

2. Mr. Kamod has appeared on behalf of the plaintiff and he has advanced submissions based on the facts pleaded in the plaint, application and the rejoinder affidavit filed in the application.

3. The plaintiff is stated to be in the business of manufacturing, selling construction materials / chemicals / materials / adhesives since the year 1969 and apart from having a major presence in India, the plaintiff claims to be doing business through overseas subsidiaries internationally in North America, South America, Middle East, Africa and Asia. The present proceeding is concerned with trademarks and house marks of the plaintiff, including HEATX, FEVICOL, LW+, LW, DR. FIXIT and an artistic depiction showing two elephants, in the backdrop of Sunset, pulling in the opposite direction. It is the case of the plaintiff that the defendant is using the impugned marks to come as close as possible to the aforementioned marks in which the plaintiff claims proprietary rights, in order to illegally take benefit of the goodwill generated in favour of the plaintiff in the context of the said marks, over a considerable period of time.

4. In so far as trademark DR. FIXIT is concerned, the plaintiff claims that the same was adopted in the year 2001. The said mark of the plaintiff is used alongwith the distinctive device of a man wearing a yellow construction helmet and this distinctive

mark is used by the plaintiff for a range of its products. The said trademark DR. FIXIT of the plaintiff is registered in Classes 1 and 19, which include word mark and device / label mark registrations. Copies of the registration certificates pertaining to the aforesaid trademark DR. FIXIT alongwith its variants are placed on record at Exhibit A1 to A8. A perusal of the same shows that such registrations date back to the year 2001 and onwards. It is seen that such registrations include device mark showing a man wearing a yellow construction helmet, which the plaintiff claims as having attained distinctiveness associated with the plaintiff over a considerable period of time. In order to show that the plaintiff has indeed generated substantial goodwill in respect to the aforesaid trademark / device mark DR. FIXIT with image of a man wearing a yellow construction helmet, the plaintiff has placed on record the details of amount spent for advertisement and promotion. It is stated that for the year 2018-2019, the said amount was about Rs.96.3 Lakhs.

5. As regards, the trademark LW and LW+, it is stated that the plaintiff adopted trademark LW in the year 1993 and in or about in the year 2009, the trademark LW+ was adopted. These trademarks were adopted in conjunction with aforesaid trademark DR. FIXIT for a range of products, including active plasticizing agents, polymers and additives and for assisting in waterproofing. The plaintiff states that LW and LW+ are arbitrary and invented

marks, used in relation to the aforementioned products of the plaintiff, which have obtained distinctiveness over a period of time. The plaintiff has then referred to the registration details of the trademarks LW and LW+, placing registration certificates at Exh.D1 to D8. A perusal of the same shows that such registrations date back to the year 2012 and onwards. It is significant that such registration certificates show that the trademarks LW and LW+ are registered as trademarks alongwith trademark DR. FIXIT and depiction of a man wearing a yellow construction helmet. It is the case of the plaintiff that customers have associated these marks with the products of the plaintiff over a considerable period of time. In order to indicate the extensive goodwill, the plaintiff has placed on record the approximate sales figures in respect of products sold under the registered trademarks LW and LW+. For the year 2018-19, the said figure is shown as Rs.265.5 Crores and the advertisement expenditure for the said period is shown to be about Rs.564.4 Lakhs.

6. As regards the house mark of the plaintiff, which is a logo showing two elephants pulling in the opposite direction, in the backdrop of Sunset, it is claimed that the plaintiff created and adopted the same in the year 1979, for use in respect of its products pertaining to synthetic resin adhesives for domestic, technical and industrial use. The plaintiff has referred to the registration obtained in respect of the said logo and registration

certificates are placed at Exhibit H1 to H4. A perusal of the same would show that the registration dates back to the year 1979 and onwards. The plaintiff has also placed on record copyright registration certificates at Exhibit I1 and I2, pertaining to the said artistic depiction showing first publication in the year 2001. The plaintiff has also placed on record elaborate pleadings, as to the manner in which the aforesaid logo is associated with the products of the plaintiff, having generated immense goodwill over the years.

7. As regards the trademark HEATX, the plaintiff has pleaded that it adopted the mark in the year 2011 and commenced use of the same in February 2012. The plaintiff claims that the adhesive sold as FEVICOL HEATX can withstand temperature upto 170 degree Celsius. The plaintiff has referred to the manner in which the original label pertaining to the trademark HEATX was designed and launched in or about the year 2012 and the manner in which the trade dress was created. The plaintiff claims subsisting copyright in the same, particularly with respect to the colour scheme in the said artistic work.

8. As regards, registration of the trademarks HEATX and FEVICOL HEATX, the plaintiff has placed on record, registration certificates at Exhibit L1 and L2, which date back to the year 2011. The plaintiff has placed on record sales figures

pertaining to the registered trademark HEATX and for the year 2020-21, the sales turnover is shown to be Rs.401 Crores.

9. It is the case of the plaintiff that it has been vigilant in protecting its proprietary rights in the aforesaid trademark and artistic works and that the plaintiff was constrained to approach this Court for seeking interim reliefs / ad-interim reliefs / *ex-parte* ad-interim reliefs against entities who had infringed upon the registered trademark and committed the tort of passing off in respect of the aforesaid marks and artistic works of the plaintiff. In fact, during the course of arguments, the learned counsel appearing for the plaintiff handed over a compilation of orders passed in favour of the plaintiff in respect of the aforementioned registered trademarks, copyrights and subsisting copyrights held in the artistic works. As many as 15 such orders are found in the said compilation, wherein this Court has recognized the proprietary rights of the plaintiff.

10. The learned counsel for the plaintiff proceeded to invite attention of this Court to the impugned marks of the defendant, which the plaintiff claimed were noticed in January 2020. The plaintiff claims that the defendant has infringed registered trademarks and copyrights, as also committed the tort of passing off by using deceptively similar marks and such artistic works that are slavish copies of all the original works of the plaintiff. By

referring to the depiction of a Rhino, in the backdrop of a setting Sun, it is claimed that the same is deceptively similar and copies the aforementioned trademark and artistic work of the plaintiff showing two elephants pulling in the opposite direction in the backdrop of Sunset.

11. The defendant is using trademark HEAT-Tik for identical product of heat resistant adhesive, which according to the plaintiff infringes its registered trademark HEATX. The plaintiff further claims that the defendant has deliberately used trademark MR. ENGINEER with image of a man wearing a construction helmet and the mark LWP+, which infringes the registered trademarks, including device marks and labels, as also artistic works of the plaintiff.

12. The plaintiff has given a table of comparison and also the inquiries made in so far as the impugned marks of the defendant are concerned. It is brought to the notice of this Court that the defendant obtained registrations for its trademark TIKAWOO, showing the image of a Rhino in the backdrop of Sunset and its trademark MR. ENGINEER, showing the image of a man wearing a construction helmet. It is submitted that although registrations have been obtained by the defendant in respect of the said marks, the plaintiff is entitled to interim reliefs, pertaining to infringement as also passing off, on the touchstone

of the law laid down by the Full Bench of this Court in the case of *Lupin Limited Vs. Johnson and Johnson*¹

13. The plaintiff has pleaded in detail as to the manner in which the defendant has allegedly indulged in infringement of its registered trademarks and committed the tort of passing off while claiming that a strong *prima facie* case is made out for grant of interim reliefs during the pendency of the suit.

14. Mr. Kamod, learned counsel appearing for the plaintiff relied upon the aforesaid pleadings and documents showing registrations of trademarks and copyrights as also subsisting copyrights in the artistic works in favour of the plaintiff to contend that the defendant has indulged in infringement as well as passing off. The learned counsel for the plaintiff made submissions in respect of each of the aforementioned registered trademarks and copyrights. During the course of arguments, the learned counsel for the plaintiff relied upon the pleadings in the plaint, application for interim reliefs and the rejoinder affidavit filed in the application, to contend that the adoption of the impugned marks by the defendant is dishonest. The learned counsel for the plaintiff made submissions in respect of the defences raised by the defendant, including the claim that the registered trademarks of the plaintiff are descriptive and common to the trade. In this context, the learned counsel for the plaintiff

¹2014 SCC Online Bom. 4596.

referred to judgment in the case of *Hiralal Parbhudas Vs. Ganesh Trading Company and Ors.*².

15. The learned counsel for the plaintiff further submitted that the rival marks, as a whole, need to be appreciated for considering whether the plaintiff deserves interim reliefs and that the approach ought not to be to look at each feature in order to ascertain the difference in the individual features. In this regard, the learned counsel for the plaintiff relied upon judgment in the case of *Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.*³. The learned counsel for the plaintiff further submitted that the defendant ought to have conducted survey in the Registry of trademarks before adopting the impugned marks and for this proposition, relied upon judgment of this Court in *Bal Pharma Ltd. Vs. Centaur Laboratories Pvt. Ltd.*⁴. It was further submitted that once the trademarks of the plaintiff were registered, they ought to be considered as distinctive and that in any case, the defendant had obtained registrations subsequently in point of time, which according to the plaintiff, were not even *prima facie* sustainable. The learned counsel emphasized on the assertion of the plaintiff that the defendant had failed to place on record any reasonable justification for adopting the impugned marks and such adoption was evidently dishonest.

² 1984 PTC 155

³ (2001)5 SCC 73

⁴ 2002(24) PTC 226

16. As regards the contentions raised on behalf of the plaintiff on the aspect of trademarks of the plaintiff being common to trade, it was submitted that for supporting the said proposition, the defendant was required to prove with sufficient evidence about extensive use of such trademarks by third parties, which the defendant in the present case could not demonstrate. It was further submitted that the defendant could not be permitted to blow hot and cold as per its own convenience, since it had sought and obtained registration in respect of its marks. In this regard, reliance was placed on judgment of this Court in the case of *Jagdish Gopal Kamath and Ors. Vs. Lime & Chilli Hospitality Services*⁵. The learned counsel for the plaintiff further submitted that unless interim reliefs, as claimed are granted, the plaintiff is likely to suffer grave and irreparable loss, thereby showing that the balance of convenience is in favour of the plaintiff. It was further submitted that since the essential, fundamental and central features of the registered copyrights and the artistic works in which the plaintiff holds subsisting copyrights, were slavishly copied in the impugned marks of the defendant, a strong *prima facie* case in respect of the tort of passing off is also made out. The learned counsel for the plaintiff has also pressed for grant of the leave petition, so that interim relief in respect of passing off can also be granted. On the aspect of passing off, the learned counsel for the plaintiff relied upon judgment of the Supreme Court in the case of *Kaviraj Pandit Durga Dutt Sharma Vs.*

⁵2015 (62) PTC 23 (Bom)

Navratna Pharmaceutical Laboratories ⁶. On this basis, the learned counsel submitted that the present application deserves to be allowed.

17. On the other hand, Mr. Khandekar, learned counsel appearing for the defendant vehemently opposed the contentions raised on behalf of the plaintiff. He submitted that no case is made out for considering the prayers made in the present application.

18. The learned counsel for the defendant relied upon pleadings in the written statement and the affidavit-in-reply filed in the present application, to contend that the defendant is not a fly-by-night operator, as is sought to be portrayed by the plaintiff. The defendant claims to be well established in the business of manufacturing and trading of wide range of products. It is stated that the existence of the defendant dates back to at least 1972 and that the defendant has been in business in various fields, including petrochemicals, spinning, weaving, knitting, fabric processing, chemicals, infrastructure etc. It is stated that the defendant is a business group having thousands of employees and it has received many awards in the aforesaid fields of business.

19. The learned counsel for the defendant invited attention of this Court to each of the trademarks and the artistic depictions of

⁶(1965) 1 SCR 737

the defendant, in order to claim that there was hardly any case of the defendant having copied any of the registered trademarks, copyrights and artistic works of the plaintiff.

20. As regards device mark of the defendant associated with the word TIKAWOO, showing a Rhino with an image of Sunset in the background, it was emphasized that there was absolutely no similarity with the registered trademark of the plaintiff showing two elephants pulling in the opposite direction with Sunset in the background. It was further submitted that the registered trademark of the defendant MR. ENGINEER, showing image of a man wearing helmet is completely distinct from the registered trademark of the plaintiff DR. FIXIT, showing the image of a man wearing a yellow construction helmet, and hence there is absolutely no ground for claiming any similarity. As regards the trademark of the defendant HEAT-TIK, it was submitted that the same is clearly different from the registered trademark HEATX of the plaintiff. By referring to the stand taken by the plaintiff, during the course of proceedings seeking registration of the trademark HEATX, wherein the plaintiff was confronted with registered trademark HEATAWAY, the learned counsel for the defendant submitted that the plaintiff had no ground to raise any objection in respect of the trademark of the defendant HEAT-TIK. It is submitted that the plaintiff cannot claim monopoly over the mark HEATX. As regards, registered

trademark LW and LW+ of the plaintiff, it was submitted that the defendant was using the mark LWP+, for the reason that LWP is short form of liquid waterproofing, thereby showing that it is a descriptive term. It is for this reason that the plaintiff cannot claim any monopoly over the short forms LW and LW+ as they also pertain to liquid waterproofing. The learned counsel for the defendant also relied upon Full Bench Judgment of this Court in the case of *Lupin Limited Vs. Johnson and Johnson (supra)* to contend that even at the interlocutory stage, the plaintiff was entitled to demonstrate before this Court that the registrations of the aforesaid trademarks of the plaintiff are *prima facie* unsustainable and hence, no protection can be granted to the plaintiff in that regard.

21. The learned counsel for the defendant referred to the sales figures of its product bearing the impugned trademarks, to contend that the same had earned considerable goodwill, thereby showing that the plaintiff could not rely upon its sales figures and amount spent on advertisement and promotion to claim any benefit in that regard. It was submitted that *prima facie* no case is made out to indicate that the defendant was riding on the goodwill of the plaintiff in the context of the said trademarks and copyrights. It is further submitted that the products of the defendant with the impugned marks were in the public domain for a considerable period of time, which factor this Court ought

to take into consideration while deciding the present application.

22. Learned counsel for the defendant relied upon judgment of this Court in the case of *Reliance Industries Ltd. Vs. Concord Enviro Systems Pvt. Ltd.*⁷ to contend that no case was made out by the plaintiff for grant of interim reliefs in the context of its logo and registered trademarks. The learned counsel for the defendant further submitted that the rival marks ought to be compared as a whole and that the differences between them are so striking that no case is made out for grant of interim reliefs by the plaintiffs. In this regard, learned counsel for the defendant relied upon judgment of the Calcutta High Court in the case of *Prem N. Mayor and Ors. Vs. Registrar of Trade Marks and Ors.*⁸. The learned counsel for the defendant further submitted that the registrations obtained by the plaintiff in respect of the said trademarks were subject to restrictions stated in the registration certificates and that the plaintiff cannot be permitted to expand its proprietary rights. For this proposition, learned counsel for the defendant relied upon judgment of the Supreme Court in the case of *Registrar of Trademarks Vs. Ashok Chandra Rakhit*⁹.

23. The learned counsel for the defendant then submitted that the plaintiff could not claim infringement on the part of the defendant for use of the trademark HEAT-TIK, because the suffix

⁷2016 SCC Online Bom 4557

⁸1968 SCC Online Cal 30

⁹AIR 1955 SC 558

added to the word HEAT on the part of the defendant completely differentiated the trademark of the defendant and no case is made out for any similarity, either phonetically or structurally with the registered trademark HEATX of the plaintiff. For this proposition, learned counsel for the defendant relied upon judgments of this Court in the case of *Burroughs Wellcome (I) Ltd. Vs. American Home Products Corporation and Anr.*¹⁰, *Charak Pharma Pvt. Ltd. Vs. Glenmark Pharmaceuticals Ltd.*¹¹, *People Interactive (India) Private Limited Vs. Vivek Pahwa and Ors.*¹² and *Datamatics Global Services Ltd. Vs. Royal Datamatics Pvt. Ltd.*¹³ as also judgment of the Supreme Court in the case of *J. R. Kapoor Vs. Micronix India*¹⁴.

24. Having heard the learned counsel for the rival parties, this Court is of the opinion that interim reliefs claimed on behalf of the plaintiff need to be considered by applying the position of law brought to the notice of this Court and its application to the facts of the present case.

25. It would be advantageous to compare the rival marks as depicted on the respective products. The comparison table is as follows:

¹⁰2001 SCC Online Bom. 852

¹¹2014 SCC Online Bom 98

¹²2016 SCC Online Bom. 7351

¹³2016(6) M.H.L.J. 249

¹⁴1994 Suppl (3) SCC 215

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| <p>Plaintiff's HEATX product Exhibit O (Page 448 of plaintiff)</p> | <p>Defendant's impugned HEAT-TIK product Exhibit Q (Page 457 of plaintiff)</p> |
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| <p>Plaintiff's DR. FIXIT LW+ product Exhibit F (Page 214 of plaintiff)</p> | <p>Defendant's impugned LWP+ product Exhibit T (Page 483 of plaintiff)</p> |
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| <p>Plaintiff's DR. FIXIT LW+ product Exhibit G (Page 254 of plaint)</p> | <p>Defendant's impugned LWP+ product Exhibit T (Page 483 of plaint)</p> |
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| <p>Plaintiff's DR. FIXIT LW+ product Exhibit F (<i>inter alia</i> Pages 214, 215, 216 of plaint)</p> | <p>Defendant's impugned LWP+ product Exhibit T (Page 483 of plaint)</p> |
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| <p>Plaintiff's DR. FIXIT LW+ product</p> <p>Exhibit F (Page 214 of plaint)</p> | <p>Defendant's impugned LWP+ product</p> <p>Exhibit T (Page 483 of plaint)</p> |
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26. In the case of *Hiralal Parbhudas Vs. Ganesh Trading Company and Ors.* (*supra*), this Court explained the position of law while comparing rival marks. This Court held as follows:

5. *What emerges from these authorities is (a) what is the main idea or salient features, (b) marks are remembered by general impressions or by some*

significant detail rather than by a photographic recollection of the whole, (c) overall similarity is the touchstone, (d) marks must be looked at from the view and first impression of a person of average intelligence and Imperfect recollection, (e) overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic tests must be applied, (f) the purchaser must not be put in a state of wonderment, (g) marks must be compared as a whole, microscopic examination being impermissible, (h) the broad and salient features must be considered for which the marks must not be placed side by side to find out differences in design and (i) overall similarity is sufficient. In addition, indisputably must also be taken into consideration the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances.

27. The said principle of law has been consistently followed in a number of judgments and this Court is not referring to all of them, as it would be unnecessary. It is clear that while comparing rival marks the overall impression is to be appreciated, rather than going into each feature of the rival marks to ascertain the similarity or difference. It is a time honoured principle that the Court would apply the test of a person of average intelligence

with imperfect recollection to ascertain as to whether it can be said that the impugned marks would create confusion in the mind of such a person. The test is to be applied from the point of view of the consumer of such product. In the case of the products in question, pertaining to the construction industry, the persons buying such products are likely to go by the impression gathered from the images depicted and the words used in respect of the said products.

28. The Court can also not be oblivious of the rights available to an entity, which has registrations for its trademarks, as guaranteed under Section 28 of the Trade Marks Act, 1999. The exclusive rights obtained upon registration are, of course, subject to the limitations and riders provided under the said Act itself, but, there can be no dispute about the fact that registration does raise a presumption of distinctiveness and the right in the entity holding such registration to protection at the interlocutory stage. The Full Bench judgment of this Court in the case of *Lupin Ltd. Vs. Johnson and Johnson (supra)*, does indicate the circumstances in which the Court can grant or refuse interim reliefs if it is shown at the interlocutory stage that the registration of a mark is *prima facie* fraudulent, unsustainable or shocks the conscience of a Court. At the same time, when the defendant is resisting the grant of interim reliefs to the plaintiff, it ought to show some justification for adopting the impugned marks. In any case, the

contention pertaining to common to trade can be raised only if the defendant is found not to be playing hot and cold, meaning thereby that the aspects of common to trade or descriptive nature of the registered trademarks of the plaintiffs cannot be entertained when the defendant itself has applied or obtained registration for its marks utilizing similar words, expressions or depictions.

29. Although the learned counsel for the rival parties have relied upon to a number of judgments, reference to which has been made while recording their contentions hereinabove, this Court does not propose to discuss each one of the said judgments, for the reason that there can be no quarrel with the propositions laid down therein. It is necessary to only apply the same to the facts of the present case as it shall determine as to whether the interim reliefs claimed by the plaintiff deserve to be granted.

30. Applying the said principles to the facts of the present case, this Court will now proceed to deal with each of the registered trademarks and copyrights, as also subsisting copyrights claimed by the plaintiff, as against the impugned marks of the defendants.

31. As regards the registered trademark DR. FIXIT and the device mark DR. FIXIT, with the image of a man wearing a yellow construction helmet, the plaintiff has impugned the mark

of the defendant MR. ENGINEER, with image of a man wearing a construction helmet. It is necessary to appreciate here that the defendant holds registration in respect of its impugned mark MR. ENGINEER, with image of a man wearing a construction helmet. Thus, the registered trademark of the plaintiff is up against the registered trademark of the defendant. There is no serious doubt about the fact that the registration of the plaintiff in respect of the said trademark and the device are prior in point of time, as compared to the registration of the said impugned mark of the defendant. The documents on record show that the registration obtained by the defendant dates back to the year 2017, while that of the plaintiff was obtained much earlier. In such a situation, the rival parties have relied upon Full Bench judgment of this Court in the case of *Lupin Ltd. Vs. Johnson and Johnson (supra)*, to allege that the registration obtained by either side can be said to be *prima facie* fraudulent and unsustainable and that this aspect can be gone into at the interlocutory stage also. The conclusions of the Full Bench judgment of this Court in the case of *Lupin Ltd. Vs. Johnson and Johnson (supra)*, are relevant and they read as follows:

Conclusions:

59. In a nutshell, our conclusions are as under:

(1) The expression "if valid" in section 28 and the words 'prima facie evidence of the validity of the trade mark' in section 31 of the Trade Marks Act, 1999 (the

Act) must be given their plain and natural meaning. The plain and natural meaning is given to these phrases by various High Courts, (paras 24, 26, 29, 31, 35, 44 and 56)

(2) Though the object of providing registration of trade mark is to obviate the difficulty in proving each and every case the plaintiff's title to the trade mark, the object is achieved by raising a strong presumption in law to the validity of the registration of the trade mark and heavy burden is cast on the defendant to question the validity of the trade mark. (Paras 34, 43, 55 and 57)

(3) A challenge to the validity of the registration of the trade mark can finally succeed only in rectification proceedings before the Intellectual Property Appellate Board. However, there is no express or implied bar taking away the jurisdiction and power of the Civil Court to consider the challenge to the validity of the trade mark at the interlocutory stage by way of prima facie finding. (Paras 34 and 53)

(4) There is nothing in the Act to suggest that any different parameters for grant of injunction are required to be applied when a plaintiff seeks injunction on the basis of registered trade mark. The relief of injunction being a relief in equity, when the

Court is convinced that the grant of interim injunction would lead to highly inequitable results, Court is not powerless to refuse such relief. (Paras 35, 36 and 47)

(5) However, a very heavy burden lies on the defendants to rebut the strong presumption in favour of the plaintiff on the basis of the registration at the interlocutory stage. The plaintiff is not required to prove that the registration of a trade mark is not invalid, but only in the cases where the factum of registration is ex facie totally illegal or fraudulent or shocks the conscience of the Court that the Court may decline to grant relief in favour of the plaintiff. (Paras 25, 27 and 55).

(6) It is not sufficient for the defendant to show that the defendant has an arguable case for showing invalidity. The prima facie satisfaction of the Court to stay the trial under section 124 of the Act is not enough to refuse grant of interim injunction. It is only in exceptional circumstances, such as, the registration being ex facie illegal or fraudulent or which shocks the conscience of the Court that Court will refuse the interim injunction in favour of the registered proprietor of the trade mark. (Para 57)

(7) The Division Bench in the case of Maxheal

Pharmaceuticals considered it as the view of Vimadalal, J. that it is "the practice of this Court" to grant injunction to the holder of a registered trade mark. However, there was no sound footing for the Division Bench to recognize it as a longstanding practice of this Court. (Para 33)

(8) Though it is considered as a practice of this Court in granting injunction in favour of the plaintiff having a registered trade mark, the same cannot be treated as a total embargo on the power of the Court to refuse grant of interim injunction. In exceptional cases, that is in cases of registration of trade mark being ex facie illegal, fraudulent or such as to shock the conscience of the Court, the Court would be justified in refusing to grant interim injunction. (Para 33)

(9) As regards the controversy at hand, the provisions of the Trade Marks Act, 1999 are not comparable with the provisions of the Designs Act, 2000 and the Patent Act, 1970. (Paras 37 and 38)

32. Applying the position of law clarified by the aforesaid Full Bench judgement of this Court, it needs to be considered whether the plaintiff is justified in contending that the depiction of the impugned mark of the defendant MR. ENGINEER with image of a man wearing a construction helmet, which is a registered

trademark, is dishonest and can be said to be *prima facie* fraudulent and unsustainable. This Court has compared the rival marks. It cannot be said that the plaintiff has made out a *prima facie* case in showing deceptive similarity between the words “DR. FIXIT” and the words “MR. ENGINEER”. The comparison of the image of the man wearing a yellow construction helmet in the registered trademark of the plaintiff, with the image of the man wearing a construction helmet in the impugned mark of the defendant, would show that the plaintiff has failed to make out a strong *prima facie* case of deceptive similarity or slavish copying on the part of the defendant. On an overall comparison between the two marks, it cannot be said that merely because the defendant has also used the image of a man with a construction helmet, it would lead to a conclusion in the mind of the consumer that the registration obtained by the defendant in respect of its mark can be said to be *prima facie* fraudulent or unsustainable. The plaintiff has therefore, failed to make out a case for grant of interim reliefs in the context of the said trademark or for infringement or passing off of the copyright.

33. As regards the registered trademark LW and LW+ of the plaintiff, as against the impugned mark LWP+ of the defendant, this Court is of the opinion that the comparison of the marks indeed shows that there is deceptive similarity. The principal

contention raised on behalf of the defendant in this regard is that the plaintiff cannot claim exclusive right for the use of the marks LW and LW+ because they are short forms of liquid waterproofing, thereby indicating that the short form is descriptive in nature and that liquid waterproofing being common to trade, the registration obtained by the plaintiff in that regard, can be said to be *prima facie* unsustainable. This Court is of the opinion that the registrations of the plaintiff as regards the trademarks LW and LW+ date back to the year 2012 onwards and considering the material placed on record, this Court finds that the plaintiff has indeed made out a *prima facie* case, indicating that considerable goodwill is created in its favour as regards use of the said registered trademark in the context of the product in question. There is substance in the contention raised on behalf of the plaintiff that a strong *prima facie* case is made out for the reason that LW and LW+ have been used as unique and abstract expressions in the context of the product of the plaintiff, over a considerable period of time.

34. In contrast, the use of the mark LWP+, by the defendant and its justification as being short form of liquid waterproofing, at this stage, cannot be accepted. It is certainly not sufficient for dislodging the claim of the plaintiff about having made out a strong *prima facie* case on the basis of its registered trademark LW and LW+. In other words, the defendant has failed to satisfy the

test laid down in the Full Bench judgment of this Court in the case of *Lupin Limited Vs. Johnson and Johnson (supra)* to show *prima facie* unsustainability of the registration of the trademarks of the plaintiff LW and LW+. The defendant is not justified in claiming that LW is a short form of descriptive nature of the product i.e. liquid waterproofing or that it is common to trade. For accepting the contention pertaining to common to trade, the defendant would have to pass the stringent test of demonstrating extensive use of the said mark. At this stage, the defendant has failed to convince this Court in that regard. Hence, the plaintiff has indeed made out a case for grant of interim reliefs in respect of trademarks LW and LW+

35. As regards the registered trademark of the plaintiff and its registered copyrights in respect of the artistic works showing two elephants pulling in opposite direction with Sunset in the background, this Court is of the opinion that comparison with the impugned mark of the defendant showing Rhino with Sunset in the background, neither shows deceptive similarity nor copying of essential and fundamental features of the registered trademark and copyright of the plaintiff. Much emphasis was placed on behalf of the plaintiff on overall comparison of the marks to contend that even if the impugned mark of the defendant was using the image of a Rhino in the foreground, the impression given by the impugned mark was of deceptive

similarity and slavishly copying the trademark of the plaintiff. But, on an overall comparison of the two marks, this Court is not convinced that a *prima facie* case is made out by the plaintiff for granting interim reliefs in the context of said trademark of the plaintiff or its copyright in its artistic work.

36. At this stage, a comparison of the two marks does not *prima facie* show that the essential features of the registered trademark and copyright of the plaintiff have been copied by the defendant. Merely because Sun is shown in the background of the image of a Rhino in the impugned mark of the defendant, it cannot be said that there is either deceptive similarity or a case of slavish copying of the registered trademark of the plaintiff or artistic work in the trademark of the plaintiff, which consists of two elephants pulling in the opposite direction with Sunset in the background. Thus, the plaintiff has failed to make out a case for grant of interim reliefs in the context of said trademark.

37. In so far as the registered trademark HEATX of the plaintiff is concerned, it needs to be compared with the impugned mark HEAT-TIK of the defendant. In this regard, while resisting the prayer made on behalf of the plaintiff for grant of ad-interim reliefs, the defendant has claimed that the plaintiff cannot claim monopoly over the word HEAT, as it is descriptive in nature and that the suffix 'TIK' added to the word HEAT in the impugned

mark of the defendant, sufficiently demonstrates difference and distinction between the rival marks. It is submitted on behalf of the defendant that the stand taken by the plaintiff while claiming registration of the trademark HEATX is significant in this context, because when the plaintiff was confronted with the mark HEATAWAY, it had taken a stand contrary to the stand being taken before this Court. Reference is made to prosecution history estoppel, to claim that the plaintiff now cannot be permitted to take a different stand in the present proceedings. While this Court is of the opinion that prosecution history may become relevant in the facts of a particular case, in the present case, the same does not assume significance, for the reason that this Court has compared the rival marks. It is found that the registered trademark of the plaintiff HEATX and the impugned mark HEAT-TIK of the defendant can *prima facie* give rise to confusion. The learned counsel for the plaintiff is justified in relying upon judgment of this Court in the case of *Boots Company PLC England and Anr. Vs. Registrar of Trade Marks Mumbai and Anr.*¹⁵ to contend that if two words are spoken in a hurried manner, there is possibility of confusion, particularly when persons from different backgrounds, coming from various parts of the country, with diversity in language do tend to pronounce English words hurriedly in such a manner that confusion can indeed arise. In that context, comparing the rival marks does *prima facie* indicate that confusion is possible.

¹⁵ 2002 Vol. 104(3) Bom. L.R. 574

38. Even otherwise, this Court is of the opinion that there appears to be *prima facie* similarity between the two rival marks. Therefore, the plaintiff has made out a case in its favour for grant of interim reliefs. It is also significant that the overall colour scheme of the impugned product of the defendant with the use of the impugned mark HEAT-TIK is likely to create confusion in the mind of the consumer, when compared with HEATX presented in specific colour scheme. An overall comparison does show that the plaintiff has indeed made out a *prima facie* case in its favour for grant of interim reliefs for infringement and passing off.

39. At this stage, it would be relevant to consider the leave petition filed on behalf of the plaintiff under Clause 14 of the Letters Patent, for combining the cause of action of infringement with that of passing off. This Court has considered the leave petition. It is allowed in the interest of justice, particularly to avoid multiplicity of proceedings. This Court has perused the pleadings on record and appreciated the contentions raised by the learned counsel for the rival parties in the context of interim reliefs claimed for causes of action of infringement as well as passing off.

40. In view of the findings rendered hereinabove, this Court is of the opinion that the present application deserves to be partly

allowed. Accordingly, there shall be interim reliefs in favour of the plaintiff as follows:

(a) Pending the hearing and final disposal of the suit, the defendant, 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 are restrained by an order of injunction from in any manner manufacturing, marketing, selling, advertising, offering to sell or dealing in the impugned products or any similar goods or any other goods, bearing the trademark LWP+ and from infringing in any manner, the registered trademarks LW and LW+ of the applicant/plaintiff. Consequently, they are also restrained from using the mark LWP+ or any mark which is identical or similar to LW and LW+ i.e. registered trademarks of the plaintiff and from manufacturing, selling, offering to sale, advertising, dealing in any goods bearing the impugned mark LWP+.

(b) Pending the hearing and final disposal of the suit, the defendant, 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 are restrained by an order of injunction from in any

manner manufacturing, marketing, selling, advertising, offering to sell or dealing in the impugned products or any similar goods or any other goods so as to pass off its impugned products bearing the trademark LWP+ as and for the products of the applicant/plaintiff bearing the marks LW and LW+ or in any other manner whatsoever;

(c) Pending the hearing and final disposal of the suit, the defendant, 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 are restrained by an order of injunction from in any manner manufacturing, marketing, selling, advertising, offering to sell or dealing in the impugned products or any similar goods or any other goods, bearing the trademark HEAT-TIK and from infringing in any manner, the registered trademark HEATX of the applicant/plaintiff. Consequently, they are also restrained from using the mark HEAT-TIK or any mark which is identical or similar to HEATX i.e. registered trademark of the plaintiff and from manufacturing, selling, offering to sale, advertising, dealing in any goods bearing the impugned mark HEAT-TIK.

(d) Pending the hearing and final disposal of the suit, the defendant, 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 are restrained by an order of injunction from in any manner manufacturing, marketing, selling, advertising, offering to sell or dealing in the impugned products or any similar goods or any other goods so as to pass off its impugned products bearing the trademark "HEAT-TIK" as and for the products of the applicant/plaintiff bearing the mark "HEATX" or in any other manner whatsoever;

(e) Pending the hearing and final disposal of the suit, the defendant, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents, and all other persons claiming through or any of them or acting on their behalf or under their instructions are restrained by an order of injunction from infringing in any manner the copyright of the plaintiff in the artistic work comprising in / reproduced on its HEATX label, and from reproducing / copying the said artistic works on any substantial part of the said artistic work of the impugned products of the defendant or on any bottle, carton, packaging material or advertising material, literature or any other substance or from manufacturing and selling or offering to sale products upon or in relation to which the said artistic works have been reproduced or

substantially reproduced or by issuing copies of said works to the public.

(f) Pending the hearing and final disposal of the suit, the defendant, its directors, proprietors, partners, owners, servants, subordinates, representatives, stockists, dealers, agents, and all other persons claiming through or any of them or acting on their behalf or under their instructions are restrained by an order of injunction from in any manner manufacturing, marketing, selling, advertising, offering to sell or dealing in the impugned products or any similar goods or any other goods so as to pass off its impugned products bearing the artistic work identical or similar to the original artistic work of the plaintiff reproduced on its HEATX label, as and for the products of the plaintiff bearing the said original artistic work in which the plaintiff holds copyright.

MANISH PITALE, J.

