 of the plaint are not true and correct that the copy right artists work titled DEVGIRI schedule B ‘DEVGIRI Speal Tea’ the deed of assignment no descriptions in detail in the particular suit or an independent deed of assignment in respect of artistic work in terms of binding between the plaintiff and assignor on this ground it is purely defective towards the entailing the right on ‘DEVGIRI Special Tea in respect of seeking the relief is totally against the norms of the copy right on this ground the schedule 'B' itself is not bringing upon the defendant. Further strict proof is required prior continues and honest registered rights holder on the work/device trade mark and the artistic work ‘DEVGIRI’ having registered lawful rights across India straight proof is required by the plaintiff. Further it is not true and correct that plaintiff has every right to enforce her right against the infringement of the said rights. The infringement of the side right must be provide under the concept of trade mark act when the said class 35 application 5622622 status opposed in the sense yet not conclusive and finalised by the Deputy Registrar of trade marks India on this ground is directly and indirectly collecting the judicial order which is causing severe fatal proceedings which is pending before the Registrar of trade marks at Chennai, and opposed by this plaintiff. When knowledge to the plaintiff that defendant No. 7 Nagaraj Kabadi has applied and application No. 5474864 class 30 VEDGIRI [LABEL] its journal No 2094 dated 03-06-2022 status opposed image ‘ VEDGIRI Strong Tea’ it is documentary evidence to show that the date of suit is 05-08-2024 filed by the plaintiff and D7 applied class 30 for Trade Mark dated 22-08-2024 at Chennai it clearly indicates that the plaintiff is going to claim two reliefs one is making opposition to the application class 30 of ‘VEDGIRI [Label] Strong Tea’ at Chennai and another this present suit seeking the relief perpetual injunction, mandatory injunction, declaratory injunction and be restrained from making any application for registration of the trade mark before the jurisdictional Registrar of Trade Marks and Copy Rights Registrar. This above stated developments not stated or referred in any corner of his pleadings concealing the true thing pleadings and it is defective pleadings in view of O 6 R 4 of CPC as follows. ‘PARTICULARS TO BE GIVEN WHERE NECESSARY in all cases in which the party pleadings relies on any misrepresentation, fraud, breach of trust, willful default, undue influence and in all the cases in which particulars may be given necessary beyond such as or exemplified in the forms aforesaid particulars shall be stated in the pleadings.

The contents of the para Nos. 6 and 7 are not true and correct that the plaintiff in the past through its distribution channels and through the customers gained the knowledge that the defendants jointly and severely have been indulged in manufacturing and selling the Tea powder and various Tea powder variants by affixing the same/similar/deceptively similar artistic work of the plaintiff and trade mark ‘DEVGIRI’ as ‘VEDGIRI’ the defendants same/similar/deceptively similar infringing passing of mark ‘ VEDGIRI’ is more fully detailed in the schedule C. The acts of the defendants amounts to infringement/passing off of the registered intellectual property rights of the plaintiff strict proof is required by the plaintiff. The defendant No. 7 in his application No-A148184/2023 date of application 22-06-2023 image ‘VEDGIRI’

Special got the copy right certificate and also trade application No. 5474864 class 30 ‘VEDGIRI [Label] Journal No 2094 Proprietor Name Nagraj N Kabadi that is defendant No 7 application date 03-06-2022. Schedule A of Plaintiff trade mark application No 5622623 no date in the pleadings and also no T.M certificate, and itself is a question full proof is required by the plaintiff and class 30 trade mark No. 5622621 dated 23-09-2022 ‘DEVGIRI’ words there is no image of pocket or pouch on this ground the said suit itself is not maintainable. Trade mark No 5622620 dated 23-09-2022 M/s Devgiri tea and produce. The words taken in both the trade mark are totally different in font, style, size, colour which is not deceptive similar in artistic work either in its spellings, font, style, size, colour, word visual presentation, etc. is not a clear indication calling the public to deal with him in respective of goods and services in the line of tea and tea products including online sales and service in the market in the mind of general public in respect of ‘DEVGIRI’. As the contentions taken in the para No 7 is also not true and correct that the defendant No 1 is selling the infringing/passing off products in the line of tea and tea powder varieties-based products under same/similar/deceptively similar mark and artistic work etc, and further the defendant Nos. 6, 8 and 9 are nowhere concerned as stated above in para No 1. The defendant No.7 is straight way denying in respect of infringing/passing off products.

The contents of the para No. 8 is not true and correct that in the market the defendant having been selling the infringing/passing off goods in the place of plaintiff, and also not true and correct that the defendants have adopted the said mark to confuse the general public and to the consumer at large as to mislead the public consumer in order to purchase their product in place of plaintiff product strict proof is required by the plaintiff.

The contents of the para No. 9 is denied in toto. The words taken in both the trade mark are totally different in phonetic, spelling, font, style, size, colour and word visual presentation etc, which is not deceptive similar in artistic work either in its spellings, font, style, size, colour, word visual presentation, etc. is not a clear indication calling the public to deal with him in respective of goods and services in the line of tea and tea products including online sales and service in the market in the mind of general public in respect of ‘DEVGIRI’. Therefore, the relief in para No. 9 against the defendant biasing upon saying false and bogus grounds which are baseless allegations holding the in completed copy right and trade mark, the act of the defendants is not causing confusing on the part of the public or to have an association with registered trade mark and copy right work of the plaintiff, and also not causing monitory and identity loss to the plaintiff and also plaintiff is not entitled immediately grant with injective relief including temporary injunction restraining the defendants. Further there is no making using deceptive similar mark and artistic work with that of the registered trade mark and copy right artist work of the plaintiff 'DEVGIRI' as a including artistic work with any same or similar with deceptive similarity on this ground strict proof is required by the plaintiff.

The contents of the para No. 10 of the plaint is also denying in toto. It is not true and correct is a clear indication calling the public to deal with him with the defendants further it is not true and correct that as on this date General public/person of average intellect. Further it is not true and correct that 'DEVGIRI and 'VEDGIRI' are phonetically and visually the same/similar/deceptive similar to the plaintiff. The plaintiff is not entitled to an urgency to grant an interim relief in favour of the plaintiff. The averments of the para No 10 of the plaint it must be require proof by the plaintiff.

The contents of the para no. 11 of the plaint is also not true and correct that the plaintiff considering the labour skill and judgment and all the efforts taken from its inception to till date in establishing the trade mark ‘DEVGIRI’. The defendants have not committed infringing passing off acts of the defendants in considered for monitory loss and hardship and claimed the damaged to the tenure of ₹.3,00,000/- the plaintiffs ought to establish the monitory loss ₹.3,00,000/- on the basis of reliable documents on this ground the plaintiff is not entitled for it.

The contents of the para No. 12 of the plaint is not true and correct that the plaintiff has issued the legal notice in this regard it is just random para in order to establish the false cause of action.

TRUE CASE OF THE DEFENDANT NO 7 AS FOLLOWS

The family business of the defendant No 7 deceased father Narayansa L Kabadi was under the name and style of M/s Jagdamaba Tea Depot and M/s Lobosa Tea Depot and M/s Bhavani Tea Depot in the year 1962, and thereafter developed and merged all 3 firms and gave the name as LOBOSA FOOD & BEVERAGES 01-04-2012 and running the business in this name throughout India and especially in Karnataka state, is one of the most popular name and good will in respect of tea products manufacturing, and in entire Karnataka state identified its name and style LOBOSA FOOD and BEVERAGES by the public at large, and this fact well known by the plaintiff.

Further, the tea manufacturing product is one of the objects which is covered and governed by the norms and rules of food safety and duly certified by the concerned authority [FSSAI] by recognizing LOBOSA FOOD & BEVERAGES is one of the appreciated document for the Genuity of the product quality and business throughout India. This fact is well known by the plaintiff.

The trade mark application No 5474864 class 30 Label journal No 2094 Nagraj N Kabadi status opposed image Tea based beverages dated 03-06-2022. Notice of opposition form TM-M48 the trademarks Act 1999 Usha Shenoy who is the plaintiff filed opposition to the trade mark dated 14-07-2023 and Form TM-O-Form of counter statement in the matter of opposition No 1227359 filed by Nagraj N Kabadi para No 1 to 13 and duly signed by the Nagraj N Kabadi an indulge- Defendant No.7 dated 24-08-2023 before the registrar of trade mark at Chennai.

a) The date of suit filed by the plaintiff 05-08-2024.

b) The date of opposition before the trade mark registrar at Chennai 04-07-2023.

c) Form of counter statement by the Nagaraj N Kabadi about [label] voluntary statement ‘DEVGIRI’ dated 24-08-2023.

d) In para No 15 sub clause [e] and [o] of the plaint that, ‘pending the hearing and final disposal of the suit the defendants by themselves and their authorised signatories, directors, Employees, agents, licensees, partners, proprietors, servants and otherwise be restrained from making any application for registration of trade mark before the jurisdictional registrar of trademarks and copy rights. In view of specific relief Act restrained against the legal proceedings, this court cannot grant declaration and injunction restraining a party from instituting/continuing legal proceedings in court which is not a sub-ordinate court, ‘Florentine estate of India ltd v/s Creef Finance ltd 2004[74] DRJ 101 DEL.

This relief claiming before this Court when opposition made by the plaintiff and counter filed by the plaintiff and form of counter statement filed by the defendant and it is a pending before the trade mark registration authorities to decide the word and logo dispute ‘DEVGIRI v/s ‘VEDGIRI, therefore in the subject matter of the dispute , the plaintiff cannot make claim in two proceedings, one is before this Court in the suit and another before the trade mark registering authority on this ground the said suit is not maintainable.

The defendant No. 7’s family business is user since 1962, and thereafter expansion of the business and merged together from name and style of M/s Jagdamba Tea Depot and M/s Lobosa Tea Depot and M/s Bhavani Tea Depot, and thereafter developed and merged all 3 firms and gave the name as LOBOSA FOOD & BEVERAGES dated 01-04-2012.

The defendant No. 7 obtained the copy right in its application No A148184/2023 title of the work, language of the work English along with its image and in Kannada language.

The defendant No.7 also has applied for trade mark under class 35, this fact well known by the plaintiff, therefore the deciding authority is Registrar of trade mark and it takes its own time, years together till then the defendant No.7 is not to be restrained by doing the business under the trade mark word and its logo, there is no preventive measures by the authorities of the trade mark or copy right about using the word and its logo on this ground the defendant is having absolute lawful right to do the business and not passing off/infringing to the plaintiffs mark 'DEVGIRI' this fact well known by the plaintiff. The defendant No 7 has no malafide intention to do business wrongfully as class 30 and 35 applications are pending before the authorities, is jurisdiction of the authority to decide over the matter not by this court to give findings upon it. On this ground the suit itself is not maintainable.

Under the Hindu religious script as follows:

a) DEV = GOD

b) GIRI = HILLS [MOUNTAINS] { DEVGIRI }

Therefore, the word used 'DEVGIRI' by the plaintiff is not monopoly the trade mark and copy right is not restricted to anybody using the same word by any person it is common to all.

Under the Hindu religious script of 4 Vedas out of which as follows:

a) VED= VEDA

b) GIRI = HILLS [MOUNTAINS] { VEDGIRI }

Therefore, the word used is hills of Veda and this cannot be restrained by the plaintiff as the entire trade mark with logo adopted by the plaintiff and defendants are altogether different, the manner, style and other artistic work of the mark adopted is totally different, there is no deceptive similar or similarity of each other and effect the minds of the consumer, and average intelligent person can differentiate between the two trademarks.

The plaintiff never made out as a prima-facie and balance of conveyance and hardship in his favour in any corner of pleadings on the basis of reliable documents and facts to establish that the defendant is misrepresenting and causing damages in deceptive way under the umbrella of passing off of products as laid down in various Supreme Court Cases.

The plaintiff has not made out on the basis of documents pertinent towards the running of the business of ‘DEVGIRI as a user since 1986 and also after obtaining the trade mark registration certificate class 30 and class 35, basing upon it, applied to

Mangalore City Corporation under KMC Act Sections 343, 346, 353 and 354 of KMC Act 1976, Section A licenses details, Section B trade details, Section C trade details, is issued and same produced before this Court along with list of documents and it is valid till 01-04-2024 to 31-03-2025, no accounts of trade duly certified by the authorities of Corporation of Mangalore about doing the business and paying of tax on this ground paying on court fee and suit valued is ₹.3,20,000/- under such circumstances the same suit is not maintainable the averments of the pleadings are false and bogus and I.A's with the support of the affidavit are false and bogus referring the DEVGIRI special tea image etc. Therefore, none of the documents in respect of having tax paid by the plaintiff in view of trade license certificate in force since 01-04-2024 to 31-03-2025. Under such circumstances stated in his pleadings user of the trade mark since 1986 no such documents are produced to substantiate his pleadings in the plaint. Under such circumstance the suit of the plaintiff is not maintainable.

The schedule A property class 30 and 5622623 in class 35 for word 'DEVGIRI', for which application No 641212 class 30 'DEVGIRI' application dated 26-09-1994, image nil status registered, and it is roundup. And application No 5622622 class 35 'DEVGIRI' application dated 23-09-2022 status opposed image nil and application No 5622623 class 35 'DEVGIRI' application dated 23-09-2022 registered 'DEVGIRI'. Oppose to class 35 by Sukdevnarayanlal Gehlot R/o Takshshila Parisar Rajendra Nagar Police Station A B Road Indoor M.P filed opposition to the trade mark application No 5622622 in class 35 it is under dispute pending before the authority and all-relevant electronic documents are here with produced.

There is deed of assignment in favour of M/s 'DEVGIRI FOOD PACKERS' now M/s DEVGIRI TEA AND PRODUCT in the year 1993 said Mr.G Nadagopal Shenoy, came down to his office then at Vishnu Commercial Artistic Car street Mangalore etc as referred in application No 5622622 is under dispute on the oppose made by the Sukdevnarayanlal Gehlot, on this ground the plaintiff has no right to claim schedule A trade mark under class 30 and 35, and the prayer sought in para no 15 [a to r] order to be dismissed with heavy cost.

The contents of the para 11 and 12 of the plaint are also false and bogus and baseless and imaginary pleadings. The contents of the para No 13 of the plaint is not true and correct . No cause of action arose on 23-07-2024, the plaintiff first came to know/confirm jurisdiction of this Court. It is the duty of the plaintiff as he must establish the cause of action with support of documents.

The contents of the para No 14 of the plaint is also not valued properly and paid court fee as prayer of sub para q of para No 15 to declare the plaintiff mark 'DEVGIRI' as a well-known mark' the court fee is not paid accordingly and on this ground the suit itself is not maintainable.

For prayer sought by the plaintiff in para No 15 clauses 'a to r' plaintiff is not entitled and suit of the plaintiff is basically not maintainable as stated above and to be dismissed with payment of heavy cost. Hence this written statement.

4. **Defendant No.3** has filed objection to the I.A. No.3 and contended that, the application filed by the plaintiff is not maintainable on law or on facts. The application filed by the plaintiff is devoid of merits, for avoiding repetition of facts, the contentions and pleading filed by the defendant herein in the written statement may be read as part and parcel of this counter. The applicant has

sought for interim order which are similar to main relief of the suit, which cannot be granted in the eyes of law. Any interim order in the nature of main relief cannot be granted unless a full trial is conducted by the Court.

Further, the applicant in his application has not at all pleaded any immediate threat or irreparable damage anywhere, the principals of Order 39 Rule 1 and 2, mandates any person seeking an interim order of injunction must show the prima facie case, balance of convenience, and irreparable damage, the plaintiff has neither pleaded nor produced anything to satisfy the requirements of law. Hence , the application is not maintainable and may be dismissed with exemplary costs.

5. Heard both sides. Perused the records.

6. The learned counsel for the Defendants furnished the Compendium of Landmark cases on Trademark and the authority reported in CRP No. 426/2023 (IPR) by Hon'ble High Court of Karnataka dated 07-06-2024.

7. In view of the above pleadings, the following points arise for consideration:

1) Whether the Plaintiff Firm has made out a prima-facie case?

2) Whether the balance of convenience lies in favour of plaintiff Firm?

3) Whether the plaintiff Firm will be put to irreparable loss and hardship, if I.A. No.3 is rejected?

4) What Order?

8. My answer to the above points for consideration are here under:

Point No.1 : In the Affirmative,
Point No.2 : In the Affirmative,
Point No.3 : In the Affirmative,
Point No.4 : As per final order.

for the following:

REASONS

9. **Points No.1 to 3**: These points are inter-linked with each other, as such they have taken up together for common discussion.

10. It is the case of the Plaintiff, that she is the registered proprietrix of trade mark 'DEVGIRI' and registered owner and author of Copy right artistic work titled 'DEVGIRI'. The defendant's are unknown and third parties to her and in the recent past through her distribution

channels and through customers, gained the knowledge that defendant's jointly and severally have been indulged in manufacturing and selling the tea powder and various tea powder variant's by affixing deceptively similar artistic work and trade mark as 'VEDGIRI' and has committed passing off of the registered IPR rights of plaintiff.

11. On the other hand, defendant No.7 has putforth the documents as to his copyright pertaining to 'VEDGIRI' and objections pending before the concerned authority as to plaintiff's trade mark pertaining to class 30 and 35 along with the reply filed by plaintiff. Further submitted, as there are pending proceedings plaintiff is not entitled for the relief and that, use of Geniric name does not ipsofacto infringes one's trade mark or cause passing off.

12. As seen, the defendant No.7 copyright is pertaining to unpublished work. Further, Plaintiff and Defendant No.7 products are pertaining to Tea's and its variants and the marketing product furnished before this court reflects the deceptive similarity as alleged. Defendant No.7 product is marketed by defendant Nos.1 to 5 as shown in the photo's furnished.

13. Further, Sec.124(5) of trade mark Act reads- the stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any

order granting an injunction directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.

The primary objective of Section 124 of the Trade marks Act is to provide a defence to either party against the claim of infringement of a registered trade mark.

14. In Amrish Aggarwal Trading vs. Venus Home Appliances Pvt. Ltd. (2024)- The decision in Sana Herbals vs. Mohsin Dehlvi (2022) was overruled by the decision of the Division Bench of the High Court. The Division Bench noted in its decision that the view taken in the case of Sana Herbals was contrary to the decisions relied on in matters such as Elofic Industries (India) vs. Steel Bird Industries (1985), Puma Stationer P. Ltd. and Anr vs. Hindustan Pencils Ltd. (2010), and Patel Field Marshal Agencies vs. P.M. Diesels (2017). The High Court placed reliance on cases wherein a rectification petition was filed simultaneously with the written statement challenging the validity of registration of the trade mark in a suit for trade mark infringement before the court could frame any issues regarding the same or order a stay on the proceedings, in line with Section 124 of the Trade marks Act. In its decision in the present case, the court observed that the Trade marks Act dictates that the proceedings in an infringement suit be stayed while a decision on the rectification proceedings is pending. Merely initiating rectification

proceedings of a trade mark shall not result in an automatic stay of the proceedings in a suit for infringement. Additionally, the court also observed that simply because the Act does not provide for an automatic stay of proceedings, it does not eliminate the need for the court to issue an order staying further proceedings in the infringement proceedings. Hence, the court overruled the decision in Sana Herbals vs. Mohsin Dehlvi (2022), to that extent.

15. Hence, contentions of Defendant No.7 with further contentions that, Plaintiff has intentionally not disclosed about the pending proceedings before the concerned authority under Trade Marks Act and of Defendant Nos.1 to 5 that, any interim order in the nature of main relief cannot be granted unless a full trial is conducted by the Court and cause of action shown in plaint is 23.07.2024 whereas, the objection filed by the plaintiff (Document -3 furnished by defendant No.7), reflect plaintiff had the knowledge of the same on 04.07.2023 itself and plaintiff has approached the Court with unclean hands and not entitled for injunction, holds no substance.

16. In the authorities relied by the learned counsel for the Defendant No.7 :

PRIORITY IN ADOPTION AND USE PREVAILS OVER PRIORITY IN REGISTRATION.

I. Century Traders v Roshan Lal Duggar Co. (1977 SCC OnLine Del 50) -observed,

> The registration of the said mark or similar mark prior in point of time to user by the appellant is irrelevant in an action for passing off and the mere presence of the mark in the register maintained by the trade mark registry did not prove its user.

II. N.R. Dongre and Others v Whirlpool Corporation and another((1996) 5 SCC 714)- observed,

> Presence of the trademark on the Internet and publication in international magazines and journals having circulation in India are also considered as use in India. The Court, therefore, held that a rights holder can maintain a passing off action against an infringer on the basis of the trans-border reputation of its trademarks and that the actual presence of the goods or the actual use of the mark in India is not mandatory. It would suffice if the rights holder has attained reputation and goodwill in respect of the mark in India through advertisements or other means.

III. M/s. L. D. Malhotra Industries v. M/s. Ropi Industries, (1975 SCC OnLine Del 172) -observed,

> In other words Ropis were prior in use and later in Registration while Malhotras were anterior in registration but posterior in use. That is the question in this appeal against the order of rectification four points arise for decision. First is the question of use of the trade mark. Use plays an all important part. A trader acquires a right of property in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and the extent of his trade. The trader who adopts such a mark is entitled to protection directly the article having assumed a vendible character is launched upon the market. Registration under the statute does not confer any new right to the mark claimed or any greater right than what already existed at common law and at equity without registration. It does, however, facilitate a remedy which may be enforced and obtained throughout the State and it established the record of facts affecting the right to the mark. Registration itself does not create a trade mark. The

trade mark exists independently of the registration which merely affords further protection under the statute. Common law rights are left wholly unaffected.

IV. Neon Laboratories Ltd v 2015 SCC OnLine SC 905.) (Civil Appeal No 1018 of 2006)- observed,

A prior application for registration of a mark is of no assistance in the use of the said mark has started 12 years after the use of their rival's mark.

VI. S.Syed Mohideen v. P. Sulochana Bai (2016) 2 SCC 683 -observed,

Trademark exists independently of the registration which merely affords a further protection under the statute, the common law rights being left completely unaffected. They further held that the registration is only a recognition of the right that have been pre-existing in common law, in should a conflict arise between the two registered properties, the evaluation of the better rights in common law is essential as the same would determine whose rights between two registered Proprietor are superior. They even said that the latter user of the mark/name in the

> business cannot misrepresent his business as the business of a prior user.

REGISTRATION WITH REGARD TO ONE CATEGORY OF GOODS NO BAR TO REGISTRATION FOR OTHER GOODS IN SAME CLASS.

I. “Vishnudas Trading as Vishnudas Kishandas Vs Vazir Sultan Tobacco Co. Ltd Hyderabad and another” - (1997) 4 SCC 201 -observed,

> Where trade or manufacturer actually trades in or manufactures only one or some of articles coming under broad classification and such trader or manufacturer had no bonafide intention to trade or manufacture other goods. Such trader or manufacturer cannot preclude other traders or manufacturers to get registration of separate and distinct goods which may be grouped under the broad classification.

II. Nandhini Deluxe v Karnataka Co- Operative Milk Producers Federation Ltd (2018) 9 SCC 183-observed,

> The Supreme Court in view of the aforesaid principles, in the instant case opined that not only visual appearance of the two marks is different, they

even relate to different products. That the proprietor of a trade mark cannot enjoy monopoly over the entire class of goods and, particularly, when he is not using the said trade mark in respect of certain goods falling under the same class.

REGISTRATION OF A COMPOSITE MARK NOT TO CONFER EXCLUSIVE RIGHTS TO INDIVIDUAL/NON-DISTINCTIVE PARTS OF THE MARK

In case of a composite trademark, which was several distinctive and non-distinctive elements, the authority to take action against an infringer is limited to the extent that the distinctive part of the trademark is misused by the infringer. It is a settled law that the proprietor of a trade mark gets exclusive right to the use the trademark taken as a whole. The proprietor has to apply to register the whole and/or each element of such part as separate trademarks to be able to claim right over any part of the mark, and further, they do not have the authority to restrain others from either using any part or word independently or in combination with other words. But if the proprietor acquires any right by long use of

> those parts or words in relation to his trade, he may, claim his right by a passing off action and prevent exploitation of his mark.

I. Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd 1955 AIR 558 -observed,

> The Supreme Court said that where a distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole.

II. Bhole Baba Milk Food Industries v Parul Food Specialties 2010 (44) PTC 736 (Del)- observed,

> The distinctiveness to which the Appellant can be a claim is to what it has got registered as a whole, and therefore, such registration cannot possibly give an exclusive statutory right to the Appellant qua a particular word of common usage.

III. Super Cassettes Industries Ltd. v Union of India & others 2010 SCC OnLine Del 1652- observed,

> In this case, the well-known mark aspect or priority in use test would not apply because sub-

> sections (1) (a) and (1) (b) of Section 11 (1) required to be satisfied conjunctively, i.e. both identity or similarity with an earlier trade mark and similarity of goods and services in respect of which were covered by the earlier trade mark had to be shown.

IV. Harjeet Kaur Vs Deputy Registrar of Trade Mark [2005 (30) PTC 330 IPAB] -observed,

> Just for the mere outlook whether any ordinary prudent individual would be mislead by the similarity of the marks. When a trademark is a composite one, the same cannot be separated by prefix and suffix to find out the similarity and dissimilarity. Although the Appellants are using T.T as well, they are using it in a totally distinctive way. Further, the Appellant has has already given an undertaking to not use the mark “T.Tex” and “T.T”, there the appeal was allowed and the DR’s order was set aside.

MARK INFRINGED BY ANOTHER TRADER EVEN WITHOUT USING WHOLE OF IT, IF ONE OR MORE ESSENTIAL FEATURES COPIED- observed,

> According to the constant case law delivered in the Hon’ble Supreme Court in India, the comparison

of trade marks should be based on the overall impression taking into consideration all the distinctive elements of each trade mark.

I. Parle Products Pvt. Ltd. V JP & Co (1972) 1 SCC 618 -observed,

The packets were of the same size and colour scheme and although the design was not the same, they bore a close resemblance that could cause confusion. The Court said that in an action for infringement, the Plaintiff must, no doubt, make out that the use of the Defendant's mark is likely to deceive, but where there similarity between the Plaintiff's and the Defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the Plaintiff rights are violated. Therefore, is one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, if the differences are of a character as to prevent on

> design from being mistaken for the other. It would be enough if the impugned mark bears such overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him.

II. Cadila Health Care Ltd. V Cadila Pharmaceuticals Ltd. (2001) 5 SCC 73 -observed,

> that there should be extra vigilance in case of medical products, so the likelihood of confusion should require lesser quantum of proof. Factors that should be considered while deciding such a case is: 1. Nature of the goods (word, label, device); 2. Degree of resemblance; 3. Nature of the mark; 4. Similarity in the nature, character and performance of the goods and rival traders; 5. Class of purchasers who are likely to buy the goods bearing the mark they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the good; 6. Mode of purchasing; 7. Any other surrounding circumstances.

III. Proctor and Gamble v Joy Creators 2011 (45) PTC 541 -observed, the court noted that for a successful action the Plaintiff needs to establish that the trademark of the Defendant "resembles its trademark in a substantial degree, on account of extensive use of the main features" of the trademark. It was important to consider that a consumer would not have both products lying side by side and this would increase the chances of deception. The Court reasoned that Total Effects was an essential and integral part of the Plaintiff's trade mark, and it's use with suffix and prefix and packaging will not change or be of significance once the essential part is used. Hence rules in favour of the Plaintiff.

IV. Max Health care Institute Limited v Sahrudya Health Care Private Limited 2017 SCC OnLine Del 12031-observed,

The deceptive similarity between the rival marks must be decided not only based on visual, structural and phonetic comparisons but also the nature of good/services and purchasing public.

The likelihood of confusion from the perspective of a common man of average intelligence and imperfect memory must also be given equal weight, and it is important to take stock of various judgments to decide what constitutes as infringement of an essential part of a mark, the instant case was also decided on the principle of judging similarity by looking beyond just the visual comparison and into the impression , the mark has created in the mind of the general public.

V. J. & P. Coats Ltd. Vs Chadha & Co. (India) [AIR 1967 Delhi 141] -observed,

Where colour of rival boxes of thread was similar, even the illiterate users may well be expected to distinguish between the opposite marks ‘Dog’ and ‘Anchor’, which are the distinct essential feature of the respective parties. Hence, there was no probability of confusion.

ABBREVIATION OF A GENERIC TERM ALSO GENERIC

Abbreviation of generic words and term are also considered to be generic, and therefore, no trade mark protection can be extended to the same, unless the Applicant can establish that the term has some-how managed to acquire a secondary meaning that is associated with the abbreviation in relation to the products or services of the Applicant. Generic terms are non-protectable terms and requires a higher degree of source identifier abilities to be protected under the Trade Mark law. In general, however, much like the case of the Registrar v Ashoke Chandra Rakshit the registry follows a general policy of denying exclusive protection over generic terms and their abbreviation, or allows the registration with a disclaimer.

I. SUPERON SCHWEISS TECHNIK INDIA V. MODI HI-TECH INDIA LTD. (2018) 250 DLT 308 -observed,

One can claim exclusive ownership over an ordinary descriptive word or their abbreviation as trademark in view of Section 9, 30 and 35 of the Trade Marks Act, 1999. In the present case, the court said that the word VAC PAC was an abbreviated form of Vacuum Pack/packaging as affirmed by Plaintiff. This is descriptive in larger term as it is used in packaging a welding shield to give a longer shelf life. Thus, using words like VAC PAC shall not entitle the owner of such word, an exclusive owner.

II. Marico Limited Vs. Agro Tech Foods Limited 2010 (44) PTC 736- observed,

> The Appellant can have no exclusive ownership rights on the Trade Mark “LOW ABSORB”. Also, the Respondent is selling its product with a prominent Trade Mark “Sundrop” and which appears on the packaging of the Respondent in a very prominent size, much larger than the size of the expression “LOW ABSORB TECHNOLOGY’. The colour scheme of the respective packaging is different merely because, the consumers are same and the trade channel is also same, it cannot be said that there is a possibility of confusion, because there are more than enough differentiating features on the packaging so as to avoid any issue of the Respondent passing of its goods as that of the Appellant. Thus, even though the two respective products of the parties are identical viz edible oil, it cannot be said that the respondent is passing of its goods as that of the Plaintiff. Appeal is dismissed.

III. Himalaya Drug Company -Vs- S.B.L Limited 2010(43) PTC 739 (Del) -observed,

' Nobody can claim exclusive aright to use any generic word, abbreviation, acronym which has become public juris. In the trade of drugs, it is common practice to name a drug by the name of the organ or ailment, which it treats or the main ingredient of the drug. Such an organ ailment or ingredient being public jurisdiction or generic cannot be owned by anyone for use as a trademark.' Hence, the Plaintiff claim is not valid.

IV. Indo Pharma Pharmaceutical -Vs- Citadel Fine Pharmaceuticals on AIR 1998 Mad 347- observed,

The two rival marks 'ENERJEX' and 'ENERJASE' contain the common feature 'ENERJ' which is not only descriptive but also public juris. Therefore, a customer will tend to ignore the common feature and will pay more attention to uncommon feature I.e 'JEX' and 'JASE'. These two cannot be said to have such phonetic similarity so as to make it objectionable. So, the word 'ENERG/J' used as a prefix in both the trade names is the abbreviation of the generic term of the English word 'energy'. As such, it is descriptive in nature and common in usage. Nobody can claim an exclusive right to the use of the word 'ENERG/J' as the constituent of any trademark.

A. Person claiming exclusive rights over an expression cannot challenge the same as generic.

Therefore, a person who has on one hand claimed exclusive rights over a mark or expression, cannot challenge the same as generic.

(I) Automatic Electric Limited -Vs- R.K. Chawan and another. 1994 SCC Online Del 632- observed,

'DIMMER DOT' of the Defendants is not a registered trade mark. The word 'DIMMER' as is understood in the common parlance is connected with an arrangement for regulating the supply of the electricity, but the product here is not a 'DIMMER', but a variable transformer. The Court further said that the Defendants got their trade mark 'DIMMER DOT' registered in Australia. The fact that the Defendant itself has sought to claim trade proprietary right and monopoly in 'DIMMER DOT', it does not lie in their mouth to say that the word

> 'DIMMER' is a generic expression. Therefore, injunction was confirmed.

(ii) Blue Hill Logistics Private Limited -Vs- Ashok Leyland Limited and others 2011 (48) PTC 564 (Mad)- observed,

> Once the First Defendant is permitted to use the mark “LUXURIA” on the buses purchased by them from the competitors of the Plaintiff, the competitors of the Plaintiff (VOLVO) could not also be prevented from using the said mark later on. There is no bonafide/honest conception of the trade mark “LUXURIA” by the 1st Defendant. Plaintiff has established a case to attract the ingredients of Section 29(4) and the infringing by use of such mark would amount to 1st Defendant taking unfair advantage of reputation of the Plaintiff's mark and would be detrimental to the registered trade mark of the Plaintiff. Having regard to the Plaintiff's exclusive right to use of the mark and weighing the various factors and also balance of convenience, the learned single Judge granted temporary injunction. Hence, appeals were dismissed.

(iii) Anchor Health and Beauty Care Pvt Ltd., -Vs- Procter and Gamble Manufacturing Co. Ltd., and others 2014 (59) PTC 105 (Del) -observed,

> After going through the rival contentions of the parties, the court decided that after themselves obtaining and seeking registration for the marks “ALL AROUND PROTECTION” and “ALLROUNDER' it was contrary for the Defendant to state that they are generic marks and therefore not open to the Defendant to contend that the Plaintiff's registered trademark “ALLROUND” was descriptive, generic and/or devoid of any distinctive and separate character and/or not capable of being registered. It was not allowed for the Defendant to “approbate and reprobate” to the detriment of an opponent. Thus, the Judgment was in favour of Plaintiff.

Protection of mark registered for goods entitled to protection for services if related to Goods.

> When the trade is applied for a good, it is seen that in most cases the protection under that trade mark would also extend to any services that are in

relation to those good, since the likelihood of confusion would exist if there are two different trade marks in goods and services which are closely related to those goods.

I. Blue Hill Logistics Private Ltd -Vs- Ashok Leyland Ltd. And others 2011(48) PTC 564 (Mad)- observed,

Where the rival marks are identical and the goods or services are also identical, there is a statutory presumption of confusion and accordingly, a prima-facie case of infringement would exist. The onus then shifts to the Defendant. There is no similarity or association between Plaintiff's goods i.e. buses with the mark “LUXURA” and 1st Defendants's intercity transport services i.e. “LUXURIA”. Plaintiff's goods/buses are bought by bus operators, State Transport Corporation who in turn use the buses for luxurious travel of the passengers. Buyers of buses are totally different from passengers who buy bus tickets. 1St Defendant's services are enjoyed by passengers for a comfortable/luxurious intercity travel. Therefore, Plaintiff cannot complain any infringement under Sub-section (2) of Section 29 of the Trade Marks Act.

II. Bourjois limited -Vs- Naunihal Singh and others 2013(53) PTC632 (Del)- observed,

> If the product and service are closely related to each other but they also have a trade connection it would be difficult to say that the goods and services are not closely related to each other. The Defendants were passing off their services as those of the Plaintiffs by using the impugned trademark/trade name for rendering saloon/spa services and as a part of their domain name. The Defendants are accordingly liable to be injuncted from using the impugned trademark/trade name.

III. Many Kagliwal and others -Vs- Mayo Foundation for Medical Education and Research, USA (2018 (2) MhLJ720) -observed,

> Goods are "related" if customers are likely to mistakenly think that the infringer's goods come from the same source as the senior user's goods or are sponsored by, affiliated with or connected with the senior user. Further, observed there is sufficient proximity between the businesses of the Defendant

and the Plaintiff and dismissed the appeal ruling in favour of the Plaintiff.

Mark infringed if used as trade name by another person

This ratio applies to a situation where the trade mark of a company is being used as the trade name of another company. Eventually any product with the same name in the market is likely to be associated with the company, especially in cases where the good are identical. Therefore, in these situations, where the trade name of a company is so similar to the trade mark of another, a right against the infringement arises.

(I) Cipla Limited -Vs- M/s. Cipla Industries Pvt. Ltd 2016(67) PTC 509 (Bom)- observed,

By giving the provisions a literal interpretation, the bench held that in to be able to invoke Section 29(4), the Plaintiff would have to show that the Defendant's mark was identical with or similar to the Plaintiff's registered trademark and was used in relation to dissimilar goods/services. Section 29(5) applied in cases where the Plaintiff's registered trademark had been used as a corporate name by the Defendant with respect to same/similar goods/services. The bench affirmed that Sections 29(4) and 29(5) were mutually exclusive and no cause of action would exist when a registered trademark was used as a corporate name with respect to dissimilar goods. While the Judgment is based on a literal interpretation of the law, it does affect the statutory rights of holders of well-known trademarks. That said, a passing off action may still be initiated in such scenarios.

(ii) Mankind Pharma Ltd -Vs- Chandra Mani Tiwari & Anron 6 July, 2018 2018(75) PTC8 (Del)-observed,

Mere affixation of the name of the Defendant company as manufacturer or marketer of the drugs/medicines sold by the Defendants, would not be sufficient use as a trade mark, even under Section 29(6). Similarly, they held that use of registered trademark as trade name or part of trade name was absent, the Court held that there was no infringement under clause (5) of Section 29. It was held that just by virtue of the fact that MERCYKIND may be deceptively similar to MANKIND or any other registered trade mark of Plaintiff with KIND as prefix or suffix, would not amount to infringement under Section 29(5).

(iii) Kala Niketan v/s Kala Niketan AIR 1983 Delhi 161, ILR 1981 Delhi 592 (Kala Niketan Case) 1981 PTC 213 -observed,

that the adoption of the Trade Name 'Kala Niketan' by the Defendant was to ride on the popularity of the Plaintiff's Trade Name and granted a decree for permanent injunction restraining the Defendant from dealing in Sarees and other textile goods in the name of 'Kala Niketan' or any other identical or deceptively similar Trade Name.

(iv) Atlas Cycles (Haryana) Ltd. Voluntary statement Atlas Products Pvt. Ltd. 2008 (36) PTC 269 Del (Atlas Case).

The Court in this case found the Defendant used the said Trade Mark to deceive and confuse the public as to the origin of goods and therefore held against the Defendant. However, the court did not restrain the Defendant from using the said Trade Name. The court instead went against the Plaintiff's reasoning that the Plaintiff had raised this issue after 7 years of incorporation of the

Defendant Company and that if an injunction is granted, it will cause serious prejudice to the Defendant. The Court held that restraining the Defendant from using it corporate name at this juncture, which it has nurtured for the last more than seven years, would result in a “civil death” for the Defendant.

(v) Raymond Ltd v Raymond Pharmaceuticals 210(44) PTC (Bom)

In this case the Division bench and the Single judge bench of Bombay High Court favoured the Defendant by pointing out that they were for different goods, and operated in completely different fields. They also held that the domain name of the Defendant incorporates part of its corporate name and the corporate name of the Defendant is not actionable as infringement of the mark.

In Civil Revision Petition No.426 of 2023 (IPR) dated 07.06.2024 in case of M/s BTV Kannada Private Limited v/s M/s Eagle Sight Media Private Limited (ESMPL) and others, observed that, As can be readily noticed, Section 21 supra, has an overriding effect over anything inconsistent with the provisions of the Act of 2015, except as otherwise provided. Hence, it cannot be said that the provisions of the Act of 1958 prevail over Section 12 of the Act of 2015 when it comes to the valuation of the subject matter for the purpose of the jurisdiction of the Court, in a commercial dispute, in a situation where any other law provides for the valuation of the suit for the purpose of jurisdiction or jurisdiction irrespective of valuation. Thus, “specified value of the subject matter” in a suit falling under the Act of 1999 will have to be under Section 12 of the Act of 2015. The said value in a suit for recovery of money will be the value of the money sought to be recovered and valuation has to be provided under Section 12(1)(a) of the Act of 2015. Under Section (12)(1)(b) and (c) of the Act of 2015, the “specified value of the subject matter” is the actual market value of the subject matter i.e., the movable or immovable property as the case may be as on the date of the suit.

Whereas, in Section 12(1) (d) of the Act of 2015, the specified value is the value of the relief estimated by the Plaintiff and there is no need to value the property.

Whether Section 12 of the Act of 2015 is repugnant to the provisions of the Act of 1958. Though the learned senior counsel appearing for the respondent would urge that Section 12 of the Act of 2015 is repugnant to the provisions of the Act of 1958, as already held, Section 50 of the Act of 1958 yields to any other law providing for the jurisdiction of the Court in situations already discussed supra. This being the position, the repugnancy if any, in the provisions of the Act of 1958 and Section 12 of the Act of 2015 is taken care of under Section 50 of the Act of 1958 itself as the said provision paves the way for Section 12 of the Act of 2015 to operate. Hence, there is no need to dwell on the contention based on Article 254(2) of the Constitution of India.

This Court has considered the aforementioned judgment. In the said case, the

Court has held that the issue relating to the valuation is a mixed question of law and fact. In the said case, the dispute was on the question of undervaluation and the Defendant's objection was to the court fee and not on jurisdiction. In such circumstances, this Court held that once the question relating to valuation is adjudicated, there cannot be a revision petition challenging the said order. However, in the present case, the issue is different. The question raised is a jurisdictional issue that results in the termination of the proceeding if answered in favour of the petitioner.

It is also urged by the learned Senior counsel for the respondent that the remedy under Section 115 of the Code of Civil Procedure ('Code' for short) is not available as even if the petition is allowed, the matter has to be remitted to the trial Court for providing the 'specified value of the subject matter' as contemplated under Section 12 of the Act of 2015. As a result, the proceeding before the trial Court will not be terminated and the

Civil Revision Petition under Section 115 of the Code is not maintainable.

It is to be noticed that in MFA No.7382/2022, this Court in an earlier round of litigation has directed the Plaintiff to provide the specified value within 15 days from the date of the order dated 02.01.2023. The order also refers to the earlier order in CRP No.545/2022 where there was a direction to value the suit under Section 12 of Act of 2015. Order VII Rule 11(b) of the Code which provides for the rejection of the plaint if the valuation is not provided within the specified date. Since the valuation is not provided as required, the plaint has to be rejected which results in termination of the proceeding before the Trial Court. Hence, the Civil Revision petition is maintainable. However, as the learned senior counsel on a specific query by the Court submits that the specified value of the movable and immovable properties exceeds Rs. 3 lakhs. Hence, instead of rejecting the plaint, this Court directs the return of the plaint to enable the

> Plaintiff to present the suit before the jurisdictional "Commercial Court" by complying the other formalities of the plaint mandated under the Act of 2015.

The principles in the above authorities clearly lay that, Person claiming exclusive rights over an expression cannot challenge the same as generic. When the trade is applied for a good, it is seen that in most cases the protection under that trade mark would also extend to any services that are in relation to those good, since the likelihood of confusion would exist if there are two different trade marks in goods and services which are closely related to those goods. Where the rival marks are identical and the goods or services are also identical, there is a statutory presumption of confusion and accordingly, a prima-facie case of infringement would exist. The onus then shifts to the Defendant.

Factors that should be considered while deciding such a case is: 1. Nature of the goods (word, label, device); 2. Degree of resemblance; 3. Nature of the mark; 4. Similarity in the nature, character and performance of the goods and rival traders; 5. Class of purchasers who are likely to buy the goods bearing the mark they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the good; 6. Mode of purchasing; 7. Any other surrounding circumstances.

If the packets were of the same size and colour scheme and although the design was not the same, they bore a close resemblance that could cause confusion. In an action for infringement, the Plaintiff must, no doubt, make out that the use of the Defendant's mark is likely to deceive, but where there similarity between the Plaintiff's and the Defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the Plaintiff rights are violated. Therefore, is one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, if the differences are of a character as to prevent on design from being mistaken for the other. It would be enough if the impugned mark bears such overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him.

Identity or similarity with an earlier trade mark and similarity of goods and services in respect of which were covered by the earlier trade mark had to be shown. Just for the mere outlook whether any ordinary prudent individual would be mislead by the similarity of the marks. When a trademark is a composite one, the same cannot be separated by prefix and suffix to find out the similarity and dissimilarity has to be seen.

17. **As already observed**, defendant No.7 mark is so close visually, phonetically to that of plaintiff mark and as would be likely to mislead a person usually dealing with one to accept the other if offered to him and defendant No.7 copyright being for unpublished work. At this stage concluded, plaintiff had made out a prima-facie case.

18. Further, nothing on record to show that , defendant No.7 is carrying out his business of Tea's in the name 'VEDGIRI' and was prior to that of plaintiff's name of 'DEVGIRI' though, had submitted that he is carrying out the said business from generations. Further, photo's reflect the sale of Tea product/packet under defendant No.7 mark by defendant Nos.1 to 5 keeping by the side of the plaintiff's product, which could mislead consumer of average intelligence into believing that the two marks were being used by the same manufacturer. For the same, Balance of convenience tilts in favour of plaintiff and if not injuncted, will result in irreparable injury/loss.

19. Further , in the authorities relied by the learned counsel for the Plaintiff :

In 2013(137) DRJ 273 in case of Malhotra Book Depot and others -Vs- MBD Electronics Pvt. Ltd. It is observed that,

> Plaintiff hold as many as 20 registrations and using this trade mark since the year 1956. Defendant has been using this trade mark since 1986. A perusal of the plaint shows that the Plaintiffs have adopted 'MBD' in most of the group markets and has achieved a house mark as the same prominently features in trade journals, periodicals magazines, cyber space with domain names having the house mark “MBD”. Where the trading name becomes a house hold name, under which trading name variety of activities are undertaken, even an action for passing off exclusively lies if the Defendant adopts identical or similar trademarks, even when the Defendant does not carry on similar activities.

In 2019(77) PTC 139 in case of Luxottica Groupo SPA and another -Vs- Mify Solutions pvt. Ltd and others. It is observed that,

> Plaintiff is the owner, registered proprietor and copyright owner of trademark 'OAKLEY', whereas Defendants are shifting the blame among themselves. Invoice admitted by Defendants 1 and 2, there being no denial that product was counterfeit. Defendants held guilty of infringement of Plaintiff's Trademark and Copyright. Suit decreed.

In 1995 (2) ILR (Del) 685 in case of R. Prakash -Vs- Chowdhary Plastic Works. It is observed that,

> “Where the claims stated at the end of specifications in the patent are alleged to have been infringed, the Court should construe the claims without reference to the body of

> the specifications and refer to the specifications only, if there is any ambiguity or difficulty in the construction of the claims in question. To find out whether the patent has been infringed the patented article or process has to be compared with the infringing article or process and unessential features in the infringing article or process are of no account and if the infringing goods are made with the same object in view which is attained by the patented article, then a minor variation does not mean that there is no privacy and a person is guilty of infringement if he makes what is in substance the equivalent of the patented article and some trifling or unessential variation has to be ignored."
>
> Considering the principle of interpretation of specifications and the claims of the patent granted to a party as stated above, I am of the view that on the same principles it cannot be said that the manufacturing, making or selling of the film disc by the Defendant is not an infringement of the patent granted to him.

In 2010(7) MLJ 497 in case of Consim Info Pvt. Ltd -Vs- Google India Pvt. Ltd-observed, since the first part of the discussion of the Grand Chamber revolved around Article 5(1) (a) and (b) of Directive 89/104 and Article 9(1)(a) and (b) of Regulation No.40/94, it is necessary to extract these provisions, in order to have a contextual understanding of the opinion delivered by the European Court of Justice. Article 5(1)(a) and (b) of Directive 89/104 reads as follows:

> "5.1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be

entitled to prevent all third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered:

(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark." Article 9(1)(a), (B) and (c) of Council Regulation No.40/94 reads as follows:

"9.1 A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered;

(b) any sign where, because of its identity with or similarity to the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public, the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) any sign which is identical with or similar to the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark

> is registered, There the latter has a reputation in the community and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the community trade mark."

Applying the above principle, the Court held that from the advertiser's point of view, the selection of a keyword identical with a trade mark has the object and effect of displaying an advertising link to the site on which he offers his goods or services for sale and that since the sign selected as a key word is the means used to trigger that display, the advertiser must be held to be using it in the context of commercial activity and not as a private matter. Even from the point of view of the referencing service provider (search engine), the Court held that the storage as keywords, of trademarks, for the benefit of the clients of the search engine constituted a commercial activity carried on with a view to economic advantage. Consequently, the Court held that the referencing service provider was actually operating "in the course of trade" while permitting advertisers to select, as keywords, signs identical, with trademarks, stores those signs and displays to its clients' on the basis thereof. However, the Court clarified that it does not follow as a corollary that the service provider itself uses those signs within the terms of Article 5 of Directive 89/104 and Article 9 of Regulation No.40/94. The Court then pointed out that the fact of creating the technical conditions necessary for the use of a sign and being paid for that service does not mean that the party offering the service itself uses the sign.

20. In other words, the service provider should have had neither knowledge nor control over the information which is transmitted or stored. The role of the service provider should be neutral, in order to establish that its liability was limited under Article 14.

> If the service provider had not played such a role, the **ECJ pointed out that they cannot be held liable for the date which it has stored at the request of an advertiser, unless, having obtained knowledge of the unlawful nature of those data or of that advertiser's activities, it failed to act expeditiously.**
>
> According to Mc Carthy, 'the issue of descriptiveness is usually tested from the view point of the hypothetical customer, who has the basic amount of knowledge about the product, which is conveyed by advertising and promotion currently available in the market place'.
>
> Section 29 reads as follows:
>
> "29. Infringement of registered trade marks – (1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark,

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark.

A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered. (6) For the purposes of this section, a person uses a registered mark, if, in particular, he-

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark.

21. For the above discussion, Points No.1 to 3 are answered in the ***Affirmative***.

22. **Point No.4**: In view of my findings on Point Nos.1 to 3, this Court proceeds to pass the following:

ORDER

I.A. No.3 filed by Plaintiff under Order 39 Rule 1 and 2 read with Section 151 of Civil Procedure Code is hereby allowed.

Defendant's are hereby restrained from using the name and/or mark and/ or artistic work including on any products and on the sales or domain name, interalia containing the word/mark 'VEDGIRI' and/or any other word/name/expression/label identical with and/or deceptively similar thereto similar with that of Plaintiff registered mark “DEVGIRI”, in any manner whatsoever, including and not limited to use of it on the products/sales counter offline or online through internet or any other such form of use, in relation to manufacturing, preparing, selling, marketing of same or similar goods and services so as to infringing/passing off the Plaintiff trademark and artistic work 'DEVGIRI'.

(Typed by the Stenographer Gr-I to the dictation, the transcript corrected and signed by me and then pronounced in the open court on this the 18th day of February, 2025.)

(Sunitha S.G.)
IV Addl. District & Sessions Judge,
D.K., Mangaluru.

SUNITHA S G

Digitally signed by SUNITHA S G
Date: 2025.02.21 11:12:55 +0530