

Pidilite Industries Limited vs Poma-Ex Products And 15 Ors on 2 August, 2017

Author: R.D. Dhanuka

Bench: R.D. Dhanuka

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THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION NO.2695 OF 2016
IN
SUIT NO.653 OF 2014

Pidilite Industries Limited)
a Company registered under the)
Companies Act, 1956 and having its)
registered office at Regent Chambers,))
7th Floor, Jamanalal Bajaj Marg,)
Nariman Point, Mumbai - 400 021.) .. Applicant/Plaintiff

VERSUS

1. Poma-Ex Products)
a firm/concern, having its address at)
78A OLF Gupta Colony,)
Delhi - 110009.) .. Defendant

Mr.Hiren Kamod a/w Ms.Mustafa Safiyuddin a/w Mr.Sumeet Rane a/w
Mr.Hassan Safiyuddin i/by Legasis Partners for the applicant/plaintiff.
Mr.B.N. Poojari for the defendant.

CORAM : R.D. DHANUKA, J.

RESERVED ON : 19th June 2017 PRONOUNCED ON : 2nd August 2017 Judgment :-

. By this notice of motion, the plaintiff seeks an order and injunction against the defendant, its partners, its directors, proprietors, servants, subordinates, representatives, stockists, dealers, agents and all ppn 2 nms-2695.16(j).doc other persons claiming under them from infringing any of the plaintiff's trademark 'FEVIKWIK' bearing registration Nos.465651 and 689062 in class 1 in any manner and from using in relation to any products/ impugned products the trademark 'KWIKHEAL' or any other mark which is identical or similar to the registered trademark 'FEVIKWIK' and from manufacturing, importing, selling, advertising, offering to sell or dealing in impugned products/any products under or bearing the

mark 'KWIKHEAL' or any mark which is identical or similar to the plaintiff's registered trademark 'FEVIKWIK' and for other reliefs in an action for trademark and copyright infringement and passing off.

2. Though Suit No.653 of 2014 was filed by the plaintiff against 16 defendant, during the course of submission in this notice of motion, learned counsel for the plaintiff sought leave to delete the names of the defendant nos.2 to 16 from the cause title of the plaint and also of the notice of motion and also made a statement that the plaintiff does not seek to press any relief against the defendant nos.2 to 16 in the suit as well as in the notice of motion. This Court accordingly granted leave to amend to the plaintiff to delete the names of the defendant nos.2 to 16 from the plaint as well as from the notice of motion and the reliefs sought against them. This Court has accordingly considered the grant of reliefs only against the sole defendant i.e. Poma-Ex Products in this notice of motion.

3. Some of the relevant facts for the purpose of deciding this notice of motion are as under :-

It is the case of the plaintiff that the plaintiff is world- renowned in the field of adhesives and sealants, construction and paint ppn 3 nms-2695.16(j).doc chemicals, automotive chemicals, art materials, industrial adhesives, industrial and textile resins and organic pigments and preparations since 1959. The products of the plaintiff are sold under the well known trademarks FEVIKWIK, FEVICOL, FEVISTIK, FEVICRYL, FEVI BOND, FEVIART, FEVIGUM, FEVITITE, M-SEAL and DR.FIXIT.

4. On 6th January 1987, the mark of the plaintiff 'FEVIKWIK' was registered bearing registration no.465651 in class 1 in respect of "cynoacrylate instant adhesive for domestic, technical and industrial purposes." The said registration is valid and subsisting. The said registration, however, contained a condition "Registration of this trademark shall give no right to the exclusive use of the letters 'KWIK' except as shown in the representation of mark." It is the case of the plaintiff that the plaintiff also registered mark "FEVIKWIK" written in a stylized manner in class 1 bearing registration No.689062 on 4th December 1995 in respect of "instant adhesive for domestic, technical and industrial purposes." On 2nd May 1996, the mark "FEVIKWIK" was registered bearing registration No.705500 in class 1 in respect of "adhesive for domestic, technical and industrial purposes included in class 1." The said registration is also valid and subsisting. It is the case of the plaintiff that in or about November 2007, the plaintiff designed and adopted a new unique and distinctive packaging for its "FEVIKWIK" products.

5. On 21st January 2008, the plaintiff applied for and obtained registration of the FEVIKWIK Distinctive Packaging in class 1 bearing registration no.1643621 in respect of "chemicals used in industry, unprocessed artificial resins, unprocessed plastics, tempering and ppn 4 nms-2695.16(j).doc soldering preparations, chemical substances for preserving foodstuffs, tanning substances, adhesives used in industry, cement for mending broken articles, cement waterproofing preparations, waterproofing chemicals in class 01." On 21st January 2008, the plaintiff applied for and obtained registration of FEVIKWIK Distinctive Packaging in class 16 bearing registration no.1643620 in respect of "stationery, office requisites (except furniture), instructional and teaching

materials (except apparatus), writing instruments, adhesive tapes, glue stick included in class 16."

6. In so far as the ownership of the copyrights in the artistic work comprised in FEVIKWIK Distinctive Packaging is concerned, it is the case of the plaintiff that the said packaging was created in-house by an employee of the plaintiff during the course of employment and constituted an original artistic work in which copyrights subsist.

7. It is the case of the plaintiff that the gross sales turnover of the plaintiff of its FEVIKWIK products which in the accounting year 2004-05 was Rs.46.43 crore became Rs.305.33 crore in the accounting year 2012-13. The plaintiff has placed reliance on the certificate issued by the Chartered Accountants Udeshi Shukla & Associates on 12 th September 2013. It is also the case of the plaintiff that the plaintiff has spent considerable amount of money as and by way of the advertisement and sales and promotional expenditure for promoting sale of the Fevi kwik products including those sold in the FEVIKWIK Distinctive Packaging.

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8. According to the plaintiff, the plaintiff has incurred the advertisement and sales and promotional expenditure during the accounting year 2005-06 at Rs.292.26 lakh whereas the said amount was increased to Rs.2124.98 lakh in the accounting year 2012-13. The plaintiff has placed reliance on the certificate of the Chartered Accountants dated 12th September 2013 in support of its case that the said amounts were incurred by the plaintiff on advertisement and sales and promotional expenditure for promoting sale of fevi kwik products including those sold in FEVIKWIK Distinctive Packaging. According to the plaintiff, the said products have been widely advertised on several T.V. Channels apart from the other modes of sales promotion.

9. Learned counsel appearing for the plaintiff invited my attention to the certificate of registration of trade mark dated 6 th January 1987 in respect of the mark 'FEVIKWIK.' He submits that in the said registration certificate, there was a disclaimer for exclusive use of letters "kwik" except as shown in the representation of the mark. He also invited my attention to the certificate of registration of trade mark dated 19th December 2007 in respect of the mark "Fevi kwik." He submits that in respect of the said second certificate of registration of trademark, there was no disclaimer in respect of the element "kwik" or any part of the trademark "Fevi kwik." He submits that the plaintiff was thus entitled to use the mark "Fevi kwik" exclusively. There were two separate elements of the trademark i.e. "Fevi" and "kwik." He submits that the plaintiff had adopted FEVIKWIK Distinctive Packaging.

10. Learned counsel invited my attention to page 36 of the plaint. He submits that the essential feature of the said packaging for its ppn 6 nms-2695.16(j).doc Fevi kwik products comprises of the plaintiff's unique and distinctive colour combination of yellow and shades of blue, the mark "Fevi kwik"

written in red lettering with a blue ball device depicted at the right side of the top of the word "Fevi kwik", the words "one drop instant adhesive" on the top of the mark and depiction of the product contained house mark Pidilite on the left side of the

packaging.

11. Learned counsel for the plaintiff invited my attention to a copy of the certified entries of the register of trademarks dated 24 th October 2009 for use in legal proceedings in respect of trademark registration bearing No.809473 in class 1 and submits that in the said certificate, there was a condition imposed that "registration of this trademark shall give no right to the exclusive use of all other descriptive matters appearing on the label." He also invited my attention to the certificate dated 7th October 2009 in respect of label "Fevi kwik" which imposed a condition that "registration of this trademark shall give no right to the exclusive use of word "KWIK." He submits that out of four certificates of registration, there was no disclaimer in two certificates whereas there was disclaimer in respect of remaining two certificates. There was a disclaimer of use of the word "KWIK." He submits that two of the marks are word marks.

12. Learned counsel for the plaintiff invited my attention to the photograph of the mark 'Fevi kwik' at Exhibit 'H' of the plaint and submits that the said trademark contains two elements. He also invited my attention to the photograph of the mark used by the defendant at Exhibit 'J' of the plaint i.e. "Kwikheal."

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13. It is submitted that on bare perusal of the impugned products of the defendant, it is apparent that the same is a colourable imitation of the FEVIKWIK products of the plaintiff. The products of the defendant are packaged in packaging which copies the FEVIKWIK Distinctive Packaging in an identical manner and comprised of unique and distinctive colour combination of yellow and shades of blue of the plaintiff's trademark. He submits that the mark "KWIKHEAL" which is similar to the mark "FEVIKWIK" written in an identical font and red lettering as that of FEVIKWIK. He submits that an identical blue ball device is depicted at the top of the words "KWIKHEAL."

14. It is submitted that the words "one drop instant adhesive" at the bottom of word "KWIKHEAL" is also identical to the word mentioned on the trademark "FEVIKWIK" which is registered trademark of the plaintiff. He submits that the defendant has thus infringed the registered trademark of the plaintiff bearing No.465651 and 689062 in class 1 for the trademark "FEVIKWIK" i.e. "FEVIKWIK" Trade Mark Registrations and the registrations bearing Nos.1643621 and 1643620 i.e. FEVIKWIK Packaging Trade Mark Registrations respectively.

15. It is submitted by the learned counsel for the plaintiff that the FEVIKWIK products, the trademark FEVIKWIK and the FEVIKWIK Distinctive Packaging of the plaintiff have acquired valuable reputation and goodwill. The trademark FEVIKWIK, the look and feel, distinctive trade dress, layout, colour scheme and get up of FEVIKWIK Distinctive Packaging and the FEVIKWIK products of the plaintiff are associated by the public, trade and the consumers exclusively with the plaintiff. It is submitted that the defendant has been misrepresenting their goods as ppn 8 nms-2695.16(j).doc that of the plaintiff which is causing tremendous loss to the goodwill and repudiation of the plaintiff's business and are also diluting the distinctiveness of the trademark of the plaintiff i.e. FEVIKWIK and the distinctive get up, layout, look and feel and colour scheme

comprised in FEVIKWIK Distinctive Packaging of the plaintiff deliberately.

16. It is submitted by the learned counsel that by virtue of such misrepresentation, the defendant is passing off or attempting to pass off their goods as those of the plaintiff. He submits that the copying/ simulation/resemblance of the impugned products with those of the plaintiff's FEVIKWIK products and the FEVIKWIK Distinctive Packaging and the similarity between the impugned mark KWIKHEAL and the plaintiff's trademark FEVIKWIK is clear evidence of the dishonest and fraudulent intention of the defendant to deceive and confuse the public, consumer and traders. It is submitted that the feature of the registered trademark and label of the plaintiff had been copied by the defendant or its impugned mark "KWIKHEAL." It is submitted that this Court has already granted leave in favour of the plaintiff under clause XIV of the Letters Patent on 20th October 2016 in so far as the action of passing off in respect of mark of the defendant is concerned under the Copyright Act, 1957.

17. It is submitted by the learned counsel that the plaintiff conducted a search on the website of the trademark registry in the month of April 2014 and came across an application made by the defendant for registering a label/package for its products "KWIKHEAL" bearing Application No.2223608 in class 16 in respect of "adhesive for stationary and household purposes." It is submitted that though the defendant has ppn 9 nms-2695.16(j).doc got its mark registered as reflected on page 58 of the plaint, the defendant is not actually using the said packaging for which the trademark registration is applied for but has been using the packaging similar to that of the plaintiff. He submits that the defendant has not even furnished its complete address on the impugned packaging deliberately with a view that nobody can trace the owner of the said impugned packaging which shows bad faith on the part of the defendant.

18. Learned counsel for the plaintiff invited my attention to the allegations made in the affidavit-in-reply filed by the defendant. It is submitted that in the said affidavit-in-reply, it is the case of the defendant that the said trademark "KWIKHEAL" is in continuous and extensive use by the defendant since July 2011. It is submitted that the defendant has not produced any documents in support of this false plea. No material is produced on record by the defendant to show any publicity material. No Chartered Accountants' certificate is annexed to show that any amount has been spent on advertisement and sales promotional expenditure or any other material to show that the defendant no.1 was the user of the said products since July 2011. He submits that in any event, the plaintiff has been using the said trademark "FEVIKWIK" since 1991 i.e. much prior to the date of commencement of the trademark "KWIKHEAL" allegedly used since July 2011 by the defendant. He submits that the defendant had pirated the products of the plaintiff. It is submitted that the mark FEVIKWIK is the word mark having no specific meaning given to it.

19. It is submitted by the learned counsel for the plaintiff that in so far as the disclaimer of the word "KWIK" in two of the registration ppn 10 nms-2695.16(j).doc certificates is concerned, the same would not give any right to the defendant to infringe the other two registration certificates registering the trademark FEVIKWIK without any disclaimer in respect of the word "KWIK." He submits that in any event, the said disclaimer makes no difference in so far as the action of passing off initiated by the plaintiff against the defendant is concerned. He submits that intention of the

defendant is to use the said trademark "KWIKHEAL" as close as possible to the registered trademark of the plaintiff.

20. Learned counsel for the plaintiff invited my attention to the photographs annexed at Exhibits 'A' and 'B' to the affidavit dated 22 nd February 2017 filed by the plaintiff. He also invited my attention to the ad-interim order passed by this Court on 5th May 2014 in terms of prayer clauses (b) and (f) of the notice of motion and prima facie findings rendered by this Court in the said order. He submits that inspite of the said ad-interim injunction granted by this Court, the defendant continued to sell the impugned products in market in blatant violation of the said ad-interim order. He submits that the impugned suit products of the defendant were being sold in Ludhiana openly in the market. In the said affidavit, the plaintiff has alleged that on 14th February 2017, the deponent of the said affidavit had visited a shop mentioned in the said affidavit in Ludhiana where the impugned suit products of the defendant were being sold.

21. The said deponent in the said affidavit alleged that he purchased 50 products/pouches of the said impugned KWIKHEAL products from the said shop. On 15 th February 2017, the said deponent visited another shop in Ludhiana and noticed that the impugned suit ppn 11 nms-2695.16(j).doc products of the defendant was displayed for sale by the said shop along with the FEVIKWIK products of the plaintiff. The said deponent took photographs of the display of the said products, copies thereof are annexed to the said affidavit at Exhibit 'B'. The said deponent visited another shop on 15th February 2017 in Ludhiana and found that the impugned suit products of the defendant were displayed for sale by the said shop along with the FEVIKWIK products of the plaintiff. The plaintiff has annexed photographs of the display of the said products. He submits that the said deponent also visited several other shops and found the same infringement by the defendant.

22. Learned counsel for the plaintiff also invited my attention to the affidavit-in-reply of the defendant alleging that the said KWIKHEAL products allegedly procured by the plaintiff and placed on record by way of filing an affidavit dated 22nd February 2017 are not manufactured or marketed or in any manner dealt with by the sole proprietor of the defendant or the defendant/firm or any person claiming under or through them and are not manufactured or marketed or dealt with in any manner with the knowledge of the sole proprietor of the defendant. It is alleged that the defendant is having its manufacturing of Poma-ex products at Gupta Colony, New Delhi- 110009 and does not have any manufacturing unit at Bawana, Delhi- 110039.

23. Learned counsel for the plaintiff invited my attention to the order dated 28th February 2017 passed by this Court recording the statement made by the defendant through their counsel that the defendant had stopped manufacturing the impugned products with the colour ppn 12 nms-2695.16(j).doc combination as alleged by the plaintiff. This Court has also recorded the statement made by the learned counsel for the plaintiff that his instructions were that the defendant was still continuing to sell the impugned products. Learned counsel for the defendant made a statement that it was somebody else who was using the same name of the defendant and manufactured the impugned products at Bawana, Delhi.

24. Learned counsel for the plaintiff placed reliance on the judgment of this Court in the case of Hiralal Parbhudas Vs. Ganesh Trading Company & Ors., reported in AIR 1984 Bom 218 and in particular paragraphs 4 and 5 and would submit that the product of the plaintiff under the registered trademark "Fevi kwik" is sold all over India and are purchased by general members of public. He submits that the persons who are acquainted with the mark of the plaintiff and if the product of the plaintiff with the registered trademark is not available the two side by side for comparison, may be deceived, if the goods were allowed to be impressed with the second mark, into a belief that such purchaser was dealing with goods which bore the same marks as that with which he was acquainted. He submits that the mark "Kwikheal" used by the defendant is deceptively similar to the last decimal. He submits that the marks must be looked at from the view and first impression of a person of average intelligence and imperfect recollection. He submits that overall structure and phonetic similarity of the mark of the defendant is identical to the registered trademark of the plaintiff. He submits that the marks must be compared as a whole and microscopic examination is not permissible. Overall similarity is sufficient for grant of an injunction and other reliefs.

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25. Learned counsel appearing for the plaintiff submits that the defendant has ex facie violated the ad-interim injunction granted by this Court on 5th May 2014. In support of this submission, learned counsel for the plaintiff invited my attention to the photographs of the label of the trademark of the plaintiff and also the photocopy of the trademark of the defendant. It is submitted by the learned counsel for the plaintiff that the photograph annexed to the affidavit dated 22nd February 2017 filed by the plaintiff would clearly indicate that under the banner of the label of the plaintiff "Fevi kwik," in the first two row and 4 th row, the products of the defendant are displayed for sale whereas in the 3 rd row, the products with the registered trademark of the plaintiff are displayed. He submits that the said photograph itself would clearly indicate that all the characteristics of the products of the defendant are similar to the products of the registered trademark of the plaintiff to the extent of last decimal. It is submitted that the defendant continues the violation of the ad-interim order passed by this Court.

26. Learned counsel for the plaintiff placed reliance on the judgment of this Court in the case of James Chadwick & Bros. Ltd. Vs. The National Sewing Thread Co. Ltd., reported in (1952) Indian Law Reports 344 (Bom) and in particular relevant paragraphs at page 360 and would submit that the plaintiff is the only one dealing with the said goods under the trademark "Fevi kwik" and thus any attempt to sell the goods under the same trademark which fixes in the mind of the purchasers the association of the trademark of the plaintiff would not be justified.

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27. Learned counsel for the plaintiff placed reliance on the judgment of the Supreme Court in the case of Midas Hygiene Industries P.Ltd. & Anr. Vs. Sudhir Bhatia & Ors., reported in 2004 (28) PTC 121 (SC) and in particular paragraph 5 and would submit that in cases of infringement either of trademark or of copyright normally an injunction must follow. Mere delay in bringing action is not

sufficient to defeat grant of injunction in such cases. He submits that the defendant initially started using the pirated trademark of the plaintiff which was subsequently stopped by it and thereafter it started using the registered trademark of the plaintiff dishonestly. He submits that inspite of ad-interim injunction granted by this Court, the defendant has continued adoption of registered trademark of the plaintiff with dishonest intention and thus it has become necessary to confirm the ad-interim injunction granted by this Court by an order dated 5 th May 2014 and other reliefs in the notice of motion be granted.

28. Learned counsel for the plaintiff placed reliance on the judgment of the Delhi High Court in the case of Foodcraft India Private Limited Vs. Saurabh Anand Trading & Ors., delivered on 9th May 2017 in Civil Suit (Commercial) No.278 of 2017 and in particular paragraphs 18, 23 and 24 thereof. He submits that the word "kwik" does not find mention in the English Dictionary. He submits that the defendant has not given any explanation for adoption of the mark "Kwikheal" and thus inference shall be drawn by this Court that the defendant has been adopted the mark "Kwikheal" with a view to take advantage of the reputation of the mark of the plaintiff and with an intention to deceive and cause confusion in the mind of the customers of the plaintiff. He ppn 15 nms-2695.16(j).doc submits that in view of such dishonest intention of the defendant, the Court has to grant injunction against the defendant on such ground.

29. Learned counsel for the plaintiff placed reliance on the judgment of the Division Bench of this Court in the case of Schering Corporation & Ors. Vs. Kilitch Co. (Pharma) Pvt. Ltd., reported in PTC (Suppl) (2) 22 (Bom) (DB) and in particular paragraphs 11 to 13 and would submit that the defendant tried to improve its goods by taking contradictory and inconsistent stand and such explanation sought to be tendered must have relevance to the intention of the defendant which the defendant has failed to explain. This Court thus shall grant the reliefs as prayed by the plaintiff in the notice of motion.

30. In so far as the issue of disclaimer raised by the defendant is concerned, learned counsel submits that there was no disclaimer in the two certificates of registration of trademark by the Registrar of Trademarks whereas in case of the other two certificates of registration of trademark, there was a disclaimer. He submits that the condition of the disclaimer made in one registration certificate cannot be used, extended or read in the other certificates of registration of trademark. In support of this submission of the registration certificates of the trademark, learned counsel for the plaintiff placed reliance on the judgment of this Court in the case of Siddhant Ice Creams Pvt. Ltd. Vs. Thanco Enterprises, 2011 (6) BomCR 174 and in particular paragraphs 13 and 14. He submits that the marks are registered by the authority inter alia qua the goods and services stipulated in a given class and thus it is not permissible to read the condition imposed by the Registrar regarding the use of a mark in one class into the registration of the same mark in another class.

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31. Learned counsel for the plaintiff placed reliance on the judgment of this Court in the case of Pidilite Industries Ltd. Vs. S.M. Associates & Ors., reported in (2003) 5 Bom CR 295 and in particular paragraphs 68 to 71 and would submit that while comparing the products, disclaimer

containing certificate of registration of trademark also has to be considered.

32. Learned counsel placed reliance on the judgment of this Court in the case of Rahul Uttam Suryavanshi Vs. Sunil Manikchand Kasliwal, reported in 2017(1) MhLJ 315 and in particular paragraph 28 and would submit that the defendant cannot be allowed to raise a plea that the word mark "kwik" is very common in nature and are fully used by the public and thus the plaintiff cannot claim exclusive ownership over those words "kwik" and thus there are no chances of misleading or confusing the customers on the ground that the defendant itself had applied for and obtained the registration of trademark "Kwikheal." He submits that since the defendant has itself obtained certificate of registration of trademark, that itself would indicate that the word mark "kwik" is not a common in nature and thus use of such word mark can mislead or confuse the customers.

33. It is submitted by the learned counsel for the plaintiff that the defendant has now changed the colour of the products similar to the colour of the products of the plaintiff on the label. The defendant has removed the word "Poma-Ex products" which was got registered by it. He once again invited my attention to the photographs produced on record and submits that the said words "Poma-Ex products" have been now removed and the label now used by the defendant is similar to the ppn 17 nms-2695.16(j).doc label of the products of the plaintiff to the last decimal. The colour of the ball is also changed as red, green and black. The last ball reflected in the label is in blue colour which is similar to the colour of the ball on the products used by the plaintiff in its registered trademark. He submits that it is thus clear that the actual use of the trademark on the products being manufactured and sold by the defendant is not similar to the registered trademark of the defendant. The defendant thus cannot seek any protection of its trademark having been registered granted under Section 30 of the Trade Marks Act, 1999.

34. In support of this submission, learned counsel for the plaintiff placed reliance on the judgment of the Supreme Court in the case of Heinz Italia and Anr. Vs. Dabur India Ltd., reported in (2007) 6 SCC 1 and in particular paragraph 18 thereof. He submits that Supreme Court in the said judgment has held that the colour scheme and overall effect of packaging has to be seen and mere fact that small changes in their packaging is an attempt to continue to mislead the purchaser and to make it more difficult for the appellant to protect their mark which mark acquired an enviable reputation in the mark and was sought to be exploited by the respondent, the appellant was entitled to grant of an injunction.

35. Learned counsel for the plaintiff placed reliance on the judgment of the Delhi High Court in the case of South India Beverages Pvt. Ltd. Vs. General Mills Marketing Inc., reported in 2015(61) PTC 231 (Del) and in particular paragraphs 4, 14, 15, 19, 23 and 25 to 30 and would submit that in the registered trademark of the plaintiff "FEVIKWIK," there are two separate elements i.e. "FEVI" and "KWIK."

ppn 18 nms-2695.16(j).doc Both are important. He submits that the expression "KWIK" had been deliberately adopted by the defendant. The expression "KWIK" has dominant feature.

36. Learned counsel for the plaintiff placed reliance on Section 28(1) and 28(3) of the Trade Marks Act, 1999 and submits that the defendant could not have applied and obtained the trademark "Kwikheal" in view of the fact that its identities with the registered trademark of the plaintiff and the similarity of the goods discovered by the said trade mark were identical. There existed likelihood of confusion on the part of the public which includes assessment of likelihood of confusion with the earlier trademark. This Court had already granted ad-interim injunction against the defendant which was suppressed by the defendant while obtaining its trademark registered. He also placed reliance on Section 30(2)(e) of the Trade Marks Act, 1999 and would submit that the plaintiff has already filed an application for rectification of the registration granted in favour of the defendant on various grounds set out in the said application annexed to the affidavit in rejoinder. He submits that though the trademark of the defendant is also registered, the suit filed for infringement of the trademark of the plaintiff and for passing off action is not barred.

37. In support of this submission, learned counsel placed reliance on the judgment of this Court in the case of M/s.Siyaram Silk Mills Ltd. Vs. M/s.Shree Siyaram Fab Pvt. Ltd., reported in 2012 (5) BomCR 306 and in particular paragraphs 3, 5, 9, 15 and 16 thereof. He submits that though defendant may have defence available based on Section 30(2)(e) of the Trade Marks Act, 1999 for an action of ppn 19 nms-2695.16(j).doc infringement on the basis of the registration of its trademark, the same did not bar institution of the suit for infringement. He also placed reliance on Sections 47 and 57 of the Trade Marks Act, 1999 and would submit that under those provisions, trademark may be removed from the register of the trademark by the Registrar or the Appellate Board on various grounds. The Registrar of Trademark or the Appellate Board has also powers to cancel or vary the registration of the trademark and rectify the register.

38. It is submitted that the Court can go behind the registration at the interlocutory stage and can grant injunction against the defendant if the registration of the trademark of the defendant is prima facie found illegal, fraudulent and shocks the conscience of the Court. He submits that the word mark "FEVIKWIK" of the plaintiff was already registered in the year 1987 for the first time and three more registrations were granted prior to the registration of the trademark of the defendant which was registered on 21st October 2011. He submits that the defendant could not have used the pirated trademark of the plaintiff and thereafter could not have applied for registration. He submits that since the registration of trademark of the defendant is in contravention of Section 11(1) of the Trade Marks Act, 1999 and is illegal, it cannot have any defence under Section 30(2)(e) of the Trade Marks Act, 1999 on the basis of the registration of its trademark.

39. Learned counsel for the plaintiff placed reliance on Section 11(1)(a), 11(1)(b), 11(2), 11(3) and 11(5) of the Trade Marks Act, 1999 and would submit that the provisions of Sections 11(1)(a) and 11(1)(b) are on higher pedestal than Section 11(2) and 11(3) of the Trade Marks ppn 20 nms-2695.16(j).doc Act, 1999. He submits that condition under Section 11(5) is absent in Section 11(1). Though the plaintiff did not file any objection within the time prescribed, the registration of the trademark of the defendant ought to have been rejected under Section 11(1)(b) of the Act. He submits that though ex parte ad-interim injunction was granted by this Court on 5th May 2014, the defendant did not disclose the said order to the Trade Mark registry and obtained registration of trademark fraudulently and illegally on 16th June 2014.

40. Learned counsel for the plaintiff placed reliance on the judgment delivered by Full Bench of this Court in the case of Lupin Ltd. Vs. Johnson & Johnson, reported in 2015 (1) Mh.L.J. 501 and in particular paragraphs 24,26, 29, 34, 35, 59 and 60 in support of the submission that the Court can go into the validity of the registration at interlocutory stage for rendering a prima facie finding on the issue as to whether any infringement of the trademark is committed by the defendant or not, though challenge to the validity of the registration of trademark can finally succeed only in rectification proceedings before Intellectual Property Appellate Board. He submits that there is no express or implied bar taking away jurisdiction or power of the Civil Court to consider the challenge to the validity of trademark at interlocutory stage by way of a prima facie finding.

41. Learned counsel for the plaintiff placed reliance on the judgment of Delhi High Court in the case of Clinique Laboratories LLC and Anr. Vs. Gufic Limited and Anr., reported in 2009 (41) PTC 41 (Del) and in particular paragraphs 11, 12 and 14 in support of the submission that a suit for infringement of registered trademark is ppn 21 nms-2695.16(j).doc maintainable against another registered proprietor of identical or similar trademark and interim order can be passed if the Court is prima facie convinced of invalidity of registration of the defendant's mark and if the Court finds infringement of the registered trademark of the plaintiff. In support of the aforesaid submission, the plaintiff also placed reliance on the judgment of the Delhi High Court in the case of Abbott Healthcare Pvt. Ltd. Vs. Raj Kumar Prasad & Ors., reported in 2014 (58) PTC 225 (Del) and in particular paragraphs 21 to 23 thereof.

42. It is submitted by the learned counsel for the plaintiff that the plaintiff has been already granted leave under Clause XIV of the Letters Patent and thus the plaintiff is entitled to apply for interim reliefs also based on passing off action in common law. He submits that for grant of interim reliefs on passing off action, criteria is different. The plaintiff has already earned goodwill and reputation in the market. The plaintiff has placed reliance on the certificate showing income and turnover of the plaintiff and advertisement and sales promotional expenses issued by the Chartered Accountants. He submits that the plaintiff is also entitled to apply for injunction under passing off action on the ground that there was total misrepresentation on the part of the defendant. The defendant has copied every single feature of the plaintiff's label till the last decimal. He submits that the defendant had adopted the word mark "KWIK" on the ground that the expression or word mark "KWIK" is mis-spelt of the expression "QUICK."

43. It is submitted that for the purpose of granting injunction for infringement of the trademark, there need not be actual confusion or deception or damages but can be granted if there is likelihood of any ppn 22 nms-2695.16(j).doc confusion or deception or damages likely to be suffered by the plaintiff. He submits that in view of Section 27(2) of the Trade Marks Act, 1999, common law action of passing off is not affected. The plaintiff is the prior user and proprietor of the trademark "FEVIKWIK." Even if this Court comes to a conclusion that the relief of injunction cannot be granted on basis of invalid registration of the defendant, this Court can grant an injunction on passing off action. He submits that the date of adoption of mark by the defendant is relevant.

44. Learned counsel invited my attention to the judgment delivered by the Division Bench of the Delhi High Court in the case of Raj Kumar Prasad Vs. Abbott Healthcare Pvt. Ltd., reported in 2014

(6) PTC 51 (Del) and would submit that the Division Bench of the Delhi High Court has confirmed and has upheld the decision taken by the Division Bench of Delhi High Court in the case of Raj Kumar Prasad (supra).

45. Learned counsel for the plaintiff placed reliance on the judgment of the Supreme Court in the case of N.R. Dongre & Ors. Vs. Whirlpool Corpn. & Anr., reported in (1996) 5 SCC 714 and in particular paragraphs at pages 720, 722 and 723 to show as to when an injunction can be granted by the Court on passing off action in common law.

46. In so far as the issue of jurisdiction raised by the defendant in the affidavit-in-reply is concerned, learned counsel for the plaintiff invited my attention to Section 134 of the Trade Marks Act, 1999 and Section 62 of the Copyright Act, 1957 and would submit that the plaintiff ppn 23 nms-2695.16(j).doc has been carrying on business in Mumbai. The suit is accordingly maintainable in this Court. He submits that though the issue of jurisdiction is raised by the defendant in the affidavit-in-reply, the said issue raised by the defendant in the affidavit-in-reply is an abuse of process of law. There is no substance in the issue raised by the defendant. No issue under Section 9A of the Code of Civil Procedure, 1908 is thus required to be framed by this Court. In support of this submission, learned counsel for the plaintiff placed reliance on the judgment of this Court in the case of Ferani Hotels Private Limited Vs. Nusli Neville Wadia and Ors., reported in 2013 (3) BomCR 669 and in particular paragraph 17 thereof.

47. Learned counsel for the plaintiff submits that the representative of the plaintiff visited Ludhiana and found gross violation of the ad-interim order passed by this Court by the defendant. He invited my attention to the affidavit dated 22 nd February 2017 filed by the plaintiff and also annexures thereto. He also invited my attention to the reply of the defendant dated 8th March 2017 to the said affidavit of the plaintiff. He submits that the said affidavit would clearly indicate that inspite of the ad-interim injunction granted by this Court, the defendant has not only been infringing the trade mark and trade label of the plaintiff or by manufacturing the goods with the identical trademark and label but has been selling the same in the open market through various retailers. He submits that the defendant has falsely denied in the affidavit-in- reply dated 8th March 2017 that the said products which are reflected in the photographs in the affidavit dated 27th February 2017 are not manufactured and/or sold by the defendant.

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48. Mr. Poojari, learned counsel for the defendant, on the other hand, submits that to the knowledge of the plaintiff, the defendant had applied for registration of the trade mark "KWIKHEAL" in the year 2011 itself as averred by the plaintiff itself in paragraph 5 of the plaint. He submits that there is no visual phonetic similarity in the mark of the plaintiff "FEVIKWIK" and the mark of the defendant "KWIKHEAL." He submits that similarly there is no similarity between the label of the plaintiff and the label of the defendant.

49. It is submitted by the learned counsel that the plaintiff has not alleged any illegality, fraud or that the mark being used by the defendant shocks conscience of the Court in the application filed by

the plaintiff inter alia praying for cancellation of the registration of the mark of the defendant. In support of this submission, learned counsel invited my attention to some of the grounds raised in the said application for cancellation of the registration filed by the plaintiff before Intellectual Property Appellant Board inter alia praying for cancellation of the registered trade mark of the defendant. He submits that the Court has to decide whether the two word marks of the rival parties are similar or not.

50. It is submitted that the application for registration of the trade mark made by the defendant was examined by the authority. The information about the said application made by the defendant was also widely published in the Trade Marks Journal. The plaintiff, however, did not raise any objection at that stage within the time prescribed. He submits that the authority was thus satisfied that the defendant had complied with all the requisitions for registration of the said trade mark for which the registration was applied by the defendant and the said trade mark 25 nms-2695.16(j).doc was accordingly registered. He submits that in any event, no sufficient case has been made out by the plaintiff in this notice of motion to consider the said registration obtained by the defendant as fraudulent and illegal.

51. It is submitted by the learned counsel that before this Court considers as to whether the mark "kwik" used by the defendant is in infringement of the registered trademark of the plaintiff or not, the Court has to consider whether the plaintiff has a right to use the said word mark "kwik" or not. He submits that the plaintiff has been using the said word mark "kwik" as prefix whereas the defendant has using the said word mark "kwik" as suffix. He submits that the said word mark "KWIK" is mis-spelt of the expression "QUICK" which means 'fast'. It is directly related to the product i.e. instant adhesive. He submits that the said product can be manufactured by other manufacturers.

52. It is submitted by the learned counsel that the defendant has disputed the factum of alleged registration of the trademark of the plaintiff. He invited my attention to the registration of the plaintiff's trademark at Exhibit 'A' at page 97 of the plaint. He submits that the plaintiff has not filed any certificate of registration but has only filed photocopy of the relevant page of Trade Marks Journal. He placed reliance on Section 137 of the Trade Marks Act, 1999 and would submit that no such entry in the register is relied upon by the plaintiff. He also invited my attention to the certificate at page 98 of the plaint and would submit that the said document would clearly indicate the disclaimer of word "KWIK."

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53. Learned counsel also invited my attention to page 101 of the plaint and would submit that the said document is a photocopy of the relevant page of Trade Marks Journal and is not a certificate of the registration of the trade mark of the plaintiff. He further submits that the said document also shows that the said alleged trademark of the plaintiff was to be associated with the earlier alleged registration of the plaintiff. He submits that in any event, the alleged registration of the trademark of the plaintiff is not valid and subsisting.

54. Learned counsel for the defendant submits that in any event, condition mentioned in the document relied upon by the plaintiff, in so far as two marks are concerned, clearly shows disclaimer of the word "kwik." He submits that since the remaining alleged certificate clearly shows that they were associated with the earlier alleged registered trademark, condition of disclaimer would apply to all the trademarks alleged to have been registered by the plaintiff. He submits that adhesive products of the plaintiff are used for industrial purposes which are sold in big container and not in pouches. He submits that in view of disclaimer of the word "kwik," the plaintiff has no exclusive right to use the word mark "kwik." He submits that as on today, two alleged registrations out of four are not even in existence. He submits that whatever is disclaimed as per those certificates cannot form part of the registered trademark.

55. In support of this submission, learned counsel for the defendant placed reliance on the judgment of the Delhi High Court in the case of Om Prakash Gupta Vs. Parveen Kumar & Anr., reported ppn 27 nms-2695.16(j).doc in 86(2000) Delhi Law Times 181 and in particular paragraphs 4, 5, 6, 9, 15 to 19, 21, 22, 24 and 40 thereof. It is submitted that the word "kwik" is common to trade and thus the authority had rightly imposed condition of disclaimer in the alleged certificate of registration.

56. It is submitted by the learned counsel for the defendant that in view of the disclaimer of the word "kwik," the said disclaimed part is not within the protection provided under Section 30(2) of the Trade Marks Act, 1999 and thus no injunction can be granted by this Court against the defendant from using the mark "kwik." He submits that though the plaintiff has referred to the disclaimer in the plaint, such disclaimer is not pointed out to this Court when the plaintiff had obtained ad-interim injunction against the defendant. He submits that if the plaintiff would have pointed out such disclaimer to this Court, ad- interim order granted by this Court in favour of the plaintiff would not have been granted. He submits that the registration, if any, granted in favour of the plaintiff would be at most for the word "FEVI."

57. It is submitted that there is thus no statutory protection available for the plaintiff for the word mark "kwik." He submits that the plaintiff has not acted with clean hand and thus the notice of motion shall be dismissed on these grounds and ad-interim order shall be vacated. It is submitted that in any event, the defendant has already discontinued the use of label after the said ad-interim order is passed by this Court. He submits that the mark of the defendant "KWIKHEAL" is already registered with the authority under the provisions of the Trade Marks Act, 1999. It is submitted that there is no provision in the Copyright Act, ppn 28 nms-2695.16(j).doc 1957 providing that a party can use only one label. He submits that the defendant is entitled to use more than one label.

58. In so far as the affidavit dated 22nd February 2017 filed by the plaintiff is concerned, it is submitted by the learned counsel that the defendant has neither manufactured any such products reflected in those photographs annexed to the affidavit-in-reply nor those products are marketed by it. He submits that no dealers of the defendant are appointed at the place mentioned in the said affidavit dated 22 nd February 2017. He submits that the defendant has no intention to use the said mark of the plaintiff and has already stopped from using the same.

59. It is submitted by the learned counsel that the word "kwik" is very common. In support of this submission, learned counsel tenders a copy of the statement from the website of the Trade Mark Ministry and would submit that the same would clearly indicate that the word "FEVI" has been registered by the plaintiff with 18 combinations. He submits that the plaintiff alone is not entitled to use the word "kwik" which is mis-spelt of the word "Quick." He submits that there is thus no infringement of whatsoever nature on the part of the defendant with the registered trademark of the plaintiff, if any.

60. In so far as the allegations of the plaintiff regarding infringement of alleged copy right by the defendant is concerned, learned counsel invited my attention to the averments made in paragraphs 15 and 22 of the plaint and would submit that the said allegations are totally vague. He placed reliance on Section 17 of the Copyright Act, 1957 ppn 29 nms-2695.16(j).doc and would submit that those averments would not indicate that the plaintiff is the first owner of the alleged copyright. He submits that no contract is placed on record between the plaintiff and in-house employee who has created such copyright. He submits that admittedly the said alleged copyright has not been registered by the plaintiff and the plaintiff has not obtained any copyright by any assignment. Name of the employee who has alleged to have created such copyright has not been disclosed by the plaintiff. He submits that since there is no copyright in favour of the plaintiff and the plaintiff does not own any such copyright, the question of any infringement of such copyright by the defendant does not arise.

61. In so far as the allegations of the plaintiff regarding passing off action is concerned, it is submitted that learned counsel for the defendant has already discontinued the use of label after ad-interim order passed by this Court. It is submitted that the registered or unregistered label of the defendant has no similarity with the label of the plaintiff and is not likely to be confused or deceived. He submits that the colour scheme and design of the label of the defendant is totally different.

62. Learned counsel submits that the principles laid down by the Supreme Court in the case of N.R. Dongre & Ors. Vs. Whirlpool Corpn. & Anr. (supra) are not in dispute. However, the case of the defendant cannot be compared with the case of N.R. Dongre & Ors. Vs. Whirlpool Corpn. & Anr. (supra). He submits that the facts before the Supreme Court in the said judgment were totally different. The defendant has not ppn 30 nms-2695.16(j).doc adopted the alleged label of the plaintiff dishonestly. Learned counsel for the defendant distinguished the judgment of this Court in the case of Hiralal Parbhudas Vs. Ganesh Trading Company & Ors. (supra) on the ground that surrounding features and characteristics of the label of the defendant are different. He submits that the plaintiff is unable to demonstrate before this Court as to how the registration of the defendant is invalid.

63. Learned counsel for the plaintiff distinguishes the judgment of the Delhi High Court in the Raj Kumar Prasad Vs. Abbott Healthcare Pvt. Ltd. (supra) on the ground that the facts before the Supreme Court in the said judgment were totally different. The marks of the defendant and the plaintiff were similar in that case which is not the situation in this case.

64. It is submitted by the learned counsel that ad-interim order granted by this Court in terms of prayer clauses (b) and (f) is also in respect of the alleged infringement of the trademark and not only

in respect of the copyright as canvassed by the learned counsel for the plaintiff. He submits that the alleged registration of the trademark annexed at page 97 of the plaint was valid only for a period of seven years and has not been renewed. Similarly another alleged certificate of the registration was valid only for a period of ten years and has not been renewed. He submits that on the date of filing the suit by the plaintiff against the defendant, the validity of the said alleged trademark has already expired. He submits that out of four alleged registrations of the trademark of the plaintiff, three registrations fall under class 1 whereas the registration of the trademark of the defendant falls under class 16.

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65. Learned counsel for the plaintiff in rejoinder submits that the grounds of fraud, illegalities, action of the defendant which shocks the conscience of this Court are not required to be raised in the application for rectification before the Intellectual Property Appellate Board, however, can be raised in the suit, which are already placed on record by the plaintiff. He submits that this Court can certainly go behind the certificate of registration for the purpose of rendering prima facie findings and for granting interim reliefs.

66. Learned counsel invited my attention to the document at page 97 of the plaint and would submit that the said document itself is a certificate of registration in respect of the trademark of the plaintiff bearing no.465651. He placed reliance on Section 23(2) of the Trade Marks Act, 1999 and also Form O-2 annexed at page 97 of the plaint which was issued by the authority in favour of the plaintiff i.e. certificate of registration. He also placed reliance on the Trade Marks Journal and also on the page 99 of the plaint which is a certificate of registration of the trademark bearing no.689062.

67. In so far as the submission of the learned counsel for the defendant that the plaintiff has not produced any evidence of entries in the register of the trademarks under Section 137 of the Trade Marks Act, 1999 is concerned, it is submitted by the learned counsel that the plaintiff has produced a certificate of registration. He submits that since the trademarks registry issued certificates to rely upon such certificates in the legal proceedings, those certificates can be marked as exhibit at the stage of evidence. He submits that at page 104 of the plaint, the ppn 32 nms-2695.16(j).doc certificate used in the legal proceedings has been filed in respect of 3rd certificate of the trademark. Evidentiary value of the certificate produced under Section 23(2) of the Trade Marks Act, 1999 by the plaintiff has to be considered at this stage. He submits that it is not the plea raised by the defendant in the affidavit-in-reply that the plaintiff has not been granted any registration certificate of the trademark for the mark "Fevi kwik."

68. It is submitted that it is not pleaded by the defendant that the plaintiff does not own the certificate of registration under Section 137 of the Trade Marks Act, 1999 or that the certificate under Section 23 (2) of the Trade Marks Act, 1999 cannot be relied upon by the plaintiff. Learned counsel for the plaintiff placed reliance on the judgment of the Karnataka High Court in the case of Zino Davidoff SA Vs. Mahendra Kumar Proprietor Associate delivered on 21st April 2011 in M.FA. No.474 and 475 of 2011 and in particular paragraphs 28, 29 and 31 to 33 thereof. He also invited my attention to paragraph 3 of the affidavit- in-reply and would submit that the defendant has itself

relied upon the certificate of registration granted to the plaintiff and thus cannot raise any contradictory stand across the bar.

69. It is submitted that the plaintiff had already disclosed disclaimer in paragraph 7 of the plaint in respect of two trademarks. As a matter of record, the plaintiff had also annexed a copy of the Trade Marks Journal showing such disclaimer. The plaintiff had also produced two certificates in original for use in legal proceedings. Learned counsel submits that there is thus no suppression of any facts as sought to be canvassed by the defendant from this Court while this Court granting ad-

ppn 33 nms-2695.16(j).doc interim relief in favour of the plaintiff or otherwise. Learned counsel distinguishes the judgment of the Delhi High Court in the case of Om Prakash Gupta Vs. Parveen Kumar & Anr. (supra) relied upon by the defendant on the ground that the facts before the Delhi High Court are totally different.

70. In so far as the submission of the learned counsel for the defendant that the mark "kwik" is common to the trade and no ownership thereof can be claimed by the plaintiff is concerned, it is submitted by the learned counsel that the defendant has not shown any document for consideration of this court to demonstrate that the word mark "kwik" is common to the trade. He submits that the defendant itself had applied for and obtained registration of the word mark "kwik" from the Trademarks authority under the provisions of the Trade Marks Act, 1999. In support of this submission, learned counsel for the plaintiff placed reliance on the judgment of this Court in the Skol Breweries Limited Vs. Som Distilleries & Breweries Limited and Shaw Wallace & Company Limited, reported in 2011 Vol. 113 (5) Bom LR 3257 and the judgment of this Court in the case of Cadila Pharmaceuticals Limited Vs. Sami Khatib of Mumbai & Anr., reported in (2011) 3 Bom CR 587 and in particular paragraphs 46 and 47 and judgment of this Court in the case of Rahul Uttam Suryavanshi Vs. Sunil Manikchand Kasliwal (supra).

71. It is submitted by the learned counsel for the plaintiff that since the defendant itself is not using the registered trademark of the defendant "KWIKHEAL" as registered, the defendant is not entitled to claim any protection under Section 30(2) of the Trade Marks Act, 1999.

ppn 34 nms-2695.16(j).doc In support of this submission, learned counsel placed reliance on the judgment of this Court in the case of M/s. Siyaram Silk Mills Ltd. Vs. M/s. Shree Siyaram Fab Pvt. Ltd. (supra).

72. In so far as the submission of the learned counsel for the defendant that there is no sufficient averments alleging infringement of the copyright of the label of the plaintiff is concerned, learned counsel for the plaintiff invited my attention to paragraphs 15 and 24 of the plaint and submits that it is the case of the plaintiff that the word FEVIKWIK Distinctive Packaging was created in-house by an employee of the plaintiff during the course of employment and constituted an original artistic work in which copyrights subsist. The plaintiff has created and developed the said artistic work comprised in FEVIKWIK Distinctive Packaging and in the process of same, has spent substantial amount on the product of the said packaging.

73. Learned counsel relied upon Section 17 of the Copyright Act, 1957 and would submit that under the said provision, the employer shall, in absence of any agreement to the contrary, be the first owner of the copyright therein. He submits that evidence can be produced at the trial stage. He submits that there is no requirement under the said Copyright Act, 1957 for disclosure of the name of the author or employee in the plaint itself. He submits that the word mark "kwik" is continued to be used by the defendant illegally. Learned counsel for the plaintiff placed reliance on the judgment of this Court in the case of Zee Entertainment Enterprises Ltd. Vs. Gajendra Singh & Ors., reported in 2008 (36) PTC 53 (Bom) and in particular paragraphs 110 and 111(A) thereof. He also placed reliance on the judgment of the Delhi High Court in the case of Gufic Ltd. & Anr. Vs. Clinique Laboratories, LLC and Anr., reported in 2010 (43) PTC 788 (Del) and in particular paragraph 10 thereof.

74. In so far as the issue raised by the defendant that in view of the two trademarks of the plaintiff having been registered as associated trademark and thus disclaimer in the first two registrations of the trademark would apply to subsequent trademark also is concerned, learned counsel for the plaintiff invited my attention to the definition of "associated trade marks" under Section 2 (c) and also placed reliance on Section 16 of the Trade Marks Act, 1999. He submits that for the purpose of the registration of the trademark as 'associated trade mark' is to avoid any confusion. He submits that there is no condition prescribed under the provisions of the Trade Marks Act, 1999 that the condition in the registration certificate of one trademark has to be read into the condition of the registration of the another trademark. He submits that every registration is an independent registration and thus condition of the registration of one trademark cannot be imported into the certificate of registration of another trademark.

75. In support of this submission, learned counsel placed reliance on the judgment of this Court in the case of Skol Breweries Limited Vs. Som Distilleries & Breweries Limited and Shaw Wallace & Company Limited (supra) and judgment of this Court in the case of M/s. Siyaram Silk Mills Ltd. Vs. M/s. Shree Siyaram Fab Pvt. Ltd. (supra).

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76. Learned counsel for the plaintiff submits that even if this court comes to prima facie conclusion that the trademark of the defendant "KWIKHEAL" is not illegal, the plaintiff is entitled to be granted injunction in passing off action. In support of this submission, learned counsel for the plaintiff placed reliance on the judgment of this Court in the case of Mehboob Khan Vs. Firoz Qureshi & Ors., reported in 2016 (4) ABR 705 and in particular paragraphs 24, 26 and 27 thereof.

REASONS AND CONCLUSIONS :-

77. A perusal of the record indicates that out of four certificates of registration in question, there was no disclaimer in respect of two registration certificates. Three trademarks of the plaintiff were registered under Class 1 and one trademark was registered under Class 16. There is also no dispute that the mark of the defendant was registered later than the registration of the marks of the plaintiff. Application for cancellation of the registration of the defendant filed by the plaintiff is pending

before the Intellectual Property Appellate Board.

78. In so far as the submission of the learned counsel for the defendant that out of four trademarks of the plaintiff, validity of the registration of the trademarks has expired after seven years from date of its registration and in respect of another certificate of registration has expired after the period of ten years for the date of its registration and the same are not renewed and thus no suit for infringement on such trademarks can be filed by the plaintiff is concerned, a perusal of the record indicates that no such plea has been raised by the defendant in the affidavit-in-reply. The defendant has made this submission for the ppn 37 nms-2695.16(j).doc first time across the bar. Be that as it may, even if the two registration certificates are not renewed as alleged by the defendant across the bar, that would not affect the passing off action adopted by the plaintiff.

79. In so far as the submission of the learned counsel for the defendant that the plaintiff did not make any allegation or raised any issue of fraud against the defendant in obtaining registration of the word mark of the defendant in application for rectification and thus cannot be allowed to be raised such plea of fraud for the first time in the plaint is concerned, it is not in dispute that no such allegation of fraud was made by the plaintiff in its application under Sections 47 and 57 of the Trade Marks Act, 1999 for rectification of the mark filed before the Appellate Authority. In my view, however, the plaintiff is not precluded from raising plea of fraud in the suit alleging infringement of the registered trademark of the plaintiff. In my view, provisions of Sections 11(1)(a) and 11(1)(b) are on higher pedestal than Section 11(2) and 11(3) of the Trade Marks Act, 1999. Condition set out in Section 11(5) of the Trade Marks Act, 1999 for refusing registration on the grounds specified in sub-section (2) and (3) of Section 11 are absent in Section 11(1).

80. Though the plaintiff did not file any objection before the authority at the time of registration of the trademark of the defendant within the time prescribed under the Trade Marks Act, 1999, in my view, the authority ought to have made an independent enquiry before the registration of trademark of the defendant. It is clear that the defendant did not inform the authority about an ex parte interim injunction granted by this Court against the defendant in respect of the impugned trademark ppn 38 nms-2695.16(j).doc and copyright granted by this Court on 5 th May 2014 and obtained registration of trademark by the defendant on 16th June 2014.

81. Be that as it may, the Court can go into the validity of the registration granted by the authority under the provisions of the Trade Marks Act, 1999 at interlocutory stage for rendering a prima facie finding on the issue as to whether any infringement of the trademark is committed by the defendant or not, though challenge to the validity of the registration of trademark can finally succeed only in rectification proceedings before Intellectual Property Appellate Board. In my view, jurisdiction or power of the Civil Court to consider the challenge to the validity of trademark at interlocutory stage by way of a prima facie finding is not taken away under the provisions of the Trade Marks Act, 1999.

82. Full Bench of this Court in the case of Lupin Ltd. Vs. Johnson & Johnson (supra) has held that Section 124(5) of the Trade Marks Act, 1999 expressly permits the Civil Court to make an interlocutory order including an 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. It is held

that the provisions of Section 124 contemplates that if the defendant's plea regarding validity of the registration of the plaintiff's trade mark is frivolous, the Court is not bound to grant the defendant time to file rectification proceedings before the Appellate Board and even if such proceedings are pending, the Civil Court can grant injunction in favour of the plaintiff in the suit for infringement of the plaintiff's trade mark. This Court has held that there is no express or implied bar in the Trade Marks Act, 1999 to completely deprive the defendant of the jurisdiction and power of the Civil Court to consider the challenge to the validity of registration of the trade mark at the interlocutory stage by way of a prima facie finding on such issue. It is held that a Court hearing and deciding an interlocutory application for injunction during the pendency of the suit is required to consider: (i) prima facie case; (ii) balance of convenience; and (iii) where an irreparable injury and injustice would be caused to the Plaintiff if any interim injunction is not granted.

83. In my view, merely because the application of the plaintiff for rectification of the registration of the trademark of the defendant is pending before the Intellectual Property Appellate Board, that cannot be a bar against this Court from deciding issue of infringement under Section 28 (1) of the Trade Marks Act, 1999 and to render a prima facie finding on the issue of validity of the registration for a limited purpose for granting interim relief against the defendant. Such prima facie finding, however, rendered by the Court would not affect the outcome of the final conclusions, as may be drawn by such Intellectual Property Appellate Board in the said application filed by the plaintiff. The principle of law laid down by the Full Bench of this Court in the case of *Lupin Ltd. Vs. Johnson & Johnson* (supra) squarely applies to the facts of this case. I am respectfully bound by the said judgment.

84. Delhi High Court in the cases of *Clinique Laboratories LLC and Anr. Vs. Gufic Limited and Anr.* (supra) and *Abbott Healthcare Pvt. Ltd. Vs. Raj Kumar Prasad & Ors.* (supra) has taken a similar view that is taken by the Full Bench of this Court. I am in complete agreement with the views expressed by the Delhi High Court in the aforesaid two judgments.

85. In so far as the submission of the learned counsel for the defendant that the plaintiff has not annexed the registration of trademark alleged to have been obtained by the plaintiff and has also not relied upon any entry in the registered trademark and thus no reliefs in the suit alleging infringement of the alleged trademark can be granted on these grounds is concerned, a perusal of the documents annexed at pages 97 and 99 of the plaint clearly indicates that the plaintiff has annexed the copy of the certificate of the registration in respect of the trademark of the plaintiff bearing no.465651 and 689062 respectively. The plaintiff has also annexed the copy of the Trade Marks Journal and also Form O-2 issued by the authority in favour of the plaintiff. The plaintiff has also placed reliance on the certificates issued by the trademark registry to rely upon in legal proceedings. On page 104 of the plaint, the plaintiff has annexed one of such certificates in respect of third certificate of the trademark. In my view, the learned counsel for the plaintiff is right in his submission that the evidentiary value of the certificate produced under Section 23(2) of the Trade Marks Act, 1999 has to be considered by this Court at this stage. Original of the certificate can be produced by the plaintiff at the stage of trial.

86. A perusal of the affidavit-in-reply filed by the defendant indicates that it is not the case of the defendant that the plaintiff has not been granted any registration certificate of the trademark for the mark "Fevi kwik." On the contrary, paragraph 3 of the affidavit-in-reply filed by the defendant clearly indicates that the defendant has referred to and ppn 41 nms-2695.16(j).doc relied upon the registration certificates issued in favour of the plaintiff by the trademark authority.

87. Karnataka High Court in the case of Zino Davidoff SA Vs. Mahendra Kumar Proprietor Associate (supra) has held that Section 137 mandates that a copy of an entry in the Register certified by the Registrar and sealed with the seal of the Trade Marks Registry is sufficient enough for being admitted in evidence without production of the original and it is for the trial Court to admit this document at the time of evidence without insisting on production of original certificate. Section 137 does not place an embargo for the trial Court not to accept the true copies or copies generated through on line for consideration of interim prayer. Such prohibition is available only while admitting it in evidence and not for considering its evidentiary value at preliminary stage.

88. Karnataka High Court held that there was no prohibition for filing a suit without production of certificate under Section 137 of the Trade Marks Act, 1999. In this case, the plaintiff has produced the certificate of registration in the plaint. The defendant itself has referred to and relied upon the said certificate. It is not the case of the defendant in the affidavit-in-reply that the plaintiff has not been granted any certificate of registration of the trademark and on that ground, the suit of the plaintiff alleging infringement of the trademark of the plaintiff deserves to be rejected or interim relief prayed by the plaintiff in the notice of motion deserves to be dismissed on that ground. In my view, the principle of law laid down by the Karnataka High Court in the case of Zino Davidoff SA Vs. Mahendra Kumar Proprietor Associate (supra) ppn 42 nms-2695.16(j).doc squarely applies to the facts of this case. I am in respectful agreement with the views expressed by the Karnataka High Court.

89. In my view, there is thus no substance in the submission of the learned counsel for the defendant that the plaintiff has not annexed the copy of the certificate of registration of the trademark or that the interim relief as prayed by the plaintiff shall be dismissed on that ground. The original certificate of registration can be produced as and when the oral and documentary evidence is led by the parties at the stage of trial.

90. In so far as the submission of the learned counsel for the defendant that the word mark "KWIK" is common and is misspell of the word "QUICK" and thus no right of any nature can be claimed by the plaintiff thereon and thus no suit could have been filed alleging infringement of the said word mark "kwik" is concerned, learned counsel for the defendant placed reliance on the statement alleged to have been obtained from the website of the trademark registry to buttress his arguments that the word "FEVI" has been registered by the plaintiff with 18 combinations. In my view, the said statement obtained from the website of the trademark registry showing that the word "FEVI" has been registered by the plaintiff with 18 combinations would not assist the case of the defendant in any manner whatsoever. Reliance placed on the said statement by the defendant is totally misplaced. The defendant could not point out any dictionary meaning of the word "kwik." The defendant did not produce any document before this Court in support of its submission that the said

word mark "KWIK" is common. On the contrary, it is an admitted position that the defendant itself had applied ppn 43 nms-2695.16(j).doc for registration of the word mark "KWIKHEAL" containing the said word "KWIK" which was common in the registered trademark of both the parties and obtained registration for the same.

91. This Court in the case of Rahul Uttam Suryavanshi Vs. Sunil Manikchand Kasliwal (supra) has held that since the defendant himself had applied for registration of the impugned mark containing the word "MOR CHHAP" which was common in the marks adopted by both the parties, the defendant could not be allowed to urge that the mark of the plaintiff containing the word "MOR CHHAP" used by the plaintiff in his trade made is descriptive or common to the trade and thus no infringement thereof could be committed by the defendant. It is clear that the word "KWIK" has been used by the plaintiff and defendant both in their marks as "FEVIKWIK" and "KWIKHEAL" respectively.

92. In my view, since the defendant has itself got the word mark "KWIK" registered, the defendant cannot be allowed to urge that the said word mark is descriptive or common to the trade and thus no infringement thereof could be committed by the defendant. Principle of law laid down by this Court in the case of Rahul Uttam Suryavanshi Vs. Sunil Manikchand Kasliwal (supra) squarely applies to the facts of this Court. I am respectfully bound by the said judgment.

93. This Court in the case of Cadila Pharmaceuticals Limited Vs. Sami Khatib of Mumbai and Anr. (supra) has rejected the contention of the defendant that the part of the mark was common to the trade on the ground that pleadings in support of that allegation was not sufficient to establish this defence on facts, nor was there any evidence to prove the ppn 44 nms-2695.16(j).doc same. This Court has held that since there was no material of extensive use and/or availability of such rival marks bearing the alleged common feature, it could not be said that the part of the mark was descriptive or common. In my view, there is no substance in the submission of the learned counsel for the defendant that since the mark "KWIK" is used by the plaintiff as suffix to the mark "FEVIKWIK" whereas the defendant has used the mark "KWIK" as prefix to his mark "KWIKHEAL" and thus there would be no likelihood of deception or confusion. Principle of law laid down by the Division Bench of this Court in the case of Cadila Pharmaceuticals Limited Vs. Sami Khatib of Mumbai and Anr. (supra) applies to the facts of this case. I am respectfully bound by the said judgment.

94. In so far as the submission of the learned counsel for the defendant that the plaintiff has though disclosed disclaimers in the two certificates of registration of trademark, it did not bring such disclaimers to the notice of this Court while obtaining ad-interim relief and thus has alleged to have suppressed the disclaimers from this Court is concerned, a perusal of the plaint and in particular averments made in paragraph 7 of the plaint clearly indicates that the plaintiff itself has disclosed about the disclaimers in the two of the registration certificates of the trademark and has also produced such certificates showing disclaimers. The plaintiff has annexed the photocopy of the relevant Trade Marks Journal in respect of those two certificates showing disclaimers. There is thus no substance in the submission of the learned counsel for the defendant that the plaintiff had not disclosed or had not brought to the notice of this Court about such disclaimers in the two of such

registration certificates of the trademark while obtaining ad-interim order.

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95. In so far as the judgment of the Delhi High Court in the case of Om Prakash Gupta Vs. Parveen Kumar & Anr.(supra) relied upon by the learned counsel for the defendant is concerned, in my view, the said judgment would not assist the case of the defendant. The facts before the Delhi High Court in that case were totally different. In that matter, the plaintiff had suppressed the fact of disclaimer in the plaint and made categorical statement before the Court that the trademark was the registered trademark. With such facts in hand, the Delhi High Court held that it amounted to a mis-representation of material fact made to the Court. In this case, admittedly the plaintiff had not only made an averment in the plaint but also had annexed the documents showing disclaimers in respect of both the trademarks to the plaint itself.

96. In my view, the judgment of this Court in the case of Pidilite Industries Ltd. Vs. S.M. Associates & Ors. (supra) relied upon by the plaintiff would assist the case of the plaintiff on the issue of disclaimer. In the facts that case, this Court has held that the disclaimer in that case did not affect the plaintiff's right to obtain an injunction for infringement. In my view, the facts before this Court in the said judgment are almost identical to the facts of this case.

97. This Court in the case of Siddhant Ice Creams Pvt. Ltd. Vs. Thanco Enterprises (supra) has held that even assuming that the registration of the mark under classes 7, 29 or 42 contained such a qualification or limitation, it cannot apply or be extended to or read into the registration of the mark under class 30. Marks are registered, inter- alia, qua the goods and services stipulated in a given class. It is impermissible to read a limitation or condition imposed by the Registrar ppn 46 nms-2695.16(j).doc regarding the use of a mark in one class into the registration of the same mark in another class. This Court rejected the submission of the defendant that if a registered proprietor is not entitled to the exclusive use of a part of a mark in respect of the registration under one class the limitation must also be held to apply to the registration of the mark under another class although the same does not contain any such limitation. In my view, the judgment of this Court in the case of Siddhant Ice Creams Pvt. Ltd. Vs. Thanco Enterprises (supra) would apply to the facts of this case. I am respectfully bound by the said judgment.

98. In so far as the submission of the learned counsel for the defendant that two trademarks of the plaintiff with disclaimer were to be associated with other trademarks without disclaimer and thus the terms and conditions of the disclaimer in the two trademarks stood incorporated in the remaining trademarks and thus the plaintiff could not file a suit alleging infringement of the trademark of the plaintiff or cannot seek interim reliefs based on such associated mark is concerned, learned counsel for the plaintiff placed reliance on the definition of "associated trade marks" under Section 2(c) read with Section 16 which clearly indicates that to avoid any confusion in a situation where an application for registration in respect of any goods or services is identical with another trade mark which is registered or in the name of the same proprietor in respect of the same goods or description of goods or same services or description of services or so nearly resembles it, the Registrar may at any time require that the trademarks shall be entered on the register as associated

trade marks.

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99. A perusal of Section 2(c) and Section 16 of the Trade Marks Act, 1999 does not indicate that the terms and conditions of the registration in registration certificate of one trademark can be read into the terms and conditions of the another certificate or registration of the trademark. In my view, reliance placed by the learned counsel for the defendant on the Trade Marks Journal No.1359 in support of this submission is totally misplaced. In my view, every registration granted by registering authority in respect of each trademark is separate and independent and thus the condition of the registration of one trademark cannot be imported into the certificate of registration of another trademark.

100. This Court in the case of Skol Breweries Limited Vs.Som Distilleries & Breweries Limited and Shaw Wallace & Company Limited (supra) has held that a condition or limitation placed in respect of one registration cannot be read into a separate and distinct registration albeit of the same trademark. The view taken by this Court in the case of Skol Breweries Limited Vs.Som Distilleries & Breweries Limited and Shaw Wallace & Company Limited (supra) applies to the facts of this case. I am respectfully bound by the said judgment. In my view, condition of disclaimer provided in two of the certificate of registration of trademark of the plaintiff cannot be read as condition in the other certificates of registration. Submission of the learned counsel for the defendant is thus without any merit and is rejected.

101. In so far as the submission of the learned counsel for the defendant that the defendant has neither manufactured any product ppn 48 nms-2695.16(j).doc reflected in the affidavit dated 22nd February 2017 filed by the plaintiff nor those products are marketed by it or that no dealers of the defendant are appointed at the place mentioned in the said affidavit is concerned, the photographs annexed to the said affidavit dated 22 nd February 2017 prima facie indicate that the words "Poma-Ex Products" have been removed by the defendant and label is now used by the defendant similar to the label of the product of the plaintiff. Photographs prima facie indicates that the label containing trademark of the plaintiff and label containing trademark of the defendant on the products being sold by those dealers which are displayed side by side ex facie indicate the similarity of the two products to the last decimal.

102. It is not the case of the defendant that those dealers, who have displayed the products of the plaintiff as well as the defendant at Ludhiana, are manufactured by the plaintiff in toto or that the trademark of the defendant is infringed by the plaintiff or a third party. In my prima facie view, there is no merit in this submission of the learned counsel for the defendant that after granting ad-interim order by this Court in favour of the plaintiff, the defendant has not manufactured those goods with infringed label containing registered trademark of the plaintiff or that the same are not sold by the defendant through a dealer. It is not the case of the defendant that the defendant has taken any action against those dealers for selling the product by infringing the trademark of the defendant. Similarly there is no substance in the submission of the learned counsel for the defendant that after an ad-interim order came to be passed by this Court, the defendant has stopped

using the label of the plaintiff.

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103. In so far as the submission of the defendant that in view of the defendant already having registered its trademark as "KWIKHEAL" and on that ground, is entitled to statutory protection under Section 30 of the Trade Marks Act, 1999 is concerned, it is the case of the plaintiff that the defendant is deliberately not using the registered trademark of the defendant in toto but has removed the words "Poma-Ex Products" and has been using the label similar to the label of the plaintiff.

104. A perusal of the affidavit-in-reply dated 8th March 2017 filed by the defendant indicates that it is the case of the defendant itself that certain insignificant alterations are made on the label according to the requirement of bulk buyers of the said products bearing trademark "KWIKHEAL" label. Though the said statement made in the affidavit dated 8th March 2017 appears to be incorrect, even if the said statement is considered since the defendant is not manufacturing and marketing products by using bearing trademark "KWIKHEAL" on labels same and similar to the registered trademark and has copied the dominant part of the registered trademark of the plaintiff i.e. "KWIKHEAL," the defendant is not entitled to protection under Section 30 of the Trade Marks Act, 1999.

105. This Court in the case of M/s.Siyaram Silk Mills Ltd. Vs. M/s.Shree Siyaram Fab Pvt. Ltd.(supra) has held that Section 29 of the Trade Marks Act, 1999 does not prohibit the filing of a suit for infringement merely because the defendant's mark is also registered. There is no bar against the Court for exercising inherent jurisdiction to entertain or try the suit for infringement. Section 29 provides a defence to an infringement action but does not bar the filing of the suit. It is ppn 50 nms-2695.16(j).doc held that Section 30(2)(e) provides a defence to an action for infringement, however, does not bar the institution of a suit for infringement. This Court considered Section 124 of the Trade Marks Act, 1999 and held that the legislature did not intend prohibiting the filing of a suit for infringement merely because the defendant's mark is also registered. The said provision expressly recognizes the right to file such an action. It is held that the defence under Section 29 can only be limited to and qua the use of the defendant's registered label mark and nothing else.

106. In my view, since the defendant is in manufacturing and marketing its products bearing its trademark "KWIKHEAL" on label different than the registered trademark of the defendant and has virtually copied the registered trademark of the plaintiff, the defendant is not entitled to seek any protection of its trademark having been registered. The principle of law laid down by this Court in the case of M/s.Siyaram Silk Mills Ltd. Vs. M/s.Shree Siyaram Fab Pvt. Ltd. (supra) squarely applies to the facts of this case. I am respectfully bound by the said judgment.

107. In so far as the issue of jurisdiction raised by the defendant in the affidavit-in-reply is concerned, the defendant has not pressed that issue seriously before this Court. Be that as it may, the defendant did not apply before this Court to frame a preliminary issue of jurisdiction under Section 9A of the Code of Civil Procedure, 1908. This Court in the case of Ferani Hotels Private

Limited Vs. Nusli Neville Wadia and Ors. (supra) has held that in certain cases, the provision of Section 9A is capable of being abused by the defendant. The defendant could not demonstrate before this Court at this stage as to how this Court has no jurisdiction to entertain, try and dispose of the suit. This Court has held that in order to ensure that Section 9A is not susceptible to grave abuse at the behest of an unscrupulous defendant, it would be within the jurisdiction and authority of the trial Judge to consider as to whether the objection as to jurisdiction arises bonafide or whether it is wholly frivolous. Be that as it may, in my prima facie view, there is no substance in this issue raised by the defendant in the affidavit-in-reply.

108. In so far as the submission of the learned counsel for the defendant that the plea of the plaintiff alleging infringement of the alleged copy right of the plaintiff is without any particulars or requisite documents is concerned, a perusal of the averments made in paragraphs 15 and 22 of the plaint indicates that the plaintiff has made sufficient averments in those two paragraphs about the alleged ownership of the plaintiff of the copyrights in the artistic work comprised in FEVIKWIK Distinctive Packaging. It is the case of the plaintiff that the said packaging was created in-house by an employee of the plaintiff during the course of employment and constitutes an original artistic work in which copyrights subsist. In paragraph 24 of the plaint, the plaintiff has alleged infringement of the said copyrights by the defendant.

109. Section 17 of the Copyright Act, 1957 provides for Ownership of Copyright and the Rights of the Owner of such copyrights. A perusal of Section 17 of the Copyright Act, 1957 indicates that in absence of any agreement to the contrary, an employer would be the first owner of the copyright in the work in the case of a literary, dramatic or artistic work made by the author in the course of his employment by the proprietor of a newspaper, magazine or similar periodical under a contract of service or apprenticeship, for the purpose of publication in a newspaper, magazine or similar periodical. The plaintiff in this case claims to be the owner of the copyrights in the artistic work i.e. FEVIKWIK Distinctive Packaging.

110. In my prima facie view, the plaintiff would be the first owner of such copyrights in the artistic work. A perusal of the said provision does not indicate that the plaintiff is required to produce any agreement or contract from the employee who has created such artistic work during the course of his employment of the plaintiff. In my view, there is thus no substance in the submission of the learned counsel for the defendant that the plaintiff not having produced any copy of the contract with the employee or not having produced any document showing assignment of the copyrights in favour of the plaintiff, the plaintiff is not entitled to allege infringement of such copyrights by the defendant.

111. This Court in the case of Zee Entertainment Enterprises Ltd. Vs. Gajendra Singh & Ors. (supra) has held that as a rule of pleading, it is not necessary for an employer to mention the names of the employees involved in making of any copyright work. The principle of law laid down by this Court in the case of Zee Entertainment Enterprises Ltd. Vs. Gajendra Singh & Ors. (supra) squarely applies to the facts of this case. I am respectfully bound by the said judgment.

112. Delhi High Court in the case of Gufic Ltd. & Anr. Vs. Clinique Laboratories, LLC and Anr.(supra) has rejected the similar ppn 53 nms-2695.16(j).doc arguments advanced by the defendant in that case which are advanced before this Court. I am in agreement with the views expressed by the Delhi High Court in the case of Gufic Ltd. & Anr. Vs. Clinique Laboratories, LLC and Anr.(supra). In my view, there is thus no merit in the submission of the learned counsel for the defendant that no cause of action is disclosed by the plaintiff in so far as the infringement of the copyrights of the plaintiff is concerned. The necessary documents can be produced by the plaintiff at the stage of oral and documentary evidence.

113. Though the learned counsel for the defendant made a statement before this Court on 28th February 2017 that somebody else was using the same name of the defendant and manufacturing the impugned product at Bhavana, Delhi, it is not the case of the defendant that somebody else has been using the same name of the defendant and manufacturing the impugned product at Ludhiana which was brought on record by the plaintiff by an affidavit dated 22nd February 2017.

114. In so far as the alleged infringement of the registered trademark FEVIKWIK Distinctive Packaging of the plaintiff is concerned, learned counsel for the plaintiff has produced samples of the products of the plaintiff as well as the defendant in Court. I have also minutely perused the photographs annexed by the plaintiff in the affidavit dated 22nd February 2017 filed by the plaintiff in these proceedings and also such samples produced. On comparison of the product samples which were produced in this Court for consideration of this Court and the photographs, it prima facie indicates that the product of the defendant ppn 54 nms-2695.16(j).doc is a colourable imitation of the FEVIKWIK product of the plaintiff. The defendant has packaged its product in packaging which copies the FEVIKWIK Distinctive Packaging in an identical manner and comprises of the plaintiff's unique and distinctive colour combination of yellow and shades of blue, the mark "KWIKHEAL" which is similar to the mark "FEVIKWIK" written in an identical font and red lettering as that of FEVIKWIK. Blue ball device depicted at the top of the words KWIKHEAL is identical to the blue ball device in the FEVIKWIK Distinctive Packaging. The overall get-up and look of the defendant's product appears to be identical to the get-up, look and feel of the plaintiff's product.

115. This Court has already taken prima facie view by an order dated 5th May 2014 holding that the defendant had adopted the packaging in respect of the impugned product with a view to ride on the reputation of the plaintiff which has been generated in the FEVIKWIK Distinctive Packaging and are seeking to misrepresent their products as those of the plaintiff leading to or likely to lead to confusion amongst the trade and the consuming public. It is held that the defendant had infringed the registered trademark of the plaintiff. The balance of convenience is also in favour of the plaintiff and continued use by the defendant would cause grave injury to the plaintiff and its trademark. The said ad-interim order passed by this Court has not been impugned by the defendant.

116. Though it is the case of the defendant that after the said ad- interim order came to be passed by this Court on 5 th May 2014, the defendant has stopped manufacturing the impugned product with the colour combination as alleged by the plaintiff, a perusal of the record ppn 55 nms-2695.16(j).doc prima facie indicates that the defendant continues to manufacture the impugned product with the colour combination of the product of the plaintiff in violation of the ad-interim order granted by this

Court.

117. The colour photographs of the product samples of the parties furnished by the learned counsel for the plaintiff for perusal of this Court which are compared by this Court for the purpose of rendering a prima facie finding are reflected herein :-

PLAINTIFF'S TRADE MARK LABEL - FRONT SIDE PLAINTIFF'S TRADE MARK LABEL - BACK SIDE ppn 56 nms-2695.16(j).doc DEFENDANT'S ORIGINAL TRADE MARK LABEL FRONT SIDE DEFENDANT'S ORIGINAL BACK SIDE LABEL DEFENDANT'S TRADE MARK REGISTRATION NO.2223608 IN CLASS 16 DATED 20/10/2011 ppn 57 nms-2695.16(j).doc DEFENDANT'S NEW/CURRENT TRADE MARK LABEL

-FRONT SIDE DEFENDANT'S NEW/CURRENT TRADEMARK LABEL

- BACK SIDE

118. A perusal of the record further indicates that the plaintiff has spent considerable amount of money as and by way of the advertisement and sales and promotional expenditure for promoting sale of the Fevi kwik products including those sold in the FEVIKWIK Distinctive Packaging. The plaintiff has annexed a certificate issued by the Chartered Accountant showing the promotional and advertising expenditure in respect of the "FEVIKWIK" product of the plaintiff ppn 58 nms-2695.16(j).doc from the accounting year 2005-06 till 2012-13. The plaintiff has incurred Rs.292.26 lakh in the year 2005-06 which is increased to Rs.2124.98 lakh in the year 2012-13. The defendant, however, has not produced any material on record of this Court to show that the defendant has incurred any amount for the advertisement and towards promotional expenditure for promoting the sale of the product of the defendant with the trademark "KWIKHEAL."

119. In my prima facie view, the plaintiff has thus garnered goodwill and reputation in the market. The amounts spent by the plaintiff is substantial and has increased multi fold between the accounting year 2004-05 and 2012-13. It is not in dispute that this Court has already granted leave under Clause XIV of Letters Patent in favour of the plaintiff on 20th October 2016 in Leave Petition No.138 of 2014. The plaintiff, in this case, has alleged infringement of the trademarks, copy rights and also has prayed for interim relief on passing of action in common law.

120. This Court in the case of Hiralal Parbhudas Vs. Ganesh Trading Company & Ors. (supra) has quoted Kerly's 'Law of Trade Marks and Trade Names' 10th Edition, with approval in which it was opined that two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same marks as that with which he was acquainted. This Court adverted to the judgment of the Supreme Court in the case of ppn 59 nms-2695.16(j).doc Corn Products vs. Shangrila Food Products, AIR 1960 SC 142 holding that in deciding the question of similarity between the two marks, the approach

must be from the point of view of a man of average intelligence and of imperfect recollection and to such a person the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause confusion between them.

121. A perusal of the FEVIKWIK Distinctive Packaging of the plaintiff with the packaging of the defendant prima facie indicates that the overall structural and phonetic similarity between two products is likely to cause confusion between them in the mind of the customers. The customers for purchase of these products duly sold at Rs.5/- each pouch may not be very intelligent everytime than the learned customers. Principles of law laid down by this Court in the case of Hiralal Parbhudas Vs. Ganesh Trading Company & Ors. (supra) applies to the facts of this case. I am respectfully bound by the said judgment. Principles of law laid down by this Court in the case of James Chadwick & Bros.Ltd.Vs. The National Sewing Thread Co.Ltd.(supra) relied upon by learned counsel for the plaintiff would assist the case of the plaintiff.

122. Supreme Court in the case of Midas Hygiene Industries P. Ltd. & Anr. Vs. Sudhir Bhatia & Ors.(supra) has held that in cases of infringement either of Trade Mark or of Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the Mark was itself dishonest. In my prima facie view, on comparison of the products including FEVIKWIK Distinctive Packaging indicates that adoption of ppn 60 nms-2695.16(j).doc the mark "KWIK" by the defendant was with dishonest intention and caused confusion in the mind of the customers with an intention to make profit and take undue advantage of the goodwill and reputation of the plaintiff. Principles of law laid down by this Court in the case of Midas Hygiene Industries P. Ltd. & Anr. Vs. Sudhir Bhatia & Ors.(supra) applies to the facts of this case. I am respectfully bound by the said judgment.

123. Delhi High Court in the case of Foodcraft India Private Limited Vs. Saurabh Anand Trading & Ors.(supra) has considered the similar ratio and rejected the similar contention. Principles of law laid down by this Court in the case of Foodcraft India Private Limited Vs. Saurabh Anand Trading & Ors.(supra) applies to the facts of this case. I am in agreement with the views expressed by the Delhi High Court in the said judgment.

124. In this case, the plaintiff has used the word "KWIK" as suffix in its trademark "FEVIKWIK" whereas the defendant has used the said word "KWIK" as prefix in its registered mark "KWIKHEAL." A similar issue is considered by this Court in the case of Schering Corporation & Ors. Vs.Kilitch Co. (Pharma) Pvt. Ltd. (supra) and the similar contentions raised by the defendant therein are rejected by the Division Bench of this Court in the said judgment. The Division Bench confirmed an injunction granted by the learned Single Judge alleging infringement of the trademark. Principles of law laid down by the Division Bench of this Court in the case of Schering Corporation & Ors. Vs.Kilitch Co. (Pharma) Pvt. Ltd. (supra) applies to the facts of this case. I am respectfully bound by the said judgment.

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125. Supreme Court in the case of Heinz Italia and Anr. Vs. Dabur India Ltd. (supra) has held that mere fact that the respondent had time and again made small changes in their packaging is an attempt to continue to mislead the purchaser and to make it more difficult for the appellants to protect their mark, which the record showed that the same had acquired an enviable reputation in the market which was sought to be exploited by the respondent. Supreme Court accordingly continued the ad-interim injunction granted by the learned Trial Judge. In this case also, the defendant has removed the word "POMA-EX" from the label of the defendant deliberately though has kept the remaining ingredients identical. The principles of law laid down by the Supreme Court in the case of Heinz Italia and Anr. Vs. Dabur India Ltd. (supra) granting injunction inspite of such small changes made by the defendant in their packaging with a view to mislead the purchasers squarely applies to the facts of this case. I am respectfully bound by the said judgment.

126. In so far as the relief sought by the plaintiff in common law i.e. for infringement of passing off action is concerned, in my view, learned counsel for the plaintiff is right in his submission that even if two of the registrations of the trademark of the plaintiff were conditional and though the trademark of the defendant is registered, the plaintiff is entitled to seek relief under passing off action in common law on the ground that the plaintiff was the prior user in point of time and has garnered goodwill and reputation in the market. The plaintiff has spent substantial amount on advertisement and sales and promotional expenses on its product. The defendant has not produced any material on record to show that it had incurred any amount on advertisement or towards ppn 62 nms-2695.16(j).doc sales and promotional expenses or has earned any goodwill and reputation in the market.

127. Supreme Court in the case of Heinz Italia and Anr. Vs. Dabur India Ltd. (supra) has considered the similar facts and has held that in an action for passing off, the plaintiff has to establish prior user to secure an injunction and that the registration of the mark or similar mark in point of time, is irrelevant. It is held that in case of registered trade marks, a passing off action is maintainable. The plaintiff has to prove that the product that he is representing had earned a reputation in the market and that this reputation had been sought to be violated by the opposite party. The plaintiff has to prima facie show that there was a dishonest intention on the part of the defendant in passing off goods and if it is shown, an injunction should ordinarily follow and the mere delay in bringing the matter to Court was not a ground to defeat the case of the plaintiff.

128. In this case, the defendant has adopted the mark of the plaintiff and has been manufacturing and selling the product with the packaging containing the mark "KWIKHEAL" which is similar to that of the trademark of the plaintiff as if the defendant has sold the product that of the plaintiff. The principles of law laid down by the Supreme Court in the case of Heinz Italia and Anr. Vs. Dabur India Ltd. (supra) granting injunction in a passing off action squarely applies to the facts of this case. In my view, the plaintiff has made out a case for grant of reliefs on the ground of infringement of the trademarks, copyrights and also passing off action in common law.

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129. In my prima facie view, there exists a high degree of phonetic similarity between the mark of the plaintiff "FEVIKWIK" and the mark of the defendant "KWIKHEAL." The word "KWIK" has dominant part of the trademark of the plaintiff "FEVIKWIK." The mark used by the defendant "KWIKHEAL" is a prima facie deceptive or misleading. In my view, the balance of convenience is in favour of the plaintiff and against the defendant. The plaintiff has made out a prima facie case.

130. I therefore pass the following order :-

(i) Notice of motion is made absolute in terms of prayer clauses (a) to

(d) and (f).

(ii) There shall be no order as to costs.

(iii) The defendant and the Court Receiver to act on the authenticated copy of this order.

R.D. DHANUKA, J.