

# Rajkumar Sabu vs Kaushalya Devi Sabu & Ors on 22 January, 2019

**Author: Rajiv Sahai Endlaw**

**Bench: Rajiv Sahai Endlaw**

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\* IN THE HIGH COURT OF DELHI AT NEW DELHI  
+ CS(COMM) 761/2016, CC(COMM) 10/2019 & IAs No.7624/2016  
(u/O XXXIX R-1 & 2 CPC), 7695/2016 (of defendant u/O XXXIX R-4 CPC), 8224/2016 (u/O XXXIX R-2A CPC), 8249/2016 (u/O XXXIX R-2A CPC), 8816/2016 (of defendant u/O XXXIX R-1 & 2 CPC), 9728/2016 (u/O XXXIX R-2A CPC), 11889/2016 (u/O XXXIX R-2A CPC), 1302/2017 (u/S 151 CPC for delay).  
RAJKUMAR SABU ..... Plaintiff

Through: Mr. Abhinav Vasisht, Sr. Adv. with  
Mr. Divyakant Lahoti, Ms. Priya  
Chauhan, Ms. Nupur Kumar, Ms.  
Amrita Grover and Mr. Parikshit  
Ahuja, Advs.

versus

KAUSHALYA DEVI SABU & ORS. .... Defendants

Through: Mr. A.K. Singla, Sr. Adv. with Mr.  
Shailen Bhatia and Ms. Neelam  
Pathak, Advs. for D-1&2.  
Mr. A.K. Singh and Ms. Ekta Nayar  
Saini, Advs. for D-3.

CORAM:

HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW  
ORDER

% 22.01.2019

1. The plaintiff has instituted this suit for permanent injunction restraining the defendants from infringing the mark 'SACHAMOTI' in relation to Sabudana of the plaintiff and from passing off their goods as those of the plaintiff and for ancillary reliefs.

2. The suit came up before this Court first on 10th June, 2016 when vide ex parte order, which continues to be in force, the defendants were restrained from using the trade mark 'SACHAMOTI' or any other trade mark which is CS(COMM) 761/2016 page 1 of 11 deceptively similar to the plaintiff's trade mark 'SACHAMOTI', amounting to infringement of the plaintiff's registered trade mark and passing off.

3. The defendants, besides filing their written statements, have also filed a Counter Claim to restrain the plaintiff from using the mark 'SACHAMOTI', claiming to be the prior user thereof. The senior counsel for the defendants states that the defendants claim to be the proprietor and prior user of the

mark 'SACHAMOTI' and have discovered the registration obtained by the plaintiff of the said mark and have thus filed the Counter Claim for permanent injunction restraining passing off. However in the same breath it is informed that the defendants had made a similar claim in a suit before the Salem Court and in which suit an interim order has been granted by the High Court of Madras restraining the plaintiff from using the mark 'SACHAMOTI'. It is however further informed that the plaintiff has approached the Supreme Court against the said order and the order of the Madras High Court has been stayed.

4. On enquiry as to how the defendants can maintain a Counter Claim in this Court when have made a similar claim before the Salem Court, the senior counsel for the defendants withdraws the Counter Claim.

5. Counter claim CC(COMM) No.10/2019 is dismissed as withdrawn.

6. The question of entitlement to use of 'SACHAMOTI' being subject matter of the lis pending in the Supreme Court, is not to be decided in this Court. Thus the injunction restraining the defendants from using the mark 'SACHAMOTI' has to be confirmed with liberty to the parties to apply for variation/modification after the outcome of the proceedings in the Supreme Court.

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7. However the defendants, after interim injunction order dated 10th June, 2016, have commenced using the mark 'SACHASABU' and the arguments by the senior counsel for the plaintiff and the senior counsel for the defendants have been heard with respect to the same.

8. The packaging of the product of the plaintiff and the defendants is as under:-

Plaintiff's packaging CS(COMM) 761/2016 page 3 of 11 Defendants' packaging

9. It is the contention of the senior counsel for the plaintiff that the use after the interim ex parte order of injunction by the defendants of 'SACHASABU' with packaging aforesaid is in violation of the ex parte order of injunction and in which regard several applications under Order XXXIX Rule 2A of the Code of Civil Procedure, 1908 (CPC) are pending.

10. Per contra, the senior counsel for the defendants has contended that there is no plea also in the plaint of 'SACHASABU' being an infringement of or amounting to passing off of 'SACHAMOTI'.

11. On my observing in the Court that 'SACHAMOTI' and 'SACHASABU' are two different words and cannot be split up and CS(COMM) 761/2016 page 4 of 11 dissected for the purpose of judging the infringement and/or passing off and the difference between the two words is bound to be noticed by a consumer, whether illiterate and innocent or educated and discerning, the senior counsel for the plaintiff has not pressed infringement of 'SACHAMOTI' by use of 'SACHASABU' and confined challenge to the act of the defendants amounting to passing off on account of similarities in the two packaging. It is argued (i) that the colour combination of the two packaging is the same i.e. of red,

orange and yellow; (ii) the sunrays on the packaging of the plaintiff have been copied by the defendants; (iii) that the preparations which can be made from the contents of the packaging have been displayed identically; (iv) the defendants having copied the four bowls and two platters as shown on the packaging of the plaintiff; (v) the arrangement of the contents of the bowl and platter on the packaging of defendants is also identical to that on packaging of plaintiff; (vi) the angle of the spoon in the bowls also is identical to that in the packaging of the plaintiff; (vii) that the dressing on the contents of the bowl on the left hand side has also been copied; and, (viii) the border of the packaging of the defendants is of pearls, which is the dominant feature in the packaging of the plaintiff.

12. I have enquired from the senior counsel for the plaintiff, whether not the uses of the contents of the two packaging can be only as shown in the packaging and whether one manufacture/supplier is entitled to restrain another from showing the same preparations.

13. The senior counsel for the plaintiff contends that the display can be different on the two packaging and if the two packets are kept in a retail CS(COMM) 761/2016 page 5 of 11 shop stacked together, 'SACHASABU' can be passed off in place of 'SACHAMOTTI'.

14. I have considered the aforesaid contentions.

15. As far as the colour scheme is concerned, the dominant colour in the packaging of the plaintiff is yellow as against the colour red in the packaging of the defendants. Though the packaging of the defendants also has red towards the borders but the hue of the two reds is different.

16. Undoubtedly the rays emanating from the centre of the packaging are the same but while the rays in the packaging of the defendants are in white colour against red background and emanating from the pearl in an oyster shell forming the predominant feature of the packaging of the plaintiff, rays in the packaging of the plaintiff are in white colour against the predominantly yellow background and are not emanating from a pearl in an oyster shell.

17. As far as the pearl at the centre of the packaging of the plaintiff and the string of white circles at the border of the packaging of the defendants are concerned, the circles on the packaging of the defendants at the border are much smaller and do not create an impact of a pearl as is clearly created in the packaging of the plaintiff.

18. The arrangement of dishes of the bowls and platters in the two packaging is however identical and it is felt that the possibility of the same misleading an unaware consumer, notwithstanding the other distinctions, cannot be ruled out. I have thus enquired from the counsel for the defendants, how much time the defendants require to change the said part of CS(COMM) 761/2016 page 6 of 11 the packaging, to be different from the packaging of the plaintiff.

19. The counsel for the defendants states that the defendants have six months of packaging and will also require approval from AGMARK and would need six months to change the said part of the packaging.

20. It is deemed appropriate to grant the said time to the defendants.

21. The parties are also at issue with respect to the endorsement at the rear of the packaging of the defendants of, 'SACHASABU' being manufactured by the makers of 'SACHAMOTI'.

22. As aforesaid, the parties are at issue as to who is the rightful owner of 'SACHAMOTI', the defendants or the plaintiffs. However as of today the registration of 'SACHAMOTI' and for rectification of which proceedings in Intellectual Property Appellate Board (IPAB) are stated to be pending, is in favour of the plaintiff.

23. It being not in dispute that the defendant no.2 Gopal Sabu is the brother of the plaintiff and the two, till the year 2015 were together in the business under inter alia the mark 'SACHAMOTI', I have enquired from the senior counsel for the plaintiff whether the defendants can be deprived of claiming their past experience in the subject goods, then under the mark 'SACHAMOTI'.

24. However on further consideration, being of the prima facie view that the purpose of the law of trade marks being, to not allow any person to claim a connection with the mark of another, thereby deriving commercial advantage therefrom, the defendants are not found entitled to make such a claim on their packaging.

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25. In this view of the matter IA No.7624/2016 under Order XXXIX Rules 1&2 of the CPC of the plaintiff, IA No.8816/2016 under Order XXXIX Rules 1&2 of the CPC of the defendants and IA No.7695/2016 under Order XXXIX Rule 4 of the CPC of the defendants are disposed of with the following directions:-

(i) The defendants are restrained from showing the bowls and the platters on their packaging as shown in the packaging of the plaintiff. The defendants are however granted six months' time to exhaust the packaging already got manufactured by the defendants and to obtain permissions if any required for effecting the said change in the packaging. Thus, this order of injunction will come into force w.e.f. 22nd July, 2019.

(ii) The defendants are also restrained from using the mark/word 'SACHAMOTI' on their packaging, e-mail ID, trade websites or otherwise, even if to show the experience of the defendants in sale and supply of the goods then under the mark 'SACHAMOTI'.

(iii) However the same will not come in the way of the defendants using the mark 'SACHASABU'.

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26. Needless to state that the aforesaid will be subject to outcome of the proceeding in the Supreme Court and with liberty to the parties to apply for variation/modification.

27. IAs No.7264/2016, 8816/2016 and 7695/2016 are disposed of.

28. IA No. 1302/2017 under Section 151 of the CPC has been filed by the defendants for condonation of eight days delay in filing documents.

29. The said application is allowed and the documents are taken on record.

30. Violation alleged in IA No.8224/2016 under Order XXXIX Rule 2A of the CPC is on account of continuance by the defendants of the domain name i.e. www.sachamotisabudana.com and www.sachamoti.in.

31. The counsel for the defendants states that the said domain names since the ex parte order, are lying dormant and inactive; neither advertising or activity of any other nature has been carried on thereon and the defendants have not posted any fresh material on the said domain names.

32. On enquiry, what is the content on the said domain names, it is stated that the same is relating to 'SACHASABU'.

33. The senior counsel for the defendants has also contended that the said domain name will be kept dormant and if the defendants at this stage give up the same, somebody else may obtain the registration thereof making it impossible for the defendants in future to get the same domain name.

34. Ex parte order dated 10th June, 2016 does not contain any specific direction with respect to the said domain names. Accordingly, it is not CS(COMM) 761/2016 page 9 of 11 deemed appropriate to impose any penalty/punishment on the defendants therefor. The defendants are however directed to forthwith remove all contents and not allow any activity whatsoever on the said domain names.

35. Yet another violation alleged in IA No.8224/2016 is, of the defendants using 'SACHAMOTI' with the device of a pearl in an oyster shell, as in the registered mark of the plaintiff, in relation to sale of coconut powder.

36. The senior counsel for the defendants states that it is the plaintiff who has got the packaging shown, manufactured and put the name of the defendants thereon to make out a case under Order XXXIX Rule 2A of the CPC. It is also contended that the date of manufacture, of after the expiry year, has also been embossed by the plaintiff.

37. The said aspect cannot be decided without evidence. The following issues are framed in IA No.8224/2016:-

(i) Whether the defendants, after ex parte ad interim order, have manufactured and sold desiccated coconut powder or any other product in the name of 'SACHAMOTI' and with the device of a pearl inside a oyster shell as in the registered mark in favour of the plaintiff? OPP

(ii) Relief.

38. Violation alleged in IA No.8249/2016 and IA No.9728/2016 of the plaintiff under Order XXXIX Rule 2A of the CPC is also taken care of by the direction aforesaid given with respect to the domain names aforesaid.

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39. The counsel for the defendants, with reference to page 320 of Part-II, Vol. II file also states that the contents thereof are no longer existing.

40. IA No.8249/2016 & IA No.9728/2016 are thus disposed of.

41. IA No.11889/2016 also under Order XXXIX Rule 2A of the CPC does not survive in view of order aforesaid and is disposed of.

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42. The counsels state that admission/denial of documents has not taken place as yet.

43. The parties to file affidavits of admission/denial of each other's documents within four weeks.

44. List for framing of issues on 26th August, 2019.

RAJIV SAHAI ENDLAW, J

JANUARY 22, 2019  
'pp'

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