

*K.S. Jadhav*

IN THE HIGH COURT OF JUDICATURE AT BOMBAY  
ORDINARY ORIGINAL CIVIL JURISDICTION

INTERIM APPLICATION (L) NO. 15502 OF 2021

IN

COMMERCIAL IP. SUIT NO.147 OF 2022

Pidilite Industries Limited

...Applicant/  
Plaintiff

*Versus*

Riya Chemy

...Defendant

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Mr. Hiren Kamod a/w Nishad Nadkarni, Mr. Aasif Navodia & Ms. Khushboo Jhunjhunwala i/b Khaitan and Co., Advocates for Plaintiff.

Mr. S. Ramakrishnan a/w Ms. Girish Thakur, Advocates for Defendant.

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**CORAM : R.I. CHAGLA, J.**

**JUDGMENT RESERVED ON : 27TH SEPTEMBER, 2022.**


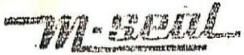

**JUDGMENT PRONOUNCED ON : 11TH NOVEMBER, 2022.**

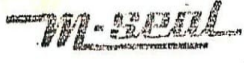
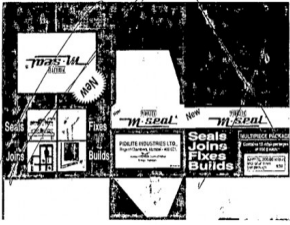



**JUDGMENT (Per R.I. Chagla, J.)**

1. The present Interim Application has been heard finally at the ad-interim stage by consent of the parties.

2. A brief background of facts is necessary.
  
3. The Plaintiff is a world-renowned company, carrying on business in the field of sealants and adhesives, construction and paint chemicals, art materials, industrial adhesives, industrial and textile resins and organic pigments and preparations since at least 1969. The mark M-SEAL was conceived and adopted by the Plaintiff's predecessors in title i.e., Mahindra Van Wijk and Visser Ltd. (later known as Mahindra Electrochemical Products Ltd. – “MEPL”.) in or about the year 1968, and has been continuously, extensively and in an uninterrupted manner used since then. **(Paragraph 5, pages 4-5 of the Plaintiff)**
  
4. The said mark and the artistic representation thereof have been acquired by the Plaintiff pursuant to agreement dated 27 March 2000, together with the goodwill thereof and the Plaintiff is the registered proprietor of the mark M-SEAL and/or marks consisting of M-SEAL as one of its leading, essential and distinctive features **(Paragraph 5, pages 4-5 of the Plaintiff)**.

5. Plaintiff's earliest trade mark registration bearing no. 282168 in respect of the mark M-SEAL, dated 16th August 1972, claiming use from 1st December 1968 is at **Exhibit B-1, pages 67-68 of the Plaintiff**. The mark M-SEAL (word per se) is the leading and essential feature of the said registration of the Plaintiff. Copies of trade mark registration certificates / online case statuses from the website of the Trade marks Registry, in respect of the Plaintiff's M-SEAL registered marks are at **Exhibits B-1 to B-10, pages 67-87 of the Plaintiff**. The registrations are valid and subsisting and the entries appearing on the register of trade marks including the dates of use thus constitute prima facie evidence of such facts. As stated above, the Plaintiff's sample M-SEAL trade mark registrations are set out below:

Mark	Application No.	Class & Status	Date of Use	Date of Application
	<a href="#">282168</a>	1 Registered	01.12.1968	16.08.1972
	<a href="#">916539</a>	16 Registered	-	07.04.2000
	<a href="#">916538</a>	2 Registered	-	07.04.2000

	<a href="#">916540</a>	19 Registered	-	07.04.2000
	<a href="#">961689</a>	1 Registered	-	06.10.2000
	<a href="#">1347394</a>	1 Registered	01.10.2001	29.03.2005
M-SEAL PHATAPHAT	982544	1 Registered	01.04.1996	09.01.2001
M-SEAL SUPERFAST	982543	1 Registered	01.02.1998	09.01.2001
	1347392	1 Registered	01.10.2001	29.03.2005
	1347391	1 Registered	01.10.2001	29.03.2005

6. It is stated that the Plaintiff's M-SEAL registration bearing No. 982544 (Exhibit B-7, pages 79-80 of the plaint) contains a disclaimer with regard to the word PHATAPHAT, however the mark as a whole is registered and to that extent all features taken as a whole stand protected by the registration. Further, it

is stated that registration bearing no. 282168 (**Exhibit B-1, page 67-68 of the plaint**) contains a disclaimer with regard to the word SEAL and the registrations bearing nos. 961689 (**Exhibit B-5, pages 76-77 of the Plaint**) and 1347392 (**Exhibit B-9, pages 83-84 of the Plaint**) have a condition imposed on it viz *“Registration of this trade mark shall give no right to the exclusive use of the all other descriptive matters appearing on the label”*. However, the Plaintiff states that these conditions do not limit the rights of the Plaintiff including for reasons set out hereinafter and in any event the rest of the M-SEAL registrations have no conditions/limitations. In any event, the Plaintiff’s mark M-SEAL (word per se) has been taken judicial notice of and has also received judicial protection in the past by this Hon’ble Court [**Pidilite Industries Limited Vs. S.M. Associates & Ors, 2004 (28) PTC 193 (Bom)**]<sup>1</sup>, despite the presence of and after consideration of the disclaimers/conditions imposed. The Plaintiff states that it is independently entitled to succeed in the present suit on the basis of the registrations listed in the table above

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1 2004 (28) PTC 193 (Bom)

and the facts/circumstances pleaded. Furthermore, common law rights in the said features subsist in favour of the Plaintiff.

7. The unique and distinctive artistic representation of M-SEAL i.e., ***M-seal*** (including in particular the unique line below the mark which is an extension from the first letter of the mark) as well as the M-SEAL Labels are original artistic works in respect of which copyrights subsist and such copyrights are owned by the Plaintiff. The initial M-SEAL label had been assigned to the Plaintiff in the year 2000 by the Plaintiff's predecessors in title and the same has been slightly modified by the Plaintiff from time to time thereafter. One of the recent packaging labels in respect of the M-SEAL (Phataphat) product was being used by the Plaintiff since 2001, a slightly modified version of which is being used since 2008. Plaintiff's copyright registration certificate in respect of one of the M-SEAL Labels is at **Exhibit 2, pages 112-114 of the Plaintiff's Affidavit in Rejoinder.**

8. The M-SEAL Label(s) *inter alia* bear the following essential features: i) a distinctive white, blue and red color scheme; ii) contrasting red, white or black lettering; iii) the mark ‘M-SEAL’ written in a unique and distinctive stylized manner written in red font upon a white background i.e. ***M-seal***; iv) the identification-mark PHATAPHAT written on the label; v) the unique and distinctively represented tagline “*SEALS JOINS FIXES BUILDS*” (hereinafter referred to as the “**M-Seal Tagline**”); written on the label. The label has other distinctive features as well all of which are represented and placed in a distinctive layout, colour scheme and get up. Though the initial label of 2001 for the product in question was slightly modified in 2008, the essential and distinctive features of the label continue to remain the same as set out above and both the M-SEAL Labels and the features thereof continue to be identified and associated by the trade and public at large with the Plaintiff alone. The M-SEAL Label(s) also containing the identification mark PHATAPHAT and the M-Seal Tagline also function as, and are



used as a trade mark and trade dress upon and in relation to the M-SEAL products of the Plaintiff. (paragraphs 6 and 7, pages 5-7 of the plaint).

9. The Plaintiff states that the Plaintiff's M-SEAL brand has been openly, continuously, extensively and uninterruptedly used, promoted and advertised by Plaintiff's predecessors in title and thereafter by the Plaintiff since at least 1968. Within a short span of time from the commencement of sales, Plaintiff's products sold under the mark M-SEAL, including in particular the unique stylized manner in which the mark M-SEAL is being used i.e. ***M-SEAL***, the earlier labels and the M-SEAL Labels also containing the M-SEAL Tagline and the sub mark PHATAPHAT, popularly came to be known and referred to as M-SEAL amongst the public at large and came to be associated exclusively with the Plaintiff. It is stated that the Plaintiff's brand M-SEAL as well as the stylized representation thereof as well as the M-SEAL Labels, M-SEAL Tagline and identification mark PHATAPHAT are well known.





10. The Plaintiff states that the Plaintiff's products under the M-SEAL brand have been extensively sold and have become extremely successful and popular and have earned Plaintiff crores of rupees in revenues. Reliance is placed on certificate of a Chartered Accountant certifying sales figures in respect of Plaintiff's products sold under the M-SEAL brand, since the year 2000-01 till March 2020, at **Exhibit C, Pages 88-89 of the Plaintiff.** The Plaintiff states that it has invested substantially in advertising, publicizing, and promoting its products under brand M-SEAL over the last several years and such promotional expenditure exceeds crores of rupees. Reliance is placed on the certificate of a Chartered Accountant certifying promotional and advertisement figures in respect of Plaintiff's M-SEAL products, since the year 2015-16 till 2019-20 at **Exhibit E, page 170 of the Plaintiff.**

11. The Plaintiff states that in or about December 2020, the Plaintiff was shocked and surprised to come across sealant products of the Defendant being sold under the mark R-SEAL,


which mark is deceptively similar to the Plaintiff's registered trade mark M-SEAL. The mark R-SEAL is also written and used by the Defendant in an identical stylized manner of disjuncting the first letter of the mark from the rest and extending the first letter into an underlining for the rest of the mark i.e., , as to that of the Plaintiff's mark . The said product of the Defendant is identical to the M-SEAL product of the Plaintiff and the Defendant's product also bears an impugned packaging/labels/trade dress which is an reproduction of and/or in appearance, almost identical or deceptively similar to the M-SEAL products of the Plaintiff, and the M-SEAL Labels. The Plaintiff further states that the dishonesty and mala fides of the Defendants is evinced by the fact that the impugned label used by the Defendant on its product also bears the impugned taglines "SEALS JOINS FIXES BUILDS"/ "BUILDS FIXES JOINS SEALS" which are identical with the M-SEAL Tagline. The impugned products of the Defendant also bear the impugned identification mark JHAT-PAT that is deceptively similar to the Plaintiff's

identification mark PHATAPHAT (paragraph 18, page 15 of the Plaintiff).

12. A comparison of the rival products and features (also available at page 16 of the Plaintiff) was tendered across the bar during the hearing dated 12 August 2022 and the same is also reproduced herein for ease of reference :



Plaintiff's M-SEAL product	Defendant's impugned products
	<div data-bbox="821 1084 1078 1431" style="border: 1px solid black; padding: 5px; margin-bottom: 10px;"> <p style="color: red; text-align: center;">M-SEAL vs R-SEAL and stylization, underlining, manner of usage of marks</p> <p style="color: red; text-align: center;">PHATAPHAT vs JHATPAT</p> </div> <div data-bbox="821 1435 1078 1675" style="border: 1px solid black; padding: 5px;"> <p style="color: red; text-align: center;">Tagline SEALS JOINS FIXES BUILDS Versus BUILDS FIXES JOINS SEALS</p> </div> <div data-bbox="1114 1160 1473 1464" style="text-align: right;">  </div> <p style="color: red; margin-top: 20px;">Colour combination and overall trade dress; use of blue, red, white and black, as well as layout / placement of features. Usage of identical terms "FAST CURING EPOXY COMPOUND/PUTTY"</p>

13. A notice dated 15 December 2020, was addressed to the Defendant by the Plaintiff through its advocates, calling upon the Defendant to cease and desist from committing the wrongful acts and from violating the Plaintiff's rights in its registered trade marks, copyrights and passing off. Vide a letter dated 19 December 2020, the Defendant, through its advocates, replied to the Plaintiff's aforesaid letter, *inter alia* setting up a stand and refusing to comply with the Plaintiff's requisitions.

14. The Plaintiff states that it had noted from the contents of the Defendant's reply dated 19 December 2020, that the Defendant has also made applications and wrongfully obtained trade mark registrations in class 1, bearing application nos. 860804 and 860805, for registration of the mark R-SEAL and a label mark containing R-SEAL () , in the same deceptively similar stylized manner as the Plaintiff's M-SEAL registered mark. Online case statuses from the website of the Trade Marks Registry in respect of the aforesaid Impugned Trade Mark Applications of the Defendant are at **Exhibits M-1 and M-2**,

pages 214 to 217 of the **Plaint**. Prior to institution of the suit, on or about 9 April 2021, the Plaintiff has filed rectification applications before the Trade Marks Registry against the Defendant's application nos. 860804 and 860805 aforesaid. Reliance is placed on copies of the rectification applications at **Exhibits M-3 and M-4, Pages 218-256 of the Plaintiff**. The Plaintiff states that the aforesaid applications and registrations by the Defendant are ex-facie illegal, fraudulent and ought to shock the conscience of this Court. The Plaintiff states that the registrations ought not to have proceeded to registration and are liable to be cancelled and removed from the Register of Trade marks. The rectification proceedings are pending adjudication.

15. Mr. Kamod, learned Counsel for the Plaintiff has submitted that infringement of a registered trade mark takes place by use of either an identical or a deceptively similar trade mark in relation to identical or similar goods. He has placed reliance on **Section 29 of the Trade Marks Act, 1999 – in particular Sections 29(2)(b) and 29 (4)**. He has submitted that

Defendant's usage of the impugned marks R-SEAL and/or , which are deceptively similar to the Plaintiff's mark M-SEAL and its unique stylized representation , is infringing the rights of the Plaintiff in its registered M-SEAL trade marks including the M-SEAL labels. The impugned mark R-SEAL is also structurally and phonetically similar to the Plaintiff's mark M-SEAL. No explanation has been given by the Defendant for adoption of the same style of writing of the impugned mark, as that of the Plaintiff's mark M-SEAL. The dishonesty on the part of the Defendant in adopting the impugned mark and as well as its representation (including the underline from the end of the first alphabet to the last and the colour scheme) is evident and apparent. It is evident that the Defendant has made every attempt to copy each feature of the Plaintiff's marks in an attempt to confuse consumers with the striking similarities whilst making minor and insignificant differences in an attempt to build up an unsustainable defense on the basis thereof.

16. Mr. Kamod has submitted that it is settled law that merely replacing one alphabet of the impugned mark and/or varying the font slightly, is inconsequential and the impugned mark is almost identical and/or deceptively similar to the Plaintiff's M-SEAL registered mark. The same is also being used in respect of identical goods as that of the Plaintiff.

17. Mr. Kamod has submitted that Defendant's impugned label bearing the impugned mark R-SEAL, is an imitation and/or a reproduction / a substantial reproduction of the Plaintiff's artistic copyright work comprised in the Plaintiff's M-SEAL Label(s) set out at **Exhibit A, page 66 of the Plaint.** Such copying and use amounts to infringement of the copyright of the Plaintiff subsisting in the said artistic works comprised in the said M-SEAL Label. He has placed reliance on **Section 51 of the Copyright Act, 1957.** He has submitted that it is the Defendant's admitted case that the colours used in the impugned label are similar to that of the Plaintiff. Slight variations in representation or placement of the colours are inconsequential and do not make

the Defendant's use non-infringing. The test to establish infringement of copyright is well settled. The Defendant's impugned work/label need not be an exact reproduction of the Plaintiff's work/label. It would be sufficient to establish copyright infringement if the Defendant's label looks similar or like a copy or is reproduction of substantial part of the Plaintiff's label, which in this case it evidently is. He has submitted that it is settled law that every intelligent copying must introduce a few changes, but that would not affect the Plaintiff's case in any manner. The Defendant's impugned work has incorporated essential and substantial features of the Plaintiffs work and therefore the test to establish copyright infringement has been met. Mr. Kamod has relied upon the judgment of this Court in *Pidilite Industries Limited Vs. S.M. Associates & Ors. (supra)* at Paragraph 24 & 25. He has submitted that bare perusal of the rival labels leaves an unmistakable impression that the Defendant's impugned label is nothing but a reproduction of the essential features of the



Plaintiff's M-Seal Labels.

18. Mr. Kamod has submitted that by using the impugned marks, label, identification mark, tagline and overall trade dress in respect of its R-SEAL products, the Defendant is seeking to misrepresent its goods as those of the Plaintiff or as having some connection with the Plaintiff, causing irreparable damage to the Plaintiff and to the goodwill and reputation of the Plaintiff's business and is also diluting the distinctiveness of the mark M-SEAL, ***m-seal***, M-SEAL Registered Marks and the M-SEAL Label also containing the M-SEAL Tagline and the identification mark PHATAPHAT of the Plaintiff. Such usage is likely to cause confusion and deception amongst the members of the trade and public at large. The same is a deliberate attempt on the part of the Defendant to trade upon the reputation and goodwill of the Plaintiff. The Defendant's mark R-SEAL written in an identical/deceptively similar stylized manner as that of the mark ***m-seal*** of the Plaintiff, the white, blue and red colour schemes, the red font, the overall layout and trade dress and

usage of the impugned labels, taglines and identification mark is clear evidence of the dishonest intentions of the Defendant to deceive and confuse the public, consumer and traders. Such wrongful actions of the Defendant amount to the tort of passing off and/or unfair competition and/or dilution and are actionable as civil wrongs.

19. Mr. Kamod has further submitted that identical defenses, as those being raised by the present Defendant, have already been raised by another Defendant in the past against the Plaintiff in respect of a suit for infringement of trade mark and copyright pertaining to the M-SEAL product of the Plaintiff. The same have been adjudicated upon by this Court in favour of the Plaintiff and injunctive reliefs have been granted in favour of the Plaintiff. Reliance is placed on the judgment of this Court in *Pidilite Industries Limited Vs. S.M. Associates & Ors. (supra)* at Paragraphs 1, 2, 7, 9, 39, 40, 41, 42, 42(8), 42(9), 43, 45, 46, 47, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 63, 76 and 84.

20. Mr. Kamod has submitted that the Plaintiff is the prior

adopter and user of the mark M-SEAL for which he has relied upon the Plaintiff's trade mark registration bearing no. 282168 in class 1, in respect of the mark M-SEAL dated 16<sup>th</sup> August, 1972, and with a user claim from 1<sup>st</sup> December, 1968. He has relied upon *Pidilite Industries Limited (supra)* to contend that the Plaintiff's acquisition of M-SEAL mark in 2000 was together with the goodwill and that judicial notice of the same had been taken in the said decision.

21. Mr. Kamod has submitted that the Defendant has failed to prove its alleged user claim or alleged reputation or goodwill. Further, the documents relied upon by the Defendant are subsequent to the user claim of the Plaintiff. The alleged sales figures provided by the Defendant are in respect of entire Defendant's firm and not in respect of R-SEAL products alone (if at all). He has further submitted that the alleged certificate of Chartered Accountant relied upon by the Defendant in the supplementary Affidavit-in-Reply at Annexure-G, Page 215 is in respect of the turnover of the Defendant's firm and not its R-

SEAL products alone (if at all). The Defendant had also sought to place reliance on (purported invoices from the year 1999 to 2005) which are alleged to be annexures to a user affidavit filed by it before the Trade Mark Registry. However, the Defendant has itself admitted that the said alleged annexures are not available and have not been produced. Defendant's reliance upon the same, therefore, is impermissible and of no assistance to the Defendant.

22. Mr. Kamod has submitted that the Defendant has neither pleaded nor alleged any acquiescence on the part of the Plaintiff. The Defendant has not even pleaded that it is an honest and/or concurrent user. He has placed reliance on judgment in *ITC Limited Vs. NTC Industries Ltd, MANU/MH/2559/2015*<sup>2</sup> (Paragraphs 15, 17, 17(26), and 19 at pages 6 to 8) and in *Aglowmed Limited Vs. Aglow Pharmaceuticals Private Limited, MANU/MH/2075/2019*<sup>3</sup> (Paragraph 18 at page 10). The Defendant has admitted that it has not taken the defense of acquiescence.

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2 MANU/MH/2559/2015

3 MANU/MH/2075/2019

In any event, the Plaintiff has not acquiesced to the Defendant's user of the impugned mark/label/trade/dress/getup/tagline. Mr. Kamod has also submitted that there is no honesty in the Defendant's adoption. He has placed reliance upon the judgment of this Court in *Cadilla Pharmaceuticals Limited Vs. Sami Khatib, MANU/MH/0497/2011*<sup>4</sup> (Paragraph 15 at page 5 and paragraph 23 (B) at page 9) in support of his contention that honesty in adoption is not a defence to an action for infringement.

23. Mr. Kamod has further submitted that the Defendant has not produced any Search Report and in fact submitted in Court that no search was conducted by the Defendant before adopting the impugned mark. The Defendant has not taken elementary precaution of making himself aware by looking at the public record of Registrar as to whether the mark in question is the property of another. Thus, the Defendant has gambled by investing whatever amount it may allegedly have, in its

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4 MANU/MH/0497/2011

infringing mark and its usage of the infringing mark cannot be a defence to an action by a registered proprietor of a prior adopted and registered mark. Mr. Kamod has in this context relied upon the decision of the Division Bench of this Court in *Bal Pharma Ltd. Vs. Centaur Laboratories Pvt. Ltd., 2002 (24) PTC 226 (Bom) (DB)*<sup>5</sup> (paragraph 9).

24. Mr. Kamod has submitted that the word 'SEAL' or the colour scheme of 'M-SEAL' packaging/label is not common to the trade or generic. He has submitted that the Defendant has not led any documentary evidence whatsoever to show the extent of sales or even the existence of sales of the alleged products bearing marks containing the term SEAL. He has placed reliance upon the decision of this Court in *Jagdish Gopal Kamath & Ors. Vs. Lime & Chilli Hospitality Services, 2015 (62) PTC 23 [Bom]*<sup>6</sup> in the context of his submission that it is not enough to merely show some use (albeit absolutely no use has been shown by this Defendant). In order to show that the term SEAL has

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5 2002 (24) PTC 226 (Bom) (DB)

6 2015 (62) PTC 23 [Bom]

become generic or become common to trade, the burden is on the Defendant, who must show use by the trade that is extensive. Further, it has been held by this Court in *Pidilite Industries Limited Vs. S.M. Associates & Ors. (supra)* that the principle or requirement of proving extensive and substantial use by third parties is applicable and even binds the Defendant at the interlocutory stage, and the Defendant has to discharge such burden conclusively even at the interlocutory stage. In the present case, the Defendant has submitted that it cannot produce any evidence of other third parties using marks containing SEAL or the alleged “natural colours” since it does not know now to prove such use. Therefore, there has been a failure on the part of the Defendant in discharging the burden upon it to prove its contention, that SEAL or that the colour scheme of M-SEAL is allegedly common to the trade, including even at the prima facie stage.

25. Mr. Kamod has further submitted that the Defendant itself has adopted, used and also fraudulently secured registration of

the impugned R-SEAL marks bearing Nos. 860804 and 860805 containing the term SEAL as their leading and essential features in a trade mark sense. He has placed reliance upon the decision of this Court in of *Pidilite Industries Limited Vs. Jubilant Agri & Consumer Products Limited, (supra) (paragraph 10.1 at page 7 and paragraphs 13.2 to 13.4 at pages 13-15)* and the decision of this Court in judgment of *Jagdish Gopal Kamath & Ors Vs. Lime & Chilli Hospitality Services,(supra)* (paragraphs 23, 29-30) in support of his submission that the Defendant is therefore estopped from contending that the term SEAL is allegedly common to the trade or generic or incapable of protection or registered in the name of various other manufacturers or third parties.

26. Mr. Kamod has further submitted that the disclaimers on one of the Plaintiff's trade mark registrations (bearing no. 282168) with respect to "SEAL", does not limit the rights of the Plaintiff in any manner. He has placed reliance upon decision of this Court in *Pidilite Industries Limited Vs. S.M. Associates &*



Ors. (supra) at Paragraph 46 and 47 and Serum Institute of India Limited Vs. Green Signal Bio Pharma Pvt. Ltd. and Ors., 2011 (6) Bom CR82<sup>7</sup> at Paragraph 17 at page 12 in support of his contention that for the purpose of comparison of the marks to adjudicate upon the possibility of confusion or deception of the public, the whole of the mark (including the disclaimed portion) would have to be compared as that is how a common man would view the marks in the market. The very disclaimer which the Defendant has sought to be relied upon was considered by this Court in Pidilite Industries Limited Vs. S.M.Associates & Ors (supra) and upon which this Court has accorded judicial notice and protection to the Plaintiff's mark M-SEAL (word per se).

27. Mr. Kamod has submitted that in the present case the Defendant is claiming rights in the impuged R-SEAL marks including the word SEAL, forming the leading and essential feature thereof, whilst at the same time claiming that the same is generic. Mr. Kamod has placed reliance upon the decision of

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<sup>7</sup> 2011 (6) Bom CR 82

this Court in *Jagdish Gopal Kamath & Ors. Vs. Lime & Chilli Hospitality Services, (supra)* at Paragraphs 23, 29-30 to contend that the conduct of the Defendant is malafide and the Defendant has taken inconsistent and contradictory stands, blowing hot and cold at the same time.

28. Mr. Kamod has submitted that it is well settled by this Court in *Lupin Vs. Johnson & Johnson, AIR 2015 Bom 50<sup>8</sup> at Paragraphs 24, 26, 45, 59(1), 59(3) and 59(5)* as well as in *Pidilite Industries Limited Vs. Poma-Ex Products, 2017 (72) PTC 1 (Bom)<sup>9</sup> at Paragraphs 79, 81-84* that the Court has the power to go behind the Defendant's registration, even at the interlocutory stage and can grant injunction against the Defendant if registration of the trade mark of the Defendant is prima facie found ex facie illegal, fraudulent and shocks the conscience of the Court.

29. Mr. Kamod has submitted that in comparison of rival marks / labels to consider whether they are similar, it has been

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8 AIR 2015 Bom 50

9 2017 (72) PTC 1 (Bom)

laid down by the Supreme Court in *Cadilla Healthcare Limited Vs. Cadilla Pharmaceuticals Limited, 2001 (2) PTC 541 SC*<sup>10</sup> that attention and stress is to be given to the common features in the two rather than on differences in essential features. Further, this Court in *Jagdish Gopal Kamath & Ors Vs. Lime & Chilli Hospitality Services, 2015 (62) PTC 23 [Bom]*<sup>11</sup> at Paragraphs **17-18** has laid down that trivial and non-distinctive matters-what one might describe as mere sideshows-do not sufficiently distinguish a rival mark.

30. Mr. Kamod has accordingly submitted that the rival marks / labels cannot sail together or co-exist without causing confusion and deception of the public at large and without violating the rights of the Plaintiff. He has submitted that a prima facie case has been made out by the Plaintiff for grant of interim reliefs sought for. Further, the balance of convenience and irreparable loss, harm and injury is also apparent from the pleadings and the material on record. The Defendant has various

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10 2001 (2) PTC (541) SC

11 2015 (62) PTC 23 [Bom]

other products apart from the impugned product, as is the Defendant's own case, and therefore the Defendant's contention that its business will shut down if an injunction is granted, is false on the face of it.

31. Mr. Ramakrishnan, the learned counsel for the Defendant has submitted that the Plaintiff has failed to produce the Deed of Assignment and therefore, the details of the Assignment of Trademark and Copyright is unknown. Further, the extract from the website of the Trademark Registry provided by the Plaintiff's records that the details of assignment are unknown. He has submitted that decision of this Court in the *M-Seal Vs. S M-Seal* (*supra*) cannot be binding and a different interpretation is possible based on the reading on the entire Deed of Assignment.

32. Mr. Ramakrishnan has further submitted that the Plaintiff has failed to prove that they had used the said mark prior to the year 2000. He has further submitted that the marks M-Seal Phataphat and M-Seal Superfast registrations which have been produced by the Plaintiff is fraudulent since the user details in

each of these certificates says 1996 and 1998 respectively. The assignment, admitted by the Plaintiff themselves is in the year 2000 therefore, there is no possibility of having used the same prior to that. The Chartered Accountant certificate provided by the Accountant is of the year 2000 onwards for M-Seal Trademark and 2005 onwards for M-Seal advertising.

33. Mr. Ramakrishnan has submitted that the Defendant has produced invoices from the year 2005. However, for the period from 1999 to 2005 the Defendant has been unable to produce invoices since the same were destroyed by them being invoices older than 7 years and beyond the period of Income Tax audit. The Defendant in the year 2005 moved from manual invoicing to Tally ERP because of which prior data could not be extracted. He has placed reliance upon Affidavits which were filed at the time of reply to the Examination Report of the two marks of the Defendant and it is at Annexure-E to the supplementary Affidavit filed by the Defendant wherein at Paragraph 4 in both Affidavits it is clearly stated that invoices for the years 1999 to 2005 have

been produced which establishes that the trademarks of the Defendant has been in use since the year 1999.

34. Mr. Ramakrishnan has submitted in support of its contention that Seal being a general word (in addition the same being the disclaimer in the Trademark of the Plaintiff that was assigned) it is required to show that the industry practice is the use of said word with their products. Alternatively, he has submitted that from trademark applications, the 1968 application of the Plaintiff is a device mark whereas the Defendant has obtained registration of R-Seal word mark and device mark. Therefore, the Defendant is on a stronger footing as compared to the Plaintiff. The Plaintiff's application comes with a disclaimer on the use of the word Seal whereas the Defendant's registration both as device and word mark have no such disclaimers. Mr. Ramakrishnan has submitted that though several judgments have been relied by the Plaintiff which states that when series theory is being argued, sales of the other marks is also to be shown. However, there is no explanation provided as to how the same

can be done apart from showing a trademark registration since no company will be willing to reveal their sales or user figures.

35. Mr. Ramakrishnan has submitted that the registration certificates of both its marks would show that the said marks have gone through a process of scrutiny by the Trademark Registry wherein an examination report was also generated to which the Defendant had responded and only after the same was the registration accorded for both applications of the Defendant. In both Examination Reports, M-Seal has not been stated as a conflicting mark. Though Plaintiff has alleged fraud, no substantiation of the same has been made. The Plaintiff has not provided proof to show that at the time of the alleged Assignment of the Trademark in its favour by Mahindra, it has done a detailed search / due-diligence. Therefore, the Plaintiff cannot claim any kind of parity in this regard by shifting onus on the Defendant to have conducted searches before filing its applications. It is the Defendant's categorical submission that its mark is completely different from the M-Seal mark.

36. Mr. Ramakrishnan has submitted that the defence of acquiescence has not been taken by the Defendant since it has always been the Defendant's stand that its marks are different from that of the Plaintiff.

37. Mr. Ramakrishnan has submitted that there are various differences when comparing the rival marks of the Plaintiff and the Defendant. The Plaintiff when comparing with the image extracted in Page 16 of the Plaintiff has done a mix and match of the two images of horizontal and vertical boxes in order to create confusion. Mr. Ramakrishnan has submitted that with regard to the box containing the particulars in horizontal manner – M-Seal prominent colour is black and blue whereas R-Seal the white background is prominent. The manner or presentation of the names are also different since R-Seal has a Star and Riya over the same. This is in line with its Registration under Trademark No.860805. Further, Jhatphat and Phataphat are phonetically different. The logo of M-Seal is in the center of the box whereas the Defendant's details are spread across the box.



The two packing can be easily distinguished. With regard to the box containing the particulars in vertical manner – M-Seal prominent colour is black and blue whereas R-Seal has an array of colours and images. In fact in these boxes R-Seal's use of the word Jhatphat is on the sides of the box and not on the face of it. The two packing can be easily distinguished. The manner or presentation of the names are also different since R-Seal has a Star and Riya over the same. This is in line its Registration under Trademark No.860805. He has further submitted that the words builds/seals/fixes/joins are the properties of the product and is not a tag-line by any means. No consumer recognizes either of the products by these words. Further, when a consumer comes to the shop he either would ask for M-Seal or R-Seal and not M-Seal Phataphat or R-Seal Jhatphat.

38. Mr. Ramakrishnan has submitted that with regard to the allegation of copyright infringement, the Plaintiff has produced their copyrighted label at Exhibit-2 of the Affidavit in Rejoinder. A mere perusal of the label and the packs of the Defendant will

clearly establish that there is a world of difference between the two. The copyright certificate issued for the Plaintiff states that the same is used from 2001 whereas the Defendant has been using the packs since 1999 itself. He has accordingly submitted that though copyright infringement is pleaded, there are no proper details on what aspect of the Defendant's image / packing is infringing the copyright of the Plaintiff and a vague pleading is made in the Plaint.

39. Mr. Ramakrishnan has sought to distinguish the decisions relied upon by the Plaintiff. He has submitted that in so far as Lupin case which is relied upon by Mr. Kamod, the principle laid down therein is not in dispute, namely whether the Court can go into the prima facie validity of the trademark though the question of registration is to be decided by the trademark registry. However, it was submitted therein that the main suit ought to be stayed post orders on the Ad-interim Relief Application since the validity of the registration was pending before the Trademark Registry and thus Section 124 will apply

in all force.

40. Mr. Ramakrishnan has distinguished the decision in the case of *Pidilite Industries Limited Vs. Poma Ex-Products case (supra)* relied upon by the plaintiff. In that case, the judgment makes the argument acknowledging that two registrations there is a disclaimer regarding the use of the word ‘kwik’ whereas the same is not the case in two others. The Plaintiff therein had admitted that the disclaimers play a vital role and the words that are disclaimed are generic in nature. The Judge in that case had agreed to this line of argument. The samples of fewikwik and kwikheal in that case reveal that the exact same colours and presentation of the colours were used by the infringing mark and it was on this basis that the Court held in favour of fevikwik. Moreover, after interim order was granted, kwikheal secured trademark registration. The facts of the present case are entirely different since the registration precedes the assignment of trademark itself.

41. Mr. Ramakrishnan has submitted that the decision of this

Court in *Pidilite Industries Limited Vs. Jubilant Agri & Consumer Products Limited, (supra)* is different from the present case as in that case, the Defendant had withdrawn its Trademark Application. The Judge in that case concluded that customers refer to the product of fevicol as “marine” and not “fevicol marine”. In the present case, customers would refer to the product as M-Seal or R-Seal and not M-Seal Phataphat and R-Seal Jhatpat. In that case, the images of marine and marine plus are seen, the picture of ply falling into the water puddle is common in both and this would definitely cause confusion to an illiterate person. It is in the facts of that case that it was canvassed that marine does not have a disclaimer or in the present case, “Seal” is common in the industry.

42. Mr. Ramakrishnan has distinguished the decision of this Court in *Cadilla Pharmaceuticals Limited Vs. Sami Khatib (supra)* wherein there was dispute between two word marks. Further, there was discussion on the importance of wordmarks as regards medical products wherein it is concluded that the tests ought to

be more stringent for medicinal products. The decision is not applicable in the facts of the present case.

43. Mr. Ramakrishnan has further submitted that the decision in *Aglowmed Limited case (supra)* and *ITC Vs. NTC (supra)* are decision of acquiescence and as has been submitted on behalf of the Defendant in the present case, that the same is not in contention. It is the case of the Defendant herein that two marks are different and thus, there is no question of acquiescence.

44. The decision relied upon by the Plaintiff namely *Serum Institute of India Limited (supra)* is a case of registered versus unregistered mark and in that context it was stated that sales figures of other marks / brands ought to have been produced. Further, there is no explanation on how this can be achieved since no entity will be willing to part with its sales figures randomly. This case was between two wordmarks and in wordmarks the words by themselves plays an important role unlike device marks in the present case wherein the entire marks

wherein the entire layout is to be seen. This Court in that case had relied upon the invoice provided by the Chemist in which the brandnames were used interchangeably and was regarding placement of “ONCO” and “BCG” which does not arise in the present case.

45. Mr. Ramakrishnan has submitted that the decision relied upon by the Plaintiff namely *Bal Pharma Ltd. Vs. Centaur Laboratories Pvt. Ltd.,(supra)* is inapplicable in the present case as that decision was on acquiescence which does not arise in the present case. Further, the decision relied upon by the Plaintiff namely *Jagdish Gopal Kamath & Ors. Vs. Lime & Chilli Hospitality Services (supra)* was a case where both entities were using “cafe madras” and where the Defendant applied for registration after receipt of cease and desist notice. The present case is different since R-Seal was applied for in the year 1999 itself prior to the assignment of the trademark.

46. Mr. Ramakrishnan has further distinguished the decision of this Court in *Pidilite Industries Limited Vs. S.M. Associates &*

Ors (supra) which has been relied on behalf of the Plaintiff. He has submitted that in that case the Defendant had only added the letter “S” to “M-Seal” and thus was found infringing in addition to the fact that the placement of colours used was similar to the M-Seal packing. Further, an individual working in Pidilite went ahead and created S M-Seal which was established as being deceptively similar to M-Seal. He has submitted that in the present case the word “R-Seal” has been used and there is a Star between R-Seal and further the word “Riya” also is part of its mark.

47. Mr. Ramakrishnan has relied upon the decision of Delhi High Court in Hamdard National Foundation (India) & Anr. Vs. Sadar Laboratories Pvt .Ltd. (CS COMM 551/2020, 9th January, 2022)<sup>12</sup> in support of his submission that when the brands have been in peaceful co-existence for a long time, the question of confusion does not arise.

48. Mr. Ramakrishnan has further submitted that the

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documents relied upon which includes Chartered Accountant Certificate reflecting Defendant's sales as an entity and the Advertising and promotional material of the Defendant which are at Exhibit-G and H of the supplementary Affidavit respectively would go to show that the Defendant has been using the word mark and device mark for a long time and the Defendant being a woman enterprise that is more than two decades old would suffer gross prejudice in the event of interim relief being granted in favour of the Plaintiff. The Defendant has obtained registration in a legal manner and has not committed fraud at any point of time. In the event interim relief sought for by the Plaintiff is allowed, the Defendant will have no option but to shut down its business since almost 80-85% of its sales are from the R-Seal brand. Accordingly, it has been submitted that the relief sought for by the Plaintiff be not granted.

49. Having considered the rival submissions, I am of the prima facie view that the Plaintiff is the prior adopter and user of the mark M-Seal. It appears from the documents on record



at Exhibit-B1 to the Plaint that the Plaintiff's Trademark Registration bearing No.282168 in Class 1 in respect of the mark M-SEAL is dated 16<sup>th</sup> August, 1972 and with a user claim from 1<sup>st</sup> December, 1968. From the Defendant's own case, the date of adoption and use of the impugned mark R-SEAL is 1999 i.e. subsequent to 1968 and user claim of the Plaintiff of 1972. I do not find any merit of the submission of the Defendant that the Plaintiff cannot claim use of the mark M-SEAL since 1972 and/or registration of the mark from 1<sup>st</sup> December, 1968 and / or that the mark was acquired by the Plaintiff from its predecessors in title only in 2000. I find that the Plaintiff's acquisition of the M-SEAL marks in 2000 was together with the goodwill thereof. Section 38 and 42 of the Trade Marks Act, 1999 specifically provides for assignment with goodwill. The Plaintiff is entitled to claim all rights and privileges in the said marks, including statutory and common law rights, from the date of first usage of the said marks by its predecessors in title i.e. from 1968. The use of the said marks by the Plaintiff's predecessors in title is

deemed to be use by the Plaintiff and inures to the benefit of the Plaintiff. An acquisition of the mark does not change the date of first usage of the mark and this will apply to the Plaintiff's trademark registration in respect of M-SEAL Phataphat and M-SEAL Superfast marks which assignment had taken place in the year 2000, but the user of this marks would go back to the usage of the marks by the predecessors in title. Thus, there is no merit in the Defendant's contention that the Plaintiff's trademark registration in respect of the aforementioned marks of the Plaintiff have a false user claim, claiming user from 1996 and 1998, despite the assignment taking place in the year 2000.

50. It is necessary to note that the averments and documents produced by the Plaintiff sufficiently demonstrate the fact of the acquisition. Further, this Court in *Pidilite Industries Limited Vs. S.M. Associates & Ors. (Supra)* has taken judicial notice of the same and had recorded in Paragraph 2 of the said decision that the predecessors in title had applied for and obtained with effect from 16<sup>th</sup> August, 1972, the registration of the trademark

“M-seal” under the Registration No. 282168 in Class 1 and that the registration of the said mark is valid and subsisting having been renewed upto 16<sup>th</sup> August, 2007. Further, the recordal of assignment is reflected and freely available on the website of the Trade Marks Registry and which is, inter alia in respect of the Plaintiff’s M-SEAL mark bearing No.282168 in Class 1 which has also been tendered across the bar during the hearing on 22<sup>nd</sup> August, 2022. Thus, the Registrar of Trade Marks, pursuant to an application by the Plaintiff has after application of mind confirmed the recordal of assignment in respect of the mark M-SEAL. Under Section 45 of the Trade Marks Act, 1999, this prima facie evidence of the Plaintiff’s ownership of the mark M-SEAL.

51. I find that the Defendant has failed to produce documents in support of its alleged user claim in respect of the impugned marks from 1999. The earliest invoice made available by the Defendant in respect of its R-SEAL product is of the year 2005, which is subsequent to the Plaintiff’s adoption and use of the

mark M-SEAL. Further, I find that the sales figures provided by the Defendant is in respect of the Defendant's firm and not in respect of the R-SEAL products alone. The certificate of the Chartered Accountant is also in respect of the turnover of the Defendant's firm and not its R-SEAL products alone. Thus, the Defendant has failed to produce the relevant documents pertaining to the use of the impugned R-SEAL products and / or in order to show its user was based on its documents.

52. The Defendant had made an attempt to place reliance on Annexures which are purported invoices from the year 1999 to 2005, in its user affidavit filed by it before the Trade Marks Registry which is at Annexure-E to the Defendant's Supplementary Affidavit-in-reply. However, these Annexures have not been made available and hence, mere reference of these Annexures is of no significance and of no assistance to the Defendant. Thus, I am of the prima facie view that the Defendant is not the prior adopter or user of the marks in question and not entitled to any rights thereon.

53. I am further of the prima facie view that upon comparison of the rival products and features which are tendered across the bar and which have been referred to hereinabove, the Defendant's adoption of the impugned mark and its representation, independently as well as in conjunction with the impugned label, impugned tagline and impugned identification mark and the overall trade dress in respect of its R-SEAL products, are violative of the rights of the Plaintiff and this is not a matter of co-incidence. No attempt has been made by the Defendant to explain or justify the adoption of the impugned mark / impugned features or deceptive similar colour combination, its representation (including with an identical under lining of the mark beginning from the end of the first alphabet), label, identification mark as well as tagline. I find no substance in the Defendant's contention that the colours used by the Defendant in respect of its packaging label are natural colours and would not cause any confusion amongst the public at large.

54. It is necessary to note that the Defendant has not taken

the defence of acquiescence since it is their stand that the impugned marks is different from that of the Plaintiff. Thus, the Defendant has neither pleaded nor alleged any acquiescence on the part of the Plaintiff. The Defendant has also not pleaded that it is an honest and / or concurrent user. It is now not open for the Defendant to make any submission that the Plaintiff had acquiesced in the Defendant's user of the mark and / or that the Defendant is an honest concurrent user. The decision relied upon on behalf of the Plaintiff in *ITC Limited Vs. NTC Industries Ltd (supra)* and in *Aglowmed Limited Vs. Aglow Pharmaceuticals Private Limited (supra)* have held that acquiescence must be pleaded and proved. It is settled law that when the Defendant's adoption itself is dishonest, no amount of user can create any rights in favour of the Defendant. In my prima facie view, there is no honesty in the Defendant's adoption of the impugned mark, apart from it being well settled that honesty in adoption is also not a defence to an action for infringement. The decision of this Court in *Cadilla Pharmaceuticals Limited Vs. Sami Khatib*

(supra) is apposite.

55. In the present case, the Defendant has not taken the elementary precaution of making himself aware by looking at the public record of Registrar as to whether the mark in question is the property of another. It is the contention on behalf of the Defendant that in the Examination Report which was generated through scrutiny by the Trade Marks Registry, M-SEAL had not been stated as a conflicting mark. However, the Defendant has not been able to establish that it had conducted any independent search of the public record of the Registrar as to whether the Plaintiff's mark M-SEAL was in existence during the registration of the Defendant's impugned mark. It has been held by this Court in *Bal Pharma Ltd Vs. Centaur Laboratories Pvt. Ltd.* (supra) that the Defendant by not conducting such search of public record of the Registrar has gambled by investing whatever amount it may allegedly have in its infringing mark and its usage of the infringing mark cannot be a defence to an action by a registered proprietor of a prior adopted and registered

mark. I do not find any merit in the Defendant's contention that the Plaintiff ought to have done a search of the register of Trade Marks prior to adopting the M-SEAL mark. This particularity, since the adoption, use and registration of the M-SEAL mark by the Plaintiff's predecessor in title, is admittedly prior to the registration and user by the Defendant of its mark.

56. Further, the case is not of honest and concurrent user as it is the Defendant's contention that the Defendant's mark is different from that of the Plaintiff. In any event, honest concurrent user is not a defence under the Trade Marks Act, 1999 and is merely an aspect or a pre-request for claiming the defence of acquiescence which in the present case such defence has neither been pleaded nor alleged by the Defendant.

57. The Defendant has sought to rely upon certain action taken by it against Roffe Construction Chemicals Private Limited and reliance has been placed on the judgment passed in that matter by the City Civil Court in Bangalore. I find that the case relied upon has no relevance and it makes no difference that the



judgment in that case was passed after purchase / assignment of assets of Roffe Construction Chemicals Pvt. Ltd. by the Plaintiff. This is particularly considering that the purchase / assignment of the assets of Roffe Construction Chemicals Pvt. Ltd. by the Plaintiff in the year 2004 did not include nor had any connection with the alleged mark R-SEAL which is the impugned mark in the present case. The Plaintiff was not even made a party to the proceedings. It is noted that the judgment in that case was passed in an undefended suit and does not assist the Defendant herein in any manner whatsoever.

58. I do not find any merit in the contention of the Defendant that the term “SEAL” or colour scheme of M-SEAL packaging/label is common to the trade or generic. The Defendant has been unable to produce any material in support of this contention. It is settled law that merely producing search reports or online case status in respect of certain marks lying on the register is not evidence of those marks being used or being available in the market. The burden of proving such alleged use

by third parties, lies on the party who is ascertaining and/or relying upon it. In the present case, the Defendant has not led any documentary evidence whatsoever to show the extent of sales or even the existence of sales of the alleged products bearing the marks containing the term “SEAL”. Likewise, the Defendant merely stating that the colours used by them in respect of the packaging of the impugned product are natural colours used by the companies across industries, has given no justification for adoption of colours similar to the Plaintiff’s M-SEAL packaging/label. The Defendant, on whom the burden lies, must show that the use by the trade is extensive. This has been laid down in the judgment relied upon on behalf of the Plaintiff namely *Jagdish Gopal Kamath & Ors. Vs. Lime & Chilli Hospitality Services (supra)*. This principle or requirement of proving extensive and substantial use by third parties is even applicable and binds the Defendant at the interlocutory stage has been laid down by this Court in *Pidilite Industries Limited Vs. S.M. Associates & Ors. (Supra)*. In fact, in the present case the

Defendant has admitted that it cannot produce evidence of other third parties using marks containing SEAL or the alleged “natural colours” since it does not know how to prove such use. Thus, the Defendant has admitted its failure to discharge the burden upon them to prove their contention that SEAL or the colour scheme of M-SEAL is allegedly common to the trade.

59. The Defendant having adopted, used and also fraudulently secured registration of the impugned R-Seal marks containing the term SEAL as their leading and essential features in a trade mark sense is estopped from contending that the term “SEAL” is common to trade or generic or incapable of protection or being registered in the name of various other manufactures or third parties. *Pidilite Industries Limited Vs. Jubilant Agri & Consumer Products Limited, (supra)* and *Jagdish Gopal Kamath & Ors. Vs. Lime & Chilli Hospitality Services (supra)* are apposite.

60. With regard to the arguments on disclaimer on some of the Plaintiff's marks and as to whether it negates the rights of the Plaintiff to claim exclusivity and protection thereof, this has

been already decided by this Court in the Plaintiff's own case against S.M. Associates & Ors. (Supra). This Court has in Paragraph 47 of the said decision held as under -

*“I am in respectful agreement that despite a disclaimer in respect of the word "Seal" I must have regard to the whole of the Plaintiffs mark including the disclaimed matter while deciding the question of infringement. A contrary view could lead to peculiar results. Take for instance where the disclaimed word is written in a distinctive style with embellishments within, on or around it, and the Opponents mark also consists of the disclaimed word written in the same distinctive manner. Were it open to the Opponent to contend that the disclaimed word ought to be ignored there would be nothing left to compare. Let me carry this illustration further with the modification that the embellishments in the two marks are different. If the disclaimed word is to be ignored all that would be left is the embellishments. This is not how a person in the market would view the marks while purchasing a product. There would remain an equal degree of possibility of deception and confusion as the public, being oblivious to the disclaimer would not analyze the marks as suggested by Dr. Shivade. In the circumstances, the disclaimer in the present case does not affect the Plaintiffs right to obtain an injunction for infringement.”*

61. This Court has in the above decision held that the Plaintiff's mark would have to be regarded as a whole including the disclaimed matter while deciding the question of

infringement. Disclaimers do not go to the market and a common man of average intelligence or the average consumer would have no knowledge of any disclaimers present in a trade mark registration. This is how a common man would view the marks while purchasing the product. This Court has thereby accorded judicial notice and protection to the Plaintiff's mark M-SEAL (word per se) despite the presence of, and after consideration of the very same disclaimer/condition on the Plaintiff's mark. The decision of this Court in *Serum Institute of India Limited Vs. Green Signal Bio Pharma Pvt. Ltd. (supra)* is also on these lines.

62. It is necessary to note that the Defendant's registration for R-SEAL does not have a disclaimer and by which the Defendant has sought to claim rights in their mark including SEAL, which forms the leading and essential feature thereof, whilst at the same time claiming that the same is generic. This conduct of the Defendant in taking inconsistent and contradictory stands is evidently *mala fide* by blowing hot and cold at the same time.

The decision of this Court in Jagdish Gopal Kamath & Ors. Vs. Lime & Chilli Hospitality Services (supra) is relied upon on behalf of the Plaintiff in this context is apposite.

63. Merely because the Defendant has registered its mark does not take away the power of this Court, even at interlocutory stage, to go behind the Defendant's registration and grant injunction if registration of the Defendant's marks is prima facie found ex facie illegal, fraudulent and shocks the conscience of the Court. This has been expressly held in the decision relied upon on behalf of the Plaintiff namely Lupin Vs. Johnson and Johnson (supra).

64. In my prima facie view, the Defendant's registrations for the impugned marks R-SEAL and are ex-facie illegal, fraudulent and of a nature that would shock the conscience of this Court. The Plaintiff's rectification proceedings in respect of the said registrations are pending adjudication before the Trade Marks Registry. Further, in my prima facie view, the Defendant has obtained the aforesaid registrations by playing a fraud upon the

Registrar of Trade Marks and concealing from him, the existence of the Plaintiff's prior registered marks. The Registrar of Trade Marks, being the custodian of all marks, ought to have conducted a search of the register before proceeding to accept the Defendant's applications, to ensure that the Defendant's marks are not violating the rights of any prior user or proprietor. Prima facie, the Defendant's marks R-SEAL and , being deceptively similar to the Plaintiff's registered marks M-SEAL and are violative of the rights of the Plaintiff. Accordingly, they are violative of the provisions of the Trade Marks Act, 1999 including **Section 11 of the Act** and ought not to have proceeded to registration. It is therefore evident that the aforesaid registrations of the Defendant are, including at the prima facie interlocutory stage, fraudulent and illegal, in violation of the provisions of the Trade Marks Act, 1999. Therefore, this Court has the power to go behind the Defendant's registrations and grant an injunction against the Defendant's wrongful activities with a view to secure the rights

of the Plaintiff.

65. In my prima facie view, I find that the rival marks / labels are similar and cannot sail together without any confusion. It is settled law as laid down by the Supreme Court in *Cadilla Healthcare Limited Vs. Cadilla Pharmaceuticals Limited (supra)* that while comparing rival marks, attention and stress is to be given to the common features in the two rather than on differences in essential features. Trivial and non-distinctive matters-what one might describe as mere sideshows-do not sufficiently distinguish a rival mark. This has been held in *Jagdish Gopal Kamath & Ors. Vs. Lime & Chilli Hospitality Services, (supra)*. The Defendant's similarities in the rival marks and labels which can be seen from comparison of the rival marks and which have been referred to hereinabove makes clear the obvious give away of the conduct of the Defendant and the infringing nature of the impugned marks/labels/identification mark/tagline and overall trade dress of the impugned products. It has been held by this Court in *Pidilite Industries Limited Vs.*



*S.M. Associates & Ors. (Supra)* that every intelligent copying would seek to introduce some differences or changes, however the same would not have any effect on the Plaintiff's case, as the Defendant's work has incorporated essential and substantial features of the Plaintiff's work. Thus, the rival marks / labels cannot co-exist without causing confusion and deception of the public at large and without violating the rights of the Plaintiff. The decision of Delhi High Court in *Hamdard National Foundation (India) & Anr. Vs. Sadar Laboratories Pvt Ltd. (supra)* relied upon on behalf of the Defendant is in my view irrelevant to the facts of the present case. In that case, the Court has held that there were no similarities in the words *Rooh Vs. Dil* and no injunction came to be granted. The judgment in that case is under challenge in appeal.

66. I do not find any substance in the attempt made on behalf of the Defendant to distinguish the decisions relied upon by the Plaintiff, in particular the factual distinction. What is necessary to note is that principles laid down in these decisions have

withstood the test of time and have been followed, relied upon and upheld by the Court time to time and is now settled law.

67. In view of the above findings and in particular considering that a prima facie case has been made out by the Plaintiff for grant of interim reliefs as well as balance of convenience and irreparable loss, harm and injury which will be caused to the Plaintiff if the injunction is not granted as against the Defendant's own case of prejudice caused to it, it is apparent that the balance of convenience weighs in favour of the Plaintiff. Further, the Defendant has other products apart from the impugned product and the contention of the Defendant that its business will shut down if an injunction is granted, cannot be accepted.

68. Accordingly, the following order is passed :

i) Interim Application (L) No.15502 of 2021 is made absolute in terms of prayer clause 'a' to 'd', which reads as under :

a. Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by a perpetual order and injunction of this Hon'ble Court from manufacturing, marketing, selling, advertising, offering to sell or dealing in the Impugned Products or sealants or any similar goods or any other goods bearing the impugned mark R-SEAL, or the impugned labels or the impugned tagline or the impugned sub-mark or any other mark/label identical with or similar to or comprising of the mark M-SEAL, , M-SEAL Registered Marks or the M-SEAL Label, M-SEAL Tagline, sub-mark PHATAPHAT or bearing the trade dress of the Plaintiff's products or using packaging similar to the Plaintiff's M-SEAL Product (including its features or colour schemes) ;

b. Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the M-SEAL Registered Marks of the Plaintiff bearing nos. 282168, 916539, 916538, 916540, 961689, 1347394, 982544, 982543, 1347392, and 1347391 and from using in relation to Impugned Products or any other goods for which the M-SEAL Registered Marks are registered or any goods similar thereto, the impugned mark R-SEAL, or any other mark or label which is identical with or similar to the M-SEAL Registered Marks of the Plaintiff (including the mark M-SEAL per se or ) and from manufacturing, selling, offering for sale, distributing, advertising or

*otherwise dealing with the Impugned Products or any other goods bearing the impugned mark R-SEAL or any label or mark identical or deceptively similar the M-SEAL Registered Marks or any features thereof ;*

*c. Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from infringing in any manner the Plaintiff's copyrights in the artistic work comprised in/reproduced on its M-SEAL Label(s) and from reproducing/ copying the said artistic works or any substantial part of the said artistic works on the Defendants' Impugned Products (including those depicted at Exhibits H to the Plaint) or any bottles, cartons, packaging material or advertising material, literature or any other substance and from manufacturing, selling, offering for sale, distributing, advertising or otherwise dealing with any Impugned Products or other similar products upon or in relation to which any labels or works infringing the said artistic works have been reproduced or substantially reproduced ;*

*d. Pending the hearing and final disposal of the suit, the Defendants, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents and all other persons claiming through or under them or acting on their behalf or under their instructions be restrained by an order and injunction of this Hon'ble Court from committing the tort of passing off and from manufacturing, marketing, selling, advertising, distributing, offering to sell or otherwise dealing in any manner in the Impugned Products or any similar goods or*

*any other goods bearing the impugned marks R-SEAL, or the impugned labels or the impugned tagline or the impugned sub-mark or any other mark/label identical with or similar to or comprising of the mark M-SEAL, , M-SEAL Registered Marks or the M-SEAL Label, M-SEAL Tagline, sub-mark PHATAPHAT or bearing the trade dress of the Plaintiff's products or using packaging similar to the Plaintiff's M-SEAL Product (including its features or colour schemes);*

- ii) The interim Application is accordingly disposed of.
- iii) There is no order as to costs.

**[R.I. CHAGLA, J.]**