

HIGH COURT OF CHHATTISGARH, BILASPUR(Judgment Reserved on 21.11.2022)(Judgment Delivered on 19.12.2022)MA No. 101 of 2022

{Arising out of order dated 19.10.2022 passed by the Judge, Commercial Court (District Level), Nava Raipur, Chhattisgarh in Commercial Suit Class A/3/2022}

1. ABIS Exports India Private Limited A Company Incorporated Under The Indian Companies Act, 1956, Having Its Registered Office At IB - Corporate House, Indramara Village Post Pendri, Rajnandgaon, Chhattisgarh - 491441.

---- Appellant/Plaintiff

Versus

1. Mr. Gunjam Nalode Sole Proprietor of Shri Mahavir Udyog Having Its Registered Office At Ward No. 9 Girdhar Nagar, Teacher's Colony Durg, Chhattisgarh - 491001

AND ALSO AT

Address 1- Dhamdha Road, Grage Line Karhidih Sikola Bhata, District - Durg (C.G.) 491001

Address 2- Village Samodha, Dhamdha Road, District Durg (C.G.) 491001.

Address 3- Dhillon Complex, 6942 + 4H6, Akash Ganga, Supela, Bhilai (C.G.) 490023 (Defendant)

---- Respondent/defendant

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For Appellant : Shri Nirnay Gupta, Shri Hasnain Alvi, Shri Rishabh Sharma and Shri Saumitra Kesharwani, Advocates

For Respondent : Shri Amrito Das, Shri Yashkaran Singh and Shri Shreyansh Mehta, Advocates

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Hon'ble Shri Justice Goutam Bhaduri &  
Hon'ble Shri Justice N.K. Chandravanshi

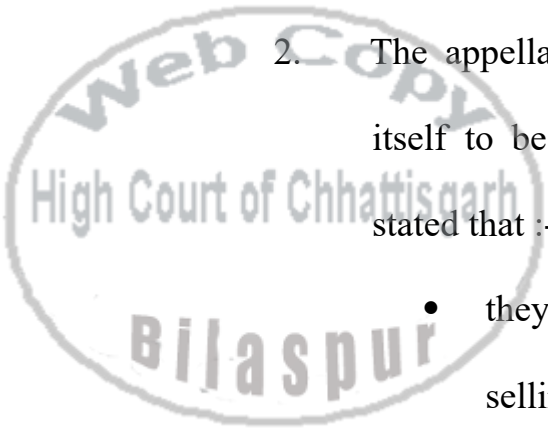
CAV JUDGMENT

Per Goutam Bhaduri, J

1. The instant miscellaneous appeal filed by the appellant/plaintiff against the order dated 19.10.2022 passed by the Judge, Commercial Court (District Level), Nava Raipur, Chhattisgarh in Commercial Suit Class-A/3/2022, whereby the application (I.A. No.1/2022) for grant of interim relief filed under Order 39 Rule 1 & 2 of the CPC has been dismissed.

2. The appellant/plaintiff ABIS Exports India Private Limited claiming itself to be a company duly incorporated under the Companies Act stated that :-

- they are engaged in the business of manufacturing and selling livestock feed, poultry products, FMCG products, edible oil, dairy products and allied range of products and also runs chain of restaurants under the well known ABIS Marks;
- the company was incorporated in the year 1985 by four brothers namely Amir Ali, Bahadur Ali, Iqbal Ali and Sultan Ali and according to their first alphabet names ABIS was established;
- the appellant and sister concerns are also engaged in Indian Agro and Food Industries and working under the company brand name ABIS;





- the product manufactured by the appellant bearing trademark ABIS is being used continuously and extensively since 1998;
- it has various offices in the State of Chhattisgarh and more than 10,000/- employees working in the offices located at Rajnandgaon, Raipur and Hyderabad, etc. and over a period of time they have received a tremendous response from the market, traders and the general public and thereby acquired goodwill and reputation over the period of time;
- with the passage of time they diversified its business in various fields i.e. manufacturing, distributing, importing, exporting, stocking, marketing and selling of various livestock feeds including poultry, fish and shrimp, poultry and dairy products, edible oil and allied range of FMCG products under the name ABIS Gold, ABIS Feed, ABIS Rice, ABIS SHRIMP, ABIS Grower, ABIS Brooder, ABIS Starter, ABIS Finisher, ABIS Silver, ABIS Rice Plus, ABIS Star, ABIS Soya Power, ABIS Star Soya, ABIS Acustar, ABIS Laziz, ABIS Soya DOC and ABIS Dairy;
- the company is also registered as ABIS Trademark. According to the appellant, apart from poultry, livestock feed and dairy products by adopting and using labels in respect of its ABIS range of products and services, one of its flagship products, being soya bean oil is manufactured and sold by





the appellant under the mark ABIS Gold and the same is being sold by the appellant since 2007;

- the appellant through its inhouse designer have designed a new artwork/packaging/trade dress for the said goods bearing the trademark ABIS Gold under the ABIS Label and was being used openly, continuously and extensively with a view to distinguish its goods from those of others;
- the appellant has also spent substantial amount of money on publicity, advertisement and sales promotion as also on research and development to popularize the said ABIS marks, ABIS label and the goods and services offered thereunder;
- the appellant spent considerable amount on advertising and promotional initiatives and for the financial year 2021-22 the sales of the appellant was to the tune of Rs.636.18 crores (approx.) and appellant had posted on the domain name [www.ibgroup.co.in](http://www.ibgroup.co.in) which is accessible to public from any part of the world;
- the appellant also offers the product in the e-commerce platform and portals and the soyabean oil under the product ABIS Gold is being sold to different purchasers and therefore, is a well known trademark under the provisions of the Trade Marks Act, 1999 (hereinafter referred to as 'the Act, 1999');





- the appellant alleged that in the year 2021 the appellant found that the respondent was manufacturing and marketing products i.e detergent cake/ washing powder & soap/hand wash/dish wash/toilet cleaners/bleaching substances under the infringement trade mark ABIS Gold, which is identical and deceptively similar to the product of the appellant ABIS label;
- having come to know about the trade mark of the respondent, the appellant conducted search on the OnLine data base/official website of the trade mark registry in various classes for the marks ABIS and ABIS Gold and found that different trade marks are registered;
- respondent's logo / label are as under :



- according to the appellant, the application of the respondent under class 3 in relation to detergent cake, washing powder, soap, hand wash, dish wash, etc. having ABIS Gold label was accepted by the trademark registry on 17.12.2020 and the registration certificate was issued on 23.05.2021, which has been objected and necessary applications have been filed by the appellant;



- the appellant came to know that the respondent is operating a website namely [www.abisgold.com](http://www.abisgold.com) to sale their goods;
- appellant claimed that appellant is the owner of the said ABIS marks which was registered in the year 2007 and contended that said domain name has been fraudulently registered by the respondent in the year 2020;
- having carried out the investigation, the appellant found that the respondent is manufacturing and marketing identical and similar products as that of the appellant by deliberately displaying marks / label on the official website and the said ABIS label is deceptively similar and confusing to the ordinary man to show that they are associated with the appellant's company;
- eventually a cease-and-desist notice was served by the appellant through its advocate asking the respondent to refrain itself from using such products being sold under the logo / label of the appellant, but it was never stopped by the respondent and subsequently a report to the police was made under Section 103 (a) of the Act, 1999. Thereafter, criminal complaint was filed; and
- according to the appellant despite the said act, the products of the respondent are found in the market and hence the civil suit was filed under Sections 134 & 135 of the Act, 1999 for permanent injunction for infringement of trademark, copy





right and passing off along with damages read with Section 29 of the Act, 1999. Along with the said suit, an injunction application was filed under Order 39 Rule 1 & 2 of CPC, which has been dismissed by the Commercial Court vide the order impugned. Thus this appeal.

3. Learned counsel appearing for the appellant/plaintiff would submit that :

- the certificate of incorporation and the very genesis of the company started with Amir Ali, Bahadur Ali, Iqbal Ali and Sultan Ali, which marks the word 'ABIS', which was incorporated in the year 1985 and thereafter with the passage of time, it acquired goodwill and reputation and associated with the general public since 1985;
- referring to range of products and the history, learned counsel would submit that the company has spent hefty amount in research and development and in the field of e-commerce, ABIS can be found with the domain name, which has attachment with the reputation, goodwill and prior user of the logo;
- under Section 2 (zg) of the Act, 1999, ABIS Gold is a well known trade mark and by effect of Section 27 of the Act, 1999 since ABIS Gold is registered as such the company is entitled to maintain the suit as being a prior user and passing off the product by the respondent;





- referring to sub-section (2) of Section 27 of the Act, 1999, learned counsel would submit that apart from the remedy under the company law, the appellant is entitled to initiate an action against any person for passing off goods or services;
- according to the appellant, the respondent/defendant was using the domain name and structure which are phonetically same and therefore, have committed a breach of Act of 1999;
- by referring to emblem of ABIS, photographs and colour, learned counsel would submit that the appellant is a long and prior user and random google search in the Internet would show the product of the appellant;
- the appellant has achieved awards, which recognized the goodwill whereas the defendant is using the logo of the appellant to sale its products;
- according to the appellant only 'iABIS' is registered whereas other application filed by the respondent for registration is being objected;
- by referring law laid down by the Supreme Court in the matter of *Laxmikant V. Patel Vs. Chetanbhai Shah and another* {(2002) 3 SCC 65}, learned counsel would submit that name under which a business trade will always be a trade mark and further would submit that whenever independently the questions of trade or service mark are in question, the name of a business







normally is attached to it and it would be a goodwill that the courts will protect and an action for passing-off will then lie;

- further referring to the law laid down by the Supreme Court in the matter of *Satyam Infoway Ltd. Vs. Siffynet Solutions (P) Ltd.* {(2004) 6 SCC 145} learned counsel would submit that the domain name of the appellant i.e. website is an intellectual property and the business identifiers, serving to identify and distinguish the business and infringement of it by passing off, the domain name shall have all the characteristics of a trade mark and an action for passing off can be found where domain names were involved;

- by placing reliance upon the decision of the Supreme Court in the matter of *Mahendra & Mahendra Paper Mills Ltd. Vs. Mahindra & Mahindra Ltd.* {(2002) 2 SCC 147} learned counsel would submit that the prayer for grant of an interlocutory injunction is at a stage when the existence of the legal right asserted by the plaintiff and its alleged violation are both contested till they are established at the trial on evidence the Court can consider the *prima facie* case. The court, at this stage, acts on certain well settled principles of administration of this form of interlocutory remedy which is both temporary and discretionary;

- learned counsel would also place reliance upon the decision of Supreme Court in the matter of *S. Syed Mohideen v. P.*





*Sulochana Bai* {(2016) 2 SCC 683} to submit that even if the registration is done the passing off could not be allowed and the use of the mark/ carrying on business under the name confers the rights in favor of the person and generates goodwill in the market and when prior user and subsequent user are registered proprietors, for the purposes of examining who generated the goodwill, the statutory rights would prevail over the common law which is proper remedy than that of infringement; and

- lastly by placing reliance upon the decision of the Supreme Court in the matter of *Midas Hygiene Industries (P) Ltd. And another vs. Sudhir Bhatia & others* {(2004) 3 SCC 90} learned counsel would submit that mere delay will not defeat any action under the Copyright Act and the Trade Marks Act.

4. Learned counsel appearing for the respondent, per contra, would submit that:-

- the respondent is engaged in the business of manufacturing and selling detergent cake, washing powder, soap, hand wash, dishwasher, toilet cleaners, bleaching preparation and substances for laundry use, cleaning, polishing, scoring and abrasive preparations, salt, spices, coffee, tea, rice and similar products and for the purposes of assigning an identity to such class of products marketed by the respondent, the respondent formulated and adopted the abbreviation 'ABIS', which stood for 'A Best Immaculate Surfactant' and consequently the origin,





form and essential features of the respondent's trade mark is different;

- according to the respondent, it is in active participant in the concerned industry since 2014 and the annual sales worth Rs.2,95,96,859/- for the financial year ending 31.03.2022, therefore, the respondent also maintains *ex facie* goodwill and reputation in the market for their products;
- the respondent's products fall within an entirely different class of products to that of the appellant and therefore it cannot be attached as alleged that dishonest adoption of the trade mark of the appellant;
- the respondent has obtained a valid and appropriate registration of the trade mark, which was granted to them after undergoing due scrutiny and procedure as enumerated in the Act, 1999;
- as per Section 9 (2) (a) of the Act, 1999 the trade mark being sought to be registered should not be of such nature as to deceive the public or cause confusion;
- the range of products manufactured and marketed by the appellant would be confined to the goods traded by them and the products of the appellant are falling under class 29, 30 & 31 whereas, the respondent procured registration for its products under the purview of class 3, therefore, the product being different both can co-exist;





- in order to claim "well known trade mark" as claimed by the appellant, certain procedure is prescribed under Section 11 (6), (7) & (8) of the Act, 1999 and hence without following the due process the appellant cannot claim for any passing off because the nature of goods and services of both the parties are entirely different;
- mere registration of trade mark would not allow the appellant to enjoy monopoly over the products and the respondent would submit that the meaning of the word 'ABIS' is also known as 'Lion, Brave';
- according to the learned counsel, the term 'passing off' implies that the respondent must have sold the goods in a manner which has deceived or would likely to deceive the public into thinking that the respondent's goods or services are that of the appellant, but the product being entirely different, the passing off is completely beyond imagination;
- since the product of respondent being different nature, it cannot be claimed that the deceptive market is adopted by the respondent; and
- under these circumstances, learned counsel would submit that the balance of convenience heavily lies in favour of the respondent because the appellant has failed to establish *prima facie* case in its favour and also failed to prove the irreparable loss. The order passed by the learned commercial court





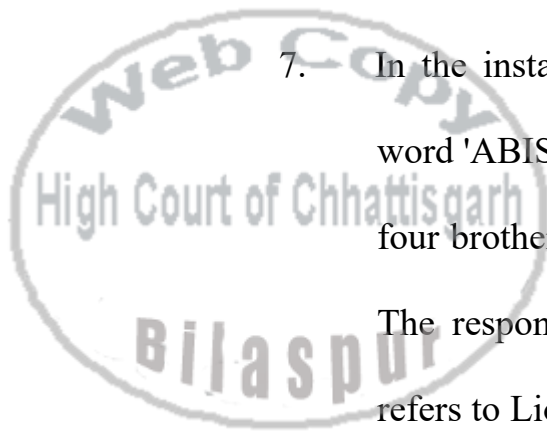
dismissing the interlocutory application of the appellant herein is just and proper, warranting no interference of this Court and hence prays for dismissal of the instant appeal.

5. We have heard learned counsel appearing for the parties at length and perused the documents appended thereto.
6. In an action for infringement or passing off, it is usual, rather essential, to seek an injunction temporary or ad-interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of.

7. In the instant case, the appellant claimed that it has a right over the word 'ABIS'. The said word derived from the first alphabet of names of four brothers namely; Amir Ali, Bahadur Ali, Iqbal Ali and Sultan Ali.

The respondent stated that the word ABIS is a generic word which refers to Lion or Brave in Pharsi and Urdu language which, *prima facie*, is correct. Thus, if the names of four brothers have been set out in such a mode, which denotes the word ABIS, it cannot be referred to only intellectual property of the appellant. The word ABIS since has different specific meaning and denotes bravery or lion cannot be construed to create a monopoly to appellant. Likewise, the use of word 'Gold' is also a common word and for use of word Gold no special rights can be claimed by the appellant.

8. The contention of the respondent that their goods are registered in a different class and there is no infringement of trade mark ABIS, which has to be judged from a business and commerce point of view and





factor such as trade channels, nature of goods and use of goods ought to be considered. The classification may not be the decisive factor but when it is claimed that registered trade mark is infringed by a person and when such question comes then the similarity of goods and service covered by such trade mark whether is likely to cause confusion in the public or an association with the registered trade mark would be a factor to be considered. The similarity of goods would include a case where the impugned goods are cognate and allied to the goods of appellant/plaintiff, for which the trademark is registered. In the instant case, the trade mark of the appellant registered for manufacturing and selling livestock feed, poultry products, FMCG products, edible oil, dairy products and allied range of products also runs chain of restaurants whereas the respondent is dealing in manufacturing and selling detergent cake, washing powder, soap, hand wash, dishwasher, toilet cleaners, bleaching preparation and substances for laundry use, cleaning, polishing, scoring and abrasive preparations, salt, spices, coffee, tea, rice and similar products. So in the case on hand, there is apparent difference of product manufactured which are used by the public at large for a different cause. Comparing the competing marks, though phonetically identical but structurally and visually do not appear to be similar trade mark that of the appellant. The appellant has an exclusive right to the use of trade mark in relation to the goods or services in respect of which the trade mark is registered, whereas the trade mark of the respondent is also registered for a different range of





product, therefore, the identity of the goods are completely different and the product of the respondent being detergent cake, soap, etc., *prima facie*, it is not likely to cause any confusion on the part of the public. The test for comparison of the two word marks was formulated by Lord Parker in *Pianotist Co. Ltd.'s* application [(1906) 23 RPC 774] as follows:

‘You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion, that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods —then you may refuse the registration, or rather you must refuse the registration in that case.’

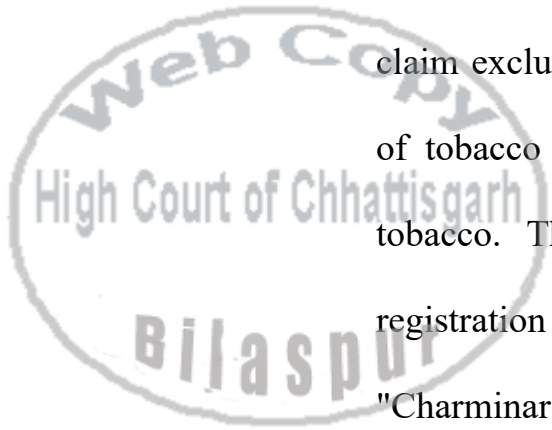
9. In order to find out the above principles whether satisfied, the respective documents were perused. It is not in dispute that the appellant's registration is with respect to goods fallen under classes 29, 30 and 31, which deals in manufacturing and selling livestock feed, poultry products, FMCG products, edible oil, dairy products and allied range of products. Whereas the respondent is engaged in the business of manufacturing and selling detergent cake, washing powder, soap, hand wash, dishwasher, toilet cleaners, bleaching preparation and substances for laundry use, cleaning, polishing, scoring and abrasive





preparations, salt, spices, coffee, tea, rice and similar products and for which the respondent procured registration for its products under the purview of class 3.

10. The Supreme Court in the matter of *Vishnudas Trading as Vishnudas Kishendas vs. Vazir Sultan Tobacco Co. Ltd., Hyderabad and Another* {(1997) 4 SCC 201} had an occasion to deal with the similar principles wherein certain manufactured tobacco under the brand name 'Charminar' was being sold. The Supreme Court held that so long such registration remains operative, the respondent Company is entitled to claim exclusive use of the said brand name in respect of articles made of tobacco coming under the said broad classification manufactured tobacco. Thereafter, when the appellant made an application for registration of *quiwam* and *zarda* under the same brand name "Charminar", such prayer for registration was not allowed. The application for rectification of the registration made in favour of the respondent Company so that the said registration is limited only in respect of the articles being manufactured and marketed by the respondent Company, namely, cigarettes. The Supreme Court held that if a trader or manufacturer actually trades in or manufactures only one or some of the articles coming under a broad classification and such trader or manufacturer has no *bona fide* intention to trade in or manufacture other goods or articles which also fall under the said broad classification, such trader or manufacturer should not be permitted to enjoy monopoly in respect of all the articles which may come under







such broad classification and by that process preclude the other traders or manufacturers to get registration of separate and distinct goods which may also be grouped under the broad classification. It further held that if registration has been given generally in respect of all the articles coming under the broad classification and if it is established that the trader or manufacturer who got such registration had not intended to use any other article except the articles being used by such trader or manufacturer, the registration of such trader is liable to be rectified by limiting the ambit of registration and confining such registration to the specific article or articles which really concern the trader or manufacturer enjoying the registration made in his favour.

11. The Supreme Court also held that if rectification in such circumstances is not allowed, the trader or manufacturer by virtue of earlier registration will be permitted to enjoy the mischief of trafficking in trade mark. The Supreme Court at para 47 held thus:-

**47.** The respondent Company got registration of its brand name “Charminar” under the broad classification “manufactured tobacco”. So long such registration remains operative, the respondent Company is entitled to claim exclusive use of the said brand name in respect of articles made of tobacco coming under the said broad classification “manufactured tobacco”. Precisely for the said reason, when the appellant made application for registration of quiwam and zarda under the same brand name “Charminar”, such prayer for registration was not allowed. The appellant, therefore, made application for rectification of the registration made in favour of the respondent Company so that the said registration is limited only in respect of the articles being manufactured and marketed by the respondent





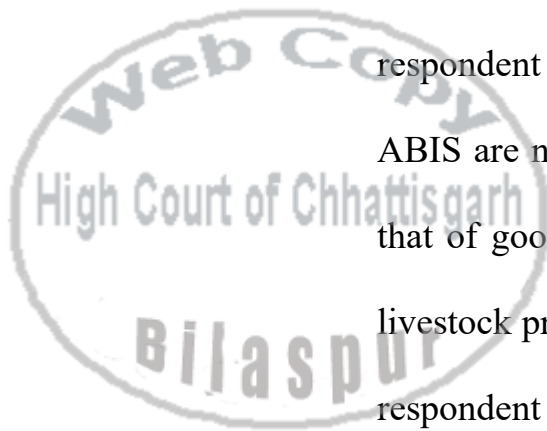
Company, namely, cigarettes. In our view, if a trader or manufacturer actually trades in or manufactures only one or some of the articles coming under a broad classification and such trader or manufacturer has no bona fide intention to trade in or manufacture other goods or articles which also fall under the said broad classification, such trader or manufacturer should not be permitted to enjoy monopoly in respect of all the articles which may come under such broad classification and by that process preclude the other traders or manufacturers from getting registration of separate and distinct goods which may also be grouped under the broad classification. If registration has been given generally in respect of all the articles coming under the broad classification and if it is established that the trader or manufacturer who got such registration had not intended to use any other article except the articles being used by such trader or manufacturer, the registration of such trader is liable to be rectified by limiting the ambit of registration and confining such registration to the specific article or articles which really concern the trader or manufacturer enjoying the registration made in his favour. In our view, if rectification in such circumstances is not allowed, the trader or manufacturer by virtue of earlier registration will be permitted to enjoy the mischief of trafficking in trade mark. Looking to the scheme of the registration of trade mark as envisaged in the Trade Marks Act and the Rules framed thereunder, it appears to us that registration of a trade mark cannot be held to be absolute, perpetual and invariable under all circumstances. Section 12 of the Trade Marks Act prohibits registration of identical or deceptively similar trade marks in respect of goods and description of goods which is identical or deceptively similar to the trade mark already registered. For prohibiting registration under Section 12(1), goods in respect of which subsequent registration is sought for, must be (i) in respect of goods or description of goods being same or similar and covered by earlier registration and (ii) trade mark claimed for such goods must be same or deceptively similar to the trade mark already registered. It may be noted here that under sub-section (3) of Section 12 of the Trade Marks Act, in an appropriate case of honest concurrent use and/or of other special circumstances, same and deceptively





similar trade marks may be permitted to another by the Registrar, subject to such conditions as may deem just and proper to the Registrar. It is also to be noted that the expression “goods” and “description of goods” appearing in Section 12(1) of the Trade Marks Act indicate that registration may be made in respect of one or more goods or of all goods conforming a general description. The Trade Marks Act has noted distinction between description of goods forming a genus and separate and distinctly identifiable goods under the genus in various other sections e.g. goods of same description in Section 46, Sections 12 and 34 and class of goods in Section 18, Rules 12 and 26 read with Fourth Schedule to the Rules framed under the Act.

12. Testing of two trade marks in order to *prima facie* view, the goods of respondent manufactured and sold under the impugned trade mark ABIS are not cognate and allied as they related to different sector than that of goods of appellant. The appellant is operating the business of livestock product, edible oil, restaurant etc. whereas the products of the respondent are detergent cake, soap, etc. Therefore, the consumer end is different which may not be confusing and, as such, we are of the *prima facie* opinion that the rival goods not being similar in nature, the case of infringement under Section 29 (2) of the Act, 1999 is not made out.
13. Section 9 (2) (a) of the Act, 1999 itself puts a rider that a mark shall not be registered as a trade mark if it is of such nature as to deceive the public or cause confusion. Respondent having been registered as ABIS, *prima facie*, it can be inferred that before such registration the official act was carried out which is required under the provisions of the Act, 1999 and, therefore, presumption of correctness would be attached to it





until rebutted otherwise. Therefore, the right of the respondent cannot be shelved unless the registration of trade mark is cancelled by the competent authorities.

14. Section 28 (3) of the Act, 1999 further contemplates that where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons as he would have if he were the sole registered proprietor. Therefore, in view of Section 28 (3) once the trademark is registered, then the appellant cannot claim preferential right as against the other registered trademark except the third party.

15. The appellant further claimed that they are the well known trademark. Section 2 (zg) of the Act, 1999 defines the 'well known trade mark' as under:-

'2 (zg) "well-known trade mark", in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.'



16. Section 11 (6) & 11 (7) of the Act, 1999 defines the procedure to declare any trademark as well known trademark. The said Section reads as under:-

**11. Relative grounds for refusal of registration.—**

xxx	xxx	xxx
xxx	xxx	xxx
xxx	xxx	xxx

(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

(i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;

(ii) the duration, extent and geographical area of any use of that trade mark;

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark;

(v) the record of successful enforcement of the rights in that trade mark; in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

(7) The Registrar shall, while determining as to whether a trade mark is known or recognised in a relevant section of





the public for the purposes of sub-section (6), take into account—

- (i) the number of actual or potential consumers of the goods or services;
- (ii) the number of persons involved in the channels of distribution of the goods or services;
- (iii) the business circles dealing with the goods or services, to which that trade mark applies.

Reading of the aforesaid provision would show that the Registrar, Trade Mark would be obliged to consider the relevant statutory rider while declaring a trademark to be a well-known trademark.

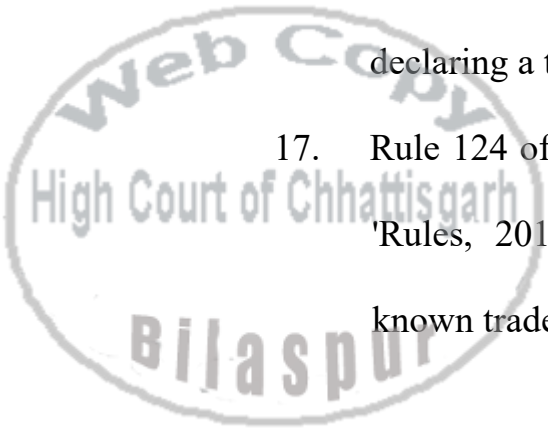
17. Rule 124 of the Trade Mark Rules, 2017 (hereinafter referred to as the 'Rules, 2017') prescribed the procedure for determination of well-known trade mark by Registrar. The same reads thus:-

**124. Determination of Well Known Trademark by Registrar.** — (1) Any person may, on an application in Form TM-M and after payment of fee as mentioned in First schedule, request the Registrar for determination of a trademark as well-known. Such request shall be accompanied by a statement of case along with all the evidence and documents relied by the applicant in support of his claim.

(2) The Registrar shall, while determining the trademark as well-known take in to account the provisions of sub section (6) to (9) of section 11.

(3) For the purpose of determination, the Registrar may call such documents as he thinks fit.

(4) Before determining a trademark as well-known, the Registrar may invite objections from the general public to be filed within thirty days from the date of invitation of such objection.



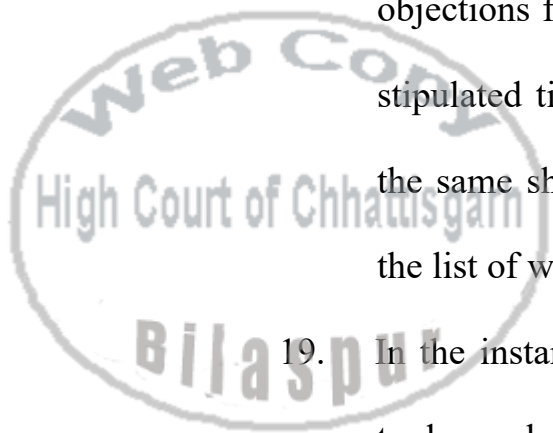


(5) In case the trademark is determined as well-known, the same shall be published in the trademark Journal and included in the list of well-known trademarks maintained by the Registrar.

(6) The Registrar may, at any time, if it is found that a trademark has been erroneously or inadvertently included or is no longer justified to be in the list of well-known trademarks, remove the same from the list after providing due opportunity of hearing to the concerned party.

18. On reading of the aforesaid provision, it is manifest that even before determining a trade mark as well known, the Registrar may invite objections from the general public to be filed in certain forms within a stipulated time and after the trade mark is determined as well known, the same shall be published in the trade mark journal and included in the list of well-known trademarks maintained by the Registrar.

19. In the instant case, though the appellant claimed itself as well-known trade mark, but nothing is on record to substantiate the same. In a passing off action, the product of the appellant and the respondent would have a significant impact. The appellant deals in manufacturing and selling of livestock feed, poultry products, FMCG products, edible oil, dairy products and allied range of products; whereas the respondent is engaged in the business of manufacturing and selling detergent cake, washing powder, soap, hand wash, dishwasher, toilet cleaners, bleaching preparation and substances for laundry use, cleaning, polishing, scoring and abrasive preparations, salt, spices, coffee, tea, rice and similar products, therefore, if an individual person goes to







purchase edible oil, certainly he would not come back with a detergent cake in his hand. Therefore, the balance of comparative hardship is missing and the misrepresentation to the public or likelihood of confusion in the minds of public or the potential customer would not, *prima facie*, exist.

20. The Supreme Court in the matter of *Laxmikant V. Patel* (supra) observed that the plaintiff must prove a *prima facie* case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction. In a case of passing off, the plaintiff does not have to prove actual damage in order to succeed in an action for passing off and likelihood of damage is sufficient. As to how the injunction granted by the Court would shape depends on the facts and circumstances of each case. The Supreme Court further held that an action for passing-off will then lie wherever the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff, or to occasion a confusion between the two businesses.
21. An action for passing off is a common law remedy, being an action for deceit. In order to find out the case of passing off, the Supreme Court in the matter of *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*, {(2001) 5 SCC 73}, laid down factors for deciding the question of deceptive similarity which are as follows “

- a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.





- b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.
- c) The nature of the goods in respect of which they are used as trade marks.
- d) The similarity in the nature, character and performance of the goods of the rival traders.
- e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.
- f) The mode of purchasing the goods or placing orders for the goods and
- g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

22. In the instant case, *prima facie*, it is manifest that both the products are entirely different. The product claimed by the appellant is in different category and it cannot be covered by a blanket monopoly to term it as a passing off. Even when no screen shots have been placed by the appellant to compare with the range of products then we are unable to appreciate how it is going to confuse in respect of domain name. In fact, the appellant is using the domain name [www.ibgroup.co.in](http://www.ibgroup.co.in) whereas the respondent is using the domain name of [www.abisgold.com](http://www.abisgold.com)

23. *Prima facie*, reading of the domain names of both the parties appear that they are different. On comparison of the domain name, it does not show that it would cause any deceptive or confusion in the mind of a purchaser who normally would be an intelligent one while dealing with



the internet purchase. Further the class of purchasers/consumers is also different. Thus, the appellant is unable to, *prima facie*, prove that the respondent has used their domain name.

24. Consequently, the balance of inconvenience and irreparable loss do not lie in favour of the appellant as the sale of detergent cake by the respondent may not suffer any loss to the business of the appellant i.e. livestock product, etc.
25. Applying the well settled principles of law, as discussed above, to the facts of the present case and for the reasons as stated *supra*, the appeal, *sans substratum*, deserves to be and is hereby dismissed.

26. There shall be no order as to cost(s).

Sd/-

(Goutam Bhaduri)  
Judge

Sd/-

(N.K. Chandravanshi)  
Judge

Gowri

Head Note

To show infringement of trademark - must be judged by their look and by their sound and also must consider the goods to which they are to be applied. Further to be considered the nature and kind of customer who would be likely to buy those goods.

व्यापार चिन्ह (ट्रेडमार्क) का अतिलंघन दर्शाने के लिये – सामान का आंकलन, उसके रूप तथा ध्वनि से किया जाना चाहिये तथा उन सामानों पर भी विचार किया जाना चाहिये, जिन पर उसे अनुप्रयोग किया जाना है। इसके अतिरिक्त ग्राहक के प्रकार तथा प्रकृति पर भी विचार किया जाना चाहिये, जो उन सामानों का संभावित क्रेता होगा।

