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**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
O. O. C. J.**

IN ITS COMMERCIAL DIVISION

**COMMERCIAL NOTICE OF MOTION (Lodging) No. 1468 OF 2019
IN
COMMERCIAL IP SUIT NO. 702 of 2019**

FinTree Education Pvt. Ltd. & Anr ..Applicants.

In the matter between :

FinTree Education Pvt. Ltd. & Anr ..Plaintiffs.

Vs

Fintree Finance Private Limited ..Defendant.

—

Mr. R.S. Apte, Senior Advocate a/with Mr. K.A. Dhavle for the Applicants/Plaintiffs.

Mr. Deepakar Livingston, Mr. Kamlesh Mali a/with Mr. R.P. Shirole , Advocates for the Defendant.

**CORAM : B. P. COLABAWALLA, J.
SEPTEMBER 18, 2019.**

P.C.:

1. This Notice of Motion has been pressed for ad-interim reliefs. In the Notice of Motion a relief is sought for injunction against the defendant from infringing plaintiff No.2's registered trade mark "FinTree" bearing application No. 2384560 and Certificate No. 1312936 in any manner and from using the mark "FinTree" in relation to any signboards, banners, entrance, hoardings, invoices, websites/domain name, or any other electronic media. A receiver is also sought for search and seizure from the defendant's office.

2. Mr. Apte, the learned Senior Counsel appearing on behalf of the plaintiffs submitted that plaintiff No.1 is a Company engaged, inter alia, in providing classroom and online training for professional certifications like CFA (Chartered Financial Analyst Course based in USA), FRM (Financial Risk Management), CFPCM (Chartered Financial Planner) and Financial Modelling. Plaintiff No.1 has developed a revolutionary platform for e-learning which is used by 10000 + candidates in over 60 countries. According to the plaintiffs, they are also engaged in providing financial consultancy services to various Companies. Mr. Apte, then submitted that plaintiff No.2 is the proprietor of the mark FinTree and has been

using the said mark since December, 2011. Prior to the incorporation of plaintiff No.1 Company, plaintiff No.2 operated "FinTree" as a sole proprietorship for the purpose of finance training and finance consulting business. He stated that plaintiff No.2 has registered its mark "FinTree" under the Trade Marks Act, 1999, the details of which are stated in paragraph 4 of the plaint. The mark has been registered under Certificate No. 1312936 dated 23rd August, 2016.

3. Mr. Apte submitted that the defendant appears to be a Non-banking Financial Company engaged in the business of lending monies to Micro-Small and Medium Enterprises in India by helping them with needed financial support and because of positive social impact. Mr. Apte thereafter brought to my attention the averments in paragraph 9 which inter alia states that in the month of January, 2019 the plaintiff came to know that the defendants were using the mark "FinTree" with a deceptively similar image. The plaintiff also came to know that the defendant has been attempting to register the mark "FinTree" with deceptively similar mark under Class 36. It is in these facts and circumstances that the Motion has been pressed for ad-interim reliefs for the purposes of an injunction and seeking the appointment of a Court Receiver. Mr. Apte submitted that

having a registered trade mark "FinTree", the defendant could not use the same and therefore at least at this stage an ad-interim injunction ought to be granted in favour of the plaintiff.

4. In this Notice of Motion the defendant has appeared and filed an affidavit-in-reply. Apart from taking me through the affidavit in reply, the learned Advocate appearing on behalf of the defendant brought to my attention the mark and label used by the plaintiff and which could be found at page No.24 of the plaint and the one used by the defendant (page 48 of the affidavit-in-reply). He submitted that on comparison of these two marks, it is totally incorrect on the part of the plaintiff to contend that two are identical or deceptively similar. On a plain look at these two, would clearly show that the two marks are totally different. The learned Advocate for the defendant also brought to my attention the provisions of Section 29 of the Trade Marks Act, 1999 and more particularly Section 29 (5) thereof. Relying upon these provisions, the learned Advocate submitted that Section 29 (5) stipulates that a registered trademark is infringed by a person if he uses such registered trademark 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. He submitted that in the present case, the word "FinTree" is a part of the trade name of the defendant and the trade carried on by the defendant is not for any goods or services in respect of which the plaintiff's trademark is registered. He submitted that the plaintiff is engaged in a totally different business, namely, that of education and that is why the trademark "FinTree" has been registered under Class 41. The registration that is sought by the defendant is under Class 36 which is really for services rendered in financial and monetary affairs and services rendered in relation to insurance contracts of all kinds. He submitted that the present suit is not for passing off but only for infringement of the plaintiff's trade mark. He submitted that this being the case, Section 29 (5) would be squarely attracted and therefore unless it was shown that the defendant was using the said trade mark, as a part of his trade name or a part of his business concern, dealing in goods and services in respect of which a trademark is registered, no injunction could be granted. In this regard, the learned Advocate relied upon a decision of a Full Bench of this Court reported in the case of **Cipla Ltd. vs. Cipla Industries Pvt. Ltd.** (2017 (2) Mh.L.J. 877 and more particularly paragraphs 25 to 27 thereof. The

learned Advocate for the defendant therefore submitted that there was no question of granting any ad-interim relief as no prima facie case was made out by the plaintiff.

5. I have heard the learned Counsel for the parties at some length and have perused the papers and proceedings. I have also perused the affidavit-in-reply filed on behalf of the defendant. I find considerable force in the argument canvassed on behalf of the defendant. Firstly, when one compares page 24 of the plaint with page 48 of the affidavit-in-reply, there is absolutely nothing similar between the two. The colour scheme is totally different, the position of the tree is totally different, the shape of the tree is totally different and what is stated below the name is also totally different. There is therefore no question of there being any deception in the mind of the person as what is used by the defendant being passed off as that of the plaintiffs.

6. Besides this, in any event, as mentioned earlier, the present suit is not for passing off. It is only for infringement. Section 29 (5) clearly stipulates that 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. What this effectively means is that if a party is found to be using a registered trade mark as a corporate or trading name or style in respect of goods dis-similar to ones for which the trade mark is registered, then there would be no infringement and consequently the plaintiff would not be entitled to any injunction. This provision, in fact, came up for interpretation before a Full Bench of this Court in the case of **Cipla Ltd. (supra)**. In paragraphs 25 to 27 of this decision the Full Bench opined as under :-

“25. Now we come to Sub-Section (5). It applies when a person uses a 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 provided his trade or business is of dealing with goods or services in respect of which the trade mark is registered. If both the conditions are satisfied, it is not necessary to prove anything further for establishing the infringement. It is not necessary to prove that the use of trade mark as a trade or business name is likely to cause any confusion on the part of the public. It is not necessary to prove that such user takes unfair advantage or such use is detrimental to the distinctive character of the registered trade-mark or its repute. Therefore, Delhi High Court in the case of Bloomberg has rightly described the provision of Sub-Section (5) as "no fault provision". This provision is distinct from Sub-Section (4). To attract this Sub-Section, the person who infringes the trade mark should be doing trade or business in goods or services in respect of which the trade mark is registered. Sub-Section (4) applies when the person against whom allegation of infringement is made uses a mark in relation to goods or services which are not similar to those for which the trade mark is

registered. Sub-Section (4) does not refer to use of a registered trade mark as a part of corporate/ trade/business name. It applies when a mark is used during the course of trade in relation to dissimilar goods or services. Sub-sections (5) applies specifically to a case where the registered trade mark is used as a part of business/corporate name provided the business of the infringer is of dealing with the goods or services in respect of which the trade mark is registered.

26. Unless both the conditions are satisfied, Sub-Section (5) will not apply. The question before us is when the first condition of Sub-Section (5) is satisfied but the second is not satisfied, whether Sub-Section (4) can be invoked. In other words, the question is whether a person who is dealing with goods or services which are dissimilar to those for which the trade mark is registered, uses registered trade mark as a part of business/corporate name, such use will attract the mischief covered by Sub-Section (4). The plain language used by the Sub-Sections (4) and (5) answers the question. Sub-Section (4) provides that "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 - (a) is identical with or similar to the registered trade mark, and (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered..." Thus, the provision is attracted when a mark which is identical with or similar to registered trade mark is used in the course of trade in relation to goods or services which are not similar to those for which the trade mark is registered. Whereas Sub-Section (5) provides that "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...".

27. The Sub-Section (4) uses the words "in the course of trade" and "in relation to goods or services" which are absent in Sub-Section (5). The Sub-Section (5) uses the words "..... 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.." These words are conspicuously absent in the Sub-Section (4). The difference in the phraseology and language used in the two Sub-Sections makes it clear that Sub-Section (4) applies in "trade mark versus mark" situation. It applies when the mark is used in the course of trade in relation to goods and services. Sub-Section (5) applies to a "trade mark versus trade/corporate/business name" situation. It is a special provision which is different from Sub-Sections (1), (2) and (4). Thus, Sub-Sections (4) and (5) apply to different situations arising out of use of a mark. Sub-Section (5) does not make Sub-Section (4) otiose. The fact that the definition of the word "mark" includes "name" is of no

consequence while interpreting Sub-Sections (4) and (5). If we hold that Sub-Section (4) will apply to those cases where the first condition of Sub-Section (5) is satisfied but second one is not satisfied, the requirement specifically incorporated in Sub-Section (4) of the mark being used in relation to goods and services will become redundant. A statute cannot be interpreted in such a manner. The use of trade mark as a part of corporate/business/trade name cannot be read into Sub-Section (4).”

7. I find that the ratio laid down by this decision squarely applies to the facts of the present case. As mentioned earlier, the services that are being rendered by the plaintiffs are totally dissimilar to the services rendered by the defendant. This is also clear from the fact that the plaintiffs’ trade mark is registered under Class 41 whereas the defendant has sought registration of its trade mark under Class 36. Class 41 deals with registration in relation to education, providing of training entertainment, sport and cultural activities. Registration under Class 36 deals with insurance, financial affairs, monetary affairs, real estate affairs. The mark of the plaintiff is admittedly not registered under class 36 and is only registered under Class 41. This being the factual position, at least prima facie and at the ad-interim stage, I find considerable force in the argument of the defendant that the plaintiff is not entitled to any injunction as the services rendered by the defendant are dissimilar to that of the services rendered by the plaintiffs.

8. This being the case, the plaintiffs are not entitled to any ad-interim reliefs. For the sake of clarity, I must state that the reason why I said that Section 29 (5) is the provision that would be relevant for our purposes is because it is clear that the trade mark "FinTree" is used by the defendant as its trade name or a part of its trade name. It is for this reason that the conditions laid down in Section 29 (5) would have to be first complied with before any injunction can be granted. This having not been done, I find that no ad-interim reliefs can be granted. The prayer for ad-interim reliefs is therefore rejected.

9. Place the Notice of Motion for hearing and final disposal on 15th October, 2019 as per its turn.

(B. P. COLABAWALLA, J.)