



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

INTERIM APPLICATION NO. 2119 OF 2025

IN

COMMERCIAL IP SUIT NO. 366 OF 2025

Empire Spices and Foods Limited,]
Having its registered office at]
A-305, Damji Shamji Corporate Square,]
Laxmi Nagar, Ghatkopar (East),]
Mumbai – 400 075.] **...Applicant**

In the matter between :

Empire Spices and Foods Limited,]
Having its registered office at]
A-305, Damji Shamji Corporate Square,]
Laxmi Nagar, Ghatkopar (East),]
Mumbai – 400 075.] **...Plaintiff**

Versus

Sanjay Bhimraoji Deshmukh]
Trading as M/s. Sanskriti Spices,]
Having address at]
Plot No. 11, Hari Om Colony,]
Kathora Road, Amravati – 444604,]
Maharashtra.] **...Respondent/Org. Defendant**

Mr. Pranshul Dube, Ms. Asma Nadaf for Plaintiff.
Mr. Amit Jamsandekar, Ms. Archita Gharat, Mr. Vighnesh Kamat i/by Mr. Shoeb Parkar for Defendant.

Coram : Sharmila U. Deshmukh, J.

Reserved on : 13th June, 2025.

Pronounced on : 30th June, 2025.

ORDER :

1. The instant application seeking interim relief for infringement of trade mark, copyright and passing off has been moved after notice to the Defendant. In context of relief of passing off, the plaint pleads that the Defendant's goods are available in Mumbai, however, by way of abundant precaution Petition under Clause XIV of Letters Patent(Mumbai) is filed. The Affidavit in reply disputes that the Defendant's goods are available in Mumbai. In absence of any submissions on jurisdictional issue *qua* the relief of passing off and the leave Petition being pending, I have considered the reliefs only in respect of infringement of trademark and copyright.

FACTUAL MATRIX:

2. To establish the Plaintiff's proprietary right in the registered trade mark, the history set out by the Plaintiff is that in the year 1972, one Ramvilas Motilal Rathi coined and adopted the trade mark "RAM BANDHU" which was used in relation to spices, papad, pickle and other food products. The registration of mark "RAM BANDHU" was applied on 25th January, 1993 by one Rambandhu Masalewale Pvt. Ltd. with user claim of 1st December, 1972 and was granted registration on 13th October, 2006. The Plaintiff claims to have been merged with Rambandhu Masalewale Private Limited under order of National Company Law Tribunal dated 21st February, 2018.

3. It is stated that the Plaintiff applied for registration of trade mark "RAM BANDHU" on 5th October, 2012 under Application No. 2406504 in class 30 with user claim of 1st December, 1972 and was granted registration on 15th January, 2015 vide Certificate No. 1197780 and on same date applied for registration of trade mark "RAM BANDHU" under Application No. 2406505 in class 30 with user claim of 1st December, 1972, which was registered on 20th January, 2015 vide Certificate No. 1198463. On 22nd May, 2021, the Plaintiff filed Form TM-P for taking over as subsequent proprietor of the mark which was allowed by the Registry.

4. To demonstrate the goodwill and reputation, the sales turnover certified by the Chartered Accountant and the promotional material is appended to the plaint. It is stated that the brand "RAM BANDHU" has been endorsed by renowned celebrities and the Plaintiff's products under the trade mark has substantial presence in the market and is a well-known mark. It is submitted that the Plaintiff is owner of artistic work "RAM BANDHU" both in Hindi and English which was created by one Mr. Dnyaneshwar M. Bachhav in the year 2002.

5. As far as presence of Defendant is concerned, it is stated that in the year 2014, the Plaintiff having noticed the Defendant's mark "SHREE RAM BANDHU" issued cease-and-desist notice to the Defendant. Upon conduct of market search, the Defendant's goods

could not found in the market and it was assumed that the Defendant has discontinued the use of its mark. In the year 2023, the Plaintiff came across the Defendant's goods under the impugned mark "SHREE RAM BANDHU" which led to issuance of further notices on 27th March, 2023 and 15th October, 2024. The response of Defendant was by letter dated 12th November, 2024 contending that the Defendant's mark which has been in use since the year 2004 is not similar to the Plaintiff's trade mark and claimed acquiescence on the part of Plaintiff for failure to take action after 2014 notice.

6. It is stated that the Defendant had on 24th May, 2004 applied for registration of label mark "SHREE RAM BANDHU PAPAD MASALA" in class 30 which was a blatant copy of the earlier logo of Plaintiff, which was abandoned. On 7th April, 2023, the Defendant applied for the mark "SHREE RAM BANDHU" claiming user since 1st April, 2004, in which objection was raised under Section 11(1) citing the Plaintiff's trade mark and absence of any supporting invoices to claim user since 2004. On 1st January, 2025, one day prior to scheduled hearing before the Trade Mark Registrar, the Defendant filed invoices as proof of use of the mark "SHREE RAM BANDHU", which according to the Plaintiff, are handwritten and completely fabricated. It is submitted that the Defendant's mark is structurally, visually, phonetically and deceptively similar to the Plaintiff's mark and the Defendant has also copied the

underlying artistic work.

7. The grant of interim relief has been opposed by the Defendant alleging delay, laches and acquiescence as despite being aware of its presence since 2014, no action was taken and thus acquiescence. It is submitted that the use of the label by the Defendant is honest and *bona fide* being ardent devotee of Lord Ram and that it is common practice in India to use God's name in business and on the product. The continuous use is contended since the year 2003-2004 of the composite label containing the words "SHREE RAM BANDHU" in usual bold font over a dark background. The sales turn over in the year 2022-2023 is stated to be about Rs. 68,97,604/- and that substantial funds have been spent on promotional activities. It is contended that the Defendant, which is proprietorship firm is in process of collating old records and have annexed documents which were readily available. It is stated that there can be no exclusivity asserted in the mark "RAM BANDHU" and the prefix "SHREE" gives sufficient distinctiveness. It is stated that the Plaintiff had applied for word mark in the year 1984, which was existing till the year 1991 and thereafter, was consciously not renewed knowing well that no rights can be claimed in the word mark "RAM BANDHU" *per se*. It is stated that the Plaintiff cannot indirectly claim exclusivity over some part of the label mark. It is submitted that in absence of any particulars of valid assignment of

rights in the artistic work from the alleged author to the Plaintiff, no ownership can be claimed in the artistic work. It is submitted that the rival trade marks are distinct and different and there is no likelihood of confusion and deception.

SUBMISSIONS:

8. Mr. Dube, learned counsel appearing for Plaintiff would submit that in the year 1993, the registration of device mark "RAM BANDHU" with prior use of 1st December, 1972 was granted with disclaimer as regards the descriptive matter, i.e. Papad Masala. He submits that in the year 2012, the Plaintiff was granted registration of the device mark "RAM BANDHU" and upon merger of the Plaintiff's predecessor with the Plaintiff under NCLT order of 21st February, 2018, the Plaintiff has taken over as subsequent proprietor of the mark. He would further point out to the invoices of the year 1994 to show user of the registered mark. He would submit that the sales turn over certified by the Chartered Accountant shows turn over of around 250 crores and the Plaintiff's product is extensively promoted through celebrity endorsement.

9. He submits that the device mark "RAM BANDHU" is nothing but a word mark and the registration certificate asserts the proprietary right in the said mark as otherwise disclaimer would have been issued. He submits that the Defendant's use of the words 'Ram' and 'Bandhu'

shows dishonest adoption of the Plaintiff's mark by the Defendant. He submits that there is no material to show the Defendant's user since the year 2004 and invoices produced for the period 2001 to 2010 are fabricated. He would further submit that there is specific pleading that after the cease and desist notice in year 2014, the use of mark had stopped as no goods of Defendant were found in the market and therefore, there is no question of acquiescence. He submits that it is well-settled that delay is not a ground for rejecting ad-interim relief in trade mark matters. In support, he relies upon the following decisions :-

Jagdish Gopal Kamath v. Lime and Chilli Hospitality Services¹

Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia²

10. *Per contra*, Mr. Jamsandekar, learned counsel appearing for the Defendant would submit that what is registered is device mark "RAM BANDHU" and not word mark as word mark could not have been registered in view of name of Hindu God 'Lord Ram'. He submits that prior user, if any, is shown of Ramvilas Motilal Rathi and Plaintiff claims to have been merged in the year 2018 under the order of NCLT without the order of NCLT on record. He submits that the Plaintiff's case of being subsequent proprietor of trade mark "RAM BANDHU" is under cloud as invoices annexed to the Plaint of 12th October, 1994 shows

1 2015 SCC OnLine Bom 531.

2 (2004) 3 SCC 90.

that order was placed for printing of brochures whereas plaintiff pleads that in the year 2018, the Plaintiff merged with the erstwhile Ram Bandhu Masala Private Limited. He would submit that the Plaintiff has further suppressed the fact that in the year 1984, the word mark "RAM BANDHU" was registered which was subsequently abandoned and there is no response to the same. He submits that as the word mark was abandoned by the Plaintiff in the year 1991, the Defendant had adopted the same in the year 2000. He submits that there is no merit in the submission of fabrication of invoices as the Plaintiff is proprietor and the invoices were written by Proprietor himself.

11. He would further submit that the Plaintiff cannot claim any exclusivity over name of deity which is the settled position in law. He submits that as the Defendant did not apply for the registration of word mark but device mark and Section 17 of Trade Marks Act, 1999 would come in a way of Plaintiff and he cannot claim exclusivity over a part of the registered device mark. He would further submit that false statement has been made in the statement of truth as the registration of 1984 has been suppressed. He would distinguish the judgment relied upon by Mr. Dube to contend that the decision of ***Jagdish Gopal Kamath v. Lime and Chilli Hospitality Services*** (supra) will not apply in case of name of deity being used as trade mark.

12. He submits that delay and acquiescence militates against grant

of interim relief as the first cease-and-desist notice was issued in the year 2014 pursuant to which no action was taken and the second and third notices issued in the year 2023 does not even mention the notice of 2014 or that the Plaintiff assumed that the Defendant had discontinued the use of the mark. He submits that in the response it is specifically mentioned that the Defendant is conducting his business since the year 2001 continuously without interruption. He would further submit that the Defendant is a proprietorship firm who enjoys goodwill and reputation in the market, which is evident from the sales figure given in the Affidavit-in-reply.

13. He would further submit that there is no cause of action for claiming infringement of copyright as it is admitted that artistic work was created by Dnyaneshwar M. Bachhav in the year 2002 and there is no written assignment as mandated by Section 19 of the Copyright Act, 1957. He would further submit that during the pendency of present proceeding, the Defendant was agreeable to change in color scheme which shows its *bona fides*. In support, he relies upon the following decisions :-

Freudenberg Gala Household Products Private Limited vs. GEBI Products³

³ Notice of Motion No. 1530 of 2015 in Suit No. 758 of 2015.

Freudenberg Gala Household Product Pvt. Ltd. vs. GEBI Products⁴

Lal Babu Priyadarshi vs. Amritpal Singh⁵

Bhole Baba Milk Food Industries Ltd vs. Parul Food Specialities (P) Ltd.⁶

Bhole Baba Milk Food Industries Ltd. vs. Parul Food Specialities Pvt. Ltd.⁷

Cadila Healthcare Ltd. vs. Diat Foods (India)⁸

Registrar of Trade Marks vs. Ashok Chandra Rakhit Ltd.⁹

14. In rejoinder, Mr. Dube would submit that the judgments relied by Mr. Jamsandekar are distinguishable as the same were rendered where the use was of sole name of deity whereas the claim of the Plaintiff is of infringement of trade mark "RAM BANDHU". He submits that the Defendant is free to use the name of deity but not the entire label mark of "RAM BANDHU". He submits that the entire device mark has been copied by the Plaintiff including the color scheme. He submits that there is no question of acquiescence as some positive act on part of the Plaintiff has to be shown. He submits that the registration of the word mark "RAM BANDHU" in 1984 was by Ramvilas Motilal Rathi

4 Commercial Appeal No. 72 of 2017 in Notice of Motion No. 1530 of 2015, decided on 1st August, 2017.

5 (2015) 16 SCC 795.

6 2011 (121) DRJ 536.

7 2011 SCC OnLine Del 4422.

8 2010 SCC OnLine Del 3445.

9 1955 SCC OnLine SC 12.

who was trading as proprietor of Ram Bandhu Masala in the year 1984 and not by the Plaintiff. He submits that as the Plaintiff is registered proprietor of device mark, it is the owner of the artistic work.

REASONS AND ANALYSIS:

15. The discussion on merits would entail consideration of the following broad issues:

(a) Whether the Plaintiff is registered proprietor of the trade mark "RAM BANDHU" and is entitled to maintain an action for infringement of trade mark.

(b) Whether the Plaintiff claims exclusivity over part of device mark which by reason of registration of trade mark "RAM BANDHU" as device mark would obstruct the claim of exclusive right part of device mark in view of Section 17 of Trade Marks Act.

(c) Whether the Plaintiff cannot claim monopoly over the device mark "RAM BANDHU" which contains the name of Hindu God "Lord Ram" and the Defendant's use of the mark is honest and bonafide adoption.

(d) Whether the absence of written assignment of copyright on record bars the Plaintiff from seeking relief in respect of infringement of copyright in the artistic work.

(e) Whether in view of delay and acquiescence it is inequitable

to grant interim relief in favour of the Plaintiff.

PROPRIETARY RIGHT OF PLAINTIFF IN THE REGISTERED MARK:

16. Upon perusal of the pleadings in the plaint, which are sketchy, there is no clarity as to the devolution of rights in the registered trade mark in favour of the Plaintiff. The action for infringement is based on the proprietary rights in the registered mark acquired by the Plaintiff pursuant to order of merger passed by NCLT in the year 2018. Though the merger is stated to be of the year 2018, the pleading is that the Plaintiff applied for registration of the mark on 5th October, 2012 i.e. prior to the order of merger. To compound the confusion, the invoices appended to the plaint of the year 1994 shows that the present Plaintiff had placed the order for printing of "RAM BANDHU" pouches, which has not been explained in the plaint.

17. Despite the pleadings not being specific and clear, what enures to the benefit of the Plaintiff is the records of the Trade Mark Registry which *prima facie* establishes that the Plaintiff has been brought on record of Trade Mark Registry as subsequent proprietor of the registered mark. The legal proceeding certificates and the extract from the online status of the Trade Mark Registry bear *prima facie* testimony to the fact of the Plaintiff being subsequent proprietor. At interim stage, there has to be *prima facie* satisfaction that the Plaintiff is entitled to maintain an action for infringement, which is evidenced

from the material on record. The question of the invoices appended to the plaint raised by the Plaintiff in the year 1994 in respect of the products marketed under the "RAM BANDHU" mark is a question which will have to await trial.

18. The history of registration of the trade mark shows that first application for registration of the device mark "RAM BANDHU" in Class 30 with user claim from 1st December, 1972 was in 1993, which was granted with disclaimer of descriptive matter. The second registration and third registration was of device mark "RAM BANDHU" both in English and Marathi language applied on 5th October, 2012 and granted. The history data shows that pursuant to a request on Form TM-P dated 22nd May, 2021 and order dated 5th January, 2022, the present Plaintiff has been brought on record as subsequent proprietor in respect of the registered trade mark. Section 31 of the Trade Marks Act, 1999 confers *prima facie* validity upon the registration of the trade mark.

19. Section 29 of Trade Marks Act, 1999 which deals with infringement of trade mark provides that registered trade mark is infringed :

(a) If a person not being the registered proprietor or permitted user;

(b) uses in course of trade;

(c) a mark identical with or deceptively similar to the trade mark in relation to goods in respect of which the trade mark is registered.

The burden is upon the Plaintiff to establish that the Defendant's mark is identical or deceptively similar to the registered trade mark.

20. As an action for infringement is based on the impugned mark being identical or deceptively similar to the registered mark, it would be apposite to examine the rival marks which are reproduced below:

Plaintiff's mark	Defendant's mark
	

21. Upon *prima facie* comparison, as far as Plaintiff's registered trade mark is concerned, the device mark has an elliptical shape with colour combination of red, white and black. The mark "RAM BANDHU" is written in white against red background, the mark having white and black boundary. The Defendant's trade mark has rectangle shape with curved boundary bordering close to the elliptical shape of the Plaintiff's mark. The Defendant's mark uses a negligible yellow

background in addition to the use of similar colour combination of red, white, black. The Defendant's mark with prefix "SHREE" to the words "RAM BANDHU" is written identically inside the rectangle shape in identical white colour against red background having outline of white and black.

22. Upon perusal of the Plaintiff's mark what strikes the eye immediately are the words "RAM BANDHU" written in white against red background which form its essential feature. Infringement takes place when the essential features of the mark have been copied. The entire mark of the Plaintiff is subsumed in the Defendant's mark with the prefix "SHREE". The added word has no significance in case of infringement as the copying of the essential features of the registered trade mark amounts to infringement but will be a matter for consideration in an action for passing off where the Defendant could escape the liability by showing that the added material distinguishes the Defendant's goods from that of the Plaintiff. The Defendant has adopted identical colour combination, layout of the registered mark with its mark written in particular font inside the rectangle shape in respect of identical goods, which cannot be mere coincidence. The adoption of identical/deceptively similar trademark *prima facie* indicates a dishonest intention of the Defendant to come as close as possible to the Plaintiff's registered trade mark. It is well settled that

rival marks have to be viewed from the aspect of average consumer with imperfect collection and the question that begs consideration is whether an average consumer would be in state of wonderment and would be confused by the two marks. *Prima facie*, in my view, the Defendant's mark is so deceptively similar and almost identical to the Plaintiff's mark that it would cause confusion in the mind of an average consumer and the consumer is most likely to associate the Defendant's product with that of the Plaintiff. The right which is conferred upon the Plaintiff by virtue of being registered proprietor thus *prima facie* entitles it to assert the exclusive right to use the same and to restrain the Defendant from using the mark.

DEFENCES RAISED BY THE DEFENDANT:

23. The pivotal defenses raised by the Defendant are (a) In view of the mark being registered as device mark, no right can be claimed in part of the trade mark which is not registered separately and (b) there cannot be any exclusivity claimed over the name of the Hindu God "Lord Ram". A distinction is attempted to be made between a device mark and word mark by the Defendant on the assumption that the Plaintiff's mark being registered as device mark, no exclusivity could be claimed in the words forming part of the device mark. A similar argument of absence of right to claim exclusivity on part of device mark was raised in case of *Jagdish Gopal Kamath vs. Lime & Chilli*

Hospitality Services (supra) where the issue concerned the mark "CAFE MADRAS". The Co-ordinate Bench held in paragraph 25 as under:

"25. But I will take the Defendant's case at its best, and will assume that the Defendant is correct that the Plaintiffs' registration is of a device mark. What of it? It is not enough merely to say, "here is a device; I do not use the device; therefore there is no infringement." We must, of necessity, consider what is the essential, prominent and leading feature of that mark, by whatever name called (label, device, composite, word). Even if the Defendant's case is to be accepted, there is nothing essential or prominent in that so-called device other than the words 'Café Madras'. This is what is protected. It is no answer at all for the Defendant to say that it has used those very words but in some other stylization and, consequently, that there is no infringement. There is simply no basis for this in trade mark law; indeed, it defeats the statutory purpose and intent, for it would then be open hunting season on every single such registration : every infringer could then claim a different 'style' or 'font' or placement and thus dilute a mark duly registered, and which registration remains unchallenged."

24. The objection on claim of exclusivity on part of the mark is founded on Section 17 of the Trade Marks Act, 1999. Section 17 deals with effect of registration of parts of a mark and confers upon the proprietor right on the use of trade mark as a whole and restricts the conferment of exclusive right in the matter of forming only part of or whole of the trade mark so registered. Section 17 envisages a situation where there are several matters comprising part of the trade mark in which case the registration of the trade mark would confer exclusivity on the proprietor to use the trade mark as a whole. In the case of ***Pidlite Industries Ltd. v. Jubilant Agri and Consumer Products Ltd***¹⁰ where Section 17(1) came up for consideration and the Hon'ble Apex

10 2014 SCC OnLine Bom 50.

Court held as under:-

"16.2 It is true that the registration of a composite mark confers upon the registered proprietor a monopoly over the trademark taken as a whole. It is not the Plaintiff's contention that the registration of a composite mark confers upon the registered proprietor exclusivity over each and every constituent part thereof (no matter how minuscule or insignificant it may be in relation to the mark considered as a whole). The Court therefore has to examine the mark as a whole. As a part of this evaluation process, the Court is required to determine what is/are the prominent and/or essential features of the mark taken as a whole. The protection and/or exclusivity will be conferred on these features and not on insignificant trivia. This Court has therefore at the outset after considering the relevant factors prima facie come to the conclusion that the word 'MARINE' forms a prominent and/or essential feature of the registered trademark (considered as a whole). If the Defendant's arguments are accepted, the consequences will be startling. Composite marks will become useless. The same will be infringed with impunity by the simple expedient of using a trademark which has, as its essential or prominent feature(s), the essential and prominent feature of the registered mark with the addition of other matter. The mandate of Section 17(1) will be totally frustrated."

25. As already discussed above, the prominent/essential feature of the registered trade mark are the words "RAM BANDHU". The test laid down by the Hon'ble Apex Court when applied to facts of present case, would entitle the Plaintiff the right to protect its essential features. There is another aspect of the matter to be considered. What happens when there is no other distinctive thing or prominent feature apart from the words. The mark "RAM BANDHU" is nothing else but the words. There is no "part" of the "whole" which is distinguishable to apply the provisions of Section 17 of Trade Marks Act, 1999. The entirety of the mark is subsumed in the Defendant's mark. As the

words "RAM BANDHU" itself forms the registered mark, the same are required to be protected and it is no defence to say that the words have not been registered separately. Pertinently, the definition of mark as contained in Section 2(m) of the Trade Marks Act, 1999 includes name, signature, word, letter or any combination thereof.

26. Coming to the contention of absence of commercial exclusivity claimed over use of name of deity, the position is well settled as evident from the decisions cited by Mr. Jamsandekar. In case of ***Bhole Baba Milk Food Industries Ltd. vs. Parul Food Specialities (P) Ltd.*** (supra) the Plaintiff claimed an exclusive right over the use of the word 'Krishna' which came to be rejected holding that the word "Krishna" is a common name, name of god/deity and is descriptive of Hindu God and cannot be the exclusive proprietary right of any one person.

27. In the decision in the case of ***Freudenberg Gala Household Products Private Limited vs. GEBI Products*** (supra), the decision in the case of ***Bhole Baba*** (supra) was considered in the context of the Plaintiff's mark which was a word of Goddess "LAXMI" and in that factual scenario, the exclusive right to use the name of the Goddess came to be rejected. Pertinently, in that case, the Co-ordinate Bench held that claiming a device or label mark is one thing and claiming word monopoly is another and no case was made out that the Defendant is using the device or label similar to that of Plaintiff. The Co-ordinate

Bench was considering the use of rival marks "LAXMI" and "MAHALAXMI".

28. There is no quarrel with the proposition of law laid down by the decisions, however the applicability of these decisions to the present case presents the difficulty. Both in *Bhole Baba* (supra) and *Freudenberg Gala Household Products Private Limited* (supra), the Courts were concerned with the use of standalone name of Hindu deity, whereas in the present case, the Plaintiff's device mark is not the sole name of deity but a combination of two separate common words 'Ram' and 'Bandhu'. The word 'Ram' is the name of Hindu God and 'Bandhu' is a sanskrit word for friendship/kinship/relationship. Separately used, there can be no exclusivity claimed in the words 'Ram' and 'Bandhu' but the moment the name of the Hindu deity is used in combination with the word "BANDHU", it loses its significance as name of deity and is registrable. The suffix of word "Bandhu" makes all the difference. The combination of these two words "RAM" and "BANDHU" is a coined word and arbitrary adaption being totally unconnected with the goods marketed under the trade mark which gives rise to claim for exclusivity. Mr. Dube would concede to the position in law that there cannot be any claim of exclusivity in respect of name of Hindu deity and submits that he has no objection if the Defendant uses the name of the Hindu God in isolation and his

objection is to the combination of words "RAM BANDHU" which has acquired distinctiveness in relation to the Plaintiff's product.

29. The decision in the case of *Lal Babu Priyadarshi* (supra) in fact, assists the case of the Plaintiff as it holds in Paragraph 19 that using the exclusive name of the book "RAMAYAN" for getting it registered as trade mark for any commodity could not be permissible under the Act. If any other word is added as suffix or prefix to the word "RAMAYAN" and the alphabets or design or length of the words are same as of the word "RAMAYAN" then the word "RAMAYAN" may lose its significance as a religious book and it may be considered for the registration as trade mark.

30. The decision of *Registrar of Trade Marks vs Ashok Chandra Rakhit Ltd* (supra) cited by Mr. Jamsandekar arose out of order of Registrar inserting disclaimer of the word "Shree" forming part of the Respondent's company therein registered trade mark "Shree Durga Charan Rakhit". The High Court held that the Respondent Company had never claimed any right to exclusive use of the word "Shree". The Hon'ble Apex Court noted that the material before the Registrar appearing on the Affidavit filed by Respondent Company clearly indicated that the Respondent was claiming a proprietary right to the name "Shree" and called its mark "Shree". It is in that context the Hon'ble Apex Court noted that where a distinctive label is registered as

a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of trade mark to use of any particular word or name contained therein apart from the mark as a whole.

31. The decision of *Ashok Chandra Rakhit Ltd* (supra) was distinguished by the Hon'ble Apex Court in *Ramdev Food Products (P) Ltd vs. Arvindbhai Rambhai Patel*¹¹ as under:

"80. In *Ashok Chandra Rakhit Ltd*. whereupon reliance has been placed by Mr Nariman, this Court was concerned with a proprietary mark of "Shree". It was claimed that the mark "Shree" was a trade mark apart from the device as a whole and it was an important feature of its device. The respondents were carrying on business in the name and style of Shree Durga Charan Rakshit. It was in the peculiar factual background obtaining therein, this Court, referred to the decision of Lord Esher in *Pinto v. Badman* to say that where a distinctive label is registered as a whole such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole. This Court in the aforementioned factual backdrop opined: (SCR pp. 268-69)

"This, as we have already stated, is not quite correct, for apart from the practice the Registrar did advert to the other important consideration, namely, that on the evidence before him and the statement of counsel it was quite clear that the reason for resisting the disclaimer in this particular case was that the Company thought, erroneously no doubt but quite seriously, that the registration of the trade mark as a whole would, in the circumstances of this case, give it a right to the exclusive use of the word 'Shree' as if separately and by itself it was also its registered trade mark and that it would be easier for it to be successful in an infringement action than in a passing-off action. It was precisely the possibility of such an extravagant and untenable claim that called for a disclaimer for the purpose of defining the rights of the respondent company under the registration."

(emphasis supplied)

The said decision has no application to the fact of this case.

81. Mr Nariman is also not correct in contending that only a

¹¹ (2006) 8 SCC 726.

label has been registered and not the name 'Ramdev'. Definition of 'mark' as contained in Section 2(j) of the 1958 Act also includes name, signature, etc.

82. Section 28 of the 1958 Act confers the right of registration whereas Section 29 thereof provides for the remedies for infringement of trade mark. What is needed by way of cause of action for filing a suit of infringement of trade mark is use of a deceptively similar mark which may not be identical. What would be deceptively similar, as defined in Section 2(d) of the 1958 Act, would be a mark if it nearly resembles that other mark as to be likely to deceive or cause confusion. It is, therefore, not a case where the respondents could raise valid defence in terms of Section 29 of the 1958 Act."

32. In the facts of *Ramdev Food Products (P) Ltd* (supra), injunction was sought against the Defendant's use of "Ramdev" alleging infringement of the Plaintiff's trade mark "Ramdev Masala". The defence raised was that the Defendant had no exclusive statutory right to use "Ramdev" apart from the label citing Section 17 of Trade Marks Act and decision of *Ashok Chandra Rakhit Ltd* (supra). In facts somewhere similar to the present case, the Hon'ble Apex Court has distinguished the decision of *Ashok Chandra Rakhit Ltd* (supra).

33. The doctrine of estoppel also prohibits the Defendant from raising the defence of non exclusivity as the Defendant has itself applied for registration of its trade mark "SHREE RAM BANDHU". A party cannot be permitted to approbate and reprobate. The fact that the Defendant applied for registration of its mark postulates acceptance by the Defendant of its distinctiveness. Mr. Jamsandekar supports the contention by relying upon the word mark "RAM

BANDHU” in the year 1984 which has subsequently been abandoned in the year 1991. As far as registration of word mark is concerned, firstly, the fact that the word mark “RAM BANDHU” was registered and was in subsistence from 1984 to 1991 indicates the validity of registration. Secondly, the word mark was registered by the Ramvilas Motilal Rathi trading as Ram Bandhu Masalewale. The abandonment of the word mark in the year 1991 cannot *prima facie* be construed as inherent incapability of registration of the mark “RAM BANDHU” as word mark.

DELAY AND ACQUIESCENCE:

34. The cease and desist notice was issued in the year 2014 and the suit was filed in the year 2025 which according to the Defendant militates against grant of interim relief to the Plaintiff. As far as delay is concerned, it is settled that mere delay cannot come in the way of grant of injunction in trade mark infringement matters. [See ***Midas Hygiene Industries (P) Ltd. vs. Sudhir Bhatia*** (supra)]. The defence here is not only delay but delay and acquiescence which is also sufficiently answered by Co-ordinate Bench in ***Jagdish Gopal Kamath v. Lime and Chilli Hospitality Service*** (supra). In the said decision, the Co-ordinate Bench noted the decision of the Delhi High Court in ***Hindustan Pencils Pvt Ltd vs. India Stationery Products***¹² which held that in law, the question arises where the proprietor of a mark, being

¹² AIR 1990 Delhi 19.

aware of his rights and being aware that the infringer may be ignorant of them, does some affirmative act to encourage the infringer's misapprehension so that the infringer worsens his position and acts to his detriment. A mere failure to sue without a positive act of encouragement is no defence and no acquiescence. A defendant who infringes the plaintiff's mark with knowledge of that mark can hardly be heard to complain if he is later sued upon it.

35. Before accepting the defence of acquiescence as the cease and desist notice was of the year 2014, the Defendant was enjoined to show *prima facie* some positive act on part of the Plaintiff and not a mere omission to take any action. There is thus no acquiescence demonstrated by the Defendant to make it inequitable to grant interim relief.

HONEST AND BONAFIDE ADOPTION:

36. The adoption of the mark "Shree Ram Bandhu" is claimed to be a honest and *bona fide* adoption for the reason that the adoption was of the name of Lord Ram and it is common for businesses to adopt the name of the God as part of its trade name. The submission is flawed as the Defendant's mark is not standalone name of Lord Ram but the coined word "RAM BANDHU". The certificate of registration would *prima facie* demonstrate user claim since the year 1972 of the device mark "RAM BANDHU" by the Plaintiff's pre-decessor in respect of

same class. At this stage, I am not inclined to go into the issue of the Defendant's invoices being false or fabricated. That adjudication can await trial. Assuming user by Defendant since the year 2004, the Plaintiff is the prior user since 1972. It is not the case of the Defendant that prior to the adoption of the mark in the year 2004, the Defendant had taken search of the Trade Mark Registry to ascertain whether there was prior user of the mark. The mark "RAM BANDHU" is an arbitrary adoption and makes no reference to the goods sold under the said label. The case would have been different if the Defendant had only used the name of the Hindu god prefix of "Shree". The difficulty has arisen as the Defendant has subsumed the entire mark of the Plaintiff as its trade mark. Since the Defendant was late player in the market and the Plaintiff having *prima facie* demonstrated prior user since 1972, the adoption of the mark "Shree Ram Bandhu" cannot be accepted to be honest adoption of label since the year 2000.

NO ASSIGNMENT OF COPYRIGHT:

37. The admitted position is that the artistic work in the device mark is the creation by one Mr. Bachhav and there is no deed of assignment of copyright placed on record. The position in law is that an artistic work can be both copyrighted and also be used as a trade mark and the device mark, if registered under the Trade Marks Act, 1999, the original artistic work in label receives protection if used to identify and

distinguish goods of the Plaintiff. Even otherwise, as the defence of prior user of art work or that the Plaintiff's artwork is not original is not *prima facie* demonstrated by the Defendant, the contention does not deserve acceptance.

38. In ***Cadila Healthcare Limited vs. Diat Foods (India)*** (supra), the Hon'ble Delhi High Court called upon the Respondent therein as to whether the Respondent was willing to change the carton where equal prominence could be given to mark so that the mark would be used in a descriptive where the Respondent was not willing to the said position, it has been pressed by Mr. Jamsandekar to support the submission that he is willing to change the color scheme of his label as and by way of interim arrangement, this offer has been rejected by Mr. Dube and rightly so, as the purpose would not suffice in view of the deceptive similarity between the Defendant's mark and the Plaintiff's mark. It is not merely the color scheme which when changed would distinguish the goods of the Defendant from that of the Plaintiff, but only when the Defendant's mark, i.e. "RAM BANDHU" is removed from the Defendant's trade mark that a likelihood of confusion with the Plaintiff would be diluted. The decision therefore, does not assist the case of the Defendant.

39. In light of the above discussion, *prima facie* case has been established that the Plaintiff has the exclusive right to use the device

mark "RAM BANDHU". In event interim relief is not granted irreparable harm and loss will be caused to the Plaintiff as the trade label of the Defendant is deceptively similar to that of the Plaintiff and is likely to cause confusion and indicate association with the Plaintiff's product diluting the Plaintiff's goodwill. Being user of the marks since 1972, balance of convenience is in favour of the Plaintiff. Accordingly, Interim Application is made absolute in terms of prayer clauses (a) and (b) which reads thus:

"(a) pending the hearing and final disposal of the suit, the Respondent by itself, and/or its partners and/or proprietors and/or servants and/or agents and/or officers and/or dealers/distributors and/or any other person claiming through and/or under such Respondent, be restrained by an order and injunction of this Hon'ble Court from using the impugned mark 'SHREE RAM BANDHU' and/or any mark which is identical or phonetically/deceptively similar to the Applicant's Trade mark 'RAM BANDHU' in any manner whatsoever, so as to infringe upon the Applicant's Trade mark 'RAM BANDHU' registered under No.589176, 2406504 and 2406505 in class 30;

(b) pending the hearing and final disposal of the suit, the Respondent by itself, and/or its partners and/or proprietors and/or servants and/or agents and/or officers and/or dealers/distributors and/or any other person claiming through and/or under such Respondent, be restrained by an order and injunction of this Hon'ble Court from using the pirated artwork 'SHREE RAM BANDHU' as depicted in Exhibit V to the Plaint and/or any other similar artwork so as to infringe upon the subsisting copyright in the Applicant's original artistic work 'RAM BANDHU' as depicted in Exhibit T to the Plaint respectively;"

[Sharmila U. Deshmukh, J.]

40. At this stage, request is made for staying this order for the period of four weeks. The said request is opposed by learned counsel

appearing for Applicant/Plaintiff, however, I am inclined to stay the order for the period of four weeks.

[Sharmila U. Deshmukh, J.]